

# Foundation Certificate

## FC1 UK Patent Law

**Friday 13 October 2023**

**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 pre-set 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 **7 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

- a) You recently filed a UK patent application claiming priority from a Japanese patent application. What documents must be filed and by when in support of the priority claim?  
**4 marks**
- b) Two weeks ago, you filed a UK patent application. It was intended that the application claim priority from a Chinese application and was filed exactly 12 months after the Chinese application. Unfortunately, the priority claim was accidentally omitted. How would you proceed and by when? What extension of time is available?  
**3 marks**
- c) Your clients wish to withdraw their current UK application (application A) and refile it as application B. In twelve months' time they intend to file a new UK patent application claiming priority from application B. What conditions must application A satisfy for this to be possible and by when?  
**5 marks**

**Total: 12 marks**

### Question 2

Summarise one decision of the UK Courts relating to novelty or inventive step. You should provide:

- a) identification of the parties;  
**1 mark**
- b) summary of the relevant facts and issues;  
**2 marks**
- c) summary of the decision; and  
**2 marks**
- d) a discussion of the precedent set by the decision.  
**5 marks**

**Total: 10 marks**

### Question 3

With reference to Section 72 *UK Patents Act*,

a) on what grounds may a UK patent be revoked?

**5 marks**

b) who may apply for revocation and by when?

**5 marks**

**Total: 10 marks**

### Question 4

You are a UK national resident in the UK. Whilst visiting a firm of US attorneys you receive an e-mail with instructions to first file (i.e. without a priority claim) a new US patent application. You forward the instructions to the firm you are visiting, who file the application on your behalf.

a) Section 23 of the *UK Patents Act (Restrictions on applications abroad by United Kingdom residents)* only applies if a patent application contains certain subject matter. What is this subject matter?

**3 marks**

b) Assuming the application contains the above subject matter, explain why Section 23 is relevant in this situation.

**3 marks**

c) Would there still have been a problem in the following situations? In each case explain your answer.

i) You had been a US national?

ii) The application had claimed priority from an earlier Chinese patent application?

**2 marks**

**Total: 8 marks**

**SECTION A Total: 40 marks**

## SECTION B

### Question 5

This question relates to opinions issued by the UK Intellectual Property Office (UKIPO) according to Sections 74A and 74B of the *UK Patents Act*.

- a) The UKIPO will not issue an opinion in respect of a patent that has been revoked. Why is this?  
**1 mark**
- b) Give two examples of reasons why one might want to obtain an opinion in respect of a patent which has expired or which has been cancelled  
**2 marks**
- c) On what grounds will the UKIPO refuse to issue an opinion?  
**3 marks**
- d) What standard of proof is applied by examiners in the opinions procedure?  
**1 mark**
- e) Summarise the procedure from requesting an opinion to issue of the opinion (including actions by third parties).  
**10 marks**
- f) Who may apply for a review of the issued opinion and within what time limit?  
**2 marks**
- g) What appeal is possible if the decision of the review is to set aside the opinion?  
**1 mark**

**Total: 20 marks**

### Question 6

- a) What are the 'Catnic' questions, as amended by the UK Supreme Court in *Actavis UK Limited and Others v Eli Lilly and Company*?

**6 marks**

- b) Your client writes:

We are the proprietors of a GB patent which relates to an artificial hip joint. An artificial hip joint is essentially a rod having a head thereon. Our patent relates to a hip joint having a teardrop-shaped head. Teardrop-shaped heads are better than spherical heads as they fit into the hip socket much better over the full range of motion of the leg.

One of our competitors manufactures a range of hip joints and we attach some samples. We are hoping that at least one of them infringes our patent. We would be grateful for your thoughts.

Review of the patent reveals that it is in force. The patent has only one claim, which is to a hip joint having a teardrop-shaped head. The description of the patent explains the advantage associated with such heads when compared to spherical heads. You also review the samples provided by the client. For each sample they have provided a brief note –

Sample number	Description	Brief note
1	Hip joint with spherical head	We have made these for many years
2	Hip joint with elliptical head	This fits the socket just as well as ours over the full range of motion. This isn't surprising really; the tip of an ellipse is the same shape as the tip of a teardrop.
3	Hip joint with cubic head	This works just as well as ours. We are still trying to figure out why.
4	Grinding tool	We saw this on the competitor's website. Apparently, you place the tool over a spherical head. Rotating the tool grinds the head until it is teardrop shaped.

**For each sample, advise if sale of the sample is likely to be an infringement of the patent. Explain your answers.**

**14 marks**

**Total: 20 marks**

## Question 7

Your client writes:

We have a PCT application for our invention. We filed it in Japanese at the Japanese patent office. It claims priority from a GB application which we allowed to lapse. We filed claim amendments in the international phase. We think the claims on file are patentable, but the examiner may need some persuasion. There is a narrowing amendment we can make that would be allowed without difficulty.

We are now approaching 30 months from the priority date and would like your advice as to how to proceed.

**a) Are there any advantages to entering the PCT application into both the GB national phase and also the EP regional phase?**

**3 marks**

**b) We have heard about 'double patenting' which may be a danger if we file both GB and EP applications from this PCT. What is this and how can we avoid this danger here?**

**5 marks**

**c) Assuming we wish to enter this application into the GB national phase, what steps do we need to take and by when? (You can assume there are no excess pages fees or excess claims fees to pay.)**

**9 marks**

**d) Finally, we also have a GB application for an update to the original invention. This was filed after the PCT application but before the PCT application was published. Claim 1 of the PCT application recites a substrate. The one example in the description is to a rubber substrate. We subsequently discovered that copper substrates are better. Claim 1 of the GB application recites a copper substrate, and the one example is to a copper substrate.**

**Can the PCT be cited against the later-filed GB application and, if so, how do we address this?**

**3 marks**

**Total: 20 marks**

## Question 8

Your client writes:

We have recently taken over three GB patent applications (P1–P3) from one of our competitors. I enclose copies of the paperwork relating to the applications.

- a) For the first application (P1) we see this started life as a PCT application and has recently been entered into the GB national phase. The PCT received a favourable ISA, with all the claims being found novel and inventive. We understand there is a PCT(UK) fast track system for expediting examination. We would be grateful if you could explain this to us. You should note that in addition to the apparatus claims of the PCT we would like to add some closely corresponding method claims.

**Write notes for your client on the PCT(UK) fast track system. You should also advise on how best to obtain protection for the method claims.**

**3 marks**

- b) The second application (P2) is a direct GB application. We are currently awaiting an examination report. Again, we would like to expedite prosecution if at all possible and would appreciate your advice.

**Suggest ways in which one can expedite prosecution of the application and for each explain what documents need to be filed.**

**7 marks**

- c) For the third application (P3), as you will see, this was filed eight months ago and consists of a description and drawings only. There is no priority claim. The subject matter of this application is of particular interest to us and one of our employees has developed a number of variants that we would like to include in the application. We would like to have only one application if possible.

**Advise how to proceed, including what documents need to be filed and by when. You only need to consider prosecution up to 18 months from the filing date of P3.**

**6 marks**

- d) When reviewing the above three applications, we found a patent owned by our competitor and which has not been assigned to us. This is of concern as we very clearly infringe it. Fortunately, we were not aware of it and have now ceased making the product in question. Unfortunately, our use started after the filing date of the patent. Should we be concerned?

**Advise your client as to any defences they may have to a claim for infringement.**

**4 marks**

**Total: 20 marks**