

Introduction

This year, candidates (even those who didn't quite pass) were noticeably better prepared than in recent previous years.

It is appreciated that candidates are under examination pressure, but it is important to read each question carefully, for example to avoid wasting time or even providing the wrong answer. Facts should be accepted where these are clearly stated. One recurring reason why marks were not awarded was not answering the question and submitting answers that attracted no marks, particularly considering ownership in question 1, non-UK rights in question 2, employment in question 3 and renewal fees and remedies in question 5.

This examination assess professional practice and marks are generally not available for statements of the law, but for application of the law to the situation presented in the question. More frequent use of the term “because” or the like would have improved the many candidates’ answers. Marks are awarded for analysis, application of the law and for advice: simple rephrasing of information provided in a question provides little value to a client.

Candidates are also reminded to allocate their time appropriately throughout the examination. A number of scripts performed well in Part A and a first question from Part B, only to fade away with a short, clearly rushed answer to the final Part B question where relatively few marks were gained. Candidates may score more highly by spreading their time evenly rather than spending excessive time on specific questions.

As always, when calculating dates (e.g. adding 16 or 18 months) candidates failed to achieve available marks.

A full consideration of the legal tests required is advisable. Sometimes candidates abbreviated the legal tests and therefore did not undertake a complete analysis of the information in the question.

Questions

Part A

Question number	Comments on questions
<p>Question 1</p>	<p>Despite clear instructions to ignore ownership issues, a significant number of candidates still did so resulting in time being wasted.</p> <p>Many candidates did not state that as an inventor, the client has a right to be named as such, or that this right extends to both the published application and any resulting granted patent.</p> <p>Some candidates muddled different mechanisms for resolving the position: a correction of the inventorship might be filed by the ex-employer but is not available to a third party. Entitlement proceedings are available to the client (which may result in a change in inventorship).</p> <p>Whilst a good proportion of candidates proposed contacting the ex-employer, fewer provided a rationale for doing so.</p> <p>A brief statement that compensation might be available in the future (and therefore the position should be monitored) was all that was necessary. Some candidates wrote a significant amount of text discussing the standards for compensation in detail, which was unnecessary in the context of a short question which has a clear problem around inventor naming.</p>
<p>Question 2</p>	<p>This question was generally well answered.</p> <p>The question specifically required advice about design rights in the UK. Consequently, discussion about patents or design rights in other territories could not be awarded any marks.</p> <p>Candidates need to distinguish between the various requirements for protection. For registration a design should be novel and possess individual character, while for infringement the test is whether or not there is a different overall impression. For unregistered design right the test for protection is whether or not the design is commonplace, while for supplementary unregistered design right it is novelty and individual character as for registered designs.</p> <p>An assertion that design right exists is insufficient to achieve marks without an explanation as to why this is so. Likewise, the assertion that to be registrable a design must be novel and have individual character is not sufficient without explaining why this is the case.</p>

	<p>With regard to supplementary UDR, it is important to make it clear that the design has first been disclosed in the UK and to exclude the possibility that the design might have first been disclosed elsewhere and has subsequently been disclosed in the UK. For example, it is not sufficient to state that supplementary UDR will last for 3 years from first disclosure in the UK because this does not preclude a previous disclosure elsewhere.</p> <p>Candidates should bear in mind that this is a legal examination and, while grammatical errors are not penalised, candidates are expected to express themselves accurately.</p> <p>Some candidates mentioned availability of supplementary unregistered design right but did not justify this by linking to the facts of the question (i.e. that the first disclosure was in the UK).</p> <p>A number of candidates did not handle well the issues around complex products (what defines a complex product) and availability of protection (what might be visible in normal use). Certainly, the cattle crush is a complex product, but the majority of the cattle crush could be expected to be visible. Candidates who mentioned visible in normal use did not provide much discussion of what this would be applicable to.</p> <p>Similarly, the cattle crush is clearly functional, but only those features solely dictated by technical function are excluded. There could still be a large degree of freedom for a designer while adequately satisfying the technical needs.</p> <p>There was often an assumption that functional features are not registrable, as opposed to features being solely dictated by their technical function.</p>
Question 3	<p>Overall, reasonable marks were achieved for this question. Candidates showed good knowledge of the legal theory of the “current situation”, and were less focused on the consequences and advice thereafter.</p> <p>Most candidates dealt well with threats and entitlement proceedings, but few went the extra distance and considered all the options for the client, let alone advising on which of the three options would be best.</p> <p>There was no evidence in the question of a threat. Candidates who commented that there was “no express threat” or that the letter was “likely” not a threat (without further explanation) failed to achieve the available mark: threats need not be express, but unless</p>

	<p>the letter went beyond notification of the existence it is definitively not a threat.</p> <p>Some candidates did not consider the need for the patentee to know about non-entitlement at the time of grant</p> <p>Entitlement proceedings can result in a range of outcomes and some candidates either did not consider that multiple outcomes were available (mark scheme reference 306) or failed to recommend one of the outcomes which would be most suitable for the client (mark scheme reference 307)</p> <p>The question clearly states that the client had Widget X made by a local company and that GB1 has a claim to Widget X. Consequently, it is a waste of time to advise checking there is infringement.</p>
<p>Question 4</p>	<p>The customer is stated to be the client's main customer. In view of this information, candidates were expected to appreciate that entitlement proceedings were unlikely to be a good way forward.</p> <p>An enabled public disclosure would be damaging to the client, and therefore candidates were expected to question if the presence of a fastener within an engine bay was enabling. A proportion of candidates asserted the disclosure was enabling. The facts of the question were that: the fastener is recognised by an individual from the client company; it is credible they might recognise it without functional details being visible to members of the public.</p> <p>Similarly, a limited and peripheral mention of a fastener in a patent filing may not be enabling, but the question indicates the presence of a detailed description. This content is important to the client from both potential prior art and basis perspectives.</p> <p>Any suitable strategy and method for achieving it was awarded marks. Some candidates made illogical or incorrect proposals/observations including: remove GB designation from the EP case prior to publication (no longer possible since EPC2000 came into force in 2007); that the EP case would be prior art for GB only if granted or if it enters GB (see PA s2(3)); file GB divisional (the pending case is EP); file PCT and have customer assign (what matter is this PCT directed to and what matter is to be assigned?); remove fastener disclosure from EP prior to publication; and "for additional advice reach out to a specialist IP firm".</p>
<p>Question 5</p>	<p>Although it was not relevant to the marks awarded, some candidates showed a poor understanding of the UK IPO procedures around grant. First, 4 December 2023 is that earliest date at which</p>

	<p>the application will be sent for grant (therefore it may remain pending for some time after this point). Since there have been multiple rounds of examination, no as of right amendment is available and in fact examination has now closed: the MPP suggests that although possible, re-opening of examination is highly unlikely. (Even in the case of novelty relevant prior art being identified, it is suggested that limiting amendments could be made post-grant.)</p> <p>At least one candidate suggested that prior user rights would be available in respect of the subject matter of any new divisional filings, since the third party activities would have started prior to the actual divisional filing.</p> <p>Some candidates stated that all formalities should be completed and then undermined this statement by stating an incomplete list of what these constituted. The mark was awarded for a simple statement that all formalities were due or a complete list of all formalities.</p> <p>The possibility of amending the EP case was often not handled well. Some candidates assumed the matter was unsearched, whilst others assumed the reverse, that it would still be possible to have invention Y searched.</p> <p>Surprisingly few candidates considered whether it was possible to amend the claims of the EP application to direct them towards Y: almost all suggested divisional instead (which is, of course, a potentially more expensive option). A</p>
<p>Question 6</p>	<p>A high proportion of candidates argued that there was intention to file a further application, thus enabling the client to refile and claim late priority. However, this does not fit with the facts of the question.</p> <p>Unfortunately, quite a significant number of candidates advised that it was perfectly possible to “fix” the priority claim validity problem by amending the Applicants / amending the filing form of PCT2 to list the correct applicants.</p>

Part B

Question number	Comments on question
<p>Question 7</p>	<p>This question was attempted by a high proportion of candidates and good marks were commonly achieved. Those who did well identified the key issues and worked their way through the complex issues.</p> <p>Marks were sometimes lost by bundling GB1, GB2 and GB3 together when the implications arising from the cases are very different: GB1 lapsed before any relevant work was done; GB2 lapses shortly; GB3 has a number of years of term remaining.</p> <p>Candidates should apply the facts of the question. Those who stated check renewals for GB2 and GB3 had considered the fact that GB1 has already lapsed. Broader boilerplate statements to check renewals on all cases, while safe, might undermine other commentary in respect of status of cases and infringement issues.</p> <p>A proportion of candidates failed to comment on the fact the client and patentee do not appear to be competing and therefore an amicable resolution might be possible. Candidates are reminded to make use of all of the information provided in the question.</p> <p>The question does not state if the client is manufacturing or not; those who assumed a specific position lost the opportunity to obtain a mark in respect of the significance of this to threats and infringement activities. Private activities are not exempt from infringement (private and non-commercial are).</p> <p>A statement that GB1 is not in force now, while relevant for future activities, does not address the fact that RB had been operating in the past. Better candidates highlighted that GB1 had expired before RB started work.</p> <p>The marks available for the handling of “research into the subject matter of the invention” were often missed, with the correct test for the exemption not stated and limited consideration of two distinct phases (historical work and future research for the second-generation product).</p> <p>A concerning number of candidates suggested filing on new developments only if the second-generation product fell outside the scope of the third party cases. FTO does not impact patentability <i>per se</i>, and in any event the youngest CN case was</p>

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	<p>around 16 years old (meaning it will not be of concern for the majority of the term of a new filing).</p> <p>Very few candidates actively considered the possibilities of actioning the threat and whether it was possible or not.</p>
<p>Question 8</p>	<p>An in-depth analysis of the given facts was required to do well in this question.</p> <p>Candidates who were cognisant of the distinctions between the patented method, seeds and carrots recognised the implications for infringement and enforcement and achieved many more marks.</p> <p>Early entry into the National/Regional phase is not the same as early processing or accelerated examination. It is possible to enter the National/Regional phase early, but nothing will happen unless early processing (EPO – GL E IX,2.8) or accelerated examination (UK – Formalities Manual 13.125) is also requested. Candidates needed to make it clear that more than early entry was required.</p> <p>While it was sometimes commented that seeds obtained through propagation can be exempted from infringement, a notable proportion of these candidates failed to indicate that this exclusion only applies where the original seeds were provided by the patentee or with their consent (i.e. the original seeds must not have been an infringement).</p> <p>Candidates who realised the practical headaches arising from the disjoint between method, seeds and carrots, and the fact the client's case is at an early stage, recommended pursuit of claims which were more proximal to the carrots.</p> <p>Analysis of a potential interim injunction was not handled well with candidates sometimes providing an incomplete consideration of the steps (either missing steps or trivial statements of law without linking to the context of the question).</p>
<p>Question 9</p>	<p>Candidates who were well versed in handling formalities issues did well here.</p> <p>While candidates generally appreciated the importance of providing a priority document, a proportion were not familiar with the opportunities available to do so (e.g. a two month extension to the normal deadline was proposed by some).</p> <p>Few candidates seemed to be aware that late filed documents received prior to publication would nevertheless be accepted.</p>

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	<p>While “normal” timelines might be expected, the client’s position would be improved if there had been a deviation. Therefore it is worth considering and checking this possibility.</p> <p>Prior art effective in the UK can stem from either an EP(GB) or GB and stating only one of these routes meant failure to achieve an available mark.</p> <p>PCT actions appeared not to be well known to most candidates.</p>
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