

Paper P4 - Amendment of Specifications for United Kingdom Patents/Applications in Prosecution, Revocation Proceedings or otherwise.

<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>	<p>To test competencies expected of a patent attorney in preparing amendments of UK patent applications and providing arguments to sustain such amendments.</p> <p>Competencies tested; Personal Effectiveness:</p> <ul style="list-style-type: none"> • Sees the overall picture. • Understands and interprets patents and other technical information. • Assimilates and makes use of data, information, themes and ideas. • Recognizes inventive concepts. • Analyses of an invention for essential and inessential features, and is able to distinguish features of an invention from those of the prior art. • Proposes actions on the basis of the information that has been provided in the question only. <p>Communicating and Influencing:</p> <ul style="list-style-type: none"> • Identifies key issues and considers how best to present these to the benefit of the client. • Writes in a logical, cohesive, and persuasive manner in order to advise and inform the recipient. • Communication is clear and will be easily understood. <p>Delivering Results:</p> <ul style="list-style-type: none"> • Outcomes reflect the client's needs and priorities. • Proposals are based on analysis of evidence and risks. • Proposals are practicable and achievable. • Outcomes comply with relevant legislation and represent good practice with a good appreciation of commercial realities of the situation presented. <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 the amendment of a UK patent application in response to patentability objections. • Can exploit knowledge in preparing amendments and preparing arguments in support of his/her case.

<p><i>Knowledge required</i></p>	<ol style="list-style-type: none"> 1. Patentable inventions 2. Search and examination of patent applications 3. Amendment and correction 4. Convention priority for UK patents <p>The Annex sets out legislation underlying the above themes.</p>
<p>Assessment method and success criteria</p>	<p>Unseen examination lasting 3 hours.</p> <p>The examination paper will comprise a patent application and a paper (such as a letter from a patent examiner) setting out patentability objections to the patent application as it stands (i.e. candidates will not be examined on amendment of granted patents). The paper will be supported by other documents which may be relevant to patentability. Descriptions may also be given of things that have been done or might be done in the future that are of concern to the patent applicant or other interested party.</p> <p>Candidates will be required to analyse general mechanical subject matter not requiring specialist technical knowledge, interpret the information provided and:</p> <ol style="list-style-type: none"> a. prepare an appropriate draft response including replying to objections that are arguable; b. prepare revised claims and other amendments that meet the requirements of the Patents Acts 1977 - 2004, which can be reasonably argued as overcoming the objections and providing the patent applicant with the widest scope of protection possible in the circumstances; c. where the revised claims might lead to unity objections, highlight this by way of a note to the Examiner or letter to the client; d. if the patent applicant has expressed particular wishes, meet these whenever possible; and e. prepare a letter (if required) to the patent applicant explaining the line taken in the proposed draft response and dealing with any other practice points that might be raised by the situation. <p>Candidates gaining 50% or more of the marks available for the paper will be deemed to have passed the examination.</p>

<i>Reading list</i>	<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)
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ANNEX - SCOPE OF THEMES

THEME	Legislative Background
1. Patentable Inventions	PA 1 - Patentable Inventions PA 2 - Novelty PA 3 - Inventive Step PA 4 - Industrial Application
2. Search and examination of patent applications	PA 14 - Making an application PA 15 - Date of filing application PA 15A - Preliminary Examination 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 21 - Observations by third parties PA 117 - Correction of errors in patents and applications PA 125 - Extent of invention
3. Amendment and Correction of patents and applications	PA 27 - General powers to amend 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 125 - Extent of invention
4. Convention applications	PA 5 - Priority Date PA 6 - Disclosure of matter, etc., between earlier and later applications

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