

## Examiner's Comments P4 2007

- Prospective candidates' attention is drawn to the sections entitled "General Approach", "Marking" and "Presentation of the Paper" in the Examiners' comments for the 2006 P4 paper. Those comments apply as much to this paper as they do to that paper.
- In general, most candidates answered the paper reasonably well but many lost marks by not assembling their answer methodically. If reasoning is not clear in an exam answer, it can be difficult to award marks. When answering the paper, candidates should consider what they think it would be best to do in their normal working practices.
- The response should not be speculative but have a real chance of leading to grant. Consequently, when statements are made, they should be backed up with arguments and reasoning as to why the statements are relevant and the best answers included this approach. Answers where a candidate has sat on the fence and so not reached a conclusion backed up by arguments as to why that particular approach was taken, lost marks. A UKIPO Examiner is unlikely to be persuaded to accept an application if there is doubt about what has been submitted.
- Notes to the Examiners or other 'workings' are rarely helpful to Examiners. Although they may be useful to candidates in working out what to say in their answers, unless the notes are put in context in the answer, they have no meaning to the Examiners.

Some more specific comments:

### Claims

- The examiners were looking for two things in the amended main claim: broadening to the cap alone (i.e. without the container) and limitation to recite an air hole through the cap which is blocked and sealed by a projection on the tube when the tube is in the second configuration. A good proportion of candidates got the amendment sought and implemented it sufficiently satisfactorily to achieve a pass result. There were a number of ways in which candidates could go wrong, some of which were fatal and some of which were not.
- Failing to broaden the claim was seen as a serious mistake since it would have necessitated the use of contributory infringement law against third parties selling (or doing any other act of infringement in relation to) only caps. There was clear support for the broadening amendment, and the client was quite clear that they sell covers without containers.
- The examiners considered the major feature of the invention, in the light of the prior art, to be the combined function of sealing and retaining. A good answer was one which was formulated with reference to the dual function (opening the air hole only when required and holding the tube in place) of the mechanism. The specification provided support for a number of possible terms to use to define the connection between the projection and the air hole, namely "mate" (page 10, line 30), "snap fit" (page 10, line 34) "plug and seal" (page 10, line 35) and "hold" (page 11, line 3) but the terms used had to be used in the context of the dual function and also there had to be no added matter, which is where many candidates missed marks.
- Many candidates mentioned an air-hole and a projection engaging with it, but not necessarily sealing the hole. While this might be physically possible (e.g. with a round hole and a square peg), and even to be a valuable claim in principle, there seems to be insufficient support for it in the application as filed, and insufficient reason for it to give rise to inventive step. Another variant, equally unsupported and uninventive in the Examiners' view, is that the projection is held (snap-fitted) in "a hole" – but that the hole is not necessarily an air-hole or vent-hole. Candidates who neglected to justify their

omission of a feature from claim 1 missed more marks than those who at least addressed the issue.

- Quite a number of candidates included further features in claim 1, which in the view of the examiners weakened the claim. The most common unnecessary addition was the groove. True, this is mentioned with the projection/air-hole on page 10 lines 29ff, but it is not tied to it, and the air hole is mentioned separately of the groove in claim 7. Some included the feature of the projection being half-way along the spout – possibly a valuable backup feature but not an essential feature that had to be included in claim 1.
- Regardless of the choice of features for claim 1, the repercussive effect was an important consideration for the dependent claims. A dependent claim that does not add any additional limitation casts doubt on the scope of preceding claims. It is suggested that candidates check that a dependent claim actually adds anything before allowing it to remain in a claim set.
- The original claim set was structured so that some potentially important features were omitted and marks were available for adding appropriate new dependent claims. These features include 'the air hole is roughly halfway along the tube' (page 10, lines 29-30), 'the tube has a length greater than the radius of the cap' (page 10, line 16-17) and 'the straw lies in the groove' (page 11, lines 1-2). An omnibus claim to the cap was of potential value, as was, to a lesser degree, an omnibus claim to the container and cap combination.
- Some candidates added an independent method claim, for instance to the method of adding a cap with the inventive features to a container. When considering infringement method claims are difficult to police and consequently the examiners did not feel that such a claim added anything to the applicant's position. Candidates are reminded to concentrate their efforts on writing claims that provide a practical form of protection.
- 10 marks were available for a main claim for a divisional application to the “downwardly projecting pipe” discussed in the specification at page 8, lines 27-29 and page 10, lines 7-14. For full marks, the claim would need to be clear, be free of spigot and integral pipe limitations (page 8 provided the broadest wording) and not include any other unnecessary limitations. Also, consideration needed to be taken of the danger of adding matter. For full marks, reasons (although not arguments) were expected as to why the claim was inventive and potentially useful.
- Many candidates included the pipe feature only as a dependent claim in the main application, which is certainly worth some marks, but missed the divisional marks. Some discussion was expected (in the Memo) of why such a claim, covering the future product, would be useful, in particular that it would not include the projection/airhole limitation. (Some proposed divisional claims included the limitations of the parent and candidates are reminded that they should consider double-patenting when structuring their answers.)
- Some candidates specified, either in a dependent claim or in the divisional, or both, that the internal pipe had to be integral, but this seems an unnecessary restriction; indeed, the detachable alternative, discussed at page 10, lines 7 to 8, would probably be more useful. Some care was needed in definition of an “internal” pipe in a claim where the container was not mentioned. The same applies when comparing the length of the pipe to a (non-existent) container.
- However, some divisional claims (or independent claims in the main application – a less attractive alternative as it will almost certainly attract a second official letter) went the other way and omitted the basic spout/hole features entirely. This is not justified and would give rise to an (albeit rectifiable) added matter issue.

- Very few defended claim 5 in its unamended form although arguably its scope was clear; some even deleted it. However, the Examiners gave as many marks to a good defence as they did to a good amendment.

#### Letter to Patent Office

- It was pleasing that the great majority of the candidates spotted the need to broaden claim 1 by directing it to a cap, not a container with cap (though with a corresponding dependent claim covering the original scope). However, to get a good proportion of the available marks it was necessary to explain why this broadening was allowable, i.e. to state support for the amendment in the original application.
- It is usually not enough to say, even in a novelty argument, “D1 does not show X”. In this paper, the US prior art had an equivalent function (e.g. the spring mechanism holding the tube down, the wall of the spout 16 lying over the orifice/vent). Marks were available for stating this and for contrasting with the client's invention and the best candidates submitted clear and coherent answers on this point.
- On inventive step many candidates mentioned that the invention elegantly combined the holding and air-blocking functions, and convincingly argued for the existence of an inventive step on that basis. Candidates failing to mention the dual function, or who did not get the correct combination of features, struggled to get marks for discussing inventive step. In an inventive step argument it is not realistic to say of a citation that it does not mention a perceived problem. The problem-solution test, in common with other approaches for assessing inventive step, does not require the 'closest' prior art to mention the problem that the invention addresses.

#### Memo to client

- The Examiners were looking for an explanation of the possibilities for amending claim 1, a reasoning for the amendment chosen, a discussion of the resulting limitation of protection, an explanation of the usefulness of a divisional, and some indication of the progress of the application and divisional, if filed. Good candidates took this approach and set out their answers clearly. It is to be noted that there were no marks available for any analysis as to why claim 1 was anticipated because it was clear that the client clearly understood the problem. Had there been reasonable uncertainty there may have been some marks, but this was not the case here.