

THE JOINT EXAMINATION BOARD

PAPER P1

BASIC UNITED KINGDOM PATENT LAW AND PROCEDURE

11th November, 1997

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.
9. Please put your answers in QUESTION NUMBER ORDER before placing in the envelope provided.

6 PAGES INCLUDING THIS PAGE

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StudentBounty.com

PART A

1. A new recruit in your office is finding it hard to understand some of the terms he has found in the files, and asks you to explain the meaning of:

- a) Secrecy order
 - b) prior secret use
 - c) Priority date
 - e) post dating
- (10 marks)

2. What are the powers of the Comptroller of the Patent Office in hearing disputes regarding patent infringement, and what additional powers does the Court have ?
(10 marks)

3. About 12 weeks ago you filed a British patent application on instructions received from a U.S. client, which claimed priority from a prior USA application.

The search report has just been issued by the Patent Office. The search has been conducted with reference to the subject matter of claims 1 to 4, and has found no relevant prior art. However, the search report indicates that claims 5 to 11 relate to a different invention. On comparing claim 1 and claim 5 you observe that they are of very different scope and relate to totally different features of the device described in the application. Claims 2 to 4 are dependant upon claim 1, and claims 6 to 11 are dependant upon claim 5.

Write paragraphs to be included in a letter to the U.S. client explaining the options open to the applicant, indicating the time limits involved.
(10 Marks)

- 4.
- (a) Summarise the circumstances in which a claim of a British patent application may be anticipated by a document, which discloses the subject matter of the claim and which was not published before the application was filed.
 - (b) Summarise the circumstances in which a claim of a British patent application is not anticipated by a document, which discloses the subject matter of the claim and which was published before the application was filed.

Ignore Secret cases in your answer
(10 marks)

5. Some years ago you acted for Mr. Smith and Mr. Jones, next-door-neighbours who had jointly invented a novel but relatively simple planter to hold garden plants. You obtained a patent with Mr. Smith and Mr. Jones as joint patentees. Mr. Smith has provided regular instructions to pay the renewal fees, and the patent is in force.

Mr. Smith attends a meeting with you and explains that since the patent was granted no real progress has been made commercially. Also Mr. Jones has moved away, and Mr. Smith does not know his current address. There is, says Mr. Smith, no formal agreement between him and Mr. Jones.

Mr. Smith explains that he recently been made redundant from the job that he has had for the past twenty five years as a long distance lorry driver. He has been visiting local garden centres and is now confident that there is market for the product. He is now proposing to make some of the planters to see if he can sell them. If the project goes well he may set up a limited company to make the planters.

Mr. Smith is seeking an assurance that if he does start making the planters, no problems will arise, and if a competitor appears with a product that is infringing the patent, he will be able to take action to enforce the patent or grant a licence to be able to collect a royalty.

Advise Mr. Smith in note form.
(10 marks)

6. A client writes:

Thank you for your letter reminding me that the fifth year renewal fee is due for payment on my British patent in mid-December this year.

I am at present in prison on remand. A date has been set for my trial in February next year, and I am confident that I will be found innocent and released at that time. I have no income at this time, and no savings.

I see that quite a lot money is involved in paying the fee. Is there any way of postponing payment of the fee, or reducing the level of fees that must be paid.

Please let me know what is involved, and outline any disadvantages, especially if I will be doing something that is irrevocable.

Write a letter to your client.
(10 marks)

PART B

7.

a) What acts constitute infringement of a patent?

b) What acts, even if they involve all of the features of the claims of a patent, and are carried out without the consent of the patentee, do not constitute infringement?

c) A recently published patent application, filed in the name of a German company, refers to method of making a paint in which a particular chemical is used as a principal ingredient. The search report of the patent application identifies only a twenty five year old USA specification which shows the chemical being used as an ingredient in a skin-lotion. Your clients, a British chemical company, have been asked to enter a contract to supply the chemical (which is not a chemical in their usual range of products) to a the research department of a University in East Anglia who are conducting a long term research project research into paints.

What factors would you consider when advising your client.?
(20 marks)

8. Write notes on two leading patent cases, identifying them and explaining the precedent(s) that the cases set.
(20 marks)

9. Your client, who used the services of a technical consultant to solve a particular problem, filed a patent application in its own name without the services of a patent agent, by writing a letter to the Patent Office just over six months ago which described the invention made in conjunction with the consultant, and paying the filing fee. Duplicate copies of the letter were filed.

The consultant has sent an executed assignment transferring all the rights in the invention to your client.

Your client visits you, bringing all the relevant papers, and wants to know what documents need to be filed at the Patent Office, and in how many copies, and whether each document attracts a fee payable to the Patent Office. Your client also wants to know when each document must be filed, and any extensions of time that are available. At this time your client is not interested in procedures following publication of the application.

Write notes outlining what the client can do at this stage providing the information that the client specifically requires.
(20 marks)

10. Your clients write:

For many years we have made various audible warning devices, especially those that are used when large vehicles are reversing. They all include an oscillator, an amplifier and a loudspeaker.

For several years we employed Mr. Bright as a designer. He was especially good at designing housings to be moulded from plastics material, and actually designed all of the housings used in our current range of products. Mr. Bright left our employment at the end of October last year, and now runs his own business importing and selling loudspeakers.

Mr. Bright has now written to us indicating that he filed a British patent application in November last year. The application has been given 'accelerated processing' and Mr. Bright says that he believes that the patent will actually be granted by mid January next year since the patent office did not cite any prior art, and have not raised any objections to the application.

The patent relates to an ultrasonic rodent deterrent, which consists of a special high frequency oscillator, an amplifier and a loudspeaker. Mr. Bright was always saying that rodents could be deterred using high frequency sound.

Mr. Bright is offering us an exclusive licence under the patent, indicating that he does not want a royalty, but he does want us to undertake that we will buy all of our loudspeakers from him in the future.

The rodent deterrent would fit into our range of products.

Is there anything that we can do to destroy the patent or have the rights to the patent in our name ?

What points will you raise, and what questions will you ask, when replying to your client?

(20 marks)