

## PEB Qualifying Examinations

### Candidate Guidance – FD4 Infringement and Validity

#### Introduction

This guidance has been prepared to assist candidates in preparing for the PEB qualifying examinations. They are 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. Using these guidelines will 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 FD4 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 Acts and Rules set out in the syllabus and with the topics examined in Foundation Units FC1 to FC3, as any of these can be relevant to the analysis and advice concerning infringement.

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.

#### Overview

FD4 is a test of the competence to properly advise a client facing the possibility of being an infringer of a patent or the proprietor of a patent being infringed. While the precise materials may change from year to year, typically the paper is made up of at least: 1 patent, 1 alleged infringement, 2 or more prior art documents and 1 letter explaining the background and seeking advice. The time allowed for this paper is 5 hours.

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 FD4 examination, candidates should:

1. Understand the fundamentals of interpreting patent claims in the UK.
2. Have experience of drafting and prosecution:
  - Drafting and prosecution skills assist a candidate in interpreting a claim and establishing the validity of the claim, as interpreted, against prior art as well as determining whether there is infringement of a valid claim.
  - A minimum of 18 months' full-time experience of drafting and prosecution, which should

enable a candidate to develop an understanding of claim drafting and interpretation.

3. Have advised on “freedom to use” or in connection with infringement proceedings:
  - Understanding of the three-way situation of a patent, a possible infringement and prior art that is tested in FD4 can be assisted by "freedom-to-use" exercises. During training in drafting and prosecution a candidate must learn to criticise the work done (for example claims drafted) and assess whether the work would withstand an attack on validity and be effective to deter a possible infringer. It is especially helpful for a candidate to be involved in any real-life freedom-to-use situation. It is suggested that, as an exercise, the candidate could be given the basic papers (for example from a previous situation) and asked to prepare a report. This could be compared with the eventual advice given.
  - Involvement in infringement proceedings, or in any part of their preparation, will also greatly assist, especially in appreciating that others will often take a different (at least initial) interpretation of a given claim. It is realised that suitable real life infringement situations are not common, but using a past example as an exercise is recommended.
4. Have completed at least three past papers under timed conditions, which should be reviewed with a tutor using the published mark scheme and the Principal Examiner’s report.
5. Have developed understanding of how the UK Courts deal with interpretation by studying at least three decisions. Real life examples show how a consistent approach for validity and infringement must be followed.
6. Be familiar with case law relating to interpretation of claims by UK courts and assessment of novelty, obviousness and infringement, including (as at March 2025):
  - Adhesive Dry Mounting v Trapp [1910] 27 RPC 341
  - Gillette Safety Razor Co Ltd v Anglo-American Trading Co Ltd [1913] 30 R.P.C. 465
  - Catnic Components Ltd v Hill & Smith Ltd [1982] RPC 183
  - Windsurfing International Inc v Tabur Marine (Great Britain) Ltd [1985] RPC59
  - Improver Corp v Remington Consumer Products Ltd [1990] FSR 181
  - Aerotel Ltd v Telco Holdings Ltd and Macrossan’s Patent Application [2006] EWCA Civ 1371
  - Kirin-Amgen Inc and others (Appellants) v. Hoechst Marion Roussel Limited and others (Respondents); Kirin-Amgen Inc and others (Respondents) v. Hoechst Marion Roussel Limited and others; [2004] UKHL 46
  - Pozzoli SPA v BDMO S.A & Other’s [2007] EWCA Civ 588
  - Virgin Atlantic Airways Ltd v Premium Aircraft Interiors Group [2009] EWCA Civ 1062
  - Schutz (UK) Ltd v Werit UK Ltd [2013] UKSC 16
  - Actavis UK Ltd v Eli Lilly & Co [2017] UKSC 48
  - Icescape Ltd v Ice-World International BV & Others [2018] EWCA Civ 2219.
  - E Mishan and Sons Inc (t/a Emson) v Hozelock Ltd [2019] EWHC 991 (Pat)
  - Vernacare Ltd v Moulded Fibre Products Ltd [2022] EWHC 2197 (IPEC).