

1. General comments

The Amendment Paper reflects daily practice for many UK patent attorneys. The Examiners are mindful of the fact that an examination is an artificial environment, and that, regardless of the actual amount of time allowed, there will always be a temptation to subject oneself to time pressure. However, the question presented each year in P4 is intended to provide a self-contained problem which can be solved using techniques that trainees will encounter in their ordinary practice leading up to the examination.

The form of the question requires a candidate to prepare a response to a letter from the UK Patent Office dealing with substantive examination. This response should be prepared in accordance with standard UK patent agent practice, and should deal with all matters raised by the Examiner. In P4 no marks are available for letterheads, sign-offs or other purely presentational matters.

It is nearly inevitable that the claims will require amendment. No candidate this year attempted to assert that the claims should be maintained unamended, though a few re-presented original claim 1 for filing in a divisional application, which was felt to advertise a lack of judgement.

The instructions from the client tell the candidate - usually indirectly - what kind and scope of protection that the client desires, in relation to market and likely competition. The amendment should firstly provide sufficient scope of protection to benefit the client's business, and should secondly meet objections raised by the examiner.

The area where the examination conditions may diverge from everyday practice is in the amount of detailed presentation required to show the examiners that the candidate has competence. For example in everyday practice it may be permissible to pass over certain obvious issues in a response, knowing that the Examiner will understand or will follow up later. This is not the correct approach in an examination in which we are testing the competence of candidates to act autonomously for clients. In P4 we need to be able to see that a candidate has dealt with all issues thoroughly in order to be able to award good marks. We are keen to ensure that the fact that a candidate has not put emphasis on an issue is because he or she has dismissed it for good reason, not because it has been overlooked.

2. Breakdown of marks

The paper seeks three elements in a candidate's response: a set of claims amended for filing at the Patent Office, a letter in response to the Examination Report, and a set of notes explaining what has been done.

The proportion of marks available for each part in the 2004 paper was:

Claims	45%
Response	30%
Notes	25%

The emphasis on the claims is deliberate – presenting claims which are incapable of providing adequate protection is a serious issue, and a candidate who shows little aptitude in this area does not demonstrate the competence being tested. Naturally, weak performance in the claims tends to carry through to the marks got for the Response and the Memo.

Standards of presentation were variable. The need to generate a legible script cannot be underestimated. The examiners found one or two scripts very difficult to read. Further, some candidates submitted all of their written materials, including almost illegible working notes, as part of their answer scripts. Candidates should be careful about doing this. Everything submitted is part of the answer. Candidates, like attorneys, must take responsibility for determining the subject-matter for submission to the Examiners. If the script contains two conflicting approaches to some issue and the Examiners cannot tell which constitutes the intended response, marks will not be given.

2.1. The claims

Candidates generally appreciate the emphasis on the claims. The amount of time taken on preparing a suitable set of claims is evident. Sometimes, however, this went too far the other way, and it was clear that too little time had been allotted for the remaining marks (which constituted over half of the marks available).

The number of marks directed to an independent claim (and in this case, only one independent claim was expected) is high. We generally worked to award up to 25 marks for claim 1. Full marks could be expected for a claim substantially as follows:

1. A sleeping bag comprising a gas inflatable mattress portion and a body covering portion attached thereto, the gas inflatable portion comprising top and bottom layers, the top layer being composed of or including a layer of closed cell foam material.

Generally, claims with increasing limitation relative to the above would be awarded successively decreasing marks. For instance, we would give fewer marks for a claim which specified the nature of the bottom layer as well as the top, and for specifying the top layer being softer than the bottom.

We encountered a wide variety of main claims. Most candidates picked up the client's comment that comfort was an important selling feature, and that this was the starting point both for identifying a commercially useful claim 1, and for establishing inventive step.

However, a few candidates seemed not to have applied any analytical thought to the process of determining an appropriate amendment. These candidates generally struggled to amass marks throughout the paper.

Some candidates added different features to distinguish from each of the citations. This should ring warning bells: by and large, both in exams and in real life, if there is an invention then it should be possible to settle on a single feature that goes to the heart of it. Moreover a jumble of unrelated features is in any event unpersuasive as it does not demonstrate a consistent thread as to what is the inventive step, or the technical advantage.

A particular requirement that the client specified was the removal of the unnecessary limitation that the body-covering portion is detachable. Failure to appreciate that this feature must be removed to provide the client with adequate protection resulted in missing out on a lot of marks. In fact nearly all candidates did remove the detachability feature from claim 1, in the light of the client's comments. Most also justified this action in their Response, though not many explained coherently or even mentioned in their Memo what they had done and why.

Some unfortunately replaced "detachably" by "permanently", which at least covered the client's main version, but the question surely implies that it would be preferable to continue to cover detachable versions.

Since the specific infringements were said to be a close copy of the client's product, candidates did not have to struggle to find an amended claim covering them. However the Examiners were looking for claims of usefully broad scope directed to an idea worth protecting.

Another 15 marks were available for a set of dependent claims that provided the client with suitable fallback positions, should further prior art become evident after grant of the patent. Some candidates spent time marking up the existing dependent claims: marks were not available for this, although one mark was available for correction of a minor error in claim 3.

Particular additional features that we identified as being useful for dependent claims included:

- The top of the mattress being softer than the bottom
- The mattress comprising a single chamber for inflation
- A hood
- A separate pillow
- A zip, gusset or pocket
- An omnibus claim.

Several of these should have been straightforward, particularly the omnibus claim.

It is easy to see how some candidates struggled to finish other parts of the paper when reviewing the extensive sets of dependent claims that they prepared. There is a need to be judicious in drafting claims, as time is limited. This reflects real life – the client

is short of money and so cannot afford extensive time spent drafting claims, and time is short in an absolute sense. It was indicative of a good quality response that a candidate understood which features could conceivably be useful as fallback positions at a later time. Long sequences of claims to different features of the hood did not get extra marks.

Several candidates, perhaps drawing on previous years' P4 papers, identified and drafted claims for divisional applications. These were of variable quality and not usually justified in the Memo. The examiners felt that a divisional application was not really necessary or appropriate, particularly in view of the shortage of money. However, some marks were awarded for a divisional claim of reasonable quality, or for a recorded appreciation that a divisional application was not really necessary.

2.2. Response to Patent Office

Generally, candidates structured their letter to the Patent Office well, despite in some cases being evidently short of time.

A good response, likely to receive a high set of marks, would be structured as follows:

1. Discussion of amendments made to the claims
2. Specific analysis of each prior art document in turn, with regard to novelty
3. Arguments in support of inventive step
4. Any other matters to be presented to the Examiner

2.2.1. Amendments

We were expecting a response to include reference to basis in the application as filed for all new claims introduced, and any amendments made to existing claims. We particularly wanted to see explicit reference where a broadening amendment was made. Marks were available to candidates who brought this to the attention of the examiners, as this demonstrated that the candidate appreciated the consequences of deleting a major feature from the claims, even if that feature was replaced by another.

Almost all candidates obtained most or all of the available marks in the response for showing support for the other amendments made. However, not many marks were available for this, so candidates who wrote pages tended to waste time. A table or list is adequate. Those candidates who simply listed or included the existing claims from the patent saved both themselves and the Examiners time. However, complicated mark-ups of the existing claims, requiring the Examiners to analyse a detailed 'cut and paste' of the claims was not helpful.

2.2.2. Novelty

Candidates who failed to make good amendments to the claims could not expect to gain so many marks for discussing novelty. Also, relying on an extremely arguable

interpretation of a prior art document was considered foolhardy, and not likely to succeed.

Far too many candidates wasted time arguing about whether the citations showed detachable covers, when they had already decided to remove the feature from claim 1! Very few explained sensibly and in orderly fashion (in their memo) why claim 1 needed to be amended and what feature was chosen to make it novel/inventive and why.

The Examiners consider that D1 shows a cover that is not detachable. It is true that the mattress elements 3 can be removed from the lower part 1,2 by undoing the laces 8, but (as seen in the section in Figure 4) the cover 4,5 appears to be sewn to the lower part. The most logical identification for the item corresponding to the “mattress” of the patent in suit would be the combination of lower part and inflatable elements. Only a few candidates offered any useful comments as to whether a mattress composed of a bag in which inflatable elements are inserted constitutes a “detachable” mattress, though for the best answers such comments were in any event superfluous.

Arguments that D1’s Cellulam reinforcement 22 was not part of the mattress were seen as brave but misguided. The mattress performs its function as a whole. Some candidates attempted to make a distinction over GB2466 by stating that the mattress was “integral” or that the mattress for one of its walls was “composed of” CCF. All these attempts seemed somewhat tenuous, and not worth the effort since defining the top wall as including CCF distinguishes easily. Why some candidates went to so much effort to specify that the bottom wall is CCF remains a mystery to the Examiners. The main commercial advantage is in the comfort, and the specification fairly clearly attributes this to the material you lie on. Some practical thought was called for here.

Many candidates pointed to EP0500 (Geysler) and distinguished on the basis of the air-impermeable jacket 3 of that document. It is true that CCF is by definition impermeable and therefore may not need a cover, but the specification does envisage one (page 5 line 20). Hence arguments of this kind were unconvincing.

Some candidates proposed a main claim based on the hood feature. This was poor, since there was no reference to it in the client’s letter at all. A few marks were available for discussing it as a possible divisional application, since there is considerable discussion of it in the specification itself, but the strong implication of the question is that it was not important to the client.

On the whole therefore, marks were awarded not only for a reasonable treatment of each document in turn, identifying the way in which the claimed invention is distinguished from the prior art, but also for an appreciation of the need to maintain claim scope. Fewer marks were available for novelty arguments which, although essentially correct, were based on an unduly limited claim.

2.2.3. Inventive step

We wanted to see novelty and inventive step dealt with separately, because this presents the arguments in the most ordered and sensible fashion. Candidates who dealt with both issues simultaneously tended to suffer as they became increasingly confused and in some cases overlooked certain matters such as combining the teachings of two documents.

In this case, one of the documents was prior art only with regard to section 2(3) of the Patents Act 1977. Some candidates missed this point, but on the whole most candidates made some reference to the point that the document could not be used as basis for an objection of lack of inventive step.

Full marks were awarded for a logical approach dealing with each document in turn. Fewer marks were awarded for mere assertions without sound basis drawn from references in the documents.

A particular problem which arose from time to time was the presentation of arguments that relied on features not in claim 1. Of those candidates who commented on the age of GB1200 (though, to some of the Examiners, 40 years is no age) most simply dismissed it as being too old to consult, which is extremely poor practice. A more plausible approach might have been to argue that the long-term availability of a given feature without a combination being made is an indication that the combination was not obvious.

Marks were not awarded for mere lip service to the task of presenting arguments in support of inventive step. Amongst the most common, and certainly the most frustrating, example of this practice is the tendency for candidates to present mere lists of differences with phrases such as “in no way teaches or suggests ...”. This does not convey an argument, it merely throws back assertions at the Patent Office. This approach is unlikely in practice to persuade.

Conversely, arguments in support of novelty in some instances included lists of the advantages of the distinguishing features. These belong in a discussion of inventive step. However, many candidates listed advantages as though that proved the inventiveness of the claimed construction. Sadly it does not: if advantages of individual features are well known and it would be obvious to put them together, then generally the combination remains obvious.

Of those candidates who used the closed-cell foam as their main feature (whether in the top wall or not), very few realised that some argument was necessary to explain why the inclusion of the feature was not obvious in view of the existing use of CCF mats. Many candidates had a claim 1 where CCF was included in either wall, yet then argued that this was more comfortable.

Quite a few candidates went for the “softer/harder foam” dichotomy as their main feature. This rather narrow claim is not unreasonable, but many of these answers did not specify that the foam was CCF. Scarcely any of these answers attempted justification for selecting one feature without the other – not a trivial matter. This ran the risk of presenting a claim introducing added matter. Of course, if the foam is

CCF, the limitation to harder/softer is then unnecessary to distinguish over the prior art.

Another popular answer was that in the invention the mattress has a single chamber. The Examiners were not impressed by this. It is true that it probably distinguishes over the invention of GB 2466, but it isn't mentioned by the client and appears a rather trivial feature. Also (*pace* several candidates) it does not in itself distinguish over EP0500, notwithstanding the multitude of ribs. It would not seem even to distinguish over the prior art envisaged by GB2466 itself in the first paragraph.

Surprisingly few candidates tried to argue that GB1200 was not a sleeping bag. The Examiners were ambivalent about the merits of this argument, but a mark or two could have been awarded for addressing the point intelligently. If a candidate had considered the point, but ultimately rejected it as being too weak to make a difference, then this could have been mentioned in the Memo.

2.2.4. Other matters

The client drew attention to the activities of competitors which he wished to stop by means of the granted patent. On the whole, candidates realised that a request for acceleration of proceedings would suit (although the UKPO is quite fast), and many provided an adequate reason for this, getting all available marks for this point. Generally, candidates who missed points such as this had already demonstrated more fundamental weaknesses in other aspects of their answer.

Most candidates that proposed divisional applications realised that they would need the client's approval before filing. Most also realised that they would need to ask the examiner to delay grant, so that the divisional application could be filed. There is of course a conflict between accelerated prosecution and deferred grant. Scarcely any candidates noted this or geared their responses accordingly.

2.3. Memorandum of Notes

The invitation to prepare a memo for advice in note form led some candidates to prepare notes that were of such a cryptic nature that the examiners struggled to interpret them. On the whole, complete sentences are to be encouraged!

The memo perhaps requires more detail than a real life scenario. Candidates should use this as an opportunity to explain the decisions taken in other parts of the paper, i.e. to "show the working". 25% of the total marks were available for this part, so it was a useful area for candidates to pick up marks. On the whole, candidates who failed to manage time effectively, and did not attempt this part or left it incomplete, struggled to pass the paper as a whole.

The memo should have included:

- Explanation of the broadening amendment made to the claims. This should have been in the context of the client's letter – comments made without appreciation that commercial protection is the primary aim for the client missed the mark.

- Explanation of the need for amendments due to the existence of prior art – this need not give rise to repetition with regard to discussion of the prior art in the letter to the Patent Office, because that letter does not acknowledge the difficulties and constraints.
- Explanation of the chosen strategy for distinguishing from the prior art. A clear and concise explanation of the reason for the candidate's choices was wanted.
- Identification and explanation of fall back positions should claim 1 ever fall.
- Demonstration that the amended claims provide protection of the preferred embodiments. Clearly, those candidates whose amendments did not achieve this suffered at this point.
- Discussion of the known infringers, a possible strategy for writing to the competitors, and the position with regard to Cellulam. There was a certain naivety to some of the answers in this area. It is not clear to the examiners what benefit the client can expect from sending a copy of the amendment to competitors.
- Note of the position with regard to provisional protection, and that the provisional protection may not cover the competitors' products.
- Discussion of the need (or otherwise) for divisional applications, the likely timescale, and the cost situation.
- Discussion of the self-inflating option – focusing on the fact that the patent application in question has lapsed, so the technology is probably available for use. Marks were available to candidates who noted that a European patent application could give rise to divisional applications and then lapse, and that a check should always be recommended. No marks were available for detailed discussion of the possibility of patenting this feature as this was entirely irrelevant.

Again, the emphasis should be on demonstrating that a candidate has considered all of the significant issues. For example, although in this case we considered that a divisional application was probably unnecessary and perhaps against the client's interests, marks were awarded for considering this and discussing it rationally. Where there is infringement, a divisional is at least worth considering.