

## Introduction

This year's pass rate (57%) was lower than last year but still above average when compared with previous years.

All Part B questions were answered evenly with the number of candidates answering as if no question was seemingly 'preferred' or 'least preferred' this year.

It is still of concern that some candidates are scoring very badly on Final Diploma examinations perhaps indicating they are attempting the papers too soon in their professional careers. It is advised that Final Diploma examinations are only attempted by those who have worked towards them by committing time to the appropriate training and believe they are ready to sit the examination.

Candidates are reminded to read the questions and in particular the bold text at the end of each question carefully and to avoid 'question spotting' type revision in their preparation. The candidates who scored well this year identified the key issue at the heart of the question and worked through it methodically using the information provided. Most marks are awarded for the most pertinent issues and spending time on peripheral issues or on areas that are not identified as being of concern do not attract marks and waste candidates valuable time.

Although it is stated every year – marks are not awarded for simply stating the law – as a practical advice paper it is important that candidates state the relevant law and then apply the facts of the question to it before coming to conclusions and advising on necessary actions. Frequently there is a mark available for advising your client on the likely outcome e.g. how likely that they will be successful in taking a particular action – this certainty or uncertainty is important to your client and should be stated.

## Questions

### Part A

Question number	Comments on questions
Question 1	<p>The average mark on this question was 4 out of 5. Most candidates scored well on this question which was a straightforward query regarding payment of fees. Question 1 was only a 5 mark question yet some candidates still wrote unnecessarily long answers. This leads to doubt as to whether the candidate understands the issue that needs addressing or is simply 'falling upon' the answer. Those candidates who described in detail all fees that may or may not become payable during the life of the application had clearly not read the question and appreciated that the client would have funding soon or would allow the application to lapse.</p> <p>It is important to be specific with language - Candidates who said '<i>before</i></p>

	<p><i>the letter is <u>received</u></i> did not get the mark as it must be paid before <u>issue</u> (i.e. earlier date). So if you wait for the letter to be received you will still have to pay the surcharge.</p> <p>It is also important to use common sense when giving advice - bear in mind that advising to '<i>pay before receipt of the notice</i>' or '<i>pay before issue of the notice</i>' is not realistic since neither of these actions are within your control. Optimal advice is to suggest that payment is made as soon as practically possible.</p> <p>Not many candidates recognised it is the RO that invites payment of the missing fees.</p> <p>Some candidates assumed the RO was UKIPO, but the question is silent on this issue and it could equally have been the EPO or IB for a UK associated client. It is inadvisable to make assumptions however; in this case there was no consequence of doing so.</p>
<p><b>Question 2</b></p>	<p>The average mark on this question was 7 out of 10.</p> <p>Compared to the average mark achieved in designs questions from previous years this was generally well answered.</p> <p>While many candidates identified deadlines of relevance e.g. 6 month priority period, a proportion failed to advise that specific action should therefore be taken today.</p> <p>One candidate suggested that US closed days would allow UK filing deadlines to be extended.</p> <p>Most understood the principle that designs in the same Locarno class could be combined to save costs, however, a smaller proportion applied the facts of the question to reach a conclusion on whether to file a single or multiple applications – a mark was available for consideration of the facts regardless of candidate's detailed knowledge of the Locarno system. It was however, necessary to come to a conclusion on whether they can be combined because they are all lighting related, or they need to be filed separately because they are different products.</p> <p>Again specificity with terminology let some candidates down in this question – many appreciated that priority needed to be claimed but it is important to appreciate that each design is only entitled to claim priority from the relevant US design on which it is based and for which there is different dates. Candidates who simply state '<i>claim priority</i>' are not giving specific enough advice.</p> <p>Some candidates suggested requesting a copy of the assignment for review – the question says it has been provided - careful reading of what the question does and does not say is important.</p> <p>Few commented on the sufficiency of the assignment documents.</p> <p>Some candidates recognised that the client was not a qualifying person but did not comment on the designer. Qualification can be through a</p>

	<p>number of routes. It is advisable to explain your reasoning stating <i>'there is no qualifying person'</i> is correct but stating that <i>'there is no qualifying person because the client is US based'</i> is better and shows the understanding of the legal point and facts.</p> <p>Some candidates appreciated that protection would last 25 years but stated it would run from registration of the design not application of the design.</p>
<p><b>Question 3</b></p>	<p>The average mark on this question was 4 out of 9.</p> <p>A surprising number of candidates did not feel there was a need to amend the clients claims as the prior art was unlikely to be found! Some candidates failed to accept the facts of the question stating that the prior art is novelty destroying and questioned it, distracting their focus from the key issues and losing time and marks.</p> <p>The most common assumption made was that Claim 2 was a dependent claim, this however, is not stated in the question and although it does not matter with respect to the mark available, advice to <i>'incorporate features of claim 2 into claim 1'</i> may not be the right practical course of action unless claim 2 is actually dependent (e.g. Claim 2 could be a different category) – in a different scenario this may cause candidates to miss out so care is encouraged when reading the information provided.</p> <p>Some candidates failed to realise that the existence of an imminent date of publication means the notification of grant could not have been the first communication under S18(4).</p> <p>Very few gained a mark for explaining that it is necessary to give a reason when identifying the amendment you wish to make.</p>
<p><b>Question 4</b></p>	<p>This question generally attracted the highest marks in Part A with an average score of 6 out of 8 showing candidates are comfortable with a stepwise approach to a single procedural issue.</p> <p>A few missed easy marks by failing to state that an extension as of right was no longer available as the deadline had passed and jumped straight to the conclusion that the case had lapsed</p> <p>Many candidates still use incorrect terminology by writing <i>'restoration'</i> instead of <i>'reinstatement'</i>.</p> <p>Some candidates highlighted the deadline is 12 months from the missed date or 2 months from removal of the cause of noncompliance without clearly stating the applicable date for this question was the 2 months date – it is not enough to state the law – the client needs to understand why and how the law is applicable to his/her scenario.</p> <p>Some candidates introduced ambiguity over what is required by the <i>'unintentional'</i> standard required by suggesting that is needed to be shown that the error was an isolated occurrence and that normal docketing procedures were robust – that is not what unintentional means.</p>

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	<p>Some candidates said 3<sup>rd</sup> party rights were '<i>unlikely</i>' as not published. This sort of vague language does not show that a candidate is confident of the answer – 3<sup>rd</sup> party rights <u>are not</u> an issue because the case is unpublished – definitive language is required to earn the mark. Others recommended requesting reinstatement asap to minimise third party rights – it should be noted that S20B requires publication if third party rights are to arise, which is not the case in the question.</p> <p>Most candidates scored well on the points relating to the missed priority period and the availability of a grace period in the US for inventor disclosures.</p> <p>Although not key to the question it may be noted that it is not necessary to complete the omitted act when requesting reinstatement of an application (cf EPO further processing procedure) once reinstatement is allowed an invitation asking you to complete the omitted act will follow.</p>
<b>Question 5</b>	<p>Average mark for this question was 3 out of 9.</p> <p>This question was the least well answered on Part A.</p> <p>Candidates generally picked up marks for peripheral points such as the need to be registered as address for service and the approaching date of the end of the compliance period.</p> <p>However, many missed the crux of the question .The candidates that seemed to struggle with this question realised that the deadline was missed and that no extension was available as of right and immediately assumed the application had lapsed and went down the line of reinstatement – presumably because after Question 4 this topic was fresh in their minds.</p> <p>The deadline to respond is a deadline set by the Examiner and not by the Act and as such failure to respond does not cause the application to lapse, it simply becomes dormant and can be put into order at any time until the end of the compliance period.</p> <p>It was therefore necessary to request a discretionary extension, and at the same time as explaining why the deadline was missed providing a response to the search and exam report. Given the facts of the question it seems likely that the extension will be granted.</p>
<b>Question 6</b>	<p>Average mark for this question was 5 out of 9.</p> <p>Many candidates' answers were muddled and it seems too many jumped straight into trying to 'fix' the issue before they had really analysed the situation and considered the impact of the various disclosures on the filings.</p> <p>Many candidates advised claiming priority in GB2 from GB1. The question makes it very clear that worldwide protection is what is key and that for the commercial interests of your client this should be your focus as such anything less than a PCT application was unlikely to be</p>

	<p>considered sound advice.</p> <p>Claiming priority in GB2 (or in the PCT) from GB1 also does not eliminate the impact of the article on GB2 which many did not mention. The subject-matter of GB2 relating to the improved head still has an effective date of 23 January 2015, which is after the publication date of the article and as such needed discussion regarding inventive step over the disclosure of the original toothbrush for the improved head.</p> <p>Once the filing of the PCT was suggested again many people simply stated '<i>and claim priority</i>' but not that they needed to claim priority to both GB1 and GB2. This is important because the client needs to appreciate that each embodiment has a different effective date.</p> <p>Most candidates appreciated that Taiwan was not covered by the PCT and suggested a national filing.</p> <p>The least appreciated points were that despite being aware of the competitor and having an unpublished application many did not consider sending the competitor a copy of the national application once filed to put them on notice nor that it would be prudent to put a watch out for applications from the competitor.</p> <p>Many candidates made the flippant comment that they needed to be registered as address for service without realising that this was necessary for both applications and those that did not make this clear were not awarded the mark.</p>
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**Part B**

Question number	Comments on question
<b>Question 7</b>	<p>Average mark for this question was 9 out of 25.</p> <p>Question 7 was directed towards advising a client on a business opportunity and required a basic Freedom to Operate/validity analysis.</p> <p>As always those Candidates with a thorough and systematic approach scored best and that it was sensible to break the answer up into activities relating to Tin or Lead or by each application/patent.</p> <p>Those who did not separate their answers often made valid legal points but related them to the incorrect embodiment e.g. tin versus lead and as such did not gain valuable marks. Some assumed that the ovens containing Tin had been sold instead of querying whether this had happened - it is important to appreciate where information is vague it is designed to get candidates to discuss both possible avenues. There is a legal difference between sale and research and development and candidates were supposed to appreciate this.</p> <p>Most candidates appreciated the difference between the risk posed by a granted patent versus a pending application with respect to possible</p>

	<p>amendments or divisionals and suggested placing the application on watch. In addition, as a result, most advised caution in publicising the interest in lead coatings until the EP was granted which was good practical advice.</p> <p>Often many candidates draw the conclusion in a question that an activity is an infringement but don't take this any further. Infringement itself is not the issue to your client ...the issue is that as a result of this infringement action may be taken against them in the form of injunction or relief e.g. damages (as appropriate) and these comments often attract marks.</p> <p>Other small comments to be mentioned include:          Small amounts of contaminant do not give rise to <i>de minimus</i> arguments. Although amounts are small they provide a demonstrable benefit.          Few commented on the key realisation that lead does function and provide the benefits of the invention (i.e. sufficient, but not supported – support can be addressed after filing)          Few considered liability to commercial customers in claims to lead granted.          Few suggested that the UK business may file an application with claims in the form of a selection invention          Candidates generally mentioned asking for a license but did not rationalise that as the two parties are working in different fields that this is more likely to be granted than if they were direct competitors of one another. Too often candidates miss these simple points which often yield excellent advice for the client.</p>
<p><b>Question 8</b></p>	<p>Average mark for this question was 13 out of 25.</p> <p>Question 8 was an infringement and validity assessment.</p> <p>This was the highest scored part B question and again those who took a methodical approach usually scored well.</p> <p>The biggest confusion for some candidates in this question was the presence of a series of continuation-in-part applications each of which discloses different subject matter and as such has different priority entitlement and as such different effective dates.</p> <p>Most candidates appreciated that it was necessary to check if the patent was in force however, better candidates realised that the London Agreement makes it rather pointless checking for validations in GB and FR, as these are automatic. What is important here is whether payment of the renewal fees has been carried out.</p> <p>Many candidates commented early on that Claims 1 and 2 were infringed however, it is important that candidates realise that this cannot be taken as meaning that Claims 3 and 4 are not infringed. Explicit statements are required so that the risk to the client can be properly ascertained. As a result easy marks could not be</p>

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	<p>awarded.</p> <p>Far too many candidates do not separate out the analysis between novelty and inventive step. It is not good enough to state that a claim is 'valid' it needs to be considered according to relevant and citeable prior art and appropriate subject matter.</p> <p>Commercial certainly has some value. Candidates suggesting a royalty free license in return for not raising invalidity questions should consider competition law issues. Collusion with the patentee to exclude others from the market through a knowingly invalid patent could be viewed dimly.</p>
<p><b>Question 9</b></p>	<p>Average mark for this question was 10 out of 25.</p> <p>This question related to infringement of different activities and the relevance of provisional protection.</p> <p>The biggest issue noticed by examiners in this question is that candidates are getting very confused by different types of infringement. The situation where there is a process claim and where the direct product of the process is an infringement of such a claim is still a form of direct or primary infringement and not secondary/contributory infringement for which there is a different test.</p> <p>The liquid extract however, was not a direct product of the process yet may still be infringing as it used the ground coffee despite the small amount used. Many people discussed the small amount of coffee used as <i>de minimis</i> and therefore decided it was not an infringement. Few who decided it was an infringement due to its importance in providing the characteristic flavour didn't then suggest any sensible way forward for the client such as obtaining the ground coffee from GSA legally (given the small amount needed it would not have been a great cost), or making the extract in Australia. Good candidates appreciated that there was no exhaustion because of the import from outside the EEA .</p> <p>Few candidates discussed the relationship of the subsidiary and whether purchase from them was an authorised activity.</p> <p>Most candidates discussed provisional protection in the UK and appreciated that until a translation was provided this was not relevant however, good candidates went on to realise that there may be similar provisions in France and that as the PCT was in French this could be relevant to the activities the client was considering in France.</p> <p>Many candidates discussed licensing even though the question made it clear that licensing had already been considered for grinding the coffee and was too expensive.</p> <p>Purchasing the ground coffee for the ice cream was rarely advised.</p> <p>Few candidates advised their clients to cease activities with respect to ground coffee in the UK and France.</p>