

Introduction

There was no evidence to suggest that the online format of the paper led to any particular difficulty for candidates. Candidates who reformatted their documents sometimes produced answers that were difficult to read. Other candidates reproduced large sections of text in different sections of their answer without using it in their argument or analysis. These are not penalised, but candidates should be aware that they have the potential to obscure their reasoning.

The 2023 paper followed the pattern of FD4 in previous years and awarded candidates marks for their ability to provide an analysis that applied current UK law in respect of infringement and validity with reasoning and justification for their conclusions. While marks are available for simply identifying features or issues, candidates need to provide reasoned arguments with support to achieve the sufficient marks to pass. Reasoning needs to be consistent across the various tasks.

Some candidates appeared to have run out of time. However, it was not clear if these candidates had formulated an answer but did not have time to write it up, or did not have an answer. Answers can be presented in note form provided that the support and reasoning can be clearly followed, but simple conclusory statements achieve few marks.

This year, the scenario provided a number of different areas to be addressed, including the use of relative terms in the claims, embodiments of the invention from different technical areas, claims covering medical procedures, and prior art from dissimilar arts. Candidates were able to achieve a pass without fully addressing all of these areas, but many were able to pick up useful marks by discussing all of these, even if superficially in some cases.

The scenario supports conclusions that:

- claims 1, 2, 3, 4, and 6 were infringed, but there is a defence under s. 4A(1) to infringement of claim 6 as being a method of treatment;
- claims 1 and 3 lack novelty in view of Document C;
- claims 1, 2, and 3 lack inventive step;
- there were no issues of sufficiency; and
- there are potential saving amendments for claims 1 and 6.

Other conclusions were acceptable if properly reasoned and supported. Many candidates passed while reaching different conclusions on one or more of these points. As in previous years, the support and reasoning for a conclusion are at least as important as the conclusion reached.

While the issue of claims covering methods of treatment do not occur in all technology areas, the general issue of inventions that are not patentable, whether under s. 1(2), s. 4(1), or s. 4A(1) (e.g. methods of doing business, computer programs *per se*, mental acts,

etc) , often arises. Candidates are expected to be able to identify such non-patentable inventions and know the consequences of claim invalidity and defences arising from the inclusion of such subject matter.

Construction

Many candidates produced reasonable meanings for the terms used in the claims. It was not enough to propose a meaning for a term, the answer also needed to provide support and reasoning to attract full marks.

Where there were a number of different examples of a feature in a claim in the patent, candidates needed to find a meaning that encompassed these examples. Simply listing the different examples does not provide a meaning. For example, the term “peg” in claim 1 needed to encompass both the ground peg and suturing device. Interpreting this as being a body that is inserted into a substrate provides one such meaning (other constructions are also possible). Similarly, for claim 2, the feature “carries a flexible cable” needed more than repeating that it extends along length or through the bore to get full marks.

Some of the features of the independent product claim (claim 1) were not explicitly stated in the patent and so needed to be constructed from the context of the invention. Examples of these are the driving end and head end of the side bar. Most candidates made a reasonable effort to explain these. Claim 1 also included some relative terms that needed more explanation.

The feature that the head end of the side bar extends at an angle to the shank needs explanation. The patent does not mention a specific angle so candidates were expected to look at the reason for the angle, to induce the curved path. It was also appropriate to discuss whether the angle was permanent or the result of the interaction of the body portion and side bar. Either was acceptable, if properly reasoned.

Most candidates recognised the issue arising from the use of the term “tightly curved path”, particularly as “tightly” is not defined in the patent other than by reference to prior art devices. While patent office examiners might consider this term non-limiting, candidates were expected to try to find a meaning that could be justified. Some candidates attempted to resolve the difference in wording between the product and method claims by linking “tightly curved” (claim 1) with “out of the substrate” (claim 6). While this is not the only answer, it represents one good approach to the problem. There is nothing in the patent that allows a specific range of angles to be defined.

The “asymmetric thread” of claims 4, 5, and 6 is a term that is defined in the patent. There is no basis for any meaning that can be derived from the patent that gives a sensible broad meaning.

Most candidates noted the inconsistency between the dependency of claim 5 and its wording. To obtain full marks, it was necessary to come to a decision on how to construe the claim in the light of this consistency.

As noted above, there is inconsistency in the wording between claims 1 and 6. Many candidates resolved this effectively. However, few effectively discussed the meaning of “to expose the end of the flexible thread”.

Infringement

Most candidates did not seem to have major problems in deciding on infringement of product claims. The main issue with the answers was the lack of reasoning. A simple statement that a feature of a claim is present was not awarded any marks. At the very least, it was necessary to specifically identify the feature of the infringement that was being alleged to correspond to the feature of the claim. Candidates who did this and explained why these correspond to the feature in question obtained good marks.

Many candidates noted that the infringement of method claim 6 constitutes a method of treatment. However, this point was not well explained in many cases. Some candidates suggested that this meant that there was no infringement rather than as a defence of invalidity. To get full marks a candidate needed to identify that the claimed method included a medical method in scope and that this was excluded from patentability as such (it was not necessary to explicitly state s. 4A(1) as long as the explanation was correct). Therefore, this was a defence to a claim of infringement of the method claim for the suturing use of the infringing device.

Some candidates seem to confuse the concept of purposive (i.e. “normal”) construction with the concept of infringement by equivalents (“Actavis”). The issues of purposive construction should have been dealt with in the construction section when deciding on the meaning of the terms in the claims. Actavis only comes into play once infringement is not found under purposive/normal construction. One example of this is the side bar being construed as being “entirely” within the tubular shaft. The logic that allows “within” to be limited to “entirely within” (i.e. a narrow meaning of the words) would normally be expected to preclude the ability to find infringement by equivalence under Actavis and would need detailed discussion to be resolved.

A number of candidates presented the standards for assessing infringement by equivalents without then going on to apply these to the facts in question.

Candidates are expected to come to a conclusion as to whether consideration of Actavis is needed for claims not infringed under purposive/normal construction with justification.

Some candidates argued that the trials conducted by the client could be defended as experimental use under s. 60(5)(b). While this may be correct, it has no impact on the intended commercial use of the products discussed by the client in their letter.

Novelty

Many candidates achieved good marks for the assessment of novelty.

While the patent itself argued that the claimed invention was different from the prior art discussed in the patent, candidates were still expected to conduct a full novelty assessment with respect to this prior art in view of the close similarity of the ground peg embodiment of the patent. However, a detailed discussion of the thigh bone screw was not expected in view of the absence of any structure corresponding to the tubular body.

The scenario supported a finding that the prior art device of Fig. 1 of the patent did not destroy the novelty of any claims due to the absence of the bent head of the side bar and the curved path not being “tightly” curved. However, as long as it was consistent with construction and properly supported and reasoned credit could be given for another conclusion.

For Document C, infringement of claim 1 turned mainly on the construction of the term “tightly curved”. The helical path in document C is clearly tighter than the path of the prior art device of Fig. 1 of the patent.

When considering claims 4 and 5, it was sufficient to simply note that the feature was absent.

Claim 6 was expected to be novel.

Most candidates demonstrated that they understood how to assess and argue novelty effectively.

Inventive Step

The assessment of inventive step was not well done in most cases. Many candidates gave no more than superficial conclusory statements or produced analyses of inventive step that were inconsistent with claim construction, infringement, and/or novelty.

As in previous years, an assessment of inventive step was required for all claims, even those that had been found to lack novelty. For claims likely to lack novelty, marks were still available for identification of the concept and the state of the art.

The assessment of inventive step must follow the approach set out in Pozzoli. An EPO-style problem and solution analysis is not appropriate and will only be awarded marks for areas where it aligns with a Pozzoli analysis.

The fact that the patent covers two embodiments from different arts (ground pegs and suturing devices) raised a number of issues for inventive step. Unless the claim had been construed to relate to only one of these, candidates needed to define the skilled person and common general knowledge in such a way as to cover both. Many candidates

presented the skilled person as a team to deal with this issue. This was perfectly acceptable if reasoned and supported.

If candidates had decided that the concept was derived from only one of the fields of art, they would need to provide a convincing argument as to why the skilled person would look elsewhere when addressing this concept, even where a team was proposed for the skilled person. For example, if the concept of a claim was presented as being in the field of suturing, explanation would be needed to explain when the skilled person would look to the field of ground pegs for the state of the art or common general knowledge.

Many candidates struggled to define the concept of a claim as opposed to its technical contribution to the art.

Some candidates produced relatively complete and well-reasoned conclusions. Those candidates who did well in inventive step usually achieved good marks in the paper overall.

Sufficiency

There is nothing in the scenario to suggest that there were any issues with sufficiency. It was sufficient to state this to achieve the single mark available.

Amendment

Discussion of amendment obviously depended on the conclusions for infringement and validity. However, there were a number of possible amendments that could be used to provide inventive step and infringement.

Amendment would be needed in any event to address the problem that Claim 6 includes a non-patentable method of treatment within its scope. Relatively few candidates recognised that such an amendment would be needed to ensure validity of the patent and a limitation to a method of securing a ground peg would achieve this.

Other amendments could include amending to limit to a suturing device if novelty and/or inventive step problems arose from the ground peg prior art, or the use of visually differentiated cables for any use.

Candidate were not expected to do more than identify the subject matter that could form the basis of such an amendment to achieve the single mark available.

Advice

In most cases, the advice was superficial at best.

The client had asked specific questions in the instructing letter. Candidates should provide explicit answers to such questions at the very least. Furthermore, these questions should have directed the candidate to the sort of general advice that may be relevant to the client.

Few candidates addressed the issue of Claim 6 covering a method of treatment and the consequent vulnerability of the patent to an invalidity action arising from this. While a saving amendment appears possible, the patent could not be enforced until this was made. This gives the client a stronger position in negotiations.

Some candidates gave advice for the client to go ahead with launching the product despite having previously concluded that claims were infringed. Advice such as this cannot be awarded marks.

There were a number of different subject that could have been discussed to obtain marks in this section. However, few marks were awarded for general comments that were not directly related to the facts in the scenario.