

Paper P6 – Infringement and Validity of UK 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 advising on UK patent infringement and validity issues. Advice should be based on a knowledge of the legal framework and be appropriate to the facts provided and the client's needs.
<i>Competencies tested</i>	<p>Personal Effectiveness:</p> <ul style="list-style-type: none"> • Sees the overall picture. • Is able to understand and interpret patents and other technical information. • Assimilates data and information provided to extract the issues. • Is able to reach an informed opinion on a finely balanced point. • Is able to use the information available to support the opinion reached. • Proposes actions solely on the basis of the information available in the question. • Identifies further information that may be required for a final opinion. <p>Communicating and Influencing:</p> <ul style="list-style-type: none"> • Identifies key issues and where appropriate the alternative scenario or interpretation. • Communication is clear, advisory, persuasive and informative. <p>Delivering Results:</p> <ul style="list-style-type: none"> • Advice reflects the client's needs and priorities. • Proposals are based on balanced analysis of information, risks and costs. • Proposals are practicable and achievable. <p>Knowledge:</p> <ul style="list-style-type: none"> • Has a thorough knowledge and understanding of the key aspects of law and practice relating to validity and infringement of UK patents. • Can exploit that knowledge in advising clients.

<p><i>Knowledge required</i></p>	<ol style="list-style-type: none"> 1. Patentable inventions. 2. Amendment of patents and patent applications. 3. Infringement including consequences of partial validity, right to continue use, effect of publication, burden of proof. 4. Revocation of Patents and putting validity in issue. <p>The Annex sets out legislation underlying the above themes.</p>
<p><i>Assessment method and success criteria</i></p>	<p>Unseen examination lasting 5 hours.</p> <p>The examination paper will comprise a letter from a client or another document explaining the problem, a patent that is potentially infringed, and no more than four other documents that may be relevant to the infringement and/or validity of the patent being considered; documents may be relevant to more than one aspect of the problem.</p> <p>Candidates are expected to analyse and interpret the information and prepare a memorandum, setting out their opinion on one or more of the following (according the requirements of the situation):</p> <ol style="list-style-type: none"> a. what is a tenable construction of the patent claims, supported by reasoning based on and referring to matter disclosed in the documentation where appropriate; b. whether the alleged infringement(s) do in fact infringe the patent concerned; c. the validity of the claims of the patent concerned in all relevant circumstances; d. the possibility of amending the patent concerned to improve the prospects of enforcement; e. "design around" possibilities to avoid the protection offered by a patent under consideration; f. options available to the client; and g. an indication of further information that might be needed; and an indication only of any other practice points that might be raised by the situation. <p>Candidates gaining 50 percent 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. Amendment of patents and patent applications	PA 19 and 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
3. Infringement	PA 60 - Meaning of Infringement PA 61 - Proceedings for Infringement of patent PA 125 - Extent of invention

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