

THE JOINT EXAMINATION BOARD
PAPER P1
BASIC UNITED KINGDOM PATENT LAW AND PROCEDURE

10 November 2003

10.00 a.m.-1.00 p.m.

*Please read the following instructions carefully. Time allowed **THREE HOURS***

- 1.** You should attempt **FOUR** questions from Part A and **THREE** questions from Part B. There are 9 questions altogether, 5 in Part A and 4 in Part B.
- 2.** Each question in Part A carries 10 marks and each question in Part B carries 20 marks.
- 3.** Where a question permits, reasons should be given for the conclusions reached.
- 4.** Please note the following:
 - Start each question (but not necessarily each part of a question) on a fresh sheet of paper;
 - Enter the Paper number, the Question number and your Examination number in the appropriate boxes at the top of each sheet of paper;
 - Write on one side of the paper only, within the printed margins, using a **BLACK** pen;
 - **DO NOT** use coloured pens or highlighters within the answers, they will not photocopy;
 - **DO NOT** staple or join pages together in any way;
 - **DO NOT** state your name anywhere in the answers.
- 5.** Unless specifically requested, answers are **NOT** required in letter form.
- 6.** **NO** printed matter or other written material may be taken into the examination room.
ALL mobile phones and electronic aids **must be** switched off and stored away.
- 7.** Answers **MUST** be legible. If the examiners cannot read a candidate's answer no marks will be awarded.
- 8.** **NO WRITING OF ANY KIND WILL BE PERMITTED AFTER THE TIME LIMIT ALLOTTED TO THIS PAPER HAS EXPIRED. At the end of the examination assemble your answer sheets in QUESTION NUMBER ORDER and place in the WHITE envelope provided.**

This paper consists of four pages including this page.

Part A – Answer Four Questions from this Part

- 1
- a) What is a priority date and why is it so important?
 - b) Under what circumstances can a national United Kingdom patent application, filed at the UK patent office, validly claim a priority date of more than one year prior to the UK filing date?
 - c) Explain the circumstances under which a claim can have more than one priority date.
 - d) For a UK patent application, what documents must be filed, and by when, to support a priority claim from a foreign patent application.
- (10 Marks)
- 2.
- a) How do you determine if there is unity of invention with two independent apparatus claims?
 - b) If there is not unity of invention, and only the first invention is searched by the Patent Office, under what circumstances will the Patent Office search the further invention?
 - c) If a divisional application is filed for an invention, what conditions must be met for the Search fee to be refundable?
- (10 marks)
3. For a UK patent application which does **not** claim priority from an earlier filed UK or foreign patent application, what formal requirements, including time limits, must have been met before the Patent Office will issue:
- a) a search report;
 - b) a combined search and examination report;
 - c) a certificate of grant.

(10 marks)

4. Outline the provisions relating to endorsing a patent Licences of Right under the Patents Act 1977 (S. 46, S. 47).

What disadvantages might result from endorsing a UK patent Licences of Right and can the endorsement be cancelled.

(10 marks)

5. A United Kingdom patent application was filed with no priority claim. The search report on the UK application cites a European patent application having a filing date earlier than the filing date of the UK application but a publication date later than the filing date of the UK application.

- (i) What is the prior art effect of the European patent application? Explain.
- (ii) What difference would it make, if any, if the European patent application were published before the filing date of the UK application?
- (iii) What is the prior art effect of a PCT application filed in the English language and designating the UK as a national designation (ignore the possibility of an EP designation in the PCT application)?

(10 marks)

Part B – Answer Three Questions from this Part

6. A new client, a very small lighting installation and design company, writes:

“Our main competitor last week started selling a lighting control system which, judging by their advertising, seems to be almost exactly the same as our patented system. Due to its complexity, they must have been developing the lighting control system for months. We telephoned the patent office to check on our patent and they told us that the renewal fee due earlier this year has not been paid. We are surprised because we use a renewal service to send us reminders and pay renewal fees on our lighting control system patent GB2202020. We are worried that our patent has lapsed and we would like to get it back and stop our competitor selling their system. Is this possible?”

Make notes for a meeting with the client, detailing the questions you would ask and the consequences of the answers. Detail also any investigations you would make prior to the meeting.

(20 marks)

7. 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; (3 marks)
 - b) divisional application (do not discuss time limits or formal requirements); (4 marks)
 - c) compulsory licence; (5 marks)
 - d) sufficiency of disclosure; (4 marks)
 - e) contributory infringement. (4 marks)
8. Discuss two of the following cases:
- a. 'Catnic' or 'Improver', either one - at your choice (claim construction)
 - b. 'United Wire v. Screen Repair Services' (repair of patented product)
 - c. 'Du Pont's (Witsiepe's) application' (anticipation – selection)
 - d. 'Lux Traffic v. Pike Controls' (novelty – prior use)
- (20 marks)

9. Explain the provisions of the Patents Act 1977 relating to amendment of applications and patents, and those relating to making a correction. Highlight the differences between amendment and correction.

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)

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EXAMINERS COMMENTS

General

Candidates are expected to have knowledge of and understand the basic provisions of the Patents Act 1977. The syllabus lays out what Sections are most important for this paper. Candidates are not expected to have a detailed knowledge, nor are they expected to discuss issues of copyright, design right, or other intellectual property, nor discuss aspects of foreign law, including European and PCT law. Accordingly, marks are awardable only for making points relevant to UK patent law.

Some questions expect just a discussion of the relevant provisions of the Patents Act, although in some questions there will also be marks available for stating what practical considerations you would also take into account. For example, to restore a lapsed patent, it is necessary to provide evidence showing that reasonable care was taken to ensure that the renewal fee was paid on time. The facts of the question might even allow it to be stated what evidence might be provided, e.g. a copy of the instructing letter to the person responsible for paying the fee, or an affidavit sworn by the person who relied on an error in a document indicating that the fee had been paid (these are not necessarily related to any question in the 2003 paper, but are stated as examples). This kind of information is much more important, in real life as well as in answering this paper, than details of the exact time limit for filing a response to an opposition to an application to correct an application, and details of the form that needs to be used, for example.

It is critical to know the relevant legislation, and candidates who can paraphrase the relevant law at appropriate points typically score fairly well. However, it is more important to have an understanding of what the law means, since otherwise it is easy to answer questions wrongly. One example where this was particularly prominent is in question 1(c) of the 2003 paper. Almost all of the candidates knew that a claim could have more than one priority date, presumably because this is written in statute. However, few candidates seem to have thought about how this might occur, and many guessed (wrongly) in what circumstances this might happen. Only those candidates that had taken the time to think about and understand the statutory provision could correctly state that a claim including alternatives, with the alternatives having different dates, could have more than one priority date.

Q1

- a) Most answers failed to say what a priority date was. The phrase from Section 5(2)(a) “supported by matter disclosed in the earlier application” was expected. This issue is particularly important because the state of art determined with respect to priority date.

- b) Many candidates mistakenly discussed divisional and replacement applications, but these are afforded the filing date of the application from which they are derived, so are not relevant to this question. The answer concerns occasions when the 12 month anniversary falls on a day when the Patent Office is closed. Wrongly, some thought that the late filed drawings provisions of Rule 2.3 could allow you to circumvent the provisions of Section 5(2).
- c) Many candidates failed to explain the circumstances, which is what the question asked for, although most were aware (by S.125(2)) that a claim could have 2 dates. Many incorrectly discussed a claim having feature combinations not found in a priority application. See also the general comments above.
- d) This required a discussion of when certified copies and any verified translations needed to be filed. Marks were awarded for mention of possible extensions of time.

Q2 The Examiners were disappointed at the extent of candidates' ignorance of the law surrounding unity of invention. Section 17(6) and (7) and Rule 32 are clear as to the requirements for there being unity, and for a further search to be carried out. Rule 102 deals with refunds of search fees paid in connection with divisional applications.

It is important to be able to determine whether or not two claims are not linked to form a single inventive concept, especially considering the consequences with regard to the costs of additional searches and divisional applications.

Q3. Some candidates were confused as to whether formal drawings (if needed) and an abstract were required before a search report could be issued. The request referred to formal requirements, so novelty and inventive step did not need discussing. A number of candidates thought that a grant fee was payable before grant. Mention of the statement of inventorship was expected if the applicant(s) were not the inventors. Many candidates overlooked the requirements for a filing date, which would need to be met before an application could be searched.

Q4 This was a straightforward question that allowed candidates to write all their relevant knowledge surrounding a particular topic, in this case licenses of right. Marks were awardable for discussing the basic provisions, and also for mention of what is opposable and on what grounds, and what is published in the journal. Marks were not awarded for detailing the exact opposition procedure, since the Examiners do not consider this to be so relevant as other issues which could be discussed. The question required a discussion of what disadvantages there might be, which gave candidates an opportunity to show that they understood what the effects of the provisions are.

- Q5 A self-explanatory question, relating to the prior art effect of European and PCT applications. To what extent a published patent document is useable against a UK patent or patent application is a very important issue, but this question was not generally well answered. Candidates were expected to know that the UK designation fee has to be paid on an EP application for it to be prior art under Section 2(3), and that a PCT application has to enter the UK national phase for it to be prior art under that Section.
- Q6 This question called for a discussion of the late payment of renewal fees, restoration and a brief attention to the question of whether there was infringement. Marks were awarded for discussing the circumstances under which the competitor may have obtained third party rights, and the extent of those rights. Most candidates failed to give due weight to the importance of evidence in restoration proceedings. Licenses of right, compulsory licenses, prior user rights and threats were not issues which needed addressing, and many candidates wasted time needlessly reproducing their knowledge on these topics.
- Q7 Candidates were required to describe the relevant law in terms suitable for consumption by a lay client. Some candidates needlessly discussed time limits for divisional applications, but generally the question was answered well. A mention of requirements for prior art and priority applications to include enabling discourses in order to be effective was expected for part d).
- Q8 A discussion of the main facts, arguments and precedents surrounding two cases was sought. Most of the candidates discussed Catnic or Improver capably, but the other cases were generally badly addressed. Sitters of this paper are expected to have read and understood a handful of cases which have set important precedents. House of Lords and Court of Appeal decisions are particularly important, and these are often the easiest to read.
- Q9 This was another question that allowed candidates to write all their relevant knowledge, in this case on the topics of amendment and correction. The Patents Act and Rules treat these issues separately, but it seems that some candidates are confused as to the differences, especially as to what can be amended or corrected and under what circumstances.