

Notes to trainers and students about the 2018 Foundation Certificate Sample Assessment Materials Mark Schemes

1. All Patent Examination Board mark schemes for live papers are subject to the standardisation process. This includes the examiners considering where alternative and legitimate answers provided by the candidate should be added to the mark scheme.
2. This sample assessment mark scheme has not been through a standardisation process and anyone consulting these Sample Assessment Materials' mark schemes should consider points 3 – 5 below.
3. Where a question contains several parts, the examiners may award marks for relevant points irrespective of whether the candidate has made the point in the same part of the question as the mark scheme.
4. Where the mark scheme indicates a whole mark is to be awarded for an answer or part of an answer, the examiners may award a half a mark if the answer is incomplete, not precise, or partially correct.
5. The Patent Examination Board operates a positive marking policy. Marks are not deducted for incorrect answers.

**FC1 – UK Patent Law
Mark Scheme – Sample Assessment Material**

SECTION A

Question 1

With reference to *Section 1 ('Patentable Inventions') UK Patents Act 1977*, what are not inventions for the purposes of the *UK Patents Act 1977*?

8 marks

Answer

Discovery **(0.5 marks)**, scientific theory **(0.5 marks)**, mathematical method **(0.5 marks)**

Literary **(0.5 marks)**, dramatic **(0.5 marks)**, musical **(0.5 marks)** or artistic works **(0.5 marks)** or any other aesthetic creation whatsoever **(0.5 marks)**

Scheme **(0.5 marks)**, rule or method **((0.5 marks) for either)** for performing a mental act **(0.5 marks)**, playing a game **(0.5 marks)** or doing business **(0.5 marks)**, a program for a computer **(0.5 marks)**, presentation of information **(0.5 marks)**

Mention of the words 'as such' **(0.5 marks)**

Total: 8 marks

Question 2

What is meant by the phrases:

a) 'Special technical features' and

1 mark

b) 'Single inventive concept'?

2 marks

Total: 3 marks

Answer

Special technical features:

Those features which define a contribution which the invention makes over the prior art.

1 mark

Single inventive concept:

There exists between the inventions a technical relationship

1 mark

which involves one or more of the same or corresponding technical features.

1 mark

Total: 3 marks

Question 3

You have filed a UK patent application. It does not claim priority. What prior art effect do the following documents have?

a) A UK application with a filing and publication date before the filing date of your application.

1 mark

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- b) A UK application with a filing date before the filing date of your application? It has not as yet been published. **2 marks**
- c) A European application filed before the filing date of your application and published after the filing date of your application. **1 mark**
- d) A *PCT* application designating the UK as a national designation (there is no EP designation) filed before your application but published after. **3 marks**

Total: 7 marks

Answer

- a) Both novelty and inventive step **1 mark**
- b) Novelty only **1 mark**
Must be published **1 mark**
- c) Novelty only **1 mark**
- d) Novelty only **1 mark**
Must have entered into GB national phase **1 mark**
Translation filed if not in English **1 mark**

Total: 7 marks

Question 4

With reference to Section 60 (*'Meaning of infringement'*) *UK Patents Act 1977*, what is meant by contributory infringement?

5 marks

Answer

Whilst the patent is in force **0.5 marks**
without the consent of the proprietor **0.5 marks**
supplies or offers to supply **0.5 marks**
in the United Kingdom **0.5 marks**
a person other than a licensee or other person entitled to work the invention **0.5 marks**
with any of the means relating to an essential element of the invention **0.5 marks**
for putting the invention into effect **0.5 marks**
when he knows or it is obvious to a reasonable person in the circumstances **0.5 marks**
that those means are suitable for putting **0.5 marks**
and are intended to put **0.5 marks**
the invention into effect in the United Kingdom. **0.5 marks**

Total: 5 marks

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Question 5

On what grounds may a UK patent be revoked?

5 marks

Answer

The invention is not patentable.

1 mark

The patent was granted to a person who was not entitled.

1 mark

The specification does not disclose the invention clearly enough and completely enough for it to be performed by a person skilled in the art.

1 mark

The matter disclosed in the specification of the patent extends beyond that disclosed in the application for the patent as filed.

1 mark

The protection conferred by the patent has been extended by an amendment which should not have been allowed.

1 mark

Total: 5 marks

Question 6

With reference to Section 14 (*'Making of an application'*) *UK Patents Act 1977* what requirements must the claims of a UK patent application satisfy?

3 marks

Answer

Define the matter for which the applicant seeks protection.

0.5 marks

Be clear and concise.

1 mark

Be supported by the description.

0.5 marks

Relate to one invention or a group of inventions.

0.5 marks

Which are so linked so as to form a single inventive concept.

0.5 marks

Total: 3 marks

Question 7

On what grounds may the validity of a UK patent be put in issue before a UK court?

5 marks

Answer

The invention is not a patentable invention.

1 mark

The patent was granted to a person who was not entitled to be granted the patent.

1 mark

The specification does not disclose the invention clearly and completely enough for it to be performed by a person skilled in the art.

1 mark

The matter disclosed in the specification for the patent extends beyond that disclosed in the application as filed.

1 mark

The protection conferred by the patent has been extended by an amendment which should not have been allowed.

1 mark

(Section 74)

Total: 5 marks

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Question 8

UK patent application B claims priority from UK patent application A.

- a) **What test must the subject matter of A satisfy in relation to the invention of B for the priority claim to be valid?**

1 mark

UK patent application B was filed exactly 12 months after the filing date of UK patent application A. On reviewing the file a week later you notice the priority claim to application A was accidentally omitted.

- b) **How would you proceed and by when?**

2 marks

- c) **Can this deadline be extended?**

1 mark

Total: 4 marks

Answer

- a) The invention of B must be supported by the subject matter of A.

1 mark

- b) File form to include priority claim
and pay fee
by 16 months from priority.

0.5 marks

0.5 marks

1 mark

- c) Cannot be extended.

1 mark

Total: 4 marks

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SECTION B

Question 9

Your rather unscrupulous client, Mr D Geezer, has arranged a visit to ask for your opinion on various aspects of his business practice.

For each of the following aspects, provide notes to advise Mr D Geezer, limiting your advice to UK patent law only.

- a) **I intend to just name myself as sole inventor for any invention made by any of my employees. My employees have agreed to this.**
3 marks
- b) **We often copy the products of our competitors. We intentionally do not check to see if they have patents because if we do not know about it we are not guilty.**
5 marks
- c) **For one product we are copying, we are aware that our competitor has a published patent application covering it. We intend to keep on manufacturing until the patent is granted then stop so that we do not infringe the patent.**
4 marks

You receive a letter from another client, Mrs G Plaice, as follows:

One of my employees invented something which is becoming commercially very valuable. The contract of employment states that anything invented by an employee is the property of my company and that employees have no financial claim on profits from any inventions they may invent.

Write a memo to advise your client on:

- d) **what significance the statement in the contract of employment would have regarding the claim on profits on any award of compensation to the inventor;**
1 mark
- e) **where the employee would need to apply for compensation and by when; and**
2 marks
- f) **what factors would be taken into account when determining if an award is to be made in an employee's favour.**
5 marks

Total: 20 marks

Answer

- a) **Inventorship is a question of fact and not of agreement and cannot be assigned.**
1 mark
 - An employee can seek to have the designation of inventorship corrected.** 1 mark
 - Filing a statement of inventorship requires filing a statement as to how title is derived.**
1 mark
 - It would be difficult for Mr Geezer to do this.**
1 mark
- 3 marks**

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- b) Damages/account of profits are not awarded against a defendant who proves that at the date of infringement he was not aware and had no reasonable grounds for supposing that a patent existed. **1 mark**
The burden of proof lies with the infringer **1 mark**
and is a heavy one. **1 mark**
Cannot rely on Section 62 if the copied product is marked as patented with the patent number. **1 mark**
5 marks
- c) Can recover damages committed between publication and grant. **1 mark**
The act must infringe the patent as granted and published. **1 mark**
If the patent is granted with claims of different scope, the amount of damages awarded is reduced **1 mark**
where it was not reasonable to expect the patent would be granted covering the act of infringement. **1 mark**
4 marks
- d) The additional term in the contract of employment is probably of no value – a court is unlikely to consider the additional term to be binding. **1 mark**
- e) Application must be made to the Comptroller or the court. **1 mark**
Must be made within the period from grant to one year after it has ceased to have effect. **1 mark**
2 marks
- f) The employee must show the patent is of 'outstanding benefit' having regard to the size and nature of the employers undertaking. **1 mark**
It must also be 'just' to make an award in the employees favour. **1 mark**
Some mention of 'the course of normal duties' or similar wording. **1 mark**
5 marks

Total: 20 marks

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Question 10

Part A

You have been asked by a client to file a request that the UK Intellectual Property Office notifies you of certain events relating to patents and applications owned by a third party.

Write a memo to your client advising them:

a) how you would proceed; **3 marks**

b) what events (for both patents and patent applications) the UK Intellectual Property Office will notify you of. **7 marks**

In relation to UK patent applications:

c) who, apart from the Comptroller, may inspect any unpublished UK patent application, and for what purpose. **1 mark**

Part B

Your client owns a large number of bicycle racks which they make available to their employees to store their bicycles whilst at work. This is the only use the client makes of the bicycle racks. The racks are manufactured by the company next door. Your client has received a letter from a third party, the essence of which is that they intend to sue your client for both manufacture for sale of the cycle racks and also sale of the cycle racks. They intend to do this as soon as their unpublished patent application is granted. Your client is aggrieved by this.

d) What advice would you give your client in relation to:

i) infringement; and **3 marks**

ii) threats? **6 marks**

9 marks

Total: 20 marks

Answer

Part A

a) File form **1 mark**
identifying the relevant event **0.5 marks**
and paying the fee. **0.5 marks**
One form must be filed per event. **1 mark**
3 marks

b) For applications – **0.5 marks**
The applicant requesting (or failing to request) examination **0.5 marks**
Publication **0.5 marks**
Notice of grant **0.5 marks**

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Application terminated or withdrawn.	1 mark
For granted patents –	
A request for an opinion under Section 74(A) (validity or infringement)	1 mark
Patent ceasing to have effect by reason of Section 25(3) (renewal fee)	0.5 marks
Renewal fee and additional fee being paid in the period specified in Section 25(4).	0.5 marks
Application for restoration.	0.5 marks
For both patents and applications –	
An entry being made in the register	0.5 marks
A document becoming available by reason of a restriction no longer applying.	0.5 marks
An application to register a transaction, instrument or event.	1 mark
	7 marks
c) The Secretary of State	0.5 marks
in connection with the subject matter of Section 22(6).	0.5 marks
(Will also accept third party threatened with infringement of an unpublished application (1 mark).)	
	1 mark

Part B

d) Firstly, as regards infringement, keeping the racks may be an infringement even though it has not been mentioned by the third party.	1 mark
Obtain a copy of the unpublished application from the UK Intellectual Property Office (Section 118(4)) and advise as to infringement.	1 mark
Did the manufacturer provide any warranty as regards infringement?	1 mark
As regards the threat re manufacture for sale, this is not an actionable threat.	1 mark
As regards the threat re sale, this is an actionable threat.	1 mark
The third party may have a defence if they used their best endeavours without success	0.5 marks
to discover the identity of the person who made the bicycle racks	0.5 marks
and they notified your client of this at the time of making the threat	1 mark
identifying the endeavours used.	1 mark
	9 marks

Total: 20 marks

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Question 11

- a) Inspection of the register of the UK Intellectual Property Office shows that a patent has been marked 'licences available as of right'. What does this mean? **2 marks**
- b) What is the procedure for endorsing a patent as 'licence of right'? **11 marks**
- c) Explain when the holder of a licence of right can bring proceedings for patent infringement. **2 marks**
- d) What is the liability of the licensor in infringement proceedings brought by the licensee? **2 marks**
- e) What is the difference between a sole licence and an exclusive licence? **1 mark**
- f) Why is this difference important in infringement proceedings? **2 marks**
- Total: 20 marks**

Answer

- a) That any person **0.5 marks**
shall be entitled as of right to a licence under a patent on such terms
as may be settled by agreement **0.5 marks**
or, in default of an agreement, by the Comptroller **0.5 marks**
on the application of either party. **0.5 marks**
- b) An application for entry is made to the Comptroller. **1 mark**
The Comptroller notifies any licensee or other person shown in the register as having
an interest in or under the patent. **1 mark**
If the Comptroller is satisfied that the proprietor is not precluded by contract from
granting licences **1 mark**
a notice is published in the patents journal. **1 mark**
- The Comptroller may on application by the holder of a licence granted under the patent
before the entry was made **1 mark**
order the licence to be exchanged for a licence of right on terms so settled. **1 mark**
- If in proceedings for infringement of the patent the defendant undertakes to take a
licence **1 mark**
no injunction shall be granted **1 mark**
and damages shall not exceed double the amount which would have been payable if
such a licence on those terms had been granted before the earliest infringement. **1 mark**

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- Such an undertaking can be given at any point before final order without admission of liability. **1 mark**
- Renewal fees are halved. **1 mark**
- 11 marks**
- c) If the proprietor refuses **0.5 marks**
or neglects to bring proceedings within two months of being asked by
the licensee **0.5 marks**
- the licensee may institute proceedings for infringement in his own name **0.5 marks**
making the proprietor a defendant. **0.5 marks**
- 2 marks**
- d) A proprietor so added as defendant shall not be liable for costs or expenses **1 mark**
unless he enters an appearance and takes part in the proceedings. **1 mark**
- 2 marks**
- e) An exclusive licence excludes the patent proprietor, whereas a sole licence
f) does not. **1 mark**
- 1 mark**
- g) An exclusive licensee can bring proceedings for patent infringement, **1 mark**
h) whereas a sole licensee may not **1 mark**
depending on the terms of the licence. **2 marks**

Total: 20 marks

Question 12

Your client, Great Gears Ltd, owns UK patent GB1234567 relating to a gear assembly. You receive the following email from a director of Great Gears Ltd:

We have recently become aware of a competitor, Britney Gears Ltd, who has started manufacturing and selling an almost identical gear assembly. We have checked the status of our patent online and have found it has lapsed due to non-payment of a renewal fee. We are surprised by this as we use a renewal reminder service to send us reminders but we never received the reminder. Our default instructions to the reminder service are to pay a renewal fee in the absence of instructions from us. What can we do?

Prepare notes for a meeting with your client, restricting your answer to issues relating to patents only. The notes should contain advice to your client in relation to both actions your client could take and also third-party rights.

20 marks

Answer

Sections 28, 28A and 62 of the Patents Act 1977:

1. If the renewal fee was due in the last six months: **1 mark**
- Pay late with surcharge **1 mark**
 No rights are lost **1 mark**

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- Begin infringement proceedings. **1 mark**
2. If the renewal fee was due more than 19 months ago (will also accept 13 months from the end of the six-month period for late payment of the renewal fee) **1 mark**
then there is nothing that can be done. **1 mark**
3. If the renewal fee was due between 6 and 19 months ago, apply for restoration: **1 mark**
- Must show that failure to pay the renewal fee was ‘unintentional’ **1 mark**
 - Evidence required **1 mark**
 - Statement about default instructions useful evidence **1 mark**
 - Statement from renewal reminder service regarding failure to send a reminder **1 mark**
 - and failure to pay the renewal fee in absence of instructions useful. **1 mark**

Third-party rights:

If the manufacture/sale started in the six months when the renewal fee could have been paid late (**1 mark**), then there are no third-party rights (**1 mark**).

If manufacture/sale started after that the notification of non-payment (**0.5 marks**) but before an application for restoration is published (**0.5 marks**), then:

If this was done in good faith (**1 mark**), Britney Gears Ltd can continue to do the act (**1 mark**).

Some discussion of the words ‘the act’ (**1 mark**).

Does not extend to granting a licence (**1 mark**).

Customers of Britney Gears Ltd may deal in the product as if it came from Great Gears (**1 mark**).

Total: 20 marks