

**FC1 UK Patent Law Mark Scheme
FINAL Mark Scheme 2024**

SECTION A

Question 1

With reference to Section 73 (*Comptrollers power to revoke patents on his own initiative*) list three grounds on which the Comptroller can revoke a patent on his own initiative

Total: 6 marks

ANSWER

- (a) If the invention for which the patent has been granted forms part of the state of the art by virtue of Section 2(3) – novelty only prior art **(1 mark)**.
- (b) When the Comptroller issues an opinion that the invention is not novel **(0.5 marks)** or inventive **(0.5 marks)**
- (c) That a patent under the Act and a European patent (UK) **(1 mark)** have been granted for the same invention **(1 mark)** having the same priority date **(1 mark)** and same applicant (or successor) **(1 mark)**. [will instead accept 'double patenting' **(1 mark)**]

Question 2

With reference to Section 74 (*Proceedings in which the validity of a patent may be put in issue*) list the proceedings in which the validity of a patent may be put in issue?

Total: 6 marks

ANSWER

- (a) infringement proceedings (Section 61) **(1 mark)**
- (b) infringement proceedings (Section 69) **(1 mark)**
- (c) proceedings in respect of an actionable threat **(1 mark)**
- (d) proceedings under Section 71 (declaration of non-infringement) **(1 mark)**
- (e) proceedings under Section 72 (power to revoke a patent of application) **(1 mark)**
- (f) proceedings under Section 58 (crown use) **(1 mark)**

Question 3

Your client, Mr Smith, is a UK national and resident. Mr Smith has developed a nose cone for a hypersonic missile. Mr Smith has instructed you to immediately file patent applications for this invention both in the UK and abroad without claiming priority so that he can start making the invention public.

With reference to at least one of Sections 22 and 23 of the UK Patents Act, suggest alternative approaches with reasons.

Total: 5 marks

ANSWER

- (a) the subject matter might be considered to relate to military technology (**1 mark**) or national security (**1 mark**)
- (b) file at UKIPO (**0.5 marks**) and wait for six weeks (**1 mark**) before filing abroad (**0.5 marks**)
- (c) request a foreign filing permit (**1 mark**)

Question 4

On 29 Sept 2020 your client, Ms Hussein, filed UK patent application GB1234567.8 for a toothbrush. There is no priority claim. On 20 Sept 2023 the UK Patent Office issued an examination report setting a deadline of 20 Jan 2024 for response. Ms Hussein never opened the envelope. Ms Hussein has now received a letter from the UKIPO stating that it is intended to treat the application as refused.

- (a) Advise Ms Hussein how to proceed.

7 marks

- (b) How would your advice have been different if the examination report had never been received?

2 marks

Total: 9 marks

ANSWER

If the candidate considers that the application is still pending -

- (a) Request a discretionary extension (**1 mark**). Provide an explanation as to why the deadline was missed (**1 mark**). Some discussion of whether the extension of time is likely to be granted (**1 mark**). File a response to the office action (**1 mark**). Some discussion of the compliance period (**1 mark**). Possibly file a divisional application (**1 mark**). General discussion of requirements for a divisional application (**1 mark**)
- (b) File a request for an extension of time under rule 111 (**1 mark**). Some discussion of supporting evidence (**1 mark**).

If the candidate considers that the application is refused –

- (a) Too late to request an as of right extension (**1 mark**). Request re-instatement (**1 mark**). Deadline 12 months from missed deadline (**1 mark**) (will also accept 20 Jan 2025). Provide an explanation of why the deadline was missed (**1 mark**). Some mention of 'unintentional' (**1 mark**). File a response to the office action (**1 mark**). Some discussion of the compliance period (**1 mark**).
- (b) Again request reinstatement (**1 mark**). Stronger case for reinstatement as one has a stronger argument re 'unintentional' (**1 mark**)

Question 5

- (a) Under what circumstances is a grant fee payable to the UKIPO? **3 marks**
- (b) What is the deadline for payment of the grant fee? **1 mark**
- (c) What extension as of right is possible and how is this obtained? **2 marks**
- Total: 6 marks**

ANSWER

- (a) 25 or fewer claims when search was requested and now more than 25 (**1 mark**).
35 or fewer pages of description when examination was requested and now more than 35 (**1 mark**). The number of excess claims/pages is now increased above the number paid earlier in the process (**1 mark**).
- (b) Two months (**0.5 marks**) from the date of notification of intention to grant (**0.5 marks**)
- (c) Two months (**1 mark**). File form, 52 (**0.5 marks**) and pay fee (**0.5 marks**).

Question 6

On 25 September 2024 you filed a UK patent application in Chinese, claiming priority from a Chinese patent application filed on 25 September 2023. The application relates to the manufacture of tiny ball bearings for use in electronic devices. You have now received a notification from the UKIPO, dated 7 October 2024, that an English language translation is required.

(a) what is the deadline for filing the English language translation?

1 mark

(b) what extension of time is available?

2 marks

On receiving the translation, you discover that all the measurements are in miles rather than millimetres. A quick check reveals that this is not a translation error – it is present both in the Chinese language text of the application as filed and the priority application.

(c) how would you address this problem?

5 marks

Total: 8 marks

ANSWER

(a) Two months from notification (or 7 Dec 2024) (**1 mark**).

(b) Two months (**1 mark**) at the discretion of the Patent Office (**1 mark**).

(c) File the translation as is (**1 mark**). Request correction of the obvious error (**1 mark**) on the grounds that one does not measure tiny ball bearings in miles (**1 mark**). File a further application with the correct units as a fall back (**1 mark**). No late declaration of priority possible (**1 mark**).

Section B

Question 7

On 29 Nov 2021, your client Big Widget PLC filed a UK patent application (D1) which discloses and claims a widget. Development of the widget did not go well, and on 1 April 2022 they withdrew the application. Shortly afterwards, Big Widget made a breakthrough in widget manufacture and re-filed the application at UKIPO on 29 April 2022 as D2. D2 contains all of the subject matter of D1 and further discloses and claims the method by which the widget is manufactured.

On 29 April 2023, Big Widget filed a PCT application (PCT1) claiming priority from D2 and identical thereto. D2 was allowed to lapse.

On 29 May 2023, D1 was unexpectedly published by UKIPO. UKIPO have no record of having received the withdrawal letter.

PCT1 has now been entered into the UK national phase as D3.

Write notes for a meeting with your client. Your notes should cover the following points

–

- (a) **The validity of the claim to priority. You should consider the claim to the widget and the claim to the method of manufacture of the widget separately.**

9 marks

- (b) **Patentability of D3. You can assume there are no documents or other prior art other than the above.**

11 marks

Total: 20 marks

ANSWER

- (a) Method of manufacture claim –
Subject matter first disclosed in D2 (**1 mark**). Priority claim is valid (**1 mark**).
Widget claim –
If D1 was not withdrawn ‘leaving no rights outstanding’ (**1 mark**) then D2 is not the first application for the invention (**1 mark**) in the UK and the priority claim is not valid (**1 mark**).
If D1 was withdrawn ‘leaving no rights outstanding’ (**1 mark**) then the priority claim is in principle valid (**1 mark**). Would need to file evidence at UKIPO (**1 mark**).
Some discussion of possible evidence (**1 mark**).

- (b) If D1 is not considered to be withdrawn then D1 is novelty only prior art against D3 (**1 mark**)

If D1 is considered to be withdrawn then D1 is not prior art (**1 mark**) even though it has been published (**1 mark**).

Method of manufacture claim –

If D1 is novelty only prior art – the method is not disclosed in D1 (**1 mark**). The method claim is therefore patentable (**1 mark**).

If D1 is not prior art – no prior art against the method claim and the method claim is therefore patentable (**1 mark**).

Widget claim –

D1 is novelty only prior art – the widget claim is not novel (**1 mark**). Consider if the method discloses a new structural feature (**1 mark**). Also consider changing the widget claim to a product by process claim (**1 mark**). Further, consider prosecuting D1 as it is not withdrawn (**1 mark**).

D1 is not prior art – no prior art against the widget claim and therefore patentable (**1 mark**).

Question 8

Write notes on two leading cases of the British Courts. For each case, your notes should cover the parties to the case, a summary of the facts of the case, a summary of the decision and a brief discussion of what precedent is set by the case. One case should have claim construction as the main issue. The other case should have novelty or inventive step as the main issue.

For each case –

- | | |
|-------------------------------|----------------|
| (a) the parties to the case | 1 mark |
| (b) summary of the facts | 2 marks |
| (c) summary of the decision | 3 marks |
| (d) precedent set by the case | 4 marks |

Total: 20 marks

ANSWER

- (a) Names of the parties to the case (**1 mark**).
- (b) Facts of the case – cursory summary (**1 mark**). More detailed discussion covering most of the main issues (**2 marks**).
- (c) Correct identification of the decision (**1 mark**). Some associated reasoning (**2 marks**). More detailed associated reasoning (**3 marks**).
- (d) Cursory summary of precedent (**1 mark**). More detailed summary identifying at least some of the main points (**2 marks**). Detailed summary identifying all the main points (**3 marks**). Consideration of more subtle consequences (**4 marks**).

Question 9

Your UK based client writes –

“We have invented a new bottle opener. In summary, the bottle opener comprises a handle and a head. Both the handle and the head are known in the art but as far as we are aware, this is the first time they have been used together. It turns out they work surprisingly well together. Nonetheless, since the bottle opener is merely made up of known parts, we assume we cannot protect it.

We have performed a patent search of our own and have found GB1 for the handle and EP1 for the head. No renewal fees have been paid on either, so we think we are OK to start making and selling the bottle opener in the UK.”

A review of GB1 shows it was filed on 21 May 2019 and granted on 7 Feb 2023. No renewal fees have been paid.

A review of EP1 shows it was filed and prosecuted in English and granted on 25 Aug 2024. Again, there is no record of any renewal fee having been paid at the UKIPO.

Write notes for a meeting with your client.

Total: 20 marks

ANSWER

The combination of head and handle is likely to be patentable (**1 mark**). The combination is novel (**1 mark**) and has an unexpected technical advantage (...‘works surprisingly well’...) and so is likely to be considered to be inventive (**1 mark**). Enquire further as to any public disclosure that might have been made (**1 mark**).

For GB1, the first renewal fee was due on 31 May 2023 (**1 mark**). Could have been paid late until 30 Nov 2023 (will also accept six months late) (**1 mark**). Since this deadline has passed, apply for restoration (**1 mark**). Can apply for restoration until thirteen months from the end of the six-month grace period (**1 mark**) (will also accept 19 months from the renewal deadline) which is 31 Dec 2024 (**1 mark**). Failure, however, must be unintentional (**1 mark**). Your client could have acquired third party rights (**1 mark**) provided they have made serious (**1 mark**) and effective (**1 mark**) preparations in good faith (**1 mark**) between the end of the grace period (**1 mark**) and publication of an application for restoration (**1 mark**).

For EP1, the first renewal fee at the UKIPO will not fall before the last day of the month three months after the date of grant (**1 mark**). Deadline for payment of the renewal fee is therefore not before 30 Nov 2024 (**1 mark**).

Infringement may therefore be an issue. If possible, wait to see how matters develop (**1 mark**). Possible cross licence if client files their own patent application (**1 mark**).

Question 10

Your clients DreamDye have discovered that obscure chemical X makes an excellent hair dye. They have a granted UK patent which has one claim which reads –

“A method of dying hair comprising the steps of

- (a) applying a mixture of X and water to hair; and,*
- (b) rinsing the mixture from the hair.”*

Your clients have recently discovered Chinese company, CurlUpAndDye, manufacturing and selling XDye which is a hair dye containing X. They sell trade-to-trade to other companies around the world and have recently approached DreamDye.

Following this approach, your clients have investigated further and have found a UK based company, FadeFree Ltd, selling XDye. FadeFree’s website states –

“We are the UK’s sole retailer of XDye to the public. If you do not feel comfortable applying this powerful hair dye yourself, feel free to contact your nearest hair salon, they are probably already using it’.

DreamDye wish to completely stop use of X as a hair dye by third parties.

Prepare notes for a meeting with your client. You should identify any potentially relevant parties and consider both direct and indirect infringement. You should also consider defences to infringement.

Total: 20 marks

ANSWER

Direct infringement –

CurlUpAndDye is not a direct infringer (**1 mark**). Not performing the method (**1 mark**). Not offering to perform the method (**1 mark**) in the UK (**1 mark**).

Fade Free Ltd – again, no direct infringement (**1 mark**). (same marks as above available re reasoning, but only once)

Third party hair salons – direct infringement as performing the method/ offering it for use (**1 mark**).

Members of the public – again direct infringement as performing the method in the UK (**1 mark**). However, most likely to be a defence on the grounds that such use is private (**1 mark**) and not commercial (**1 mark**).

Indirect infringement –

XDye is an essential element of the invention, rather than a staple product (**1 mark**), as is an obscure chemical (**1 mark**).

CurlUpAndDye – knows or it is obvious that the means are suitable for putting the invention into effect in the UK (**1 mark**) and are intended to put the invention into effect in the UK (**1 mark**) as it is sold as hair dye (**1 mark**). Depends on where the sale to FadeFree takes place - If sale to FadeFree is in the UK then indirect infringement (**1 mark**) otherwise not (**1 mark**). FadeFree Ltd – sale of Xdye to salons (**0.5 marks**) and the public (**0.5 marks**) is contributory infringement.

Defences to infringement –

Sale of the product by CurlUpAndDye before the filing date of the client's patent may make the patent invalid due to a lack of inventive step (**1 mark**) or possibly novelty depending on the instructions sold with the dye (**1 mark**). Also, potential right to continue to do 'the act' under Section 64 (**1 mark**).