

Foundation Certificate Syllabus

UK Patent Law FC1 (P1) Contents

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**PEB Foundation Certificate
UK Patent Law FC1 (P1)**

1. Guidance for Candidates

The Patent Examination Board is an examination agency which has been accredited by IPReg to offer an examination only route for the Foundation Level Qualifications for patent attorneys. FC1 UK Patent Law is one of five examinations within the PEB Foundation Certificate. Together, the five examinations of the PEB Foundation Certificate:

- a) provide a structure which is benchmarked within the QAA Frameworks for Higher Education Qualifications of UK Degree-Awarding Bodies (2014) as being at Level 6 – a professional graduate-level certificate
- b) develop an understanding and appreciation by the candidates of all the Intellectual Property Law and Professional Ethics Subjects set out in Schedule A of the IPReg Accreditation Handbook
- c) equip candidates with the transferable skills set out in Schedule B of the IPReg Accreditation Handbook.

You should refer to the Qualifying Examination Foundation Certificate Programme Specification for full information on the Foundation Certificate including:

- QAA Credits of study
- QAA Level 6 Benchmarking
- IPReg Intellectual Property Law and Professional Ethics subjects
- IPReg General Transferable Skills
- Meeting the Minimum Competence Standard required for a Pass in the Foundation examinations.

The Foundation Certificate is structured to be equivalent to 60 QAA credits (where one credit is 10 hours of study). Each Foundation Certificate examination equates to 12 credits of study. You should, therefore, expect to spend around 120 hours of study in preparation for this examination.

2. The Syllabus

Summary:

To be successful in this examination, you will need to:

- demonstrate an understanding and appreciation of the Patent Law topics set out in Schedule A of the IPReg Accreditation Handbook in so far as they relate to patent law in the UK. You will thus need to demonstrate knowledge of the main provisions of the UK Patents Act 1977, the related Patents Rules, and the principles which underpin patent law in the UK.
- demonstrate that you have acquired the transferable skills set out in Schedule B of the IPReg Accreditation Handbook. You should refer to the Foundation Programme Specification Appendix B for more information. In summary, the transferable skills may be demonstrated by recall of relevant principles, laws and rules, and/or applying them to one or more given scenario(s).

The **Content** states the topics which are covered and gives the related IPReg patent law topics in brackets.

The **Learning Outcomes** describe what you will have to demonstrate in the examination to show that you have the required knowledge and transferable skills. The section 'Meeting the requirements for a Pass' in the Foundation Programme Specification explains how the Learning Outcomes link to the minimum Pass requirements.

The final two columns list the key sections of the **legal provisions** relevant to the content and learning outcomes.

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	Content (IPReg Patent topics)	Learning Outcomes	Patents Act 1977	Patents Rules 2007
1	The law relating to patentable inventions in the UK (Requirements for patentability, novelty, inventive step, subject matter)	a) Define the requirements for a patent to be granted on an invention, including: <ul style="list-style-type: none"> • novelty • inventive step • industrial applicability • exclusions to patentability b) Describe the available patent protection for methods of treatment or diagnosis and biotechnological inventions c) Explain whether a document is prior art d) Apply (a) to (c) to a scenario	PA 1 – Patentable inventions	
			PA 2 – Novelty	PR 5
			PA 3 – Inventive step	
			PA 4 – Industrial application	
			PA 4A – Methods of treatment or diagnosis	
			PA 76A and PA Schedule A2 – Biotechnological inventions	
2	In relation to UK patent applications, the: <ul style="list-style-type: none"> • right to apply for and obtain a patent • determination of inventors • ownership of a patent • the relationship between employer and employees (Inventorship, ownership and employee rights)	a) Define the right to apply for and obtain a patent b) Describe the procedure for naming the inventor(s) c) Describe the implications of co-ownership d) Recall the provisions relating to employee inventions, including compensation e) Identify inventorship and ownership issues in a scenario	PA 7 – Right to apply for and obtain a patent	
			PA 13 – Mention of Inventor	PR 10,11
			PA 36 – Co-ownership of patents and applications for patents	
			PA 39 – Rights to employees’ invention	
			PA 40 & 41 – Compensation of employees for certain inventions	
			PA 42 & 43 Enforceability of contracts relating to employees’ inventions	

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3	The law relating to the UK patent application process (Obtaining a patent in the UK)	<ul style="list-style-type: none"> a) Describe how to make a UK patent application, including a divisional application b) List the requirements for obtaining a filing date for a UK patent application c) Describe the procedure from filing through search and examination to grant, including any available extensions of time d) Define the deadline for placing a UK patent application in order for acceptance e) Recall the provisions relating to reinstatement of a UK patent application f) Apply (a) to (e) to a scenario 	PA 14 – Making an application	PR 12, 15, 16, 113, 115
			PA 15 – Date of filing application	PR 17 to 22
			PA 15A – Preliminary examination	PR 23, 24
			PA 16 – Publication of application	PR 26
			PA 17 – Search	PR 27
			PA 18 – Substantive examination and grant or refusal of patent	PR 28 to 30
			PA 20 – Failure of application	
			PA 20A – Reinstatement of applications	PR 32
			PA 20B – Effect of reinstatement	
			PA 117B – Extension of time limits specified by Comptroller	PR 107, 108, 109
			PA 119 – Service by post	PR 111
PA 120 – Hours of business and excluded days	PR 110			
4	The law relating to amendment and to correction of UK patent applications and patents (Obtaining a patent in the UK)	<ul style="list-style-type: none"> a) Identify when a patent or patent application can be amended b) Explain the procedure for amending a patent or patent application c) Identify when an error in a patent or patent application can be corrected d) Explain the procedure for correcting an error in a patent or patent application e) Describe the differences in the law relating to an amendment and a correction of a patent application or patent f) Apply (a) to (e) to a scenario 	PA 19 – General power to amend	PR 31
			PA 27 – General power to amend specification after grant	PR 35, 75
			PA 75 – Amendment of patent in infringement or revocation proceedings	
			PA 76 – Amendments of applications and patents not to include added matter	
			PA 117 – Correction of errors in patents and applications	PR 105, PR49, PR50
			PA 117A – Effect of resuscitation of a withdrawn application under Section 117	

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5	The impact of national security or public safety issues on filing UK or overseas patent applications (Laws and procedures relating to the protection of patents (domestic, international and comparative))	a) Describe the restrictions on publishing UK patent applications because of national security or public safety issues b) Explain the restrictions on the process for filing patent applications outside the UK c) Apply (a) and (b) to a scenario	PA 22 – Information prejudicial to national security or safety of the public	
			PA 23 – Restrictions on applications abroad	
6	Priority (Priority)	a) Identify the circumstances in which priority can be claimed b) Describe the mechanism for claiming priority, including late priority claims c) Explain the effects of claiming priority d) Determine whether a later application can validly claim priority from an earlier application	PA 5 – Priority date	PR 3 and 6 to 9
			PA 6 – Disclosure of matter etc., between earlier and later application	
7	The duration of a UK patent (Obtaining a patent in the UK)	a) Describe the procedure when a patent is granted b) Define the term of a patent and the renewal process for maintaining the patent c) Explain the restoration process and the implications of restoring a lapsed patent d) Describe the procedure for and implications of surrendering a patent e) Apply (b) and (c) to a scenario	PA 24 – Publication and certificate of grant	
			PA 25 – Term of Patent	PR 36 to 39
			PA 28 – Restoration of lapsed patents	
			PA 28A – Effect of order for restoration of patent	PR 40
			PA 29 – Surrender of patents	

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8	UK patents and patent applications as forms of property (Intellectual property transfer, commercialisation and licensing)	a) Describe the transactions, events and instruments in patents and patent applications governed by PA 30 b) Explain the effect of registration of a transaction, event or instrument and the implications of non-registration c) Describe licences of right and the procedure for applying for and cancelling such licences d) Describe the information which is available on the Register or by inspection	PA 30 – Nature of, and transactions in, patents and applications for patents	
			PA 31 – Nature of, and transactions in, patents and applications for patents in Scotland	
			PA 32 – Register of patents etc	PR 47, 103, 104
			PA 33 – Effect of registration	
			PA 46 – Patentee’s application for entry in register that licences are available as of right	PR 43, 73
			PA 47 – Cancellation of entry made under section 46	PR 75
			PA 68 – Effect of non-registration on infringement proceedings	
			PA 118 – Information about patent applications and patents, and inspection of documents	PR 54
9	The law relating to infringement of UK patents (Direct and indirect infringement, remedies, evidence, defences, differences between novelty and freedom-to-operate searching)	a) Identify the acts which infringe a UK patent and the circumstances in which such acts do not constitute infringement b) Describe the relief which may be claimed by a patentee for an infringing act, including any restrictions on the recovery of damages c) Explain the implications of a UK patent being found to be partially valid during infringement proceedings	PA 60 – Meaning of infringement	
			PA Schedule A1 – Derogation from patent protection in respect of biotechnological inventions	
			PA 61 – Proceedings for infringement of patent	
			PA 62 – Restrictions of recovery of damages for infringement	
			PA 63 – Relief for partially valid patent	
			PA 64 – Right to continue use begun before priority date	

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		d) Describe the circumstances in which an infringing act which was begun before the priority date of the patent may continue e) Explain when a certificate of contested validity may be issued and any implications of its issue f) Describe how a co-owner or an exclusive licensee brings infringement proceedings g) Explain the rights available between publication of the UK application and grant of the UK patent h) Describe the burden of proof for determining if a product is made by a patented process i) Differentiate between novelty and freedom to operate searches j) Apply (a) to (i) to a scenario	PA 65 – Certificate of contested validity of patent PA 66 – Proceedings for infringement by a co-owner PA 67 – Proceedings for infringement by exclusive licensee PA 69 – Infringement of rights conferred by publication of application	
10	In relation to UK patents and patent applications: <ul style="list-style-type: none"> • groundless threats • declaration of non-infringement • false marking (Direct and indirect infringement)	a) Explain when proceedings for a groundless threat may be brought b) Describe the remedies for a groundless threat and describe when these remedies are available c) Explain when a declaration of non-infringement may be sought and any implications if it is issued d) Outline the consequences of unauthorised claims in relation to patents and patent applications	PA 70 – Threats of infringement proceedings PA 70A – Actionable threats PA70B – Permitted Communications PA70C – Remedies and defences PA70D – Professional advisers PA70E – Pending registration PA70F – Proceedings for delivery up etc PA 71 – Declaration as to non-infringement PA 110 – Unauthorised claim of patent rights	

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		e) Apply (a) to (e) to a scenario	PA 111 – Unauthorised claim that patent has been applied for	
11	The law relating to challenging UK patents and patent applications (Defences)	a) Describe when and how third party observations can be filed	PA 21 – Observations by third parties	PR 33
		b) List the grounds of revocation of a UK patent and who may file an application for revocation	PA 26 – Patent not to be impugned for lack of unity	
		c) Describe when the comptroller can revoke a UK patent on his own initiative	PA 72 – Power to revoke patents on application	PR 73, 87
		d) As set out in section PA 74, identify the proceedings in which validity may be put in issue	PA 73 – Comptroller's power to revoke patents on his own initiative	
		e) Describe the matters on which a Patent Office Opinion can be requested and the procedure for obtaining such an Opinion	PA 74 – Proceedings in which validity may be put in issue	
			PA 74A and 74B – Opinions by Patent Office	PR 92 to 100
12	The effect of European patents and applications in the UK (Laws and procedures relating to the protection of patents (domestic, international and comparative))	a) Describe the effect of a European patent or European patent application in the UK	PA 77 – Effect of European patent (UK)	
		b) Determine whether or not a European patent application filed via the Patent Cooperation Treaty is prior art for a UK patent application	PA 78 – Effect of filing an application for a European patent (UK)	PR 114
		c) Identify the authentic text of a European patent or European patent application for UK proceedings	PA 79 – Operation of PA 78 in relation to certain European patent applications	
			PA 80 – Authentic text of European patent and patent applications	

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13	The effect of applications under the Patent Co-operation Treaty in the UK (Laws and procedures relating to the protection of patents (domestic, international and comparative))	a) Describe the effect of an International patent application in the UK b) Describe the procedure for entering the national phase in the UK, including any extensions of time c) Apply (b) to a scenario	PA 89 – Effect of International application for patent	
			PA 89A – International and national phases of applications	PR 66, 67, 68, 69, 70
			PA 89B Adaptation of provisions in relation to Inter – national application	
14	Definitions in the Patents Act 1977 (Laws and procedures relating to the protection of patents (domestic, international and comparative), inventorship, ownership and employee rights)	a) Explain the main terms and phrases set out in PA 130	PA 130 – Interpretation	
15	UK Patent law cases	a) Explain how the scope of protection is determined with reference to PA 125 and leading cases b) Describe the parties to, the facts of and the legal principles established by the listed leading cases	PA125 – Extent of invention <i>Interpretation/construction</i> <ul style="list-style-type: none"> • Catnic v Hill & Smith [1982] RPC 183 (HL) • Improver v Remington [1990] FSR 181 	

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	Content (IPReg Patent topics)	Learning Outcomes	<u>Patents Act 1977</u>	<u>Patents Rules 2007</u>
	(Novelty, inventive step, Direct and indirect infringement)		<ul style="list-style-type: none"> • Kirin-Amgen Inc v Hoechst Marion Roussel Limited [2004] UKHL 46 • Actavis v Eli Lilly [2017] UKSC 48 <p><i>Inventive step</i></p> <ul style="list-style-type: none"> • Windsurfing v Tabur Marine [1985] • RPC 59 • Pozzoli Spa v BDMO [2007] EWCA Civ 588 CA <p><i>Novelty</i></p> <ul style="list-style-type: none"> • Merrell Dow v Norton [1995] UKHL 12 [1996] RPC 76 (HL) • Synthon v SmithKline Beecham [2005] UKHL 59 [2006] RPC 10 • Dr Reddy’s Laboratories v Eli Lilly [2008] EWHC 2345 (Pat), [2009] EWCA Civ 1362 	

3. Reading

NB All the Acts and Rules referred to in this syllabus are essential reading.

Other books and/or websites listed here can be used to support your learning. It is not an exhaustive list and other sources of information can be used.

- *CIPA Guide to the Patents Acts* (2011) Ed. Paul Cole, pub. Sweet and Maxwell (The Black Book)
- *Patents Training Manual* (2010) Ed. Gwilym Roberts, pub. CIPA
- *The Manual of Patent Practice* (2014), pub. IPO

4. The Examination

This syllabus is assessed via a three hour unseen examination. The pass mark is 50%.

The question paper is divided into Section A and Section B.

There are 100 marks available in total: 40 marks in Section A and 60 marks in Section B.

Candidates are instructed to attempt **all** questions in Section A and **three questions from four questions** in Section B.

- Each question in Section A is worth between 1 and 10 marks.
- Each question in Section B carries 20 marks.