

## FD4

- This is a hard paper
- This paper can be passed
- You need to practise a lot
- If you practise, you pass

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## Mark Scheme

- Construction (20)
- Infringement (20)
  - Novelty (20)
- Obviousness (20)
- Sufficiency / Amendment / Advice (20)

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## Timing

- Only 5(?) hours
  - DO NOT type too soon
- POSSIBLY 2.5 hours on analysis
  - POSSIBLY 2.5 hours typing
    - It depends on YOU

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## Documents making up the Question

- Instructions – CGK? Insufficiency? Prior use? Other parties?
  - Patent – Construction, CGK? Prior art?
    - Prior art – §2(2) or §2(3)
    - Prior art - more prior art? CGK?
- Product or Process which may fall in scope of claim
  - People who may be infringing

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## Analysis

- What are you trying to do ?
  - Give Commercial Advice
- Select points which are important to the advice you are required to give
- Ignore points which have no commercial relevance

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## Analysis

- Skim read everything
  - Divide up the Claims
  - Read everything in detail
- Possibly re-divide claims as you go

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## Words in The Question

- Clues in the question
  - Patentese Words
  - Interesting Phrases
  - Nothing misleading

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## Basis

- ALWAYS note BASIS
- MUST include BASIS EVERYWHERE in your answer
  - No Basis, no marks
  - Page and line numbers
  - References to drawings
  - Reference to Case Law or PA

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## Selecting Key Points and Issues

- Select points which impinge on the advice you will give
- You MUST construe (parts of) the Claims
  - Many readings
  - YOU NEED A SYSTEM
    - In your head
    - Highlighting
    - Grid System

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## Grid System

| Patent  | Prior Art 1 | Prior Art 2 | Infringe ment 1 | Infringe ment 2 |
|---------|-------------|-------------|-----------------|-----------------|
| Lever   | Yes         | Yes         | No              | Yes             |
| Ratchet | No          | ???         | ???             | ???             |
| Pawl    | ???         | ???         | Yes             | Yes             |

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## Highlighting

A widget having a lever connected to a ratchet, wherein the motion of the lever is substantially constrained by a pawl and the lever acts on a moving mechanism which acts to advance a slide to a forward position.

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## Highlighting

A widget having a lever connected to a ratchet, wherein the motion of the lever is substantially constrained by a pawl and the lever acts on a moving mechanism which acts to advance a slide to a forward position.

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## Other Topics - Notes

- Obviousness
- Infringement (§60(1) or §60(2))
  - Other Infringers
  - Insufficiency
  - Amendment
    - Advice

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## Control Yourself

- Once you have done many readings, you should have points to think about
  - You will NOT get all the points
    - DON'T PANIC
  - 50% is a good pass/enough
- You have NOT finished reading

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## Construction

- Probably hardest part of question
- MUST know what the claims mean
  - MUST construe in a vacuum
- You can easily fail if you construe in light of infringement or prior art
  - Mainly based on the Patent
    - Can use CGK

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## Construction

- You MUST NOT construe in detail every word in a claim – no selection
  - You are looking for key points
- Only construe in detail points which make a difference to your advice
- Construction is NOT making up new words

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## Construction

- Construe sensibly
- Do NOT use dictionary definitions
  - Look for support in the Patent
    - Repercussive effect
  - Examples are usually narrow
    - Look to form vs function

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## Construction

- Amgen (HoL) Purposive construction ... is intended to give the patentee the full extent ... of the monopoly which a reasonable person skilled in the art, reading the claims in context, would think he was intending to claim.
- Virgin vs Premium – what PSA knows about drafting
- Actavis is NOT relevant to construction

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## Construction

- For each important point
  - Broad vs Narrow
- What do you feel comfortable with
  - Make a decision
  - STICK TO IT

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## Infringement

- Does anything fall within the scope of any claim?
  - EXPLAIN why EVERY feature of every claim is present ...
- ... in the same combination as in the claim
  - If not all features present ?

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## Infringement

- DIRECT - does the product or process fall within scope of the CLAIM as construed (§60(1))?
- CONTRIBUTORY - Does the product constitute a “means essential” according to the scope of the CLAIM (§60(2))?
- ACTAVIS - does the product or process fall in scope of PROTECTION (§60(1) or (§60(2))?

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## Infringement

- §60(1)(a) – product – makes, disposes of, offers to dispose of, uses, imports or keeps
- §60(1)(b) – process – uses or offers for use
  - §60(1)(c) – direct product of process – disposes of, offers to dispose of, uses, imports or keeps
- §60(2) – means essential – supplies or offers to supply

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## Infringement

- Make sure you knows §60(3) and §60(5) as well

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## Infringement

- Is there more than one potential infringer?
  - Who are the ACTORS?
  - What ACTS are they carrying out?
  - How do these ACTS relate to §60?

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## Novelty

- Check that the disclosure is enabling
- EXPLAIN where EVERY feature of every claim is disclosed ...
- ... in the same combination as in the claim

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## Novelty

**You must identify all the prior art and state that it is prior art.**

- Check the following
  - Date – is it §2(3) novelty-only prior art or §2(2) full prior art
  - Enablement – is the prior disclosure enabled
  - Prior use – find the evidence
  - Oral Disclosure – find the evidence
  - Is any of the earlier disclosure CGK?

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## Obviousness

- You may need to attack every claim
- If some claims CLEARLY lack novelty, you MAY not need to attack those claims
  - If some claims are CLEARLY not infringed, you may not need attack those claims
- Must set out your structure AND reasons

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## Obviousness

- FORGET problem/solution
  - Do Pozzoli
  - Pozzoli tests are similar to problem/solution but are NOT the same
- You need to show you know the differences and can apply them

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## Pozzoli

- 1a. Who is Skilled Person
  - 1b. What is their CGK
- 2. What is the Inventive Concept or Construe
- 3. Where do you start and what is the difference
- 4. Was it obvious to do the difference

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## Pozzoli

- CGK is VERY Important
- You CANNOT just combine two documents
  - Either document + CGK
  - Or CGK + document

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## Pozzoli

- The clues for GCK are in the question – client letter, patent, prior art – look for “WELL known”, “many years”, “conventional” or similar
  - Read the Question Carefully
- CGK is what a skilled person knows without thinking
- Patent documents and articles in journals are NOT CGK
  - Old documents are not usually CGK
- Review Articles, Handbooks, Encyclopaedias etc may be CGK
  - EXTENSIVE prior use may be CGK

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## Pozzoli

- Where you start is based on what the skilled person was thinking, not on features in common
- Usually, there is a reason for wanting to change something and so you start with that something

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## Pozzoli

- You then need to set out WHY the skilled person WOULD have made the change
- Just saying that the missing feature is in the prior art is NOT enough
  - Must give reasons

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## Sufficiency

- Is there a sufficiency point?
  - Max 3 marks
- It will be absolutely neon lit

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## Amendment

- Remember Amendment
  - Narrowing amendments only
  - No intermediate generalisations
  - Need to keep inventive step and infringement in mind
- Don't waste time on minor drafting errors

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## Advice

- What about Advice
  - Licences
  - Cross Licences
  - Change Product
    - Give up
  - Investigations

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## Typing

- Only start typing if you have a very good idea of what you are going to type
- Should be a mechanical exercise – you should have done all the thinking
  - Develop a style you can rely on
    - Do it in sections
  - Use few words but lots of space

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## Typing

- Do a construction section
  - You (and the Examiner) can refer to it
  - Helps you STICK to your construction
  - Give REASONS for your construction
- Make sure you end each point with a clear CONCLUSION
  - No point of construction is worth more than a page of typing

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## Typing

- Novelty and Infringement sections
- No need for prose – bullet points – but just ticks is not enough – needs clarity
- Every claim feature – even those you did not construe in detail

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## Typing

- Obviousness – you need to write prose
- Put yourself in place of skilled person
  - Use the clues in the question
  - Set out REASONS clearly
  - Come to a conclusion

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## Typing

- Amendment – provide basis and reasons why it improves Patentee's position
  - Sufficiency – is there a point? If so, address it quickly
- Advice – very case dependent – pick relevant points only from your list

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## Checking

- Try to check
  - Do NOT change your answer
- Make sure you have typed it so the Examiner can understand it
  - Look for omitted "not"

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## Summary

- Remember the time problem
- Select points to construe in detail
- Provide reasons for their construction
- Provide reasons for all other topics
- Type it out so it can be understood
  - Check what you have typed
  - DON'T PANIC