

FD1¹ Advanced IP Law & Practice Berryman/Moulin: Course Description

Course summary

This intensive 1.8 day revision course is designed to help prepare trainee patent attorneys for the Final Diploma (FD) Advanced IP Law & Practice paper. The Examination Guidance describes FD1 as a test of “*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.*” Participants are expected to have underpinning knowledge of the relevant law, built up from Foundation Certificate and subsequent study, practical experience and prior learning.

The underpinning knowledge will be reviewed, with the main emphasis of the course being practical and focused on the competencies that FD1 tests. There will be advice from the tutors on examination technique, including how to analyse questions and present answers appropriately. The application of knowledge and technique will be illustrated by discussion of past paper questions, including supervised group, small group and individual work in which participants can practise and receive feedback from the tutors on previously unseen past exam questions.

Pre-course preparation

Participants are asked to read the FD1 Syllabus, Examination Guidance and Instructions to Candidates from past papers. They will need to revisit and build on their Foundation knowledge of the relevant sections of the acts, rules and treaties in the FD1 Syllabus. The better prepared each participant, the more the individual – and the group – will get out of this intensive course.

Upon completion of pre-course preparation, participants should be able to:

- describe the scope of the FD1 Syllabus and the knowledge and competencies required;
- understand the format of the exam, including the number and types of questions that need to be answered, and the exam instructions and regulations;
- as far as possible, have the level of practical experience set out on pages 2-3 of the Examination Guidance; and
- recall and describe the areas of law and practice that are tested in FD1.

Course Content

¹ Formerly the P2 paper.

- **Tour of the Act**
The tutors will provide, through oral quick-fire questions and associated discussion, an overview of the key parts of law that are tested in the FD1 paper. Summary handouts will be provided on specific topics, including groundless threats (s. 70), formalities deadlines and designs.
- **Exam Technique**
Participants will receive advice from the tutors on the Examiner's expectations in terms of a good FD1 answer, managing time efficiently and organising answers to maximise marks, as well as advice on gaining marks which are easy to overlook.
- **Blind Questions – Part A**
Participants will review some previously unseen Part A questions, initially as a group with tutors prompting, challenging and inviting comments from other participants as appropriate, to help develop skills in identifying legal issues and clearly explaining them. Later questions will be tackled individually. After each question has been discussed, the structuring of a suitable answer and appropriate conclusions will be considered.
- **Designs**
After an overview of the relevant law on designs, the tutors will provide advice on tackling design questions, and the group will address previously unseen questions on designs and discuss the structure of a suitable answer.
- **Blind Questions – Part B**
After a discussion of exam technique for answering Part B questions, participants will address previously unseen questions in small groups to promote contributions by all individuals. Tutors will move between groups to prompt and challenge. After discussion within the groups, a general review of each question will be undertaken and the structuring of a suitable answer and appropriate conclusions considered.
- **Final Questions**
Participants will be able to raise any topics about which they remain unclear. Teaching will be through direct responses to participant queries.

Expected Learning Outcomes

After the course, participants will:

- have reinforced knowledge of key aspects of law with which a person advising clients on UK matters needs to be familiar;
- be able to identify what the Examiner expects in an answer – application of understanding of law and practice to the question by means of structured analysis and reasoned, balanced discussion, producing practicable advice that meets the client's needs;
- have gained confidence in their analysis of questions and assimilation of information; and
- improved their ability to formulate answers which meet the Examiner's expectations.

ANNEXE A: EXTRACTS FROM THE FD1 SYLLABUS²
SETTING OUT CONTENT THEMES AND RELEVANT LEGAL PROVISIONS

CONTENT THEMES	LEGAL PROVISIONS	
	Legislation	Rules
1. Available forms of intellectual property	Parts I and III of the Copyright, Designs and Patents Act 1988 (CDPA) The Patents Act 1977 (PA) The Registered Designs Act 1949 (RDA) The Trade Marks Act 1994 The Treaty on the Functioning of the EU (EU) EU 34 to 36 EU 101 to 102 CDPA 51 to 53	
2. The law and practice relating to patentable inventions in the UK	PA 1 – Patentable inventions PA 2 – Novelty PA 3 – Inventive step PA 4 – Industrial application PA 4A – Methods of treatment or diagnosis PA 76A and PA Schedule A2 – Biotechnological inventions	Patent Rules (PR) PR5
3. In relation to inventions in the UK: - the right to apply for and obtain a patent - determination of inventors - ownership of a patent - the relationship between employer and employees	PA 7 – Right to apply etc. PA 8 – Determination before grant of questions about entitlement to patents PA 10 – Handing of applications by joint applicants PA 11 – Effect of transfer of application under Sections 8 or 10 PA 12 – Determination of questions about entitlement to foreign and convention applications PA 13 – Mention of inventor PA 36 – Co-ownership of patents and applications for patents PA 37 – Determination of right to patent after grant PA 39 – Rights to employees' invention PA 40 & 41 – Compensation of employees for certain inventions PA 42 & 43 – Enforceability of contracts relating to employees' inventions	Implementing Regulations to the European Patent Convention (EPR) EPR 14 PR 10, 11
4. The law and practice relating to the UK patent application process	PA 14 – Making an application PA 15 – Date of filing application PA 15A – Preliminary examination	PR 12, 15, 16, 103, 104, 113 to 115 PR 17 to 22 PR 23, 24

² You should read the full syllabus (http://www.cipa.org.uk/download/FD12015_Final.pdf) to understand the Learning Outcomes you will have to demonstrate in the examination to show that you have the required knowledge and skills.

CONTENT THEMES	LEGAL PROVISIONS	
	Legislation	Rules
	PA 16 – Publication of application PA 17 – Search PA 18 – Substantive examination and grant or refusal of patent PA 20 – Failure of application PA 20A – Reinstatement of applications PA 20B – Effect of reinstatement PA 117B – Extension of time limits specified by Comptroller PA 119 – Service by post PA 120 – Hours of business and excluded days	PR 26 PR 27 PR 28 to 30 PR 32 PR 107, 108,109 PR 111 PR 110
5. The law and practice relating to amendment and to correction of UK patent applications and patents	PA 19 – General power to amend PA27 – General power to amend specification after grant PA75 – Amendment of patent in infringement or revocation proceedings PA 76 – Amendments of applications and patents not to include added matter PA 117 – Correction of errors in patents and applications PA 117A – Effect of resuscitation of a withdrawn application under Section 117	PR 31 PR 35, 75 PR 49, 50, 105
6. The duration of a UK patent	PA 24 – Publication and certificate of grant PA 25 – Term of patent PA 28 – Restoration of lapsed patents PA 28A – Effect of order for restoration of patent PA 29 – Surrender of patents PA 128B – SPCs PA Schedule 4A – SPCs	PR 36 to 39 PR 40 PR 42
7. UK Patents and patent applications as property	PA 30 – Nature of, and transactions in, patents and applications for patents PA 31 - Nature of, and transactions in, patents and applications for patents in Scotland PA 32 – Register of patents etc. PA 33 – Effect of registration PA 46 – Patentee's application for entry in register that licences are available as of right PA 47 – Cancellation of entry made under Section 46 PA 68 – Effect of non- registration on infringement proceedings PA 118 – Information about patent applications and patents, and inspection of documents	PR 47, 103, 104 PR 43, 73 PR 75 PR 54
8. The law and practice relating to infringement of UK patents	PA 60 – Meaning of infringement PA Schedule A1 – Derogation from patent protection in respect of biotechnological inventions PA 61 – Proceedings for Infringement of patent PA 62 – Restrictions of recovery of damages for infringement PA 63 – Relief for partially valid patent	

CONTENT THEMES	LEGAL PROVISIONS	
	Legislation	Rules
	PA 64 – Right to continue use begun before priority date PA 65 – Certificate of contested validity of patent PA 66 – Proceedings for infringement by a co-owner PA 67 – Proceedings for infringement by exclusive licensee PA 69 – Infringement of rights conferred by publication of application PA 100 – Burden of proof in certain cases	
9. In relation to UK patents and patent applications: <ul style="list-style-type: none"> - Groundless threats - Declaration of non-infringement - False marking 	PA 70 – Remedy for groundless threats of infringement proceedings PA 71 – Declaration as to non-infringement PA 110 – Unauthorised claim of patent rights PA 111 – Unauthorised claim that patent has been applied for	
10. The law and practice relating to challenging UK patents and patent applications	PA 21 – Observations by third parties PA26 – Patent not to be impugned for lack of unity PA 72 – Power to revoke patents on application PA 73 – Comptroller's power to revoke patents on his own initiative PA 74 – Proceedings in which validity may be put in issue PA 74A and 74B Opinions by Patent Office PA 125 – Extent of invention	PR 33 PR 73 to 84, 87 PR 92 to 100
11. Priority	Paris Convention (PC) PC 4 – Priority of right PA 5 – Priority Date PA 6 – Disclosure of matter, etc., between earlier and later applications	PR3, 6 to 9
12. The law and practice relating to European patents and patent applications and their effect in the UK	European Patent Convention Article (EPC Art) 2 – European patent EPC Art 52 – 57 EPC Arts 58 to 62 – Persons entitled to apply for and obtain European patents – Mention of inventor EPC Art 68 – Effect of revocation of the European patent EPC Art 69 – Extent of protection EPC Art 70 – Authentic text EPC Art 71 – Registration of transfer of a European patent EPC Art 79 – Designation of contracting states EPC Art 93 – Publication of a European patent application EPC Art 94 – Examination of a European patent application EPC Art 97 – Refusal or grant EPC Art 99 – Opposition EPC Art 100 – Grounds for opposition EPC Art 105a to c – Request for limitation or revocation	EPR 14 EPR 16, 17 EPR22 & 85 EPR 39 EPR 70, 70a EPR 71(3)

CONTENT THEMES	LEGAL PROVISIONS	
	Legislation	Rules
	EPC Art 121 – Further processing EPC Art 122 – Re- establishment of right EPC Art 123 – Amendments PA 77 – Effect of European patent (UK) PA 78 – Effect of filing an application for a European patent (UK) PA 79 – Operation of Section 78 to certain EP applications PA 80 – Authentic text of European patents and patent applications	
13. The law and practice relating to European patents and patent applications and their effect in the UK	Patent Cooperation Treaty (PCT) Chapters I and II PA 89 – Effect of international application for patent PA 89AI – International and national phases of applications PA 89BA – Adaptation of provisions in relation to international application	PR 65 to 70
14. The law and practice relating to patentable inventions in UK, EPC, US and Japan	35 US Consolidated Patent Laws (USC) 101 – 103 EPC Art 52 – 57 Japanese Patent Act JP 29, 30 and 32 PA 1 – Patentable inventions PA 2 – Novelty PA 3 – Inventive step PA 4 – Industrial application PA 4A – Methods of treatment or diagnosis	
15. The law and practice in relation to obtaining patents in USA, Japan and via the EPC for an invention made in the UK	PA 23(1)(a) – Restrictions on applications abroad 35 USC 112 35 USC 119 to 121 EPC Art 76 EPC Art 79 EPC Art 93 EPC Art 94 JP 30 Exception to lack of novelty of invention JP 36 Patent Applications JP 43 Paris convention priority claim JP 44 Divisionals JP 48-3 Request for examination of application	EPR36
16. The law and practice relating to UK and Community Registered designs, UK design right, Community unregistered design and UK copyright	Please refer to the syllabus for D&C Law (FC4)	Please refer to the syllabus for D&C Law (FC4)

ANNEXE B

HOW TO PREPARE FOR FD1 AND THE COURSE

A. General preparation for FD1

1. Read and familiarise yourself with the FD1 Syllabus to understand:

- which areas of the law you are expected to know;
- what you will have to demonstrate in the exam to show that you have the required knowledge and skills; and
- what practical experience it is helpful for participants to have.

The syllabus is available from the Patent Examination Board (PEB) website.

2. Seek out opportunities in your office to obtain the recommended practical experience set out on pages 2-3 of the Examination Guidance.

Discuss this with your training supervisor/line manager.

3. Read and familiarise yourself with recent past FD1 (P2) Exam Papers, including consideration of the Examiner's Reports, the Mark Scheme (available for 2014 onwards) and Sample Pass Scripts, to understand the format and requirements of the exam and how marks are allocated.

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

4. Build on your notes from Foundation Certificate to ensure you are up to date on the areas of law and practice that are set out in the FD1 Syllabus and tested in the exam. Suggested reference sources include:

- **UKIPO Manual of Patent Practice.** Available from the UKIPO website.
- **PCT Applicant's Guide.** Available from the WIPO website.
- CIPA's ***The Patents Training Manual***, chapters 9, 10 and 13-16. Available from CIPA.
- Doug Ealey's ***Study Guide to the Patents Act*** (latest edn.). Available from CIPA.
- ***CIPA Guide to the Patents Act*** ('Black Book': latest edition, and supplement) – the key reference book.
- ***CIPA Informals lectures*** in the Informals area of the CIPA website.
- Also see the suggested reading set out at the end of the FD1 Syllabus

B. Specific preparation for this course

5. During the course we will be working through a number of long answer questions, with several of these being based on the topics below.

Therefore as preparation, please ensure that you would be able to answer the following questions by reviewing the relevant legislation and, in particular, the following sections of the UK Patents Act:

Section 60:

1. What are the various infringing acts in relation to both product and process inventions?
2. Describe the secondary ('indirect' or 'contributory') infringement provisions as concisely as possible. Your answer should define under what circumstances an act would be considered as secondary infringement.
3. Under what circumstances does the burden of proof of infringement shift from the patent owner to the alleged infringer?

Section 70:

1. What constitutes a threat, and what doesn't?
2. When is a threat actionable, and when isn't it?
3. When is a threat justifiable, and when isn't it?
4. When a threat is made in relation to a patent application (rather than a granted patent), how does this fit into questions 2 and 3?

Sections 39 and 40:

1. Describe (as concisely as possible) the various circumstances in which an invention made by an employee belongs to their employer.
2. Describe (as concisely as possible) the circumstances in which an employee can derive compensation for their invention.

Please also familiarise yourself with **Section 5 (Priority)**.

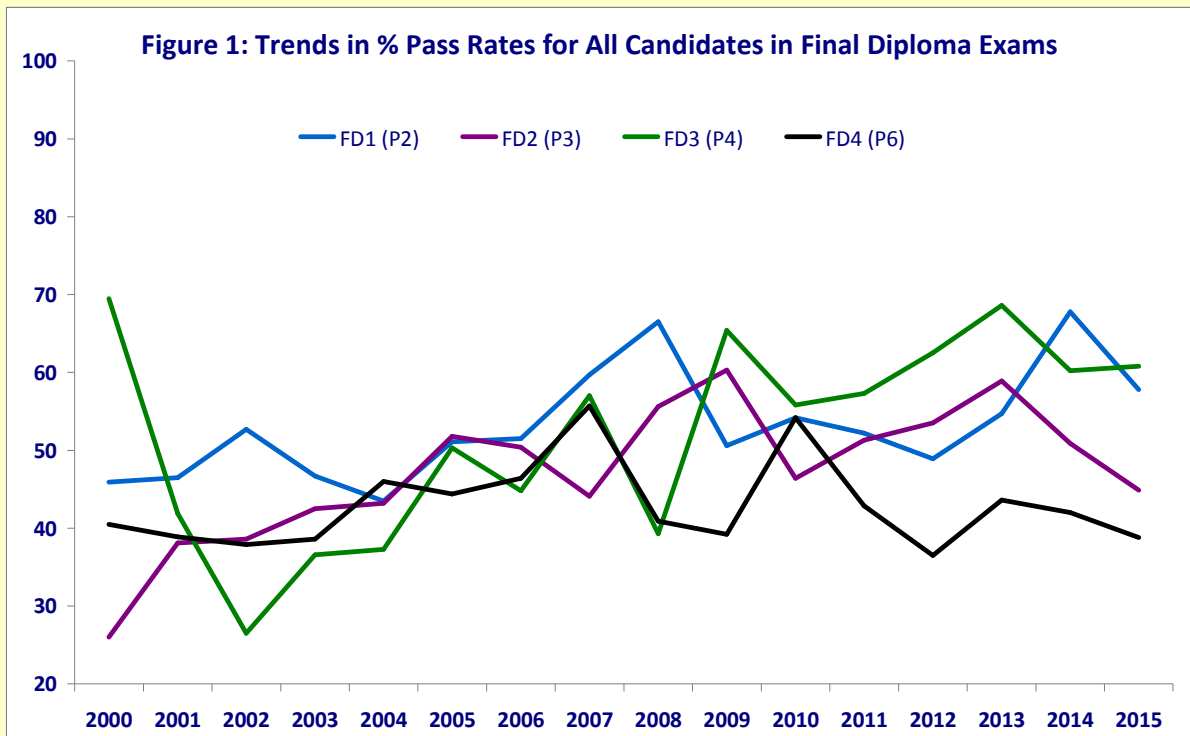
C. Materials to bring to the course

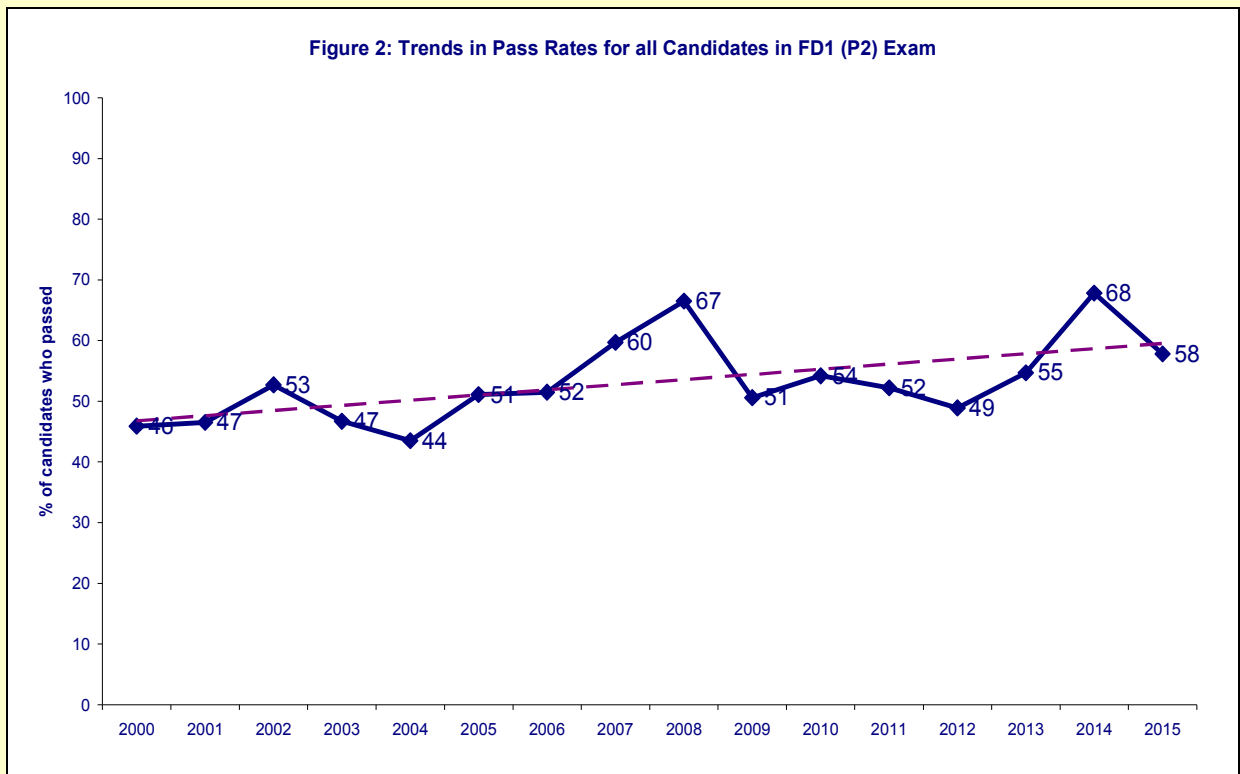
You should bring along:

- the relevant parts of the legal texts covered by the syllabus (at least the Patents Act and Rules, Registered Designs Act and Part III of the CDPA 1988);
- if desired, other reference texts, such as the CIPA Black Book or Doug Ealey's study guide and
- pens and writing pad to supplement the paper that will be supplied during the course.

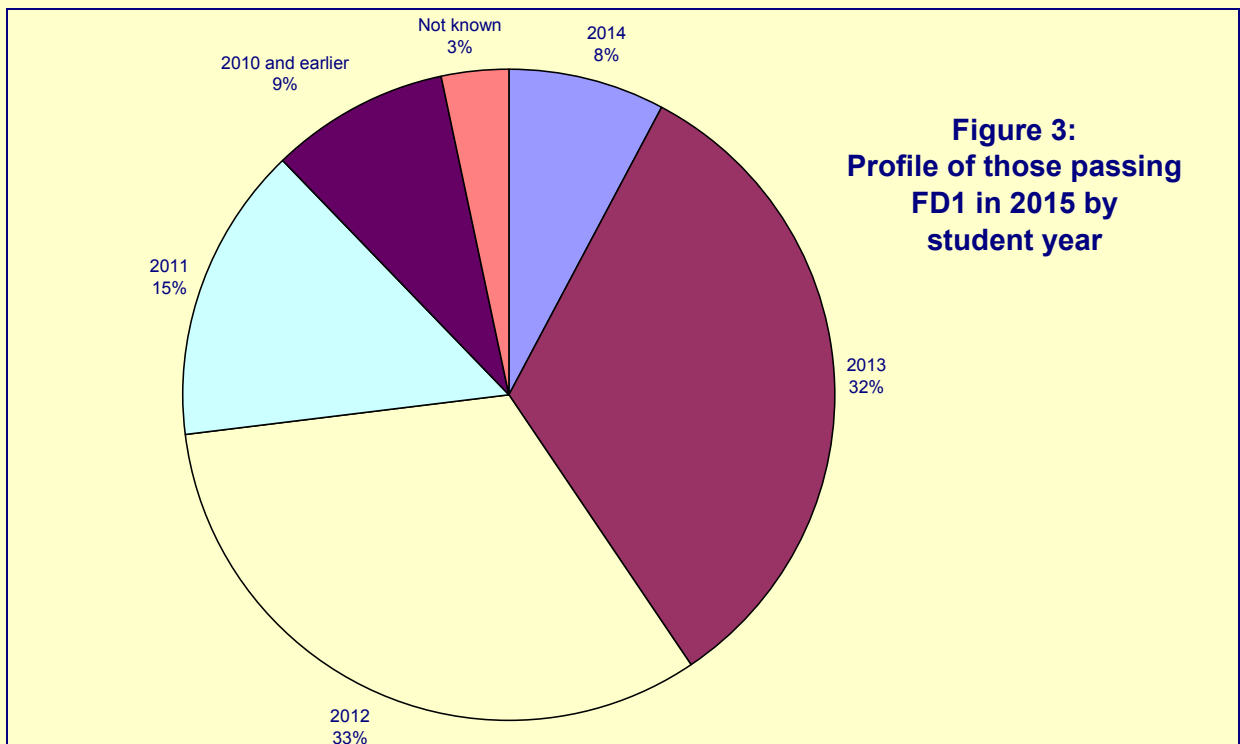
ANNEXE C: TRENDS IN OVERALL PASS RATES FOR FD1 (P2)

Figure 1, drawing on PEB data for all candidates, indicates that, since 2000, the pass rate for FD1 (P2) has fluctuated substantially year to year: from a low of 44% in 2004 to a high of 68% in 2014. **Figure 2** indicates that the linear trend for passing has been gradually upwards from 46% in 2000 to 58% in 2015. The mean pass rate over the period 2000-15 was 53% as against 47% for FD2 (P3), 52% for FD3 (P4) and 43% for FD4 (P6).



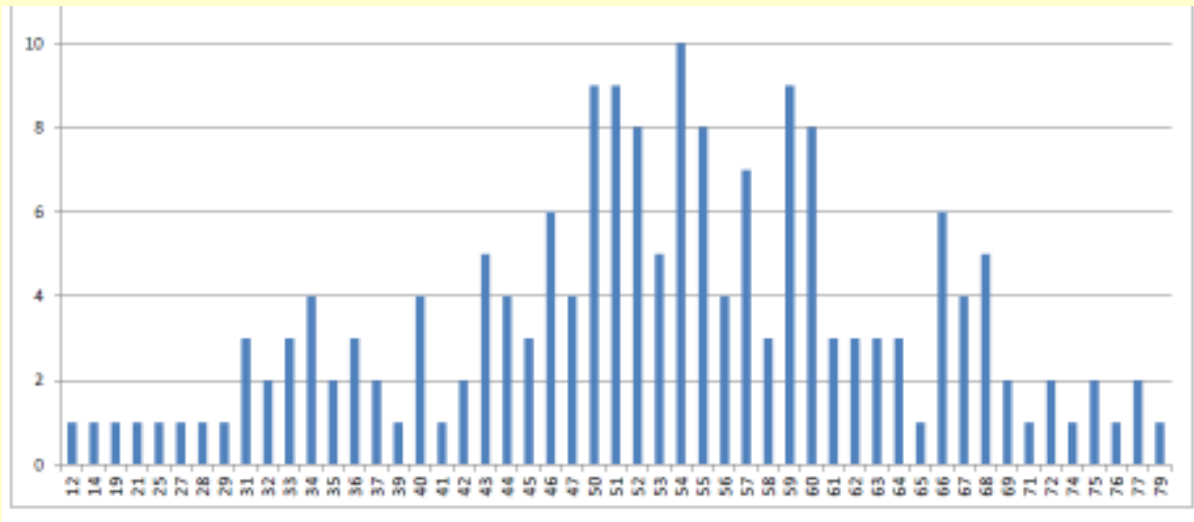


Our analysis (**Figure 3**) indicates that 60% of those who passed FD1 in 2015 had been students in the profession for more than two years.



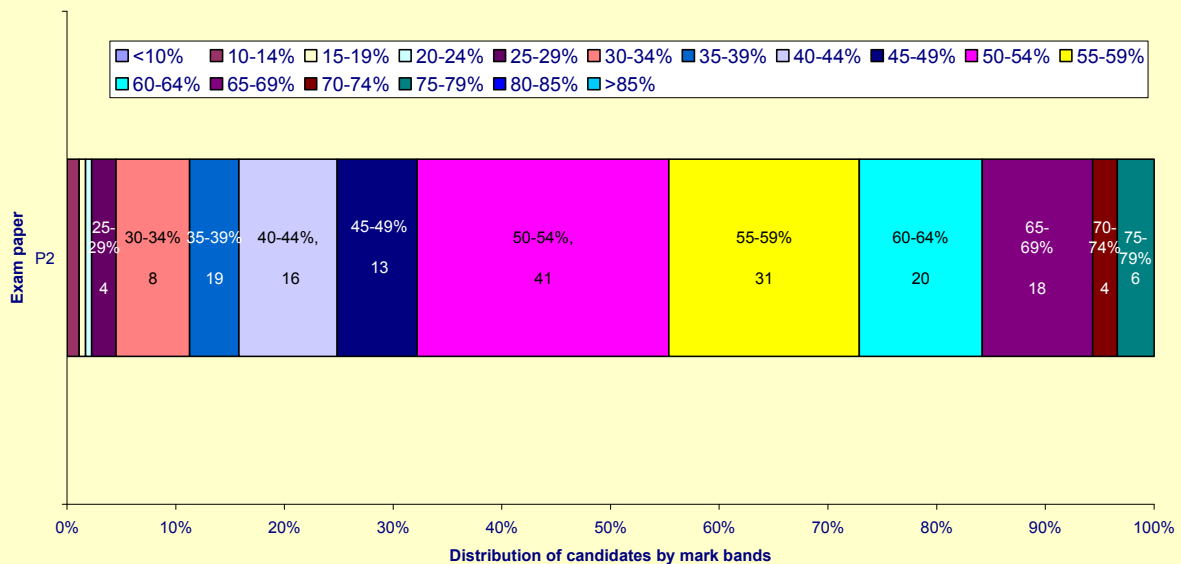
In 2014, the PEB published (**Figure 4**) the distribution of marks for all the candidates who took the FD1 (P2) exam.

Figure 4: The mark distribution of FD1 (P2) exam candidates in 2014



This was the first year PEB has published this information, so we do not whether this mark distribution is typical. But analysis of the marks indicates that, 71, or 40% of all candidates secured marks of between 43 and 55, while 41 candidates (23% of all) were “narrow passes”, with marks of 50 to 54, and 13 (7%) were ‘narrow fails’, with marks of 45 to 49 (see **Figure 5**).

Figure 5: Distribution of Candidates' Marks in 2014 P2 Exam
(177 candidates)



This points to the importance of candidates ensuring that candidates maximise all possible marks available, as one or two marks can make the difference between a pass and a fail.