

Examiner's Comments on P1, November 2004

Question 1

Part a) required the listing of the grounds of section 72 of the Patents Act. Paraphrasing the words of the Act gained marks quickly. (5 marks were available)

Part b) – Section 72 (1) specifies who may file a revocation application, although the commentary in the Black Book also is helpful. (1½ marks)

Part c) - Candidates were expected to state that revocation actions could be filed before the Patent Office, the High Court (aka the Patents Court) or the Patents County Court. A small percentage of the total marks available were awarded to the few candidates who mentioned the relevant courts in Scotland, Northern Ireland and the Isle of Man. (1½ marks)

Part d) - Revocation applications can be filed even after expiry, surrender or lapse, although there were no marks in this instance for specifying the good reasons why someone might do that. In the case of entitlement proceedings, Section 72(2)(b) specifies that it is the launching of entitlement proceedings that must be made within a certain period, not the revocation application which may depend on it. (2 marks)

Question 2

The provisions relating to licences of right (Section 46) which would be relevant to someone considering marking their patent in this way are: the reduction in renewal fees (one half the amount), how the application for a licence of right entry in the register could be made, under what circumstances the Comptroller would make an entry in the register, what the effect of this in infringement proceedings would be, and how to revoke a licence of right entry. (6 ½ of the 10 marks were available for licence of right issues.)

The timing of the payment of renewal fees is relevant. For late payment the first month is without fine but the fine increases with every subsequent month that it is late. There is no loss of rights if the renewal fee is paid within six months of it being due. No discussion of the likelihood of restoration was required, only a brief comment on how fees were to be paid at the required times. Anyone can pay the fees (e.g. proprietor's patent agent, friend or family member), or the proprietor could have paid them by mailed cheque from overseas. (3 ½ marks)

Question 3

Part b) relates to the Section 1(2) exclusions. A mark went to those who mentioned the “only to the extent that a patent ... relates to that thing as such” qualifier. A mark was available for specifying that a technical contribution removed an invention from an excluded category. (7 marks total)

A mention of inventions unpatentable for reasons other than not being inventions was not required.

Question 4

Part a) required mention only that a form and a fee were required (1½ marks).

Parts b) and c) required more. Rule 94 concerns how an applicant can, within 14 days of filing a document, request that the Comptroller prevent the document being publicly accessible. Suitable reasons are required before the Comptroller will exercise their discretion. Peripheral issues are documents filed in relation to Section 40 compensation proceedings, and documents which are sent to the Patent Office for inspection and return. The provisions of Section 118 subsections (4) and (5) were relevant to part c). (8 ½ marks)

Question 5

Marks were available for stating the provisions of Section 125(1) or Article 69 EPC, and the provisions of the Protocol to Article 69 EPC. Marks were available also for stating the Catnic/Improver/Protocol questions, although some marks were awarded to Candidates who discussed the reasoning and conclusions of the Catnic or Improver decisions without stating the questions. There should be mention what the variant needs to have a material effect on, the time when it must have been obvious to the skilled person that the variant would have no material effect, what the answer to a question must be before moving onto the next question.

Question 6

This question required the discussion of two cases, one having novelty as a main issue and another having inventive step as a main issue. The discussion required was not limited to the novelty/inventive step of the case, and most candidates correctly discussed other issues in their selected cases. Some cases could be discussed more than others, and the marking allowed for this so as not to penalise candidates who discussed larger cases. Discussions of cases which did not have novelty or inventive step as a main issue, and discussions of EPO cases, attracted no marks.

The identities of the parties and a summary of the facts and issues contended was required. With cases such as Windsurfer, General Tire and Lux Traffic, a discussion of the terms of the independent claims (Lux involved two patents as well as two alleged infringers), and a comparison thereof to each important piece of prior art, was

rewarded. Marks were awarded for correctly identifying the decision on each point argued in the case (e.g. in respect of each prior art attack), and for identifying precedents set.

Question 7

Mostly the question concerned UK national phase entry of a PCT application, although there were also a few marks for discussing peripheral issues.

A small number of marks were available for identifying the relevant issues, since this is part of the skill required of a patent agent.

Part a) was for a maximum of 11 marks and required a listing of the documents and fees (although not the fee amounts) needed to enter the UK national phase. The question clearly stated that there had been no amendments and that there was no priority claim, so no marks were available for discussing these matters. If early entry into the national phase is required, this must be explicitly requested. To get rapid grant, it is necessary to request accelerated examination and to give a reason for this. Mere combined search and examination is not enough.

Although the question did not specifically request it, maximising infringement remedies is clearly a relevant issue. 2 additional marks were available for mentioning the fee for publishing the translation into English and/or sending a copy of the translation to the alleged infringer, and the advantages of these actions.

Part b) required mention that an action for infringement could be brought only after grant. Although damages are often available for actions taken before grant, it is a primary issue that injunctions are available only after grant. Secondary issues are that damages may be reduced by Section 69(3) only in respect of action before grant, and that third party observations can only be filed before grant. (3 ½ marks)

Part c) relates to Section 73 of the Patents Act. Candidates were expected to specify that the Comptroller would revoke the UK patent (not the EP(UK) patent) if the two related to the “same invention”.

Candidates were expected to discuss how it is determined whether two patents relate to the same invention, although there was no penalty for not knowing the recent Kimberley-Clark case. . (3 ½ marks)

Question 8

a) This called for a list of the acts from Sections 60(1) and (2) of the Act. (6 marks)

b) Section 60(5) lists the exempted acts. It is notable that the ‘experimental’ exemption applies only if done for experimental purposes relating to the subject-matter of the invention. (3 marks)

c) Section 61(3) states that the Comptroller can consider infringement only if the proprietor and the alleged infringer agree. There has been a relevant law change following the examination. A mark was available for identifying that the Comptroller can award a declaration of non-infringement under Section 71. (1½ marks)

- d) Section 61 lays out the remedies. (4 marks)
- e) The remedies that the Comptroller can and/or cannot award are in Section 61(3). (1½ marks)
- f) Aside from a sole proprietor, a co-owner, an exclusive licensee and a licence or right holder are the only entities who can bring an infringement action. Normal licence holders and compulsory licensees do not qualify. Marks were available for pointing out what happens with proprietors if an action is brought by anyone other than a sole proprietor. (4 marks)

Question 9

- a) Section 39 sets out the conditions under which an invention may belong to an employee (who may then benefit from the invention), and also the possibility of compensation under Section 40. Section 42 was also relevant to this question. (6 marks)
- b) This required a discussion of Section 66 and of the post-grant provisions of Section 36. (5 marks)
- c) This relates to Section 69. Relevant issues include the requirement for there to have been infringement of the claims as published and as granted, and the provisions of Section 69(3). (4 marks)
- d) Section 62(1) contains all the material for which marks were available. It needed to be appreciated that other forms of relief for infringement would still be available to the patentee. (5 marks)