

■ Patent
■ Examination
■ Board

FD1 Advanced IP Law and Practice

Specimen Mark Scheme

For first examination in October 2025

Mark scheme provisional pending consultation

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Guidance for FD1 Examiners

The question paper comprises:

Section A: three scenario-based questions (total 25 marks)

Section B: three longer scenario-based questions each worth 25 marks (total 75 marks).

Total marks available – 100

1 The FD3 syllabus contains Learning Outcomes which specify what candidates must know, understand and be able to do. These Learning Outcomes reflect the generic Learning Outcomes for the Final Diploma set out in the Programme Specification. The examination specifically tests candidates' ability to meet these Learning Outcomes.

2 The Levels of Response grids are used to determine the mark to be awarded for each task. Read the candidate's response for the task, referring to the Generic Criteria and QP-Specific Criteria.

What the levels mean:

- Levels 3 and 4: the candidate's response to the task meets, or exceeds, the standard of competence that demonstrates achievement of the learning outcomes.
- Level 2: the candidate's response to the task has not met the standard of competence that demonstrates achievement of the learning outcomes. A Pass in the examination can be achieved if a sufficient level of competence is demonstrated in the other tasks.
- Levels 1 and 0: the candidate's response to the task is significantly below the required standard of competence and the candidate cannot be awarded a Pass for the FD3 examination.

3 The QP-Specific Content is material that candidates may include in their answers, but is not exhaustive. Other responses that meet the task requirements may be acceptable. The QP-Specific Content is designed to help examiners to award an appropriate mark within the correct level.

4 The level should be first determined by starting at the highest level and working down until the level that best matches the answer is reached. Then the mark within that level should be determined.

5 The questions should be marked separately and a mark awarded for each question, then the marks totalled and transferred to the marks spreadsheet.

6 A **best-fit** approach should be applied. Responses may contain both strengths and weaknesses and may be inconsistent in terms of the level achieved for different assessment criteria.

Part A

Question 1

You work in-house as a patent attorney for UK Company Horizon. In early June 2023 a research scientist named Drew submitted a detailed Invention Disclosure Form for review. It was agreed that the concept (Concept X) was commercially significant and should be progressed, and so shortly afterwards, your predecessor (Attorney P) drafted and filed a GB patent application. The patent application GB-1 was filed on 30 June 2023.

Today, a literature article by UK Company Skyline has come to light, which contains a full disclosure of Concept X. Drew is mentioned as deviser of Concept X and the leader of the team that developed the invention. The article was submitted on 31st May and the publication date is 10 August 2023.

A report from Human Resources shows that Drew joined Horizon from Skyline on 1 June 2023, having worked there as a research scientist.

Prepare notes for a meeting with your Leadership Team to discuss the issue.

8 Marks

	Generic Criteria	QP-Specific Criteria:	Mark Range
Level 4	<ul style="list-style-type: none">Response is wide-ranging with a clear and consistent focus on the scenarioConclusions are presented and relevant justification providedCommunication is sophisticated and highly effective	<p>Candidate addresses the Level 3 Specific Criteria to an excellent level. In addition to the QP-Specific Level 4 criteria, marks can be awarded for relevant advice or alternative solutions that lead to significant client advantage/solution</p> <p>L41 (L32) Investigate the situation and talk to Drew and/or collect evidence (e.g. look at lab books, find evidence of when Concept X was invented)</p> <p>L42 (L36) Analyse the ethics of continuing prosecuting the application based on a concept not originating from Horizon (e.g. was a Form 7 filed by Attorney P?; do have Horizon have a duty to Skyline ...?)</p> <p>L43 (L37) The technical preparations for publication are due soon (5 weeks), therefore action is required asap</p>	7-8
Level 3	<ul style="list-style-type: none">The response addresses (nearly) all the pointsSome arguments are a little weak but there is clear focus on the scenarioConclusions are usually supported by appropriate justifications	<p>Candidate addresses most Level 3 QP-Specific criteria to a competent level</p> <p>Entitlement</p> <p>L31 Horizon does not appear to be the rightful owner because – reason required (e.g. the submission date of the article, the information in the article, the full description etc.)</p>	5-6

	<ul style="list-style-type: none"> • Communication is generally appropriate and effective 	<p>L32 Investigate the situation and talk to Drew and/or collect evidence</p> <p>L33 Skyline would appear to be the first owner – <i>clear statement required</i></p> <p>L34 The invention may be owned by Drew (discussion required, for example he may not have been employed by Skyline)</p> <p>L35 Entitlement proceedings may be brought.</p> <p>Other considerations</p> <p>L36 Analyse the ethics of continuing prosecuting the application based on a concept not originating from Horizon</p> <p>L37 The technical preparations for publication are due soon (5 weeks)</p> <p>L38 Discuss any measures to reduce future risk (e.g. of another inventor bringing confidential information from a previous employer) (such as recommend rolling out training at Horizon to remind the employees of their fiduciary responsibilities, revising the invention disclosure form to state date invention made, etc.)</p>	
Level 2	<ul style="list-style-type: none"> • Response is basic and may contain weaknesses and/or inconsistently relate to the scenario • Conclusions may not be appropriately justified • Advice is not provided • Conclusions are not given or are given but not justified • Communication is not consistently appropriate or effective • The law may be recited but not applied to the facts of question 	<p>Candidate addresses the Level 3 QP-Specific Criteria to a basic level</p> <p>L21 (L31) Horizon does not appear to be the rightful owner</p> <p>L22 (L33) Skyline would appear to be the first owner</p> <p>L23 (L34) The invention may be owned by Drew</p> <p>L24 (L38) Discuss any measures to reduce future risk</p>	3-4
Level 1	<ul style="list-style-type: none"> • Response is insufficient and may have minimal focus on the scenario • Justifications for conclusions are not provided • Communication is inappropriate or ineffective 	<p>Candidate addresses some of the Level 3 QP-Specific Criteria but at an unsatisfactory level</p>	1-2
Level 0	<ul style="list-style-type: none"> • No response or no response worthy of credit. 	<p>Candidate gives no response, or gives no credit-worthy response</p>	0

Question 2

Your new UK based client asks for advice regarding its European patent application EP1 filed on 1 April 2020 claiming priority from a UK patent application GB1 filed on 1 April 2019. The GB1 has lapsed irrevocably. GB1 and EP1 both disclose and claim product "Block". An intention to grant communication (under Rule 71(3) EPC) was issued by the European Patent Office in October 2022.

However, after paying the grant fee and filing German and French translated claims, your client decided that, at the time, it had no wish to proceed with validations. Your client is contacting you to say that circumstances have changed: its latest version of product Block is selling well in the UK and it now wishes to have UK patent protection.

Advise your client on the situation.

9 Marks

	Generic Criteria	QP-Specific Criteria:	Mark Range
Level 4	<ul style="list-style-type: none"> Response is wide-ranging with a clear and consistent focus on the scenario Conclusions are presented and relevant justification provided Communication is sophisticated and highly effective 	<p>Candidate addresses the Level 3 QP-Specific Criteria to an excellent level. In addition to the QP-Specific Level 4 criteria, marks can be awarded for relevant advice or alternative solutions that lead to significant client advantage/solution</p> <p>L41 (L31) Check whether the EP patent has granted (with explanation - as grant fee paid and translated claims filed)</p> <p>L42 (L32) If not paid, then is no longer possible to pay it (because no due care)</p> <p>L43 If mention of grant of the European patent in the European Patent Bulletin was on or before 1 April 2020, then grant would have happened before the 4th year renewal fee was due to EPO</p> <p>L44 (L35) If EP1 has granted, first UK renewal fee due on 30 April 2021 (or end of April), but presumably not been paid</p>	8-9
Level 3	<ul style="list-style-type: none"> The response addresses (nearly) all the points Some arguments are a little weak but there is clear focus on the scenario Conclusions are usually supported by appropriate justifications Communication is generally appropriate and effective 	<p>Candidate addresses most Level 3 QP-Specific criteria to a competent level</p> <p>Entitlement</p> <p>L31 Check whether the EP patent has granted</p> <p>L32 Check whether the 4th year European maintenance fee was due prior to grant date and was paid</p> <p>L33 If not paid, then is no longer possible to pay it</p> <p>L34 UK validation not required due to London agreement</p> <p>L35 If EP1 has granted, first UK renewal fee due on 30 April 2021 (or end of April)</p>	5-7

		<p>L36 Grace period until 31 October 2021 (or end of month) – advise client to pay renewal fee with surcharge</p> <p>L37 Anyone can pay the renewal fee (therefore, you don't have to appoint yourself as address for service)</p> <p>L38 Check allowed/granted claims of EP1 actually cover latest version of product Block</p>	
Level 2	<ul style="list-style-type: none"> • Response is basic and may contain weaknesses and/or inconsistently relate to the scenario • Conclusions may not be appropriately justified • Advice is not provided • Conclusions are not given or are given but not justified • Communication is not consistently appropriate or effective • The law may be recited but not applied to the facts of question 	<p>Candidate addresses the Level 3 QP-Specific Criteria to a basic level</p> <p>L21 (L36) Grace period until 31 October 2021 (or end of month)</p> <p>L22 (L37) Anyone can pay the renewal fee</p>	3-4
Level 1	<ul style="list-style-type: none"> • Response is insufficient and may have minimal focus on the scenario • Justifications for conclusions are not provided • Communication is inappropriate or ineffective 	<p>Candidate addresses some of the Level 3 QP-Specific Criteria at an unsatisfactory level</p> <p>L11 (L32) Check whether the 4th year European maintenance fee was due prior to grant date and was paid – wrong year given</p> <p>L12 (L35) - wrong date given</p> <p>L13 (L36) - wrong date given</p>	1-2
Level 0	<ul style="list-style-type: none"> • No response or no response worthy of credit. 	<p>Candidate gives no response, or gives no credit-worthy response</p>	0

Question 3

Last month you filed a patent application GB1 at the UK IPO in Chinese directed towards protective boots for dogs and cats. GB1 claims priority from a Chinese application, CN1, filed on 2 October 2023. All fees were paid on filing and the priority document was filed. Today, you receive notification from the UK IPO, dated 11th October, that a translation is required. On review of the case, you notice that all references to the sizes of the boots have been written in metres instead of centimetres in both CN1 and GB1 and it is clear that the sizes referred to would not provide suitable shoe sizes for the pets described.

Prepare notes for a meeting with your client

8 marks

	Generic Criteria	QP-Specific Criteria:	Mark Range
Level 4	<ul style="list-style-type: none"> Response is wide-ranging with a clear and consistent focus on the scenario Conclusions are presented and relevant justification provided Communication is sophisticated and highly effective 	<p>Candidate addresses the Level 3 QP-Specific Criteria to an excellent level. In addition to the QP-Specific Level 4 criteria, marks can be awarded for relevant advice or alternative solutions that lead to significant client advantage/solution</p> <p>L41 Otherwise the comptroller may refuse the application L42 (L32) The mistake in the unit of measurement is an error that cannot be fixed by amendment (because there is no basis) L43 (L36) File a new application that is correct, as soon as possible, whilst pursuing the current application with request for correction of the error (in order to preserve the earliest date in case of intervening prior art) (no need to pay fees on new application until fate of original filing is decided)</p>	7-8
Level 3	<ul style="list-style-type: none"> The response addresses (nearly) all the points Some arguments are a little weak but there is clear focus on the scenario Conclusions are usually supported by appropriate justifications Communication is generally appropriate and effective 	<p>Candidate addresses most Level 3 QP-Specific criteria to a competent level</p> <p>L31 The deadline for filing a translation of the application is 11 December 2023 OR 2 months from notification; (one or the other required for mark) L32 The mistake in the unit of measurement is an error that cannot be fixed by amendment L33 Argue that it is immediately clear that there is an obvious error – because sizes referred to would not provide suitable shoe sizes for the pets described... L34 ...and that it is immediately evident that nothing else could have been intended in the original specification because e.g. centimetres requires only the unit of measurement to change; whereas any other unit of measurement will also require a change in the number as well as the unit</p>	5-6

		<p>L35 Also, centimetres match the sizes of animal paws, which should be supported with evidence (balance of probabilities)</p> <p>L36 File a new application that is correct, as soon as possible, whilst pursuing the current application with request for correction of the error</p> <p>L37 A discussion of the consequence if you cannot, or do not, make the correction (e.g. Client might obtain a patent that is completely unsuitable for the target animals/not commercially relevant; will need to continue with the new application (fees, costs etc.))</p>	
Level 2	<ul style="list-style-type: none"> • Response is basic and may contain weaknesses and/or inconsistently relate to the scenario • Conclusions may not be appropriately justified • Advice is not provided • Conclusions are not given or are given but not justified • Communication is not consistently appropriate or effective <p>The law may be recited but not applied to the facts of question</p>	<p>Candidate addresses the Level 3 QP-Specific Criteria to a basic level</p> <p>L21 (L33) Argue that it is immediately clear that there is an obvious error</p> <p>L22 (L34) ...and that it is immediately evident that nothing else could have been intended in the original specification</p> <p>L23 (L35) Also, centimetres match the sizes of animal paws</p> <p>L24 (L37) You cannot/should not make the correction - no discussion given</p>	3-4
Level 1	<ul style="list-style-type: none"> • Response is insufficient and may have minimal focus on the scenario • Justifications for conclusions are not provided • Communication is inappropriate or ineffective 	<p>Candidate addresses some of the Level 3 QP-Specific Criteria at an unsatisfactory level</p> <p>If wrong date given, no mark to be awarded</p> <p>L11 (L31) - wrong date given</p>	1-2
Level 0	<ul style="list-style-type: none"> • No response or no response worthy of credit. 	Candidate gives no response, or, gives no credit-worthy response	0

Part B

Question 4

The Chief Executive Officer of a new client, Daisy Dairies (D), contacts you for advice. Daisy Dairies is an organic UK dairy company which has carried out research for ways to reduce the incidence of biting flies in its dairy herds without using insecticides. Biting flies are a major problem as the bites of the flies cause disease in the cows and the flies stress the animals, which stops them from grazing, feeding and sleeping.

Daisy Dairies has found that if the cows are painted with black-and-white stripes so that the cows look like zebras, the cows have 50% fewer flies on their bodies and exhibit significantly less stressed behaviour, such as flicking their tails and shaking their heads. Cows painted with only white stripes or only black stripes did not show any reduction in the number of flies on their bodies. The paint used in the research was commercially available paint.

Daisy Dairies filed a priority application, GB-P1, on 2 April 2022 and a PCT application, PCT1, claiming priority from GB-P1 on 2 April 2023. The specifications of GB-P1 and PCT1 are identical. Category 'A' citations were identified in the International Search Report. PCT1 has a single claim to:

A method of treating a livestock animal, the method comprising painting black-and-white stripes onto the animal such that biting fly attacks are reduced.

Because painting individual cows is time-consuming and the paint rubs off after a few days, Daisy Dairies has carried out further research and has found that if the cows are covered with a black-and-white striped blanket, the same reduction in biting flies is observed. The blanket is made of an extremely thin but strong, breathable material which is comfortable for the cows. The material is commercially available.

The company filed a priority application, GBP2, on 17 July 2022, and a PCT application, PCT2, claiming priority from GBP2, on 17 July 2023. The specifications of GBP2 and PCT2 are identical. PCT2 has only category 'A' citations identified in the International Search Report and has a single claim to:

A protective blanket for a livestock animal, the blanket comprising:

a) a black-and-white striped blanket; and

b) a magnetic closure comprising first and second magnetic sections on opposing surfaces of an end flap of the blanket, wherein the first and second magnetic sections are releasably engageable with one another.

Daisy Dairies has now discovered that a competitor in the UK, Mabel Milk (M), is using exactly the same striped blankets with their cows, except that the blankets use hook and loop fasteners instead of magnetic closures. Mabel Milk is also exporting the blankets with the hook and loop fasteners to the US and China, where they have become immediately and immensely popular with beef producers.

The CEO of Daisy Dairies tells you that she wants to know if Mabel Milk or the beef producers are infringing PCT1 or PCT2.

Write notes in preparation for a meeting with your client. Ignore any potential issues concerning designs and trademarks.

25 marks

	Generic Criteria	QP-Specific Criteria:	Mark Range
Level 4	<ul style="list-style-type: none"> Response is wide-ranging with a clear and consistent focus on the scenario Conclusions are presented and relevant justification provided Communication is sophisticated and highly effective 	<p>Candidate addresses the Level 3 QP-Specific Criteria to an excellent level. In addition to the QP-Specific Level 4 criteria, marks can be awarded for relevant advice or alternative solutions that lead to significant client advantage/solution</p> <p>L41 Contact a local practitioner about late entry into the US and CN if national phase entry has not occurred. (or if the candidate explains what to do themselves)</p> <p>L42 Methods of treatment are patentable in the US</p> <p>L43 Discussion on whether methods of treatment are patentable in the UK and Japan. (claims may need to be reformulated)</p> <p>L44 Who is making the blanket with hook and loop fasteners? Mabel Milk or another manufacturer?</p>	20-25
Level 3	<ul style="list-style-type: none"> The response addresses (nearly) all the points Some arguments are a little weak but there is clear focus on the scenario Conclusions are usually supported by appropriate justifications Communication is generally appropriate and effective 	<p>Candidate addresses most Level 3 QP-Specific criteria to a competent level</p> <p>PCT-1:</p> <p>L31. The effective date of the claim is 2 April 2018 (the filing date of GB-P1)</p> <p>L32. The national phase entry date for the US and China was 5 October 2023 (30m from the priority date; date passed)</p> <p>L33. The national phase entry date for UK is 5 November 2023 (31m from the priority date). (If candidates discuss EP also acceptable.)</p> <p>L34. Check whether national phase entry (for the US and China) has occurred</p> <p>PCT-2:</p> <p>L35. The effective date of the claim is 17 July 2021 (filing date of GB-P2)</p> <p>L36. The national phase entry date for the US and China is 17 January 2024 (30m from the priority date; date not passed)</p> <p>L37. The national phase entry date for UK is 17 February 2024 (31m from the priority date; not passed)</p> <p>Patentability (MoT):</p> <p>L38. In the absence of other prior art the MoT is novel (because only category A citations)</p> <p>L39. The method of treatment is inventive as there are significant advantages in reducing the number of biting flies</p>	13-19

		<p>Patentability (blanket): L310. PCT-1 is prior art against PCT-2 in the US but can be dealt with by common ownership provisions L311. PCT-1 will be s2(3) prior art against PCT-2 if PCT-1 enters the UK national phase (or EP nat phase) L312 Check - is there a double-patenting conflict between GBP2 and PCT-2(GB)?</p> <p>Infringement: L313. No-one is directly infringing PCT-1(US or JP) (because they are not painting their cows). L314. There is no literal infringement (by Mabel Milk under normal claim construction because hook and eye fastenings are different to magnetic closures) L315. Infringement by equivalence in the UK? (does the variant infringe because it varies in a way which is immaterial to the claimed invention?) Yes or no - with reason L316. Infringement by equivalence in US and China? contact local counsel for advice</p> <p>Actions: L317. Accelerate prosecution as no immediately enforceable rights L318. Discussion on whether there is any point in entering the national phase in the UK or China for PCT-1 L319. Licensing discussion - may be attractive as some parties are not competitors. L320. Look for basis to broaden claims to generic fasteners L321. Put Mabel Milk on notice.</p>	
<p>Level 2</p>	<ul style="list-style-type: none"> • Response is basic and may contain weaknesses and/or inconsistently relate to the scenario • Conclusions may not be appropriately justified • Advice is not provided • Conclusions are not given or are given but not justified 	<p>Candidate addresses the Level 3 QP-Specific Criteria to a basic level</p>	<p>7-12</p>

	<ul style="list-style-type: none"> • Communication is not consistently appropriate or effective • The law may be recited but not applied to the facts of question 		
Level 1	<ul style="list-style-type: none"> • Response is insufficient and may have minimal focus on the scenario • Justifications for conclusions are not provided • Communication is inappropriate or ineffective 	<p>Candidate addresses some of the Level 3 QP-Specific Criteria at an unsatisfactory level</p> <p>Wrong dates: L11 (L31) L12 (L32) L13 (L33) L14 (L35) L15 (L36) L16 (L37)</p>	1-6
Level 0	<ul style="list-style-type: none"> • No response or no response worthy of credit. 	Candidate gives no response, or, gives no credit-worthy response	0

Mark scheme provisional pending consultation

Question 5

Your client, Storeit plc, uses storage silos to store cement which is a powdery material. The silos are emptied from the bottom and re-filled from the top and filling a silo too quickly or over-filling a silo can give rise to damage to the silo. To minimise the risks, the top of a silo is fitted with a pressure release valve (valve) to prevent excess pressure building up. Because the cement is powdery there is a risk that the valve can become blocked and regular cleaning is required.

Storeit purchases valves from Protectit plc and agreed to purchase on a trial basis a newly available valve, which was then installed in one of Storeit's silos. The new valve is said to be self-cleaning and is covered by Protectit's European Patent EPB. EPB was filed in November 2021 without any claim to priority and granted 6 months ago. The new valve is not functioning as well as expected and Storeit has made and tested a modified valve on one of its own silos. The modification made by Storeit has resulted in a dramatic improvement in the self-cleaning function over Protectit's product. You recently filed a UK patent application GBA to the modification on behalf of Storeit.

The market potential for Storeit's improved valve is worldwide, but Storeit does not have the capabilities to meet potential demand.

Storeit told Protectit about the modification after filing GBA. Protectit is keen to make and sell the modified valve but says it does not need to account to Storeit because the modified valve is a straightforward change to its product and anyway it owns the modification because it is a variation on the subject matter of EPB and falls within the scope of the claims of EPB.

The Technical Director of Storeit has been talking to a colleague at another company, Keepit Limited, which also uses cement storage silos. The Technical Director believes that in October 2021 Keepit purchased two valves made in accordance with EPB from Protectit. These two valves were installed by Keepit at the tops of two of its silos.

Prepare notes forming the basis for advice to your client.

25 marks

	Generic Criteria	QP-Specific Criteria:	Mark Range
Level 4	<ul style="list-style-type: none">• Response is wide-ranging with a clear and consistent focus on the scenario• Conclusions are presented and relevant justification provided• Communication is sophisticated and highly effective	<p>Candidate addresses the Level 3 QP-Specific Criteria to an excellent level. In addition to the QP-Specific Level 4 criteria, marks can be awarded for relevant advice or alternative solutions that lead to significant client advantage/solution</p> <p>L41 (L33) Check status of EPB (renewals mostly due November 2023, national phase should be completed, London Agreement countries) L42 (L34) Look for equivalents/other family members in other countries (e.g. USA, which could block international exploitation) L43 (L310) Was the sale in confidence? L44 Has K made any other disclosure ...?</p>	20-25

		<p>L45 Need suitable evidence – for example copy of invoice/delivery note/written confirmation (prior use is always difficult to prove to a sufficiently high level)</p> <p>L46 Can use the prior sale to K/weakness of EPB to encourage P to take a licence</p>	
Level 3	<ul style="list-style-type: none"> • The response addresses (nearly) all the points • Some arguments are a little weak but there is clear focus on the scenario • Conclusions are usually supported by appropriate justifications • Communication is generally appropriate and effective 	<p>Candidate addresses most Level 3 QP-Specific criteria to a competent level</p> <p>FTO and validity searches</p> <p>L31 Conduct validity searches (for GBA and also for EPB)</p> <p>L32 Conduct FTO search on GBA (anything other than EPB that could present problems?)</p> <p>L33 Check status of EPB</p> <p>L34 Look for equivalents/other family members in other countries</p> <p>L35 Check the valve falls within the scope of EPB</p> <p>Actions regarding EPB</p> <p>L36 P will infringe (by making modified valves) if GBA grants</p> <p>L37 In Europe, S cannot manufacture/market its improvement due to EPB</p> <p>L38 or (effectively) licence anyone other than P</p> <p>L39 S can oppose EPB (in the next 3 months/before end of opp period)</p> <p>L310 Has P disclosed the VALVE with the sales to K</p> <p>L311 Is installation at the top of a silo making the VALVE available to the public? (i.e. can you see it?)</p> <p>L312 Is the valve installation an enabled disclosure</p> <p>Actions regarding GBA</p> <p>L313 GBA owned by S not P (P's VALVE is in the public domain)</p> <p>L314 GBA improvement novel over EPB (made and tested at S's location)</p> <p>L315 GBA improvement appears inventive over EPB due to dramatic improvement</p> <p>L316 File PCT within 12 months of GBA and claiming priority from GBA</p> <p>L317 File in non PCT countries</p> <p>L318 Accelerate GBA on the basis of possible infringement by P</p> <p>L319 Monitor the market for any potential infringement of GBA by P</p> <p>Licensing</p> <p>L320 Open licensing negotiations with P</p>	13-19

		<p>L321 If no equivalents could look for alternative licensee outside EP area</p> <p>L322 EPB is granted and can be enforced immediately</p>	
Level 2	<ul style="list-style-type: none"> • Response is basic and may contain weaknesses and/or inconsistently relate to the scenario • Conclusions may not be appropriately justified • Advice is not provided • Conclusions are not given or are given but not justified • Communication is not consistently appropriate or effective • The law may be recited but not applied to the facts of question 	<p>Candidate addresses the Level 3 QP-Specific Criteria to a basic level</p> <p>L21 (L37) In Europe, S cannot manufacture/market its improvement – no reasoning</p> <p>L22 L314) GBA improvement novel over EPB – no reasoning</p> <p>L23 (L315) GBA improvement appears inventive over EPB – no reasoning</p>	7-12
Level 1	<ul style="list-style-type: none"> • Response is insufficient and may have minimal focus on the scenario • Justifications for conclusions are not provided • Communication is inappropriate or ineffective 	<p>Candidate addresses the Level 3 QP-Specific Criteria to a basic level</p>	1-6
Level 0	<ul style="list-style-type: none"> • No response or no response worthy of credit. 	<p>Candidate gives no response, or, gives no credit-worthy response</p>	0

Mark scheme provisional pending consultation

Question 6

A longstanding client calls you sounding panicked. They inform you that they have stumbled on a third-party EP patent which granted a few months ago. They believe that the claims, despite using unusual terminology, encompass a very profitable product which the client has been making and selling in the UK for nearly 8 years. The client is particularly concerned as the case was not identified during analysis of a freedom to operate search, which your firm conducted prior to product launch.

Prepare points to consider as part of a subsequent analysis.

25 Marks

	Generic Criteria	QP-Specific Criteria:	Mark Range
Level 4	<ul style="list-style-type: none"> Response is wide-ranging with a clear and consistent focus on the scenario Conclusions are presented and relevant justification provided Communication is sophisticated and highly effective 	<p>Candidate addresses the Level 3 QP-Specific Criteria to an excellent level. In addition to the QP-Specific Level 4 criteria, marks can be awarded for relevant advice or alternative solutions that lead to significant client advantage/solution</p> <p>L41 (L311) The client may be infringing because it is at least making and selling (no mark for MUDIOK), (using and importing do not appear to be undertaken by the client, but check)</p> <p>L42 If validity analysis is contrary to client position, suggest cease actions/seek license to continue</p> <p>L43 If validity analysis supports client position, consider possibility of continuing or</p> <p>L44 taking positive action such as opposition filing/national invalidity challenge</p> <p>L45 Was the technical scope of search sufficient (i.e. should it have included the unusual terminology)</p> <p>L46 Check when the FTO search was done and whether the EP patent was published at that time</p> <p>L47 Was a top-up search carried out (18 months) after launch?</p>	20-25
Level 3	<ul style="list-style-type: none"> The response addresses (nearly) all the points Some arguments are a little weak but there is clear focus on the scenario Conclusions are usually supported by appropriate justifications 	<p>Candidate addresses most Level 3 QP-Specific criteria to a competent level</p> <p>Consider prima facie relevance of case:</p> <p>L31 Review relevance of claims to product</p> <p>L32 Identify effective date of EP case</p> <p>L33 Confirm EP case designates UK</p> <p>L34 Renewal fees are still payable, therefore monitor</p> <p>L35 Consider if EP case lacks novelty over client sales (unusual terminology may have helped an invalid case sneak past Examiner)</p> <p>Consider if client has prior user rights:</p>	13-19

	<ul style="list-style-type: none"> • Communication is generally appropriate and effective 	<p>L36 Investigate if client made serious and effective preparations for the UK sales and in advance of the effective date of the claims</p> <p>Consider potential liability:</p> <p>L37 Activities of client prior to publication of EP are not an infringement</p> <p>L38 Activities after publication could constitute infringement of provisional protection</p> <p>L39 If published in English</p> <p>L310 If acts infringed case as published and as granted and if reasonable to expect patent would have granted</p> <p>L311 The client may be infringing because it is at least making and selling (no mark for MUDIOK)</p> <p>L312 Check whether client has a contractual liability to customers who infringe</p> <p>L313 Remedies include damages/account of profits, delivery up/destruction, injunction, declaration of infringement (and validity) (need to say all for mark)</p> <p>L314 Preliminary injunction unlikely due to 8 years on market</p> <p>Consider mitigations:</p> <p>L315 Client may be able to avoid damages/account of profits if can show defence of innocent infringement ...</p> <p>L316 ... as (i) did not know about case and (ii) was diligent in undertaking FTO review prior to launch - so may not reasonably be expected to know</p> <p>L317 Customers may have other defence to infringement (e.g. if private non-commercial)</p> <p>If a potential concern:</p> <p>L318 Check for divisional filings/other family members which could also be relevant to UK (eg national GB)</p> <p>L319 Undertake validity search/analysis</p>	
<p>Level 2</p>	<ul style="list-style-type: none"> • Response is basic and may contain weaknesses and/or inconsistently relate to the scenario • Conclusions may not be appropriately justified • Advice is not provided 	<p>Candidate addresses the Level 3 Specific Criteria to a basic level, but insufficient to pass E.g.: No/insufficient reasoning/discussion given; Advice not given; No conclusion made/justified; Incomplete list/information.</p> <p>L21 (L35) Consider if EP case lacks novelty over client sales – no reasoning</p>	<p>7-12</p>

	<ul style="list-style-type: none"> • Conclusions are not given or are given but not justified • Communication is not consistently appropriate or effective • The law may be recited but not applied to the facts of question 	<p>L22 (L313) Remedies include damages/account of profits, delivery up/destruction, injunction, declaration of infringement (and validity) – incomplete list given</p> <p>L22 (L314) Preliminary injunction unlikely – no reasoning</p>	
Level 1	<ul style="list-style-type: none"> • Response is insufficient and may have minimal focus on the scenario • Justifications for conclusions are not provided • Communication is inappropriate or ineffective 	Candidate addresses the Level 3 QP-Specific Criteria to a basic level	1-6
Level 0	<ul style="list-style-type: none"> • No response or no response worthy of credit. 	Candidate gives no response, or, gives no credit-worthy response	0

Mark scheme provisional pending consultation