

## EXAMINERS' COMMENTS

### (A) 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).

The scenarios presented naturally vary from year to year, so that the criteria for arriving at a good answer vary correspondingly. However there are certain aspects that are unlikely to be ingredients of a good answer. Because the Examiners want to test the abilities listed above, a good answer is very unlikely to involve extending time limits or deferring major issues while further enquiries are made of the client. For the same reason, procedural niceties and the presentation format of documents play little or no role, although there may be a few marks associated with acceleration of prosecution and the like. The Examiners are looking for strategic judgement in prosecution, hence candidates should demonstrate the reasoning behind their strategic approach in the memo, letter or other work product as specified in the examination question.

The instructions from the client tell the candidate - usually indirectly - what kind and scope of protection that the client desires, in relation to market and likely competition. The amendment should provide sufficient scope of protection to benefit the client's business, and meet objections raised by the patent office examiner.

Divisional filing can be an important strategy. The question routinely explains to candidates how they should deal with any proposed divisional filings in their answer. However, 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 divisionals for each and every novel feature. In the exam, as in real practice, it is essential to discriminate to succeed.

#### (2) MARKING

The form and content of proposed claims usually determine a large proportion of the available 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). To avoid hinting at acceptable answers, specific indication of the mark allocation is not given in the question.

In the 2006 paper the allocation was claims 40 marks, response letter 32 marks and memorandum of notes 28 marks. 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, for the following reasons.

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 that may significantly affect the marks awarded, but which cannot meaningfully be itemised. The available marks are however grouped into categories and the numbers of marks available in respect of certain elements predetermined, to assure general consistency of marking between the Examiners.

The marks awarded to a candidate depend overall on how “good” (i.e. effective, correct, appropriate, self-consistent and so forth) their answer is. It cannot even always be said that marks will be gained just by mentioning a certain point. 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 not only to see correct claims and arguments, but to be persuaded that the candidate produced them for valid reasons. The memorandum of notes is important in this respect.

### (3) PRESENTATION OF THE ANSWER

The best answers to P4 are usually expressed concisely. 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 the aim.

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, that is, to “show the working”. This year 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 it is in document A that 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, although not realistic, is convenient for the Examiners since it presents 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 by some.

The Examiners do their best, but find some scripts very difficult to read. If parts of the answer are genuinely illegible, the Examiners cannot give marks for them. Candidates should also be wary 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.

## (B) PAPER P4: THE 2006 PAPER

### (1) PRIOR ART

Candidates were expected to note routinely that both the GB and EP documents were full prior art; no marks were awarded in this respect.

### (2) CHOICE OF AMENDMENT

#### General

The main type of amendment acceptable to the Examiners related to the particular way in which the two layers were joined together.

Candidates who relied on a "joined by moulding"-type amendment in claim 1 were often not successful. This was not because this was a wrong feature and unjustifiably limiting. On the contrary, whether the claim was limited to moulding or not was probably of little importance. Rather, the fault was that such candidates generally paid little regard to what "joined by moulding" actually meant. The apparent belief was that somehow it implied a sort of interlock or inter-fit, or in any event some kind of more definite or stronger connection. In fact however such wording could equally well cover something like D2, with the level of adhesion achieved being indeterminate (and perhaps worse than in D2).

The very minimal technical implications of limiting the product merely to having been joined by moulding should have been evident. Defining the product by a method of construction might lead to problems with enforcement. Most importantly, from a practical marking viewpoint, it does not support sufficiently strong arguments in favour of inventive step, particularly in the light of the client's letter.

The Examiners were looking for an appreciation of what the client regarded as being important. Almost all candidates adopted a claim 1 that was in the right direction, but many missed out on considerable marks through lack of attention to the meaning of the claim wording, or through not tying their choice of claim to the client's needs. A key statement in the client's letter was that the "direct integrated attachment of the two layers is very important". This isn't wording that one can use directly in claims, but the specification provided many ways to bring the idea into play.

### Claim 1

A 'hole/projection' limitation tended to give candidates a good chance of producing a passing answer. However, the distinction over the "projections" in D1 needed to be made properly. In D1 the pins extend up from the bottom layer and through holes in the elastomer layer in the alternative embodiment, holding it in place at least horizontally.

One acceptable form of the 'hole/projection' limitation was to define the connection as involving 'interlocking formations'. However even these answers ranged from poor to very good, depending on the exact wording used in context and the subsequent justification given. The wording "fitting formation ... providing a form interlock" in lines 2-3 of page 4 provided basis for this approach.

The mere wording "the connection surface is formed to oppose disconnection" (page 4 lines 1-2) seemed to the Examiners inadequate – a slightly wavy surface would probably "oppose disconnection" but would not really be the client's invention.

As mentioned above, 'moulding' variations could give validity with further features, but were otherwise harder to justify. Overall passes for this approach were consequently fewer. Limitation to moulding was not necessarily dangerous, although the feature per se was not apt to ensure patentability. The specification tends to assume that the lift is moulded (for example, see page 2 line 7), rather than regarding moulding as a distinguishing feature.

Further, a distinction based on the two layers of the lift forming a "single piece" was felt to be weak. In what way is the two-layer, glued lift of D2 not a "single piece", if the client's lift is?

### Sub-claims

Several marks were available for useful additional sub-claims, in particular to the various shapes of the holes/projections, which developed the basic idea. The odd mark was also available for tidying up existing claims (for example, those with incorrect dependency).

The "dovetail" aspect caused considerable confusion. All the embodiments in Figures 2-5 are presented as dovetail-type connectors (last line of description). Moreover the terms "dovetail", "reverse taper" and "trapezoidal" tend to be used as equivalents (4/14, 4/23-24, 4/35 – 5/1, 5/5-8). Hence no marks were available for elaborate hierarchies of sub-claims here. Very few candidates appeared to recognise that it would bolster the distinctiveness of the claim to specify that the formations should be trapezoidal etc. in cross-section (bottom of page 4).

A dependent claim specifying a mounting pin (and therefore bringing the claimed device into the conventional "type" of D2, whereas otherwise it is not so limited) was a meaningful back-up claim. It

could provide a useful position in the event that some other ‘surprise’ prior art like D1 turned up. However, some candidates gave the impression that this was a major point and wasted time including multiple claims elaborating on this feature.

Some marks were also available in the memo for a discussion of the amendment’s likelihood of success – clearly the client wants a quick grant – and for a discussion of possible backup positions.

#### Divisional(s)

The filing of a divisional did not appear important, although the Examiners like to see that it has been thought about.

When divisional filing was proposed, a few marks were available according to the choice of subject-matter and provided that appropriate reasoning was given in the memo. Many candidates suggested filing a divisional without saying why it might be useful to the client.

Where the chosen feature was the “notch”, a claim to a whole shoe, or at least including a heel, was required.

#### (3) CLARITY

The Examiner had objected to lack of clarity.

The basis for many amendments aimed at clarifying the main claim - for example, describing the hard layer as ‘rigid’ and the soft polymer as ‘shock absorbent’ - appeared hazy. Nor was it usually apparent how the amended version was any clearer than the original.

Responses arguing that the existing wording is adequately clear and meaningful seemed as good as any. It could always be determined that one polymer was softer than the other even though the degrees of hardness and softness were not able to be specified. A skilled person already knew of such hard/soft proposals, for example from D2.

#### (4) PATENT OFFICE LETTER/ARGUMENTS

The letter should explain the amendments made, and where appropriate reassure the Patent Office that they correspond to information in the original application as filed. Candidates did this to varying degrees of effect.

On a general point, any justification of an amendment that asserts as its basis “the description as a whole” is skating on thin ice. This is an examination intended to test candidates’ analytical abilities and the Examiners want to see good judgement.

#### Novelty

Generally, if the correct amendment was selected, candidates identified suitable arguments for novelty.

Most candidates obtained most of the marks available for distinguishing over D2. However, and rather surprisingly, none made the simple point that not only are layers 19 and 21 in D2 held together by adhesive – not in itself inconsistent with the use of an interlocking formation – but also they are flat.

By contrast D1 presented problems to many candidates. Firstly, few candidates recognised that D1 anticipated the original claim 1 by having a hard layer 24 and a soft layer 26 or 28, or the alternative elastomer layer. Some candidates thought that, because the skirt 26 was said not to provide any significant shock attenuation, claim 1 was not anticipated. However, original claim 1 does not mention shock attenuation and, even if such a vague feature is inserted as was done by many candidates, this is more an explanation of intent than a convincing distinguishing feature. More seriously, and in any event, the slug 28 is expressly present to provide shock attenuation (page 2, lines 21ff. of D1), and likewise the elastomeric layer in the alternative embodiment.

Candidates were expected to note that while the pins 70,72 of D1 have a sort of interlocking shape, it does not belong to the connection between the two layers - rather it is within the heel (that is, the pins correspond more to the shank 6b of the invention and of standard top lifts). As noted above, there is also a kind of interlock between the bases of the pins and the holes in the elastomer layer, but it holds the layers neither in a fitting formation nor as one piece (or however one decides to define it).

### Inventive Step

For inventive step, a key requirement was to point out that the invention could improve the attachment of the layers to one another (that is it overcomes the relative ease of detachability of the layers of the lift from one another). D1 did not provide means for interlocking a lower layer of the lift with an upper layer of the lift as such. There is not much to say about D2 other than that in the client's view adhesive is often not enough to avoid detachment. Regarding D1, it is useful to note that the sliding arrangement of the lower layer 24 relative to the heel is inimical to an integrated double-layer lift.

Many candidates did not adequately explain why it was not natural to combine D1 and D2, or missed this point altogether.

In constructing an argument for inventive step, it is not sufficient to repeat the novelty arguments and to replace the phrase “does not disclose” with “does not teach or suggest”. The client's letter and the application as filed give information of substance enabling argument about advantages, non-obvious solutions to technical problems, and other angles designed to get to the point of the invention.

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.

Candidates do not need to use problem/solution terminology in their arguments, but it is acceptable.

No marks were given for arguments based upon the age of the documents, although those pointing out that the shoe of D1 would be difficult to manufacture and that it was complex in structure compared to the shoe of the invention were given some weight.

### Other

A couple of marks were awarded for requesting accelerated prosecution and one mark for requesting delay of grant to allow for the filing of any potential divisional application(s).

### (5) MEMORANDUM OF NOTES

The best candidates gave clear explanations of:

- what they had done;
- how they had met the majority of the client's concerns;
- their awareness of the conflict of competing commercial interests; and
- the meeting of time constraints imposed by the situation.

Very few candidates noted why D1 was in fact novelty-destroying, in spite of the client's puzzlement on this point.

### (6) OTHER GENERAL POINTS

#### Time Management

Mostly, time management was good this year. Those candidates who struggled to complete their script tended to be ones who had not identified a clear path towards a complete answer, so time management was merely symptomatic of more general weakness. By focusing attention on the correct issues, strong candidates were able to complete the script without being distracted by miscellaneous matters that do not get marks.

To provide a concrete example, this year it was evident that no extension of time was required. Candidates who distracted themselves with a detailed discussion of UK extension of time procedure were not gaining extra marks and were wasting valuable minutes. With enough of these distractions, candidates could lose sufficient time to put them at risk of not completing the paper.

#### Answer Structure

As previously suggested in last year's Examiners Comments, scripts should preferably be submitted in the order of claims, letter to the Patent Office, and then the memo.

The Examiners suggest that candidates write out at least their proposed main claims in longhand. Complex amendments on the printed sheet are often difficult to follow. Moreover, candidates who merely marked up the printed sheet of claims often missed valuable marks available for corrections to dependencies or improvement of unclear claim language. By writing the claims out, a candidate has at least to think about the language used. It cannot be assumed that the claims of the application as filed are optimum and to be retained in all respects. Marks may be available for improving the applicant's position by amendment.

(7) MARKING SCHEDULE

	<b>Item</b>	<b>Mark</b>	<b>Comment</b>	<b>Alt.</b>
<b>Claims</b>				
1	Hole/projection fit Interlock formation etc.	25	“surfaces opposing disconnection” is not enough	
	Connected by moulding process	0	New process but not apparent from the product, or not meaningful/inventive in product claim	18
sub	Separate dovetail (i.e. preserve remainder of claim 2 & tie it in with new claim 1)	2	In addition to the existing claims, of course.	
	Hole/projection (if not in claim 1)	0		3
	Various shapes of projection/hole and upper/lower	4		
	Specify urethane/soft/lower/ lower layer natural	3		
	Whole shoe/ notch	2		
	Hole is through-hole	1		
	Omnibus	1		
Div	Notch	2		
	Possible improvements: Tidy claim 3 (repetition) Correct dependency of claim 4 Page 2/30 – not “heel body”			
	<b>TOTAL FOR CLAIMS</b>	<b>40</b>		
<b>Letter to UKPO</b>				
General	Describe amendments (amend.s to existing claims; point out new claims)	2		
	Basis for amendments to existing claims	3		
	Basis for new claims (if any)	3		
	Deal with hard/soft clarity objection	2	(if only to deny that there is a problem)	
	Request accelerated grant	2		
	Request delay for divisional (if proposed)	1		
Novelty	D2 has no interlock & is flat	3	(& not moulded, if relevant)	
	D1 does not have fitting engagement of lower layer (either skirt or slug) with upper (lower with <u>heel</u> ), even in final alternative. Parts not moulded together (if relevant)	4		



	So Examiner's argument (4) about claim 2 is wrong	1		
Inventive Step	Cannot have interlock of lower/upper in D1	3	No marks for arguments based on age	
	D2: Recognise detachment problem solved	3		
	Advantages of claimed inv.: over D2 as above; simpler than D1; easier to manufacture + to fit & replace oneself	2	But a list of advantages is not an argument in favour of inventive step, if the construction itself is obvious.	
	Combination of D1/D2 doesn't get us there (Exam. Point (5))	3		
	<b>TOTAL FOR UKPO LETTER</b>	<b>32</b>		
<b>Memo</b>	Explain action taken and timing	2	Client paragraph 1; preferably avoid another round.	
	Explain need to amend in view of D2 (& D1)	3	(as recognised by client)	
	Explain why D1 is relevant	2	(because clt did not understand)	
	Mention client's comment on direct integrated attachment, hence choice of amendment	3		
	Discuss rejected alternatives & backup positions	2	Discussion of prospects of application also useful.	
	Explain broadening of dovetail	2		
	Not poss. to add embodiments	2	(not merely a "risk"!)	
	- but have made sure new ones are covered, in addition to all existing embodiments	4		
	No need for new application (can't anyway – competitor is out there)	3	Usefulness or otherwise of a method claim	
	Divisionals (or not)	3		
	Investigate and comment on activities of competitor; accelerated prosecution	2		
	<b>TOTAL FOR MEMO</b>	<b>28</b>		