

Foundation Certificate

FC1 UK Patent Law

Friday 18 October 2019 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 Section 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 **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 **seven sheets**, including this sheet.

SECTION A

Question 1

With reference to *Section 60 UK Patents Act 1977 (Meaning of infringement)*, list five acts which do not constitute infringement of a patent.

5 marks

Question 2

Write notes on one leading case of the British courts where novelty or inventive step is the main issue. 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.

- a) **Parties to the case** **1 mark**
- b) **Summary of the facts to the case** **2 marks**
- c) **Summary of the decision** **2 marks**
- d) **Precedent set by the case** **5 marks**

Total: 10 marks

Question 3

Explain whether it is possible for a UK patent application to claim priority from the following. In each case justify your answer.

- a) **A UK design application;** **1 mark**
- b) **A scientific paper published in a reputable scientific journal;** **1 mark**
- c) **A European patent application which does not designate GB;** **1 mark**
- d) **A US provisional application** **1 mark**

Total: 4 marks

Question 4

With reference to *Section 110 UK Patents Act 1977 (Unauthorised claim of patent rights)*, what defences are available to a claim that a person has falsely represented that something disposed of by that person for value is a patented product.

3 marks

Question 5

With reference to *Section 36 UK Patents Act 1977 (Co-ownership of patents and applications for patents)*, summarise the rights of joint proprietors of a patent.

8 marks

Question 6

According to *Section 1 UK Patents Act 1977 (Patentable inventions)*, a scheme, rule or method for performing a mental act as such is not patentable. Explain how this exclusion is interpreted in practice, the aim of the exclusion and how a claim may avoid the exclusion

4 marks

Question 7

With reference to *Schedule A2, Section 76A UK Patents Act 1977 (Biotechnological Inventions)*, state three biotechnical inventions which are not patentable.

6 marks

PART A Total: 40 marks

SECTION B

Question 8

- a) According to *Section 74A UK Patents Act 1977*, who may request the Comptroller to issue an opinion?
1 mark
- b) On what issues will the Comptroller issue an opinion?
4 marks
- c) The Comptroller will issue an opinion in respect of an expired patent. Give one example of a situation in which this might be useful to a third party.
1 mark
- d) What must be filed when requesting such an opinion?
3 marks
- e) Briefly summarise the procedure followed by UKIPO from the receipt of such a request for an opinion through to the issuance of the opinion.
10 marks
- f) According to *Section 74B UK Patents Act 1977*, who may seek a review of the opinion?
1 mark

Total: 20 marks

Question 9

Your client writes:

We make tarmac. As you may be aware, tarmac is essentially a mixture of glass particles and tar. We have discovered that for a particular ratio X of tar to glass particles the tarmac has very desirable properties for laying as a road surface. We filed a PCT application for our invention and then to be honest we forgot about it.

We have now discovered a competitor who is selling bags of tarmac with a tar to glass particle ratio of X . They are also selling tar and bags of glass particles. They are selling these goods to a single customer, who is using them to lay roads.

What should we do?

You obtain a copy of the PCT application. It was filed on 1 July 2017 without claiming priority. There is no record of it being entered into any national or regional phase. The PCT application has one independent claim, which is to a method of applying tarmac to a road surface, the tarmac having a ratio of tar to glass particles in the range $X \pm 10\%$. The search report does not cite any relevant prior art. The written opinion only raises a minor clarity objection.

Prepare notes for a meeting with your client. In addition to notes as to how to proceed, your notes should also include a list of potentially infringing acts and parties with reasons, and also whether there are any potential defences to infringement.

Total: 20 marks

Question 10

Respond to the following questions asked by your client:

- a) My friend and I have jointly developed an invention. My friend is not interested in filing a patent application. However, I would like to obtain patent protection. My friend is agreeable to this and is happy to sign any documents required. How should I proceed?
4 marks
- b) I disclosed my latest invention at a public talk this morning before I came to this meeting. Can I file the notes I handed out as a patent application? Is there anything else you suggest I should be doing in relation to filing the application? Even if I do file the notes as an application, the filing will be after I gave the talk and so presumably the talk is still prior art?
5 marks
- c) I have heard that by making one of my patents 'licence of right', renewal fees are halved. What other consequences does this have?
8 marks
- d) Whilst on the subject of licences, I have attempted to obtain an exclusive licence to a patent owned by a third party. In reply, the third party has offered me a sole licence. What is the difference between the two?
3 marks

Total: 20 marks

Question 11

- a) Your client makes hinges for gates. They filed their own patent application (P1) on 14 November 2018 to a hinge mechanism for a garden gate. You review the application and see it comprises one claim, a description and drawings only. The one claim is to a garden gate hinge. The description describes several embodiments of the hinge, both alone and in combination with a garden gate.

The clients have paid the filing and search fees for P1 and a search report issued on 14 February 2019. The search report cites one document D1. D1 is a PCT application designating all states. It has a priority date of 14 June 2017 and was published on 14 December 2018. D1 relates to a lid for a biscuit tin but the description shows use of a hinge which is substantially identical to the client's hinge apart from scale.

Advise your client on the procedure for prosecuting P1 through to grant, including any time scales. Include a detailed consideration of the impact (if any) of D1 as prior art and how you might overcome it if necessary.

16 marks

- b) Your client has a new embodiment of the hinge. The new embodiment is identical to the previous embodiment but also includes a restoring spring. Your client states that such restoring springs are in common use with garden gate hinges but they would like to protect this variant. You file a second application P2 today claiming priority from the first. The second application includes the content of the original application P1 as well as a description of the new embodiment and also a dependent claim (claim 2) to the restoring spring.

What objection will the UKIPO raise to a combination of claims 1 and 2 during examination? Explain your answer.

4 marks

Total: 20 marks