

## P1 2010

### Examiners' Comments

#### Part A

##### Question 1

This question was popular with candidates, and was generally answered well, with most candidates demonstrating an understanding of the differences in entitlement between a patent application and a patent. The question required a clear understanding of the provisions of Section 7 and Section 39 of the UK Patents Act 1977 as Amended. In particular, the Examiners sought assurance that candidates understood the differences between any person having the right to apply for a patent, (Section (7)(1)) but only those who were inventors, entitled to the property in the invention or their successors in title having the right to have a patent granted to them (Section (7)(2)). Furthermore, the Examiners wished to see that candidates understood how the specific statutory provisions of Section 39 transferred that property to an employer in the situations where an employee was expected to invent (Section 39(1)(a)) or where special obligations arose to further the employer's interests (Section 39(1)(b)).

##### Question 2

Few candidates attempted this question, and the understanding of the requirements of national phase entry was variable. This question required knowledge of the deadlines and practice of entering the UK national phase at 31 months from priority/earliest filing as laid out in Section 89A and rules 85(1) to 85(7A) of the UK Patents Act 1977 as Amended. The Examiners were keen to see that candidates understood the documentation required (NP1, copy of application if not already sent by IB, translations of application and amendments, request for republication in English) and deadlines for filing

other documentation such as Form 9A and Form 10, as well as Form 7 if required.

### Question 3

The concept of amendment was understood well, but fewer candidates understood that a correction was governed by different principles, in particular, the concept of an obvious error and an obvious correction. The Examiners sought confirmation that candidates understood the fundamental difference between an amendment and a correction in accordance with Section 19 and Section 117, respectively, of the UK Patents Act 1977 as amended. A recitation of the various times that an applicant may make an amendment following the issuance of the search report, and that any amendments should not add matter to the application as prescribed by Section 76 was required, as well as knowledge that this may be done at the applicants' own volition. In terms of corrections, the Examiners expected candidates to have knowledge of the types of corrections that can be made at any time before grant (error of translation, transcription, clerical error or mistake) in a patent application or document filed in correction therewith. Marks were also available for the criteria of the error and correction being obvious, and for the publication of correction and opposition process.

### Question 4

This question was answered by almost all candidates, and generally the principles were understood well, with the majority of candidates also appreciating the different circumstances applying to entitlement challenges based on patentability, sufficiency and added matter. The question required knowledge not only of the grounds of revocation but who is entitled to use each, and as such, an understanding of provisions laid out in Section 72 of the UK Patents Act as Amended needed to be demonstrated. Candidates were expected to know that four of the grounds (patentability, sufficiency, matter added to application and extension of protection) are available to all, but that entitlement is only available to a person entitled to the invention as

shown in a ruling in accordance with Section 37, within 2 years of grant (unless the false proprietor knew he was not entitled to the patent at the time it was granted). Marks were also awarded to candidates who mentioned that revocation may be requested from the Court or Comptroller, and that the Comptroller may revoke applications or patents of his own accord under Section 73.

### Question 5

Again, this question was attempted by a large number of candidates, with almost all arriving at the correct answer to the second section. However, the concept of priority, as well as how and when it can be claimed, is a fundamental principle of patent law, and the Examiners expected candidates to show a solid grasp of the relevant provisions and how to use them. Whilst some candidates clearly demonstrated their knowledge of the basic concepts, some failed to do so. A discussion of the enactment of Section 5 of the UK Patents Act as Amended in terms of the priority date being *prima facie* the filing date of an application, the ability to claim priority for a relevant application containing the same invention and/or subject matter filed less than 12 months before the filing of an application, as well as multiple priorities and the provisions for a second application serving to substantiate priority when a first has been withdrawn under certain conditions, was required. Marks were also available for knowledge of how to claim priority, including when unintentionally omitted. Parts a), b), c) and d) required an understanding of the Paris convention, in that patent applications and utility models may be used as priority claims for a patent application, but an industrial design may not.

### Part B

### Question 6

This question proved popular, with many candidates showing the ability to think through the problem and offer constructive advice. However, whilst

most candidates were able to consider how patent filings could be made to support taking action against an infringer, few considered other issues such as prior user rights. In question 6, the Examiners required a demonstration that candidates were able to apply their knowledge of the law to a practical situation, and to counsel their client accordingly. The various parts of the question involved knowledge of the formalities for completing a UK patent application, the determination of whether a publication falls within the state of the art, and simple actions to determine infringement and put a potential infringer on notice without falling within the provisions for groundless threats of infringement. Marks were awarded for a strategic approach to covering the client's existing and new products, for example, in filing a new application having a priority claim to the existing application, and for safeguarding the client, for example, by considering prior user rights of the potential infringer, and even whether the potential infringer had existing patents or applications that could be relevant. Marks were also available for a clear understanding of the benefits of accelerating the publication and grant of a patent application in these circumstances.

### Question 7

Whilst many candidates who attempted this question had a clear understanding of an exclusive licence, there was some confusion between a licence of right and a compulsory licence, with the relevance of each to enforcement also being less well understood. The question required candidates to understand that a licence under a patent application can take several forms, each of which grants a different scope of rights to the licensee. The Examiners expected candidates to know that an exclusive licence is exclusive with respect to all, including the proprietor. The exclusive licensee therefore has similar rights to the proprietor in terms of enforcement and exploitation. However, the licence should be registered within 6 months of conclusion, or as soon as reasonably practical thereafter to enable recovery of costs in infringement proceedings. With respect to a licence of right, candidates needed to demonstrate a knowledge of the ways in which such licences are granted and cancelled, as well as the consequences in terms of

infringement remedies and halving of renewal fees. It was also necessary to show an understanding that both an exclusive licensee and a holder of a licence of right can sue for infringement, respectively as of right or after an unsuccessful request for the proprietor to take action; and of the liability (or otherwise) of the proprietor to costs if joined in an action.

#### Question 8

In general candidates who attempted this question answered the first three parts well. However, a general understanding of the effect of where the act takes place and of the type of act itself was not widespread, with some candidates missing the relevance of the exact wording of Section 60 of the UK Patents Act as amended. This question required a thorough understanding of Section 60 of the UK Patents Act as amended, and its operation in a variety of situations. Candidates needed to consider the type of act, where it was carried out and where the ultimate effect of the act took place. For example, Section 60(1)(c) provides that the importation of a product obtained directly by means of a patented process is an infringement, and in contrast to Section (1)(b) this is not limited to the process being carried out in the UK. In advertising a product candidates were required to discuss whether this was an offer to dispose, as exportation is not a specific act covered by Section 60. If a component part of a patented product satisfies the criteria of being an essential element of the invention and the knowledge of the person supplying the product of the intention to use it in a patented product, then unless this is a staple product Section 60(2) is relevant. Finally, in considering the situation of an offer on a US website, candidates needed to understand the territorial effects of where the offer was made and whether this really was an act in the United Kingdom.

#### Question 9

This question was generally answered well, although candidates should remember that not only does the state of the art contain a broad range of disclosures these need to be enabling and some are excepted under certain

circumstances. The question allowed candidates to show their knowledge and understanding of the contents of the state of the art, which stretches beyond just the contents of published patents and patent applications, and includes all matter made available to the public before the priority date, in the United Kingdom or elsewhere. This covers matter made available by written or oral description, by use or in any other way, and candidates should also distinguish between those disclosures relevant for novelty only and those relevant for both novelty and inventive step. It is also necessary to consider whether such disclosures are enabling disclosures. Certain acts are not disclosures, and candidates were expected to know of the exceptions relating to international exhibitions and breach of confidence. The current case law on inventive step is laid out as the modified *Windsurfer* test (*Windsurfing International Inc. vs. Tabur Marine (GB) Ltd*) in *Pozzoli vs BDMO*, and candidates were required to be able to summarise the steps to show their understanding of how inventive step is determined in the UK.