

Foundation Certificate

FC1 UK Patent Law

Friday 22 October 2021

10:00 to 13:20 UK British Summer Time (GMT + 1 hour)

Examination time: 3 hours 20 minutes plus 10 minutes upload time

The 3 hours 20 minutes is allocated as follows:

10 minutes – Downloading and printing the question paper;

3 hours – Answering the questions;

10 minutes – Two screen breaks of 5 minutes each.

At 13.20 you MUST immediately stop answering the questions. You then have **10 minutes** in which to upload your Answer document to the PEBX system.

You MUST upload your Answer document to the PEBX system by 13.30. After 13.30 you will not be able to upload it and your examination will be void.

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. You must use the Answer document for your answers.
6. Do not attempt to change the font style, font size, font colour, line spacing or any other preset formatting in the Answer document.
7. Start each question on a new page. To begin a new page, press the Control key and the Enter key simultaneously.
8. When you begin a new question, type in the question number at the top of the page.
9. Do not state your name anywhere in your answers.

This question paper consists of **5 sheets** in total, including this sheet.

AT THE END OF THE EXAMINATION

10. Upload your Answer document to the PEBX system. You should upload it as a Word document. PEBX will automatically convert it to PDF.

SECTION A

Question 1

Your client claims to have invented a perpetual motion machine. List three grounds on which the UKIPO might raise an objection.

3 marks

Question 2

a) Is it possible to claim priority from the following? In each case explain your answer.

- i) A GB patent application filed by a third party in the last 12 months;
- ii) A PCT application filed within the last 12 months;
- iii) A brochure posted to the UKIPO, within the last 12 months, as part of a mail shot to thousands of UK addresses.

3 marks

b) Section 5 of the *UK Patents Act* allows priority to be claimed either from i) an earlier application for a patent or ii) an earlier application for protection of an invention. Give an example of the latter.

1 mark

c) Explain why it is possible to claim priority from a patent application filed in Taiwan. Taiwan is not a party to the Paris Convention.

1 mark

Total: 5 marks

Question 3

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

a) on what grounds can one apply for revocation of a patent; and

5 marks

b) who can apply for revocation of a patent?

5 marks

Total: 10 marks

Question 4

Section 74A of the *UK Patents Act* relates to opinions issued by the UKIPO.

- a) For what reasons may the UKIPO refuse to issue an opinion?
4 marks
- b) Who prepares the written opinion?
1 mark
- c) Explain in what circumstances, if any, the opinion is binding on the requester of the opinion.
1 mark
- d) If the UKIPO decides not to issue an opinion, who may appeal this decision?
1 mark

Total: 7 marks

Question 5

Reinstatement is requested when the applicant fails to comply with a requirement of the Act or Rules within a period which is set out in the Act or Rules or specified by the Comptroller.

- a) Section 20A (*Reinstatement of applications*) lists five periods for which reinstatement is not possible. What are these?
5 marks
- b) The Comptroller will only reinstate an application if three criteria are satisfied. What are these?
3 marks
- c) What is the deadline for requesting reinstatement?
1 mark

Total: 9 marks

Question 6

What criteria must be satisfied before the Comptroller will refer an application for preliminary examination?

3 marks

Question 7

The UK IPO has cited the abstract of an earlier UK patent application as prior art against your client's application. Is the abstract valid prior art?

3 marks

SECTION A Total: 40 Marks

SECTION B

Question 8

Your client writes:

You recently filed a UK patent application on our behalf for a widget. We have now received the Combined Search and Examination Report. The deadline for responding is not for some time.

The content of the report is straightforward. There is an objection that independent claims 1 (to the widget) and 3 (to a widget adhesive) lack unity and, accordingly, the examiner has only searched claims 1 and 2.

We definitely want to keep the searched claims. However, we cannot decide what to do about the unsearched claims without a search report.

The examiner has objected to claim 1 in view of a large amount of prior art. However, we note the examiner is happy to accept claim 2.

We know there is a competitor ready to launch a rival widget. They are not planning on selling a widget adhesive at this time, but you never know. We have managed to obtain a sample of the competitor's widget, which is enclosed.

You review the file. All is in order. The application has not as yet been published.

Advise your client generally. Your advice should cover actions they could take and also any defences the competitor may have. You can assume that the only relevant prior art is the art mentioned in the question.

20 marks

Question 9

Write notes on **TWO** leading cases of the British courts. One should have claim construction as the main issue. The other case should have novelty or obviousness as the main issue.

For each case provide the following information:

- a) the parties to the case; **1 mark**
- b) a summary of the facts and issues relevant to the decision; **2 marks**
- c) an outline of the decision; and **3 marks**
- d) what precedent is set by the case. **4 marks**

Total: 20 marks

Question 10

An associate in France writes:

We have filed a PCT application in French at WIPO. The application does not claim priority. The application has 20 pages of description and 15 claims. We amended the claims in the international phase reducing the claims to 10.

We would be grateful if you could enter this application into the GB national phase and obtain grant as soon as possible. We will be entering the application into the EP regional phase ourselves.

- a) What steps would you take to enter the PCT application into the GB national phase and to expedite prosecution?
13 marks
- b) Give at least three reasons why the client might need to have a GB patent granted whilst waiting for the European application to be granted.
3 marks
- c) What issue may arise when the parallel European application is granted?
4 marks

Total: 20 marks

Question 11

This question relates to extensions of time.

- a) List five deadlines that cannot be extended.
5 marks
- b) By what procedure and by how much can each of the following deadlines be extended? Is the extension discretionary or as of right?
 - i) The deadline for responding to an examination report.
4 marks
 - ii) Payment of a renewal fee. You do not need to consider restoration.
3 marks
 - iii) The deadline for filing a statement of inventorship.
5 marks
- c) The extensions of time available for filing a certified copy of a priority document are slightly different to those available for filing a statement of inventorship. Explain the differences.
3 marks

Total: 20 marks