

**FC1- UK Patent Law  
FINAL Mark Scheme 2018**

**SECTION A**

**Question 1**

Provide notes on the recent 'Actavis' decision of the British Courts. Your notes should cover the following:

- |                                      |                |
|--------------------------------------|----------------|
| a) Parties to the case.              | <b>1 mark</b>  |
| b) Summary of the facts of the case. | <b>2 marks</b> |
| c) Summary of the decision.          | <b>2 marks</b> |
| d) Precedent set by the case.        | <b>5 marks</b> |

**Total: 10 marks**

**Answer**

(a)  
Actavis and Eli Lilly (1 mark)

(b)  
Minimalistic summary (1 mark)  
More detailed summary, identifying at least the compound in question and claim wording (2 marks)

(c)  
Correct identification of infringement/non infringement (1 mark)  
Discussion of further points (2 marks)

(d)  
Minimalistic discussion of precedent (1 mark)  
Some mention of new Improver questions (2 marks)  
Essentially word perfect recitation of new Improver questions (3 marks)  
Some discussion of consequences in change of wording of Improver questions (4 marks)  
Discussion worthy of newsletter/article (5 marks)

**FC1- UK Patent Law  
FINAL Mark Scheme 2018**

**Question 2**

With reference to *Section 72 UK Patents Act (Power to revoke patents on application)*,

- a) who can apply to revoke a patent; and, **2 marks**
- b) on what grounds? **8 marks**

**Total: 10 marks**

**Answer**

(a)

Any person (1 mark) including the proprietor of the patent (1 mark)

(b)

Grounds –

- (i) the invention is not patentable (1 mark)
- (ii) the patent was granted to a person who was not entitled to be granted that patent (1 mark)
- (iii) the specification of the patent does not disclose the invention clearly enough and completely enough (0.5 marks for either ) for it to be performed by a person skilled in the art (0.5 marks)
- (iv) the matter disclosed in the specification of the patent extends beyond that disclosed in the application for the patent as filed (1 mark)
- (v) the protection conferred by the patent has been extended by an amendment which should not have been allowed (1 mark)

An application on ground (ii)

(vi) may only be made by a person found by the court to be entitled to be granted the patent or granted a patent for part of the matter (1 mark)

(vii) may not be made if that action was commenced after the end of the period of two years (0.5 marks) beginning with the date of grant (0.5 marks) unless it is shown the registered proprietor knew at the time of grant or transfer (0.5 marks) of the patent to him that he was not entitled to the patent (0.5 marks)

**Total: 10 mark**

**FC1- UK Patent Law  
FINAL Mark Scheme 2018**

**Question 3**

- a) With reference to *Section 117 UK Patents Act (Correction of errors in patents and applications)*, what errors may the Comptroller correct?

**4 marks**

**Answer**

Any error of translation (0.5 marks), transcription (0.5 marks), clerical error (0.5 marks) or mistake (0.5 marks) in any specification of a patent (0.5 marks) or application for a patent (0.5 marks) or any document filed in connection with a patent or such an application (1 mark).

**4 marks**

- b) What test must be satisfied before the Comptroller will make a correction of an error in the specification of a patent application?

**2 marks**

**Answer**

The request shall not be granted unless the correction is obvious (1 mark) (in the sense that it is immediately evident (0.5 marks) that nothing else could have been intended (0.5 marks) in the original specification)

**2 marks**

- c) With reference to *Section 27 UK Patents Act (General power to amend specification after grant)*, describe the procedure for making an amendment to a patent post grant.

**3 marks**

**Answer**

Must be made in writing (1 mark), must identify the proposed amendment (1 mark) and state the reason for making the amendment (1 mark).

**3 marks**

**FC1- UK Patent Law  
FINAL Mark Scheme 2018**

d) From what date does a post grant amendment take effect?

**1 mark**

**Answer**

The amendment is considered to have effect from the date of grant of the patent (1 mark)

**1 mark**

**Total: 10 marks**

**Question 4**

With reference to *Section 46 UK Patents Act* ('Patentees application for entry that licences are available as of right')

a) Who may apply to the Comptroller for an entry to be made in the Register to the effect that licences under the patent are to be available as of right?

**1 mark**

**Answer**

The proprietor

**1 mark**

b) When can such an application be made?

**1 mark**

**Answer**

At any time after grant

**1 mark**

c) What steps will the Comptroller take on receipt of such an application?

**3 marks**

**Answer**

Give notice of the application (0.5 marks) to any person registered as having a right under the patent (0.5 marks).

If satisfied that the proprietor of the patent is not precluded by contract (1 mark) from granting licences under the patent (0.5 marks) shall make the entry (0.5 marks).

**3 marks**

**FC1- UK Patent Law  
FINAL Mark Scheme 2018**

- d) What are the consequences of a defendant taking a licence of right during infringement proceedings?

**3 marks**

**Answer**

No injunction shall be granted against him (0.5 marks). Damages (0.5 marks) will not exceed double the amount (1 mark) which would have been payable by him as licensee (0.5 marks) if such a licence had been granted before the earliest infringement (0.5 marks).

**3 marks**

- e) What two conditions must be met before the Comptroller will cancel a licence of right?

**2 marks**

**Answer**

Balance of all renewal fees that would have been payable had the entry not been made are paid (1 mark)  
No existing licence (0.5 marks) or all licensees consent (0.5 marks).

**2 marks**

**Total: 10 marks**

**FC1- UK Patent Law  
FINAL Mark Scheme 2018**

**SECTION B**

**Question 5**

- a) What is a priority date and why is it important?

**5 marks**

**Answer**

The date of priority counts as the date of filing (1 mark) for assessment of patentability (1 mark) amongst other things. Some reference to the words 'supported by the earlier disclosure' (1 mark). It is important as it allows one to file a first application then file later applications (1 mark) after public disclosure of the subject matter of the application (1 mark).

**5 marks**

- b) With reference to section 5 of the UK Patents Act (Priority Date) explain what is meant by partial priority. Give an example of how this could arise.

**5 marks**

**Answer**

A claim can have more than one priority date (1 mark). File a first application for subject matter A (1 Mark). A second application for subject matter B (1 Mark). File a third application with a claim covering both A and B (1 Mark) and claiming priority from both (1 Mark). Any other reasonable example considered.

**5 marks**

Your client rings you on a Friday and describes a rubber widget to you that he has developed. You draft and file a patent application P1 for it that day. Claim 1 of the application reads:

1. A rubber widget

Your client rings you again on Saturday. He has discovered that the widget can also be made from metal and in fact he intends to publish a paper relating to the metal widget on Sunday. On the Saturday you draft and file a new patent application P2. Claim 1 of P2 reads

1. A widget, the widget being either metal or rubber

P2 claims priority from P1.

You have now received a search report on P2 from the UK Patent Office. The search report cites your clients own paper.

- c) Explain how the UK Patent Office can cite the clients own paper even though it was published after P2 was filed. You should give some thought to what filing date the UK Patent Office will award P2

**FC1- UK Patent Law  
FINAL Mark Scheme 2018**

**4 marks**

**Answer**

P2 was filed when UKIPO was closed (1 mark). It claims priority from P1 (1 mark). It therefore receives the next working day as its filing date (1 mark) which is after the date of disclosure of the paper (1 mark)

**4 marks**

- d) What restriction could you make to claim 1 of P2 so that the UK Patent Office could no longer cite the paper? Explain your answer.

**2 marks**

**Answer**

Restrict the claim to the rubber version (1 mark). This is supported by P1 (0.5 marks) and so this subject matter has an effective filing date before the date of disclosure of the paper (0.5 marks).

**2 marks**

- e) Stepping back to point where you have drafted but not filed P2, how should you have proceeded to ensure all the subject matter obtains a filing date before the date of publication of the paper? At the end of your filing strategy you should have only one pending patent application covering both embodiments

**4 mark**

**Answer**

File P2 on Saturday (1 mark) not claiming priority (1 mark). File P2 again within 12 months of filing of P1 (0.5 marks) claiming priority from P1 and P2 (1 mark). Let P1 and P2 lapse (0.5 marks).

**4 mark**

**Total: 20 marks**

**FC1- UK Patent Law  
FINAL Mark Scheme 2018**

**Question 6**

a) A US attorney writes:

Our client is considering filing a UK application claiming priority from a US application filed on 20 November 2017. The US application contains 35 claims and has 45 pages, including a sequence listing which is 2 pages long. The client would like to request combined search and examination on filing. We understand that the UK patent office has recently introduced changes to the search and examination fee structure but we are not sure of the details.

a) Advise the US attorney of the fee changes which would apply when filing the UK application, including what fees are payable, when these are payable and how they are calculated. The exact amount of the fees is not required.

**11 marks**

**Answer**

Application must be filed by 20 November 2018 and thus search/examination will be requested after 6 April and the new fee structure is therefore applicable (1 mark).

Excess claims fees –

When requesting search (1 mark) one must pay an excess claims fee for every claim over 25 (1 mark) – so 10 claims would be payable (1 mark). Calculated based on the number of claims in the application on the date the request for search is filed (1 mark). Could reduce the number of claims to avoid/reduce paying the excess claims fees (1 mark).

Excess pages fees –

When requesting examination one must pay an excess pages fee for each page of description over 35 (1 mark) calculated on the date of the request for examination (1 mark). Sequence listings do not count (1 mark) so 8 pages payable (1 mark). Could reduce the number of pages, e.g. by changing font/spacing, to reduce the fees (1 mark).

**11 marks**

b) A few days later, the US attorney writes:

I understand that a grant fee is now payable for some UK applications but I am not sure how the UK Intellectual Property Office determines whether a grant fee is payable.

Explain the grant fee process to the US attorney, including the circumstances in which the grant fee is payable as well any deadlines or extensions for paying the grant fee.

**9 marks**

**FC1- UK Patent Law  
FINAL Mark Scheme 2018**

Grant fee –

The patent office carries out a check for unpaid excess claims or pages fees at the time of acceptance (1 mark). A fee is required where –

(i) there were 25 or fewer claims fees when search was requested and there are more now (1 mark)

(ii) there were 35 or fewer pages of the description when examination was requested and there are more now (1 mark)

(iii) the number of excess claims or pages has increased above the number paid earlier in the process (1 mark).

The patent office will advise the applicant if a grant fee is due (1 mark). Applicant has two months to pay the fee (1 mark).

Excess claims fees or excess pages fees are not taken into account where the corresponding request for search or exam was filed before 6 April 2018 (1 mark).

Two month extension (1 Mark). Form 52 (0.5 marks) and payment of fee (0.5 marks).

**9 marks**

**Total: 20 marks**

**FC1- UK Patent Law  
FINAL Mark Scheme 2018**

**Question 7**

Your client has acquired a portfolio of UK patents and applications.

- a) **What actions in relation to the whole portfolio should be undertaken at the UK Intellectual Property Office?**

**2 marks**

- b) **For each of the UK patents and applications listed below, advise your client as to what actions should be taken within the next six months and by when. For any dates you give, explain how they have been calculated.**

- i) Patent D1 was filed on 10 February 2013. It was granted on 2 October 2018.

**5 marks**

- ii) Patent application D2 (which has no excess pages and no excess claims) was filed on 28 January 2013 and is pending. A first office action was issued on 28 January 2018. A response has been filed and the Patent Office has yet to reply. The client wishes to file a divisional application.

**6 marks**

- iii) Patent application D3 is the GB national phase of a PCT application. All necessary steps to enter the application in to the GB national phase have been completed. The application was entered into the GB national phase on 1 October 2018. On review of the file you note the applicants have filed an earlier GB application which is identical to the PCT. There are 13 months between the filing dates of the GB and PCT applications. The PCT does not claim priority from the GB application.

**4 marks**

- iv) Patent application D4 is an unpublished patent application filed eight months ago. No fees have as yet been paid. Your clients are aware of a potential infringer.

**3 marks**

**Total: 20 marks**

**Answers**

(a)

Request recordal of the assignment document (1 mark) within six months of the date of the assignment (1 mark)

**2 marks**

(b)(i)

5<sup>th</sup> and 6<sup>th</sup> year renewal fees (0.5 marks each) are both due on 31 Jan 2019 (0.5 marks).  
End of month (1 mark) three months (1 mark) from grant date (0.5 marks).

**FC1- UK Patent Law  
FINAL Mark Scheme 2018**

7<sup>th</sup> year renewal fee is due 28 Feb 2019 (0.5 marks). End of month six years from filing (0.5 marks)

5 marks

(b)(ii)

On the parent case – ask the Patent Office for an update (1 mark) as the compliance deadline is 28 Jan 2019 (0.5 marks). Later of four years and six months from priority and twelve months from first office action (1 mark)

For the divisional application divisional deadline is 28 Oct 2018 (0.5 marks). Three months before compliance deadline (1 mark). File application (0.5 marks), pay filing fee (0.5 marks), search fee (0.5 marks) and exam fee (0.5 marks).

6 marks

(b)(iii)

Request late addition of priority (0.5 marks), pay fee (0.5 marks), by 1 November 2018 (0.5 marks). One month from entry into regional phase (1 mark). File evidence (0.5 marks) (will also accept wait for patent office to request evidence) that the omission was ‘unintentional’ (1 mark)

4 marks

(b)(iv)

File statement of inventorship (0.5 marks), search fee (0.5 marks), filing fee (0.5 marks), exam fee (0.5 marks), request expedited prosecution (0.5 marks), provide copy of the application to potential infringer (0.5 marks).

3 marks

**Total: 20 marks**

**Question 8**

Your client writes:

I used to work for an automotive manufacturer. I worked in the accounts department however since I have a background in chemistry I was assigned a task of developing new coatings. As a result of this I developed a new coating which, when applied to a spark plug, significantly increases the reliability of the spark plug. I filed a GB patent application having one claim to a combination of coating and spark plug. The application has been granted. I now make and sell these coated spark plugs. Sales have really taken off so I left my employment and sell them full time.

I have received a letter from my former employers demanding that I assign the patent to them immediately. They have threatened me with future infringement proceedings if I do not comply immediately. I understand they have sent letters to my customers again threatening infringement proceedings. They have already started supplying the coating to customers in the UK and abroad.

I would like to retain my patent and stop their supply.

**FC1- UK Patent Law  
FINAL Mark Scheme 2018**

- a) Summarise the provisions of Section 39 UK Patents Act (Right to employees inventions). In your opinion, who is entitled to the invention, your client or his employer? Explain your answer.

**8 Marks**

Answer

Belongs to the employer if –

Was made in the course of normal duties (0.5 marks) of the employee.

In the course of duties falling outside his normal duties (0.5 marks) but specifically assigned to him (0.5 marks)

And the circumstances in either case (0.5 marks) were such that an invention might reasonably be expected to result (0.5 marks) from the carrying out of his duties (0.5 marks).

Also belongs to the employer if –

The invention was made in the course of the duties of the employee (0.5 marks) and at the time of making the invention (0.5 marks), because of the nature of his duties and the particular responsibilities arising from the nature of his duties he has a special obligation (0.5 marks) to further the interests of the employer's undertaking (0.5 marks).

Likely to belong to the employer (1 mark). Invention followed from duties specifically assigned to the client (1 mark). Some discussion of whether the invention might reasonably be expected to follow from carrying out of his duties (1 mark).

**8 Marks**

- b) Assuming your client is entitled to the invention, what action can your client take to prevent supply of the coating by the automotive manufacturer? What would your client need to be able to demonstrate to be successful in such an action?

**7 Marks**

Answer

Proceedings for contributory infringement (1 mark) for supply in the UK (1 mark). Cannot be brought for supply abroad (1 mark) as there is a double territorial requirement (1 mark),

Need to determine if it was known (0.5 marks) or obvious (0.5 marks) to a reasonable person (0.5 marks) in the circumstances (0.5 marks) that these means are suitable for putting (0.5 marks) and are intended to put (0.5 marks) the invention into effect.

**7 Marks**

- c) For both your client and your clients customers discuss whether they can bring proceedings for groundless threats (Section 70 UK Patents Act). If so, what remedies are available?

**5 Marks**

**FC1- UK Patent Law  
FINAL Mark Scheme 2018**

Answer

Client - no (1 mark), cannot bring proceedings for a threat to bring proceedings for an infringement alleged to consist of making (0.5 marks) or importing (0.5 marks) a product for disposal (0.5 marks).

Customer - yes, exclusion does not apply (1 mark).

Remedies –

Declaration that the threats are unjustifiable (0.5 marks)

Injunction against continuation of the threats (0.5 marks)

Damages in respect of any loss which the plaintiff or pursuer has sustained by the threats (0.5 marks)

**5 Marks**

**Total: 20 marks**