

**THE JOINT EXAMINATION BOARD**  
**PAPER P3**  
**Preparation of Specifications for United Kingdom and Overseas Patents**  
**2006**

**EXAMINERS' COMMENTS**

**GENERAL**

In this question you are told that the client produces bathroom and bedroom mirrors. That is accordingly the business which it is your first task to protect. The client has written to you to tell you about a new type of extensible wall mounting for one of their existing mirrors. The client also has sent a subsequent email message regarding a new application of a concave magnifying mirror. The client is disclosing the invention at an exhibition today and, apart from a telephone call, you have no way of obtaining any further information. You are told that you are to provide the widest practicable protection for your client.

**INDEPENDENT CLAIMS**

Claims were expected to the extensible wall mounting and to the magnifying mirror. Since these were concepts which could be used independently, it was expected that two independent claims should be provided, one directed to each concept.

Independent claims which read:-

a) A shaving mirror comprising:  
a magnifying mirror.

and

b) A mirror mount comprising:  
an extensible arm.

would pass. Candidates who failed to cover both concepts independently failed to gain all of the available marks.

In claim a), substituting “vanity” or another equivalent term for “shaving” and “concave” for “magnifying” was acceptable. The omission of “shaving” means that the candidate was effectively claiming prior art. The inclusion of a second mirror, flat or otherwise, in claim a) was considered to be an unnecessary limitation.

It follows from this that features such as “a plane mirror”, “back-to-back”, “frame”, “frame grooves”, “spacing rib” and “snap fit frame” are all considered inessential features, but could be the subject of dependent claims.

In claim b), the inclusion of a mirror and some means for mounting the extensible arm was acceptable. The inclusion of the yoke arrangement was penalised, as was any requirement that the mount was attached to a vertical surface. It follows from this that features such as “pivoting yoke”, “pivoting mount”, “lazy tongs”, “end stops” and “wall mount” are all considered inessential features, but could be the subject of subsidiary claims.

In this case method claims were not expected.

A small number of candidates attempted to cover both concepts in a single independent claim. This approach was not expected by the Examiners since it was considered that there was little to unify these seemingly disparate concepts. Those candidates struggled to provide a satisfactorily unifying claim since this was generally attempted by reference to providing some means for “enlarging the image”, with dependent claims to the enlarging being by way of a magnifying mirror or by way of the mirror being moved towards the user on an extensible arm. Although this was considered to be an innovative attempt, it is considered that it is questionable whether a plane mirror on an extensible arm can be considered to enlarge the image. If the "means for enlargement" was the placing of the mirror closer to the user, then this would be known from existing mirrors, causing the claim to lack novelty. Alternatively, if the "means for enlargement" was the properties of the mirror itself, then the claim does not cover the non-magnifying embodiment. Hence, such a claim is caught in a squeeze between novelty and covering both embodiments. However, where the dependent claims provided a claim coterminous with independent claims a) or b) above these were then marked accordingly.

Drafting multiple independent claims in a shot-gun fashion, where each had slightly differing scope, presumably in the hope that at least one of the claims may align with that expected by the Examiners rarely scored highly.

A total of 40 marks were available for the independent claims, split evenly between the two independent claims.

## **DEPENDENT CLAIMS**

Quite a variety of dependent claims in the traditional graduated form were then available, for example:

- an additional flat mirror;
- the mirrors are back to back;
- the mirror(s) are located in frame groove(s);
- a spacing rib is defined by two frame grooves;
- the mirror(s) snap-fit into the frame;
- a yoke is operable to pivotally receive the mirror;
- the yoke is pivotally coupled with the extensible arm;
- a wall mounting is provided at an opposite end of the extensible arm to the yoke;

- the extensible arm is pivotable on the wall mounting;
  - the extensible arm is a lazy tongs;
  - an end of the lazy tongs has bearings which are slidably engaged on the wall mounting/yoke;
  - stops are provided to prevent the extensible arm from disengaging with the wall mounting/yoke; and
  - a combination of the concave mirror arrangement and the extensible arm arrangement.
- Omnibus claims were also expected.

A total of 30 marks were available for the dependent claims and omnibus claims. No more than 10 dependent claims were requested and so only the first 10 dependent claims were marked.

## **SPECIFICATION**

The body of the specification should start with a title (Rule 16(2)&(3)). The title ought not to be narrower in scope than the independent claims.

The introductory portion of the description ought to have explained the field of the invention sufficiently to assist the search examiner in determining the technical classification. Again, the field of the invention ought not to be narrower in scope than the independent claims.

The introductory portion of the description ought then to have acknowledged the known and relevant prior art and set the scene for the invention. In this regard, only the known wall mounted mirror and yoke mounted mirror ought to have been acknowledged. It was considered that the known “lazy tongs” system ought not to have been acknowledged since it is not considered to be relevant prior art. (Very few candidates acknowledged it as prior art).

It was expected that the description should then include a summary of invention which provides some justification for the chosen claims including, to a general extent, the dependent claims. This justification may include an indication of any benefits or advantages provided by the independent and dependent claims.

The body of the specification should continue with the description, claims and the drawings (Rule 16(2)). As well as the benefit of setting out a cogent introduction and summary of invention, which provides an initial justification/arguments in favour of the novelty and inventive step of the drafted claims, this section is helpful to the Examiners when reviewing the drafted claims, particularly where unexpected wording is used. Hence, candidates would be well advised to carefully review the arguments set out in their introduction against their drafted claims and summary of invention to ensure that they are consistent. This may also be useful to candidates as a sanity check to help ensure

that they do not fall into the trap of failing to claim what they clearly understood the invention to be.

A total of 10 marks were available for the introductory portion.

A list of figures ought to be provided in the description (Rule 16(4)) and, although it may seem obvious, this list ought to be consistent with the drawings. (A surprisingly high number of candidates unnecessarily lost marks because of this). Phrases such as “according to the invention”, used in this list in a way which suggests any limitation of the invention to the illustrated embodiments, should be avoided.

In the specific description the time honoured strict setting out of the structure of the apparatus in some detail, followed by its mode of operation, was looked for, with all alternative embodiments described separately and subsequently and also in detail. Although later amendments can be based on the drawings, it is much easier if there is appropriate wording in the written description. Candidates are reminded that the purpose of the description is to satisfy Section 14(2) and to ensure that the application does not fall foul of Section 72(1)(c).

Hence, it would be advisable that all the claimed features are clearly disclosed. It is good sign if the specific description can be understood without looking at the drawings.

Consistent reference numerals should to be used in the description and different drawings when referring to the same feature.

A total of 20 marks were available for the specific description, with most of these marks being allocated to the sensible annotation of the drawings provided and the associated description of the embodiments.

## **MISCELLANEOUS**

Notes to the Examiner are not useful and do not gain marks since they do not form part of the drafted specification on which candidates are being examined. Other perennial advice is worth repeating also. Write on every other line. Perhaps make each claim the subject of a new page, or at least leave very large gaps between them. This way you make plenty of room for later amendments.

## **MARKING SCHEDULE**

A schedule used for this year’s examination is attached with a “health” warning. This is a paper in which candidates can take different approaches, which, if properly drafted and based on the information contained in the question, are equally acceptable. In real life, two patent attorneys will rarely produce an identical claim, but they should often have identical scope! Therefore this schedule should be regarded as a guide to how individual answer scripts were marked.

<b>INTRODUCTION</b>		
Title	No narrower than main claims	4
Field of Invention	Encompasses but no narrower than main claims	
Prior art	Acknowledges no more than prior art disclosures – only wall mounted mirror and vanity mirror <b>NOT LAZY TONGS</b> (unrelated field)	
	Sensible description to set scene	
Summary of Invention	More than a list of claims – highlight how features of the claims overcome any problem highlighted in prior art/provide advantages	6
<b>DESCRIPTION</b>		
List of Figures	Sensible description of figures 1/2/3/4	4
Labelling of Figures	Sensible labelling of figures 1/2/3/4, correct sheet numbering	
Description	Sufficient in detail to provide enabling disclosure of claims, provide back-up positions for all features, especially if not claimed	16
<b>MAIN CLAIMS</b> Sufficient & sensible breadth - Novel	shaving [vanity] mirror comprising: a magnifying [concave] mirror	20
	A mirror mount comprising: an extensible arm	20
<b>DEPENDENT CLAIMS</b>  Suitable back-up positions for main alternatives.  Sensible order  Antecedence, dependencies.	<b>MAXIMUM OF 10 CLAIMS</b> Mirror dependent claims additional plane [flat] mirror mirrors back to back mirror(s) located in frame groove spacing rib defined by two frame grooves mirror(s) snap-fit in frame Extensible arm dependent claims a yoke [frame/mount] operable to pivotally receive the mirror yoke [frame/mount] pivotally coupled with the extensible arm a wall [surface] mounting at opposite end of the extensible arm to the yoke [frame/mount] the extensible arm is pivotable on wall [surface] mounting extensible arm is a lazy tongs an end of the lazy tongs comprises bearings which are slidable engaged on the wall [surface] mounting/yoke [frame/mount] stops/retainers provided to prevent extensible arm from disengaging with yoke [frame/mount]/wall [surface] mounting combination of concave mirror and extensible arm Omnibus Claims	30