

Question 1.

- a) Actavis and Eli Lilly 1✓
- b) Eli Lilly has a patent for use of premetrexed disodium for use with vitamin B12 for the treatment of cancer.

Actavis sought a declaration of non-infringement for its product which used premetrexed disprotassium instead of disodium (as well as the use of other substances).

The high court found that the Actavis product did not infringe. 1✓

Eli Lilly appealed for indirect infringement.

Eli Lilly won. Actavis appealed that decision.

The final decision was that Eli Lilly's patent was not infringed by Actavis's substance.

- c) Actavis's substance was found to not infringe Eli Lilly's patent, directly or indirectly.

A person skilled in the art would understand from the patent that strict compliance with the literal meaning of 'premetrexed disodium' was intended. However, a skilled person would see that the effect of the variant 'dipotassium' did not affect the performance of the invention for the purpose for which it is intended.

Potassium and sodium are in the same group in the periodic table and therefore many of their properties are the same. As is the case for the properties which are material for their function in this invention. 0

The improver questions were reformulated:

Does the variant fall within the literal meaning of the claim?

1. Would a skilled person understand that the literal meaning was intended?
2. Does the variant produce a material effect on the invention in respect of its intended purpose?

Examiner's
use only

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3. Would the skilled person recognise that the variant has no material effect?

Prosecution history never affected the determination of the scope of claims but, the Eli Lilly patent originally contained claims broader than those which were granted. The Actavis product would have fallen in the scope of the earlier claims but during prosecution, the applicant was directed to narrow the claims to disclude premetrexed dipotassium. This was noted in proceedings. 2✓

This sets out that the prosecution history may be considered when determining the scope of the claims.

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MARKS AWARDED 4/10

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Question 2.

- a) any person can revoke a patent (except the proprietor). 1✓
- b) – the patent was applied for or granted to a person who was not entitled to the grant of that patent. 1✓
- added subject matter which extends beyond the subject matter of the application as filed. 1✓
 - the removal of added subject matter after grant results in broadening of the claims after grant.
 - the claims are not supported by the description
 - the subject matter is not patentable. 1✓
 - the specification is not enabling such that a person skilled in the art would not be able to work the invention given the specification. 0.5✓ 0.5✓

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MARKS AWARDED 5/10

Question 3.

- a) The controller may correct errors of his own volition where the correction is obvious where the error is in a form submitted in relation to the application 0.5✓, errors on the register, 0.5✓
- b) The Controller must be satisfied that it is obvious that there was an error and that the correction 1✓ 0.5✓ too is obvious. 1.5
- c) The proprietor can make an application on a form to the Controller to amend the specification at any time after grant. The Controller will send this application to the Examining Division who will assess if the amendment adds matter or broadens the scope of the claims. They will not assess for clarity or sufficiency. If the Examiner is satisfied, the amendment is published in the Register and third parties can oppose the amendment if they choose to. 0
- d) The amendment is deemed to have effect from the date of grant of the patent. 1✓ 1

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MARKS AWARDED 3/10**Question 4**

- a) The proprietor of the patent in question. 1✓ 1
- b) At any time after the grant of the patent. 1✓ 1
- c) The Controller will publish on the Register a notice of the request to make licences available as of right. 0.5✓ He will check that there is nothing on the Register that would prevent licences of right being 0.5✓ made available (ie if there is an exclusive licensee 1✓ recorded on the Register). Then if satisfied that nothing prevents this he will notify the applicant and any other person recorded as having an interest or rights in the patent that licences are available as of right. 2
- d) He will only be liable for damages 0.5✓ up to 2 times 1✓ the cost that he would have 0.5✓ incurred 0.5✓ had he taken out a licence of right in respect of the infringing act. 2.5

He may get a licence of right from the Controller.

- e) The Controller must be satisfied that:
- No licence of right has been taken out

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MARKS AWARDED 6.5/10

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Question 5.

- a) Priority date (which is in relation to subject matter of the invention) is the date, before which anything made available to the public by written or oral disclosure or by any other means will be considered as the 1✓ state of the art for the purpose of assessing novelty and inventive step. Anything 1✓ made available to the public before the priority date can be cited as prior art if it is relevant to the subject matter for which priority is claimed.

There may be more than one priority date if for example there are 2 features in an invention, each of which were first disclosed in earlier applications filed on different days.

For subject matter for which priority is not claimed, the priority date is the filing date of the application. So priority date is the earliest date that the subject matter in question was disclosed in a patent application, in the UK or in another jurisdiction which is party to the Paris Convention.

It is important because if a public disclosure occurs regarding subject matter in a application that was filed after the disclosure, that disclosure can be novelty destroying for that subject matter. However if priority is claimed to an application filed before that disclosure, 1✓ the application can claim priority from that earlier date and subsequent disclosure cannot be cited against it for the purpose 1✓ of assessing novelty and inventive step.

Where priority is claimed from more than one applications with different filing dates, the priority date is the earliest of those filing dates.

- b) Application 1 claims invention with feature A and is filed on 1 Jan 2018
Application 2 claims invention with feature B and is filed on 2 Jan 2018
On 1 February 2018, if you file an application 3 claiming features A, B and C in claim 1 partial priority arises. You can make a valid priority claim to

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application 1 for feature A. This gives feature A the priority date of 1 Jan 2018. 1✓ You can make a valid priority claim for feature B in respect of Application 2. These are only partial priority claims since only particular features within the claim for application 3 have valid priority claims to those particular documents. Feature C has a priority date which is the filing 4✓ date of the application 3.

However, since application 3 claims A, B and C the priority date of the three features in combination is the filing date of application 3, with features A and B separately having partial priority claims.

Partial priority means that only part of the subject matter claimed in an application has a valid claim to priority from an earlier application.

- c) Whilst P2 was filed on Saturday, the UKIPO will receive it on Monday. 1✓ It will therefore be given the filing date of Monday 1✓. Since the paper was published on Sunday it is 1✓ considered part of the state of the art since this consists of anything (whether a written document or oral disclosure) that was made available to the public by written or oral disclosure or by any other means at any time before the filing date of the application (or priority date if priority is claimed).

- d) since the disclosure was made for a 'metal widget', the claim should be restricted to not provide a metal widget.

This could be by removing the option of the widget being made from either metal. Such that the claim will read 'a widget being made from rubber'. However 1✓ this is the same as the P1 claim. 0.5✓ An alternative would be to claim it being made from rubber and 'not metal'. This will ensure the publication does not get cited. Alternatively, claim 'a widget being made from metal and rubber'. However it may still get cited for inventive step purposes.

The rubber option claims the priority date of P1 so the subsequent disclosure on Sunday cannot 0.5✓ be cited in respect of this subject matter.

- e) Withdraw P1 (effective on Monday) and file P2 on Saturday (effective on Monday) claiming both embodiments. You can either withdraw P1 leaving no rights outstanding such that it cannot form the basis of a priority claim. You would lose the benefit of its earlier priority date in respect of the

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rubber option. It will not be published so will not count as a disclosure and so will not be novelty destroying.

You could withdraw P1 as above but leaving the right to claim priority from it outstanding. Then file the new application claiming priority from it. It will get published when the subsequent application is published.

On Saturday (or Monday) file the new application claiming priority from P1 (if rights left outstanding). Claim both embodiments (rubber and metal versions of the widget).

advise the client on the consequences of disclosure and ask him to hold-off the publication of his paper until after the patent application has been filed. He can publish it on Monday if you also file on Monday since 'state of the art' is made available to the public before the filing date of the invention.

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MARKS AWARDED 14/20

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Question 7.

- a) Register the assignment of each right to the client with the UKIPO within 6 months of the assignment or as soon as practicable afterwards. Send evidence to the Controller of the assignment.

Send the new address for service to the UKIPO so that future correspondence will be sent to the client (or to you as the agent if they prefer). 1✓ 1✓

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- b) i) pay the grant fee within 2 months of grant (so by 2 December 2018)

The first renewal fee was due on the fourth anniversary and the second was due on the 5th anniversary (10 February 2018) of filing (10 February 2017). However since the patent was granted (by 2 January 2019), these can be paid within 3 months 1✓ 0.5✓ 0.5✓ 0.5✓ of the date of grant along with a request for renewal once form. These can be paid late if this deadline is missed by requesting renewal and paying the renewal fees and an additional fee within 6m beginning the renewal due date (so by 2 July 2019).

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0.5✓ The next renewal fee is due on the 6th Anniversary (10 February 2019). This can be paid (along with a request for renewal) within a

period of 3 months ending with the renewal fee due date. Or within the 6 month period starting with the due date by paying an additional fee on top of the other requirements listed above.

- ii) The compliance period ends the later of:
- 12 months from issuance of the 1st office action (28 January 2019)
 - 1✓ 4 years 6 months from the filing date (28 July 2017)
 - 3 months from the first observation report
 - 28 days after an appeal was dropped.

0.5✓ So the end of the compliance period in this case is 28 January 2019. A divisional application must be filed before the end of the compliance period (ie by 28 January 2019). 0.5✓ Then file claims, abstract, request examination and search 0.5✓ file statement of inventorship and 0.5✓ pay the examination, divisional filing and search fees within 2 months of the divisionals initiation. If you file it within the last 3 months of the compliance period, all these things are due on the filing of the divisional.

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- iii) If nothing is done, the UKIPO will revoke the GB patent since it does not allow double patenting. Since it is preferable to maintain the GB application – since it is identical and has the same filing date, withdraw the PCT (GB) application or amend the claims such that it claims a different invention.

PCT(GB)1 NPE = 1 Oct 2018 ~ 30 months from filing of PCT so GB application

4th anniversary of GB filing date will arrive in more than 6 months so renewal fees need not be paid.

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- iv) Pay filing fee by 12 months from filing date. 0.5✓

0.5✓ Request early publication by filing a form and paying a fee since no damages can accrue until the person is aware of the claims of the patent application. You can request search and pay search fee and file abstract, claims by 12 months from filing date or if priority is claimed by the earlier of 2 months from priority date and 12 months from filing date.

0.5✓ File statement of inventorship by 16 months from filing date (or from priority date if priority is claimed).

You can request accelerated examination if you wish to get grant as soon as possible so as to enforce your patent against the infringer,

0.5✓ You can send the infringer a copy of your claims to start accruing damages before publication of the specification.

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MARKS AWARDED 10.5/20

Question 8.

- a) An invention invented by an employee in the course of his normal duties, 0.5✓ or outside of his normal duties but in the course of duties 0.5✓ specifically assigned to him where an invention may reasonably be 0.5✓ 0.5✓ expected to result, will be taken to belong to his employer.

Where an invention results from an employee and is made outside of the course of his normal duties or where an invention may not reasonably be expected to arise from his duties but that employee is 0.5✓ under an obligation to further the interest of his employer 0.5✓ as a result of his position (eg manager) then the invention is determined to belong to the employer.

Where an patent has been granted to an employer for an employee's invention and the invention is of outstanding benefit to the employer (factoring in the size and nature of the employers and employee's undertaking) the employee shall be entitled to compensation for any patent (UK or foreign) granted to the employer.

Where a patent is granted to an employee for his invention and the employee has assigned or licensed the right to the employer and the benefit given to the employee has not been adequate in relation to the benefit to the employer (factoring in the size and nature of the employer's and employee's undertaking) the employee will be entitled to compensation.

In my opinion, although the employee was recruited 1✓ as an accountant, since he was specifically assigned to a task which resulted in the invention, the employer 1✓ is entitled to the patent. He was employed at the time of devising the invention. I think since the task was to 1✓ 'develop a new coating' it is reasonable to expect that a patentable invention could be created as a result of the execution of this task. However it must be noted that the law specifies inventions arising from work in the course of an employee's 'normal' duties. Their normal duties, were accounts not chemistry.

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- b) He can apply to the court for an injunction to prevent the manufacturer from continuing to manufacture or supply the coating and the spark plugs in the UK. The patent is for the combination of coating and spark plugs, not just for the coating alone, so the manufacturer may not be directly 1✓ infringing by supplying the coating. However if it can be shown that the act of supplying or offering to supply by the 1✓ manufacturer, in the UK without the proprietors consent, of an essential means necessary for putting the invention into effect in the UK, where 0.5✓ 0.5✓ 0.5✓ they know or it is reasonable for them to know that the coating they intend to supply is suitable for putting the invention into effect this will be considered to be contributory infringement. The threats indicate they are aware of the patent so they cannot use the innocent infringer defence. The coating is 'new' so it cannot be a staple product. He can also get an order for the manufacturer to stop exporting the contributory infringing coating.

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- c) The threat made to the client is in relation to the assignment of her patent. A reasonable person in her position would understand that a patent exists (since she owns it) and that they intend to bring infringement proceedings against her. Asking her to immediately assign the patent to them is not considered a 'permitted communication' so she may take action against this threat.

0.5✓ Threats are only non-actionable if they are made to the 0.5✓ manufacturer or importer since they are the root of the infringement. It doesn't specify that they threatened her in respect of 1✓ those acts however requesting an assignment may be considered to be requesting her to cease all action in respect of the coating and spark plug combination which is not a permitted communication.

Remedies

- 0.5✓ An injunction against future threats
- 0.5✓ Damages for the loss (harm) sustained by the client who has been aggrieved by the threats

They are not the proprietor of the patent, so are not entitled to bring infringement proceedings unless, and if so after, they are assigned the patent.

The threats made to the customers is actionable since the customers are 1✓ neither importing nor manufacturing the infringing articles.

If customers will understand from the letter that a patent exists (which is likely from the detail in the question) and since they are informed that infringement proceedings will begin against them, they may action the groundless threats.

It seems that a reasonable person in the position of such customers would understand the above points from the communications.

Remedies

- Injunction against future threats
- Damages for the loss caused to the aggrieved customers.

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MARKS AWARDED 13.5/20