

PAPER PS — BASIC OVERSEAS PATENT LAW AND PROCEDURE

SYLLABUS

<i>Element</i>	Syllabus	
<i>Level</i>	JEB Foundation Paper	
<i>Prerequisites</i>	Degree in Science, Engineering, Technology or Mathematics or equivalent, as set out in section 6 of the Regulations.	
<i>Aim</i>	To test knowledge and understanding of overseas patent law and International Conventions affecting the United Kingdom	
<i>Competencies required</i> <i>Candidates for the examination will be tested on the themes set out below.</i>	<p>Knowledge and Understanding Has a general knowledge and understanding of the Patent Cooperation Treaty (PCT) and the European Patent Convention (EPC), and their rules and procedures, including entering the national or regional phase. The general principles and requirements of the Paris Convention and World Trade Organisation as applied to patents. General knowledge of the national patent laws and procedures in the countries set out below</p> <p>United States of America, Canada, Mexico Japan, China, South Korea, Taiwan, India Hong Kong, Singapore Australia, New Zealand Argentina, Brazil Israel, Saudi Arabia South Africa Germany, France, Netherlands, Italy, Spain, Poland, Norway</p>	
<i>Knowledge and understanding of these themes (which are set out in more detail below) for patents and, where applicable, utility models is required for the examination</i>	<ol style="list-style-type: none"> 1. Patentable inventions 2. Restrictions on making patent applications overseas for UK residents 3. Applying for and obtaining a patent overseas by national application and via the PCT and EPC 4. Entering the national or regional phase from an International (PCT) application 5. Search and examination of International (PCT), European and overseas patent applications 6. Opposition to European patents and opposition, re-examination and revocation of overseas patents, interference proceedings 7. Claiming priority (under the Paris Convention and bilateral treaties) 	

<i>Assessment method and success criteria</i>	<p>Unseen examination lasting 3 hours. The examination paper will comprise six questions of which five must be answered. Each question will carry twenty marks. The questions will require knowledge and a demonstration of understanding of the law and procedure.</p> <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>	<p>The CIPA European Patents Handbook, the European Patent Office (EPO) guidelines, National law relating to the EPC (published by the EPO) the PCT Applicants Guide, the Manual for the Handling of Patents, Designs And Trade Marks Throughout The World (Kluwer, Ed. by Arnold & Siedsma)</p>	

SCOPE OF THEMES

THEME	Content
1. Patentable Inventions	<p>What may be patented Novelty Inventive Step Industrial Application Grace periods for prior disclosures Differences between patents and utility models</p>
2. Restrictions on publication and making patent applications abroad	<p>UKPA 23 - Restrictions on applications abroad</p>
3. Applying for and obtaining a patent or utility model overseas by national applications and via the PCT and EPC	<p>Who may apply Where to file Preparation of descriptions, claims and abstracts Disclosure of best mode for performing an invention Payment of claims fees Procedure on grant National registration procedure</p>
4. Entering the national or regional phase from an international (PCT) application	<p>Time limits for making an application and filing formal documents Provisions for correction or amendment on entering the national or regional phase Translation requirements</p>
5. Search and examination of International (PCT), European	<p>Time limits for requesting search or examination Preparation of response to search reports and official actions Requirements to disclose prior art</p>

<p>and overseas patent applications and utility models</p>	<p>Procedures for correction or amendment of PCT and EPC Terms for reply to official actions Extensions of time Provisions for reinstatement or restoration of lapsed applications</p>
<p>6. Opposition to European patents and opposition, re-examination and revocation of overseas patents and utility models.</p>	<p>Time limits Procedure Who may oppose or bring proceedings Limited to EPO, USA, Japan, Germany</p>
<p>7. Claiming priority (under the Paris Convention and bilateral treaties)</p>	<p>Term for claiming priority Formal requirements</p>

The following are as amended and in force at 1 June 2010:

UKPA = United Kingdom Patents Act 1977

EPC = European Patent Convention 2000

PCT = Patent Co-operation treaty