

THE JOINT EXAMINATION BOARD

Paper P2

Patent Agents' Practice

12 November 2001

10.00 a.m. – 2.00 p.m.

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

1. The Candidates 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. Write on ONE SIDE of the paper only in BLACK INK. Start each question (but not necessarily each part or section of a question) on a fresh sheet of paper.
4. Put the paper number (P2) and question number clearly in the two boxes on the left at the head of the paper. You must also write YOUR EXAMINATION NUMBER in the single box provided on the top right hand side of the answer paper.
5. Do NOT give any indication of your name on your answer script.
6. No printed matter or other written material of any kind may be taken into the examination room.
7. Please write clearly, illegible answers cannot be marked.
8. **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 and place them in the envelope provided.**

This paper consists of **seven pages**, including this page

THE JOINT EXAMINATION BOARD

PAPER P2

PATENT AGENTS' PRACTICE

12th November, 2001
10.00 a.m. – 2.00 p.m.

PART A - (Answer all Questions)

1. A private inventor has two unrelated UK patent applications, 99.11111.5 filed on 22 September 1999 and 00.12222.3 filed on 26 October 2000. Application 99.11111.5 was published on 22 March 2001 and has a single claim: "A fishing rod substantially as described in the accompanying specification". Application 00.12222.3 is unpublished.

The inventor now approaches you concerning his patent applications. The application papers and specifications were prepared and filed by an unqualified acquaintance of the inventor. The acquaintance subsequently left his wife, who does not know where he is. The inventor has just received the formal Patent Office notice of abandonment of application 99.11111.5 as a result of failure to request examination.

Write a memorandum concerning the inventor's position and action(s) you recommend be taken.

(10 Marks)

2. A director of a registered charity writes to you:

"We have been working with many developing countries to import into the UK local hand made products. Typically these products comprise metal objects such as candle sticks and wooden tables in traditional style but each having uniquely carved legs. The products are sold by us in the UK through our own shops.

"It has recently come to our attention that Housefix plc, the well-known DIY Superstore, has started to sell a range of so-called "ethnic" products. The Housefix products are mass produced in the Far East. From a distance, however, they look similar to the developing countries' products which we are importing. Closer inspection shows that they do not have the detail of our imports.

"Sales of Housefix products is damaging the market for the developing countries' products. Is there anything we can do to stem this competition?"

Write an analysis of the situation to form the basis of advice to the client.

(10 Marks)

3. You are acting for the patentee in an infringement action, the alleged infringer applied for revocation. In consequence, experiments have been carried out by a university professor, who is your side's expert witness. You and your client have received the report of the experiments from the professor.

The professor was unable to carry out the process described in Example A of your client's patent. Example A is of the manufacture of the material of Claim 2. He could not suggest how to make the material of Claim 2 of the patent in any other way. The professor confirmed that Example B, which is of the manufacture of the material of Claim 3, worked as described. Referring to the professor's report, your client now writes:

"Presumably this does not matter because the infringer is using the process of Example B to make the material of Claim 3. I assume that the professor need not disclose the problem with Example A and Claim 2 to the Court, as it is not relevant to infringement.

"In fact, Example A was entirely made up. We knew from the outset that the material of Claim 2 could not be made. We only included Example A in papers sent to you to draft the original application to disguise from our competitors what we were really doing.

"Your advice would be appreciated."

[Note: Claims 2 and 3 both depend separately on a 'generic' Claim 1]

Write notes setting out points which would form the basis of your advice to the client.

(10 Marks)

4. *Assuming that they are new, comment on the patentability of each of the following, giving reasons for your conclusions:*

- a. A method of measuring the onset of XYZ disease in animals comprising the step of passing a low voltage current through the thigh of a suspect animal and measuring the response.
- b. A standard container coloured green, the green having a light intensity (Munsell) number less than 3, so that finger marks caused by people handling the container cannot be seen.
- c. Genetically modified yeast which is resistant to alcohol enabling stronger beers to be produced.
- d. A computer programme for processing ultra sound data so that the resultant images are more easily interpreted by medical practitioners.

(8 Marks)

5. You have sent a draft patent application to your client for approval. You and your client are aware that the invention represents a break-through and, therefore, protection will be sought in key industrial parts of the world, including USA, Japan and the European Union.

Late last Friday an injunction was obtained to prevent publication of a confidential description of the invention in a book written by a former employee of your client. Unfortunately, one shop had put the book on display last Friday evening ready for Saturday. The shop proprietor was unaware of the injunction until after he opened his shop on Saturday. By then several customers had been into the shop to buy newspapers, none had looked at or bought any books. The books were removed an hour after opening.

Explain the position and set out the recommendations which you would make to your client.

(5 Marks)

6. The technical director of a small local (UK) engineering firm speaks to you today at a local business lunch. On 12 October 2001, he drafted and filed at the UK receiving office a PCT application. The application, he says, is an extension of previous work carried out by an associated German firm. Priority has been claimed from a German application filed on 12 October 2000:

- the application is jointly in the name of the UK firm and the German firm, EP and US are designated;
- an employee of the UK firm, John Jones, was designated as the only inventor (but not as applicant) in the PCT application;
- no designation fees have been paid, all fees due on filing have been paid.

The technical director shows you a letter which he has received today from the International Bureau noting that:

- the application was not signed by all the applicants;
- an agent should be appointed to represent the German company;
- the inventor appears to be an applicant for the purpose of the US, and an agent should be appointed on his behalf.

One month had been given to respond. The technical director felt that he was out of his depth, and would like you to act as agent in the case.

What step(s) would you take immediately? What other issues should be considered?

(7 Marks)

PART B (Answer 2 Questions)

7. Your client writes:

"I have been looking at machines which are made by the US Company United Flint Operatives Inc. (UFO).

"The UFO machines are designed to manufacture a particular powdered mineral X which is used as a catalyst. The machines crush raw materials to a powder. The powder is passed over a series of vibrating sieves to separate and grade the powder by grain size. I have found that electrostatic effects cause the powder to adhere to the sieves supplied with UFO machines rather than falling through. The sieves become clogged. When this happens the machine has to be shut down and the sieves cleaned, losing valuable production time.

"I have experimented by replacing the sieves supplied with the UFO sieves with alternatives which I have found in Thailand. The Thai sieves are manufactured of carbon fibre filaments mounted in glass reinforced fibre frame. My vendor in Thailand says that the sieves were designed for sifting rice powders in response to complaints that conventional sieves impart a metal taste to the rice powder.

"When I receive the sieves, I drill holes in the frames so that the sieves can be bolted to the UFO Machines. I also fix a pair of electrodes on opposite sides of each sieve. A small alternating current can thus be fed through the electrodes to the carbon fibre filaments.

"I have had access to one plant in which mineral X is processed and have tried out my sieves. The modified Thai sieves seem to overcome the problems with the existing sieves and I am ready to market them to all users of UFO machines.

"UFO must have found out about the trials, and has written to me to say that import and sale of the sieves constitutes infringement of their UK Patent 7,000,000. UFO has also sent a circular letter to all users of their machines warning any user that purchases of my sieve could infringe not only UFO's UK Patent 7,000,000 but also UFO's design right and copyright in their original sieves."

UK Patent 7,000,000 describes and claims (there is only one claim) a process for preparing a catalyst comprising extracting, from an ore, mineral X, crushing X to a powder, and grading the powder using vibrating sieves. The resulting graded powder has much more catalytic activity than the ungraded powder used previously. The specification states that the uniformity of grain size of the powder is important in achieving the best catalytic effect. The crushing and grading steps, as such, are well known for other purposes.

Write a letter of advice to your client, including any measures the client might take to improve his position.

(25 Marks)

8. On 26 April 2001 you filed a PCT application PCT/GB01/08888 on behalf of a client. The invention is a pharmaceutical preparation effective against the viral form of Smith Disease. The application designates all PCT countries and has a single claim:

- A pharmaceutically active preparation containing the compound V.

The specification fully describes the preparation of compound V with results of tests showing that compound V eliminates the virus responsible for viral form of Smith Disease. Priority was claimed from an UK application filed on 26 April 2000. The specification and claim of this earlier UK application was identical to that of the PCT application.

The search report, recently published, contains one X citation (citation relevant to novelty): WO00/80000A. The University now writes:

"Smith Disease is a collective name for two illnesses having separate bacterial and viral forms but having similar symptoms. The viral form is not responsive to the presently approved drugs for Smith Disease. Our patent application describes and claims the first effective drug against the viral form. We plan to establish a joint venture company with a partner to continue development and carry out clinical trials. The most promising potential partner is conducting a due diligence exercise.

"The potential partner's solicitor has looked at the situation but says that patent application PCT/GB01/08888 is invalid and that our drug infringes patent WO00/80000A. As a result the investor is refusing to proceed with the joint venture pending resolution of the position."

WO00/80000A was published on 13 November 2000. It is the publication of a US origin PCT application, designating US, EP and JP, filed on 8 May 2000 and claiming priority from a US Provisional Application filed on 8 May 1999.

WO00/80000A states that a class of compounds A is useful in treatment of Smith Disease. The specification describes in detail the preparation of a compound B, which is a member of Class A, gives evidence of its efficacy against the bacterial form of Smith Disease, and states that compound B is effective against Smith disease. Your client states that the structure of compound B is such that it could not be effective against the viral form of Smith's disease. Compounds B & V are both members of Class A.

WO00/80000A has two claims:

1. A pharmaceutically active preparation containing a compound of Class A
2. A method of preparing a pharmaceutically active compound comprising the steps of [the steps would inevitably make compound B and nothing else]

Write a letter of advice to your client including proposals to improve or clarify the situation.

(25 Marks)

9 A French associate writes:

"My client's European (UK) patent 0,999,999, which was granted on 10 May 2000 and relates to paint, appears to be being infringed.

"It has been our practice to prosecute European applications for French companies in French. When the applications are ready to be granted, we prepare English and German translations and send the translation of claims to the European Patent Office as part of the grant process for European Patents. Subsequently, we arrange for the English translation to be verified and filed at the UK Patent Office.

"That procedure was used in this case. Unfortunately, however, the translation filed at the UK Patent Office contains an error in the range of "sunblock" mentioned in both the specification and claims. The translation states the range to be 15% to 25% "sunblock", whereas it should have been 5% to 25%. The error also occurs in the English claims of the European Patent, but not in the original French language specification and claims of the European Patent.

"Very fortunately, we understand that you prosecuted on our client's behalf an independent UK application having the same French priority as the European application. The resulting UK patent has been granted with the correct range of "sunblock". In the circumstances, it may be better to rely on this UK patent to deal with the infringement and to discontinue European (UK) Patent 0,999,999.

"The alleged infringer is the British subsidiary, Muradeco Limited, of an Italian paint manufacturer, Muradeco s.p.a.. We have just had word from our client that Muradeco s.p.a has stated its intent to file an opposition to European Patent 0,999,999, (we have no idea on what basis, as we are unaware of any relevant prior art).

"Our client has analysed paint being imported to the UK under the Muradeco brand name. We have found that their super exterior gloss paint contains 26% "sunblock", general purpose paint 18% "sunblock", and the economy paint range 7% "sunblock".

"European Patent 0,999,999 which designates DE, FR, GB and IT fully describes the preparation and use of "sunblock" in paints, and its effect in reducing deterioration of paint in sunlight.

"Inspection of the tins of paints imported by Muradeco shows that only the super-exterior gloss (26% sunblock) was made in Italy, the other two paints appear to have been imported from outside the European Union where our client has no patents. Our client is anxious to stop the sales of the Muradeco paints in the UK as soon as possible."

"I should be grateful for your advice on the situation in the UK and a note of your recommendations."

Draft a reply in the form of a letter for your French Associate as requested.

(25 Marks)