

THE JOINT EXAMINATION BOARD

PAPER P1

Basic United Kingdom Patent Law and Procedure

Monday 9 November 2009

10.00 a.m. – 1.00 p.m.

Please read the following instructions carefully. Time Allowed – 3 HOURS

1. You should attempt **four of questions 1 to 5** in Part A and **three of questions 6 to 9** in 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 either part only the first ones presented will 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 state your name anywhere in the answers;
 - e. Write clearly, examiners cannot award marks to scripts that cannot be read;
 - f. 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.** Do not staple or join your answer sheets together in any way. Any answer script taken out of the examination room will not be marked.

This paper consists of four pages including this one.

Part A – Answer four questions from Questions 1 to 5

1. For the purpose of assessing whether an invention is new, under the provisions of the UK Patents Act 1977 as amended, what is considered to form part of the state of the art?

(10 marks)

2. What acts can constitute infringement of a patent granted for an invention under the provisions of the Patents Act 1977 as amended, where the invention is a process?

(10 marks)

3. Your client writes:

“Thank you for sending the UK Search Report to us, for our patent application. Now that we have the results of the search report, what steps need to be taken before we can expect grant of a UK Patent?”

You refer back to your file, and determine that the application was filed on 5 October 2008, without a claim to priority. The application has not yet been published, and no request for early publication of the application has been made.

Write notes describing the procedure for achieving grant, taking account of the provisions of the UK Patents Act 1977 as amended.

(10 marks)

4. What are the circumstances in which a person can apply for compensation for making an invention the subject of a Patent granted by virtue of the UK Patents Act 1977 as amended? Explain the criteria used to determine whether compensation may be available.

(10 marks)

5. Where a UK patent has ceased to have effect in the UK by reason of a failure to pay a renewal fee, in what circumstances can the patent be restored? Note any time limits for taking appropriate action.

(10 marks)

Part B – Answer three questions from Questions 6 to 9

6. In what circumstances, by what procedure, and by how much, can the following periods defined in the UK Patents Act 1977, as amended, and the Patents Rules 2007, be extended by the applicant?
- The period for requesting substantive examination of a UK Patent Application;
 - The period for putting a UK Patent Application in order;
 - A period set by the Comptroller for response by an applicant to a Report under Section 18(3) of the UK Patents Act 1977 as amended;
 - The period for furnishing the Comptroller with a copy of an earlier application from which a present application for a patent claims priority.

(20 marks)

7. Your client filed a UK patent application on 10 December 2008. The subject of the application was an improvement to a car tyre.

He has now told you that his product development is going well but that the product improvement can also be applied to a bicycle tyre. He would like to extend his potential patent protection to cover bicycle tyres as well.

He explains that the same general principle as for the car tyre improvement applies to bicycle tyres. However, additional explanation may be needed to show how the invention can be made to work for bicycle tyres.

You check the original patent specification and it does not refer to any possibility of extending the invention to bicycle tyres. It also does not include any information from which the bicycle tyre improvement could be ascertained. On the other hand, there are general statements of invention which do not specify the limitation of the invention to car tyres.

Explain to your client the options available to him, and possible pitfalls which may arise.

(20 marks)

8. Your client writes:

“As you know, we filed an application some time ago for a UK Patent. We received your recent letter concerning the Combined Search and Examination Report. We see that the deadline for responding to the Report is 16 June 2011.

The content of the Report is reasonably clear. There is an objection that the claims lack unity, and I see that the Examiner has only searched on some of the claims.

We definitely want to keep the searched claims, but we are not sure about the unsearched claims. Without a search, we cannot decide what to do.

We also see that the Examiner has objected to claim 1, but that he seems to accept that claim 2 defines patentable subject matter. We would be happy with that.

We know that a competitor is out there ready to launch a rival product to our own. We would like to achieve patent protection as soon as possible, but keep our options open on the remaining unsearched claims at the same time.”

You refer to your file, and you note that the application was filed on 16 June 2009, without a claim to priority. It has not yet been published. Your inspection of the papers confirms the client’s information.

You also inspect the claims, and from your knowledge of the client’s business, you confirm that claim 2 (which is dependent on claim 1) would cover the client’s product.

Advise your client on the options open to him.

(20 marks)

9. Explain the following terms, as used in the UK Patents Act 1977 as amended:
- Unity of invention
 - Account of profits
 - Inventor
 - Methods of treatment or diagnosis

(20 marks)