

Final Diploma Syllabus

Advanced IP Law and Practice FD1 (P2)

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1. Guidance for Candidates

The aim of the Final Diploma examinations is to assess whether a candidate has built on knowledge gained at the Foundation level and reached a minimum level of competency at which the candidate is deemed to be safe to practise. The Final Diploma examinations are based on core competencies that are expected of a patent attorney.

Final Diploma candidates need to demonstrate that they:

- have a thorough knowledge and understanding of the law;
- can apply their knowledge of the law in a manner that is appropriate to the facts provided and the client's needs; and
- are able to express advice in a clear and consistent manner.

The Final Diploma examinations test candidates' ability to:

- see the overall picture;
- assimilate and make use of data, information, themes and ideas provided;
- extract and identify key issues and consider how best to present these in the context of the situation provided;
- write in a logical, cohesive and clear manner; and
- provide outcomes and proposals that:
 - i. reflect the client's needs and priorities;
 - ii. are based on analysis of information available and, where appropriate, risks and costs;
 - iii. are practicable and achievable; and
 - iv. meet the requirements of relevant law and represent good practice with an appreciation of commercial realities of the situation presented.

This syllabus tests candidates' ability to:

- handle situations met in day to day practice with an emphasis on applied knowledge;
- generate logical, considered and effective proposals for the way ahead;
- evaluate risk and propose mitigating actions;
- take account of the impact of proposals on others; and
- identify further information or evidence that may be required for a final opinion but, where necessary, propose actions on the basis of limited information including appropriate consideration of the available alternatives.

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Format of PEB syllabuses

Each syllabus contains:

- 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).

2. The Syllabus

Summary: To complete this examination successfully, you will need to demonstrate a thorough understanding of intellectual property law governing the UK and basic patent law in Europe, the United States and Japan. You will be able to recall the relevant principles, laws and rules. You will be able to demonstrate your knowledge and skills by giving commercially relevant advice to a client together with your reasoning in response to a given scenario. A scenario may require analysis in respect of more than one of the **content** groups listed below.

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 and skills.

The final two columns list the key section of the **legal provisions** relevant to the content and learning outcomes. You will find hyperlinks to the relevant documents the first time each is mentioned.

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	Content	Learning Outcomes	Legislation	Rules
1	Available forms of intellectual property	a) Assess the limitations of available forms of intellectual property: <ul style="list-style-type: none"> • Patents • Designs • Trade Marks • Copyright • Confidential Information • Know How 	<u>Parts I and III of the Copyright, Designs and Patents Act 1988 (CDPA)</u>	
			<u>The Patents Act 1977 (PA)</u>	
			<u>The Registered Designs Act 1949 (RDA)</u>	
			<u>The Trade Marks Act 1994</u>	
			<u>The Treaty on the Functioning of the EU (EU)</u>	
			EU 34 to 36 EU 101 to 102	
			CDPA 51 to 53	
2	The law and practice relating to patentable inventions in the UK	a) Apply the law and practice governing patentable inventions to a scenario	PA 1 – Patentable inventions	
			PA 2 – Novelty	<u>Patent Rules (PR) PR5</u>
			PA 3 – Inventive step	

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	Content	Learning Outcomes	Legislation	Rules
			PA 4 – Industrial application	
			PA 4A – Methods of treatment or diagnosis	
			PA 76A and PA Schedule A2 – Biotechnological inventions	
3	In relation to inventions in the UK: <ul style="list-style-type: none"> • the right to apply for and obtain a patent • determination of inventors • ownership of a patent • the relationship between employer and employees 	a) Analyse a scenario and provide reasoned advice to a client on an appropriate course of action in relation to: <ul style="list-style-type: none"> i. inventorship, ii.the right to apply for and own a patent, iii.co-ownership and the implications thereof, iv.employee compensation 	PA 7 – Right to apply etc.	
			PA 8 – Determination before grant of questions about entitlement to patents	
			PA 10 – Handing of applications by joint applicants	
			PA 11 – Effect of transfer of application under Sections 8 or 10	
			PA 12 – Determination of questions about entitlement to foreign and convention applications	<u>Implementing Regulations to the European Patent</u>

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	Content	Learning Outcomes	Legislation	Rules
				<u>Convention</u> (EPR) <u>EPR 14</u>
			PA 13 – Mention of inventor	PR 10, 11
			PA 36 – Co-ownership of patents and applications for patents	
			PA 37 – Determination of right to patent after grant	
			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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4	The law and practice relating to the UK patent application process	Analyse a case and a) Determine if a UK patent application is entitled to its filing date b) Advise a client on the implications of the search and/or examination results c) Determine the actions to be taken on a UK patent application, including obtaining extensions of time if necessary	PA 14 – Making an application	PR 12, 15, 16, 103, 104, 113 to 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	

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	Content	Learning Outcomes	Legislation	Rules
			PA 22 & 23 - Information prejudicial to national security and restrictions on applications abroad	
			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
5	The law and practice relating to amendment and to correction of UK patent applications and patents	<p>a) Demonstrate an understanding of the difference between an amendment and a correction of a patent application or patent.</p> <p>b) Analyse a scenario and advise a client whether an amendment and/or a correction may be carried out and if so, when</p>	<p>PA 19 – General power to amend</p> <p>PA27 – General power to amend specification after grant</p> <p>PA75 – Amendment of patent in infringement or revocation proceedings</p>	<p>PR 31</p> <p>PR 35, 75</p>

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	Content	Learning Outcomes	Legislation	Rules
			PA 76 – Amendments of applications and patents not to include added matter	PR 49, 50, 105
			PA 117 – Correction of errors in patents and applications	
			PA 117A – Effect of resuscitation of a withdrawn application under Section 117	
6	The duration of a UK patent	Analyse a scenario and advise on a course of action taking into account <ul style="list-style-type: none"> a. Term b. Restoration c. Surrender d. SPCs 	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	
			PA 29 – Surrender of patents	PR 40

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	Content	Learning Outcomes	Legislation	Rules
			PA 128B – SPCs	PR 42
			PA Schedule 4A – SPCs	
7	UK Patents and patent applications as property	Analyse a scenario and advise on a course of action taking into account: <ul style="list-style-type: none"> • Licensing • Assignment • Registration of transactions • Obtaining information about patents and patent applications • Inspection of documents 	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	PR 47, 103, 104
			PA 32 – Register of patents etc.	
			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

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	Content	Learning Outcomes	Legislation	Rules
			PA 68 – Effect of non-registration on infringement proceedings	
			PA 118 – Information about patent applications and patents, and inspection of documents	PR 54
8	The law and practice relating to infringement of UK patents	Analyse a scenario and advise on a course of action taking into account: <ul style="list-style-type: none"> • Available remedies • Impact of partial validity • Right to continue use • Effect of publication • Burden of proof 	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	

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	Content	Learning Outcomes	Legislation	Rules
			PA 64 – Right to continue use begun before priority date	
			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	
			PA 100 – Burden of proof in certain cases	
9	In relation to UK patents and patent applications: <ul style="list-style-type: none"> • Groundless threats • Declaration of non-infringement • False marking 	Analyse a scenario and advise on a course of action	PA 70 – Remedy for groundless threats of infringement proceedings	
			PA 71 – Declaration as to non-infringement	

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	Content	Learning Outcomes	Legislation	Rules
			PA 110 – Unauthorised claim of patent rights	
			PA 111 – Unauthorised claim that patent has been applied for	
10	The law and practice relating to challenging UK patents and patent applications	Analyse a scenario and advise on a course of action	PA 21 – Observations by third parties	PR 33
			PA26 – Patent not to be impugned for lack of unity	PR 73 to 84, 87
			PA 72 – Power to revoke patents on application	
			PA 73 – Comptroller's power to revoke patents on his own initiative	
			PA 74 – Proceedings in which validity may be put in issue	PR 92 to 100
			PA 74A and 74B Opinions by Patent Office	

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	Content	Learning Outcomes	Legislation	Rules
			PA 125 – Extent of invention	
11	Priority	Analyse a scenario and advise on the: <ul style="list-style-type: none"> • Validity and effect of a priority claim • Late declarations to priority • Entitlement to make a priority claim 	<u>Paris Convention (PC)</u> PC 4 – Priority of right	
			PA 5 – Priority Date	PR3, 6 to 9
			PA 6 – Disclosure of matter, etc., between earlier and later applications	
12	The law and practice relating to European patents and patent applications and their effect in the UK	Analyse a case and provide reasoned advice on the effect of a European patent or application in the UK taking into consideration: <ol style="list-style-type: none"> a) Ownership b) Patentability c) Scope d) The Application Process e) Opposition f) Central limitation/revocation g) Amendment and correction 	<u>European Patent Convention Article (EPC Art) 2</u> – European patent	EPR 14
			EPC Art 52 – 57	
			EPC Arts 58 to 62 – Persons entitled to apply for and obtain European patents – Mention of inventor	EPR 16, 17
			EPC Art 68 – Effect of revocation of the European patent	

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	Content	Learning Outcomes	Legislation	Rules
			EPC Art 69 – Extent of protection	
			EPC Art 70 – Authentic text	
			EPC Art 71 – Registration of transfer of a European patent	EPR22 & 85
			EPC Art 79 – Designation of contracting states	EPR 39
			EPC Art 93 – Publication of a European patent application	
			EPC Art 94 – Examination of a European patent application	EPR 70, 70a
			EPC Art 97 – Refusal or grant	EPR 71(3)
			EPC Art 99 – Opposition	
			EPC Art 100 – Grounds for opposition	

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	Content	Learning Outcomes	Legislation	Rules
			EPC Art 105a to c – Request for limitation or revocation	
			EPC Art 121 – Further processing	
			EPC Art 122 – Re-establishment of right	
			EPC Art 123 – Amendments PA 77 – Effect of European patent (UK)	
			PA 78 – Effect of filing an application for a European patent (UK)	
			PA 79 – Operation of Section 78 to certain EP applications	
			PA 80 – Authentic text of European patents and patent applications	

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	Content	Learning Outcomes	Legislation	Rules
13	The law and practice relating to European patents and patent applications and their effect in the UK	Analyse a case and provide reasoned advice on the effect of an International patent or application in the UK taking into consideration: <ul style="list-style-type: none"> • making an International application • the time limits for requesting search or examination during the International phase • the procedures for responding to the search report or written opinion • the procedure for entering the regional phase in Europe (EPC), the national phase in the UK and the national phase for each of the other G7 countries • correction or amendment during the International phase and on entering the national or regional phase 	<u>Patent Cooperation Treaty (PCT) Chapters I and II</u>	
			PA 89 – Effect of international application for patent	
			PA 89AI – International and national phases of applications	
			PA 89BA – Adaptation of provisions in relation to international application	PR 65 to 70
14	The law and practice relating to patentable inventions in UK, EPC, US and Japan	a) Demonstrate an understanding of the differences between what is patentable in UK, EPC, US and Japan b) Demonstrate an understanding of the differences between what constitutes prior art in UK, EPC, US and Japan	<u>35 US Consolidated Patent Laws (USC) 101 – 103</u>	
			EPC Art 52 – 57	
			<u>Japanese Patent Act</u> JP 29, 30 and 32	
			PA 1 – Patentable inventions	

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	Content	Learning Outcomes	Legislation	Rules
			PA 2 – Novelty	
			PA 3 – Inventive step	
			PA 4 – Industrial application	
			PA 4A – Methods of treatment or diagnosis	
15	The law and practice in relation to obtaining patents in USA, Japan and via the EPC for an invention made in the UK	Analyse a case and recommend a course of action for obtaining a patent in USA, Japan and via the EPC for a UK invention taking into consideration : <ul style="list-style-type: none"> a. Disclosure requirements for specifications b. Types of US patent applications c. Divisional applications d. Designation of EP contracting states, including extension states e. Deadlines for requesting examination f. Grace periods 	PA 23(1)(a) – Restrictions on applications abroad 35 USC 112	
			35 USC 119 to 121	
			EPC Art 76	EPR36
			EPC Art 79	
			EPC Art 93	
			EPC Art 94	
			JP 30 Exception to lack of novelty of invention	

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	Content	Learning Outcomes	Legislation	Rules
			JP 36 Patent Applications	
			JP 43 Paris convention priority claim	
			JP 44 Divisionals	
			JP 48-3 Request for examination of application	

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16	The law and practice relating to UK and Community registered designs, UK design right, Community unregistered design and UK copyright	Analyse a scenario and provide reasoned advice taking into account the following factors: <ul style="list-style-type: none">• What can be protected• Who qualifies for rights• Entitlement and Ownership• Duration• Licences of right• Rights granted by registration• Infringement• Grace periods and Prior disclosures• Renewal and restoration• Multiple designs	Please refer to the syllabus for D&C Law (FC4)	Please refer to Syllabus for D&C Law (FC4)

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3. Reading List

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)
- *Russell-Clarke and Howe on Industrial Designs (2010)* Martin Howe QC, pub. Sweet and Maxwell
- *Terrell on the Law of Patents (2010)* Richard Miller, QC; Guy Burkill, QC; His Honour Judge Birss, QC; Douglas Campbell, pub. Sweet and Maxwell
- *Community Design Law: Principles and Practice (2002)* David Musker pub. Sweet and Maxwell
- *Community Designs Handbook (Ed ITMA,CIPA, Imogen Wiseman and William Jones) (2013)* Sweet and Maxwell
- *Copinger and Skone James on Copyright (2013)* Nicholas Caddick, QC; Gillian Davies; Gwilym Harbottle, pub. Sweet and Maxwell
- *PCT Applicant's Guide (WIPO)*
- *Designs and Copyright Training Manual (2008)* Rebecca Chambers, Ed. Keith Farwell and William Jones, pub. CIPA
- *Manual for the Handling of Applications for Patents, Designs and Trademarks Throughout the World: Supplement 104 (2003)* Godeau, Constance Zigmata, pub. Kluwer Law International (The Brown Book)
- *Patents Acts – How to Pass P2 (2013)*, Doug Ealey, pub. CIPA
- *Patents Training Manual (2010)* Ed. Gwilym Roberts, pub. CIPA

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- Guidelines for Examination in the European Patent Office (November 2014)
- National Law relating to the EPC (2013 16th edition), pub. EPO
- *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*
- Please refer to the D&C Law (FC4) reading list

4. The Examination

This syllabus is assessed via a four hour unseen examination. The pass mark is 50%.

The examination paper will comprise a series of problems set out in two parts – Part A and Part B.

There are 100 marks available in total: 50 marks in Part A and 50 marks in Part B.

Candidates are instructed to attempt questions as follows:

- Part A – attempt all six questions;
- Part B – attempt two questions from three 25 mark questions.