

P1 – Basic UK Patent Law and Procedure

Friday 3 October 2014

2.00 p.m. – 5.00 p.m.

Time allowed – THREE hours

INSTRUCTIONS TO CANDIDATES

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.
3. If more than four questions are answered in Part A, or more than three questions are answered in part B, only the first four or three presented in each respective part will be marked.
4. Start each question (but not each part of each question) on a fresh sheet of paper.
5. Enter the question paper reference number (P1), the question number, and your candidate number in the appropriate boxes at the top of each sheet of paper.
6. The scripts are photocopied for marking purposes.
 - a. Use **black ink**.
 - b. Write on one side of the paper only.
 - c. Write within the printed margins.
 - d. Do not use highlighter pens on your answer script.
7. Do not state your name anywhere in the answers.
8. Write clearly: examiners cannot award marks to scripts that cannot be read.
9. Reasoning should always be given where appropriate.

INFORMATION FOR CANDIDATES

1. The total number of marks for this paper is 100.
2. At the end of the examination the invigilator will instruct you to:
 - a. count the number of pages you have used;
 - b. use the boxes on each page of the answer script to number pages in the format "1 of 25, 2 of 25 etc";
 - c. place your answer sheets in order in the white envelope, seal the envelope and leave the envelope on the desk.
3.
 - a. Do not staple the pages, or use sellotape or treasury tags.
 - b. You may take the examination paper with you.
4. This question paper consists of 5 pages in total, including this page.

Part A

Question 1

In this question assume that the only relevant prior art is the prior art referred to in the question.

- a) Client A demonstrated their invention at an exhibition. The invention is a black box having input and output ports. Whilst the public could see what the box does, it was not possible to determine how this was achieved. Can the client still obtain a GB patent for the invention?

3 marks

- b) Client B writes 'we recently showed our invention to a customer. The customer is now making and selling the invention. Can we still obtain a GB patent for the invention?'

Advise Client B.

3 marks

- c) Client C writes 'We recently filed a GB patent application for two embodiments of our invention. The day after filing, a GB application in the name of our competitor was published. This discloses the first of our embodiments but not the second. Can we still obtain a GB patent?'

Advise Client C.

4 marks

Total: 10 marks

Question 2

- a) Methods of treatment or diagnosis are not patentable. Summarise the provisions of the UK Patents Act 1977 relating to such methods.

6 marks

- b) Your client has invented a method of immunisation (i.e. one which prevents rather than cures a disease). Is the method excluded from patentability?

1 mark

- c) Your client has invented a method of diagnosis of a human disease in which a patient's blood is tested in a test tube. Is the method excluded from patentability?

1 mark

- d) Your client claims to have invented a perpetual motion machine. List two grounds on which UKIPO is likely to object to an application for the invention.

2 marks

Total: 10 marks

Question 3

- a) A first GB patent application is filed on 1 October 2013. A second GB application is filed on 1 October 2014 without claiming priority from the first. Is it still possible to add a priority claim to the second application to claim priority from the first? If so, what is the time limit for doing so and what extensions of time are available? Outline the procedure.

4 marks

- b) A first GB application is filed on 1 October 2013. A second GB application is filed on 5 October 2014. Is it still possible to add a priority claim to the second application to claim priority from the first? If so what is the time limit for doing so and what extensions of time are available? Outline the procedure.

6 marks

Total: 10 marks

Question 4

Under the UK Patents Act 1977, what acts constitute infringement of a patent for a process?

10 marks

Total: 10 marks

Question 5

- a) What is the time limit for filing a statement of inventorship in respect of a GB patent application? What extensions of time are available?

3 marks

- b) What is the time limit for filing a statement of inventorship in respect of a GB divisional patent application?

3 marks

- c) An inventor informs you that he does not wish to have his name and address (or at the very least his address) published. How would you proceed and by what time limit?

3 marks

- d) What is the consequence of failure to file a statement of inventorship in respect of a GB patent application?

1 mark

Total: 10 marks

Part B

Question 6

Provide notes on opinions by UKIPO. Your notes should cover the following.

- a) On what issues UKIPO will issue an opinion. **3 marks**
- b) On what grounds UKIPO may refuse to issue an opinion. **3 marks**
- c) Who may file the request for an opinion. **1 mark**
- d) The procedure followed through to issue of the opinion (including actions that can be taken by third parties). **7 marks**
- e) Review and appeal. **6 marks**

Total: 20 marks

Question 7

Your client has recently acquired a portfolio of GB patents and applications from a third party. None of the patents or applications has a priority date. Write notes on the actions that need to be taken for each of these.

- a) Patent D1 was filed on 31 January 2010 and granted on 30 September 2014. Inspection of the register shows that no renewal fees have been paid. **3 marks**
- b) Application D2 was published on 28 March 2014. Inspection of the register shows that no request for examination was filed. **5 marks**
- c) For application D3 an examination report was issued on 30 May 2014 setting a four month time limit for response. No response was filed. **2 marks**
- d) Application D4 was filed on 1 January 2008. An examination report was issued on 17 February 2014 raising a non-unity of invention objection and setting a three month time limit for filing a response. A response was filed on time restricting the claim set to one of the two inventions only. No reply has been received from UKIPO to date. **6 marks**
- e) Application D5 was filed on 1 September 2013. A request for search has been filed and the filing and search fees paid. This application is of particular interest to the client as they are aware that many of their competitors are starting to develop products in this field in the UK. **2 marks**

There are a further 2 marks available for general points.

2 marks

2 marks

Total: 20 marks

Question 8

- a) Your client writes 'We hold a licence to a GB patent but never recorded it. As we understand it we are the only company that holds a licence to the patent. Can we sue a third party for patent infringement and to what extent does the patent proprietor need to be involved?'

Advise your client.

10 marks

- b) Your client writes 'We have been selling our patented product for many years. The patent has however come to the end of its 20 year life. We have asked our suppliers to make sure that any new product they supply to us is no longer marked as patented but we are still running down our old stock fulfilling pre-existing orders placed when the patent was still in force. One of our competitors has now requested that we cease providing product marked as patented. This would mean we have to scrap all our existing stock. This would significantly damage our business. What should we do?'

Advise your client.

4 marks

- c) What are the remedies for a groundless threat of infringement and what acts are specifically identified as not being threats?

6 marks

Total: 20 marks

Question 9

Provide notes on two leading cases of the British Courts. For each case your notes should cover the parties to the case, a summary of the facts of the case, a summary of the decision and a brief discussion of what precedent is set by the case. One case should have claim construction as a main issue. The other should have novelty or inventiveness as a main issue.

Total: 20 marks