

UK Patent Law FC1 (P1)

Friday 16 October 14:00 to 17:00

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 the required four questions are answered in Part A, or more than the required three questions are answered in Part B, only the first four or three presented in each respective part will be marked.
4. The total number of marks available for this paper is 100.
5. Start each question (but not each part of each question) on a new sheet of paper.
6. Enter the question number in the appropriate box at the top of each sheet of paper.
7. Do not state your name anywhere in the answers.
8. Write clearly as examiners cannot award marks to answer scripts that cannot be read.
9. The scripts may be photocopied for marking purposes.
 - (a) Use only **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.
10. Instructions on what to do at the end of the examination are on the Candidate Cover Sheet.
11. This question paper consists of 7 sheets, including this sheet.

PART A

Question 1

- a) UK patent application B claims priority from UK patent application A. What test must the subject matter of A satisfy in relation to the invention of B for the priority claim to be valid?

1 mark

- b) UK patent application B was filed exactly 12 months after the filing date of UK patent application A. On reviewing the file a week later, you notice the priority claim to application A was accidentally omitted. How would you proceed and by when? Can this deadline be extended?

3 marks

- c) Your client has only one patent application (a UK application). They wish to withdraw this patent application and refile it to 'regenerate' their priority date. What conditions must be met for this to be possible?

3 marks

- d) What documents must be filed and by when to support a priority claim in a UK patent application from a non-UK application?

3 marks

Total: 10 marks

Question 2

You have filed a UK patent application. It does not claim priority. What prior art effect do the following documents have:

- a) A UK application with a filing and publication date before the filing date of your application?
1 mark
- b) A UK application with a filing date before the filing date of your application. It has not as yet been published?
2 marks
- c) A European application filed before the filing date of your application and published after the filing date of your application?
1 mark
- d) A PCT application designating the UK as a national designation (there is no EP designation) filed before your application but published after?
3 marks
- e) A US application filed before the filing date of your application but published after the filing date of your application?
1 mark
- f) A secret UK patent application the publication of which has been prohibited?
1 mark
- g) A document lodged in a public library before the filing date of your application which has never been read?
1 mark

Total: 10 marks

Question 3

Describe briefly one decision of the UK courts relating to novelty or inventive step. You should provide:

- a) the identities of the parties; **1 mark**
- b) a summary of the facts and issues; **2 marks**
- c) a summary of the decision; **2 marks**
- d) a discussion of the precedent set by the decision. **5 marks**

Total: 10 marks

Question 4

- a) What is meant by contributory infringement as defined by Section 60(2) of the UK Patents Act 1977? **5 marks**
- b) What acts are specifically identified as not being acts of contributory infringement in Section 60(3) of the UK Patents Act 1977? **5 marks**

Total: 10 marks

Question 5

- a) On what grounds may a UK patent be revoked? **5 marks**
- b) Who may apply for revocation and when? **5 marks**

Total: 10 marks

PART B
Question 6

a) Explain what is meant by 'purposive construction'. **1 mark**

b) List the Improver questions. **8 marks**

c) Your client owns a UK patent for a roller. The roller has a plurality of pyramidal teeth on its outer face. In use the roller is rolled over a thin sheet of metal to produce a pattern in the sheet. This pattern increases the flexibility of the sheet. It is known in the prior art to use a roller having a plurality of domes on its outer face. Use of the new roller results in a significant increase in the flexibility of the sheet.

Claim 1 of the patent reads 'A roller for use on a metal sheet, the roller having an outer face having a plurality of pyramidal teeth extending outwardly from the outer face.'

The client has provided you with a plurality of rollers manufactured in the UK by competitors and would like to know if manufacture of any of these rollers is an infringement of the patent:

i) **A roller having a plurality of domes on its outer face.** **1.5 marks**

ii) **A roller having a plurality of cubic teeth on its outer face.** **1.5 marks**

iii) **A roller having a plurality of generally pyramidal teeth on its outer face. The top of each tooth is domed.** **4 marks**

Justify your answers. You may wish to employ the Improver questions where appropriate.

d) Your client's patent also includes a claim to a method of manufacture of a metal sheet by use of such a roller. Your client has identified a UK distributor of a metal sheet having a plurality of pyramidal indentations in a face. The sheet is manufactured abroad. Does the distributor infringe your client's patent? **4 marks**

Total: 20 marks

Question 7

Your rather unscrupulous client Mr D Geezer visits you to ask for your opinion on various aspects of his business practice.

For each of the following, provide general advice limiting your advice to UK patent law only.

- a) **One of my employees invented something which is becoming commercially very valuable. The contract of employment states that anything invented by an employee is the property of my company and that employees have no financial claim on profits from any inventions they may invent. Can the employee obtain compensation? If so where would they need to apply and by when? What factors would be taken into account when determining if an award is to be made in the employee's favour?**
8 marks

- b) **Going forward I intend to just name myself as sole inventor for any invention made by any of my employees. My employees have agreed to this.**
3 marks

- c) **We often copy the products of our competitors. We intentionally do not check to see if they have patents because if we do not know about it we are not guilty.**
5 marks

- d) **For one product we are copying we are aware that our competitor has a published patent application covering it. We intend to keep on manufacturing until the patent is granted then stop so that we do not infringe the patent.**
4 marks

Total: 20 marks

Question 8

Your client has this week acquired a portfolio of UK patents and applications from a third party, listed below.

Prepare notes for a meeting with the client on each of the patents and applications in the portfolio. The notes should summarise what steps you suggest taking in the near future and by when. For Document D3 you should also consider third party rights.

- a) **UK patent D1 was filed on 31 August 2010 and was granted on 3 September 2015. To date no renewal fees have been paid.**
3 marks

- b) **UK patent application D2 was filed on 20 October 2014. The application does not claim priority. Only a description and drawings along with a form 1 naming the third party as applicant were filed. Your client has, however, made their own developments to the invention described in this first application which they also wish to cover. You only need to consider the documents that need to be filed up to publication.**
5 marks

- c) **UK patent D3 has been granted. Renewal fees fell due on 31 March 2014 and 31 March 2015 and have not been paid.**
12 marks

Total: 20 marks

Question 9

- a) Inspection of the register of the UK Intellectual Property Office shows that a patent has been marked 'licences available as of right'. What does this mean?
2 marks

- b) What is the procedure for and effect of endorsing a patent as 'licence of right'?
11 marks

- c) Can the holder of a licence of right bring proceedings for patent infringement? What is the position and liability of the licensor in such proceedings?
4 marks

- d) What is the difference between a sole licence and an exclusive licence? Why is this important in infringement proceedings?
3 marks

Total: 20 marks