

FC1- UK Patent Law
FINAL Mark Scheme 2020

SECTION A

Question 1

With reference to *Section 1* of the *UK Patents Act 1977 (Patentable inventions)*, list six things which are **not** inventions for the purposes of the Act.

3 marks

Answer

Any six of Sections 1(2). 0.5 marks each

3 marks

Question 2

GB patent application A was filed on 16 September 2019. GB patent application B was filed on 16 September 2020, along with a request for early publication. It has not as yet been published. When filing B, the claim to priority from application A was accidentally omitted. What steps should you take to correct this omission and by when? What extensions of time are available?

5 marks

Answer

Withdraw the request for early publication (1 mark). File form (form 3) requesting addition of the priority claim (1 mark). This must be done by sixteen months from the filing date of A (0.5 marks) and after withdrawal of the request for early publication has been filed (0.5 marks). No extension of time available (1 mark). After filing the form 3, file a new request for early publication (1 mark).

5 marks

Question 3

Write notes on the facts of, and the precedent set by, the recent case *Actavis UK Ltd and Ors v Eli Lilly and Co*. In addition, this case sets out a test under which the prosecution history for a patent may be considered. What is this test?

Facts – 2 marks
Precedent – 5 marks
Test – 3 marks

Total: 10 marks

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Answer

Facts of the case – cursory summary (1 mark). More detailed summary (2 marks)

Precedent - Cursory summary of precedent (1 mark). More detailed summary identifying at least some of the main points (2 marks). Detailed summary identifying all of the main points (3 marks). Consideration of more subtle consequences of the decision (4 marks). Publication worthy summary (5 marks).

Test -

- I. the point at issue is truly unclear if one confines oneself to the specification and claims of the patent (1 mark), and the contents of the file unambiguously resolve the point (1 mark), or*
- II. it would be contrary to the public interest for the contents of the file to be ignored (1 mark).*

10 marks

Question 4

With reference to Section 33 of the UK Patents Act 1977 (Effect of registration etc. on rights in patents)

- a) Name the five transactions, instruments or events which may be recorded in the register of patents and patent applications.

5 marks

- b) Why is it important to register such transactions, instruments or events?

5 marks

Total: 10 marks

Answer

- a) *any of Section 33(3) (5 marks)*

- b) *any person who acquires the property in, or a right in or under, a patent or patent application is not affected by an earlier transaction, instrument or event if he did not know of it at the time of his own acquisition (1 mark) and if at that time it had not been registered or notified to the Comptroller (1 mark).*

If a person became a proprietor or exclusive licensee before a particular infringement occurred, he cannot be awarded costs (0.5 marks) or expenses (0.5 marks) if the relevant transaction, instrument or event was not registered before the date of the infringement (1 mark), unless either of the two conditions in Section 68 is met. The conditions are that registration occurs within a period of six months of the date of the transaction, instrument or event (0.5 marks), or it is established that registration within that period was not practicable but occurred as soon as practicable thereafter (0.5 marks).

10 marks

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Question 5

Your client writes:

We have a number of GB patents in your care. Whilst we have successfully licenced some of these, we feel that the renewal fees are prohibitively expensive in the current financial climate. This may change in the future. Is there some way we can reduce these fees?

Summarise the advantages and disadvantages associated with making an application for entry in the register that licences are available as of right.

9 marks

Give an example of a situation where UKIPO would refuse such an application.

1 mark

Total: 10 marks

Answer

Advantages

Renewal fees reduced by half (1 mark)

Can be cancelled when finances improve (1 mark)

Disadvantages

Third party can obtain a licence on request (1 mark)

Fee reductions must be paid back when the patent is no longer licence of right (1 mark)

Limit on damages in infringement proceedings (1 mark) to twice what would have been payable under the licence of right (1 mark)

Better terms for existing licensees (1 mark)

Cancellation of LoR can be opposed (1 mark)

Licensees can bring infringement proceedings (1 mark)

When it is precluded by contract (1 mark)

10 marks

Question 6

Can a patent application be filed in the name of a partnership? Explain your answer.

2 marks

Answer

An LLP is a corporate body (0.5 marks) so yes (0.5 marks). A partnership is not, so no (0.5 marks) but can file in the name of the partners (0.5 marks). Candidates who answer yes to the second half provided the partners are also named for Scottish partnerships will also receive the mark.

2 marks

SECTION A Total: 40 marks

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SECTION B

Question 7

Your client writes:

We own GB patent GB3141592 for a method of manufacturing pies. The method gives the pastry a very distinctive fluffy texture. We have recently been sampling the produce of one of our competitors and believe their cheese pies are made by the same method. We are concerned they are going to expand into the area of meat pies. We have asked them about their method but have not received any reply.

We have decided to take legal action but sadly have discovered that our patent has lapsed due to non-payment of a renewal fee. As you may recall, we pay our own renewal fees. We have a copy of a letter to UKIPO from our Managing Director instructing payment of the renewal. We can see from our bank account that payment was never taken.

What should we do? In particular, we are concerned by the fact that, even though we know very well they are using our process, we haven't caught them in the act.

Prepare notes for a meeting with your client. You should consider actions your client could take and also third-party rights.

Total: 20 marks

Answers

- (a) *if the renewal fee was due in the last six months (0.5 marks) then pay late with surcharge (0.5 marks). Begin legal proceedings/letter before action (1 mark).*
- (b) *if the renewal fee was due more than 19 months ago (1 mark) there is nothing that can be done (1 mark).*
- (c) *if the renewal fee was due between 6 and 19 months ago apply for restoration (1 mark). Must show failure to pay was unintentional (1 mark). Evidence is required (1 mark). Letter from MD useful (1 mark). Check what happened to the failure to pay letter from UKIPO (1 mark).*

Third party rights – if manufacture started in the six months when the renewal fee could have been paid late there are no third party rights (1 mark). If use began after notification of non-payment (1 mark) but before publication of the application for restoration (1 mark) then if this was done in good faith (1 mark) the competitor can continue to do the act (1 mark). Some discussion of 'the act' with reference to meat and cheese pies (1 mark). Does not extend to granting a licence (1 mark) but customers can deal in the product (1 mark).

Burden of proof—the court will assume the pie is made by the method unless the competitor can show otherwise (1 mark). Competitor not required to disclose if unreasonable to do so (1 mark).

Some mention of threats (1 mark)

Total: 20 marks

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Question 8

Your client has acquired a portfolio of UK patents and applications. Prepare notes for a meeting with your client summarising what steps need to be taken and by when.

- a) Application A was published on 16 March 2020 and no request for examination has been filed. Discuss in detail what extensions of time are available.

6 marks

- b) Application B is a PCT application which has been entered into the GB regional phase. No statement of inventorship has been filed. It is not necessary to consider what extensions of time are available.

3 marks

- c) Application C is pending. An examination report was sent on 16 June 2020 and set a two-month deadline for filing a response. The client informs you they will not be able to provide instructions for filing a response for at least another week.

5 marks

- d) Application D was filed 11 months ago. It has one claim to a metal widget. The applicants have discovered that a cheaper rubber widget also works. The clients wish to protect both metal and rubber widgets in a single application.

6 marks

Total: 20 marks

Answers

- (a) *Request for examination was due six months from publication and has been missed (0.5 marks). File form (form 52) (0.5 marks) and pay fee (0.5 marks). File form (form 10) (0.5 marks) and pay exam fee (0.5 marks). Must be done by 2 months from deadline (0.5 marks). Further discretionary extension possible (0.5 marks). Request must be filed within the two month extended deadline (0.5 marks). File form (form 52) (0.5 marks), pay fee (0.5 marks), file evidence (1 mark).*

- (b) *File a statement of inventorship (form 7) (1 mark). This must be filed by later of sixteen months from priority (1 mark) and two months from the beginning of the national phase (1 mark).*

- (c) *Request a two month extension of time (1 mark) in writing at UKIPO today (1 mark). Ring the examiner and ask for a further discretionary extension of time (1 mark) with reasons (1 mark). If accepted then file a response by the new deadline (0.5 marks), otherwise file a holding response today (0.5 marks).*

- (d) *Withdraw the earlier application except to serve as basis for priority (1 mark). Broaden the claim (1 mark) and add extra embodiment to description (1 mark). File updated application claiming priority from the earlier application (1 mark) by twelve months from earlier application (1 mark). Pay filing (0.5 marks) and search (0.5 marks) fees*

Total: 20 marks

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Question 9

In relation to UK patent law and procedure, draft a letter to a UK client explaining the meaning of the following terms:

a) A divisional application (do not discuss time limits or formal requirements). **4 marks**

b) Sufficiency, in particular the various ways in which an objection on the grounds of lack of sufficiency can arise. **4 marks**

Also, explain to your client:

c) The circumstances in which a court will award compensation to an employee in respect of an invention belonging to an employer for which a patent has been granted. You are not required to discuss determination of the amount of compensation but should include the time window in which it can be applied for. **6 marks**

Finally, explain to your client:

d) The consequences of surrendering a patent. **6 marks**

Total: 20 marks

Answers

- a) *A divisional application is a separate application in its own right (1 mark). It obtains the same effective filing date as the parent application (1 mark). Typically filed when UKIPO raised an objection on the grounds that the parent application has claims to more than one invention (1 mark). Prosecuted independently of the parent application (1 mark).*
- b) *The application must disclose the invention in a manner which is complete enough for the invention to be performed by a person skilled in the art (1 mark). An objection can arise if the patent does not support that which it specifically purports to deliver (1 mark). An objection can also arise where the claim is cast more widely than the teaching of the patent enables (1 mark). The test is whether the patent imposes an undue burden on the skilled man to arrive at a workable prototype of the invention (1 mark).*
- c) *(a) the invention is of outstanding benefit to the employer (1 mark) (having regard to the size (1 mark) and nature (1 mark) of the employers undertaking) and (b) it is just the employee should be awarded compensation (1 mark). This does not apply where a relevant collective agreement provides for the payment of compensation (1 mark). It must be applied for between grant (0.5 marks) and one year (0.5 marks) after the patent ceased to have effect.*
- d) *No action for infringement (1 mark) and no claim in respect of crown use (1 mark) lies in respect of any act done before the date of advertisement of the acceptance of the offer to surrender the patent (1 mark).*

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Surrender does not terminate revocation proceedings (1 mark) nor does it terminate entitlement proceedings (1 mark). Surrender of a GB patent does not allow one to avoid the double patenting provisions (1 mark).

Total: 20 marks

Question 10

Your client writes:

We have a granted European patent designating the UK. The patent was filed and prosecuted in German at the EPO. We validated the patent at UKIPO, filing the necessary English language translation of the granted patent at UKIPO, which was subsequently published by UKIPO.

We have become aware of a competitor who is potentially infringing the patent. Having read claim 1 of our patent, we note it contains two errors. The first is a simple typographical error. The second error is more serious and affects the scope of the claim. On a more positive note, the competitor appears to be making fairly minimal use of the invention. The invention has a wide range of applications which do not appear to have occurred to the competitor yet.

You review claim 1. The English language translation of claim 1 is narrower in scope than the original German claim. To make matters worse, whilst the goods sold by the competitor to date fall within the scope of the German language claim, they do not fall within the scope of the English language claim.

- a) **In terms of infringement, explain what it means to say that the scope of one claim is narrower than another.**

1 mark

- b) **Summarise the provisions of Section 80 of the UK Patents Act 1977 (Authentic text of European patents and patent applications) relating to determination of the authentic text of a European patent for the purposes of proceedings before a UK Court. Your answer should not be restricted to infringement proceedings only.**

4 marks

- c) **Write notes for a meeting with your client. Your notes should cover the following:**

- (i) **What can be done as regards the typographical error.**
- (ii) **What can be done as regards sales made to date by the competitor. Explain your reasoning.**
- (iii) **What else can be done to minimise the consequences of these translation errors? Explain your reasoning with particular reference to the defences to infringement that the competitor may have.**

15 marks

Total: 20 marks

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Answers

- (a) *It is possible for there to be a product/process/article which infringes the broader claim but not the narrower claim (1 mark).*
- (b) *The authentic text is the text in the language of the proceedings before the EPO (1 mark). However, the authentic text is the English language translation (1 mark) if the translation confers protection which is narrower than that conferred by the original text (1 mark). In revocation proceedings the original text is the authentic text (1 mark).*
- (c)
- (i) *Apply in writing (0.5 marks) identifying the proposed correction (0.5 marks). Provide evidence that it is 'immediately evident' that nothing else could have been intended (1 mark)*
- (ii) *Nothing (1 mark). The Court will use the faulty English language translation as the authentic text and there is no infringement (1 mark)*
- (iii) *Prepare a correct translation (1 mark). File a request for publication at UKIPO (1 mark). Send a copy to the alleged infringer (1 mark).*

Defences – the proprietor cannot bring infringement proceedings for 'new' acts unless before the day of the act (1 mark) the corrected translation is published by UKIPO (1 mark) or is sent to the infringer (1 mark).

Even then, the infringer may have a defence if (a) they began in good faith (1 mark) to do an act which would not constitute an infringement of the patent as originally translated but would do so under the amended translation (1 mark); or (b) they made in good faith (1 mark) serious (1 mark) and effective (1 mark) preparations to do such an act.

Total: 20 marks