

**THE JOINT EXAMINATION BOARD**

**PAPER P1 - Basic UK Patent Law and Procedure**

**Monday 7<sup>th</sup> November 2011**

**3.00 p.m. – 6.00 p.m.**

*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 4 pages including this one.

## **PART A**

### **Question 1**

Summarise the provisions of the UK Patents Act 1977 relating to:

- a) Withdrawal of a UK patent application by the applicant; and
- b) Surrender of a granted UK patent.

In each case, explain any consequences of the provisions.

**[10 marks]**

### **Question 2**

What, for the purposes of the UK Patents Act 1977, is not an invention?

**[10 marks]**

### **Question 3**

According to the UK Patents Act 1977; under what circumstances do the following documents count as prior art to a non-convention UK patent application if they are published after the filing date of that UK patent application:

- i) A GB patent application;
- ii) A EP application having GB as a designated state;
- iii) A PCT application designating GB; and
- iv) A PCT application designating the EPC?

**[10 marks]**

### **Question 4**

Explain what is meant by the type of infringement which is commonly referred to as "contributory" or "indirect" infringement and which is defined in Section 60(2) of the UK Patents Act 1977.

To which act(s) does an allegation of "contributory" infringement not apply?

**[10 marks]**

### **Question 5**

List five proceedings in which the validity of a granted UK patent may be put in issue? Do not consider Opinions by Patent Office provided under Section 74A of the UK Patents Act 1977.

**[10 marks]**

## **PART B**

### **Question 6**

Your client writes:

"I used to work in the warehouse for a car manufacturer in Oxford. One day, when I was strapping my children into their car seats, I came up with the idea of making plastic covers for the seat belt in the shape of animals in the hope it would make it easier to get the children to sit still. I filed a GB patent application for the clip that holds the animal to the seat belt. The application has now been granted, and I now sell my products through various outlets as "Aniclips". These have really taken off and I have recently left my job to concentrate on this full time.

Last week I received a letter from my ex-employers, alleging that they owned the invention and I should assign it to them immediately. In addition I noticed that they have started selling "KiddyClips" as accessories at their dealerships and online. These clip onto the seat belt in the same way as my Aniclips do, and come in similar colours and animal shapes."

You check the Register. Your client has a granted patent and it is in force. A search reveals no prior art additional to that found by the UKIPO, and in your view the claims are valid. On examining the KiddyClips product it appears to fall within the claims of the granted patent.

Advise your client on:

- i) The circumstances in which the "Aniclips" invention might belong to your client's former employer.
- ii) What questions would you have to ask to determine ownership of the "Aniclips" invention?
- iii) If your client were to sue for infringement and be successful, what remedies could he get?

Restrict your answer to a consideration of patent rights. Do not consider trade mark, design rights or copyright as part of your answer.

**[20 marks]**

### **Question 7**

In accordance with the UK Patents Act 1977, explain the following:

- a) What are the minimum requirements for a UK patent application to be given a filing date?
- b) In addition to the minimum requirements, what is required to complete the filing of a patent application?
- c) What is the purpose of an abstract and how does it form part of the state of the art?
- d) What criteria should the claims of a patent application meet?

**[20 marks]**

### Question 8

Your client has a granted European patent designating the UK. The patent is based on an application filed and prosecuted at the EPO in German. Your client is aware of a potential infringer. An English translation of the granted patent has been filed at the UKIPO and subsequently published by the UKIPO.

Your client tells you that the English translation of the granted claims contains two errors. The first is a typographical error in claim 1, where the word "inorganic" has been spelled "onirganic". The second is that the wording of claim 1 is significantly narrower in English than in the original German.

- a) What is the authentic text of the granted EP(UK) patent?
- b) What can you do before the UK IPO to correct both errors?

The potential infringer is based in the UK and is acting outside the scope of the English translation of the granted claims but within the scope of the granted German claims.

- c) Does this potential infringer have a defence to infringement, and if so, what is it?

[20 marks]

### Question 9

Your client writes:

"I filed a UK patent application eight months ago and wrote it myself. It covers a locking wheel nut for undoing alloy wheels. The locking wheel nut has three flanges to help you grip and apply force to turn each wheel nut. Being able to do this easily has been a long-standing problem, and no product on the market has ever been as easy to use. After filing, I talked to a well-known tyre company, Wheely's Tyres about distributing the locking wheel nuts to all their UK outlets, and they would now like to use it in their outlets. However, since then I've discovered that it works just as well with two flanges, and this version is cheaper to make. I'd like to make and sell both. I'm worried though that other people may try to copy my idea. What can I do?"

You review the application and the claims are all limited to a locking wheel nut having exactly three flanges. There is no mention in the application of a locking wheel nut with only two flanges. You also carry out a search and discover one document that is relevant to the claims, US 1,400,001, published in 1958. This document teaches that it is not possible to achieve enough force to turn a wheel nut with fewer than four flanges, and discloses only locking wheel nuts with more than three flanges.

Advise your client on:

- a) Whether he can amend his patent application to cover the two flange embodiment.
- b) If he cannot amend the patent application; what alternatives are there?
- c) Is a claim to a two-flange locking wheel nut likely to be inventive over US'001?
- d) What secondary factors could be taken into account when considering inventive step?

[20 marks]