

THE JOINT EXAMINATION BOARD

PAPER P1

BASIC UNITED KINGDOM PATENT LAW AND PROCEDURE

20th November 2001

10.00 a.m. – 1.00 p.m.

Please read the following instructions carefully. This is a THREE HOUR paper.

1. You should attempt four questions from Part A and 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 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.

4 PAGES INCLUDING THIS PAGE

PART A

1. What is a patentable invention as defined in the Patents Act 1977 ?
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. a) Can a claim in a patent have more than one priority date ?
b) What conditions must be satisfied in relation to a British patent application in order to accord it a filing date ?
c) Under what circumstances can a British patent application be accorded a filing date which is later than the date of filing of the Form 1/77 and the description of the invention ?
d) What is a “replacement application” ?
e) What is non-unity of invention ?

10 marks

4. What are the substantive and formal requirements for conducting a Preliminary Examination and Search, and for conducting a Substantive Examination ?

10 marks

5. A British patent application has been filed under the Patents Act 1997 and the associated Rules, by the employer of the inventor, with no claim to priority :

- a) when can a divisional application be filed ?
b) what documents are necessary to file the divisional application, if the divisional is filed 17 months after the parent application ?
c) what further document(s) need to be filed, and within what time limits, if the divisional application is to proceed to grant ? is there any possibility of an extension of time for the filing of these further document(s) ?

10 marks

PART B

6. Identify and discuss two leading UK Court cases relating to patents, commenting on the important points of each case.

20 marks

7. A client writes :

“We are a small family run business, and we make scientific equipment. We have been approached by Ed Boffin, an ex-employee who retired in October 2000 after twenty-seven years with the company. He has sent to us a copy of a patent that was granted to him in January 2001. We knew nothing about the patent application while he was employed by us.

The patent relates to a sophisticated pH meter which would fit with the rest of our range of products.

The letter from Ed explains that he realised he was on to a good thing when he exhibited a prototype at an inventors club meeting in 1998. Several members of the club who saw the device said that the results were impressive – even if they did not understand how it worked.”

What questions do you ask at the meeting ?

How will the answers shape the advice that you will give to the client ?

What specific options could be considered by your clients ?

20 marks

8. Write notes on :

- a) rectification of the Register
- b) restoration of a lapsed patent
- c) revocation of a patent on the Comptroller’s initiative
- d) licences of right.

20 marks

9. A Japanese associate sends to you on 20th November 2001 by fax, a copy of a published International patent application, which is in Japanese, and which claims a priority date from a Japanese patent application of 24th March 2000, with a letter that confirms the name and address of the applicant and provides instructions to enter the National Phase at the British Patent Office and to secure the best protection for the invention as it is suspected that a potential infringer may start operating in the United Kingdom over the next few months.

What information would you request from your associate ?

What are the requirements for entry into national phase for this application at the British Patent Office ?

What are the time limits and extensions of time which may be available ?

20 marks