

FC1 (P1) – UK Patent Law
Mark Scheme 2015

PART A
Question 1

- a) UK patent application B claims priority from UK patent application A. What test must the subject matter of A satisfy in relation to the invention of B for the priority claim to be valid?
1 mark
- b) UK patent application B was filed exactly 12 months after the filing date of UK patent application A. On reviewing the file a week later, you notice the priority claim to application A was accidentally omitted. How would you proceed and by when? Can this deadline be extended?
3 marks
- c) Your client has only one patent application (a UK application). They wish to withdraw this patent application and refile it to 'regenerate' their priority date. What conditions must be met for this to be possible?
3 marks
- d) What documents must be filed and by when to support a priority claim in a UK patent application from a non-UK application?
3 marks
- Total: 10 marks**

Answer

- a) The invention of B must be supported by the subject matter of A.
1 mark
- b)
- i. File form
0.5 marks
 - ii. And pay fee
0.5 marks
 - iii. By 16 months from priority
1 mark
 - iv. Cannot be extended
1 mark
- c)
- i. The application must be unconditionally withdrawn, abandoned or refused
1.5 marks
 - ii. It must not have been made available anywhere to the public
0.5 marks
 - iii. It must not have left any outstanding rights; and,
0.5 marks
- Cont...**

FC1 (P1) – UK Patent Law
Mark Scheme 2015

- iv. It must not have served to establish a priority date for another application made anywhere
0.5 marks
- d) Certified copy
1 mark
- by 16 months from priority
1 mark
- Translation only due on request
1 mark
- Total: 10 marks**

Question 2

You have filed a UK patent application. It does not claim priority. What prior art effect do the following documents have:

- a) A UK application with a filing and publication date before the filing date of your application?
1 mark
- b) A UK application with a filing date before the filing date of your application. It has not as yet been published?
2 marks
- c) A European application filed before the filing date of your application and published after the filing date of your application?
1 mark
- d) A PCT application designating the UK as a national designation (there is no EP designation) filed before your application but published after?
3 marks
- e) A US application filed before the filing date of your application but published after the filing date of your application?
1 mark
- f) A secret UK patent application the publication of which has been prohibited?
1 mark
- g) A document lodged in a public library before the filing date of your application which has never been read?
1 mark
- Total: 10 marks**

Cont...

FC1 (P1) – UK Patent Law
Mark Scheme 2015

Answer

- | | |
|--|---------------|
| a) Both novelty and inventive step. | 1 mark |
| b) Novelty only | 1 mark |
| Must be published | 1 mark |
| c) Novelty only | 1 mark |
| d) Novelty only | 1 mark |
| must have entered into GB national phase | 1 mark |
| and translation filed if not in English | 1 mark |
| e) None | 1 mark |
| f) None | 1 mark |
| g) Novelty and inventive step | 1 mark |

Total: 10 marks

Question 3

Describe briefly one decision of the UK courts relating to novelty or inventive step. You should provide:

- | | |
|---|----------------|
| a) the identities of the parties; | 1 mark |
| b) a summary of the facts and issues; | 2 marks |
| c) a summary of the decision; | 2 marks |
| d) a discussion of the precedent set by the decision. | 5 marks |

Total: 10 marks

Answer

- | | |
|------------------------------------|----------------|
| a) Identities of the parties | 1 mark |
| b) Summary of the facts and issues | 2 marks |
| | Cont... |

**FC1 (P1) – UK Patent Law
Mark Scheme 2015**

- c) Summary of the decision **2 marks**
- d) A discussion of the precedent set by the decision **5 marks**
- Total: 10 marks**

Question 4

- a) What is meant by contributory infringement as defined by Section 60(2) of the UK Patents Act 1977? **5 marks**
- b) What acts are specifically identified as not being acts of contributory infringement in Section 60(3) of the UK Patents Act 1977? **5 marks**
- Total: 10 marks**

Answer

- a) Whilst the patent is in force **0.5 marks**
- Without the consent of the proprietor **0.5 marks**
- Supplies or offers to supply **0.5 marks**
- In the United Kingdom **0.5 marks**
- A person other than a licensee or other person entitled to work the invention **0.5 marks**
- With any of the means relating to an essential element of the invention for putting the invention into effect **0.5 marks**
- When he knows or it is obvious to a reasonable person in the circumstances **0.5 marks**
- That those means are suitable for putting **0.5 marks**
- And are intended to put **0.5 marks**
- The invention into effect in the United Kingdom **0.5 marks**

Cont...

FC1 (P1) – UK Patent Law
Mark Scheme 2015

- | | |
|---|------------------------|
| b) Does not apply to: | |
| Supply | 1 mark |
| Offer | 1 mark |
| Of a staple commercial product | 1 mark |
| Unless the supply or offer is made for the purposes of inducing the person supplied (or person to whom the offer is made) | 1 mark |
| To do an act which constitutes an infringement of the patent | 1 mark |
| | Total: 10 marks |

Question 5

- | | |
|--|------------------------|
| a) On what grounds may a UK patent be revoked? | 5 marks |
| b) Who may apply for revocation and when? | 5 marks |
| | Total: 10 marks |

Answer

- | | |
|--|----------------|
| a) The invention is not patentable | 1 mark |
| The patent was granted to a person who was not entitled | 1 mark |
| The specification does not disclose the invention clearly enough and completely enough for it to be performed by a person skilled in the art | 1 mark |
| The matter disclosed in the specification of the patent extends beyond that disclosed in the application for the patent as filed | 1 mark |
| The protection conferred by the patent has been extended by an amendment which should not have been allowed | 1 mark |
| b) Any person (including the proprietor) | 1 mark |
| at any time after grant. | 1 mark |
| | Cont... |

**FC1 (P1) – UK Patent Law
Mark Scheme 2015**

For the second ground above can only be brought by a person found to be entitled to be granted the patent.

1 mark

Must be brought within two years of grant,

1 mark

unless the person registered as proprietor of the patent knew at the time of grant he was not entitled to the patent.

1 mark

Total: 10 marks

FC1 (P1) – UK Patent Law
Mark Scheme 2015

PART B
Question 6

a) Explain what is meant by 'purposive construction'. **1 mark**

b) List the Improver questions. **8 marks**

c) Your client owns a UK patent for a roller. The roller has a plurality of pyramidal teeth on its outer face. In use the roller is rolled over a thin sheet of metal to produce a pattern in the sheet. This pattern increases the flexibility of the sheet. It is known in the prior art to use a roller having a plurality of domes on its outer face. Use of the new roller results in a significant increase in the flexibility of the sheet.

Claim 1 of the patent reads 'A roller for use on a metal sheet, the roller having an outer face having a plurality of pyramidal teeth extending outwardly from the outer face.'

The client has provided you with a plurality of rollers manufactured in the UK by competitors and would like to know if manufacture of any of these rollers is an infringement of the patent:

i) **A roller having a plurality of domes on its outer face.** **1.5 marks**

ii) **A roller having a plurality of cubic teeth on its outer face.** **1.5 marks**

iii) **A roller having a plurality of generally pyramidal teeth on its outer face. The top of each tooth is domed.** **4 marks**

Justify your answers. You may wish to employ the Improver questions where appropriate.

d) Your client's patent also includes a claim to a method of manufacture of a metal sheet by use of such a roller. Your client has identified a UK distributor of a metal sheet having a plurality of pyramidal indentations in a face. The sheet is manufactured abroad. Does the distributor infringe your client's patent? **4 marks**

Total: 20 marks

Cont...

FC1 (P1) – UK Patent Law
Mark Scheme 2015

Answer

- a) Some mention of the fact that language should be given a ‘purposive’ and not necessarily literal construction. **1 mark**
- b)
- i. Does the variant have a material effect upon the way the invention works? **1 mark**
 - ii. Would this have been obvious at the date of publication of the patent to a reader skilled in the art **1 mark**
 - iii. Would the reader skilled in the art nevertheless have understood from the language of the claim that the patentee intended that strict compliance with the primary meaning was an essential requirement of the invention? **1 mark**
- c)
- i. No **0.5 marks**
Pyramidal cannot mean domed as this is the prior art **1 mark**
 - ii. No **0.5 marks**
Pyramidal does not mean cubic **1 mark**
 - iii. Some mention of the fact that further information is required **1 mark**
For asking if the roller works in the same way? **1 mark**
Some discussion of whether this would be obvious to one skilled in the art **1 mark**
Some discussion of whether the description has anything to say about such shapes? **1 mark**
- Cont...**

FC1 (P1) – UK Patent Law
Mark Scheme 2015

- d) For realising that further information is required 1 mark
- For asking if the product is manufactured by the claimed process or by a different process? 1 mark
- For some discussion of the meaning of 'directly' 1 mark
- Some mention of the fact that it does not matter that the method was performed abroad abroad, i.e. it is the act of importation in the UK that is the infringing act 1 mark
- Total: 20 marks**

Question 7

Your rather unscrupulous client Mr D Geezer visits you to ask for your opinion on various aspects of his business practice.

For each of the following, provide general advice limiting your advice to UK patent law only.

- a) **One of my employees invented something which is becoming commercially very valuable. The contract of employment states that anything invented by an employee is the property of my company and that employees have no financial claim on profits from any inventions they may invent. Can the employee obtain compensation? If so where would they need to apply and by when? What factors would be taken into account when determining if an award is to be made in the employee's favour?** 8 marks
- b) **Going forward I intend to just name myself as sole inventor for any invention made by any of my employees. My employees have agreed to this.** 3 marks
- c) **We often copy the products of our competitors. We intentionally do not check to see if they have patents because if we do not know about it we are not guilty.** 5 marks
- d) **For one product we are copying we are aware that our competitor has a published patent application covering it. We intend to keep on manufacturing until the patent is granted then stop so that we do not infringe the patent.** 4 marks
- Total: 20 marks**

Cont...

FC1 (P1) – UK Patent Law
Mark Scheme 2015

Answer

- a) The additional term in the contract of employment is probably of no value - a court is unlikely to consider the additional term to be binding. **1 mark**
- The employee must show the patent is of 'outstanding benefit' **1 mark**
- having regard to the size **1 mark**
- and nature **1 mark**
- of the employers undertaking. It must also be 'just' to make an award in the employees favour. **1 mark**
- Application must be made to the Comptroller or the Court. **1 mark**
- Must be made within the period from grant to one year after it has ceased to have effect. **1 mark**
- Some mention of 'the course of normal duties' or similar wording. **1 mark**
- b) Inventorship is a question of fact and not of agreement and cannot be assigned. **1 mark**
- An employee can seek to have the designation of inventorship corrected. **1 mark**
- Filing a statement of inventorship requires filing a statement as to how title is derived. It would be difficult for Mr Geezer to do this. **1 mark**
- c) Damages/account of profits are not awarded against a defendant who proves that at the date of infringement he was not aware **1 mark**
- and had no reasonable grounds for supposing **1 mark**
- that a patent existed. The burden of proof lies with the infringer **1 mark**
- and is a heavy one. **1 mark**
- Cannot rely on Section 62 if the copied product is marked as patented with the patent number. **1 mark**

Cont...

FC1 (P1) – UK Patent Law
Mark Scheme 2015

- d) Can recover damages committed between publication and grant. 1 mark
- The act must infringe the patent as granted and published. 1 mark
- If the patent is granted with claims of different scope the amount of damages awarded is reduced 1 mark
- where it was not reasonable to expect the patent would be granted covering the act of infringement 1 mark
- Total: 20 marks**

Question 8

Your client has this week acquired a portfolio of UK patents and applications from a third party, listed below.

Prepare notes for a meeting with the client on each of the patents and applications in the portfolio. The notes should summarise what steps you suggest taking in the near future and by when. For Document D3 you should also consider third party rights.

- a) UK patent D1 was filed on 31 August 2010 and was granted on 3 September 2015. To date no renewal fees have been paid. 3 marks
- b) UK patent application D2 was filed on 20 October 2014. The application does not claim priority. Only a description and drawings along with a form 1 naming the third party as applicant were filed. Your client has, however, made their own developments to the invention described in this first application which they also wish to cover. You only need to consider the documents that need to be filed up to publication. 5 marks
- c) UK patent D3 has been granted. Renewal fees fell due on 31 March 2014 and 31 March 2015 and have not been paid. 12 marks
- Total: 20 marks**

Cont...

FC1 (P1) – UK Patent Law
Mark Scheme 2015

Answer

- a) Both 5th and 6th year renewal fees **2 marks**
are due by end of the month three months from grant i.e. 31 December 2015.
- b) File a new application claiming priority from the first **1 mark**
covering the new embodiment **0.5 marks**
by 20 October 2015 **0.5 marks**
File claims **0.5 marks**
and abstract **0.5 marks**
filing fee **0.5 marks**
and search fees **0.5 marks**
and form 1 **0.5 marks**
File form 7 by 20 Feb 2016 **0.5 marks**
naming the original inventor and new inventor **0.5 marks**
- c) For the first renewal six month grace period expired 30 September 2014 **0.5 marks**
For the second 30 Sept 2015 **0.5 marks**
Can apply for restoration up to 13 months from the end of the grace period **0.5 marks**
i.e. 31 October 2015 **0.5 marks**
Need to file evidence that the failure to pay was ‘unintentional’ **1 mark**
Your client can apply for restoration as they have acquired the patent after it has lapsed **0.5 marks**
but they will need evidence from the former proprietor relating to the circumstances surrounding the failure to pay the fee **0.5 marks**
- Cont...**

**FC1 (P1) – UK Patent Law
Mark Scheme 2015**

- As to third parties - in the period between it no longer being possible to pay the renewal fee
1 mark
- and publication of the application for restoration
1 mark
- a person who began in good faith
1 mark
- to do an act which would have constituted an infringement or in good faith made effective and serious preparation
1 mark
- to do such an act has the right to continue to do the act
1 mark
- The right does not extend to granting licenses
1 mark
- The right extends to any partners of the third party for the time being in the business
1 mark
- The third party may assign the right (or transmit it on death) to any person who acquires that part of the business in the course of which the act was done or preparations made
1 mark

Total: 20 marks

Question 9

- a) Inspection of the register of the UK Intellectual Property Office shows that a patent has been marked 'licences available as of right'. What does this mean?
2 marks
- b) What is the procedure for and effect of endorsing a patent as 'licence of right'?
11 marks
- c) Can the holder of a licence of right bring proceedings for patent infringement? What is the position and liability of the licensor in such proceedings?
4 marks
- d) What is the difference between a sole licence and an exclusive licence? Why is this important in infringement proceedings?
3 marks

Total: 20 marks

Cont...

FC1 (P1) – UK Patent Law
Mark Scheme 2015

Answer

- a) That any person **0.5 marks**
 shall be entitled as of right to a licence under a patent on such terms as may be
 settled by agreement **0.5 marks**
 or, in default of an agreement, by the Comptroller **0.5 marks**
 on the application of either party **0.5 marks**
- b) An application for entry is made to the Comptroller **1 mark**
 The Comptroller notifies any licensee or other person shown in the register as having
 an interest in or under the patent **1 mark**
 If the Comptroller is satisfied that the proprietor is not precluded by contract from
 granting licences **1 mark**
 a notice is published in the patents journal **1 mark**
 The Comptroller may on application by the holder of a licence granted under the
 patent before the entry was made **1 mark**
 order the licence to be exchanged for a licence of right on terms so settled **1 mark**
 If in proceedings for infringement of the patent the defendant undertakes to take a
 licence **1 mark**
 no injunction shall be granted **1 mark**
 and damages shall not exceed double the amount which would have been payable if
 such a licence on those terms had been granted before the earliest infringement **1 mark**
 Such an undertaking can be given at any point before final order without admission of
 liability **1 mark**
 Renewal fees are halved **1 mark**
- c) If the proprietor refuses **0.5 marks**
 or neglects to bring proceedings within two months of being asked by the licensee **0.5 marks**
 the licensee may institute proceedings for infringement in his own name **0.5 marks**

Cont...

**FC1 (P1) – UK Patent Law
Mark Scheme 2015**

- making the proprietor a defendant **0.5 marks**
- A proprietor so added as defendant shall not be liable for costs or expenses **1 mark**
- unless he enters an appearance and takes part in the proceedings **1 mark**
- d) An exclusive licence excludes the patent proprietor whereas a sole licence does not **1 mark**
- An exclusive licensee can bring proceedings for patent infringement whereas a sole license may not **1 mark**
- depending on the terms of the license **1 mark**
- Total: 20 marks**