

THE JOINT EXAMINATION BOARD

PAPER P1

Basic United Kingdom Patent Law and Procedure

Monday 8 November 2010

10.00 a.m. – 1.00 p.m.

Please read the following instructions carefully. Time Allowed – 3 HOURS

1. You should attempt **four of questions 1 to 5** in Part A and **three of questions 6 to 9** in Part B. There are nine questions altogether, five in Part A and four in Part B
2. Each question in Part A carries 10 marks and each question in Part B carries 20 marks. If more than the required number of questions are answered in either part only the first ones presented will be marked.
3. Please note the following:
 - a. Start each question (but not necessarily each part of each question) on a fresh sheet of paper;
 - b. Enter the Paper Number (P1), the question number and your Examination number in the appropriate boxes at the top of **each** sheet of paper;
 - c. The scripts are photocopied for marking purposes. Please write with a **dark inked pen** on one side of the paper only and within the printed margins, and do not use highlighters in your answer;
 - d. Do not state your name anywhere in the answers;
 - e. Write clearly, examiners cannot award marks to scripts that cannot be read;
 - f. Reasoning should always be given where appropriate.
4. Under the Examination Regulations **you may be disqualified from the examination and have other disciplinary measures taken against you if:**
 - a. you are found with unauthorised printed matter or other unauthorised material in the examination room;
 - b. your mobile phone is found to be switched on;
 - c. you copy the work of another candidate, use an electronic aid, or communicate with another candidate or with anyone outside the examination;
 - d. you continue to write after being told to stop writing by the invigilator(s). **NO WRITING OF ANY KIND IS PERMITTED AFTER THE TIME ALLOTTED TO THIS PAPER HAS EXPIRED.**
5. **At the end of the examination assemble your answer sheets in question number order and put them in the WHITE envelope provided.** Do not staple or join your answer sheets together in any way. Any answer script taken out of the examination room will not be marked.

This paper consists of four pages including this one.

Part A

1. In accordance with the UK Patents Act 1977 as amended:
- (a) who has the right to apply for a patent; and
 - (b) who has the right to obtain a granted patent?
 - (c) Summarise the circumstances in which the rights to an invention made by an employee in the UK pass to the employer.

[10 marks]

2. What are the steps required to enter the UK national phase of a PCT application originally filed on 1st June 2008 in German at the German Patent Office and amended during the international phase after publication? The application did not claim priority. Mention any applicable deadlines to be met in the next six months.

[10 marks]

3. When may a UK patent specification be amended or corrected pre-grant and what are the restrictions on making such amendments and corrections?

[10 marks]

4. Who may apply for revocation of a granted UK patent and on what grounds?

[10marks]

5. Explain what is meant by a "priority date" and in what circumstances you can claim priority from an earlier application. Can a UK patent application filed under the UK Patents Act 1977 as amended claim priority from the following and what is the time limit for claiming priority?

- (a) A UK patent application;
- (b) A German utility model application;
- (c) A PCT application; and
- (d) A Japanese industrial design application.

[10 marks]

Part B

6. A new client, The Real Hinge Company, writes:

"We filed a UK patent application covering a hinge mechanism for a garden gate on 4 December 2009. We received a search report dated 25 March 2010, in which the examiner cited a single document D1.

Although we have looked at the report, we are not certain how it affects whether we can proceed with the application. We need protection only in the UK. We launched our hinge product on 1 June 2010, and recently we have become aware that our rivals, Locks 'n' More are selling an almost identical copy of the hinge for garden gates in garden centres in the south of England. Obviously we want to stop this as soon as possible.

We also want to sell a new model after Christmas, which will have a spring attachment, but as yet we have not shown this to any of our customers or suppliers."

You read the search report and the application documents, and note the following

- The application includes a description, drawings and set of claims, but no abstract.
- The claims include one independent claim to a hinge, with dependent claims to its use on a gate, in particular, a garden gate.
- D1 is a PCT publication, having a priority date of 7 July 2008 and a publication date of 7 January 2010. All available states are designated. The document claims a garage door but shows such a door incorporating a substantially identical hinge design.

Explain to your client his options for obtaining patent protection, and also what could be done to stop the alleged infringement. Include any relevant timescales (precise date calculations are not required).

1. What steps must be taken to complete the client's UK application.
2. Under what circumstances is D1 prior art, and is it possible to distinguish over it?
3. Can anything be done about the alleged infringement? (ignore any copyright or design right issues). Briefly, what do you recommend?

[20 marks]

7.

- i) Explain what is meant by an exclusive licence. Must it be registered and if so by when? What are the consequences of non-registration?
- ii) What is the procedure for and the effect of endorsing a patent "licence of right"?
- iii) Can (a) an exclusive licensee and (b) the holder of a licence of right take action against an infringer of the patent? What restrictions, if any, are there on the licensee bringing the action for infringement.

[20 marks]

8. Under which of the following circumstances might a claim of a UK patent be infringed? Give reasons.

- a. Importing a product made by a process which (process) is the subject of a UK patent;
- b. Advertising a product for export;
- c. Offering for sale a component part of a patented product;
- d. Advertising a product on a US web site, priced in US dollars.

[20 marks]

9. For the purposes of assessing whether a claimed invention is novel or involves an inventive step under the UK Patents Act 1977 as amended, what forms the state of the art? With reference to leading cases, outline the steps taken to assess whether an invention involves an inventive step.

[20 marks]