

P1 2007 Examiner's Comments

Overview

The examination seeks to test candidates' knowledge of the law. There is no assumption that candidates have extensive experience of practical application of the provisions being examined but obviously this could prove useful in enabling a candidate to understand particular situations. In general, scripts were of an acceptable quality, and met the required standard.

The stronger candidates were those who answered questions in full, with reasoned basis for their answers. This may seem a flippant point, but it is evident that some candidates have engaged in rote learning and, while this approach enables retention of some key facts which can then be recited in answers, it runs the risk that an answer will not be focused on the facts presented in the question.

Part A

Although many of the questions in part A of the paper are 'closed', i.e. a yes/no answer could be used, candidates will appreciate that such a response would be insufficient for a pass mark. Marks are awarded for analysis of the facts, then for identifying the relevant provisions of the law and for applying them to the situation described in the question. Essentially, this can be distilled into the phrase 'show your working'.

Question 1

Question 1 was attempted by almost all candidates. Part a) is a well known scenario and marks were awarded for stating that the document is prior art, and that it does not matter if it has been read or not, because the relevant legal provision describes as prior art anything 'made available to the public' prior to the earliest priority date.

Part b) led to some extremely long answers. A relatively brief discussion of this topic would lead to delivery of the key points, which are that the marketing would make the product itself prior art if an enabling disclosure had taken place, any 'new use' would thus have to stand on its own merits as to novelty and obviousness, in particular a new medical indication (second medical use) of the product could potentially be patentable, and that if the marketing took place in breach of confidence then a patent application could be filed up to 6 months after that marketing.

In part c), the provisions of the law are clear and candidates' knowledge of these was being tested. In essence, a candidate was expected to know, and to explain, that 'serious and effective preparations' were required, that prior user right only applied to the same product or process in future, no significant expansion of use was permitted, and that the right was capable of being passed on to a beneficiary or as part of a business purchase but was otherwise not transferable

Question 2

Few candidates attempted this question.

In part a), a discussion of the salient points concerning declarations of non infringement was sought. These are covered largely by the provisions of Section 71 UKPA 77.

Candidates obtained good marks by discussing the process by which a declaration can be obtained. This includes details of the steps to be taken, by whom, and in what time period. Candidates were expected to recognise that the person seeking the declaration should be the same as the person committing (or intending to commit) the act in respect of which the declaration is sought, for the declaration to be of value. Further, candidates were rewarded for noting that a full description of the act in question is required.

Candidates were rewarded for noting that deadlines for the response process between the applicant for the declaration, and the patentee, are 6 week periods.

Part b) concerned threats provisions (S.70). In this case, the examiners were seeking certain key points such as the fact that a “person aggrieved” by a threat can seek redress. The relief which can be obtained includes a declaration that the threats are unjustifiable, damages, and an injunction. The provisions of subsection 70(4) of UKPA as amended were also expected to be discussed. These provisions limit the scope for bringing an action for groundless threats if the actions complained about are concerned with the making or importing of a product, or the use of a process, or if the person threatened is engaged in these activities.

Question 3

This question asked candidates to list the minimum criteria for obtaining a filing date in the UK, and then to achieve a published patent application. Most candidates answered this question, and a high average mark was achieved.

Candidates maximised their marks by recognising that there are several ways of achieving a filing date. For example, a description of the invention can be provided, or a reference can be provided to an earlier filed application.

Candidates generally provided well organised answers identifying the key features of a “completed” patent application.

Question 4

Most candidates answered this question and all but a few had a high degree of knowledge of the relevant provisions. The examiners were seeking confirmation that candidates knew when an application definitely could not be amended, when the applicant has the right to amend voluntarily, and what restrictions are imposed on

such amendments (e.g. added subject matter). Similarly, in respect of granted patents, the restrictions imposed on patentees should have been discussed (discretion, broadening the scope of the patent), together with the different proceedings in which amendment could be applied for.

Question 5

As with question 4, this question sought confirmation of candidates' knowledge of a particular provision of the law, together with associated procedural points. Candidates generally responded well to this question, providing a near complete answer to both parts.

Most candidates seem to have a good understanding of the requirements for securing a filing date on a divisional application.

Question 6

Question 6 relates to a scenario commonly faced in the prosecution of UK Patent Applications.

The applicant has several actions available to him, none of which need to be carried out immediately. Candidates achieved good marks by stating what could be done, what didn't need to be done, and what could be deferred.

The application is yet to be published, so voluntary amendment before publication seems to be appropriate. However, this voluntary amendment does not need to constitute a response to the Examination Report, which can be deferred. The applicant's concern regarding copycat products can, to some extent, be allayed by the inclusion of the voluntary amendment in the published patent application.

The filing of a divisional application can be delayed until the response to the Examination report has been made. In the meantime, a search request can be made in respect of the currently unsearched claims. A request for acceleration of this search might be useful, but shouldn't be necessary.

On the other hand, candidates who argued that it would be useful to have a divisional application on file, and published under S 16, also received good marks as although this is contrary to the client's view that a divisional application is not required yet, it provides further 'provisional' protection.

Question 7

This question asked for candidates' knowledge of the provisions allowing 'rescue' of a situation which can arise from time to time. Candidates who mapped out a clear and well ordered 'time line' generally benefited.

Candidates were expected to have a thorough knowledge of possibility of getting an immediate filing date by identifying the earlier foreign application and the provisions

for extension of the period for making a declaration of priority. It was expected that candidates would know that evidence in support of the late priority claim needs to be provided, and that the legal test is that the missing of the original deadline was “unintentional”.

Candidates would then receive good marks from identifying the other actions which would need to be carried out, such as submission of a verified translation of the original French patent specification.

Question 8

Part a) required candidates to know the provisions relating to extensions of time available for the deadline for requesting examination.

Part b) was best answered by candidates who knew and understood the terminology of this area of the law. Terms such as “renewal date” and “renewal period” can easily be confused. A suggestion to check the Register was always rewarded. Again, in terms of the question of restoration of the patent, the fact that the legal test for restoration is governed by the word “unintentional” should have been mentioned.

Part c) was straightforward but it was frustrating to see that many candidates are not aware of the availability of a retrospective extension of time in these circumstances, without significant procedural steps being required.

Part d) required application of the ‘Threats’ provisions to a scenario. The rather naïve question from the client invited some excellent responses. The examiners were particularly looking for points regarding the threats provisions, the inconsistency of information on the Register, and the risk of third party rights and limitation on damages arising through failure to record the assignment.

Question 9

Regarding part a), candidates were expected to understand the provisions of section 60 of the UKPA 77. Answers discussing the exact provisions of the law (e.g. “direct product”) were rewarded. The examiners were also seeking confirmation of an understanding of burden of proof in such circumstances.

In part b), the examiners were seeking paraphrasing of the law, in that an invention or patent must be of outstanding benefit, and that it is “just” that an employee should be awarded compensation.

Part c) asked for a discussion which could have led in several directions. However, as noted in *Kirin-Amgen*, candidates should have a clear understanding that, in the end, the Protocol to Article 69 is fundamental to all of these discussions. Hence, candidates were rewarded if they had an appreciation that the two extreme scenarios identified in that Protocol act as a starting point to claim construction.

Part d) asked for candidates to provide details of the procedure for obtaining (and limitations on) provisional protection. Candidates needed to demonstrate they understood the differences between patent applications filed and published by the UKIPO and European patent applications published by the EPO and designating the UK. In particular, consideration of non-English language European patent applications was expected. Candidates were given high marks if they demonstrated a clear understanding of the circumstances in which the potential for provisional protection can be enhanced, such as by the filing of amended claims before S 16 publication.