

Examiner's
use only**Question 1**

- a) Anyone can apply for a patent including representative such as patent attorney or client themselves. **1✓** **1**
- b) The patent may be granted to the following people.
- i) inventor or inventors. **1✓**
- ii) If inventor with another entity or person **0.5✓**, has any agreement, assignment or under any rule of law **0.5✓** at the time of making the invention **0.5✓** then that person or entity are entitled to be granted the invention. **3.5**
- iii) successor in title of **1✓** the above two categories. inventor is the actual deviser of the invention and employer derives the right to employee's invention under (ii) condition.
- If the inventor dies or goes bankrupt then he can pass on the right to his successor.
- c) When applicant is not the inventor then he files a statement of inventorship which contains **1✓** a statement indicating how applicant derives the right to be granted the invention. **1**
- d) The statement of inventorship can be filed from 16 months from priority date. **1✓** Where there is no priority claimed 16 months from filing date. As of right 2 months **1✓** extension is available for filing statement of inventorship by filing form 52 + paying a fee. **2**

MARKS AWARDED 7.5/10**Question 2**

- a) The assignment document should contain the patent number any rights in or under the patent that are assigned. e.g. right to claim priority. The assignment document must be signed by both **0.5✓** parties for it to be valid. **0.5**
- b) An assignment must be recorded with the UKIPO within 6 months of the transaction or as soon as practicable after the 6 month period. **0**
- c) Recording the assignment puts third parties on notice. If the assignment is not recorded within 6 months of execution and if conflicting transaction is recorded then person who acquired the rights by assignment will lose all the rights **0.5✓** in respect of the patent

If infringement 1✓ occurred before recording the assignment 1✓ then the person who acquired the right through assignment would not be liable for rights or remedies available in respect of infringement. They cannot claim any damages or account of profits from potential infringer.

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d) Following rights are not exercisable by co-owner without consent of other co-owner.

- Amend the specification 0.5✓ or apply for any 0.5✓ amendment or apply for 0.5✓ revocation of the patent
- Grant a licence. 0.5✓
- Assignment under the patent 0.5✓
- Mortgage their share of patent. 0.5✓

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MARKS AWARDED 6/10

Question 4

a) Catnic Components Ltd vs Hill & Smith.

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b) Catnic had patent to lintel having a rear member extending vertically.

Hill & Smith had a lintel with a rear member 6° to 8° inclined to the vertical.

Catnic alleged Hill & Smith of infringement alleging that their lintel falls within the scope of their claim 1.

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c) The court found that Hill & Smith's lintel infringed Catnic's patent because the skilled person would understand that the patentee would not have intended a strict compliance with extending vertically to mean exactly 90°. Putting such a narrow limitation in the claim would render their monopoly worthless. Having the a rear member inclined at 6° to 8° vertically does not have any material effect on the load bearing capacity and this would be obvious to a person skilled in the art.

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d) Precedent set by the case.

The claims should be given purposive construction rather than purely literal meaning. The protection conferred by a patent can be obtained from claims However if there is an ambiguity then description and drawings can be referred to resolve the ambiguity.

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<p>A person skilled in the art and what he would have understood by patentee's wording in the claim are also important factors when construing the claims.</p> <p>The claims must be interpreted such that there is a fair protection for the patentee and reasonable degree of certainty for third parties.</p> <p style="text-align: right;">MARKS AWARDED 8/10</p>		3
Question 5		
a) A UK patent application can be withdrawn any time before grant of the application. 1✓		1
b) The effective date of the withdrawal is the date 1✓ on which the application is received by the UKIPO.		1
c) Either the applicant or their representative may withdraw the application. One of the co-owner may not withdraw the application 1✓ without 1✓ consent of other co-owners.		2
d) The request for withdrawal must be in writing to the UKIPO. Stating the application number and name of the applicant. If the withdrawal is to prevent publication then this should be received before the preparations for the publication are complete, and priority needs to be regenerated then have to specify at time of withdrawal that no rights are outstanding with 1✓ regards 1✓ to the application.		2
e) The patent may be surrendered any time after grant of the patent but not if any infringement or invalidity proceedings are pending 1✓ before the court or comptroller.		1
f) The effective date of surrender is date on which the application for surrender is made to the UKIPO. 0		0
g) After the surrender of the patent the patent proprietor will not be liable for rights or remedies if the patent is infringed 0 and they would not receive royalties in respect of the patent.		0
MARKS AWARDED 7/10		

Question 6

- a) Invention involves an inventive step if it is not obvious to person skilled the art in light of their common general knowledge at the time of the invention.

Windsurfer/Pozzoli test. obviousness assessment.

- 1) i) Identify the notional skilled person in the art. 1✓
 ii) Identify the common general knowledge of the skilled person. 1✓
- 2) Identify the inventive concept 1✓ of the invention from the claim if it is not readily available construe the claim 1✓.
- 3) Identify if there are any differences between the inventive concept 1✓ and prior art documents 1✓ which form part of the state of the art.
- 4) If there are any differences then would skilled person with their common general knowledge at the time of making the invention think that these differences are obvious 1✓ or is there any degree of ingenuity required to constitute 1✓ those differences.

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- b) i) Since the application as filed does not disclose 2 finger embodiment or any mention of it in the description it is not possible to amend the application covering 2 finger embodiment. 1✓ The client can withdraw the application and refile but this way the filing date of 3 Jan 2017 will be lost. which covers the 3 finger embodiment.

The client could file priority claiming 0.5✓ application 0.5✓ from an earlier application by 03 January 2018. i.e. Within 1 year priority period. and in this application include the 2 finger 0.5✓ embodiment.

- ii) Document A – This would not be a problem at all because it teaches away 1✓ from the invention. According to this document it is impossible to grip a bullet with less than 4 fingers. Whereas in the present invention can use either 2 or 3 fingers which is contrary to the suggestion of 'A'. 1✓

Document B – The document B is filed on 20 December 2016 and assuming that the application publishes at 18 months from this date. around 20 June 2018.

This document has not been published so will only need to be considered for assessment of novelty only under section 1✓ 2(3) UKPA. so as long as there is one feature in the claim which is different 'B' novelty won't be an issue either.

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MARKS AWARDED 14.5/20

Question 7

- a) A certified copy of the priority document must be submitted by 16 months from the priority date. 2 months **0.5✓** as of right extension **0.5✓** is available by filing form 52 **0.5✓** and paying a fee.

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- b) Renewal fees for a UK patent only fall due after the patent has granted. However, renewal fees are payable in respect of 5th year and fall due on 4th anniversary of the filing date. The renewal fees must be paid in respect of 5th year and any subsequent year after that until the expiry of the patent. The renewal fees due after 4 years of the filing date must be paid within 3 month of the grant of the patent. The renewal fees must be paid by end of the month in which anniversary falls. Renewal fees can be validly paid 3 months in advance of when they fall due.

The renewal fees can be paid in 6 month **0.5✓** grace period by paying additional fees **0.5✓** this is available of as of right **0.5✓** but late payment fee also have to be paid.

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- c) Responding to an examination report.

2 months **0.5✓** as of right **0.5✓** extension is available by requesting the extension in writing. **0.5✓**

Further 1 month extension is available but this would be at the discretion **0.5✓** of the Examiner.

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- d) Filing a divisional application.

The deadline to file divisional application is 3 months within the compliance deadline of the parent application.

The compliance period for the parent application is 4½ years from the filing date or 1 year from the issuance of the first examination report whichever is later.

The compliance deadline for divisional is the same as that of parent.

The compliance deadline can be **0.5✓** extended as of right **0.5✓** by 2 months **0.5✓** by filing form 52 **0.5✓** and paying a fee. In order to file divisional. If exam report under 18(4) notice of allowance is issued on application and the divisional must be filed within 1 month of notice of allowance no extension available. If notice of allowance is issued as first examination report then have 2 months to file divisional application.

Even if the divisional is filed after notice of allowance still have to be filed 3 months before compliance deadline of the parent. If this not possible extend the compliance period of the parent as described above.

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MARKS AWARDED 7/20

Question 8

- a) A person infringes a patent for an invention without the consent of the proprietor in the United Kingdom where the invention is a process^{0.5✓} he disposes of^{0.5✓}, offers to dispose of^{0.5✓}, imports^{0.5✓} or uses^{0.5✓} a product obtained directly by means of the process^{1✓} or he keeps any such product for disposal^{0.5✓} or otherwise. ^{0.5✓}
- b) A UK resident^{0.5✓} should not file^{0.5✓} or cause^{0.5✓} to file a patent application abroad^{0.5✓} if it contains information relating to military technology^{0.5✓} or publication of such application is prejudicial to national security^{0.5✓} or safety of the public^{0.5✓} unless he has obtained written confirmation to file the an application abroad from the comptroller.^{0.5✓} or unless he has filed application with the UKIPO 6 weeks before and he has not received any objections to file abroad^{0.5✓} or prohibiting him to publish the application. or any such directions have been revoked.
- c) Third-party observations may be filed by any person^{0.5✓} with regards to the patentability^{0.5✓} of the invention Third party observations can be filed anonymously. ^{0.5✓}

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Procedure for third party observations.

The third party observations must be filed in writing^{0.5✓} to the comptroller^{0.5✓} stating why the patent^{0.5✓} should not be granted and raising any prior art documents that might be relevant to the patentability of the invention in particular novelty and inventive step. and providing evidence in support of the statements filed in the third party observations.

Advantages of third party observations.

- Relatively cheaper than other proceedings post grant of the patent. eg. revocation or invalidly
- Can prevent patent from being granted.
- Party can remain anonymous.

Disadvantages of third party observations.

- Third party does not become party to proceedings. ^{0.5✓}
- The comptroller may consider^{0.5✓} third party observation and cite the documents in the next examination report or might not do anything and just forward the documents and third party observations to the applicant^{0.5✓} since the patent office is not bound to act on them.

- Applicant may make amendments to their patent application in which case the patent would become even stronger and more problematic for third party. The amendments filed by the applicant can overcome the prior art documents cited by third parties since the patent hasn't granted yet.

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