

Final Diploma Syllabus

Infringement and Validity FD4 (P6)

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1. Guidance for Candidates

The aim of the Final Diploma examinations is to assess whether a candidate has built on knowledge gained at the Foundation level and reached a minimum level of competency at which the candidate is deemed to be safe to practise. The Final Diploma examinations are based on the core competencies that are expected of a patent attorney.

Final Diploma candidates need to demonstrate that they:

- have a thorough knowledge and understanding of the law;
- can apply their knowledge of the law in a manner that is appropriate to the facts provided and the client's needs; and
- are able to express advice in a clear and consistent manner.

The Final Diploma examinations test candidates' ability to:

- see the overall picture;
- assimilate and make use of data, information, themes and ideas provided;
- extract and identify key issues and consider how best to present these in the context of the situation provided;
- write in a logical, cohesive and clear manner; and
- provide outcomes and proposals that:
 - i. reflect the client's needs and priorities;
 - ii. are based on analysis of information available and, where appropriate, risks and costs;
 - iii. are practicable and achievable; and
 - iv. meet the requirements of relevant law and represent good practice with an appreciation of commercial realities of the situation presented.

This syllabus tests candidates' ability to:

- analyse and prepare advice on UK infringement and validity issues that are appropriate to the facts provided and the client's needs;
- reach an informed opinion on a finely balanced point;
- use information provided to support the opinion reached;

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- propose actions based solely on information provided;
- identify further information or evidence that may be required for a final opinion but, where necessary, propose actions on the basis of limited information; and
- where appropriate, identify an alternative scenario or interpretation.

Format of PEB syllabuses

Each syllabus contains:

- A **summary** which gives an overview of the examination content and scope.
- A **content** section which advises you what knowledge and/or skills you need for the examination.
- A **learning outcomes** section which describes what you will have to demonstrate in the examination to show that you have the required knowledge and/or skills.
- Lists of the key sections of the **legal provisions** relevant to the content and learning outcomes (where relevant).

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2. The Syllabus

The syllabus is set out in an order which guides candidates through the tasks to be undertaken in the examination.

Summary: To complete this examination successfully, you will need to demonstrate a full understanding of the law and practice of patent infringement and validity issues in the UK. You will also need to demonstrate an ability to advise lay clients on their best course of action in matters related to patent infringement and validity.

The **Content** advises you what knowledge and skills you need for this examination.

The **Learning Outcomes** describe what you will have to demonstrate in the examination to show that you have the required knowledge and skills.

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

	Content	Learning Outcomes	<u>Patents Act 1977 and EPC¹ 2000</u>	<u>Patent Rules 2007</u>
1	The law and practice relating to patentable inventions in the UK	a) Apply the law and practice governing patentable inventions to a case b) Construe a patent claim using the principles from Actavis v Eli Lilly [2017] UKSC 48 c) Determine the prior art	PA 1 – Patentable inventions PA 2 – Novelty PA 3 – Inventive step PA 4 – Industrial application PA 125 – Extent of invention	PR5

¹ European Patent Convention

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	Content	Learning Outcomes	<u>Patents Act 1977 and EPC¹ 2000</u>	<u>Patent Rules 2007</u>
		d) Apply prior art to the claim construction		
2	The law and practice relating to the amendment of UK patents	a) Evaluate the possibility of amending a patent to improve the prospects of enforcement b) Determine the appropriate procedure for amending the patent c) Assess the implications of amending the patent	PA 27 – General powers to amend 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 EPC Art 105a – Request for Limitation or revocation	PR35 PR105

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	Content	Learning Outcomes	<u>Patents Act 1977 and EPC¹ 2000</u>	<u>Patent Rules 2007</u>
3	The law and practice relating to infringement of a UK patent	<ul style="list-style-type: none"> a) Apply the law and practice governing infringement to a case b) Determine the infringing acts c) Apply the claim construction to the infringing acts using the principles from Actavis v Eli Lilly [2017] UKSC 48 d) Evaluate whether there are 'design around' possibilities to avoid the protection offered by a patent under consideration 	PA 60 – Meaning of Infringement PA 61 – Proceedings for Infringement of patent PA 64 – Right to continue use begun before priority date PA 125 – Extent of invention	
4	The law and practice relating to challenging validity of a UK patent	<ul style="list-style-type: none"> a) Determine the available procedures for challenging the validity of the patent b) Evaluate the appropriate procedures 	PA14(3) – Sufficiency PA72 – Power to revoke patents on application PA74 – Proceeding in which validity of patent may be put in issue EPC Art 99 – Opposition EPC Art 100 – Grounds for opposition	

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	Content	Learning Outcomes	<u>Patents Act 1977 and EPC¹ 2000</u>	<u>Patent Rules 2007</u>
5	Advise lay clients during the process of examining potential infringements of patents	<ul style="list-style-type: none"> a) Summarise your conclusions from your analysis (sections 1 to 4 above) b) Based on your conclusions, recommend the most appropriate course(s) of action c) Justify the recommended course(s) of action d) Indicate where further information is needed e) Indicate other practice points that may be raised by the situation 	See all sections of the Patents Act and EPC above and PA70 – Remedy for groundless threats of infringement Proceedings PA71 – Declaration or declarator as to non-infringement PA74A – Opinions on matters prescribed in the rules	

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3. Reading List

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)
- Terrell on the Law of Patents (2010) Richard Miller, QC; Guy Burkill, QC; His Honour Judge Birss, QC; Douglas Campbell, pub. Sweet and Maxwell
- How to Pass P6 (2013), Nigel Frankland, pub. CIPA

4. The Examination

This syllabus is assessed via a five hour unseen examination. The pass mark is 50%. Candidates will be instructed to analyse the information provided and undertake the following task:

Your task is to prepare advice to your client on whether the attached granted patent may be enforced and defended.

Prepare notes on which you would base advice in which you:

- Provide an opinion on infringement and validity in the UK only.
- Identify other patent related legal issues pertinent to the facts presented.
- Outline possible actions that may be taken to strengthen your client's legal position.
- Summarise the opinions formed in a - c above.