

THE JOINT EXAMINATION BOARD

PAPER P1 - BASIC UNITED KINGDOM PATENT LAW AND PROCEDURE

Monday 7 November 2005 - 10.00 a.m. – 1.00 p.m.

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

1. You should attempt **only FOUR questions from Part A and only THREE questions from Part B.** There are nine questions altogether, five in Part A and four in Part B.
2. Each question in Part A carries 10 marks and each question in Part B carries 20 marks. If more than the required number of questions are answered in any Part then the final question of that Part will not be marked.
3. Please note the following:
  - a. Start each question (but not necessarily each part of each question) on a fresh sheet of paper;
  - b. Enter the Paper Number (P1), the question number and your Examination number in the appropriate boxes at the top of each sheet of paper;
  - c. The scripts are photocopied for marking purposes. Please write with a **dark inked pen** on one side of the paper only and within the printed margins, and do not use highlighters in your answer;
  - d. Do not staple or join pages together in any way;
  - e. Do not state your name anywhere in the answers;
  - f. Write clearly, examiners cannot award marks to scripts that cannot be read;
  - g. Reasoning should always be given where appropriate.
4. Under the Examination Regulations **you may be disqualified from the examination and have other disciplinary measures taken against you if:**
  - a. you are found with unauthorised printed matter or other unauthorised material in the examination room;
  - b. your mobile phone is found to be switched on;
  - c. you copy the work of another candidate, use an electronic aid, or communicate with another candidate or with anyone outside the examination;
  - d. you continue to write after being told to stop writing by the invigilator(s).  
**NO WRITING OF ANY KIND IS PERMITTED AFTER THE TIME ALLOTTED TO THIS PAPER HAS EXPIRED.**
5. **At the end of the examination assemble your answer sheets in question number order and put them in the WHITE envelope provided.** Any answer script taken out of the examination room will not be marked.

This paper consists of six pages, including this page.

**Part A Answer four questions from this part**

1.
  - a) If a Patent application has two independent apparatus claims, how will the Patent Office determine whether or not there is unity of invention between the two claims?
  - b) If there is not unity of invention and so the search report relates only to the first invention, what actions need to be taken, and by when, before the Patent Office will conduct a search for prior art relating to the second invention?
  - c) If a divisional application is filed, under what circumstances will the Patent Office issue a refund of the search fee paid in respect of the divisional application?

[10]

2. In relation to the Patents Act 1977 (as amended) explain the meaning of the following terms:

- a) Innocent infringement
- b) Groundless threat of infringement proceedings
- c) Delivery up
- d) Comptroller's power to revoke patents on his own initiative

[10]

3. What are the provisions of the Patents Act 1977 (as amended) relating to compulsory licences?

[10]

4. Explain at what times during the UK patent application procedure the description, claims and/or drawings may be amended or corrected by the applicant.

What requirements must be met for an amendment or correction to be allowable?

Under what circumstances can a UK patent be amended after grant?

[10]

5. What is meant in the Patents Act 1977 (as amended) by "inventive step"?

[10]

**Part B – Answer three questions from this part**

6. Your UK client wants you to file a UK patent application for an invention he made recently:

- a) what is the minimum information and documentation required to be filed at the Patent Office to establish a filing date?
- b) On discussing your draft specification with the client, you discover that a filing date must be established today, and you are unable to get the application documents to the Patent Office in Newport by courier or other delivery service. What options do you have for filing the application today?
- c) Once the application has been filed with the minimum documentation, what other information and documentation must be filed, and what action must be taken, to keep the application pending for 13 months following the filing date? State the relevant deadlines, but do not discuss extension possibilities.
- d) Three weeks after filing the application, your client advises you that he disclosed his idea at a conference the day after the application was filed. However his disclosure included a new embodiment of his invention, which he thinks will be important and so he wants to protect it. The embodiment falls within the scope of the broadest claim of the application. What, if anything, can be done? What restrictions, if any, would there be on the protection given to the new embodiment by your proposed course of action?
- e) After you have filed the UK patent application, your client tells you that he had already filed a UK patent application himself for his idea, shortly before coming to talk to you. Discuss what actions would need to be taken, and by when, to secure the date of the previous application as a priority date, mentioning any possible extensions of time.

[20]

7. A client writes to you instructing you to pay a renewal fee on a granted UK patent. Due to financial constraints, your client had been unable to send you these instructions until five months after the fee was due, but still one month before expiry of the six month grace period existing for renewal fees. Unfortunately, you never received your client's letter, presumably because of an error in the postal system. Consequently, the Patent Office issued a letter indicating that the Patent had lapsed due to the fee not being paid on time. You forwarded the letter on to your client as usual and the client telephones you. He is very upset because he thinks someone else has started using his invention.

Discuss the provisions of the Patents Act 1977 (as amended) and Rules relating to restoration, applying them to your client's situation. If it is possible to get the patent reinstated, explain what would need to be done and by when. Detail what you could do to maximise the chances of your first communication with the Patent Office resulting in a favourable decision straight away.

[20]

8. A client writes:

We are a small gymnasium equipment design and manufacture company, with a few patents and applications in our portfolio. We have received a letter from Bob Madeupname who was employed as our Financial Director until he left us a year ago. The letter enclosed a copy of a UK patent granted last month and naming Bob as sole inventor and sole proprietor. The patent relates to an exercise bike which would fit neatly into our 'Spin' range.

Bob's letter explains that he wants to license his patent to your client.

Bob explains that he built a prototype and tested it on the users at a local gym some time ago, but that he wanted to get a patent before exploiting his invention. The prototype apparently was commended by those who tested it.

Bob left your client in bad grace and your client does not want to take a licence.

- a. Could your client claim ownership of Bob's patent? Give reasons.
- b. Discuss whether Bob's patent is likely to be valid in view of the testing at the local gym.
- c. State briefly what options are available to your client.

[20]

9. Your client filed a first UK patent application on 3 October 2003 with no priority claim. The first application describes and claims a fire extinguisher (the Mark I) which has numerous advantages over fire extinguishers available on the market at the time.

Your client developed a Mark II fire extinguisher which is the same as the Mark I but with some additional features.

On 30 September 2004, a second UK patent application was filed, claiming priority from the first application. The second application includes all the description and claims of the first application and additionally describes and claims the Mark II.

In respect of each of the following disclosures, state whether it has the potential to be relevant prior art to the claims in the second application in respect of novelty and/or inventive step.

State also what, if any, further information is needed.

Give reasons where appropriate.

- a) An extinguisher sold extensively in the UK from 1932 until 1939, when a shortage of raw materials caused production to cease.
- b) A tender for manufacturing proposals from your client for the Mark II fire extinguisher dated 10 September 2004 and marked "Commercial In confidence". The tender describes in detail the Mark II extinguisher and how it should be made. The tender is addressed to six manufacturers, in the UK and overseas.
- c) A journal article dated 9 October 2003 describing some (but not all) of the details of the Mark I extinguisher and discussing its advantages.
- d) The journal article of c), but with a statement that it is a report of a conference "fire control" held in Paris on 22 September 2003.
- e) A UK patent application which was filed on 20 September 2003, and published on 26 March 2004 but then withdrawn, describing an extinguisher similar to both the Mark I and Mark II extinguishers.
- f) A European patent application designating GB having similar contents to the patent application in e), but filed on 10 June 2003 and published on 12 December 2004.
- g) A PCT application filed in Japanese at the Japanese patent office, designating GB (but not EP(GB)) and filed on 10 April 2003 claiming priority from a Japanese Patent application filed on 11 April 2002. The

PCT application was published on 14 October 2003. You determine that the PCT application describes a fire extinguisher nearly identical to the Mark II extinguisher, but that the sole extinguisher described in the Japanese priority application lacks some key features of the Mark I and Mark II extinguishers.

[20]