

P6 EXAMINERS' COMMENTS

I. General Remarks

In real life infringement and validity cases there are usually at least two possible arguments or approaches and this year's P6 was no exception. As a result a number of candidates concluded that claim 1 was not infringed. This was a perfectly acceptable scenario and if well reasoned, such candidates could pick up most of the available marks for analysis of that claim and achieve an overall pass, but if such candidates did not explore possible alternative interpretations that might lead to infringement, they generally lost the opportunity for significant numbers of marks for considering infringement of claims 2 to 7. Marks are available for considering infringement and validity (novelty and obviousness) of all claims.

While it is important to decide on a construction and apply it to the features of the claims, from the comments below, it can be seen that candidates who are blind to an alternative possible infringement interpretation will do their client a disservice and will lose the opportunity for marks by focussing only on a non-infringement argument. Candidates who found for non-infringement of claim1 but also identified possible infringement interpretations and advised how, in negotiation, counter-arguments would be presented in favour of non-infringement were able to pick up all or the majority of available marks (assuming an adequate use of interpretation was made).

On validity, many candidates found claims not to be new but failed to consider the possibility that a claim might be new, and so lost out on the opportunity for marks in discussing obviousness. The Examiners recognise that in some cases it is difficult to discuss obviousness when a claim is not new. However, candidates who ruled out any possibility of a finding of novelty on an alternative construction, and therefore did not attempt inventive step of claim 1 or 2, missed out on some of the marks available for a full discussion of inventive step.

For example, most candidates found claim 1 not to be new having regard to Document D. This is a sound conclusion. More thorough candidates raised the

possibility that the secure gripping provided by teeth (6) at the front part of the tool might provide gripping for purposes of rotation, but not necessarily amount to retaining means suitable for removing and storing. (Does the cap fall out when you tip the tool up?). A proper discussion of obviousness vis-à-vis Document D includes identification of a feature that may not be provided by Document D and analysis of whether that feature is obvious having regard to common general knowledge or Document C.

Similar comments can be made in relation to claim 2 (is the front end of the tool necessarily a cup? Are the teeth of the front end equivalent to a plurality of spaced ridges diverging outwardly?). Most candidates recognised that claim 3 was novel vis-à-vis Document D. Similarly, most candidates recognised that the “knurled surface” of claim 4 conferred novelty. A few candidates spotted that the air pressure gauge 12 of Document D has a pin that is adapted to be inserted into the valve of a tyre. Does this mean that claim 5 lacks novelty? It has to be considered whether the pressure gauge is “the opposite end” of the accessory and whether “the opposite end [of the accessory] is adapted... to release air from the tyre”. Most candidates who addressed the question concluded it is not. In the case of claim 7 one can consider the obviousness/inventiveness of providing a kit of parts.

For each of these claims there is ample room for discussing inventive step. Analysis need not be lengthy. Indeed (in this case), a short paragraph or two is all that is required to select a point of novelty in claim 1 and analyse it vis-à-vis Document C and/or common general knowledge, whereupon the further analysis of each independent claim need amount to only a sentence or two.

The better candidates concluded that the Patentee could amend to the features of claim 5 (or the feature of a tapered point described at page 8 lines 60 to 61) or claim 6, to result in a claim that is new and has a reasonable chance of being found valid, but that claim 5 could easily be avoided by a re-design and claim 6 is not infringed.

Some candidates concluded that claim 1 is not new and “therefore” claims 2 to 7 are also not new, or that claim 1 is infringed and “therefore” claims 2 to 7 are also infringed. Not only did such candidates lose the opportunity for many marks by

failing to adequately discuss the dependent claims, but also little or no discretion was exercised in marking papers with such serious errors. Such candidates were likely to fail. Candidates should take great care not only to avoid unintentional errors in such statements, but also to avoid misunderstandings that might lead the Examiner to believe that the candidate does not understand the concepts behind dependent claims.

The following table shows how the marks were allocated for the four major sections of the paper. It can be seen from this that as usual the majority of marks are found for discussion and reasoning of features found in claims 1 and 2. In this year's paper the emphasis was on interpretation and novelty. Marks are spread relatively evenly throughout the paper which should be evident since there were clearly considerably more issues in claims 1 and 2 than the sub-claims and claim 7. The fact that claims 1 and 2 accrue higher marks is a result of the number of features to discuss and not a cue for candidates to write pages of general speculation. Candidates should address all features in a concise fashion, demonstrating the ability to judge which features are important by the reasoning provided.

Claims	Interpretation	Infringement	Novelty	Inventive step
1	8/9	5/6	8	3
2	5/6	5/6	9	2
3	2	2	3	2
4	2	2	4	2
5	1	1	2	2
6	1	1	2	2
7	3	3	2	2

The variation in marks for claims 1 and 2 for interpretation and infringement allow the Examiners to allocate marks flexibly. In addition to the marks identified below for sufficiency, amendment and the letter of advice, there were two further marks "floating" for the Examiners to use at their discretion. More specific remarks are provided below.

II. Interpretation

Candidates can accrue a good proportion of the available marks for the examination by methodically breaking up the claims and addressing the individual elements or words. Many nuances can be missed by not adopting a methodical approach. As a general rule (not absolute), if there are 8 marks for interpretation then there are probably about 8 features worth making a comment about ranging from stating what “comprising” means in the claim to an explanation of what “torque” means in the context of the patent. The following are a few remarks about specific features.

Claim 1. Candidates should note that the tubular member is a part of the accessory and that it is the tubular member that has “one end” and “the opposite end”. Many candidates incorrectly applied these terms to the accessory, rather than the tubular member.

“suitable for” needs interpreting. Note that the bottle cap remover of Document C is not suitable for removing a tyre valve cap as a result of its size unless the tyre valve cap is exceptionally large (perhaps for an aircraft or a tractor).

The patent’s description is unhelpful in determining what is meant by “reducing the amount of torque required”. The candidate can be sure that if it is important to know the precise definition of a term of the art, the definition will be given. The Examiners appreciate that candidates are from different fields of technology and do not expect anything more than an expression of ability to think laterally. Therefore, it was not necessary for the candidate to understand that torque = tangential force x radius. Many candidates validly took the view that the author is using the term “torque” more colloquially to mean the applied force or effort required to rotate the valve, which might indeed include gripping force (i.e. radial force). Perhaps it is the knurled exterior surface 8 that improves grip and therefore permits rotation with reduced force (equal tangential force, but reduced radial force)? A detailed analysis of torques and forces was not required, provided the

candidate gave rational and consistent reasoning as to the interpretation based on the disclosure of the patent.

N.B. the term “torque” is used informally as a general expression in Document B and more correctly in Document A. Note also that a term can have different meanings in different documents.

- Claim 2. Marks were available for discussing whether a cup necessarily has a base (relevant when it comes to considering novelty vis-à-vis Document D) and for considering “spaced” and “ridges” and “diverging outwardly”. These terms are all relevant when considering infringement and when considering novelty vis-à-vis the “notching or grooving 7” of Document C and the “teeth 6” of Document D.
- Claim 3. The interpretations applied to “from 10° to 20° with the axis” were many and varied. A great number of candidates stated that a purposive construction should be applied, and promptly threw the author’s specific limitations out the window. Neither *Catnic* nor *Improver* nor *Amgen* permits the reader to disregard strict limitations set out in a claim. The client’s device has an internal taper at “about 10°” to the axis. At issue, therefore, is whether the lower end of the range “10° to 20°” encompasses “about 10°”. In the interpretation section, one can consider rounding approximations. Later, when it comes to infringement, one can consider manufacturing variations/tolerances or possible re-design.
- Claim 4. Greater diameter than what? Some candidates took the view that the repercussive effect of claim 4 on claim 1 is that torque reduction does not require that the opposite end is of greater diameter [than the cap]. This is an intelligent discussion, but not the only conclusion. Claim 4 may simply give structural clarity to the functional definition of claim 1.

Claim 5. Some candidates had difficulty identifying how the “opposite end” could be adapted to be inserted into the valve of the tyre, when the arrangement of Figure 1 is not so adapted. Page 8, lines 60 to 61, explains how the end 7 can be extended to a tapered point. Clearly this is not the embodiment shown in Figure 1.

N.B. One might consider whether the “tubular member” is the end 1 or the end 1 in combination with the middle 9 and the end 7. All are possible. All are consistent with the embodiment in which the end 7 extends to a tapered point. Many candidates, however, failed to notice that the end 1 is in itself a tubular member. Some candidates even considered that “tubular” does not necessarily mean hollow. A tube that is not hollow is more properly called a “bar”.

Claim 6. This claim presented few difficulties.

Claim 7. Many candidates wrote at length interpreting “conventional” and “designer” and “specifically adapted to cooperate” but failed to consider the term “kit”. A collection of items made and sold separately do not necessarily form a kit of parts. Consideration should be given as to whether a “kit” means that the parts are packaged, sold, or offered for sale as a set.

III. Infringement

Candidates had to decide whether the client’s device contained two of the claimed features in particular, i.e. did it “comprise a tubular member” and explain why; was the “opposite end” “adapted” to facilitate rotation by reducing the amount of “torque” required – how and why; was the retaining means suitable for “storing” – how and why. It can be seen straight away that here are five features to discuss using your interpretation and then in addition it is necessary to mention that the remaining features are present and why e.g., the client states that his device is a vehicle accessory, candidates should mention this pointing to the statement in the client’s proposal. By providing reasoning, the five or six marks available to the candidate are

easily obtained. Candidates should remember that in order to prove infringement it is necessary to show that all features of the claim are present in the client's device.

Candidates who found infringement of claim 1 generally followed one of two lines of argument, and the Examiners were prepared to accept either, for example:

- (A) "comprising a tubular member": "tubular" means something which is shaped like a tube, like a pipe or a cylinder but it does not have to be exactly cylindrical – i.e., tube like. Base portion 1a is effectively a short tube, albeit it does not have parallel sides, but it is tube like and therefore a tubular member. "at one end" and "the opposite end" referred to ends of the tubular member. Part 1a has an end (1g/1i or 1b) which is adapted to facilitate rotation of the tubular member. The part (1j) of the tubular member is wider in diameter than the cap, so a reduced amount of torque is required to rotate the tubular member (vis-à-vis rotating the cap) when removing the cap. This line of argument was generally the better argument for finding infringement.

- (B) The opposite end of the entire accessory (1c, 1d and 1k) is adapted to facilitate rotation of the tubular member. It is described (Document A lines 13 to 14) how this tapered stem allows a variable torque to be applied, depending upon where the device is gripped by the user. It can be quickly rotated, whereby it "spins" and the cap can be removed quickly and easily. Thus, once initial loosening of the cap has been achieved, the cap can be easily rotated at low torque. Thus (it can be argued) the tapered end is adapted to facilitate rotation of the tubular member by reducing the amount of torque required to rotate it.

After interpreting the claims and, all being well, applying the interpretation to the client's device, many candidates concluded their infringement section with a summary of infringement, listing who may be infringing what and who may be a contributory infringer. Often these summaries added little or nothing that was not already stated in the infringement section and merely served as a summary for general advice at the end. Candidates perhaps find such a summary to be a useful aide-memoire before moving on to validity, but if this is the purpose, it is best kept

very brief. No marks were awarded for re-stating the law on contributory infringement.

IV. Validity – General

Many candidates summarised the separate items of prior art before discussing validity. There are no specific marks available for listing the various items, but a good discussion of the prior art referenced in D1 at page 14, lines 18 to 24 in many cases merited one or two bonus marks.

IV.A Novelty

It can be seen from the marking scheme that this paper had more emphasis on novelty than inventive step. Marks were available for a detailed analysis of novelty of each claim with respect to Document C and Document D individually. Candidates should remember to not only indicate why certain features are not present based on use of interpretation but also why the other features are present.

Candidates should have borne in mind that the Patent Office Examiner had apparently already found there to be novelty with respect to Document C. Any contrary conclusion flies in the face of the Examination, which is acceptable provided it is reasoned and based on use of interpretation. In particular novelty of claim 1 over Document C was dependent on whether the bottle cap could be considered to be suitable for use as an accessory for vehicles and capable of storing a tyre valve cap. Novelty over Document D revolved primarily around whether the gripper was suitable for removing and storing, however, to maximise marks for claims candidates still had to identify *inter alia* whether Document D contained a “tubular member”, whether the opposite end was adapted to facilitate rotation and why (based on interpretation) and whether it reduces the amount of “torque” required (again as interpreted). While it might seem like a lot of marks are allocated to claim 1 for novelty, the marks are split between consideration of two documents available for novelty and for consideration of a number of points. The Examiners are looking for a reasonable explanation of why there is novelty or not as the case may be, they are not looking for a precise number of features to be addressed so candidates who do a less

thorough explanation do not gain all the available marks but are not penalised in any other way.

IV.B Inventive Step

Many candidates found that Claim 1 lacked novelty over Document D based on their interpretation but then did not consider whether, if they were wrong and a court found claim 1 to be novel, it would lack inventive step. For example, it was possible to consider that if claim 1 was found to be novel because the gripper was in practice (e.g., shown by the defendant's evidence) to be incapable of storing the tyre cap and marks were available for considering if this feature was obvious over Document D or Document D and Document C (as common general knowledge). Similarly with claim 2, candidates who found also claim 2 to lack novelty also had an option to consider inventive step under this claim.

Many candidates started their inventive step analysis at claim 3 with a consequence that up to five marks were not available. However, this could easily be compensated by using that time to create a better inventive step argument with the remaining claims or in a different section of the paper. Having said that, a number of candidates decided that Document C was not available as prior art in a related technical field to be combined with Document D. This is despite the fact that candidates were expressly advised that the Patent Office search had found Document C and it had been cited. The new features of claims 3 and 4 could be found in Document C thereby providing a lack of inventive step argument. Even if your own view is that the documents should not be combined, the better approach to this was to mention your reservation but also carry out the analysis as if the documents are combinable. The new feature of claim 5 was in neither prior art document and the client did not apparently infringe claim 6 although if the candidate had sufficient time it was worth mentioning whether this claim had an inventive step. As ever, the best approach to assess inventive step is the four step test set out in *Windsurfing v Tabur Marine* ([1985] RPC 59 (CA)). Candidates are not penalised for using a problem solution approach and it is understood that elements of this approach have been used occasionally in the UK.

IV.C Internal Validity/Sufficiency

This was not a major issue in this paper, but some candidates identified points of possible insufficiency and were able to gain a mark.

V. Amendment

Three marks were available for indicating the possibilities for amendment by the Patentee. There were a few possibilities but marks are awarded to any answer which is sensible and which explains whether the client would infringe the amended claim(s).

VI. Letter of Advice

This is the simplest section of the paper as marks are awarded for summarising conclusions and giving general advice. There should be a summarised assessment of the infringement, novelty and inventive step analysis, mention of potential amendment issues. In addition the following points could be addressed: Does the client infringe yet or is it a potential future infringement? Is there a possibility for an interim injunction against your client ? What considerations are there for interim injunctions ? Should your client give the undertaking? Could your client file an application for revocation of the patent ? Is Motorbit likely to obtain relevant amendments ? Is there a potential threats action against Motorbit ? All or various combinations of these points would secure all or most of the six marks for this section. A number of candidates usefully noted that the patent expires in two years. (Some candidates considered this a short time and others considered it a long time. It is for the client to make such subjective assessments. Similarly, there is no merit in speculating over how deep are the client's pockets).