

THE JOINT EXAMINATION BOARD

PAPER P1

BASIC UNITED KINGDOM PATENT LAW AND PROCEDURE

15th November, 1995

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.
8. NO writing whatsoever, including numbering of papers, is allowed prior to the commencement of the examination or after it has finished.

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PART A

Candidates may answer no more than four questions selected from questions 1 to 6 in PART A and no more than three questions selected from questions 7 to 10 in PART B.

1. Explain the provisions of the Patents Act 1977 concerning the amendment of a Specification, after grant, before the Comptroller. (10 marks)
2. Explain the differences between a "Licence of Right" and a "Compulsory Licence". Outline the grounds on which such licences may be obtained. (10 marks)
3. An invention must have certain characteristics to be patentable under the Patents Act 1977. What are they?
The Patents Act 1977 specifies several things that are not patentable inventions under the Act. What are they? (10 marks)
4. What are the grounds for revocation of a patent granted under the Patents Act 1977? Who can apply for revocation, and to which forum? (10 marks)
5. What do the following terms appearing in the Patents Act 1977 mean:
 - employee;
 - exclusive licencee;
 - patented product; and
 - published.(10 marks)
6. What does the term "priority date" mean? Can there be any disadvantage in publishing information regarding an invention after the priority date of a patent application relating to that invention? (10 marks)

PART B

7. A client sends to you an assignment document, identifying a USA corporation as the assignee and your client as the assignor. It is signed by the President of the USA corporation, dated only a few days ago. It does not carry any seal or other marking. The assignment relates to a British patent.

Your client mentions that the USA corporation has changed its name in recent months. A register inspection at the British Patent Office shows that the patent stands in the old name of the USA corporation. The sixth year renewal fee was due for payment on 27th May, 1995, but there is no confirmation in the register that it has been paid.

You decide to telephone the client to discuss the matter. What points would you raise with the client?

(20 marks)

8. A client telephones to make an appointment for an urgent meeting. You gather from the conversation that he has received a letter from a competitor threatening to sue him for infringement of a patent that relates to a process for making stained glass.

Your client commented:

“I do not make stained glass. I import chemicals from Poland. I do supply some of the chemicals to manufacturers of stained glass - but I do not make stained glass myself.”

Before the client arrives you ascertain that the patent mentioned by your client does stand in the name of the competitor and is in force, and all the claims relate to a method of making stained glass.

What points are you going to discuss with your client?

(20 marks)

9. A Japanese associate writes explaining that he filed an application in Japan under the Patent Co-operation Treaty, in the Japanese language, claiming priority from a Japanese patent application of 18th June 1993. The International application designates the United Kingdom (GB) and has completed International Preliminary Examination with a favourable report, to which amended claims were annexed. Your associate asks what documents must be filed, and what fees must be paid, and when, and what extensions of time are available, to enter the National Phase of the International application at the United Kingdom Patent Office.

Prepare a reply to the associate. (It is not necessary to give the amount of the fees, but identify by name each fee payable).

(20 marks)

10. You receive a letter from the Company Secretary of a new client company which reads as follows:

Dear Sirs,

Re British Patent No. 2.....
Truevox loudspeaker

I took over as Company Secretary three months ago following the death of my predecessor following a long illness.

In the last week a problem has arisen in connection with one of our patents which relates to our Truevox product - an important item in our range of loudspeakers.

I have received a memo from our Marketing Manager saying that in recent months one of our competitors has been selling a very similar loudspeaker. I enclose a copy of the patent specification and a copy of a technical leaflet giving details of our competitor's product.

Please let me know what further information you require.

Yours faithfully,

Company Secretary.

A register inspection at the Patent Office shows that the patent has lapsed due to non-payment of the renewal fee that should have been paid in March 1995.

The published patent specification contains a clear main claim to a loudspeaker reciting three technical features, and the leaflet describing the competitor's loudspeaker also refers to the same three technical features.

Prepare a set of questions that you would like to put to the Company Secretary before you advise in full, and indicate how the answers to the questions might shape your final advice.

(20 marks)