

EXAMINERS' COMMENTS

PAPER P4: GENERAL ISSUES

(1) GENERAL APPROACH

A P4 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 - this will require skill in dealing with novelty and obviousness issues;
- understand and assess objections raised by the Patent Office or opponent;
- (crucially) identify, in the light of all 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 show understanding of fundamental prosecution strategies 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 very unlikely to involve simply deferring the apparent major issues while further enquiries are made of the client.

The instructions from the client give indications to the candidate about the kind and scope of protection that the client desires, in relation to market and likely competition. The proposed amendment should provide the proper protection to benefit the client's business, while meeting objections raised by the examiner. Candidates may be expected to counter weak or incorrect objections by argument alone.

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 that divisional filing is not necessarily expected. In real practice divisional filing although important is an exception. The Examiners look with suspicion at answers that purport to "protect the client's position" or "maximise protection" by proposing divisional filings for each and every novel feature. In the exam, as in real practice, you must discriminate to succeed. Divisional filing proposals are of course almost always possible, but not always necessary or appropriate. The marks available in a given paper for any such proposals will vary accordingly.

(2) MARKING

The claims usually determine a large proportion of the available marks; typically about half. The remainder of the marks are divided, often about equally, between the letter to the Patent Office and the memorandum of points (or the client letter, if a letter is requested). To avoid hinting at acceptable answers, specific indication of the mark allocation is not given in the question.

In the 2005 paper the allocation was: claims 43 marks, response letter 29 marks, memorandum of notes 28 marks. By request, a copy of the marking schedule used by the Examiners is attached. This should be referred to with awareness that it cannot be more than a guide to the marking. P4 is not a list of questions with individual clearly-defined answers. It is a single question with a single complex answer. Equally good answers may differ widely. There is great scope for variation among answers with respect to elements which may significantly affect the marks awarded, but which cannot meaningfully be itemised. The available marks are grouped into categories and the numbers of marks available in respect of certain elements approximately predetermined, to assure general consistency of marking between the Examiners. Each script is marked by two Examiners.

The marks given also depend on how self-consistent the answer is. It cannot even always be said that, just by mentioning a certain point, marks will be gained. A candidate who accompanies a correct element or argument with another one entirely at odds with it risks getting few or none of the available marks. Also, the Examiners want to see that the candidate lit upon the chosen claims and arguments for genuine reasons. The memorandum of notes can be important in this respect.

The marking schedule gives a version of claim 1 thought by the Examiners to be good, but it must not be thought that only a claim closely similar to this one would get good or adequate marks. Where “negative” amounts are indicated, these are not for differences relative to the specific sample claim shown, but indicate a reduction in the maximum marks available for any claim deficient in the manner identified; the actual mark obtained out of that maximum will still depend on the overall drafting quality.

(3) PRESENTATION OF ANSWER

The best answers to P4 are often the shorter ones. Time is well spent reading and thinking, to ensure a good and thorough understanding of the client's patent application and its relationship to the prior art, so that this can then comfortably be linked to the client's aims. A sensible practical approach, accompanied by reasoned arguments and explanations as to why that approach was chosen, is what is wanted.

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, the memorandum may require more detail than a real life file note, meeting note or letter. Candidates should use this as an opportunity to explain the decisions taken in other parts of the paper, i.e. to “show the working”. 28% 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 seriously incomplete, struggled to pass the paper overall. Brief note form is acceptable for a memorandum, provided that it can be understood. Complete sentences are advisable.

Thus, there might be notes indicating:

- assessment of the prior art, noting specifically why amendment is needed (rather than simply stating that claim 1 is not new over document A, candidates gain marks by noting what in document A anticipates);
- discussion of amendment options, their pros and cons in the light of the client's comments, and any other surrounding factors, 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 significant questionable issues of basis, unity or clarity, whether or not raised by the Examiner;
- indication of 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.

In real life, some of these explanations give a client the chance to see why you have chosen a particular approach or claim wording, and to expose any wrong assumptions.

Order of presentation is not crucial, but the Examiners prefer the response followed by the memorandum. In the response, most candidates put the claims before the letter which isn't realistic, but the Examiners like it because it puts the most important things first. There is a recent trend for sub-claims to be presented on a mass of pages, with one tiny claim on each. Presumably this is to leave room for subsequent insertions, but it is taken to unnecessary extremes.

The Examiners do their best, but find parts of some scripts very difficult to read. Candidates should have in mind that if parts of the answer are genuinely illegible, the Examiners cannot give marks for them. Candidates should also beware of submitting all of their written materials, including working notes and scribbles. Everything submitted is part of the answer. If the script apparently contains two conflicting approaches to the same issue, and the Examiners cannot tell which was finally intended, the candidate risks not getting marks for that issue. Like attorneys, candidates must take responsibility for deciding what the answer is.

P4: 2005 PAPER

(1) PRIOR ART

Candidates were expected to note that the GB document was prior art by virtue of Section 2(3) only. The EP prior art clearly anticipated claim 1 so that amendment was needed. In the Examiners' view the GB document also anticipated: see section (4) below.

(2) CHOICE OF AMENDMENT

There were two main lines of amendment giving a decent main claim, and almost all candidates went for one or the other of these two although the quality of drafting varied widely. The two main options were

- an angled lay-up of the bristles and
- the use of discrete holding members or holding tubes in the process.

The Examiners preferred the latter option, because being a true "process" invention it followed on more naturally from the invention and method claims as originally presented.

There is a clear indication in the client's letter that this feature is being used by the competitor and is important in practice.

However, it is clear from the client's letter that the "angled bristles" invention provides considerable advantages and is used in the competitor's products. These advantages are largely "product" advantages, so the feature lends itself to a product claim instead of or in addition to a method claim. A product claim to a seal with angled bristles, independent of the production method, was a valuable claim (which however few candidates proposed). For this reason the Examiners were prepared to give as many marks for the "angled bristles" option as for the "discrete holders" invention, if well presented with both product and process claims. The description in the application on pages 6 and 7 has basis for the product claim, and explanation of the relevant advantages. Presentation of this method-independent claim in the pending application might cause upheaval in the examination/search procedure, so it is probably more appropriate to a divisional filing.

It is clear from the client's letter that large quantities of money are being spent (on a new factory) so that the additional cost of a divisional filing should not be an obstacle.

Because in this particular paper the amendment presented a number of additional drafting issues - discussed below - the Examiners were prepared to give most of the available "claims" marks for a choice of either one of the main lines of amendment, since both covered the infringer's activities. It was not necessary to claim both, and propose a divisional, in order to get a pass.

A number of candidates proposed divisional applications to apparatus for making the filled tubes, and even to the filled tubes themselves, but these gained few marks.

(3) DRAFTING ISSUES

The paper presented a number of drafting issues which many candidates overlooked entirely, while those that did address them did not always do so convincingly. Probably for that reason, there were few very high marks despite the high pass rate.

(a) An issue which definitely should have been addressed, because the Patent Office raised it, was the reference to "radial" bristles in claims 1 and 4. The application's disclosure gives scope for dealing with this in various ways. It was important to present a coherent approach. One way is to say that even "angled" bristles project substantially or at least partly radially, and that this is how the term is used in the application on page 6. The term could then be left in claim 1, and claim 4 clarified using "true radius". Or, the options (truly radial, angled away from the true radius) could have been separately specified either in the main claim or in dependent claims. [But, see (b) below]. Most candidates did not deal with this satisfactorily.

(b) A separate issue, not raised by the Patent Office but hinted at in the client's letter and clear in the application itself, was that of whether the claim had to be or should be limited to circular seals. No situation with a non-circular seal was presented, but the feature was clearly not conferring patentability and the description clearly says it is not required. Marks were therefore available for broadening the claim to non-annular seals. Doing this required confidence in amendment and a self-consistent approach. Where the candidate had gone for the "angled bristles" claim, it was difficult because there is then no "radius" to define against. Numerous candidates tried to broaden by deleting the reference to "annular" at the end of claim 1, but left the "coaxial clamping rings" in the earlier stage so that the broadening

was ineffective. However a number of candidates saw that the clamping members could reasonably be renamed as “plates”. With relevance to point (a) above: candidates who removed the restriction to annular seals should realise that references to “radial” then became meaningless and should have been clarified or removed.

(c) The Patent Office had objected that the main method claim should include the step of cutting. A response is needed. Many candidates simply ignored the objection, which did not earn marks.

Others introduced the cutting step, and this was an acceptable response. However a surprising number introduced it into the claim after the step of fixing (welding), even though in the only example given it precedes it (page 5). This ordering would not seem completely impossible, but none of the candidates concerned gave any justification for their choice.

Some resisted the objection, and argued that the cutting step need not be included in the claim. Marks were awarded for reasonable argument, e.g. with reference to page 5 line 15 (although this passage does immediately follow a description of the cutting at line 13). It could be argued for example that the cutting, although practically essential per se, was not an essential feature of the newly-claimed concept involving the discrete holders. Or, that it was not actually essential because you could get a complete seal just by pulling the discrete holders off the bristles, without cutting. [The Examiners tended to the view that in practice cutting would be necessary: after simple removal of the holders the ends of the bristles would probably have to be extensively finished to make the circumference uniform.]

(d) Where candidates drafted claims to the “angled bristles” invention, the Examiners were looking for awareness that saying “at an angle to the radius” is vague and, depending on context, may not distinguish from truly radial. Then, the awareness should be followed up with appropriate and self-consistent claim drafting or interpretative comment. For example, candidates could have drafted an unambiguous distinction by referring to bristles angled away from the radius, or oblique with reference to the geometrical or true radius. There is plenty of basis for this in the description text. Or, candidates could have asserted in their response that when interpreted in the light of page 6, “at an angle to the radius” clearly means at a non-zero angle. Too often a weak definition was presented without comment, support or apparent awareness of the issue.

(e) Some candidates included the manufacture of the bristle bundles as a step in their method claims. This seems an undesirable limitation, and better left in a sub-claim. Claim 1 could just refer to “providing” the bundles.

Some described the discrete bundles in the claim by saying that their angle of inclination to the radius **could** be varied. This does not really make sense in a method claim.

(f) Product claims or product-by-process claims corresponding to the “discrete holders” method claim generally got no marks, since in general they lacked novelty and/or gave no protection beyond that of the process claim. The same applied to omnibus claims directed to a seal product, unless perhaps that of the claim 5 method, or of course a method including the angled bristles.

(g) Dependent claims should have been added where appropriate. Where the “angled bristles” option had been chosen for the main claim, there was little scope for additional dependent product claims, because the description contains little additional information. However whichever option was chosen for the main claim, the other option could have been included as a dependent method claim. The “discrete holder” option gave some options for

dependent claims, including reusable tubes and use of adhesive. See the marking schedule. Many candidates offered no additional dependent claims at all.

(4) PATENT OFFICE LETTER/ARGUMENTS

(a) The letter should explain the amendments made, and where appropriate reassure the Patent Office that they correspond to information in the original application made. On the whole, candidates did this well.

(b) The response was overdue, so that a two-month extension (obtainable as of right and retrospectively) should have been requested. Many candidates overlooked this, missing easy marks.

(c) In relation to the prior art, novelty and inventive step needed to be asserted properly. This is done by describing the difference clearly and saying why it is significant. Even for a pure novelty point it is worth saying why a difference is significant, because it shows that it is a real difference and not merely a matter of wording.

For example, many candidates with claims to the “discrete holder” invention elaborated at length on the fact that the prior art did not show such discrete holders, without saying anything about their significance i.e. that they make the bristles easier to handle, so that you can move them around and set them to any angle you want.

(d) Some candidates argued that claim 1 was novel over GB because GB did not disclose a “jig”. The Examiners were usually not convinced by this. Firstly, “jig” is such a general word that the distinction is intrinsically unconvincing, even though GB doesn’t describe how its clamping rings are “arranged”. Secondly, although we don’t have “file wrapper estoppel” here, it’s surely undesirable to suggest for posterity that the term “jig” means something narrower than “any support which provides sufficient alignment”. Almost all candidates had introduced another clearly novel limitation into their claims, such as the tubular holders, so that the argument was unnecessary.

(e) Not many marks were available for inventive step, since there was only one document to argue over. Arguments for inventive step must be linked to the features of the main claim presented. A number of candidates erred in this respect.

Arguments are not strengthened by using underlining or rhetorical phrases such as “in no way discloses...” and the Examiners suggest not doing this. Almost invariably, parts of candidates’ answers phrased in such a way were weak in content.

(f) As mentioned previously, candidates needed to deal with the “radial” clarity issue. Few did so.

(g) Finally, a large number of candidates went to lengths to explain how their amended claim covered both inwardly and outwardly extending bristles. Generally this did not gain marks. The paper did not seem to lay stress on this point, save that obviously one should not gratuitously exclude either possibility. Admittedly the client’s letter mentions both, but the claim always covered both so that there seemed little to discuss. Sub-claims specifying (while covering both of) inward and outward bristles were not awarded marks.

MEMORANDUM OF NOTES

Most relevant issues have been mentioned in the “General” section above. In the present paper, the Examiners were looking for some assessment of the patentability prospects of the chosen amendment, of the usefulness or otherwise of any proposed (or already filed) divisional, and of the level of confidence that these would cover the competitor’s activities. Some comments on the value of process claims earned marks. The possible significance of the competitor having a former employee of the client, indicating likely infringement of method claims, was also relevant here.

Marking Schedule

Claims	43
Claim 1	25
Suitable claim 1: 1. A method of manufacturing a brush seal element comprising the steps of: preparing a plurality of bundles, each bundle comprising a discrete holder within which multiple bristles are held; positioning said plurality of bundles of bristles on a carrier member such that the ends of the bristles project from the carrier member; clamping the bristles projecting from the carrier member between a pair of clamping members located on a brush seal assembly jig; integrally joining the clamping members and the bristles such that the resulting seal element has radially extending bristles; and severing the bristles part way between the discrete bundles and the clamping plates. “tube” instead of “holder” is equally acceptable. removing all reference to clamping rings desirable as removes all reference to annular brush seals	25
Placing severing step before joining, or other examples of misrepresenting the method steps as being in a specific (wrong) order.	-4
Alternative answer: Removing “annular” and limiting to the angular lay-up This method claim is almost as good. The letter points to this answer too, so don’t over-emphasise relative importance of first claim above. 25 marks awarded if this “angular” claim is accompanied by a valid product claim.	20
Defining the angular lay-up in a manner which does not exclude the radial direction	-3
Faults common to both paths	
Not removing annular	-3

Not adding the severing step and providing no justification for doing so.	-5
Other claims	14
Claim to brush seals not rewarded – no novelty in the product (unless angled, of course).	
Dependent claims:	
Angled bundles (if option 1 main claim)	2
Reintroducing the annular shape	1
Preassembly of bundles(if option 2 main claim)	2
Reusable tubes	2
Predetermined number of bristles	1
Reference abutment face	1
Amend claim 4 for consistency	2
Omnibus claim	1
Device for manufacturing a brush seal element	3
Divisional Claim	4
Divisional claim to “other” amendment option	4

Response	29
Extension of Time	2
Basis for amendment: if amendment is wrong then fewer marks available:	9
Amendment option 1	
- removal of ‘annular’ (p7 line 21)	2
- holding bristle bundles prior to assembly (p4 line 25)	2
- cutting to length (p5 line 13)	2
Or	
Amendment option 2	
- removal of “annular”	2
- angular alignment	2
Amendment of claim 4 (if required given amendment to claim 1 – mark awarded if candidate recognises no amendment to claim 4 required)	1
Basis for new sub claims	2
Novelty	4
[2 marks per document – generally comparative and dependent on a novel amendment. Good amendments will render all 4 marks available]	
Noting section 2(3) prior art	2

Inventive Step	4
Use appropriate arguments in support of IS – not credit if arguments do not relate to the claim submitted	
Clarity and support	4
Severing – adding feature removes problem	2
Addressing issue with claim 4	2
Other points	4
Request acceleration	2
Requesting opportunity to file divisional before grant	2
Notes for memo to client	28
Explain need for amendment	2
Explain amendment	3
- Avoided prior art by amending to...	2
- Noting only needed to distinguish from s2(3) prior art – IS not necessary	1
Explain impact of amendment:	4
- removed feature to ensure maximum protection	2
- inserted feature to distinguish from prior art but impacts on scope	2
Amended claim 4 to clarify scope – or note the absence of a need to do so	1
Added claim to jig to enhance protection	2
Discuss other options for amendment	5
- recognise that sub claims don't provide good options for amendment and that new sub claims provide suitable fall back positions should this be required	2
- identify other option for claim 1 (angled lay up/pre-bundling as the case may be)	3
Showing we cover preferred embodiments	2
Extension of Time – note that no loss of rights has taken place	1
Other advice	8
Suggest divisionals –need to decide quickly as acceleration requested	2
Options for dealing with Generic – early grant, warning with copy of granted patent (not pending application)	3
Practicality of method claims (product of process theoretically covered, but...)	2
Note possible impact on provisional protection by amending claims	1