

THE JOINT EXAMINATION BOARD

PAPER P1

Basic United Kingdom Patent Law and Procedure

Monday 5th November 2007

10.00 a.m. – 1.00 p.m.

*Please read the following instructions carefully. Time Allowed – **THREE HOURS***

1. You should attempt **only FOUR questions from Part A and only 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. If more than the required number of questions are answered in any Part, then the final question of that Part will not 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 **six** pages, including this page.

Part A – Answer four questions from Questions 1 to 5

1

- a) A document was lodged in a public library before the priority date of an application filed under the UK Patents Act 1977 as amended. It can be proved that it had not actually been read before the priority date. Should the document be treated as prior art?
- b) Does marketing a product prevent any new use for the product being patented?
- c) What are the limits on prior user rights (the right to continue use begun before the priority date of a patent) acquired by virtue of the provisions of the UK Patents Act 1977?

(10 marks)

2

- a) Explain the procedure for obtaining a Declaration of Non Infringement for a client under the UK Patents Act 1977 as amended. Assume that proceedings for Infringement have not been commenced against your client.
- b) What are the provisions in the UK Patents Act 1977 as amended for obtaining relief against a groundless threat of infringement of a UK Patent? Assume that the threat in question was made after 1 January 2005.

(10 marks)

3

- a) On an application filed under the UK Patents Act 1977 as amended, what criteria must be satisfied for an application to be afforded a filing date?
- b) On such an application, what further requirements must be satisfied for the application to be published under Section 16 of the UK Patents Act 1977 as amended? Ignore the possibility of the application being subject to a security order.

(10 marks)

4

- a) What provisions are there for amendment of an application filed under the UK Patents Act 1977 as amended?
- b) What provisions are there for amendment of a Patent granted on such a UK Patent application?

(10 marks)

5 Under the UK Patents Act 1977 as amended:

- a) Under what circumstances can a divisional application be filed? When can it be filed?
- b) What documents must be filed, and by when, for a divisional application. What criteria must be met for the divisional application to be accorded the filing date of its parent?

(10 marks)

Part B – Answer three questions from questions 6 to 9:

- 6 You have just written to your client to report a combined Search and Examination Report on his application. The application has ten claims. The Report covers only claims 1 to 5 on file and, although the Examiner has objected to claim 1 on the ground of lack of inventive step, you suggest a simple amendment to this claim will overcome this.

The application is due to be published under Section 16, UKPA 1977 as amended, in April 2008. The Examiner has set 1 November 2008 as a date by which a response to the examination report is due.

Your client responds to your letter by indicating that your proposed amendment is fine. He also tells you that both ideas are proving quite successful. He is worried about other people using his idea but he is not sure he wants to file a divisional application just yet.

Advise your client on the best course of action. Mention any action that should be taken to secure the client's rights, and what action can be taken before a divisional application needs to be filed.

Detailed discussion of the requirements for filing a divisional application is not required.

(20 marks)

- 7 You receive an email from a French client. The email notes that they sent instructions to you over two months ago to file a UK Patent Application, claiming priority from a French patent application with filing date of 6 September 2006. They are concerned that they have not received a confirmation from you that you have filed the application. With the email, your client sends a copy of his original instructing letter, which provides the filing date and application number of the French patent application.

It appears that the instructions were never received by you.

What can be done in relation to filing the application? Identify the actions that need to be taken, and by when, in order to secure a filing date for the application, and such that the application can proceed to Preliminary Examination and Search (Section 17 UKPA 1977 as amended), and Publication (Section 16 UKPA 1977 as amended).

(20 marks)

- 8 You receive a letter from Mr Bloggs at your long standing client, Aspinall & Co. He tells you:

“I’ve recently taken over the management of Aspinall & Co, from the previous managing director, Mr Cox, who has recently retired. Mr Cox had managed the patent portfolio for a number of years and, looking at things, there had been no problems until the last few months of his time here. I think things just got a bit too much for him.

I’ve found the following matters which make me think we’ve got quite a lot to catch up on:

- a) I have a letter from you reminding us to request examination on our pending UK Patent Application 0612345.1. I understand that the due date for doing this was 15 October 2007, so I’m concerned that we’ve missed the deadline. We need to continue this application to prevent a major competitor gaining on us in the market.
- b) I have found records of a UK Patent (GB 2234567) which appears to have been granted some time ago. Your reminder letter suggests to me that a renewal fee was due on 2 March 2007. I doubt this was paid. Again, this patent is crucial as we are about to conclude a deal with a potential licensee of the patent.
- c) You sent us a letter some time ago concerning an Examination Report on our pending UK Patent Application 0434567.3. I am concerned that we have not dealt with this, as the issues which you reported in this letter were relatively straightforward and I see that you’ve suggested a solution. I’m happy with the solution, but the due date for response was 30 September 2007.
- d) We’ve just threatened a competitor (our letter dated 1 September 2007) with infringement of another UK patent (GB 2298765) which we acquired in June 2006. I’ve just checked the Register and the patent is still in the name of the company from which we acquired it. Is this a problem?

I know that you’ve been working with Aspinall & Co for a long time, so I trust you will sort this out for me as well as you can. Please take whatever action needs to be done to strengthen our position and advise us on anything which could limit our rights.

Set out the actions you would take in each case, and, if appropriate, any concerns which should be brought to the client’s attention. Identify any relevant provisions of the UK Patents Act 1977 as amended which support your answer.

(20 marks)

9 In the context of UK Patent Law, write brief notes on the following:

- a) A direct product of a patented process
- b) Compensation for employees' inventions
- c) Purposive construction
- d) Provisional protection

(20 marks)