

October 2018: Candidate Cover Sheet

Exam Paper: FC1 UK Patent Law

Candidate No:

Venue:

At the end of the examination:

1. Count up the number of sheets you have used which you wish to be marked.
2. Use the boxes on each sheet of the answer script to number the sheets: '1 of 25', '2 of 25' etc.
3. If you have used extra sheets, please add your candidate number and the examination reference to these sheets too.
4. Do not staple the sheets, or use adhesive tape or treasury tags.
5. Write the number of sheets of paper you have put in this envelope here (do NOT include this cover sheet in your calculations).

No. of Sheets	
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6. Place the answer sheets that you wish to be marked in order in the white envelope provided with this sheet uppermost and the examination paper detail and your candidate details **showing through the envelope window**.
7. Seal the envelope and leave it on your desk face up.
8. Leave any spare answer script paper on your desk.
9. You may take the examination paper with you.

For examiner's use only:

	Section A				Section B				Total
	Qu 1	Qu 2	Qu 3	Qu 4	Qu 5	Qu 6	Qu 7	Qu 8	
Marks available	10	10	10	10	20	20	20	20	
Marks awarded									



Foundation Certificate

FC1 UK Patent Law

Friday 5 October 2018 14:00 to 17:00

INSTRUCTIONS TO CANDIDATES

1. You should attempt **all** questions in Section A and any **three** questions in Section B.
2. The marks for each question in Section A are shown next to the question. Each question in Section B carries **20** marks.
3. If more than the required three questions are answered in Part B, only the first three presented 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 will be photocopied for marking purposes.
 - a) Use only **blackink**.
 - 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 seven sheets, including this sheet.

SECTION A

Question 1

Provide notes on the recent *Actavis* decision of the British courts. 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) Precedent set by the case. 5 marks
- Total: 10 marks**

Question 2

With reference to *Section 72 UK Patents Act 1977* ('Power to revoke patents on application'):

- a) who can apply to revoke a patent; and 2 marks
 - b) on what grounds? 8 marks
- Total: 10 marks**

Question 3

- a) With reference to *Section 117 UK Patents Act 1977* ('Correction of errors in patents and applications'), what errors may the Comptroller correct? 4 marks
 - b) What test must be satisfied before the Comptroller will make a correction of an error in the specification of a patent application? 2 marks
 - c) With reference to *Section 27 UK Patents Act 1977* ('General power to amend specification after grant'), describe the procedure for making an amendment to a patent post grant. 3 marks
 - d) From what date does a post grant amendment take effect? 1 mark
- Total: 10 marks**

Question 4

With reference to *Section 46 UK Patents Act 1977* ('Patentee's application for entry in register that licences are available as of right'):

- a) Who may apply to the Comptroller for an entry to be made in the Register to the effect that licences under the patent are to be available as of right? 1 mark

- b) When can such an application be made? 1 mark

- c) What steps will the Comptroller take on receipt of such an application? 3 marks

- d) What are the consequences of a defendant taking a licence of right during infringement proceedings? 3 marks

- e) What two conditions must be met before the Comptroller will cancel a licence of right? 2 marks

Total: 10 marks

SECTION B

Question 5

a) What is a priority date and why is it important?

5 marks

b) With reference to *Section 5 UK Patents Act 1977 ('Priority date')*, explain what is meant by partial priority. Give an example of how this could arise.

5 marks

Your client rings you on a Friday and describes a rubber widget to you that he has developed. You draft and file a patent application P1 for it that day. Claim 1 of the application reads:

1. A rubber widget

Your client rings you again on Saturday. He has discovered that the widget can also be made from metal and in fact he intends to publish a paper relating to the metal widget on Sunday. On the Saturday, you draft and file a new patent application P2. Claim 1 of P2 reads:

1. A widget, the widget being either metal or rubber

P2 claims priority from P1.

You have now received a search report on P2 from the UK Patent Office. The search report cites your client's own paper.

c) Explain how the UK Patent Office can cite the clients own paper even though it was published after P2 was filed. You should give some thought to what filing date the UK Patent Office will award P2.

4 marks

d) What restriction could you make to claim 1 of P2 so that the UK Patent Office could no longer cite the paper? Explain your answer.

2 marks

e) Stepping back to point where you have drafted but not filed P2, how should you have proceeded to ensure all the subject matter obtains a filing date before the date of publication of the paper? At the end of your filing strategy you should have only one pending patent application covering both embodiments

4 marks

Total: 20 marks

Question 6

a) A US attorney writes:

Our client is considering filing a UK application claiming priority from a US application filed on 20 November 2017. The US application contains 35 claims and has 45 pages, including a sequence listing which is two pages long. The client would like to request combined search and examination on filing. We understand that the UK patent office has recently introduced changes to the search and examination fee structure but we are not sure of the details.

Advise the US attorney of the fee changes which would apply when filing the UK application, including what fees are payable, when these are payable and how they are calculated. The exact amount of the fees is not required.

11 marks

b) A few days later, the US attorney writes:

I understand that a grant fee is now payable for some UK applications, but I am not sure how the UK Intellectual Property Office determines whether a grant fee is payable.

Explain the grant fee process to the US attorney, including the circumstances in which the grant fee is payable as well any deadlines or extensions for paying the grant fee.

9 marks

Total: 20 marks

Question 7

Your client has acquired a portfolio of UK patents and applications.

- a) **What actions in relation to the whole portfolio should be undertaken at the UK Intellectual Property Office?**

2 marks

- b) **For each of the UK patents and applications listed below, advise your client as to what actions should be taken within the next six months and by when. For any dates you give, explain how they have been calculated.**

- i) Patent D1 was filed on 10 February 2013. It was granted on 2 October 2018.

5 marks

- ii) Patent application D2 (which has no excess pages and no excess claims) was filed on 28 January 2013 and is pending. A first office action was issued on 28 January 2018. A response has been filed and the Patent Office has yet to reply. The client wishes to file a divisional application.

6 marks

- iii) Patent application D3 is the GB national phase of a PCT application. All necessary steps to enter the application into the GB national phase have been completed. The application was entered into the GB national phase on 1 October 2018. On review of the file, you note the applicants have filed an earlier GB application which is identical to the PCT. There are 13 months between the filing dates of the GB and PCT applications. The PCT does not claim priority from the GB application.

4 marks

- iv) Patent application D4 is an unpublished patent application filed eight months ago. No fees have as yet been paid. Your clients are aware of a potential infringer.

3 marks

Total: 20 marks

Question 8

Your client writes:

I used to work for an automotive manufacturer. I worked in the accounts department. However, since I have a background in chemistry, I was assigned a task of developing new coatings. As a result of this, I developed a new coating which, when applied to a spark plug, significantly increases the reliability of the spark plug. I filed a GB patent application having one claim to a combination of coating and spark plug. The application has been granted. I now make and sell these coated spark plugs. Sales have really taken off, so I left my employment and sell them full-time.

I have received a letter from my former employers demanding that I assign the patent to them immediately. They have threatened me with future infringement proceedings if I do not comply immediately. I understand they have sent letters to my customers, again threatening infringement proceedings. They have already started supplying the coating to customers in the UK and abroad.

I would like to retain my patent and stop their supply.

- a) **Summarise the provisions of *Section 39 UK Patents Act 1977* ('*Right to employees' inventions*'). In your opinion, who is entitled to the invention, your client or his employer? Explain your answer.**
8 marks
- b) **Assuming your client is entitled to the invention, what action can your client take to prevent supply of the coating by the automotive manufacturer? What would your client need to be able to demonstrate to be successful in such an action?**
7 marks
- c) **For both your client and your client's customers discuss whether they can bring proceedings for groundless threats (*Section 70 UK Patents Act 1977*). If so, what remedies are available?**
5 marks

Total: 20 marks