

Foundation Certificate Syllabus

UK Patent Law FC1 (P1) Contents

**Guidance for Candidates
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The Examination**

Effective from and including the 2018 examinations

**PEB Foundation Certificate
UK Patent Law FC1 (P1)**

1. Guidance for Candidates

Format of PEB syllabuses

PEB syllabuses contain:

- 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).

Candidates should also refer to the [Qualifying Examinations Foundation Certificate Programme Specification](#)

2. The Syllabus

Summary: To complete this examination successfully, you will need to demonstrate knowledge of the main provisions of the UK Patents Act 1977, the related Patents Rules, and the principles which underpin patent law in the UK. You will be able to recall the relevant principles, laws and rules, and/or apply them to one or more given scenario(s).

The **Content** advises you what knowledge 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.

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

**PEB Foundation Certificate
UK Patent Law FC1 (P1)**

	Content	Learning Outcomes	<u>Patents Act 1977</u>	<u>Patents Rules 2007</u>
1	The law relating to patentable inventions in the UK	a) Define the requirements for a patent to be granted on an invention, including: <ul style="list-style-type: none"> • novelty • inventive step • industrial applicability • exclusions to patentability b) Describe the available patent protection for methods of treatment or diagnosis and biotechnological inventions c) Explain whether a document is prior art d) Apply (a) to (c) to a scenario	PA 1 – Patentable inventions	
			PA 2 – Novelty	PR 5
			PA 3 – Inventive step	
			PA 4 – Industrial application	
			PA 4A – Methods of treatment or diagnosis	
			PA 76A and PA Schedule A2 – Biotechnological inventions	
2	In relation to UK patent applications, the: <ul style="list-style-type: none"> • right to apply for and obtain a patent • determination of inventors • ownership of a patent • the relationship between employer and employees 	a) Define the right to apply for and obtain a patent b) Describe the procedure for naming the inventor(s) c) Describe the implications of co-ownership d) Recall the provisions relating to employee inventions, including compensation e) Identify inventorship and ownership issues in a scenario	PA 7 – Right to apply for and obtain a patent	
			PA 13 – Mention of Inventor	PR 10,11
			PA 36 – Co-ownership of patents and applications for patents	
			PA 39 – Rights to employees’ invention	
			PA 40 & 41 – Compensation of employees for certain inventions	
			PA 42 & 43 Enforceability of contracts relating to employees’ inventions	

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3	The law relating to the UK patent application process	a) Describe how to make a UK patent application, including a divisional application b) List the requirements for obtaining a filing date for a UK patent application c) Describe the procedure from filing through search and examination to grant, including any available extensions of time d) Define the deadline for placing a UK patent application in order for acceptance e) Recall the provisions relating to reinstatement of a UK patent application f) Apply (a) to (e) to a scenario	PA 14 – Making an application	PR 12, 15, 16, 113, 115
			PA 15 – Date of filing application	PR 17 to 22
			PA 15A – Preliminary examination	PR 23, 24
			PA 16 – Publication of application	PR 26
			PA 17 – Search	PR 27
			PA 18 – Substantive examination and grant or refusal of patent	PR 28 to 30
			PA 20 – Failure of application	
			PA 20A – Reinstatement of applications	PR 32
			PA 20B – Effect of reinstatement	
			PA 117B – Extension of time limits specified by Comptroller	PR 107, 108, 109
			PA 119 – Service by post	PR 111
PA 120 – Hours of business and excluded days	PR 110			
4	The law relating to amendment and to correction of UK patent applications and patents	a) Identify when a patent or patent application can be amended b) Explain the procedure for amending a patent or patent application c) Identify when an error in a patent or patent application can be corrected d) Explain the procedure for correcting an error in a patent or patent application e) Describe the differences in the law relating to an amendment and a correction of a patent application or patent f) Apply (a) to (e) to a scenario	PA 19 – General power to amend	PR 31
			PA 27 – General power to amend specification after grant	PR 35, 75
			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	PR 105, PR49, PR50
			PA 117A – Effect of resuscitation of a withdrawn application under Section 117	

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5	The impact of national security or public safety issues on filing UK or overseas patent applications	a) Describe the restrictions on publishing UK patent applications because of national security or public safety issues b) Explain the restrictions on the process for filing patent applications outside the UK c) Apply (a) and (b) to a scenario	PA 22 – Information prejudicial to national security or safety of the public	
			PA 23 – Restrictions on applications abroad	
6	Priority	a) Identify the circumstances in which priority can be claimed b) Describe the mechanism for claiming priority, including late priority claims c) Explain the effects of claiming priority d) Determine whether a later application can validly claim priority from an earlier application	PA 5 – Priority date	PR 3 and 6 to 9
			PA 6 – Disclosure of matter etc., between earlier and later application	
7	The duration of a UK patent	a) Describe the procedure when a patent is granted b) Define the term of a patent and the renewal process for maintaining the patent c) Explain the restoration process and the implications of restoring a lapsed patent d) Describe the procedure for and implications of surrendering a patent e) Apply (b) and (c) to a scenario	PA 24 – Publication and certificate of grant	
			PA 25 – Term of Patent	PR 36 to 39
			PA 28 – Restoration of lapsed patents	
			PA 28A – Effect of order for restoration of patent	PR 40
			PA 29 – Surrender of patents	

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8	UK patents and patent applications as forms of property	a) Describe the transactions, events and instruments in patents and patent applications governed by PA 30 b) Explain the effect of registration of a transaction, event or instrument and the implications of non-registration c) Describe licences of right and the procedure for applying for and cancelling such licences d) Describe the information which is available on the Register or by inspection	PA 30 – Nature of, and transactions in, patents and applications for patents	
			PA 31 – Nature of, and transactions in, patents and applications for patents in Scotland	
			PA 32 – Register of patents etc	PR 47, 103, 104
			PA 33 – Effect of registration	
			PA 46 – Patentee’s application for entry in register that licences are available as of right	PR 43, 73
			PA 47 – Cancellation of entry made under section 46	PR 75
			PA 68 – Effect of non-registration on infringement proceedings	
			PA 118 – Information about patent applications and patents, and inspection of documents	PR 54
9	The law relating to infringement of UK patents	a) Identify the acts which infringe a UK patent and the circumstances in which such acts do not constitute infringement b) Describe the relief which may be claimed by a patentee for an infringing act, including any restrictions on the recovery of damages c) Explain the implications of a UK patent being found to be partially valid during infringement proceedings	PA 60 – Meaning of infringement	
			PA Schedule A1 – Derogation from patent protection in respect of biotechnological inventions	
			PA 61 – Proceedings for infringement of patent	
			PA 62 – Restrictions of recovery of damages for infringement	
			PA 63 – Relief for partially valid patent	
			PA 64 – Right to continue use begun before priority date	

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		d) Describe the circumstances in which an infringing act which was begun before the priority date of the patent may continue e) Explain when a certificate of contested validity may be issued and any implications of its issue f) Describe how a co-owner or an exclusive licensee brings infringement proceedings g) Explain the rights available between publication of the UK application and grant of the UK patent h) Describe the burden of proof for determining if a product is made by a patented process i) Differentiate between novelty and freedom to operate searches j) Apply (a) to (i) to a scenario	PA 65 – Certificate of contested validity of patent PA 66 – Proceedings for infringement by a co-owner PA 67 – Proceedings for infringement by exclusive licensee PA 69 – Infringement of rights conferred by publication of application	
10	In relation to UK patents and patent applications: <ul style="list-style-type: none"> • groundless threats • declaration of non-infringement • false marking 	a) Explain when proceedings for a groundless threat may be brought b) Describe the remedies for a groundless threat and describe when these remedies are available c) Explain when a declaration of non-infringement may be sought and any implications if it is issued d) Outline the consequences of unauthorised claims in relation to patents and patent applications e) Apply (a) and (b) to a scenario	PA 70 – Remedy for groundless threats of infringement proceedings PA 71 – Declaration as to non-infringement PA 110 – Unauthorised claim of patent rights PA 111 – Unauthorised claim that patent has been applied for	

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11	The law relating to challenging UK patents and patent applications	a) Describe when and how third party observations can be filed b) List the grounds of revocation of a UK patent and who may file an application for revocation c) Describe when the comptroller can revoke a UK patent on his own initiative d) As set out in section PA 74, identify the proceedings in which validity may be put in issue e) Describe the matters on which a Patent Office Opinion can be requested and the procedure for obtaining such an Opinion	PA 21 – Observations by third parties	PR 33
			PA 26 – Patent not to be impugned for lack of unity	
			PA 72 – Power to revoke patents on application	PR 73, 87
			PA 73 – Comptroller's power to revoke patents on his own initiative	
			PA 74 – Proceedings in which validity may be put in issue	
			PA 74A and 74B – Opinions by Patent Office	PR 92 to 100
12	The effect of European patents and applications in the UK	a) Describe the effect of a European patent or European patent application in the UK b) Determine whether or not a European patent application filed via the Patent Cooperation Treaty is prior art for a UK patent application c) Identify the authentic text of a European patent or European patent application for UK proceedings	PA 77 – Effect of European patent (UK)	
			PA 78 – Effect of filing an application for a European patent (UK)	PR 114
			PA 79 – Operation of PA 78 in relation to certain European patent applications	
			PA 80 – Authentic text of European patent and patent applications	

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13	The effect of applications under the Patent Co-operation Treaty in the UK	a) Describe the effect of an International patent application in the UK b) Describe the procedure for entering the national phase in the UK, including any extensions of time c) Apply (b) to a scenario	PA 89 – Effect of International application for patent PA 89A – International and national phases of applications PA 89B Adaptation of provisions in relation to Inter – national application	PR 66, 67, 68, 69, 70
14	Definitions in the Patents Act 1977	a) Explain the main terms and phrases set out in PA 130	PA 130 – Interpretation	
15	UK Patent law cases	a) Explain how the scope of protection is determined with reference to PA 125 and leading cases b) Describe the parties to, the facts of and the legal principles established by the listed leading cases	PA125 – Extent of invention <i>Interpretation/construction</i> <ul style="list-style-type: none"> • Catnic v Hill & Smith [1982] RPC 183 (HL) • Improver v Remington [1990] FSR 181 • Kirin-Amgen Inc v Hoechst Marion Roussel Limited [2004] UKHL 46 • Actavis v Eli Lilly [2017] UKSC 48 <i>Inventive step</i> <ul style="list-style-type: none"> • Windsurfing v Tabur Marine [1985] • RPC 59 	

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			<ul style="list-style-type: none"> • Pozzoli Spa v BDMO [2007] EWCA Civ 588 CA <p><i>Novelty</i></p> <ul style="list-style-type: none"> • Merrell Dow v Norton [1995] UKHL 12 [1996] RPC 76 (HL) • Synthon v SmithKline Beecham [2005] UKHL 59 [2006] RPC 10 • Dr Reddy's Laboratories v Eli Lilly [2008] EWHC 2345 (Pat), [2009] EWCA Civ 1362 	

3. Reading

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)
- *Patents Training Manual (2010)* Ed. Gwilym Roberts, pub. CIPA
- *The Manual of Patent Practice (2014)*, pub. IPO

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.