

Introduction

Candidates generally performed well this year and several who did not quite pass came close to doing so. A marked improvement was seen in the quality, accuracy and structure of the answers. Fewer careless mistakes and bad advice were observed.

General points are:

- The Examiners are looking for a brief, accurate analysis of the situation set out in a question together with clear, cogent advice to the client relevant to the situation. This requires explanations such as, for example, of the effective date of subject matter **because** it is not entitled to priority; the client is at risk of infringement proceedings **because** it is making and selling the product (and not simply reciting MUDIOK when certain acts are clearly not present); or that an amendment is allowable **because** it is a narrowing amendment. Candidates who simply give possible facts and actions without justification are less likely to achieve marks.
- Many candidates do not do a thorough enough analysis of the relevant topics when providing their answer, and so miss relatively straightforward marks, or waste time considering aspects that are not of immediate relevance to the question.
- There also appears to be a need to better appreciate commercial considerations and implications for the client, such as third party rights and liability and provisional protection (all of which cropped up this year).
- Those who structured their questions or broke them up to clearly address one point then move on to the next did better than those who presented streams of consciousness, even if they were clearly struggling to understand the premise of the questions.
- The Examiners are aware that many candidates memorise lists of aspects of law and practice that they intend to reproduce in their answers in the expectation that they will gain marks. While including unnecessary information in an answer does not lead to a deduction of marks, it takes time to type which may deprive candidates of the opportunity to provide relevant analysis or advice.

Questions

Part A

Question number	Comments on questions
<p>Question 1</p>	<p>Candidates achieved good marks on this question.</p> <p>Whilst a significant proportion of candidates did not recognise that the renewal fees for the parent and divisional fall due on the same date, many candidates correctly calculated the renewal fee payment dates and provided the legal test required for the application to be restored.</p> <p>Consideration of the likelihood of success, in light of the facts presented, was sometimes overlooked.</p> <p>Most candidates appreciated the threat of third party rights accruing, but very few considered whether a first communication from the UK IPO had been received during the grace period and the impact this might have for the client in potentially improving their position.</p> <p>Candidates were sometimes unclear about the formal timing of lapse. This is effective from end of May 2021 (when the initial fee was due – a grace period payment allows lapse to retrospectively be treated as if it never happened, rather than being a postponement of lapse as such.) This is relevant where candidates mention activities undertaken “while the patent is lapsed” rather than using calendar references.</p> <p>Several candidates believed the divisional had only recently been granted despite the compliance period clearly having expired several years previously, and some candidates considered the 2022 renewal fee, which carried no mark.</p> <p>Overall, however, this question was answered well by many candidates.</p>
<p>Question 2</p>	<p>This question was generally well answered. However, many candidates recited details that were clearly not required. The question concerned forms of design protection that were available and could be used to maximise the client’s protection, not whether the design met any conditions for registrability. Despite being guided towards the various types of design right,</p>

	<p>many candidates were unable to resist discussing the validity of the design, which was awarded no marks.</p> <p>While a good proportion of candidates correctly stated the law for EUUDR and UKSUDR, recognising the need for the first disclosure to be within the particular territory, relatively few recognised the practical issue that a disclosure in one territory could preclude protection in the other and a potential solution was simultaneous disclosure.</p> <p>One of the key pieces of information was the simultaneous launch and this was overlooked by many as to its impact.</p> <p>The fact that the publication of the design application could prejudice the various UDRs was rarely considered.</p> <p>Some candidates interpreted the “in house” aspect of the scenario to relate to the novelty of the design, rather than ownership.</p>
<p>Question 3</p>	<p>Candidates generally appreciated that post-grant amendment was required, and that amending from a long-life light bulb to a dimmable long-life light bulb would be allowable because it is a narrowing amendment, but very few candidates appreciated that a request for these amendments must be accompanied by a reason, and that they are discretionary.</p> <p>The amendment distinguishes from the novelty-only prior art of EPX which will have designated GB and which discloses only a long-life light bulb. However, a notable number of candidates did not appreciate that EPX could form part of the state of the art under Section 2(3).</p> <p>Many candidates appreciated that a licensing agreement can be put in place in the UK, although a mark could not be awarded for general proposals for a license without specifically referring to the GB territory. Several candidates failed to appreciate that the lapse of EP1 results in freedom to operate for the competitor in other key jurisdictions.</p> <p>Overall, reasonable marks were achieved for this question.</p>
<p>Question 4</p>	<p>Few candidates achieved good marks on this question.</p> <p>This question raised ethical considerations. However, few candidates considered the ethical aspects of continuing with the application and the need for making a quick decision due to imminent publication, or how the company might avoid a similar</p>

	<p>situation arising in the future. Mitigating a client's risk and not just focussing on securing them rights is important.</p> <p>Although most candidates realised that Skyline (or Drew) is the first owner of Concept X, they omitted to explain that Horizon could not be the first owner in view of the literature article. Drew is a company employee, so you can readily obtain detailed information simply by asking him.</p> <p>Most candidates appreciated the possibility of entitlement proceedings.</p> <p>Some candidates lost time by again considering validity, which was not awarded any marks. In particular, some candidates considered whether submission of the article was a public disclosure and so resulted in the article being prior art for GB1.</p> <p>Candidates should be aware of the interests of their client (i.e. not Skyline or Drew) as doing so helps focus on the key matters rather than peripheral comments (which may be correct analysis, just of more limited relevance) where marks are not available. Examples include detailed discussions of S2(4) or US grace periods – the client does not appear to be the rightful owner.</p> <p>The low average mark reflected these difficulties.</p>
<p>Question 5</p>	<p>The question leaves scope for discussion, and candidates should not make superficial statements of law without tying the law to the facts of the question.</p> <p>Candidates were expected to analyse the two potential disclosures and to reach at least a tentative conclusion, and then to advise what action the client should take. However, discussions were often incomplete or lacking depth. Although consideration of an enabling disclosure was dealt with by most candidates, some candidates were not thorough in their approach and so failed to identify all the potential disclosures and conclude whether each of those disclosures was enabling.</p> <p>The hydrofoils are visible when sailing slowly, but is this an enabling disclosure given the complex mathematical function and the need for close inspection? The image on the competitor's website is also a disclosure, but again is this enabling? A complex mathematical function is unlikely to be discernible from a 2-dimensional photograph.</p> <p>Well informed candidates discussed both the issues of whether or not observation by third parties could be controlled</p>

	<p>(Hozelock/Claydon) and the level of detail which could be observed (zoom lenses, if images from multiple angles are required etc).</p> <p>Article 55 EPC is only available where there has been evident abuse. This requires a deliberate intention to cause harm, or knowledge of the possibility of causing harm, as evidenced by the message to be on the lookout for the competitor's new yacht. A speculative breach of confidentiality was not sufficient to obtain the mark relating to evident abuse.</p> <p>The 12-month grace period in the USA is only available in respect of disclosures derived from the inventor. However, this mark was often missed as the link between the third party web image and the client was not explicitly made – such that it does not constitute an independent disclosure.</p> <p>Often candidates did not discuss the inventive step aspect of patentability, though the surprising effect is mentioned in the question.</p> <p>Should a patent application be filed at all because this will necessarily result in full disclosure of the mathematical function? Any applications should be timed to take account of any possible further disclosures and available grace periods. It would be sensible to accelerate any UK patent application because the competitor is a potential infringer and is UK-based.</p>
<p>Question 6</p>	<p>On the whole, this question was not well answered.</p> <p>This question presents a relatively normal circumstance of the need to re-file a priority document, though some candidates instead focused on attempts to revive the previous application.</p> <p>The 12-month Paris Convention period has passed, there is no possibility of restoring priority, and the current patent application cannot be re-established. Since there was no intention, all due care cannot be met. The legal standard is clear. Some candidates appeared unwilling to commit to the reality and suggested it would just be “unlikely”, “difficult”, “challenging”, “hard”.</p> <p>Concerningly, some candidates suggested that re-establishment could be requested “just in case”. A few candidates used “all due care” and “unintentional” almost interchangeably.</p> <p>There appears to be no publication of the invention, so there is the possibility of starting over and filing a new priority application. The problem is that the current application has not been withdrawn</p>

	<p>leaving no rights outstanding, so the first step is to attend to this and then to file a new priority application as soon as possible.</p> <p>A small number of candidates advised that because the client drafted the spec, it should be reviewed, to ensure it is adequate, which is an important suggestion.</p> <p>Finally, you can file a PCT application or national applications to provide global cover with maximum duration. Candidates who scored poorly tended to fail to pick up on the importance of maximising the term of protection, which is part of the crux of question.</p>
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Part B

Question number	Comments on question
Question 7	<p>This question was attempted by the majority of candidates. The average mark was low, but a good number of candidates did, in fact, manage to achieve excellent marks on this question and those that did identified the key and more complex issues.</p> <p>Aspects of patent practice which feature in this question include some fundamental topics including inventorship, entitlement and ownership.</p> <p>The assessment of ownership, entitlement proceedings, enforcement and extending protection via a PCT/national applications were generally well handled, suggesting candidates are comfortable with these basic elements of the question. However, candidates often did not follow a train of thought to its conclusion, offering advice along the way. For example, very few candidates considered the implications and potential outcomes of the entitlement proceedings, and offered a suggestion of which option would be most valuable.</p> <p>Practical advice on how to handle individual issues was often lacking to a greater or lesser extent. Very few candidates seemed to propose a discussion or consider the pros and cons of the different outcomes. A mark was available to discerning candidates who spotted the disjoint in kitchenware which might provide some space for FTO.</p> <p>Few candidates appreciated wider legal and commercial implications of the scenario, such as whether equivalent</p>

	<p>applications exist and concluding how to sensibly handle the situation with CrackPots.</p>
<p>Question 8</p>	<p>The average mark achieved for this question was disappointing.</p> <p>Limited detail was provided by the question – consequently, marks were awarded for identifying important considerations without the need for a great depth of discussion. A brief review should indicate the primary issues are infringement, validity and freedom to use, together with questions regarding the initial search.</p> <p>Aspects that were well handled related to relatively straightforward legal and commercial considerations, including the relevance of the claims to the product and determining the effective date of the claims, identifying potentially infringing acts and suggesting proactive actions against competitor.</p> <p>The distinction between validation and designation was not well appreciated. Comments that GB validation is essentially automatic overlook the fact that the GB designation might have been removed (perhaps explaining why the case was not picked up in the FTO search?).</p> <p>While most candidates commented on post-grant liability and provisional protection, few commented on the phase of activities prior to publication – yet this could be significant depending on whether the EP case was relatively old or relatively recent.</p> <p>While many commented on innocent infringement, few appeared to consider if the defence was justified – there does not appear to be actual knowledge of the case and diligent searching was done.</p> <p>Some candidates mechanically proposed licensing as a solution. Clearly, paying unnecessarily is undesirable and the more discerning candidates properly caveated that licensing should be resorted to only if necessary.</p> <p>As an FTO search was carried out by your firm, a potential liability exists if this was done negligently. Consideration of why a relevant patent might not have been picked up is therefore worthwhile (e.g. the mentioned EP patent might not be the only thing missed).</p> <p>Some candidates misinterpreted the “unusual terminology” as relating to clarity.</p>
<p>Question 9</p>	<p>The average mark achieved for this question was disappointing.</p>

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	<p>The subject matter of ranges in this question required careful analysis.</p> <p>Candidates were generally able to access marks relating to an assessment of effective dates and patentability of EP1. However fewer gained marks relating to sensible actions to take on the European application, and an analysis of infringement and FTO.</p> <p>A significant number of candidates recommended a sub-range (170-185) that was not novel over the prior art.</p> <p>All specifically disclosed embodiments are worth discussing, even if not in great depth. Few candidates picked up the mark for a discussion of the examples.</p> <p>A good proportion of candidates seemed to comment on the significance of launching in the UK with the same concentration as the US, but consideration of equivalents was less common.</p>
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