

**Question 1**

- a) Anyone can apply **1✓** for the grant of a patent for an invention either alone **✓0.5** or jointly **✓0.5** with another or others.

The applicant may be an individual, or a body with a legal status formed under law, such as a company.

- b) The patent may be granted

- i) in first instance to the inventor of **1✓** the invention for which a patent is sought
- ii) to a successor in title of the inventor, who has obtained a right **✓0.5** to a patent to the invention through transmission, such as on death, or an assignment **0.5✓** assigning the rights to the invention, or patent application

- iii) to the person (or body corporate) who due to a law **0.5✓** or rule is entitled to the invention

This can include the employer. If invention created by employee, in line of their duties, then employer is proprietor of the invention

- c) The applicant must file at the Office a statement indicating who they believe & understand the inventors to be. The statement must be filed in good faith

- d) The statement of inventorship must be filed within 16m of filing. **1✓**

Ext of 2m as of right. **1✓**

**MARKS AWARDED 5.5/10**

**Question 2**

- a) It must be in writing **0.5✓** stating the assignor & assignee & details of assignment, & it must be signed by the assignor. **0.5✓**

- b) To record an assignment at the UKIPO

- a form must be completed and filed **0.5✓**
- evidence of the instrument of transfer, **0.5✓** such as a copy of the assignment need to be filed
- a fee needs to be paid **0.5✓** (as it is a change in legal title.)

Examiner's  
use only

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If the UKIPO is satisfied with the application for recordal of the assignment, they shall register the assignment, record it on the register & notify the applicant of the change.

- c) If an assignment has not been recorded within 6 months of execution, then, in infringement proceedings<sup>1✓</sup>, the applicant (proprietor of the patent or patent application) will not be awarded costs<sup>0.5✓</sup> or expenses. <sup>0.5✓</sup>

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- d) A co-owner of a patent may not make an application to amend<sup>0.5✓</sup> or withdraw<sup>0.5✓</sup> or revoke the patent without the consent of the other co-owners

A co-owner of a patent may not grant a license<sup>0.5✓</sup> under or a mortgage<sup>0.5✓</sup> over a patent without the consent of the other co-owners

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**MARKS AWARDED 6.5/10**

### Question 3

- a) Before the comptroller will consider an application for a declaration of non-infringement the applicant must show that
- they contacted the proprietor<sup>0.5✓</sup> of the patent requesting a declaration of non-infringement<sup>0.5✓</sup> and providing him with all the relevant details<sup>0.5✓</sup> of the act for which they wish a declaration of non-infringement to cover.
  - the proprietor must have not responded<sup>0.5✓</sup> or refused<sup>0.5✓</sup> to provide a declaration.

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- b) It is a statement indicating that the described<sup>1✓</sup> act of the holder of the declaration does not infringe the patent.

It can be used by the holder if proceedings for infringement are brought against him by the<sup>1✓</sup> owner of the patent.

It does not provide him with a right to do the act if it infringes the patent.

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If proceedings are brought against the holder of the patent, and the decision is in favour of the holder of the patent, then they will not be liable for their costs as between solicitor & client.

- c) No it is not different. The Comptroller has the same<sup>1✓</sup> authority with regards to infringement proceedings

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- d) – if they wish to begin doing an act and are concerned about infringement proceedings being brought against them then it will provide<sup>1✓</sup> some protection

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- if they wish to file their own application for a patent

**MARKS AWARDED 6.5/10**

#### Question 4

- a) Catnic Components v Hill & Smith Ltd.
- b) Catnic had a patent to cover a steel lintel. The steel lintel is for providing structural support above doors and windows. The invention comprised of a part that extended “vertically” from the lintel so as to attach to the structure.

Hill & Smith Ltd developed & were selling a steel lintel, that only differed in that the part did not extend “vertically” but at an angle of about 6 degrees. This had no technical effect on how the lintel operated.

Catnic brought proceedings for infringement.

- c) It was held that the skilled person reading the patent would understand that vertically meant substantially vertical rather than literally vertical. Therefore, extending at an angle of about 6 degrees did not fall outside the scope of the patent.

Therefore, Hill & Smith were found to be infringing the patent.

- d) The precedent set by the case is that claims should be given a purposive construction rather than a literal one.

What would the skilled reader have understood the patent to mean?

This case has been used & elaborated on in subsequent cases such as Improver v Remington. Current case law applies a purposeful construction to the claims.

**MARKS AWARDED 5/10**

#### Question 6

- a) The approach for assessing obviousness is that given in the Pozzoli v BDMO case, which reformulated the Windsurfing approach.

1a) First, identify the person skilled in the art. 1✓

- who is this person, what is their technical area, they are generally a worker, who will not invent items, but is not afraid to make trial and error.

1b) Attribute to the skilled person, the common general 1✓ knowledge.

- this includes knowledge of the state of the art identified at the time of filing the application for a patent.

2) Identify the inventive concept<sup>1✓</sup> of the claim. <sup>1✓</sup>

- it may be necessary to construe claim first. <sup>1✓</sup>

As stated in Pozzoli v BDMO, need to strip away all unnecessary verbiage of the claim, & identify what are the features that contribute to the inventive concept.

3) Identify the differences between the features that give rise to the<sup>1✓</sup> inventive concept of claim and the state of the art. <sup>1✓</sup>

- What are the features that have not been disclosed?

4) Is it obvious?

- Would it have been obvious<sup>1✓</sup> to the skilled person at the time of the application, with reference to the state of the art & taking into account their general knowledge, to include the features.

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b) i) An amendment cannot be made that adds matter to the application as originally filed. <sup>1✓</sup>

An amendment cannot be made to a claim which is not supported by the description.

Amending the application to cover the two-finger embodiment would not be allowable as it would be adding matter.

Therefore, it is not possible to amend the application to cover the two-finger embodiment.

Instead, can file a new application that covers both the two-finger and three-finger embodiments<sup>0.5✓</sup>. Can claim priority from the application filed on 30<sup>0.5✓</sup> January<sup>0.5✓</sup> 2017 in respect of the subject matter for the three-finger embodiment. Then, can leave the original application lapse, & proceed with the second application only.

b) ii) Document A filed in 1957

- it is prior art for inventive step and novelty. <sup>1✓</sup>

Document B filed on 20 Dec 2016

- it has not been published before filing date of present application, therefore it is novelty only prior art. <sup>1✓</sup>

Notes on Doc A

- it only discloses a four-finger instrument
- in Doc A, it teaches that it is impossible to grip a bullet with fewer than four fingers
- teaches away from embodiments with<sup>1✓</sup> fewer than four fingers

- the skilled person would have understood the **1✓** four-fingers to be an essential component of the invention & would not have modified it to achieve the subject matter of the present application

#### Notes on Doc B

- different construction technical field, with a different scale cranes & pipes v surgery and bullets.
- does not disclose a surgical instrument
- discloses two fingers

#### Novelty

Doc B does not disclose **1✓** a three-finger surgical instrument **1✓**, so present app is novel over B.

Doc A does not disclose a three finger surgical instrument, so present application is novel over A

#### OBVIOUSNESS

- The person skilled in the art is a technician who fabricates surgical tools
- The common general knowledge of the person skilled in the art is a general awareness of surgical instruments & their purpose.
- The inventive concept of the claim is to reduce the number of fingers on a surgical instrument capable of removing bullets.
- The difference between the state of the art & the claim is that the claim discloses three fingers while the state of the art discloses four.
- Would it be obvious?

The use of only three fingers instead of four would not be obvious to a person skilled in the art. Doc A teaches away from using less than four fingers. On reading A, the skilled reader would understand that four fingers was an essential requirement for removing bullets. Therefore, they would not be motivated to modify the subject matter of A to have three fingers

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**MARKS AWARDED 15.5/20**

#### Question 8

- A patent is infringed if while the patent is in force in the UK and without the consent of the proprietor

where the patent is for a process **0.5✓** he uses **0.5✓** or offers for use the process in the UK when he knows, or has reason to believe, that's its use there would be an infringement

where the patent is for a process, he uses, imports<sup>0.5✓</sup>, exports, disposes of<sup>0.5✓</sup>, offers to dispose of<sup>0.5✓</sup> or stores for disposal a product which has been obtained directly as a<sup>1✓</sup> result of the process when he knows or has reason to believe that it is an act of infringement.

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b) A resident of the <sup>0.5✓</sup>UK is prohibited from making the first filing<sup>0.5✓</sup> for an invention abroad<sup>0.5✓</sup>, in cases where

- the subject matter relates to military technology<sup>0.5✓</sup> or other subject matter important for national security. <sup>0.5✓</sup>
- the subject matter relates to/is of importance to national safety. <sup>0.5✓</sup>

unless

- not less than 6 weeks<sup>0.5✓</sup> prior to the foreign filing the applicant has filed an application at the UKIPO and
- the applicant did not receive a communication detailing that the application was being placed under restrictions. <sup>0.5✓</sup>

Alternatively, may apply for a permit to file abroad from the UKIPO.

If another person (other than UK resident) has already filed the first application relating to the invention abroad, then a UK resident can file subsequent applications relating to the same invention abroad without restrictions (assuming<sup>0.5✓</sup> they are entitled<sup>0.5✓</sup> to do so.)

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- c) – At any time while a patent is pending<sup>0.5✓</sup>, any person may file third-party observations on the patent application to the office
- There is no fee
  - They may be made anonymously<sup>0.5✓</sup>
  - The third party observations may relate to inherent patentability of<sup>0.5✓</sup> the subject matter of the application, to novelty or inventive step.
  - The third party observations may bring prior art documents to the attention of the examiner.
  - The person filing the third party observations does not become party to the proceedings. <sup>0.5✓</sup>
  - The Comptroller enters the third party observations in the register. They will be taken account of during examination<sup>0.5✓</sup>
  - The Comptroller forwards the third party observations to the applicant<sup>0.5✓</sup>
  - The Applicant may, if they wish, provide & file a response to the third party observations

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**MARKS AWARDED 11.5/20**

### Question 9

- a) – Entry into GB national phase is 31 months **0.5✓** from priority.  
 – Therefore need to enter GB national phase by 13 Feb 2018.  
 – Can get a 2m extension to enter – form & fee. **0.5✓**  
 – On entry file – File request & indicate  
     – File PCT doc – or reference to  
     – File claim amendments  
     File translation of PCT doc on filing **0.5✓**  
 – File translation of amended claims on filing. **0.5✓** **2**
- b) • Request early publication. **1✓**  
 • Provide translations of documents  
 • File statement of inventor form **1.5**
- Request early publication & complete outstanding **0.5✓** items so that patent can be published early.
- The patent has rights from the date of its publication. These cannot be enforced until after the patent has granted & are
- c) The infringer is making selling the identical valve in the UK. Enforcing the rights of the granted patent will prevent them from exporting goods to Europe. **1✓** **1**
- d) i) “Double patenting” – **1✓** the EP application automatically designates the UK so a EP(GB) patent will be granted. However, the EP(GB) and GB patents are identical in scope, and so an objection to ‘double patenting’ having two patents for the same invention will be raised. **2**
- ii) Withdrawing the GB designation before grant. **1✓**
- e) i) – Surrendering does leave any rights  
     – The EP(GB) application filed granted later so has longer term  
 ii) should have withdrawn the EP(GB) instead. **0**
- f) i) GB granted EP(GBN) granted & surrendered in relation to surrender? to confirm the wish to surrender the EP(GB) patent  
     Invitation to reinstate the EP(GB) patent **0**
- ii) Unintentional.

**MARKS AWARDED 6.5/20**