

THE JOINT EXAMINATION BOARD

PAPER P1

BASIC UNITED KINGDOM PATENT LAW AND PROCEDURE

11th November, 1992

10.00 a.m. - 1.00 p.m.

Please read the following instructions carefully. This is a THREE HOUR paper.

1. You should attempt no more than four questions from Part A and no more than three questions from Part B.
2. The number of marks allotted to each question is placed in brackets at the end of the question.
3. Where a question permits of reasons being given for the conclusions reached, such reasons should be given.
4. Start each question (but not necessarily each part of each question) on a fresh sheet of paper and number it clearly in the margin. Write on one side of the paper only using BLACK ink. You must write your examination number and the designation of the Paper in the top right hand corner of the sheet. You must NOT staple pages together. You must NOT state your name anywhere in the answers.
5. Unless specifically requested answers are NOT required in letter form.
6. NO printed matter or other written material may be taken into the examination room.

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PART A

1. Who owns an invention made by an employee?
In what circumstances can the employee claim a reward from his/her employer in respect of the invention? (10 marks)
2. A British Patent Application has been filed under the Patents Act 1977 and the associated rules by the employer of the inventor.
 - a) When can a Divisional Application be filed?
 - b) What documents are necessary to file the Divisional Application?
 - c) What further documents need to be filed, and when, if the Divisional Application is to proceed? (10 marks)
3. What is a 'priority date' and why is it important? In what circumstances can any one claim have more than one priority date? (10 marks)
4. Outline the duties of the Patent Office Examiner when conducting Preliminary Examination and Search, and when conducting Substantive Examination. (10 marks)
5. Explain the rights of the proprietor of a Patent Application after the specification has been published under S.16. (10 marks)

PART B

6. A new client writes:

Dear Sirs,

For many years our Technical Director handled all the Patent matters for the company. He has recently retired, and we are finding it a bit difficult to understand the rather skimpy records that he kept.

We do, however, have a problem that needs your urgent attention.

We enclose a copy of our British Patent 2222222B, which relates to a mousetrap. We know that our competitors Snap Ltd., have imported a large number of mousetraps which are virtually identical to our traps, and they are in a warehouse in Southampton. We believe that they will be re-exported to the USA or Canada during the next few weeks; we are currently negotiating in USA an important sales contract for our mouse traps.

We do not know if there are any overseas equivalents to the British Patent.

What action, if any, can we take against Snap Ltd?

Yours faithfully.

On completing a Patent Family search you find that the only equivalent is a European Patent, which designated Germany, France and United Kingdom. This European Patent was granted three years ago, but was opposed. The opposition proceedings terminated four months ago, with the Patent being sustained in an amended form.

On checking the status of the two cases at the British Patent Office you find that the renewal fees have been paid on British Patent 2222222B and it is in force, but no renewal fees at all have been paid to the British Patent Office in connection with the European Patent.

Write notes on the points to be covered in a letter to your client.

(20 marks)

7. A client visits you and shows you a letter that he has just received, which reads:

November, 1992

Dear Sirs,

Re: British Patent Application 9200001

I filed this Patent Application on 2nd January, 1992.

I have seen advertisements in the newspaper for your 'TONOBEL' machine, which you appear to have been selling since June of this year. This machine will be an infringement of my Patent when it is granted. You will just have to believe this because my Patent Application is not published yet.

I am writing to you now to let you know that if you are still making and selling your 'TONOBEL' machine next July when my Patent Application is published I will bring proceedings against you for infringement as soon as I can.

Yours faithfully,

Ian Vantor.

- a. What can you find out about Application 9200001 on behalf of your client?
- b. What can your clients do to stop Mr. Vantor having a Patent granted to him?
- c. List any questions that you would ask your client, explaining why you would ask these questions and how the answers would help you decide on a course of action. (Ignore any question of threats).

(20 marks)

8. A German associate sends to you a copy of a published international application filed, in German, at the European Patent Office, claiming priority from an earlier German Patent Application. The priority date is 6th June, 1990, and the International (PCT) application has a filing date of 4th June, 1991.

Your associate explains that the application designated all the available states when it was filed, and preliminary international examination has been completed, with the claims being amended. He encloses a copy of the amended claims, in German.

The applicant is running short of money, but hopes that a major contract will be signed soon, which should give him some funds. However, it has been decided to enter the National phase at the British Patent Office.

Indicate precisely what documents have to be filed at the British Patent Office, and the nature of the fees that have to be paid, for the National Phase at the British Patent Office to proceed, indicating the last possible date for filing each document and paying each fee, mentioning any extensions of time that may be available.

(20 marks)

9. Write notes on the meaning of, and procedure relating to:

Rectification
Restoration
Revocation

(20 marks)