

P1 2012 Examiner's comments

General comments

The quality of answers provided this year by the successful candidates was on the whole good and most obtained significantly more than 50 marks. However, the overall pass rate has decreased and the marks from the candidates that failed were lower than usual.

As has been mentioned in previous examiners' comments, it is vital that the candidates read the whole question and consider what is being asked before answering. Far too many candidates had a 'shotgun' approach to answering questions, writing down everything they know in the general area of the question. On the whole this approach did not prove as effective as providing concise answers directly related to what was being asked.

As a further point, paper P1 is a test of basic UK patent law and procedure. In order to perform well, candidates should have a good knowledge of basic procedural matters such as the deadlines for filing common forms, claiming priority, filing divisional applications etc. A knowledge of which deadlines can be extended and how is essential. A review of past papers should give candidates a good idea of the types of question that are likely to be asked. Candidates are also reminded that any theme on the syllabus may be examined.

Part A

Question 1

This question required candidates to discuss the factors taken into account when calculating the amount of compensation due to an employee for an invention made in the course of their employment. The degree of knowledge shown by candidates was variable. The essential point was that the compensation should be a fair share of the benefit derived (or expected to be derived) by the employer from any of the invention, the patent for the invention, or assignment of the patent or the invention. Few candidates distinguished between the invention and the patent for the invention. Factors which determine the fair share include (but are not limited to) the nature of the employee's duties, the remuneration of the employee, the effort and skill devoted by the employee and other parties and the contribution made by the employer in both technical and commercial terms. This second part of the question was answered well.

Question 2

On the whole this question was answered well by candidates. This question required knowledge of Section 33 of the UK Patents Act which many candidates appeared to know well. The second part of the question related to the importance of registering transactions, instruments and events. The essential points here are that registration puts third parties on notice, a third party may claim the same rights if the transaction is not recorded providing they have acted in good faith and finally potentially reduced costs in any future patent infringement action. Most candidates identified the first two points but some missed the good faith requirement and also potentially reduced costs.

Question 3

The first part of this question asked candidates to discuss the nature of a divisional patent application and under what circumstances may it be filed. The main points the examiners were looking for were that the divisional is separate from and independent of the parent but takes the benefit of the filing date of the parent. A divisional application is typically filed when there is a non-unity of invention issue. All of these points were addressed well by the candidates. A point missed by many of the candidates is that a client may wish to file a divisional application to divide out the claims to which there are objections and so allow the parent application to go through to grant quickly. This would be desirable if, for example, there is a potential infringer, or to claim Patent Box relief.

The second part of the question simply asked for the time limit for filing a divisional application. This is a regular question and candidates who had prepared adequately for the exam should have been able to obtain full marks without difficulty.

Part three asked for the deadline for filing a search request on a divisional application. This was answered less well. The search request is due the later of (i) two months after filing or (ii) 12 months from priority (or filing date if there is no priority). If the divisional application is filed less than six months before the compliance deadline then it is due on filing.

Question 4

This was a very straightforward question relating to late addition of a priority claim which was answered well by most candidates. Examiners were keen to see that candidates understood the difference between (i) a situation where the second application is filed with a priority claim but outside the priority period; and (ii) a situation where the second application is filed inside the

priority period but with a missing priority claim. The remedies available are very different in the two situations. It was clear from the answers to this question that some candidates had not appreciated this.

As a general point the question gives specific dates for the filing dates of the priority applications. In order to answer the question fully candidates should give both the rules and also apply them to give concrete dates by which actions must be taken. Many candidates correctly provided the rules but then failed to apply them.

Question 5

This was a straightforward question which most candidates attempted and answered well. The main point the examiners were looking for was an understanding that any party (either alone or jointly) can apply for a patent but only a restricted range of parties can be granted the patent. Most candidates appeared to appreciate this point although there was some lack of clarity as to the parties who could be granted the patent. These fall generally into three classes – (i) inventors or joint inventors; (ii) any person(s) who before the time of the invention (1) entered into an agreement with the applicant or (2) were otherwise entitled; and (iii) any successor(s) in title to the inventor(s) or any person(s).

Part B

Question 6

The first part of part (a) of the question asked candidates to assess whether a method of designing a lawnmower blade would be considered to be an invention. This is similar to the recent ‘Halliburton’ decision and candidates who were aware of this decision answered the question well. However, it was not necessary to know this case to obtain full marks. Candidates who indicated the most relevant exceptions to patentability and gave reasons as to whether or not the invention would be excluded under these exceptions gained full marks. Some candidates decided to answer the question of whether a lawnmower blade which had been designed by the method would be patentable. This was not what was being asked.

The second part of part (a) asked candidates to assess whether an interactive television guide would be considered to be an invention. The main point examiners were looking for here was knowledge that a mere presentation of information is not regarded as an invention. As with part (a), to gain full

marks, the candidates were expected to indicate all the relevant exceptions to patentability and gave reasons as to whether or not the invention would be excluded under these exceptions.

Part (b) asked the candidates to discuss the main steps in Windsurfing/Pozzoli approach to assessing obviousness. This is fundamental case law that candidates should know well. Most candidates had the general idea but often detail was lacking. In particular many candidates had difficulty distinguishing between 'common general knowledge' and 'the state of the art'. The examiners were also looking for some comments on the nature of the person skilled in the art and what constitutes the state of the art.

Question 7

This question asked candidates to give general advice to a client who has developed a new electrical screwdriver but has now discovered a pending UK patent application for very similar subject matter. A practical advice based question of this type is normally included each year. However, in general, this question was answered poorly. When faced with general discussion-type questions of this form, candidates would do well to spend a few minutes considering the general structure of their answers to make sure all the main points have been identified.

The fundamental point here is that as things stand the application is likely to go through to grant unamended. One should therefore consider if the client's screwdriver falls within the scope of the claims on file and also set out for the client the risks associated with launching the product now.

The examiners were mainly looking for a discussion of the relative merits of filing third party observations, an application for revocation and/or a declaration of non-infringement. An advantage of third party observations is that action can be taken immediately and one may prevent the application proceeding to grant. On the other hand the client would not become party to the proceedings. In contrast, with an application for revocation the client would become party to the proceedings but one has to wait until the patent is granted before action can be taken. Very few candidates addressed the declaration of non-infringement point well. In particular few candidates were aware of the need to write to the patent proprietor for written acknowledgement of non-infringement. The examiners were also looking for some discussion of the importance of the new prior art.

A further point the candidates should have considered is what action the competitor is likely to take. The competitor cannot take action until the patent is granted but may put the client on notice with a view to obtaining provisional protection.

Question 8

The first part of this question asked candidates to discuss infringement of a process claim by dealing in the product. This required knowledge of Section 60(1)(c) of the Patents Act and was answered well by almost all candidates. A point some candidates missed was that if the product is novel then there is a presumption of infringement.

The second part related to plant varieties. This part was not answered at all well. Candidates should always expect at least one question each year on a less common area of the syllabus. This question required knowledge of Section 76A (Schedule A2).

The third part required a discussion of the patentability of methods of treatment or diagnosis. The key point the Examiners were looking for was a detailed knowledge of Section 4A(1) of the Patents Act. Marks were also awarded for a discussion of the patentability of substances or compositions for use in any such method and first and second medical use claims.

The final part required a discussion of the meaning of the term 'Unity of invention'. On the whole this was answered well. Marks were awarded for appreciation that two or more inventions shall be linked to form a single inventive concept where there exists between those inventions a technical relationship which involves one or more of the same or corresponding special technical features. A discussion of the meaning of the term 'special technical feature' was also required. Marks were also awarded for mention of divisional applications and an appreciation that non unity of invention was not a ground for post grant revocation.

Question 9

Question 9 asked for a discussion of the actions that need to be taken in respect of three patents and applications that a client has recently acquired. This was a practical question which was generally answered well by candidates.

For all three cases one should take over representation and record the assignment. Surprisingly few candidates mentioned these points.

P1 is granted and the only outstanding matter is the payment of renewal fees. Marks were awarded for checking that the last renewal fee had been paid and for recognition that if it had not been paid, the six month period for late payment had not expired.

For P2 the situation was more complex. Most candidates realised that the deadline for filing a response to the official action was today and that this deadline could be extended on request. Fewer candidates appreciated the point that the request for the extension does not need to be filed today but could be filed when filing the response.

An important point missed by some candidates was that the compliance deadline also expired today. Some candidates did not consider this point at all. Some considered it but calculated the deadline as 10 November 2012. As this fell on a Saturday it was extended to the 12th (today). All the candidates who correctly calculated the compliance deadline were aware it could be extended by filing form 52 and paying the appropriate fee.

P3 should have been straightforward. The deadline for requesting examination was 8 November 2012. Marks were awarded for checking if this had been paid and if it had not then an appreciation that the deadline could be extended to 8 January 2013.