

Paper Ref	Sheet	Percentage Mark Awarded
FC1	1 of 17	64%

Examiner's use only

Section A

Question 1

(a)

- The inventive must be novel and inventive 0.5 0.5
- The invention must not be excluded under section 1(2) of the act
- The invention must be capable of industrial application ¹
- The invention must not be prohibited from invention under sections 3 and 4A

2

(b)

Inventions that excluded by Section 1(2)

- Scientific theories, mathematical models/methods, discoveries 0.5 0.5 0.5
- Musical, artistic, Literature, dance, aesthetic creations whatsoever 0.5 0.5 0.5 0.5
- Scheme or rule for playing a game, performing mental act, method/way of doing business, computer program, 0.5 0.5 0.5 0.5
- Presentation of information 0.5

7.5

The above are excluded provided the invention falls solely within the exclusion category as such. 0.5

MARKS AWARDED: 9.5/10

9.5

Page sub-total

Paper Ref	Sheet
FC1	2 of 17

Examiner's
use only

Question 2

- The co-owners of a patent have an equal and undivided share of the patent.
- They cannot assign, mortgage or license the patent without consent of all co-owners. 0.5 0.5 0.5
- They cannot amend the patent without consent of all co-owners. 0.5
- They cannot commence revocation proceeding without the consent of co-owners. 0.5
- They cannot enter/cancel licence as of right without the consent of all co-owners.
- They can bring proceeding against others unilaterally, but must make the other owners aware of proceeding, however they are not liable for cost unless they participate in proceedings.
- They can work the invention independently from the other co-owners. 0.5

MARKS AWARDED: 3.5/8

3.5

Page sub-
total

Paper Ref	Sheet
FC1	3 of 17

Examiner's
use only

Question 3

(a)

0.5

The comptroller may correct errors or mistakes that relate to

- Transcription 0.5
- Translational 0.5
- Clerical 0.5
- Typographical

(b)

The error or mistake must be obvious to the comptroller/skilled person such that it is clear nothing other than the correction could have been intended at the time of filing the application.

1.5

MARKS AWARDED: 3.5/6

3.5

Page sub-
total

Paper Ref	Sheet
FC1	4 of 17

Examiner's
use only

Question 4

(a)

Any person can apply for a patent, either solely or jointly.

Must be a natural or legal person, so incorporated bodies can also apply for patents.

(b)

A patent may be granted to

- Primarily to the inventor or inventors, 1✓
- Or in preference, by enactment or any rule or law, foreign law, any international treaty or convention, to any person who entered into agreement with the inventor or inventors, before making the invention, who was at the time whole entitled to invention, whilst in the UK. 0.5
- Or to the successor in title to the persons above 1✓
- And no one else.

(c)

A statement of inventorship should be filed when the applicant or applicants are not the inventor or inventors, and where this and the derivations of rights are not made on filing. 1✓

The statement of inventorship should be filed within 16 months of the earliest priority date of the invention. Rule 10(1). 1✓

The statement of inventorship is listed in part 2 of schedule 4 of the act and therefore is extendable by rule 108(2) and 108(3). 0.5 0.5

2

4

Page sub-
total

Paper Ref	Sheet
FC1	5 of 17

Examiner's
use only

Rule 108(2) gives an extension as of right, can only be used one, must be applied for in writing, using a PF52 form and paying prescribed fee. The ^{1✓} extension is for 2 months and can be applied for between the period in which the deadline passed (i.e. after the 16 months) and 2 months thereafter.

Rule 108(3) is a discretionary extension of another 2 months as the comptroller sees fit. The Comptroller may request evidence. Another PF52 + fee is required unless the request is made at the same time as the extension under R108(2).

4

MARKS AWARDED: 10/10

10

Page sub-
total

Paper Ref	Sheet
FC1	6 of 17

Examiner's
use only

Question 5

(a)

- The request must be filed to the UKIPO in writing, with statement + evidence of the assignment along with a fee. The assignment must be signed by the assignor + purchaser. There must be a sworn/signed statement from a witness testifying to the truthfulness. The assignor is a corporate body, then a company seal is required.

0.5
0.5
0.5

1.5

(b)

- A later transaction, instrument or event (such as an assignment) will have entitlement over an earlier transaction that has not been registered within 6 months providing
 - The person registering the later transaction did not know at the time of registration of the earlier transaction, and
 - Or where the patent is not published, that the earlier person of the first assignment did not provide notice to the Comptroller.
- A person will not be able to claim damages/account of profits (retroactively) if not assigned

0.5
0.5

2

1

3.5

MARKS AWARDED: 3.5/6

Page sub-
total

Paper Ref	Sheet
FC1	7 of 17

Examiner's
use only

Question 6

Case 1

Actavis v Eli Lilly

Actavis sought a declaration of non-infringement in relation to a medicament that includes a pemetrexed salt and vitamin B12 in acid.

Eli Lilly had a UK patent in force with a scope with a claim that protected the medicament with B12, acid a pemetrexed disodium. Actavis believed that by changing the salt to dipotassium instead of the disodium they would circumvent the protection conferred by Eli Lilly's patent.

The High court and Court of Appeal held that the Actavis did not infringe Eli Lilly's patent and the case was referred to the UK Supreme Court. The Supreme Court overturned the decision of the lower courts stating that Actavis would infringe the patent.

The precedent set by the decision was to reformulate the purposeful claim construction test as laid out in Catnic and Improver where the previous test was from the point of view of the notional person in the art.

- Does the item fall within the literal wording of the claim? And if not,
- Does the item as a variant of invention perform in the same way as the invention in ways that are otherwise immaterial?

The new test

- Does the item perform that item perform the same function in substantially the same way as the invention?

1

1

1

Page sub-
total

Paper Ref	Sheet
FC1	8 of 17

Examiner's
use only

- Would the skilled person know at the time of filing the application that the invention performs the function in the same way?
- Would the reader of the patent believe the patentee intended that the strict compliance with literal wording of the claim?

If the answer to the above question is yes, yes, no then the act would be deemed to infringe the patent.

The decision brings the UK into closer alignment with similar doctrine of equivalent provisions of the USPTO AIA and the EPC.

It is somewhat contentious as it appears to extend the scope of protection conferred by a claim to embodiment not listed in the specification and potentially makes it unclear/uncertain to 3rd parties if certain acts are protected by patents or not.

Case 2

Windsurfing vs Tabor Marine

Windsurfing has a granted patent to a boat that comprise a dual boom system that could easily detach for safety and storage purposes. Tabor challenged the patent on the grounds that that the patent lacked inventiveness in light of two prior disclosures

- A young boy who claimed to invent as similar boom, that was attached to a paddle board
- A prior art publication that has the boom attached to a differently shaped (square) boat.

3

1

1

Page sub-
total

Paper Ref	Sheet
FC1	9 of 17

Examiner's
use only

The house or lords overturned the decisions of the lower courts and said that the patent lacked inventiveness over the prior disclosures and set out the 4-step inventive step that was later reformulated in Pozzoli

- 1) Identify the invention, and where it cannot be identified, construe it

In the case of windsurfing v tabor, step 1 was construed to be a detachable boom with a bangor shape

- 2) Identify the notional skilled person in the art and the common general knowledge available to him

The skilled person of step 2 was determined to be a manufacture, designer and hobbyist who would have been aware of the prior art publication.

- 3) Identify the differences (if any) between invention as defined in step 1 and the closet prior art,

The differences were the shape of the boom, the attachment to the boat instead of a paddle board

- 4) Any determine if the skilled person would consider such differences constitute an inventive step, without prior knowledge of the invention (i.e. no hindsight)

It was deemed that the skilled person having view of the prior art publication would understand that the boom could be readily attached to other vessels and therefore the patent lack inventive merit.

MARKS AWARDED: 12/20

12

2

2

Page sub-
total

Paper Ref	Sheet
FC1	10 of 17

Examiner's
use only

Question 8

Assumption for question – The question states that the V2 is similar to v1 but has slightly different values. My answers below are on the assumption that the said different values mean that V2 is not disclosed by GB-1 and therefore cannot claim priority from it.

Also, the question says ‘...state whether it may be relevant prior art for the purposes of novelty...’. It don't believe the question is clear to whether if we are meant to determine if the disclosure forms part of the state or the art, or actually assess it for novelty, or both.

0.5 (a) The valve sold abroad is relevant for both novelty and inventive step for both V1 and V2. The earliest priority data to V1 is 3 Oct 2018, however the mentioned valve were sold from 2015. GB-2 claims partial priority to GB-1 however, as V2 was not present at all in GB-1, it cannot claim priority rights from this date. Instead, the earliest priority right to V2 is the 0.5 filing date of GB-2 which is 30 September 2019. For novelty s2(2) it makes no difference to where in the world the disclosures are made. 0.5 Hence the disclose made in 2015 (up to 2018) makes it form part of the state of the art by S2(2) and can be considered for inventive step.

1.5

(b)

0.5 I. V1 independent claim – The priority right of V1 is 3/10/18 (from GB-1) and the manufacturing details were not sent until after this date. Hence it does not form part of the state of the art and cannot be used for either novelty of inventive step against V1.

Page sub-
total

Paper Ref	Sheet
FC1	11 of 17

Examiner's
use only

- II. Section 2(4) of the patents act provides provisions that do not constitute disclosures that form part of the state of the art, one of which is disclosures made by the inventor in confidence, even when the confidence has been unlawfully breached. The disclosure must be made within the 6 months prior to filing the application, and details on the disclosure must be made on filing on at the UKIPO (which is not stated in the question). As mentioned, the priority date of V2 is the filing date of GB-2 which is 30/9/19. If the criteria above is met then they would not be relevant for novelty or inventive step.
- 0.5
- 0.5
0.5
- If no evidence was provided on filing and the manufacturer had no obligation to be confidential, then it would be prejudicial to novelty and inventiveness
- (c)
- I. V1 – the journal is published after the priority date of the V1 (3/10/18) and therefore it is not part of the state of the art for V1 and not relevant for either novelty or inventive step (despite disclosing some of the details of V1). Also, novelty requires all of the features to be shown in a single disclosure. The question implies that the journal does not have all the features of V1 so cannot be relevant for novelty.
- 0.5
- 0.5
- II. V2 – Is S2(2) art and relevant for inventive step. However the question states that the V2 is similar but different to V1. The disclosure made by the journal article (is implied by the question)
- 0.5
- 0.5

2

Page sub-
total

Paper Ref	Sheet
FC1	12 of 17

Examiner's
use only

not to have all features of V2 and the journal will not be cited for novelty. However, it may be cited for inventive step.

2

(d)

I. V1- I feel like the meant to answer that this would be constitute a pre-filed/post-published disclosure (i.e. s2(3)) against V1, however question (c) states that it has 'some of the details of V1'. Novelty, whether for 2(2) or 2(3) needs comprise ALL of the features. So it will not be cited for novelty and so the fact that the article is a report of a conference held before the priority date of V1 changes nothing. Again, not relevant for inventive step.

0.5

1

II. V2 – the disclosure is still forms part of the state of the part for novelty and inventive step, but as the question says its different, V2 is novel over the disclosure.

0.5

(e)

I. V1 – The UK patent would be part of the state of the art under s2(3) and as it has an earlier priority date, but later publication date (than the priority right of V1). However, S2(3) is to prevent double patenting so I believe the withdrawal of the means would be it would not be considered for novelty. Inventive step is not considered by 2(3) art. Also, the word 'similar' implies to me 'not the same', the valve of patent would need to the same for novelty.

0.5

0.5

0.5

0.5

2.5

II. V2- the priority date and publication date of the GB application predate the priority date of the invention so it would form part of the state of the art under s2(2). It would be considered for novelty and inventive step

0.5

Page sub-
total

Paper Ref	Sheet
FC1	13 of 17

Examiner's
use only

regardless to the withdrawal of the application, but again 'similar to v2' is not the same as v2 so would not be novelty destroying.

(f)

I. V1 – novelty s2(3), not inventive step – but isn't relevant to novelty

0.5 because question says 'similar' implying different.

0.5 II. V2 – novelty s2(3), not inventive step – but isn't relevant novelty because question says 'similar' implying different

(g)

10

MARKS AWARDED: 10/20

1

Page sub-
total

Paper Ref	Sheet
FC1	14 of 17

Examiner's
use only

Question 9

(a)

The patents act states:

An invention made by the employee belongs to the employer if it is made over the course of their duties of the employee, or if not part of their duties, tasks assigned to them and where there is a reasonable expectation the invention would arise from the performing those duties or actions. Similarly the patent belongs to the employer is the over the course of their duties and where the employee has a special obligation to further the interests of the employer undertaking. All other inventions shall belong to the employee.

As your company makes printers and the invention is a new printer, it would appear that the creatia above is met (i.e. the printer was made over the course of the duties of the employee) and there is no dispute over the ownership of the printer belonging to the employer.

However, the patent act states that no term entered into by the employee with their employer (or someone connected to the employer) will be enforceable if it ^{1✓} diminishes their rights in respect to employee invention ownership and compensation.

The patent act states that employees are entitled to compensation and therefore the term of the contract that diminishes their right to compensation in not enforceable.

In awarding compensation to the employee(s) for inventions that belong to the ^{1✓} employer, the comptroller will take into amongst other things, the size and nature ^{1✓}

Page sub-
total

Paper Ref	Sheet
FC1	15 of 17

Examiner's
use only

of the employer undertaking and to whether the invention has been of
 1✓ outstanding benefit. If it is 'just' that employee(s) be given compensation, or
 1✓ additional compensation where the benefit derived by the employee is
 inadequate compared to the benefit derived from the employer, then the
 comptroller will award such compensations.

As you have said, the printer is very valuable to will business, it appears to meet
 the criteria of the invention being of 'outstanding' benefit and therefore the
 employee will be able to claim compensation.

The amount of compensation awarded will be judged on the what is the 'fair
 share' taking into consideration, the invention in question, the patent of the
 invention and the assign/rights in or under the patent.

Furthermore, the comptroller will take into account the skill and effort of the
 employee, the skill and effort of their colleagues, any contributions made by the
 company (i.e. administration task, research material provided etc).

1✓ The employee can apply to either the courts or the Comptroller of the UKIPO for
 compensations. There is no time limit in which the employee can claim
 compensation. Even if the employees dies, the rights to derive benefit from the
 invention are passed on to his inheritors who can pursue the claim.

(b) An act is determined to be infringing a UK patent in the patent is in force in
 the UK and the act is done without the consent of the proprietor. This includes
 processes where the infringer uses the process, or offers to use the process and
 knew or had reason to know at the time that the patent was in force. Also,
 persons that dispose, offer to dispose, import or keep products are that made

6

Page sub-
total

Paper Ref	Sheet
FC1	16 of 17

Examiner's
use only

from said process are deemed to infringe. It is likely that the UK distributor infringes your patent by importing the plate.

1

(c)

1✓ The patents act does have a provision to fine by a monetary amount, the persons that are falsely or misleadingly either stamping or engraving their products as patented or pending if that is not the case.

1✓ However there are provisions that allow for timely disposal of stock that carries such markings if it was correctly true (i.e there was a patent that has expired, withdrawn, been revoked). This allows the proprietor to get rid of old stock

1✓ without worrying about a fine.

3

If it can be established that the proprietor acted due diligence, then he will not be subject to the fine.

(d)

As the patent has reached the maximum life, it cannot be reinstated. However, the current status of the patent has no bearing on infringing act whilst the patent was alive. Hence it may be possible to claim damages or account of profits

1✓ between the time infringing act commenced (providing it was after publication of the patent) and before the expiry of the patent. However, as the patent has now

1✓ expired, no remedies are available for acts performed out the expiry (and the competitor can continue to make the product).

2

12

MARKS AWARDED: 12/20

Page sub-
total

Paper Ref	Sheet
FC1	17 of 17

**Examiner's
use only**

**Page sub-
total**