

THE JOINT EXAMINATION BOARD

PAPER P1 – Basic UK Patent Law and Procedure

Monday 12th November 2012

3.00 p.m. – 6.00 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 is 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;
 - g. You must number all the pages of your answer script. Once the exam finishes, an additional 5 minutes will be allowed for you to do this.
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, number all the pages 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 4 pages including this one.

PART A**Question 1**

[10 marks]

Under Section 40 of the UK Patents Act 1977, an employee who has made an invention which has always belonged to his employer may be awarded compensation. According to Section 41, what factors are to be taken into account when determining the amount of that compensation?

Question 2

[10 marks]

- a) Name five transactions, instruments or events which may be recorded in the UK Register of patents and patent applications? [5]
- b) Why is it important to register such transactions, instruments or events? [5]

Question 3

[10 marks]

- a) What is a divisional patent application and in what circumstances may a divisional application be filed under the UK Patents Act 1977? [4]
- b) What is the time limit for filing a divisional application based on a UK patent application? [3]
- c) What is the deadline for filing a search request on the divisional application? [3]

Question 4

[10 marks]

- a) A United States patent application US1 was filed on 14 September 2011. Is it now possible to file a UK patent application claiming priority from US1? [4]
- b) A first UK patent application GB1 was filed on 28 July 2011 and a second UK application GB2 was filed on 28 February 2012 without claiming priority. GB2 comprises all the information in GB1 together with additional material describing a new embodiment. Can a priority claim to GB1 be added to GB2 and, if so, to what extent would such a priority claim be effective? [6]

Question 5

[10 marks]

- a) Who can apply for a UK patent? [2]
- b) To whom may the patent be granted? [4]
- c) Under what circumstances must an applicant file a statement explaining the derivation of his right to be granted a patent? [2]
- d) What is the deadline for filing such a statement? [2]

PART B**Question 6**

[20 marks]

a) Discuss whether or not the following ideas would be considered as inventions under the UK Patents Act 1977:

- i) A method of designing a blade for a lawnmower using a set of equations modelling the cutting ability of the blade [6]
- ii) An interactive television programme guide which allows a user to select a subset of channels (so-called favourite channels) so that the programme guide only displays information relating to those channels on the television [4]

b) Discuss the steps in the structured approach to assessing obviousness known as the "Windsurfing/Pozzoli" approach. [10]

Question 7

[20 marks]

Your assistant has taken the following message from your client:

"For some months now, we have been developing a new electrical screwdriver with a redesigned motor. Our regular watch of our competitor's portfolio has revealed a pending UK patent application GB 3333333 for an electrical screwdriver incorporating a similar motor. Please can we arrange a meeting to discuss whether we are free to launch our new screwdriver?"

Your checks reveal that examination has been requested on GB3333333 and that the UKIPO search report has located only electrical screwdrivers with standard motors.

You have conducted a further prior art search and have located a ten-year old manual for a motor which is similar to the redesigned motor.

Write notes for a meeting with your client to discuss his options.

Question 8

[20 marks]

In the context of the UK Patents Act 1977, discuss the following:

- a) Infringement of a process claim by dealing in the product [5]
- b) Plant variety [5]
- c) Method of treatment or diagnosis [5]
- d) Unity of invention [5]

Question 9

Your client Factor Limited writes:

"In June of this year our competitor Power Limited assigned to us its patent portfolio relating to a revolutionary form of cooling in a refrigerator. Since acquiring the portfolio, all our time has been focussed on developing a refrigerator incorporating the new technology to launch for Christmas.

We were assured that all deadlines before we acquired the portfolio had been dealt with and thus we assume that all is in order with the portfolio. We are interested in pursuing all cases in the portfolio. I enclose copies of paperwork relating to the portfolio provided by Power Limited."

You review the paperwork and note that there are three cases; P1, P2 and P3.

P1 is a UK patent filed on 15 June 2005 without a priority claim. P1 was granted on 15 August 2008.

P2 is a UK patent application filed on 12 February 2008 claiming priority from an earlier application filed on 20 February 2007. A first examination report issued on 10 November 2011 setting a two month deadline for response. The previous attorneys filed a response which dealt with all major objections. A second examination report issued on 12 May 2012 setting a six-month term for responding to clarity issues.

P3 is a UK patent application filed on 8 November 2010 and published on 8 May 2012. The UK search report located only documents of background relevance.

Write notes for a meeting with your client to discuss the status of the three cases and any outstanding deadlines and actions to be taken.