Examiner's Report Year 2024
FD1 – Advanced IP Law and Practice

Patent Examination Board

Introduction

The majority of candidates seemed well prepared and there were fewer low scoring scripts than previously. Candidates should remember that marks are awarded for analysis, application of the law and for advice. Quality of content is more important than volume. Marks could be improved by possibly writing less but planning which points merit particular attention. The mark scheme is fairly brief, and candidate answers can be equally brief by focussing on the legal points to be made. Candidates are also reminded to allocate their time appropriately throughout the paper. Some candidates perform well in Part A and their first question from Part B, only to fade away with a short, rushed answer to the final long question where relatively few marks are gained. Candidates might score more highly by allocating their time evenly, thus achieving some of the more straightforward marks. Questions are carefully phrased, and candidates should thoroughly review the wording to ensure that as many relevant points as possible are captured: ambiguities are invitations for candidates to consider different outcomes (without excessive speculation); a plurality of items (claims, articles, parties, acts, territories, prior art disclosures etc) typically requires candidates to address each separately and to consider the legal significance of any distinctions to achieve the available marks. Once again, there was a notable number of date calculation errors, particularly this year in recording an incorrect year. Candidates should always take care to get dates right as this is a critical skill in the profession. A full consideration of the legal tests required is advisable. Sometimes candidates abbreviate a legal test and therefore do not undertake a complete analysis of the information in the question, thereby not achieving available marks. Answers need to be complete, as well as correct.

Questions

Part A

Question number	Comments on questions
Question 1	A straightforward formalities problem was presented that required attention to detail. Overall, this question was answered very well with most candidates netting at least 3 of the possible 4 marks. However, incomplete answers often meant available marks could not be awarded (for example, candidates needed to advise that both a search request and a search fee are required because omission of either does not meet the requirements). Some candidates spent time discussing actions that were not necessary, such as the deadline for filing a statement of inventorship, which was not required as the

	inventor was the only applicant. Others suggested reinstatement, which would not be available due to the possibility of extensions remaining.
Question 2	Most candidates systematically dealt with UK RDR and UK UDR. However, supplementary unregistered design protection was often not considered; recognising that it is not available is an important conclusion. Particularly on the UDR point, a number of candidates simply wrote down everything that they had learned about UDR. In the first scenario, marks could not be awarded because it was not appreciated that design applications can claim priority from utility models and/or that the expiry of the priority period carries over to the next working day. In scenario two, whilst the fact that a grace period exists was often correctly identified, the fact that it must be in relation to disclosures from the designer (not owner or author) was not. It was necessary in the third scenario to appreciate that there is no absolute novelty requirement for designs. A number of candidates recognised the issue of whether the disclosure of Product C in the US may be novelty destroying for registered designs in the UK and Europe but failed to fully set out the legal test. The relevant law was often not stated or incorrectly portrayed. For those who applied the correct test, it is worth remembering the importance of being pragmatic based on the facts in the question: prima facie the design conference was international and might be expected to become known in the normal course of business to those in the relevant design field in the EEA/UK. There would have been no harm in suggesting further investigation to reach a definitive answer, but it is unreasonable to assume that the disclosure is not likely to be prior art.
Question 3	Priority – what it is, when and how it can or cannot be claimed and by whom - is a fundamental aspect of patent practice. Providing analysis and advice would have been a good way to approach this question. Candidates could achieve better marks by clearly setting out the consequences of the facts. A quick check of dates shows that a priority claim is needed, otherwise the client's product launch will be novelty-destroying for the broad subject-matter and full prior art for the improvements. However, the priority deadline for the broad subject-matter has been missed. A priority claim to the AU application is important because the later GB application is not the first for the broad subject-matter. Contrary to the suggestion of some candidates, it is not possible to withdraw the AU filing so that the GB application becomes the first filing, since the AU case was pending when the GB was filed. For restoration of priority, most candidates could identify the different standards of "all due care (EP)" and "unintentional (UK, US)". However, their application was poorly handled. Candidates sometimes only indicated that the UK standard "might" be met (the facts of the question clearly state that instructions were sent, with no contrary information) or that the facts could satisfy all due care (there is

	nothing in the question to suggest all due care was shown – the client had not checked that the email had been delivered, and there was no backup). On the other hand, the client clearly did intend to file the PCT at the EPO as evidenced at least by the undelivered email. In line with UK case law that indicates that for restoration of priority to be successful the applicant must undertake the originally intended act, the new application should be filed with the EPO as RO. Many candidates omitted to advise the client that even though the EPO might refuse restoration, this could be revisited on entry into the National phase in the UK and USA where it would be likely to be successful due to the lower standard of the "unintentional" criterion. A common mistake was to advise the client to file at the UK because of the lower standard. The improvements should be considered in their own right. Those candidates who set out multiple relevant options for protection for the client did well on this point.
Question 4	To analyse the situation in Question 4, it was necessary to consider the information provided in the question and apply the relevant law. Many candidates appeared unwilling to definitively conclude that the client was not entitled to the improvement when there was no indication to suggest this was the case. This affected these candidates' ability to score well elsewhere in the question. Some candidates attempted to bend the facts of the question to suit their own purposes. Although candidates generally appreciated that the one-way nature of the NDA might mean that the client was not under an obligation of confidence, very few candidates appreciated that the result of this conclusion was that the disclosure of the improvement to the client would constitute a public disclosure. Many candidates lost time considering issues such as entitlement proceedings in the event that C filed a patent application to the original invention, despite the clear steer that the issue at stake is whether the client's wish to file a patent application also covering the improvement would cause problems. Indeed, candidates, as professional advisors, were expected to thoroughly address why the client's proposal might not be the best course of action. The possible outcomes of potential entitlement proceedings were reasonably well addressed. Cross-licensing with C was proposed by some candidates. A cross-licensing proposal presumes an interest from C in licensing the technology: this is not clear from the question, and in any event cross-licensing would result in loss of exclusivity for the client's main invention in return for access to "minor" improvements.
Question 5	This was a challenging scenario where a filing error might lead to an early and undesirable publication of an invention which has not been fully protected. Candidates were therefore expected to suggest reasonable actions which could

	mitigate detriment. It was necessary to ensure that the second invention is properly protected as soon as possible without impacting the first invention, but also (even if success is not guaranteed) attempting to avoid an unduly early publication of the erroneous figures. If should be recalled that there is no text in the description or basis for clear and robust claims, so whilst an attempt might be made to rely on the figures as is, this is unlikely to be ideal. Some candidates proposed withdrawal of GB2, which would have negatively impacted protection for the original invention. Others suggested amendment to remove the figures (amendments are published along with the original text as filed). It is important to recognise that a correction attempt should be filed as soon as possible, as the erroneous figures would need to be removed before preparations for publication are complete (i.e. it would not be enough to simply file a request for correction in time for completion of the preparations for publication). Candidates rarely considered both outcomes of success vs failure of the correction, resulting in lower marks. Whilst this question posed problems for many candidates, those who accurately and completely knew the test for correction of an obvious error achieved better marks.
Question 6	This presented a straightforward situation requiring analysis regarding missed deadlines and advice as to how to remedy the problem. Almost all candidates appreciated the deadlines had expired for requesting examination and paying the examination fee, and for requesting the two-month as-of-right extension. In addition, the majority of candidates advised that reinstatement should be requested but mistakes were made in the calculation of the deadline. A common problem was confusion with the European deadline which also includes "two months from removal of non-compliance". Several candidates erroneously stated that the application was deemed withdrawn (triggering the 12 month deadline for reinstatement) at the end of the period of two month as-of-right extension (if one had been requested). Also several candidates believed that a discretionary extension can be requested retrospectively, whereas this must be requested before the as of-right-extension ends. It is worth remembering third party rights will accrue and therefore early action is desirable, even when the deadline is some time away. This is particularly important in view of the interest from the competitor. Many candidates gave the usual advice to request reinstatement as soon as possible to minimise third-party rights but failed to appreciate that there was a real risk of third-party activity in view of the competitor's interest in the glove at the pre-launch party.

Part B

Question number	Comments on questions
Question 7	The question provides a scenario where inexperienced inventors muddle their way towards solving problems arising from their hobbies. There are several different aspects, including entitlement and ownership, missing documents, patentability and infringement but the extent to which each issue was addressed was variable. There appeared to be no major issues with entitlement and ownership, although a small number of candidates wrote in some detail about whether M was employed by D. Entitlement by virtue of employment clearly was not an issue in this question. Some candidates were reluctant to draw a conclusion and instead gave an analysis of ownership either way without concluding that M was a co-inventor. The assessment of how to handle the missing drawings was generally well executed, as was the patentability of GB1. With respect to each of the disclosures, most candidates wrote in detail about enablement and novelty. Fewer discussed the impact of the disclosures regarding inventive step. Most candidates identified that WO1 was needed to enter the National phase in GB but relatively few mentioned EP. Few candidates addressed the fact that the web forum members have an exemption to potential infringement. A significant number of candidates discussed in detail patent protection for the client in the US even though there was no indication in the question that the US was of interest to the client. A notable number of candidates also advised on cross-licensing between D and E. This is off-the-cuff advice with no serious thought as to the viability of this to D as a hobbyist. Many candidates included "prejudicial to patentability" in their answer, instead of providing firm separate conclusions for novelty and inventive step. A notable number of candidates got caught up considering whether the prior website disclosures were sufficient, rather than considering their impact on novelty and inventive step. Many candidates concluded that the original forum post was not an enabling disclosure of the invention because later work by D and M had to solve technical issues to produce a prototype. There is no evidence that the original post was not enabling, only that perhaps the circuit was not very good and technical issues with it were resolved with later work. So, the issue is whether what is claimed in GB1 is novel and inventive over the forum posts, not whether the forum posts can be ignored because they are not an enabling disclosure. When infringement was considered, identification of all the potential infringers and consideration of relevant exemptions/defences picked up marks. Candidates also needed to provide client-specific advice on how to rectify or improve the situation based on the facts.

	Many candidates provided a stock answer of monitoring Regional/National phase entry but did not note that the reason for monitoring was to see whether claims went on to grant that would be infringed.
Question 8	Most candidates did well by identifying the key legal issues. Those who were methodical about tackling each issue scored excellent marks. A number of candidates discussed in detail the prior art effect of GB2 depending on whether it was published before or after the filing date of EP1. The question unambiguously states that GB2 has a priority date. As such, the latest publication date of GB2 can easily be calculated as being before the filing date of EP1. A number of candidates did not draw any distinction between direct infringement and indirect infringement and instead referred to "infringement" generally. These candidates often overlooked or did not thoroughly consider contributory infringement, and so could not access a block of marks. Others mentioned it, but were not accurate and complete enough with the test. The validity assessment of EP1 was generally well handled, although some candidates considered sufficiency for Claim 2, instead of focussing on the bad priority claim. A number of candidates thought Claim 2 of EP1 lacked sufficiency because GBX did not disclose the special electrical converter in detail. Most then advised that Claim 2 could be opposed on this ground. They also assumed that EP1 has the same content as GBX, although there is nothing in the question that indicates this. Some candidates did not appreciate that the claims of EP1 could have different effective dates. They noted that all of the subject-matter of EP1 was either entitled to priority or none of it was. This then impacted their analysis of the prior art effect of GB2. Some lower scoring candidates failed to distinguish between Claims 1 and 2. Candidates are reminded that stating something is/isn't novel/inventive without discussion will not score a mark. In a situation like this a reasoned discussion is just as important as the conclusion. Some answers were confusing in their treatment of Claim 1 vs Claim 2 (for example switching back and forth) making it hard to determine which they were assessing. Giving clear, well set out answers is akin to giving clear, well set out advice to clients. Almost all candidates picked up the possibility of opposition but far fewer were familiar with the London Agreement. Most candidates addressed the client's activities in the UK but fewer adequately advised on the client's activities in France.
Question 9	The majority of candidates identified the key legal issues for this question although the depth of analysis of each legal issue varied widely with some candidates analysing each issue in detail and others providing only a cursory review.

	Candidates who advised that the effective date of each of the claims of EP1 is the filing date, but for different reasons, did well. It is important to be explicit when explaining the earliest dates of claims. Surprisingly, most did not appreciate that PCT1 could have different claim scopes in different countries. Despite the clear instructions to consider only GB and EP markets, a number of candidates either focused mainly on GB and did not consider EP, or discussed filing applications claiming priority from GB3 outside of EP. Often candidates questioned the sufficiency of broad claims. The claims are exemplified and, therefore, are prima facie sufficient in the absence of evidence to the contrary. Additional data might be useful for supporting inventive step. Candidates needed to be more thorough when analysing the patentability of EP1; many did not consider the effect of both the magazine and GB1/GB2. The s.2(3) aspect caused by the bad claim to priority and the consequences were also not well handled. Generally, candidates failed to pick up marks for the more commercial aspects, such as: considering whether the claims of PCT1 could be broadened; the pros and cons of EP vs GB National phase entry; the fact that the competitor's launch cannot be prevented; the likelihood provisional protection would be back-dated to publication; and some evaluation of the FTO position and whether it would be prudent to proceed with the sale. Candidates who lumped all the claims together and applied their reasoning broadly to them could not be awarded all of the available marks for the analysis. The majority of candidates referred to entering the National/Regional phase early but only about half of them realised that they needed to explicitly request early processing. Most candidates noted the need to put the competitor on notice by alerting them to the existence of the application