

THE JOINT EXAMINATION BOARD

PAPER P1

BASIC UNITED KINGDOM PATENT LAW AND PROCEDURE

16th November, 1994

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. Explain the meaning of two of the following terms:
 - A) Groundless threats (5 marks)
 - B) Innocent Infringement (5 marks)
 - C) Delivery up (5 marks)
 - D) An Injunction (5 marks)
2. What is meant by “purposive construction” of claims? (10 marks)
3. Explain the provisions of the Patents Act 1977 concerning the corrections of errors in patents and applications. (10 marks)
4. Explain the powers that the Comptroller has to revoke a British patent on his own initiative. (10 marks)
5. What are the minimum requirements for establishing a filing date for an original British patent application? Are there any additional requirements if claiming convention priority? What further documentation needs to be filed, and within what time limits (mention any extensions available), to ensure that the application is published? (10 marks)

PART B

6. A client writes:

"I launched my 'Guardian' product in England in time for the Christmas market in 1987. Although many details were sorted out during the development programme, which lasted several months, no patent application was filed for the product because, at the time, it did not seem to be clever or inventive.

"Since the product was launched it has been quite a success, and it earns good money for my company. There is no similar product on the market at the moment, and so I can charge a high price.

"I have now received a letter from a firm of Patent Attorneys drawing my attention to the existence of a British patent granted in the name of a U.S. corporation.

"What should I do?"

You find that the British patent, which has a filing date of 10th August, 1988, was granted in August, 1991, and is in force with the 7th year fee paid in good time. The priority date claimed was 14th August, 1987. The patent has claims which clearly cover the 'Guardian' product.

Prepare notes for a meeting with the client, indicating the options you would explore, and any questions you would ask the client, indicating the reasons why the answers to those questions would be of importance.

(20 marks)

7. Comment on the patentability of four of the following:

- A) A novel and non-obvious computer read-only memory with the ability to calculate the volume of a sphere of any selected diameter. (5 marks)
- B) A novel and non-obvious vehicle licence plate with symbols to indicate the town and county where the vehicle is first registered. (5 marks)
- C) A novel and non-obvious method of making a dressmaking pattern. (5 marks)
- D) A novel and non-obvious method of purifying blood for use during open heart surgery. (5 marks)

- E) A method requiring the use of an alcohol having four carbon atoms, when a 25 year old prior art document discloses, in precisely the same method, the use of 'an alcohol having from one to ten carbon atoms' although neither the description, nor any of the specific examples, discloses a four carbon atom alcohol. (5 marks)
- F) A mechanism, when an identical mechanism has been described but not claimed in a published European patent application which designated the U.K. (5 marks)

8. Are the following statements true or false? Explain briefly.

- A) Any patent granted under the Patents Act 1949 is deemed to be endorsed 'Licences of right' for the last four years of the life of the patent. Then, if the patent covers any type of product, anyone can have a licence to manufacture or market that product. (5 marks)
- B) There is no particular penalty for filing any European patent application directly at the European Patent Office in Munich. (5 marks)
- C) If I am employed and I make an invention during working hours the rights to the invention belong to my employer. (5 marks)
- D) Even if you know that a patent is partially invalid, it is just as dangerous to infringe the valid part as it would be to infringe a fully valid patent. (5 marks)

9. A client writes:

- A) "For many years I have been marketing a switch made from components moulded from thermoplastic material, some of the components being plated with metal. I have now discovered that the switch has a much longer operative life if the components are made of a thermoset plastic (i.e. a plastic that becomes hard when heated) rather than a thermoplastic (i.e. a plastic that becomes soft when heated). No design changes are needed in the switch, but the components have to be moulded in a different way.

"Before launching the new switch I carried out my own searches and I located a European Patent which, at first sight, seems to be extremely relevant. From the enclosed copy of the patent you will see that although the main text was in French, with just the claims translated into English (and German), the United Kingdom was designated.

“The English version of the main claim specifies all the features of my new switch, right down to the use of thermoset plastic material. However, I speak French well, and it seems to me that this is a mistranslation of the French word for ‘plastic’ in the original French claim.: Indeed, all of the examples given in the specification involve the use of a thermo-plastic, and there is no reference at all to a thermoset plastic.

“Please let me have your comments.”

Your investigations at the British Patent Office show that all the necessary formalities in **connection** with the European Patent (UK) were completed at the time of grant and the main claim of the English translation as filed at the British patent Office is the same as that in the published specification of the European patent. The register shows that the European Patent (UK) is in force and is endorsed ‘Licences of Right’. Your translator confirms the error in translation observed by the client. All of the claims relate to the switch. (There are no method claims).

Write a letter, advising your client.

(20 marks)