

Paper Ref	Sheet	Percentage Mark Awarded
<b>FC1</b>	<b>1 of 15</b>	<b>60%</b>

Examiner's  
use only

Question 1

The description of a patent must disclose the invention in a sufficiently clear and complete manner such that a person skilled in the art can work the invention. As perpetual motion machines are known in the art to be impossible, any description  
1✓ would not satisfy this requirement.

An invention must be industrially applicable. As perpetual motion machines are  
1✓ not known to exist, they do not satisfy this requirement.

Scientific discoveries or the discovery of a law of nature are not patentable. Because a perpetual motion machine, if truly feasible, would essentially be the discovery of a new law of nature, they would not be patentable.

**MARKS AWARDED: 2/3**

2

Page sub-  
total

Paper Ref	Sheet
<b>FC1</b>	<b>2 of 15</b>

Examiner's  
use only

Question 2

- a)
- (i) No, the priority application and the current application must have the same applicant, unless the rights of the priority application have been assigned to the current applicant.
- (ii) Yes, if the same person has the right to file and claim priority to both the PCT application and the current application
- (iii) No, priority may only be claimed with respect to a patent application or another form of protection for scientific inventions.
- b) Utility model (available in certain foreign countries)
- c) Taiwan is a member of the WTO, so UK patent applications can claim the priority of Taiwan patent applications (via the TRIPS agreement).  
However, this only applies to UK applications filed after Taiwan joined the WTO.

3

1

1

5

MARKS AWARDED: 5/5

Page sub-  
total

Paper Ref	Sheet
<b>FC1</b>	<b>3 of 15</b>

Examiner's  
use only

Question 3

a) Grounds for application for revocation:

- 1✓ Patent does not fulfil requirements of patentability as prescribed in the Patents Act (e.g., lack of novelty, lack of inventive step, pertains to an invention that is not patentable, etc.)
- 1✓ Patent was granted to a person who was not entitled to the grant of the patent
- 1✓ Patent does not disclose the invention in a sufficiently clear and complete manner for a person skilled in the art to work the invention
- 1✓ Patent as granted contains subject matter that extends beyond the original disclosure
- 1✓ Patent as granted contains an amendment that should not have been allowed for extending beyond the original disclosure

5

1✓ 1✓

b) In general, any person (including the proprietor of the patent) may apply for the revocation of a patent.

However, if the patent is to be revoked on grounds of non-entitlement of the grantee of the patent, only a person who claims to be entitled to the patent may apply for the revocation. A revocation on such grounds must

3.5

0.5✓ be filed within 2 months of the grant of the patent, unless it can be shown that the grantee of the patent knew he was not entitled to the patent at the

0.5✓  
0.5✓

time of grant.

8.5

**MARKS AWARDED: 8.5/10**

**Page sub-  
total**

Paper Ref	Sheet
<b>FC1</b>	<b>4 of 15</b>

Examiner's  
use only

Question 4

a) Reasons to refuse the issue of an opinion:

- Request is deemed frivolous or vexatious by the comptroller ✓0.5 0.5✓
- Res judicata – the issue in question has already been dealt with in a 1✓ previous proceeding with the comptroller or the court
- The comptroller decides the issue should be settled by the court
- 1✓ • Any reason for which the comptroller decides an opinion should not be issued 3

b) An examiner 1✓ 1

c) The opinion is not binding under any circumstances 1✓ 1

d) The requester; appeal must be initiated within 1 month of the UKIPO's 0.5✓ decision 0.5

**MARKS AWARDED: 5.5/7**

5.5

**Page sub-  
total**

Paper Ref	Sheet
<b>FC1</b>	<b>5 of 15</b>

Examiner's  
use only

Question 5

a) No reinstatement possible for missing the deadline for:

- Filing a new application where the earlier application was filed by one who was not entitled to a patent
- Obtaining a filing date
- Filing claims or description
- Appealing a refusal for patent
- Filing a divisional application

1✓

b) Criteria for reinstatement:

- 1✓ • The comptroller is satisfied that the failure to comply with the requirement was unintentional
- 1✓ • The required act to comply with the requirement has been performed
- An extension of time must not still be available under other provisions of the Patents Act or Rules

2

(part a)

0.5✓ c) 12 months from the failure to comply with the requirement

0.5

**MARKS AWARDED: 3.5/9**

3.5

Page sub-  
total

Paper Ref	Sheet
<b>FC1</b>	<b>6 of 15</b>

Examiner's  
use only

Question 6

Application must have a filing date, i.e., the following information/documents

1✓

must have been provided:

- A request for the grant of a patent
- Contact details of the applicant
- Something that appears to be a description, or a reference to an earlier application

1✓

In addition, the filing fee and search fee must have been paid.

2

MARKS AWARDED: 2/3

2

Page sub-  
total

Paper Ref	Sheet
<b>FC1</b>	<b>7 of 15</b>

Examiner's  
use only

Question 7

No, the abstract of a patent/patent application is not valid prior art. The abstract is only a concise summary of the invention described the patent/application and should not be used to interpret the invention/patent or considered part of the state of the art.

0

**MARKS AWARDED: 0/3**

0

**Page sub-  
total**

Paper Ref	Sheet
<b>FC1</b>	<b>8 of 15</b>

Examiner's  
use only

Question 9

1✓ Claim construction: Improver v Remington

Improver had a patent for a hair removal device that called for a rotary part with a helical spring. The spring would pluck out hairs as it rotated.

Remington had a patent for a similar hair removal device, which used a rubber tube with slots instead of a helical spring to pluck out hairs. Apart from this difference, the two devices were essentially identical.

1✓

Improver sought to invalidate Remington's patent on grounds of anticipation by its own patent. Improver claimed that the scope of protection of its own patent included Remington's device.

1✓

It was decided that the crux of the issue was whether the term "helical spring" in Improver's patent should be construed to include the slotted rubber tube of Remington's device.

Lower courts found no anticipation. The House of Lords affirmed.

Firstly, the court confirmed that purposive construction is the proper way of construing claims, rather than other principles such as pith and marrow. The language of the claims should be interpreted as they would be seen in the eyes of a person skilled in the art, rather than how the inventor intended it to be interpreted.

Page sub-  
total

Paper Ref	Sheet
<b>FC1</b>	<b>9 of 15</b>

Examiner's  
use only

Secondly, to resolve the issue at hand, the court devised the Improver questions as a test to see whether a variant of a patented invention should be included in the scope of protection of that patent. The questions are as follows.

- Does the variant fulfil essentially the same purpose as the claimed invention when the claims are interpreted literally?
- Would a person skilled in the art have understood that the variant fulfils the same purpose?
- Does the language in the description or the claims require the person skilled in the art to interpret the claims such that the variant should not be included in the scope of protection of the patents?

If the answer to the first two questions is yes and the third no, then the variant should be included in the scope of protection of the patent. In this case, the court found that although Remington's rubber tube did fulfil the same purpose as the helical spring of Improver and a person skilled in the art would have understood this, a person skilled in the art would not have interpreted the term "helical spring" to include a slotted rubber tube based on the language of the claims and description. Therefore, no anticipation was found.

3✓

The Improver questions became and still remain a widely used standard for claim constructions. However, subsequent cases, including *Kirin Amgen v Marion Hoescht Russell Limited* and *Actavis v Eli Lilly*, have confirmed that the Improver questions is only one way of implementing purposive construction and should not be considered the only standard. How suitable the Improver questions are in today's patent law remains to be seen.

6

Page sub-  
total

Paper Ref	Sheet
FC1	10 of 15

Examiner's  
use only

1✓ Obviousness: Windsurfing v Tabur Marine

Windsurfing had a patent for a windsurfing boat with a free sail held by two arcuate booms (a Bermuda rig). The free sail had the advantage that it could be let go in case of trouble.

Tabur Marine ("TM") attacked Windsurfing's patent on grounds of obviousness. TM claimed that similar apparatuses had been disclosed previously, and Windsurfing's apparatus was obvious in light of these:

- Prior use – a boy had been seen using the same apparatus some 10 years prior, except that the sail rig was attached to a paddle board instead of a boat
- 2✓ • A prior article in a windsurfing magazine had described the exact same apparatus, except that the rig used was a square rig instead of a Bermuda rig

Lower courts had found that the patent was valid. The House of Lords reversed, finding that Windsurfing's patent was obvious in light of the prior disclosure.

1✓ In the decision, the Windsurfing test was devised to answer issues of obviousness. The test involves the following steps.

- First, identify the inventive concept of the patented invention (in this case, the free sail with the Bermuda rig)
- 3✓ • Then, identify the person skilled in the art (in this case, windsurfers and related athletes and hobbyists, who would likely have seen the prior article in the windsurfing magazine)

7

13

Page sub-  
total

Paper Ref	Sheet
<b>FC1</b>	<b>11 of 15</b>

Examiner's  
use only

- Next, establish the common general knowledge of the person skilled in the art, i.e., what he would have known at the time of filing (in this case, the person skilled in the art would know about different rigs and their advantages, and they would likely have seen the prior article in the windsurfing magazine)
- Finally, establish whether the inventive concept of the invention would have been obvious to a person skilled in the art at the time of filing of the patent application (in this case, yes, a person skilled in the art would have known that the Bermuda rig had better manoeuvrability over the square rig and had a reason to adopt it instead)

In light of the above test, the court found Windsurfing's patent obvious. The Windsurfing test became a widely used standard for determining obviousness, until *Pozzoli v BDMO* revised the test by swapping the first two steps to form the Pozzoli test.

**MARKS AWARDED: 13/20**

Page sub-  
total

Paper Ref	Sheet
<b>FC1</b>	<b>12 of 15</b>

Examiner's  
use only

Question 10

a) Steps to be taken to enter national phase:

- 1✓ • File request for GB patent
- 1✓ • File English translations of the PCT application as filed and the amendment introduced during international phase
- 1✓ • Pay prescribed fees (claim fee and search fee)

1✓ To expedite prosecution, early publication of the application should be requested and a request for examination should be filed as soon as possible, preferably with the entry to national phase. All responses should be filed within their deadlines and no extension of time should be requested.

b) Reasons:

- 1✓ • Possible infringement of the patent is occurring in the UK and the client wants to begin proceedings
- 1✓ • UK is a major market for the invention and the client wants to begin business operations as soon as possible
- 1✓ • Obtaining allowable claims faster to submit to EPO or other countries to accelerate examination of corresponding patent applications in those places

5

3

Page sub-  
total

Paper Ref	Sheet
<b>FC1</b>	<b>13 of 15</b>

Examiner's  
use only

- 1✓  
1✓
- c) If the EP application has the exact same claims/scope of protection as the UK patent, double patenting will arise as two UK patents will have been granted for the same invention. However, if the EP patent is amended (during prosecution or after grant) such that its claims/scope of protection is different to those of the UK patent, no double patenting occurs.

2

**MARKS AWARDED: 10/20**

10

Page sub-  
total

Paper Ref	Sheet
<b>FC1</b>	<b>14 of 15</b>

Examiner's  
use only

Question 11

a) Deadlines that cannot be extended:

- 1✓ • Request for reinstatement of rights to a patent
- 1✓ • Late declaration of priority
- 1✓ • Late payment of renewal fee (not including restoration)
- Entry into GB national phase
- 1✓ • Filing an appeal to a decision

4

b)

(i) Response period to an examination report is a deadline specified

0.5✓ by the comptroller. Extensions are at the discretion of the

0.5✓ 0.5✓ comptroller; however, he must grant an extension of two months if  
the applicant applies for an extension (with the prescribed fee)

1.5

before the deadline arrives and no prior extension had been  
granted. Any further extension of time is at the discretion of the  
comptroller.

(ii) Renewal fees may be paid up to six months after the original due

0.5✓ date of the renewal if an additional fee is also paid at the same

2

0.5✓ 0.5✓ time. This 6-month extension is available as of right. No further  
0.5✓ extensions available.

(iii) The deadline for filing a statement of inventorship is the later of 16  
months from the priority date (filing date if no priority claimed) or 2

0.5✓ months from the filing date. An extension of 2 months is available

Page sub-  
total

Paper Ref	Sheet
<b>FC1</b>	<b>15 of 15</b>

Examiner's use only

0.5✓ of right if the statement is filing within the extended period with the prescribed extension fee. No further extensions available.

1.5

c) The deadline for filing a certified copy of a priority document is a deadline specified by the comptroller, so its extension is completely at the discretion of the comptroller, according to the Patents Act and Rules. The deadline for filing a statement of inventorship is statutorily defined in the Patents Act and Rules, so only an extension thereof can only be given according to the Act and Rules and no further extension can be obtained.

1✓

1

**MARKS AWARDED: 10/20**

10

Page sub-total