

THE JOINT EXAMINATION BOARD

PAPER P1

**BASIC UNITED KINGDOM PATENT LAW
AND PROCEEDURE**

17th November 1998

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 envelope provided.

THIS PAPER COMPRISES 4 PAGES (INCLUDING THIS FRONT SHEET)

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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. What is a patentable invention as defined in the Patents Act 1977 - and what subject matter is excluded from patentability.
(10 marks)
2. What are the grounds of revocation of a patent as specified in the Patents Act 1977? Is there any restriction on who can plead these grounds, and is there any time limit involved? Where can an application for revocation be made?
(10 marks)
3. What is a priority date, and why is it important? Can a patent application have more than one priority date? Can a claim have more than one priority date?
(10 marks)
4. In what circumstances can an error be corrected under the Patents Act 1977? Outline the procedure for the correction of an error.
(10 marks)
5.
 - a) Who may make an application for a patent?
 - b) To whom may a patent be granted?
 - c) Who may apply to the Comptroller, and when, for an entry to be made in the register that licences are available as of right?
 - d) Who may apply to the comptroller, and when, for cancellation of an entry in the register that licences are available as of right?
(10 marks)
6. Explain the meaning of the following terms;
 - a) a person skilled in the art,
 - b) exclusive licence,
 - c) published,
 - d) prior art, and
 - e) Abstract
(10 marks)

PART B

7. Are the following statements true or false? Provide explanatory comments.
- a) “I have only told a few of my closest friends about my invention, so I can still file a Patent application.”
 - b) “I know that the claims of the Patent relates to a machine that incorporates a specific motor together with other elements. I only import the motor from Taiwan and supply it to the factory of X Ltd. in Wolverhampton, where all the machines supplied the British market are made. It is X Ltd. that actually makes the machine, so I have nothing to worry about.”
 - c) “The marking ‘Patent Pending’ on this product does not mean anything. I can make a product that works in exactly the same way as this one, and because I did not know the Patent number before I started no-one can ever stop me.”
 - d) “If the government put a secrecy order on my patent application, then they must pay me compensation.”

(20 marks)

8. Provide the following information regarding each of two leading cases relating to British Patents:
- a) the identity of the case (e.g. the names of the parties to the case)
 - b) a summary of the facts
 - c) an outline of the decision, and
 - d) comments on the precedents set by the case.

(20 marks)

9. A new client attends a meeting at your office, and brings with him a copy of a Patents Form 7/77 (Statement of Inventorship and of right to grant of a Patent) that he has received from the Patent Office. The form relates to a Patent Application filed recently by the client’s employer, and names him as inventor. The form indicates that the applicant derives the right to the invention ‘by virtue of Section 39 of the Patents Act 1977’.

The client explains that the specification is closely based on a ‘suggestion’ that he put in the ‘suggestions box’ at his place of work some months ago.

The client has brought a copy of his contract of employment with him, and this document has a clause reading:

“INVENTIONS: The ownership of inventions made by employees will belong to the employer in accordance with the provisions of Section 39 of the Patents Act 1977.”

The client requests general advice as to what he can, should or might do, but in particular wants to know if he can get any money out of his employer, as his salary is very low.

Do you need to ask the client any questions before you can advise? If so, what are the questions, and how do you think that the answers will shape your advice? What points will you cover in your advice ?

(20 marks)

10. What documents must be filed at the British Patent Office, and when, to enter the National Phase of an International Application filed under the terms of the Patent Co-operation Treaty in Japan by a Japanese company naming an employee as the inventor, and claiming priority from a Japanese application that had been filed 11 months previously, and which has undergone International Preliminary Examination? Provide details of any extensions of time that may be available.

The Patent Department of a Japanese company sends instructions to enter the National Phase of an International Application as outlined above forwarding copies of all documents filed at and issued by the Receiving Office, and the instructions arrive a few days before the deadline. Your associate says that the original Japanese application was filed on 24th May 1996 and the priority document was filed with the Receiving Office on 10th November 1997.

Prepare notes on the options available that should be brought to the attention of the Japanese company, mentioning the advantages and disadvantages of each option.

(20 marks)