

THE JOINT EXAMINATION BOARD

PAPER P4

**AMENDMENT OF SPECIFICATIONS FOR UNITED KINGDOM PATENT
APPLICATIONS IN PROSECUTION, REVOCATION PROCEEDINGS OR
OTHERWISE**

Thursday 6th November 2003

10.00 a.m. - 1.00 p.m.

*Time Allowed - **THREE HOURS***

Please read the following instructions carefully.

1. Note the following:
 - Enter the Paper Number, the question number and your Examination number in the appropriate boxes at the top of each sheet of paper
 - Write on one side of the paper only, within the printed margins, using a **BLACK** or **BLUE-BLACK** pen
 - **DO NOT** use coloured pens or highlighters within the answers - they will not photocopy
 - **DO NOT** staple or join pages together in any way
 - **DO NOT** state your name anywhere in the answer
2. **NO** printed matter or other written material may be taken into the examination room. **ALL** mobile phones and electronic aids **must be** switched off and stored away.
3. Answers **MUST** be legible. If the examiners cannot read a candidate's answer no marks will be awarded.
4. **NO WRITING OF ANY KIND WILL BE PERMITTED AFTER THE TIME ALLOTTED TO THIS PAPER HAS EXPIRED. At the end of the examination assemble your answer sheets in order and put them in the WHITE envelope provided.**

This paper consists of **19** pages including this page.

THE JOINT EXAMINATION BOARD**PAPER P4 - AMENDMENT**Instructions: continued

In this paper, you should assume that a United Kingdom patent application comprising the attached specification (identified as GB 0222221.8) was filed at the UK Patent Office on June 1st, 2002 without any claim to priority. The UK Patent Office has issued the attached Official Letter.

You have received information about the application and Official Letter from your client in the form of the attached letter with enclosures.

Your task is to prepare the following:

1. A letter to the UK Patent Office in response to the Official Letter, accompanied by a set of amended claims if appropriate. (Please note that for the purpose of this examination you are **not** required to propose any amendments to the description of the patent application.)
2. A memorandum consisting of notes to provide the basis of later advice and comment to your client explaining the actions you have taken and the reasons for those actions. These notes should be restricted to patent matters; you are **not** required to consider any other matters such as copyright or design protection. Letter form is **not** required.

You should accept the facts given in the paper and base your answer on those facts. In particular, you should **not** make use of any special knowledge that you may have of the subject matter concerned, and you must assume that the prior art referred to is in fact exhaustive. Where only extracts of documents are presented, you should assume that those extracts contain all relevant material.

If your advice to your client will include a suggestion that one or more divisional applications should be filed, you should draft the corresponding independent claim(s) and your memorandum should indicate your grounds for believing the filing of such divisional application(s) to be advisable. You should **not** draft a description or any dependent claims for a divisional application.

If you submit amended claims and/or independent divisional claim(s), please place these at the top of your papers when handing in your answer.

Document List:

Client's letter - 1 page

Official letter - 1 page

Client's application GB 0222221.8 - 6 pages text, 1 page drawings

US 5 555 666 - 3 pages text, 1 page drawings

US 4 000 333 - 2 pages text, 1 page drawings

GB 2 300 400 - 1 page

3/19

LETTER FROM CLIENT

Fred Wiper
Matador Ltd.

5 November 2003

P Pedant
Chartered Patent Attorney

Dear Mr Pedant

Please can you help? I filed my own patent application and have managed thus far but am at a loss with this letter from the Patent Office. Unfortunately I have left it until the last minute and we have to reply soon, but I am just this morning embarking on a three-week stay on the International Space Station which it would be difficult to postpone.

To give you some background, we make garden products and have just recently started producing integral moulded doormats which are easily and cheaply mass-produced compared to standard bristle mats. We thought this water-filled mat idea was new but someone seems to have thought of it before, though I have never seen any on the market. However, we still think our design is better. The Smith US patent relies on having a complicated base structure. The Jones patent relies on extra brushes which we don't use, and in any case he has the water level above the bristles. The Curry one seems to have nothing to do with us: perhaps this is a mistake?

Please would you do the best you can with the Examiner. We have heard that another company, Footsore Limited, whom we have not come across before, is marketing a similar "wet cleaning" mat. Apparently they normally make indoor rubber mats for hospitals and so forth, and have not been on the household market before, but it seems that there is considerable interest in providing a range of rubber moulded mats for general purposes, a field in which they have some expertise, so we see them as a threat to our business.

Yours sincerely

F. Wiper

OFFICIAL LETTER

Application No: GB 0222221.8

Applicant: Matador Limited

Latest date for reply: 7 November 2003

Patents Act 1977
Examination Report under Section 18(3)

Novelty (Section 1(1)(a))

- (1) The invention as defined in claim 1 at least is not new and/or is obvious in view of what has already been disclosed in the following documents:

US 5555666 (Smith) - wall 12, parts 20

US 4000333 (Jones) - rim 12, flexible member 19

GB 2300400 (Curry) - the whole document

Clarity (Section 14(5)(b))

- (2) Claim 1 is unclear: "water level" is not defined.
- (3) Claim 2 is unclear: claim 1 does not refer to any flexible members outside the rim.
- (4) Claim 4 refers to "an upwardly extending rim", but this already appears in claim 1.

Amendment

- (5) In amending the application, care should be taken to avoid addition of subject-matter contrary to Section 76(2).

DOORMAT

5 This invention relates to a doormat. In particular this invention relates to the heavy-duty moulded doormats which have usually hitherto been made of rubber and which have the function of removing gross adherent mud or slush before the user enters a building.

10 It is known to provide for example a moulded rubber doormat which has a number of upstanding ridges or spikes. However, while such mats are to some extent effective they soon become dirty and clogged with mud.

15 The present invention is defined in claim 1.

In use the mat according to the invention will be supplied with water within the rim so that when mud is removed from the shoe by moving the shoe to and fro against the upstanding flexible members (such as spikes or ribs) within the rim the mud is softened and washed from the tops of these points or ribs by the water. Since the upstanding members are flexible, they will bend into and out of the water as the mat is used and this will in effect wash them clean and ensure that they are continuously useful for their cleaning function.

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35 In practice the mat will usually be provided with the upwardly extending flexible members over the greater part of its upper surface, and the rim defining the container for containing water will surround some but not all of the flexible members. In this way gross adherent material can be removed outside the rim and the region within the rim, provided with water, can be used for cleaning the remaining mud from the shoe more effectively.

While all of the upwardly extending flexible members can have the same profile, it is possible for those within the rim and protruding above the water level to be more deformable than those outside the rim since they are needed to cope with the remaining relatively smaller adherent patches of material and to deform down into the water in order to be washed clean.

The flexible members can be ribs extending transversely to the direction of movement of the foot (and accordingly generally longitudinal, referred to the usual shape of door mats) or may be upwardly extending spikes or nodules.

The flexible members may be arranged in a regular or a random pattern; thus, if ribs are used, they may be integral parallel unbroken upstanding ribs or may be arranged as short aligned ribs in parallel rows. Where spikes are used they can be arranged in a generally hexagonal pattern for ease in moulding.

The mat may if desired have an upwardly extending rim extending all the way around the periphery in addition to the rim extending around the area suitable for containing water.

A preferred design of mat has in addition to the area for containing water and in addition to other areas containing upwardly extending flexible members such as spikes or ribs, one or more relatively plain areas so that the user can stand on such an area with one foot while moving the other foot and without the foot on which the user stands deforming any spikes or ribs. However, preferably the greater part of the surface is covered with spikes. If necessary the area to be stood on can be suitably marked or indicated.

Another optional but advantageous feature according to the present invention is to have the back of the mat provided with score lines or crease lines whereby it can be folded to a smaller size for transport and cleaning. For example, two such fold lines can be provided extending across the back of the mat behind the rim which defines the water-containing area.

While the mat can have a variety of shapes and still fall within the invention, it is generally envisaged for it to be 30-60 cm long and 22-45 cm wide. The overall thickness of the mat, that is to say the thickness of the base plus the height of the upwardly extending portions, will generally be from 2 to 5 cm. However, it is stressed that these numerical limitations do not affect the broad scope of the invention as defined above.

The invention will be further described with reference to the accompanying drawings, in which:

Figure 1 is a general diagrammatic plan view of a mat according to the invention;

Figure 2a is a similarly diagrammatic plan view of an alternative embodiment of a mat according to the invention;

Figure 2b is a section through the mat of Figure 2a in the longitudinal direction; and

Figure 3 is a diagrammatic plan view of a further embodiment of a mat according to the invention.

In **Figure 1** a doormat is a single moulding of rubber or synthetic elastomeric composition or other suitable waterproof material, and consists of a flat base 1 from which a plurality of spikes 2 extend upwards. A rim 3 extends all the way around a central portion of the mat, and within the rim a further array of somewhat finer spikes 4 extends upwards. (It will of course be apparent that the spikes shown should extend over the whole of the

relevant areas.) The upstanding rim 3 defines a tray for holding a supply of water, usually in such a way that the spikes protrude from the water but can be deformed to pass into it when the mat is in use. In the particular example shown in Figure 1 the spikes 2 and 4 and the rim 3 all extend to the same height.

In **Figure 2a** a generally similar arrangement is shown except that an upwardly extending rim 5 extends around the whole mat. This rim, with two cross members 6, defines the central area for holding water and two separate outer areas which are to be used for dry scraping. In the embodiment shown in Figure 2a the spikes 2 and 4 are replaced by ribs 7 and/or 8 as shown. (It will be apparent that these ribs and the spikes 4 as shown in Figure 2a extend over the whole of their relevant areas, and that the exact configuration of the ribs is optional). Moreover, if desired, flexible ribs could replace the spikes 4 within the water-holding area defined by the rim 5 and the cross-members 6.

Figure 2b is a cross-section through Figure 2a. It will be apparent from Figure 2b how the various ribs and spikes extend to the same general level as the surrounding rib 5 and cross-members 6. Moreover, it will be clear that the ribs 5 and cross members 6, as well as the spikes 4, are upwardly tapered so that the mat can be readily moulded and removed from the mould, while still providing ribs of a suitable strength and flexibility. Moreover, in Figure 2b the arrows 14 indicate a suitable location for a fold line extending across the mat on the back thereof so that the end portions can be folded around the central portion when it is desired to transport the mat away for cleaning.

Figure 3 shows a further embodiment of a mat according to the invention in which the moulding provides

a surrounding rib 5 and several integral cross-members 9,10 11 and 12 defining various compartments. Of these only the central compartment 13 is intended to contain water and again it is provided with spikes 4 as shown in the preceding embodiments. There are two raised portions each in the shape of a shoe print within two of the various compartments, indicating to the user that he can advantageously put his weight on these portions of the mat without deforming any of the flexible upwardly extending portions.

It will be apparent from each of the figures that the various ribs are provided with internally rounded angles so that the mat may be readily cleaned. Moreover, these rounded angles assist in retaining the ribs upright so that the area defined by the central portion in each mat can contain water without undue loss or spillage.

Where reference is made herein to the "water level" within the raised portion it will be understood to mean "the effective water level when the mat is in use".

CLAIMS

- 5 1. A doormat provided with a raised rim to define a shallow container for water and having upwardly extending flexible members at least some of which are within the rim so as to protrude above the water level.
- 10 2. A doormat as claimed in claim 1, wherein the flexible members within the rim are more deformable than those outside the rim.
- 15 3. A doormat as claimed in claim 1 or 2, in which the upwardly extending members are transverse ribs, spikes or nodules.
- 20 4. A doormat as claimed in any preceding claim, further comprising an upwardly extending rim around its periphery.
- 25 5. A doormat as claimed in any preceding claim, further comprising one or more plain areas so that the user can stand on such an area with one foot while moving the other foot, without the foot on which the user stands deforming the upwardly extending members.
- 30 6. A doormat as claimed in any preceding claim which is of rubber.
- 35 7. A doormat as claimed in any preceding claim the back of which is provided with crease lines to facilitate folding of the mat.
8. A doormat substantially as herein described with reference to, and as illustrated in, the accompanying drawings.

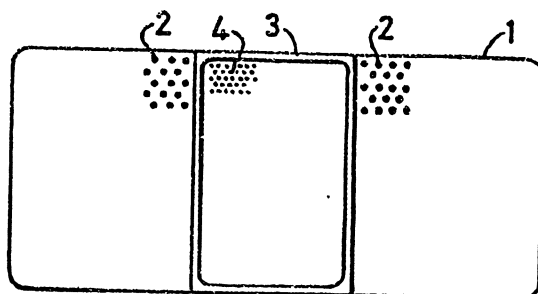


FIG. 1.

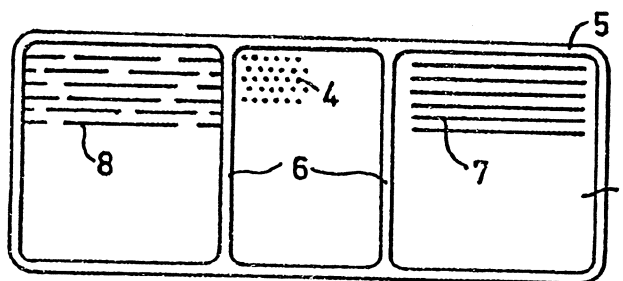


FIG. 2a.

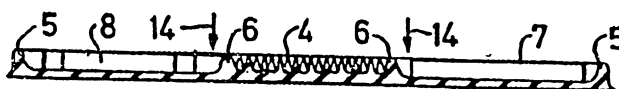


FIG. 2b.

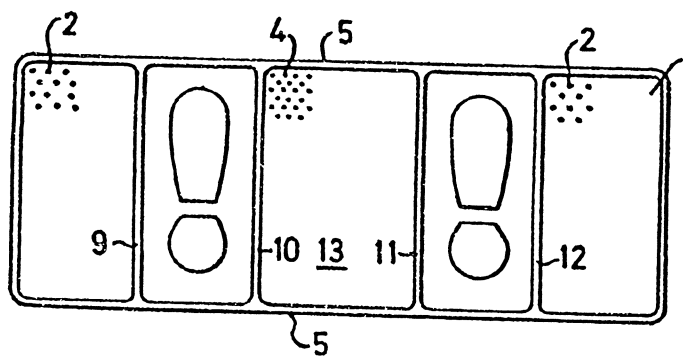


FIG. 3.

US 5 555 666 - Smith

Filed : 25 July 1995

Published : 17 September 1996

SHOE WIPING MAT ASSEMBLY**BACKGROUND OF THE INVENTION**

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The invention relates to mat assemblies adapted to be positioned on the floor or ground and used for cleaning dirt, debris, etc. from the soles of shoes.

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It is an object of this invention to provide a shoe cleaning mat assembly which combines a liquid containing reservoir for exposing the soles of the shoes to a liquid cleaning solution and a cleaning means capable of brushing or scraping debris trapped in the crevices or cavities of treaded soles. It is a further object to create such an assembly which incorporates support means to maintain the soles at the optimum depth in the liquid while creating a recess area to receive removed debris.

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SUMMARY OF THE INVENTION

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The invention is a shoe wiping mat especially suited for cleaning shoes having crevices or ridges on the soles defining channels and ridges in which debris can remain trapped after wiping on ordinary mats, and is in particular suited for treaded shoes, such as tennis, running or boat shoes, cleated shoes, such as golf shoes, or work boots. The combination of wiping bristles and liquid contact increases the cleaning efficiency.

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The shoe wiping mat assembly comprises in general a four sided shallow tray which defines a liquid retention compartment. Within the liquid retention compartment are relatively rigid, relatively non-compressible support means, which may comprise a grid, ridges, or posts, extending upwardly from the bottom of the tray whereby the upper edges or ends of the support means create a generally horizontally disposed surface.

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Extending upwardly from the bottom of the tray and generally filling open areas of the support surface are a large number of bristles, composed of natural or synthetic material which is relatively rigid yet able to flex or bend to some degree as the soles are wiped across them. The bristles extend a short distance above the support surface formed by the support means so that they will extend into the crevices of the shoe soles. A cleaning liquid, such as water or any other suitable cleaning or disinfecting solution, is placed in the liquid retention compartment. The upper surface of the water is maintained at a level above the support surface yet below the upper ends of the bristles, such that the soles of the shoes will be wetted by the liquid, and below the ends of the bristles, such that the bristles extend above the liquid level.

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BRIEF DESCRIPTION OF THE DRAWINGS

FIG. 1 is a top view of the invention.

5 FIG. 2 is a side view with a portion of the side wall removed to expose the cleaning means, liquid and support means.

FIG. 3 is a partial top view of an alternate embodiment of the invention, showing posts as the support means.

10 FIG. 4 is a partial top view of another alternate embodiment of the invention, showing ridges as the support means.

15 FIG. 5 is a top view of another embodiment which comprises a separate chamber containing an absorbent material.

DETAILED DESCRIPTION OF THE INVENTION

20 As shown primarily in FIGS. 1 and 2, a shoe wiping mat assembly 10 comprises a bottom member 11 and side wall members 12 joined to form a unitary liquid retention compartment 13. The overall configuration of the invention is that of a shallow, rectangular tray having relatively short, generally upstanding side walls 12 and a relatively large bottom 11 presenting an upper surface area of sufficient area to extend beyond the edge of standard shoes in all directions when a person is standing on the assembly 10 with both feet. It is preferred that the bottom 11 and side walls 12 be composed e.g. moulded entirely of plastic materials, but other materials having sufficient liquid permeability, strength and flexibility may be substituted. A rectangular configuration is shown, but other shapes are possible.

25 As shown in FIG. 1, the interior of the liquid compartment 13 is substantially filled with support means 20 and cleaning means 90. Support means 20 are relatively rigid moulded members interspaced within the liquid compartment 13, preferably but not necessarily made of a hard plastic or rubber, capable of sustaining the weight of a person to maintain the shoe soles a distance above the bottom member 11. The support means may be a grid 21 as shown in FIG. 1, ridges 22 as shown in FIG. 3 or posts 23 as shown in FIG. 4. The upper portions of the support means 20 form a generally horizontally disposed support surface 31. The support surface 31 is primarily open to the bottom 11, i.e. the support means 20 occupy only a relatively minimal part of the surface area with a large number of open areas 33 being present. The support means is a separate component placed into the liquid retention area 13. The height of the support surface 31 is approximately 0.75 inches from the bottom 11.

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45 Extending upwardly from the bottom 11 of the liquid retention compartment 13 between the support means 20 are cleaning means 90, which preferably comprise a large number of relatively rigid but somewhat flexible bristles 91 made from either natural or synthetic materials. It is preferred that the cleaning means 90 be composed of plastic and be similar in configuration and composition to known products referred to as indoor/outdoor carpet, although in this application the bristles 91 should be longer than those present in the carpet application, having a length of approximately 1 inch above the bottom 11. It is preferred that the bristles 91 occupy and fill the majority of the space between the support means 20, although they may be positioned in rows, tufts, or the like.

5 To maximize the cleaning efficiency of the assembly 10, the liquid retention compartment 13 is filled with a liquid 99, such as water or other suitable cleaning or disinfecting solution. It is important that the surface 32 of the liquid 99 be maintained at a proper height. Preferably the side walls 14 extend above the liquid surface 32 and are provided with a number of drain apertures 16, shown in FIG. 2, positioned at the desired height to allow excess liquid 99 to drain.

10 In an alternative embodiment shown in FIG. 5, the mat assembly 10 is provided with an absorbent means 51 adjacent to the liquid retention compartment 13, e.g. a cloth, carpet or sponge type material, attached to a hard surface or positioned within an absorbent compartment 50 formed similar to the liquid retention compartment 13. The absorbent means 51 is used to remove any residual liquid 99 remaining on the soles after they have been
15 cleaned in the liquid retention compartment 13.

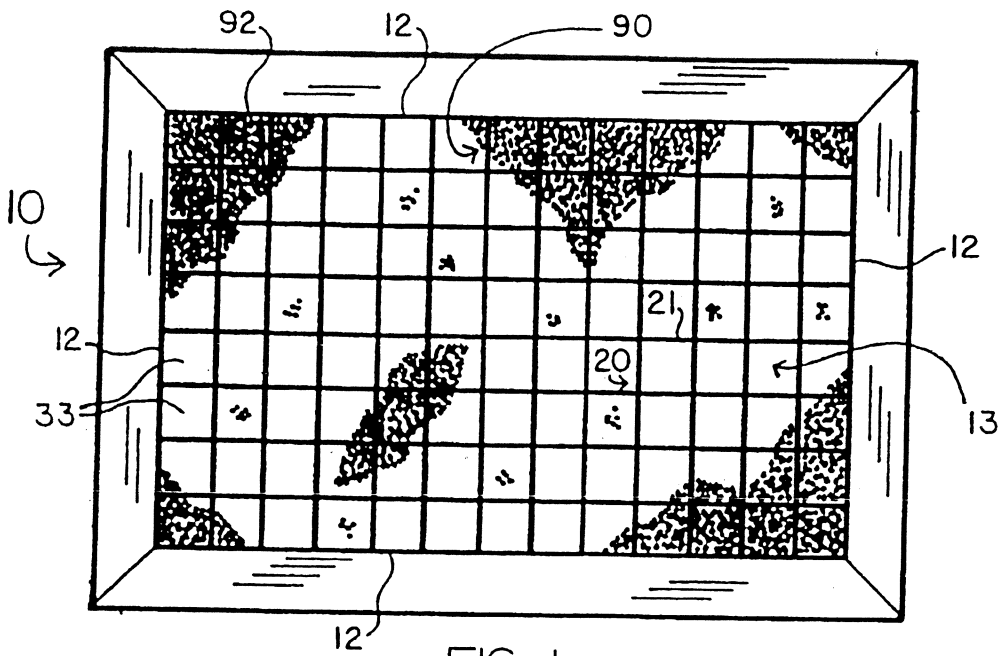


FIG 1

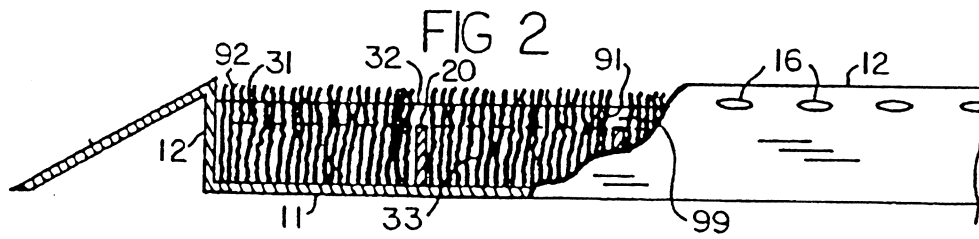


FIG 2

FIG 3

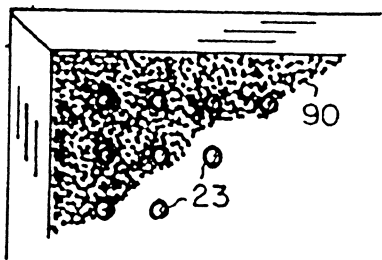


FIG 4

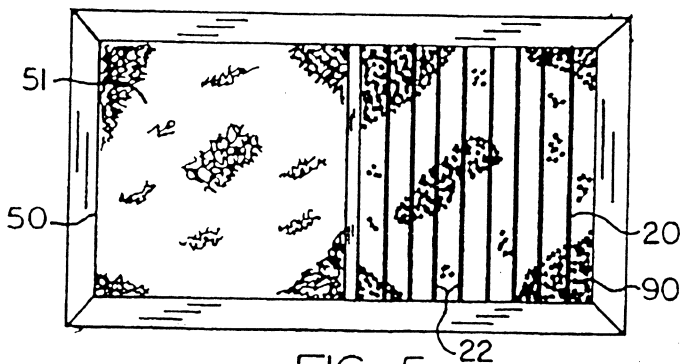
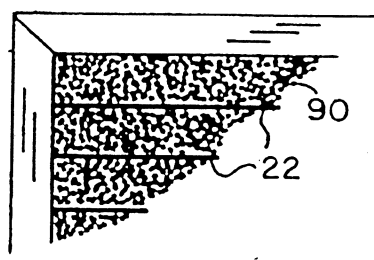


FIG 5

US 4 000 333 - Jones
(EXTRACT)

Filed : 5 July 1987

5 Published : 19 September 1988

SHOE SOLE CLEANER

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BACKGROUND OF THE INVENTION

This invention relates to a cleaner device for removing dirt from the soles of a variety of shoes or boots. The device
15 comprises a liquid-containment tray, and a bristle type mat structure supported in the tray with the bristle ends extending up through liquid in the tray. A person can stand on the mat structure while shifting his/her feet back and forth on the mat surface. A liquid-scrubbing effect is
20 achieved to remove dirt from the sole areas of the person's shoes.

Fig. 1 is a top plan view of a shoe sole cleaner device embodying our invention.

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Fig. 2 is a sectional view taken on line 2-2 in Fig. 1.

Fig. 3 is a fragmentary enlarged view of the Fig. 1 embodiment taken in the same direction as Fig. 2.

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DESCRIPTION OF A PREFERRED EMBODIMENT OF THE INVENTION

Figs. 1 and 2 show a shoe sole cleaner comprising a liquid containment tray 7 having a bottom wall 10 and four upstanding
35 side walls 12. Cleaning liquid (detergent and/or sanitizing liquid) is disposed within the tray to a level designated by numeral 14.

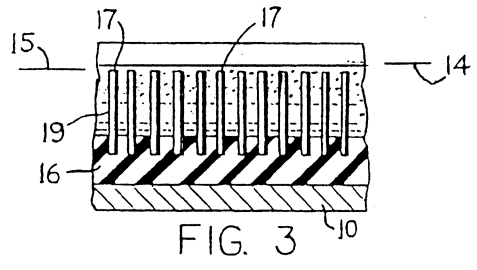
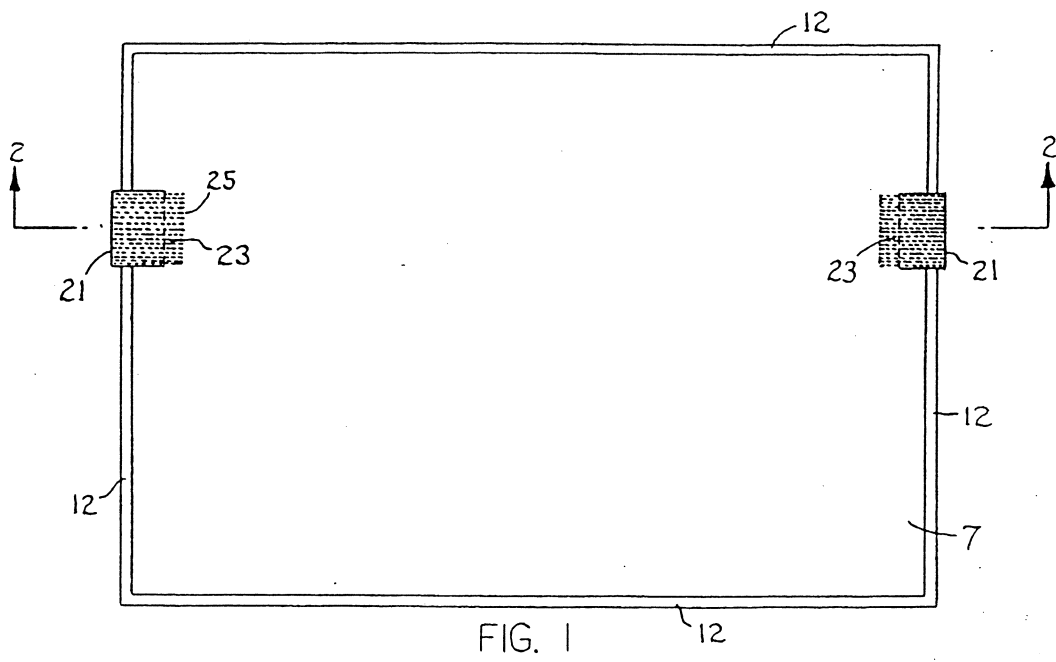
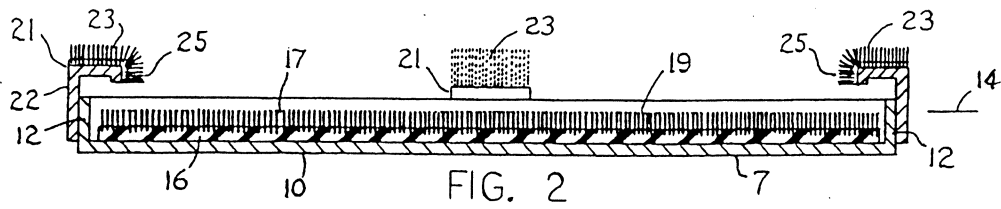
A shoe sole-engagement mat structure 19 is supported on the
40 tray bottom wall. The mat structure comprises a flexible backing sheet 16 formed of rubber or plastic material. The mat structure also comprises closely spaced bristles 17 extending upwardly from sheet 16. The bristles are formed of relatively stiff plastic material, whereby the bristles bend
45 only slightly under the weight of a person's shoe. Each bristle 17 has a lower end portion embedded in backing sheet 16, whereby each bristle assumes a vertical position in tray 7. Each bristle has a preferred length of about a three quarter inch. The bristles are closely spaced, e.g. on the

order of 0.03 inch or less. The bristle upper edges define a plane 15 located a slight distance below liquid level plane 14: see Fig. 3.

- 5 In use, the bristle edges scrape against the wetted shoe sole surface to remove soil from the shoe surface.

- 10 Auxiliary shoe cleaner components 21 are affixed to selected ones of the tray side walls to supplement the cleaning action of mat structure 19. Each auxiliary cleaner component comprises an L-shaped bracket 22 having its upper surface and inner side surface covered with a carpet material 23.

- 15 Carpet material 23 provides a vertical cleaner side face 25 that can be engaged by an edge surface of a shoe sole that might not be easily engaged by aforementioned bristles 17.



GB-A-2 300 400 - K. Curry
(EXTRACT)

Filed : 10 March 2001

Published : 18 September 2002

BRUSHES

A brush as shown in Fig(s). 1 and 2 (Fig. 2 is a section along II-II indicated in Fig. 1) is especially suitable for cleaning dirt from clothes, footwear, soft furnishings, carpets, curtains and the like. It is especially effective for removing pet hair.

The brush has an operative surface (14) moulded from elastomeric or resilient material, e.g. natural and/or synthetic rubber, so as to provide an array of projecting bristles (16) which displace and grip dirt, and especially hair, which may be clinging to flexible objects such as those mentioned above. To help grip particularly obstinate hairs the surface can be wetted. The bristles are integrally formed with the operative surface (14) in a generally even distribution, typically with from 1 to 4 bristles per square centimetre. They are preferably between 1 and 5 mm in diameter and between 1 and 5 mm high.

The rubber layer providing the surface (14) may itself be made thick and stiff enough to constitute the brush e.g. with a peripheral reinforcement (18), or it may be supported by a discrete backing plate and/or handle (not shown).

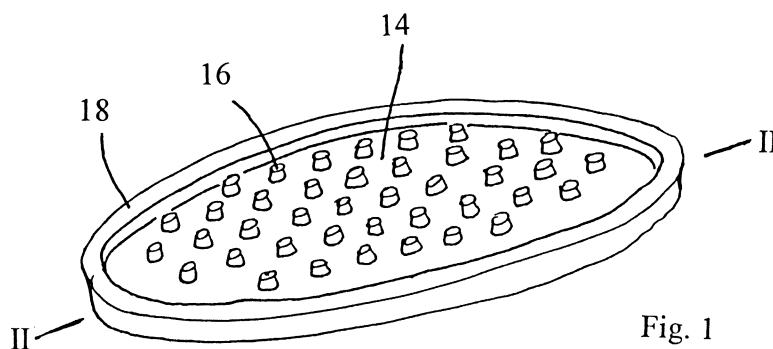


Fig. 1

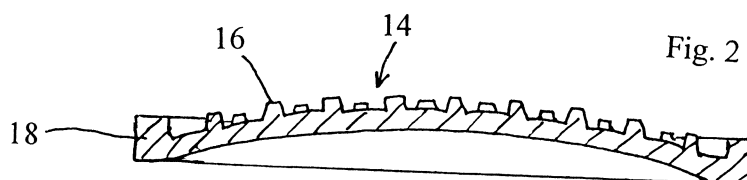


Fig. 2

THE JOINT EXAMINATION BOARD

EXAMINERS' COMMENTS

NOVEMBER 2003

PAPER P4

Amendment of Specifications for United Kingdom Patents, Applications in Prosecution, Revocation Proceedings or otherwise

GENERAL

P4's aim is to test candidates' ability to respond by amendment and argument when documents are cited against the client's patent application (or patent), with objections from the Patent Office (or from an applicant for revocation). As explained in the syllabus candidates are expected to show a detailed knowledge of "all aspects" of patent prosecution and revocation

Usually the question is set up to require and enable preparation of a full response for filing at the Patent Office. The Examiners want to see that the candidate can

- understand a patent /application written by somebody else, and interpret its claims;
- assess the relevance of cited documents to what is disclosed and claimed;
- see what amendments could be made to cure any invalidity;
- understand and assess objections raised by the Patent Office or opponent, and
- (crucially) identify in the light of the circumstances set out in the question which among possible lines of response best furthers and protects the client's interests.

Candidates must then show understanding and control of language, logic and argument in preparing claim amendments and a letter replying to the objections. Candidates must understand fundamental prosecution strategy and legal constraints affecting amendment and division, in particular the prohibition on extending the original disclosure (Section 72(1)(d)(e) and Section 76).

Because the Examiners are looking for strategic judgement in prosecution, the scenarios presented vary from year to year. However candidates should note that because the Examiners want to test the abilities listed above, a correct answer is unlikely to involve extending time limits or deferring major issues while further enquiries are made of the client. For the same reason, procedural niceties play only a small role although there may be a few marks associated with acceleration of prosecution and the like. Candidates have the opportunity to demonstrate the reasoning behind their strategic judgement in a client memo or other work product as specified in the question. This is discussed in more detail under the heading "approach" below.

Divisional filing can be an important strategy. The question routinely explains to candidates how they should deal in their answer with any proposed divisional filings. Candidates are reminded however that divisional filing is not necessarily expected. In real practice divisional filing although important is an exception. The Examiners look very hard at candidates who purport to "protect the client's position" or "maximise protection" by proposing divisionals for each and every novel feature. In the exam, as in real practice, you must discriminate to succeed.

MARKING

The form and content of proposed claims usually attract a large proportion of marks; typically about half. The remainder of the marks will then be divided, often about equally, between

the letter to the Patent Office and the memorandum of points (or client letter, if a letter is requested). In order to avoid hinting at acceptable answers detailed indication of the mark allocation is not given in the question.

APPROACH

Good answers to P4 are often no more than six pages of writing. Time spent ensuring a good and thorough understanding of the patent/application and its relationship to the prior art, so that this can then comfortably be linked to the client's aims, is time well spent. Sensible approaches giving well reasoned arguments as to why that approach was chosen over others are sought.

Candidates should take pains to record points for the requested "memorandum" (or client letter) as specified in the question. Claims do not usually explain themselves, and letters to the Patent Office naturally pass over many issues. So, a memorandum of points is where you show the Examiner that you know what you are doing. The briefest note form is acceptable for a memorandum, provided that it can be understood.

There might be typically:

- assessment of the prior art, explaining in particular why amendment is needed (rather than simply stating for example that claim 1 is not new over document A, candidates gain marks by explaining why claim 1 is not new over document A);
- discussion of amendment options, their pros and cons in the light of the client's comments, and any other surrounding factors, and showing awareness of any problematic or arguable technical points e.g. in the prior art;
- justification for the choice of amendment made, and for any other strategic decision e.g. to make a divisional filing;
- indication of awareness of any questionable issues of basis, unity or clarity;
- indication of any potential fall-back positions should the amended independent claim not be accepted by the Examiner;
- discussion of tactics and or commercial aspects with regard to any competitors mentioned in the question or similar points arising in the question.

2003 PAPER

INTRODUCTORY

The invention in this paper was a doormat having a wet-cleaning area. The Patent Office letter cited three earlier documents as destroying patentability and alleged lack of clarity in some of the claims. Instructions from the client

- made clear that no further instruction would be available for preparing a response;
- (as usual) failed to understand the objections, but
- set out some helpful commercial background, including the existence of a competitor Footsore believed to be marketing a range of moulded rubber "wet cleaning" mats about which however not much detail is given.

The client's original main claim was as follows:

"A doormat provided with a raised rim to define a shallow container for water and having upwardly extending flexible members at least some of which are within the rim so as to protrude above the water level."

CLARITY POINTS

A clarity objection was directed to claim 1's reference to "the water level". Most candidates appreciated the rather weak formal point that this lacked an antecedent, but relatively few considered the substantive meaning of the language, and the implications in a product claim of language which concerns the manner of use of the product. Really, the only definition that can be derived from the "water level" feature is a **maximum** water level that the mat will take. For example the prior art Jones mat could easily be half-filled so that the bristles protrude above the water level. Some candidates dealt with this objection by specifying that the mat is actually filled with water, thus unnecessarily limiting the client's options should there be illicit copying. Candidates were expected to realise that this claim feature was almost without effect but nevertheless was arguably clear, or deletable from the claim without harm.

The problem with claim 2 is that claim 1 does not require that there be any flexible members outside the rim, so there is no proper antecedent for "those outside the rim". Surprisingly few candidates appeared to understand this. Alarming, some candidates appear to have limited claim 1 to require flexible members both inside and outside the rim - a serious limitation - solely to meet the clarity objection against claim 2.

NOVELTY

One of the cited documents (Curry) was an intermediate publication and thus available only for attacking novelty. Curry's document described a brush, suitable for a variety of hand-held uses. A brush as described is not a doormat, and candidates were expected to assert novelty on this basis alone. [e.g. with reference to the "Workmate" case, Hickman v. Andrew]. However, a number of candidates introduced additional claim limitations to provide novelty over the Curry document.

Candidates were expected to note that the Smith and Jones documents destroyed novelty so that amendment was required. Most candidates appreciated this but fewer gave a clear identification of the features of Smith and Jones that anticipated.

The application disclosed several technical features which were novel.

In the Examiners' view the fact that Footsore makes moulded rubber mats, and the client's comments about the commercial advantages of these coupled with the lack of much detailed information about the Footsore mats, indicated that an all-moulded wet-use mat would be a good and broad choice of amended claim 1. The application's disclosure of this feature was clear, although not in an existing claim or claim-type statement so that candidates had to word the amendment themselves. Candidates were expected to realise that they are at liberty to select any novel feature properly disclosed in the application as filed, even if not present in the original claims.

Claim 1 limited to a two-region or "wet/dry" mat is more severely reduced in scope and not clearly applicable to the Footsore mats, but is emphasised in the description as having considerable advantages. Candidates could score useful marks for this claim too. Care was needed to avoid the Smith and Jones documents. In either case the wording introduced had to be clear and provide novelty without undue limitation to score good marks.

A significant number of candidates lost a lot of marks by introducing two (or more) new limitations - in some cases, limitations that had little to do with one another - when one was sufficient for novelty.

Some claims alleged novelty in specified flexibility of the bristle members, allowing them to dip into and out of the water. These did not convince in view of the Smith prior art, where when the user's shoes rest on the support 20, some bristles 91 must surely be pushed into the water. Candidates were expected to notice that the Examiner's reference to the supports 20 was technically wrong.

Candidates need to be aware of the implications of dependent claims. Some introduced a sub-claim specifying waterproof material for the doormat. This has unfortunate implications for the scope of claim 1. There were also some marks for curing the clarity points and supplementing the dependent claims.

There were several options for potential divisional applications, but most of these were of limited practical value in the Examiners' opinion. The client's letter does not show any clear need. However where the main claim had been amended to specify the all-moulded feature, a divisional to the "wet/dry" feature attracted marks and vice versa.

INVENTIVE STEP / PATENT OFFICE LETTER

The standard of argument here varied widely. A convincing argument (and a proper explanation to the client) requires acknowledgement - implicit or explicit in the response letter - of how close the prior art is. It also requires a chain of logic tied to claimed features. Thus, candidates who adopted the "moulded" feature were expected to note the existence of previous dry-use all-moulded rubber mats (application: page 1 first and second paragraphs), and candidates who used the "wet/dry" feature needed to make sensible comments about the absorbent area 51 in Fig. 5 of Smith and the auxiliary components 21 in Jones. As an example of the logic point: several candidates adopted the taper of the flexible members as a distinguishing feature (which in itself gained low marks) and argued that the taper made the mat easier to release from the mould. But, their claim did not specify a moulded mat.

CLIENT MEMORANDUM

As is often the case, many candidates apparently left the preparation of the "client memo" until the last minute and missed out on marks accordingly. In this paper 50% of the marks were available for the claims, with 25% for each of the letter to the Patent Office and the client memo. While this distribution will not always be the same, in general the ability to explain what was needed, why it was needed and how it was achieved is an important element in the overall answer, and one which frequently throws light on the candidate's suitability to practise in the profession. Candidates should treat this part of the question seriously and allow adequate time in which to record points on their memo. Points can be accumulated in rough note form during the reading stage, and selected and clarified later.

In the present paper the memo enabled the candidate to explain for example why their amendment was chosen, what alternatives there were, what fall-back positions were available, what divisional applications might or might not be filed, what time was available for such steps, and to enquire into Footsore's activities.