

THE JOINT EXAMINATION BOARD

PAPER P1 - BASIC UNITED KINGDOM PATENT LAW AND PROCEDURE

Monday 6 November 2006 - 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, as 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 **five** pages, including this page.

Part A Answer four questions from Questions 1 to 5

1. In the context of UK patents:
 - a) What is a priority date and why is it important?
 - b) Explain the circumstances under which a patent claim can have more than one priority date.
 - c) For a UK patent application, what documents must be filed, and by when, to support a priority claim from a foreign patent application? Mention what extensions of time, if any, are available.

(10 marks)

2. Under the provisions of the UK Patents Act 1977 as amended relating to compulsory licences:
 - a) What is a compulsory licence?
 - b) Who may apply for a compulsory licence?
 - c) To whom must the application be made?
 - d) When is the earliest that an application can be made?
 - e) What are the grounds for applying for a compulsory licence (distinguish between applicants for a licence who are residents of WTO and non-WTO countries)?

(10 marks)

3. Describe briefly one leading case relating to novelty or inventive step under the UK Patents Act 1977 as amended.

The information you should provide is:

- 1) The identity of the parties to the case,
- 2) A summary of the facts and the issues contended,
- 3) An outline of the decision, and
- 4) Comments concerning at least one important precedent set by the case.

(10 marks)

- 4.
- a) On an application filed under the UK Patents Act 1977 as amended, what criteria must be satisfied for an invention to be patentable (ignore procedural requirements)?
 - b) What are not treated as inventions for the purposes of the UK Patents Act 1977 as amended and thus are excluded from patentability?

(10 marks)

5. An alleged infringement has all the features of an independent claim of a UK patent except for one feature which does not fall within the literal wording of the claim. Explain why there might still be infringement of the UK patent. No discussion of indirect or contributory infringement (UK Patents Act 1977 S.60(2)) is needed.

(10 marks)

PART B Answer three questions from Questions 6 to 9

- 6.
- a) Explain the provisions of the UK Patents Act 1977 as amended relating to amendment of applications and patents, and those relating to making a correction. Highlight the differences between amendment and correction.
 - b) Indicate the procedure that would be followed at the Patent Office (not the Courts) when seeking to make an amendment or to correct an error in a patent application and in a patent, indicating any relevant time constraints.

(20 marks)

7. Under the UK Patents Act 1977 as amended
- a) What acts constitute infringement of a UK patent?
 - b) List **four** different acts which are exempted from constituting infringement.
 - c) Under what circumstances may the Comptroller consider an issue of infringement?
 - d) What remedies may be sought by a patentee in infringement proceedings before a court?
 - e) What remedies may be sought by a patentee in infringement proceedings before the Comptroller?
 - f) Who may bring an action for infringement?

(20 marks)

- 8.
- a) A UK patent for a mechanical invention was filed on 25 September 2002 and granted on 2 November 2006. The patent claims priority from a Japanese patent application filed on the 2 October 2001.
 - i) When is the first renewal fee payable to the UK Patent Office? Can it be paid late, and if so, by when?
 - ii) What is the maximum term of the patent? From when is the maximum term calculated?
 - b) A new client writes to you seeking advice. He has received a letter from the Patent Office telling him his patent has ceased because he failed to pay the 10th renewal fee on his granted UK patent. He has been discussing the grant of a licence under the patent to someone who has very recently sold some infringing products.

You check the register and find that the fee was due for payment ten months ago.

What can be done? Mention any time limit for applying for restoration, what you need to establish in order to restore the patent, and any likely impact on the licence discussions.

(20 marks)

9. In relation to UK patent law and procedure, draft a letter to a UK client explaining the meaning of the following terms:
- a) third party observations;
 - b) divisional application (do not discuss time limits or formal requirements);
 - c) sufficiency of disclosure;
 - d) indirect or contributory infringement. (20 marks)