

**FC1 UK Patent Law Mark Scheme
FINAL Mark Scheme 2023**

SECTION A

Question 1

- a) You recently filed a UK patent application claiming priority from a Japanese patent application. What documents must be filed and by when in support of the priority claim?
4 marks
- b) Two weeks ago you filed a UK patent application. It was intended that the application claim priority from a Chinese application and was filed exactly 12 months after the Chinese application. Unfortunately, the priority claim was accidentally omitted. How would you proceed and by when? What extension of time is available?
3 marks
- c) Your clients wish to withdraw their current UK application (application A) and re-file it as application B. In twelve months' time they intend to file a new UK patent application claiming priority from application B. What conditions must application A satisfy for this to be possible and by when?
5 marks

Total: 12 marks

ANSWER

- a) Certified copy (1 mark) of priority application, 16 months from priority (1 mark), translation of priority application due on request (1 mark), some mention of PDAS (1 mark)
- b) File form (0.5 marks), pay fee (0.5 marks), by 16 months from priority (1 mark), no extension of time available (1 mark).
- c) Must have been filed in the same country (0.5 marks); Must not have left any rights outstanding (0.5 marks); Must have been unconditionally (0.5 marks) withdrawn (0.5 marks), abandoned (0.5 marks) or refused (0.5 marks); Must not have been made available anywhere to the public (0.5 marks); Must not have served to establish a priority date for another application anywhere (0.5 marks); Not later than the date of filing of the new application (0.5 marks) Some discussion of 'not later than' i.e. before (0.5 marks)

Question 2

Summarise one decision of the UK Courts relating to novelty or inventive step. You should provide:

- a) identification of the parties; **1 mark**
- b) summary of the relevant facts and issues; **2 marks**
- c) summary of the decision; and **2 marks**
- d) a discussion of the precedent set by the decision. **5 marks**

Total: 10 marks

ANSWER

- a) Names of the parties, or any reasonable abbreviation thereof (1 mark)
- b) Cursory summary (1 mark). More detailed discussion covering most of the main issues (2 marks).
- c) Correct identification of decision (1 mark) associated reasoning (2 marks)
- d) Cursory summary of precedent (1 mark) more detailed summary identifying at least some of the main points (2 marks). Detailed summary identifying all the main points (3 marks). Consideration of more subtle points (4 marks). Summary worthy of a newsletter (5 marks)

Question 3

With reference to Section 72 UK Patents Act,

a) On what grounds may a UK patent be revoked?

5 marks

b) Who may apply for revocation and by when?

5 marks

Total: 10 marks

ANSWER

(a) not patentable (1 mark).

granted to a person not entitled (1 mark)

specification does not disclose the invention clearly enough and completely enough for it to be performed by a person skilled in the art (1 mark)

matter disclosed in the specification of the patent extends beyond that disclosed in the application for the patent as filed (1 mark)

the protection conferred by the patent has been extended by an amendment which should not have been allowed (1 mark).

(b)

Any person (0.5 marks) including the proprietor (0.5 marks)

Any time after grant (1 mark)

Second ground can only be brought by a person found to be entitled to be granted the patent (1 mark)

Must be brought within two years of grant (1 mark)

Unless the person registered as proprietor of the patent knew at the time of grant that he was not entitled to grant of the patent (1 mark)

Question 4

You are a UK national resident in the UK. Whilst visiting a firm of US attorneys you receive an e-mail with instructions to first file (i.e. without a priority claim) a new US patent application. You forward the instructions to the firm you are visiting who file the application on your behalf.

- a) Section 23 of the UK Patents Act (*Restrictions on applications abroad by United Kingdom residents*) only applies if a patent application contains certain subject matter. What is this subject matter?

3 marks

- b) Assuming the application contains the above subject matter, explain why Section 23 is relevant in this situation.

3 marks

- c) Would there still have been a problem in the following situations? In each case explain your answer

- a. you had been a US national? or
b. the application had claimed priority from an earlier Chinese patent application?

2 marks

Total: 8 marks

ANSWER

- (a) information relating to military technology (1 mark), national security (1 mark) safety of the public (1 mark)
- (b) because a person resident in the UK (1 mark) has without written authority granted by the Comptroller (1 mark) caused to be filed outside of the UK an application for a patent (1 mark)
- (c) US national – no difference. The test is one of residence, not nationality (1 mark). Claims priority from a Chinese application - Section 23 no longer applies, section 23(2) (1 mark)

Section B

Question 5

This question relates to opinions issued by the UK Intellectual Property Office (“UKIPO”) according to Sections 74A and 74B of the UK Patents Act.

- a) The UKIPO will not issue an opinion in respect of a patent that has been revoked. Why is this?
1 mark
- b) Give two examples of reasons why one might want to obtain an opinion in respect of a patent which has expired or which has been cancelled
2 marks
- c) On what grounds will the UKIPO refuse to issue an opinion?
3 marks
- d) What standard of proof is applied by examiners in the opinions procedure?
1 mark
- e) Summarise the procedure from requesting an opinion to issue of the opinion (including actions by third parties); and
10 marks
- f) Who may apply for a review of the issued opinion and within what time limit?
2 marks
- g) What appeal is possible if the decision of the review is to set aside the opinion?
1 mark

Total: 20 marks

ANSWER

- (a) if a patent is revoked it is revoked ‘ex tunc’ ie as if it had never existed (1 mark)
- (b) all reasonable answers considered. E.g. if a licensee wishes to argue that a licence fee should be repaid (2 marks)
- (c) in such circumstances as may be prescribed (1). If he considers it to be inappropriate (0.5 marks). Frivolous (0.5 marks). Vexatious (0.5 marks). Already considered in relevant proceedings (0.5 marks)
- (d) balance of probabilities (1 mark)
- (e) file request form (0.5 marks) accompanied by a statement setting out the question (0.5 marks), the requesters submissions on the question (0.5 marks) and any matters of fact to be taken into account (0.5 marks). The statement must be accompanied by a list of persons having an interest in the question (0.5 marks) and particulars of any relevant proceedings (0.5 marks). The statement is further accompanied by any evidence referred to in the statement (0.5 marks). The comptroller notifies the patent holder (0.5 marks), holder of a licence or sub-licence (0.5 marks), any person in the ‘list of persons’ (0.5 marks) and anyone else that appears to the Comptroller to be likely to have an interest (0.5 marks). The request is advertised (0.5 marks). Within

four weeks of advertisement (0.5 marks) any person (0.5 marks) may file observations. These must be sent to the patent holder and requester (0.5 marks). The patent holder/requester has two weeks (0;5 marks) to file observations in reply. The matter is then referred to an examiner for preparation of an opinion (0.5 marks). The opinion is then issued to the patent holder (0.5 marks), the requester (0.5 marks) and any party who filed observations (0.5 marks).

- (f) patent holder (1 mark) within three months after the date on which the opinion is issued (1 mark)
- (g) no appeal possible (0.5 marks) except where the appeal relates to a part of the opinion which is not set aside (0.5 marks)

Question 6

- a) What are the “Catnic” questions, as amended by the UK Supreme Court in *Actavis UK Limited & Others v Eli Lilly and Company*?

6 marks

- b) Your client writes:

“We are the proprietors of a GB patent which relates to an artificial hip joint. An artificial hip joint is essentially a rod having a head thereon. Our patent relates to a hip joint having a teardrop shaped head. Teardrop shaped heads are better than spherical heads as they fit into the hip socket much better over the full range of motion of the leg.

One of our competitors manufactures a range of hip joints and we attach some samples. We are hoping that at least one of them infringes our patent. We would be grateful for your thoughts.”

Review of the patent reveals that it is in force. The patent has only one claim which is to a hip joint having a teardrop shaped head. The description of the patent explains the advantage associated with such heads when compared to spherical heads. You also review the samples provided by the client. For each sample they have provided a brief note –

Sample Number	Description	Brief Note
1	Hip joint with spherical head	We have made these for many years
2	Hip joint with elliptical head	This fits the socket just as well as ours over the full range of motion. This isn't surprising really, the tip of an ellipse is the same shape as the tip of a teardrop.
3	Hip joint with cubic head	This works just as well as ours. We are still trying to figure out why
4	Grinding tool	We saw this on the competitors web site. Apparently, you place the tool over a spherical head. Rotating the tool grinds the head until it is tear drop shaped.

For each sample advise if sale of the sample is likely to be an infringement of D1. Explain your answers.

14 marks

Total: 20 marks

ANSWER

(a)

(i) notwithstanding that it is not within the literal meaning of the relevant claims (0.5 marks) of the patent does the variant achieve the same result (0.5 marks) in substantially the same way (0.5 marks) as the invention (0.5 marks) ie the inventive concept revealed by the patent?

(ii) would it be obvious to the person skilled in the art (0.5 marks), reading the patent at the priority date (0.5 marks) but knowing that the variant achieves substantially the same result as the invention (0.5 marks) that it does so in substantially the same way as the invention (0.5 marks)?

(iii) would a reader of the patent have concluded that the patentee nonetheless intended that strict compliance (0.5 marks) with the literal meaning (0,5 marks) of the relevant claim of the patent was an essential requirement (1 mark) of the invention?

(b)

Sample 1 No infringement (1 mark). Fails the third test – the description clearly distinguishes between tear drop shaped and spherical. Will also accept it fails test one or test two if a convincing reason is given (1 mark). Also, a Gillette defence (1 mark)

Sample 2 Infringement (1 mark). Client states it works in the same way (1 mark) Also obvious that it works in the same way (1 mark).

Sample 3 No infringement (1 mark). Works in the same way (1 mark) but according to the client it is not obvious why (1 mark).

Sample 4 Probably contributory infringement (1 mark). Means suitable for putting the invention into effect (1 mark) in the United Kingdom (1 mark) known/obvious – instructions for use are on the competitor's website (1 mark). Sale in the UK? (1 mark).

Question 7

Your client writes:

We have a PCT application for our invention. We filed it in Japanese at the Japanese patent office. It claims priority from a GB application which we allowed to lapse. We filed claim amendments in the international phase. We think the claims on file are patentable, but the examiner may need some persuasion. There is a narrowing amendment we can make that would be allowed without difficulty.

We are now approaching 30 months from the priority date and would like your advice as to how to proceed.

a) **Are there any advantages to entering the PCT application into both the GB national phase and also the EP regional phase?**

3 marks

b) **We have heard about ‘double patenting’ which may be a danger if we file both GB and EP applications from this PCT. What is this and how we can avoid this danger here?**

5 marks

c) **Assuming we wish to enter this application into the GB national phase, what steps do we need to take and by when? You can assume there are no excess pages fees or excess claims fees to pay.**

9 marks

d) Finally, we also have a GB application for an update to the original invention. This was filed after the PCT application but before the PCT application was published. Claim 1 of the PCT application recites a substrate. The one example in the description is to a rubber substrate. We subsequently discovered that copper substrates are better. Claim 1 of the GB application recites a copper substrate, and the one example is to a copper substrate.

Can the PCT be cited against the later filed GB application and if so how do we address this?

3 marks

Total: 20 marks

ANSWER

(a) one can pursue different scopes of protection in EP and GB (1 mark). Expedite prosecution in GB with the narrowing amendment for patent box (1 mark) and also possibly for enforcement (1 mark). All other reasonable answers considered.

(b) the UKIPO will revoke the GB patent (1 mark) if the EP patent is granted with claims to the same invention (1 mark) designating GB (1 mark). Either withdraw the GB designation of the EP patent application (1 mark) or ensure the EP and GB are granted with different claims (1 mark)

- (c) By 31 months from priority (0.5 marks)
File English language translation of PCT (1 mark) and amended claims (1 mark)
Pay regional processing fee (1 mark) and file NP1 (1 mark)
- By 33 months from priority (0.5 marks)
File a request for search (1 mark) and pay the search fee (1 mark)
File a request for examination (1 mark) and pay the examination fee (1 mark).
- (d) The PCT is novelty only prior art against the later filed GB (1 mark) on entry of the PCT into the GB national phase (1 mark). No action required however as the PCT does not disclose a copper substrate (1 mark).

Question 8

Your client writes:

We have recently taken over three GB patent applications (P1 – P3) from one of our competitors. I enclose copies of the paperwork relating to the applications.

- a) for the first application (P1) we see this started life as a PCT application and has recently been entered into the GB national phase. The PCT received a favourable ISA with all the claims being found novel and inventive. We understand there is a PCT(UK) fast track system for expediting examination. We would be grateful if you could explain this to us. You should note that in addition to the apparatus claims of the PCT we would like to add so closely corresponding method claims.

Write notes for your client on the PCT(UK) fast track system. You should also advise on how best to obtain protection for the method claims.

3 marks

- b) The second application (P2) is a direct GB application. We are currently awaiting an examination report. Again, we would like to expedite prosecution if at all possible and would appreciate your advice.

Suggest ways in which one can expedite prosecution of the application and for each explain what documents need to be filed.

7 marks

- c) For the third application (P3), as you will see this was filed eight months ago and consists of a description and drawings only. There is no priority claim. The subject matter of this application is of particular interest to us and one of our employees has developed a number of variants that we would like to include in the application. We would like to have only one application if possible.

Advise how to proceed including what documents need to be filed and by when. You only need to consider prosecution up to 18 months from the filing date of P3

6 marks

- d) When reviewing the above three applications we found a patent owned by our competitor and which has not been assigned to us. This is of concern as we very clearly infringe it. Fortunately, we were not aware of it and have now ceased making the product in question. Unfortunately, our use started after the filing date of the patent. Should we be concerned?

Advise your client as to any defences they may have to a claim for infringement.

4 marks

Total:20 marks

ANSWER

- (a) fast track prosecution must be requested before national examination has started (0.5 marks). Can only be requested in claims 'sufficiently correspond' to those on which the ISA is based (0.5 marks). This means of same or similar scope (0.5 marks) or narrower in scope (0.5 marks). A change in claim category means the claims no

longer 'sufficiently correspond' (0.5 marks). For the new claims one must file a divisional application if one wants expedited prosecution for the parent (0.5 marks).

(b)

- (i) if the application has environmental benefit (0.5 marks) then one can file a green channel request (0.5 marks). The request must be in writing (0.5 marks) along with a reasoned assertion as to why the invention is of environmental benefit (0.5 marks).
- (ii) PPH if applicable (0.5 marks). File a request form (0.5 marks), claim comparison table (0.5 marks) and supporting work product (0.5 marks).
- (iii) direct request for accelerated examination (0.5 marks) along with a reason (0.5 marks). Typical reasons include becoming aware of an infringer (0.5 marks), to attract a potential investor (0.5 marks) and to obtain faster grant to support a PPH request in another country (1 mark).

(c)

Record the assignment of P3 to your client (0.5 marks)
File a new application claiming priority from the first (0.5 marks)
Which covers the additional embodiments (0.5 marks)
Claims (0.5 marks)
Abstract (0.5 marks)
Filing fee (0.5 marks)
Search fee (0.5 marks)
Form 1 (0.5 marks)
All by 12 months from filing date of P3 (0.5 marks)
File a statement of inventorship (0.5 marks)
By sixteen months from priority (0.5 marks)
Naming the original inventor and the new inventor. (0.5 marks)

(d)

For use before publication – no infringement (1 mark).
For use between publication and grant – only infringement if there is infringement of the claims both as published and granted (1 mark)
For use after grant – any of the non-infringing acts S60(5) or any other reasonable point (1 mark)
Some mention of innocent infringement (1 mark).