

Paper P3 - Preparation of Specifications for United Kingdom Patents

<i>Element</i>	Syllabus
<i>Level</i>	JEB Advanced Paper
<i>Prerequisites</i>	Either P1 OR Trade Mark Foundation Paper T2 and Common Foundation Papers (OR be exempt from the Common Foundation Papers).
<i>Aim</i>	To test competencies expected of a patent attorney in preparing United Kingdom patent specifications and patent claims for United Kingdom.
<i>Competencies tested</i>	<p>Personal Effectiveness:</p> <ul style="list-style-type: none"> • Sees the overall picture. • Understands and interprets technical information. • Assimilates and makes use of data, information, themes and ideas. • Recognises inventive concepts. • Analyses an invention for essential and inessential features, and distinguishes features of an invention from those of the prior art. • Drafting, of specification and claims, is of reasonable scope, based on the information available. <p>Communicating and Influencing:</p> <ul style="list-style-type: none"> • Identifies key issues and considers how best to present these in drafting. • Drafting is accurate, clear and will be easily understood. • Drafting claims that are suitable for use as a priority basis in other jurisdictions and for successful prosecution in the UK. <p>Delivering Results</p> <ul style="list-style-type: none"> • Drafting reflects the client's needs and priorities. • Drafting is based on reasonable analysis of information available.

	<ul style="list-style-type: none"> • Drafting meets the requirements of relevant law and good practice. <p>Knowledge</p> <ul style="list-style-type: none"> • Has a thorough knowledge and understanding of the relevant aspects of law and practice relating to patentability in the UK. • Can exploit that knowledge in preparing draft specifications and claims.
<i>Knowledge required</i>	<ol style="list-style-type: none"> 1. Patentable inventions in the UK. 2. Basic understanding of mechanical subject matter. <p>The Annex sets out legislation underlying the above themes.</p>
<i>Assessment method and success criteria</i>	<p>Unseen examination lasting 4 hours.</p> <p>The examination paper will comprise a document (such as a letter from a client) describing a new invention for which patent protection is sought; the invention will be a mechanical problem not requiring specialist technical knowledge. Other documents may be provided which are relevant to the scope of claims that can be drafted, or to the specific description. Information may also be given about issues of concern to the prospective patentee.</p> <p>Candidates will be required to analyse and interpret the information given and:</p> <ol style="list-style-type: none"> a. draft one or more independent claims for use in the UK which are of sufficient breadth to cover the client's interests, containing all essential features, while being arguably novel over the given prior art; b. draft one or more sets of dependent claims for use in the UK to provide suitable fall back positions in

	<p>independent claim(s) fail(s) during prosecution, demonstrating a knowledge of claim hierarchy;</p> <p>c. draft an introduction and specific description for use in the United Kingdom to provide suitable support for the claims and basis for any additional features that may be added during prosecution;</p> <p>d. draft an abstract (if required) for use in the United Kingdom;</p> <p>e. where the proposed claims might lead to unity objections in an application, highlight this;</p> <p>f. if the client has expressed particular wishes, meet these whenever possible, and explain where this is not possible; and</p> <p>g. write a letter (if required) to the client explaining the draft and the selection of claims proposed and dealing with any other practice points that might arise.</p> <p>Candidates gaining 50% or more of the marks available for the paper will be deemed to have passed the examination.</p>
<p><i>Reading list</i></p>	<ul style="list-style-type: none"> • 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 set out in the Annex • Terrell on the Law of Patents (Sweet and Maxwell)

ANNEX A - SCOPE OF THEMES

THEME	Legislative Background
1. Patentable Inventions in the UK	PA 1- Patentable Inventions PA 2- Novelty PA 3 - Inventive Step PA 4 - Industrial Application

PA = Patents Acts 1977 to 2004 (as amended and in force at 1st June 2010)