

THE JOINT EXAMINATION BOARD

PAPER P1 – Basic UK Patent Law and Procedure

Friday 11th October 2013

2.00pm - 5.00pm

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;
 - 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 5 pages including this one.

PART A**Question 1****[10 marks]**

In the UK Patents Act, what things are listed as not being an invention for the purposes of the Act?

Question 2**[10 marks]**

Section 23 of the UK Patents Act sets out restrictions on filing patent applications outside the United Kingdom.

- a) To whom do these restrictions apply? [2]
- b) What information must an application contain for the restrictions to apply? [3]
- c) If the restrictions apply, outline the procedure which should be followed. [3]
- d) What are the consequences of not complying with these restrictions? [2]

Question 3**[10 marks]**

A UK patent application is to be filed claiming priority from a Chinese patent application. A declaration of priority will be made at the time of filing.

- a) What information must be specified for a declaration of priority to be effective? [2]
- b) What is the normal deadline for filing a copy of the Chinese patent application? [1]
- c) What extensions of time for filing the copy of the Chinese patent application are available and how are these obtained? [5]
- d) When must a translation of the priority document be filed? [2]

Question 4**[10 marks]**

Post grant amendment of a UK patent is permitted provided that the amendment does not result in the specification disclosing additional matter and the amendment does not extend the protection conferred by the patent.

- a) What are the minimum requirements for an application to the Comptroller for post grant amendment of a UK patent? [3]
- b) Summarise the procedure after the application is received. You should assume the amendment is accepted and no opposition is filed. [6]
- c) From when does the amendment take effect? [1]

Question 5

[10]

The Comptroller has the power to correct errors under Section 117 – Correction of Errors in Patents and Application of the UK Patents Act.

- (1) What types of error can be corrected? (2)
- (2) In which documents can errors be corrected? (2)
- (3) Who may apply to the Comptroller for a correction to be made? (1)
- (4) Outline the procedure for correcting an error in the applicant's name. (5)

Please turn the page for Part B.

PART B**Question 6****[20 marks]**

You have received the following email from a Chinese patent attorney today (Friday 11 October 2013):

'We filed a PCT application on 12 March 2012 in Chinese at the Chinese patent office. The application claims priority from a Chinese application filed on 12 March 2011. Amendments to the claims along with an explanatory statement were filed in the International phase.

Our clients have advised us that they wish to enter this application into the UK national phase. This is because they are aware of a potential infringer in the UK. All documents are in Chinese and no translations are available at this time.'

- a) Is it still possible to enter the UK national phase? [2]
- b) If so what steps need to be taken and by what deadlines? [9]
- c) How would you address the lack of translations? [4]
- d) What further beneficial steps could be taken in light of the potential infringer? [3]
- e) Are there any other documents which might be required before grant? [2]

[Restrict your answer to UK national phase entry only. There are no marks available for considering filing a European regional phase application]

Question 7**[20 marks]**

Comment on the following questions asked by your clients—

- (a) I intend to give a talk on my invention tomorrow. Is it OK for me to file the notes of the talk today as a UK patent application and then file a top up application with further information and claims after the talk? [4]
- (b) We are considering indicating on the UK Patents Register that licences are available as of right for one of our patents. What effect will this have? [6]
- (c) We have jointly developed an invention with the company next door. They are not interested in filing a patent application. Can we file a UK patent application for the invention in our own name? [4]
- (d) We and another company are co-owners of a UK patent. What are the consequences of this for us and also for our suppliers and customers? (6)

Question 8

[20 marks]

A new client, Joints-Are-Us, writes:

'For many years we have produced joints for robots. In the last month we have expanded into the field of artificial hip joints for humans. The artificial hip joints have a rod for attachment to a femur and a head which is received in a hip socket. We have designed a number of such hip joints with various head shapes and have had machinery made to produce the joints.

We have performed a patent search and have identified two UK patents, D1 and D2, owned by Hips-Are-Us which are of concern to us.'

The client has provided you with three hip joints, one with a spherical head, one with an elliptical head and one with a cubic head.

Review of patent D1 reveals that all the new hip joints infringe the claims of this patent. The last renewal fee was due on 31 May 2012 and has not been paid. No application for restoration has been published.

A review of patent D2 reveals that it is in force. The patent has only one claim; the claim is to a hip joint having a teardrop shaped head. The description states that this is an improvement over joints having spherical heads.

With regard to patent D1:

- a) What is the deadline and procedure for applying for restoration? [6]
- b) Assuming the application for restoration is successful, does the client have a defence to a potential claim for infringement? [6]
- c) What is the best course of action for the client in respect of D1? [1]

With regard to patent D2:

- d) For each of the client's hip joints discuss briefly whether they are likely to be considered an infringement of D2. [7]

Question 9

[20 marks]

- a) What are the grounds for revocation of a UK patent and who can raise them? [10]
- b) Summarise the provisions of the UK Patents Act relating to:
 - a. Withdrawal of a UK patent application at the request of the applicant [5]
 - b. Surrender of a UK patent [5]