

Foundation Certificate

FC1 UK Patent Law

Friday 21 October 2022

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 **6 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

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

- a) According to Section 1(1), what conditions must an invention satisfy in order to be patentable?
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

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

8 marks

Question 3

- a) With reference to Section 117 *UK Patents Act (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

Total: 6 marks

Question 4

- a) Who can apply for a UK patent?
2 marks
- b) To whom may the patent be granted?
4 marks
- c) Under what circumstances must a statement of inventorship (Patents Form 7) be filed? When must it be filed and what extension of time is available?

You do not need to consider divisional applications.

4 marks

Total: 10 marks

Question 5

a) Describe the procedure for recording an assignment at the UK Patent Office. **2 marks**

b) Describe two potential consequences of a failure to record an assignment within six months of execution. **4 marks**

Total: 6 marks

SECTION A Total: 40 marks

SECTION B

Question 6

Write notes on two leading cases of the British Courts. For each case 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. One case should have claim construction as the main issue. The other case should have novelty or inventive step as the main issue.

20 marks

Question 7

Your client, Big PLC, owns UK patent GB7654321 for a bicycle wheel. Big PLC has recently become aware of a third party who has recently started manufacturing an identical bicycle wheel.

Inspection of the status of the patent reveals that a renewal fee has not been paid. You have worked for this client for many years and are aware that one of the directors is responsible for payment of renewal fees. You are also aware that this director has recently left the company. Your firm is the address for service for the patent.

Prepare notes for a meeting with your client. Consider actions your client could take and also any potential third-party rights.

20 marks

Question 8

Your client filed a UK patent application (GB1) on 3 October 2018 with no priority claim. The application describes a V1 valve and includes one independent claim to the V1 valve. The V1 valve has advantages over existing valves.

The client then developed the V2 valve. The V2 valve is similar to the V1 valve but has slightly different features.

On 30 September 2019, your client filed a second UK application (GB2) claiming priority from GB1. The second application includes all of the first application, a description of the mark two valve and a second independent claim to the V2 valve.

For each of the following disclosures state whether it may be relevant prior art for the purposes of novelty and inventive step for both independent claims of GB2. Explain your answer. In addition, for each disclosure explain what further information, if any, is needed.

- a) A valve sold extensively and only abroad from 2015 to 2018. **2 marks**
- b) A tender for manufacturing proposals from your client for the V2 valve dated 10 September 2019 and marked 'in confidence'. The document describes the V2 valve in detail and was sent to one hundred manufacturers in the UK and abroad. **3 marks**
- c) A journal article dated 9 October 2018 describing some of the details of the V1 valve. **3 marks**
- d) The same journal article as c), only now with a statement that it is a report of a conference held on 22 September 2018. **2 marks**
- e) A UK patent application filed on 20 September 2018 and published on 26 March 2019. It has now been withdrawn. The application describes valves similar to the V1 and V2 valves. **4 marks**
- f) A European patent application designating GB, filed on 10 June 2018 and published on 12 December 2019. The content of the application is identical to that of e). **1 mark**
- g) A PCT application filed in Japanese at the Japanese Patent Office. The PCT designates GB but not EP. It was filed on 10 April 2018 claiming priority from a Japanese patent application filed on 11 April 2017. The PCT was published on 14 October 2018. The PCT describes a valve similar to the V2 valve. The priority application describes a valve which lacks key features when compared to the V1 and V2 valves. **5 marks**

Total: 20 marks

Question 9

a) Your client writes:

As you know, we make printers. An employee in the design team has invented a new type of printer and we have now obtained a granted patent for it. The printer is now becoming very valuable to our business. We were always aware that this might be the case and so had all our employees sign a new contract of employment which includes a term that anything invented by an employee is the property of the company and the employee has no financial claim on it. Nonetheless, can the employee obtain some form of compensation? If so, where would they need to apply and when? Further, what factors would be taken into account when determining if an award is to be made in the employee's favour?

8 marks

b) Your client further writes:

We also own a patent having a single claim to a method of manufacture of a steel plate using a metal roller having a very distinctive surface pattern. We have identified a UK distributor of steel plates bearing this pattern. The plate is manufactured abroad. Does the distributor infringe our patent?

4 marks

c) Your client further writes:

One of our patents has recently reached the end of its 20-year life. We have a large amount of stock which is marked as patented and are currently running this stock down. One of our competitors has threatened to take legal action on the grounds that we are now falsely marking our product as patented. What is the penalty for this and what defences do we have?

5 marks

d) Your client further writes:

The threat from the competitor made us review the recently expired patent. On review, we realised that the competitor appears to be infringing the patent and has been doing so for some time. Presumably, as the patent has now expired, there is nothing we can do about it?

Prepare notes for a meeting with your client addressing all of the above points.

3 marks

Total: 20 marks