

Introduction

Candidates scored well this year. Many candidates displayed a detailed knowledge of the UK Patents Act. However, as always, there were a small number of candidates who were clearly insufficiently prepared for the exam.

As in previous years, many candidates could not be awarded available marks due to the way in which they structured their answers. Candidates are advised to spend some time thinking how they are going to answer a question before they start writing. In particular they should ensure they have answered all parts of the question. Typically, the questions are designed so that answers can be divided into separate sections.

Questions

Part A

Question number	Comments on questions
Question 1	Question 1 asked what conditions an invention must satisfy in order to be patentable and what are not inventions for the purposes of the Act. This was a simple test of rote learning on a core part of the syllabus. Nearly every candidate scored well.
Question 2	Question 2 related to the rights of joint proprietors of a patent. Again, this was answered well by candidates.
Question 3	Question 3 asked which errors can be corrected by the Comptroller and what test must be satisfied before the Comptroller can do so. A surprising number of candidates were not aware of the test, i.e. the Comptroller can only correct an error if the correction is obvious, in the sense that it is immediately evident that nothing else could have been intended.
Question 4	Question 4 related to who can apply for a patent, to whom a patent may be granted and also to when a statement of inventorship must be filed. Almost all candidates appreciated that any person can apply for a patent. There seemed to be some confusion, however, as to whom the patent may be granted. Almost all candidates answered the part of the question relating to the statement of inventorship well, with most candidates knowing what extensions of time were available.
Question 5	Question 5 related to the procedure for recording an assignment at the UK Patent Office and potential consequences of a failure to record such an assignment. A surprisingly large number of candidates were unaware that one only needs to file evidence to establish the transaction if the Form 21 is not signed by both parties. Most candidates were familiar with the consequences of failure to record the assignment.

Part B

<p>Question 6</p>	<p>Question 6 asked the candidates to write notes on two leading cases of the British courts, one relating to claim construction and the other relating to novelty and inventive step. Overall the examiner felt that this year's answers were better than for similar questions in previous years. Previous examiner reports have emphasised the importance of reading beyond the simple headnotes to cases and reading the cases themselves. Many candidates appear to have followed this advice, which was evident in their answers.</p> <p>A small number of candidates provided summaries of cases relating to topics other than claim construction or novelty or inventive step. These attracted no marks.</p>
<p>Question 7</p>	<p>Question 7 related to failure to pay a renewal fee and also any third-party rights that may accrue due to such failure.</p> <p>The answer to this question fell neatly into two halves. Many candidates lost marks by simply approaching this question in a "stream of consciousness" manner and mixing together the two issues.</p> <p>Of the candidates who structured their answers well, most candidates were able to appreciate the three different possibilities for late payment of the renewal fee: payment as of right within the first six months, payment at the discretion of the Patent Office between six and 19 months and then no possibility of payment later than 19 months. Candidates, however, seemed to be more unsure as to the third-party rights that could accrue and, in particular, exactly when they start and end.</p>
<p>Question 8</p>	<p>Question 8 was the least popular question on the paper and related to the effect of various documents as prior art on two independent claims in a patent application. The question was, in fact, very straightforward but had a large number of constituent parts. For each of the seven sub-questions, candidates needed to consider both novelty and inventive step for two claims. By far the best approach to this question was to create a table with a row for each claim and a column for each sub-question. Disappointingly, very few candidates took this approach. Of all of the questions on the paper, it was here that poor planning resulted in many candidates not achieving available marks.</p> <p>For Part (a), almost all candidates appreciated that the fact that the valve was sold only abroad made no difference. Novelty is a worldwide test.</p> <p>As to Part (b), the question here is whether the disclosure was in confidence or not. The fact that the tender was marked "in confidence" does not necessarily make it so and the fact that it was sent to 100 manufacturers in the UK and abroad suggests that this might not be the case.</p>

Question 8	<p>As to Parts (c) and (d), whilst the journal was published after the filing date of the mark one application, this was only just the case. An important question is when the article was submitted to the journal and whether this was in confidence. As to Part (d), the paper was published shortly after the conference and is therefore assumed to be an accurate summary of the talk given at the conference, unless there is evidence to the contrary</p> <p>For Part (e), almost all candidates appreciated that this prior art was novelty-only prior art and the fact that the earlier application had been withdrawn made no difference. The same applied to Part (f).</p> <p>The final part, Part (g), seemed to cause the most problems. This PCT application is only novelty-only prior art if it is entered into the UK national phase and an English language translation is filed at UKIPO. A final issue that only a very small number of candidates addressed was that of the Japanese priority application and whether this might also have been prior art.</p>
Question 9	<p>Again, this question was answered well by most candidates.</p> <p>Part (a) asked candidates what factors would be taken into account when determining if an award is to be made in favour of an employee. This was answered well.</p> <p>Part (b) related to product by process claims. The essential point here is that further information was required to determine if the product was, in fact, made by the claimed method. Almost all candidates appreciated the point that it was irrelevant that the method was performed abroad.</p> <p>Part (c) related to marking a product as patented once the patent has expired. Whilst this has not been asked often, most candidates answered this well.</p> <p>The final part of the question related to the possibility of bringing proceedings for infringement once the patent has expired. A surprising number of candidates were of the opinion that once the patent had expired, nothing could be done. It is, of course, still possible to take action for infringing acts performed whilst the patent was in force.</p>