Patent Examination Board

Foundation Certificate Syllabus

International Patent Law FC3 (P5)

Contents

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 outside the UK. You will thus need to give general strategic advice regarding protecting an invention using an international portfolio of patent and utility model applications to cover the following countries;
    - Argentina, Brazil, Canada, Mexico, USA
    - China, Japan, South Korea, Taiwan
    - Australia, New Zealand, Singapore
    - India, Israel, Saudi Arabia, South Africa, and
    - EPC, Germany, France, Italy, Spain, Netherlands, Norway, Poland

  You will need to demonstrate knowledge of the main provisions of the Patent Cooperation Treaty (PCT) and the European Patent Convention (EPC). You will also need to demonstrate knowledge of the national patent/utility model laws, and procedures for applying for and obtaining patent/utility model rights in Australia, China, Germany, Hong Kong, Japan, Singapore and USA

- demonstrate that you have acquired the transferable skills set out in Schedule B of the IPReg Accreditation Handbook. Candidates should refer to Transferable Skills for more information but in summary, the transferable skills may be demonstrated by being able to recall the relevant principles, laws and rules, and/or apply them to one or more given scenario(s).

The **Content** states the topics which are covered in the examination 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 column lists the key sections of the following **legal provisions** relevant to the content and learning outcomes.

	Content (IPReg topics)	Learning Outcomes	Legislation	Rules
1	General considerations for protecting inventions in • Argentina, Brazil, Canada, Mexico, USA • China, Japan, South Korea, Taiwan • Australia, New Zealand, Singapore • India, Israel, Saudi Arabia, South Africa, and • EPC, Germany, France, Italy, Spain, Netherlands, Norway, Poland • (Rationale and purpose of the patent system, strategic creation and management of patent portfolios,tThe legal protection of trade secrets and confidential information obtaining a patent in other key jurisdictions, laws and procedures relating to the protection of patents (domestic, international and comparative), priority)	a) Describe the rationale for and purpose of the patent system b) Evaluate and compare alternative ways in which a client's invention may be protected in the listed countries, including outlining: • the strategic creation and management of a patent portfolio and • the principles for the legal protection of trade secrets and confidential information c) For each country explain whether a patent or utility model can be obtained via the PCT, the EPC and/or the national route d) Explain the differences between patents and utility models e) Define the underlying principles for claiming priority, with reference to the Paris Convention or other treaties as appropriate f) Identify any grace periods for prior disclosures g) Apply (a) to (f) to a scenario	Paris Convention (PC) PC4 Right of priority PC5 Priority date	

	Content (IPReg topics)	Learning Outcomes	Legislation	Rules
2	The patent application process via the PCT – the international phase (PCT procedure, laws and procedures relating to the protection of patents (domestic, international and comparative), priority)	a) Describe how to make an international (PCT) application: a. who may apply b. where the application may be filed c. the minimum requirements to obtain a filing date d. time limits for filing formal documents e. content of the description, claims and abstract f. claiming priority b) Define the time limits for requesting search or examination during the international phase c) Describe the procedures for responding to the search report or written opinion d) Explain the procedure for correction or amendment during the international phase	Patent Cooperation Treaty (PCT) Chapters I and II	
3	The patent application process via the PCT – the national/regional phase in • Brazil, Canada, Mexico, USA • China, Japan, South Korea • Australia, New Zealand, Singapore • India, Israel, Saudi Arabia, South Africa, and	a) Outline the procedure for entering the regional phase in Europe (EPC) or the national phase for each of the listed countries including: a. time limits (and any extensions of time) b. translation requirements c. the payment of claims fees d. deadlines for examination (including any extensions of time) e. any other documents required at filing b) Identify whether the application can be amended on entering the national or regional phase	The European Patent Convention (EPC) EPC Art 153 The PCT Applicant's Guide National phase	EPR 159 - 163

	Content (IPReg topics)	Learning Outcomes	Legislation	Rules
	• EPC, Germany, France, Italy, Spain, Netherlands, Norway, Poland • (PCT procedure, obtaining a patent in other key jurisdictions, laws and procedures relating to the protection of patents (domestic, international and comparative))			
4	The patent application process via the EPC (European patent procedure, laws and procedures relating to the protection of patents (domestic, international and comparative), requirements for patentability, nature of an invention, novelty, inventive step, subject matter, priority)	a) Define the requirements for a patent to be granted on an invention: • Novelty • Inventive step • Industrial application • Exclusions to patentability b) Describe how to make an EP application: a. who may apply b. where the application may be filed c. the minimum requirements to obtain a filing date d. the time limits for filing formal documents e. the content of the description, claims and abstract e. the payment of claims fees f. claiming priority	<u>The European Patent Convention</u> (EPC) a) EPC Arts 52 to 57 b) EPC Arts 58 to 62 – Persons entitled to apply for and obtain European patents – Mention of inventor EPC Arts 75 to 86 Filing and requirements for a European patent application EPC Arts 87 to 89 Priority c) EPC Art 93 Publication of a European patent application	 EPR 35, 36, 38-45, 47, 51 EPR 52, 53 EPR 36, 70

	Content (IPReg topics)	Learning Outcomes	Legislation	Rules
		c) Define the time limits for requesting search or examination d) Describe the procedures for responding to the search report or examination report e) Explain the procedure for correction or amendment of a pending application and central limitation for a granted patent f) Describe the procedures for further processing and re-establishment g) Outline the procedure on grant including the national validation procedure for the following countries: Germany, France, Netherlands, Italy, Spain, Poland, Norway h) Outline the procedure for requesting a patent with Unitary Effect	d) EPC Art 94 Examination of a European patent application e) EPC Art 123 Amendments EPC Art 105a to c Request for limitation or revocation f) EPC Art 121 Further processing EPC Art 122 Re-establishment of right g) EPC Art 97 Grant or refusal EPC Art 65 Translation of the EP patent <u>National law</u> relating to the EPC h) Regulation (EU) No 1257/2012 of the European Parliament and of the Council of 17 December 2012 implementing enhanced cooperation in the area of the creation of unitary patent protection	EPR 62a, 63, 64 EPR 70a, 71 EPR 126, 127, 131, 132, 134 EPR 137, 139 EPR 135 EPR 136 EPR 71 Rules relating to Unitary Patent Protection (UPR) – UPR 5, 6, 20
5	Obtaining a patent or a utility model via the national patent offices in: • Australia, • China, • Germany, • Hong Kong,	a) Define the restrictions on filing applications abroad as set out in section 23 of the UK Patents Act b) Identify which of the listed countries have similar provisions c) Define the requirements for patentability (e.g. novelty, inventive step, exclusions)	<u>The Patents Act 1977</u> (PA) PA 23	

	Content (IPReg topics)	Learning Outcomes	Legislation	Rules
	• Japan, • Singapore and • USA (Obtaining a patent in other key jurisdictions, laws and procedures relating to the protection of patents (domestic, international and comparative), requirements for patentability, nature of an invention, novelty, inventive step, subject matter, priority) .	d) Outline the application process: a. Who may apply b. Where the application may be filed c. The content of the description, claims and abstract d. The payment of claims fees e. Time limits for filing formal documents f. Claiming priority e) Define any time limits, including extensions of time, for requesting search and/or examination f) Outline the examination procedure, including any time limits (and extensions) for responding to any objections from the examiner g) Describe any requirements to disclose prior art		
6	The law relating to opposition, re-examination and/or revocation of granted EP patents, Japanese patents, US patents and German patents and utility models. (Defences)	a) Identify who may bring opposition, re-examination and/or revocation proceedings b) Define any time limits associated with each process c) Describe the procedure before each patent office d) Outline any appeal process	<u>The European Patent Convention</u> (EPC) EPC Arts 99 to 101 - Oppositions EPC Art 105 Intervention of the assumed infringer EPC Arts 106 to 108 – Appeal	EPR 76 EPR 99

3. Reading

NB The Patent Cooperation Treaty (PCT) and the European Patent Convention (EPC) 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.

- *Patents Training Manual* (2010) Ed. Gwilym Roberts, pub. CIPA
- Guidelines for Examination in the European Patent Office (March 2022)
- National Law relating to the EPC (2019 20th edition), pub. EPO
- *PCT Applicant's Guide (WIPO)*
- *Manual for the Handling of Applications for Patents, Designs and Trademarks Throughout the World: Supplement 104* (2003) Godeau, Constance Zigtema, pub. Kluwer Law International (The Brown Book)
- *Manual of Patent Examining Procedure* (uspto.gov)
- Japanese Patent Office
- *An Annotated Guide to the European Patent Convention* Derk Visser
- *References to the EPC* Jelle Hoekstra
- The *Cross-Referenced Patent Cooperation Treaty*
- *Unitary Patent Guide*

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.