

FC1 UK Patent Law Mark Scheme
FINAL Mark Scheme 2022

SECTION A

Question 1

With reference to Section 1 ('*Patentable Inventions*') UK Patents Act 1977

- a) According to Section 1(1) what conditions must an invention satisfy in order to be patentable?

2 marks

- b) According to section 1(2), what are not inventions for the purposes of the UK Patents Act 1977?

8 marks

Total: 10 marks

Answer

- a) new (0.5), involves an inventive step (0.5), capable of industrial application (1 mark);

2 marks

- b) discovery (0.5), scientific theory (0.5), mathematical method (0.5)
literary (0.5), dramatic (0.5), musical (0.5) or artistic (0.5) works, any other aesthetic creation whatsoever (0.5)
scheme, rule or method (0.5 for each, maximum of 1 mark) for performing a mental act (0.5), playing a game (0.5), doing business (0.5), program for a computer (0.5)
presentation of information (0.5)
mention of the words 'as such' (0.5)

8 marks

Total: 10 marks

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Question 2

With reference to Section 36 of the UK Patents Act (*co-ownership of patents and applications for patents*) summarise the rights of joint proprietors of a patent.

8 marks

Answer

Each of them (0.5) shall be entitled by himself (0.5) or his agents (0.5) to do in respect of the invention concerned (0.5) for his own benefit (0.5) and without the consent of (0.5) or the need to account to (0.5) the other or others, any act which apart from this subsection and section 55 (crown use) amount to an infringement (0.5) of the patent concerned.

One of them shall not without the consent of the others (0.5)

- a) amend the patent (0.5) or apply for such an amendment to be allowed (0.5) or for the patent to be revoked (0.5);
- b) grant a licence under the patent (0.5) or assign (0.5) or mortgage (0.5) a share in the patent or in Scotland cause or permit a security to be granted over it (0.5)

8 marks

Question 3

- a) With reference to Section 117 UK Patents Act (*Correction of errors in patents and applications*) what errors may the Comptroller correct?
- b) What test must be satisfied before the Comptroller will make a correction of an error in the specification of a patent application?

4 marks

2 marks

Total: 6 marks

Answer

- a) an error of translation (0.5), transcription (0.5), clerical error (0.5) or mistake (0.5) in any specification of a patent (0.5) or application for a patent (0.5) or any document filed in connection with a patent or such an application (1 mark)
- b) The request shall not be granted unless the request is obvious (1 mark) – in the sense that it is immediately evident (0.5) that nothing else could have been intended (0.5) in the original specification.

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Question 4

a) Who can apply for a UK patent? **2 marks**

b) To whom may the patent be granted? **4 marks**

c) Under what circumstances must a statement of inventorship (Patents Form 7) be filed?
When must it be filed and what extension of time is available? Candidates do not need
to consider divisional applications.

4 marks

Total: 10 marks

Answer

a) any person (1 mark), alone (0.5) or jointly with another (0.5)

b) a patent may be granted to

(i) the inventor (1 mark);

(ii) any person who by virtue of law (0.5) or by virtue of an enforceable agreement (0.5) entered into with the inventor before making of the invention (0.5) was at the time of making the invention (0.5) was entitled to the whole of the property in the UK;

(iii) the successor in title to the above (1 mark)

c) If the applicant is not the inventor (1 mark). Must be filed by 16 months from priority (1 mark). Extension of time of two months (0.5) available as of right (0.5). Further extension at the discretion of the Comptroller (1 mark).

Total: 10 marks

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Question 5

- a) Describe the procedure for recording an assignment at the UK Patent Office.
2 marks
- b) Describe two potential consequences of a failure to record an assignment within six months of execution.
4 marks

Total: 6 marks

Answer

- a) file form 21 (0.5), pay fee (0.5), file evidence sufficient to establish the transaction (0.5) if not signed by the parties (0.5)
- b)
- (i) in infringement proceeding (1 mark) the assignee will not be awarded costs (0.5) or expenses (0.5) where infringement has occurred before the assignment was recorded (1 mark).
 - (ii) a person who acquires the patent application is not affected by the earlier (non recorded) assignment (0.5) if he did not know of it (0.5)

Total 6 marks

PART A TOTAL: 40 Marks

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SECTION B

Question 6

Write notes on two leading cases of the British Courts. For each case your notes should cover the parties to the case, a summary of the facts of the case, a summary of the decision and a brief discussion of what precedent is set by the case. One case should have claim construction as the main issue. The other case should have novelty or inventive step as the main issue.

Total: 20 marks

Answer

Parties to the case	(1 mark)
Summary of the facts of the case	(2 marks)
Summary of the decision	(2 marks)
Precedent set by the case	(5 marks)

Total: 20 marks

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Question 7

Your client Big PLC owns UK patent GB7654321 for a bicycle wheel. Big PLC have recently become aware of a third party who have recently started manufacturing an identical bicycle wheel.

Inspection of the status of the patent reveals that the patent is not in force as a renewal fee has not been paid. You have worked for this client for many years and are aware that one of the directors is responsible for payment of renewal fees. You are also aware that this director has recently left the company. Your firm is the address for service for the patent.

Prepare notes for a meeting with your client. Consider actions your client could take and also any potential third party rights.

Total: 20 marks

Answer

1. If the renewal fee fell due in the last six months (1 mark) then pay late with a surcharge (1 mark). No rights are lost (1 mark). Send a letter before action (1 mark). Some explanation as to why this is not a threat (1 mark). If this does not resolve the matter then begin infringement proceedings (1 mark).
2. If the renewal fee fell due more than 19 months ago (1 mark) there is nothing that can be done (1 mark).
3. If the renewal fee fell due between 6 and 19 months ago then apply for restoration (1 mark). One must show that failure to pay the renewal fee was 'unintentional' (1 mark). Evidence is required (1 mark). Investigate what has happened to the notifications from UKIPO, in particular were they sent to the client? (1 mark) Investigate with the client what happened internally to the reminders when received (1 mark). Does the client have any evidence of intention to pay the renewal fee? (1 mark)

Third party rights -

1. if manufacture started in the six months when the renewal fee could have been paid late (0.5 marks) then there are no third party rights (0.5 marks). If manufacture started after notification of non-payment (0.5 marks) but before an application for restoration is published (0.5 marks) then if this was done in good faith (1 mark) the third party can continue to do the act (1 mark). This does not extend to granting a licence (1 mark). Customers of the third party can deal in the product as if they came from the third party (1 mark).

Total: 20 marks

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Question 8

Your client filed a UK patent application (GB1) on 3 October 2018 with no priority claim. The application describes a V1 valve and includes one independent claim to the V1 valve. The V1 valve has advantages over existing valves.

The client then developed the V2 valve. The V2 valve is similar to the V1 valve but has slightly different features.

On 30 September 2019 your client filed a second UK application (GB2) claiming priority from GB1. The second application includes all of the first application, a description of the mark two valve and a second independent claim to the V2 valve.

For each of the following disclosures state whether it may be relevant prior art for the purposes of novelty and inventive step for both independent claims of GB2. Explain your answer. In addition, for each disclosure explain what further information, if any, is needed.

- a) A valve sold extensively and only abroad from 2015 to 2018. **2 marks**
- b) A tender for manufacturing proposals from your client for the V2 valve dated 10 September 2019 and marked 'in confidence'. The document describes the V2 valve in detail and was sent to one hundred manufacturers in the UK and abroad. **3 marks**
- c) A journal article dated 9 October 2018 describing some of the details of the V1 valve. **3 marks**
- d) The same journal article as (c) only now with a statement that it is a report of a conference held on 22 September 2018. **2 marks**
- e) A UK patent application filed on 20 September 2018 and published on 26 March 2019. It has now been withdrawn. The application describes valves similar to the V1 and V2 valves. **4 marks**
- f) A European patent application designating GB, filed on 10 June 2018 and published on 12 December 2019. The content of the application is identical to that of (e). **1 mark**
- g) A PCT application filed in Japanese at the Japanese Patent Office. The PCT designates GB but not EP. It was filed on 10 April 2018 claiming priority from a Japanese patent application filed on 11 April 2017. The PCT was published on 14 October 2018. The PCT describes a valve similar to the V2 valve. The priority application describes a valve which lacks key features when compared to the V1 and V2 valves. **5 marks**

Total: 20 marks

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Answer

- a) Full prior art for both claims (0.5) sale is a public disclosure (0.5) sale is before the effective filing date of both claims (0.5) location is irrelevant (0.5)
- b) V1 claim – tender document not citeable for either novelty or inventive step as it is dated after 3 Oct 2018. (0.5)
V2 claim – tender document is only not prior art if the recipient was under an obligation of confidence (0.5). The burden of proof lies with the patent proprietor (0.5). The large number of copies may be relevant (0.5). Also of relevance is the nature and position of the person receiving the communication (0.5). If the document is not in confidence, then it is citeable for both novelty and inventive step (0.5).
- c) V1 claim – not citeable for either novelty or inventive step (0.5) as published after the filing date of the mark one application (0.5). Was the submission to the journal before 3 Oct 2018 (0.5) and if so, was it in confidence? (0.5)
V2 claim – journal citeable for both novelty and inventive step (0.5). Not a novelty destroying disclosure (0.5).
- d) V1 claim – was the conference open to the public or was there a duty of confidence? (0.5) Paper published shortly after the conference and therefore is assumed to be an accurate summary of the talk (0.5) . The talk may possibly be citeable for both novelty and inventive step (0.5).
V2 claim – same as (c) above (0.5).
- e) V1 claim – the patent application has been published (0.5). Subject matter in the application both as filed (0.5) and published (0.5) is therefore novelty only prior art (0.5) as filed before 3 Oct 2018 but published after (0.5). However, the disclosure is only ‘similar’ and therefore unlikely to be novelty destroying (0.5).
V2 claim – application citeable for both novelty and inventive step (0.5) as published before 30 Sept 2019. Subsequent withdrawal of the application is irrelevant (0.5).
- f) V1 and V2 claims – The EP application is novelty only prior art (0.5) for subject matter in the application both as filed and published (0.5).
- g) V1 claim – PCT is novelty only prior art (0.5) if entered into the UK national phase (0.5) and an English language translation is filed at UKIPO (0.5). However, the disclosure of the PCT is not novelty destroying for the V1 claim (0.5).
V2 claim – PCT is full prior art for both novelty and inventive step (0.5) as the PCT was published before 30 Sept 2019 (0.5).
The priority claim is not relevant (0.5) as the PCT was filed before the filing date of the mark one claims (0.5). The priority application is not prior art unless it was published before 3 Oct 2018 (0.5). Unlikely as 18 months from 11 April 2017 is 11 October 2018 (0.5).

Total: 20 marks

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Question 9

a) Your client writes

“As you know we make printers. An employee in the design team has invented a new type of printer and we have now obtained a granted patent for it. The printer is now becoming very valuable to our business. We were always aware that this might be the case and so had all our employees sign a new contract of employment which includes a term that anything invented by an employee is the property of the company and the employee has no financial claim on it. Nonetheless, can the employee obtain some form of compensation? If so, where would they need to apply and when? Further, what factors would be taken into account when determining if an award is to be made in the employee’s favour?”

8 marks

b) Your client further writes

“We also own a patent having a single claim to a method of manufacture of a steel plate using a metal roller having a very distinctive surface pattern. We have identified a UK distributor of steel plates bearing this pattern. The plate is manufactured abroad. Does the distributor infringe our patent?”

4 marks

c) Your client further writes

“one of our patents has recently reached the end of its 20 year life. We have a large amount of stock which is marked as patented and are currently running this stock down. One of our competitors has threatened to take legal action on the grounds that we are now falsely marking our product as patented. What is the penalty for this and what defences do we have?”

5 marks

d) Your client further writes

“The threat from the competitor made us review the recently expired patent. On review we realised that the competitor appears to be infringing the patent and has been doing so for some time. Presumably as the patent has now expired there is nothing we can do about it?”

Prepare notes for a meeting with your client addressing all of the above points

3 marks

Total: 20 marks

Answer

- a) The additional term in the contract of employment is unlikely to be enforceable (1 mark). The employee is entitled to compensation if he/she can show the patent is of ‘outstanding benefit’ (1 mark) having regard to the size (1 mark) and nature (1 mark) of the employers undertaking. It must also be ‘just’ to make an award in the employees favour (1 mark). The application must be made to the Court or the Comptroller (1 mark) and must be made in the period from grant to one year after the patent has ceased to have effect (1 mark). Also some mention of the wording ‘in the course of normal duties’ or similar wording (1 mark).
- b) realising further information is required (1 mark). Is the plate manufactured by the claimed process or by a different process? (1 mark). Some discussion of the word ‘directly’ (1 mark). It does not matter that the method was performed abroad, it is the act of possession/importation in the UK that is the infringing act (1 mark).

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- c) penalty is a fine on conviction (1 mark). Two defences – firstly that the representation was made after the patent expired and before the end of a period with is reasonably sufficient (1 mark) to enable the accused to take steps to ensure the representation is not made/continues to be made (1 mark). Secondly, the accused used due diligence (1 mark) to prevent the commissioning of the offence (1 mark).
- d) Cannot take action for new acts of infringement as the patent has now expired (1 mark). However, one can take action for acts of infringement committed whilst the patent was in force (1 mark) and in the period of six years back from the date of the claim (1 mark).

Total: 20 marks