

## Consultation on simplifying and modernising the examination system for qualifying as a patent attorney

### The Purpose of the Consultation

The Legal Education and Training Review (commissioned by the Solicitors Regulation Authority, the Bar Standards Board and ILEX Professional Standards) has recently been published. IPReg is also overseeing the restructuring of the Patent Examination Board. This has prompted a wider review of the provision of patent examinations and the examined element of the route to qualification generally. This consultation does not cover issues around “in office” supervised training although IPReg will shortly be issuing competency checklists in relation to that “in office” element of training.

### Proposal

- Require all trainee patent attorneys to pass an accredited examined Foundation level course and no longer accredit Foundation level examinations which are provided independently of corresponding accredited courses.
- Withdraw P3 (Drafting) and P4 (Amendment) but require all trainee patent attorneys to take and pass the EQE drafting and amendment papers or the EQE as a whole before entry on the register.

### Confirmations

- If any changes are made following the consultation, there will be proper transition arrangements to ensure current students are not adversely affected.
- Nothing will affect the standard of the examinations and the areas and levels of competencies to be tested by them.
- In relation to the Foundation level examinations, the consultation is seeking views on the provision of accredited examined courses against an examination only system. It would be wrong to infer, however, that IPReg would only support the provision of accredited examined course by academic bodies rather than by a commercial provider or the PEB.
- P2 (Patent Agent Practice) and P6 (Infringement and Validity of Patents) are not the subject of this consultation.

## Background

- The training of patent attorneys is divided into two parts:
  - i. the theoretical background necessary to undertake the job; and
  - ii. the practical skills required to do so.
- The scientific theoretical background is acquired by obtaining a relevant science degree prior to joining the profession. This is then supplemented by the legal theoretical background which is tested at Foundation level.
- The practical skills required to do the job are taught as a result of a period of supervised practice. The most fundamental of these are then tested at Finals level.

## History

- The patent examination system was established in its current form in 1992 with the establishment of the JEB exams comprising Foundation papers and Finals papers. Exemption from the Foundation papers could be achieved by taking and passing the certificate course at Queen Mary. Exemptions from the amendment and drafting papers could be achieved by taking and passing the corresponding European Qualifying Exams.
- When the system was first established roughly half of all trainees took the Foundation papers and half attended the Queen Mary Course. At that time, CIPA and ITMA jointly arranged programmes of lectures to cover the syllabuses of the various Foundation papers. Around 10 or so 1 hour lectures were held for each paper.
- In the early 90's roughly half of the work undertaken by UK patent attorneys involved prosecution of patents before the UKIPO and half involved prosecution before the EPO.<sup>1</sup> Nowadays around 85% of patents in force in the UK are acquired via the EPO and European practice is the mainstay of virtually all patent attorney practices.
- In 2002, Professor Sherr<sup>2</sup> reviewed the then existing education and examination systems and amongst his recommendations and comments were:
  - i. The running and setting of the Foundation level exams should be passed to the Higher Education institutes providing Foundation courses; and
  - ii. Candidates should not be allowed to sit the Finals level examinations until they have at least 2-3 years of practice.

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<sup>1</sup> Comparing numbers of patent applications filed at the UKIPO with the numbers of European patent applications prosecuted by UK attorneys.

<sup>2</sup> A Sherr, Where Science meets Law, November 2002

### Foundation exams

- The proportion of students taking the Foundation exams has decreased over time. Since 2007 only around 20% of students take the Foundation papers, dropping to 16% in 2012 with numbers of students dropping as low as 17 students in 2010

| Year  | Candidates passing P1 | Students joining CIPA | % taking Foundation exams |
|-------|-----------------------|-----------------------|---------------------------|
| 2007  | 21                    | 140                   | 15%                       |
| 2008  | 39                    | 139                   | 39%                       |
| 2009  | 24                    | 102                   | 24%                       |
| 2010  | 17                    | 100                   | 17%                       |
| 2011  | 34                    | 132                   | 26%                       |
| 2012  | 25                    | 153                   | 16%                       |
| Total | 160                   | 757                   | 21%                       |

- Of the 25 students who passed P1 in 2012, 22 were based outside London and 3 were based in London. Most of the students were being trained in attorney firms of 5 or more attorneys with only 1 being trained by a sole practitioner and 1 being in industrial practice.
- The centralised CIPA lectures no longer provide a comprehensive lecture series covering the entirety of the core syllabus in detail and have not done so for a number of years.
- Foundation level courses are run by Queen Mary, Brunel and Bournemouth. Queen Mary is a full time 3 month course; Brunel is a day release course; and Bournemouth is a course based around distance learning.
- All course providers are accredited by QAA and all courses comprise 60 academic credits of training on the subjects covered. 60 credit hours is intended to represent 600 hours of actual learning. In the case of Queen Mary, this consists of 150 hours face to face lecturing/teaching and 450 hours directed learning.

### Costs

- Current costs for attending the Foundation level courses are: Queen Mary £5,500; Bournemouth £4,500; Brunel £2,670.
- The costs for sitting all of the JEB Foundation level exams is £800.
- Many Foundation level candidates attend the JDD revision courses at a cost of £3,480 if attending all the sessions for all of the papers. The JDD course provides approximately 12 hours' worth of teaching per paper.
- Given that most of the current foundation examination candidates are based outside of London, attending the Queen Mary or Brunel courses is unlikely to be practical. However the Bournemouth Course, being a distance learning based course would be and the costs for doing so compared with the costs of sitting the JEB Foundation level exams and attending the JDD courses are broadly the same.

### Concerns over Foundation level examinations

- IPReg has no means of assessing the quality and consistency of the teaching of students taking the Foundation level exams whether in terms of quality of input; hours spent; or content. In contrast IPReg does review the provision of accredited course providers and accredited course providers are themselves fully accredited by the QAA in terms of assessment of teaching provision.
- Combining the provision of both the theoretical learning forming the legal background for a patent attorney with the practical development of the skills necessary to act as a patent attorney blurs the distinctions between the two. Although undoubtedly, practitioners and on-the-job training are best placed to provide the latter, that is not necessarily the case for the former. It is questionable that students taking the Foundation exams get the level of input on the theoretical basis of intellectual property law in addition to the practical input from practitioners which can be confirmed if the two are separated.
- Training for the Foundation level exams is spread amongst a large number of firms and therefore it is difficult for IPReg to undertake any kind of assessment in a rigorous and cost effective manner.
- Unlike the Foundation courses where those providing the teaching set the exams, in the case of the Foundation exams there is no connection between those setting the exams and those undertaking the teaching. This means that the Foundation examination system does not act to provide confirmation that a student has understood a broader taught syllabus to satisfactory level. Rather the examination system only is a test that a student has sufficient knowledge to pass the content of that test. It does not provide an assurance of any wider knowledge.

### Drafting and amendment exams

- The UK drafting and amendment exams are only taken and passed by approximately half of all trainees, with the remainder relying upon the EQE exemptions.
- Every European patent attorney is required to pass the EQE –no exemptions are given for having passed the corresponding UK exam.
- In practice every student looking to qualify as a UK patent attorney will also be looking to qualify as a European patent attorney.
- In contrast to the UK drafting and amendment exams the EQE papers provide a choice between mechanics/electronics papers and a chemistry paper.
- In order to sit the EQEs it is necessary to have trained under the supervision of a European patent attorney for 3 years.
- Although the obligatory 3 year training period does not exist in the case of the UK exams, in practice most trainee patent attorneys do not obtain a UK qualification before obtaining a European qualification because of the length of time necessary to acquire the level of skills necessary for entry onto the register.
- The Swiss national patent attorney qualification system which has only just been set up has adopted the same approach as is being proposed; foregoing the setting of national

drafting and amendment examinations but making the passing of the corresponding European papers an obligatory part of qualification as a Swiss patent attorney.

## **Concerns over drafting and amendment examinations**

- IPReg's fundamental concern over the UK drafting and amendment examinations is that it represents unnecessary duplication of testing.
- Since all UK attorneys are choosing to qualify as European attorneys testing drafting and amendment skills both as part of the EQE and UK qualifications systems means that the same skills are tested twice.
- This is an unnecessary regulatory burden which costs the UK profession approximately £50,000 per year in terms of exam fees alone. This does not include the hidden costs involved in preparing and training candidates for the examinations.

## **Assessment against the regulatory objectives**

### **Protecting and promoting the public interest**

IPReg's primary concern must be that the standards for entry onto the registers are maintained so as to protect the public and maintain the high level of quality of the UK patent profession. Neither of the two proposed changes adversely impacts those standards. The EQEs have long provided a means for trainees to enter the register without taking the UK examinations and roughly half of the trainees qualifying never pass the UK examinations. Although differences in practice exist, UK and European law is harmonised and the same skills are required for drafting and prosecution before both the UKIPO and the European patent office. The Foundation level courses have long provided an alternative to the Foundation level exams. Adopting the proposal will make no change in the standards required for qualification as an attorney.

### **Protecting and promoting the interests of consumers**

It is in the interests of consumers that they can be reassured that their patent attorney has an appropriate theoretical background understanding for the work they are undertaking. The replacement of the Foundation examinations with the taught and examined courses will ensure that IPReg can be satisfied that every attorney has undertaken a minimum amount of training to achieve that aim and does so in a broadly cost neutral manner.

### **Improving access to justice**

The proposals will have no adverse impact on access to justice. The replacement of the Foundation level examinations with accredited courses will have no impact at all on the 80% of students who already attend such courses. Given that the costs of attending the Bournemouth distance learning course is broadly similar to the costs for taking the Foundation level exams and attending a revision course, requiring attendance at such a course will not have any significant impact upon numbers of recruits.

Replacement of the drafting and amendment papers with their European equivalents may delay qualification as a patent attorney for small numbers of students by a few months. However, the delay would not prevent such students from providing services and acting before the UKIPO. Nor is any delay likely to impact on the provision of reserved legal activities. Litigation and advocacy services can only be provided once an attorney has completed an approved litigation course. Normally such courses are only completed after qualification as both a UK and European patent attorney.

#### **Supporting the principles of the rule of law**

No relevant impact.

#### **Encouraging an independent, strong, diverse and effective legal profession**

The imposition of an obligatory theoretical training program for patent attorneys will strengthen the understanding of the law. No adverse impact on the diversity of the profession is expected. By the time that trainees study for or attend an accredited training course, they almost invariably have obtained a training position. The only exceptions to this are a small number of students who take the MSc in Intellectual Property Law course at Queen Mary. However, the proposed amendments would have no impact on such students since the course already exempts such students from attending any other Foundation level course or taking the Foundation level examinations.

#### **Increasing public understanding of the citizen's legal rights and duties**

No relevant impact.

#### **Promoting and maintaining adherence by authorised persons to the professional principles**

No relevant impact.

### **Assessment against the regulatory principles**

#### **Proportionality**

80% of trainee patent attorneys already attend an accredited training course. It is considered that requiring the 25 or so trainees a year who currently do not to attend such a course to do so is a proportionate approach to enabling IPReg to have oversight of their training and ensure that such trainees acquire the theoretical background which forms the basis of their work as patent attorneys. As noted above, it is believed that the costs for doing so are broadly cost neutral. If training for the Foundation level exams were to be retained amongst the firms which currently utilise the Foundation level examination system, oversight of such training would be significantly more intrusive and would not be achieved in a cost effective manner since it would require IPReg to devote resources to investigating such training across a large number of entities.

Replacement of the drafting and amendment examinations with their European equivalents would reduce the regulatory costs to the profession by at least £50,000 per annum. The adverse impacts

are believed to be minimal, at most delaying qualification of a small number of trainees by a few months.

## **Accountability**

This proposed change to the examination system will be the subject of a full public consultation.

## **Consistency**

Requiring attendance at an accredited Foundation level course will enable uniform training standards to be applied. The incorporation of the European drafting and amendment examinations into the national qualification system provides a uniform standard at both levels.

## **Transparency**

The above proposal simplifies the current examination system which is currently a mixture of exemptions and exceptions. If adopted, the requirements for qualification would be:

- Obtaining an appropriate technical scientific background knowledge prior to entry to the profession
- Attendance at an accredited Foundation level course to obtain the theoretical legal background knowledge as a patent attorney
- At least two years' supervised practice under a qualified attorney to acquire the practical skills necessary to practice as a patent attorney
- Confirmation of the most important of those skills by passing the drafting and amendment papers of the EQE and advanced level papers on patent attorney practice and the interpretation and criticism of patents

## **Targeted**

IPReg's concerns over the provision of teaching of the theoretical legal background for patent attorneys is addressed by the proposals as is IPReg's concerns over unnecessary duplication of testing in the UK and European qualifications. The proposal solely addresses those issues and is therefore targeted solely at those problems.

## **Consultation**

**The consultation closes at 5 pm on 17<sup>th</sup> March 2014.**

## **Contact Details**

Please email your response to: Ann Wright, Chief Executive, via

[ipreg@ipreg.org.uk](mailto:ipreg@ipreg.org.uk)

clearly marking the correspondence "Response to Consultation"

## Glossary

**CIPA** - Chartered Institute of Patent Attorneys

**EPO** – European Patent Office – responsible for granting European patents which have effect throughout Europe including the UK

**EQE** - European Qualifying Exam – The examinations required to qualify as a European Patent attorney entitled to practice before the European Patent Office. The EQE comprises the following four papers:

| Paper | Subject    | Content   |
|-------|------------|---|
| A     | Drafting   | The preparation of claims and an introduction for a European patent application   |
| B     | Amendment  | Preparing a response to an official letter from the European patent office to amend a European patent application and place it in order for grant |
| C     | Opposition | Preparing grounds of opposition to the grant of a European patent   |
| D     | Law        | Legal questions on procedural law for practising before the European patent office  |

In order to sit the European Qualifying Exam a candidate must:

- i) Have a science degree;
- ii) Have undertaken 3 years' training under the supervision of a qualified European patent attorney; and
- iii) Have passed the EQE pre-examination which is a multiple choice test testing basic comprehension of European procedural law.

**Finals level examinations** – Advanced level examinations for qualification as a UK registered patent attorney set by the Joint Examination Board. The Finals level examinations comprise the following four papers:

| Paper | Subject               | Content  |
|-------|-----------------------|--|
| P2    | Patent Agent Practice | Tests competencies expected of a patent attorney in handling problems met in day to day practice with an emphasis on applied knowledge |

|     |  |  |
|-----|--|--|
| P3* | Preparation of Specifications for UK Patents | The preparation of claims, an introduction and description for a UK patent application   |
| P4* | Amendment of Specifications for UK Patents   | Preparing a response to an official letter from the UKIPO patent office to amend a UK patent application and place it in order for grant |
| P6  | Infringement and Validity of UK Patents      | Tests competencies expected of a patent attorney in advising on UK patent infringement and validity issues.                              |

\* EQE Paper A (Drafting) and Paper B (Amendment) provide exemptions for passing the corresponding UK papers (papers P3 and P4) as does passing the EQE examination as a whole.

**Foundation level accredited courses** – Courses accredited by IPReg as fulfilling the educational requirements for foundation level education for patent attorneys. Currently accredited courses include:

- Queen Mary, University of London, Certificate in Intellectual Property Law (<http://www.ccls.qmul.ac.uk/courses/certificates/intellectualproperty/index.html>)
- University of Bournemouth Intellectual Property Post Graduate Certificate (<http://courses.bournemouth.ac.uk/courses/postgraduate-degree/intellectual-property/none/438/>)
- Brunel, University of London, Intellectual Property Law Post Graduate Certificate (<http://www.brunel.ac.uk/courses/postgraduate/intellectual-property-law-pgcert>)

**Foundation level examinations** – The examinations set by the Joint Examination Board testing the basic academic knowledge for qualifying as a patent attorney. The foundation level examinations required to qualify as a patent attorney comprise the following five papers:

| Paper | Subject                           | Content  |
|-------|-----------------------------------|--|
| LAW   | Basic English Law                 | General knowledge of the English legal system, Court structures and civil procedure, contract law, tort, personal property and company law                             |
| D & C | Design and Copyright              | Knowledge and understanding of UK designs law and the law of copyright as it applies in the industrial sphere  |
| P1    | Basic UK Patent Law and Procedure | General knowledge and understanding of the Patents Act 1977, as amended, the Patents Rules as in force and the principles underlying patent law in the United Kingdom. |

|    |   |   |
|----|---|---|
| P5 | Basic Overseas Patent Law and Procedure | General knowledge and understanding of the Patent Cooperation Treaty (PCT) and the European Patent Convention (EPC), and their rules and the national laws of selected overseas countries |
| P7 | Principles of Trade Mark Law            | General knowledge of the Trade Marks Act 1994, Community Trade Mark regulation and the basic principles of passing off and associated rules and case law                                  |

**ITMA** – Institute of Trade Mark Attorneys

**JEB** – Joint Examination Board established by CIPA and ITMA to run the examination system for patent attorneys and trade mark attorneys being replaced by the PEB as from 2014

**PEB** – Patent Examination Board established by CIPA as a successor body to the JEB

**UKIPO** – UK Patent Office – responsible for granting patents in the UK