

Examiner's
use only**Question 1**

- private; non-commercial use (e.g private individual) 1✓
- experimental purposes relating to the subject matter of the invention 1✓
- clinical trials used for obtaining marketing authorisation of medicinal product 1✓
- extemporaneous preparation of a medicine (prescribed by a medical practitioner) in a pharmacy 1✓
- use for the needs of and the body of a ship that temporarily entered UK waters (must be registered outside UK) 1✓

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MARKS AWARDED 5/5**Question 2**

- a) Dr Reddy Laboratories vs Eli Lilly 1✓ 1
- b) Dr Reddy ... sought revocation of Eli Lilly's patent covering (specifically) olanzapine on the grounds that it lacked novelty over the earlier Lilly's patent which disclosed a Markush structure covering olanzapine 1✓
important drug (broadly) 1
- c) patent covering olanzapine was held novel over the earlier „broad” patent, revocation not successful. 1✓ 1
- d) precedent is of great importance to the concept of „selection inventions”.

earlier patent disclosed a Markush that covered millions of millions of compounds, with a preferred subclass of 86 000 compounds that covered olanzapine. Olanzapine per se, however, was nowhere specifically disclosed in the earlier patent

the court held that a disclosure of a broad genus of species cannot amount to a disclosure of each of the species in their individualised form in simple words: „generic” does anticipate „specific”

Multiple selections would have to be made by the skilled reader in order to arise specifically arrive at olanzapine starting from the broad Markush

structure of the earlier patent, i.e olanzapine not specifically disclosed by Markush.

the precedent inevitably finds application in, inter alia, novelty of sub-ranges selected from broad numerical ranges, in addition to chemical cases^{2✓}

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MARKS AWARDED 5/10

Question 3

- a) no, Paris Convention does not provide for^{0.5} a patent validly claiming priority from a design application
- b) no, journal is not a patent application or a utility model^{0.5}
- c) yes, EPO application will be treated as a Convention application, irrespective of withdrawal^{0.5} ^{0.5} of designation
- d) yes, US is a Paris Convention country.^{0.5}

0.5

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0.5

2.5

MARKS AWARDED 2.5/4

Question 4

he is not liable during a reasonable period (after the patent expired/was revoked) in which to dispose of the remaining stock. ^{1✓}

a valid defence would also be to demonstrate due diligence – i.e he couldn't stop other people from selling marked products after the expiry of reasonable period (but he made reasonable attempts at doing so) ^{1✓}

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MARKS AWARDED 2/3

Question 5

subject to any agreements to the contrary, joint proprietors are each entitled to equal, undivided share in the patent

subject to any agreements to the contrary, each proprietor ^{0.5✓} can work the invention ^{0.5✓} to his own benefit, without it being infringement ^{0.5✓} of other proprietor's rights, independently of others

subject to any agreements to the contrary (or contested entitlement), a proprietor 0.5✓ cannot, without consent of other proprietor's:

- amend 0.5✓, apply to amend 0.5✓ a patent/patent application
- apply to revoke 0.5✓ a patent
- assign 0.5✓, license 0.5✓, mortgage 0.5✓ a share in the patent

a product disposed of by a joint owner is treated as if disposed by a single proprietor.

upon death of a proprietor, his share passes to his successors in title (not to other joint proprietors)

this is a special version of tenancy in common

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MARKS AWARDED 5/8

Question 6

„as such” – ... only to the extent that the invention relates to these elements
1✓ „as such”.

Of course, in practice, this does not mean that the invention is not patentable merely because such elements are present in the claim. It is only where the „technical contribution” of the invention relies on those elements.

I don't remember parties to the case that set the precedent (not on syllabus – not fair...), but the test goes along the lines of:

- properly construe the claim
- identify technical contribution of the invention (excluding the excluded subject matter)
- decide whether the contribution arises from the features that have technical character (or otherwise whether excluded subject matter defines the technical contribution) 1✓

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MARKS AWARDED 2/4

Question 7

use of human/animal 1✓ embryos for commercial 0.5✓ purposes
 processes for modifying 1✓ human genom 1✓ line
 human body 0.5✓ and simple discovery of its 0.5✓ elements
 processes for genetically modifying animals, wherein it would cause them
 suffering (unnecessary) and be without medical advancement to humans
 cloning of humans

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MARKS AWARDED 4/7

Question 8

- a) anybody, including the proprietor 0.5 0.5
- b) • whether a particular act constitutes or would constitute an infringement of a patent 0.5
- whether, or to what extent, an invention of a granted patent is a patentable invention 0.5
 - whether the specification discloses the invention in a clear and complete enough manner for it to be carried out by the skilled person 0.5
 - whether a patent contains subject matter that extends beyond the content of the application as filed 0.5
 - whether there has been an impermissible post 0.5 grant amendment that broadened the scope of protection
 - whether an animal/medicinal product SPC is valid 0.5
- even if the patent was surrendered or lapsed, but not evoked ab initio
- c) damages can be claimed up to 6 years back in infringement proceedings – hence could be relevant 1✓
- d) form 0.5✓ + fee 0.5✓ + statement
- question on which opinion is sought 0.5

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- any pertinent facts relevant to the question^{0.5}
- requester's submissions on the question

also:

- names + addresses of any people who could have interest in the question^{0.5}
- any evidence relied upon
- details of any relevant proceedings^{0.5} to the question

file all in duplicate

e) request is lodged with UKIPO

the Comptroller will check the request; he will not issue an opinion if:

- the request is frivolous /vexatious
- the question has been dealt with properly in other proceedings
- it is otherwise inappropriate to do so.

before the Comptroller notifies the request, the requester may withdraw the request (in which case, Comptroller will notify patent holder that the request was made, withdrawn and that he will not issue an opinion – at this stage, only requester is party to proceedings)

the Comptroller will then notify the request to:

- patent holder^{0.5} / exclusive licensee^{0.5}
- any registered patent holders
- a person that has requested a ^{0.5}caveat in respect of issuance of s74A opinion
- people mentioned in the requester's^{0.5} submission

this commences the „observations period“^{0.5} of 4weeks.

During that period, anybody^{0.5} can comment on requester's submissions.^{0.5} They must serve the requester and^{0.5} patent holder^{0.5} with submissions. Then, 2 weeks for proprietor's submissions on the question. Must forward submissions to requester and person who made the observations

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then, examiner will prepare and issue an opinion 0.5✓. It is a completely non-binding opinion.

Review may be sought by proprietor only, 3 months from issuance of the opinion.

f) proprietor only 0.5

13.5

MARKS AWARDED 13.5/20

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0.5

Question 10

a) „jointly developed” – i.e both are inventors and both are entitled to the invention

friend has a right to be named on application (as an inventor)

file application in the names of both

1✓ execute an assignment of rights in application from „agreeable”

1✓ friend to „patent-savy” friend

make sure both signatures are present, in writing.

file with the UKIPO:

1✓ form + fee + evidence of transaction (could be the assignment executed above, but enough if both friends sign the form)

if „agreeable” friend does not want to named, write to the Comptroller to waive the right to be mentioned (name – need reasons) (address – no reasons needed) before preparations for publication are complete (PD + 18m – 5 weeks).

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b) „public talk”;

ask client:

- name of the talk ? compare with OJ list of international exhibitions
- what's the invention ?
- what did you say ?
- has anybody else seen the notes

assess whether client's disclosure was enabling

tell client:

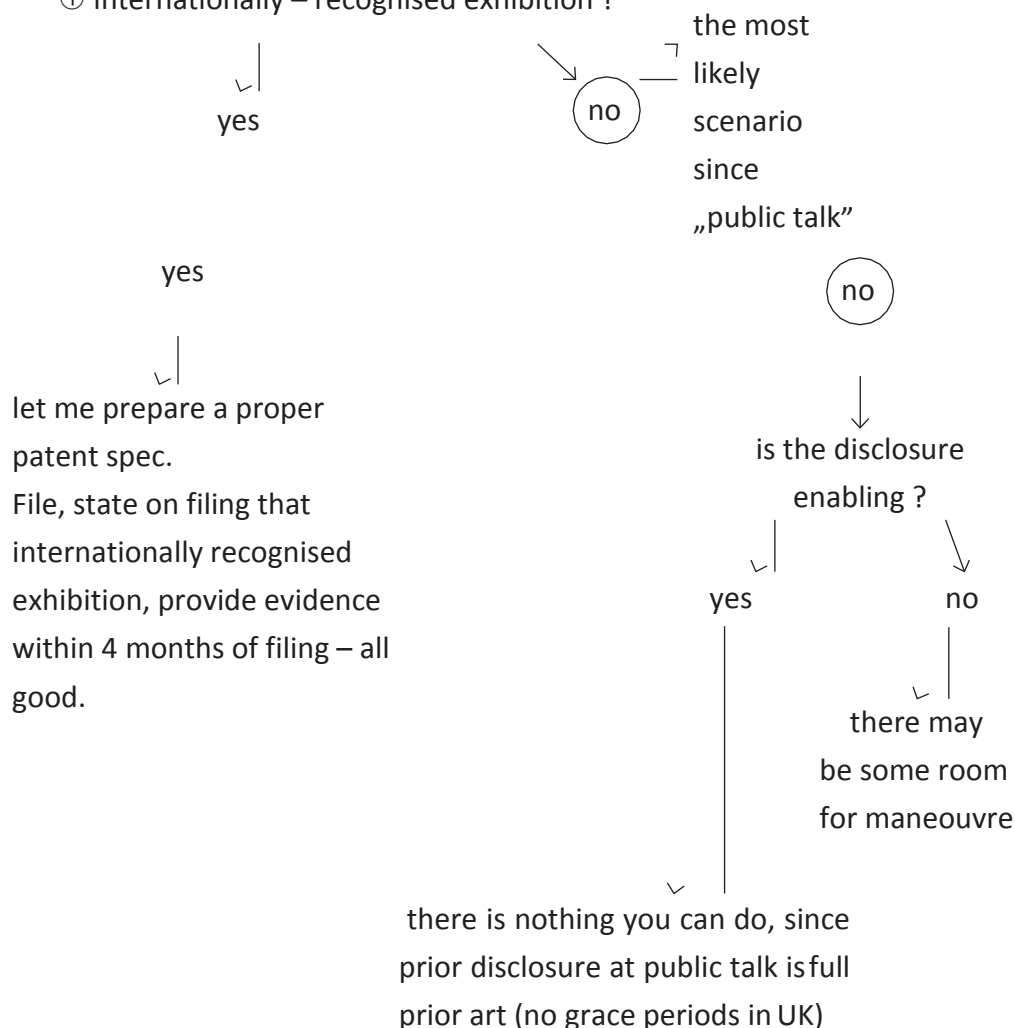
1✓1✓• you can file notes only

1✓• I do not recommend it

- can file claims up to 12m from filing
- description requires certain patent lingo; otherwise, even if the paper shows the invention, it is not 1✓ a robust application and will leave no options for proceeding when a prior art document is found + will be prone to formal objections – offer drafting help
- also, claims – they will almost certainly add matter when filed later
- to get a filing date, you also need an indication that a patent is sought and information enabling contact with applicant

points to consider

① internationally – recognised exhibition ?



1✓ if the disclosure is on filing date (i.e if we somehow draft and file today)
then not prior art

- c)
- anybody can take a licence as of right 0.5✓0.5✓ on proprietor's terms or otherwise on terms set 0.5✓ by the comptroller, if terms cannot be agreed with proprietor
 - Comptroller can exchange existing licences with licences 1✓ of right (if latter are on better terms)
 - renewal fees are halved for those fees wherein renewal date falls after the date when licences of right are available
 - during infringement proceedings, the defendant 0.5✓ can take a licence as of right; without admission of liability for infringement ; in addition, 0.5✓ any damages will be limited to maximum of 2x the value of licence royalties
 - you can apply to register that licences of right are available by filing a form (no fee required), however, there may be no contradictory contractual obligations and registered rights holder must consent (Comptroller will check this)
 - if you want to cancel an entry made, you need to apply to UKIPO (form), third parties can oppose your request
 - if you cancel successfully, your rights are as 1✓ if the entry had never been made. Also, you need to pay balance of all discounted renewal fees.

4.5

- d) exclusive licence gives the exclusive licensee the same rights in the invention as the rights 1✓ of a proprietor, with exclusion of all others (including the proprietor)

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sole licence – proprietor still has his rights in the invention there are no other licensees.

13.5

MARKS AWARDED 13.5/20

Question 11

a) filing date : 14.11.18, filing + search fees paid

search report : 14.02.19

by 12 months from first filing (14.11.19) :

0.5 0.5 • file abstract

extendable as of right, PF52 + fee within 2 months of expiry of deadline

0.5 by 16 months from first filing (14.01.20):

0.5 • file statement of inventorship (PF7)

extendable as of right, PF52 + fee, within 2 months of expiry of deadline

0.5 = 18 months from first filing – publication (i.e. 14.03.20)

↓

0.5 by 6 months from publication, request examination, 0.5 0.5 pay

examination fee and excess pages fees 1 ✓ (over 35 pages) as appropriate.

(i.e 14.09.20) extendable as of right by 2 months, PF52 + fee, as above

✓ D1 is potentially a s2(3) prior art document, PCT designates all states – ok, but:

0.5 ✓ has it validly entered GB national phase ? (fee, 0.5 0.5 translation if appropriate)

0.5 Or has it been supplied to the EPO in one of its official languages and has filing fee been paid?

if no, then not s2(3) art.

if yes (any of the above), then s2(3) art.

D1 – lid for biscuit tin (not garden gate)

use of a hinge which is substantially identical novelty only, not citable for inventive step.

we need base novelty over D1 to advance prosecution; options;
(preferences)

- argument that since the purpose of s2(3) is to ✓ prevent double patenting, a small hinge for a ✓ biscuit tin cannot anticipate larger garden gate hinge (refer to scale + purpose as „novel” features)

- dummy amendment (anything that renders P1 novel over D1)
- substantive admendment (based on one of embodiments)

„use” limitation to garden gates

before preparations for publication are complete, should go for a voluntary amendment and add claims covering „several embodiments” based on the description (in writing, indicate basis – will be accepted)

if this happens, a grant fee may be due 2 months from s18(4) notice of allowance (if over 25 claims end up in the claim set, fee for each claim over 25).

also, may want to try adding hinge + gate combination claims

if we're novel over D1, then no unity issues

if not, the examiner may raise an a posterior lack of unity objection (in which case, file a divisional to combination claims before last 3 months of compliance period)

Compliance period (for putting application in order)

0.5filing date + 4.5 years (i.e. 0.5✓ or if first s18(3) report issues in last 12 months of calculated compliance period (as calculated above), it's mailing date of the report + 12 months

↑

also extendable as of right, 2m, PF52 + fee

once application enters examination, s18(3) report may issue ; objections (if any) will depend on how we deal with D1 (if at all) beforehand ; need to file a response 1✓ by the deadline set in the report, S1176 extension of 2 months available (apply in writing)

- b) today, D1 is a published document irrelevant if it entered GB/EPO national/regional phases

it is full prior art against the embodiment defined by combination of claims 1 + 2; since restoring springs are „in common use” with garden gate hinges, the examiner will most likely raise a lack of inventive step objection, since it'd have been obvious for the skilled person to make such a modification to the hinge ; to overcome, argue that D1 is in a remote field (biscuit tins) to the present invention

there is also a possibility that (since the two applications are filed by the same applicant, have the same priority dates), the examiner may allege that, since springs are „common use”, the two applications relate to the same invention. double patenting However, springs feature arguably renders P2 novel over P1, so easy to address.

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MARKS AWARDED 15/20

Examiner's
use only

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