

PEB Qualifying Examinations

Candidate Guidance – FD1 Advanced IP Law and Practice

Introduction

This guidance has been prepared to assist candidates preparing for the PEB Qualifying Examinations. It is intended to identify the knowledge and experience candidates should attain prior to sitting the examination.

Different candidates will have widely different opportunities for training and gaining experience, depending on the pattern of work in their firms or companies. This guidance is designed to help candidates to identify areas where the knowledge and experience gained in the workplace will have to be supplemented through tutorials, seminars, training courses, private study or other means.

This guidance should be read together with the FD1 syllabus. Syllabi are reviewed annually and updated versions are published on the PEB website in the April before the October examination session. It is recommended that candidates familiarise themselves with the statutes set out in the syllabus.

Candidates are recommended to make use of past question papers and mark schemes, which are also available on the PEB website. In addition, the Principal Examiners' reports on the examinations explain common areas of weakness seen in candidates' answers.

Examiners report that there is a clear link between the length of professional experience and success in the Qualifying Examinations. In particular, examiners recommend that, when tackling examination questions, candidates should imagine being in front of the client and giving advice, provide the client (in the scenario) with advice not a list of relevant law, identify the problem areas in the question and apply the law to those areas, and where chronology of events is important create a timeline.

It is unlikely that candidates with less than three years' experience in the profession, including at least a year acting mainly on their own responsibility, will have sufficient experience to be successful in the FD1 examination.

In addition to professional experience listed below, candidates are advised to attend at least twelve hours per year of CPD seminars, including some delivered outside their workplace, such as those offered by CIPA. Candidates are also advised to regularly read a monthly IP law publication.

Overview

The FD1 examination tests candidates' competence to properly advise and act for a client in any matter relating to the preparation, prosecution, exploitation and enforcement of patent rights in the UK and via the EPC and PCT. Knowledge of the basic patent law in major countries (notably the USA and Japan) is also required.

The question paper comprises a number of short-answer questions relating to application and prosecution procedural matters and three optional, longer questions from which two should be attempted. The longer questions each present a scenario where a client requires advice on patent matters in a commercial situation. Knowledge of the principles of leading case law is recommended, though it is not necessary to quote any cases. Candidates should be familiar with the different needs and expectations of clients from different backgrounds, for example with

regards to the consequences and costs of suggested actions, and should give sound practical advice accordingly.

The FD examinations test candidates' ability to assess issues pertinent to the facts presented taking into account regulatory requirements (IPReg's Core Regulatory Framework), the Registered Patent Attorney's duties to clients, and professional ethics applicable to IP practitioners. A script that contains unethical advice, proposals or statements does not meet the requirements for award of a Pass in an FD examination.

Guidance

It is strongly recommended that before taking the FD1 examination, candidates should have advised on and/or prepared **the majority** of the items in the following list, and should be aware of considerations for the others in practice:

GB patents/applications:

- Assignment
- Change of name or address
- Requesting file wrappers and/or UKIPO register extracts
- Filing statutory declaration or affidavit in support of ex-parte and inter-partes proceedings
- Request for a discretionary extension of time under r.108 and/or r.110
- Application to restore a UK patent lapsed for non-payment of a renewal fee
- Pre-litigation negotiations with a third party

EP (UK) patents/applications:

- Completing acceptance/grant procedures before the European Patent Office, being thoroughly familiar with key due dates
- Effecting validation of a granted European Patent (UK), being thoroughly familiar with key due dates including renewal fee due dates
- Applying for further processing of a European patent application
- EPO Opposition procedure
- EPO central limitation procedure

GB or EP (UK) patents/applications:

- Opinion on potential protection available for a proposal (not yet the subject of a patent application or other registered protection) in light of the prior art
- Opinion on inventorship and/or ownership, including employee's rights
- Opinion on infringement
- Opinion on validity (patentability)
- Opinion on validity (sufficiency)
- Opinion on availability of convention priority, including requesting a "late" priority claim

General/Multi-jurisdiction:

- Estimate of the cost of filing a UK, European and/or International patent application
- Taking over representation of a UK/European/International application or granted patent
- Estimate of the cost of filing a patent application in the US or Japan
- Any matter involving competition law issues
- Availability of different types of IP right available for a project (e.g. patent, utility

- model, trade mark, registered and unregistered design rights, copyright, etc.)
- Comparison of claim types available in different jurisdictions

Patent Office Hearings:

Experience of preparing for, either as principal or assistant:

- ex-parte or inter-partes hearings, at the UK, European or any other national Patent Office. Have attended, either as principal or assistant:
- one ex-parte or inter-partes hearing, at the UK, European or any other national Patent Office

Official Actions from Patent Offices

Experience of reviewing and advising on:

- Five official actions from WIPO or a National Patent Office acting as Receiving Office, International Search Authority or International Examining Authority for an International Patent Application.

Experience of advising on and responding to:

- Ten official actions from the UK and/or European Patent Office, of which at least 5 are from the UK Patent Office
- Five office actions from any other Patent Offices, but especially from the USPTO and JPO

Filing new patent applications

Experience of filing or sending instructions for filing:

- Ten UK or European patent applications
- Five International patent applications
- Five patent applications, or five national phase entries, at other Patent Offices
- A national phase entry to the UK national phase
- At least one entry to the European regional phase