

Paper Ref	Sheet	Percentage Mark Awarded
<b>FC1</b>	<b>1 of 11</b>	<b>55%</b>

Examiner's use only

1)

0.5                      0.5  
a) Must be novel, involve an inventive step and be capable of industrial application. 1

2

b)

- Presentation of information 0.5
  - Rule/scheme/method of doing business, playing a game, performing a purely mental act, computer programs 0.5      0.5      0.5      0.5
  - Scientific theory, mathematical method, discovery 0.5                      0.5                      0.5
  - Any dramatic, literary, musical or aesthetic creation whatsoever 0.5      0.5      0.5                      0.5
- ...as long as the invention relates to that thing as such 0.5

7.5

**MARKS AWARDED: 9.5/10**

9.5

**Page sub-total**

Paper Ref	Sheet
<b>FC1</b>	<b>2 of 11</b>

Examiner's  
use only

2)

- Each joint owner has an equal undivided share of the patent, subject to any agreement to the contrary

- Can't amend spec, revoke patent, grant license, assign, mortgage without permission from other joint owners

- Can do anything for their own benefit that would otherwise constitute infringement

- Can bring proceedings without others consent, but others are made party to the proceedings (not liable for costs unless they make arguments)

**MARKS AWARDED: 4.5/8**

4.5

Page sub-  
total

Paper Ref	Sheet
<b>FC1</b>	<b>3 of 11</b>

Examiner's  
use only

3)

a) Errors in transcription, translation, clerical errors, mistake in

specification/claims/any document filed in relation to the patent/application.

b) It must be immediately obvious that nothing else could have been intended.

1.5

**MARKS AWARDED: 5/6**

5

3.5

1.5

Page sub-  
total

Paper Ref	Sheet
<b>FC1</b>	<b>4 of 11</b>

Examiner's use only

4)

a) Anyone, solely/jointly

2

b) - Inventor 1✓

0.5

- Anyone entitled to invention by law/agreement

2.5

- Successor in title of either of the above 1

c)

2

- If the applicant is not the inventor 1✓

1✓

- The deadline is 16 months from priority (no extension)

**MARKS AWARDED: 6.5/10**

6.5

Page sub-total

Paper Ref	Sheet
<b>FC1</b>	<b>5 of 11</b>

Examiner's  
use only

5)

0.5 0.5 a) File PF21 with evidence signed by both parties & pay fee  
0.5

b) – Earlier transaction not effective over later one earlier transaction was not

0.5 registered and person carrying out later transaction did not know about the

0.5 earlier one

1 - Damages for infringements post-assignment not awarded to new owner (unless  
it can be shown that it was not practicable to record assignment within 6 months  
of execution, but that it was done as soon as was practicable)

3.5

**MARKS AWARDED: 3.5/6**

1.5

2

Page sub-  
total

Paper Ref	Sheet
<b>FC1</b>	<b>6 of 11</b>

Examiner's  
use only

6)

Interpretation/Construction

Catnic vs Hill + Smith:

- Catnic had a patent for a steel lintel for providing support above windows and doorways, patent specified a “vertical bar”
- Hill produced an almost identical lintel with a bar offset by about 6-8 degrees from the vertical
- Catnic brought infringement proceedings
- High court – infringed “pith and marrow”
- Court of Appeal – not infringed
- House of Lords – infringed under “purposive construction”
- Would skilled person believe that it was the intention of the applicant that strictly vertical was an essential requirement?
- In this case, skilled person would know that a slight offset from the vertical would have no effect on the way that the invention works
- Effectively allowed “substantially” to be written into the claim

1

1

1

1

Novelty/Inventive Step

Merrel Dow (MD) vs Norton:

- MD had patent for terfenadine, an antihistamine
- Patent expired in 1992, other companies began to sell terfenadine
- MD patented the previously unknown acid metabolite
- MD tried to sue other companies for selling a “means to produce the acid metabolite”

1

1

Page sub-  
total

Paper Ref	Sheet
<b>FC1</b>	<b>7 of 11</b>

Examiner's  
use only

- It was argued that there was prior use, as subjects in clinical trials had already produced the acid metabolite of terfenadine in their livers (therefore method of manufacture part of the state of the art) – however decision wasn't actually based on prior use
- MD were unsuccessful - can't grant a patent to stop a trader doing something that they are already doing
- Test for anticipation = test for infringement
- If the act would constitute infringement, it would also constitute anticipation before filing

1

1

**MARKS AWARDED: 8/20**

8

Page sub-  
total

Paper Ref	Sheet
<b>FC1</b>	<b>8 of 11</b>

Examiner's  
use only

7) How long ago was the renewal fee due? Renewal period is the three months ending with the last day of the calendar month in which the renewal was due. If the renewal fee is not paid in this time, it can be paid within the six month period following the renewal period, with an additional surcharge. If the renewal period ended less than 6 months ago then we can pay the renewal fee with the surcharge. After this period, the application is treated as having lapsed from the renewal date.

1✓

1✓

If we are past the 6 month period for late renewal, then we can apply for restoration of the patent within 13 months, providing evidence that missing the deadline was unintentional. The patent office may accept evidence of the resignation of the director responsible for the payment of renewal fees as sufficient to show that missing the 6 month deadline was unintentional (don't need to prove all due care was taken). If we are past this 13 month deadline then nothing can be done.

1✓

1✓ 1✓

1✓

If the third party began preparations in good faith in the time between the end of the 6 month late renewal period but before the publication of the request to reinstate the patent, then they can continue to do the act without it constituting infringement (this does not allow them to grant a license, but does allow them to assign the right to carry out the act to anyone responsible for that part of their business).

0.5

0.5

1✓

1✓

If they started preparations before the end of the 6 month late renewal period, and we do get the patent reinstated, then we could ask Comptroller to decide if there is infringement/start civil proceedings (IF the product is being manufactured/imported/sold in the UK). If there is infringement, we can seek

Page sub-  
total

Paper Ref	Sheet
<b>FC1</b>	<b>9 of 11</b>

Examiner's  
use only

damages, account of profit, injunction, destruction of infringing articles (can't seek both damages AND account of profit).

10

**MARKS AWARDED: 10/20**

Page sub-  
total

8)

Part	V1 Claim		V2 Claim		Explanation	More info needed?
	Nov	I/S	Nov	I/S		
a	Y	Y	Y	Y	Made available to the public before filing of priority & present application	
b	N	N	N	N	After priority date so no for V1, supposition of confidence means not disclosed to the public so no for V2	
c	N	N	Y	Y	Not available to public before priority filing so no for V1, but different claims can have different priority dates, was available before filing claim to V2	
d	Y	Y	Y	Y	State of the art includes oral disclosures, presentations etc.	
e	Y	N	Y	Y	Filed in the UK before priority application but published after, so novelty only for V1 claim, still counts as state of the art if	

Paper Ref	Sheet
<b>FC1</b>	<b>11 of 11</b>

Examiner's use only

					withdrawal was not before publication so yes to both for V2	
f	Y	N	Y	N	Filed in EP designating UK before both applications, published after both applications, so novelty only for V1 and V2 claim	1
g					PCT(UK) becomes state of the art for this purpose when it enters the UK national phase (doesn't count if UK designation is withdrawn)/when published by IB in English 0.5 0.5	1
					Did PCT enter UK national phase (or was designation withdrawn)? What language was it published in?	

MARKS AWARDED: 8/20

8

Page sub-total