

Introduction

This year's pass rate was low, with the proportion of candidates scoring below 35 being much greater than usual. However, there were also candidates who achieved high marks on the paper showing a clear difference between those who were ready to sit the paper and those who were not. It was apparent that the lowest marks were obtained in Part B, where candidates were required to manage more complex or detailed scenarios. Those who passed did well across both Part A and Part B, applying good knowledge of the law and being able to address issues arising from complex situations.

This year the Examiners noticed a marked change in the general ability of candidates with a larger proportion than usual seeming to have a lower level of knowledge and experience. The main feedback points are given below.

- Many seemed ill prepared, not only in practice points but also in the law. Basic knowledge of fundamental law and formalities aspects was frequently lacking in accuracy and detail. As FD1 is a law paper, full knowledge of the key legal tests and standards and the ability to apply them are required.
- Candidates struggled to deal with the "real life" scenarios where not all information was present, and often made poor assumptions or failed to identify key points over peripheral issues. As this is a practice paper, these skills are critical.
- Careless mistakes, particularly with dates and calculations, were noticeably more prevalent than usual.
- Advice that a product can be launched because the client has a patent or a design right raised particular concern: these are negative rights and the ownership of a patent or design does not provide freedom to operate.

Once again, we urge firms to consider whether the candidates they are supporting have reached the right stage of their professional training for taking Final Diploma examinations.

Part A

Question number	Comments on questions
Question 1	The average mark achieved for this question was 3 out of 5. Question 1 was a short question designed to ease candidates into the examination. While most candidates scored reasonably, many missed one or two marks through poor analysis. Candidates need to give advice to their clients based on the law and the situation.

	<p>Expressions such as “because” and “due to” might help focus the mind and encourage giving advice within an answer.</p> <p>The Examiners were looking for an analysis of whether or not the situation was one where there was a public disclosure and, if so, whether it was enabling. There were two possible disclosures to consider: the document itself and the testing of the invention.</p> <p>Consideration of enablement was not well addressed on the whole. A completed patent application should be enabled but a draft may not be enabled. The fact that the coffee shop owner successfully implemented the invention from the information given in the draft was mentioned by some.</p> <p>The draft is specifically stated to be for an EP filing, so it is necessary to consider the stricter EP standard for such a disclosure (and recognition was provided for realising other territories may have lower thresholds).</p> <p>Candidates needed to consider and evaluate the significance of “Important” in the context of the question. The discussion of implied confidence was often not well discussed (the absence of confidential marking does not guarantee there is no implied confidence).</p> <p>Many candidates concluded there had been a breach of confidence and went on to apply the 6 month grace period on this basis, despite no evident abuse.</p> <p>Very few candidates used the correct wording for “evident abuse” or “intention to harm”. It seems that the understanding of this point (and the distinction between UK and EP law) was generally not appreciated.</p>
<p>Question 2</p>	<p>The average mark achieved for this question was 5 out of 10.</p> <p>Whilst discussion of registered designs was generally well handled, the complexities around unregistered rights were often not fully recognised. Most candidates noted that Senior has UDR in its frame, but very few noted that Alten also has UDR in addition to her application for a registered design. In fact, both parties independently created their designs and are, therefore, both entitled to UDR. However, in the absence of copying, they cannot stop each other via such unregistered rights.</p> <p>The question states “<i>You have recently filed ...</i>” and “<i>Subsequently ... made a prototype which she demonstrated ...</i>”. However, a significant number of candidates were concerned about public</p>

	<p>disclosure by Alten to Senior and the need to rely on a grace period.</p> <p>Few candidates seemed to identify that Alten had supplementary UKUDR, which is surprising given the recent changes in the law (and the FD1 Syllabus) relating to Brexit.</p> <p>Several candidates wasted time on irrelevant points such as detailing the length of registered design protection which, as the design application was recently filed, was not yet relevant to the client.</p> <p>Overall, however, this question was answered well by many candidates.</p>
<p>Question 3</p>	<p>The average mark achieved for this question was 4 out of 8.</p> <p>This question was straightforward for the majority of candidates.</p> <p>Most candidates were able to calculate both the compliance period and the examination report deadlines correctly. However, a surprising number of candidates stated that the exam report deadline could have been extended until 30 February. If, under examination conditions, the number of days in a month is elusive, then <i>“the last day of the month”</i> is acceptable and, in this way, the information to the client would at least have been accurate.</p> <p>Yet again, candidates who knew extensions of time did well. Restoration was not appropriate for this scenario because extensions were available.</p> <p>Good candidates also remembered to advise the filing of a response, which is rather critical when the question relates to responding to a substantive examination report.</p> <p>However, fewer candidates appreciated the need for swift action throughout. It was clear from the question that urgent action was required and that you faced an uphill battle to overcome the "comprehensive" objections. Candidates who said they would wait until they had obtained a discretionary extension before responding were not being diligent for their client.</p> <p>Procedural irregularities may provide a great remedial route, but the absence of a record of receipt does not prove the UK IPO/ postal system failed in any way. Recognition was given for checking, though relying on a positive outcome is risky. It is always advisable, therefore, to pursue multiple remedial routes in parallel where possible.</p>

<p>Question 4</p>	<p>The average mark achieved for this question was 3 out of 9.</p> <p>An unexpectedly high proportion of candidates did not appear to be familiar with the steps around grant of an EP patent and therefore overlooked these details, and could not achieve available marks. Candidates are expected to understand the interplay between the EP and UK systems.</p> <p>The question asks candidates to “<i>Advise your client on the situation</i>”, and so actions to be taken were expected in the answer. Fundamental to this question was appreciating when the fourth year maintenance fee was due at the EPO and whether or not it could have been paid. The rest of the answer flows from this assessment. Some candidates appreciated the EP renewal fee issue but failed to apply the law correctly. However, most simply missed it.</p> <p>It is essential that candidates know what renewal fees are payable, to whom and when. Errors were repeatedly made in these aspects.</p> <p>Many candidates also didn't pick up the marks for recognising that anyone can pay a renewal fee and for checking the client's new product against their own patent claims, despite clear clues in the question of these marks: "new UK based client" and "latest version".</p>
<p>Question 5</p>	<p>The average mark achieved for this question was 4 out of 10.</p> <p>Candidates need to analyse a situation and give advice to their client, providing sufficient information for the client to understand what is being said. For example, “<i>If the priority claim is valid the effective date of PCT1 is 17 December 2019, but if the priority claim is not valid the effective date is 17 December 2020. The actual priority date is at present unknown because ...</i>” However, whilst most candidates spotted that the priority claim for PCT1 might be invalid, many didn't appreciate the underlying reasoning for why this might be the case. Several assumed that the mismatch between the two Applicants would automatically render the priority claim invalid but did not consider that it was possible for an assignment to have taken place prior to filing PCT1 but it cannot yet be verified.</p> <p>Relatively few candidates identified the need to check ownership based on the clear disjoint between your client and the person who created the invention. Some candidates did an analysis of S39</p>

	<p>regarding employee inventions; this cannot apply, however, because at the time of conception Abacus did not exist.</p> <p>A purely practical mark was available for candidates who realised there would not be any clarity for some time. Often candidates assumed the position would be clear and they would somehow immediately be able to determine internal processes of a third party.</p> <p>Pursuing additional filings to maximise the opportunity for the client was not often captured. The compact invention was unpublished and had alleged benefits/challenges which were overcome.</p> <p>Candidates need to make sure their advice is appropriate for the client's needs. The scenario clearly stated that the general burner design was important to the client, as well as the compact units. As a result, any suggested claim amendment needed to try and ensure protection for both embodiments, especially as there were options for being able to protect the general burner.</p>
Question 6	<p>The average mark on this question was 3 out of 8.</p> <p>Candidates seemed to find this question difficult and this was reflected in the scores.</p> <p>Several candidates had appreciated there was a deadline for the filing of a translation but did not know what it was.</p> <p>With regards to the issue of the error, candidates generally understood the need to argue that it was obvious there was an error and that it was immediately evident that nothing else could have been intended, but many candidates did not discuss the two-step test in a logical way or provide much detail for why they came to their conclusion. The question provides the information that the sizes referred to in terms of metres would not provide suitable shoe sizes for the pets described, thus providing the answer to the first requirement. Candidates should then have made an argument that it is immediately evident nothing else could have been intended because, for example, centimetres require only the addition of a single character, while millimetres would be unsuitable because the shoes would be too small, or perhaps that changing the units completely to, for example, inches would also not remedy the error and so would not be considered. Regardless of the arguments made a reasoned approach was required.</p>

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	<p>A noticeable number of candidates expected that amendment could still be possible, despite being told in the question that the priority application also contained the error and it was throughout the specification.</p> <p>A number of candidates advised to simply withdraw and refile the application (if there was no intervening disclosure) but offered no alternative course of action if the withdrawal option was not available for them. Good candidates suggested that correction and refiling could be done in parallel (the first case is either anticipatory if correction is possible or not anticipatory as correction is not possible), or correction could be promptly pursued so refiling could at least be undertaken before publication.</p>
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Part B

Question number	Comments on question
Question 7	<p>The average mark on this question was 9 out of 25. Whilst this is low, a good number of candidates did achieve excellent marks on this question. Those who did identified the key and more complex issues.</p> <p>There were good marks to be obtained if the candidates followed the proper flow of assessing effective dates, calculating national phase entry dates and considering citability of PCT as novelty-only prior art. Many people missed marks though for not following the full flow, or for not considering EP and the US in addition to the UK. Where a question has multiple jurisdictions, marks are normally available for discussing all of them.</p> <p>A significant number of candidates did not provide the analysis to establish the effective dates for X in PCT1 and for X and Y in GB1. In addition to gaining the marks for the analysis, a clear statement of effective dates would help in establishing correct dates for national phase entry and reduce the number of errors made. A mark was available for realising that the PCT application could be filed claiming priority from GB1 with a request for restoration of the right to priority. However, almost every candidate incorrectly stated that a late filing of priority claim should be made. This is not correct because a PCT could not be filed within the 12 month priority period.</p>

	<p>Whilst the vast majority of candidates understood the concept of Section 2(3) prior art when applied to a PCT application, few presented a complete and accurate analysis of the possible national phase outcomes.</p> <p>It is clear from the question that your client is in a pretty desperate situation and her only chance to expand commercially (beyond TW) is via new filings. However, there is uncertainty around whether and where PCT1 has or will enter the national phase, and also which countries, if any, will accept the priority claim. You cannot wait until you have the answers to these points, as there is no time to do so. Instead, you should think about what you can do today for your client. A possible option is to file and claim priority anyway. The worst case scenario is that the priority is invalid but then you are only back where you started from.</p> <p>As Examiner reports have previously stated, it is generally inadvisable to abandon a priority date, but several candidates suggested withdrawing GB1 and refiling to cover only Z. There is always a risk of intervening prior art and, in this case, there is the disclosure to T which may not have been in confidence. Few discussed the impact of this if no CDA had been in place.</p>
<p>Question 8</p>	<p>The average mark achieved for this question was 7 out of 25. Again, the low average obscures the fact that this question was reasonably well tackled by a good proportion of those who attempted it, but the average was pulled down by a few candidates who were not sufficiently prepared for Final Diploma examinations.</p> <p>As previously noted, Examiners are expecting candidates to analyse a situation and provide clear, cogent advice to their client. In this context, if a candidate simply lists, for example, all forms of relief for infringement without identifying those that are relevant to the situation outlined in the question, this does not constitute either analysis or advice and cannot be awarded marks.</p> <p>Candidates generally recognised infringement but often didn't review the practical position and concluded that there seemed to be limited liability/impact in light of current circumstances.</p> <p>Candidates often state the law and practice as they understand it, but do not apply themselves to the situation set out in the question. For example, a candidate may write "<i>Need to determine who made a technical contribution to the car wash</i>" but this statement does not explain how to find the answer. You have a</p>

	<p>client who has informed you that the invention may have been made jointly. The obvious action is to ask the client what information she may have that could potentially identify whether or not she contributed to the invention once the application has been published. Assertions require justification.</p> <p>Marks were available for actions against both the GB patent and EP application because your client is UK based and, therefore, potentially affected by both. Many candidates missed marks by dealing with only one of them.</p> <p>The discussion of ownership was usually poor, as was the discussion of infringement and remedies in the context of Xand's activities: the theory was well understood, but the practical application of it was not well done.</p> <p>The scenario made it clear that evidence was required. Candidates were expected to identify where evidence was required and from whom, and then to advise on the basis of what might be found. For example, while entitlement proceedings might be a valid possibility for this scenario, evidence clearly needs to be gathered first so the strength of a case may be assessed before definitive advice can be given on whether or not to proceed.</p>
<p>Question 9</p>	<p>The average mark achieved for this question was 5 out of 25.</p> <p>Although a few candidates scored well on Question 9 a larger number did badly on this question.</p> <p>Use of the information given was key in this question. A complex array of disclosures by different parties, in different forms and scenarios, across a timescale of several years affected validity of the patents involved, as well as the actions and rights that were available to the parties. Candidates missed valuable marks by not considering the timing and impact of every disclosure.</p> <p>The crux of this question, however, was whether one or both parties could rely on prior use exemptions as a result of their activities, in a seasonal scenario. Once this has been worked out, advice could then be provided.</p> <p>The discussion around continuous activities and serious and effective preparations attracted a good number of marks but this was generally not very well delivered.</p> <p>It is important to present advice to your client and not to the other party or parties involved. In this case, options that were available to SAX were often presented. A list of options available to another</p>

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	<p>party is only relevant if advice is then given as to how it might impact your client and what actions might be taken to safeguard your client.</p> <p>At few candidates touched on the disclosure of eggs and questioned whether it could anticipate the moulds – a plug does not anticipate a socket but it may make it obvious.</p>
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