

P1 2008

Examiners' Comments

Part A

Question 1

Part (a) – it is important to note the date from which the term is measured.

Part (b) - candidates were expected to provide a brief reason as to why a particular application can, or cannot, give rise to a claim to priority.

Question 2

The key differences between entitlement to apply for and entitlement to be granted a patent needed to be set out. Any 'person' can apply for a patent, and an explanation of the term 'person' should be provided. The various avenues available for transfer of the entitlement to be granted a patent, from the inventor(s) to the eventual patent owner, should be explored.

Question 3

Grounds for revocation of a patent are set out in Sections 72 and 73 of the UK Patents Act 1977 as amended.

Some grounds for revocation are not available to all applicants for revocation.

Question 4

Part (a) sought answers identifying that false marking relates to the unauthorised claim of patent rights in accordance with section 110 of the UK Patents Act 1977 as amended. A criminal offence occurs if a product is disposed for value when it is marked so as to indicate that it is a patented product.

Part (b) required an understanding of the concept of 'direct product' in terms of S60 of the UK Patents Act 1977 as amended. (*Pioneer Electronics Capital Inc and anr. v Warner Music Manufacturing Europe GmbH and anr.*).

Discussion of Surrender in part (c) was expected to include mention that an application for surrender was open to opposition, that surrender is unavailable when revocation proceedings are pending, and that it eliminates the possibility of action for an infringement occurring before the surrender.

### Question 5

The principal criteria for putting an application in order for commencement of preliminary examination are set out succinctly in section 15A(1) UK Patents Act 1977 as amended.

The content of preliminary examination is set out in the remainder of section 15A.

### Part B

Despite the more scenario based focus of several of these questions, the examiners accept that candidates will have limited practical experience in the areas concerned and so practical advice to clients was not expected. The examiners sought identification of the legal points which might arise in addressing these issues in real life.

### Question 6

Candidates were rewarded for identifying cases and confidently explaining the facts relating to them, how these facts applied to the law, and the impact of the identified decisions.

Most candidates selected either *Catnic Components Ltd and another v Hill and Smith Ltd* or *Improver Corp v Remington Consumer Products Ltd* to discuss claim construction and *Windsurfing International Inc v Tabur Marine (Great Britain) Ltd* for its discussion of inventive step.

### Question 7

A useful approach is to consider each party, manufacturer, retailer, user, in respect of each claim in turn so that all possibilities are considered, picking up most if not all marks on offer. Which activities, by whom, fall within the scope of which claims?

Discussion of the impact, if any, of renewing the patent in the extension period, or if it is not renewed in time, was expected.

Further steps could include: checking when the client's activities began; an assessment of the validity or otherwise of the patent concerned. including prior art searches; an action to prevent further 'unjustified' threats, and considering the possibility of a licence.

Candidates were not expected to identify all these courses of action, or assess the relative merits of them.

### Question 8

Candidates were expected to answer only 4 parts of this 5 part question.

In respect of Unity of Invention, candidates were expected to be able to explain the nature of the term, and how it relates to a 'single inventive concept'. An understanding that unity is a requirement for grant, but not a ground for invalidity, was also expected. A discussion of how to resolve a finding of disunity was also sought.

Damages and an Account of Profits - are mutually exclusive remedies.

There is a two step test for establishing that such a correction to the specification should be allowed. The examiners were also expecting a discussion of the correction of other errors in a patent application per se, such as in the Request for Grant.

Joint ownership - the statutory provisions apply in the absence of agreement to the contrary, and what these statutory provisions were. Rights of, and restrictions on, co-owners of a patent should also have been discussed to achieve full marks on this point.

Recordal of licences - marks were awarded for noting time limits, and discussing the consequences of failure to comply with them.

### Question 9

Part (a) sought a discussion of the desirability of marking products in order to avoid a defence of innocent infringement, and consequent limitation on damages, and how to mark the products. Candidates could also obtain marks for noting the ready availability of patent information per applicant either by formal inspection of the register or by on-line searching although full marks could be obtained even without mentioning this.

Part (b) looked for a brief discussion of *Menashe Business Mercantile Ltd v William Hill Organization Ltd*.

Good answers to part (c) recognised the need to determine, quickly, what the content of the already filed application could establish in the way of a claim to priority. The term 'top up' was interpreted variably, but most candidates recognised that it could mean the addition to an existing application of new subject matter (not allowed) or the filing of a new application including the new subject matter. Candidates who suggested a further filing to take place on the day of the conference presentation were rewarded. Further, candidates were expected to recognise the possible prior art impact of the conference disclosure, on new subject matter contained a later filed patent application. Candidates might also consider (first) withdrawing the first case and (second) filing the new case without a priority claim to avoid uncertainty over the entitlement to priority date of any later 'convention' filings.

Candidates in part (d) were expected to recognise the error in the statement, and to refer back to the original statute to correct the position. Mention of the difference between in vitro and in vivo diagnosis obtained marks.

Part (e) looked for candidates to discuss the law relating the right to claim damages from the publication of an application. Candidates generally explained well the provisions concerning the timing of any damages claim, and limitations thereon.