

Examiner's  
use only**Question 1**

not an infringement of a patent:

- private, non- commercial use 1✓
- experimental use (sue for experimental purposes). 1✓
- use by a qualified pharmacist/medical practitioner in preparing a medication for a prescription. 1✓
- use within or in the body of a ship that has accidentally or temporarily entered UK waters (both inner and outer waters). 1✓
- use within or in the body of an aircraft that has accidentally or temporarily entered UK airspace/land. 1✓

5

MARKS AWARDED 5/5

**Question 2**

- a) Merrel Dow v Norton 1✓
- b) Merrel Dow owned a patent to terfenadine (an antihistamine) which patent had expire.
  - The patent disclosed that the terfenadine was converted into the active substance in the liver.
  - On expiry of the patent, Norton began selling terfenadine.
  - Before Norton began to sell terfenadine, Merrel Dow filed a new patent to the active substance, formed by metabolism of terfenadine by the liver, following consumption of terfenadine.
  - Once granted, Merrel Dow brought infringement proceedings against Norton.
  - Norton counterclaimed that Merrel Dow's patent lacked novelty over:
    - i) prior use of terfenadine by volunteers that took terfenadine during trials.
    - ii) Prior disclosure in Merrel Dow's first patent of active substance being formed following consumption of terfenadine. 2✓

1

2

- c) The High Court decided that Merrel Dow's patent to the active substance lacked novelty over their first patent and the 2nd patent (to the active substance) was revoked. 1✓
- d) Precedent:
- Although anticipation by prior use was judged not to disclose the invention, it set a precedent of applying this as a ground in revocation proceedings.
  - The patients who administered terfenadine in the trials were not aware of what they had taken or what affect it had. Thus this was not considered to be an enabling use. Precedent = prior use must be enabling.
  - Anticipation by prior disclosure was judged to apply - the first patent had enabled the skilled person to work the invention of the second patent by taking terfenadine.
  - Precedent = anticipation by disclosure must be enabling. It doesn't matter if the exact way in which invention works is unknown, as long as a method to work it is disclosed. For example, a tribe may consume material containing quinine because they know it helps to fight malaria. It doesn't matter that they don't know the exact structure of the material that they eat, the fact that they know the material helps fight malaria is what matters. 3✓

1

3

7

MARKS AWARDED 7/10

**Question 3**

- a) No – the UK patents act does not provide for priority to be claimed from a design application. 0.5✓
- b) No – the UK patents act does not provide for priority to be claimed from a non-IP disclosure. 0.5✓
- c) Yes – it does not matter if the EP patent application does not designate GB, the patents act allows for any EP application to form a 0.5✓ priority document.

0.5

1

0.5

- d) No – the UK patents act does not allow priority to be claimed from non-PCT, EP or GB patent applications.

2

MARKS AWARDED 2/4

0

**Question 4**

- defences are that the thing disposed of was at one point patented and that altering the thing such that it no longer represents that it is patented was not feasible (less strict than practicable) in the time since the patent ceased to exist. 1✓
- The person could also argue that a patent does exist (if it is true), with evidence of this. 1✓

2

MARKS AWARDED 2/3

**Question 5**

- joint proprietors of a patent have the same rights as sole proprietors 0.5✓ with respect to infringement proceedings. They may bring infringement proceedings against another without the permission of the other proprietors (the others are notified and attend as defendants but not party to proceedings unless they choose).
- joint proprietors have the right to work the invention and may use, keep, dispose of, offer to dispose of or import the invention without being considered to infringe. 0.5✓
- Any person supplied with the invention may work it as if it had been 0.5✓ supplied from a sole proprietor.
- Joint proprietors may do any act that keeps the patent / patent application in force without the permission of the other proprietors.
- Joint proprietors may not 0.5✓ assign 0.5✓, license 0.5✓, sell, mortgage 0.5✓, amend or 0.5✓ withdraw 0.5✓ a patent / patent application (or any rights in it) without the permission of each of the other proprietors.

4.5

MARKS AWARDED 4.5/8

**Question 6**

- In practice, a scheme, rule or method for performing a mental act may be patentable if it is capable of industrial application and if the patent application / patent is not directed to the excluded subject matter “as such”. 1✓
- If a claim is directed to the use of the scheme, rule or method for performing a mental act for improving a technology, for example the performance of the technology or the efficiency of the technology, then the claim may not be excluded. 1✓
- Alternatively, the scheme, rule or method for performing a mental act could be combined with non-excluded subject matter.
- The aim of the exclusion is to prevent the patenting of anything that could be performed mentally without industrial applicability. 1✓

3

**MARKS AWARDED 3/4****Question 7**

Biotechnological inventions.

- Any plant not including microorganisms or animal variety 0.5✓ (variety being a particular set of plant or animal characterised as having a particular set of shared characteristics).
- Any naturally occurring substance, for example a plant component or a gene 0.5✓, but a particular method of isolating a naturally occurring substance may be patentable.
- a human being 0.5✓ at any stage of its formation 0.5✓ (for example, including a fertilised ovum).

2

**MARKS AWARDED 2/6****Question 8**

- a) Any person may request, including the proprietor of the patent 0.5✓ / application. 0.5✓
- b) The Comptroller will issue an opinion on – whether or not a specific act infringes a claim of the patent/appn. 0.5✓

1

	Examiner's use only
<ul style="list-style-type: none"> <li>- whether or not a specific claim is valid.</li> </ul> <p>The Comptroller will not issue an Opinion on matters that are frivolous or vexatious (that have already been decided in proceedings, for example).</p>	0.5
<p>c) If a third party had infringed the patent whilst it was in force and within the last 6 years (during which time the proprietor could bring infringement proceedings forward). 1✓</p>	1
<p>d) Such an opinion must be requested in writing, together with a fee. The 0.5✓ question on which the party wants an opinion should be clearly laid 0.5✓ out and the party's own written statements should be provided together with their statements of fact 0.5✓.</p>	1.5
<p>e) The request for an opinion will be forwarded to the patent proprietor 0.5✓, any licensee or anyone with a 0.5✓ particular right and any person with a caveat requesting notification of such 0.5✓.</p> <ul style="list-style-type: none"> <li>- The request will be advertised in the Journal. 0.5✓</li> <li>- Within 4 weeks 0.5✓ of advertisement, any 3<sup>rd</sup> parties 0.5✓ (or the proprietor/licensee/right holders) may file their own written statements addressing that of the requester 0.5✓ and supporting their own opinion of the matter in question. They must also file any documents relied upon and any statements of fact.</li> <li>- Within another 4 weeks, the proprietor or 3<sup>rd</sup> parties may file written 0.5✓ submissions in response to those 0.5✓ already filed, again submitting any relevant prior art documents or statements of fact.</li> <li>- After this time, the Comptroller will transfer issue to an Examiner who will consider the statements made and come to an opinion 0.5✓. This will be published 0.5✓ together with the Examiner's comments and a copy of the Opinion will be supplied to any interested parties 0.5✓.</li> </ul>	6
<p>f) A review of the opinion may be sought by the proprietor of the patent / exclusive licensee. 0.5✓ 0.5✓</p>	1

11

**MARKS AWARDED 11/20**

**Question 10**

- a) Your friend and yourself are inventors, irrespective of ownership of the patent application. Thus, you should discuss the matter of inventorship with your friend – is he/she happy to be mentioned on a patent application as an inventor? If not he/she can waive their right to being mentioned.
- If you are to be the sole applicant, then an assignment will need to be **1✓** filed with the UKIPO by 16 months from filing. The assignment must be in writing, detailing that the ownership rights of your friend are to pass from him/her to you. This must be signed by your friend (good for both of you to sign). This assignment will be used as proof of your derivation of rights from your friend.
  - you should not publicly disclose the invention and, if you need to disclose it to someone then you should make sure it is done confidentially and that the person knows that the material is confidential. If possible, have a non-disclosure agreement signed.
- b) The public talk will not be considered prior art if it took place on the same day as filing the application **1✓**. Was the talk at a conference recognised by the UKIPO as not resulting in a disclosure of the invention? If so then you have 6 months to file the application, but will need to provide an official certificate from the conference organisers.
- The notes may be filed as a patent **1✓** application (anything that looks like a description is acceptable) but you should **1✓** try to add as much detail to them as possible as they cannot be added to after filing without altering the priority date.
  - Claims are not needed on filing but it is much easier to ensure protection of your invention if claims are present on **1✓** filing. Consider including claims.
  - You will need to state that a UK patent is sought and identify the applicant and their contact details on filing (all in writing).
  - If you file this you will be allocated a filing date.

1

- Are you a UK national/resident? If not then you will need to use a UK agent or include another applicant on the application who is a UK national or resident.
- c) If a patent is made 'licence of right' then this fact will be advertised in the Journal. As a consequence, any third party who wishes to obtain a 0.5✓ licence may apply and will be granted such a licence if they agree 0.5✓ to your terms. If not, the Comptroller may step into settle terms. 0.5✓
- If a person infringes your patent and, during proceedings, they agree to take a licence of right, then you may not be awarded an injunction against 0.5✓ them. They may proceed to defend the alleged infringement and/or to invalidate your patent. If you are awarded costs and/or damages, they will be limited to no more than twice the cost/ earnings of a standard 0.5✓ licence holder.
  - Once you have a licence of right, and you wish to terminate it then you may only do this if licensees agree or you are not prevented by any licence holders. You must pay back all renewal savings made at the same time and 1✓ request in writing.
- d) An exclusive licence may bring forward infringement proceedings 1✓ without the permission of the proprietor whilst a sole licensee requires the proprietor's permission and for the proprietor to be a defendant in the proceedings. Therefore, sole licensee has fewer rights.

4

3.5

1

9.5

**MARKS AWARDED 9.5/20**

### Question 11

- a) Assumed that the description does not comprise more than 35 pages and that excess page fees 1✓ are not required.

Assumed that the claims do not comprise more than 25 claims and that excess claims fees are not required.

(If they were then claims fees would be due on requesting search and pages fees would be due on requesting examination).

P1 – publication of the search report 0.5✓ allows 6 months deadline for 0.5✓ the 0.5✓ payment and request of examination.

- The Examiner will cite the prior art of the search report when objecting to the patentability of the invention. Exam reports should be responded to within the time limit set by Examiner (extendable by 2 months as of right) 1✓.
- In between issue of the Search Report and issue of the first Examination report, the application may be voluntarily amended as many times as the applicant wishes, without the discretion of the Examiner.
- After issuance of the first Examination report, the applicant may voluntarily amend once only and all other amendments must be in response to the Examiner's comments and objections. Further voluntary amendments are at the discretion of the Examiner. Should clearly identify amendments.
- The applicant must file a statement of 0.5✓ inventorship by 16 months from priority 0.5✓ ↳ 14 May 2020. This must detail the inventors and how their rights are derived.
- The application and search report will publish by around 18 months from filing ↳ around July 2020. The date of publication initiates the time for filing examination fees and request. (6 months after publication of Search Report).
- The priority period of the application ends on 14 November 2019. Thus, if the applicant is interested in obtaining protection in any other jurisdictions, they should consider filing other applications and claiming priority before this date.
- The compliance period of the patent application is the time by which the application must be in order for grant. This expires by the later of 4.5 years and 12 years from receipt of the first Examination Report.
  - 4.5 years – 14 May 2023 0.5✓
  - First Exam Report not yet issued. 0.5✓
- If the application is not yet in order for grant by this time then a 2 month extension is available as of right.



- If the client wishes to file a divisional from this application then they must do so whilst the application is pending, 3 months before the end of the compliance period.
- If on grant, the number of claims is above 25 then fees must be paid per claim over 25.
- If the number of pages is above 35, then fees must be paid per page over 35.
- On receiving a notification of grant, the applicant must pay grant fee and excess claims and pages fees within 3 months.

detailed consideration of the impact of D1:

- D1 has a priority date before that of the client's application but it was published after the priority date of the client's application. Therefore, D1 is only relevant when assessing the novelty **1✓** of the application.
  - Even so, the hinge used in D1 is "substantially identical" to the client's hinge. Thus, it would seem to be problematic w.r.t. novelty.
  - The description of the client's application seems to provide basis for amending the claim so that the hinge is in **1✓** combination with a garden gate (whereas D1 describes a hinge for a biscuit tin). **1✓**
  - Thus amendment of the claim to be directed to a hinge in combination with a garden gate seems to distinguish the claims from D1 and achieve novelty over D1.
  - Thus, amending the claims as described above seems to lead to novel and inventive claims.
  - This amendment may be made voluntarily or in response to Exam Report.
- b) The UKIPO will raise a lack of unity objection against claims 1 and 2. This is because claim 1 is identical to claim 1 of the 1<sup>st</sup> application, which is to a garden gate hinge and Claim 2 is to a restoring spring.
- The claims of a UK patent must be directed to one invention or must be unified by the same special technical feature or multiple special technical features that solve the same technical problem.

- In the applicant's case, the claims are not unified by a common special technical feature.
- This could be rectified by amending claim 1 to include a restoring spring (for which there appears to be basis in the description).
- Otherwise, the UKIPO will only search the first invention and will request an additional search fee to search the 2nd invention. The Client could file a divisional application to the 2nd invention if they so wish.

8.5

**MARKS AWARDED 8.5/20**