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1) a) Must file a written declaration of priority within 12 months of priority date, file a form, file copy of the priority document duly certified by a competent authority within the country that the priority document was filed in e.g., Japanese patent office or a copy that is verified to the satisfaction of the comptroller – this must be filed by 16 months from priority date, and file a copy of an English translation of the priority document within 16 months of priority date (if requested by comptroller).

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b) Can request an extension of 2 months as of right by filing from 52 and paying fee – must be requested within the 2 months (no extension available for requesting the late declaration) – so 2 months extension from the 12 month deadline. Must provide evidence and show that the deadline was missed unintentionally.

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c) Application A must be withdrawn before preparations for publication have been completed – otherwise application A will publish. Publication is 18 months from filing, and there is no set deadline for when preparations for publication will be complete but typically it will be a month or less before the publication deadline of 18 months. So must withdraw A in good time before the 18 month deadline, if left to late towards the 18 month deadline preparations are likely to have been completed. If application A publishes before then it will become prior art against application B and the new application filed 12 months later. Depending on when A publishes - before or after filing of B – it will either be full prior art or novelty only, but if the A and B are the same then it doesn't matter if B is novelty only prior art – it will still knock out application B and also the new application claiming priority from B.

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- 0.5 Application A must also be fully withdrawn such that no rights are left outstanding including withdrawing the right for it to serve as basis for a priority application.

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1✓ 2) Windsurfing vs Tabur

Windsurfing held a patent for a windsurfing board with sails held together by two arcuate portions. Tabur sold a very similar windsurfing board but with rectangular portions. Windsurfing sought infringement proceedings against Tabur and Tabur counter-claimed that windsurfing's patent was invalid based on two pieces of

1✓ prior art 1) prior use – a boy was seen with a sail and arcuate portions but for a different type of board and 2) a windsurfing magazine showed a very similar sail but without the arcuate portions.

1✓ The high court found that the patent was valid, however this was overridden by the court of appeal who found that the patent was invalid based on the prior use.

The precedent set was that a series of questions were formulated in order to determine obviousness:

- i) identify the inventive concept
- ii) identify the skilled person and impart their common general knowledge on them
- 3✓ iii) identify the differences between the inventive concept and the prior art
- iv) at the time of filing (priority) of the patent and without prior knowledge of the invention, would the differences have been obvious to the skilled person or would they have required a degree of invention?

It was found that the question of obviousness is best decided by looking at the differences between the prior art and the specific inventive concept of the claims

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in question, and not a more general concept derived from the description as a whole.

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3) a) A patent may be revoked if

- 1✓ i) the invention is not a patentable invention (it is not new or inventive)
- 1✓ ii) the patent was granted to a person who is not entitled to the grant of the patent
- 1✓ iii) the subject matter in the specification of the patent extends beyond that of the application as filed
- 1✓ iv) the specification of the patent does not describe the invention in a clear or complete enough manner to enable the skilled person to perform the invention.
- 1✓ v) the scope of protection conferred by the patent was extended after grant with an amendment that should not have been allowed.

- 0.5 0.5
- 1✓ b) anyone including the proprietor of the patent, in regard to entitlement, only the person found by the court to be rightfully entitled to the granted patent can apply for revocation on entitlement grounds, and they must do so within 1 year of grant of the patent unless it is shown that at the time of grant the proprietor knew they were not entitled to its grant. Also, a co-proprietor may not apply to revoke the patent on their own, all co-proprietors must consent to apply to revoke.

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- 1✓ 4) a) subject matter relating to military technologies or subject matter that is
1✓ 1✓ prejudicial to national security or prejudicial to public safety.
- 1✓ b) The section states that a UK resident filing an application for an invention must
1✓ file the application in the UK and not overseas, unless the application was first
filed in the UK within 6 weeks of filing the application overseas, or if the
application is mentioned in this section (23) or section 22.
- c) i) no section 23 does not apply if the person is not a UK national and is first
filing outside the UK
- ii) yes – the first application should have been filed in the UK not china

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5) a) The opinion will have no use – if patent is revoked the questions that may be answered by an opinion have already been answered (i.e., such as invention is not new or inventive, it is not described clearly and completely enough to enable the invention to be performed by skilled person etc – one of these questions has already been decided upon if the patent is revoked).

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b) There may still be an opportunity for the patent to be renewed or reinstated (if within 19 months of the expiry). Also, a proprietor of a patent, even if expired, can take action against infringement that occurred whilst the patent was still in force up until 6 years from date of infringement action, so if a person started an act whilst patent was still in force but has not expired, they may still seek an opinion on the patent such that they have certainty as to whether the proprietor may bring infringement action against them (or if they can counter-claim).

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c) The UKIPO will not issue an opinion in circumstances so prescribed, if under the circumstances the request is frivolous or vexatious, if the question for which the opinion is sought has already been dealt with/decided upon in relevant proceedings.

2.5

d) Balance of probabilities

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e) Any person may request an opinion including the proprietor, they must make the request for an opinion in writing and send to the UKIPO, form must be filed

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0.5 and fee paid, the person making the request must file a statement indicating the
0.5 question that should be considered for the opinion, file submissions and a
0.5 statement of any matters of fact that were not considered, file details of any other
0.5 parties that they are aware would have an interest in the opinion and file any
0.5 details/particulars of any proceedings relating to the patent/application that may
0.5 be relevant to the question set out for the opinion.

0.5 0.5 The UKIPO will then notify the proprietor, any licensees or sub-licensees, any
0.5 person who has filed a caveat, the people mentioned in the filing by the
0.5 requestor, and any other parties that may be interested in the application for an
0.5 opinion. The UKIPO will also advertise the application for an opinion.

0.5 Any 3rd parties may then file observations as to the question set out in the
0.5 application. They have 4 weeks from advertisement to do so. Any observations
0.5 will then be notified to the proprietor, licensees, and requestor.

0.5 The UKIPO will then issue the opinion, they will notify the proprietor, requestor,
0.5 and any person who has filed 3rd party observations. The UKIPO publishes
0.5 (advertises) the final opinion the website.

The opinion is not a binding decision.

f) The person who made the request only.

g) No appeal available

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6) a) Must address 2 questions from point of view of skilled person: a) does the variant fall within the scope of the meaning of literal interpretation of the claims? And if not b) if it not a variant covered by a) does the variant have a material or immaterial effect to the invention?

0.5 Notwithstanding that the variant of the invention does not fall within the literal
0.5 meaning, does it provide substantially the same effect in the substantially same
0.5 way?

0.5 Would it be obvious to the skilled person at the priority date that the variant
0.5 providing a substantially same effect, does so in substantially the same way?
0.5

0.5 Nevertheless, would it be obvious to the reader by reading the language of the
0.5 claims that the author meant for strict compliance with the literal meaning of the
1 claims to be an essential requirement for the invention?

b) A person infringes a patent of a product (which is the case here), if they, without the consent of the proprietor, in the UK and in relation to the product, perform the following acts: make, dispose of, offers to dispose of, use or import or keep for disposal or otherwise.

Competitor is manufacturing – so if product is within scope of claims then it would be infringement.

1 – hip joint with spherical head

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For product to infringe “spherical head” must fall within the “teardrop-shaped head” of claim 1. Does not matter if they have made them “for many years”, it is whether the scope of the claim in the patent covers a “spherical head”. Spherical relates to the shape of a sphere, a teardrop shaped head would probably not be considered a spherical shaped head, due to the point on one end of the tear drop shape, and so spherical would not be considered within the scope of tear dropped shape. Also it appears that the inventive concept may be the fact that the head is teardrop shaped and not spherical. Therefore no infringement.

1✓
1✓

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2 – hip joint with elliptical head

The tip of the elliptical head would be considered “teardrop-shaped”. There is no limitation in the claim that the whole of the head must be teardrop shaped, therefore even if it is just the tip, the product still has a “tear dropped shaped head” meaning it falls within the scope of the claim and therefore infringes.

1✓

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3 – cubic head

Does not matter if it works just as well, a cubic head would not be considered a teardrop shaped head, and therefore product does not fall within scope of the claim and therefore no infringement.

1✓

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4 – Grinding tool

This tool allows a user of it to produce a teardrop shaped head hip joint – which would be an infringing product. Therefore the competitor is infringing the patent as contributory infringement.

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1✓
Contributory infringement is where a person other than the proprietor or joint proprietor, licensees or other person entitled to the rights under the patent, supply or offer to supply in the UK means to allow another to put an infringing product on the market, use or dispose of the product, where they knew or there were circumstances such that it would be obvious to a reasonable person that the product would infringe. Must be intention to put the product on the market.
Therefore the grinding tool is contributory infringement as it is supplying the means for either themselves or another to infringe the patent as the grinding tool is used to directly make the exact same product that is covered by the patent.

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7) a) A GB patent can be designated out of the EP patent, therefore could potentially get different claim scopes in the direct GB national phase patent to the GB patent out of the EP patent, also if one were to grant sooner than the other e.g. the direct GB grants before the EP, then you could get provisional protection or further protection compared to if you just had the EP. Also if there is a threat of infringement specifically in the UK and not other EP countries, could request early entry into the GB phase and request expedited prosecution and early publication of English translation (to gain provisional protection) as this would gain protection for the invention in the UK potentially quicker than if it were gained through the GB designation of EP (also no opposition period/procure in UK so may likely be quicker than EP designating GB).

2

b) Double patenting is where a patent is granted twice (or more) for the same invention. Both patents must have independent claims with the same scope of protection i.e., the same invention for double patenting to occur. This can commonly occur where there is GB patent for an invention and an EP designating the UK is then granted. If this happens the UKIPO will automatically withdraw/cancel the GB patent and effectively replace it with the GB designation of EP. In this instance, in order to avoid the double patenting they must withdraw the GB patent before it is granted (i.e., notification of publication of grant) such that when the EP (GB) is entered into the UK there is no conflicting GB patent.

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c) By 31 month deadline – file form NP1 and pay national entry application fee, file a copy of an English translation of PCT spec and translation of amendment

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1✓ made in the international phase, file a request for search and pay search fee, also must file a statement of inventorship if not named on PCT application.

0.5 By 33 month deadline – file request for examination and pay examination fee,

1✓ 1✓ Normally, if requested by UKIPO must also file English translation of priority document and translation of priority search report – however in this case the priority document is in English so no translation needed, but if it is not available to the comptroller and is requested - must file a copy of the priority document.

Can also file a response to the objections raised in the international phase making the narrowing amendment to expedite the procedure.

7

d) The PCT application was filed before the GB application but published afterwards – so it is early filed later published, meaning the PCT can be cited as novelty only prior art against the GB application. Claim 1 of PCT application recites “a substrate” and claim 1 of GB application recites “a copper substrate”.

1✓ The broad does not disclose the narrow, so the broad “substrate” in PCT claim 1 does not disclose the narrower “copper substrate” in GB claim 1, and the description of PCT only discloses “rubber substrate”. Therefore claim 1 of GB

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1✓ application does not lack novelty over the PCT application, and the PCT application cannot be cited for inventive step. So GB application will overcome the citation of the PCT.

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