

Paper Ref	Sheet	Percentage Mark Awarded
FC1	1 of 19	64%

Examiner's
use only

1. The Comptroller may revoke a patent on his own initiative if he becomes
0.5 aware, after grant, of prior art which destroys the novelty of the patent.

The Comptroller may revoke a patent on his own initiative after advertising
an opinion related to the patentability of an invention in which the opinion
0.5 stated the invention was not patentable, for example because of lack of
novelty or inventive step.

- 1✓ The Comptroller may revoke a patent on his own initiative if a European
1✓ patent designating the UK is granted to the same applicant in relation to
1✓ the same invention, constituting double patenting. The Comptroller will not
revoke the UK patent until the opposition period has expired for the
European patent designating the UK.

MARKS AWARDED: 4/6

4

Page sub-
total

Paper Ref	Sheet
FC1	2 of 19

Examiner's
use only

2. Revocation, infringement, entitlement, limitation, proceedings related to actionable threats, appeal proceedings.

1✓

MARKS AWARDED: 3/6

3

Page sub-
total

Paper Ref	Sheet
FC1	3 of 19

Examiner's
use only

3. It is an offense for a UK resident to file or cause to be filed a patent application outside the UK without written permission of the Secretary of State, where the patent application is the first filing, and the patent application relates to any of:

- 1✓ • Military technology.
- Information prejudicial to the safety of the public.
- 1✓ • Information prejudicial to national security.

Mr Smith is a UK resident and his invention relates at least to military technology. Instead of following Mr Smith's instructions, the following alternative approaches should be considered.

- 0.5
1 File the application in the UK first and wait 6 weeks before filing any other applications. If no Section 22 secrecy order has been made, or any secrecy order has been withdrawn by the end of the 6 week period, then it will be possible to file the application in other countries. The subsequent applications may claim priority from the UK filing in order to retain the priority date, as long as they are filed within 12 months of the UK filing by the same proprietor. If no Section 22 order is maintained by 6 weeks from the date of filing, then it is not an offence to file abroad.
- 1 File a request in writing for permission to file the application abroad at the same time as the UK application and wait for written permission to be granted or refused before filing any applications. If the Secretary of State provides written permission to file abroad, it is not an offence to file abroad.

5

Page sub-
total

Paper Ref	Sheet
FC1	4 of 19

**Examiner's
use only**

Since Mr Smith's invention does not claim priority, it can be assumed that no patent applications have been filed previously for the invention.

MARKS AWARDED: 5/5

**Page sub-
total**

Paper Ref	Sheet
FC1	5 of 19

Examiner's
use only

1✓ 4a. It is possible to request reinstatement of a patent application within 1 year of
1✓ a deadline which was not met. Therefore, the latest date for requesting
reinstatement is 20 January 2025. It is necessary to pay a fee and file a form. If
the request is granted it is necessary to complete the omitted act within 2 months
1✓ of issue of the communication to that effect, which in this case is to respond to
the examination report.

1✓ It is also necessary to file evidence that failure to respond to the examination
1✓ report was unintentional. This may be difficult to prove as Mrs Husseni received
the examination report. However, unintentional acts include anything out of the
person's control including uncharacteristic mistakes. Mrs Husseni may have to
provide evidence about what she does to process her mail, specifically patent
related mail, once it is received. If the missed deadline was a result of an
ongoing process, it will be difficult to achieve reinstatement.

The patent application was filed on 29 September 2020 therefore was likely
published as soon as possible after 18 months after the filing date, 29 March
2022. Therefore, it is not possible to file the same application again as it has
been published and therefore publically disclosed.

It will also not be possible to file another application with the same subject matter
and claim priority from the original filing as the 12 month priority period which
begins with the date of filing expired on 29 September 2021.

The compliance period for the application will expire on the later of 4.5 years
1✓ from the date of filing, 29 March 2025, or 12 months from the first substantive
exam report, 20 September 2024. Therefore, the compliance period ends on 29
March 2025.

Page sub-
total

Paper Ref	Sheet
FC1	6 of 19

Examiner's
use only

It is possible to file a divisional application until 3 months before the end of the compliance period therefore the deadline to file a divisional is 29 December 2024. It is only possible to file a divisional application while the parent application is still pending, however GB1234567.8 has not been finally refused as the period for filing an appeal in relation to the refusal has not expired. The deadline to file an appeal is 3 months from the decision. If a divisional application is filed within the last 6 months of the priority period, that is after 29 September 2024, then it is necessary to file the following on the initiation date: claims; search request and fee; exam request and fee; description; applicant details; request for grant of a UK patent; priority claim.

6

b. It would be necessary to check Mrs Husseni's address for service and applicant details to ensure the UKIPO have a correct record of how to contact

1✓ either the client or her patent attorney. It would be simple to prove that failure to respond to the exam report was unintentional if it was possible to prove the letter

1✓ was never received, for example if there was an error in the address. The deadline for response is calculated from the date the communication was issued, rather than the date it was received, therefore the deadline does not change. The advice would be to request restoration before 20 January 2025, pay the fee, and file evidence that the failure was unintentional. Then, if the request is granted, file a response to the exam report within 2 months.

2

Mrs Husseni should file a request to change her address for service to the address of her patent attorney to prevent this from happening again.

MARKS AWARDED: 8/9

8

Page sub-
total

Paper Ref	Sheet
FC1	7 of 19

Examiner's
use only

5a. A grant fee is payable to the UKIPO when there are excess claims fees (over 25 claims) and/or excess page fees (over 35 pages of description) due in an

1✓ application which is in order for grant. The grant fee should be paid if the

1✓ applicant is satisfied with the text intended for grant and does not wish to make any amendments. If excess claims fees and page fees are not due, then the grant fee at the UKIPO is zero and there is no fee payable to proceed to grant.

2

b. The grant fee is due within 2 months of issue by the UKIPO of the communication of intention to grant.

1

c. A 2 month extension is available as of right by filing a request in writing before the end of 2 months after the deadline to pay the grant fee. There is no fee payable for this request.

1

MARKS AWARDED: 4/6

4

Page sub-
total

Paper Ref	Sheet
FC1	8 of 19

Examiner's
use only

6a. If the translation is not filed on the filing date, the deadline to file is within 2 months of an invitation to file the English language translation. Therefore, the deadline is 7 December 2024.

1

b. It is possible to request an as of right extension of 2 months by filing a request in writing before the expiry of 2 months after the deadline. That would extend the deadline to 7 February 2024. A further discretionary extension is available for a maximum of 2 months from expiry of the first extension by filing a request in writing before expiry of 2 months after expiry of the first extension. That would extend the deadline to 7 April 2024. It would not be possible to extend the deadline further.

1

c. It is possible to correct errors in translation or copying, or mistakes, at any point in the patent application process.

1 In order for an error in the specification to be corrected, it is necessary to file a request in writing pointing out the error and providing a correction. It will be necessary to identify the error in the Chinese language text and the English translation. The error must be obvious and it must be immediately evident that nothing else could have been intended at the date of filing other than the proposed correction.

1 It may be obvious that the measurements should not have been in miles, as the application relates to tiny ball bearings for use in electronic devices. However, it may be difficult to argue that it is immediately evident that only millimetres could have been intended at the date of filing, as there are so many other units which could have been used, for example micrometres.

Page sub-
total

Paper Ref	Sheet
FC1	9 of 19

Examiner's
use only

If the Examiner is not satisfied that only millimetres could have been intended at the date of filing, it would be possible to withdraw the application leaving no rights outstanding and refile the application, as it has not yet reached 18 months after the priority date (25 March 2025) at which point the application would be published.

If it is possible to correct the Chinese application, then a UK application could be filed within 14 months of the date of filing the Chinese application, by 25

November 2024, claiming priority from the Chinese application and making a declaration of late priority. It would be necessary to file the priority application and a translated copy by the 14 month deadline.

If it is not possible to correct or re-file the priority application, the Chinese application may serve as prior art for a re-filed UK application.

MARKS AWARDED: 6/8

4

6

Page sub-
total

Paper Ref	Sheet
FC1	10 of 19

Examiner's
use only

7a. It is possible to refile the same subject matter and restart the priority clock if the following is true:

- D1 was filed before D2. This is true as D1 was filed on 29 November 2021 and D2 was filed on 29 April 2022.
- D1 was filed in the same country as D2. This is true as both applications were filed in the UK.
- D1 was unconditionally withdrawn or refused without leaving any rights outstanding, including the right to claim priority. Big Widget PLC claim they withdrew D1 but UKIPO have no record of it having been received.
- D1 does not form the basis of any other priority claim. There is no information to suggest D1 forms the basis of another priority claim.
- D1 has not been publically disclosed. D1 has been published by the UKIPO. However, it is not clear whether it has been validly published.

If Big Widget PLC can prove that they sent a withdrawal letter to the UKIPO

1✓

1✓ before D2 was filed, and that the withdrawal met the requirements stated above,

1✓ then the claim to priority based on D2 is valid, and D1 was not validly published.

In that instance, the priority date of PCT1 is maintained as 29 April 2022. The

1✓

priority date is maintained both for the widget and for the method of

1✓

manufacturing the widget.

However, if Big Widget PLC cannot prove they withdrew D1, or the withdrawal

1✓

did not meet the requirements above, then the claim to priority based on D2 is not valid, and D1 was validly published.

Page sub-
total

Paper Ref	Sheet
FC1	11 of 19

Examiner's
use only

If D1 has been validly published, then withdrawing it at this stage will have no effect on the priority date of PCT1.

If D1 was not withdrawn, then D2 is not the first filing of the subject matter supporting the disclosure of the widget itself. In that instance, it will not be possible to claim priority for the widget from D2. The effective filing date of the subject matter relating to the widget will be 29 April 2023. However, it will be

1✓ possible to claim priority for the method of manufacture of the widget, which was first disclosed in D2 on 29 April 2022.

It is possible to make a late priority claim within 1 month of entering the UK national phase of a PCT application. However, D1 may not serve as basis for priority because the priority period (12 months) has expired, nor will it be possible to make a late claim to priority (14 months).

b. If D1 is not treated as withdrawn, then it serves as novelty-only prior art for D3,

1✓ as D3 is a PCT application designating the UK which has entered the UK national phase. D1 was filed on 29 November 2021 which is before the priority date of D3, 29 April 2022.

D1 is not relevant to inventive step for D3 as it was not published until 29 May 2023, which is after the priority date of D3, 29 April 2022.

1✓ D1 only discloses the widget and does not disclose the method by which the widget is manufactured. D1 is not relevant to the novelty of the method of manufacturing the widget. Therefore, D3 will be novel over D1 if the method of manufacturing the widget is incorporated into claim 1 of D3.

Page sub-
total

Paper Ref	Sheet
FC1	12 of 19

Examiner's
use only

- If D1 is treated as withdrawn, then there is no prior art for D3. The only other documents are the priority document D2 and the PCT application PCT1, neither of which can be cited as prior art.
- 1✓ There is no concern about double patenting as D3 has entered the UK national phase but D2 has been allowed to lapse.

MARKS AWARDED: 11/20

11

Page sub-
total

Paper Ref	Sheet
FC1	13 of 19

Examiner's
use only

8.

Claim Construction

- a. Improver v Remington.
- b. Improver held a patent for an epilator which used a helical steel spring to remove hairs from skin. Remington sold a product which comprised an arcuate rubber rod with slits along its length which could grip hairs to remove them. Improver brought infringement proceedings in respect of Remington's product. Remington made a counter-claim of invalidity on the basis of lack of sufficiency and lack of inventive step.
- c. The independent claim of the Improver patent was worded such that the helical steel spring was an essential element of the invention. Therefore, because the Remington epilator did not include a helical steel spring, it was not infringing. The Improver patent was upheld to be sufficient and possess inventive step.
- d. The precedent set for the case was that the Improver questions were formulated and should be asked in order as follows:
 - Does the variant have a material effect on the way the invention works? If yes, then the variant is outside the claim. If not, proceed to the next question.
 - Would the fact the variant does not have a material effect on the way the invention works have been obvious to the skilled reader of the specification on the date of publication? If no, then the variant is outside the claim. If yes, proceed to the next question.

1

1

2

Page sub-
total

Paper Ref	Sheet
FC1	14 of 19

Examiner's
use only

- Would the skilled reader have interpreted from the language of the claim that the patentee intended that strict compliance with the primary meaning of the claim was an essential element of the invention? If yes, then the variant is outside the claim. If no, the variant infringes.

3

Inventive Step

- Pozzoli SpA v BDMO.
- Pozzoli held a patent for a CD case in which two CDs could be stored, which was smaller in height than a standard case for storing two CDs, as the Pozzoli case overlapped the CDs and spaced them apart axially so they would not come into contact. Pozzoli accused BDMO of infringement and brought proceedings. BDMO brought a counter-claim of invalidity on the basis of lack of inventive step.
- Pozzoli argued that there was a prejudice in the industry against stacking CDs. However, the court did not believe there was a long-felt need for CD storage cases that were shorter than 2:1 height to width ratio. Once the skilled person considered that the height needed to be reduced, it was obvious to overlap the CDs. Further, it was obvious to space the CDs axially such that they could be removed individually. The Pozzoli patent was invalidated due to lack of inventive step. The court also suggested that the Windsurfer questions needed reformulating.
- The precedent set by this case is the Pozzoli/Windsurfer approach to determining whether an invention possesses inventive step. The steps should be carried out in order as follows:

1

2

2

Page sub-
total

Paper Ref	Sheet
FC1	15 of 19

**Examiner's
use only**

- Identify the person skilled in the art and their requisite general knowledge.
- Construe the claim and identify the inventive concept.
- Determine differences between the inventive concept and the prior art.
- Determine whether the differences would have been obvious to the skilled person, or if they required inventive step.

3

MARKS AWARDED: 15/20

15

**Page sub-
total**

Paper Ref	Sheet
FC1	16 of 19

Examiner's
use only

10. None of the parties mentioned have consent from DreamDye to use their process, since DreamDye wish to completely stop all use of X as a hair dye by third parties.

None of the companies mentioned, nor the hair salon, are dealing with XDye for private, non-commercial purposes, therefore they do not have that defence to infringement.

Members of the public who purchase XDye from FadeFree in the UK are likely using XDye for private, non-commercial purposes therefore they have that defence to infringement.

Other potential defences may include that the person using the method is doing so for research purposes related to the subject matter of the invention.

While a patent for a process is in force, it is infringement to use the process or offer to use the process in the UK, if the infringer knows, or it would be obvious to the reasonable person that use or offering to use the process without the proprietor's consent constitutes infringement.

Hair salons who purchase XDye and follow the process of the patent to dye hair are directly infringing the patent. It is likely not even necessary for the salon worker to mix XDye with water as it likely already contains water. It is customary to rinse dye from hair once the dying process is complete.

Members of the public who purchase XDye and follow the process of the patent to dye hair are directly infringing the patent.

Where there is a UK patent for a process, it is infringement to make, use, dispose of, offer to dispose of, import, or keep for any of those purposes, a

Page sub-
total

Paper Ref	Sheet
FC1	17 of 19

Examiner's
use only

product that was manufactured directly using that patented process. If the hair dye XDye is a mixture of X and water as described in the claim then it is arguable that it is infringement to import, dispose of, or make XDye. XDye likely contains both X and water along with other ingredients.

Indirect infringement comprises supplying or offering to supply to a person not entitled the means for putting the essential elements of an invention into effect, where the infringer knows that the means are suitable for or intended for use to infringe the patent. There is a defence for indirect infringement if the means are staple commercial goods and they are not provided in order to induce infringement. It is unlikely that hair dye would be classed as a staple commercial good.

- 1✓ CurlUpAndDye are based in China and do not carry out any activity in the UK.
- 1✓ Although they likely export XDye to the UK, they are not infringing the UK patent.
- 1✓ 1✓ FadeFree Ltd. import, dispose of, offer to dispose of, and presumably keep XDye. This is direct infringement if XDye is a mixture of water and X. XDye is very likely to contain water along with X and other ingredients. FadeFree Ltd. are indirectly infringing the patent as they are selling the means to put the essential elements of the patent into effect.

Innocent infringement occurs when the party infringing is not aware, or does not have reasonable grounds for supposing, that a patent exists. For example, it is possible that the members of the public are innocent infringers. It is unlikely FadeFree Ltd are innocent infringers as they are the sole retailer of XDye in the UK and will likely have researched the product.

Page sub-
total

Paper Ref	Sheet
FC1	18 of 19

**Examiner's
use only**

It will be necessary to send permitted communications to all potential and confirmed infringers including:

- A patent exists;
- DreamDye are the proprietors of that patent;
- Attempting to identify who is infringing the patent;
- Due diligence to inform the third parties that DreamDye are attempting to identify the infringers.

The communication should contain accurate information which is not misleading. The communication cannot request the third parties make any undertaking, cease doing anything with respect to the patent, or deliver up any goods.

A threat of infringement proceedings is a communication which may reasonably be understood to mean that a patent exists and the proprietor intends to bring infringement proceedings on another party. It is not an actionable threat when it is sent to a party who is using a patented process, making a patented product for disposal, or importing a patented product for disposal. It is not an actionable threat when the threat relates to any of those acts, or an act which if done, would be done in the UK without the proprietor's consent.

If the communications are unsuccessful and the infringement persists, DreamDye should bring infringement proceedings, at least against FadeFree Ltd if not also against hair salons using their process.

**Page sub-
total**

Paper Ref	Sheet
FC1	19 of 19

**Examiner's
use only**

DreamDye should make the public aware of their patent, which may prevent the defence of innocent infringement and discourage third parties from using the process.

MARKS AWARDED: 8/20

8

**Page sub-
total**