

Introduction

Overall, candidates did well this year with a large number of candidates scoring in the 60-70 mark range. As always though, there were a few candidates who were not adequately prepared for the examination.

Candidates scored well on questions which simply required a recitation of the relevant portion of the Act. Candidates did not score as well on questions which required interpretation of facts. Many candidates took a “stream of consciousness” approach to answering questions, rather than spending time thinking about what exactly was being asked and how best to structure the answer so that all points were covered. The Examiner cannot over-emphasise the importance of this.

Questions

Part A

Question number	Comments on questions
Question 1	Question 1 asked the candidates to list grounds on which UK IPO might raise an objection to the patenting of a perpetual motion machine. On the whole, this was answered well. Most candidates realised that since a perpetual motion machine is believed to be impossible, one cannot file an enabling description.
Question 2	Question 2 was a simple question relating to claiming of priority. The only part of the question which caused difficulty was whether one could claim priority from a brochure posted to UK IPO. A brochure is not an earlier application for a patent and so cannot be used as a basis for priority.
Question 3	Question 3 was a simple test of rote learning. The question asked the candidates to recite the grounds on which one can apply for a revocation of a patent and also who can apply for revocation of a patent. This was answered well by most candidates.
Question 4	Question 4 was also a test of rote learning relating to written opinions. Again, this was answered well by most candidates.
Question 5	Question 5 related to reinstatement of a patent application. Many candidates struggled to list five periods for which reinstatement is not possible. Almost all candidates were aware that reinstatement

	is only possible if failure to comply with a requirement of the Act was unintentional. Many candidates, however, appeared to be uncertain of the deadline for requesting reinstatement.
Question 6	Question 6 related to the criteria that must be satisfied before an application is referred for preliminary examination. It is simply required that the application has a filing date, is pending and that the application fee has been paid. Most candidates answered this well. A number of candidates believed that it was also necessary to pay the search fee before one obtains a preliminary examination report. This is not the case.
Question 7	<p>Question 7 related to whether the abstract of an earlier UK application can be cited as prior art against a later filed application. Candidates did not answer this well. Many candidates believed that the abstract of an earlier application cannot be cited as prior art in any circumstances.</p> <p>Any document that is in the public domain before the filing/priority date of the later filed application can be cited as prior art.</p> <p>Candidates should also have considered “novelty-only” earlier applications, i.e. ones which have an earlier filing date than the current application but are published after the filing date of the current application. Unusually, the abstract of such novelty-only applications is not citable as novelty-only prior art.</p>

Part B

Question number	Comments on questions
Question 8	<p>Question 8 was a long question relating to a patent application for a widget and a widget adhesive. The applicants are aware of a competitor who is ready to launch a rival widget. The applicant has provided you with a copy of the competitor's widget and this point was fundamental to correctly answering the question. Very few candidates appeared to realise this.</p> <p>The structure of candidates' answers was poor, with many candidates appearing to list points in random order as they occurred to them whilst answering the question. Candidates would have done well to think how to structure the answer before starting to write.</p>

	<p>The fundamental point of the question is that there are two alternative ways to proceed. If the competitor's widget infringes a combination of claims 1 and 2 then one simply combines claims 1 and 2 to obtain grant and then enforces their patent. One could file a divisional application to claim 1 alone which can be prosecuted at leisure.</p> <p>Alternatively, if the competitor's widget only infringes claim 1 then clearly combining claims 1 and 2 together is not a reasonable solution. One has to argue the merit of claim 1 with the examiner or, alternatively, search the description for an alternative feature which is patentable and which still covers the competitor's widget.</p> <p>Almost all candidates recognised the need to file a divisional application and/or pay an additional search fee for the unsearched subject matter of claim 3.</p> <p>Most candidates identified the defences that the competitor may have, i.e. that they were unaware of the patent application and/or have prior user rights.</p> <p>Of all the answers marked by the Examiner, only a handful appeared to appreciate the fundamental point that how one proceeds depends upon exactly which claim is infringed.</p>
Question 9	<p>Question 9 asked for two leading cases of the British courts, one relating to claim construction and the other relating to novelty or obviousness.</p> <p>Overall, this question was answered well by candidates, with many candidates being able to produce very detailed summaries of the cases. Having said that, the question was divided into four parts. Surprisingly, some candidates did not structure their answer in this way.</p>
Question 10	<p>Question 10 relates to entry of a PCT application (in French) into the GB national phase. Almost all candidates answered this question well and appreciated the need to file an English language translation of both the application as filed and the amended claims.</p> <p>Surprisingly few candidates suggested filing a pre-emptive response at the UK Patent Office addressing the issues raised in the international phase. Many candidates suggested waiting for a first office action before responding.</p> <p>The last part of this question related to double-patenting. Whilst most candidates understood the general idea, very few candidates</p>

	<p>realised that a double-patenting objection is only raised when the two patents are for the same invention.</p>
Question 11	<p>Question 11 relates to extensions of time, in particular, which deadlines cannot be extended and also what extensions are possible for a selection of deadlines.</p> <p>Not many candidates answered this question. The candidates who did answer it fell into two groups: those who answered it particularly well and those who answered it particularly badly.</p> <p>A detailed knowledge of which deadlines can and cannot be extended is fundamental knowledge for a practising patent attorney.</p>