

THE JOINT EXAMINATION BOARD

PAPER P2

PATENT AGENTS' PRACTICE

14th November, 2000

10.00 a.m. - 2.00 p.m.

StudentBounty.com

*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. 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. **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

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**14<sup>th</sup> November, 2000  
10.00 a.m. 2.00 p.m.**

**PART A (Answer all Questions)**

1. Your client Dr A writes:

“Thank you for the copy of the International Preliminary Examination report on my PCT application. As you know I have negotiated, but not signed, a deal under which the application will be licensed for a staged down-payment and a royalty. The first stage payment is due on 1 February 2001, and until that arrives I cannot afford any substantial out goings. I do not want to lose any patent cover as this will dilute my potential royalty income. Can you suggest how I should proceed in the next three months?”

The PCT application was filed on 17 April 1999 claiming priority from an earlier UK application filed on 25 May 1998 (which has lapsed). US, GB and Europe were designated in the PCT application.

*Write a memorandum explaining the options on which you will base your advice to the client.* (10 Marks)

2. Recently your UK client saw, in Peru, a novel kite: the shape ensured that it had much greater lift than conventional kites. The client felt that the novel shape might in time be further developed. The client spoke to the Peruvian maker of the kite who was a private individual not interested in marketing the kite.

Your client believes there to be a substantial market for the kite and is planning to invest to make decorated kites incorporating the novel shape for the UK market. The client now asks you to confirm that an unregistered design right in the kite will protect his investment.

*Explain the basis on which you might formulate your response to the client.* (10 Marks)

3. You are acting for a patentee in a revocation action in the Patent Office. The patentee writes to you:

“We have discussed the revocation case. In view of the statement of case put forward by the applicants for revocation it appears that the applicant’s case is well founded. I am concerned that a public record of a revocation decision will damage my commercial position in other countries. I have, therefore, decided to surrender my UK patent to avoid a formal revocation decision and to prevent the plaintiffs statements of case going onto the public record. Please take the necessary action.”

*Can your client’s wishes be met? Explain your answer.* (6 Marks)

4. ***Comment on the permissibility of the following possible amendments:***

- a. in a UK patent application, after publication, to acknowledge prior art;
  - b. in a claim of a UK patent application to broaden a claim prior to grant;
  - c. in a UK patent application, changing in claim 1 “sterilized” to “rendering substantially free of bacteria”;
  - d. to reinstate to a claim of a recently granted patent, a feature deleted from the claim during prosecution.
- (9 Marks)

5. A new client, a small start-up company, writes:

“We have invented a new screening test for virus X. We are seeking funds to develop and market the invention. A venture capital company is showing considerable interest but has drawn our attention to UK Patent 3500000 which relates to virus screening. The only example in the Patent describes the screening for the presence of virus Y. The venture capital company has asked whether we infringe Patent 3500000. In discussion, the venture capital company has indicated that it needs to be fully satisfied about our patent position before it will release the money we need. How do you advise us to proceed?”

***Set out and explain the possible courses of action the client might take. Note any preliminary issues needing clarification.*** (10 Marks)

6. You are the authorised representative in a PCT application originating in the UK. The application contains two different species of the invention. Claim 1 is a generic claim, Claim 2 which depends on Claim 1 relates to species A, Claim 3 also depending on Claim 1 only relates to species B.

The International Search Authority (ISA) has now written saying that a partial search has been carried out on the basis of the invention of Claims 1 and 2. In the light of the search, Claim 1 appears not to be novel and, therefore, the invention of Claims 2 and 3 are not so linked as to be regarded as a single inventive concept. The applicant is invited to pay an additional search fee within 15 days, in respect of Claim 3.

***Set out the options available to your client.*** (5 Marks)

**PART B (Answer 2 Questions)**

7. You receive today the following fax from the Company Secretary of a marine propeller manufacturer, whose main market is Europe:

“I enclose details of our UK application 0077777.5 (filed 29 November 2000) in view of the impending publication of the invention, we have decided to proceed without consulting you.

The inventor is very keen to promote the excellence of the company's performance. In June, unbeknown to us, he submitted a paper containing details of his new mathematical theory underlying his new fuel efficient propeller design to the International Institute of Boat Building Engineers, for presentation at their November conference in Los Angeles USA. Late in the day, our inventor asked his line manager if he could go to Los Angeles to make the formal presentation of his paper on 29 November 2000. The line manager felt he had no option other than to give permission.

A preliminary information sheet was posted from the US to prospective conference attendees on 7 November 2000. As far as I can tell the preliminary notice was not received in the UK until 10 November 2000. The preliminary information stated that “The mathematical theory underlying a fuel efficient new 5 bladed propeller design will be presented. A non dimensional constant R relating various blade parameters is derived. R is shown to be  $>6$ ”. Presumably, as the information sheet did not reach the UK until after our application was filed, none of this causes us a problem.”

The bulk of the specification of application 0077777.5 comprises the mathematical theory as submitted to the conference. In the specification, there is one specific calculation in which R is 8. The application contains no claims but contains the following additional statements (only):

“This invention relates to the theory of marine propellers having at least 5 blades to provide improved efficiency. Five bladed propellers have been proposed previously, this theory shows how to maximise efficiency.

For a five bladed propeller, R is preferably between 6 and 10. The theory indicates that 5 blades is the minimum necessary to achieve fuel savings. More blades are possible, but not less.”

***Draft a letter of advice to your client, commenting on the present position and steps which might be taken to improve the situation.***

(25 Marks)

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8. Your client X has a licence under European Patent 0888888 (filed 25 September 1985). The patent was granted on 10 November 1988 with a single claim and entered the national phase

in UK, France and Germany. The Spanish designation has lapsed without a Spanish translation. No equivalent patents exist in any other part of the world. The licence was signed solely by the Company Secretary of the licensor and is otherwise relevant to the problem:

- i. X is licensed exclusively under EP Patent 0888888 for the manufacture and sale in any part of the world devices defined in Claim 1 of the patent;
- ii. in connection with the licence, X has been provided with a data pack which is acknowledged, to enable the licensed devices to be manufactured;
- iii. in consideration of the licence and the data pack X will pay the licensor a royalty of 10% of the ex works selling price of the device;
- iv. in consideration of the licence and the data pack royalties shall be paid until such time as the licensed device ceases to be manufactured;
- v. X will purchase certain designated materials to manufacture the device from the licensor;
- vi. the licence shall be for 25 years or the time the device is made by X (if longer);
- vii. the annual minimum royalty payable under Clause iii. is £ 100K.
- viii. X shall not challenge the validity of Patent 0888888.

Your client notes that the data pack provided under the licence (Clause ii) was identical to the drawings and descriptions in the patent specification.

Your client is now being driven out of large parts of the European market by a competitor who is making, in Spain, a device falling within the scope of the claim of the licensed patent and selling it throughout the European market (including the UK). Your client states that he has written to the competitor but received a reply saying that Patent 0888888 was invalid because of a Document D. Furthermore the competitor argued that as the Spanish designation was abandoned, manufacture in Spain is with the consent of the patentee and, therefore, export to other EU countries is in accordance with the principle of free movement of goods in the EU. The patentee is aware of the problem but seems reluctant to take action.

**Comment on your client's situation and options you would want to discuss with your client at a meeting.**

(25 Marks)

9. Dr Alfred, Vice Chancellor of the University of Didcot and a Director of Didcot Link Limited, the University's commercial arm, wrote to you:

“I have been recommended to you by Electro Products who you know them well. A situation has arisen on which you

Dr Jane was the University's Head of Physics before her retirement. Since that time she has had an unpaid honorary role in the work of retired senior researchers to use university facilities to do research without the teaching burdens.

Before her retirement, Dr Jane worked on a new optical device. The students who worked with her. The work was funded jointly by grants from the Optics Research Council and Maxihard Inc of USA, the well known computer company. Before she retired Dr Jane provided a full write-up of her work acknowledging the help of the PhD students. It is one of my tasks to seek commercial outlets for University research.

Since April, Dr Jane has carried out further work at the University on the processor, and now has an improved device which looks very promising commercially. She has called on me to discuss the way forward but it was clear that there was little common ground. Dr Jane is now working with Electro Products to put her new design into production.

It is my view that Electro Products is far too small to be able to market the device effectively, and licence from Didcot Link to Maxihard seems a much better prospect. From a University policy point of view, a licence to Maxihard for something exciting like this would give the company something tangible for all the financial grants Maxihard has given the University in recent years. It will also demonstrate to the funding bodies the effectiveness of our exploitation company. As far as I know Dr Jane's work has not been published.

Can you advise us on how to proceed?"

Your secretary made an appointment for Dr Alfred to call to discuss his letter tomorrow. Dr Alfred has just rang to say that he plans to bring Dr Jane with him to help explain the technology and the background.

***Analyse all the issues raised by the question. Note any particular problems you foresee with the meeting as proposed.***

(25 Marks)