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Q1:

The following, provided that the subject matter relates to them as such, are not inventions:

- Discoveries, scientific theories, mathematical methods 0.5
- Methods, rules or schemes for performing mental acts, playing games or conducting business 0.5
- Presentation of information 0.5
- Computer programs 0.5

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Q2:

- GB-A was filed on 16 September 2019
- GB-B was filed on 16 September 2020
- As GB-B was filed within 12 months of GB-A, it is not necessary to request a late declaration of priority
- 0.5✓
 - Priority may be declared within the later of 4 months from filing, or 16 months of the priority date of the earlier application (GB-A's filing date)
 - Therefore, the deadline for declaring priority is 16 January 2021
 - In order to declare the priority, the country of filing and the date of filing of the priority application are required
- 1✓
 - As the priority was not declared on filing, it is necessary to file PF3 and pay a fee (£40) when declaring the priority
 - 1✓
 - This deadline falls under part 1 of schedule 4 and, therefore, cannot be extended
 - A certified copy of the priority document, or a copy otherwise verified to the comptroller's satisfaction, should also be provided within this 16 month from priority time limit
 - The deadline for providing a copy of the priority document falls under part 2 of schedule 4. Therefore, an as of right extension of 2 months is available if Form 52 and a fee are paid if the request is made within 2 months of the time limit expiring. A copy of the priority document may also be filed later than 2 months from the expiry of the 16 month period at the discretion of the comptroller but evidence as to why it wasn't filed on time is also required

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- However, as the priority application is a UK application, it will not be necessary to file a certified copy of it
- However, it will only be possible to make the declaration of priority if technical preparations for early publication have not been completed. As GB-B has not yet been published, if the technical preparations for publication haven't been completed by the UKIPO, then we should
1✓
0.5✓ withdraw the request for early publication before submitting the request.

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Q3:

Facts:

- Eli Lilly had a patent for the use of permetraxed disodium combined with vitamin B12 as a medicament for a cancer treatment.
- Actavis used permetraxed dipotassium (and various other related salts not including permetraxed dipotassium) in combination with vitamin B12 as a medicament for a cancer treatment.
- Actavis sought a declaration of non-infringement and Eli Lilly counterclaimed for infringement
- Overall, it was found that Actavis infringed Eli Lilly's patent, not by way of normal interpretation, but instead through the doctrine of equivalents.

1

Precedent:

- Prior to this case, the UK did not have a law in place for the Doctrine of Equivalents. Actavis v Eli Lilly is the case law that brought the Doctrine of Equivalents into effect in the UK.
- The Supreme Court established that the question of variants and the question of normal interpretation should be treated as two separate questions. This led to a reformulation of the "Improver Questions" (see below) relating to whether a variant to an invention will infringe.
- The Supreme Court also established that the skilled person should not have the burden of working would whether a variant infringes. Instead, one must consider whether the skilled person would find it obvious that a

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variant achieves a result in substantially the same way, given that they know it achieves substantially the same result.

- This case also set the precedent that one may consider the file history of a case in determining the interpretation of the claims if it unambiguously resolves a point.

Test:

- Notwithstanding that the variant does not fall within the scope as a matter of normal interpretation, does the variant achieve substantially the same result in substantially the same way?
- Would the skilled person find it obvious, reading the patent at the priority date and knowing that the variant achieves substantially the same result, that it does so in substantially the same way?
- Nonetheless, would the skilled person have understood from the language used in the patent that compliance with the literal meaning was an essential requirement?
- If the answer to the above is “yes, yes, no”, then the variant infringes.

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Q4:

a)

- Assignments 1✓
- Licences (e.g. exclusive, sub, sole, as of right...) 1✓
- Mortgages 1✓
- Security 1✓
- Charges (e.g. floating, fixed) 1✓

5

b)

- It is necessary to register such transactions, instruments or events (TIE) because any such person does not have access to the rights and remedies afforded by such TIEs until it is recorded in the register
- 1✓ • In infringement proceedings, the beneficiary of a TIE will not be awarded 0.5✓ costs or expenses unless:
 - 0.5✓ ○ The TIE was recorded at the UKIPO within 6 months of the date of the TIE, or
 - 0.5✓ ○ It was recorded later (or not yet recorded) because it was not practicable to do so
- 1✓ • Furthermore, the beneficiary of the TIE may not enforce their rights against bona fide purchasers for value without notice of the TIE (because it wasn't recorded) until the TIE is recorded at the UKIPO. Therefore, it is important to register such TIEs.

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- In order to validly recorded in the register, a request for recordal must be made on PF21 and a fee must be paid and the TIE itself must be in writing and signed by, or on behalf of, the assignor.

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Q5:

Advantages

- 1✓ Making licences of right available has the advantage that there is a 50% reduction in renewal fees.
- Also, as it is advertised in the register, this event may attract more licensees because it is easier to obtain a licence. This could increase the revenue that the client gets because there may be a wider pool of licensees
- 1✓ It may also be cancelled at any time provided that notice is given to any licensees and the comptroller is informed. This provides flexibility and means that the client is not tied to providing licences of right
- A licence of right may also be made available at any time during the lifetime of the granted patent

Disadvantages

- 1✓ The client says that they believe that the renewal fees are prohibitively expensive, however, this might change in the future. Whilst entering a notice in the register that licences are available as of right results in a 50% reduction of renewal fees (provided that the request is made at least 10 days before the last day to pay the relevant renewal fee), if this subsequently changes and an entry is made to cancel the availability of licences as of right, all of the discounts in renewal fees must be paid back.
- The client says that they have successfully licensed their invention. However, if they make licences available as of right, this may deter some

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- of their current licence deals. Additionally, if the terms of the licence of right are more favourable than their current licence deals, their current licensees may exchange their current licence deal for a licence of right.
- 1✓ If the terms of the licence cannot be agreed upon by the proprietor and a licensee of right, the comptroller will settle the terms of the licence (which the client may not agree with)
 - 1✓ The client will be prohibited from requesting an entry to be made regarding the availability of licences of right if they currently are licensing out that particular patent under an exclusive licence

General comments

- The client also asks how they can reduce the fees. As they have a number of GB patents, only some of which are successfully licensed, if the non-licensed patents aren't being exploited and there are no other parties that want to license it, then one option may be to surrender the unsuccessful patents so that renewal fees are no longer payable.

When would the UKIPO refuse such an application?

- The UKIPO would refuse such an application where someone else is listed in the register as already having an interest in the right (i.e. an exclusive licensee) and
- 1 where the consent of that person has not been provided. This is because licences as of right may not be granted in the event that someone else already possesses an exclusive right to it.

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Q6:

- A patent may only be filed by a natural or legal person
- A patent may be filed by more than one person
- A partnership is not a natural or a legal person so a patent cannot be filed by a partnership as a partnership is not capable of owning personal property. 0.5
- If it is a limited liability partnership, then a patent application can be filed in its name because an LLP is capable of owning assets 1✓

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1.5

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Q7:

Lapsed Patent

- First, we need to consider whether the patent is in force.
- The patent has lapsed due to non-payment of a renewal fee, however, we need to find out when this occurred. It is still possible to validly renew the patent in the grace period provided that the renewal fee and an additional late fee is paid.
- 0.5✓
0.5✓ • The grace period is 6 calendar months beginning immediately after the end of the month in which the renewal date for the patent fell.
- 1✓ • If we are within this grace period, the patent may be renewed without any loss of rights occurring and no third party intervening rights will arise.
- If however, we are outside of this period, it is no longer possible to request renewal within the grace period. Instead, we would have to rely on restoration.
- 1✓ • For a restoration request to be admissible, it must be made within 13 months from the expiry of the grace period (i.e. 19 months from the end of the month in which the renewal date fell)
- A restoration fee must also be paid.
- 1✓ • The request must be made on PF16 and must be accompanied by the grounds and evidence for restoration.
- If no evidence is filed, then the Comptroller will specify a period in which the evidence must be furnished.
- 1✓ • The request must convince the Comptroller that the failure to pay the renewal fee was unintentional. If the Comptroller is satisfied that the

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failure to request the renewal fee in time was unintentional, he/she will specify a period within which the omitted acts must be completed.

- In this case, the omitted acts that need to be completed are the payment of the renewal fee and the additional fee.
- Based on the present scenario, it is likely that the client will be able to convince the Comptroller that the failure to pay the renewal fee was unintentional as their managing director has instructed the payment of the fees but the payment was never taken from the bank.
- If, however, the Comptroller doesn't allow the request and chooses to refuse it, the proprietor may request to be heard within 1 month of the refusal.
- Finally, if we are outside the window to request restoration, there is nothing that the proprietor can do and the patent will be unenforceable.

1✓

1✓ 1✓

Effect of restoration

- Anything done under the patent (e.g. granting licences) between the expiry of the patent and the request for restoration will be taken to be valid.
- Assuming that an act is an infringing act, any act done at a time where it was possible to still validly renew the patent (i.e. through the grace period) will still be an infringing act.
- Between the expiry of the grace period and the Comptroller publishing in the register that a request for restoration has been made, if a third party

1✓ 1✓

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continues to do, or resumes, a previously infringing act, then this will still be considered to be an infringing act.

- If however, between the expiry of the grace period and the publishing of the request for restoration, a third party:

1✓ ○ Commences, in good faith, an act which would be considered to be an infringing act had the patent not lapsed, or

○ Makes, in good faith, serious and effective preparations to do such an act,

1✓ ○ That third party may continue to do, or, as the case may be, do, such an act notwithstanding the restoration of the patent. This is known as third-party/intervening rights.

1✓ • These third party rights do not extending to granting licences to do the act. However, they do extend to authorise any partners in business for the time being to do the act and may also be transferred on death/corporate dissolution to a person that acquires that part of the business.

1✓ • The third party rights are limited to the use at the time of request for restoration was published in the register.

“Infringing” Act

- The client says that they believe that their competitors make their pies with their patented method, however, they do not know that this is the case.

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- One possibility to consider is that their competitors may have prior user rights if they used the method before the filing/priority date of the client's patent.
- Also, can't prevent them from using the method if it is, in fact, a different method that doesn't fall within the scope of their patented method
- The exclusive right of the proprietor is to prevent the use, or offer for use, of a process in the UK without the consent of the proprietor (provided that the patent is in force)
- The question says that they asked their competitors about their method but they haven't received a reply yet
- We do not know what was included in their letter to the competitor, however, it does not appear that they informed the competitors that they are in possession of a patent. If they just asked their competitors about their method, it is understandable why the competitors didn't reply.
- Provided that the patent is restored/renewed, they should make a justified threat to the competitors. They should write to their competitors letting them know that they have a right under the patent and that they are seeking to discover, whether, or by whom, an infringing act is committed.
- They should not make an express threat, but instead, should just include information that they believe to be true and which is necessary for that purpose.
- This is also important if subsequent infringement proceedings are to be brought because then the competitor will not be able to invoke the innocent infringer provision in saying that they were not aware, and had

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no reason to believe, that a patent for the method existed (because my client informed them that they had a right under the patent).

- They also state that they haven't caught their competitors in the act. They should see if it is possible to catch them in the act.
- If the competitors do not reply to the threat within a reasonable time, then they can initiate infringement proceedings. Although they must be careful because they do not have any evidence that their competitors are actually using their process.

Conclusion

- Overall, they will not be able to take any legal action if their patent is unable to be revived.
- However, if their patent is revived, they should bring this to the attention of their competitors.
- If it was innocent infringement, they will not be entitled to damages. However, they will be able to get an injunction preventing further use.
- If third party rights are in force, these will be limited to the use of the process in cheese pies at the time of the request for restoration and the competitor won't be allowed to expand to meat pies because they displayed no intention to expand to meat pies.

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Q8:

a)

- The deadline for requesting examination and paying the examination fee is 6 months from publication of the application
- The application was published on 16 March 2020 so the deadline for requesting examination and paying the associated fee is 16 September 2020
- An as of right extension of 2 months may be requested as the request for examination falls under parts 2 and 3 of schedule 4. This means that no evidence needs to be filed explaining why the request was not filed on time.
- This means that if an extension for requesting examination is made within 2 months of the expiry of the time limit (i.e. by 16 November 2020) on PF 52 and accompanied by the prescribed fee, this time limit may be extended.
- This time limit may be extended by a further periods of 2 months provided that the first extension (i.e. an extension within 2 months of the expiry of the time limit to request examination) was made.
- However, for requests for extensions beyond the first extension, evidence must be filed and the extension is discretionary.
- May also be possible to request reinstatement of the application.
- The request for reinstatement must be made within 12 months of the expiry of the time limit (16 September 2020) and must be accompanied by a fee. Reinstatement must be requested on PF14.

0.5

0.5✓

0.5✓
0.5✓

0.5✓

1✓

3.5

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- Evidence should be filed convincing the Comptroller that the failure to request examination in time was unintentional.

b)

- The application has been entered into GB national phase. This means that form NP1 and any necessary translations must have been filed.
- 1✓
1✓ • A statement of inventorship must be filed within 2 months of national phase entry, however, if a statement of inventorship (or an equivalent thereof) was filed during the international phase of the PCT and it is to the satisfaction of the Comptroller, it will not be necessary to file a statement of inventorship.
- Also, where the applicant is the inventor, no statement of inventorship will be required as it is not necessary to show the derivation of rights.

2

c)

- If the examination report was sent on 16 June 2020 and set a 2 month deadline for filing a response, this means that the response to the examination report is 16 August 2020.
- The time limit for responding to the response has expired, however, there is an as of right extension available (no form required or fee payable).
- 1✓ • The as of right extension is 2 months and is retroactive in that the extension takes effect when the response is filed (i.e., don't need to request it early).

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- This means that it is possible to extend the deadline for response until 16 October (today).
- As the client has informed me that they will not be able to file instructions for at least another week, this deadline will be missed and the patent application will be deemed to be withdrawn on the date the response was due (16 August).
- When a patent is withdrawn/deemed to be withdrawn/refused due to missing a time period, it may be possible to request reinstatement of the application.
- The request for reinstatement must be made within 12 months of the expiry (by 16 August 2021).
- A reinstatement fee must be paid and must be requested on PF14.
- the client must submit the grounds that they rely on, together with evidence that illustrates that the failure to file the response in time was unintentional.
- It is not clear from the question why the client missed the deadline. If the Comptroller is not convinced that the failure to meet the time limit was unintentional, he/she will refuse the request for reinstatement.
- The client can request to be heard.
- If the Comptroller maintains their objection that the request should not be allowed, the client has 28 days to appeal this decision.
- If the request for reinstatement is allowed, the Comptroller shall specify a period in which the response must be filed and it is imperative that the client give the instructions by then.

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- One thing to bear in mind is that the compliance period is probably approaching. Usually, responses are set a 4 month time limit for response.
- As this one sets a 2 month limit, it is likely that the compliance period is a maximum of 12 months away from 16 June 2020.
- Therefore, if it's necessary, the client may also want to request an extension of the compliance period using form 52 and paying a fee.

1

d)

- Application D was filed 11 months ago and contains a claim to a metal widget
- 1✓ • The applicant wants to file a single application protecting both metal and rubber widgets (let's call this application E)
- Application E should be drafted such that it contains all of the subject matter of application D, together with all of the subject matter necessary to make a claim for the rubber widget.
- 1✓ • As application D was drafted 11 months ago, it is still possible to claim priority from application D (provided that it hasn't been unconditionally withdrawn, abandoned or refused).
- It may be possible to protect both widgets in a single application if the inventions are unified by a single inventive concept
- If application E is filed on a weekend, it is best to file it without a claim to priority so that the application can have an earlier filing date (i.e., so that it

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can have the date of filing as its filing date, rather than the next working date)

- The priority can then be declared later (provided that it's done within 16 months of the priority date of application D)
- Application D can then be intentionally withdrawn so that the client doesn't have to worry about examining that application
 - Or the application can be allowed to lapse by not paying the relevant search and application fees
- When this happens, all of the subject matter in the application relating to the metal widget will have the priority date of application D and all of the subject matter in the application relating to the rubber widget will have the filing date on the date on which application E was actually filed
- As we are close to the 12 month from priority date, we need to start thinking about the payment of the application and search fees.
- A request for search must be filed on PF9A and the search fee must be paid from the later of 2 months from filing of application E, or 12 months from priority (in this case we will use the 2 months from filing deadline).
- The application fee must also be paid by this time
- If combined search and examination is desired, the request for examination on PF10 and the examination fee can be paid/filed together with the request for search.
- A new claim, directed to both the metal and rubber widgets must also be filed within this time limit.

1✓

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- However, if these acts are not done within the time limit, there is an as of right extension available under Parts 2&3 of Schedule 4 upon the submission/payment of Form 52 and the prescribed fee (and completion of the act) if it is done within 2 months of the expiry of the time limit for completing the S15(10) acts.

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Q9:

a)

1✓

- A divisional application occurs when there is more than one invention in an application and those inventions are not joined by a single inventive concept.

- In order for a patent to be granted, it must be directed towards a single invention, or if directed towards multiple inventions, must be joined by a single inventive concept.

- Two or more inventions are joined by a single inventive concept where there is a technical relationship between those inventions, wherein a technical relationship comprises one or more special technical features, which, when considered as a whole for each invention, make a contribution over the prior art.

1✓

- Therefore, where two or more inventions are not joined by a single inventive concept, it is not possible to pursue them in a single application and instead, the subject matter for those claimed is “divided” out of the initial application and pursued in a separate application – known as a divisional.

- In order for the divisional application to be valid, it cannot disclose matter beyond that which was disclosed in the original parent from which it was divided (known as the parent application).

- If it discloses subject matter beyond that which was disclosed in the parent application as filed, then the divisional application will not be allowed to proceed towards grant.

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b)

- 1✓ Sufficiency relates to whether the specification for a patent / patent application is framed in such a way that a person skilled in the art would be able to work the invention.
- 1✓ In order for a patent to be granted, they must be supported by the description, however, there is an additional requirement in that the description must also enable the skilled person to carry out the act.
- 1✓ E.g. if a patent application claimed “a time machine” and the description for the patent application stated “a time machine” (and this was the only disclosure of the invention), the claim would be supported, however the description wouldn't be sufficient as there is not disclosure enabling the skilled person to implement the invention.
- 2 Sufficiency may be objected to at various stages. First, an objection may be raised on the grounds of sufficiency during examination if the Examiner believes that the claims are not sufficiently enabled/described in the description.
- Sufficiency may also be put to issue during revocation proceedings or as a counterclaim to infringement (i.e., claiming that the patent is invalid because it does not contain a sufficiently enabling disclosure).

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- 0.5 0.5 • On application made by an employee within one year from expiry of granted patent
 - 1✓ • Proceedings under S40 UKPA can only be brought if the patent has been granted, it cannot be brought in the case of a rejected patent application.
 - 1✓ • Where the invention, or patent for the invention, is of outstanding benefit to the employer
 - 1✓ 1✓ • In relation to, amongst other things, the size and nature of the employer's undertaking
 - 1✓ • The court shall order the employee compensation to be paid by the employer such that it secures for the employee a fair share of the benefit that the employer has, or is expected to, derive from the invention or patent for the invention.
 - 1✓ • However, the court may not award compensation to the employer where it is determined that there were other collective compensation arrangements (such a trade union) in which compensation for the patent and/or invention was arranged for the employee.
- d)
- 1✓ • If a patent is surrendered, it is not possible to bring infringement proceedings in respect of acts committed prior to the date of surrender, even if they are infringing acts
 - 1✓ • The date of surrender is deemed to be the date on which the Comptroller publishes the surrender in the Official Journal

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- Another consequence is that the patent, prior to surrender, may be subject to exclusive or otherwise licensing agreements
- In the case of surrender of the patent, right holders (such as exclusive or non-exclusive licensees) are entitled to end their contract. This may have negative effects on the proprietor of the patent because then the patent is free to use be all and the proprietor will stop receiving any payments/royalties.
- 1✓ • Surrender also can't be made if there are ongoing proceedings regarding either the validity of the patent
- 1✓ • If there are ongoing proceedings regarding the entitlement of the patent, the patent may only be surrendered if the person claiming to be entitled also consents.

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