

THE JOINT EXAMINATION BOARD
PAPER P1
BASIC UNITED KINGDOM PATENT LAW AND PROCEDURE
18th November 2002
10.00 a.m. – 1.00 p.m.

*Please read the following instructions carefully. Time allowed – **THREE HOURS**.*

1. You should **attempt FOUR questions from Part A and THREE questions from Part B**. There are 9 questions altogether, 5 in Part A and 3 in Part B.
2. The each question in Part A carries 10 marks and each question in Part B carries 20 marks.
3. Where a question permits, reasons should be given for the conclusions reached.
4. Please note the following:
 - Start each question (but not necessarily each part of each question) on a fresh sheet of paper.
 - Enter the Paper Number, the question number and your Examination number in the appropriate boxes at the top of each sheet of paper.
 - Write on one side of the paper only, within the printed margins using a **BLACK** pen.
 - **DO NOT** use coloured pens or highlighters within the answers - they will not photocopy.
 - **DO NOT** staple or join pages together in any way.
 - **DO 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. ALL mobile phones and electronic aids **must be** switched off and stored away.**
7. Answers **MUST** be legible. If the examiners cannot read a candidate's answer no marks will be awarded.
8. **NO WRITING OF ANY KIND WILL BE PERMITTED AFTER THE TIME ALLOTTED TO THIS PAPER HAS EXPIRED. At the end of the examination assemble your answer sheets in QUESTION NUMBER ORDER and place in the WHITE envelope provided.**

This paper consists of 5 pages, including this page.

PART A

1. What subject matter is excluded from patentability in the UK?

Explain how you might reword a claim relating to subject matter which is excluded from patentability to obtain allowance without changing the invention.

(10 marks)

2. Describe briefly the facts relating to and the precedent set by one leading case relating the novelty or inventive step of UK patents.

(10 marks)

3. When can a divisional application be filed from a UK patent application, and by what date must it be in order for grant?

What restrictions, if any, exist on the subject matter that can be claimed in a divisional application?

Would any of your answers be different if the application is filed as a divisional of a divisional application? Explain.

(10 marks)

4. What are the grounds of revocation of a patent granted under the Patents Act 1977?

Is there any restriction on who can plead these grounds of revocation? Is the situation different for UK patents granted on European applications?

Under which circumstances might the Comptroller revoke a patent on his own initiative?

(10 marks)

5. An alleged infringement contains a feature which is very similar to an essential element of an independent claim of a UK patent but is not “literal” within the meaning of the words of the claim when read together with the description. Explain under what circumstances might infringement of the UK patent still occur.

(10 marks)

PART B

6. Write brief notes on five of the following topics:

- (a) commercial success as an indication of patentability
- (b) licences of right
- (c) a certificate of contested validity
- (d) a supplementary protection certificate
- (e) an account of profits
- (f) secrecy orders

(20 marks)

7. (a) What is maximum term of a UK patent for a mechanical invention granted on an application that claims priority from a prior US patent application?
- (b) In what year is the first renewal fee payable to the Patent Office?
- (c) A new client writes to you seeking advice because his former patent attorney has failed to pay the renewal fee despite a timely written instruction to renew the patent. Discuss the client’s situation and what if anything can be done, assuming:
- (i) that the due date for paying the fee was five months ago,
 - (ii) that the due date for paying the fee was seventeen months ago, and
 - (iii) that the due date for paying the fee was two years ago.

(20 marks)

8. Comment on the following statements:

- a) "It is acceptable to print 'patented' on my product without giving the number because the claims of my patent do not actually cover the product".
- b) ~~"It is ok to infringe my competitor's patent because it is marked 'licences available as of right' so he cannot sue me".~~
- c) "A competitor has just sent me copies of some prior art documents which deprive some claims of my patent of novelty and arguably render some others obvious. However, some claims which are still clearly valid are infringed by him, so I do not plan to amend and I assume I can sue him under those claims should the matter get to be contested in court".
- d) "My competitor says that he does not infringe my patent because he has a granted patent for an improvement and he is selling the improvement rather than the product described in my patent".
- e) "I have been developing product A for 4 years and have just launched it. Now, however, I am being threatened for infringement of patent B granted on an application filed 2 years ago with no priority claim. Although I did not disclose my invention publicly until recently, it cannot be fair if I infringe the patent B".

(20 marks)

9. Your client, company Why, writes:

"We own a patent jointly with Mr Eh, who used to work for us but was recently made redundant. The patent relates to an invention that Mr Eh made on his own four years ago and is unrelated to his work for us. At the time, Mr Eh did not have any money so he asked us to apply and pay for a patent application on the condition that he would be a joint owner. We agreed but we do not have a formal agreement with Mr Eh other than his contract of employment, which does not say anything about inventions or patent applications.

The patent relates to a process for making a chemical. We do not have the manufacturing capacity to make as much chemical as we are able to sell, so, we also license firm Jay to make the chemical using the process. We sell the chemical made by us and by firm Jay on the market at a reasonable profit. We already make a small annual payment to Mr Eh to recognise his contribution to the invention. However, now he says he wants a large royalty on every litre of chemical we sell including that which we make ourselves, and he says if we do not agree he will stop the firm Jay from using the process, since they do not have his permission to use the process. This royalty would make selling the chemical unprofitable.

What can we do?"

Write notes on your client's position, and on what actions they could take to improve their position.

(20 marks)