

Introduction

Part of the test with FD2 is invention-spotting and then preparing a set of claims that maximises the scope of protection, bearing the given state of the art in mind. The claims also need to be fully supported by the specification.

This year's paper really separated out the candidates who understand how to craft a set of claims of suitable scope and those who do not. The Examiners felt that some candidates were either a long way from being equipped with the necessary skills to pass or simply did not take enough time to consider how to get the best scope of protection for the client. Drafting is one of the core skills that separates patent attorneys from others in the IP profession. As a result, passing competent candidates, as well as those who demonstrate that they understand what is required but do not necessarily get the claims spot on, is of paramount importance to the Examiners.

For the avoidance of doubt, the text that is provided includes all the language and terminology that the Examiners expect to see in the claims and candidates are advised to use this rather than trying to make up their own terms to describe the invention

Lack of time did not seem to be an issue for the majority of candidates this year, considering the amount of information supplied. Some candidates appeared to only understand the invention while writing up the Specific Description, leading to the late inclusion of independent claims, which had little or no basis in the Description they had just written, or otherwise lacked unity with their original independent claims.

The invention

The invention described was an insert for a machine tool bed and a mount for a machine tool bed. The invention also encompassed a kit of parts comprising the insert and the mount.

Main claim

The Examiners expected the insert and the mount to be claimed separately to maximise the scope of protection. 'Plug-and-socket' types of claims should be easily within the capability of candidates from all technical backgrounds and such claims require no specific legal or technical knowledge. It was still certainly possible to pass if candidates included a single claim to both an insert and a mount, however it was much harder as, for example, no kit of parts claim is then relevant.

No marks were allocated (or awarded) for an independent method claim unless candidates constructed a claim directed to a novel method of attachment. Otherwise, the method claim simply recites the features of the apparatus claims and the Examiners believed greater value was to be had through apparatus claims.

Dependent claims

The paper set out a clearly identifiable list of optional features which most candidates spotted. Candidates are cautioned against using method language for apparatus features because such language can impart a lack of clarity to a claim. Candidates are also recommended to take their time to identify correct dependencies, particularly if they have more than one independent claim.

Marks were not awarded for a dependent claim to specific dimensions: if such a feature needs to be included in an independent claim during prosecution, the invention probably has little to distinguish it from the prior art. As a result, such a dependent claim adds little value.

Introduction and background

A concise title related to what has been claimed as the invention, followed by a credible description of the field of invention, is expected. The field of invention shouldn't be a mere recitation of an overly detailed title, or indeed, just the title itself. Too many candidates know that a title and field are necessary but do not know their purpose which often shows in the answer provided. Candidates should be familiar with the Patents Rules, which will guide them to something of merit in both these essentials.

The paper provided a lot of background information, mainly to assist candidates who do not deal with mechanical inventions on a day-to-day basis, and candidates were credited for using all or a credible selection of the information provided. A description of at least Figure 2 (which showed the prior art) was also expected in this part of the specification.

Statements of invention

Candidates are reminded that the role of the statements of invention is to provide support for inventive step arguments during prosecution. As a result, marks are awarded for providing a) a description of what the claimed features does and b) a credible explanation of why the inclusion of such a feature is advantageous. Many candidates seem to struggle to explain why the addition of an optional feature is advantageous: marks are not given for vague statements such as 'it is cheap to manufacture' because

such a statement is unlikely to support an inventive step argument during prosecution. If no credible advantage is available, inclusion of the feature should be questioned.

Statements of invention to provide basis for other possible and plausible independent claims (e.g. method claims) were awarded bonus marks.

The figures were generally well described this year. A surprising number of candidates chose not to use Figure 1 and/or Figure 2. In practice, one is advised to use as much of the information provided by a client as possible. It is suggested that exam candidates should do likewise, although there are no penalties for omission of some figures if this does not detract from the description of the invention.

Specific description

The specific description was generally well constructed this year. Marks were awarded for describing i) the insert, ii) the mount, iii) how the insert works, iv) how the mount works, and v) how the mount and insert co-operate.

Candidates are reminded that a specific description needs to be specific: description of a feature as 'possibly having' or 'may have' is not appropriate for this section of the specification.

Abstract

This section was generally well done with candidates providing a title that matches the one given at the top of the specification. Marks were generally lost for failure to include a statement of the field and/or reference numerals. The Examiners were pleased to note most candidates did include an abstract this year, which meant there was a chance of getting the marks available.