

Part A

Question 1

In relation to UK patents:

- a) Who can apply for a patent?
2 marks
- b) To whom may the patent be granted?
4 marks
- c) Under what circumstances must a statement of inventorship be filed?
1 mark
- d) When must the statement of inventorship be filed and what extension of time is available, if any? You are not required to consider divisional applications.
3 marks

Total: 10 marks

Answer

(section 7 UK Patents Act)

- a) Any person (1 mark). Alone (0.5 marks) or jointly with another (0.5 marks).
- b) A patent may be granted to
 - a. Inventor/joint inventor (1 mark)
 - b. Any person who by virtue of law (0.5 marks) or by virtue of an enforceable agreement (0.5 marks) entered into with the inventor before making of the invention (0.5 marks) was at the time of making the invention (0.5 marks) was entitled to the whole of the property in the UK
 - c. The successor in title to the above (1 mark).

(section 13 UK Patents Act)

- c) If the applicant is not the inventor (1 mark).
- d) Must be filed by 16 months from priority (1 mark). Extension of time available for two months as of right (1 mark). Further extension at discretion of the Comptroller (1 mark).

Question 2

- a) With reference to section 30(6)(b) of the *UK Patents Act*, a patent assignment document is void unless two conditions are satisfied. What are these conditions?
1 mark
- b) Describe the procedure for recording an assignment at the UK Intellectual Property Office.
2 marks
- c) Describe two potential consequences of a failure to record an assignment within six months of execution.
4 marks
- d) With reference to section 36(3) of the *UK Patents Act*, what rights are not exercisable individually by one of the co-owners of a patent without the consent of the other co-owners?
3 marks

Total: 10 marks

Answer

- a) The assignment must be in writing (0.5 marks) and signed by the assignor (0.5 marks) - Section 30(6)(b)
- b) File form 21 (0.5 marks) and pay fee (0.5 marks), file evidence sufficient to establish the transaction (0.5 marks) if not signed by the parties (0.5 marks). – Section 32, rule 47
- c) Two possible consequences –
- In infringement proceedings (1 mark) the assignee will not be awarded costs (0.5 marks) or expenses (0.5 marks) where infringement occurred before the assignment was recorded (1 mark) – Section 68;
 - A person who acquires the patent application is not affected by the earlier (non recorded) assignment (0.5 marks) if he did not know of it (0.5 marks) – Section 33.
- (other reasonable options will be considered)

- d) Amend the specification for the patent (0.5 marks) or apply for such an amendment to be allowed (0.5 marks) or for the patent to be revoked (0.5 marks); grant a licence under the patent (0.5 marks) or assign (0.5 marks) or mortgage (0.5 marks) a share in the patent – Section 36(3)

Question 3

Your client is considering filing an application for a declaration of non-infringement under section 71 of the *UK Patents Act*.

- a) **What must have occurred before the Comptroller will consider such an application?**
4 marks
- b) **What is the effect of a declaration of non-infringement?**
3 marks
- c) **Explain whether a declaration of non-infringement made by the Comptroller differs in effect to a declaration of non-infringement made by the court.**
1 mark
- d) **Describe two situations in which the ability to file an application for a declaration of non-infringement would be useful to a client.**
2 marks

Total: 10 marks

Answer

- a) The required two steps-
- The client has applied in writing (0.5 marks) to the proprietor (0.5 marks) for a written acknowledgment to the effect of the declaration or declaratory claimed (0.5 marks), and has furnished him with full particulars (0.5 marks) in writing (0.5 marks) of the act in questions (0.5 marks); and,
 - That the proprietor has refused (0.5 marks) or failed (0.5 marks) to give any such acknowledgement.
- b) Creates an estoppel (1 mark) against the patentee contending the acts including the article (1 mark) set out in the declaration (1 mark) constitute an infringement of the patent
- c) No difference (1 mark)

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- d) Two situations –
 - a. Create a path to market (1 mark)
 - b. Altering a product after a finding of infringement (1 mark)
 - c. (Any other reasonable alternative considered)

Question 4

Write notes on one leading patent case of the British courts. The case should have claim construction as a main issue. Your notes should cover the following:

- a) parties to the case; **1 mark**
- b) summary of the facts of the case; **2 marks**
- c) summary of the decision; **2 marks**
- d) discussion of precedent set by the case. **5 marks**

Total: 10 marks

Answer

- a) each party (0.5 marks). Will accept abbreviations
- b) minimalistic summary (1 mark). Identifies the main issues (1 mark)
- c) correctly identifies the outcome (infringement/no infringement) (1 mark). Summarises the reasoning for the decision (1 mark)
- d) very minimalistic discussion – eg ‘sets a new test for infringement’ (1 mark)
 Better than the above, some discussion of the new test (2 marks)
 Detailed discussion of the new test, accurate but not necessarily word perfect (3 marks)
 As above but with commentary, interpretation (4 marks)
 Perfect answer of a quality suitable for a newsletter/article (5 marks)

Question 5

This question relates to withdrawal of UK patent applications (section 14 *UK Patents Act*) and surrender of UK patents (section 29 *UK Patents Act*).

Withdrawal

- a) When may a UK patent application be withdrawn?
1 mark
- b) What is the effective date of withdrawal of a UK patent application?
1 mark
- c) Who may withdraw a UK patent application?
2 marks
- d) Describe the requirements for withdrawing a UK patent application.
2 marks

Surrender

- e) When may a UK patent be surrendered?
1 mark
- f) What is the effective date of surrender of a UK patent?
1 mark
- g) What are the consequences of surrender of a UK patent?
2 marks

Total: 10 marks

Answer

Withdrawal

- a) At any time before the date of grant (1 mark).
- b) Withdrawal takes effect from the date of receipt of the request at the UKIPO (not the date it is actioned by the UKIPO). (1 mark)
- c) The applicant (1 mark). In the case of joint applicants both applicants must apply (1 mark).

- d) Write to the patent office requesting withdrawal (1 mark). Withdrawal must be unambiguous (1 mark).

Surrender -

- e) At any time (1 mark).
 - f) The date of publication of the acceptance of the offer to surrender (1 mark)
 - g) No claim for infringement for acts committed whilst the patent was in force (1 mark).
- No need to repay licence royalties (1 mark).

Part B

Question 6

- a) Discuss how obviousness is assessed. Pay particular attention to the 'Windsurfing/Pozzoli' approach.

10 marks

- b) On 3 January 2017, your client filed a patent application for a surgical instrument which has three fingers and which is used to pull cylindrical objects such as bullets from patients. You have reviewed the application and it has one claim drafted to a surgical instrument having exactly three fingers. The description comprises one embodiment having exactly three fingers. Your client informs you it has now developed a further version having two fingers, which they would also like to protect.

There are two pieces of prior art which you need to consider when answering this question:

A – An earlier UK patent application filed in 1957 which discloses a similar surgical instrument but having four fingers. This document teaches it is impossible to grip a bullet with fewer than four fingers.

B – An earlier UK patent application filed on 20 December 2016. This discloses an attachment for a crane having two fingers which is used to pick up pipes. This application has not as yet been published.

- i) **Advise your client on whether it is possible to amend the patent application to cover the two-finger embodiment. If not, what alternatives are possible?**

4 marks

- ii) **In relation to the three-finger embodiment, how would you address these two earlier documents if they were to be cited by the examiner during examination?**

6 marks

Total: 20 marks

Answer

a) Windsurfing/Pozzoli

- i. Identify the notional 'person skilled in the art' (1 mark)
- ii. Identify the relevant common general knowledge of that person (1 mark)
- iii. Identify the inventive concept (1 mark) of the claim in question (1 mark) or if that cannot readily be done construe it (1 mark)
- iv. Identify what, if any, differences exist between the matter cited as forming part of the state of the art (1 mark) and the inventive concept of the claim (1 mark) or the claim as construed
- v. Viewed without any knowledge of the alleged invention as claimed (1 mark), decide whether those differences constitute steps which would have been obvious to the person skilled in the art (1 mark) or whether they require any degree of invention (1 mark).

b) Advice to the client -

- i) Not possible to amend the application without adding subject matter (1 mark). Can file a new patent application within 12 months claiming priority (0.5 marks) from the first (0.5 marks) and directed to both two and three fingered embodiment (0.5 marks), but the two fingered embodiment will only benefit from the later filing date (0.5 marks). Alternatively, can keep the existing application for the three fingers, and file a second application directed to the two fingered embodiment only (0.5 marks), not limited to 12 months (0.5 marks).
- ii) First document – can be cited for novelty and inventive step (1 mark). The document teaches away from the current invention (three fingers) (1 mark) and so there is a good argument that the current invention is not obvious over this document (1 mark). Second document – when published will be citeable for novelty only (1 mark). Claim 1 of the current invention (three fingers) is novel over the disclosure of this document (1 mark) which discloses only two fingers (will also accept is directed to a surgical instrument and not an attachment to a crane) (1 mark) and therefore is not relevant.

Question 7

By what procedure and by how much can each of the following deadlines be extended? Is the extension discretionary or as of right?

(There is no need to consider reinstatement or restoration.)

- | | |
|--|----------------|
| a) Filing a certified copy of the priority document. | 5 marks |
| b) Payment of a renewal fee. | 3 marks |
| c) Responding to an examination report. | 4 marks |
| d) Filing a divisional application. | 8 marks |

Total: 20 marks

Answers

- a) file form 52 (0.5 marks) requesting extension of two months (0.5 marks) within the 2 month extended period (0.5 marks). As of right (i.e. no evidence is required) (0.5 marks). If beyond that then discretionary (0.5 marks) extension of further two months (0.5 marks) available by filing form 52 (0.5 marks) with evidence (0.5 marks) and fees (0.5 marks). File within further 2 months (0.5 marks)
- b) can be extended as of right (0.5 marks) by up to six months (0.5 marks). No extension beyond six months possible (0.5 marks). Pay renewal fee with late payment surcharge (0.5 marks). The surcharge depends on the number of months of extension required (1 mark).
- c) can be extended as of right (0.5 marks) by two months (0.5 marks) on filing a request in writing (0.5 marks) within the two month extended period (0.5 marks). Further extension possible at the discretion (0.5 marks) of the Comptroller on terms as he sees fit (0.5 marks). Cannot be extended beyond the period for putting the application in order (1 mark).
- d) discretionary (1 mark) extension of two months (1 mark) available under rule 19 (1 mark). But two months (0.5 marks) as of right (1 mark) extension to the compliance period (0.5 marks) (and hence the divisional deadline) with form 52 (0.5 marks). Further discretionary (0.5 marks) two months (0.5 marks) with form 52 (0.5 marks) plus evidence (0.5 marks) plus fee (0.5 marks).

Question 8

In the context of the *UK Patents Act*, discuss:

- a) infringement of a patent for a process by dealing in a product of the process;
6 marks
- b) the provisions of section 23 (restrictions on applications abroad by UK residents).
You are not required to discuss the penalties for contravention of this section; and
6 marks
- c) third-party observations.
8 marks

Total: 20 marks

Answers

- a) it is an infringement where the invention is a process (0.5 marks) and one disposes of (0.5 marks), offers to dispose of (0.5 marks), uses (0.5 marks) or imports (0.5 marks) any product obtained directly by means of a patented process (1 mark) or keeps any such product for disposal (0.5 marks) or otherwise (0.5 marks). Some mention of 'without intermediary' (1 mark) and whether the product has lost its identity or not (0.5 marks).
- b) no person resident in the UK (0.5 marks) shall without written authority from the Comptroller (0.5 marks) file (0.5 marks) or cause to be filed (0.5 marks) outside the UK (0.5 marks) an application for an invention unless
 - i) been filed in the UK at least six weeks before (0.5 marks)
 - ii) no directions under section 22 (0.5 marks)

Only applies if

- i) relates to military technology (0.5 marks) or prejudicial to national security (0.5 marks)
- ii) prejudicial to safety of the public (0.5 marks)

Does not apply if first filed outside the UK (0.5 marks) by a person resident outside the UK (0.5 marks).

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- c) where a patent has been published (0.5 marks) but a patent has not been granted (0.5 marks) any other person (0.5 marks) may make observations in writing (0.5 marks) to the Comptroller (0.5 marks) on the question of whether the invention is a patentable invention (0.5 marks) (some mention of the fact that observations on other points will not be considered (0.5 marks)), stating reasons for the observations (0.5 marks) and the Comptroller shall consider the observations (0.5 marks).

A person does not become party to any proceedings before the Comptroller by reason only that he makes such observations (0.5 marks). Will also accept third party can remain anonymous (0.5 marks)

Observations forwarded to applicant (0.5 marks). Does not apply to any observations which
i) disparage any person (0.5 marks) in a way likely to damage such a person (0.5 marks); or,
ii) be generally expected to encourage offensive (0.5 marks) immoral (0.5 marks) or anti-social (0.5 marks) behaviour

Question 9

An associate in Japan writes:

‘We filed a PCT application on 13 July 2015 in Japanese at the Japanese patent office. The application is for a valve. The application does not claim priority. We amended the claims of the application in the international phase.

We have now become aware of an infringer making and selling an identical valve in the UK. We wish to stop this as soon as possible. We will be filing a European application from the PCT in due course. However, for now we would like you to enter this case into the GB national phase and obtain grant as soon as possible.’

- a) **What steps do you need to take and by when to enter the PCT application into the GB national phase?**
6 marks
- b) **What further steps would you take to expedite prosecution and improve your client’s position as regards the infringer?**
4 marks
- c) **Give an advantage that follows from having the GB patent granted whilst waiting for the European application to be granted.**
1 mark

- d) In due course the GB application is granted. Shortly thereafter the parallel EP application is accepted by the EPO with claims of identical scope.
- i) What issue is likely to arise when the EP application is granted?
1 mark
 - ii) What step can be taken at the EPO to avoid this and by when?
1 mark
- e) Following on from part (d), due to an administrative error on the part of the attorney handling the EP application, the EP application is validated in the UK as an EP (GB) patent. In an attempt to correct this error the attorney then surrendered the EP (GB) patent.
- i) Why was surrendering the EP (GB) patent a bad decision?
1 mark
 - ii) What should have been done instead?
1 mark
- (f) The proprietor will shortly receive an invitation from the UK Intellectual Property Office.
- iii) Summarise the content of this invitation. What is the earliest date the UK Intellectual Property Office will issue this invitation?
4 marks
 - iv) What test is applied by the UK Intellectual Property Office when considering the response?
1 mark
- Total: 20 marks**

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Answers

a) By 31 months from filing (0.5 marks) ie 13 Feb 2018 (0.5 marks) –

- i) file English translation of PCT (0.5 marks) and of amended claims (0.5 marks)
- ii) pay regional processing fee (0.5 marks) and file NP1 (0.5 marks)

By 33 months from filing (0.5 marks) ie 13 April 2018 (0.5 marks) –

- i) file a request for search (0.5 marks) and pay search fee (0.5 marks)
- ii) file a request for examination (0.5 marks) and pay examination fee (0.5 marks)

b)

- i) Take 33 month steps on entry (0.5 marks)
- ii) file a response addressing prior art in international phase (0.5 marks)
- iii) request accelerated publication of translation to get provisional protection (1 mark)
- iv) request expedited examination (0.5 mark) – cite infringer as reason (0.5 marks)
- v) request early entry (1 mark)

c) For example:

- i) can enforce the patent, or
- iii) can pursue a broader scope of protection with EP application

(will accept any other reasonable alternative) (1 mark)

d)

- i) double patenting (1 mark)
- ii) withdraw GB designation (0.5 marks) before date of publication of notice of grant (0.5 marks)

e)

- i) Because the UK Patent Office will begin proceedings to revoke the GB patent (and not the EP(GB) patent) (1 mark)
- ii) should have surrendered the GB patent and kept the EP(GB) patent (1 mark)

f)

- iii) The invitation is to make observations (1 mark) and to amend the specification of the patent (1 mark). The later of the end of the opposition period (1 mark) or the date on which opposition proceedings are disposed of (1 mark)
- iv) test applied – ‘for the same invention’ (1 mark)