

FC3¹ International Patent Law: Course Description

Course summary

This intensive two-day revision course is designed to help prepare trainee patent attorneys for the Foundation Certificate (FC) Patent Examination Board (PEB) paper on International Patent Law: for which candidates are expected to demonstrate knowledge of: the main provisions of the Patent Cooperation Treaty (PCT) and the European Patent Convention (EPC); the national patent/utility model laws, and procedures for applying for and obtaining patent/utility model rights in the USA, Canada, Mexico, Japan, China, South Korea, Taiwan, India, Hong Kong, Singapore, Australia, New Zealand, Argentina, Brazil, Israel, Saudi Arabia, South Africa, Germany, France, the Netherlands, Italy, Spain, Poland and Norway. Candidates are expected to be able to recall the relevant principles, laws and rules, and/or apply them to one or more given scenario(s).

The underpinning knowledge will be presented via lectures linked to handout notes on the main topics of the syllabus. There will be opportunities for individual and small group practice of questions from recent exams so that participants can learn, with feedback from the tutors, on how to apply their knowledge to exam questions. The tutors will also provide advice on exam technique and the examiner's expectations.

Content

The course comprises sessions on EPC Law, International Agreements, the USA, other Foreign Law (three sessions) and the PCT. These cover the seven themes of the FC3 syllabus (see **Annexe A**). There is also a session on exam technique, a short session of quick-fire questions across the syllabus and closing advice on post-course final preparations for the exam. Below we set out a summary of the content of each session and expected learning outcomes.

¹ Formerly the P5 paper.

Pre-course preparation

Summary

Annexe B sets out guidance on pre-course preparation. Through reading the FC3 syllabus and instructions to past papers and sending in an answer to a past paper specified by the tutors, participants will understand what the syllabus covers, the expected depth of knowledge and the format and challenge of the exam. It would be helpful for participants to also read (and listen to) Informals' lectures on relevant topics and, as far as time permits, look at the other materials set out in Annex B. The course lectures and notes will cover the key areas of the syllabus, but it will be helpful to have awareness of the EPO Guidelines and PCT Applicants Guide.

Expected learning outcomes

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

- describe the scope of the FC3 syllabus, the syllabus themes and the 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
- outline key features of the EPC and PCT.

Session 1: EPC Law

Session summary

In this session, participants will gain outline knowledge of the EPC law required for FC3. This is a key part of the FC3 syllabus, typically accounting for two-fifths of exam questions. Teaching will be through lectures by the tutors linked to handout material on the topics. There will also be practice of past exam questions. The session will cover: patentability; filing procedure; examination and grant; renewal fees; limitation, revocation, opposition and appeal proceedings; common provisions; and petition for review.

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:

- what may be patented under the EPC – the definition of novelty and state of the art under the EPC and the EPO's problem and solution approach to assessing inventive step;
- applying for and obtaining a European Patent (EP) - who may apply; where to file; language of the EP application; date of filing; reference filing; claims and abstracts; payment of fees; claims to priority; and divisionals;
- examination and grant – the European search report; examination; amendments to the application; corrections rule; notice of allowance; renewal fees, and protection conferred by EP patents;
- limitation, revocation, opposition and appeal proceedings;
- common provisions – third party observations; further processing and re-establishment of rights; and
- petition for review.

Session 2: Exam Technique

Session summary

In this session, the tutors will discuss the breakdown of marks between questions on the EPC, PCT, USA and other countries (and general priority questions) over recent exams and will provide participants with advice on how to:

- manage the time pressures of the exam – allocating time appropriately to questions and each Part and not answering more than the required number of questions; and
- respond to exam questions to meet examiner expectations - how to structure answers and the importance of applying their knowledge and understanding of the law to the facts of the question and applying reasoning (rather than writing down all they know on the subject).

Throughout the course, participants will practise past questions and receive feedback from the tutors and the group.

Expected learning outcomes

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

- recognise what the examiner expects in a question answers and how to structure answers;
- recount how many questions need to be answered in each Part of the paper and how marks are distributed across the paper; and
- recall strategies for managing time pressures during the exam.

Session 3: International Agreements (Paris Convention, WTO, the TRIPS Agreement and Priority)

Session summary

In this session, participants will gain outline knowledge of the Paris Convention, WTO, the Trade Related Aspects of Intellectual Property (TRIPS) Agreement and Priority, as required for FC3. Teaching will be through lectures by the tutors linked to handout material on the topics.

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 Paris Convention (Articles 2-4);
- the WTO and its membership;
- the TRIPS Agreement and its key areas of harmonization; and
- how Priority works with respect to EPC and PCT applications and national filings.

Session 4: Foreign Law 1 (Canada, Mexico, Japan, China, South Korea, Taiwan and India)

Session summary

In this session, participants will gain outline knowledge of patentable inventions and utility models, applying for and obtaining a patent or utility model, entering the national phase from a PCT application, search and examination of patent applications and utility models, and claiming priority in Canada, Mexico, Japan, China, South Korea, Taiwan and India. Teaching will be through lectures by the tutors covering these topics for each country, linked to handout material on each.

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, for each of the countries, of:

- patentable inventions and utility models;
- applying for and obtaining a patent or utility model;

- entering the national phase from a PCT application;
- search and examination of patent applications and utility models, and;
- claiming priority.

Session 5: USA

Session summary

In this session, participants will gain outline knowledge of the America Invents Act (AIA) and US patent practice. Teaching will be through lectures by the tutors linked to handout material on the topics. There will also be practice of past exam 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 AIA – first to file; third party observations; post grant review; filing by assignee; accelerating examination; prior-use defence; and other provisions; and
- US practice – general provisions; filing and prosecution; further features; and post grant.

Session 6: Foreign Law 2 (Netherlands, Germany, France, Italy, Spain, Poland and Norway)

Session summary

In this session, participants will gain outline knowledge of patentable inventions and utility models, applying for and obtaining a patent or utility model, entering the national phase from a PCT application, search and examination of patent applications and utility models, and claiming priority in the Netherlands, Germany, France, Italy, Spain, Poland and Norway – and also restrictions on UK residents filing abroad. Teaching will be through lectures by the tutors covering these topics for each country, linked to handout material on each.

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, for each of the countries, of:

- patentable inventions and utility models;
- applying for and obtaining a patent or utility model;
- entering the national phase from a PCT application;
- search and examination of patent applications and utility models, and;
- claiming priority.

Session 7: Foreign Law 3 (Hong Kong, Singapore, Australia, New Zealand, Argentina, Brazil, Israel, Saudi Arabia and South Africa)

Session summary

In this session, participants will gain outline knowledge of patentable inventions and utility models, applying for and obtaining a patent or utility model, entering the national phase from a PCT application, search and examination of patent applications and utility models, and claiming priority in Hong Kong, Singapore, Australia, New Zealand, Argentina, Brazil, Israel, Saudi Arabia and South Africa. Teaching will be through lectures by the tutors covering these topics for each country, linked to handout material on each.

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, for each of the countries, of:

- patentable inventions and utility models;
- applying for and obtaining a patent or utility model;
- entering the national phase from a PCT application;
- search and examination of patent applications and utility models, and;
- claiming priority.

Session 8: PCT

Session summary

In this session, participants will gain outline knowledge of the aspects of the PCT relevant to FC3. Each year, typically around a fifth of exam questions are on the PCT. Teaching will be through lectures by the tutors linked to handout material on the topics. There will also be practice of past exam 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:

- an overview of the PCT system – membership; interaction with national and regional filings; who can file; where to file; language; and, time limits;
- filing procedure and initial processing;
- search and publication;
- examination – Chapter I and Chapter II;
- National phase entry; and
- EPO regional phase entry.

Session 9: EPC/PCT/foreign law questions and pick n mix

Session summary

In this session, the tutors will test participants' knowledge across the syllabus through a quick-fire, pick-n-mix question game involving individual answers from the whole group.

Expected learning outcomes

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

- recognise their level of knowledge across the syllabus, and
- identify areas where they need to do further reading and practice.

Session 10: Final preparations for the exam

Session summary

In this closing session, the tutors will advise on how participants can best prepare for the FC3 paper in the intervening weeks before the exam. They will provide 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 FC3 exam; and
- identify areas where they need to do further reading and practice.

ANNEXE A
THE FC3 SYLLABUS THEMES

Theme	Learning outcomes
1. The law relating to patentable inventions under the EPC/PCT and for each of the listed countries	a) Define the requirements for a patent to be granted on an invention: <ul style="list-style-type: none"> - Novelty - Inventive step - Industrial application - Exclusions to patentability b) Identify any grace periods for prior disclosures c) Explain the differences between patents and utility models d) Apply (a) to (c) to a scenario
2. The impact of national security or public safety on filing patent applications	a) Define the restrictions on filing applications abroad as set out in section 23 of the UK Patents Act b) Identify which of the listed countries have similar provisions c) Apply (a) and (b) to a scenario
3. The patent application process via the PCT	a) Describe how to make an International (PCT) application: <ul style="list-style-type: none"> a. who may apply b. where the application may be filed c. the minimum requirements to obtain a filing date d. time limits for filing formal documents e. preparation of description, claims and abstract b) Define the time limits for requesting search or examination during the International phase c) Describe the procedures for responding to the search report or written opinion d) Explain the procedure for correction or amendment during the International phase e) Outline the procedure for entering the regional phase in Europe (EPC) or the national phase for each of the countries listed above: <ul style="list-style-type: none"> a. time limits (and any extensions of time) for national/regional phase entry b. time limits (and any extensions of time) for filing formal documents c. translation requirements d. the payment of claims fees f) Identify whether the application can be corrected or amended on entering the national or regional phase
4. The patent application process via the EPC	a) Describe how to make an EP application: <ul style="list-style-type: none"> a. who may apply b. where the application may be filed c. the minimum requirements to obtain a filing date d. the time limits for filing formal documents e. the preparation of description, claims and abstract f. the payment of claims fees b) Define the time limits for requesting search or examination c) Describe the procedures for responding to the search report or examination report

Theme	Learning outcomes
	d) Explain the procedure for correction or amendment of a pending application and central limitation for a granted patent e) Describe the procedures for further processing and re-establishment f) Outline the procedure on grant including the national validation procedure for the listed countries
5. The process for obtaining a patent or a utility model via the national patent office in the countries listed above	a) Outline the application process: <ul style="list-style-type: none"> a. Who may apply b. Where the application may be filed c. The preparation of description, claims and abstract d. The payment of claims fees e. The disclosure of best mode for performing an invention (where applicable) f. Time limits for filing formal documents b) Define any time limits, including extensions of time, for requesting search or examination c) Outline the procedures for responding to the search report or examination report (office action) d) Describe any requirements to disclose prior art e) Compare the procedures for applying for and obtaining a patent or utility model via the PCT, the EPC or the national route
6. The law relating to opposition, re-examination and/or revocation of granted EP patents, Japanese patents, US patents and German patents and utility models	a) Identify who may bring opposition, re-examination and/or revocation proceedings b) Define any time limits associated with each process c) Describe the procedure before each patent office d) Outline any appeal process
7. National law relating to priority and the underlying principles governing priority from the Paris Convention	a) Define the underlying principles for claiming priority with reference to the Paris Convention b) Describe the requirements for claiming priority when filing an International (PCT) application, a European (EPC) application and national patent applications for each of the countries listed above. c) Determine whether a later application can validly claim priority from an earlier application

ANNEXE B: HOW TO PREPARE FOR FC3 AND THE COURSE

A. General preparation for FC3

1. Read and familiarise yourself with the FC3 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.

2. Read and familiarise yourself with recent past P5 exam papers, Examiner's Reports, Mark Scheme (for 2014 onwards) and Sample Pass Scripts to understand the format and requirements of the exam.

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

3. Recommended reading (and listening²), as far as time permits:

- The CIPA Informals' lectures on the EPC, PCT, Priority, Renewals and US patent law: available from the Informals section of the CIPA website.
- CIPA's *The Patents Training Manual*, chapters 6-8 and 16.
- *The EPO guidelines* <http://www.epo.org/law-practice/legal-texts/guidelines.html>
- *The PCT Applicants* Guide <http://www.wipo.int/pct/en/appguide/index.jsp>

4. Reference works for consultation before and after the course

- The EPO's *National Law Relating to the EPC* (16th edn. September 2013), available online at <http://www.epo.org/law-practice/legal-texts/national-law.html>
- Kluwer IP Law's '*Brown Book*' Manual for the Handling of Patents, Designs and Trade Marks Throughout the World.
- The *European Patents Handbook*, published by Sweet & Maxwell.
- *A Guide to the EPC 2000* (latest edition), 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

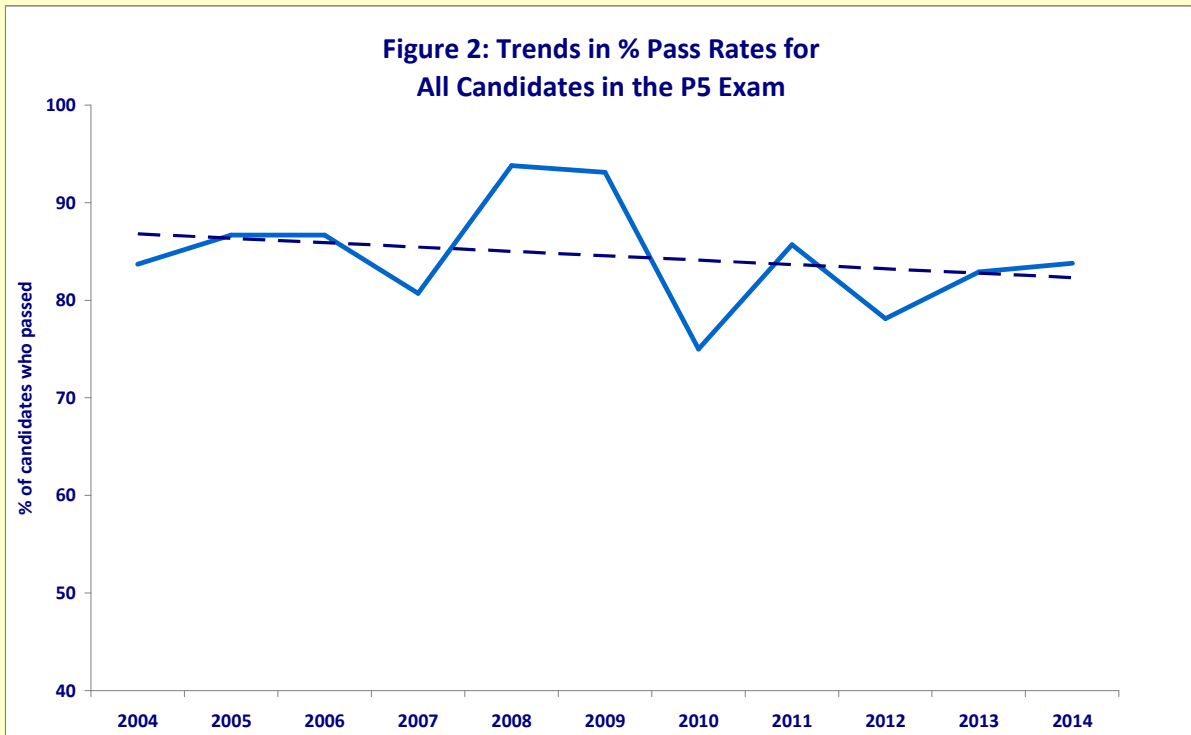
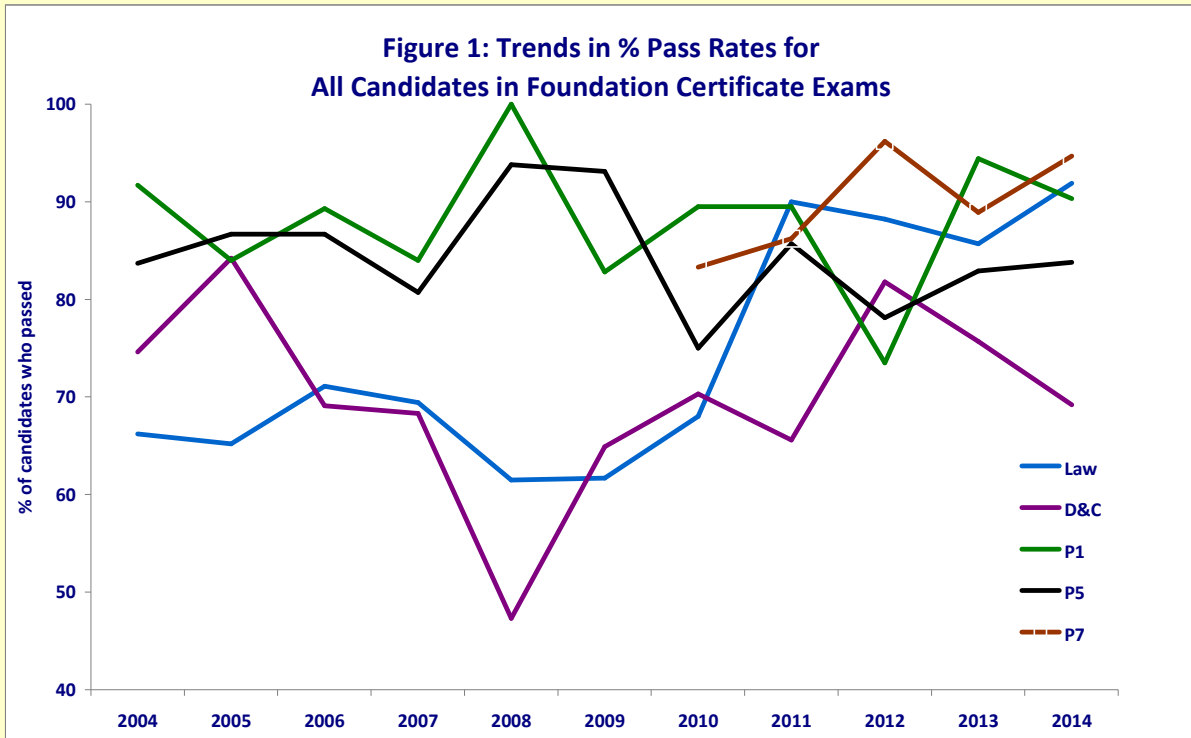
B. Specific preparation for this course

5. Attempt and send to the tutors an answer to a past paper which will be specified in the pre-course instructions sent out 4-6 weeks before the course date.

² In the case of the Informals' lectures

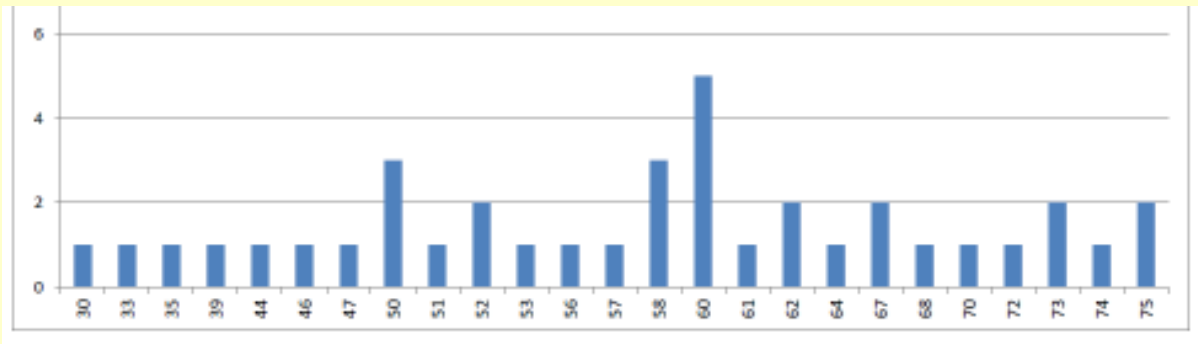
ANNEXE C: TRENDS IN OVERALL PASS RATES FOR P5

Figure 1, drawing on PEB data for all candidates, indicates that, since 2004, the pass rate for the P5 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 slightly downwards, averaging around 85%.



In 2014, the PEB published (**Figure 3**) the distribution of marks for all the candidates who took the P5 exam.

Figure 3: The mark distribution of P5 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. Analysis of the marks indicates a wide spread in marks, but nearly a fifth of candidates scored 50 to 53 marks, and so were 'narrow passes'. This highlights the importance of candidates maximising all possible marks available: one or two marks can mean the difference between a pass and a fail.