

Introduction

The standard of answers this year was highly variable. A number of candidates produced excellent papers and at the other extreme a few candidates were clearly not ready to take the examination. On the whole the performance of candidates was fairly typical of recent years.

The examiner was pleased to note that the structure of answers has improved compared to recent years. For some candidates this is still a problem area. The advice is always – read the question and make sure you are clear as to exactly what is being asked, identify the issues and then systematically address each issue in turn. Answers which discuss points of interest in the general area of the question rarely score well.

Part A

Question number	Comments on questions
Question 1	<p>This was a straightforward question relating to who can apply for and be granted a patent and also the filing of the statement of inventorship. Almost all candidates answered this well.</p> <p>The only stumbling block was the question of who can be granted a patent. Most candidates had the general idea but in most cases, the necessary detail was lacking.</p>
Question 2	<p>This was a straightforward question relating to patent assignment. Surprisingly few candidates knew the procedure for recording an assignment. This can be done by the two parties signing the Form 21 or, alternatively, by filing evidence sufficient to establish the transaction.</p> <p>Apart from the above, this question was answered well.</p>
Question 3	<p>This question related to declarations of non-infringement as set out in Section 71 of the UK Patents Act. It was not popular with candidates and those who did answer it did not answer it well.</p> <p>Most candidates were able to identify situations in which applying for a declaration of non-infringement would be useful. The majority of candidates struggled to identify the steps that must be taken before one can file such an application.</p> <p>The examiner appreciates that filing an application for a declaration of non-infringement is unlikely to form part of day-to-day practice for many candidates. However, such applications are a useful tool and candidates should have knowledge of them.</p>

Question 4	<p>This question asked for a summary of a leading case on claim construction. This question makes a regular appearance and a well-prepared candidate should be able to produce summaries of leading cases on novelty, inventive step and infringement without difficulty.</p> <p>A number of candidates summarised cases relating to issues other than claim construction. Candidates are reminded of the importance of reading the question carefully.</p> <p>A number of candidates produced very minimalistic case summaries. Such candidates were not adequately prepared for the examination. It is important to read more than the case summary in the CIPA guide or the case headnote. Candidates would benefit from reading the decisions in their entirety.</p>
Question 5	<p>This question related to withdrawal of patent applications and surrender of patents. On the whole this was answered well.</p>

Part B

Question number	Comments on question
Question 6	<p>Part a) of question 6 asked for a discussion of how obviousness is assessed with particular reference to the Windsurfing/Pozzoli approach. This was answered well, although a few candidates did not recite the relevant steps in sufficient detail.</p> <p>Part b)i related to an amendment of a patent application to include a new two-fingered embodiment of a device. Most candidates realised that this was not possible without adding subject matter. Most candidates suggested filing a new application covering both two- and three-fingered embodiments and claiming priority from the first. Only the best candidates appreciated that there was an alternative solution - to file a new application to the two-fingered embodiment which did not claim priority from the original application. The original application would be novelty only prior art against the later application.</p> <p>Part b)ii related to overcoming two cited pieces of prior art, documents A and B. Document A caused candidates little difficulty. Almost all candidates appreciated that this taught away from the current invention. Document B caused candidates more difficulty. Not all candidates appreciated that this document was novelty, only prior art.</p>

Question 7	<p>Question 7 related to various different types of extension of time that can be obtained under the UK Patents Act. Overall this question was answered poorly by most candidates.</p> <p>Part b) related to late payment of a renewal fee. Almost all candidates appreciated that this could be paid six months late as of right, along with a surcharge.</p> <p>Most candidates struggled to differentiate between parts a) (late filing of a priority document) and c) (late filing of a response to an office action). In both cases, one can obtain a two month extension as of right, followed by a further discretionary extension. Exactly how this is achieved though is different in the two cases.</p> <p>Part d) (extension of time for filing a divisional application) caused almost all candidates difficulty. Many candidates knew that one could extend the divisional deadline by extending the compliance deadline. Only a small number of candidates appreciated that one could directly extend the divisional deadline.</p>
Question 8	<p>This question related to a variety of topics, all of which form part of the core practice of patent attorneys – infringement, the provisions of section 23 and third party observations. This question was answered acceptably well by almost all candidates.</p> <p>The only point the examiner noted was the large number of candidates who stated that third party observations can be filed by any party. They can only be filed by <u>any third party</u>. This exact same point was also mentioned in last year's examiner's comments.</p>
Question 9	<p>The first half of question 9 related to entry of a PCT application into the GB national phase. Again, this is a regular question and the examiner was surprised by the number of candidates who had only a vague knowledge of the steps required.</p> <p>The second half of the question related to double patenting. Most candidates had only a superficial knowledge of this. The main point is that the UKIPO will revoke the GB patent rather than the GB national phase of the EP patent. In cases of double patenting, one should be sure not to let the EP (GB) patent lapse. The test applied by the UKIPO when assessing double patenting is, are the two patents 'for the same invention'.</p>