

THE JOINT EXAMINATION BOARD**PAPER P1****BASIC UNITED KINGDOM PATENT LAW AND PROCEDURE****21st November, 2000****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 to be 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 examiner's 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.

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PAPER P1
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21st November, 2000

PART A

1. What must be filed at the patent office to establish a filing date for a British patent application?

Assuming that the application does not claim priority, is not derived from an earlier application, and is filed in the name of the inventor what further documents must be filed and within what time limits for the application to reach a stage at which it is published by the patent office?

Mention any extensions of time that may be available.

(10 marks)

2. What are the provisions for making an amendment and correcting an error in the specification of a pending patent application?

Outline advantages and disadvantages (if any) of making an amendment compared to correcting an error.

(10 marks)

3. A client writes:

‘I am finding it difficult to find the money to pay renewal fees on my British patents. I have heard that it is possible to reduce the level of renewal fees. Please can you explain how this is done.’

Write a brief letter to the client, mentioning any disadvantages of any course of action that you describe.

(10 marks)

4. Discuss the patentability of:

- i) a trigger unit for detonating a landmine;
- ii) a sensor for sensing atmospheric ozone developed as part of a PhD research project and exhibited at a University ‘Open Day’ attended by prospective students;
- iii) a computer programme which controls a multicolour press to ensure colour alignment;
- iv) a method of applying oil paint to canvas to create an oil painting.

(10 marks)

5. Explain the meaning of each of the following terms as you would to a new client.

- i) priority document
- ii) divisional application
- iii) third party observations
- iv) person skilled in the art
- v) secret application.

(10 marks)

PART B

6. What are the grounds of revocation of a British patent?

Where can an application for revocation of a British patent be made?

Who may file an application for revocation?

Is there any time limit that relates to the filing of an application for revocation?

What is the procedure that is followed where an application for revocation is filed with the Comptroller?

Mention any extensions of time that might be available.

(20 marks)

7. How does the Patents Act 1977 define 'an invention...for which an application has been made or for which a patent has been granted' ?

What is Article 69 of the European Patent Convention and what is the Protocol on Interpretation of Article 69 of the European Patent Convention, and how is it introduced into the Patents Act 1977?

Outline relevant precedents set by case law in the area of interpretation of claims.

(20 marks)

8. You receive a fax from your Japanese associate:

Tokyo
20th November 2000

Re International Application PCT/JP00/00099
Tamada International Plastics Corp

A British department store has just started selling goods that are imported from Taiwan which are identical to the example of the invention described in our client's PCT application (mentioned above). The goods are clearly within the scope of all of the claims as published. Our client wants to stop these activities as soon as possible and wants compensation for loss of profits from the United Kingdom market. We are also concerned that other companies may start manufacturing or importing these goods soon.

The PCT application was filed, in Japanese, at the Japanese Patent Office on 7th January 2000 claiming a priority date of 8th January 1999 and designating all available states. The application was published in Japanese, with the search report, on 19th July 2000. A demand under Chapter II PCT was filed on 10th August 2000.

No relevant prior art was cited and no amendments have been made to the application during international preliminary examination. A Written Opinion has issued which is totally favourable.

--ooOoo--

The associate sends copies of the application as filed, a translation into English, and a copy of the Written Opinion.

Assume the facts above are correct and prepare notes for a letter to your associate recommending a course of action to meet the client's objectives.

Mention any deadlines that exist and mention any risks that might be associated with any of the steps that you propose to take.

(20 marks)

9. A new client sends documents relating to a British patent application which reach you on the morning of 21st November 2000 including the initially filed application and all subsequent items up to the publication of the application by the patent office on 19th April 2000. No further papers are enclosed.

The client has explained that the case had been handled for him by a friend, a retired patent attorney who died some weeks ago following a few months of illness. The client is coming to meet you on 22nd November.

The application was filed on 11th October 1999 claiming priority from an earlier British patent application, which was filed with the identical specification and drawings on 16th October 1998.

The specification has three independent claims, each with their own dependent claims. Three searches were done and three documents were cited, one against each of the three independent claims. You conclude that the teaching of each document is so relevant that, in each case, it teaches the subject matter of the independent claim and all of the relevant dependant claims.

The first cited document is a US patent specification published on 9th September 1999 in connection with an application filed in the US Patent and Trademark Office on 6th April 1998 which claims priority from a British Application of 15th September 1997.

The second cited document is the specification of a PCT application filed in the USA on 18th May 1998 claiming a priority date of 20th May 1997 which designated only the states of Australia, Canada, Germany and United Kingdom. The specification was published on 24th November 1999. No Demand was filed under Chapter II PCT and there is no trace of the applicant having entered the National phase of the International application. The case appears to have been totally abandoned following issuance of the search report.

The third document is a report in a magazine dated 28th October 1998 of a lecture that had been given the previous month at a Congress held in Peru.

Write notes relating to the matters you will discuss during your meeting with the client.

(20 marks)