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FC1	1 of 14	55%

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Q1) Scientific theories

Discoveries 0.5

Mathematical methods 0.5

Rules, schemes, methods for: playing a game, performing a mental act, doing business 0.5 0.5

Programs for a computer 0.5

Presentation of information 0.5

(To the extent that invention relates to those things as such).

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Q2) Application B was filed within the priority window, so is eligible to claim priority.

0.5 Priority may be claimed up to 4 months after the filing of application B (16 months after the priority date) - So must be claimed by 16/09/2020 + 4 months = 16/01/2021.

1✓ Applicant must file a declaration of priority, the application number, filing date and country of filing of application A, and pay a fee.

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Q3) Interpretation/Construction case law

Parties to the case - Eli Lilly and Actavis and Ors.

Facts - Eli Lilly held a patent, brought infringement proceedings against Actavis.

Actavis counter claimed invalidity, patent was revoked.

Precedent - The proprietor of a patent creates an estoppel when they make an argument during examination/appeal. They cannot then go on to rely on an argument to the contrary.

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Q4) a) Registerable transactions:

Assignment of the patent or patent application, or a right in or under it. ^{1✓}

The grant of a licence of a sub-licence. ^{1✓}

Mortgaging a share of the patent or granting a security interest over it. ^{1✓}

Making, by personal representative, an assent. ^{1✓}

The court ordered transfer of a patent or application. ^{1✓}

0.5✓ b) A transaction should be registered within 6 months of its occurrence. If it is

1✓ not, then in any infringement proceedings for an infringement that occurred

0.5 0.5 before the registration, the claimant will be able to recover any costs or expenses.

1✓ The transaction will also not be enforceable against any person obtaining a conflicting interest in ignorance of the transaction - for two unregistered transactions, the later of the two is given favour.

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Q5) The client could make his patents available for licences as of right. Licence
1✓ as of right patents have a 50% reduction in the cost of renewal fees, however if it
1✓ a later date the client choses to end the licence as of right status, they will have
to back pay the discounted amount.

The client may obtain more licences if the patents are licensable as of right, as
their licence as of right status will be advertised in the journal and noted in the
register (the knowledge that a licence is available is public). Any person may
1✓ obtain a licence for a price agreed on between the proprietor and licensee, or at
a price set by the comptroller at the request of either of them. This does mean
that the client might not be able to obtain as favourable terms (they might not be
able to make as much money per licence), as if they are charging a high amount
the prospective licensee may have the comptroller set the price. Similarly, the
licence will lack exclusivity (meaning that it is easier for any person to obtain one,
not that they are not exclusive licences), which again may drive down the price.

The client will not be able to apply for licence as of right status if the terms of any
of his current licence agreements preclude this - particularly for example if one
patent has an exclusive licencee.

1✓ Any person who holds a licence pre-dating the licence as of right status of a
patent may apply to the comptroller to have his licence exchanged for a licence
as of right.

1✓ In the case of any infringement, the licence holder(s) may request the proprietor
bring infringement proceedings. If the proprietor did not want to do so, for
example if he didn't not think it was worth the time or cost, the licence holders
could then bring infringement proceedings themselves after two months and add

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the proprietor as a defendant. He would not be liable for any costs unless he made an appearance at the proceedings and took part.

For any infringement action that the proprietor did bring, the licensees may

1✓ join/intervene to recover compensation for the infringement. This could dilute any account of the profits that the proprietor received.

The proprietor would not be able to surrender any of the patents that had active licence holders, where they did not consent.

1✓ The UKIPO would refuse an application where a patent already has an exclusive licensee.

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Q6) Yes, a patent may be applied by any person, alone or jointly. A person is entitled to a patent where they have a legally enforceable agreement with the inventor pre-dating the making of the invention, and granting them full ownership of the invention. A partnership is a joint venture of people, could have such an agreement with an inventor and so own the property, and so could apply for a patent.

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Q7) First, check when the deadline for renewal of the patent was.

- 0.5✓ If it was within the last 6 months, pay the renewal fee and a surcharge within the
- 0.5✓ 6 month extension period from the renewal deadline. No rights will be lost in this
- 1✓ case. If this is the case, then the competitor will be infringing the patent and will
- 1✓ have no right to work the invention, even if they only began the infringing actions
- 1✓ after the lapse of the patent. The client can write to the competitor alleging
- 1✓ infringement on the grounds of using a patented process. The communication
- must include a statement that a patent exists and is in force (make sure the
- patent is renewed first!), and must include details about the patent which are
- accurate in all material respects and not misleading in any material respects. It
- must include information enabling the identification of the product or process in
- which it is alleged that infringement is occurring. The client must not ask them to
- give an undertaking, cease doing for commercial purposes anything related to a
- product or process, or deliver up or destroy any allegedly infringing goods. The
- 1✓ client should send them a copy of the patent. In case of any counter suit for a
- threat, the client can defend themselves if, despite having taken reasonable
- steps, they have not yet identified anyone carrying out an infringing act, and have
- informed the recipient of this at or before the time of making the threat. So the
- client should make sure that they specify that they have not identified a person
- doing the infringement, or of the steps that they have taken, at least at the same
- time as making the threat.
- 1✓ If the deadline for renewal was more than 6 months ago but less than 19 months
- ago, request restoration of patent. Restoration will only be granted where it is
- 1✓ shown that the failure to meet the deadline was unintentional. Evidence of this
- 1✓

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1✓ must be provided - the letter will be useful in this regard. If the competitor's use of the method was a continuation or repetition of an earlier infringing action (so if it was first done when the patent had not lapsed, or during the 6 month extension period), then they are infringing the patent. If, however, they only began in good faith to do the act, or made serious and effective preparations to do the act, after the 6 month infringement window had passed, then they will have the right to do the act (use the method to make the pies) or to continue to do the act. This does not include the right to grant a licence to third parties to do the act, however, if any person acquires the business or part of the business where the acts were done, or were being prepared to be done, they will have the right to do them (again without the right to grant a licence). Any person who obtains the pies from the competitor shall have the right to deal in them as if they had been obtained from the client (proprietor).

1✓ If the patent lapsed more than 19 months ago, then nothing can be done to restore it, or to stop the competitor using the method if its use started after the 6 month extension period and was not a continuation or repetition of an earlier infringing act. No damages or an account of the profits would be recoverable. If, as mentioned before, the acts were a continuation or repetition of an earlier infringing act, they the client can still be sue for infringement within 6 years of the act's occurrence to recover damages or an account of the profits.

In general, if infringement is found to have occurred, the client may - obtain an injunction against the continuation of the act of infringement (unless the patent is irrevocably lapse), damages OR an account of the profits, an order to deliver up

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or destroy the infringing goods, and a declaration or declaratory that the patent is valid and has been infringed by the defendant.

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0.5✓ Q8)a) Examination must be request by 6 months after the publication of the application. Deadline = 16/03/2020 + 6 months = 16/09/2020. Can, however, 0.5 request a two month extension by right. No evidence is required, file form 52 and 0.5 pay fee. New deadline to request examination is 16/11/2020. Further extension 0.5 could be obtained at the comptroller's discretion.

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1✓ b) The statement of inventorship must be filed by 33 months from the filing or priority date of the application. If the national phase was entered at the 31 month 1✓ deadline, then this is two months after national phase entry.

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1✓ c) First, must request two month extension by right in writing, which brings the 1✓ deadline to respond to 16/10/2020. Client will not be able to give instruction until 1✓ a later date, so we must request a further extension, which may be granted at the 1✓ comptroller's discretion. Will be useful to provide an explanation and evidence to the comptroller of why the client cannot meet the deadline, as well as an indication of how long an extension is required. A fee will be payable for the extension.

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1✓ d) The client can file a new application for both a metal and rubber widget, and 1✓ claim priority from application D. The application must be filed within the 12 1✓ month priority window from the filing of the earlier application (so within 1 month from now). Alternatively, if the client does not want to file within the next month, they can withdraw application D leaving no rights outstanding. Application D will not have been published yet (publication happens 18 months from filing/priority) so will not become part of the state of the art (as it will not go on to be published, having been withdrawn). Can file an application for both a metal and rubber

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widgit greater than 1 month from now, however it is best to do it sooner rather than later in case someone else develops the widget(s) and files first.

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Q10) a) If a product or act infringes a narrow claim, then it must also infringe a broader claim, however this is not true in reverse. The broad claim contains the scope of the narrow claim, but also additional subject matter not present in the narrow claim. Use of this subject matter therefore does not infringe the narrow claim, but does infringe the broad claim. In other words, a narrow claim can be infringed in fewer ways than a broad claim.

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b) If proceedings are brought in the UK for a patent in a foreign language, the person bringing proceedings must provide a translation.

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0.5 c) i) The comptroller may correct errors of translation, transcription or clerical errors or mistakes. Alternatively, the applicant may request to amend the patent.

0.5 He must, in writing, indicate the amendment (in this case, correction), and state the reason for making it. The comptroller will allow the correction of a mistake

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1 where it is obvious - meaning it is self-evident and where nothing else could have been intended in the specification.

ii) Where a person infringes a patent as correctly translated, but not as originally translated, no damages (or an account of the profits) shall be payable by them

1✓ unless the corrected translation had been provided to the UKIPO and published before the date of the infringement occurring. The client may bring infringement proceedings seeking an injunction against the continuation of the acts of

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1✓ the infringing actions occurred before any corrected translation had been published. This is a form of innocent infringement - the competitor can argue that at the time of infringement they did not know, and had no reasonable grounds to suppose, that they were infringing the patent.

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1✓
1✓
①✓

iii) The competitor has not exploited the invention in all the ways claimed. The client should file a corrected translation with the UKIPO and pay a fee to publish the corrected translation. Once published, if the competitor infringes the patent by using any of the other applications of the invention they will not be able to use the defence stated in above in (ii).

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