

Introduction

A large number of candidates sat the exam this year. The pass marks fell generally into two groups. The first group lay substantially in the 50-60 mark range. Unusually this year, however, there was a second group of candidates with marks centred in the 20-30 mark range. It would seem that the candidates fell into a first group who had prepared for the exam and a second group who had not. Overall, the quality of the scripts was not as high as in previous years, although this might be down to candidates not having as much face-to-face contact with mentors as usual over the past 12 months.

The structure of candidates' answers also seems to have suffered. Many candidates took a shotgun approach to answering questions, writing everything they knew about a particular topic in the hope that some of the content might have attracted marks. Almost invariably, this approach does not do well. This approach often leads to candidates missing parts of a multi-part question. The examiner cannot emphasise too strongly the importance of reading the question carefully, and determining exactly what is being asked.

Questions

Part A

| Question number | Comments on questions |
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| Question 1 | Question 1 was a straightforward question requiring the candidates to list six things which were not inventions for the purposes of the Act. Almost every candidate scored well on this question. |
| Question 2 | Question 2 related to the late addition of a priority claim for a GB patent application. Most candidates answered this well. An important point that many candidates missed, however, was that before one can add the priority claim, one must withdraw the request for early publication and then re-file it once the priority claim has been added. |
| Question 3 | Question 3 required candidates to write notes on the recent <i>Actavis</i> case and also to explain the test under which the prosecution history for a patent may be considered. This question was answered surprising badly by candidates. Since a very similar question was asked last year, most candidates were perhaps not expecting the topic to be tested again this year. |

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| Question 4 | Question 4 was a straightforward question relating to transactions, instruments and events and why it is important to record them. It was a simple test of rote learning that almost all candidates answered well. |
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Part B

| Question number | Comments on question |
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| Question 5 | Question 5 was a straightforward question relating to the advantages and disadvantages of licences of right. Again, most candidates answered this well. |
| Question 6 | Question 6 asked whether a patent application could be filed in the name of a partnership. This seemed to cause a problem for many candidates. The answer is that one cannot file a patent application in the name of a partnership, but one can file it in the name of the partners. An LLP is a corporate body and so one can file a patent application in the name of an LLP. |
| Question 7 | <p>Question 7 was a long question relating to a method of manufacturing pies. The question fell neatly into two halves: the first relating to non-payment of the renewal fee and the second relating to third-party rights that third parties may have acquired due to non-payment of the renewal fee.</p> <p>Coming back to the point mentioned above regarding the structure of the answers, some candidates mixed these two separate issues together, producing answers that appeared to have a 'stream of consciousness' format and which did not address all of the possible options. Candidates would do well to sit and consider the question for a few moments and then simply list the main points that should be addressed, before starting to write the answer.</p> <p>As to the late payment of the renewal fee, there were three options, depending on how overdue the renewal fee was. If the renewal fee is less than six months overdue, it can simply be paid with a surcharge. If it is more than 19 months overdue, there is nothing that can be done. If it is between these two limits then one can apply for restoration, although in this case third-party rights may have been gained.</p> |

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| | <p>The second part of the question relating to third-party rights was answered well, although few candidates distinguished between the manufacture of cheese pies (which was already occurring) and meat pies (which the competitor may not have yet started to manufacture).</p> <p>Few candidates mentioned that a court would assume the pie is made by the method, unless a competitor can show otherwise. On the other hand, it was pleasing to note that most candidates mentioned that when writing to the competitor, one must bear these threat provisions in mind.</p> |
| Question 8 | <p>Question 8 related to a portfolio of UK patents and applications and how one should proceed for each of them.</p> <p>Part (a) related to the extensions of time that were available for requesting examination. A surprising number of candidates were unclear as to what extensions were available and when evidence was required.</p> <p>Part (b) related to the time limit for filing a statement of inventorship on a GB application split from a PCT application. Most candidates answered this well.</p> <p>Part (c) related to a patent application where the deadline for filing a response to an office action was due imminently. This part was not answered terribly well. The fundamental point was that a discretionary extension of time was still available. If this was granted, one could file a response. If it was not granted, one could file a holding response.</p> <p>Part (d) related to broadening the scope of coverage of a patent application within 12 months of filing. This was answered surprisingly poorly, with candidates producing a whole range of possible schemes. The essential point is that one should file a new patent application covering both the old and new subject matter, and claim priority from the first.</p> |
| Question 9 | <p>Question 9 was a four-part question, asking the candidates to explain, in general terms, common topics in patent law.</p> <p>The first part related to divisional applications. On the whole, this was answered well. The main points that the examiner was looking for was that a divisional application receives the same filing date as the parent application and is prosecuted independently of the parent application.</p> |

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| | <p>Part (b) related to the meaning of the term 'sufficiency'. Again, this was answered well, with many candidates explaining the circumstances in which a sufficiency objection can arise.</p> <p>Part (c) related to compensation for an employee. Again, this was answered well by candidates who had prepared adequately for the exam.</p> <p>Part (d) related to the consequences of surrendering a patent. On the whole, this was not answered well at all. It is appreciated that this is not something that would arise in day-to-day practice, but it should still form part of the general knowledge of a patent attorney.</p> |
| Question 10 | <p>Question 10 related to correction of a simple typographical error in the claim of a patent and also, more significantly, an error in the translation of claim 1 of the patent when it was translated from German to English during prosecution before the EPO which has restricted the scope of the claim.</p> <p>Most candidates provided a good explanation of what it means to say that the scope of one claim is narrower than another. Most candidates also realised that the authentic text is the text in the language of proceedings before the EPO, unless the translation confers protection which is narrower than that conferred by the original text, in which case the authentic text is the English language translation. Few candidates mentioned that this was not the case for revocation proceedings.</p> <p>Candidates understood well how to correct the typographical error. There was some confusion, however, as to how to proceed as regards the potential infringer who infringed the broader German language claim, but did not infringe the narrower English language translation of the claim. In a nutshell, nothing can be done as regards past infringements; however, the situation can be rectified by preparing a corrected translation and having it published by UK IPO. Any current infringer, however, would have a defence that they had begun infringing in good faith.</p> |