

**Paper P2 - Patent Agents' Practice**

Element	Syllabus
Level	JEB Advanced Paper.
Prerequisites	Either P1 OR Trade Mark Foundation Paper T2 and Common Foundation Papers (OR be exempt from the Common Foundation Papers).
Aim	To test competencies expected of a patent attorney in handling problems met in day to day practice with an emphasis on applied knowledge.
Competencies tested	<p><b>Personal Effectiveness:</b></p> <ul style="list-style-type: none"> <li>· Sees the overall picture.</li> <li>· Assimilates data and information provided to extract the issues.</li> <li>· Generates logical, considered and effective proposals for the way ahead.</li> <li>· Evaluates risk and proposes mitigating actions.</li> <li>· Takes account of impact of proposals on others.</li> <li>· Identifies further information or evidence needed, but where necessary proposes actions on the basis of limited information, including appropriate consideration of the alternatives available.</li> </ul> <p><b>Communicating and Influencing:</b></p> <ul style="list-style-type: none"> <li>· Writes to persuade, advise and inform.</li> <li>· Can produce appropriate written material to suit requirement (e.g. letter, brief, recommendation, statement of facts).</li> <li>· Communication is clear and will be easily understood.</li> </ul> <p><b>Delivering Results:</b></p> <ul style="list-style-type: none"> <li>· Advice reflects client's needs and priorities.</li> <li>· Proposals are based on balanced analysis of information, risks and costs.</li> <li>· Proposals are practicable and achievable.</li> <li>· Recognises and balances resources (e.g. costs/ time/ manpower) involved in options put forward.</li> </ul> <p><b>Knowledge:</b></p> <ul style="list-style-type: none"> <li>· Has a thorough knowledge and understanding of the application of the key aspects of law and practice as will be required by a person advising clients on UK matters.</li> <li>· Can exploit that knowledge in advising clients, and in dealings with the Patent Office, foreign associates and persons from other professions.</li> </ul>

Knowledge required	<ol style="list-style-type: none"><li>1. Forms of Intellectual Property protection available and their limitations.</li><li>2. Patentable inventions.</li><li>3. The right to apply for and obtain a patent, inventorship, ownership and employee relations.</li><li>4. Making patent applications, their search and examination, amendment and correction of applications.</li><li>5. Filing patent applications abroad, patentability and disclosure requirements in EPC, Japan and US.</li><li>6. Provisions as to patents after grant - term, unity, amendment and restoration.</li><li>7. Patents and patent applications as a form of property, the patent register, securing information about patents, patent applications and inspection of documents.</li><li>8. Infringement including impact of partial validity, right to continue use, effect of publication, burden of proof and threats, marking, obtaining information about infringement (including from abroad).</li><li>9. Revocation of patents and putting validity in issue.</li><li>10. European patents (and applications therefor) effective in the UK. The European Patent Convention and Rules in so far as they interact with or inform UK law and practice and/or relate to the validity or revocation of patents effective in the UK.</li><li>11. International applications for patents (PCT) and entering the UK national phase from an international application.</li><li>12. Registered designs effective in the UK – what is protectable, proprietorship, rights given by registration, duration and infringement.</li><li>13. Unregistered design rights effective in the UK; what is protectable, who qualifies for rights, duration and infringement, licences of right.</li><li>14. Convention applications (patents and designs).</li></ol> <p><b>The Annex sets out legislation underlying the above themes.</b></p>
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<p>Assessment method and success criteria</p>	<p>Unseen examination lasting 4 hours. The examination paper will comprise a series of problems set out in two parts.</p> <p>The first part (Part A) comprises about 6 problems each requiring analysis and advice involving law and practice taken from no more than two specific areas of knowledge (listed above). Candidates will be required to write letters, memoranda, and other appropriately responsive material. These problems will be particularly directed at testing the knowledge and communicating competencies.</p> <p>The second part (Part B) comprises three or four problems. Responses to two of these problems will be required. The problems will be longer and wider ranging than those in the first part, will test the range of competencies, and probe a number of different aspects of law and practice.</p> <p>The weighting given to each of Parts A and B is equal. Marks are not given for mere recitation of statutes or regulations. Rather marks are given for applying these to the specific facts or situations of a question, giving options, recommendations or opinions and providing the underlying analysis, as appropriate.</p> <p>Candidates gaining 50 percent or more of the marks available for the paper will be deemed to have passed the examination.</p>
<p>Reading list</p>	<ul style="list-style-type: none"> <li>· The CIPA Guide to the Patents Acts and supplements (pub Thompson - Sweet and Maxwell) including the cases discussed in the commentary on those parts of the Patents Act where thorough knowledge is sought</li> <li>· Russell-Clarke and Howe on Industrial Designs (Thompson - Sweet and Maxwell)</li> <li>· Terrell on the Law of Patents (Sweet and Maxwell)</li> <li>· Community Design Law Principles and Practice – David Musker (Sweet and Maxwell)</li> <li>· Copinger and Skone James on Copyright (Thompson - Sweet and Maxwell)</li> <li>· PCT Applicant's Guide (WIPO) - Including the entries for US and JP</li> <li>· Patent, Trademark and Copyright Law (US) - BNA Books</li> <li>· Blackstone's Statutes on Intellectual Property (Oxford University Press)</li> <li>· Manual for the Handling of Applications for Patents, Designs and Trade Marks throughout the World especially the entries for Patents in Japan and the US.</li> </ul>

**ANNEX - SCOPE OF THEMES**

THEME	Legislative Background	Rules/Forms etc
1. Available forms of industrial protection	Scope of Parts I and III of the Copyright, Designs and Patents Act 1988 (CDPA), the Patents Act 1977 (PA), the Registered Designs Act 1949 (RDA), and the Trade Marks Act 1994, the kinds of protection available and terms, derogation from protection CT Arts 28 to 30 CT Arts 81 and 82 CDPA 51 to 53	
2. 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
3. The right to apply for and obtain a patent, inventors, ownership, employees, resolving issues	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	General procedures in cases of reference to Comptroller: PR 73 to 84 and PR Schedule 3  EPR 14  PR 10 and F7, PR 11
4. Making a patent application, search, examination, 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 patents not to include added matter PA 20 - Failure of application PA 20A - Reinstatement of applications	PR 12, 15, 16, 103, 104, F1 PR 17 to 2 PR 23, 24 PR 26 PR 27, F9A PR 28 to 30, F10  PR 31  PR 32

	<p>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 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>PR 33  PR 49, 105</p> <p>PR 109</p> <p>PR 111</p> <p>PR 50, 107, 108, 110 and 113 to 115</p>
<p>5. Making applications abroad, patentability and disclosure requirements in certain countries</p>	<p>PA 23(1)(a) - Restrictions on applications abroad - the six week rule  35 USC 101 - 103 Patentability in the US, differences in requirements between UK and US, one-year grace period.  35 USC 112 - Specification  35 USC 119 - Benefit of earlier filing (Provisional Application)  EPC Art 52 to 57 Patentability  EPC Art 79 Designation of Contracting States  EPC Art 93 Publication of a European patent application  EPC Art 94 Request for examination [of a European patent]  Japan: know similarities and differences between patentability requirements of UK and JP. Japanese grace period and examination request system.</p>	
<p>6. 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  PA 128B – SPCs  PA Schedule 4A - SPCs</p>	<p>PR 36 to 39</p> <p>PR 35</p> <p>PR 35 and 73 to 84</p> <p>PR 49, 105</p> <p>PR 40</p> <p>PR 42</p>
<p>7. Patents and patent applications as a form of property, securing information</p>	<p>PA 30 - Nature of, and transactions in, patents and applications for patents  PA 32 - Register of patents etc.  PA 33 - Effect of registration</p>	<p>PR 47, 103</p>



	<p>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  PA 77 - Effect of European patent (UK)  PA 78 - Effect of filing an application for a European patent (UK)  PA 79 Operation of s78 to certain EP applications  PA 80 - Authentic text of European patent and patent applications</p>	<p>EPR 70, 70a  EPR 71(3)</p>
11. International Applications	<p>PCT Chapters I and II  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</p>	<p>II PCT Rules 90, 90bis, 91  PR 65 to 70</p>
12. Registered Designs effective in UK	<p>RDA 1 - Registration of designs  RRA 1A - Substantive grounds for refusal of registration  RDA 1B - Requirement for individual character  RDA 1C - Designs dictated by their technical function  RDA 2 - Proprietorship of designs  RDA 3C - Date of registration of designs  RDA 7 - Right given by registration  RDA 7A - Infringements of rights in registered designs  RDA 8 - Duration of registered designs  RDA 11A - Grounds for invalidity of registration.  The equivalent provisions of Council Regulation (EC) No 6/2002 on Community Designs</p>	
13. Unregistered design rights effective in the UK	<p>CDPA 213 - Design right  CDPA 214 - The designer  CDPA 215 - Ownership of design right  CDPA 216 - Duration of design right  CDPA 217 to 220 - Qualification  CPDA 226 to 228 - Infringement  CDPA 236 - Infringement of copyright  CDPA 237 to 239 Licences of Right  The provisions of Council Regulation (EC) No 6/2002 on Community Designs relating to unregistered designs</p>	
14. Convention applications	<p>Paris Convention of 1883 (as amended)  Article 4  PA 5 - Priority Date</p>	<p>PR 6 to 9, F1</p>

	PA 6 - Disclosure of matter, etc., between earlier and later applications RDA 14	
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The following are as amended and in force on 1 June 2010

PA = Patents Acts 1977 to 2004

RDA = Registered Designs Act 1949 (as amended)

PR = Patents Rules 2007

F = Patent Form Number

CDPA = Copyright, Designs and Patents Act 1988

CT = Community Treaty (also known as the Treaty of Amsterdam)

USC = United States Code

EPC = European Patent Convention 2000

EPR = Implementing regulations to the European Patent Convention 2000

PCT = Patent Co-operation Treaty