

THE JOINT EXAMINATION BOARD

PAPER P1

Basic United Kingdom Patent Law and Procedure

Monday 10th November 2008

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 be ignored.
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 four pages including this page.

Part A - Answer four questions from Questions 1 to 5

1. Under the UK Patents Act 1977 as amended:
 - a) What is the maximum term of a Patent granted on a UK Patent application?
 - b) Explain whether a UK Patent application can claim priority from the following:
 - a. A Spanish application for a Registered Design
 - b. A German application for a Utility Model (Gebrauchsmuster)
 - c. A French application for a Patent
 - d. An International (PCT) patent application.

(10 marks)
2. According to the provisions of the UK Patents Act 1977 as amended,
 - a) who may apply for a patent?
 - b) who may be validly granted a patent?

(10 marks)
3. Under the UK Patents Act 1977 as amended:
 - a) What are the grounds for revocation of a patent granted on a UK Patent application?
 - b) Who may apply for revocation?

(10 marks)
4. In relation to the UK Patents Act 1977 as amended, explain the meaning of the following terms:
 - a) False marking
 - b) Direct product of a patented process
 - c) Surrender of a patent

(10 marks)
5. With reference to the provisions of the UK Patents Act 1977 as amended:
 - a) Which criteria must be met before the Comptroller will refer an application for a patent under the UK Patents Act 1977 for preliminary examination?
 - b) What is preliminary examination looking for?

(10 marks)

Part B – Answer three questions from Questions 6 to 9

6. Provide notes on two leading cases of the British courts. One case should have claim construction as a main issue; the other case should have novelty or obviousness as a main issue.

For each case, provide the following information:

- i) The parties to the case
- ii) A summary of the facts and issues relevant to the decision
- iii) An outline of the decision; and
- iv) What precedent is set by the case.

(20 marks)

7. Your client, Rosetree Trading Limited, a manufacturer of garden hoses in the U.K., writes:

“Our biggest customer for our new garden hose (Garden Retail plc) emailed me this morning to let me know that they had received a letter from one of our competitors (Privet Systems Limited). I have attached a copy of the letter for your perusal. We are worried that Garden Retail will stop buying our new garden hose. They have indicated that they may cancel their next order, if this doesn't get sorted out. Our new hose is the same as the Privet hose. Please advise what we should do.”

The letter from Privet reads as follows:

“Privet Systems is the proprietor of UK Patent GB2147323. A copy of the patent is attached. The patent contains three claims, which are directed to:

- 1. *a garden hose*
- 2. *a method of attaching the garden hose to an outside tap; and*
- 3. *a method of manufacturing the garden hose.*

Each of these claims is infringed by a product that you are selling. This is the Rosetree garden hose, which is identical to hose shown in our patent application. We ask that you immediately stop selling this product, and give all remaining stock to us without delay. Your sales of this product are severely damaging to our business. We look forward to receiving confirmation by return that you will agree to this.”

You check the Register and find that the patent referred to by Privet has a filing date of 3 September 1998. The renewal fee due in September 2008 has not yet been paid.

Which patent claims might be infringed by (i) Garden Retail, (ii) your client? Explain why.

What is the position if the renewal fee due in September 2008 is not paid within the allowed 6 months extension period.

Set out briefly what actions might be taken by your client. Ignore any matters relating to trade marks, designs or copyright.

(20 marks)

8. Write notes, suitable for inclusion in a letter to a client, on **four** of the following issues in relation to the provisions of the UK Patents Act 1977 as amended:

- a) Unity of invention
- b) Damages and Account of Profits
- c) Correction of an error in a patent application
- d) Joint ownership of a UK Patent
- e) Recordal of a licence on the Register

(20 marks)

9. Comment on **four** of the following statements:

- a) We don't put details of our patent rights on our products because we don't want our competitors to know about them.
- b) My computerised betting system falls within the claims of a UK patent, but if I put my computer system off shore, for UK customers to use on-line, I can avoid infringement of the patent.
- c) I am delivering a paper to a conference today and I therefore filed it as a patent application yesterday at the UKIPO. I will top it up with further information and claims next week.
- d) Medical diagnostic methods are always unpatentable.
- e) Once my company's UK patent application has been published, I can sue competitors for damages.

(20 marks)