

FC1- UK Patent Law
FINAL Mark Scheme 2019

SECTION A

Question 1

According to Section 60 (*meaning of infringement*) list five acts which do not constitute infringement of a patent

5 marks

Answer

Any five of Section 60(5), one mark for each

Total: 5 marks

Question 2

Write notes on one leading case of the British Courts where novelty or inventive step is the main issue. Your notes should cover the parties to the case, a summary of the facts of the case, a summary of the decision and a brief discussion of what precedent is set by the case

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

Total: 10 marks

Answer

- Correct identification of the two parties (1 mark)*
- Cursory summary (1 mark). More detailed summary covering most of the main issues (2 marks)*
- Correct identification of decision (1 mark). Associated reasoning (2 marks)*
- Cursory summary of precedent (1 mark). More detailed summary identifying at least some of the main points (2 marks). Detailed summary identifying all the main points (3 marks). Consideration of more subtle consequences of the decision (4 marks). Summary worthy of newsletter (5 marks).*

Total: 10 marks

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Question 3

Explain whether it is possible for a UK patent application to claim priority from the following? In each case justify your answer.

- a) **A UK design application;** 1 mark
- b) **A scientific paper published in a reputable scientific journal;** 1 mark
- c) **A European patent application which does not designate GB;** 1 mark
- d) **A US provisional application** 1 mark

Total: 4 marks

Answer

- a) *No (0.5 marks). A UK design application is not an application for an invention (0.5 marks).*
- b) *No (0.5 marks). Same as above (0.5 marks),*
- c) *Yes (0.5 marks). An EP application is treated as equivalent to an application in a convention country (0.5 marks).*
- d) *Yes (0.5 marks). It is possible to convert a US provisional application into a full US patent application (0.5 marks).*

Total: 4 marks

Question 4

With reference to Section 110 UK Patents Act (Unauthorised claim of patent rights) what defences are available to a claim that a person has falsely represented that something disposed of by that person for value is a patented product

3 marks

Answer

There is a patent for the product (1 mark)

The representation was made after the patent expired/revoked and before the end of a period which is reasonably sufficient to enable the accused to take steps to ensure the representation is not made/continues to be made (1 mark)

Used due diligence to prevent the commission of the offence (1 mark)

Total: 3 marks

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Question 5

With reference to Section 36 of the UK Patents Act (Co-ownership of patents and applications for patents) summarise the rights of joint proprietors of a patent.

8 marks

Answers

Each of them (0.5 marks) shall be entitled, by himself (0.5 marks) or his agents (0.5 marks), to do in respect of the invention concerned (0.5 marks), for his own benefit (0.5 marks) and without the consent of (0.5 marks) or the need to account to (0.5 marks) the other or others, any act which would apart from this subsection and Section 55 (Crown Use) amount to an infringement (0.5 marks) of the patent concerned

*One of them shall not without the consent of the other or others(0.5 marks) –
(a) amend 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);
(b) grant a licence under the patent (0.5 marks) or assign (0.5 marks) or mortgage (0.5 marks) a share in the patent or in Scotland cause or permit a security to be granted over it (0.5 marks).*

Total: 8 marks

Question 6

According to Section 1 UK Patents Act (*Patentable Inventions*) a scheme, rule or method for performing a mental act as such is not patentable. Explain how this exclusion is interpreted in practice, the aim of the exclusion and how a claim may avoid the exclusion

4 marks

Answer

Any reasonable point acceptable, including but not limited to any four of the following-

To be interpreted narrowly – covers acts that are carried out by ‘purely mental means’ and does not extend to those which are merely capable of being performed mentally. (1 mark)

The aim of the exclusion is to prevent patents being granted which could be infringed by thought alone (1 mark)

A claim carried out on a computer is not excluded (1 mark)

A claim avoids the mental act exclusion if it is ‘tethered’ to a step of manufacturing a designed product. (1 mark)

Some discussion of the meaning of ‘as such’ (1 mark).

Total: 4 marks

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Question 7

With reference to Schedule A2 of Section 76A UK Patents Act (Biotechnological Inventions) state three biotechnical inventions which are not patentable?

6 marks

Total: 6 marks

Answers

Any three from -

The human body (0.5 marks), at the various stages of its formation and development (0.5 marks), and the simple discovery of one of its elements (0.5 marks), including the sequence or partial sequence of a gene (0.5 marks);

Processes for cloning (1 mark) human being (1 mark);

Processes for modifying the germ line genetic identity (1 mark) of human beings (1 mark);

Uses of human embryos (1 mark) for industrial (0.5 marks) or commercial (0.5 marks) purposes;

Processes for modifying the genetic identity of animals (0.5 marks) which are likely to cause them suffering (0.5 marks) without substantial medical benefit to man or animal (0.5 marks), and also animals resulting from such processes (0.5 marks);

Any variety of animal or plant (0.5 marks) or essentially biological process (0.5 marks) for the production of animals or plants, not being a micro-biological or other technical process (0.5 marks) or the product of such a process (0.5 marks).

Total: 6 marks

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SECTION B

Question 8

- a) According to Section 74A UK Patents Act who may request the Comptroller to issue an opinion?
1 mark
- b) On what issues will the Comptroller issue an opinion?
4 marks
- c) The Comptroller will issue an opinion in respect of an expired patent. Give one example of a situation in which this might be useful to a third party.
1 mark
- d) What must be filed when requesting such an opinion?
3 marks
- e) Briefly summarise the procedure followed by UKIPO from the receipt of such a request for an opinion through to the issuance of the opinion.
10 marks
- f) According to Section 74B UK Patents Act who may seek a review of the opinion?
1 mark

Total: 20 marks

Answers

- a) *The patent proprietor (0.5 marks) or any other person (0.5 marks)*
- b) *As to whether a particular act constitutes, or if done would constitute, an infringement of the patent (0.5 marks); and,
As to whether, or to what extent, the invention in question is not patentable because the condition in Section 1(1)(a) (ie new) (0.5 marks) or (b) (ie involves an inventive step) (0.5 marks) is not satisfied.
Whether the specification of the patent discloses the invention clearly enough and completely enough for it to be performed by a person skilled in the art (0.5 marks)
Whether the matter disclosed in the specification of the patent extends beyond that disclosed in the application for the patent as filed or, if the patent was granted on a divisional application or new application under s8(2), s12(6) or s37(4) the earlier application as filed (0.5 marks)
Whether the protection conferred by the patent has been extended by an amendment which should not have been allowed (0.5 marks)
Whether a SPC is invalid under Article 15 of the medical products regulation (0.5 marks)
Whether an SPC is invalid under Article 15 of the plant protection products regulation (0.5 marks)*

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In each case above paraphrasing is acceptable.

- c) *Infringement/validity opinion relating to an act performed whilst the patent was still in force (1 mark);
Any other reasonable answer is acceptable*
- d) *File form (0.5 marks); pay the fee (0.5 marks); file a statement setting out the question on which an opinion is requested (0.5 marks); file submissions including any matters of fact which are to be taken into account (0.5 marks). File details of any person whom the requester is aware of having an interest in the question (0.5 marks). File details of any proceedings of which the requester is aware that have relevance to the patent and the question (0.5 marks).*
- e) *The making of the request is advertised (0.5 marks). The request is also notified to the patent holder (0.5 marks), and registered licensee (0.5 marks) or sub licensee (0.5 marks), anyone who has filed a caveat (0.5 marks), any person named in the statement (0.5 marks) and any person who appears likely to have an interest (0.5 marks).*

Any person (0.5 marks) may file observations (0.5 marks) within four weeks (0.5 marks) of the date of advertisement (0.5 marks) of the request. These are sent to the patent holder (0.5 marks) and the requester (0.5 marks). Any person to whom the observations are sent (0.5 marks) may send observations in reply (0.5 marks)

UKIPO prepares the opinion (0.5 marks). This is sent to the requester (0.5 marks), the patent holder (0.5 marks) and any person who filed observations (0.5 marks). Published on the web site (0.5 marks).

- f) *The patent holder (0.5 marks) and an exclusive licensee (0.5 marks).*

Total: 20 marks

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Question 9

Your client writes:

'We make tarmac. As you may be aware tarmac is essentially a mixture of glass particles and tar. We have discovered that for a particular ratio X of tar to glass particles the tarmac has very desirable properties for laying as a road surface. We filed a PCT application for our invention and then to be honest we forgot about it.

We have now discovered a competitor who is selling bags of tarmac with a tar to glass particle ratio of X. They are also selling tar and bags of glass particles. They are selling these goods to a single customer who is using them to lay roads.

What should we do?

You obtain a copy of the PCT application. It was filed on 1 July 2017 without claiming priority. There is no record of it being entered into any national or regional phase. The PCT application has one independent claim which is to a method of applying tarmac to a road surface, the tarmac having a ratio of tar to glass particles in the range X +/- 10%. The search report does not cite any relevant prior art. The written opinion only raises a minor clarity objection.

Prepare notes for a meeting with your client. In addition to notes as to how to proceed, your notes should also include a list of potentially infringing acts and parties with reasons and also whether there are any potential defences to infringement.

Total: 20 marks

Answers

For the PCT application –

- a) *pay regional processing fee (0.5 marks) and file NP1 (0.5 marks)*
- b) *file a request for search (0.5 marks) and pay search fee (0.5 marks)*
- c) *file a request for examination (0.5 marks) and pay examination fee (0.5 marks)
All of the above as soon as possible (0.5 marks) and before 31 months from filing (0.5 marks)*
- d) *file a response to the written opinion addressing the clarity objection (0.5 marks)*
- e) *request expedited examination (0.5 marks) citing the infringers as a reason (0.5 marks).*

Infringing Acts –

- a) *For the competitor (0.5 marks) –*
 - (i) *supply/offer to supply of the tarmac mixture (1 mark). Whilst the claim is a method claim the mixture is an essential element of the invention (0.5 marks) provided the infringer knows or it is obvious to a reasonable person in the circumstances (0.5 marks) that those means are suitable for putting and are intended to put (0.5 marks) the invention into effect in the UK.*
 - (ii) *supply/offer to supply of the tar and bags of glass (1 mark). Potential defence – these are staple commercial products (0.5 marks). However this defence does*

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not apply if the offer is made for the purpose of inducing the person supplied to do an act which constitutes an infringement of the patent (1 mark).

- b) *for the customer (0.5 marks)-*
- (i) use of the process to lay a road (1 mark).*
 - (ii) disposes of (0.5 marks) or keeps (0.5 marks) the direct product (0.5 marks) of the process (ie the road surface (1 mark))*
- c) *the owner of the road (0.5 marks)*
- (i) keeps the direct product of the process (1 mark).*

Further defences to infringement –

- (i) process was in use before the filing date of the PCT (0.5 marks) and hence the patent is invalid (0.5 marks)*
- (ii) bags of tarmac in the correct mix were offered for sale by the competitor before the filing date of the PCT (0.5 marks)*

Further actions –

- (i) put competitor and customer on notice of the patent application (0.5 marks)*
- (ii) make further enquires as to date of first use above (0.5 marks);*
- (iii) trap purchase of bags of tarmac and also tar and glass (0.5 marks).*
- (iv) further prior art search (0.5 marks).*

Total: 20 marks

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Question 10

- a) Respond to the following questions asked by your client –
- b) My friend and I have jointly developed an invention. My friend is not interested in filing a patent application however I would like to obtain patent protection. My friend is agreeable to this and is happy to sign any documents required. How should I proceed?
4 marks
- c) I disclosed my latest invention at a public talk this morning before I came to this meeting. Can I file the notes I handed out as a patent application? Is there anything else you suggest I should be doing in relation to filing the application? Even if I do file the notes as an application the filing will be after I gave the talk and so presumably the talk is still prior art?
5 marks
- d) I have heard that by making one of my patents 'licence of right' renewal fees are halved. What other consequences does this have?
8 marks
- e) Whilst on the subject of licences, I have attempted to obtain an exclusive licence to a patent owned by a third party. In reply the third party has offered me a sole licence. What is the difference between the two?
3 marks

Answers

- (a) *File the application in the name of the client (1 mark). Have the friend sign an assignment document (1 mark) and record this at UKIPO (1 mark). This can be done before (0.5 marks) or after filing (0.5 marks).*
- (b) *Yes (1 mark). Claims are not required (1 mark). File a claim set if possible (1 mark) also a description of any other embodiments of importance (1 mark). The talk is not prior art as all days are indivisible (1 mark)*
- (c) *Any person shall be entitled as of right to a licence under the patent (0.5 marks) on such terms as may be settled by agreement (0.5 marks) or, in default of an agreement, by the Comptroller (0.5 marks) on the application of either party (0.5 marks).*

In proceedings for infringement of the patent if the defendant undertakes to take a licence no injunction shall be granted (0.5 marks) and damages shall not exceed double the amount (0.5 marks) which would have been payable if such a licence on those terms had been granted before the earliest infringement (0.5 marks).

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If the proprietor refuses (0.5 marks) or neglects (0.5 marks) to bring proceedings for infringement within two months (0.5 marks) of being asked by the licensee the licensee may institute proceedings for infringement in his own name (1 mark).

Cancelling the licence or right results in repayment of the missing renewal fees (1 mark)

Existing licensees can exchange the licence for a licence of right if more favourable (1 mark)

- (d) *An exclusive licence excludes the patent proprietor whereas a sole licence does not (1 mark). An exclusive licensee can bring proceedings for infringement whereas a sole licensee may not (1 mark), depending on the terms of the licence (1 mark).*

Total: 20 marks

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Question 11

- a) Your client makes hinges for gates. They filed their own patent application (P1) on 14 November 2018 to a hinge mechanism for a garden gate. You review the application and see it comprises one claim, a description and drawings only. The one claim is to a garden gate hinge. The description describes several embodiments of the hinge, both alone and in combination with a garden gate.

The clients have paid the filing and search fees for P1 and a search report issued on 14 Feb 2019. The search report cites one document D1. D1 is a PCT application designating all states. It has a priority date of 14 June 2017 and was published on 14 December 2018. D1 relates to a lid for a biscuit tin but the description shows use of a hinge which is substantially identical to the client's hinge apart from scale.

Advise your client on the procedure for prosecuting P1 through to grant, including any time scales. Include a detailed consideration of the impact (if any) of D1 as prior art and how you might overcome it if necessary

16 marks

- b) Your client has a new embodiment of the hinge. The new embodiment is identical to the previous embodiment but also includes a restoring spring. You client states that such restoring springs are in common use with garden gate hinges but they would like to protect this variant. You file a second application P2 today claiming priority from the first. The second application includes the content of the original application P1 as well as a description of the new embodiment and also a dependent claim (claim 2) to the restoring spring. What objection will the UKIPO raise to a combination of claims 1 and 2 during examination? Explain your answer

4 marks

Total: 20 marks

Answers

- a) *File an abstract (0.5 marks) by 12 months from filing (0.5 marks). File a statement of inventorship (0.5 marks) by 16 months from filing (0.5 marks). Request examination (0.5 marks) by 6 months from publication (0.5 marks), pay exam fee (0.5 marks), file form 10 (0.5 marks) and pay excess pages fees if any (1 mark). Respond to the office action within the time set by UKIPO (1 mark). Application to be in order for grant by later of 12 months from first office action (0.5 marks) or four years and six months from priority (0.5 marks).*

D1 is novelty only prior art (1 mark) if entered into the EP regional phase (0.5 marks) or GB national phase (0.5 marks) and fees paid (1 mark) and any necessary translations filed (1 mark). If D1 is not so entered then no claim amendment is necessary as D1 is the only cited document (1 mark). If D1 is novelty only prior art then two options – (a) make no claim amendment (1 mark). Argue that the 'garden gate' element implies a scale limitation. A biscuit tin hinge is different in scale and not a garden gate hinge (1

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mark). (b) Amend the claim to a combination of garden gate and garden gate hinge (1 mark). D1 is novelty only prior art and does not disclose such a combination (1 mark). Any other reasonable alternative is acceptable.

16 marks

- b) Lack of inventive step (1 mark). A combination of claims 1 and 2 does not have the priority date of the original application as the spring was added later (1 mark). D1 was published before the claim to the spring was added and so is full prior art (1 mark). This can be combined with the common general knowledge of use of a restoring spring in this field (1 mark).*

4 marks

Total: 20 marks