

P1 2009

Examiners' Comments

PART A

Question 1

This question required a clear understanding of the provisions of Section 2 of the UK Patents Act 1977 as amended. The examiners sought assurance that the candidate understood the meaning of the phrase “made available to the public”, the nature of the disclosure (i.e. by written or oral description, by use or in any other way), and the timing of the disclosure (i.e. before the priority date of the invention). Then, the examiners wanted confirmation that the candidate understood the special provisions of section 2(3) as they relate to post published (but prior filed) patent applications, including the provisions as they relate to European and PCT applications.

All candidates attempted this question.

Question 2

Most candidates also attempted this question. The examiners wanted an explanation of the provisions of section 60 of the UK Patents Act 1977 as amended, as they related to an invention comprising a process.

In particular, the provisions of section 60 (1) (b) and (1) (c) needed to be set out. Marks were awarded for noting the circumstances in which it was required to establish that the infringer knew that the act infringed a patent, or that it would be obvious to a reasonable person that that were the case. Marks were also awarded for noting when it needed to be established that a particular act was being, or would be, performed in the UK. In addition, section 60 (2) applies whether the invention is a product or a process, and so an explanation of this provision was also expected.

Question 3

From the information made available in the question, the client is inviting advice on what options he has. This could include amendments in light of the UK Search Report, requesting Substantive Examination (if it has not already been requested – the question is silent on this), responding to any objections raised at that stage, and eventual grant.

The question notes that a request for accelerated publication has not been made. The Examiners awarded marks for discussions of the various options for acceleration of prosecution of the application.

Marks were also available for noting any possibly outstanding requirements, such as a Statement of Inventorship, or Formal Drawings.

Question 4

Compensation is available to 'a person' in two circumstances. Candidates who addressed this question generally were successful in identifying the first of these, namely in relation to inventions made by employees. The question was focused on the criteria for compensation as set out in Section 40 of the UK Patents Act 1977 as amended, and the examiners were not expecting candidates to demonstrate a knowledge of the process by which such compensation could be sought.

Marks were available for explanations of the two scenarios provided for in the Act, namely when an employee has made an invention which, by reason of that employment, belongs to the employer, and when an employee has made an invention which, although belonging to him, is then assigned or exclusively licensed to the employer. The criteria are different for these two cases, and the examiners were keen to see that candidates understood this.

Question 5

This question was concerned solely with the opportunity to restore a patent which had ceased due to non payment of a renewal fee. No marks were available for discussion of late payment of renewal fees.

Candidates who demonstrated a knowledge of the provisions of Section 28 and Section 28A, and associated rules, received high marks for this question. The examiners were particularly keen to see commentary on the due dates for filing an application for restoration, which inevitably would involve a discussion of the basis for calculation of such dates. Candidates were expected to know that the test for restoration is now whether the failure to pay was unintentional. The examiners also awarded extra marks for detailing the process for payment of the missing renewal fee, for considering who should make an application for restoration, and what would happen if a patent was owned by joint proprietors.

PART B

Question 6

This question looked to enquire as to the candidate's knowledge of the opportunities for extending periods of time which might be encountered in the prosecution of a UK Patent Application. In each case, the examiners sought confirmation that the candidate knew how a period had been established, and therefore how it could be extended. As several of the scenarios required the same response, the examiners anticipated high marks for this question. Although few candidates attempted this question, the average mark was indeed high.

Question 7

The purpose of this question was to explore the candidate's understanding of priority and amendment. The examiners were interested in candidates' ability to set out all of the options available to the client, and to explain any problems (or losses of rights) that could arise from availing of such approaches.

For example, the option of amending the existing application to remove the limitation to car tyres has basis in the statements of invention. Candidates were rewarded for noting that this might give rise to new prior art, and also there is the risk of insufficiency of disclosure as the invention relates to bicycle tyres.

A new application could also have been filed, claiming priority from the existing application (assuming it is itself a first filing). This could include description of the specific improvement for bicycle tyres. Candidates were expected to be able to explain the concept of partial priority in this context.

Withdrawing the existing application and refiling with a new specification should also have been mentioned, but with the proviso that candidates discuss the very significant loss of rights that this option might entail.

If the bicycle tyre improvement is sufficient to establish novelty over the existing disclosure, then it is arguable that a second filing, not claiming priority from the first, and focused on the bicycle tyre invention, is also a viable option. Marks were available for discussing the prior art impact of the first application on the second application in such circumstances.

Question 8

All candidates attempted this question, which was intended to reflect a realistic situation which might arise in practice. The examiners were interested in determining if the candidates could identify the various options available to patent applications in these situations, and to highlight any issues which might arise if particular options were taken.

The main options that the examiners were anticipating would be considered included early publication (with or without amended claims) accelerating the existing application to grant, either by amendment of the claims down to the subject matter of claim 2, or by holding out for the broader claim 1, requesting additional searches from the UKIPO on the existing application, filing divisional applications, or a combination of two or more of these. There also existed the possibility of filing a second application, claiming priority from the first, although the benefit of doing this was not clear from the facts provided in the question.

The client's needs should have given rise to mention of the various provisions for acceleration of the application process, such as early publication, and accelerated examination. Marks were awarded for explaining the procedure for these.

Provisional protection should also have been discussed, particularly as linked to the state of the claims. Candidates were awarded high marks for discussing that the potential infringement had to be inspected before making any assumptions as to what voluntary amendment (if any) to make at this stage.

On balance, the examiners favoured a solution involving filing a divisional application for the unsearched claims, with a request for a search. However, candidates who opted to obtain a search first and then file a divisional application were not penalised.

Candidates could also gain marks from discussing the options for putting the proprietor on notice. The wisdom of some of these options is debatable but, in the context of this examination, candidates were not penalised for presenting commercially dubious strategies.

Stronger candidates would also have seen that the question is silent on whether the objection to claim 1 is surmountable, and whether claim 2 covers the competitor product. Extra marks were available for noting these points and determining if any advice would turn on them.

Question 9

This question requires little further explanation, as it clearly requires candidates to demonstrate their knowledge of the statutory basis for the existence of the four concepts in UK Patent law. Good marks were awarded to candidates who could refer to provisions of the Act and Rules without paraphrase.

In part (a), the Examiners were looking out for an explanation involving the concept of a "single inventive concept". Marks were also awarded for noting that Section 26 denies the possibility of objecting to a lack of unity in a granted patent.

Part (b) looked for an understanding of the concept of an Account of Profits, when it can be sought, and the fact that it is mutually exclusive, as a remedy, with Damages.

Part (c) sought reference to the legal definition of Inventor. Marks were also awarded for commentary on the nature of joint inventorship, and the right of an inventor to be named (or not, as the case may be) in a patent application.

Part (d) was intended to ascertain candidates' understanding of the provisions of Section 4A of the UK Patents Act 1977 as amended. Casual use of the phrase "method of treatment" or "method of diagnosis" needs to be qualified by the provisions of that section, inasmuch as the extent to which such methods are patentable depends on the nature of the methods and whether they are performed on a human or animal body.