

2003 – P3 – EXAMINERS' COMMENTS (Final Form)

In this year's question, by far most candidates appreciated that invention could arguably lie in employing the principle of operation of the sealant gun to make a one-hand operated clamping device, and one which could be quick to use.

However, far too many candidates unnecessarily limited themselves claiming still what they saw, rather than the arguable invention. For basically this was along the lines:

"A clamping device having jaws and indexing (or toggle) (or ratchet) means arranged in use to hold the jaws closed and releasable to permit them to open."

A claim to such a clamping device in which the jaws are associated with handles pivotally attached one to another is accordingly deemed too narrow as is one in which the toggle has a hole through which the ratchet passes.

The Examiners do expect the candidate to know how to present the invention as to make it appear that there is indeed an inventive step with regard to the prior art. There was, in this instance, no need whatever to mention the sealant gun in the patent specification, and to do so presents a hostage to fortune when trying to convince a Patent Office Examiner that the claims are non-obvious. There was clear need to mention a g-clamp.

It will be seen above that a passable main claim could be very short. It was noticeable that by far most candidates claimed "a clamping device". Only one or two claimed a clamp. As most candidates did not go on to use the expression "clamping device" to cover for example both a clamp and a vice, there was perhaps little point in using two words where one would suffice.

By the same token, a large number of candidates, towards the end of their specific description, included a paragraph having the clause "other embodiments will occur to those skilled in the art" without giving even the slightest hint as to what such embodiments might comprise. This was the opportunity to suggest a vice and/or a linear clamp in which the handles were not pivotally attached if these alternatives occur to the candidate, otherwise it is better to say nothing!

A number of candidates also seemed not to appreciate that the specific description should be just that – specific – and that the use of general terms in this portion of the specification is not helpful. The best answers also started off the specific description by describing the components of the clamp and how they fitted together. The subsequent description of how the clamp was operated in practice then followed on logically and clearly.

Care is still needed in the drafting of the preamble, to reflect the actual facts. "G-clamps are known in the workshop and d-i-y world" is true, A "G-clamp has been postulated" is inaccurate. It is also, as a matter of fact, untrue that a G-clamp **cannot** be operated with one hand. If one has the fixed jaw and, perhaps, the anvil appropriately contacting the work piece it may be possible to use one hand. This of course means that a main claim will fail whose distinguishing feature from the prior art is one-handed operation. It is however generally true that the traditional G-clamp is slower to use than the clamp of the

invention. But it also happens to be the case that one can usually exert more pressure with a g-clamp than with the scissor clamp of this question. In other words the g-clamp does not have to be disparaged in order to show invention in the clamping device of the question. There does not always need to be a problem with the prior art that the invention is to solve; the invention may be an improvement over the prior art.

As usual, many candidates presented “notes to the Examiner”, some of which were quite long. These are rarely if ever useful. It is the preamble, the claims, the specific description and the abstract which earn the marks and the Examiners are well capable of determining from those whether the candidate is “fit to be let loose on the public in his own right”.

Turning to the Abstract, a minor point but worth a mark or two; it is not necessary to include the words “The present invention provides a” or “There is provided”. It is accepted practice to begin with the article (or method). In this case “A clamping device comprising ...” is a proper way to start.

One or two candidates presented method claims. These were deemed unnecessary, and candidates are reminded that they do not show their expertise by including method claims in such instances, just as they don’t, in this instance, by describing the sealant gun. The question is to be treated as a real life example.

Similarly, dependent claims should only relate to features which have a reasonable likelihood of distinguishing the invention patentably in the event that the subject matter of the main claim is found to be unpatentable. Although most candidates bore this in mind, a few answers contained several claims which related to unimportant features. The Examiners were looking for dependent claims principally directed to; handles, handles pivoted, handles pivoted intermediate their ends, pivoting jaws, hard rubber jaws, grooved jaws, spring loaded handles, spring loaded indexing.

Candidates are reminded that they make it difficult for themselves to pass if they do not attempt each part of the question. It is also good advice to write on every other line only – for clarity and to enable amendments to be made. If the claims are long, then it is a good idea to start each one on a new page.

This year no candidate evinced any inability to deal with the subject matter of the question and to describe the mechanical object adequately. Candidates passed or failed entirely on their ability professionally to present a good broad claim, to introduce it accurately and in such a way as to convince the reader that there is an invention present, and to describe specific embodiments accurately according to established custom.