

## **P1 2011 Examiner's Comments**

### **General Comments**

Overall the quality of answers provided for P1 this year was very high. However, candidates are reminded that it is vital to read the entire question fully and understand what is being asked before writing an answer. Providing a short, accurate answer that reflects what was required by the question is far more likely to gain marks than writing down everything the candidate knows on a similar topic or additional facts they would like to share with the Examiners. It should also be noted that P1 is about basic UK law and not the EPC. Lastly, poor handwriting, crossings out and answers scrawled all over the page also make it hard for the Examiners to award all of the marks a candidate may deserve.

### **Part A**

#### **Question 1**

This question required candidates to demonstrate that they understood the processes and effects of withdrawal of a patent application and surrender of a granted patent. It was important to note that both of these are voluntary acts, carried out by the applicant(s) or proprietor(s), as appropriate. In the case of withdrawal, whilst the withdrawal itself cannot be corrected, an error in such a withdrawal can be, and there are clear differences in the effect of withdrawing an application before publication (before preparations for publication are completed) and afterwards. In the case of surrender, this may not be carried out whilst any proceedings, such as infringement or validity proceedings, are in process, and there may be issues if licensees are involved. Furthermore, unlike revocation, once an application has been published or granted, both have an *ex nunc* effect.

## **Question 2**

Section 1(2) of the UK Patents Act (as amended) 1977 clearly states that certain acts are not considered to be an invention for the purposes of the Act. Although “invention” as such is not defined, the exclusions on this basis are clear. Candidates needed to take care not to recite portions of Section 1 that were not relevant, such as those acts excluded on other grounds such as morality. A wholesale recitation of everything that may not be an invention with no explanation does not demonstrate an understanding of exclusions from patentability.

## **Question 3**

Question 3 required a thorough understanding of the manner in which certain documents can become prior art through Section 2(3) of the UK Patents Act (as amended) 1977, even if, in three examples, these are not GB publications. Candidates were expected to understand what made an application for a patent an “application under the Act” and therefore relevant to section 2(3). For example, in the case of an EP application, designation of the United Kingdom is sufficient, whereas in the case of a PCT application, entry of the national or regional phase is necessary. Most candidates overlooked the language criteria for an EP(PCT) application, where the PCT publication should be in English, French or German,.

## **Question 4**

A surprisingly large number of candidates did not understand the concept of contributory or indirect infringement at all. The supply, or offer to supply, in the UK, of any of the means, relating to an essential element of the invention, for putting the invention into effect, where the person knows, or it is obvious to a reasonable person in the circumstances, that those means are suitable for putting, and are intended to put, the invention into effect in the UK is as much an infringement as a direct infringement, such as the making of a patented product. The double territorial requirement is key, as is the fact that it is only

necessary for a reasonable person in the circumstances to think it is obvious that the element could be used to put the invention into effect. The standard defence to such an allegation of infringement is the staple product defence (Section 60(3) UKPA 1977), unless this is to induce infringement. Recitations of direct infringement in relation to patented products and processes were not relevant to the question.

### **Question 5**

This was a good example of candidates not reading the question fully before writing an answer: the question asked for the proceedings in which the validity of a patent can be put into issue, and not for the grounds of revocation. These proceedings are set out in Section 74 of the UKPA1977, and are limited to (a) by way of defence, in proceedings for infringement of the patent under Section 61 or in relation to publication under Section 69; (b) in proceedings under Section 70 in relation to groundless threats of infringement; (c) in proceedings in which a declaration of non-infringement in relation to the patent is sought under Section 71; (d) in proceedings before the court or the comptroller under Section 72 for the revocation of the patent; and (e) in proceedings under Section 58 in relation to disputes as to Crown Use. Entitlement proceedings are not included in this list.

## **Part B**

### **Question 6**

This question proved to be very popular, with all candidates attempting it. It was intended to get candidates to explain how an invention vests in an employer by law, and in what circumstances there could be an exception to this. It was important to note that the client had worked in the warehouse at his ex-employer's business, and therefore discussions as to whether he was on the board of directors, had a special obligation to his employers or was even employed to design seatbelts were not relevant, whereas understanding his contract of employment, when, where and how the invention was made, did he work on it during his working hours or with his employers resources were far more pertinent to the question. The second half of the question required candidates to understand the scope of remedies available for infringement. Here it was important to clarify not just that damages and an account of profits are mutually exclusive, but that one relates to the loss incurred by the client and the other the unwarranted profit enjoyed by the infringer. Also, some candidates did not mention that it would be possible to obtain a declaration that the patent was valid and infringed, which in some cases may be just as valuable to a client as an injunction or delivery up and destruction if reputation is at stake.

### **Question 7**

This question was aimed at testing candidates' understanding of the more formal aspects of a patent application, including both filing and the purpose of certain sections of a specification. For example, it is important to know that an application is awarded a filing date by making a request for grant of a patent, providing details to identify the applicant, and a description, something resembling a description or a reference to another filing. It should be noted that the description also includes any drawings referred to therein. The claims and abstract can be filed subsequently with no effect on the filing date. Many candidates seemed uncertain of the purpose of an abstract, which is primarily

an aid to searching, with many claiming it never formed part of the state of the art. Similarly, there was some uncertainty on what criteria the claims of a patent application should meet, with some candidates discussing novelty and inventive step (which are relevant to whether the application can be granted) and others not understanding the relevance of unity.

### **Question 8**

Few candidates attempted this question, which was concerned mainly with the possibility of correcting certain errors in a granted patent where the language of proceedings had not been English, and whether an infringer could have a defence to infringement on this basis. The correction of the word “onirganic” in the claims could be dealt with by requesting correction under Section 117 UKPA 1977, and the error in the translation in accordance with Section 80 UKPA 1977 as the translation filed originally is narrower in scope than the authentic text. With regards to the possible defence to infringement, candidates were expected to discuss whether the potential infringer could have benefited from a prior use defence. In this situation, if a potential infringer begins in good faith to do an act which would not constitute an infringement of the patent as originally translated, or of the rights conferred by publication of the application as originally translated, but would do so under the amended translation, or makes in good faith effective and serious preparations to do such an act, he shall have the right to continue to do the act or, as the case may be, to do the act, notwithstanding the publication of the corrected translation and notwithstanding the grant of the patent.

### **Question 9**

This was attempted by almost all candidates, yet virtually none gave any real discussion of secondary factors that could be taken into account when assessing inventive step, which is surprising given the recent developments in case law on this point. Virtually all candidates understood that amending to include the two-flange variant of the client’s invention would result in added matter, and therefore was not an option, yet many went on to suggest filing

divisional applications for the same invention. In considering what the client could do, the Examiner's were looking for a reasoned discussion of the merits of withdrawing the first application or filing a second either with or without a claim to priority based on the first. With regard as to whether the two-flange nut is inventive over the art, the art contained a specific teaching away, and the two-flange nut appears therefore to be a surprising result. Other secondary factors that could be taken into account for considering inventive step included long-felt want, the age of the art and commercial success. A long discussion on the test for inventive step based on Pozzoli was not required.