

# Foundation Certificate

## FC1 UK Patent Law

**Friday 16 October 2020**

**14:00 to 17:00 UK British Summer Time (GMT + 1 hour)**

**Total time allowed: 3 hours 30 minutes**

Starting from the time when you download the question paper, you have 3 hours 30 minutes in which to:

- Print this question paper (if wished)
- Answer the questions
- Take two screen rest breaks of 5 minutes each
- Save your Answer document to your hard drive as a pdf
- Upload your answer document to the PEBX system.

### 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.
10. **Candidates who have been granted approval to handwrite their answers:** Instructions on what to do at the end of the examination are on the Candidate Cover Sheet.

This question paper consists of **6 sheets** in total, including this sheet.

### AT THE END OF THE EXAMINATION

11. Save your Answer document to your hard drive and follow the instructions for uploading your document onto the PEBX system.

## SECTION A

### Question 1

With reference to *Section 1* of the *UK Patents Act 1977 (Patentable inventions)*, list six things which are **not** inventions for the purposes of the Act.

**3 marks**

### Question 2

GB patent application A was filed on 16 September 2019. GB patent application B was filed on 16 September 2020, along with a request for early publication. It has not as yet been published. When filing B, the claim to priority from application A was accidentally omitted. What steps should you take to correct this omission and by when? What extensions of time are available?

**5 marks**

### Question 3

Write notes on the facts of, and the precedent set by, the recent case *Actavis UK Ltd and Ors v Eli Lilly and Co*. In addition, this case sets out a test under which the prosecution history for a patent may be considered. What is this test?

**Facts – 2 marks**  
**Precedent – 5 marks**  
**Test – 3 marks**

**Total: 10 marks**

### Question 4

With reference to *Section 33* of the *UK Patents Act 1977 (Effect of registration etc. on rights in patents)*

a) Name the five transactions, instruments or events which may be recorded in the register of patents and patent applications.

**5 marks**

b) Why is it important to register such transactions, instruments or events?

**5 marks**

**Total: 10 marks**

### **Question 5**

Your client writes:

We have a number of GB patents in your care. Whilst we have successfully licenced some of these, we feel that the renewal fees are prohibitively expensive in the current financial climate. This may change in the future. Is there some way we can reduce these fees?

**Summarise the advantages and disadvantages associated with making an application for entry in the register that licences are available as of right.**

**9 marks**

**Give an example of a situation where UKIPO would refuse such an application.**

**1 mark**

**Total: 10 marks**

### **Question 6**

Can a patent application be filed in the name of a partnership? Explain your answer.

**2 marks**

**SECTION A Total: 40 marks**

## SECTION B

### Question 7

Your client writes:

We own GB patent GB3141592 for a method of manufacturing pies. The method gives the pastry a very distinctive fluffy texture. We have recently been sampling the produce of one of our competitors and believe their cheese pies are made by the same method. We are concerned they are going to expand into the area of meat pies. We have asked them about their method but have not received any reply.

We have decided to take legal action but sadly have discovered that our patent has lapsed due to non-payment of a renewal fee. As you may recall, we pay our own renewal fees. We have a copy of a letter to UKIPO from our Managing Director instructing payment of the renewal. We can see from our bank account that payment was never taken.

What should we do? In particular, we are concerned by the fact that, even though we know very well they are using our process, we haven't caught them in the act.

**Prepare notes for a meeting with your client. You should consider actions your client could take and also third-party rights.**

**Total: 20 marks**

### Question 8

Your client has acquired a portfolio of UK patents and applications. Prepare notes for a meeting with your client summarising what steps need to be taken and by when.

- a) Application A was published on 16 March 2020 and no request for examination has been filed. Discuss in detail what extensions of time are available.

**6 marks**

- b) Application B is a PCT application which has been entered into the GB regional phase. No statement of inventorship has been filed. It is not necessary to consider what extensions of time are available.

**3 marks**

- c) Application C is pending. An examination report was sent on 16 June 2020 and set a two-month deadline for filing a response. The client informs you they will not be able to provide instructions for filing a response for at least another week.

**5 marks**

- d) Application D was filed 11 months ago. It has one claim to a metal widget. The applicants have discovered that a cheaper rubber widget also works. The clients wish to protect both metal and rubber widgets in a single application.

**6 marks**

**Total: 20 marks**

### Question 9

In relation to UK patent law and procedure, draft a letter to a UK client explaining the meaning of the following terms:

a) A divisional application (do not discuss time limits or formal requirements). **4 marks**

b) Sufficiency, in particular the various ways in which an objection on the grounds of lack of sufficiency can arise. **4 marks**

Also, explain to your client:

c) The circumstances in which a court will award compensation to an employee in respect of an invention belonging to an employer for which a patent has been granted. You are not required to discuss determination of the amount of compensation but should include the time window in which it can be applied for. **6 marks**

Finally, explain to your client:

d) The consequences of surrendering a patent. **6 marks**

**Total: 20 marks**

## Question 10

Your client writes:

We have a granted European patent designating the UK. The patent was filed and prosecuted in German at the EPO. We validated the patent at UKIPO, filing the necessary English language translation of the granted patent at UKIPO, which was subsequently published by UKIPO.

We have become aware of a competitor who is potentially infringing the patent. Having read claim 1 of our patent, we note it contains two errors. The first is a simple typographical error. The second error is more serious and affects the scope of the claim. On a more positive note, the competitor appears to be making fairly minimal use of the invention. The invention has a wide range of applications which do not appear to have occurred to the competitor yet.

You review claim 1. The English language translation of claim 1 is narrower in scope than the original German claim. To make matters worse, whilst the goods sold by the competitor to date fall within the scope of the German language claim, they do not fall within the scope of the English language claim.

- a) **In terms of infringement, explain what it means to say that the scope of one claim is narrower than another.**

1 mark

- b) **Summarise the provisions of *Section 80 of the UK Patents Act 1977 (Authentic text of European patents and patent applications)* relating to determination of the authentic text of a European patent for the purposes of proceedings before a UK Court. Your answer should not be restricted to infringement proceedings only.**

4 marks

- c) **Write notes for a meeting with your client. Your notes should cover the following:**

- i) **What can be done as regards the typographical error.**
- ii) **What can be done as regards sales made to date by the competitor. Explain your reasoning.**
- iii) **What else can be done to minimise the consequences of these translation errors? Explain your reasoning with particular reference to the defences to infringement that the competitor may have.**

15 marks

**Total: 20 marks**