

**FC1 (P1) UK Patent Law
Final Mark Scheme 2025**

SECTION A

Question 1

- a) Is it possible to claim priority from the following? In each case explain your answer.
- i) A US utility patent application filed 13 months ago.
3 marks
 - ii) An EP application filed 11 months ago. The GB designation has been withdrawn.
1 mark
 - iii) An application filed at UKIPO comprising a completed Form 1, along with an annotated sketch of a product.
2 marks
- b) Explain why it is possible to claim priority from an EP patent application. The EPO is not a party to the Paris Convention.
1 mark
- c) Give an example of something from which priority can validly be claimed other than a patent application.
1 mark
- Total: 8 marks**

Answer

- a)
- (i) Possibly (**0.5 marks**) can claim priority up to 14 months from priority (**1 mark**). Need to be able to file evidence that the delay was unintentional (**1 mark**). Must be no early publication request or the request must have been withdrawn (**0.5 marks**).
 - (ii) Yes (**0.5 marks**). Withdrawal of the GB designation is irrelevant (**0.5 marks**).
 - (iii) Yes (**0.5 marks**). The application is an application for a patent (**0.5 marks**). Some discussion of whether an annotated sketch will suffice as a description (**1 mark**).
- b) The UK Patents Act states that EP applications are considered to be equivalent to UK applications for the purposes of priority (section 78) (**1 mark**).
- c) Any reasonable answer accepted – earlier application for protection of invention, German utility model, French ‘Certificat d’utilite’ etc (**1 mark**)

Total: 8 marks

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Question 2

- a) List the main points that should be included under English and Scottish law in a patent assignment document assigning a UK patent application from party A to party B. You are not expected to draft the assignment document.

4 marks

- b) What stamp duty is payable on an assignment document which relates solely to the assignment of one UK patent application? You can assume the assignment document was signed in the last ten years. Justify your answer.

2 marks

- c) Describe two potential consequences of failing to record an assignment document within six months of execution.

4 marks

Total: 10 marks

Answer

- a) Parties to the agreement (**0.5 marks**) date (**0.5 marks**) application number (**0.5 marks**) consideration (**0.5 marks**) jurisdiction (**0.5 marks**) right to file foreign applications (**0.5 marks**) right to file divisional applications (**0.5 marks**) right to claim priority (**0.5 marks**). All other reasonable points considered.

4 marks

- b) None (**1 mark**). Assignment relates to IP only (**1 mark**).

2 marks

- c) In infringement proceedings (**0.5 mark**) no costs (**0.5 marks**) or expenses (**0.5 marks**) where infringement occurred before the assignment was recorded (**0.5 mark**). Person who acquires the patent is not affected by the earlier (non-recorded) assignment (**0.5 marks**) if he did not know of it (**0.5 marks**), unless it was not practicable to register it earlier (**1 mark**).

4 marks

Total: 10 marks

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Question 3

- a) According to Section 1(2) (*Patentable Inventions*), UK *Patents Act 1977*, what are not inventions?

8 marks

- b) List two grounds on which the UKIPO would object to an application for a perpetual motion machine.

2 marks

Total: 10 marks

Answer

- a) Discovery (**0.5 marks**), scientific theory (**0.5 marks**), mathematical method (**0.5 marks**).

Literary (**0.5 marks**) dramatic (**0.5 marks**), musical (**0.5 marks**) artistic (**0.5 marks**) works, any other aesthetic creation whatsoever (**0.5 marks**).

Scheme (**0.5 marks**) rule or method (**0.5 marks for either**) for performing a mental act (**0.5 marks**) playing a game (**0.5 marks**) doing business (**0.5 marks**), program for a computer (**0.5 marks**).

Presentation of information (**0.5 marks**).

As such (**0.5 marks**)

8 marks

- b) Non enabling disclosure (**1 mark**) incapable of industrial application (**1 mark**). Any other reasonable answer considered.

2 marks

Total: 10 marks

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Question 4

Actavis v Eli Lilly [2017] UKSC sets out a test under which the prosecution history for a patent may be considered. What is this test?

4 marks

Answer

The point at issue is truly unclear (**1 mark**) if one confines oneself to the specification and claims (**1 mark**) and the content of the file unambiguously resolves the point (**1 mark**); or, it would be contrary to the public interest for the file to be ignored (**1 mark**).

Total: 4 marks

Question 5

Licences of right are available for your client's patent.

List eight potential disadvantages of this for your client.

8 marks

Answer

- (i) No control over who takes a licence. Third parties can obtain licences on request (**1 mark**)
- (ii) Terms of the licence determined by the Comptroller if necessary. (**1 mark**)
- (iii) Cancellation of the licence of right can be opposed (**1 mark**)
- (iv) Better licence terms for existing licensees (**1 mark**)
- (v) Limit on damages in infringement (**0.5 marks**) to twice what would have been payable under the licence of right (**0.5 marks**)
- (vi) Licensee can bring infringement proceedings if proprietor refuses/neglects to do so (**1 mark**)
- (vii) Infringers can take a licence at any time in infringement proceedings (**1 mark**)
- (viii) Taking a licence may prevent the patent holder from obtaining an injunction (**1 mark**)

Any other reasonable answer considered

Total: 8 marks

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SECTION B

Question 6

Six months ago, Ms Shah started developing her new flask, which is a replacement for vacuum flasks. The walls of the flask are made from chemical X, which is rigid, chemically inert and a good thermal insulator. Two months ago, Ms Shah started advertising and making preparations for sale of her new flask. Ms Shah is interested in the UK only.

Ms Shah has now received a letter from Cups Are Us Ltd (CAUL), bringing their patent GB1 to her attention. The patent was filed on 1 April 2014 and granted on 15 May 2019. Your investigation of the patent shows that the last renewal fee was paid on 30 April 2023.

GB1 discloses a cup made of X and comprises three claims, which are:

1. A container comprising X.
2. A container as claimed in claim 1, wherein the container is a cup.
3. A container as claimed in claim 2, further comprising a stand.

Your prior art search reveals two documents published before GB1:

- M1 A magazine article showing a kettle made from X.
M2 A further magazine article showing a metal travel mug arranged in a rubber sleeve to retain heat.

You can assume there are no further patents owned by CAUL and there is no further prior art.

Write notes for a meeting with Ms Shah. Your notes should cover the following areas:

- | | |
|---|----------------|
| a) how CAUL might address failure to pay the renewal fee for GB1; | 3 marks |
| b) third-party rights potentially acquired by Ms Shah; | 5 marks |
| c) infringement of GB1. Consider each claim in turn; | 4 marks |
| d) validity of GB1. Again, consider each claim in turn; and | 3 marks |
| e) advice to the client as to how to proceed in view of the letter from CAUL. | 5 marks |

Total: 20 marks

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Answer

1. Renewal fee

- Renewal fee was due 30 April 2024 (**0.5 marks**).
- Could have been paid until 31 Oct 2024 with surcharge (**0.5 marks**).
- Can be paid until 19 months from due date (will accept 30 Nov 2025) (**1 mark**).
- Some mention of 'unintentional' (**1 mark**).

3 marks

2. Third party rights

- Client may have acquired third party rights in respect of acts done -
- In good faith (**1 mark**).
- After grace period (**1 mark**).
- Before publication of application for restoration (**1 mark**).
- Check if an application for restoration has been published (**1 mark**)
- Otherwise, Ms Shahs activities fall within the window (**1 mark**)

5 marks

3. Infringement

- Claim 1 is infringed. A flask is a container (**1 mark**).
- Claim 2 arguably infringed – is a flask a cup? (**1 mark**)
- No direct infringement of claim 3 – no stand. Alternatively any reasonable argument regarding indirect infringement (**1 mark**).
- Advertising/ making preparations for sale are infringing acts (**1 mark**).

4 marks

4. Validity

- Claim 1 not novel over M1 (**1 mark**).
- Claim 2 novel (**0.5 marks**) but lacking inventive step over M1 + M2 (will accept any reasonable argument) (**0.5 marks**).
- Claim 3 novel (**0.5 marks**). Will accept any reasonable argument regarding inventive step (**0.5 marks**).

3 marks

5. How to proceed in view of the letter from Cups Are Us Limited

- No action for groundless threats - third party allowed to bring attention to the existence of a patent (**1 mark**).
- Wait to see if an application for restoration is filed (**1 mark**)

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- Possibly bring a revocation action (**0.5 marks**)/obtain UKIPO opinion on validity/infringement (**0.5 marks**) but will take time.
- Negotiate licence/purchase with patent proprietor (strong prior art) (**1 mark**).
- Possibly launch at risk. The only claim that is valid is not infringed (**1 mark**).

5 marks

Total: 20 marks

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Question 7

You have received the following email from the CEO of your client, BigWidget Ltd (BWL):

As you are already aware, we have a GB patent for the five-sided widget (the Penta-widget). We have now developed the Octo-widget, which is an update of the Penta-widget. We are very excited about the Octo-widget as it is a significant improvement on the original. The scope of the original patent is sufficiently broad that it covers the update but, nonetheless, we would be grateful if you could file a further application for the improvement.

The inventor retired from our company last year but still comes in two days a week as an R&D expert, during which time he developed the Octo-widget. We have never signed any paperwork with him relating to this. Nonetheless, the Octo-widget was developed using our money and resources, and so belongs to us. We are not sure the inventor agrees with this and would not be surprised if he tried to commercialise it himself.

Finally, we have shown the Octo-widget to one of our customers – Teton Gears Ltd (Teton). Teton have a confidential process for testing widgets and have sent us data showing a significant improvement in widget performance. Please include this data in the application.

Write notes for a meeting with your client. Your notes should be broken down into the following areas:

- | | |
|---|----------------|
| a) ownership and inventorship; | 9 marks |
| b) the client's disclosure to Teton; | 3 marks |
| c) use of the Teton data; and | 3 marks |
| d) steps that should be taken, by the client, in particular in relation to the inventor. | 5 marks |
| Total: 20 marks | |

Answer

Ownership and inventorship

- By default, the inventor is the owner (**1 mark**).
- Unless developed by an employee (**1 mark**).

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- In the course of employment (**1 mark**).
- Who provides the funding/resources is not relevant (**1 mark**).
- Appreciation that the issue of ownership is not clear cut on the facts provided(**1 mark**).
- Some discussion of the facts that would be taken into consideration – eg how he is paid, NI contributions, verbal agreements between the parties etc (**1 mark**).
- The inventor may not be under an obligation to assign (**1 mark**).
- Teton are unlikely to be considered to be owners (**1 mark**) unless they made more of a contribution than simply performing a test (**1 mark**)

9 marks

Client's disclosure to Teton

- Was the disclosure in confidence? (**1 mark**).
- If not confidential then the invention has been disclosed and no longer patentable (**1 mark**).
- Was there an implied duty of confidence? (**0.5 marks**)
- If so, this should be formalised in an agreement (**0.5 marks**).

3 marks

Use of the Teton data

- Is it possible to include the data without disclosing the method? (**1 mark**).
- If not then are Teton agreeable to this? (**1 mark**).
- Is the data necessary, for example to support inventive step or is other data possible? (**1 mark**).

3 marks

Steps that should be taken by the client

- Advise the inventor to seek his own advice regarding working the invention in view of the existing patent (**1 mark**)
- Consultancy agreement with the inventor which covers ownership of future inventions (**1 mark**)
- Confirmatory assignment from the inventor to the client for the existing invention (**1 mark**)
- Watch for patent filings (**0.5 marks**) and sales (**0.5 marks**) by the inventor
- File the patent application (**0.5 marks**). Not necessary to wait completion of the consultancy agreement/ assignment before filing the application (**0.5 marks**).

5 marks

Total: 20 marks

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Question 8

Your client has invented a new method of processing vegetable seeds. Seeds processed by the method grow into plants which look the same as normal except that they have blue leaves. Vegetables from such plants look and taste identical to normal but the vegetables are resistant to vegetable fly.

Your client has filed a PCT application in English with one claim, which is to a method of processing seeds. The PCT application was filed 28 months ago with no priority claim. The client has not as yet sold any seeds made by the method.

Your client has recently seen a field full of vegetable plants with blue leaves. Your client has spoken to the farmer, who says these new seeds are a big hit this year. Farmers for miles around are buying them from Seeds Are Us Ltd, in Nottingham. Your client would like to stop farmers from stealing the invention.

Prepare notes for a meeting with your client. Your notes should cover:

- a) **entry of the PCT application into the GB national phase. You are not expected to calculate deadlines or consider addition of further claims;**
5 marks
- b) **who are the potential infringers, the infringing acts and any defences to infringement there may be?; and**
10 marks
- c) **any proactive steps that can be taken in relation to the infringers at this time.**
5 marks

Total: 20 marks

Answer

(a)

- Enter the PCT into the GB national phase as soon as possible (**1 mark**). Pay filing fee (**0.5 marks**), search fee (**0.5 marks**), exam fee (**0.5 marks**), excess pages fees (**0.5 marks**). Request combined search and examination (**0.5 marks**) and accelerated examination (**0.5 marks**) on the grounds of a potential infringer (**0.5 marks**). Address issues raised in the international phase (**0.5 marks**)

5 marks

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(b)

- Seeds Are Us Limited (**1 mark**). Possible direct infringement of the method (**1 mark**). Also, seeds are a direct product of the method and so keeping/selling the seeds is also infringement (**1 mark**). Could potentially argue that the seeds are processed by a different method/processed abroad/additional steps etc (**1 mark**) but the burden of proof lies with the manufacturer as the seeds are new (**1 mark**).
- Farmers (**1 mark**) – use/keeping the direct product of the process (**1 mark**).
- Purchasers of the vegetables – e.g. shops/members of the public (**1 mark**). Some discussion of whether the vegetables are direct products of the process (**0.5 marks**). Private/non-commercial use defence (**0.5 marks**)
- Some discussion of prior use/validity (**1 mark**)

10 marks

(c)

- Cannot bring infringement proceedings without a GB granted patent (**1 mark**)
- Notify Seeds Are Us Limited of the existence of the application (**1 mark**).
- Notify farmers of the existence of the application (**1 mark**). Some discussion of the fact that the farmers are also potential customers (**1 mark**)
- Some mention of interim injunctions (**1 mark**).

5 marks

Total: 20 marks

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Question 9

Your client has acquired a portfolio of UK patent applications.

For each of D1–D4 listed below, advise your client as to how to proceed:

- a) Patent application D1 was filed on 2 June 2021. A first office action issued on 25 February 2025 and a response has been filed. The UKIPO has yet to reply. The client wishes to file a divisional application. For any dates you give, explain how they have been calculated.

7 marks

- b) D2 was filed 17 months ago with no priority claim. The filing and search fees have been paid. There are no excess pages or excess claims. However, D2 was filed in the name of your client and, on further discussion with your client, it appears the invention was jointly developed with the brother of your client. The brother of your client has no interest in obtaining patent protection.

4 marks

- c) For D3, filed five years ago, your client has received a notice of intention to grant dated one month ago. There is a grant fee payable. However, the client is not happy with claim 1 and desires a further claim amendment.

5 marks

- d) For D4, your client has also received a notice of intention to grant and a grant fee is due in one month's time. The client, however, has an EP patent (filed in English) claiming priority from D4. The EP patent was granted ten months ago and has not been opposed. You are not expected to consider what should be done in respect of the EP patent.

4 marks

Total: 20 marks

Answer

- i) On the parent case, ask the UKIPO for an update (**1 mark**). The compliance deadline is 25 Feb 2026 (**0.5 marks**). This is the later of four years and six months from priority (**0.5 marks**) and one year from the first office action (**0.5 marks**). The divisional deadline is therefore 25 Nov 2025 (**0.5 marks**) which is three months before the compliance deadline (**0.5 marks**). File divisional application (**0.5 marks**), pay filing fee (**0.5 marks**), search fee (**0.5 marks**), exam fee (**0.5 marks**) excess pages fee (**0.5 marks**) and excess claims fee (**0.5 marks**). File statement of inventorship (**0.5 marks**).

7 marks

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ii) Have an assignment document drafted and signed by your client and his brother assigning the rights to your client (**1 mark**). Statement of inventorship was due 16 months from filing (**1 mark**). Request a two-month extension of time (**0.5 marks**) and pay the fee (**0.5 marks**). File statement of inventorship (**1 mark**).

4 marks

iii) File voluntary amendment (**1 mark**) along with justification for the late amendment (**1 mark**). If the amendment is refused and if still more than three months from the compliance deadline, one can file a divisional application (**1 mark**) and then make the claim amendment as of right (**1 mark**). Alternatively, If the amendment is accepted then pay the grant fee (**1 mark**).

5 marks

iv) Some mention of double patenting (**1 mark**). EP has been validated in GB as it is in English (**0.5 marks**). IF EP and GB are not for the same invention (**1 mark**) then pay the grant fee (**0.5 marks**). Otherwise amend D4 to differentiate from the EP (**0.5 marks**) If differentiation is not possible then there is little to be gained by paying the grant fee (**0.5 marks**)

4 marks

Total: 20 marks