

## Final Diploma Syllabus

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### Amendment of Specifications FD3 (P4)

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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:

- demonstrate the skills of amendment and argumentation to support such amendment for UK patent applications;
- recognise novel and inventive concepts;
- analyse an invention for essential and non-essential features and distinguish features of an invention from those of the prior art;
- draft a specification, or amend claims, as required, of reasonable and appropriate scope based on the information available.

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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**

The syllabus is set out in an order which guides candidates through the tasks to be undertaken in the examination.

**Summary:** To complete this examination successfully, you will need to demonstrate a full understanding of the law and practice of patentable inventions and convention priority for UK patent applications. You will also need to demonstrate a full understanding of the examination procedure and the amendment and correction of patent applications. You will need to be able to draft a response (including amended claims) to a UK examination report and you will need to justify your choice of action to lay clients.

The **Content** advises you what knowledge and skills 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 sections of the **legal provisions** relevant to the content.

	<b>Content</b>	<b>Learning Outcomes</b>	<b><u>Patents Act 1977</u></b>	<b><u>Patent Rules 2007</u></b>
1	The law and practice relating to patentable inventions in the UK	a) Apply the law and practice governing patentable inventions to a case  b) Determine the prior art	PA1 – Patentable inventions PA2 – Novelty PA3 – Inventive step PA4 – Industrial application PA125 – Extent of invention	PR5

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	<b>Content</b>	<b>Learning Outcomes</b>	<b><u>Patents Act 1977</u></b>	<b><u>Patent Rules 2007</u></b>
		c) Apply prior art to the claims of an application to determine what might be patentable		
2	The needs of lay clients	a) Incorporate the wishes and priorities of the lay client into the response and amended claims where possible		
3	The law and practice relating to the amendment of UK patent applications during the search and examination procedure	a) Assess the validity of the objections raised in the examination report b) Evaluate the possibility of amending a patent application to achieve the grant of the patent c) Determine the appropriate procedure for amending the patent application d) Assess the implications of amending the patent application	PA 14 – Making an application PA 15 – Date of filing application PA 17 – Preliminary examination and search PA 18 – Substantive examination and grant or refusal of patent PA 19 – General power to amend PA 21 – Observations by third parties PA 76 – Amendments of applications and patents not to include added matter PA 117 – Correction of errors in patents and applications	PR105

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	<b>Content</b>	<b>Learning Outcomes</b>	<b><u>Patents Act 1977</u></b>	<b><u>Patent Rules 2007</u></b>
4	The requirements for claims of a patent specification suitable for grant of a UK patent	<p>Using your conclusions from 1 to 3 above, and ensuring any amendments deal with valid editorial objections raised by the examiner:</p> <p>a) Analyse an invention for essential and inessential features</p> <p>b) Draft an amended independent claim(s) which is of sufficient breadth to cover the lay client's interest, contains all the essential features, and which is distinguished from the prior art</p> <p>c) Draft an amended set of dependent claims with an appropriate hierarchy and which provide suitable fall back positions if independent claim(s) fail(s) during prosecution or enforcement</p>	<p>PA 14 – Making an application</p> <p>PA 19 – General power to amend</p> <p>PA 76 – Amendments of applications and patents not to include added matter</p> <p>PA 117 – Correction of errors in patents and applications</p>	<p>PR12</p> <p>PR105</p>
5	Requirements for filing a response to the UK examination report	Based on your amended claims prepared in 4 above:		

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	<b>Content</b>	<b>Learning Outcomes</b>	<b><u>Patents Act 1977</u></b>	<b><u>Patent Rules 2007</u></b>
		a) Draft a response to the UK examination report including arguments in favour of patentability		
6	Advise lay clients during the process of amending a UK patent application	a) Summarise your conclusions from your analysis (sections 1-5 above) b) Justify the actions taken in the proposed draft response and amended claims (prepared in 4 and 5 above) to the lay client c) Indicate if the amended claims raise any issues relating to the priority date of the claimed invention (if such a priority claim is present) d) Indicate other practice points that may be raised by the situation, including the possibility of filing a divisional application where necessary	See all sections of the Patents Acts above and PA5 – Priority date PA6 – Disclosure of matter etc., between earlier and later applications	

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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)
- *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%.

Candidates will be instructed to analyse the information provided and undertake the following task:

Your task is to prepare:

1. a letter to the UK Intellectual Property Office in response to the Examination Report;
2. a set of amended claims, if considered necessary;
3. notes on which you would base advice to your client in which you
  - i. explain the actions you have taken and why;
  - ii. provide full reasoning for your actions;
  - iii. outline future actions, if any, that your client could take to secure full protection of its commercial interests.