

Introduction

The background to this year's paper was, on the face of it, simple. The patent proprietor has a patent and a competitor has launched a competing product which has drastically reduced sales in a short period of time. In the circumstances the candidate's task was to provide solutions to help the Proprietor, so far as possible.

The underlying technology was simple – paper envelopes provided with tamper evident means to show if an attempt had been made to open the envelopes. Candidates did not appear to have any more difficulty than usual in understanding the concepts. It was considered that no specialist technical information was required to understand the documents

The patent itself was a short document with a single independent Claim and five dependent Claims. The dependent Claims were short and only one (Claim 3) had multiple dependencies.

This year there was a single potentially infringing article – the No-Peek Envelope. The envelope was described in a very short press release and was confirmed in the client's letter as being the potentially infringing article.

As previously, there were two pieces of patent prior art to consider (Documents C and D). Document C did contain two embodiments (a cardboard envelope and a paper envelope) and this was spotted by the candidates which achieved the higher marks. Document D described a single embodiment. It was believed that the prior art documents clearly set out the points of interest.

Whilst some of the feedback received from candidates stated that the exam is 'time pressured' there seemed little evidence that candidates failed to provide their thoughts on each section of the paper.

The paper allowed the best candidates to demonstrate that they were able to understand the salient points, apply a consistent thought process and provide sound advice to help satisfy the client's aims.

As last year, it appears to the examiners that many candidates were either taking the exam without adequate preparation, too early, or both. These candidates clearly did not meet the requirements of the assessment criteria.

As before, candidates are reminded that if they do not attempt all of the sections, or if they provide a cursory attempt on, say, inventive step, they are unlikely to meet the assessment criteria and pass the paper.

Whilst the overall standard of handwriting was generally satisfactory this year, candidates are again reminded that it is difficult to award marks if the answer script is not clearly written and legible. It is often easier to mark scripts where candidates write on alternate lines and clearly space the answers provided.

Construction

The patent to be construed was a recently granted UK patent with a single independent Claim and five dependent Claims.

Candidates are again reminded that the Construction section is the forum for candidates to explain what each of the important terms in the Claim actually mean in the context of the patent – it is not an opportunity to re-state the claimed features in alternate language. Basis for the construction arrived at should be provided from the materials available.

The key to construction of Claim 1 was in relation to the word 'lightweight'. The specification gave a clear and unequivocal definition of what was meant by 'lightweight' (paper having a basis weight of 80gsm or less). Moreover, the client's letter only contained a reference to "...our lightweight envelopes" and "...our paper envelopes" clearly hinting that the specific basis weight was of importance.

That said, most candidates saw the relevant passage about lightweight and the somewhat contradictory passages about cardboard and paperboard and came to a view about the term 'lightweight' – either it meant something (80gsm or less) or it meant nothing (based on the disclosure of Claim 6).

Some candidates referred to the 'repercussive effect of Claim 6' and then construed lightweight in Claim 1 as meaning 'paper, paperboard or cardboard'. This appeared illogical as it had the effect of making Claim 6 irrelevant (which ignoring 'lightweight' they had sought to remedy).

The examiner's unanimously preferred the interpretation that lightweight had the specific meaning set out in the patent. Candidates who took the latter view were not penalised as long as the supporting argumentation was cogent and defensible. Indeed, some of the scripts with the highest overall marks took the approach that 'lightweight' did not have the definition set out in the patent.

On the whole, the construction of what 'tamper evident means' (TEM) meant was handled reasonably, although some candidates failed to consider what irreversible meant in context.

On the whole, candidates scored reasonably well on this section.

Claim 2 was handled reasonably well although surprisingly few candidates considered properly what was meant by 'a pair' (two shoes are not necessarily a pair!).

Claim 3 was addressed fairly well on the whole. It required candidates to think about what parts of the envelope formed the TEM (*e.g.* the perforated line in isolation from the slits).

The best candidates saw the lack of antecedence of 'continuous slits' due to the dependencies in Claim 4 and the potential error in relation to 'flap portion/pouch portion'. Construction of the Claim required candidates to consider the terms 'lines of weakness' and 'major portions' and to consider their position and function.

Claim 5 had similar challenges to Claim 4. On the whole it was construed satisfactorily.

In the examiner's view candidates should have stated that Claim 6 was not needed and should be deleted (based on a construction of Claim 1). Candidates which took a different view over Claim 1 were able to obtain marks here. Again, this depended on candidates ensuring that Claim 1 meant something other than the materials specified in Claim 6.

Infringement

Sales of the No-Peek envelope were ongoing and so infringement (if any were to be found) was ongoing.

Document B does not mention a specific grade of paper used in the No-Peek envelope, although it does mention 'lighter grades' for clients which send lots of mail, clearly inferring that at least some of the activities of Envelopes-4-U will infringe. Even if it was not possible to definitively state if there was infringement, a balanced conclusion together with the suggestion of checking an actual envelope was what the examiner's required.

Candidates who did not construe the term lightweight as meaning ≤ 80 gsm found little trouble in finding that Claim 1 is infringed. Many candidates seemed to find difficulty in determining whether or not the adhesive was present at both edges and on the flap portion.

On the whole the infringement section appeared to present little difficulty to candidates. Some candidates did not achieve the marks that they might have because they simply indicated by a cross or a tick if the particular integers were present. It is essential that candidates both indicate that a feature is shown in the infringement and say where it is in the document.

This year there were relatively few marks available for infringement (14) indicating the simplicity of the analysis required.

Candidates are reminded that points are available for stating conclusions (whether in each section or at the end of the paper) and these should not be missed.

It was expected that Claims 1, 2, 5, 6 would be found to be infringed.

Novelty

There were two patent documents to be considered, a US patent (Document C) and a translation of an old French patent (Document D). Although Document C was a longer document it was not thought that it was of a complexity which would unduly challenge candidates.

Document C did disclose paper and cardboard materials for envelope construction, although no specific basis weights were given. On balance the examiner's preferred the view that this feature was not disclosed in Document C.

The other features of Claim 1 were all disclosed in Document C. Most candidates were able to point to the correct parts of Document C to demonstrate that features were taught. Some candidates failed to set out where the feature was taught - it is difficult to award a point for a cross or a tick without a supporting statement!

Claim D did not mention materials or basis weights. On balance, the examiner's preferred the view that Document D did not disclose the features of Claim 1. Finding that the other features of Claim 1 were present in Document D appeared to present little problem, although there were some candidates which appeared to confuse the frangible portions 10 with the TEM.

In conclusion the examiners considered that neither Document C nor D disclosed the features of Claim 1, although marks were awarded where candidates were able to apply their construction in an a clear, cogent and non-contradictory fashion.

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Claim 2 required a degree of application with regards Document C as it required candidates to determine what was a slit, what was a pair, and apply their construction appropriately to the teaching of Document C. As always, the examiners were looking for consistency of analysis and application.

The examiners considered that Claim 2 was not anticipated by either documents, although candidates which were able to apply their construction to the elongate portions of the frangible parts of Document C were able to gain marks if the analysis was appropriate.

Claim 3 was also considered to be novel over documents C and D, either by dependence or based on the construction applied.

Claim 4 appeared to pose little problem to most candidates.

Claims 5 and 6 similarly appeared to pose little difficulties.

The examiner's preferred position was that all of the Claims were novel. However (and at risk of repetition) candidates which arrived at different, appropriately supported, answers were awarded marks.

Inventive Step

There were 20 marks available for inventive step this year (a similar amount to last year). Candidates must be able to provide a coherent and appropriate analysis of inventive step to satisfy the paper in this regard. Unfortunately, and as with many (if not all) previous years, many candidates again failed to demonstrate that they were able to do so. In practice, an analysis of inventive step is key to most validity questions and candidates should be prepared and able to consider inventive step in an exam setting.

As in previous years, the candidates who gave a good or reasonable account of themselves in this section were those that tended to meet the assessment criteria and pass the paper.

The starting point for an inventive step analysis is a clear statement of the test to be applied. That should not be a task which is beyond candidates!

The skilled person appeared to exist in the field of envelopes (rather than paper products *per se*) - this did not appear to be controversial. There was an opportunity to discuss if the field related to envelopes *per se* or tamper evident envelopes (which may have had a bearing on the common general knowledge (CGK)). It was also possible to discuss if the skilled person was a team (*e.g.* as in the infringement - envelope specialists and glue specialists) or was a single person.

In terms of the CGK some discussion of whether envelopes which are two-a-penny all over Europe represent the CGK and whether document C itself was CGK (the client's letter implies that patent documents do not form part of the CGK).

Taking document C as the closest prior art, the question to ask with respect to Claim 1 was whether or not it would have been obvious from the CGK to make a 'lightweight' envelope. This drew in the bone of contention about the field of endeavour. If the field was tamper evident envelopes the CGK (assuming the skilled person would know about European envelopes) is only taught cardboard TEM envelopes. As the balance of Document C is directed towards the cardboard embodiment it may well have been inventive to use a lightweight material. In contrast, if the field of endeavour was envelopes *per se* it is well known to make them out of all basis weights and the choice, as set out in the Patent, would have been obvious.

Examiner's Report 2016 FD4 – Infringement and Validity

The examiners were looking for a clear exposition of these ideas.

Interestingly, and as a lesson to all candidates, in one of the best-answered sections on inventive step the candidate had construed 'lightweight' in Claim 1 as having the broad rather than the restrictive meaning and then discussed inventive step "...on the basis that I am incorrect on my construction of the term lightweight in Claim 1..." and then provided a well-considered inventive step analysis.

The examiners do not consider this to be 'hedging your bets' rather it is providing a fall-back position should the principal point of construction go against you. It is recognising that in finely nuanced situations it is possible to have alternate outcomes which require understanding.

In many other cases, where candidates were able to discuss points of difference and provide an inventive step analysis points were awarded.

The examiner's expectation was that candidates would have found that Claim 1 was obvious, on the basis that the field of endeavour was envelopes, the skilled person was an envelope specialist and that the CGK (including the European envelopes) clearly incentivised the use of lighter grades of paper for reducing postage costs.

Regarding Claim 2, the inventive feature was the presence of slits at either side of the flap. Once it was recognised that the prior art taught that slits can be at either side to facilitate opening in either direction it appeared trivial to facilitate opening in both directions. It was considered that Claim 2 was obvious.

Claims 3 and 4 both seemed to lack inventive step starting from document C, based on the above criteria, although candidates which opted for a different construction of perforated line may have found the Claim inventive.

Claims 5 and 6 appeared to pose little difficulty.

Sufficiency

In terms of sufficiency, there was a point which was missed by almost all candidates relating to the adhesive. The adhesive was said to be essential for carrying out the invention but did not feature in the claim. Moreover, the adhesive was only identified by a trade mark and from an obscure source (a single shop in Chile). It would have been appropriate to question of the disclosure in the patent enabled the skilled person to carry out the invention without an undue burden of the type which is not permitted.

Amendment

There were amendments to be made to correct the claims ('flap' to 'flap portion' in Claim 1; 'pouch' to 'flap' in Claim 4; change dependency of Claim 4; delete Claim 6 (on the examiner's view)).

It was also necessary to substantively amend Claim 1 to make it patentable over the prior art.

The examiners were prepared to award any supportable amendment which captured the infringement whilst being able to distinguish patentably the Claims.

As each of the claims were likely unpatentable, the examiners expected an amendment from the description and thought that 'both the flap portion and pouch portion bear adhesive' or that 'the

adhesive is not aligned with the slits'. It should be noted that both prospective amendments may be circumvented by re-design and the best candidates mentioned this in their advice section.

Advice

The advice section is the crux of the paper. It is an opportunity for candidates to bring some disparate points together and to demonstrate that they have understood the commercial context in which the task is posed.

Too many candidates troop out boiler-plate answer and points in this section. These will not be awarded marks unless they are pertinent to the situation in hand.

For example, checking if renewals had been paid indicated a lack of attention to detail (the client's patent was not old enough to require payment of a renewal fee).

The points of contention clearly related to whether or not infringement action should be launched or whether amendment should be sought first under S.27. In the circumstances, it seemed inappropriate to await for s.27 when damage is being done to the client's business.

Some candidates considered the live entitlement issue to the client's patent (under s.37(5)). A few candidates wondered if the ex-employee had used some of the client's confidential information. These were all points which would have attracted marks.

Many candidates suggested the possibility of licencing but ignored the 'bad blood' between the client and the ex-employee.

Some candidates discussed the Envelopes-4-U patents (which is how the instruction arose) but, perhaps surprisingly, many did not.

The examiners were prepared to award marks for sensible and appropriate points based on the materials to hand, especially those which demonstrated that candidates understood the commercial context of the dispute. This is seen as the opportunity for candidates to demonstrate that they can apply the conclusions to provide sensible commercial advice.

On the whole this section was answered reasonably. An analysis of poorly scoring papers indicated that candidates had enough time to write many pages of points, it was simply that the points written down were not ones which the examiners could reward.