

Introduction

As in previous years, the standard of answers was highly variable. There were a number of excellent scripts. Some candidates appeared not to be sufficiently prepared to take the examination.

On the whole, the structure of answers was not as good this year as in previous years. A shotgun approach to answering questions was very much in evidence. Answers often included several pages on issues that were not asked in the question. It is strongly emphasised that candidates should carefully read the question and decide what is being asked. For the longer questions in particular, candidates should identify each issue of relevance (for example, infringement, entitlement, revocation) and then break down their answer such that each issue is addressed. A 'stream of consciousness' type approach which intermingles separate issues rarely scores well.

Part A

Question number	Comments on questions
Question 1	<p>Question 1 asked candidates to provide notes on the recent 'Actavis' decision of the British courts. This is an important recent decision which has significantly impacted day-to-day practice of UK patent attorneys. Candidates should have a detailed knowledge of this decision.</p> <p>On the whole, this question was answered well. Most candidates were able to identify the changes to the improver questions and the significance of these changes. Few candidates discussed the potential importance of the prosecution history of the patent.</p>
Question 2	<p>Question 2 related to who can apply to revoke a patent and on what grounds.</p> <p>Again, this question was answered well. What distinguished responses that were awarded high marks was a detailed knowledge of the Act. Average candidates identified the grounds for revocation in a general sense. Good candidates were able to explicitly recite the provisions of the Act.</p> <p>A number of candidates seemed unaware that the proprietor was able to revoke their own patent.</p>
Question 3	<p>Question 3 related to what errors the Comptroller may correct and how this is done.</p> <p>Again, most candidates appeared to know what can be corrected, but only in a general way. Again, the best responses explicitly recited the provisions of the Act.</p>

Question 4	<p>Question 4 related to licences of right, the effect of taking a licence of right during infringement proceedings and the conditions that must be met before the Comptroller will cancel a licence of right.</p> <p>This question was answered well, although there was some uncertainty as to the steps the Comptroller will take on receipt of such an application.</p>
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Part B

Question number	Comments on question
Question 5	<p>Part 5a) asked for the meaning of priority date and some discussion of why it is important. The main point that the examiner was looking for was that the priority date acts as an effective filing date for determination of the prior art. This part of the question was answered well.</p> <p>Part 5b) asked for an explanation of the meaning of partial priority and for an example of how this could arise. Again, this caused candidates little difficulty.</p> <p>The remainder of the question related to a scenario in which a client filed a second patent application on a Saturday, claiming priority from an earlier first patent application, and then disclosed the invention on the Sunday. Most candidates appreciated that the second patent application would receive Monday as its filing date, and hence the client's own disclosure would count against the new subject matter in the second patent application.</p> <p>Very few candidates were able to identify what should have been done to avoid this problem. The second application should have been filed <u>without</u> claiming priority from the first so that it received Saturday as its filing date. A third application could then be filed on the Monday claiming priority from the first two applications, and the first two applications allowed to lapse.</p> <p>On the whole this question was answered well by candidates.</p>
Question 6	<p>Only a small number of candidates answered this question. The candidates who did answer it tackled it well.</p> <p>The UK Patent Office recently introduced a new fee structure, introducing excess claims fees, excess pages fees and grant fees.</p> <p>This question essentially asked candidates when these new fees were payable and how they were calculated. It was a straightforward question on an important change in practice of the UK Patent Office. This topic will continue to be examined.</p>

Question 7	<p>Part 7a) related to general matters that should be attended to when taking over a patent portfolio on behalf of a client. One should record the assignment and take over representation as soon as possible.</p> <p>Part 7b)i) related to payment of renewal fees on a recently granted patent. The majority of candidates answered this well, recognising that the fifth and sixth year renewal fees were due within three months of grant. A small number of candidates were of the opinion that the fifth and sixth year renewal fees were not payable as the grant date did fall more than five years after filing.</p> <p>Part 7b)ii) related to prosecution of a parent case and the filing of a divisional application. The majority of candidates were able to correctly calculate the compliance deadline on the parent case and the divisional deadline, and also the steps that were necessary to file the divisional application. A significant number of candidates neglected to mention what should be done as regards the parent application. As the compliance deadline was imminent, one should contact the Patent Office in order to expedite a response from them.</p> <p>Part 7b)iii) related to a late declaration of priority. Few candidates were aware that a late declaration of priority can be made within one month of entry of a PCT application into the GB national phase.</p> <p>Part 7b)iv) related to the situation where the clients owned an unpublished application and were aware of a potential infringer. The essential point is that one should expedite prosecution of the patent application by paying any outstanding fees and requesting accelerated prosecution. One should also put the potential infringer on notice of the existence of the patent application.</p>
Question 8	<p>Part 8a) related to employee inventions. The question asked candidates to recite the provisions of section 39. Most candidates had a general idea of the circumstances in which an employee invention belongs to the employer. The best candidates were able to set out in detail the circumstances in which an invention belongs to an employer rather than the employee.</p> <p>This part of the question also asked candidates for an opinion as to whether the invention belonged to the employer or the employee. It is likely that the invention would be considered to belong to the employer as it was created as a result of duties specifically assigned to the employee. Some discussion of whether the invention was reasonably expected to result from the carrying out of the duties was required.</p>

	<p>Part 8b) related to contributory infringement. The patent had a claim relating to a combination of spark plug and coating, whereas the manufacturer was only providing the coating. A surprising number of candidates argued that this was direct infringement, rather than contributory infringement.</p> <p>Of the candidates who correctly identified that this was contributory infringement, they almost invariably answered this part of the question well.</p> <p>Part 8c) related to threats. The main point that the examiner was looking for was that threats made to a manufacturer or importer of a product for disposal are not actionable threats. Threats made to the client's customers, however, were actionable threats.</p> <p>A number of candidates stated that a client's customers do not infringe the patent as they had bought the product from the client in good faith. This was not correct.</p> <p>Almost all candidates who answered this part of the question were able to correctly identify the remedies available.</p> <p>Part 8c) asked candidates to consider the position of the client, the client's customers and also the remedies available. Many candidates unnecessarily failed to achieve marks as they did not address all three points.</p>
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