

**Patent Examination Board**  
**Notice**  
**Law Changes for 2018 Qualifying Examinations**

The PEB examinations are based this year on legal texts and case law which were in force on **6 April 2018**.

Candidates will not be penalised for basing their answers on any amendments to the law enacted after 6 April 2018, or any case law published after 6 April 2018, and before the date of the examination. However, candidates must be consistent in their application of any recent changes in the law and are advised to mention in their answer if they are relying on provisions of law enacted or published after 6 April 2018.

In relation to Brexit, no law changes have yet been implemented and the syllabuses and examinations are, as yet, unaffected.

Some law changes have taken place in the year to 6 April 2018. Here is the PEB advice in relation to these changes.

**FC3 – Foreign Law**  
**FD1 – Advanced IP Law and Practice**

**EPC**

As from 1 April 2018, R51 EPC has been amended such that the European Patent renewal fee in respect of the 3rd year may not be validly paid more than 6 months before it falls due. For all other years the renewal fee may not be validly paid more than 3 months before it falls due.

Prior to 1 April 2018, the supplementary search fee that falls due upon entry into the European regional phase is reduced by EUR 190 if the international search report was drawn up by the US, Japanese, Korean, Chinese, Russian or Australian patent office. For applications that enter the European regional phase from 1 April 2018, the reduction in the supplementary search fee will not be available.

Guidelines for Examination Section C-III, 5. The November 2017 version of the EPO Guidelines for Examination permits the Examining Division to issue a summons to oral proceedings as the first substantive communication if it is considered that the response to the search opinion presents no possibility of grant.

**China**

China's patent examination guidelines have been amended as from 1 April 2017 particularly in relation to patentability of computer software and business methods.

**FC4 – Design and Copyright Law**

CDPA 107 and RDA 24B: sections updated in light of the Digital economy act 2017  
CDPA 253 and RDA 26, 24A: sections updated to take into account the Intellectual property (unjustified threats) act 2017

The UK has ratified the Hague Agreement, which will enter into force on 13 June 2018. Whilst this introduces changes to the RDA and Registered Design Rules, the Sections/Rules

on the FC4 syllabus are not affected. This is mentioned merely for the candidates' information.

## **FC5 – Trade Mark Law**

The changes introduced by Regulation 2015/2424, amending the EU Trade Mark Regulation (Regulation (EU) 207/2009), are now fully in force. A list of articles amended with effect from 1 October 2017 can be found at the end of the Regulation, under Article 4.

The extant EU Trade Mark Regulation is now Regulation (EU) 2017/1001. This particular regulation amended the numbering of the articles in the previous EUTMR (207/2009), including the amendments introduced by Regulation 2015/2424. However, it introduced no substantive changes to the law. A correlation table linking the old to new numbering can be found in Annex III of the Regulation.

The (UK) European Union Trade Mark Regulations 2016 (SI 2016 No. 299) updated UK domestic legislation with cross references to the amended EUTMR, and introduced the new terminology (i.e. "European Union" in place of "Community").

## **FD4 – Infringement and Validity**

### **FD1 – Advanced IP Law and Practice**

Candidates will be expected to be able to apply the reasoning behind the decision of the Supreme Court in *Actavis UK Limited and others v Eli Lilly and Company* ([2017] UKSC 48).

## **All Foundation Certificate examinations except FC3**

### **FD1 – Advanced IP Law and Practice**

The Intellectual Property (Unjustified Threats) Act 2017 is now in force, introducing changes to the law relating to unjustified threats.

### **FD1 – Advanced IP Law and Practice**

#### **UK**

Changes to fees have come into effect which include increases to the application fee, search fee and examination fee as well as increases to renewal fees for patents for the 12th year onwards but only regarding the amount payable which is not necessary for the exam. Of more significance is the proposal to introduce, for the first time in the UK, fees for both "excess claims" (£20 per claim above 25) and "excess pages" (£10 per page over 35) in an application. The claims fees are payable, if necessary, when requesting **search** of a UK application. The page fees are payable, when requesting **substantive examination** of a UK application. This means that these will not apply where the UK application is only being used in order to establish a priority date for subsequent applications.