

THE JOINT EXAMINATION BOARD

PAPER P1

BASIC UNITED KINGDOM PATENT LAW AND PROCEDURE

16th November 1999

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, reasons should be given for the conclusions reached.
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 number 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.

This paper consists of five pages including this page.

PART A

1. What are the grounds of Revocation of a British patent ?

Who may file an application for revocation and where can the application be filed ?

What are the time limits associated with the filing of an Application for revocation ?

(10 Marks)

2. When are renewal fees payable in connection with a British patent ?

Outline the options and procedure to be adopted if the Patentee realises that a fee has not been paid :

- (a) three months after the due date ?
- (b) thirteen months after the due date ?

(10 Marks)

3. A client writes :

I am finding it difficult to afford the renewal fees on my British Patent, which are now getting very expensive. Is there any way of paying a lower fee ? I have not yet started production of the machine described in the Patent, but I hope that I may be able to in the next two or three years - and then the Patent may be very useful.

What advice do you give the client ? Mention any possible disadvantage of any course of action that you propose.

(10 Marks)

4. What acts constitute infringement of a British Patent ?

What acts are exempted from constituting infringement of a British Patent ?

(10 Marks)

5. Explain what is meant by each of the following terms in relation to the Patents Act 1977 :

- a) employee
- b) exclusive licence
- c) inventor
- d) International Exhibition
- e) published

(10 Marks)

6. For an invention to be patentable the invention must be novel.

- a) what does novel mean ?
- b) under what circumstances can a valid patent be granted for an invention which was prior disclosed to the public in a printed publication before the filing date of the patent application ?

(10 Marks)

PART B

7. You are a Patent Attorney in private practice in Central London. It is 4 p.m. on a Friday and you receive a facsimile letter from a client stating that he has just completed a press conference concerning a project which is of crucial importance to his company. The project is a new chemical for enhancing the flavour of fish and chips and your client wants to know if he can still obtain some protection for his company's invention.

The facsimile letter contains a copy of the press release which was handed out at the press conference and explains that this is all the information your client has, but it also represents everything which was disclosed at the press conference.

The press release identifies previous attempts to enhance the flavour of fish and chips but provides no technical background about these attempts. The press release does explain the theory behind the new flavour enhancing technology and provides a detailed example of how it is done.

Draft a letter of advice outlining what steps you have taken to secure protection for your client and what further action is required to complete the application in the UK.

(20 Marks)

8. The case of *Windsurfing v. Tabur Marine* raises interesting points concerning prior disclosure and lack of inventive step. Explain the points and precedents set by the case.

(20 Marks)

9. A client comes to see you with a clip made of plastic that is dimensioned to be snapped onto the body of a ball-point pen to enable the pen to be clipped into a pocket with the ball uppermost. The client explains that many people lose the caps of their ball point pens and a clip of this type may be of great value. A search reveals a British Patent which is in force and which has a claim directed to a retractable ball-point pen provided with a clip which is integral with a ball point pen, so that the pen may be clipped into a pocket with the ball uppermost. The Patent claims priority from a US Patent application filed just over ten years ago in the name of Texas corporation.

The client is very surprised at the search result as he has never seen anything like his invention on sale, even though he has visited a large number of stationary shops when researching his own plastic element.

What factors do you take into account when advising your client as to his freedom to sell the clip ?

(20 Marks)

10. Comment on the following statements :

- a) do not rush to record an assignment at the Patent Office, you can always deal with that formality just before you sue a competitor;
- b) if two people own a patent jointly, they can each behave as if they are the sole proprietor;
- c) if an employee makes an invention he should never look to his employer for extra compensation - he was paid to invent and should expect no more reward than his salary;
- d) if a European patent application is filed in the German language and an English translation is subsequently filed at the British Patent Office after the patent has been granted to bring the European Patent into effect in the United Kingdom, and if that translation is incorrect and the claims in the English translation are narrower than the claims in the German text, there is nothing that the Patentee can do to put things right;
- e) if I make a mistake in a patent application, for example using 'g' when I should have used 'kg', it is always easy to correct it, even after the patent has been granted;
- f) provided that an invention does not relate to anything 'secret' I can file a patent application naming a British company as applicant directly at the European Patent Office in Munich if I wish.

(20 Marks)