

# THE JOINT EXAMINATION BOARD

## PAPER P1

### BASIC UNITED KINGDOM PATENT LAW AND PROCEDURE

8 NOVEMBER 2004

10.0 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 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
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 each 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 equipment **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.

**NO WRITING OF ANY KIND WILL BE PERMITTED AFTER THE TIME 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 are the grounds for revocation of a British Patent?
  - b) Who may file an application for revocation?
  - c) Where can an application for revocation be filed?
  - d) What is the time limit for filing an application for revocation?

10 marks

2. Your client writes

“As you know, I currently have six British Patents, filed between six and twelve years ago. Although you prosecuted the patents to grant for me, I pay the renewal fees myself. I am taking a sabbatical and going abroad for a year, before resuming business when I return, and would like you to outline any options there are for reducing my renewal fee payments, and outline also any options there are for deferring payments without incurring significant additional charges.”

Outline what options your client has, including their advantages and disadvantages, and advise your client what would need to be done to implement those options.

10 marks

3.
  - a) What criteria must an invention satisfy to be a patentable invention?
  - b) What are not treated as inventions for the purposes of the Patents Act 1977 and thus are excluded from patentability?

10 marks

4. By virtue of Section 118 of the Patents Act 1977, after publication of a British Patent Application, the comptroller will on request (and on payment of a fee) provide certain information about the application and allow inspection of documents on the Patent Office file relating to the application.

- a) Explain how a request to be provided with copies of papers from the Patent Office file can be made,
- b) Explain how, and under what circumstances, an applicant for a patent can prevent a document filed from being made publicly available, and
- c) Explain under what circumstances papers from the Patent Office file can be made available before publication, and to whom.

10 marks

5. What is meant by “purposive construction” of claims.

10 marks

**PART B – Answer three Questions from this part.**

6. Provide the below listed information regarding two different cases:

- a) One leading British case having novelty as a main issue; and
- b) One leading British case having inventive step as a main issue.

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 on at least one important precedent set by the case.

20 marks

7. A French associate sends you a copy of a published PCT application designating, *inter alia*, the UK and including an EP (GB, DE, FR) designation. The application was published in French with a search report very recently, on 27 October 2004, and has a filing date of 25 April 2003 and no priority claim. No amendments to the PCT application have been made. The associate explains that the applicant has been selling the product which is the subject of the application throughout Europe for a year or so. She explains also that a rival product has just appeared on the British market which seems to be a clear infringement, and that the applicant wants to stop this as soon as possible. The associate will prosecute the European application to grant (in French) and then validate in the UK, but also wants you to file a UK national phase and to get it granted as soon as possible since it could take some time to get the European application granted. The associate will provide you with all the documents you ask for relatively quickly.

Make notes indicating:

- a) What documents you will need, and what actions you will need to take to get a British Patent granted as soon as possible. You do not need to discuss deadlines.
- b) What advantages will flow from having a British granted whilst waiting the European application to be granted, and
- c) What the consequences would be of eventually having a UK patent and an EP(UK) patent granted. Consider the possibility that the claims of the two patents may be of different scope.

20 marks

- 8.
- a) What acts constitute infringement of a British 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) Explain any differences in the remedies available in proceedings before a court compared to proceedings before the Comptroller.
  - f) Who may bring an action for infringement?

20 marks

9. Comment on the following statements:

- a) If an inventor's contract of employment states that all inventions made automatically belong to his or her employer, it is not possible for the inventor to benefit from any of their inventions in any way.
- b) If two companies jointly own a patent, neither company has any say in what the other company does in relation to the patent and the invention.
- c) My company can make and sell the exact same product described in our competitor's published patent application without fear of penalty as long as we stop doing it before the patent is granted, since only then can the competitor stop us.
- d) Our company does not check what patents our competitors have because we cannot be held to infringe what we do not know about.

20 marks