

Examination Guidance

Knowledge and Experience for Final Diploma Examination FD4 Infringement and Validity (P6)

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

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.

Guidance

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.
 - Eighteen months of full-time experience of drafting and prosecution should give a candidate a basic understanding of claim drafting and interpretation.
3. Have advised on "freedom to use" or in connection with infringement proceedings.

- An understanding of the three-way situation of a patent, a possible infringement and prior art that is tested in FD4 will be greatly assisted by "freedom-to-use" exercises. During training in drafting and prosecution a candidate must learn to criticise the work done (e.g. 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, initially the candidate can be given the basic papers (e.g. from a previous situation) and asked to prepare a report. This can 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. Again, using a past example as an exercise is recommended.
4. Have completed at least three past papers under examination conditions.
 - These should be reviewed in detail with a tutor.
 5. Have reviewed the Examiner's comments for at least 3 past papers.
 6. Have studied at least 3 decisions, to learn how the UK Courts deal with interpretation.
 - These are real life examples and emphasise how a consistent approach for validity and infringement must be adopted and followed.
 7. Be aware of the topics examined in Papers FC1 to FC3 as any of these can be relevant to the analysis and advice concerning infringement. In particular, refer to the FD4 syllabus for relevant sections of the UK Patents Act and related rules required for the examination.
 8. Be familiar with case law relating to interpretation of claims by UK courts and assessment of novelty, obviousness and infringement; as of June 2008, suitable case law is believed to include:
 - *Improver Corp v Remington Consumer Products Ltd* [1990] FSR 181
 - *Windsurfing International Inc v Tabur Marine (Great Britain) Ltd* [1985] RPC 59
 - *Pozzoli SPA v BDMO S.A & Other's* [2007] EWCA Civ 588
 - *Conor Medsystems Inc (Respondents) v Angiotech Pharmaceuticals Inc and others. (Appellants)* [2008] UKHL 49
 - *Adhesive Dry Mounting v Trapp* (1910) 27 RPC 341

- United Wire v Screen Repair [2000] FSR 204
- Merck & Co Inc v Generics (UK) Limited [2003] EWHC 2842 (pat).
- 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
- Aerotel Ltd v Telco Holdings Ltd and Macrossan's Patent Application [2006] EWCA Civ 1371
- Astron Clinica Ltd & Others [2008] EWHC 85 (Pat); [2008] WLR (D) 12

Feedback from Examiners

Examiners' Reports for each past paper are available from the PEB website. In summary candidates perform satisfactorily on:

- Assessment of novelty
- Assessment of infringement

and candidates would benefit by giving more attention to:

- Preparation of a detailed interpretation of the claims.
- Modifying the interpretation during the examination after realising e.g. from reading the art that the interpretation is inadequate in some respect.
- Ensuring that an interpretation modified in this way is then consistently applied throughout the answer.
- Providing a reasoned assessment of inventive step.
- Providing useful advice to the client based on the conclusions reached and the particular facts of the question, rather than a list of standard actions that would be common to any infringement situation.

In more detail, on interpretation of the claims, Examiners find that candidates who take an iterative approach to interpretation tend to score good marks. In an iterative approach, an initial interpretation is taken. This may have to be modified later in light of information or knowledge from another part of the question. This isn't an endless cyclical process, but one in which candidates take a first interpretation then realise during analysis of, say, novelty, that the interpretation needs fine tuning – perhaps there is a term they thought unimportant which now clearly is; perhaps there is a term upon which novelty turns and they realize they looked only in passing at that term first time round, thinking it to be straightforward. If it is realised that more detail is needed then the detail should be added.

If the initial interpretation of a given feature is modified during consideration of, say, infringement and the modified interpretation used to reach conclusions in the infringement section then the same, modified interpretation must also be used for all sections. Hence, when the interpretation is modified during the examination then candidates should go back and modify this wherever it is used. Thus, candidates have to accept that their conclusions on the right meaning of features in the claims may emerge during the examination and that the final interpretation may only come during or even towards the end of the whole exercise.

Candidates who err towards a fuller interpretation of the claims also tend to score good marks. The features selected for interpretation set the framework for the rest of the examination. These features can then each be discussed under validity and infringement, leading to a detailed discussion of many points relevant to the final interpretation and conclusions. A point not covered in the interpretation will not be discussed further, and if it is relevant potential marks will not be gained.