

Foundation Certificate Syllabus

International Patent Law FC3 (P5)

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Effective from and including the 2018 examinations

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 be able to give general strategic advice regarding protecting an invention using an international portfolio of patent and utility model applications to cover the following countries.

- Argentina, Brazil, Canada, Mexico, USA
- China, Japan, South Korea, Taiwan
- Australia, New Zealand, Singapore
- India, Israel, Saudi Arabia, South Africa, and
- EPC, Germany, France, Italy, Spain, Netherlands, Norway, Poland

You will need to demonstrate knowledge of the main provisions of the Patent Cooperation Treaty (PCT) and the European Patent Convention (EPC). You will also need to demonstrate knowledge of the national patent/utility model laws, and procedures for applying for and obtaining patent/utility model rights in Australia, China, Germany, Hong Kong, Japan, Singapore and USA

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 column lists the key sections of the following **legal provisions** relevant to the content and learning outcomes.

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	Content	Learning Outcomes	Legislation	Rules
1	<p>General considerations for protecting inventions in</p> <ul style="list-style-type: none"> • Argentina, Brazil, Canada, Mexico, USA • China, Japan, South Korea, Taiwan • Australia, New Zealand, Singapore • India, Israel, Saudi Arabia, South Africa, and • EPC, Germany, France, Italy, Spain, Netherlands, Norway, Poland 	<p>a) Describe the rationale for and purpose of the patent system</p> <p>b) Evaluate and compare alternative ways in which a client’s invention may be protected in the listed countries, including outlining:</p> <ul style="list-style-type: none"> • the strategic creation and management of a patent portfolio and • the principles for the legal protection of trade secrets and confidential information <p>c) For each country explain whether a patent or utility model can be obtained via the PCT, the EPC and/or the national route</p> <p>d) Explain the differences between patents and utility models</p> <p>e) Define the underlying principles for claiming priority, with reference to the Paris Convention or other treaties as appropriate</p> <p>f) Identify any grace periods for prior disclosures</p> <p>g) Apply (a) to (f) to a scenario</p>	<p><u>Paris Convention (PC)</u> PC4 Right of priority PC5 Priority date</p>	
2	<p>The patent application process via the PCT – the international phase</p>	<p>a) Describe how to make an international (PCT) application:</p> <ol style="list-style-type: none"> a. who may apply b. where the application may be filed c. the minimum requirements to obtain a filing date d. time limits for filing formal documents 	<p><u>Patent Cooperation Treaty (PCT)</u> Chapters I and II</p>	

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	Content	Learning Outcomes	Legislation	Rules
		<ul style="list-style-type: none"> e. content of the description, claims and abstract f. claiming priority <ul style="list-style-type: none"> b) Define the time limits for requesting search or examination during the international phase c) Describe the procedures for responding to the search report or written opinion d) Explain the procedure for correction or amendment during the international phase 		
3	<p>The patent application process via the PCT – the national/regional phase in</p> <ul style="list-style-type: none"> • Brazil, Canada, Mexico, USA • China, Japan, South Korea • Australia, New Zealand, Singapore • India, Israel, Saudi Arabia, South Africa, and • EPC, Germany, France, Italy, Spain, Netherlands, Norway, Poland 	<ul style="list-style-type: none"> a) Outline the procedure for entering the regional phase in Europe (EPC) or the national phase for each of the listed countries including: <ul style="list-style-type: none"> a. time limits (and any extensions of time) b. translation requirements c. the payment of claims fees d. deadlines for examination (including any extensions of time) e. any other documents required at filing b) Identify whether the application can be amended on entering the national or regional phase 	<p><u>The European Patent Convention (EPC)</u> EPC Art 153</p> <p><u>The PCT Applicant's Guide</u> National phase</p>	EPR 159 - 163

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4	The patent application process via the EPC	<p>a) Define the requirements for a patent to be granted on an invention:</p> <ul style="list-style-type: none"> • Novelty • Inventive step • Industrial application • Exclusions to patentability <p>b) Describe how to make an EP application:</p> <ol style="list-style-type: none"> a. who may apply b. where the application may be filed c. the minimum requirements to obtain a filing date d. the time limits for filing formal documents e. the content of the description, claims and abstract e. the payment of claims fees f. claiming priority <p>c) Define the time limits for requesting search or examination</p> <p>d) Describe the procedures for responding to the search report or examination report</p> <p>e) Explain the procedure for correction or amendment of a pending application and central limitation for a granted patent</p> <p>f) Describe the procedures for further processing and re-establishment</p> <p>g) Outline the procedure on grant including the national validation procedure for the following countries: Germany, France, Netherlands, Italy, Spain, Poland, Norway</p>	<p><u>The European Patent Convention</u> (EPC)</p> <ol style="list-style-type: none"> a) EPC Arts 52 to 57 b) EPC Arts 58 to 62 – Persons entitled to apply for and obtain European patents – Mention of inventor EPC Arts 75 to 86 Filing and requirements for a European patent application EPC Arts 87 to 89 Priority c) EPC Art 93 Publication of a European patent application d) EPC Art 94 Examination of a European patent application e) EPC Art 123 Amendments EPC Art 105a to c Request for limitation or revocation f) EPC Art 121 Further processing EPC Art 122 Re-establishment of right g) EPC Art 97 Grant or refusal EPC Art 65 Translation of the EP patent 	<p>EPR 35, 36, 38-45, 47, 51</p> <p>EPR 52, 53</p> <p>EPR 36, 70</p> <p>EPR 62a, 63, 64 EPR 70a, 71 EPR 126, 127, 131, 132, 134 EPR 137, 139</p> <p>EPR 135 EPR 136 EPR 71</p>

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	Content	Learning Outcomes	Legislation	Rules
			<u>National law</u> relating to the EPC	
5	<p>Obtaining a patent or a utility model via the national patent offices in:</p> <ul style="list-style-type: none"> • Australia, • China, • Germany, • Hong Kong, • Japan, • Singapore and • USA 	<p>a) Define the restrictions on filing applications abroad as set out in section 23 of the UK Patents Act</p> <p>b) Identify which of the listed countries have similar provisions</p> <p>c) Define the requirements for patentability (e.g. novelty, inventive step, exclusions)</p> <p>d) Outline the application process:</p> <ol style="list-style-type: none"> a. Who may apply b. Where the application may be filed c. The content of the description, claims and abstract d. The payment of claims fees e. Time limits for filing formal documents f. Claiming priority <p>e) Define any time limits, including extensions of time, for requesting search and/or examination</p>	<p><u>The Patents Act 1977 (PA)</u> PA 23</p>	

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	Content	Learning Outcomes	Legislation	Rules
		f) Outline the examination procedure, including any time limits (and extensions) for responding to any objections from the examiner g) Describe any requirements to disclose prior art		
6	The law relating to opposition, re-examination and/or revocation of granted EP patents, Japanese patents, US patents and German patents and utility models.	a) Identify who may bring opposition, re-examination and/or revocation proceedings b) Define any time limits associated with each process c) Describe the procedure before each patent office d) Outline any appeal process	<u>The European Patent Convention (EPC)</u> EPC Arts 99 to 101 - Oppositions EPC Art 105 Intervention of the assumed infringer EPC Arts 106 to 108 – Appeal	EPR 76 EPR 99

3. Reading

NB The Patent Cooperation Treaty (PCT) and the European Patent Convention (EPC) 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.

- *Patents Training Manual* (2010) Ed. Gwilym Roberts, pub. CIPA
- Guidelines for Examination in the European Patent Office (November 2014)
- National Law relating to the EPC (2013 16th edition), pub. EPO
- PCT Applicant's Guide (WIPO)

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- *Manual for the Handling of Applications for Patents, Designs and Trademarks Throughout the World: Supplement 104* (2003) Godeau, Constance Zigtema, pub. Kluwer Law International (The Brown Book)
- *A Guide to the EPC 2000* (2014), Nicholas Fox, pub. CIPA
- *Manual of Patent Examining Procedure* (uspto.gov)
- Japanese Patent Office
- *An Annotated Guide to the European Patent Convention* Derk Visser
- *References to the EPC* Jelle Hoekstra
- *The Cross-Referenced Patent Cooperation Treaty*

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.