

Examiner's
use only**Question 1**

- a) Actavis v Eli Lilly 1✓
- b) Actavis sought a declaration for non-infringement for salts of pemetrexed, and the free acid, with the vitamin B12 for use as a medicament. Eli Lilly's patent had a claim to pemetrexed disodium in combination with 2✓ vitamin B12 for use a a medicament.
- c) The decision was found that Actavis did infringe Eli Lilly's patent and this decision was arrived at by the re-formulation of a 3 part test as decided by the judge. 1✓
- d) The court reviewed to two steps previously used in other cases which was as follows:
- (a) claim construction as viewed with normal interpretation;
- (b) in the case of a variant not caught by (a), does the variant differ to the invention is an immaterial way.

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It was decided that purposive construction was not best way as was previously (Improver v Remington) to review this case as it put too much emphasis on what was obvious to the skilled person at publication. The test was re-formulated from Improver to give the following:

- (i) notwithstanding that the variant does not fall under the literal meaning of the claim, does the variant achieve substantially the same result in substantially the same way?
- (ii) would it have been obvious to the person skilled in the art, at the time of the priority, knowing that it achieved substantially the same result, that it did so in substantially the same way?
- (iii) nevertheless, did the proprietor of the invention intend that the claims be construed with literal meaning, and that it was essential when construing the invention?

When this was applied re Actavis it was found that the answer re (a) was no as salts of pemetrexed, and free acid, is clearly not pemetrexed disodium.

When applying (b) (i) it was found that yes the variant does achieve substantially the same result in substantially the same way. Also for (ii) it was found to be yes as at the time of the priority date Actavis already a portfolio of compounds that worked in this way and therefore it would of been obvious to a skilled person. For (iii) it was clear that a literal meaning was not intended and was also clear because the court used the file wrapper (which has not been used before in UK court) to see that the pemetrexed disodium had been restricted to this in prosecution. Therefore as the answer was (i) yes, (ii) yes and (iii) no. it was found that Actavis infringed Eli Lilly's patent. 4✓

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MARKS AWARDED 8/10

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Question 2

- a) any person can apply (including the proprietor). But if co-proprietors, need 1✓1✓ consent from all co-proprietors. 2
- b) – if the patent is not patentable 1✓(patentability)
- if the subject matter of the patent extends beyond that of the subject matter in the 1✓patent application as filed (added matter)
 - the specification is not clear and complete enough to be carried out by a person skilled in the art (sufficiency) 0.5✓0.5✓
 - the protection conferred has been broadened by an amendment that should not have 1✓been allowed (extent of protection)
 - the patent has been granted to a person who is not entitled to the patent (entitlement) 1✓

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This final ground can only be used 1✓by a person who is entitled to the patent 0.5✓0.5✓and must be applied for within 2 years after the patent is granted, unless the 0.5✓proprietor knew he was not entitled to the patent. (bad faith)

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MARKS AWARDED 9.5/10

Question 3

- a) The Comproller may correct an error in the abstract or in the specification if it is related to a registered trade mark. 0
- b) That it was obvious **1✓** that it was an error and it couldn't have possibly meant to mean **0.5✓** something else and that it couldn't have meant to mean any else other that what it is corrected to. 1.5
- c) The proprietor must apply to Comptroller in writing **1✓** requesting the amendment and giving **1✓** reasons + **1✓** evidence of what correction should be. 3

No infringement proceedings should be pending.
- d) It is retro active and therefore takes effect from the date of grant as if it was always the corrected version.**1✓** 1

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MARKS AWARDED 5.5/10

Question 4

- a) The proprietor applies to the Comptroller. **1✓** If a co-proprietor, needs consent from the other co-proprietors. 1
- b) An application can be made anytime after grant of the patent**1✓** 1
- c) The Comptroller will contact**0.5✓** any licencees**0.5✓** and any person with rights in or under the patent and make sure that there no **1✓** contracts prohibiting the proprietor from**0.5✓** granting further licences. If the Comptroller is satisfied that the proprietor is not prohibited by any prior contracts he will **0.5✓** publish that licences are available as of right in the Patents Journal. 3
- d) Injunction cannot be granted.**0.5✓**

The damages**0.5✓** are limited to double**1✓** what would have been payable if the defendent had obtained a licence before the first infringing act was committed.**0.5✓0.5✓** 3

- e) All the licencees with a right in or under the patent give consent (don't object) to 1✓ the licence of right being cancelled. No infringement proceedings are pending

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MARKS AWARDED 9/10

Question 5

- a) A priority date is effectively the date of filing of the patent application 1✓. If a patent application claims priority, then the priority date is the date of filing of the earlier filed application. (that is claimed). It is important because it allows later filed applications to claim priority and so the priority 1✓ date of the second application becomes the same as the first. This allows an application to be filed in a different country without losing a year in which someone else could of filed something.

It is also important because it is the date which decides what constitutes prior art. 1✓ Anything filed before that date can be used for novelty and inventive step against the patent application

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- b) Partial priority is when the claim(s) of an application claim priority to an earlier application that doesn't cover all the invention 1✓ so that not all of the claims have a priority date. The claims would have different priority dates, having the priority date of the earlier application and some having the filing date of the current application

This could arise if amendments have been made in the 12 month priority period and new subject matter had been added. The new subject matter would have the date of filing opposed 1✓ to the priority date.

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- c) The UKIPO can cite the clients own paper as Saturday 1✓ is a non working day and therefore P2 would effectively be filed on Monday. 1✓

As the feature of the widget 1✓ being metal is not contained in P1 it does not get the priority date of P1, even though it was claimed, and is effectively filed on Monday so that is the priority date, and the client disclosed on Sunday.

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The rubber feature would have priority date of Friday, as it was claimed in the priority document.

- d) Could restrict claim 1 to just a rubber widget, as this was claimed in P1 it has a **1✓** valid priority claim and therefore has a **0.5✓** priority date before the client disclosed. 1.5
- e) Should have withdrawn P1 so no rights were left outstanding, and therefore it wasn't published and had not served as a priority claim and done this before P2 was filed so that P2 could have **1✓** both embodiments with the same filing date. 1

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MARKS AWARDED 13.5/20

Question 7

- a) The name of the applicant should be changed to the clients and the applicant details. Can request amendment at the UKIPO and file a form. **1✓** 1
- b) i) As D1 was filed on 10 February 2013 the first two renewal fees (5th year and 6th year) should have been paid by 28 February 2017 as it is 4 years from filing, as the renewal date was 10 February 2017 and 28 Feb 2018. as was due 10 Feb 2018. We will have to pay the next renewal fee (for 10 February 2019, 7th year) by the 28 February 2019 as have until the last day of the month in which the renewal falls due but it is available **0.5✓0.5✓** to pay 3 months before so we can pay this from the 1 November 2018. 1
- ii) The application has to be in a position allowable for grant the later of 4½ years from the **1✓** filing date or 12 months after the issuance of the first office action. This means that it should be ready by 28 January **0.5✓** 2019 as this is 12 months from the first office action (4½ years from filing would be 28 July 2017). There is a 3 month compliance period before this **0.5✓** date to get things in order which begins on **1✓** 28 October 2018. We will have to wait for the response from the examiner to decide what to do.
- 0.5✓** If a divisional is filed before this compliance period **0.5✓** need to re file it with the filing fee and applicants details and indication a patent is sought and a a reference to the earlier application. The claims + abstract, **0.5✓0.5✓** search fee and request, exam request and exam fee and application fee are all due two months after filing and can be extended as of right by 2 months with a fee and further extended with discretion of the examiner (R108(2) and (3)). A declaration of

inventorship would be due 16 months from priority and a declaration of priority. If the divisional is filed in the compliance period all the requirements that are normally 2 months after will be due on filing

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iii) On entry to the GB national phase the UKIPO will start provisions to abandon the earlier filed GB application so there are not two identical patents in the UK (double patenting). I suggest to instead surrender the PCT (GB) application in the UK as this has a later filing date and therefore can likely have more prior art cited against it. The earlier filed GB will be further along in the patent processes and therefore less fees will have to be paid for it.

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iv) 0.5✓ Could apply for early publication to give D4 provisional protection over the infringers. We would not want to make any actionable threats so more information would be needed about the potential infringer. 0.5✓ However, we could send a copy of the claims to them to make them aware they are possibly infringing or send a permitted communication. 0.5✓

0.5✓ Regarding D4, search fee and request for search 0.5✓, as well as the application fee, and the request for exam and examination fee will all be due at the 12 months from filing date. Could apply for a combined search and examination to allow the patent to be published earlier.

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MARKS AWARDED 9.5/20

Question 8

a) If the invention arising during the 0.5✓ normal duties of an employee then the invention belongs to the employer. In this case it was not the employees normal duties as he works in the accounts department. However, the other provision is whether the employee 0.5✓ had been assigned special duties in which 0.5✓ an invention is likely to arise. I think this is yes as he was assigned the task of 1✓ developing coatings and that duty 1✓ led to the invention.

1✓ Therefore, I think that the invention belongs to the former employer.

Other provisions involve whether there was a 0.5✓ 'special obligation' arising from that duty but I don't think that applies here as it is aimed more at directors and managers.

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- b) The client can apply for an injunction to stop the automotive manufacturer supplying the coating. Would need to prove that they are effecting the clients sales and damaging profits and customers are confused between the two businesses.

Can bring infringement proceedings against the manufacturer by showing that they are unauthorized to dispose and offer to dispose, keep, import, manufacture or use the invention, while it is in force, within the UK.

The client could receive if he won damages, injunction, delivery-up, or destruction of the automotive manufacturers coating.

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- c) Regarding the keeping of the invention, this is an actionable threat and therefore the 1✓ customers would be able to bring proceedings. Secondary infringement constitutes an actionable threat. They could get costs paid to them and an injunction so no other threats can be made regarding the secondary infringement. The former employer would not have a defence as he has successfully contacted the primary infringer and cannot say he received no response.

0.5✓0.5✓ The manufacture for disposal is not an 1✓ actionable threat as it is primary infringement and therefore the client cannot bring proceedings against his former employers.

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MARKS AWARDED 8/20