

2005 P1 EXAMINERS' COMMENTS

1.
 - a) In determining whether there is unity of invention, the Patent Office determine whether the claims define two or more inventions not linked so as to form a single inventive concept – Section 17(6). In practise, this involves determining whether the claims involve a common concept which is novel and inventive over the prior art.
 - b) The applicant needs to file a further search request and pay a further search fee. This is due by 3 months before the expiry of the Rule 34 period, which is extensible, and while the application is still pending. Alternatively, a divisional application could be filed and the invention searched in the divisional.
 - c) According to Rule 102, if the search fee was previously paid on the parent/earlier application and a refund is requested, the refund will be given.

2.
 - a) Innocent infringement is covered by Section 62. Many candidates mistakenly stated that innocent infringement relates to not knowing that an act was infringement, whereas the law instead relates to knowledge or suspicion of the existence of a patent. Many candidates also did not state that the effect of innocent infringement was the non-availability of the remedies of damages and account of profits.
 - b) Section 70 relates to groundless threats of infringement proceedings. Candidates were expected to state the conditions needed for threats to be groundless, who may bring an action against whom, the available remedies and what acts were excluded.
 - c) Delivery up is a remedy available for infringement. It is awardable only by a court. Only a brief discussion of what is delivery up was needed for full marks.
 - d) Section 73 relates to the Comptroller's power to revoke patents. The powers apply only to Section 2(3) prior art and double patenting. Marks were awarded for pointing out that patentees are given an opportunity to submit observations and amend in either situation, and that it is the UK patent (not the EP(GB)) that is revoked in a double patenting situation.

3. This question relates to Sections 48, 48A and 48B. Marks were available for identifying who may apply for a compulsory licence, to whom an application may be made, for specifying that such cannot be made until at least 3 years after grant, and that the application can be for a licence or for an entry in the register that licences are available as of right. A summary of the grounds for a licence being awarded was expected, and an indication of the differences between the grounds for WTO and non-WTO proprietors. A mention was expected of the condition that reasonable efforts to obtain a licence must have failed.

4. Section 19 and Rule 36 dictate when a patent specification can be amended pre-grant. Corrections under Section 117 and Rule 91 can be made at any time pre- or post-grant.

Section 76 specifies that amendments will not be allowed if it results in the application disclosing matter extending beyond that disclosed in the application as filed. Corrections are not governed by Section 76 (this is important for candidates to appreciate), but Rule 91 sets a two-part test which must be fulfilled before a correction will be allowed.

Post grant, amendments are made under Section 75 if there are proceedings in which validity may be (not necessarily is) put into issue. In the absence of such proceedings, application to amend is made to the Comptroller under Section 25. Post-grant amendments may not extend the protection conferred. They are discretionary so must also be made in good faith and without unreasonable delay to be allowable.

5. Marks were available for stating the relevant provisions of Section 3 of the Patents Act, particularly that to involve an inventive step an invention must not have been obvious to a person skilled in the art at the filing/priority date (not the time the invention was made). There were marks available for stating the test laid down in the *Windsurfer* case, and for general awareness.
6. In respect of a UK Patent application with no previously filed applications from which priority can be claimed:
 - a) The minimum requirements to establish a filing date are: a description of the invention (and any drawings), an indication that a patent is sought and an identification of the applicant or information sufficient to enable the applicant to be contacted – Section 15(1).
 - b) The application can be filed by fax to the Patent Office in Newport, by hand at the Patent Office in London or on-line using the new software. Some candidates who did not know this were awarded a mark for saying that a foreign application could be filed and priority later claimed from it, since this would have secured rights, albeit at significant additional cost.
 - c) Claims, an abstract and a search request need to be filed and the search and application fees paid within 12 months. If the applicant's details were not included with the application as filed, these need to be provided within 2 months of a relevant letter from the Patent Office. Section 15(10).

- d) Many candidates got this wrong. When a new application is filed claiming priority and including additional subject matter to that in the specification of the priority application, the additional matter is not entitled to the priority date. Thus, a dependent claim to some of the additional subject matter in the new application is not entitled to the priority date, even if the relevant independent claim is. Applying this to the question, there does not seem to be anything gained by filing an application with a revised specification and claiming priority from the earlier application since (assuming the conference disclosure was enabling) the additional subject matter already forms part of the state of the art. Crucially, any dependent claim based on the additional matter would be invalid (because it would not be entitled to the priority date) and thus the application as a whole would at best be only partially valid. The best course of action is not to re-file, but instead to ensure that the claims of the existing application are not amended before grant to exclude the new embodiment. Although action in respect of the US and other countries having a grace period could be useful, this is outside the scope of the P1 question and syllabus.

- e) This relates to new Rule 6(2) and related provisions. Candidates who did not know about this Rule and said that a new application claiming two priorities could be filed got some marks since this would have secured appropriate protection. Candidates should be careful not to confuse the provisions concerning the late declaration of priority with the provisions of Section 5(2A)(b).

7. What an applicant needed to show before they could obtain restoration changed with the Patents Act 2004 from 'reasonable care' having been taken to ensure that the renewal fee was paid on time to it being 'unintentional' that the fee was not paid. Which law applied depended on whether the renewal fee was due before or after 1 January 2005. Since the question did not specify when the fees were due, candidates got marks for discussing both laws. Relevant also was the 19 month deadline for applying. Many candidates incorrectly stated that restoration must be applied for within 2 months of finding out that the deadline was missed. That is not true for UK patents, although is true for applications for restitutio under the EPC (not, however, covered by the P1 syllabus). The application for restoration be made without delay.

To be successful before the Patent Office, a form needs to be filed and a fee paid. Critically also needing to be filed is evidence (and additional explanation if needed) that establishes that the proprietor did enough to try to pay the fee on time. Such evidence should be in the form of an affidavit, statutory declaration or witness statement from a suitable person. A copy of the instructing letter that never arrived would be helpful.

The question clearly required a discussion of Sections 28A(3) and (4).

8. a) Candidates were expected to discuss the relevant provisions of Section 39. Many failed to state that for an invention to belong to an employer under Section 39(1)(b) the invention must be made in the course of the employee's duties. The employee must have been employed at the time the invention was made (the patent application filing date is not relevant). Bob's job title might not be representative of his exposure to the products of the client's business, and candidates who discussed this were rewarded.

b) Crucial to the validity of the patent is: the timing of the prototype use (was this before the filing/priority date?); whether the use in the gym was public use; and whether the invention (as claimed) would have been derivable from inspection of the prototype. A discussion of these issues was expected of candidates.

c) The key options are entitlement proceedings before the Comptroller under Section 37 and revocation proceedings before the Comptroller or the Court under Section 72. The revocation proceedings might be for lack of entitlement or invalidity through prior art. In either case, the onus to prove falls on the client and success would depend very much on the evidence put forward, but unfortunately most candidates failed to mention this. Discussion of the possibility of the client taking a licence was not expected.

9. The question does not specify whether the claims to the Mark II extinguisher in the second application were dependent or independent, but this is not relevant to the answer.

It is important for candidates to appreciate that a priority claim is valid only to the extent that a claim in a later application is supported by an application from which priority is claimed.

The fact that the Mark II included some additional features does not automatically make the Mark II claims valid over any prior disclosure of the Mark I (or an extinguisher like it) since those additional features might be obvious ones.

The question clearly asks for a statement as to whether a disclosure has the potential to be relevant prior art in respect of novelty and/or inventive step. Most of the marks were available for such statements, although some marks were available for raising other relevant points.

a) This extinguisher was publicly available prior to the relevant dates, so is potentially prior art for novelty and inventive step to claims to both Marks I and II. The fact that the extinguisher has been unavailable for so long does not affect the issue of anticipation, but on inventive step it might be argued that the skilled person would not consider taking features from it to combine with other features.

- b) The date of the tender is too late to affect the Mark I claims. On the face of it the tender does not constitute a public disclosure, so probably would not be prior art either for the Mark II claims. In such a normal commercial process, explicit agreement by the recipients of the tender to keep the information confidential would not seem necessary. A bonus mark was awarded to candidates who said that if the (confidential) tender had led to public disclosure in breach of confidence prior to the filing date of the second application, this would not have been prior art.
- c) The journal article is too late to affect the Mark I claims. It has potential to be prior art for novelty and inventive step against the Mark II claims. Although the journal article does not disclose all the features of the Mark I extinguisher, the question does not let the reader determine to what extent the Mark II claims are affected.
- d) The journal article itself is no more relevant than c) above. Surprisingly few candidates correctly indicated that oral disclosure at the conference (of which the journal article is evidence) would have been potential as prior art against all claims for novelty and inventive step. The oral disclosure would need to have been enabling.
- e) Section 2(3) (novelty only) against the Mark I claims and Section 2(2) (novelty and inventive step) against the Mark II claims. The fact that the prior application was withdrawn is irrelevant to its prior art effect.
- f) Since the European patent application was filed before and published after both UK applications, it is novelty only prior art. Candidates are reminded that the requirement for the GB designation fee to have been paid on an EP(GB) application for it to be citable as Section 2(3) prior art ceased some years ago.
- g) To be relevant to the novelty only of the Mark I claims, the PCT application would have needed to enter the GB national phase. It is relevant for novelty and inventive against the Mark II claims whether or not the national phase was entered, even if never translated from Japanese. In this case, the issue of the extent to which the PCT application is entitled to its priority date did not impact on the answer.