Examiner's Report 2019
FC1 – UK Patent Law

Patent Examination Board

Introduction

A larger number of candidates than usual sat the examination this year. The pass rate was lower than usual and some candidates failed the paper quite badly. It appeared that some candidates sat this paper too early. It is recommended that candidates should prepare for at least a year before sitting the paper.

Many candidates structured their answers well. However, a persistent number of candidates again seemed to favour a "stream of consciousness" approach to answering questions. Almost invariably, such an approach does not score well. Candidates are advised to spend some time, after reading a question, identifying exactly what is being asked and then addressing each point in turn in order to obtain the maximum number of marks.

Questions

Part A

Question number	Comments on questions
Question 1	Question 1 was a straightforward question requiring the candidates to list acts which do not constitute infringement according to Section 60. Almost all candidates answered this question well.
Question 2	Question 2 was a standard question asking candidates to write notes on one leading case in the British courts relating to either novelty or inventive step. Again, this question was answered well. No candidate scored full marks however. For full marks to be awarded, the examiner was looking for an in-depth knowledge of the case, which typically can only be acquired by reading the court decision, rather than a summary. Reading the full decisions is important practice, as often there are incidental points which are not mentioned in summaries.
Question 3	Question 3 was a short questions asking whether a patent application could claim priority from various documents. On the whole this was answered well. The question asked the candidates to justify their answer in each case. In many instances, candidates simply wrote the answer without any justification. This, of course, failed to achieve marks. The important point is that a patent application can only claim priority from an earlier application for an invention. Many candidates are simply of the opinion that a patent application can only claim priority from an earlier patent application.

Question 4	Question 4 was again a short question, worth only three marks. This question asked for the defences available to a claim that a person has falsely represented that something is a patented product. Again, this was answered well, although many candidates missed the obvious point that one defence was that the product was in fact patented.
Question 5	Question 5 asked candidates to summarise the rights of joint proprietors of a patent. This was a simple test of memory and the question was either answered very well or poorly.

Part B

Question number	Comments on question
Question 6	Question 6 was a more taxing question and asked candidates to explain the meaning of the mental act exclusion. This question was answered surprisingly well in many cases. The examiner was looking for some discussion of the meaning of the words "as such", some appreciation that exclusions tend to be interpreted narrowly and also that some discussion of how an objection on these grounds can be avoided by "tethering" the claim in a technical application. The question was divided into three parts, i.e. how the exclusion interpreted, the aim of the exclusion and how a claim may avoid the exclusion. Candidates who answered the question well separated their answers into these three parts. Candidates who took more of a stream of consciousness approach tended to answer the question less well.
Question 7	Question 7 asked candidates to state three biotechnical inventions which are not patentable according to Section 76A of the Patents Act. This part of the syllabus has not been examined for many years. Candidates who were familiar with this part of the syllabus answered the question well.

Question 8	Question 8 was a long question relating to obtaining an opinion from the Comptroller. Not many candidates answered this question and those who did seemed to be aware of the procedure only in vague outline. The examiner is aware that obtaining such an opinion is not part of day-to-day practice; however, this is an important tool of which all patent attorneys should be aware. In particular, candidates should be aware of the grounds on which the comptroller will issue an opinion and so when this tool is available. This is not available in all cases.
Question 9	Question 9 related to potential infringement of a patent application directed to a method of applying tarmac having a specific composition. The question was in two parts, the first part being how to enter a PCT into the GB national phase and secondly, identification of infringers and infringing acts. The first part relating to entry of the PCT into the GB national phase was answered well, with many candidates identifying all of the steps required. The second part of the question proved more challenging. The claim was to a method of laying a road employing tarmac of a specific composition. A competitor sold the tarmac mixture whilst a customer of the competitor used the tarmac mixture to lay the road. For the customer, the position is relatively straightforward. The customer was employing the method and so this was a case of direct infringement. The customer also had in their possession the direct product of the process. Few candidates appreciated that, if the road was being laid for a third party, then the third party was also in possession of the direct product of the process. For the competitor, this was a question of contributory infringement. The tarmac mixture is an essential element of the invention and so there was a case of contributory infringement. The competitor also sold tar and glass particles. These are staple products; however, if they are sold with an inducement to perform the infringing act, this may also be an infringement. Most candidates missed this point.

Question 10	Question 10 was a popular question and was answered well. The first part of the question was answered well by almost all of those candidates who recognised that an assignment was required, either before or after filing. The second part was more problematic. Many candidates did not appear to appreciate that since the public disclosure was on the same day of the meeting then, if the patent application was filed that day, the talk does not count as prior art. The last two parts of the question relating to licences were answered well.
Question 11	Question 11 related to a patent application directed to a garden gate hinge. Part A of the question asked for a general overview of patent prosecution from receipt of the search report up to grant and also some discussion as to how the claim of the application could be amended in view of a prior art document D1. The first part of this was answered well by most candidates, although in some cases detail was lacking. The second part proved more challenging. Many candidates correctly identified that D1 was novelty-only prior art. Surprisingly, however, very few candidates seemed to appreciate that it was only novelty-only prior art if D1 was entered into the GB or EP regional phases and the appropriate fees/translations filed. If D1 was not entered into the GB/EP regional phase then no claim amendment was required. If D1 was so entered then the examiner was looking for some argument that the claim was novel as it was a garden gate hinge, rather than a biscuit tin hinge, or, failing that, amending the claim to relate to a combination of garden gate hinge and garden gate to provide novelty. Part B of the question related to a second application P2, which claimed priority from P1. P2 was identical to P1 except that it included a second embodiment of the hinge including a restoring spring and a dependent claim 2 to the spring. Part B was a question about priority date. By combining claims 1 and 2, one loses the original priority date and so D1 now becomes full prior art. Many candidates seemed to be confused on this point and identified the issue as being one of added subject matter or non-unity of invention.