

Foundation Certificate

UK Patent Law FC1

Friday 13 October 2017 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. Any candidate script removed from the examination room will not be marked.
12. This question paper consists of eight sheets, including this sheet.

Part A

Question 1

In relation to UK patents:

- a) Who can apply for a patent?
2 marks
 - b) To whom may the patent be granted?
4 marks
 - c) Under what circumstances must a statement of inventorship be filed?
1 mark
 - d) When must the statement of inventorship be filed and what extension of time is available, if any? You are not required to consider divisional applications.
3 marks
- Total: 10 marks**

Question 2

- a) With reference to section 30(6)(b) of the *UK Patents Act*, a patent assignment document is void unless two conditions are satisfied. What are these conditions?
1 mark
 - b) Describe the procedure for recording an assignment at the UK Intellectual Property Office.
2 marks
 - c) Describe two potential consequences of a failure to record an assignment within six months of execution.
4 marks
 - d) With reference to section 36(3) of the *UK Patents Act*, what rights are not exercisable individually by one of the co-owners of a patent without the consent of the other co-owners?
3 marks
- Total: 10 marks**

Question 3

Your client is considering filing an application for a declaration of non-infringement under section 71 of the *UK Patents Act*.

- a) What must have occurred before the Comptroller will consider such an application?
4 marks
- b) What is the effect of a declaration of non-infringement?
3 marks
- c) Explain whether a declaration of non-infringement made by the Comptroller differs in effect to a declaration of non-infringement made by the court.
1 mark
- d) Describe two situations in which the ability to file an application for a declaration of non-infringement would be useful to a client.
2 marks

Total: 10 marks

Question 4

Write notes on one leading patent case of the British courts. The case should have claim construction as a main issue. Your notes should cover the following:

- a) parties to the case;
1 mark
- b) summary of the facts of the case;
2 marks
- c) summary of the decision;
2 marks
- d) discussion of precedent set by the case.
5 marks

Total: 10 marks

Question 5

This question relates to withdrawal of UK patent applications (section 14 *UK Patents Act*) and surrender of UK patents (section 29 *UK Patents Act*).

Withdrawal

- a) When may a UK patent application be withdrawn?
1 mark
- b) What is the effective date of withdrawal of a UK patent application?
1 mark
- c) Who may withdraw a UK patent application?
2 marks
- d) Describe the requirements for withdrawing a UK patent application.
2 marks

Surrender

- e) When may a UK patent be surrendered?
1 mark
- f) What is the effective date of surrender of a UK patent?
1 mark
- g) What are the consequences of surrender of a UK patent?
2 marks

Total: 10 marks

PART B

Question 6

- a) Discuss how obviousness is assessed. Pay particular attention to the 'Windsurfing/Pozzoli' approach.

10 marks

- b) On 3 January 2017, your client filed a patent application for a surgical instrument which has three fingers and which is used to pull cylindrical objects such as bullets from patients. You have reviewed the application and it has one claim drafted to a surgical instrument having exactly three fingers. The description comprises one embodiment having exactly three fingers. Your client informs you it has now developed a further version having two fingers, which they would also like to protect.

There are two pieces of prior art which you need to consider when answering this question:

A – An earlier UK patent application filed in 1957 which discloses a similar surgical instrument but having four fingers. This document teaches it is impossible to grip a bullet with fewer than four fingers.

B – An earlier UK patent application filed on 20 December 2016. This discloses an attachment for a crane having two fingers which is used to pick up pipes. This application has not as yet been published.

- i) **Advise your client on whether it is possible to amend the patent application to cover the two-finger embodiment. If not, what alternatives are possible?**

4 marks

- ii) **In relation to the three-finger embodiment, how would you address these two earlier documents if they were to be cited by the examiner during examination?**

6 marks

Total: 20 marks

Question 7

By what procedure and by how much can each of the following deadlines be extended? Is the extension discretionary or as of right?

(There is no need to consider reinstatement or restoration.)

- | | |
|--|----------------|
| a) Filing a certified copy of the priority document. | 5 marks |
| b) Payment of a renewal fee. | 3 marks |
| c) Responding to an examination report. | 4 marks |
| d) Filing a divisional application. | 8 marks |
| Total: 20 marks | |

Question 8

In the context of the *UK Patents Act*, discuss:

- | | |
|--|----------------|
| a) infringement of a patent for a process by dealing in a product of the process; | 6 marks |
| b) the provisions of section 23 (restrictions on applications abroad by UK residents).
You are not required to discuss the penalties for contravention of this section; and | 6 marks |
| c) third-party observations. | 8 marks |
| Total: 20 marks | |

Question 9

An associate in Japan writes:

'We filed a PCT application on 13 July 2015 in Japanese at the Japanese patent office. The application is for a valve. The application does not claim priority. We amended the claims of the application in the international phase.

We have now become aware of an infringer making and selling an identical valve in the UK. We wish to stop this as soon as possible. We will be filing a European application from the PCT in due course. However, for now we would like you to enter this case into the GB national phase and obtain grant as soon as possible.'

- a) **What steps do you need to take and by when to enter the PCT application into the GB national phase?**

6 marks
- b) **What further steps would you take to expedite prosecution and improve your client's position as regards the infringer?**

4 marks
- c) **Give an advantage that follows from having the GB patent granted whilst waiting for the European application to be granted.**

1 mark
- d) **In due course the GB application is granted. Shortly thereafter the parallel EP application is accepted by the EPO with claims of identical scope.**
 - i) **What issue is likely to arise when the EP application is granted?**

1 mark
 - ii) **What step can be taken at the EPO to avoid this and by when?**

1 mark

Cont...

- e) Following on from part (d), due to an administrative error on the part of the attorney handling the EP application, the EP application is validated in the UK as an EP (GB) patent. In an attempt to correct this error the attorney then surrendered the EP (GB) patent.

i) **Why was surrendering the EP (GB) patent a bad decision?**

1 mark

ii) **What should have been done instead?**

1 mark

- f) The proprietor will shortly receive an invitation from the UK Intellectual Property Office.

i) **Summarise the content of this invitation. What is the earliest date the UK Intellectual Property Office will issue this invitation?**

4 marks

ii) **What test is applied by the UK Intellectual Property Office when considering the response?**

1 mark

Total: 20 marks