

**THE CHARTERED INSTITUTE OF PATENT ATTORNEYS
ADVANCED PATENT PARALEGAL COURSE
SYLLABUS**



Introduction - Structure of the syllabus

This syllabus is set out as follows:

1. Information **about the qualification**.
2. The **aims of the qualification**.
3. A module-by-module description of the **qualification content** which contains the:
 - a) name and number of the module and section of the syllabus;
 - b) content of each section of the syllabus;
 - c) learning outcomes for each section of the syllabus.

The learning outcomes set out what candidates will have to demonstrate **by assessment** to show that they have the required knowledge and/or skills.

4. Information about **the assessment modalities**.

1. About the qualification

This qualification builds on the skills and knowledge acquired after successful completion of the Introductory Certificate in Patent Administration. It develops the more complex skills, knowledge and practice of Patent and Design Administration.

It encourages the development of problem-solving skills as applied to the work of a paralegal practitioner working in both private practice and in industry.

As with Introductory Certificate, it encourages utilisation and expansion of candidates' existing knowledge, and supports them in their day-to-day role and career aspirations.

The course requires the development of skills in and understanding in core subjects as well as allowing candidates to choose from a range of elective modules once available.

Successful completion of the qualification requires candidates to pass all the core modules over a period of one year.

Successful completion of the elective modules will provide additional accreditations to the qualification. When available, elective modules must be successfully completed within the same year as the core modules.

Aims of the qualification

The aims of the qualification are to develop:

- the enhanced knowledge and skills necessary to deal with the filing; prosecution and post-grant formalities of GB, EP and PCT patent applications;
- the ability to apply skills and knowledge, using a problem-solving approach;
- an understanding of the critical importance of meeting legal requirements and deadlines, and how to remediate situations where legal requirements and deadlines are not met;
- the opportunity to acquire skills and knowledge in specific areas of patent and design law which may be relevant to the paralegal's own areas of practice or for future career pathways.

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Qualification Level

The level descriptors build on those used within the Regulated Qualifications Framework (RQF) and the European Qualifications Framework (EQF). Levels 4-8 are intended to be consistent with the five levels within the Framework for Higher Education Qualification in England, Wales and Northern Ireland (FHEQ).

Level 6	Knowledge descriptor (the holder ...)	Skills descriptor (the holder can ...)
	1. Has advanced practical, conceptual or technological knowledge and understanding of a subject or field of work to create ways forward in contexts where there are many interacting factors. 2. Understands different perspectives, approaches or schools of thought and the theories that underpin them. 3. Can critically analyse, interpret and evaluate complex information, concepts and ideas	a) Determine, refine, adapt and use appropriate methods and advanced cognitive and practical skills to address problems that have limited definition and involve many interacting factors. b) Use and, where appropriate, design relevant research and development to inform actions. c) Evaluate actions, methods and results and their implications.

Notional Learning Time

Under the QAA's Credit Framework, 1 credit is equivalent to 10 hours of study/notional learning hours.

The Advanced Patent Paralegal Course has a notional credit value of 40 credits/400 hours.

The notional learning hours are based on the amount of study that an average candidate would be expected to undertake before successfully completing the examination. There may, however, be variations in the time spent by different candidates.

Notional learning hours includes all time expected to be spent by a student in pursuit of the qualification. This may include:

- on-the-job training
- work in professional practice;
- independent/self study and reading
- preparation for contact hours
- completing the required webinars
- coursework, revision and assessment (formative and summative)

The APPC develops and assesses candidates' professional competence: experience gained in day-to-day professional practice provides numerous learning opportunities.

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2. Qualification content

3.1 Core Modules

3.1.1 Module 1: GB

This Module will build on candidates' knowledge of GB formalities acquired through completion of the Introductory Certificate in Patent Administration. The aim is to provide advanced knowledge and critical awareness of UK patent formalities, deadlines and associated practice and relevant law. It will enable candidates to further develop their skills, and to identify both where rights could be lost and to identify appropriate systems for restoring them. This module will encourage candidates to learn when to act autonomously, and when to seek advice or knowledge from other sources.

Subject Content	Learning Outcomes
Course content and structure	At the end of Module 1.1 candidates will be able to: Plan how to study the course
Priority	At the end of Module 1 in the context of GB patents and patent applications, candidates will be able to: - Explain what is meant by the terms "priority", "priority claim", "multiple priorities" and "partial priority" - Identify the requirements for a valid priority claim - Make a late claim to priority within the relevant deadlines using correct forms and fees and including any supporting evidence as required - Understand the implications of the withdrawal of an application, including those for subsequent priority claims
Filing; prosecution, grant and post-grant procedures	- Prepare relevant forms for use during filing, prosecution and in post grant proceedings - List circumstances in which accelerated examination may be requested - Submit a request for accelerated examination - Describe the implications, for subsequent examination, of a request for accelerated examination - Prepare relevant documentation for making amendments to a UK patent application during prosecution (both pre- and post- publication), and state the extent to which such voluntary amendments can be made - Describe the procedure for making voluntary amendments, including when voluntary amendments can be validly made - Submit a request for accelerated examination - Explain the purpose of third-party observations and describe the procedure for submitting third-party observations, including any time limitations and deadlines - File a divisional application in the relevant format and within the correct time limits, and understand the impact of the compliance period on the filing of divisional applications - Understand what a sequence listing is for GB patent applications, and what the requirements are for including a sequence listing in a GB application

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	• Understand the difference between time limits set by the Patents Act 1977 and/or the Rules and those set by the Comptroller, and the availability of extensions to these time limits for different circumstances • Correctly apply the Patent Rules 2007 in relation to extensions of time limits • Explain the concept of discretionary extension of a time limit and summarise the types of evidence that can be used to support a request for a discretionary extension of a time limit • State the consequences of missing an inextensible deadline • Prepare and file a request for a first, or subsequent, extension of time limit, including relevant deadlines and any supporting evidence required • Explain the circumstances in which a UK patent application might need to be reinstated and identify those circumstances in which reinstatement may, and may not, be available • File and deal with a request for reinstatement, including time limits, forms and fees • List the possible outcomes of a request for reinstatement, including options for appeal • Summarise the effects of reinstatement for both the applicant and third-parties • Analyse communications from clients, associates and patent offices and identify any subsequent further action and/or outcomes • Describe the difference between an ex-parte and an inter-partes hearing • Outline the steps for requesting a hearing at the IPO • File a request for a declaration of non-infringement at the IPO and the subsequent procedure • File a request for a validity opinion at the IPO and outline the subsequent procedure
Inventorship & Entitlement	• Explain how entitlement to apply for a patent arises • Identify information required in order to support a statement of inventorship and the right to grant of a patent • Explain situations in which inventorship may change subsequent to filing a patent application and describe how to add and remove inventors subsequent to filing an initial Patent Form 7, including deadlines • File a new application subsequent to an entitlement action, including deadlines and fees
The Register of Patents	• List the information available in the Register of Patents and when that information becomes publicly available • Access the Register of Patents and retrieve relevant information in relation to patents and patent applications on the Register • Change entries in the Register of Patents using the relevant forms, fees, with any evidence required to support the change and within relevant deadlines
Renewals and post grant procedures	• Explain the period available for paying renewal fees • Explain the circumstances in which back renewal fees are payable and calculate deadlines for paying these fees

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General	• Calculate what renewal fees are payable and the period in which these fees can be paid, including any surcharges payable • Explain the circumstances in which a UK patent might need to be restored and identify those circumstances in which reinstatement may, and may not, be available • File a request for restoration of a patent within the available time limits, using the correct forms and fees • List the possible outcomes of a request for restoration of a patent, including options for appeal • Summarise the effects of restoration of a patent for both the patentee and third-parties • Apply Part 7 of the Patent Rules 2007 “Proceeding Heard Before the Comptroller” • Identify when a task is outside of their scope of practice and describe what to do in such circumstances • Consider and describe how to address a particular scenario in relation to GB patents and patent applications, and explain any outcomes and solutions arising from the analysis • For a given scenario, identify any issues arising and outline a plan to address these issues • Reflect on their learning
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3.1.2 Module 2: PCT

This Module will build on candidates' knowledge of PCT formalities acquired through completion of the Introductory Course in Patent Administration. The Introductory course was only able to cover most aspects of the PCT at a very high level and it will be necessary during the advanced course to take each of the steps in the PCT and consider them in greater depth. The material below may therefore seem to be repeating much already covered; there may be some repetition of the straightforward aspects of the procedure but only in so far as it is necessary to understand the underlying principles, restrictions, and alternatives available when using the PCT. The aim is therefore to provide advanced knowledge and critical awareness of PCT patent formalities, deadlines and associated practice and relevant law. It will enable candidates to further develop their skills, and to identify both where rights could be lost and to identify appropriate systems for restoring them. This module will encourage candidates learn when to act autonomously, and when to seek advice or knowledge from other sources.

Subject Content	Learning Outcomes
Filing PCT applications and formalities during the International Phase	At the end of Module 2, in the context of PCT patent applications, candidates will be able to: • Explain the choice of Receiving Office (RO) and the reasons for filing in different offices and the rules governing that filing • Detail the timeline of a PCT application up to end of International Phase and calculate deadlines • File an International Patent Application under the PCT including all relevant forms for filing including the RO/101, declaration, sequence listing and deposits and with the correct fees • Understand why a filing date may be lost and be able apply the procedures to remediate errors and a loss of filing date • Select a relevant International Search Authority (ISA) • Select and deselect designated states • Understand the language of the application and translation requirements, including deadlines • Pay fees correctly apply the procedures for fee refunds procedures in case of incorrect payment • File priority documents within the correct deadlines • Apply for extension procedures as available during the International Phase • Describe the stages of the application process during the International Phase and calculate deadlines • Understand the process of examination formal requirements and to respond to a notification of missing parts • Describe what happens when there is an interruption of proceedings • Analyse PCT communications and calculate and record appropriate deadlines therefrom • Describe the format and scope of the International Search • Explain what happens at publication of application and search report and effect in designated states • File a Demand for Preliminary Examination, and including amendments

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Filing PCT applications and formalities during the Regional and National Phase	• Explain what may influence the choice of International Preliminary Examination Authority (IPEA) • Outline the way in which WIPO communicates with designated offices, including the communication of the application, search and written opinion to all designated offices • Identify and calculate subsequent deadlines • Describe the timeline of a PCT application in the National and Regional phase, including those countries with time limits different from the 30-month deadline • Instruct overseas patent attorneys to handle national phase applications
Correction of errors in the International phase	• Correct errors in the International phase, and explain the effect of this on the national/regional phase • Register a transfer of a PCT application • Register a change of representative and change of applicant
Online filing	• Outline the various ways for online filing of documents during the filing and prosecution of PCT applications and compare and contrast the differences
General	• Analyse complex scenarios in relation to PCT patent applications, and explain any outcomes and solutions arising from the analysis

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3.1.3 Module 3: EP Patents

This module will build on candidates' knowledge of EP formalities acquired through completion of the Introductory Course in Patent Administration. The aim is to provide advanced knowledge and critical awareness of EP patent formalities, deadlines and associated practice and relevant law. It will enable candidates to further develop their skills, and to identify both where rights could be lost and to identify appropriate systems for restoring them. This module will encourage candidates to learn when to act autonomously, and when to seek advice or knowledge from other sources.	
Subject Content	Learning Outcomes
Priority	At the end of Module 3, in the context of EP patents and patent applications, candidates will be able to: • Identify the requirements for a valid priority claim • Make a late claim to priority, including deadlines, forms and fees and any supporting evidence required • Utilize Priority Document Access Service (PDAS) • Identify the PDAS participating offices • Locate the DAS code from filing receipts/communications
Filing; prosecution and grant	• Explain the different types of European patent applications • Understand the different filing routes, including in an emergency • Explain the difference between Designation, Extension and Validation states • Understand what a sequence listing is for EP patent applications, and what the requirements are for including a sequence listing in an EP patent application • Detail the timeline of an EP application up to grant and outline the examination procedure • Request accelerated prosecution, and the circumstances when accelerated prosecution can be requested • File a Patent Prosecution Highway request • File relevant forms and documents including file missing parts • Analyse communications from the EPO, calculate deadlines therefrom and describe the relevant responses required • Apply for a refund of an examination fee before and after the issuance of the 1st examination report • Explain the purpose of third-party observations and correctly submit third party observations, including any time limitations and fees payable
Oral Proceedings	• Describe the process for Oral proceedings, including calculate deadlines and describe the relevant responses required. • Identify a Summons to attend Oral Proceedings, and calculate associated deadlines • Describe tasks associated with the pre-proceedings process • Outline the consequences of not attending oral proceedings • File a request for a change date/time of oral proceedings and outline the circumstances in which this can be done

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	• Prepare complete bundle of documents for attorney to use at oral proceedings • Understand the difference between an Interlocutory Decision, a Decision to Maintain, a Decision to Maintain in Amended Form and a Decision to Reject and calculate related appeal deadlines • Identify decisions issued by the Opposition Division & Minutes of the Oral Proceedings
Reestablishment of Rights	• Explain the consequences of missing an inextensible deadline • Identify when Reestablishment is available • File a request for Reestablishment of Rights within the correct time limits and with the correct fee • Identify the information and evidence that required to support a request • Describe the possible outcomes of a request for reinstatement, including options for appeal
Divisional applications	• List the requirements for filing a divisional application, including the content of a divisional application • Calculate the time limits for filing a divisional application • File a divisional application • File back renewal fees for divisional applications
Validations	• Describe the associated deadlines from the date of grant of a European Patent • Explain the London Agreement and how it impacts on validation requirements • State the post grant translation requirements for selected countries • List Powers of Attorney requirements for selected countries • List those countries that require a local address for service
Oppositions & Appeals	• File a Notice of Opposition within correct deadlines • Identify the ways to file an Opposition and/or pay the fee • Explain the availability of extensions in Opposition proceedings • Describe the difference between active and passive oppositions • Explain the consequences of withdrawal of an opposition and potential consequences • Identify and analyse a Communication issued pursuant to Rule 82(2) EPC • Explain the circumstances this Communication is issued • Respond to the Communication pursuant to Rule 82(2) EPC including calculating deadline
Maintenance of a patent in amended form	• Outline the procedures after a decision to maintain a patent in amended form with associated procedures, including consequential actions required and associated deadlines
Appeals	• File an appeal • Explain any associated further actions and deadlines and fees

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Maintenance fees	• Describe the difference between Ex-Parte Appeal Proceedings (pre-grant) and Inter Partes Appeal Proceedings (post-grant) appeals • Analyse communications from the Board of Appeal, and identify the appeal number and appealing parties, and calculate deadlines arising therefrom • Correctly pay maintenance fees • Explain the circumstances in which back maintenance fees are payable and calculate deadlines for paying these fees • Calculate what maintenance fees are payable and the period in which these fees can be paid, including any surcharges payable
Unitary Patents	• Explain the Requirements of a Unitary Patent Request • Complete and File a Unitary Patent Request Form • Summarise Unitary Patent renewal system including costs for clients
General	• Analyse complex scenarios in relation to EP patents and patent applications, and explain any outcomes and solutions arising from the analysis

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3.1.4. Module 4: Professional Conduct and Ethics

This module will build on candidates' knowledge of Professional Conduct introduced in the Introductory Patent Paralegal Course. The aim is to develop a critical awareness of the issues surrounding professional conduct and an IP paralegal's role. This module will encourage candidates learn when to act autonomously, and when to seek advice or knowledge from other sources.

Subject Content	Learning Outcomes
The Legal Services Act 2007	At the end of Module 4 candidates will be able to - Describe a paralegal's ethical, legal, and financial responsibilities within the context of a registered Patent Attorney's responsibilities as set out in the IPREG Code of Conduct - Describe a registered Patent Attorney's Duty of Care to clients - Describe how the Legal Services Act applies to regulated Patent Attorneys
The role of IPReg	Explain the role of IPReg
The IPReg Code of Conduct	Identify matters in relation to an entity's Terms of Business in order to comply with IPReg Code of Conduct
Standards of Care and Duties to clients	
Handling of client monies	Identify situations in which a money laundering check may be required for client monies
Terms of Business	
Handling complaints	
Confidentiality	- List instances that may be subject to a complaints procedure - Outline the nature of a confidential relationship and circumstances where a breach of confidentiality may occur
Conflict of Interest	Identify conduct that may be in breach of the IPReg Code of Conduct

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3. Assessment

This syllabus is assessed via a variety of assessment methods.

4.1 Core Modules

The core modules will be assessed by means of an assignment to be completed within a fixed period of time.

Each module will be assessed separately.

The law and practice that will be assessed is the law and practice that is current at the time of the last teaching session of the module.

The assignment

The assignment will consist of one or more tasks.

The assignment will not necessarily assess all the learning outcomes.

The assignment may require candidates to outline a plan for the assignment and to reflect on their learning.

The assignment will require candidates to prepare and submit a submission addressing all the tasks of the assignment.

Tasks

The tasks may one or more of:

- i. form-based tasks; or
- ii. short answer questions such as data entry or date calculations; or
- iii. longer answer questions where an analysis and explanation is required; or
- iv. a scenario with related tasks (the scenario materials will either be part of the question or provided separately); or
- v. a combination of one or more the above.

Additionally, tasks may be set which relate to the scenario presented in any form question.

If reasoning, explanation and/or calculations workings are required in an answer, the question will advise the candidate accordingly.

Materials required

These assignments will be open-book and candidates are expected to have access to materials such as textbooks, online resources, legislation and treaties and supporting rules and regulations, manuals and guidelines of the relevant patent offices, patent forms, fee information and calendars.

Assessment outcomes

The assessment will detail the outcomes that are being assessed.

Successful completion of the assessment will be on the basis of being able to demonstrate through the content in the submission that they have achieved the learning outcomes outlined in the assessment.

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To be awarded the qualification, the candidate needs to have successfully completed all of the core modules along with any chosen elective modules, once available, within a period of one year.

Candidates will be awarded a final grade for the qualification.