

Introduction

The question concerned a casing for an outdoor display with some fairly close prior art, inviting candidates to restrict the scope of the application in a way, out of a number of possibilities, that seemed to accord best with the client's intentions. On the whole, candidates chose sensible amendments, though in many cases supporting arguments were weaker and explanatory notes weaker still, possibly because of insufficient time left for this section, worth nearly a third of the marks. In the Examiners' view there were two main possibilities for amendment, namely the anti-reflective sheet and the box construction, the former according better with the client's immediate aims.

Claim 1

High marks were awarded for fairly simple amendments to claim 1 that introduced an anti-reflective sheet into the construction between the aperture panel and the screen – it was considered that merely mentioning such a sheet without specifying its location was too broad in being (a) vulnerable to an inventive-step attack using D2 and (b) possibly not supported by the disclosure. The better solutions to the clarity point specified simply that the LEDs were aligned with the holes 'in the assembled state' (as page 5) or 'in use': merely deleting the offending clauses both removed from the claim its functional aspect and, again, possibly rendered it vulnerable to an objection of added subject-matter.

If, as thought preferable, the anti-reflective sheet 5 is introduced into the claim, care needed to be taken. In the first place, it could be defined broadly, along the lines of 'a sheet with anti-reflective capabilities [or similar]', as per page 7 line 9, or a narrower amendment limiting to a sheet with an anti-reflection coating, as page 5 line 25. The former course is likely to be harder to defend, as D2 has a sheet with anti-reflective properties, namely the window 28, used for a broadly similar purpose, while the latter course seems safer against the prior art while still covering the client's main interest. Note that the mere inclusion of claim 5 into claim 1 does not cover either of these possibilities. Care also needs to be taken not to specify a combination not disclosed, e.g. a translucent sheet with an anti-reflection coating.

Specifying that the anti-reflective sheet 5 is flat (or of uniform thickness) was thought to be a useful feature, offering as it does a further distinction over D1, but perhaps not needed in claim 1, at least if the 'anti-reflection coating' option was chosen.

Specifying that each row of openings 8, or holes 4, has a fin above it may provide an additional distinction over D2 which if anything has one fin on each lamp acting as a light shield, such an additional distinction may be unnecessary since there are stronger novelty arguments, but the additional inclusion is probably harmless (see under novelty below). Some candidates, however, amended the claim in such a way as to exclude the client's alternative single-slit version.

If, despite the client's comments at the end of his second paragraph, the box-like nature of the casing is taken as the distinguishing feature, some marks were certainly awarded for this, as it does seem to be new against the cited documents, but care needed to be taken in

defining how the front plate assembly fits to or in the box 2, and probably the side walls 3a of the plate should be included so that the full solid sealing construction results.

In terms of covering the single-slit option, amendments to claim 1 in this direction were thought unsafe (see below).

Dependent claims

Candidates who opted for the preferred amendment to claim 1 also generally, and correctly, adjusted claim 5 accordingly. Many candidates also picked up that claim 4 is probably best amended to change 'plate' to 'screen' to correspond to claim 1. Quite a number of candidates, added no dependent claims, even though there was considerable scope for this, and indeed thirteen marks available.

Useful distinctive features not already present in the claims include: the flatness of the sheet 5, as noted above; further details of the construction of the sheet (particularly if the broader option was chosen in claim 1); including the plate 5 in the modular construction of claim 4; the upstanding edges of the plate 3 and the ledge in the side walls of the box; and the claim to the display assembly including the casing, and to the removable property of the circuit board with the LEDs.

The latter, and perhaps the sidewall/side-plate construction, might be sufficiently distinctive to merit a divisional application, but provided they were included in dependent claims no additional marks were envisaged for such a divisional.

It did not appear to the examiners that there is a need for a claim to a kit of parts. Manufacturers might assemble a display using the casing, but this is adequately covered by the claims to the casing itself. A claim to a completed display was expected, as there is support for it (e.g. page 4) and it increases the chances of a valid claim surviving in the event of further attack on the patent when granted – and also, of course, because the client is herself intending to sell displays.

The wording of the claim to a complete display was not always good. In the first place, such a claim needed to refer to a display assembly or similar, rather than continue the 'casing' claims. In the second place, the claim should specify the combination of casing and circuit board with light-emitting elements, or similar, since otherwise it is not a claim to a display. It is also thought advisable to tie up the aligned light-emitting elements thus introduced to those already mentioned in claim 1.

Finally, even though the matter will disappear from future papers, the omnibus claim might be usefully discussed. It was not thought necessary to amend this claim, since all the drawings show some aspect of the embodiment described (and in any event the claim only refers to a casing 'as described'); but an omnibus claim to a display appears somewhat of a stretch, since no display is shown and hardly any characteristics are described apart from the casing.

As a matter of exam technique, if candidates are not inclined to use the spare set of claims provided, it would be a courtesy if – as some did – they could indicate on their written-out claim 1 the amendments made, e.g. by underlining.

Response

In general, the first part of the response, i.e. describing the amendments made and demonstrating their basis, was handled well enough. Good marks could be ensured by:

- referring for support, where possible, to the general description of the invention (e.g. page 5 line 25), rather than just the specific description of the embodiment (page 7 lines 5-10);
- taking care when the amendment is a selection from various possibilities (e.g. justifying a restriction to coated transparent sheets) or a single aspect of a complex whole (e.g. the removable assembly of page 8 line 16 as opposed to merely a screw connection, done well by some candidates).

In the Novelty arguments, it is better to expand the bare (if true) statement such as 'Document D1 does not show X' by demonstrating that feature X1, which D1 does have, cannot be considered to be an X; this has a better chance of forestalling a follow-up objection by the Examiner. It is also advisable to point out all distinctions between claim 1 and the prior art, rather than merely to find one and leave it at that. For instance, as regards D1, doubt can usefully be cast on the Examiner's assumption that a box-like body must be present somewhere, before proceeding to further distinctions – such a body might not be closed at the front by the plate, for instance. Some statement is expected that the lens sheet of D1 is not specifically 'anti-reflective'.

Particularly in discussing D2 there are several points to be brought out, not least that the window 28 appears to be continuous, i.e. to have no openings, so there is no 'screen' as claimed (nor indeed is there any 'screen' at all if the window 28 is taken to be the 'transparent sheet' as in the preferred amended claim). Many candidates made the point that there is only a single light shield ('fin') per lamp in D2, rather than a 'plurality', and the possibility should also be considered (if only to be dismissed) that the two lamps 21, 22 of D2 could be deemed to be one unit, or one casing, in which case there is a 'plurality' of fins.

In arguing inventive step most candidates set out their arguments in a reasonably well-ordered fashion. If the Pozzoli approach was used, more care could be taken in setting out what the CGK could reasonably be taken to be, rather than assuming without justification, say, that it included both D1 and D2 (particularly as the client was obviously not aware of D1). The introduction of the application itself on page 4 might be a reasonable assumption for the skilled person's background. Certainly in real life one should be circumspect about admissions as to what constitutes common general knowledge.

Most candidates rightly argued that even if some kind of 'anti-reflective' sheet were to be incorporated in D1, major changes would have to be made, either by replacing the lens sheet with such a sheet, or by adding one. Here the answers that did not specify the location of the anti-reflective sheet had a harder time, though many such included a dependent claim with this detail. Many bold assertions were made to the effect that because D1 said that the lens sheet should be 'as transparent as possible' (page 14), this led the skilled person away from incorporating a 'sheet with anti-reflective properties'. No marks were deducted for such a statement, of dubious validity as far as, say, coated

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transparent sheets are concerned, though the statement does lead away from the specific measure used in D2.

As to the clarity point, some candidates described the problem as being that the existing claim does not state clearly enough that the light-emitting elements are not included in the claim (a 'problem' that some solved by deleting the reference altogether). The real difficulty is that the claimed casing does not in fact include these elements, so any statement made in the claim about them is not clear unless restricted to configurations where the light-emitting elements are indeed present.

Report [*Notes for client advice*]

Most candidates made a reasonable fist of explaining what had been done in the response, and why that line had been chosen and others rejected, or reserved for later if needed. In many cases the explanation was rather sketchy, possibly through lack of time, and in some cases time was wasted reiterating the arguments in defence of the patentability of the claims that had already been made in the response, though some view of their likely success keeps the client informed.

Most candidates addressed the client's point about the single-slit version of the screen, and usually explained that it was not possible to add material explicitly describing the new configuration. Not all dealt adequately with whether existing claim 1 covered the version, so that, if it did, no action was necessary.

Most candidates discussed the possibility of a divisional application, say to the sealed box-like construction, even if only as a long shot unlikely to be of great interest to the client. Some candidates suggested a divisional to a display assembly including the casing claimed in the parent application, which is surely unnecessary.

A new application to the single-slit variant is implausible, as the existing application is almost certainly published, being a 2013 application, to judge from the application number, and would be available for inventive-step objections. A divisional application, as suggested by a few candidates, is impossible.

And for this year's word we have nothing to report, except for the perennial 'preceeding', the correct spelling of which some candidates might wish to check.