PAPER P3 2008

In this question you are told that the client installs computer networks and he has produced a cable accessory which he wishes to disclose to a manufacturer. That is the business which it is your task to protect. The client has written to you to tell you about a new type of cable tidy for adjusting the length of network cables. The client is on his way to a conference to disclose the invention and 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

An independent claim was expected to the cable tidy.

Independent claims which read:-

> A cable tidy comprising a first part having an anchor for the cable and a second part having a guide for ends of the cable, the guide being positioned such that relative rotation of the first and second parts causes both ends of the cable to be wrapped around the anchor.

or

> A cable tidy comprising first and second parts, in which the first part has an anchor for the cable and the second part is relatively rotatable to wrap ends of the cable around the anchor.

would lead to a pass (assuming the description, dependent claims and abstract were also adequate) .

Other designations such as "a cable storage device", or "a cable adjuster" were equally acceptable.

The omission of the some structure which "counter-rotated" or provided for "relative rotation" to enable both ends or parts of the cable to be wrapped around the anchor lost marks since those claims generally lacked novelty over the drum-type extension cable.

Paul Cole's book on the fundamentals of patent drafting discusses the strength of a 'functional claim'. 'Means plus function' is a well recognised style of drafting and good marks can be achieved with that style.

However, claims limited by the result to be achieved (e.g. 'No-Fume' type claims) often run the risk of being no more than a 'free beer' type claim – 'anything which winds up the cable without twisting it' – because they lack any distinguishing structure. Candidates should refer to the No-Fume decision, and also the patent specification itself, GB253528. The patent claim does recite structure.

Thus, simply claiming the result to be achieved without reference to any structure did not score well. The Examiners noticed that many candidates who seemed to fall into this trap

often had a similar formulation of claim where one or two integers were recited, followed by a clause beginning “wherein” or “such that”, followed by the desired result of the cable being shortened/lengthened/wound. Candidates may benefit from reviewing their claims to see if they have used such a formulation and, if so, considering carefully whether they have included sufficient detail for the claimed structure to enable the shortening/lengthening/winding to be achieved. To this end, one possible technique which may be helpful to candidates would be to try to sketch the apparatus as set out in the claim that has been drafted; this often helps highlight shortfalls in wording and helps test whether all the apparatus features which the candidate may have intended to be present in order to achieve the desired functionality are in fact present in the claim.

Dependent claims which added features to provide a claim of similar scope to the main claims outlined above, were awarded some of the marks ‘lost’ by the original main claim

The inclusion of a mechanism which “locked” the two parts together or the inclusion of “the cable” were considered to be unnecessary limitations. Features such as “circular parts”, “two outlets”, “a ribbon cable” or “snap fitting” are all considered inessential features and ought to be the subject of dependent claims.

In this case, method claims were not expected. It might be argued that a method claim could be of benefit in preventing use of the product (a method of winding the cable up from the ‘middle’) by competing network installers, but a product claim was felt to be sufficient.

As mentioned in previous years, drafting multiple independent claims in a shot-gun fashion, where each had slightly differing scope, was felt to show a lack of judgement on the part of the candidate and rarely scored highly. This approach can also cause considerable difficulty for the candidate when drafting the introductory portion of the application, as well as causing unity problems and increased expense to the client. (If the additional independent claims are not likely to be pursued in divisional applications, why include them?)

A total of 40 marks were available for the independent claims.

DEPENDENT CLAIMS

Quite a variety of dependent claims in the traditional graduated form were then available, for example (in no particular order):

- The components are circular parts
- The anchor is a central pin
    - the pin has a slot/slit
- The cover snap-fits on the base
- The cover snap-fits on the pin
    - the pin has a deformable enlarged end received by an aperture in the cover
- The cover has ‘inlet(s)/guide(s)’
    - there are two ‘inlets’
    - the inlets are diametrically opposed
    - the inlet edges are rounded
- There are provided finger holes to assist grip during rotation

- There are provided ribs/ridges to assist grip during rotation
- The combination of the cable and the cable tidy
    - the cable is a network cable
    - the cable is a flat/ribbon cable
    - the internal height matches the cable width
- Mechanism to inhibit relative rotation
    - cooperating bumps & depressions
    - the pin has a friction fit in the cover
    - the pin and the aperture have flat faces
- The parts are transparent

An apparatus omnibus claim was expected.

A total of 25 marks were available for the dependent claims.

Candidates might find it useful first to make bullet point notes on the features of their dependent claims to enable them to structure these claims in a sensible order prior to writing them out. This might also provide some time advantage to candidates when writing out the claims since subsequent renumbering and awkward dependencies can be avoided.

Candidates might also wish to consider whether features that they have selected for a dependent claim would truly assist in prosecution and cause a UK-IPO examiner to change his mind when assessing novelty and inventive step. If a candidate is unable to envisage how the feature of a dependent claim might convince the examiner that an amended claim was now novel and inventive due to the inclusion of that dependent feature, then perhaps that feature ought not to be a dependent claim. A guide to this is the ability to specify the problem solved or advantage obtained by the feature of the dependent claim.

SPECIFICATION

The body of the specification should start with a title (Rule 12(4)&(6)). The title ought not to be narrower in scope than the independent claims (and ought no to recite the invention itself).

The introductory portion of the description ought to explain 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 subject matter of the independent claim(s).

The introductory portion of the description ought to acknowledge the known and relevant prior art and set the scene for the invention.

It was expected that the description should then include a summary of the 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. Care should be taken to distinguish between the use of the terms “the invention”, “aspect of the invention”, “preferred feature” and “embodiment of the invention”.

Notwithstanding the obvious benefits to the client 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, for the purposes of the examination this section is particularly helpful to the Examiners when reviewing the drafted claims, particularly where unexpected wording is used. Although this examination paper is drafted with a particular result in mind, the Examiners acknowledge that other solutions sometimes arise unexpectedly; a well constructed introduction may well prove invaluable in those circumstances. Also, candidates would continue to be well advised to carefully review their arguments set out in the introduction against their drafted claims and summary of invention section to ensure that they are consistent. This may be useful to candidates as an internal 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 (Rule 12(7)). Candidates are reminded that the drawings generally show embodiments of the invention and ought to be described as such. Consistent reference numerals ought to be used in the description and different drawings when referring to the same feature.

The body of the specification should continue with the description (Rule 12(4)).

The specific description setting out the structure of the apparatus in some detail, followed by its mode of operation, was looked for, with variations or other embodiments described separately and subsequently and in as much detail as possible. Again, candidates are reminded that the specific description generally describes embodiments of the invention and the wording of the text should therefore reflect this. The use of the word 'preferably' in the specific description can lead to doubt as to whether the feature being referred to is actually a part of the particular embodiment being described. 'Preferred features' should be set out in the introduction /summary of the invention and the dependent claims.

Candidates are reminded that a purpose of the description is to satisfy Section 14(3) and to ensure that the application does not fall foul of Section 72(1)c.

It would be advisable, therefore, that all the claimed features are clearly disclosed and that the terminology of the claims can be followed through to the specific description.

For simple mechanical cases, at least, one test of a specific description is whether it can be understood without the drawings.

A total of 20 marks were available for the specific description, with marks being allocated to the sensible annotation of the drawings provided and the associated description of the embodiment and the client's potential modifications to it.

ABSTRACT

The abstract commences with the title (Rule 15(1)), and then indicates the technical field (Rule 15(3)(a)), the technical explanation of the invention (Rule 15(3)(b)) and the

principal use of the invention (Rule 15(3)(c)). The abstract should indicate the figure which should accompany the abstract when published (Rule 15(4)). Where a feature of the invention included in the abstract is illustrated in a drawing, the feature must be followed by the reference for that feature used in that drawing (Rule 15(6)).

A total of 5 marks were available for the abstract. Many candidates score a low mark on this section because they provide a poorly drafted abstract, for example leaving out reference numbers and simply repeating the wording of claim 1.

MISCELLANEOUS

Notes to the Examiner are rarely 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 and perhaps make each claim the subject of a new page, or at least leave very large gaps between them, to make plenty of room for later amendments.

MARKING SCHEDULE

A schedule used for this year's examination is attached. Candidates can take different approaches which, if properly drafted and based on the information contained in the question, are equally acceptable. Two patent attorneys might not produce identical claims, but they should have the same scope! The schedule is a guide and the examiners can depart from the schedule when the case requires. Papers are marked independently by two examiners and the marks are then compared and any discrepancy resolved before final moderation of the results by the JEB members.

Section	Main Criteria	Mark	Comment
INTRO			
Title	No narrower than main claims	1	
Field of Invention	Encompasses but no narrower than main claims	1	
Prior art	Acknowledge no more than prior art disclosures – 1) fixed length; 2) coiled; 3) wound.	1.5	
	Sensible description to set scene	1.5	
Summary of Invention	More than a list of claims – highlight how features of the claims overcome any problem highlighted in prior art/provide advantages	5	
DESC			
List of Figs	Sensible description of figs 1 to 3	2	
Labelling of Figs	Sensible labelling of fig 1 to 3, correct sheet numbering	2	
Description	Sufficient in detail to provide enabling disclosure of claims, provide back-up positions for all features, especially if not claimed	16	
MAIN CLAIM Sufficient & sensible breath - Novel	A [cable]/[elongate flexible member] [tidy]/[storage device] comprising a first part having an anchor for the [cable]/[efm] and a second part having a guide for ends of the [cable]/[efm], the guide being positioned such that [relative rotation/counter rotation] of the first and second parts causes both ends of the [cable]/[efm] to be wrapped around the anchor. A [cable]/[elongate flexible member] [tidy]/[storage device] comprising first and second parts, in which the first part has an anchor for the [cable]/[efm] and the second part is relatively rotatable to wrap [two]/[opposite] ends of the [cable]/[efm] around the [first part]/[anchor].	40	
DEPENDENT CLAIMS Suitable back-up positions for main alternatives. Sensible order Antecedence, dependencies.		25	
	Circular parts		
	Anchor is a central pin		
	Pin has slot/slit		
	Cover snap fits on base		
	Cover snap fits on pin		
	Pin has deformable enlarged end received by aperture in cover		
	Cover has ‘inlet(s)/guide(s)’		
	Two ‘inlets’		
	Inlets diametrically opposed		
	Inlets rounded		
	Finger holes		
	Ribs/Ridges		
	Combination of cable and cable tidy		
	Network cable		
	Flat/Ribbon cable		
	Height matches cable width		
	Inhibit relative rotation		
	Bumps & Depressions		
	Pin has friction fit in cover		
	Pin and aperture have flat faces		
	Transparent parts		
ABSTRACT	Title, tech field, explanation, use, refs, figure	5	