

**P1: Basic United Kingdom Patent Law and Procedure
Mark Scheme 2014**

**Part A
Question 1**

In this question assume that the only relevant prior art is the prior art referred to in the question.

- a) Client A demonstrated their invention at an exhibition. The invention is a black box having input and output ports. Whilst the public could see what the box does, it was not possible to determine how this was achieved. Can the client still obtain a GB patent for the invention?

3 marks

- b) Client B writes 'we recently showed our invention to a customer. The customer is now making and selling the invention. Can we still obtain a GB patent for the invention?'

Advise Client B.

3 marks

- c) Client C writes 'We recently filed a GB patent application for two embodiments of our invention. The day after filing, a GB application in the name of our competitor was published. This discloses the first of our embodiments but not the second. Can we still obtain a GB patent?'

Advise Client C.

4 marks

Total: 10 marks

Answer

- a)
- i. Not a public disclosure of how the device works **1 mark**
 - ii. Can still patent the way in which the box achieves the function **(0.5 marks)** if inventive over what the box does **(0.5 marks)** **1 mark**
 - iii. International exhibition **(0.5 marks)** in the last six months **(0.5 marks)** **1 mark**
- b)
- i. If the disclosure was not in confidence then no. **1 mark**
 - ii. If in breach of confidence then yes **(1 mark)**, six month grace period **(1 mark)** **2 marks**

- c)
- i. For the first embodiment no – earlier application is a novelty destroying disclosure **(1 mark)** provided the first embodiment is in both the earlier application as filed and published **(1 mark)**

2 marks
 - ii. For the second embodiment yes. A claim to the second embodiment is novel over the earlier application **(1 mark)**. The earlier application cannot be cited for inventive step **(1 mark)**

2 marks
- Total: 10 marks**

Question 2

- a) Methods of treatment or diagnosis are not patentable. Summarise the provisions of the UK Patents Act 1977 relating to such methods.

6 marks
 - b) Your client has invented a method of immunisation (i.e. one which prevents rather than cures a disease). Is the method excluded from patentability?

1 mark
 - c) Your client has invented a method of diagnosis of a human disease in which a patient's blood is tested in a test tube. Is the method excluded from patentability?

1 mark
 - d) Your client claims to have invented a perpetual motion machine. List two grounds on which UKIPO is likely to object to an application for the invention.

2 marks
- Total: 10 marks**

Answer

- a)
 - i. Methods of treatment on the human **(0.5 marks)** or animal **(0.5 marks)** body by surgery **(0.5 marks)** or therapy **(0.5 marks)**

2 marks
 - ii. Methods of diagnosis on the human **(0.5 marks)** or animal **(0.5 marks)** body

1 mark
 - iii. Does not apply to a substance or composition for use in the method

1 mark
 - iv. section 4A(3)

1 mark
 - v. section 4A(4)

1 mark
- b)
 - i. Yes. Therapy is to be given a broad interpretation relating to treatment of a disease, rather than a narrow interpretation of 'curative medical treatment'

1 mark

- c) ii. No. Inventions carried on extra-corporeally do not involve treatment carried out 'on the human or animal body' **1 mark**
- d) i. not capable of industrial application (section 3) **1 mark**
- ii. insufficient description (section 14(3)) or claims not supported by the description (section 14(5)) **1 mark**
- Total: 10 marks**

Question 3

- a) A first GB patent application is filed on 1 October 2013. A second GB application is filed on 1 October 2014 without claiming priority from the first. Is it still possible to add a priority claim to the second application to claim priority from the first? If so, what is the time limit for doing so and what extensions of time are available? Outline the procedure. **4 marks**
- b) A first GB application is filed on 1 October 2013. A second GB application is filed on 5 October 2014. Is it still possible to add a priority claim to the second application to claim priority from the first? If so what is the time limit for doing so and what extensions of time are available? Outline the procedure. **6 marks**
- Total: 10 marks**

Answer

- a) i. Yes **(0.5 marks)**, as of right **(1 mark)** **1.5 marks**
- ii. Time limit is 16 months from 1 October 2013 **1 mark** which is 1 February 2015 **(0.5 marks)**. **1.5 marks**
- iii. No extension is possible **1 mark**
- b) i. Yes **1 mark**
- ii. Time limit is two months from 1 October 2014 **(0.5 marks)** which is 1 December 2014. **(0.5 marks)** **1 mark**
- iii. No extension possible **1 mark**

- iv. File form **(1 mark)**, with fee **(1 mark)** and evidence that omission to file within the normal period was 'unintentional' **(1 mark)**

3 marks

Total: 10 marks

Question 4

Under the UK Patents Act 1977, what acts constitute infringement of a patent for a process?

10 marks

Total: 10 marks

Answer

- i. Uses the process **1 mark**
- ii. Offers it for use **1 mark**
- iii. In the United Kingdom **1 mark**
- iv. When he knows **0.5 marks**
- v. Or is obvious to a reasonable person in the circumstances **0.5 marks**
- vi. That use without the consent of the proprietor would be an infringement **1 mark**
- vii. Disposes of **0.5 marks**
- viii. Offers to dispose of **0.5 marks**
- ix. Uses **1 mark**
- x. Imports **1 mark**
- xi. Any product obtained directly by means of the process **1 mark**
- xii. Or keeps any such product for disposal or otherwise **1 mark**

Total: 10 marks

Question 5

- a) What is the time limit for filing a statement of inventorship in respect of a GB patent application? What extensions of time are available? **3 marks**
- b) What is the time limit for filing a statement of inventorship in respect of a GB divisional patent application? **3 marks**
- c) An inventor informs you that he does not wish to have his name and address (or at the very least his address) published. How would you proceed and by what time limit? **3 marks**
- d) What is the consequence of failure to file a statement of inventorship in respect of a GB patent application? **1 mark**
- Total: 10 marks**

Answer

- a)
- i. 16 month from priority (**1 mark**). May be extended as of right (**0.5 marks**) by two months (**0.5 marks**) and for a further two months (**0.5 marks**) at the discretion of the Comptroller (**0.5 marks**) **3 marks**
- b)
- ii. Two months from the date of filing the divisional application (**1 mark**) or 16 months from priority if this is longer (**1 mark**). Due on entry if filed within six months of the r30 compliance date (**1 mark**) **3 marks**
- c)
- iii. For address only a simple request in writing is sufficient **1 mark**
 - iv. For name and address supporting reasons must be filed **1 mark**
 - v. Request must be filed before preparations for publication are complete **1 mark**
- d)
- i. Application considered to be withdrawn **1 mark**
- Total: 10 marks**

Park B
Question 6

Provide notes on opinions by UKIPO. Your notes should cover the following.

- | | |
|---|----------------|
| a) On what issues UKIPO will issue an opinion. | 3 marks |
| b) On what grounds UKIPO may refuse to issue an opinion. | 3 marks |
| c) Who may file the request for an opinion. | 1 mark |
| d) The procedure followed through to issue of the opinion (including actions that can be taken by third parties). | 7 marks |
| e) Review and appeal. | 6 marks |
| Total: 20 marks | |

Answer

What issues

- i. Whether an act constitutes (or would constitute an infringement) **1 mark**
- ii. Validity (**1 mark**) but only on grounds of novelty or inventive step (**1 mark**) **2 marks**

What grounds

- iii. The Comptroller considers it would be inappropriate to do so **1 mark**
- iv. In prescribed circumstances – the request is frivolous (**0.5 marks**) or vexatious (**0.5 marks**); the question has been sufficiently answered in other proceedings (**0.5 marks**); or, the requester has given notice that the request is withdrawn (**0.5 marks**) **2 marks**

Who may file

- v. Anyone **1 mark**

The procedure

- vi. Request filed on form 17 (**0.5 marks**); with fee (**0.5 marks**); with statement setting out the question, the requesters submission and any matters of fact asked to be taken into account (**0.5 marks**); details of whom the requestor is aware as having an interest in the question (**0.5 marks**); details of any proceedings or relevance to the patent (**0.5 marks**); **2.5 marks**
- vii. Request advertised; **1 mark**
- viii. Request notified to patent proprietor and any registered licensee or sub-licensee any anyone who has filed a caveat; **1 mark**
- ix. Any party may file observations within four weeks of publication of the request. **1 mark**

x. Observations in reply may be filed within four weeks of the end of the period for filing observations;

1 mark

xi. Decision sent to requester, the proprietor and any party who filed observations. Notice of issue of decision published.

1 mark

Review and appeal

xii. Only the proprietor or exclusive licensee may apply for review

1 mark

xiii. Must be made within three months beginning on the date the opinion was issued

1 mark

xiv. Only if it was 'wrongly concluded' that the patent was invalid **(1 mark)** or an act does not constitute an act of infringement **(1 mark)**

2 marks

xv. Appeal to the Patents Court **(1 mark)** but only on restricted grounds. **(1 mark)**

2 marks

Total 20 marks

Question 7

Your client has recently acquired a portfolio of GB patents and applications from a third party. None of the patents or applications has a priority date. Write notes on the actions that need to be taken for each of these.

a) Patent D1 was filed on 31 January 2010 and granted on 30 September 2014. Inspection of the register shows that no renewal fees have been paid.

3 marks

b) Application D2 was published on 28 March 2014. Inspection of the register shows that no request for examination was filed.

5 marks

c) For application D3 an examination report was issued on 30 May 2014 setting a four month time limit for response. No response was filed.

2 marks

d) Application D4 was filed on 1 January 2008. An examination report was issued on 17 February 2014 raising a non-unity of invention objection and setting a three month time limit for filing a response. A response was filed on time restricting the claim set to one of the two inventions only. No reply has been received from UKIPO to date.

6 marks

e) Application D5 was filed on 1 September 2013. A request for search has been filed and the filing and search fees paid. This application is of particular interest to the client as they are aware that many of their competitors are starting to develop products in this field in the UK.

2 marks

There are a further 2 marks available for general points.

2 marks

Total: 20 marks

Answer

- a) First renewal fee due 31 Jan 2014 **(1 mark)** but moved to 31 December 2014 **(1 mark)**.
Next renewal fee due 31 Jan 2015 **(1 mark)**

3 marks

- b) Time limit for requesting examination was 28 September 2014 and has been missed **(1 mark)**. Request an extension as of right by filing form 52 **(1 mark)** and paying fee **(1 mark)**, file request for examination on form 10 **(1 mark)** any pay the examination fee **(1 mark)**.

5 marks

- c) File a response before 30 November 2014 **(1 mark)** and request an extension of time when filing the response **(1 mark)**

2 marks

- d) Compliance date later of 4 years and six months from priority **(0.5 marks)** or 12 months from issue of first examination report **(0.5 marks)**. Compliance date 17 February 2015 **(0.5 marks)**. As this is imminent contact the examiner to determine if there are issues outstanding **(1 mark)**.

2.5 marks

The divisional time limit is three months before the compliance date **(1 mark)** ie 17 November 2014 **(0.5 marks)**. File a divisional application to the second invention before expiry of the divisional time limit **(1 mark)**. Contact the examiner to ensure the application is not granted until the divisional application is filed **(1 mark)**.

3.5 marks

- e)
- File statement of inventorship
 - Request early publication

1 mark

1 mark

Also record assignment **(1 mark)** and change of address for service **(1 mark)**

2 marks

Total: 20 marks

Question 8

- a) Your client writes 'We hold a licence to a GB patent but never recorded it. As we understand it we are the only company that holds a licence to the patent. Can we sue a third party for patent infringement and to what extent does the patent proprietor need to be involved?'

Advise your client.

10 marks

- b) Your client writes 'We have been selling our patented product for many years. The patent has however come to the end of its 20 year life. We have asked our suppliers to make sure that any new product they supply to us is no longer marked as patented but we are still running down our old stock fulfilling pre-existing orders placed when the patent was still in force. One of our competitors has now requested that we cease providing product marked as patented. This would mean we have to scrap all our existing stock. This would significantly damage our business. What should we do?'

Advise your client.

4 marks

- c) What are the remedies for a groundless threat of infringement and what acts are specifically identified as not being threats?

6 marks

Total: 20 marks

Answer

- a) Check it is an exclusive licence **(1 mark)**. If it is not then no automatic right to bring proceedings **(1 mark)**.

Record the licence immediately. **(1 mark)** Effect of non-registration - no award of damages **(0.5 marks)** or account of profits **(0.5 marks)** in respect of infringement before the date of registration. **(1 mark)** Total loss of rights by lack of timely registration of licence in the event of registration of a conflicting transaction. **(1 mark)** Six month time limit for recording the licence. **(1 mark)**

Patent proprietor should be made party to the proceedings **(1 mark)** but shall not as a defendant be liable for costs or expenses **(1 mark)** unless he makes an appearance and takes part in the proceedings. **(1 mark)**

10 marks

- b) Penalty under section 110 is a fine only. **(1 mark)** In particular a court would not order the steps requested by the competitor **(1 mark)**

Penalty does not apply in a period which is 'reasonably sufficient' **(1 mark)** to enable the accused to take steps to ensure the representation does not continue to be made **(1 mark)**

4 marks

c)

- A declaration to the effect that the threats are unjustifiable **1 mark**
- An injunction against continuation of the threats **1 mark**
- Damages in respect of any loss which the plaintiff has sustained by the threats. **1 mark**
- Providing factual information about a patent **1 mark**
- Making enquires of the other person for the sole purpose of discovering whether or by whom the patent has been infringed **1 mark**
- Makes an assertion about the patent for the purposes of any enquiry so made **1 mark**

Total: 20 marks

Question 9

Provide notes on two leading cases of the British Courts. For each case your notes should cover the parties to the case, a summary of the facts of the case, a summary of the decision and a brief discussion of what precedent is set by the case. One case should have claim construction as a main issue. The other should have novelty or inventiveness as a main issue.

Total: 20 marks

Answer

- Parties to the case **1 mark**
- Summary of the facts **2 marks**
- Summary of the decision **2 marks**
- Discussion of precedent **5 marks**

Total: 20 marks