

FC1¹ UK Patent Law: Course Description

Course summary

This intensive 1.8 day revision course is designed to help prepare trainee patent attorneys for the Foundation Certificate (FC) Patent Examination Board (PEB) paper on UK Patent Law: for which candidates are expected to: “demonstrate knowledge of the main provisions of the UK Patents Act 1977, the related Patents Rules, the principles which underpin patent law in the UK; and be able to recall the relevant principles, laws and rules, and/or apply them to one or more given scenario(s)”².

The course is intended to build upon participants’ understanding of the Patents Act and Rules through presentations by the tutors on selected topics of the syllabus, supported by handout notes, and working through past paper questions. The course aims to provide an overview of what the Patents Act seeks to achieve and how the various groups of sections, in combination with the relevant Rules, meet that objective. The tutors’ aim is that participants come away feeling more sure-footed about their knowledge and understanding of the Act and Rules so that, for a given question in the examination, they will be able to identify the relevant section(s) in the overall context of the Act and to frame their answers accordingly.

Content

The course starts with an introductory session on the syllabus, exam technique and feedback on pre-course work. This is then followed by sessions which involve a mix of presentations by the tutors on key topics of the syllabus with practice and discussion of questions. Below we set out a summary of the content of each session and expected learning outcomes.

¹ Formerly the P1 paper

² FC1 Syllabus

Pre-course preparation

Summary

Annexe B sets out guidance on pre-course preparation. Through reading the FC1 syllabus (**Annexe A**) and instructions to past papers and answering the pre-course questions, participants will understand the coverage of the syllabus, the depth of knowledge required and the format of the exam. It is recommended that participants read (and listen to) Informals' lectures on relevant topics and look at the other materials set out in Annexe B. As this is principally a revision course, participants should come with an understanding of the areas of law and practice covered by the syllabus. However, the tutors will provide presentations and notes on selected topics.

Expected learning outcomes

At the completion of your pre-course preparation, participants will be able to:

- describe the scope of the FC1 syllabus, its themes and level of knowledge expected on each;
- recall the format of the exam, including numbers of questions they are required to answer, and the exam instructions and regulations;
- discuss what particular challenges they found in doing the specified past paper; and
- discuss the key areas of law and practice covered in the syllabus.

Unit 1: Overview of the FC1 Syllabus, the Exam and Exam Technique

Session summary

This session will start with round-the-table short questions for participants, followed by an introductory overview of the FC1 syllabus and discussion of the examination by the tutors. This will include advice on time budgeting and format/length of answers. The session will close with the tutors handing back to the participants their answer scripts to the pre-course questions and highlighting salient points arising from the answers, with reference to exam technique where appropriate.

Expected learning outcomes

At the end of this session, participants will be able to:

- recognise what the examiner expects in answers;
- appreciate how to structure answers; and
- recall strategies for allocating time across questions and managing time pressures during the exam.

Units 2-6: Q&As, Notes on Selected Topics and Case Law

Session summary

Sessions 2-6 form the core of the course and involve a mix of question practice and short lectures/presentations on selected topics by the tutors.

The question practice will involve the tutors handing out questions to be answered on a group (usually a pair) basis, allowing time for study of the question allocated to each group and then each pair in turn setting out to the overall group an answer to the question, before the discussion is opened to all. At the end of each Q&A, the tutors will hand out later his notes on the questions, setting out the key points relevant to a good answer.

The short lectures/presentations on selected topics by the tutors will be supported by handout notes, and include cross-referencing to the relevant parts of the acts and rules were necessary,

especially where time limits and extensions are concerned. The topics covered will include: patentability; the procedures for filing and securing grant of patents in the UK (having regard to relevant International conventions, particularly the Paris Convention); inventorship and inventors' compensation; pre- and post-grant correction and amendment; renewal and restoration; licensing and assignment of patents; infringement; groundless threats of infringement; revocation proceedings; and, extensions of time in proceedings before the IPO.

At a convenient point, midway through the course, in **Session 4**, the tutors will discuss leading case law, with particular reference to novelty, inventive step and infringement.

In **Session 6**, the tutors and group will briefly review recent past papers to see how the course would have prepared the participants for those questions and to address any points arising.

The lecture topics, together with the questions pre-course and during the course, provide an overview of the main provisions of the Act, so that the participants will have covered the main provisions and seen how to apply them to a given set of circumstances as required by the past paper questions.

Expected learning outcomes

At the end of this session, participants will be able to describe and explain - demonstrating this by applying this knowledge to their answers to past exam questions - their understanding of:

- the characteristics of patentable matter;
- rights to apply for and obtain a patent – including inventorship, ownership and employee rights;
- the procedure for obtaining a patent – including search and examination, amendment and correction of applications;
- priority;
- patents after grant – including term, renewal, amendment and restoration;
- patents as a form of property – including compulsory licences, the patent register, securing information about patents and inspection of documents;
- infringement - including the impact of partial validity, right to continue use, effect of publication and threats;
- challenging validity and revocation of patents;
- the effect of European patents and applications;
- entering the UK national phase from an international (PCT) application;
- Convention applications;
- leading cases on novelty, obviousness and infringement; and
- interpretation

Unit 7: Final preparations for the exam

Session summary

In this closing session, the tutors will advise on how participants can best prepare for the FC1 paper in the intervening weeks before the exam, providing guidance on further practice of past exam papers and on materials to read, and recap key points on exam technique.

Expected learning outcomes

At the end of this session, participants will be able to:

- plan their final stages of revision and practice for the FC1 exam; and
- identify areas where they need to do further reading and practice.

ANNEXE A: THE FC1 SYLLABUS THEMES

| Knowledge Themes | Relevant legal provisions |
|--|--|
| 1. The law relating to patentable Inventions in the UK – characteristics of patentable matter | <ul style="list-style-type: none"> ○ Patentable Inventions (PA1 & PR5) ○ Novelty (PA2) ○ Inventive Step (PA3) ○ Industrial Application (PA4) ○ Methods of Treatment or Diagnosis (PA 4A) ○ Biotechnological Inventions (PA76A & PA Schedule A2) |
| 2. The right to apply for and obtain a patent, determination of inventors, ownership, employee rights | <ul style="list-style-type: none"> ○ Right to apply for and obtain a patent (PA 7) ○ Mention of Inventor (PA 13 & PR 10-11) ○ Co-ownership of patents and applications for patents (PA 36) ○ Rights to employees' invention (PA 39) ○ Compensation of employees for certain inventions (PA 40-41) ○ Enforceability of contracts relating to employees' inventions and Supplementary (PA 42-43) |
| 3. The law relating to the UK patent application process | <ul style="list-style-type: none"> ○ Making an application (PA 14 & PR 12, 15-16, 113 & 115) ○ Date of filing application (PA 15 & PR 17-22) ○ Preliminary Examination (PA 15A & PR 23-24) ○ Publication of application (PA 16 & PR 26) ○ Search (PA 17 & PR 27) ○ Substantive examination and grant or refusal of patent (PA 18 & PR 28-30) ○ Failure of application (PA 20) ○ Reinstatement of applications (PA 20A & PR 32) ○ Effect of reinstatement (PA 20B) ○ Extension of time limits specified by Comptroller (PA 117B & PR 107-109) ○ Service by post (PA 119 & PR 111) ○ Hours of business and excluded days (PA 120 & PR 110) |
| 4. The law relating to amendment and to correction of UK patent applications and patents | <ul style="list-style-type: none"> ○ General power to amend (PA 19 & PR 31) ○ General power to amend specification after grant (PA 27 & PR 35 & 75) ○ Amendment of patent in infringement or revocation proceedings (PA 75) ○ Amendments of applications and patents not to include added matter (PA 76) ○ Correction of errors in patents and applications (PA 117 & PR 49-50 & 105) ○ Effect of resuscitation of a withdrawn application under Section 117 (PA 117A) |
| 5. The impact of national security or public safety issues on filing UK or overseas patent applications | <ul style="list-style-type: none"> ○ Information prejudicial to national security or safety of the public (PA 22) ○ Restrictions on applications abroad (PA 23) |
| 6. Priority | <ul style="list-style-type: none"> ○ Priority Date (PA 5 & PR 3 & 6-9) ○ Disclosure of matter, etc., between earlier and later applications (PA 6) |
| 7. The duration of a UK patent | <ul style="list-style-type: none"> ○ Publication and certificate of grant (PA 24) ○ Term of Patent (PA 25 & PR 36-39) ○ Restoration of lapsed patents (PA 28) ○ Effect of order for restoration of patent (PA 28A & PR 40) ○ Surrender of patents (PA 29) |
| 8. UK patents and patent applications as forms of property | <ul style="list-style-type: none"> ○ Nature of, and transactions in, patents and applications for patents (PA 30) ○ Nature of, and transactions in, patents and applications for patents in Scotland (PA 31) ○ Register of patents etc. (PA 32 & PR 47 & 103-104) |

| Knowledge Themes | Relevant legal provisions |
|---|--|
| | <ul style="list-style-type: none"> ○ Effect of registration (PA 33) ○ Patentee's application for entry in register that licences are available as of right (PA 46 & PR 43 & 73) ○ Cancellation of entry made under section 46 (PA 47 & PR 75) ○ Effect of non-registration on infringement proceedings (PA 68) ○ Information about patent applications and patents, and inspection of documents (PA 118 & PR 54) |
| 9. The law relating to infringement of UK patents | <ul style="list-style-type: none"> ○ Meaning of Infringement (PA 60) ○ Derogation from Patent Protection in respect of Biotechnological Inventions (PA Schedule A1) ○ Proceedings for Infringement of patent (PA 61) ○ Restrictions of recovery of damages for infringement (PA 62) ○ Relief for partially valid patent (PA 63) ○ Right to continue use begun before priority date (PA 64) ○ Certificate of contested validity of patent (PA 65) ○ Proceedings for infringement by a co-owner (PA 66) ○ Proceedings for infringement by exclusive licensee (PA 67) ○ Infringement of rights conferred by publication of application (PA 69) ○ Burden of proof in certain cases (PA 100) |
| 10. In relation to IK patents and patent applications: <ul style="list-style-type: none"> ○ Groundless threats ○ Declaration of non-infringement ○ False marking | <ul style="list-style-type: none"> ○ Remedy for groundless threats of infringement proceedings (PA 70) ○ Declaration as to non-infringement (PA 71) ○ Unauthorised claim of patent rights (PA 110) ○ Unauthorised claim that patent has been applied for (PA 111) |
| 11. The law relating to challenging UK patents and patent applications | <ul style="list-style-type: none"> ○ Observations by third parties (PA 21 & PR 33) ○ Patent not to be impugned for lack of unity (PA 26) ○ Power to revoke patents on application (PA 72 & PR 73 & 87) ○ Comptroller's power to revoke patents on his own initiative (PA 73) ○ Proceedings in which validity may be put in issue (PA 74) ○ Opinions by Patent Office (PA74A & 74B & PR 92-100) |
| 12. The effect of European patents and applications in the UK | <ul style="list-style-type: none"> ○ Effect of European patent (UK) (PA 77) ○ Effect of filing and application for a European patent (UK) (PA 78 & PR 114) ○ Operation of PA 78 in relation to certain European patent applications (PA 79) ○ Authentic text of European patent and patent applications (PA 80) |
| 13. The effect of applications under the Patent Cooperation Treaty (PCT) in the UK | <ul style="list-style-type: none"> ○ Effect of international application for patent (PA 89) ○ International and national phases of applications (PA 89A & PR 66-70) ○ Adaptation of provisions in relation to international application (PA 89B) |
| 14. Definitions of the Patents Act 1977 | <ul style="list-style-type: none"> ○ Interpretation (PA 130) |
| 15. UK Patent law cases | <ul style="list-style-type: none"> ○ Extent of invention (PA 125) <p><i>Interpretation/construction</i></p> <ul style="list-style-type: none"> ○ Catnic v Hill & Smith [1982] RPC 183 (HL) ○ Improver v Remington [1990] FSR 181 ○ Kirin-Amgen Inc v Hoechst Marion Roussel Limited [2004] UKHL 46 <p><i>Inventive step</i></p> |

| Knowledge Themes | Relevant legal provisions |
|------------------|--|
| | <ul style="list-style-type: none"> ○ Windsurfing v Tabur Marine [1985] RPC 59 ○ Pozzoli [2007] EWCA Civ 588 CA <p><i>Novelty</i></p> <ul style="list-style-type: none"> ○ Merrell Dow v Norton [1995] UKHL 12 [1996] RPC 76 (HL) ○ Synthon v SmithKline Beecham [2005] UKHL 59 [2006] RPC 10 ○ Dr Reddy's Laboratories v Eli Lilly [2008] EWHC 2345 (Pat), [2009] EWCA Civ 1362 |

PA = The Patents Act 1977 (as amended) PR = The Patent Rules 1997 (as amended and in force)

ANNEXE B: HOW TO PREPARE FOR FCI AND THE COURSE

General preparation for FC1

A1. Read and familiarise yourself with the FC1 syllabus, to understand its scope and the levels of knowledge expected.

- The syllabus (the themes of which are reproduced in **Annexe A**) is available online from the Patent Examination Board website.

A2. Read and familiarise yourself with recent past P1 exam papers, Examiner's Reports, Mark Scheme (for 2014) and Sample Pass Scripts to understand the requirements of the exam.

- Exam papers, Examiner's Reports, the Mark Scheme (for 2014) and Sample Pass Scripts are available online from the Patent Examination Board website

B. Recommended additional pre-course reading (and listening³):

- The CIPA Informals' Foundation lectures series for 2015 and 2014, covering a range of relevant topics: available from the Informals section of the CIPA website.
- CIPA's *The Patents Training Manual*, chapters 6-8, 14 and 16.
- Two introductory books and revision tools on IP law which have chapters relevant to all Foundation courses: *Intellectual Property Law* by Jennifer Davis (OUP: latest edn.), ch. 6 on patents, and *Intellectual Property Law Concentrate* by Tim Press (OUP: latest edb.), ch. 2 on copyright and ch. 7 on patents.

C. Legislation and reference works for consultation before and after the course

- The latest version of the *Patents Act 1977*. * www.ipo.gov.uk/patentsact1977.pdf
- The *Patents Rules 2007* (as amended and as in force). * <http://www.ipo.gov.uk/patentrules2007.pdf>
- *CIPA Guide to the Patents Act ('Black Book'**: latest edition, and first supplement)
- Cases discussed in the commentary on the aspects of novelty, obviousness and infringement.
- The Manual of Patent Practice (latest edn.), published by the IPO
- The IPO website IP Professional section on patents <http://www.ipo.gov.uk/pro-types/pro-patent/p-law.htm>

* Please bring these with you to the course.

Specific preparation for the course

D. Attempt and send to the tutors (at least a week before the course) an answer to the questions in Annexe C. The address to which answers should be sent will be provided in the course instructions issued 4-6 weeks before the course date.

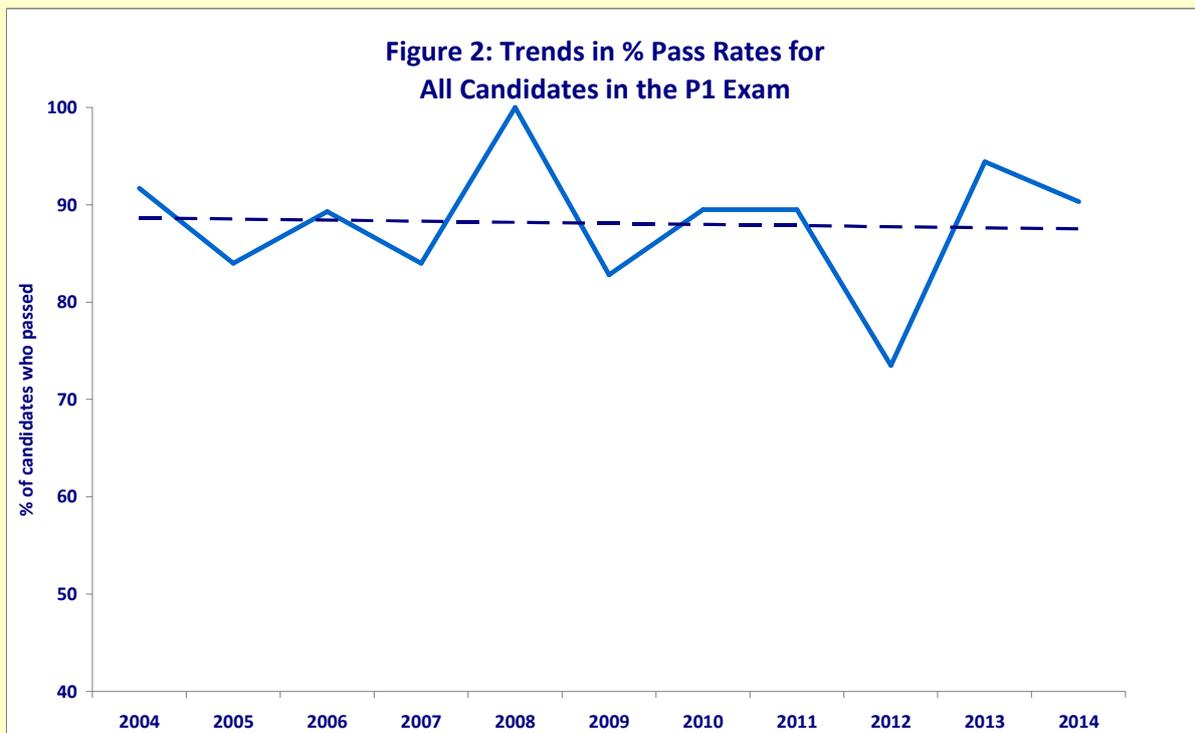
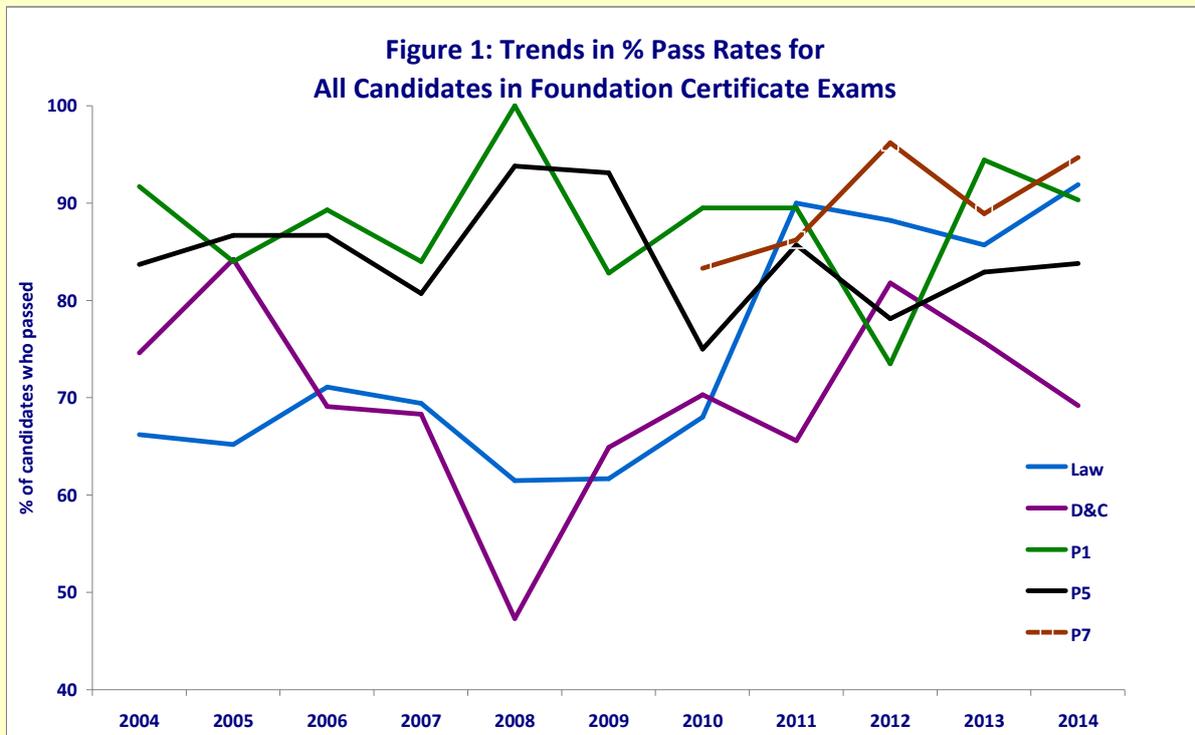
³ In the case of the Informals' lectures

ANNEXE C: PRE-COURSE QUESTIONS TO BE ANSWERED

1. What is a patentable invention as defined in the Patents Act 1977?
What subject matter is excluded from patentability?
2. What are the grounds of revocation of a patent as specified in the Patents Act 1977?
Is there any restriction on who can plead these grounds, and is there any time limit involved?
Where can application for revocation be made?
3. In the context of UK patents:
 - a) What is a priority date and why is it important?
 - b) Explain the circumstances under which a patent claim can have more than one priority date.
 - c) For a UK patent application, what documents must be filed, and by when, to support a priority claim from a foreign patent application?
Mention what extensions of time, if any, are available.
4.
 - a) How do you determine if there is unity of invention with two independent apparatus claims?
 - b) If there is not unity of invention, and only the first invention is searched by the Patent Office, under what circumstances will the Patent Office search the further invention?
 - c) If a divisional application is filed for an invention, what conditions must be met for the Search fee to be refundable?
5. By virtue of Section 118 of the Patents Act 1977, after publication of a British Patent Application, the comptroller will on request (and on payment of a fee) provide certain information about the application and allow inspection of documents on the Patent Office file relating to the application.
 - a) Explain how a request to be provided with copies of papers from the Patent Office file can be made,
 - b) Explain how, and under what circumstances, an applicant for a patent can prevent a document filed from being made publicly available, and
 - c) Explain under what circumstances papers from the Patent Office file can be made available before publication, and to whom.

ANNEXE D: TRENDS IN OVERALL PASS RATES FOR UK PATENT LAW (P1)

Figure 1, drawing on PEB data for all candidates, indicates that, since 2004, the pass rate for the P1 exam has fluctuated year to year: from a low of 75% in 2010 to a high of 94% in 2008. **Figure 2** indicates that the linear trend for passing has been broadly stable at around 88%.



In 2014, the PEB published (**Figure 3**) the distribution of marks for all the candidates who took the P1 exam.

Figure 3: The mark distribution of P1 exam candidates in 2014



This is the first year PEB has published this information, so we do not know whether mark distribution in 2014 was typical. But analysis of the marks indicates a wide spread in marks.