

THE JOINT EXAMINATION BOARD**PAPER P2****PATENT AGENTS' PRACTICE****9 November 1999****10.00 a.m. - 02.00 p.m**

Please read the following instructions carefully. Time Allowed-four hours

1. You should attempt ALL questions from Part A and two (2) questions from Part B. There are 9 questions altogether, 6 in Part A and 3 in Part B.
2. The marks attributed to each question in Part A is shown and each question in Part B carries 25 marks. Questions answered in excess of two in Part B will not be marked.
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. u 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. **At the end of the examination please double check that you have fully complied with instruction 4 and assemble your answer sheets in question number order to hand in.**

This paper consists of **six** pages including this page.

PART A - Questions 1 to 6 (Answer all Questions)

1. Can the following situations be remedied? If so, what would you do and why, noting any condition which might be applied:
 - a. The 5th renewal fee and late payment for a patent were paid near the end of the late payment period, but a wrong (non-existent) patent number was quoted in the form 12/77; subsequently you are notified by the Patent Office that the patent has lapsed.
(4 Marks)
 - b. Your computer based record system has crashed, with the result that two UK substantive examination requests due last week were overlooked.
(2 Marks)
 - c. You file two patent applications for the same applicant on the same day, neither of which claim priority, one is a PCT entitled "COMPOUND", the other a UK application entitled "FENCE POST". Owing to a clerical mistake, the specifications were interchanged, with the FENCE POST specification being filed with the PCT application and the COMPOUND specification with the UK application. You realise the mistake nine weeks later when the International Bureau asked that the title on the PCT specification be brought into conformity with that on the PCT application form.
(4 Marks)
2. Mendip Caverns Limited has recently opened to the public a group of caves near Wells where pre historic men lived.

The Chief Executive, Mr Devons, of Mendip Caverns writes:

"We are planning a gift shop which will sell reproductions of a stone-age decorated urn, fragments of which was found in the caves. The shape of the urn was regenerated from the fragments using a standard computer model technique by Dr Western of Wells University. The decorated painted surface of the original fragments was entirely lost, but Dr Western has produced a surface decoration for the urn to indicate how it might have looked.

We plan to get a commercial ceramics manufacturer to make a batch of 200 of the decorated urns to be put on sale on a date to coincide with the first publication in the scientific press of Dr Western's work on the cave fragments.

Interest in the reproduction urn is certain to be great both in the UK and abroad - especially in the US and Japan. We want to protect our rights against illegal reproduction."

Write a memorandum forming the basis of your advice to your client.

(10 Marks)
3. A PCT application was filed on 1 November 1999 claiming priority from a UK application filed on 3 November 1998. All fees have been correctly paid. An error in a chemical formula has been noticed in Claim 1. What options are available to correct this in the international phase of the PCT application.
(5 Marks)

4. A recently granted UK Patent 3,400,000 was filed on 28 February 1997 claiming priority from a US Patent Application 444444 filed 24 June 1996. A new material M was mentioned in the US application 444444. Comment on the validity in UK Patent 3,400,000 of claims to the new material M and a process P for making the material M in the light of:
- A European Patent Application EP1A published on 3 May 1996 mentioning M.
(2 Marks)
 - A European Patent Application EP2A published on 31 November 1996 mentioning M. EP2A was filed on 31 March 1995 and has no priority claim.
(3 Marks)
 - A PCT Application US/PCT3A, filed on 30 May 1997 and published on 30 November 1997, describing M and process P. US/PCT3A claims priority from a US application 222222 filed on 30 May 1996 which contained the description of M and P; US application 222222 is a continuation in part of an earlier US application which has now proceeded to issue as a granted patent.
(4 Marks)
 - The publication in a conference on 25 June 1996 of the information in US Patent Application 444444.
(2 Marks)
5. A client originally decided to allow a UK patent to lapse by not paying the renewal fee due on 1 May 1999; but changed his mind later. On Friday 29 October 1999 the client sent by a courier company a package containing a correctly completed form 12/77 and a cheque correctly made out for the renewal fee and late fee payment. The handwritten package and instructions to the courier company stated delivery was to the Patent Office, Newport Road, Cardiff. The package was delivered on 29 October 1999 by the Courier Company to the Patient Record Office, City Hospital, Newport Road, Cardiff. The hospital realised the mistake and forwarded the package to the Patent Office in Cardiff Road, Newport by 1st class post on 1 November 1999 arriving the following day.
- The Patent Office has telephoned informally the client drawing attention to the situation. The client seeks your advice.
- Write a letter to the client setting out his position and what action may be open to him. Note separately any points which led you to any particular conclusion.
(7 Marks)
6. Your client complains that potential purchasers of his product are being dissuaded from buying because his main competitor is widely advertising his product "UK patent pending" and is backing this up by making it clear, verbally, to potential customers that he has a policy of enforcing its rights. Your client says that he has checked the **internet** which shows one UK patent application in the name of the competitor, which lapsed two years ago.

Write a letter of advice to your client

(7 Marks)

PART B - Questions 7 to 9 (Answer 2 Questions)

7. Your German client Electrox GmbH has a UK Patent 2,888,888 granted 5 years ago with two claims:

1. A general semiconductor device doped with a Group V or Group VI element.
2. A method of doping semiconductor device X with a Group V or Group VI element comprising the steps A, B, C.

Your client also has a parallel European Patent EP 1,234,567B designating GB and filed on the same day with the same priority, and which has been the subject of opposition proceedings. The claims of the European Patent at grant were identical to the UK patent. This patent is being handled by another attorney.

The Opposition Division ordered revocation of EP 1,234,567B on the grounds that claim 1 lacked novelty in view of Document D. Document D describes a method comprising steps A and C to dope a semi-conductor device with a Group V element. Your client states that his three stage manufacturing process, including step B, ensures much greater consistency of doping levels which are vital to enable device X to work.

An Appeal Board in the European Patent Office has just ordered the Opposition Division to maintain European Patent EP 1,234,567B on the basis of the first subsidiary request presented at the appeal hearing. The subsidiary request contains one claim:

1. A semiconductor device X doped with a Group VI element.

At the time of the Appeal Board, your client had apparently instructed the attorney handling the case to secure this claim, at all costs, as this product was the subject of a licence deal.

The finding of the Opposition Division regarding the original claim 1 was upheld.

Your client has just discovered and wishes to take immediate action to stop a third party company manufacturing in Hong Kong and selling into the UK, device X doped with a Group V element.

Write a memorandum setting out the options to form the basis of a meeting with your client.

(25 Marks)

8. Dr Skill writes:

"I used to work as a full time consultant for Bigger and Bigger but that arrangement ceased some two years ago. About six months before I left, I made an invention relating to metal coatings processes. Unfortunately, my consultancy agreement with Bigger and Bigger said nothing about inventions, but Bigger and Bigger said that if I filed a patent application it would be a breach of the confidentiality agreement between the firm and myself. Eventually Bigger and Bigger said that they would apply for a patent, and they would allow me to participate in the firm's "Bounty for Innovation." scheme. The scheme provides bonuses of up to £500 to staff who contribute to the firm's business success through innovative ideas.

"I was told by the firm in early 1998 that a UK patent application 97.23456 had been filed on 1 November 1997, but as there were alternative, better ways to improve the process concerned, the company would allow the application to lapse.

"I was surprised, therefore, to see the attached article in the technical press recently. The improved metal coating process seems identical to mine. I feel that I have been cheated by Bigger and Bigger: I have no wish to prevent Bigger and Bigger or their licensees using my invention but I do want appropriate compensation. Can you let me know what I should do?"

TECHNICAL ARTICLE

Bigger and Better than Ever

Bigger and Bigger announced the signing of their second licence for their improved metal coating process. The new licensee US Maxismelt Corporation say they are delighted with the new process, which in trials showed a 50% energy saving compared with the previous process. US Maxismelt is the world's biggest metal plating company. Bigger and Bigger state that the improved process, invented by the firm's technical director, is the subject of UK Patent Application 98.00001 dated 3 January 1998 and that recently a worldwide patent has been sought.

Write a letter replying to Dr Skill: provide a separate note of any point relevant to your conclusions not covered by the letter.

(25 Marks)

9. Kansas Crops Inc, US agricultural suppliers have applied for a European patent for a new process to manufacture tomato paste. The application EP9A, was filed on 10 November 1997. The search report, which was published with the application 13 May 1999, had no citation. The patent application stated that the new process reduced the heating required preserving more vitamin C and produced a better tasting product.

The application describes the process in full detail, gives several commercial uses of tomato paste and contains a single claim to the process.

Kansas Crops (K) has granted an exclusive licence in Europe for the process to Saucy Tomato plc (S), a well known UK food processing company. The licence provides to S an exclusive licence to make in the European Union, and to import from K and exclusively distribute and sell in the European Union, tomato paste in accordance with European patent EP9A.

The Chief Executive of Saucy Tomato plc (S), now writes:

“You are aware of our exclusive licence with K. In practice, it has been more economical to import the new tomato paste in bulk from K and to re-package it here, than to manufacture it in the UK. We have recently seen tomato paste, frozen uncooked cheese and tomato pizzas and tinned spaghetti in a “new zingy” tomato sauce distributed by Francofoods SA of Nantes, France. The taste of the paste is identical to the K product, and we suspect that the pizzas and the spaghetti sauce are made from the same paste too. Some paste packages are marked “Made in France”, others “Made in USA”, all the pizzas are marked “Made in France.”

Our commercial manager tells me that Francofoods has been getting bulk supplies of the new tomato paste from Orient Foods of Korea who have a similar exclusive licence agreement to ours with Kansas but covering South East Asia. The pizzas and spaghetti appear to be made in Nantes using the bulk paste from Orient.

This blatant infringement of our exclusive rights has reduced our profits by 50%, as we have had to reduce prices to match the Francofoods price. K appears to be doing nothing to stop Orient re-selling the bulk product to Francofoods. Please advise me.”

Write a letter to the Chief Executive of Saucy Tomato. Make a note to the examiner of any relevant points which might not be apparent from your letter.

(25 Marks)