Examiner's Report Year 2025
FD1 – Advanced IP Law and Practice

Patent Examination Board

Introduction

Consistent with last year, the majority of candidates seemed well prepared and the number of poorly scoring scripts was lower than previously.

FD1 is a practice paper. Marks are awarded for analysis, application of the law and advice. Advice should be clear and accurate. A number of candidates "hedged their bets" by writing multiple possible scenarios rather than selecting one over the others, despite the question requiring a clear answer. This results in the client not being given clear advice.

In a number of cases, candidates recited everything they knew about a particular area instead of applying the law to the facts of the scenario. This approach means that available marks cannot be achieved. Additionally, a significant amount of time can be lost by addressing points tangentially related to the issue of concern.

Candidates who methodically worked through the legal tests as set out in the appropriate case law or statute, and applied them to the facts of the question, were awarded good marks.

The mean marks for all questions can be found below the feedback on individual questions.

Questions

Part A

Question number	Comments on questions
Question 1	Almost every candidate recognised that a conflict of interest was key, but advice from candidates on how the conflict should be handled varied widely. A good proportion of candidates stated that the potential conflict meant that representation of the competitor was inadvisable. However, a number of candidates wrote that, despite having identified a conflict of interest, they would try to work for both parties anyway because they did not want to turn away business. However, it is not possible for a sole practitioner to firewall themselves from the other client, so this was poor advice. Few candidates discussed the need to avoid disclosing any details of the conversation. It is incautious (and not in the interests of the client) to investigate further. A number of candidates suggested that they would tell their existing client about the approach from the potential new client without realising that this could be sharing confidential information. Overall, Question 1 was generally well answered.

Question 2	It was good to see so many candidates performing well in the designs question. Some achieved a high score by simply taking a consistent and logical approach to the scenario and facts of the question. Those who did less well missed out because they stated the law but then did not apply it to the facts of the question. Time was also wasted by writing about aspects of design law that were not relevant to this particular question. Candidates should have considered all possible design rights when offering advice. Marks relating to unregistered designs were handled less well. Some candidates applied supplementary rights for the original design but not for the new one, thus missing a potential mark. Many candidates advised filing a new registered design right for the updated design. Fewer candidates appreciated that the updated design might already be protected by the original registered design right, or not be registerable over it. A fair number of candidates automatically assumed that the old design had lapsed for lack of payment of renewal fee. Even if this was the case, some candidates did not appreciate that the grace period was still running and the renewal fee (plus additional fee) could still be paid.
Question 3	This question exposed some weaknesses in the understanding and use of priority. Candidates, on the whole, correctly established that neither GB1 nor PCT1 could be used to claim priority. Interestingly, a significant number of candidates then thought that no further application to protect the original invention could subsequently be filed. In other words, these candidates did not consider filing an application having no claim to priority. Some that did consider this option merely recommended filing a GB case, which would not give your client the geographical coverage that a PCT application would have provided. Other candidates went on to advise a filing strategy including claiming priority back to a new GB application. These candidates advised that the priority clock could be re-started if the cases had been withdrawn leaving no rights outstanding. However, the Act clearly says that the case would need to have been withdrawn leaving no rights outstanding **and** not having served to establish a priority date in relation to another application, wherever made, so this advice was incorrect.

	The majority of candidates did not have any issues in advising on a filing strategy for the improvement. However, a number of candidates did not provide a justification for their strategy (for example, maximising term, maintaining flexibility, delaying costs). Most candidates appreciated that even though protection for the original and improved air fryers could be obtained for the client, the competitor might have prior user rights (i.e. a defence to infringement) if the rumours proved correct. Many candidates could not be awarded available marks because they did not consider all the possible routes for securing rights to the original invention – even if some of those routes were less attractive. Intentional withdrawal means that the applications do not meet the standard required for reinstatement. Some candidates stated it was "unlikely" they could be reinstated, and therefore it was not clear whether the candidate believed the facts were suitable for reinstatement or not. It is important where an outcome is clear that the point is made in this manner.
Question 4	The scenario in this question intentionally placed "you" at a distance from the problem (both its cause and your ability to directly fix it). The mark scheme is driven by the comments of the MD "*Can you think of anything associated which might be a problem for us?"* and the guidance for candidates given in bold. It is possible there is nothing to be concerned about but it is also possible this situation could have a damaging outcome. It must first be determined if there is any risk by understanding if the inventor simply wants to be added or if other inventors are also to be removed (because this provides a very different ownership position for your client). Next, if only inventorship and not ownership is being questioned (for example the patentee was nevertheless entitled to the invention), then there is no risk to your employer. It would be unwise to suggest appeasing C by including them as an inventor without understanding the consequences of this act and the precise demands C is making. The key risk arises if C is recognised as an inventor; if others are removed as being inventors; and if the licensor does not have entitlement from C. Changes in ownership, depending on whether or not there remains a common owner before and after, will impact whether the exclusive license remains in place or lapses. However, the licensee would be entitled to a replacement license on reasonable terms, but those terms may not be the same as at present (for example

	exclusivity for the main product could potentially be lost). If the parties cannot agree, then the terms may be set by the comptroller. An entitlement action could be taken now, or after grant, meaning there could be uncertainty for some time. Given the risks, it is important to put parties on notice of your interests and ensure that your license is registered. Candidates generally handled the ownership and entitlement aspects of the question well, but many did not offer a full consideration of the potential consequences to the licensing situation. Some candidates seemed not confident with advising on inventorship/ownership scenarios when the inventor in question is not an employee, as in this case with the contractor. Many candidates did not comment on the difference in risk for the client in relation to the contractor being a sole inventor versus an additional inventor. Whilst many candidates correctly advised that evidence should be collected to determine whether the contractor was an inventor, fewer appreciated that none of MajorTech's employees may be genuine inventors. This would be critical to the client as inventorship and ownership of the patent application could change causing lapse of the exclusive license. C is indicated as being a contractor rather than an employee; in such circumstances, employee compensation would not apply.
Question 5	Many candidates did well on this question. However, the inherent uncertainty in the scenario clearly threw some candidates who were awarded poor marks. The question was deliberately ambiguous as to which case has the earlier effective date. While many candidates dealt well with the two outcomes in respect of patentability, a smaller number realised that both cases could grant and there could be FTO problems for both parties. Reviewing the claims of PCT1 to determine if the client's tool fell within the scope of the claims was often overlooked in favour of focussing on the patentability of GB2. A significant proportion of candidates also did not advise on the possibility of Natur infringing GB2. Where candidates did consider the client's risk of potentially infringing a GB application stemming from PCT1, fewer also considered the risk of the GB designation of a PCT(EP) application. A number of candidates also advised checking the register or checking the effective dates of PCT1. This would not be possible until the PCT application publishes. This underlines the importance

	of setting up a watch on PCT1 so that the effective date(s) of PCT1 can be established, and assessing the client's garden tool against PCT1's claims. Candidates often were not precise enough in their use of language (for example, it is important to indicate what should be monitored or why monitoring is required) and so could not achieve available marks. Almost all candidates appreciated that the relationship between PCT1 and GB1/GB2 depended on the exact effective date(s) of PCT1. They also knew that regardless of which application had the earlier effective date, the application in question would be a s.2(3) document (which is good). Fewer candidates then went on to consider inventive step. This was a significant improvement in the application of s.2(3) compared to recent examinations. Some candidates overlooked the fact that the question states the product is currently sold by your client.
Question 6	Most candidates did a good job of working through the restoration analysis by correctly identifying when the 5th year renewal fell due, the expiry of the grace period, and recognising that filing a request for restoration was required in order to restore the patent in the UK. However, some candidates made date calculation errors, and care should be taken to double check answers. Candidates should endeavour to be explicit with statements where possible. Renewal dates fall on a specific day which is the last day of the month. The term "end of the month" in different contexts may or may not mean the last day of a month, so is best avoided. The procedural aspects of the question were handled less well. Many candidates assumed that the Board minutes were enough to prove the unintentional nature of the lapse; very few considered that this was a document from a year ago and yet a more recent and therefore perhaps more relevant document was the instructions to you. It was, therefore, possible there had been a change of mind in that time and the unintentional requirement was not guaranteed to be met. This highlights that many candidates try (understandably) to find the best possible outcome for their client. However, it is important to consider that giving a client false hope is not helpful and that if there is a chance a process may not be successful it is important to make them aware of that risk. Most candidates did a good job of working through the restoration analysis by correctly identifying when the 5th year renewal fell due, the expiry of the grace period,

	and that filing a request for restoration was required in order to restore the patent in the UK.

Part B

Question number	Comments on question
Question 7	In this question, candidates had to address a scenario where the protection requirements are uncertain (because details of the competitor product are unclear), and the client has broad claims that appear invalid and needs to obtain enforceable rights quickly. Whilst candidates often handled some of these aspects well, few dealt with all thoroughly. It is important that candidates can be comfortable with uncertainty and adapt accordingly. There were two main courses of actions to consider – either speed proceedings up to get a narrow and enforceable claim that may cover the competitor OR maintain breadth for as long as possible whilst waiting to understand how to direct the prosecution of the cases when more information came to light. Most candidates only considered the former when in fact the latter might be a better course of action than putting arguments on file too early that might limit the options and require the cost of later Divisionals. Few candidates showed an appreciation that provisional protection being available from publication is dependent on the granted claims being reasonably foreseeable based on the published claims. This is a key reason for introducing valid claims which are as broad as possible at an early stage. The procedural and formalities aspects of the GB2 filing were generally well handled, but candidates generally did not provide good advice for how to place the patent portfolio in the best possible standing by proceeding with national phase filings with a useful set of claims. Candidates generally performed a good validity analysis of PCT1, including effective dates of the claims and evaluating the novelty and inventiveness of the claims against the prior art, but did a less thorough job of considering all of the possible amendment opportunities. Many candidates considered one viable option for amendment, but did not appreciate that other options (even if less favourable) might exist. Again, a more rigorous approach would have helped candidates here.

	While many candidates identified that GB2 was intentionally discontinued **by you**, only a few highlighted that it is the intention of the **applicant** that matters. Many candidates appeared to have reproduced everything they knew about interim injunctions, without linking it to the facts of the case, and concluded that an interim injunction would be granted. However, interim injunctions are (apparently) only exceptionally granted on pending applications. Moreover, the client does not definitely know that the competitor's product will launch, where it will launch or whether it falls within the scope of PCT1 or GB2. There is a great deal that is not known about this situation, which would impact an application for an interim injunction.
Question 8	About 40 % of candidates answered this question. Although the question states that the first communication from the examiner was issued in 2023 and a Notice of Intention to Grant was issued on 24 October 2025, many stated that the Notice of Intention to Grant was the first communication, which consequentially influenced the deadline for Divisionals. It is important to bear in mind that an application does not automatically grant when the period set in the Notice of Intention to Grant passes, only that it could proceed to administrative grant at any subsequent point. Further, Divisional applications cannot be filed once an application reaches administrative grant (which is in contrast to EP practice where an application is considered pending until publication of the mention of grant - therefore, care is needed around the casual use of non-specific "grant" language). Most candidates dealt with the CIP and US aspects for the prior art well, bu not always systematically and therefore very few mentioned, for example, US-A in its own right. Candidates were generally performing a legal analysis for the patentability of GB1 effectively, but few considered the wider commercial situation and advised accordingly. A significant number of candidates discussed irrelevant points of law, for example whether Blueberry was infringing Tulip's patents, instead of focusing on the key issue, which was optimising Blueberry's portfolio for acquisition by Tulip. Marks were awarded for analysing the impact that the acquisition might have on the filing strategy for GB2. Candidates with a good understanding of the law around Divisional applications picked up marks in the first part of this question. However, a number omitted to deal with renewal fees.

	The patentability questions were generally well answered, although a number of candidates seemed to lose track of which publications were involved and so only considered GB-X for example, thus not accessing marks for looking at US-A and US-B. Excluded subject matter was not handled well on the whole. Despite the clear pointer in the question, few candidates considered both the UK and the US, which meant that a number of the marks were missed. Of the candidates who concluded that claim 3 was patentable, very few actually used the required wording of achieving a technical effect.
Question 9	This question was attempted by more than half of the candidates. The segmented nature of the question seemed to suit many candidates, with many good scores being achieved. The legal analysis aspects of this question were generally well handled for Matters 1 and 2, though less so for Matter 3. This question had several instances which required further investigation, for example in Matter 1 MashTun's entitlement to priority, determining whether EP-W was entitled to priority, whether there was an earlier published US application, and in Matter 2, whether the student actually contributed to the invention. Candidates rarely advised investigating further. In Matter 1, there is nothing in the question that unambiguously confirms that GB1 is not entitled to priority from GB2. However, many candidates were quick to state that it was. Analysis of the impact of the ranges of GB1 with respect to EP-W was not well done. Very few candidates looked beyond limiting to Claim 2 in terms of amendment and so did not consider whether there was basis for limiting the ranges. Candidates picked up that there was one example but usually in the context of sufficiency, not inventive step over the whole breadth of the claim. Many candidates went into detail about whether EP-W was entitled to priority or not. However, relatively few candidates appreciated that the subject-matter of US-W may be present in an earlier filed US application (because US-W is a CIP). This earlier application may have published and be relevant against GB1 with respect to both novelty and inventive step. In Matter 2, candidates did a good job of analysing the situation with respect to MashTun and the student, but seemed to overlook that the University might have rights. Most candidates described the inventor-ownership aspect of MashTun's employee and the

	student well. However, fewer candidates appreciated that the student may not be an inventor at all, or that the invention may have been created at a time when the student was not employed by MashTun. It was surprising how few candidates advised reviewing the student's presentation in advance to ensure that all developments were captured in the application, and that further examples or details may be needed for the application. In Matter 3, few appreciated the difference between GB3 and GB4 in terms of grant date and lost marks for appreciating the length of time since grant mattered because, for GB3, knowledge at grant of lack of entitlement would then need to be shown. Most candidates described MT's entitlement to GB3 and GB4 by virtue of E's employment. They also usually went on to describe the possibility of E applying for compensation. However, many candidates did not appear to have a systematic or rigorous approach to handling the compensation aspect of this question. Candidates were expected to discuss the possibility of an outstanding benefit: there is nothing in the question which is definitive either way. It should be recalled that your client is the patentee and therefore it is in their interests for the benefit to not be considered outstanding. (License income and reduced labelling costs are factors to be considered, but are not decisively outstanding even for a small entity. There is no indication of the scale of these benefits.) Few candidates realised that it was too late for E to launch an entitlement action for GB3.

Mean Marks by Question

FD1	Q1	Q2	Q3	Q4	Q5	Q6	Q7	Q8	Q9	Total
Marks available	3	10	8	10	9	10	25	25	25	100
Mean mark	2.0	5.9	4.2	4.0	4.6	5.5	11.2	9.6	11.0	47.28