

## Introduction

Candidates did not score as well as usual this year. Many candidates struggled with the longer questions, in particular the infringement question and the question relating to expediting prosecution.

Having said that, the majority of candidates structured their answers well and better than in previous years.

## Questions

### Part A

Question number	Comments on questions
<b>Question 1</b>	Question 1 related generally to priority, in particular which documents need to be filed in support of a priority claim and also the late addition of priority claims. On the whole, this question was answered well. Some candidates were confused between adding a priority claim to an application filed within the 12-month priority deadline and one filed after the 12-month priority deadline.
<b>Question 2</b>	Question 2 asked candidates to summarise one decision of the UK courts relating to novelty or inventive step. This question (or a variant thereof) makes an appearance almost every year and was generally answered well. However, it was surprising that there were a number of candidates who did not answer this question well.
<b>Question 3</b>	Question 3 related to revocation, in particular on what grounds a UK patent can be revoked, by whom and when. Almost all candidates scored well.
<b>Question 4</b>	Question 4 related to section 23 of the UK Patents Act (restrictions on applications abroad by UK residents).  Part (a) asked candidates what type of subject matter an application must contain for section 23 to apply. Almost all candidates answered this well.  Parts (b) and (c), however, were not answered well at all. The essential point is that you, an attorney resident in the UK, instructed the first filing of a US patent application whilst visiting the US. Section 23 applies as you are resident in the UK. Your

	<p>nationality or the fact that you are visiting the US at the time is not relevant. Many candidates made reference to the nationality and/or residence of the applicant, which again is not of relevance here.</p> <p>As to Part (c), the nationality of the attorney is not relevant. It is purely residence that is important.</p> <p>Many candidates appeared to be confused as to the requirements of section 23. Candidates are advised to familiarise themselves with these requirements.</p>
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## Part B

Question number	Comments on questions
<b>Question 5</b>	<p>Question 5 was a long question relating to opinions issued by the UK IPO. Most of the question related to summarising the procedure for obtaining an opinion and also the possibility of review and appeal. Candidates who had prepared well performed well here and obtained high marks. Many candidates, however, were only aware of the procedure in outline and did not score as well.</p> <p>The introductory part of the question asked why UK IPO will not issue an opinion in respect of a patent that has been revoked. If a patent has been revoked, then it is considered never to have existed and so no opinion is possible. Very few candidates appeared to appreciate this point.</p> <p>Candidates also struggled to give reasons one would want to obtain an opinion in respect of a patent which has expired or which has been cancelled. Even if a patent has expired, the proprietor can still take action for acts performed whilst it was in force and so third parties may wish to obtain an opinion, for example, relating to patentability.</p>
<b>Question 6</b>	<p>Question 6 related to patent infringement.</p> <p>The first part of the question was a recitation of the <i>Catnic</i> questions as amended by the Supreme Court in <i>Actavis UK Limited v Eli Lilly &amp; Co.</i> These questions are core knowledge for a UK patent attorney. It is difficult to see how one can provide an infringement opinion in all but the most basic of cases without a detailed knowledge of them and how to apply them. The majority of candidates recited these questions well, in many cases,</p>

perfectly. One point that was often missed by candidates is that one should read the patent **at the priority date**, rather than at the date of the alleged infringement.

In Part B, candidates were provided with a number of samples of hip joints having differently shaped heads and were asked if the sale of such hip joints would be an infringement of a patent having one claim to a hip joint having an teardrop-shaped head.

The first hip joint had a spherical head. Most candidates correctly identified that sale of such a hip joint would not be an infringement of the patent. Many candidates, however, were unable to clearly articulate as to why this was the case. There are two main reasons: first, hip joints having spherical heads have been on sale for some time. If the claim covers spherical heads then the claim would not be novel. Second, the description of the patent distinguishes between spherical heads and teardrop-shaped heads and so clearly the term teardrop-shaped was not to be interpreted as to cover spherical heads.

The second sample of a hip joint had an elliptical head. Many candidates were of the opinion that sale of such a hip joint was not an infringement of the patent and gave a long explanation as to why an elliptical shape is different to a teardrop shape. This suggests that the candidates have not understood the *Actavis* decision or how to apply it. The question gave candidates a hint that elliptical and teardrop-shaped heads worked in the same way and this would be obvious to one skilled in the art. Accordingly, it is likely that there would be infringement.

The third sample had a cubic head. Most candidates were of the opinion that there was no infringement since a cubic head was clearly not teardrop shaped. However, this is not really the test. As was hinted at in the question, whilst the cubic head does work in the same way as the teardrop-shaped head, it was not clear why.

The final sample was a grinding tool. The majority of candidates realised that it was not appropriate to apply the *Catnic* questions to the grinding tool and the question here was more one of contributory infringement.

Overall, whilst most candidates appeared to be able to recite the *Catnic* questions, they did not appear to recognise when and how to apply them. Again, candidates are advised to familiarise themselves with this part of the syllabus.

<p><b>Question 7</b></p>	<p>Question 7 related to entry of a PCT application into the GB national phase. Part A asked the candidates if there were advantages to entering the PCT application into both the GB national phase and EP regional phase. Many candidates struggled with this. One could, for example, expedite prosecution of the GB case as a deterrent to third parties and for Patent Box tax benefits, whilst pursuing a broader scope of protection with the EP application.</p> <p>Part B related to double-patenting. A double-patenting issue can arise if the EP (GB) and GB patents are both granted with claims relating <b>to the same invention</b>. Many candidates failed to appreciate this important point. If a double-patenting objection arises, the UK IPO will revoke the GB patent, rather than the EP (GB) patent. Most candidates appreciated one can avoid this issue by either withdrawing the GB designation of the EP application or amending the claim sets so that they relate to different inventions.</p> <p>In Part C, candidates were asked what steps were needed to enter a PCT application into the GB national phase. Some candidates answered this very well. However, a surprising number of candidates were unsure as to exactly what fees needed to be paid and when.</p> <p>The final part of Question 7 related to the prior art effect of a PCT application. Almost all candidates identified that the PCT application was novelty-only prior art, although only very few candidates explained that this was only the case if the PCT was entered into the GB national phase.</p>
<p><b>Question 8</b></p>	<p>Question 8 was the least popular question on the paper and very few candidates answered it well.</p> <p>The main problem seemed to be Parts (a) and (b), which related to expediting prosecution of GB patent applications. Almost no candidate was aware of the PCT (UK) fast-track system. In Part (b), the examiner was looking for a discussion of the green channel system, the patent prosecution highway and the traditional method of simply requesting expedited examination along with a reason.</p> <p>Part (c) was a scenario in which the applicants wished to add further developments to an invention to an existing patent application. The way forward is to refile the application, claiming priority from the first, with the new application including the additional subject matter and broader claims. Most candidates</p>

	<p>recognised this point. The complicating factor was that the original application was filed in the name of a different applicant and so assignment of the first application to the new applicant is necessary. Many candidates missed this secondary point.</p> <p>The final part of Question 8 related to a patent that your client clearly infringes. Your client has now ceased the infringing act. The question asked what defences to infringement may be available. The important question here is when the infringing acts occurred. If they occurred before the patent was published then there is no infringement. If the infringing acts occurred between publication and grant then there is only infringement if there is infringement of the claims both as published and as granted. If the infringing acts occurred after grant then there is very little defence to infringement apart from the provisions of section 60(5).</p>
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