Examiner's Report Year
FD1 – Advanced IP Law and Practice

Patent Examination Board

Introduction

This year's pass rate of 47% was comparable to previous years.

Part A was generally better scored than Part B. This is a common trend seen most years showing that candidates' ability to understand the law and apply it to simple situations is good but there is more of a struggle to separate out the issues in a more complex scenario. This can often be down to approach rather than ability and it cannot be stressed enough how more time planning and structuring an answer can help to ensure the candidate provides a full analysis.

There are still a number of candidates who score below 20% each year. These candidates are not at the right stage of their professional careers to be attempting Final Diploma examinations. The standard of candidates' scripts at this lower end of the mark range is concerning. It calls into question the quality of supervision/training some candidates are receiving and why they are attempting the examinations without the sufficient preparation.

FD1 is a difficult examination and candidates generally do better with more experience so they can identify what the key issues are and provide practical advice to their clients.

Questions

Part A

Question number	Comments on questions
Question 1	The average mark achieved for this question was 2 out of 4. Question 1 was a short question designed to ease candidates into the examination. However, answers suggested a low level of familiarity with either the practical significance of the steps, or the associated timings, for the 'new' grant procedure which has been in place since 1 October 2016. Most knew the usual two month deadline and the compliance period but many suggested wrongly that an extension was possible. The essential point for this question is that once the application is granted, there is no possibility of filing a divisional and no extensions to any periods could possibly apply. More practically, many failed to mention checking to see if the case is pending, since the point at which pendency ceases is outside the Applicant's control and may not happen immediately on the date indicated in the UKIPO letter (though a significant delay may be unlikely). Some candidates appeared to have confused the time period under Rule 31(4)(a) and the deadline set by Rule 19 and S15(9).

	Rule 31(4)(a) sets a time period of two months for making amendments. Because amendments can be made, the application cannot proceed to grant within this time period. Because the application cannot proceed to grant within this time period, a divisional can still be filed. Rule 31(4)(a) does not, in of itself, set a deadline for filing divisional applications. Contrary to many candidate's answers, the time period in Rule 31(4)(a) is not a deadline that can be extended as of right under Rule 108.
Question 2	The average mark achieved for this question was 6 out of 10. It was good to see a much stronger set of marks being achieved in the designs question than has been achieved in previous years. It is clear from the question that the independent researcher is the owner of the design. Consequently, the museum will require an agreement (an assignment or a licence) to be in place if it wishes to control marketing of the models. This was dealt with well by most candidates. The design appears to be new, for example because the question states that there is no existing record of the design of the Mayflower, and possesses individual character because the limited number of wooden beams cannot convey many aspects of the design, leaving the researcher considerable freedom when completing the design. The design should be registered either as a Community registered design or in both UK and the Netherlands in order to cover the client's needs and can best be protected with line drawings. It is advisable to seek registration before the opening of the exhibition, but if this is not possible then the grace period may be used, although this does not protect against independent third-party designs. This has been covered a few times now in FD1 and is generally well answered. The question states that there is likely to be interest in the design during the exhibition, so the commercial value of the design may be short-lived and the initial registration period of 5 years may be sufficient. However, some candidates felt that the "considerable interest" may suggest a need for a longer duration of protection. Candidates were awarded the mark for justifying why term was relevant to their advice regardless of which way they went. Answers that mentioned the term for a registered design but failed to give advice on tailoring it to the needs of the client did not attract the mark. Unregistered design rights will, or will in due course, exist automatically in UK and EU but registration may be preferable because, for example, unregistered design right requires proof of ownership or proof of copying to enforce. A justified reason was required for the mark.

Question 3	The average mark achieved for this question was 4 out of 7. This question was straightforward for the majority of candidates, who appreciated that the priority year ended on Saturday 12 October 2019 when the UKIPO was closed for Convention filings. Those candidates who did badly on this question usually had not appreciated that that the deadline for claiming priority had not expired. Advice to argue the drawings could be added as a correction was not appropriate because a description of the drawings cannot inevitably lead to only one precise version of a drawing. Few candidates suggested filing a further corrected PCT application, but not paying the fees, as a back-up until it has been confirmed that the problems with PCT1 have been resolved. Candidates are encouraged to be specific when using terminology and in some cases the subtlety of the nature of "closed" and "open" days was confused with "working" and "non-working" days.
Question 4	The average mark achieved for this question was 5 out of 9. Many candidates have commented that they felt this year's examination was heavily PCT-weighted. However, it is important candidates are conversant with the PCT, particularly its interplay with national law. It was in general well handled. Most candidates appreciated the need for the claims to be in English to trigger provisional protection, and that how to put the competitor on notice and entering the UK national phase (or EP regional phase) early were required. Fewer candidates realised that explicitly requesting early processing also had to occur. Situations where candidates made errors included incorrectly stating that the deadline for submitting the certified copy of the priority document was four months from the filing date, rather than 16 months from the priority date. (Although it is appreciated that in this particular case you would arrive at the same date this is not always the case so care needs to be taken.) Interestingly very few candidates suggested entering the EP regional phase in German and filing a translation of the claims for publication by UKIPO. Equal marks were available for either route. However, as many candidates had not appreciated that there were other options available, few gained the additional mark for justifying their choice of action with a reason, for example by entering the UK national phase there is a benefit in that there is no opposition at UKIPO.

Question 5	The average mark achieved for this question was 5 out of 10. The biggest issue highlighted by this question was inconsistencies and lack of practicality in candidates' advice. Many, having appreciated that GB1 Claim 1 was not novel, suggested trying to enforce their invalid claim against S anyway. Others suggested amending Claim 1 to make it novel (for example by limiting to the features of Claim 2) but then suggested trying to enforce this claim when it was clear that S did not infringe Claim 2. A few candidates suggested amending Claim 1 to make it novel using an amendment that would still cover S's colander. While this is not wrong in theory, Question 5 states that there are no other embodiments described in GB1. This was a clear piece of information given to point candidates to limiting to Claim 2 only. Most candidates appreciated GBa was S2(3) novelty only prior art for GB1 but a worrying number believed GBa was novelty only prior art against all designations of EP1. These candidates usually incorrectly advised that EP1 should be unilaterally amended to Claim 2 only, resulting in a patent with an unnecessarily limited scope of protection for EP designations other than for just EP(GB). Good candidates appreciated the commercial significance lay in the actions of L rather than S and used this sensibly in their advice. Often in competitive situations candidates advise licensing and the examiner comments every year make it clear that this is not necessarily a sensible approach. However, this year it was clear in the question that Ahmed was not against negotiations with either company and yet most candidates suggested enforcement rather than an amicable arrangement. This approach that some candidates have of "learning" previous stock answers to questions is not a good approach to passing FD1. A consideration of the facts in each question needs to be made and relevant advice given.
Question 6	The average mark on this question was 4 out of 10. Candidates seemed to find this question difficult. For good marks candidates needed to distinguish clearly between instances of direct infringement and potential indirect infringement. Some candidates appeared to try to hedge their bets by simply referring to "infringement" instead of specifically identifying "direct infringement" or "contributory infringement". These candidates were only awarded the available marks for either type of infringement if it was clear from the rest of their answer which type of infringement was under discussion. C directly infringes through its gardening team so there is little need to consider indirect infringement by C.

	Use by C's customers is also a direct infringement, but private and non-commercial use is exempt. Candidates are advised again to be specific with their language, for example to recognise there is a difference between acts which are not infringements and acts which are infringements but for which an exemption exists. It is not correct for example to say "private customers don't infringe". The largest issue in this question, however, lay in the way contributory infringement was dealt with and was primarily caused by paraphrasing the law and therefore not correctly applying the legal test. The double territorial requirement was key to this part of the question. First, the supply/offer needed to be in the UK and, second, the invention was intended to be put into effect in the UK. Stating that there is an "intention to put the invention into effect" is not the test. The test is whether the invention is "intended to be put into effect in the UK". The absence of this part of the law dramatically affects the application of the facts in the question and therefore ultimately candidates' advice. For indirect infringement, however, the central issue in this situation relates to the first point, namely on where ownership of Weedy was transferred. If the point of sale was in the UK, then M was potentially a contributory infringer, but if the point of sale was outside the UK there was no contributory infringement by M. Finally, Weedy was not a staple commercial product because the question informs that Z is a known but rarely used hair dye reagent.

Part B

Question number	Comments on question
Question 7	The average mark on this question was 12 out of 25. Candidates generally answered this well and identified the key and more complex issues but then lost marks for not making straightforward points, for example carrying out validity searches or FTO searches. A first step is to carry out a number of basic checks. Validity searches should be conducted on GBA and EPB. A freedom-to-operate search is advisable for GBA to check whether anything other than EPB could present problems. The status of recently-granted EPB should be checked, including validations where the London Agreement does not apply, and renewals. A check for equivalents of EPB in other countries, such as USA, should be made. It should be confirmed whether or not the modified valve falls within the scope of EPB. If GBA proceeds to grant then any manufacture or sale of the modified valve by P would infringe. S cannot make or sell the modified valve in Europe because of EPB and licence to anyone other than P. S can file an opposition against EPB in the next three months. As to grounds, one should investigate whether P has disclosed the original valve with the sales to K or whether the sale was in confidence. Perhaps K has made a disclosure of the original valve. Evidence is required, such as a copy of an invoice, delivery note or written confirmation from K because prior use is always difficult to prove. As prior use is difficult to prove is there an easier option? For example, have any other disclosures been made? Is installation of the original valve at the top of a silo a disclosure to the public (perhaps it is not visible). Even if the original valve can be seen, is there an enabling disclosure (perhaps the relevant components are internal). In some papers the lack of distinction between a disclosure being enabled and being available to the public lost meant candidates failed to achieve marks. GBA is owned by S and not P and the improved valve is novel over EPB in that is was made and tested at S's location and appears inventive due to the dramatic improvement. A PCT application should be filed within 12 months of GBA and claiming priority from GBA. Direct filings should be made in non-PCT countries. Prosecution of GBA should be accelerated on the basis of possible infringement by P. The market should be monitored for any infringement by P.

	S does not have the capabilities to meet potential demand, so should open licensing negotiations with P. S can use the weakness of EPB (prior sale, poor performance) to encourage P to take a licence. It is possible to look for an alternative licensee in countries outside Europe where P has no equivalents. Note that EPB is granted and can be enforced immediately.
Question 8	The average mark achieved for this question was 13 out of 25. This Part B question was by far the best answered. In most cases all issues/topics were identified but a lack of systematic analysis meant that simple marks were missed. Candidates who did well considered each disclosure individually and the circumstances surrounding each one and their impact to the gripping tool and the software. Consideration needed also to be given to the different jurisdictions. The information regarding the bag swap, the prototype display and the magazine article all had slightly different fact patterns associated with them. Discussions around who had made the disclosures, whether they were public and enabled or made in breach of confidence was expected. Having considered the impact of each possible disclosure on the different subject matter, clear advice was needed as to what actions your client could take and any time periods that were key. Although it is appreciated that candidates are under pressure in an examination situation, more care is needed in planning and writing answers. For example, candidates would advise filing a GB application within the six month period for abusive disclosures and then advise filing a PCT application within 12 months of GB1's filing date. It is frustrating to see these sorts of errors and although credit would be given for the appreciation of the 6-month limit it casts doubt on a candidate's overall understanding.

Question 9	The average mark achieved for this question was 7 out of 25. Although some candidates scored very well on Question 9, a much larger number of candidates did exceptionally poorly on this question making the average mark very low for a Part B question compared to previous years. The question related to validity and infringement of differing subject matter, which is a common scenario in FD1 papers. In this scenario US and PCT applications were used to encourage candidates to consider the impact of these as prior art due to jurisdiction or whether or not national phase had been entered. In many circumstances additional information would have been needed to draw any conclusions meaning a large number of marks were available for considering both possibilities. Many candidates lost easy marks for not making straightforward points. It was possible to gain at least five marks before any detailed analysis of validity or infringement was required, for example assigning effective dates to subject matter, checking the status of PCT-X, calculating the national and regional phase deadlines for PCT-X, putting PCT-X on watch, and obtaining a sample of Leafclean's leafblower. Some of the common issues came from candidates deciding, without adequate information, whether the disclosure at the conference was or was not enabled. Making a blanket decision without the necessary facts closed off discussion points that could have gained marks. The application of PTC-X as prior art in both US and EP was often incomplete, resulting in not all marks being picked up. Many candidates provided only a superficial analysis which would have been of no benefit to a client in real life. It is important to follow through an analysis to its natural conclusion and, if at any point additional information is required, both options should be discussed. Similarly, the consequences to the client if PTC-X did or did not enter the EP regional phase were incompletely analysed. Many candidates suggested the US provisional was citable. It is not, although it does provide an earlier priority date for the PCT subject matter.