P6 2010

Examiners' Comments

General

The P6 Paper for 2010 related to a nail pulling device with straightforward features. The pass rate was 54%.

With the simplicity and amount of subject matter candidates could get close to 50 marks with well thought out construction, infringement and novelty arguments that did not necessarily have to span pages and pages. On the other hand, candidates who did not carefully construe each feature in the claims, or who did but then in the infringement and novelty sections, did not say *why* each feature was or was not found, so that they missed vital "explanation marks, generally failed.

The extra hour for the paper this year seems to have had a significant benefit, with far fewer candidates appearing to run out of time.

Overall, the construction, novelty and infringement aspects were well dealt with.

Once again the inventive step and advice sections were particularly poor. Many candidates produced acceptable construction, novelty and infringement sections only to fail due to picking up no or only minimal marks for inventive step and advice.

Many candidates confused clarity/support and sufficiency. Having a clear understanding of the distinction is important as insufficiency is listed in S.72 as a ground for invalidity, but deficiencies in clarity or support are not. See sections 72.14 and 14.24 – 14.25 of the "Black Book". Although there were very few marks available for sufficiency in the paper this year those candidates would have wasted time as a result of this confusion.

For example a number of candidates suggested extensive amendments to correct supposed clarity issues in the claims. Lack of clarity seldom needs correcting since ultimately the claim is read to make sense. If it can't be read in a sensible way (i) it is probably impossible to determine whether it is infringed and (ii) there is probably no basis for amending it anyway.

There were also many suggestions to amend the claims on an insufficiency basis just because the claims were broader than the specific disclosure. The question is whether there is sufficient teaching for a skilled person to perform the invention across the breadth of the claim – which there usually is for simple mechanical inventions. Very good reasons have to be given for any credit to be given for this type of suggestion because "Biogen-type insufficiency" only occurs where a claim is extremely broad and speculative. Ordinarily a patentee is entitled to generalise from the specific embodiments to provide a reasonable degree of protection, and in such circumstances support and clarity are not grounds for revocation of a patent.

Many candidates chose to provide diagrams in their answers, of parts of the illustrated embodiment or generalisations of them, which can be very helpful.

Construction (27 marks)

Although a separate construction section is used by most candidates (and the Courts), candidates were still awarded marks if the points of construction were included in the analysis of validity/infringement (or indeed elsewhere). A separate construction section may, however, assist in fostering a thorough and consistent approach.

There were a lot of candidates who hedged their bets and did not provide a conclusion, preferring to adopt an "either/or" answer, then cherry pick which construction they wanted when determining novelty and using an alternative construction for infringement. When done properly discussing multiple constructions can demonstrate an appreciation of complex issues. Ultimately, however, candidates are encouraged to reach conclusions and to carry those conclusions through the remainder of the paper. Not doing so can lead the Examiner to think that the candidate does not have the required skills to evaluate the options and reach a consistent conclusion that can form the basis for clear advice to a client. 'On my broad interpretation, claim 1 is infringed but invalid' is something a client can understand. 'On my broad interpretation claim 1 is infringed, and on my narrow interpretation claim 1 is valid', is not useful advice.

Too many candidates seemingly believe that if a feature is narrowly defined in the specification or only present in an example or diagram, then that feature must be construed narrowly in a claim, without even thinking what the skilled person would understand by the term. For example, many candidates decided that a handle must be formed from or with the jaws, as that was what was present in the specification and diagrams – despite the handle being a feature having the purpose of applying greater leverage on the jaws, thus a skilled person would not construe it so narrowly.

The following were possible points for discussion.

Claim 1 (15.5 marks)

"*A nail pulling tool*"

Sets the scene. P6, L3ff: "My invention is a tool for pulling nails from timber…….nailed connection….floorboards….packing cases". So the nails are of the fastening kind,

although there is nothing in the claims regarding the use of nails to fasten two different parts together.

"comprising"

Has the following integers, but may have others.

"a pair of jaws"

"a pair": two (usually applied to matching, co-operating or complementary items)

"jaws": mandible-like members, usually for biting (into) or gripping something. Items 12, 14 in the illustrated embodiment: P6L17, "my nail extraction tool 10 has a pair of jaws 12, 14 articulated together at a pivot 16."
Do the jaws need to be movable with respect to each other? Probably not: e.g. repercussive effect of claim 3; no mention of a pivoted connection in claim 1.

"engageable with the shank of a nail to be extracted,"

So the jaws probably act to grip the shank when the tool is being used. P6L18: "The tips of the jaws curve inwardly, being designed to reach around a nail head and to grip the shank of the nail on opposite sides just below the head in use".

The nail is not part of the claimed subject matter.

The shank = the part of a nail between its head end and its pointed end.

"the tool having a support foot"

Something on which the tool stands or is supported in use. P6L29: "Handle 20 has a central foot part 24 having a convexly curved sole which can be rested against the timber 28 or another convenient surface adjacent to the nail head 30."

Does the foot have to be separate part from the jaws? Probably not: for example, the jaw could also be the foot.

"engageable with a surface in which the nail is situated"

See "engageable with the shank", above. The description specifically admits of more possibilities here than the claim: technically it is not necessary for the tool to rest on the same surface as that in which the nail is situated: any convenient surface adjacent the nail head will do. In any event "engageable" means that this surface is not part of the claimed subject matter. As long as the tool is capable of being used in the claimed manner, the terms of the claim are arguably met, even if the tool is capable of being used or is usually used in other ways.
"Which" refers to the surface.

"and on which the tool is rollable and rotatable"

"rotatable" - movable with a pivoting motion.

"rollable" - suggests rotary motion against the surface without slippage (like part of a wheel). P7L5, "the handle 18 can be forced to the left (in the direction of arrow A, Fig. 3) so that the whole tool rolls and rotates on the foot 24 and draws the nail out of the timber".

Again does "which" refer to the surface? Or possibly the support foot? In fact it makes little difference, as the rolling contact is between these two items. P7 L6 says support foot, but on the other hand the repetition in the claim, "*in which...and on which...*" could suggest that the surface is being referred to in both instances.

"*to pull the nail from the surface.*"

See above. So the support foot acts as "rolling fulcrum" allowing the tool to pull out the nail. Rolling and rotating motion means that the jaws move away from the surface and take the nail with them. P7L10: nails "can be drawn out in a single rolling movement of the tool".

Does foot have to be more than a mere fulcrum? – e.g. load spreading function at least to the same extent as the central part 24 of the handle 20 in the illustrated embodiment?

Claim 2 – dependent on Claim 1 (2.5 marks)

"in which each jaw is attached to a handle"

"each" => both jaws individually attached to a separate handle? The illustrated embodiment has a different handle for each jaw. P6L23, "Jaw 12 is formed at the end of a handle 20 and jaw 14 is formed at the end of a handle 18." But the claim also covers the case where both jaws are attached to the same handle.

"attached" might suggest that the jaws and handle(s) are initially made as separate parts which are subsequently joined together. But this is inconsistent with the illustrated embodiment, in which each jaw and its respective handle is a unitary casting. So "attached" must include integrally formed (.

"handle" = a grip attached to an object for using or moving it. Part 18 attached to jaw 14 is referred to in the patent as a handle, but in fact it is the sliding weight 26 which is gripped to use the tool. In this light, it appears that the weight 26 should be regarded as a part of the handle for jaw 14.

Claim 3 – dependent on Claim 1 or Claim 2 (2.5 marks)

"in which the jaws are connected together by a pivot passing through them."

"them" = the jaws. P6L17, "my nail extraction tool 10 has a pair of jaws 12, 14 articulated together at a pivot 16." It can be argued that "*a* pivot passing through [the jaws]" requires one pivot which passes through both jaws (while still allowing other pivots to be present anywhere in the tool).

Alternatively, the jaws can be regarded as a collective entity, so a pivot passing through only one jaw will meet the claim.

Claim 4 – dependent on Claim 2 or Claim 3 (4.5 marks)

"in which the jaws are attached to their respective handles"

No antecedent at all for handle(s) when dependent on claim (3 not 2). No antecedent for each jaw being attached to a *respective* (i.e. a different) handle in

any event. This inconsistency caused some candidates to read the jaws of claim 2 as being attached to "respective" (i.e. different) handles too; whereas it is in fact possible that the error lies in claim 4.

"so that the nail is tightly gripped during rolling and rotation of the tool"

"tightly" is a relative/subjective term. It is reasonable to interpret as sufficiently tight to prevent the tool from slipping on the nail during extraction (c.f. problems with extracting larger nails with carpenters' pincers as described P3LL2-3).

Such attachment does not in itself inevitably result in such gripping, so is this a separate functional requirement of the handle and jaw arrangement? In the illustrated embodiment, "The lever arm formed by the separation between the foot 24 and the jaws 12, 14 ensures that the jaws tightly grip the nail and also ensures that even quite a long nail can be drawn out in a single rolling movement of the tool. However the length of the handle 18 relative to that separation (if necessary with extension of the casting 26) provides a mechanical advantage, allowing even a tightly embedded nail to be levered out". Page 7, lines 11-14.

Claim 5 – dependent on any preceding claim (2 marks)

"comprising a sliding weight"

Sliding weight is the heavy metal casting described P6L33-P7L4 in the illustrated embodiment. Also more broadly described P6L32 as a "percussion arrangement" = something arranged to hit or be hit. Sliding => one part or surface moving across or along another. Perhaps a guiding function. In the illustrated embodiment, the casting 26 slides up and down on the handle 18.

"by which the jaws can be driven into the surface in which the nail is situated."

Use of the weight drives the jaws into the surface.

Infringement (20.5 marks)

It is important that candidates give a conclusion as to whether a feature is present or not, and that sufficient reasoning is given to explain why the conclusion has been reached.

Claim 1 (11 marks)

"*A nail pulling tool*"

Mr Z's tool is apparently a nail puller, e.g. sales compete with client's tool, and client says it works in a similar way, for extracting nails: P3LL11-15.

"*comprising a pair of jaws*"

The tool does have a pair of (co-operating) jaws: see items labelled as jaws in sketch D, and caption relating to outward movement of one pivot, causing the jaws to grip the nail.

"*engageable with the shank of a nail to be extracted,*"

"[T]he anvil is hit with a hammer to drive the jaws into the wood around the nail head. The handle is then pulled in the direction of arrow B to grip and extract the nail." Page 2, lines 12-14. Client's description seems plausible here. It would appear to be the jaws which engage the nail, and it also appears that the jaws can reach around the nail head to engage the shank in the same way as with the patented tool, e.g. as described at page 6, lines 18-19, the jaws are "designed to reach around a nail head and to grip the shank of the nail on opposite sides just below the head in use."

"*the tool having a support foot*"

The support pad shown in sketch D appears to be something on which the tool is supported in use, P3LL14-15 (and is a distinct projecting part, providing a fulcrum spaced from the jaws). The pad acts to spread the load.

"*engageable with a surface in which the nail is situated*"

The support pad of sketch D is engageable with a surface in which the nail to be extracted is situated, in the same way as the sole of the central foot part 24 of the handle 20 in the illustrated embodiment of the patented tool.

"and on which the tool is rollable and rotatable"

Pulling on the handle in the direction of arrow B to grip and extract the nail as described by the client P3LL13-15 would appear to cause the tool to roll (and rotate) on the nail-containing surface without slipping. The curved support pad allows the tool to roll on the underlying surface.

"to pull the nail from the surface."

Pulling on the handle in the direction of arrow B causes the nail to be pulled out from the surface.

Conclusion: Claim 1 infringed by the tool illustrated in sketch D.

Claim 2 (2 marks)

"in which each jaw is attached to a handle"

The finger grip shown in sketch D is directly attached (solidly connected to) one of the jaws. It appears to serve a similar purpose to handle 20, 22 in the patented tool in making it easier to open and close the jaws and position them on either side of the head of a nail to be extracted, as described P6LL24-26. Thus it is probably a "handle" attached to one of the jaws (unless "handle" is given a narrow meaning e.g. as to shape).

The vertical handle is called such by the client ("long *handle*", page 3, line 12). This is reasonable as it is manipulated to work the tool. It is connected to the other jaw by one of the pivots. This feature is therefore present.

Conclusion: Claim 2 infringed by the illustrated tool.

Claim 3 (3 marks)

"in which the jaws are connected together by a pivot passing through them."

The jaws do appear to be connected together for relative (compound) hinging movement, by the linkage and the pivots at both its ends.

The linkage pivots only pass through one jaw each.

Conclusion: Claim 3 infringed/not infringed, depending on interpretation of "a pivot passing through them".

Claim 4 (2 marks)

"in which the jaws are attached to their respective handles"

The jaws are attached to respective handles: see comments on claim 2 above.

"so that the nail is tightly gripped during rolling and rotation of the tool"

"The handle is then pulled in the direction of arrow B to grip and extract the nail", P3 LL13-15. Pulling the handle also results in the tool rolling and rotating on the support pad, to pull out the nail.

Conclusion: Claim 4 infringed.

Claim 5 (2 marks)

"comprising a sliding weight"

The anvil is of a substantial size and if made of metal will be quite heavy. However it does not slide. Neither does the hammer used to hit it.

"by which the jaws can be driven into the surface in which the nail is situated."

The anvil is used to drive the jaws into the surface in which the nail is situated, P3LL12-14, "To deal with sunken nails, the anvil is hit with a hammer to drive the jaws into the wood around the nail head."

Conclusion: Claim 5 not infringed.

Novelty (22 marks)

Some candidates considered novelty and inventive step claim-by-claim. This is perfectly acceptable, but the more thorough approach (used by the majority) is to consider novelty first and then inventive step.

When discussing novelty, selecting the main points for discussion does not mean only commenting on any single feature of a claim that is missing from the cited art. This risks missing out on the majority of allocated marks.

In order to obtain the maximum number of marks all features of the claims should be considered, rather than stopping as soon as one feature have been found not to be present.

Below is a table summarising the points for consideration with regard to novelty.

Claim 1 (15 marks)

	Crowbar	Claw hammer (/Club hammer)	Pincers
A nail pulling tool	(✓) P2LL16-17: nails still in floorboards ✓ P2LL31-34 notched end gouges surrounding wood & grips nail shank. Nail then pulled from floorboard.	✓ P2LL20-29.	✓ P2LL361-P3L1.
comprising	✓	✓	✓
a pair of jaws	✓ P2LL31 & 32: notched end. (×) If interpretation is that jaws must be movable.	✓ P2LL21-22: Claws. (×) If interpretation is that jaws must be movable.	✓ P2L37-P3L1: curved jaws, 2 off, see C1-C3.
engageable with the shank of a nail to be extracted,	✓ P2LL33-34.	✓ P2L23, "on either side of the shank", & P2LL25-29 + B2. Probable that claws engage shank when driven under nail head.	✓ P2LL36-37 + C2, C3. Probable that jaws engage shank beneath nail head.
the tool having a support foot	(✓) curved end of crowbar, or surface of it that contacts timber during nail extraction. (×) For narrower interpretations this feature may not be present. Then falls to be considered under inventive step.	(✓) claws/timber engaging surface of hammer head – see B1, B2; P2LL23-24. (×) – as crowbar.	(✓) Possibly curved jaws or their timber contacting surfaces – P2L37 – P3L1. (×) – as crowbar.
engageable with a surface in which the nail is situated	✓ curved end and timber contacting surface can do this.	✓ Claws and timber engaging surface can do this.	✓ Jaws do this during nail extraction.
and on which the tool is rollable and rotatable	✓ This happens during nail extraction.	✓ This happens during nail extraction.	✓ This happens during nail extraction.
to pull the nail from the surface.	✓ The nail is extracted, P2L32, "pull it from a floorboard".	✓ The nail is extracted, P2L24, "lever the nail out".	✓ The nail is extracted, P3,L1, "lever the nail out".

Conclusion: Claim 1 old in view of any one of these pieces of prior art – though possibly distinguished by "support foot".

CLAIM 2 (1.5 marks)

Dependent on claim 1.

In which each jaw is attached to a handle	✓ Notched end is connected to remainder of crowbar which is used as a lever, i.e. handle, during nail extraction.	✓ Both claws are attached to remainder of hammer head and handle.	✓ Each jaw has its own handle.

Conclusion: Claim 2 old in view of any one of these pieces of prior art.

CLAIM 3 (3 marks)

Dependent on claim 1 or claim 2.

in which the jaws are connected together by a pivot passing through them.	× No pivot; crowbar per se has no relatively moving parts.	× No pivot; claw hammer per se has no relatively moving parts.	✓See drawings. Jaws/handles pivotally connected together.

Conclusion: Claim 3 old in view of pincers only.

CLAIM 4 (3 marks)

Dependent on claim 2 or 3.

in which the jaws are attached to their respective handles	× No separate handle for each jaw.	× No separate handle for each jaw.	✓Each jaw is attached to its own handle
so that the nail is tightly gripped during rolling and rotation of the tool	×	×	✓/ × The handles have to be squeezed together to grip the nail (P2L37); the pincers are rolled/rotated on the underlying surface to extract the nail (P3L1) but the rolling and rotation does not appear to significantly influence the gripping force.

Conclusion: Claim 4 new with respect to crowbar and claw hammer. Claim 4 new with respect to pincers, unless a broad interpretation is taken of the functional gripping requirement, in which rolling/rotation does not need to cause gripping.

CLAIM 5 (3.5 marks)

Dependent on any preceding claim

comprising a sliding weight	× No moving parts, so no sliding weight, unless the entire tool is interpreted as a weight, which "slides" relative to the timber during gouging (P2LL31-32). But this somewhat far-fetched.	(×) Claw hammer per se has no moving parts, as crowbar, so no sliding weight. Club hammer does not slide.	× No sliding weight.
by which the jaws can be driven into the surface in which the nail is situated.	×	(×)	× Nothing to drive the curved jaws into the timber. Pincers cannot readily deal with sunken nails – P3LL1-2.

Conclusion: Claim 5 new.

Inventive Step (15 marks)

There were marks available for discussion of inventive step of each of the claims. Marks are awarded for selecting a suitable starting point and applying the analysis.

Although, as noted above, examiners want candidates to show that they can reach a decision or conclusion on issues, one should exhibit extreme caution before unequivocally advising a client that a patent is invalid because the subject matter is obvious over prior art. It is possible to miss counter-arguments. One should put oneself in the position of the patentee and consider what arguments might be put forward to support patentability. However technically simple the subject matter may appear, a finding of obviousness should seldom be reached without consultation with a skilled person.

Once again the vast majority of candidates scored poorly on inventive step, with less than 10% gaining more than a third of the available marks. Candidates generally answered in one of four ways:

a. Stated that claims 1-4 or 1-3 were novel and they "therefore must be inventive" because none of the prior art disclosed all the features;

b. Stated that "there would be no motivation to combine the features of A, B and/or C" with absolutely no arguments as to why not;

c. Didn't bother setting out an answer on inventive step for claims they found to be old. E.g. at the very least, considering the possible relevance of other prior disclosures in relation to claim features whose presence in a "novelty destroying citation" is doubtful; or

d. Set out a problem and solution approach using a single prior art document as the closest prior art. Although this is an acceptable approach, it is unlikely to gain all of the available marks.

Very few candidates set out to discuss inventive step by considering features of the prior art independently and analysing them to determine what they were for, and whether a skilled person would use those features in combination with other prior art to arrive at the claimed combination.

The following are possible discussion points for consideration.

Pozzoli/Windsurfer approach:

Person skilled in the art (PSA) is a hand tool designer/manufacturer, or perhaps a tradesperson or the like habitually concerned with the extraction of nails or lifting floorboards.

The claw hammer, crowbar and carpenter's pincers are probably common general knowledge as are their methods of use in lifting floorboards or, in the case of the pincers, extracting nails. (These methods are described as commonplace in client's letter, P2L12).

It is a matter for evidence and testimony of experts, but the inventive concept of claim 1 would appear to be the support foot which forms a fulcrum on which the tool rolls and rotates so that a nail gripped in the jaws is pulled from a surface. These features are present in each of the crowbar, claw hammer and pincers, to the extent that they provide such a fulcrum. Making the "foot" a distinct, e.g. projecting part or part separated from the jaws would not appear to affect how the tool works, and so could be regarded as a mere workshop variant. Making support surfaces larger to reduce applied pressures is well known. So even if it were new, claim 1 could well be seen as obvious over any one of these prior tools.

Claim 2 is likewise likely to be seen as obvious, as these tools each have jaws attached to a handle. In the crowbar and claw hammer, the jaws share a handle. In the pincers, the jaws have individual handles.

In the crowbar and the claw hammer, both jaws are formed from a single solid piece of metal. This does not suggest pivotally connected jaws. However the pincers have jaws connected together by a pivot passing through them. So claim 3 is probably just as obvious as claim 1 in view of the pincers. When we get this far, we have to be careful that we are not mosaicing 3 documents – i.e. look at the complete combination claim 1&3 and 1, 2 and 3, and then ask if that is obvious over C + CGK, or B + CGK, or A + CGK, or C in view of A, or C in view of B……or other combinations of two prior disclosures. C may be a sensible starting point, if it has almost all the combination of features defined by claims 1&3. But don't forget that sometimes the features of a claim can be more or less evenly split between two prior disclosures. For an obviousness attack to succeed, the two prior disclosures must be ones that the (knowledgeable but unimaginative) skilled person would consider combining.

The handles of the claw hammer and of the crowbar do not appear to have any influence on how tightly the jaws grip the nail. The handles of the pincers do appear to provide increased leverage and in that sense tighter grip at the nail than the squeeze or grip applied at the handles, which can and (for the pincers to work effectively) must, be applied during rolling and rotation of the pincers for nail extraction. However if claim 4 is interpreted as requiring a causal link between the rolling and rotation movement and an improvement of the grip of the jaws on the nail, this is not present in or suggested by the pincers.

The claw hammer can be driven into the timber by a club hammer so as to undermine a nail head. The crowbar can gouge out the surrounding wood by its own momentum. However neither of those mechanisms would appear to suggest a sliding weight. Neither the pincers nor the crowbar is suitable for hitting to drive its jaws into the timber around a sunken nail head. Claim 5 is likely to be found inventive.

Amendment (6 marks)

In general this section was not well dealt with.

Many candidates decided amendments to include features such as "relatively small jaws" (but relative to what?) or jaws facing downwardly and handles being vertical (again, relative to what?) were suitable. This type of amendment suggestion did not generally attract high marks.

One possibility is to specify in claim 1 that the force applied to the handle to pull out the nail also causes the jaws to grip the nail more tightly. There is basis for this in the final sentence of the description. Could perhaps also specify that the handle to which the pull is applied is operatively attached to one jaw and another handle is operatively attached to the other jaw and forms a lever arm engageable with the surface. The latter features provide more "structure" if the functional statement linking pulling on the handle to an increased grip on the nail is insufficient on its own. All of these features are arguably present in Mr. Z's tool; although there the main handle is less directly linked to its associated jaw than in the client's tool. Such enhanced gripping does not appear to be suggested in the prior art.

Additionally or alternatively claim 1 could be amended to specify that the tool is provided with a percussion arrangement by which hingedly connected jaws can be driven into the timber on either side of the nail head; see page 6, lines 32 and 33. Although the club hammer and the cooperating part of the claw hammer head is a percussion arrangement for driving the claw hammer claws into the timber on either side of the nail head, the claws are not hingedly interconnected. Is there anything in the prior art that suggests such an interconnection? For example is there anything to make the skilled person consider combining the pincers and the claw hammer? Perhaps PSA might realise that pincers could be made to deal with sunken nails if their jaws could be driven into the timber – e.g. by making them smaller as in the crowbar which has small jaws better adapted to gouging, and also shaping the jaws or some other convenient part so that they/it can be hit to drive the jaws in. But perhaps this is not a very strong obviousness attack, as several modifications to the pre-existing tools have to be made simultaneously. Presumably the problems of prior tools (crowbar, claw hammer, pincers) when dealing with sunken nails have been long known, without the invention having been made. Does this suggest that invention is not obvious?

Sufficiency (0.5 marks)

No issues? Invention as broadly claimed is not necessarily effective in extracting sunken nails, as promised P6LL4-5?

Advice (9marks)

In this section of the paper marks are awarded for summarising conclusions and giving general advice.

The advice of most candidates was generally formulaic and concentrated on telling the client exactly which claims were infringed, which were novel and which were inventive, without any practical advice at all.

Many candidates seemingly believe that applying for an interim injunction and suing the alleged infringer should be the first port of call – despite advising the client that their patent is invalid.

Points for discussion:

Is Mr. Z's business based in UK? If not, only sales to customers taking place in UK infringe, or if his website clearly targeted at UK customers.

May be difficult to go after individual customers of Mr Z in UK. Retailers may be worthwhile, but must take care regarding threats.

Look at sale and purchase agreement with Mr Z. Are there any enforceable non-compete covenants?

Does the agreement discuss ownership and/or right to use of further developments/IP outside scope of patent?

Does the agreement include any covenants/warranties as to the validity of the patent?

Is there a possible cause of action for breach of contract?

Need to amend patent. Can do so in IPO under s.27. These amendments are advertised for possible opposition. But if unnoticed by Mr. Z they may be easier to obtain than during course of litigation. Delay occasioned by this procedure may mean an interim injunction is not available.

Put Mr Z on notice – but this conflicts with amendment strategy under s.27.

Issue (non-threatening) notices drawing attention of Mr. Z's major customers to existence of patent. If Z is a manufacturer or importer, there is more scope to take a hard line against him. Z has knowledge of the patent, and so is not "innocent".

Negotiation with Mr Z. Emphasise clear infringement and seeming bad faith given intimate prior knowledge of patent. If patent validity challenged, point out possibility of saving amendment and continued infringement.

Is the client willing to offer a licence, e.g. to gain new income via internet sales? Can client benefit as distributor of Mr. Z's new tool in UK?

Can amend in course of litigation – s.75, but will be open to opposition by respondent, Mr Z.

Any damages award may be reduced if patent partially valid and as no valid claim infringed prior to amendment. But injunction probably valuable to client in its own right.

Interim injunction – may not be available if client has already delayed action - but court may be sympathetic if "serious impact" only recently manifest. Mr. Z's new business more recently established, so balance of convenience may favour client. How long established was Mr. Z's former business, prior to sale to client? Cross-undertaking; consider the financial strengths of parties. Court may order speedy trial instead.

Request IPO opinion for infringement and/or validity (after amendment, to improve patentee's position, and as Z will be notified). What benefit would this give?

The "real" Examiners' Comments

As an indication of some possible pitfalls and how to avoid them, a selection of the Examiners' summaries of individual answer scripts is provided below. The Examiners mark according to a detailed schedule, but often provide comments summarising each answer script.

Good solid paper.

Difficult to read. Pretty good answer.

Good novelty. Consistent.

All sections full of "ifs and buts" - no concrete conclusions anywhere.

Very broad construction for Claim 5. Just worth a pass.

Stopped after novelty. Not too bad up to there.

Answers not always clear and not enough conclusions.

Construction shaky; rest of paper suffered as a result.

Not enough explanation for conclusions.

OK; strange construction arguments.

Novelty and advice a bit confused.

Good appreciation of points in issue.

Great novelty and infringement sections; poor advice.

Pass - no issues.

Good overall; poor inventive step.

Really good in all sections.

Novelty and inventive step combined and muddled. Missed a lot of marks.

Confused about "jaws"; novelty section woolly.

Seemed to run out of time so no chance of passing.

Clear pass.

Good except for advice and amendment.

A really good paper. Understood all the major points.

Awkward construction of jaws. Not quite there.

Clear fail. Not always consistent.

Construction not decisive enough. Gave problems later on.

Not bad, but construction is lightweight and no real advice.

Good paper. Picked up on all major points.

Not enough detail in conclusions. Questionable amendment.

Missed out on lots of marks by not considering all parts.

Borderline - too much fence sitting.

No clear decisions on construction so candidate "fudged" infringement and novelty to suit

Speculative throughout; no clear answers.

Pass: good inventive step section - one of the few to do it properly.

Good up to inv then no marks at all afterwards; a shame.

Good pass.
