

THE JOINT EXAMINATION BOARD**PAPER P1****BASIC UNITED KINGDOM PATENT LAW AND PROCEDURE****19th November, 1996****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. In the appropriate boxes at the top of each sheet please enter the designation of the paper, the question number, and your Examination number. Write on one side of the paper only using BLACK ink. 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.
7. Answers **MUST** be legible. If the examiners cannot read a candidate's answer no marks will be awarded.
8. NO writing whatsoever, including numbering of papers, is allowed prior to the commencement of the examination or after it has finished.
9. Please put your answers in QUESTION NUMBER ORDER before placing in the envelope provided.

4 PAGES INCLUDING THIS FRONT SHEET

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PAPER P1

BASIC UNITED KINGDOM PATENT LAW AND PROCEDURE

19TH NOVEMBER, 1996

10.00 a.m. - 1.00 p.m.

PART A

Candidates may answer no more than four questions selected from questions 1 to 6 in PART A and no more than three questions selected from questions 7 to 10 in PART B.

1. What is meant by “purposive construction“ of claims? (10 marks)
2. A British patent application was filed just over two years ago by the employer of the inventor. When can a divisional application be filed? What documents are needed to file the divisional application? What further documents need to be filed if the divisional application is to proceed to grant, and when? (Mention any extensions that may be available). (10 marks)
3. Explain the procedures that are followed when a patent application is filed at the British Patent Office that relates to an item of “secret” military equipment. (10 marks)
4. Provide an outline of one leading case relating to British Patents. (10 marks)
5. A client writes indicating that he has a new prototype, which has inventive features. He would like a British Patent to be granted as soon as possible. Outline the procedures that you would follow at the British Patent Office, indicating the timetable generally in terms of months from the filing date. (10 marks)
6. What is a priority date? Why is it important? Can a patent have more than one priority date? Can a claim have more than one priority date? (10 marks)

PART B

7. What are the grounds of revocation of a patent granted under the Patents Act 1977? Is there any restriction on who can plead these grounds? Outline the procedure followed in an application for revocation made to the Comptroller, from the filing of the initial papers, to the issuance of the decision. Outline any appeal procedures that may be available.

(20 marks)

8. What is the difference between “making an amendment” and “correcting an error”? Explain the provisions of the Patents Act 1977 regarding the amendment of a patent application and a patent, and also the provisions regarding the correction of an error in a patent application and in a patent. Indicate the procedure that would be followed at the Patent Office when seeking to amend, or correct errors in, a patent application or a patent, indicating any relevant time constraints.

(20 marks)

9. Write notes on five of the following topics:

selection inventions
a declaration of non-infringement
licences of right
a certificate of contested validity
a supplementary protection certificate
an account of profits

(20 marks)

10. A client approached you in early November 1996, bringing a prototype of a product. The client explained that he hoped to launch the product in January of 1997, and said that he had never seen anything like it on the market. The prototype was a sophisticated device, and clearly a lot of effort had gone into its conception and design.

Following the visit of the client you made a search that revealed a British patent, granted in the name of a Japanese corporation. The patent was granted in 1990 following the filing of an application in September of 1988 which claimed priority from a Japanese application of November 1987.

A register inspection shows that the usual data was put on the register at grant (proprietor, title, application date and number, priority details and grant details), and apart from

entries on the part of the register relating to renewal fees, no further entries have been made. The last renewal fee payment was made in August of 1995.

The device described in the specification of the patent is very straightforward, but you have reached the conclusion that your client's prototype falls within the scope of nearly all of the claims of the patent. The cover page of the patent does not list any cited references.

Prepare notes for a meeting to be held with the client in late November 1996, outlining the various options open to the client, indicating their advantages and disadvantages.

(20 marks)