

UK Patent Law FC1 (P1)

Friday 21 October 2016 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 six sheets, including this sheet.

Part A

Question 1

With reference to Section 1 ('*Patentable Inventions*') UK *Patents Act 1977*:

- a) What conditions must an invention satisfy in order to be patentable according to Section 1(1)?
2 marks
- b) According to Section 1(2), what are not inventions for the purposes of the UK *Patents Act 1977*?
8 marks

Total: 10 marks

Question 2

- a) With reference to Section 14(5) ('*Making of an application*') UK *Patents Act 1977*, what requirements must the claims of a UK patent application satisfy?
3 marks
- b) What is meant by the phrases 'special technical features' and 'single inventive concept', and how are they related?
3 marks
- c) Slightly less than 12 months ago you filed a new UK patent application on behalf of your client. It does not claim priority and to date no fees have been paid. The application includes two independent claims, claim 1 and 10, which relate to different inventions. The client informs you it is the subject matter of claim 10 that is important and that they would like to have searched. However, they only have sufficient funds to pay one search fee. They do not wish to give up the subject matter of claim 1 unless absolutely necessary. How would you proceed?
4 marks

Total: 10 marks

Question 3

a) Can a UK patent application claim priority from the following:

- i) an earlier UK patent application?
- ii) an earlier PCT application which does not designate either the UK or the EPO?
- iii) an earlier UK design application?
- iv) an earlier UK patent application which has now been withdrawn?

In each case justify your answer. You can assume the later filed application is to be filed within 12 months of the first.

7 marks

UK patent application B was filed after UK patent application A. B should have claimed priority from A. It is now more than 12 months from the filing date of A.

What are the two ways in which the priority claim can now be made? (In each case state the deadline for making the priority claim, indicate whether any evidence is required, and if it is required what it must demonstrate.)

3 marks

Total: 10 marks

Question 4

With reference to the UK *Patents Act 1977*, what is the meaning of the following terms:

a) Innocent infringement (Section 62 (*'Restrictions on recovery of damages for infringement'*))

4 marks

b) Third party observations (Section 21 (*'Observations by a third party on patentability'*))

3 marks

c) Inventor (Section 7 (*'Right to apply for and obtain a patent'*))

3 marks

Total: 10 marks

Question 5

a) In which proceedings may the validity of a UK patent be put in issue before a UK court?

5 marks

b) On what grounds may the validity of a UK patent be put in issue before a UK court?

5 marks

Total: 10 marks

Part B

Question 6

This question relates to Section 60 (*Meaning of Infringement*) and Section 61 (*Proceedings for infringement of patent*) UK Patents Act 1977.

- a) With reference to Section 60(1), what acts constitute infringement of a UK patent?
Only consider the case where the invention is a product.
10 marks
- b) According to Section 60(5), an act which would normally constitute an infringing act does not do so if it meets one or more conditions. List two such conditions.
1 mark
- c) According to Section 60(6), who may bring an action for infringement?
4 marks
- d) With reference to Section 61(1), what final remedies may be sought by a patentee in infringement proceedings before a court?
3 marks
- e) Your client's UK patent has reached the end of its 20 year lifetime and has expired. Your client is aware of an infringing act committed whilst the patent was in force.

Explain whether it is still possible to sue for infringement.

2 marks

Total: 20 marks

Question 7

Your client, Big PLC, are the proprietor of a UK patent application A. The application claims priority from an earlier UK application B which has been allowed to lapse. Application A has been published and you have just received an examination report raising substantive objections.

- a) What is the deadline for filing a divisional application?
- b) What documents, forms and fees have to be filed and by when?

11 marks

Big PLC also own a *PCT* application filed in English which claims priority from a UK patent application. Claim amendments were filed in the International Phase. We are now approaching 30 months from the priority date.

- c) What actions need to be taken, and by when, in the next four months, to enter this application into the UK national phase? Restrict your answer to UK national phase entry only. There are no marks available for considering entering the *PCT* application into the EP regional phase.

6 marks

- d) How would your answer be different if the *PCT* application had claimed priority from a Chinese application?

3 marks

Total: 20 marks

Question 8

You have been asked by a client to file a request that the UK Intellectual Property Office notifies you of certain events relating to patents and applications owned by a third party. With reference to Section 118 (*'Information about patent applications and patents, and inspection of documents'*) UK Patents Act 1977,

- a) How would you proceed?
- b) What events (for both patents and patent applications) will the UK Intellectual Property Office notify you of?

10 marks

In relation to UK patent applications:

- c) Who, apart from the Comptroller, may inspect any unpublished patent application, and for what purpose?

1 mark

Your client owns a large number of bicycle racks which they make available to their employees to store their bicycles whilst at work. This is the only use the client makes of the bicycle racks. The racks are manufactured by the company next door. Your client has received a letter from a third party, the essence of which is that they intend to sue your client for both manufacture for sale of the cycle racks and also sale of the cycle racks. They intend to do this as soon as their unpublished patent application is granted. Your client is aggrieved by this.

- d) What advice would you give your client in relation to both infringement and threats?

9 marks

Total: 20 marks

Question 9

Your client, Great Gears Ltd, own UK patent GB1234567 relating to a gear assembly. You receive the following email from them:

"We have recently become aware of a competitor, Britney Gears Ltd, who have started manufacturing and selling an almost identical gear assembly. We have checked the status of our patent online and have found it has lapsed due to non-payment of a renewal fee. We are surprised by this as we use a renewal reminder service to send us reminders but we never received the reminder. Our default instructions to the reminder service are to pay a renewal fee in the absence of instructions from us. What can we do?"

Prepare notes for a meeting with your client. Restrict your answer to issues relating to patents only. You should consider both actions your client could take and also third party rights.

20 marks