

FC1 UK Patent Law Mark Scheme  
FINAL Mark Scheme 2021

**SECTION A**

**Question 1**

Your client claims to have invented a perpetual motion machine. List three grounds on which the UKIPO might raise an objection.

**3 marks**

**Answer**

Section 4 – not capable of industrial application (1 mark)

Section 14(3) – insufficient description (1 mark)

Section 14(5) – claims not supported by the description (1 mark)

Any other reasonable alternative considered

**Total: 3 marks**

**Question 2**

a) Is it possible to claim priority from the following? In each case explain your answer.

- (i) A GB patent application filed by a third party in the last 12 months;
- (ii) A PCT application filed within the last 12 months;
- (iii) A brochure posted to the UKIPO, within the last 12 months, as part of a mail shot to thousands of UK addresses.

**3 marks**

b) Section 5 of the UK Patents Act allows priority to be claimed either from (i) an earlier application for a patent or (ii) an earlier application for protection of an invention. Give an example of the latter.

**1 mark**

c) Explain why it is possible to claim priority from a patent application filed in Taiwan. Taiwan is not a party to the Paris Convention.

**1 mark**

**Total: 5 marks**

**Answer**

(a)

- (i) No (0.5 marks). Some discussion of assignment (0.5 marks)
- (ii) Yes. The UK Patents Act specifically states this is possible. (1 mark)
- (iii) No. Even though this was posted to the UKIPO it is not a patent application. (1 mark)

(b) A German Utility Model. A French 'Certificat de Utilité'. (1 mark) [s. 5(5)(a) and 5(5)(b)]

(c) Taiwan is a Party to the WTO. (1 mark)

**Total: 5 marks**

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**Question 3**

With reference to Section 72 UK Patents Act (*Power to revoke patents on application*)

- a) On what grounds can one apply for revocation of a patent; and, **5 marks**
- b) Who can apply for revocation of a patent? **5 marks**
- Total: 10 marks**

**Answer**

- (a)
- (i) the invention is not patentable (1 mark)
  - (ii) the patent was granted to a person who was not entitled to be granted the patent (1 mark)
  - (iii) the specification does not disclose the invention clearly enough and completely enough (0.5 marks for either) for it to be performed by a person skilled in the art (0.5 marks)
  - (iv) the matter disclosed in the specification of the patent extends beyond that disclosed in the application for the patent as filed (1 mark)
  - (v) the protection conferred by the patent has been extended by an amendment which should not have been allowed (1 mark)
- (b) any person (1 mark) including the proprietor (1 mark)

An application on ground (ii)

- (vi) may only be made by a person found by the court to be entitled to be granted the patent or granted a patent for part of the matter (1 mark);
- (vii) may not be made if that action was commenced after the end of the period of two years (0.5 marks) beginning with the date of grant (0.5 marks) unless it is shown the registered proprietor knew at the time of grant or transfer (0.5 marks) of the patent to him that he was not entitled to the patent (0.5 marks).

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**Question 4**

Sections 74A of the UK Patents Act relate to opinions issued by the UKIPO.

- a) For what reasons may the UKIPO refuse to issue an opinion?  
**4 marks**
  - b) Who prepares the written opinion?  
**1 Mark**
  - c) Explain in what circumstances, if any, the opinion is binding on the requester of the opinion.  
**1 mark**
  - d) If the UKIPO decides not to issue an opinion who may appeal this decision?  
**1 mark**
- Total: 7 marks**

**Answer**

- (a) in such circumstances as may be prescribed (1 mark); if it is inappropriate in the circumstances (1 mark); if the request appears to be frivolous (0.5 marks) or vexatious (0.5 marks); if the question upon which the opinion is sought appears to have been sufficiently considered in any relevant proceedings (1 mark)]
  - (b) an examiner (1 mark)
  - (c) the opinion is not binding for any purpose (1 mark).
  - (d) the person making the request (0.5 marks) only (0.5 marks)
- Total: 7 marks**

**Question 5**

Reinstatement is requested when the applicant fails to comply with a requirement of the Act or Rules within a period which is set out in the Act or Rules or specified by the comptroller.

- a) Section 20A (*Reinstatement of applications*) lists five periods for which reinstatement is not possible. What are these?  
**5 marks**
  - b) The comptroller will only reinstate an application if three criteria are satisfied. What are these?  
**3 marks**
  - c) What is the deadline for requesting reinstatement?  
**1 mark**
- Total: 9 marks**

**Answer**

- (a) an extension of time is still available (1 mark); in relation to any proceedings before the comptroller (1 mark); for purposes of section 5(2A)(b) (late declaration of priority) ( 1 mark); the period for requesting reinstatement (1 mark); extension of time limits by the comptroller (1 mark)

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- (b) the applicant requests him to do so (1 mark) the request complies with the relevant requirements of the rules (1 mark) and failure was unintentional (1 mark)
- (c) twelve months from termination (1 mark)

**Total 9 marks**

**Question 6**

What criteria must be satisfied before the comptroller will refer an application for preliminary examination?

**3 marks**

**Answer**

The application has a date of filing (1 mark); the application has not been withdrawn (1 mark); and, the application fee has been paid (1 mark). Section 15A

**Total 3 marks**

**Question 7**

The UKIPO has cited the abstract of an earlier UK patent application as prior art against your client's application. Is the abstract valid prior art?

**3 marks**

**Answer**

If the abstract was published before the filing/priority date of your client's application then it is full prior art (1 mark). If the earlier application was filed before but published after the filing date of the client's application (1 mark) then it is not novelty only prior art (1 mark). Section 14(7)

**Total: 3 marks**

**PART A TOTAL: 40 Marks**

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**SECTION B**

**Question 8**

Your client writes:

*“You recently filed a UK patent application on our behalf for a widget. We have now received the Combined Search and Examination Report. The deadline for responding is not for some time.*

*The content of the report is straightforward. There is an objection that independent claims 1 (to the widget) and 3 (to a widget adhesive) lack unity and accordingly the examiner has only searched claims 1 and 2.*

*We definitely want to keep the searched claims. However, we cannot decide what to do about the unsearched claims without a search report.*

*The examiner has objected to claim 1 in view of a large amount of prior art. However we note the examiner is happy to accept claim 2.*

*We know there is a competitor ready to launch a rival widget. They are not planning on selling a widget adhesive at this time but you never know. We have managed to obtain a sample of the competitors widget which is enclosed.”*

You review the file. All is in order. The application has not as yet been published.

Advise your client generally. Your advice should cover actions they could take and also any defences the competitor may have. You can assume that the only relevant prior art is the art mentioned in the question.

**20 marks**

**Answer**

Provide a copy of the application to the competitor (1 mark). Request early publication (1 mark)

Threats action cannot be brought for simply providing information (1 mark) or infringement consisting of making a product (1 mark)

Request expedited prosecution (1 mark) on the grounds there is a potential infringer (1 mark).

Pay an additional search fee for claim 3 (1 mark)

If claims 1 + 2 cover the infringing product then file a response combining these (1 mark). Consider filing a divisional to original claim 1 (1 mark).

Otherwise argue against the examiners objections to claim 1 (1 mark). Can wait to file a divisional to claim 3 until after receipt of the additional search report (1 mark)

Failure to provide the competitor with a copy of the application may provide the competitor with a defence that they were not aware (1 mark) and had no reasonable grounds for supposing (1 mark) that the patent existed. Section 62(1).

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Also, if only claim 1 is infringed there may be restriction on recovery of damages (1 mark) as it would seem unlikely that claim 1 will be granted (1 mark). Section 69

There may also be prior user rights (0.5 marks). The competitor may have a defence if they had made in good faith (0.5 marks) effective (0.5 marks) and serious (0.5 marks) preparations to do the act. Section 64.

Also some discussion of 'the act' (1 mark). Some mention that it is construed narrowly and there must have been a definite intention to sell the product at the filing date (1 mark). Ask the client if they have further information on what the competitor was doing and when (1 mark).

**20 marks**

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**Question 9**

Write notes on **TWO** leading cases of the British courts. One should have claim construction as the main issue. The other case should have novelty or obviousness as the main issue.

For each case provide the following information –

- a) the parties to the case; **1 mark**
- b) a summary of the facts and issues relevant to the decision; **2 marks**
- c) an outline of the decision; and **3 marks**
- d) what precedent is set by the case. **4 marks**

**Total: 20 marks**

**Answer**

- (a) names of the parties to the case (1 mark)
- (b) facts of the case – cursory summary (1 mark); more detailed discussion covering most of the main issues (2 marks)
- (c) correct identification of decision (1 mark). Associated reasoning (2 marks)
- (d) cursory summary of precedent (1 mark). More detailed summary identifying at least some of the main points (2 marks). Detailed summary identifying all the main points (3 marks). Consideration of more subtle consequences of the decision (4 marks).

**Total: 20 marks**

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**Question 10**

An associate in France writes:

*“We have filed a PCT application in French at WIPO. The application does not claim priority. The application has 20 pages of description and 15 claims. We amended the claims in the international phase reducing the claims to 10.*

*We would be grateful if you could enter this application into the GB national phase and obtain grant as soon as possible. We will be entering the application into the EP regional phase ourselves.”*

- a) What steps would you take to enter the PCT application into the GB national phase and to expedite prosecution?  
**13 marks**
  - b) Give at least three reasons why the client might need to have a GB patent granted whilst waiting for the European application to be granted.  
**3 marks**
  - c) What issue may arise when the parallel European application is granted?  
**4 marks**
- Total: 20 marks**

**Answer**

- (a)
  - (i) file English translation of PCT (1 mark) and amended claims (1 mark)
  - (ii) pay regional processing fee (1 mark) and NP1 (1 mark)
  - (iii) file a request for search (1 mark) and pay search fee (1 mark)
  - (iv) file a request for examination (1 mark) and pay examination fee (1 mark)
  - (v) request early national phase processing (1 mark)
  - (vi) file a response addressing prior art in the international phase (1 mark)
  - (vii) request publication of the translation (1 mark) to get provisional protection (1 mark)
  - (viii) request expedited examination (1 mark)
- (b) to enforce the patent; patent box; to act as a deterrent abroad; any other reasonable alternative considered. (3 marks)
- (c) double patenting (1 mark). UKIPO will revoke the patent if the EP application is granted designating GB (1 mark) for the same invention (1 mark). Some discussion of ‘for the same invention’ (1 mark). Section 73.

**Total: 20 marks**



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**Question 11**

This question relates to extensions of time.

- a) List five deadlines that cannot be extended **5 marks**
- b) By what procedure and by how much can each of the following deadlines be extended? Is the extension discretionary or as of right?
- i) The deadline for responding to an examination report. **4 marks**
- ii) Payment of a renewal fee. You do not need to consider restoration. **3 marks**
- iii) The deadline for filing a statement of inventorship **5 marks**
- c) The extensions of time available for filing a certified copy of a priority document are slightly different to those available for filing a statement of inventorship. Explain the differences **3 marks**
- Total: 20 marks**

**Answer**

- (a) any five of the deadlines in schedule 4, part 1 (1 mark for each)
- (b)
- (i) can be extended as of right (0.5 marks) by two months (0.5 marks) on filing a request in writing (0.5 marks). Further extension possible at the discretion (0.5 marks) of the Comptroller on terms as he sees fit (1 mark). Cannot be extended beyond the period for putting the application in order (1 mark).
- (ii) can be extended as of right (0.5 marks) by up to six months (0.5 marks). No extension beyond six months possible (0.5 marks). Pay renewal fee with late payment surcharge (0.5 marks). The surcharge depends on the number of months of extension required (1 marks).
- (iii) file form (0.5 marks) requesting an extension of two months (0,5 marks). Fee payable (0.5 marks). As of right (0.5 marks). Further discretionary (0.5 marks) extension available by filing form 52 (0.5 marks) with evidence (0.5 marks) and fee (0.5 marks). Further extension must be requested within the two month (further) extended period (0.5 marks) and is limited to two months (0.5 marks).
- (c) In contrast to the deadline for filing the statement of inventorship, for filing a certified copy of the priority document the further extension is available after filing evidence but is not limited to two months (1 mark) nor does it have to be filed within two months of the deadline (1 mark). Must be filed by the time preparations for publication are complete or priority will be lost (1 mark).