

THE JOINT EXAMINATION BOARD

PAPER P1

BASIC UNITED KINGDOM PATENT LAW AND PROCEDURE

17th November, 1993

10.00 a.m. - 1.00 p.m.

Please read the following instructions carefully. This is a THREE HOUR paper.

1. You should attempt no more than four questions from Part A and no more than three questions from Part B.
2. The number of marks allotted to each question is placed in brackets at the end of the question.
3. Where a question permits of reasons being given for the conclusions reached, such reasons should be given.
4. Start each question (but not necessarily each part of each question) on a fresh sheet of paper. In the appropriate boxes at the top of each sheet please enter the designation of the paper, the question number, and your Examination number. Write on one side of the paper only using BLACK ink. You must NOT staple pages together. You must NOT state your name anywhere in the answers.
5. Unless specifically requested answers are NOT required in letter form.
6. NO printed matter or other written material may be taken into the examination room.
7. Answers MUST be legible. If the examiners cannot read a candidate's answer no marks will be awarded.

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PART A

1. When can a divisional application be filed, and by when must it be in order for grant? Are there any restrictions on the subject matter that will be allowed to be present in a divisional application? (10 marks)

2. An overseas associate asks for full comments concerning the possibility of applying to the Patent Office to amend a recently granted patent, including details of the procedure to be followed. Prepare notes on the points you will discuss in your reply. (10 marks)

3. What happens if a patent application is filed for an invention which is such that publication of the invention would be prejudicial to the defence of the realm? (10 marks)

4. Who can obtain copies, from the British Patent office, of papers from the file of a pending British patent application before publication of that application?

What is the procedure for obtaining, from the British Patent Office, copies of papers from the file of a pending British patent application after the date of publication of the application?

After publication of an application under Section 16, for what reasons might the Comptroller refuse to supply copies of certain papers present in the file of an application? (10 marks)

5. What are the grounds of revocation of a patent granted under the Patents Act 1977? Is there any restriction on who can plead these grounds of revocation?

Outline the procedural steps in an application to the Comptroller for revocation of a patent under the Patents Act 1977. (10 marks)

6. Comment on the meaning, in the context of the Patents Act 1977, of the following:

- a) Ex parte proceedings
- b) Ex post facto analysis
- c) Postdating
- d) Date of filing (of an application for a patent). (10 marks)

PART B

7. What, under the terms of the Patents Act 1977 is infringement? - and what is not infringement?

Section 61 of the Act specifies various forms of relief that may be available to a patentee in proceedings for infringement - what are they?

(20 marks)

8. What is the maximum term of a European patent (UK) granted on an application that claims priority from a prior US application? When is the first renewal fee payable to the British Patent Office?

A client fails to pay a renewal fee on a European patent (UK) that was granted three or four years ago, and contacts you seeking advice on what can be done to rectify the situation. Provide comments, assuming

a) that the due date for paying the fee was three months ago, and

b) that the due date for paying the fee was nine months ago, and

c) that the due date for paying the fee was twenty-one months ago.

(20 marks)

9. A client writes:

"As you know we are a medium sized manufacturing company. We have been approached by an ex-employee who retired last year after twenty-three years' service with the company. He has sent us a copy of a patent granted to him 18 months ago, with a very rambling letter offering us a licence. The letter goes into the whole history of the making of the invention, when apparently he realised he was onto a good thing after he exhibited a prototype at an "Inventor's Fair" and several people said that although they did not understand how his machine worked, the results were most impressive.

" To cut a long story short, he had a Patent Agent get him the patent but the he fell on hard times, and although he has apparently paid the fees to keep the patent alive, he has not been able to raise the money to manufacture the machine.

"The machine would, actually, fit in quite well with the rest of our range, but the royalty mentioned in the letter is much too high to be realistic. Can we meet to discuss the matter?"

In preparation for the meeting you check the register and find that the patent is in force. A search does not reveal any relevant prior art. The patent appears to be well drafted, with claims of a good scope.

Outline the points that you would discuss with your clients. What questions would you ask, and why?

(20 marks)

10. Identify two leading cases relating to patents, and provide notes outlining the important points of the cases.

(20 marks)