

Infringement and Validity (P6) Examiners' comments – 2004

Although this paper is entitled Infringement & Validity, it is emphasised that without carrying out a thorough interpretation or construction of the claims, it is always going to be a struggle to pass this paper. This year it was noticeable that more candidates than in previous years did attempt this approach.

The P6 examination is intended to test the candidates' powers of analysis, use of information, reasoning, ability to construct an argument, to understand and apply the principles of claim interpretation and infringement, the knowledge of relevant case law and its application to the facts of the question, to be consistent when discussing infringement and validity. It is crucial to show the steps of reasoning used to reach every conclusion, indeed this is more important than the conclusion reached. Nevertheless, the conclusions must be indicated as usually they influence other parts of the answer. The examination therefore requires

- a) the scope of the claims of the patent provided to be properly and thoroughly interpreted,
- b) the product(s) or process(es) which may infringe to be assessed to determine whether they have the technical features of the claim, the acts which may constitute infringement identified,
- c) the validity, i.e. including both novelty AND inventive step, of all of the claims to be assessed and/or solutions identified to any validity difficulties, including possible amendment – candidates must not ignore inventive step even if they have found lack of novelty ,
- d) practical steps which might be taken by the patentee to protect its interests, including some indication of whether the available steps are likely to be successful, and improve the position of the patentee.

Candidates are reminded that, within the parameters set by the paper, the situation presented is intended to reflect reality. In that reality, there are always arguments presented on both sides.

In this examination the answers of candidates ranged from opinions that the claims were all novel and inventive and infringed by at least one of the products in issue to opinions that the claims were hopelessly invalid and amendment to cure invalidity could not catch any of the potentially infringing acts. It was possible to pass the exam with high marks having reached conclusions at either end of the spectrum, provided the reasoning was explained and the approach consistent throughout.

It is difficult for candidates to acquire enough marks to pass the exam if they do not tackle all the major areas where there is room for reasoning. A clear and complete construction section usually establishes the basis for the remainder of the paper. Once the construction has been established, then the features of the claims must also be identified in the infringement section and in the novelty sections and, where appropriate in the inventive step section as well. Extensive discussion of the scope of every feature may not

be necessary, for instance if a claim is apparently clear in the context of the specification, and if the infringement and prior art clearly display the feature there is little point in speculating on the scope of the feature. If a feature is unclear, but the difference between possible scopes would not affect the questions of infringement nor validity, then it is unlikely to be prudent to spend time exploring the scope in detail. In contrast if a feature is unclear but the scope is pivotal when the question of infringement is concerned then a detailed analysis of the scope must be undertaken, the relevant facts identified, and mention of the law and its application to the facts. It is entirely possible that the facts presented in the question paper may seem to be inadequate for a conclusion to be reached in which case there are marks to be gained in pointing out what further information is needed and how to go about collecting it. If, in a construction section, a particular feature is discussed in detail this should be followed up in the infringement and validity sections with a discussion as to whether the feature as construed is present. The conclusions should be consistent. As to the features which do or do not need in depth discussion, this is one of the aspects of this paper on which a candidate is expected to use both judgment and discretion. Judgment as to which issues or features are of major importance and which are not is one of the fundamental aspects of dealing with a real-life situation.

It is also important for candidates, once they have analysed an independent claim, to continue by analysing dependent claims to determine whether the features defined contribute any feature(s) which may influence the infringement and validity issues. Thus, if claim 1 is new, the claims depending from it will normally be new too. However, there may still be a discussion as to whether the features of the subclaims are disclosed in the prior art, in case the reasoning and conclusions regarding the novelty of claim 1 are spurious or in doubt, e.g. because the court might reach a different view of the scope of the claim, or of the disclosure of the prior art. Similarly, the inventive step of subclaims should be discussed even if a claim from which they depend has, in the initial opinion of the candidate, an inventive step. Candidates must remember that the reasoning they use is only an opinion and that there is invariably a contrary opinion. Candidates are advised that they can always consider what that contrary opinion might be and not rely on a single point of view. For example if the candidate is of the view that Claim 1 is valid because of a particular construction of a feature, the consequence of the feature being eventually found to have a different meaning leading to a decision of invalidity can be explained by the candidate which then requires that the dependent Claims are considered. Marks are available for this analysis provided the reasoning is clearly provided and dependency acknowledged.

Likewise, if a potential infringing act is, in the opinion of the candidate, outside the scope of a claim, the subclaims should ideally be discussed, to deal with the situation arising that the court disagrees with the opinion. Marks are awarded for such analyses.

Candidates should note that reference to "selection of points" relates to the degree of discussion, not a peremptory "yes/no" indication.

The question as to the influence on the scope by reference in a product claim to the intended use of the product often arises in real life. It arose again in this year's paper.

Most candidates appreciate a claim is not limited to products explicitly described as being used in the stated application. However it is not correct that the description has no influence on scope, and candidates who stated this missed marks. In this exam, not a great deal turned on the issue, but it was relevant to the abrasive scouring pad prior art.

The claim defined “bodies... formed of ...pieces of polymer”. A careful explanation as to the relationship between these features was important when it came to considering whether the material of abrasive particles in the infringement and the prior art was determinative for infringement of and validity of one of the subclaims. The scope of “irregular” generated extensive discussion from some candidates. In the end little turned on it as the relevant potential infringement was certainly not non-spherical and regular in shape or size, but rather irregular on any interpretation. The cuboidal scouring pads of the prior art could have been irregular or not depending on whether irregular was interpreted to be anything but spherical and this was a possible interpretation, provided it was reasoned by reference to the text and the purpose.

The size of the particles was clearly critical when it came to infringement and validity and should have been discussed in detail by all candidates. There should have been some analysis of the term “average”. Some candidates pointed out correctly that the reference to the average meant that a population having individuals outside the range ought still to be covered provided the “average” was within the range, but many then went on to suggest that a limited proportion of the infringing sample may infringe, these being inconsistent statements. There were points to be gained for explaining the various potential meanings of the term “average” and for reasoning being displayed for concluding that the scope in the context was one of these (such as a particular mean or a sort of mode). It was relevant that the examples did not give values for an “average”. The specification pointed to the criticality of carrying out the measurements under special conditions, using specified techniques, and points were gained by candidates who questioned whether the worked examples, the alleged infringements and even the prior art products had been or could be measured as specified. The accuracy of the ends of the range for the particle size was important and how the qualifiers “about” affected the interpretation were important matters for discussion. Cross-referring to the use of the same qualifier in the context of other values in other claims, questioning whether the meanings should imply the same level of accuracy, gained points, as did discussing whether the measurement technique for the abrasive particles and the definition of the size by a single value and not an average were relevant to construction.

The fact that the patentee himself apparently had difficulty determining the longest diameter should have set alarm bells ringing about the clarity of the claims, the ability to prove infringement, and/or the sufficiency of the claims.

In the process claim it was interesting that the definition of the surfaces being cleaned was different to that in claim 1, but little turned on this as the infringements and the closest prior art were within both definitions. There was an issue regarding the scope of the term “liquid detergent”, and candidates were expected to point out that this seemed broad enough to cover water with the bodies and no other additives, regardless of any

dictionary definitions of the term “detergent”. The consequences of this must be set out for the client. If a justified interpretation that was narrower than this was given, and was followed through in the infringement (especially contributory infringement) and validity sections, then points were still given.

The sufficiency of the description of the retrofit device with pivotal sieve was worth mentioning.

The information concerning the retrofit device supplied to the ex-customer was minimal and the reasoning should have been displayed if it was stated that the candidate assumed this had all the features specified in the process claim, for instance by stating that it was not explicit that the client’s device had all those features, but it seemed reasonable to assume it did.

In the contributory infringement section, knowledge as to whether the process is intended to be carried out in the jurisdiction is relevant. It might have been questioned whether such knowledge might be assumed, for instance, whether the device, e.g. the sieve part, was specially adapted to the particle size of the bodies to be removed. Since other size ranges of bodies appear to be on the market, perhaps such knowledge cannot immediately be assumed. There were some jurisdictional issues worth discussing, relating to actions of the overseas supplier with respect to both bodies and retrofit device, and points were gained by pointing these out, and questioning whether any common design to suggest joint tortfeasorship existed.

On inventive step most candidates used the textbook (CGK) as the starting point although a few managed to justify an alternative. If the Windsurfer approach can be used it is usually best to explain and apply this to the facts. However the examiners appreciate that the majority of candidates are very familiar with EPO-style problem-solution approach, and if this test was applied adequately, then marks were awarded. In either event the relevant prior art must be identified, the skilled person mentioned, the relevance of common general knowledge and an indication of what this appears to be. The difference from the prior art has to be identified and the question as to whether it would have been obvious to the person skilled in the art at the priority date to put the invention into effect discussed. There are usually hints in the question as to whether a problem with the prior art was recognised, or whether identifying the problem was part of the invention, whether the step taken from the prior art was inventive or not, whether there are advantages, and whether these were expected or not.

Commercial sense is rewarded. Many candidates pointed out that it may not be commercially wise to sue or threaten a potential (even though now ex-) customer, but more fruitful to get them onside in the hope of being able to collect evidence with their help. If comments are made about the availability of preliminary orders such as interim injunctions, candidates should show they understand the distinction from permanent orders requested after full trial. The urgency must be explained and the problems that arise where there is a serious difficulty with validity. But if the patentee is manufacturing in the jurisdiction, and his market is being demonstrably damaged, and damages would

not be an adequate remedy, then it may be worth seeking such a preliminary injunction, although the court is more likely on current practice, to order accelerated trial instead.

Candidates are also advised to use the document names given in the question. There is no point in renaming these documents and it causes confusion.

Marks were awarded according to the following generalised scheme showing examples of relevant features to be construed and discussed with respect to infringement, novelty and inventive step. Other appropriate selections also attracted marks. The conclusions reached are not as important as the reasoning but must be consistent with the reasoning.

Construction:

Total marks: 18

Claim No.	Examples of features for construction/interpretation
Claim 1	foam; bodies; spherical; irregular; polymer; average; largest diameter; about
Claim 2	comprises
Claim 3	further comprise; embedded in; matrix of the polymer
Claim 4	about
Claim 5	about; ratio measured by which parameter ?
Claim 6	process; liquid detergent; for; surface; contact; pivotal sieve

Infringement:

Total marks: 24

Claim No.	Embodiment 1–spherical bodies	Embodiment 2-irregular bodies
Claim 1	Is it a “foam” body? Is it suitable for? Is it spherical? Is it a polymer? What is the “average” “largest” diameter? Effect of temperature on size?	Is it a “foam” body? Is it suitable for?. Is it irregular? Is it a polymer? What is the “average” “largest” diameter? Effect of temperature on size ?
Claim 2	Is the polymer comprised of polyurethane? Depends on whether “bodies” includes abrasive	Is the polymer comprised of polyurethane?
Claim 3	Are there abrasive particles? Are the abrasive particles “embedded in matrix”? Improver analysis to the use of adhesive film?	Are there abrasive particles? Are the abrasive particles “embedded in matrix”? dependency
Claim 4	What is size of abrasive? dependency	dependency
Claim 5	Polymer to abrasive particle ratio by weight? Need evidence	dependency
Claim 6	direct/contributory infringement depends on infringement by foam bodies	depends on infringement by foam bodies

Novelty:**Total marks: 18**

Claim No.	Document B	Document C
Claim 1	Is it a “foam” body? Is it suitable for? Are they spherical or irregular bodies? Is it a polymer? What is the “average” “largest” diameter? Does it include 2mm?	Is it a “foam” body? Is it suitable for? Are they spherical or irregular bodies? Possibly the “droplets” ? Is it a polymer? What is the “average” “largest” diameter? droplets are 0.5-1mm
Claim 2	Is there any polyurethane in the body?	Is there any polyurethane in the body?
Claim 3	Are there abrasive particles? dependency	Are there abrasive particles? N.b. droplets dependency
Claim 4	dependency	Abrasive particle size - evidence? dependency
Claim 5	dependency	Polymer to abrasive ratio– evidence? dependency
Claim 6	no disclosure of pivotal sieve	no disclosure

Inventive Step:**Total marks: 23**

Claim No.	Embodiment 1–spherical bodies	Embodiment 2-irregular bodies
Claim 1	Inventive concept? Shape or size? Doc B is CGK (spherical bodies – 2mm) Is it obvious to reduce body diameter to “about 1.5mm”? Is the range “about 0.5 mm to 1.5 mm obvious? Combine with Doc C (is the same technical field) – are there irregular bodies (droplets on the fibres on pads have scouring action – 0.5-1mm) advantage of smaller bodies/relatively uniform size/narrow diameter range Is it obvious to try smaller spherical bodies or irregular bodies? Is it obvious to try uniform narrow range of bodies?	
Claim 2	Is use of polyurethane as all or part of polymer obvious? Backing material in Doc C – not droplet material. Well known polymer – obvious to try?	
Claim 3	No abrasive in known circulating bodies (Doc B) Abrasive in droplets (Doc C) stuck to acrylic resin Obvious to incorporate abrasive in matrix of polymer in circulating bodies?	
Claim 4	Abrasive in Doc C is fine to coarse – needs evidence to correspond to particle size	
Claim 5	No indication in art of ratio of polymer to abrasive – no indication of an advantage associated with the ratio – evidence	
Claim 6	New feature of process is pivotal sieve – is it inventive? Needs evidence. Does inventive step depend on inventive step of claims 1 to 5?	

Amendment: 4 marks

For example: Amend range from “0.5 mm to 1.5 mm” to “0.8 mm to 1.2 mm”.
Introduce inventive features from sub-claim (dependent on analysis)
Comments on whether amendments capture alleged infringements

Sufficiency: 3 marks

Example 1 states sizes in dry or wet state but not at 60°C, so example may not support the inventive concept of the claimed range of average largest diameter bodies. Rest of description may be sufficient to overcome deficiency.

Is the description sufficient with respect to the retrofit device and the pivotal sieve?

Letter: 7 marks

Summary of infringement, novelty and inventive step analysis, potential amendment issues, possible issues caused by delay in obtaining amendment, possibility of preliminary injunction, basis for preliminary injunction, avoiding threats actions, any other general advice based on result of the assessment.

Floating marks: 3 marks

For example: Remarks on prior art mentioned in the Patent (Doc A)
Remarks on direct infringement and contributory infringement