

## 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.

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## 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.

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### 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.