

P1 Examiner's Comments 2013

General Comments

Overall, the standard of answers this year was high with most candidates comfortably reaching the required pass mark. On the whole, candidates demonstrated a good knowledge of the core subject matter areas of the syllabus, although as with last year, candidates struggled to answer questions directed to less common areas of the syllabus.

The examiner would be grateful if candidates could remember to write their answers in black ink. Candidates' scripts are photocopied and the photocopies provided to the examiner for marking. If candidates use light blue ink, the resulting photocopied scripts can be difficult to mark.

There was a significant improvement in exam technique this year. On the whole candidates' answers were directly related to the question being asked. Some candidates unnecessarily lost marks on the long questions due to the poor structure of their answers. Typically a long question will require a candidate to address a number of points. Candidates would do well to spend a few minutes making sure they have identified all of the points that need to be addressed and then breaking the answer down into a number of separate parts, each part addressing one point.

Section A

Question 1

This question asked what are not inventions for the purposes of the Act. This was a simple test of rote learning of Section 1(2) of the Act. Almost every candidate answered this question and answered it well.

Question 2

This question asked about foreign filing restrictions which are set out in Section 23 of the Act. Again, on the whole this question was answered well.

Many candidates appeared to be confused about whom these restrictions apply to. Foreign filing restrictions apply to any person resident in the UK, regardless of their nationality. The restrictions only apply to applications which contain information relating to military technology, information which is prejudicial to national security or prejudicial to the safety of the public.

Satisfying the foreign filing restrictions is relatively straightforward. One can either obtain a foreign filing permit from the Patent Office or file first at the UK Patent Office and then wait six weeks before filing abroad. Full marks were awarded for noting that first filing must be at the UK patent office but it is noted that any type of application can be filed at the UKIPO, a UK national application, a PCT application or an EP application as set out in <http://www.ipo.gov.uk/practice-sec-023.pdf>.

Question 3

This question related to the procedure to be followed when filing a GB application which claims priority from a foreign application which is not in English. This procedure is set out in Rules 6, 8 and 9 of the Patent Rules 2007.

The main stumbling block for candidates appeared to be the extensions of time available for filing a copy of the priority application at the UK Patent Office. These are governed by Rule 108(2) and (3) together with Schedule IV – part 2. A two month extension of time beyond the normal sixteen months is available as of right provided that it is requested before the end of the extension period, the Form 52 filed and fee paid (Rule 108(2)). A further discretionary extension is available on filing the relevant form and paying the fee, although this supporting evidence must also be provided (Rule 108(3)).

A number of candidates failed to appreciate that a translation of the priority document is only required if specifically requested by the UK Patent Office.

Question 4

This question related to post grant amendment. Surprisingly few candidates answered this question, although those that did answered it well.

Requesting post grant amendment is relatively straightforward and is set out in section 27 and associated rules (in particular rule 35). Importantly the amendment takes effect from the date of grant.

Question 5

This question related to the correction of errors in patents and applications and caused candidates a surprising number of problems. As set out in the question, Section 117 of the Act is the relevant legal basis. Dealing with each part of the question in turn –

- (i) not all errors can be corrected. Only errors of translation, transcription, clerical errors and mistakes can be corrected.
- (ii) errors can be corrected in any specification of a patent or application. They can also be corrected in any document filed in connection with a patent or application.
- (iii) any person can apply to correct an error, not only the applicant
- (iv) many candidates were unclear as to the difference between correcting an error in an applicants name, recording a change in applicants name and in some cases recording an assignment to a new applicant. The procedure for correcting an error is set out in rule 49.

SECTION B

Question 6

This question was not popular with candidates. Whilst the question was straightforward it required a detailed knowledge of the steps required to enter a PCT application into the GB national phase. Many candidates appeared to know in general terms what is required but often the detail was lacking.

It was still possible to enter the application into the GB national phase until 12 October. As this was a Saturday this deadline is extended to Monday 14 October.

To enter the application into the GB national phase the following steps are required –

By 31 months from priority -

- File an English language translation of the application as published and amendments if annexed to the IPER.
- Payment of a national fee

By 33 months from priority –

- File a request for examination and pay the associated fee

Within two months of the national phase beginning (effectively 33 months from priority)

- File a request for search and pay the associated fee; and
- File a statement of inventorship if not named on the PCT application

The examination was held on Friday 11 October. Accordingly, although we are still within the 31 month period for entering the UK national phase, a problem to be faced is that there are no English language translations available. However, the deadline for filing the required translations can be extended as of right by two months on payment of a fee. A further discretionary extension is available on payment of a fee. Supporting reasons must also be provided. Whilst most candidates did appreciate that an extension was available the detail was lacking.

The question asked candidates what further beneficial steps could be taken in light of the potential infringer. The main points the examiners were looking for here are that one should notify the potential infringer of the application and also request re-publication of the application in English to obtain provisional protection. It may also be beneficial to request expedited prosecution and also to address any outstanding objections to accelerate prosecution. Most candidates were aware of the need to put the potential infringer on notice although re-publication was often overlooked. As an alternative to waiting for republication, it is also possible to serve an English translation of the specification on the infringer.

As to further documents, the main documents which may be required are the priority document (if not filed in the international phase) and a translation of the priority document if requested.

Question 7

The first part of this question related to an inventor who intended to give a talk on his invention the next day and wished to protect his invention by filing a first patent application before the talk containing only the slides and a further application after the talk with claims. Few candidates suggested asking the client if the talk was public or confidential. This is an important consideration.

Other points the examiners were looking for were (i) an appreciation that one can file an application without claims although this is undesirable, and (ii) if possible one should draft and file the full application now before the talk.

The second part related to licences of right which are set out in Section 46 of the Act. Almost all candidates appreciated that a licence of right reduces the renewal fees by 50% and entitles a licensee to a licence on terms agreed by the parties or by the Comptroller. Fewer candidates mentioned that existing licences can be exchanged for new ones, the potential limit on the grant of an injunction or damages or that a licensee can institute proceedings if the proprietor refuses to do so.

The third part caused candidates some difficulty with many candidates being unable to provide the client with clear advice as to how best to proceed. The main point the examiners were looking for was an appreciation by the candidate that as set out in Section 7 of the Act any party can file a patent application but only the party entitled to the invention can be granted the patent. It is therefore possible for the client company to file the application. However before grant rights to the invention will need to be assigned from the company next door to the client company. Preferably this should be done before the application is filed.

The final part of the question related to the consequences of joint ownership of a patent. This arises quite often and is something with which candidates should be very familiar. The points the examiners were looking for are set out in sections 36 and 66 of the Patents Act. All candidates set out the consequences for the patent proprietors. A significant number of candidates however did not address the consequences for suppliers and customers and so lost marks unnecessarily.

Question 8

This question was popular with candidates but on the whole was not answered well. Part (d) in particular caused candidates considerable problems.

The deadline for applying for restoration is 19 months from the renewal fee deadline and so in this case was 31 December 2013. The procedure for restoration is set out in rule 40. The main point is that the filed evidence must show that failure to pay the fee was unintentional.

Most candidates appreciated that the clients had a good defence to infringement under Section 28A of the Act. The main points here were (i) that the client's acts were performed after the deadline for

late payment of the renewal fee but before an application for restoration had been published (ii) the acts were performed in good faith and had constituted serious and effective preparations. Further marks were available for mentioning that the client only had the right to continue with 'the act' but not to licence third parties to do so and also a discussion of the meaning of 'the act'.

The best course of action for the client is simply to do nothing and wait for the restoration period to expire. A number of candidates suggesting contacting the proprietor of the lapsed patent. However, this was generally considered to be bad advice unless the candidates explained that there was some benefit in keeping the patent alive such as taking an exclusive licence.

Turning now to part (d), candidates were asked to consider whether manufacture of a number of embodiments of a hip joint infringed a patent having a claim to a hip joint with a teardrop shaped head. The client's embodiments had spherical, cubic and elliptical heads respectively.

In order to answer this part, candidates were required to have basic knowledge of the principles of claim interpretation, in particular Kirin-Amgen and also Catnic. Almost all candidates were able to recite the principles of interpretation. However, very few candidates were then able to apply them to the question. Many candidates appeared to be confused as to the difference between patentability and infringement. Answers such as 'the elliptical embodiment is not patentable over the tear drop shaped embodiment and so is an infringement of the patent to the tear drop shaped embodiment' were common. This is not the test.

The question comes down to interpretation of the term 'tear drop shaped' in the patent claim. Would a court interpret this sufficiently broadly to cover spherical, elliptical or cubic heads (in which case there is infringement) or more narrowly than this? The Catnic principle is a guide as to how to interpret terms in a claim.

For the spherical embodiment, this was not an infringement. The patent states that tear drop shaped heads are an improvement over spherical heads. The patentee clearly did not intend the term 'tear drop shaped' to be understood to cover spherical heads.

For the cubic head, this was most unlikely to be an infringement of the patent. The term 'tear drop shaped' could not reasonably and fairly be interpreted to cover cubic embodiments.

For the elliptical head the position is unclear. Candidates were expected to realise that further input would be required from the client as to whether this embodiment worked in the same way as an

embodiment with a tear drop shaped head, and whether this would have been obvious to one skilled in the art.

Question 9

The first part of question 9 asked for a list of grounds of revocation of a granted patent. This is a simple test of rote learning and was answered well by almost all candidates. The grounds are set out in section 72.

As to who can apply to revoke, any person may apply except on the grounds of entitlement where only the entitled person can apply.

The second part of the question asked candidates to comment generally on the provisions of the UK Patent Act relating to withdrawal of an application and surrender of a patent. A large number of points could have been mentioned by candidates and any relevant point would have gained marks. Examples of points the examiners were looking for included:

Withdrawal (From Sections 14, 117 and 5 of the Act)–

- An applicant may withdraw an application at any time up to grant
- If there are joint applicants withdrawal requires the consent of all applicants
- There is no possibility of restoration of a withdrawn application unless the application was withdrawn in error
- Withdrawal takes effect from the date the application for withdrawal is received by the Patent Office, and not the date it is actioned
- One can withdraw an application leaving no rights outstanding to re-set the priority date

Surrender (Section 29 of the Act) –

- A patent proprietor may at any time give notice to the Comptroller of an offer to surrender the patent
- Any person can oppose surrender
- If the Comptroller is satisfied that the patent may be surrendered the patent ceases to have effect from the date that acceptance is advertised
- One cannot surrender a patent whilst any proceedings such as infringement/validity proceedings are live (Rule 42).