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QUESTION 1

a)

- 1✓ A certified copy of the Japanese patent application and an English translation  
1✓ thereof need to be filed in support of the priority claim pursuant to Section 5 of  
1✓ the UK Patents Act, and these should be filed by 16 months from the earliest  
priority date.

3

b)

Pursuant to Section 5, it is possible to request for a late declaration if the application in suit was filed within 2 months immediately from the end of period of 12 months from the earliest priority date. It will be necessary to satisfy the comptroller that the failure of filing the application within the original 12-month deadline was unintentional. Therefore, Patents Form 1 has to be filed within 14 months from the date of the Chinese application claiming priority to it, and to provide evidence showing that the failure to file within 12 months was

1

- 1✓ unintentional. Pursuant to Patents Rule 108, this 14-month deadline is non-extendible.

c)

Pursuant to Section 5, the application A has to meet:

- 0.5 - filed in the same country as application B  
0.5  
0.5 0.5 - before the filing of application B, application A has been unconditionally  
withdrawn without:  
0.5 ○ being published;  
0.5 ○ any outstanding rights being available; and

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0.5 ○ forming a basis for any priority claim.

7.5

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QUESTION 2

- 1✓ a) Windsurfing international v Norton
- b) the invention is a surfing board.
- c) the patent in suit was considered not inventive and revoked
- d)

For determining whether a claim involves an inventive step, the follow questions may apply:

1. identify an inventive concept of the invention
2. identify the person skilled in the art in the technical field of the invention, and common general knowledge in the field, and assume a mantle the person skilled in the art
- 3✓ 3. identify what, if any, difference between cited known art and the invention
4. determine, without the knowledge of the invention in suit, whether the difference constitutes a step that is obvious to the person skilled in the art, or whether it requires any degree of invention.

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QUESTION 3

a)

Pursuant to Section 72 of the UK Patents Act, grounds that a patent may be revoked are:

- 1✓ (1).the invention in the patent is not a patentable invention pursuant to Section 1 of the UK Patents Act;
- 1✓ (2).the person who to whom the patent was granted was not entitled to be granted such patent;
- 1✓ (3).the specification of the patent was not clear enough and complete enough for it to be performed by a person skilled in the art (a requirement prescribed in Section 14);
- 1✓ (4).the specification of the patent was amended to include additional matter that was not disclosed in the specification of the application for a patent as filed, or where the application was an application filed based on an earlier application pursuant to Section 8(3), Section 12 or Section 37(4) as a result of a proceeding or reference on the entitlement or filed based on an earlier application pursuant to Section 15(9), not disclosed in the specification of the earlier application (a requirement prescribed in Section 76);
- 1✓ (5).scope of protection of the patent was extended after grant (a requirement prescribed in Section 76).

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b)

0.5  
0.5 For an application for revocation based on any of grounds (1), (3), (4) and (5) mentioned in answer to question (a) above, any person, including the proprietor himself, may make the application to the comptroller or the court.

1✓  
1✓  
1✓ As for an application for revocation based on ground (2) mentioned in answer to question (a) above, only the person who is determined in an entitlement proceedings or reference to be entitled to be granted such patent and not any other person may file the application for revocation on the ground (2), and this should be done within 2 years from the date of grant of the patent in suit unless it is shown that the person who was granted the patent at the time of grant or at the time of obtaining the right to the patent that he was not entitled to the patent.

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QUESTION 4

a)

1✓ Pursuant to Section 23, the subject matter is military technology, or any other  
1✓ technology that may be prejudicial to national security or to the safety of the  
1✓ public.

b)

Section 23 is relevant in this situation because:

- 1✓ 1. Section 23 applies to any resident in the UK, as I am a UK resident, this section is relevant.
- 1✓ 2. The application is a first filed (without priority claim) application, this means there is no earlier application having been filed at the UKIPO, so that this application has not been subject to an examination by the UKIPO whether the applicant may cause the application to be filed outside the
- 1✓ UK. If an application has been filed at the UKIPO, and no direction that the applicant cannot file the application outside of the UK has been issued within 6 weeks of filing, or if any direction(s) has been issued, all of them has been withdrawn, then can the application be filed outside of the UK. If the application was first filed by a non-UK resident outside of the UK, then Section 23 does not apply.

c)

- 1✓ i) If I had been a US national, but still a UK resident, then this would still be a problem, because it is based on residence not nationality. Only when I had not been a UK resident, then it would not be a problem to me.

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ii) If the Chinese application was filed by non-UK residents, then it would not be a  
1✓ problem. However, if the Chinese application was filed by a UK resident without  
the approval of the UKIPO, then the problem still applies.

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#### QUESTION 5

a)

A patent that has been revoked is deemed as having never been granted.

Therefore, after being revoked, there is no patent to be examined for issuing an opinion.

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b)

A patent that has expired, for example due to the proprietor's failure to renew the patent may be renewed late pursuant to Section 25(4) of the UK Patents Act within 6 months from the original renewal deadline, or if after 6 months may be restored pursuant to Section 28 of the UK Patents Act within 19 months from original renewal deadline.

If a patent is cancelled due to an error in the patent office, the proprietor may request for resuscitation of the cancelled patent, pursuant to Section 117.

Therefore, a patent is expired or cancelled does not mean that the patent is definitely not enforceable for good. Requesting for an opinion pursuant to Section 74A, if result in that the patent being found to lack novelty or inventive step, it may be used to revoke the patent, so that if successful, the patent will not be enforceable for good.

1

c)

- Claim(s) of the patent is not clear or concise;
- Claim(s) of the patent lacks a support by the description;
- Claims of the patent lack of unity;

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- Patent was granted to a person not so entitled;
- Specification included additional matter as included additional matter not disclosed in the specification as filed;
- patent scope extended after grant.

0

d)

affidavit or declaration

0

e)

0.5

Any person (including the proprietor) may request for an opinion to be issued on a patent, by filing patents form 16 and paying prescribed fee, to the question whether an invention is a patentable invention.

The comptroller will refer the patent to be examined by an examiner if the request meets the prescribed requirements.

The examiner will conduct an examination on the patent and report the findings to the comptroller.

0.5

The comptroller will send a copy of the report to the person who made the request, and where such person is not the proprietor of the patent, to the

0.5

proprietor of the patent and giving the proprietor an opportunity to make observation and/or amend the specification.

0.5

The proprietor may request for a review of the opinion within 2 months of date of the opinion to the comptroller, by making an observation and where applicable amending the specification of the patent.

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The comptroller will forward the observation and amendment (if any) to the examiner to consider whether to set aside the opinion.

If the Examiner report to the comptroller whether the opinion sustains after the consideration of the observation and amendment (if any).

If the Examiner is not persuaded, and considered that claims were not novel or inventive, the comptroller may proceed to revoke the patent.

2

f)

the proprietor or exclusive licensee may apply for a review of the issued opinion within 2 months of the date of the opinion.

1✓

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g)

appeal to the court for a revocation pursuant to section 72.

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QUESTION 6

a)

0.5 1. Would the alleged acts of infringement achieve substantially the same results  
0.5 in substantially the same way as the patent in suit, i.e. having the same inventive  
0.5 concept as the patent in suit?

0.5 2. Would the fact (i.e. the acts of infringement achieve substantially the same  
0.5 results in substantially the same way as the patent in suit) be obvious to the  
person skilled in the art at the date of publication of the patent in suit?

0.5 3. Would the person skilled in the art understand that the patentee intended for a  
strict compliance of the language chosen for framing the claims?

If the answer to the first two questions are yes, and to the last one is no, then there is an infringement.

b)

Construction of scope of protection

To determine whether an alleged product infringes the claim of the patent in suit, it would be necessary to construe (the parts in the bracket) the protection scope of such claim. The claim of the patent in suit directs to: a hip joint (it is a hip joint, so that if a product would fall outside of the scope of protection of this claim if it is not a hip joint) having (open-ended, including the subsequently recited features, but may include other features) a teardrop-shaped head (the head is of a a specific shape i.e. teardrop-shaped).

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Based on client's letter, an artificial hip joint is essentially a rod having a head thereon, which means a hip joint having a head is a common general knowledge in the art.

Sample 1 – Hip joint with spherical head

This sample is a hip joint, hence falls within the subject matter of the claim in suit. However, the head in sample 1 has a spherical shape, which is obviously a different shape to a teardrop shape, as the person skilled in the art would understand that a teardrop cannot be spherical. Therefore, sample 1 falls outside of the claim in suit, hence sale of sample 1 is unlikely to be an infringement of the patent.

1✓ Separately, it is irrelevant whether the client, being the patentee has been making this for many years for analysing infringement unless the alleged infringer has been making this many years before the priority of the patent in suit.

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Sample 2 – Hip joint with elliptical head

This sample is a hip joint, hence falls within the subject matter of the claim in suit. Sample 2 is not literally within the scope of the claim in suit, as elliptical head is not teardrop-shaped head. However, it seems to be a variation to teardrop-shaped head. Therefore, to determine whether sample 2 falls within the protection scope, it may be necessary to apply the 'Catnic' questions.

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1. Would the alleged acts of infringement achieve substantially the same results in substantially the same way as the patent in suit, i.e. having the same inventive concept as the patent in suit?

1✓

Answer: According to the brief note, elliptical head fits the socket just as well as teardrop-shaped head. Therefore, the answer to question 1 is YES.

2. Would the fact (i.e. the acts of infringement achieve substantially the same results in substantially the same way as the patent in suit) be obvious to the person skilled in the art at the date of publication of the patent in suit?

1✓

Answer: According to the brief note, the good effect of “working well” is expected by a person skilled in the art as the tip of an ellipse is the same shape as the tip of a teardrop. Therefore, the answer to question 2 is YES as well.

3. Would the person skilled in the art understand that the patentee intended for a strict compliance of the language chosen for framing the claims?

1✓

Answer: As the wording in the claim in suit about the shape is “teardrop-shaped”, which is defined by a movement of a liquid, so that the person skilled in the art would understand that such description is not to strictly mean a very specific shape, but generally a shape with a tip at one end while the other end with a smooth curve surface. Hence the answer to question 3 is NO.

As the answer to the first two questions are yes, and to the last one is no, then there is an infringement. Therefore, sample 2 falls within scope of the

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claim in suit, hence sale of sample 2 is likely to be an infringement of the patent.

Sample 3 – Hip joint with cubic head

This sample is a hip joint, hence falls within the subject matter of the claim in suit. However, the head in sample 3 has a cubic shape, which is obviously a different shape to a teardrop shape, as the person skilled in the art would understand that a teardrop cannot be cubic. Therefore, sample 3 falls outside of the claim in suit, hence sale of sample 3 is unlikely to be an infringement of the patent.

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Sample 4 – grinding tool

This sample is grinding tool, which is not the patented product, hence sample 4 falls outside of the claim in suit, hence sale of sample 4 is unlikely to be an infringement of the patent.

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## QUESTION 7

a)

Advantages of entering both GB and EP national phase are:

It is possible that different sets of claims to be used for examination in the two applications, so that if subsequently both applications are granted and the claims are different in scope, such as the broader scope currently on record and the narrowing scope that you feel will be granted without difficulty, you will have different protection scopes for the invention.

0

b)

Double patenting between a UK patent and a European patent (UK) is a ground based on which the UKIPO may revoke the patent on its own initiative pursuant to Section 73 of the UK Patents Act.

1✓

If an invention is granted with both a UK patent and a European patent (UK), both patents were granted to the same proprietor or successor in title of them, with a same priority date, then there would be a double patenting issue. So that in this case, if the EP patent application (UK) and the GB national phase application are granted with the same set of claims, there would be a double patenting issue.

1✓

To avoid this danger, it would be necessary to ensure that no claim in the UK application before grant is of the same scope as any claim in the European patent application (UK) before grant. For example, you can file different claim set in the two applications for examination or amend them to be different either as voluntary amendment or when responding to an examination report.

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c)

0.5 GB national phase begins on the expiry of 31 months from the priority date, if the following are filed at the UKIPO (since it is approaching 30 months, it is likely a copy of the application has been sent to the patent office, hence not mentioned below):

- 1✓ (1).request for national phase entry in writing or by filing form NP1
- 1✓ (2).English translation of the specification of the PCT application
- 1✓ (3).English translation of the amendment made during the international phase
- (4).English translation of the statement and certificate for deposit of biological material, if such information is included in the PCT application pursuant to Schedule 1 of the UK Patents Rules
- 1✓ (5).Pay fee

If the above English (3), or (4) if applicable is not furnished to the patent office, the comptroller will issue notice to the applicant to file the documents accordingly, and the national phase will begins upon expiry of 3 months after the notice.

If inventor or inventors was not identified in the PCT application, then it would be necessary to file a statement of inventorship identifying the inventor(s) and where at least one applicant is not an inventor a statement of derivation of right to the invention by the applicant, within 2 months after the GB national phase begins.

If a certified priority document has not been furnished to the PCT application, a copy needs to be filed at the UKIPO within 2 months after the GB national phase begins.

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If there is a late priority claim, i.e. international filing date is within 14 months of the earliest priority date, then declaration pursuant to Section 5(2A) would need to be made with required evidence within 1 month from the GB national phase begins.

1✓ 0.5 A request for search with fee needs to be filed within 2 months from the GB national phase begins.

A request for examination needs to be filed within 33 months from the priority date, or if it expires later, 2 months from the GB national phase begins.

7

d)

1✓ As the PCT application was filed before the filing of the GB application but published after the filing of the GB application, after the PCT application enters GB national phase, it would form part of the state of the art pursuant to Section 1✓ 2(3), which can be cited as a prior art for assessing novelty (but not inventive step) of the GB application.

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1✓ However, as the PCT application does not disclose an embodiment with copper substrate, so that the GB national phase application would not destroy novelty of the GB application.

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