

Response to consultation on simplifying and modernising the examination system for qualifying as a patent attorney

Introduction

The IP Federation represents the views of a significant number of major innovative UK companies in matters concerning intellectual property policy. A list of members is attached. Our member companies are extensively involved with IP in Europe and internationally. Not only do they own considerable numbers of IP rights, but they are affected by the activities and IP rights of competitors. They may be either plaintiffs or defendants in IP related court actions.

The consultation

1. The IP Federation welcomes the opportunity to respond to IPReg's consultation on proposals for simplifying and modernising the examination system for qualification as a patent attorney.
2. Our responses to the specific proposals made by IPReg are set out below. In addition to these specific points, it is observed that the current consultation exercise appears to be unduly restricted in terms of its scope. It does not appear that IPReg has identified or attempted to identify what the overall standard of qualification should be, or whether changes in the perceived importance and use of intellectual property by businesses within the UK require a corresponding change in the standard of qualification of intellectual property professionals such as patent attorneys. It is suggested that changes such as those proposed would be better considered after a wider review of the standards of training and qualification within the UK as a whole. We would further support provision of a clear statement of skills and competency requirements for the training and qualification of patent attorneys within the UK profession.

Proposal regarding Foundation level qualification

3. Our view is that it is beneficial for there to be alternate routes to Foundation qualification other than university courses. All of the University courses are based in the South of England. Such courses may not be attractive, on location and cost grounds at least, to trainees based away from London e.g. in the Midlands/North of England. Such courses may also well not be attractive to new entrants with significant experience of technical work in an industrial context, whom we would wish to encourage to join the profession. We therefore believe it is necessary to have available qualification routes that can be completed with the flexibility that those some way into their career may require to deal with commitments both in and out of work. The proposal to remove the

provision of the Foundation examinations, in effect, runs counter to the recommendations outlined by the Legal Services Board of improving diversity and access to justice.

4. We recognise that a distance-learning type course may well satisfy our perceived need for flexibility of learning. However, we would query whether distance-learning, followed by examination, is any better a certification of knowledge than the examination of a candidate motivated to self-study and capable of passing the same examination.
5. This proposal threatens the UK Regulator's ultimate control of standards governing the UK profession. This is because the UK profession and IPReg will have no effective influence on the University providers, their taught syllabus emphasis, or the examining standards.
6. It is noted that a not insignificant number of trainees (since 2007, around 20% of students) take the Foundation Examinations.

Proposal regarding the withdrawal of P3 and P4

7. We strongly disagree with the proposal to withdraw P3 and P4. In fact, we would prefer for P3 and P4 to be a mandatory component of the qualification as a Chartered Patent Attorney.
8. Qualification as a Chartered Patent Attorney is highly regarded, and we believe that control over the qualification within the UK is essential not only to maintaining the standard of the UK profession but also to the ability of the profession and its regulators to fulfil the objectives of the Legal Services Board in terms of promoting diversity within the legal professions.
9. In terms of professional standards, it should first be noted that the European and UK qualifications fulfil two quite different needs. The European qualification is primarily a qualification to enable practice before the European Patent Office. As a result it does not test a candidate's knowledge of, for example, copyright law, design law, or basic trademark law. Nor does it test a candidate's ability to advise on matters of infringement or entitlement. In contrast, the UK qualification does cover these broader areas of patent law, and intellectual property law more generally. The UK qualification certifies that a Registered Patent Attorney is competent to advise the public on patent matters generally, not merely before one particular regional Office; or on the narrow focus of pre-grant procedure. Thus, despite the two qualifications requiring candidates to successfully pass examinations testing similar skill-sets, there is no reason why it should be expected that the regulatory objectives of one qualification should be fulfilled by success in the examinations for the other.
10. In respect of the Finals papers P3 and P4 and the European Qualifying Examination (EQE) papers A and B, whilst these papers are aimed at testing the same general areas of skill, Papers A and B are quite different in character from papers P3 and P4. The different character of the

exams is a result of the need for papers A and B to be suitable for candidates sitting those exams using a language other than their mother tongue. The result, particularly for Paper A, is that the test becomes one of spotting inventions in either an 'electrical/mechanical' or 'chemical' technical field, followed by piecing together a claim jigsaw-style from selected language within the paper itself. Such an exam does not necessarily test the skills needed for original drafting work, which requires linguistic skill and adeptness not often found in candidates whose education and experience until their entry into the patent attorney profession will in all probability have been focussed almost exclusively on technical subjects, and very rarely found in a candidate's second language. As a result, the skill of original drafting can be tested more thoroughly in a paper where it can be assumed that the candidate has a thorough command of the language of the paper. Similar problems exist with Paper B. It is considered unlikely that Papers A and B will ever be able to be as thorough a test of the core drafting and amendment skill as papers P3 and P4.

11. Moreover, both Papers A and B require the candidate to work in the European style. It is in fact most preferable for many specifications to be drafted in a style suitable for multiple jurisdictions, where some European quirks (such as the two-part claim form) can be at best unnecessary; and where some European practices (e.g. the use of 'means for ...' functional definition) can be extremely limiting. Paper P3 should be able to test better the candidate's ability to draft a specification suitable for multiple jurisdictions. Indeed the public is entitled to expect that a patent specification drafted by a patent attorney will be substantially suitable for filing in key foreign jurisdictions. As a regulatory matter, therefore, we believe that there is a strong case for making papers P3 and P4 mandatory.
12. However, our strongest objection to the proposal to withdraw Papers P3 and P4 is that its implementation would result in the loss of control within the UK over access to the profession, since it would be a prerequisite for potential candidates to satisfy the criteria for sitting the EQE, as well as whatever criteria the UK profession chose to maintain. It is our view that the impact of this loss of control would severely damage IPReg's ability to support the Legal Service Board's regulatory objective to encourage a strong, independent, diverse and effective legal profession.
13. A diverse legal profession, as defined by the Legal Services Board, (see their [regulatory objectives](#) document, in particular paragraph 43) '*is one that reflects and is representative of the full spectrum of the population it serves so as to harness the broadest possible range of talent in the meeting of the regulatory objectives*'. Approved regulators should '*promote equality and diversity through [their] regulatory framework*', in particular '*ensuring that there are no artificial barriers or discriminatory hurdles to legal careers caused by regulation*'.
14. The abolishing of papers P3 and P4, making it instead a requirement for candidates to pass the corresponding European papers, results in the

additional burden for potential entrants to the UK patent attorney profession to satisfy the criteria for the European qualification, over which IPReg has no control and limited influence. Thus the implementation of the proposal would effectively remove IPReg's regulatory control over entrance into the patent attorney profession in the UK, and thus would also remove a substantial element of its power to encourage diversity within the patent attorney profession. By handing over sovereignty for the examination of drafting and amendment skills to the European Patent Office, IPReg is further denying itself the right to withdraw any exemption, and will have no control over the content or quality of the European Qualifying Examinations.

15. Were the prerequisites for candidacy for the EQE identical to those for the UK exams, of itself this may seem a largely academic concern. However, whilst the prerequisites for candidacy for the EQE are similar to those for the UK examinations, they are not identical. In particular, whilst both require a candidate to have knowledge of a technical field up to degree level, with certain exceptions, in the UK, the requirement for degree-level knowledge is subject to exemption through demonstration that a candidate has gained an equivalent level of knowledge through experience of technical work. This can of course be demonstrated with a CV in combination with appropriate references, for example, with discretion being exercised by a suitable regulatory authority under the guidance of IPReg. Such a system enables those with substantive experience of technical work in a commercial environment to join the patent attorney profession.
16. In relation to the EQE, however, the assessment of whether or not a candidate has the appropriate level of technical knowledge is more rigid, and lacks the flexibility necessitated by the objective to encourage a diverse profession. The EQE has a very stringent requirement for a set period of experience before examinations can be taken. The proposal to make papers A and B a mandatory part of qualification as a patent attorney in England and Wales will reintroduce a three year pre-qualification practice requirement to the UK, via the back door. There is also a need for a STEM degree, as explained further below, for entry to the EQE which will reintroduce this requirement to the UK profession and entry to the register of patent attorneys in England and Wales. In the event that a new entrant does not have a recognised technical degree, the only way in which it is possible to demonstrate the appropriate level of technical knowledge is through obtaining ten years of experience of European patent work under the supervision of a European patent attorney. Such work is unlikely to be attractive to a person who, having taken, for example, a vocational route into an engineering career, and gained substantial technical experience over many years, wishes to enter the patent attorney profession. Yet candidates with real experience of science, technology and engineering within a commercial context, and to a suitable level, are extremely valuable to the patent attorney profession, regardless of whether or not they have an academic degree, since they bring with them a degree of commercial awareness not found in the very recent graduates who tend to form the majority of private practice entrants to the profession. Such candidates may be particularly valuable

to in-house departments, where staff from within a company's own technical function may be ideally suited to train as patent attorneys in the in-house department. The requirement for an academic degree, or to spend a further ten years working effectively as an apprentice is, in those circumstances, an artificial barrier and a discriminatory hurdle that is created solely by a regulatory system lacking appropriate discretion.

17. It is further noted that IPReg does not appear to have any influence on the prerequisites for sitting the EQE. Thus, should further requirements be imposed on potential candidates for the EQE, resulting quite possibly in further diversity damaging measures, IPReg would be left with no means to fulfil its regulatory objective to encourage a diverse profession. It is to be emphasised that such concerns are not merely theoretical. There is a clear direction of travel towards the imposition of further prerequisites prior to candidates being able to sit the EQE, demonstrated not only by the creation of the preliminary Paper D, but also the relatively recent debate as to whether a masters-level degree should be a prerequisite for candidacy for the EQE.
18. The consultation document suggests that national patents are becoming less important, referring to statistics relevant to the past 20 years or so, in which case it may perhaps be argued that regulation of the UK profession separate to the European system is, in the areas tested by papers P3 and P4, regardless of the objective, a fruitless pursuit, since the ability to represent clients before the European Patent Office is almost essential to any practising patent attorney. However, it is noted firstly that there is currently active discussion about the presently increasing rate of filing of UK national patent applications at the UK IPO, perhaps due either to the new Patent Box tax regime (which encourages the filing of cheaper UK patent applications that are more likely to reach grant quickly) or fear of the looming unitary patent system. European practice may become a lesser part of the profession's work in the near future.
19. Moreover, it remains possible for employees to represent their employers before the European Patent Office. For in-house patent attorneys, therefore, the UK qualification alone may suffice on a practical level; it provides the restricted "patent attorney" title and results in the employer gaining the benefit of legal privilege in respect of professional communications made by those attorneys. It is suggested that the regulatory system within the UK should not put such in-house departments at a disadvantage.

Conclusion

20. We believe that the proposal to abandon the Foundation Level examinations is misguided. We strongly object to the proposal to abolish papers P3 and P4. Implementation of either of these proposals, it is believed, may have a serious impact on diversity within the UK patent attorney profession; and, in the case of the abolishing of P3 and P4, we have a specific and, as far as we are aware, as yet unaddressed concern that

IPReg would be removing crucial elements of its ability to fulfil its own regulatory objectives.

21. We encourage IPReg to withdraw these proposals, and instead review the qualification system within the UK in a holistic manner, defining firstly the purposes of the UK qualification to enable potential future changes to be made that are consistent with the needs of the public, the needs of the profession, and indeed IPReg's own objectives as defined by the Legal Services Board.
22. We strongly urge IPReg to reconsider the proposed minimum time service before qualification and the proposed STEM degree requirement. We further support provision of a clear statement of skills and competency requirements for the training and qualification of patent attorneys within the profession.

IP Federation
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IP Federation members 2014

The IP Federation represents the views of UK industry in both IPR policy and practice matters within the EU, the UK and internationally. Its membership comprises the innovative and influential companies listed below. Its Council also includes representatives of the CBI, and its meetings are attended by IP specialists from three leading law firms. It is listed on the joint Transparency Register of the European Parliament and the Commission with identity No. 83549331760-12.

AGCO Ltd
Airbus
ARM Ltd
AstraZeneca plc
Babcock International Ltd
BAE Systems plc
BP p.l.c.
British Telecommunications plc
British-American Tobacco Co Ltd
BTG plc
Caterpillar U.K. Ltd
Dyson Technology Ltd
Element Six Ltd
Eli Lilly & Co Ltd
ExxonMobil Chemical Europe Inc.
Ford of Europe
Fujitsu Services Ltd
GE Healthcare
GKN plc
GlaxoSmithKline plc
Glory Global Solutions
Hewlett-Packard Ltd
IBM UK Ltd
Infineum UK Ltd
Johnson Matthey PLC
Merck Sharp & Dohme Ltd
Microsoft Limited
Nokia UK Ltd
Pfizer Ltd
Philips Electronics UK Ltd
Pilkington Group Ltd
Procter & Gamble Ltd
Renishaw plc
Rolls-Royce plc
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UCB Pharma plc
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