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Section A -Question 1

The three grounds are:

- 1✓
- When the Comptroller comes to know that there is double patenting. For instance, when there is a GB grant and a EP grant designating UK, and the scope of protection is the same.
 - When the Comptroller comes to know that the patent is not granted to a person not entitled to the patent.
 - When the Comptroller comes to know that there is unallowed amendment that go beyond the application as originally filed or that that the scope of protection goes wider that it should after an amendment after grant.

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Section A – Question 2

The proceedings in which the validity may be put in issue:

- 1✓ (a) As a defence when there is an infringement proceeding
- 1✓ (b) In a proceeding involving groundless threat
- 1✓ (c) In a proceeding involving revocation of a patent.

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Section A- Question 3

Under Section 23, a person resident in UK (nationality is not an issue) cannot first file an application outside of UK without the explicit approval from the Comptroller. Furthermore, since the invention is related to a nose cone for a

1✓ hypersonic missile (i.e. related to military technology and may be prejudicial to

1✓ the public safety), it is likely that the Comptroller will restrict publication or communication with specified parties. Therefore, he should not make the invention public, unless prior approval has been sought. Failure to comply with the national security requirements may result in a jail term and/or a fine.

0.5 We recommend Mr Smith to first file a patent application in UK to secure a filing

1 date. Subsequently, at least after 6 weeks of filing the UK patent application (but within 12 months of the filing of the UK patent application), and if the Comptroller

0.5 does not issue any notification to Mr Smith relating to the restriction in publication or communication, we can then file patent applications abroad claiming priority to the UK application. In this manner, the patent applications filed abroad will still be able to retain the priority date (for assessment of novelty).

Alternatively, Mr Smith can consider filing a PCT application through the UK Intellectual Property Office (UKIPO) as the receiving office.

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Section A – Question 4

a) Filing date: 29 Sep 2020

First Examination Report: 20 Sep 2023; setting a response deadline by 20 Jan 2024

Consequently, Compliance period: later of 4 years 6 months of the filing date (i.e. 29 Mar 2025) and 1 year from date of issuance of the first examination report (20 Sep 2024). Therefore, the compliance date is 29 March 2025.

Since Mrs Husseni has received the examination report (despite that she has not opened the envelope), we should immediately file a divisional application claiming priority to the parent application, pay application fees, request for search and pay search fee, request for examination and pay examination fee. Before requesting for examination, voluntary amendments to the specification may be made to overcome the objections in the examination report. Written submissions may be submitted with the amendments, but it is at the discretion of the Comptroller to consider the written submissions. If required, a request for an extension of time for 2 months as-of-right can be filed for extending the compliance period of the divisional application so that any objections can be addressed promptly.

b) If the examination report had never been received, we should inform the Examiner in writing, and request for an extension of time of 2 months and submit evidence (possibly a statutory declaration) for a further extension of time. We should also call the Examiner immediately. Once the

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Examiner approves a further extension, we should file a response as soon as possible, and within the extended time period specified by the Examiner. If required, a request for an extension of time for 2 months as-of-right can be filed for extending the compliance period of the parent application so that any objections can be addressed promptly. We should also monitor the deadline to file a divisional application (3 months before the compliance period of the parent application and before the application will be treated as refused), in the unlikely event that the discretionary extension of time is not granted.

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Section A- Question 5

- 1✓ (a) Grant fee is payable to the UKIPO, if there are excess claim fees (if the number of claims increased during the prosecution) and/or excess page fees (if the number of pages increased during the prosecution). 1
- (b) 1 month from the issuance of date of intention to grant 0.5 0.5
- (c) This deadline can be extended for 2 months as of right. This can be obtained by filing the prescribed form, Form 25. 1✓ 1.5
- 0.5
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Section A – Question 6.

- a) 2 months from the date of the UKIPO notification indicating the furnishing of the English translation. This means 7 December 2024 (sat). Since it falls on an excluded day, it is automatically extended to 9 December 2024 (Mon).
- b) The Applicant can file a request for a 2-months extension of time as of right. A further discretionary extension of time of another 2 months may be allowed, if evidence is submitted and a separate request form is filed before the end of the above extended time period.
- c) Although it is not a translation error, a correction should still be filed if there is a typographical error in the specification of an application for a patent. Amendment, in this case, is not suitable as it will go beyond the disclosure of the priority application. A request in accordance of the regulations must be submitted. It must be shown that it is inevitably the correction and unambiguously disclosed, i.e. no other possible options for the mistake in the specification. Since the application relates to the manufacture of tiny ball bearings for use in electronic devices, it can be submitted that that a skilled person would understand that it has to be in millimetres, instead of miles (due to the scale suitable for use in electronic devices). We should also look through the specification, for instance, the drawings, to provide support for such arguments.

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Section B- Question 7

- a) To consider validity of the claim to priority of PCT1, let's consider the facts.

PCT1 (filed on 29 April 2023) is identical to D2, and claims priority to D2 (filed on 29 Apr 2022). D2 was allowed to lapse.

PCT1 has all the subject matter of D1 (i.e. claims of a widget) and further claims the method by which the widget is manufactured.

D1 was filed on 29 Nov 2021, withdrawn on 1 April 2022, and unexpectedly published on 29 May 2023. Note that UKIPO has no record of having received the withdrawal letter.

D3 is the UK national phase of PCT1.

Both D1 and D2 is filed in the same country. D2 contains the subject matter of D1 and additional subject matter relating to the method by which the widget is manufactured. Therefore, for D2 to serve as a priority application, D1 must be withdrawn and leave no outstanding rights before D2 is filed.

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Although D1 is not being used to serve as a priority date, it seems that D1 is not withdrawn without any outstanding rights. At least for the fact that UKIPO has not record of having received the withdrawal letter. In other words, D2 is thus not the first application being filed for the subject matter of D1.

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In such a case, the claim to priority of D2 is invalid for the subject matter of D1.

1✓

Relevant date for claim of a widget will be 29 April 2023.

Relevant date for claim of a method by which the widget is manufactured will be 29 April 2022. This is because the priority claim is valid, as it is the first application that is filed for the method by which the widget is manufactured.

1✓

1✓

May need to investigate with the client how the withdrawal is done, and if there is any evidence of such withdrawal.

1✓

b) Patentability of D3.

When PCT1 entered into the UK national phase as D3, D1 becomes a relevant prior art to D3. Although D1 was published after the PCT1 application has been filed, D1 has an earlier filing date and PCT1 comprises all of the subject matter of D1. Therefore, D1 is a prior art for novelty only, and not a full prior art. In such circumstances, the claim to the widget in D3 will lack novelty over D1.

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D2 was allowed to lapse, so even if it is not published, it is also relevant to the novelty of D3 (as the priority claim to D2 for PCT 1 is invalid).

Unless the client is able to provide evidence that a withdrawal of D1 was indeed filed before publication of D1 (and assuming no rights is left outstanding for D1) and it was the UKIPO's error in publishing D1, there is

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nothing much the client can do, except to delete the claims to the widget of D3.

As for the method by which the widget is manufactured, D2 is not a relevant prior art because PCT1 can validly claim priority to the D2. As for D1, it does not comprise the added matter in D2/PCT1 (i.e. the disclosure relating to method of manufacturing the widget). Therefore, the method claims in D3 are novel over D1. Note that D1 cannot be used for the assessment of inventive step for D3, because it is published after the priority date of 29 April 2022. Consequently, the method claims would be considered novel and inventive.

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Section B – Question 9

1. To advise client that it is possible to file a patent application claiming a new bottle opener comprising a handle and a head, and possibly a method for opening the bottle using such bottle opener. Since there is a surprising effect to the combination of the handle and head, we could argue inventive step for such claimed combination. Therefore, we should file a patent application before the client starts to make and sell the bottle opener in UK. This is assuming that the client has not made other public disclosure in UK or anywhere else in the world.
2. The patent search that was done seems to confirm that there is no disclosure to a bottle opener comprising a head and a handle. Also need to tell client that even if client has a patent for his bottle opener, he may still infringe GB1 and EP1, depending on his product that is manufactured.
3. Although renewal fees are not paid for GB1 and EP1, we need to check other relevant deadlines. Specifically, we need to check if an extension of time (EOT) as-of -right and/or restoration of a patent due to non-payment of renewal fees is possible.
4. GB1 was filed on 21 May 2019 and granted on 7 Feb 2023. Since it is granted less than 45 months from the filing date, the renewal deadline for paying the renewal fee is 21 May 2023 (which can be paid till the end of the calendar month). The proprietor of GB1 is not able to obtain 6 months of EOT as-of-right because the deadline has lapsed. Furthermore, the proprietor is able to restore the patent within an

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- 1✓ additional of 13 months (calculated from the end of 6 months). This means that if the proprietor files a request to restore the patent (after 6 months but before 19 months from renewal deadline of end of May 2023), and provides evidence that that the non-payment is non-intentional. Consequently, the client is at risk infringing the patent of GB1. To conduct a FTO to make sure the client's product does not fall within the scope of claims of GB1. To recommend client to monitor prosecution of GB1.
- 1✓ 5. For EP1, it is filed and prosecuted in English. Thus, UK is an automatic designated state of EP1. Need to check whether EP1 is validated in UK. It has 3 months from the date of grant to validate in UK (i.e. 25 November 2024). The renewal fees become due only if the EP patent is validated in UK and it can be paid by the end of the calendar month of November 2024). To also advise that a 6-month EOT as-of-right is possible. To recommend client to monitor prosecution of EP1.
- 1✓ 6. If the client needs to market the bottle opener, recommend to start after the 6-month extended period of EP1. Possible to obtain third party rights

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Section B – Question 10

1. Client is Dream Dye which has a granted UK patent. The rights of a patent are territorial. Unless the client also has a patent in China or other jurisdictions, the client is not able to take action against the Chinese company, CurlUpAndDye (manufacturing and selling X dye) and companies that it has traded in these other jurisdictions.
2. However, the client is able to take action against the UK-based company, FadeFree Ltd, selling XDye and other UK-based hair salons who are using the XDye. However, it may not be commercially viable to go after the hair salons as these hair salons are potential clients of Dream Dye.
3. Dream Dye's patent is a method claim, so there would be a direct infringement if anyone would to use the claimed method, without the consent of the proprietor (i.e. Dream Dye). In this case, the UK-based hair salons would be directly infringing the patent.
4. As for Fadefree, there is alleged contributory infringement. This is because XDye contains chemical X, which is an essential element (Chemical X) in the client's claimed method. Therefore, by offering to dispose or supplying or selling XDye would allow unauthorised persons to obtain the essential element to work the claimed invention, and inevitably putting the invention into effect.
5. Defences to infringement: Fadefree and/or the UK based salons may claim innocent infringement since there has no reasonable knowledge of the existence of a patent. Furthermore, we need to advise the client to find out more information on when did the Chinese company start

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manufacturing and selling Xdye. The use of Xdye may be prejudicial to the patentability assessment of DreamDye's patent.

6. In addition, Fadefree can argue that the Chemical X is a staple commercial product as a defence to contributory infringement. Unless the client is able to prove that that Fadefree is inducing, with the reasonable knowledge, that such supply would allow an unauthorised person to put the claimed invention to effect (and thus infringing DreamDye's patent). Fadefree's website appears to claim that they are the sole retailer of XDye (which seems to suggest the use chemical X) and suggesting customers to contact the nearest hair salon to make purchase. Such behaviour can arguably be considered as inducing the consumers.
7. Suggest the client to put Fadefree on notice after doing a trap purchase. Since Fadefree is importing the XDye into UK, so groundless threat may not apply. However, it does not apply to act of selling/offering to dispose/using. So take note of the use of permitted communication to Uk-based salons when putting them on notice. Informing Fadefree and Uk-based salons of client's patent number (and a copy of the granted specification) and highlighting to them that Xdye comprises Chemical X.

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