

## **Qualifying Examination Guidance**

### **Knowledge and Experience for Final Diploma Examination FD1 Advanced IP Law and Practice (P2)**

#### **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.

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 address this paper.

#### **Overview**

This examination tests the 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.

While the precise materials may change from year to year, typically the paper is made up of six compulsory short questions relating to application and prosecution procedural matters and two or three longer questions 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, e.g. with regards to the consequences and costs of suggested actions, and should give sound practical advice accordingly. The time allowed for this paper is 4 hours.

## Guidance

It is recommended the candidate be familiar with the statutes set out in the syllabus. In addition, it would be helpful for the candidates to have sufficient practical experience, as described below.

### Miscellaneous Practice Matters

Candidates should have advised on and/or prepared at least half of the items in the following list, and should be at least aware of considerations for the others in practice:

#### For 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

#### For 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

#### For 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

Have prepared for, either as principal or assistant:

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

#### Official Actions from Patent Offices

Have reviewed and advised on:

- 5 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.

Have advised on and responded to:

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

#### Filing of New Patent Applications

Have filed or sent instructions for filing:

- 10 UK or European patent applications
- 5 International patent applications
- 5 patent applications, or 5 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

#### Experience external to the workplace

Have attended:

- 12 hours per year of CPD seminars, including at least some outside the workplace.

Have regularly read:

- 1 monthly IP law publication

#### **Feedback from Examiners**

Examiners' Reports for each past paper are available on the PEB website. In summary Examiners find that candidates would benefit by giving more attention to:

- Priority
- Ownership (who owns rights; how transferred; assignments, etc)
- Novelty (especially 'Article 54(3) EPC' type situations)
- Inventive step
- Imagining being in front of the client and giving advice
- Providing the client with advice, not a list of the law that is relevant
- Identifying problem areas in a question and applying the law to those areas
- Creating a time line where the chronology of events is important to the question.