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1)

A perpetual motion machine cannot be described sufficiently clearly and
 1✓ concisely to be repeated by a skilled person since such a device is impossible to
 create.

Since it cannot be made it is simply a mental construct, these are excluded from
 patentability

Since this cannot be a real invention the UKIPO may object on the grounds that
 the applicant has operated in bad faith

A perpetual motion machine (if real) would be considered desperately important
 to the development of the UK and so would likely be seconded by the crown
 without publication

MARKS AWARDED: 1/3

1

2)a)

i) Under the Paris Convention priority can be claimed for an application filed
 within 12 months of the parent, however, it must be filed by the proprietor of the
 first filed application or their successor in title. If the third party has been acquired
 1✓ by the proprietor of the GB application or if the right to claim priority has been
 assigned by contract from the third party to the new applicant, then, yes, if they
 remain separate entities or no contract exists, then, no.

ii) Under the Paris convention a PCT application is equivalent to a national filing
 1✓ for the purpose of claiming priority, so yes, as long as the PCT was filed by the

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proprietor or his successor in title and the right to claim priority from it has not be assigned by contract elsewhere

i) and ii) in both of the cases I have assumed that the application from which priority is claimed does not itself claim priority and is the first disclosure of the invention.

1✓ iii)No, a such a brochure is not an application for a patent nor an application for the protection of an invention, and so does not give rise to a right to claim priority

3

2)b)

1✓ PCT application, US provisional application, German utility model

1

2)c)

0 Any application for a national patent with equivalent rights to those of a GB national application can be used as the basis for a priority claim. A Taiwanese application satisfies this criteria for signatories to the Paris Convention. This may not be the case for applications claiming priority in Taiwan, since they are not a party to the Paris Convention as so will have different criteria for priority documents.

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3)a)

- 1✓ The subject matter of the patent is not patentable, it is not disclosed sufficiently
1✓ clearly and concisely for the skilled person to replicate the invention, the person
1✓ seeking to patent the invention is not entitled to it, the subject matter of the
1✓ specification has been extended from what was originally disclosed in the patent
1✓ application, the protection conferred by the patent has been extended in a way
that should not have been allowed

5

- 1✓ 3)b) any person can apply to either the courts or the controller for the revocation
of a patent at anytime after grant of the patent if the proprietor knew at the time
of filing that they were not entitled to the patent or if the third party applying for
revocation is entitled to at least a part of the patent. In other cases, any person
can apply for revocation of a patent between the date of grant and 2 years on
from the date of grant.

1

MARKS AWARDED: 6/10

6

- 1✓ 4)a) An opinion can be sought by any person (including the proprietor) on any
aspect of any patent or application, even if it has expired. The controller may
refuse the request if he considers it to be inappropriate or unethical.

1

0 b) The patent controller

0

- 1✓ c) An opinion of the UKIPO is not binding on any person although it may aid build
confidence on validity or non-infringement of a UK patent and act as precedent in
other jurisdictions.

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0 d) There is no process for appeals against a refusal to issue an opinion, so no one may appeal.

MARKS AWARDED: 2/7

0

2

5)a)

Failure to request entry into the National phase

1✓ Reinstatement of a priority claim if the subsequent application was filed more than 14 months after the original filing date

Reinstatement of the priority claim if the declaration of priority was not made within 16months of the earliest priority date

Failure to file for a divisional application within the correct time period

Failure to request examination of the patent application

Failure to pay a second (or more) search fee when requested. Additional claims must be filed in separate applications claiming priority to the first or divisionals

1

1✓ b) The fee for reinstatement has been paid (along with the missed fees), the request for reinstatement has been filed and the evidence submitted was sufficient to convince the controller that there was a genuine mistake and intention to comply.

2

c) 13 months from the date of missed deadline in order to give some certainty to third parties, this date is not indefinite.

0

3

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6)

1✓ The request for a patent must be made (form NP1), a description or reference to a previous application must be filed, filing fee must be paid.

1

MARKS AWARDED: 1/3

7)

1✓ 1- Perhaps, everything that has been made publicly available before the filing date (or priority date) of the application is part of the prior art. If the abstract was publicly available before the filing date (or priority date); e.g., if the earlier application was published before the new application was filed; then it (the abstract) is prior art.

1

2- If the content of the abstract is wholly disclosed in the description of the application as filed then the specification may be prior art with the filing date of the patent application e.g. in cases where the prior art was filed before but published after the new application, the specification (which contains the same disclosure as the abstract), in this second case, would be novelty only prior art.

3- However, the abstract is not necessarily filed with a patent application and not necessarily precisely disclosed in the specification as filed. In this third case, the filing date of the patent application may not be the same as the abstract therein.

1✓ If the abstract was filed along with the application, then it will have the same filing and publication date as the application itself and can therefore be part of the novelty only prior art in the case where the new application is filed in the window between filing and publication of the earlier application.

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In the case where the abstract is filed up to a year after the application, the abstract can only be known from the publication date of the earlier application and so, in this case may be novelty and inventive step prior art.

MARKS AWARDED: 2/3

8)

The first step is to assess the competitor widget and decide whether it is covered by either of claims 1 and 2 (or some other allowable possible amendment from the patent description to claims 1 or 2). We should then pursue the subject matter that covers the competitor widget in this first application, as a priority.

- If the competitor widget is only covered by claim 1 then we should review the examiners report and prior art in detail and create a case for the allowability for claim 1 over the large amount of prior art. In this scenario, there is little value in making any threat to our competitor or giving them notice of our unpublished application as it seems unlikely that claim 1 will grant as it is and may need further amended during examination, but we must try to convince the examiner. If we were to issue them with notice of our unpublished application they may (allowably) request to see the unpublished application and adjust their widget accordingly, however this would extend the window by which they were aware of our patent application and the potential size of any successful litigation against them.

- If the competitor widget is covered by claim 2, after our assessment, then we may choose to respond to the examiner with an amendment limiting our claims to

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1✓
1✓
1✓
claim 2 and seek to file one or two divisional applications to the removed claim 1 and claim 3 subject matter. In this scenario we may issue the competitor with notice of our patent as soon as possible, after amendment to claim 2, giving the maximum period where they would be liable for future infringement proceedings. An infringer can only be held account from the first moment they were aware of the patent being cited against them – in this case that is either upon publication or our issuance of the letter making them aware of the patent application and its content. Making this amendment before publication would give the maximum notice to our competitor of potential infringement, in this scenario.

1✓
- On claim 3, it seems right to pursue the protection of the invention, at least until we have seen a search from the examiner. In light of the evidence that our competitor is not currently pursuing a widget adhesive, the best course of action would be to remove the unity objection by deleting claim 3. We will then either file a further application to claim 3 claiming priority to the first application (if the first application was filed within the last 12 months, we have not assigned the right to claim priority by contract elsewhere and the UK application does not already claim priority) or to file for a divisional application to the subject matter of claim 3. In either case, claim 3 should be removed from this application to expedite the allowance of either of claims 1 or 2 and hasten any action we may take against our competitor's product.

1✓
1✓
Since they are a competitor it is reasonable that they would become aware of our patent upon its publication. However, they may attempt the defence that they could not reasonably have been expected to know about the patent. To mitigate

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this we should add details of the patent number to our widget and make the competitor aware of our patent application as soon as we are comfortable that the claims will grant that cover their product.

1✓

The competitor would only be liable for infringement of our patent if their infringing activity is in the UK (and without our permission) – if they do not perform any infringing acts within the UK then they cannot be held to account based on the UK application. We should further analyse where our competitor undertakes any infringing acts such as: manufacturing, disposing, importing or storing their widget (or offering to do the same), in the UK or abroad, and seek to file further applications claiming priority to the UK application in those countries (assuming that we are still within the priority period for our first application).

Further, we would need to be clear on the relevant dates of sale or public disclosure of their product as it may for prior art to our patent application.

Also, the competitor can only be liable for infringement of a patent in the UK if they started their activity after the publication date of our patent. If the competitor started their activity before the publication (or other awareness of our patent application) they may be able to continue to produce their widget with certain limitations e.g., they cannot modify their widget to further infringe our claims and

0.5

1✓

only they or their nominated successor may practice.

Further, if the claims change between publication and grant then the future potential damages due to us will be reduced after any infringement proceedings that we have initiated.

12.5

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9)

Dr Reddy vs Eli Lilly

1

Dr Reddy sought a patent to a particular chemical composition 'olineprenone'(maybe?). Eli Lilly had a previous published application containing a Markush type claim for several thousand chemical formulas, spanning the formula sought by Dr Reddy. The issue at stake was: can the disclosure of a very broad Markush type formula remove the novelty of an individual formula within the large set of possible formulas.

1

The decision was made that the individual formula (the species) of Dr Reddy is Novel over the broad disclosure of Eli Lilly (the genus) since the individual formula was not explicitly disclosed, rather it was disclosed within a vast range of several thousand possible formulas.

1

The precedent this case sets is that an individual composition can be novel over a very broad range of disclosed Markush formulation options if that formula has not be explicitly and individually disclosed in the prior art document.

2

Actavis vs Eli Lilly

1

In this case Actavis had a patent granted claiming a specific product, Eli Lilly developed a product that had the same function as the claimed product but differed from the claimed product in one or more quantifiable ways. The issue at stake was should a claim cover just the elements and particulars that are stated

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or should it also cover the obvious alternate compositions that the skilled person might reasonably use in the context of the inventive concept.

1

The decision was that in this case, the alternative composition created by Eli Lilly did fall within the scope of the claims of Actavis based on the doctrine of equivalents, i.e., the skilled person at the time of filing the Actavis patent would have reasonably attempted the alternative composition of Eli Lilly as an equivalent solution to the problem solved by the claimed composition.

1

The precedent set by this case is not that the doctrine of equivalents is followed carte blanche, it is more narrow. The claims in combination with the specification and disclosures therein must be taken together on a case by case basis to be evaluated whether the skilled person, at the time of filing the patent, would reasonably select known alternatives to the specific wording of a claim and thereby allow for a claim to be taken as a purposive construction of a solution and not a limited single solution. Importantly, the specification is key to interpreting the claims in such cases as is the assessment of the skills and capabilities of the skilled person. Particularly, the skilled person must not invent or broaden the claims with hindsight, rather select from known equivalents at the time of filing the patent application in order to interpret the breadth of a claim.

2

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10)a)

Before the expiry of the 31-month national phase deadline of the PCT, file form

- 1✓ 1✓ NP1, pay the national fee and a translation of the French application into English
1✓
1✓ 1✓ claiming priority to the PCT application, giving a certified copy of the PCT to the
1✓ 1✓ UKIPO. Further, we should pay the search fee and file the request for search.

We must also file a declaration of priority and declaration of inventorship. Further

- 1✓ 1✓ we should pay the examination fee and file the request for examination as soon
1✓ as possible to expedite examination of the UK application. We should also file a
copy of the amendments made during PCT phase. A translation of the French
PCT priority document is not required unless requested by the controller.

8

b)

- 1✓ - Early access to state aid or tax incentives based on granted patent document
1✓
1✓ - Known competitor activity in the UK, seeking to initiate infringement against
known actors in the UK
1✓
1✓ - Gain a granted patent in the UK in order to increase the company value to
potential buyers in the UK
- Deliver on corporate goals/contracts for generating granted patents in the UK
- To obtain different protection for the invention from both applications in the UK.

3

The UK application may grant quickly with a particular claim allowing that
decision to inform a different branch of amendment to the claims for the EP
equivalent.

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c)

1✓ If the parallel EP application (which designates the UK) grants with the same
1✓ subject matter as the UK national application, an objection based on double
patenting will arise. In this case one of the direct UK application or the EP
derived application must be abandoned. In order to avoid this the UK application
may seek a different variation of the claims from those pursued in the EP (or vice
versa)

2

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