

Foundation Certificate

FC1 UK Patent Law

Friday 25 October 2024

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 **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

With reference to Section 73 (*Comptroller's power to revoke patents on his own initiative*), list three grounds on which the Comptroller can revoke a patent on his own initiative.

6 marks

Question 2

With reference to Section 74 (*Proceedings in which the validity of a patent may be put in issue*), list the proceedings in which the validity of a patent may be put in issue.

6 marks

Question 3

Your client, Mr Smith, is a UK national and resident. Mr Smith has developed a nose cone for a hypersonic missile. Mr Smith has instructed you to immediately file patent applications for this invention, both in the UK and abroad, without claiming priority, so that he can start making the invention public.

With reference to at least one of Sections 22 and 23 of the UK *Patents Act*, suggest alternative approaches with reasons.

5 marks

Question 4

On 29 September 2020, your client, Mrs Husseni, filed UK patent application GB1234567.8 for a toothbrush. There is no priority claim. On 20 September 2023, the UK Patent Office issued an examination report setting a deadline of 20 January 2024 for response. Mrs Husseni never opened the envelope. Mrs Husseni has now received a letter from the UKIPO stating that it is intending to treat the application as refused.

a) Advise Mrs Husseni how to proceed.

7 marks

b) How would your advice have been different if the examination report had never been received?

2 marks

Total: 9 marks

Question 5

- a) Under what circumstances is a grant fee payable to the UKIPO?
3 marks
 - b) What is the deadline for payment of the grant fee?
1 mark
 - c) What extension as of right is possible and how is this obtained?
2 marks
- Total: 6 marks**

Question 6

On 25 September 2024, you filed a UK patent application in Chinese, claiming priority from a Chinese patent application filed on 25 September 2023. The application relates to the manufacture of tiny ball bearings for use in electronic devices. You have now received a notification from the UKIPO, dated 7 October 2024, that an English language translation is required.

- a) **What is the deadline for filing the English language translation?**
1 mark
- b) **What extension of time is available?**
2 marks

On receiving the translation, you discover that all the measurements are in miles rather than millimetres. A quick check reveals that this is not a translation error – it is present both in the Chinese language text of the application, as filed, and the priority application.

- c) **How would you address this problem?**
5 marks
- Total: 8 marks**

Total for SECTION A: 40 marks

SECTION B

Question 7

On 29 November 2021, your client, Big Widget PLC, filed a UK patent application (D1) which discloses and claims a widget. Development of the widget did not go well, and on 1 April 2022 they withdrew the application. Shortly afterwards, Big Widget made a breakthrough in manufacture of the widget and refiled the application at UKIPO on 29 April 2022 as D2. D2 contains all of the subject matter of D1 and further discloses and claims the method by which the widget is manufactured.

On 29 April 2023, Big Widget filed a PCT application (PCT1) claiming priority from D2 and identical thereto. D2 was allowed to lapse.

On 29 May 2023, D1 was unexpectedly published by UKIPO. UKIPO have no record of having received the withdrawal letter.

PCT1 has now been entered into the UK national phase as D3.

Write notes for a meeting with your client. Your notes should cover the following points:

- a) **The validity of the claim to priority. You should consider the claim to the widget and the claim to the method of manufacture of the widget separately.**
9 marks
- b) **Patentability of D3. You can assume there are no documents or other prior art other than the above.**
11 marks

Total: 20 marks

Question 8

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.

For each case:

- | | |
|-------------------------------|----------------|
| a) the parties to the case; | 1 mark |
| b) summary of the facts; | 2 marks |
| c) summary of the decision; | 3 marks |
| d) precedent set by the case. | 4 marks |

Total: (10 marks x 2) 20 marks

Question 9

Your UK-based client writes:

We have invented a new bottle opener. In summary, the bottle opener comprises a handle and a head. Both the handle and the head are known in the art but, as far as we are aware, this is the first time they have been used together. It turns out they work surprisingly well together. Nonetheless, since the bottle opener is merely made up of known parts, we assume we cannot protect it.

We have performed a patent search of our own and have found GB1 for the handle and EP1 for the head. No renewal fees have been paid on either, so we think we are OK to start making and selling the bottle opener in the UK.

A review of GB1 shows it was filed on 21 May 2019 and granted on 7 February 2023. No renewal fees have been paid.

A review of EP1 shows it was filed and prosecuted in English and granted on 25 August 2024. Again, there is no record of any renewal fee having been paid at the UKIPO.

Write notes for a meeting with your client.

Total: 20 marks

Question 10

Your clients, DreamDye, have discovered that obscure chemical X makes an excellent hair dye. They have a granted UK patent which has one claim which reads:

A method of dying hair comprising the steps of:

- (a) applying a mixture of X and water to hair; and*
- (b) rinsing the mixture from the hair.*

Your clients have recently discovered Chinese company, CurlUpAndDye, manufacturing and selling XDye, which is a hair dye containing X. They sell trade-to-trade to other companies around the world and have recently approached DreamDye.

Following this approach, your clients have investigated further and have found a UK-based company, FadeFree Ltd, selling XDye. FadeFree's website states:

We are the UK's sole retailer of XDye to the public. If you do not feel comfortable applying this powerful hair dye yourself, feel free to contact your nearest hair salon, as they are probably already using it.

DreamDye wish to completely stop use of X as a hair dye by third parties.

Prepare notes for a meeting with your client. You should identify any potentially relevant parties and consider both direct and indirect infringement. You should also consider defences to infringement.

Total: 20 marks