

PAPER P1 – BASIC UNITED KINGDOM PATENT LAW AND PROCEDURE
SYLLABUS

ELEMENT	SYLLABUS	
Level	JEB Foundation Paper	
Prerequisites	Degree in Science, Engineering, Technology or Mathematics or equivalent, as set out in section 6 of the Regulations.	
Aim	To test knowledge and understanding of UK Patent Law	
Competencies tested	<p>Knowledge and Understanding</p> <p>Has a general knowledge and understanding of the Patents Act 1977, as amended, the Patents Rules as in force and the principles underlying patent law in the United Kingdom.</p> <p><i>Specific knowledge of the European Patent Convention and the Patent Cooperation Treaty is not required for this paper except where they impact on the national law.</i></p>	
Knowledge and understanding of these themes is required for the examination	<ol style="list-style-type: none"> 1. Patentable inventions 2. Right to apply for and obtain a patent, inventorship, ownership and employee rights 3. Making patent applications, their search and examination, amendment and correction of applications 4. Provisions as to patents after grant – term, unity, amendment, restoration 5. Patents as a form of property, compulsory licences, the patent register, securing information about patents, patent applications and inspection of documents 6. Infringement including impact of partial validity, right to continue use, effect of publication, threats, marking 7. Revocation of patents and putting validity in issue 8. Effect of European patents and applications 9. Entering the UK national phase from an international (PCT) application 10. Convention applications 11. Restrictions on publication and making patent applications abroad 12. Leading cases on novelty, obviousness and infringement 13. Interpretation 	
Assessment method and success criteria	<p>Unseen examination lasting 3 hours. The examination paper will comprise a series of questions set out in two parts.</p> <p>The first part (Part A) comprises five questions of which four must be answered. Each question will carry ten marks. These questions will be particularly directed at testing knowledge.</p>	

	<p>The second part (Part B) comprises four questions of which three must be answered. Each question will carry twenty marks. The questions will require knowledge and a demonstration of understanding of the law.</p> <p>Candidates gaining 50% or more of the marks available for the paper will be deemed to have passed the examination.</p>	
Reading List	The CIPA guide to the Patents Acts and supplements (pub. Thomson – Sweet & Maxwell) and cases discussed in the commentary on the aspects of novelty, obviousness and infringement.	

SCOPE OF THEMES

THEME	Legislative Background	Rules
1. Patentable Inventions	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	PR5
2. The right to apply for and obtain a patent, inventors, ownership, employees' rights	PA 7 - Right to apply for and obtain a patent PA 13 - Mention of Inventor PA 36 - Co-ownership of patents and applications for patents 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 and Supplementary	PR10, 11
3. Making patent applications, search, examination, correction and amendment	PA 14 - Making an application PA 15 - Date of filing application PA 15A - Preliminary Examination PA 16 - Publication of application PA 17 - Search PA 18 - Substantive examination and grant or refusal of patent PA 19 - General power to amend PA 76 - Amendments of applications and	PR 12, 15, 16, 103, 104 PR17 to 22 PR 23, 24 PR 26 PR 27 PR28 to 30 PR 31

	<p>patents not to include added matter PA 20 - Failure of application PA 20A - Reinstatement of applications PA 20B - Effect of reinstatement PA 21 - Observations by third parties PA 117 - Correction of errors in patents and applications PA 117A - Effect of resuscitation of a withdrawn application under Section 117 PA 117B - Extension of time limits specified by Comptroller PA 118 – Information about patent applications and patents, and inspection of documents PA 119 - Service by post PA 120 - Hours of business and excluded days Other rules relating to irregularities, time limits and their extension, translations. PA 125 - Extent of invention</p>	<p>PR32 PR33 PR49, 105 PR109 PR 111 PR 50, 107, 108, 110 and 113 to 115</p>
<p>4. Provisions as to patents after grant - term, unity, amendment and restoration</p>	<p>PA 24 - Publication and certificate of grant PA 25 - Term of Patent PA 26 - Patent not to be impugned for lack of unity PA 27 - General power to amend specification after grant PA 75 - 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 28 - Restoration of lapsed patents PA 28A - Effect of order for restoration of patent PA 29 - Surrender of patents</p>	<p>PR36 to 39 PR35 PR35, 73, 75 PR 49, 105 PR 40</p>
<p>5. Patents and patent applications as a form of property, securing information about</p>	<p>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.</p>	<p>PR 103</p>

<p>patents, patent applications and inspection of documents</p>	<p>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</p>	<p>PR 43, 73, 75 PR 43, 73, 75 PR 54</p>
<p>6. Infringement including impact of partial validity, right to continue use, effect of publication, threats, marking</p>	<p>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 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 70 - Remedy for groundless threats of infringement proceedings PA 71 - Declaration as to non-infringement PA74A and 74B Opinions by Patent Office PA 100 – Burden of proof in certain cases PA 110 – Unauthorised claim of patent rights PA 111 – Unauthorised claim that patent has been applied for PA 125 - Extent of invention</p>	<p>PR 92 to 100</p>
<p>7. Revocation of patents and putting validity at issue</p>	<p>PA 72 - Power to revoke patents on application PA 73 - Comptroller's power to revoke patents on his own initiative</p>	<p>PR 73, 75, 87 PR 73, 75</p>

	PA 74 - Proceedings in which validity may be put in issue PA74A and 74B Opinions by Patent Office PA 125 - Extent of invention	PR 92 to 100
8. Effect of European patents and applications	PA 77 - Effect of European patent (UK) PA 78 - Effect of filing and application for a European patent (UK) PA 79 – Operation of PA 78 in relation to certain European patent applications PA 80 - Authentic text of European patent and patent applications	
9. Restrictions on publication and making patent applications abroad	PA 22 – Information prejudicial to national security or safety of the public PA 23 - Restrictions on applications abroad	
10. International applications	PA 89 Effect of international application for patent PA 89A International and national phases of applications PA 89B Adaptation of provisions in relation to international application	
11. Convention applications	PA 5 - Priority Date PA 6 - Disclosure of matter, etc., between earlier and later applications	PR 3 and 6 to 9
12 Interpretation	PA 130 - Interpretation	

PA = Patents Act 1977 as amended and in force at 1st June 2010

PR = Patents Rules 1997 as in force at 1st June 2010