

Examiners' Comments

P4 2011

General comments

The paper this year continued in a similar vein to previous years and sought to provide an opportunity for candidates to demonstrate their practical abilities in as realistic a setting as possible, rather than attempting to catch people out in elephant traps, set fiendishly difficult puzzles, or test arcane knowledge. It was hoped and it appeared from the scripts that this was achieved.

By and large, candidates seemed to know what was expected of them and provided their answers in an appropriate format, in many cases displaying a great familiarity with points discussed and suggestions made in previous examiners' comments. Clearly, many candidates have worked hard to prepare for this paper and that is also to be applauded. All that notwithstanding, candidates should not lose sight of the fact that overall what is sought is a sensible, safe response addressing the client's needs, and a clear communication to the client of what has been done and why. The paper was generally marked in such a way that answers that did provide these elements would pass, and answers that did not, would not. For example, a candidate would typically gain more marks in the inventive-step section with a few good clear, relevant arguments than by slavishly following all of the Pozzoli steps but not making many relevant points.

As is discussed in more detail below, a common issue in this year's paper was added subject-matter. Many amendments, especially in relation to dependent claims or the proposed divisional claim, appeared to 'sail close to the wind' in this regard. The examiners were keen to give candidates the benefit of the doubt, but were unable to do so if (as was often the case) there was no acknowledgement of the issue, let alone a reasonable argument in support of the amendment. It can be generalised that if you do something that is potentially contentious, you need to take care to justify and to explain your actions. This is as important in a real-life scenario as it is in the P4 exam.

Brief introduction to the paper

GB 0999999.9 ('the application') concerns a reusable routing pouch having a wipe-clean address field on the back of the pouch which is covered by and viewable through a transparent window in the flap. When the pouch is opened by a recipient, the address field can then easily be wiped clean and reused. Elongate slots in the front and back of the pouch allow easy viewing of the pouch contents during transit.

US 1111111 ('D1') discloses a pouch having two pockets: one for holding the pouch contents, and the second, viewable through a window in the front of the pouch, for holding a routing pad containing multiple address fields. In the first embodiment, the routing pad is a block of paper having sheets which can be torn off when used up. In the second embodiment, the routing pad is a plastic sheet onto which addresses can be written using a permanent marker pen. The window may be covered by transparent material to protect the pad. The pouch includes circular sight holes extending all the way through the pouch for determining whether the pouch is empty.

Catalogue extract no. 2222222 ('D2') discloses a routing envelope having multiple wipe-clean address fields made from wipe-clean plastic, and transparent plastic covers for the envelopes to protect the wipe-clean address fields during transit.

The Examiner asserts that Claims 1, 5, 6, 7, 8 and 10 are anticipated by D1, and that Claims 2 and 3 are obvious in view of D2. The Examiner also raises a clarity objection against Claim 4, and a further novelty objection against Claim 11.

The client asks you to reply to the report, and tells you that a very good feature of his design is that the addressee can very easily erase their name from the pouch once they've opened it but that otherwise the address is protected, and that he is keen to keep open the option of protecting the elongate sight slot feature when he has more money.

Claim 1

25% of marks were allocated to Claim 1. An amendment to Claim 1 was sought which includes the features that the window is in the closure flap, that the window comprises transparent material (and is not merely an opening), and that the window covers the address block when the flap is closed. This specific combination of features was considered to give rise to the advantages mentioned by the client: namely that the address block is protected in transit but is easily erasable once the pouch is opened. The positioning of the window in the pouch flap gives clear novelty over D1. Most candidates went for an amendment of this sort; there were many different attempts to express this, some more successful than others.

The examiners felt it was unnecessary to limit Claim 1 also to the feature of wipe-clean material because it is arguably not an essential feature (it is suggested as an optional feature in the summary of invention on page 2, lines 24–25, for example), and because one could conceive of potentially useful reusable address blocks that were not wipe-clean (for example one that can be written on in pencil and then rubbed out with an eraser). On the other hand, it was felt that an opposing view could reasonably be taken (there is, for example, no disclosure of any alternative to a wipe-clean address block in the application, and a wipe-clean surface is particularly relevant to the advantages mentioned by the client), so a further limitation of Claim 1 to wipe-clean material was generally neither rewarded nor penalised.

It is true that the application contains a clear statement to the effect that the window does not have to be in the flap (page 2, lines 22–24), but this is a clear point of novelty over D1 and an important factor in terms of inventive step, and no arrangements are disclosed in the application where the window is not in the flap, so it is difficult to justify a claim in which this feature is not present (especially if the feature is included as a dependent claim, implying that Claim 1 is intended to be so broad as to cover envelopes with other arrangements of the window).

Many candidates missed that Claim 1 is defective in more ways than are mentioned by the Examiner. For instance, the phrase “in use” is not helpful – this could be “in use when in transit (flap shut)”, or “in use during the stuffing process (flap open)”, for instance. Since it seems essential to the invention that the address field is visible through the window when the flap is shut, arguably this should be stated.

In their handling of Claim 1, candidates were expected to consider the meaning of the term ‘window’. The UK Examiner had asserted that the ‘opening’ of D1, which can be covered or uncovered, was equivalent to the ‘window’ of the application, and the question therefore arises of whether or not the term ‘window’ in Claim 1 should be interpreted narrowly (covering only ‘solid’ windows that include transparent material) or broadly (for example covering any kind of opening, covered or uncovered). This is significant firstly because an uncovered window would not provide protection for the address field in transit, which has implications at least for inventive step, and secondly because it is arguable that the transparent material portion is an essential feature of the invention (see the summary of invention on page 2, lines 21–22, for example). This latter point becomes a particular issue if, for example, the feature of the window

comprising transparent material is included in a dependent claim, which implies a broader interpretation of window in Claim 1 extending beyond the scope of the application as filed.

In view of the above, when considering a Claim 1 that did not include the transparent material feature, the examiners had to look for clues as to the candidate's intent: if a candidate gave an argument why 'window' should be construed to cover only 'solid' (protective) windows, or even simply acknowledged that there may be an issue in this regard, the examiners could more confidently give higher marks for Claim 1. Otherwise it was assumed that candidates had overlooked the issue entirely or deliberately constructed Claim 1 so to omit the transparent material feature, and a lower mark was given.

Some claims relied on the wipe-clean material feature alone for novelty and/or inventive step (in some cases in conjunction with the feature of a transparent material portion covering the window, which does not distinguish over D1). These claims were considered to be poor, firstly because of the inventive-step objection that has already been raised (with some justification) based on D2, but secondly because such a claim may even be anticipated by the plastic sheet of D1: it could be argued that the plastic sheet described in D1 is inherently a "wipe-clean" material, and the only reason it does not wipe clean in D1 is that permanent markers are used. Many candidates did provide arguments against this interpretation in their response (for example, if a non-permanent marker is described in D1 as causing 'smudging' on the plastic sheet, is that not different to 'wipe-clean'?), but, even so, the claim was considered to be unnecessarily precarious in terms of novelty and inventive step, and was in any event not directed squarely to the features of interest to the client.

A claim directed to the feature that the address block contains only a single address field is arguably novel – D1 and D2 disclose only pouches having multiple address fields – but only if worded very carefully so as not to read onto the individual address fields which, put together, constitute the multiple address blocks of D1 and D2. Even if the claim is novel, there remains an inventive-step issue, and the claim again does not meet the client's requirements.

Another possible amendment includes the feature that the address block is laminated to or otherwise integrated into the pouch. Such a claim is novel, distinguishing over the removable routing pad of D1, and arguably inventive, but is not ideal because again it does not address the client's commercial interests. In this regard, it is not enough to say that the address block is "on" the face of the pouch – it must be "laminated" if this feature is to distinguish clearly over D1.

The elongate slots feature was another possible amendment, of course, having novelty and at least arguable inventive step. Clearly the client was interested in this feature, but given cost considerations it was considered more appropriate to protect this feature via a divisional application in due course (see below).

Some claims put forward by candidates were 'kitchen sink' style claims including several essentially unrelated features. Such claims were generally novel (barely at least) but more or less failed on inventive step and were marked accordingly. In other cases claims included essentially all possible features, achieving novelty and inventive step by default, but providing protection that was far too narrow. In all such cases it appeared that insufficient thought had been given to the amendment.

While it is of course possible in principle to broaden the claim during prosecution, great care should be taken when removing claim elements because of the possibility of adding subject-matter. There is, for example, a recitation in the statement of invention (at page 2, lines 19–21) of an 'address block' rather than a 'reusable address block' as in Claim 1 but, given the focus of

the description on the reusability of the block and the fact that this reusability contributes significantly to the inventive step of the claim, there are good grounds for considering it to be an essential feature of the invention whose removal from Claim 1 would add matter to the application. This was a particular problem with the divisional claims proposed by candidates (see below).

One example of claim broadening was the removal of the term ‘window’ from Claim 1, in some cases substituting the transparent material portion feature for it. If such an amendment is to be made, it is vital that adequate basis be given. For this sort of amendment, the examiners are looking for more than just a page reference or even a statement that the terms have been used interchangeably in the specification. A candidate could for example consider (in the client memo if nowhere else) whether a flap could be envisaged with a transparent material portion but not a window (such as a flap with a transparent plastic pouch stuck on top, and no visibility of the address block beneath the flap) or vice versa, and whether the term ‘window’ may imply properties that the term ‘transparent material portion’ does not (such as possibly being uncovered, as discussed above, or having a rectangular shape, perhaps), and vice versa – if not only to demonstrate to the examiners that the issue has properly been considered and understood.

Dependent claims

12% of the marks were allocated to the dependent claims. Credit was given for fixing problems with the existing claim set, for a sensible choice of additional dependent claims and for appropriately adapting the existing dependent claims to match the amendments to Claim 1.

An important point to make is that it was considered an error to remove existing dependent claims because they did not seem novel or inventive (pre-amendment) or were not considered to provide ‘useful fallbacks’ or the like. With an appropriate amendment to Claim 1 all dependent claims would of course be novel and inventive by virtue of their dependency on it. That they may not provide a useful fallback (or similar) in view of the cited prior art is an insufficient reason to remove them; any of the dependent claims might conceivably provide a useful fallback with regard to as-yet-unseen prior art, especially if the anticipation of Claim 1 by that prior art was only ‘accidental’ (in which case incorporating an apparently trivial feature from the dependent claims might suffice for patentability). Of course in jurisdictions levying excess claims fees, or where a clarity objection is threatened, the removal of dependent claims may be more clearly justified.

In a similar vein, many candidates amended Claims 8 or 9 to clarify the purpose of the elongate sight slots, presumably in response to the objection raised by the UK Examiner. This is more of a grey area; for the reasons given above, the original claims did not *require* amendment, though this clarification (i.e. that the slots allow contents to be seen) was useful. This ties up with the “opening” in claim 1 and distinguishes over the front pocket of D1 which arguably is not filled through the same opening that the envelope is.

Candidates should be wary of substantial rewrites of dependent claims. This is rarely required in practice or in the examination, and carries a substantial risk of adding matter. At the very least, candidates should be prepared to explain in detail the support for any amendments that do not have literal basis in the application. Whether or not adequately justified, candidates may wish to reflect on whether amendments of this sort represent the best use of their time in the exam.

There were some instances of intermediate generalisations being introduced into the claims, particularly in relation to the reinforcement structures of the elongate sight slots. References to

‘tape or fibres’ rather than ‘strips of tape or strong fibres’, and certainly references to ‘reinforcement’ rather than ‘linear reinforcement’, and the like, arguably represent such generalisations, and may add subject-matter. Whether or not a candidate feels that these terms are justified, they should consider that if they do not explain why, or even raise the issue, an examiner will generally not give them the benefit of the doubt.

Candidates were expected to fix Claim 4 to make it dependent on Claims 2 and 3 only (which is moot if the wipe-clean feature of Claim 2 is incorporated into Claim 1, though marks were deducted if it appeared that such an amendment was made specifically to address the clarity objection), and to amend Claim 11 to refer only to Figure 2 (Figure 1 shows the prior art).

Assuming that Claim 1 was directed to the preferred amendment that the window is in the closure flap and comprises transparent material, credit was generally given to dependent claims directed to the following features:

- The elongate sight slot is reinforced by strips of tape or strong fibres/ linear reinforcement structures perpendicular to the slot orientation
- The fastener sections on the back face of the pouch are longer than the fastener sections on the flap [to accommodate bulging of the pouch from overstuffing]
- The address block is laminated to the pouch material/over the primary material of the pouch
- The pouch is made entirely of wipe-clean material
- The address block consists of a single address block (or similar, care must be taken to avoid reading onto prior art with multiple address blocks)
- The sight slots extend nearly the entire length of the pouch

Dependent claims including the following features were generally not given much credit (nor usually penalised – but see below):

- The wipe-clean material is polythene or polyester
- The pouch is made entirely of tear-resistant materials
- The strips of tape or strong fibres comprise flexible plastic, string, rubber or flexible bands of metal
- The tape or fibres are laid across the elongate slots at regular intervals
- The address block is indicated by written instructions/heavy outline of the block
- The fasteners are Velcro®
- Kit of parts claims

The division of features into those attracting marks and those not is somewhat arbitrary in places and in practice there was some ‘wiggle room’ depending on how the claim set worked as a whole.

No excess-claims fees are payable in the UK but it should be noted that very large numbers of dependent claims may be objected to on clarity grounds. Full credit was not given when candidates appeared to be taking a ‘scattergun’ approach and including very large numbers of dependent claims regardless of merit, partly because an objection might arise in real life from such an approach.

Divisional applications

7% of marks were allocated to divisional applications. It was felt that the client's instructions clearly signposted a claim directed to an appropriate form of the elongate sight slot feature. Many candidates reported that they had already filed a divisional, which seems a bit precipitate, particularly for an impecunious client.

A limitation to original Claim 8 or 9, possibly also including a phrase such as 'for viewing contents of the pouch', would be the safest option. Many took out all reference to the "window" in the main claim, a course the examiners felt to be risky. Some referred to the "statement of invention" on page 2 lines 19-21 as justification, but many ignored altogether the risk of addition of subject-matter. Of course, this is curable, but it is still undesirable. No candidates who referred to the statement of invention discussed whether the sentence of lines 21-22 ("The envelope has ...") had to be read as continuing from the previous sentence; contrast the next sentence, which says "The transparent material portion can be ...".

Most answers went for the above-mentioned elongate slot feature in some form. Suggested divisional claims seemed to be evenly split between versions with a single elongate slot but the contents "visible", and paired slots on front and back. Candidates are not expected to draft dependent claims for divisional applications but it would be appropriate to comment on the strength of the claim (in this case not particularly good) and to consider what might be a realistic fall-back position (the reinforcement features, for example). The transparent material cover is also a useful claim, though possibly obvious if one is allowed to consider known window envelopes.

Letter to Patent Office

33% of marks were allocated to the response to the examination report, split between basis/support, novelty, inventive step and clarity headings.

- Basis/support

Generally speaking a candidate can achieve a pass mark for this section by correctly listing page and line numbers for each claim, but usually there is more to do in order to get full marks.

Candidates were often penalised because they did not give adequate explanations for their amendments. A page reference will generally suffice for amendments finding literal basis in the application as originally filed, but otherwise a little more is expected, if only to persuade the examiners that candidates properly understand the requirements relating to added subject-matter.

One common error in terms of added matter was to claim the feature of a 'reinforcement' means and so on of the elongate sight slots. There was in the application a clear disclosure of linear reinforcement structures (at that level of generality and also in detail) but basis is a bit thin for reinforcement structures more generally. Candidates could have pointed to the transparent cover over the slots to argue that a broader term than 'linear reinforcement' was justified, but generally they did not and instead only referred to the passages relating to linear reinforcement. The examiners had to assume in that case that candidates did not properly appreciate the issue of impermissible intermediate generalisations.

- Novelty

Again, pass marks could usually be obtained by identifying briefly features of Claim 1 that were not disclosed in the prior art (and this is arguably a good approach in a real life situation given issues with file-wrapper estoppel in the US and so on) but in this paper the examiners would

rather see more evidence that a candidate understands the cited prior art in particular, and the concept of novelty more generally – for example by identifying correspondences between features of Claim 1 and each prior-art citation before identifying features of Claim 1 that are not present in the citation (the points of novelty).

Candidates were expected to give a novelty analysis for both D1 and D2. An analysis of the prior art cited in the application was not required here, since no objection was raised.

Not all candidates dealt separately with the two (or more) different embodiments of D1, which often resulted in confused argument.

As mentioned above in relation to Claim 1, it may be appropriate to consider whether or not the plastic sheet in D1 constitutes ‘wipe-clean material’.

- Inventive step

There have been great efforts to standardise the assessment of inventive step (the Pozzoli decision being the most recent in the UK), but it is not so easy to standardise an approach to arguing in favour of one. This is an area of some subjectivity, requiring the use of advocacy skills which are a matter of both style and substance, and which are generally improved with practice and experience. It is therefore difficult to suggest a ‘model answer’ or a general best practice for replying to this section, though some general points are given below, followed by specific comments in relation to the problem set in this year’s paper.

When constructing inventive-step arguments, one is usually looking to the text of the application and the prior art, and to the feedback from the client (to whom it is often clear not only how the prior art differs from the present invention, but why) for source material. It is not normally necessary, and it can furthermore be dangerous, to rely on anecdotal/unsubstantiated and/or specialist information known to the candidate, or to base arguments on overly convoluted or speculative technical analyses. This is not only true of the exam but also in real-life situations. A candidate who is only able to construct arguments of the latter type should consider carefully whether or not they have chosen a suitable amendment.

It is noted that a rigorous application of the ‘Pozzoli test’ requires an identification of differences between the inventive concept and the prior art, but candidates should not place too much emphasis in the inventive step section on statements such as ‘the prior art does not teach or suggest feature X’, since this is essentially a restatement of a novelty argument without using the word ‘disclose’. The real meat of the argument comes afterwards, explaining why the skilled man would be directed elsewhere, faced with such a deficit of features, or would be prejudiced against consulting a document, or would be unable to combine the disclosures of two documents, and so on.

Candidates should as ever take care not to base inventive-step arguments on features which are not present in Claim 1, for example by arguing that a single address block is easier for a user to read but not specifying in Claim 1 that (only) a single address block is provided. This issue did not seem to crop up very often this year, but, when it did, it was typically in more subtle ways: candidates often used a more ‘conversational’ style of language in the inventive-step section, as a result casually introducing synonyms for, or abbreviations of, claim features (‘window’ for ‘transparent material portion’, and so on) without apparently considering the significance of the change. This sort of thing can be considered a question of style rather than substance, but candidates should remember that the examiners very much want to be persuaded that a candidate knows what they are doing, and a clear, precise use of language is a good way to do so.

Specifically in relation to this year's paper, the preferred amendment (see Claim 1, above) has the following intrinsic advantages (all signposted within the exam texts), which are indicative of the presence of inventive step:

- A separate insert is not required
- The addressee can easily erase his or her name from the pouch once they have opened it (which applies also if the wipe-clean feature is not included in Claim 1, e.g. if pencil and eraser are used).
- A wipe-clean material / non-permanent markers can be used because the transparent material covers the address block while the pouch is in transit

With regard to the prior-art documents, one could argue that the obvious combination of D2 with D1 (if there is one) is to use a separate sleeve to protect the address block, and that even a more arbitrary combination of features of the two documents would not result in the claimed feature of the transparent material window in the flap.

For versions of Claim 1 including the wipe-clean material feature, it could also be argued that D1 already discloses a wipe-clean address block (in the second embodiment) but teaches that permanent inks and solvents should be used to avoid smudging, thus teaching away from the combination of the wipe-clean material with the protective transparent material window in the flap.

It could also be argued that the construction process of the claimed pouch is simpler and that the materials required are cheaper compared to D1, but this is somewhat speculative and may well not be true (D1 does not, in at least one embodiment, require any transparent material to be provided or bonded to the pouch, for example).

With regard to other features that were occasionally included in Claim 1: the single address field had the benefit that it provided a tidier appearance and that there was less likelihood of confusion on the part of the user; the elongate sight slot provided greater visibility of documents inside the pouch (a bit underwhelming); the linear reinforcement of the elongate sight slot improves the longevity and strength of the pouch (also underwhelming); the address block being laminated to the pouch allows for less expensive material to be used for the pouch; and the relative sizes of the fastener sections accommodates bulging of the envelope. Other advantages may exist.

Finally, with regard to the first step of the Pozzoli test (where applied in full – this is not required for good marks in this section) the skilled man is not likely to be a user of stationery materials, but a designer or manufacturer. It is difficult to say exactly what would have constituted common general knowledge (CGK): the prior art of Figure 1 almost certainly would have done, D2 probably would, and D1 possibly would. In practice one might want to err on the side of caution, however, because an admission that a piece of prior art is CGK can be damaging to inventive-step arguments but also have a damaging effect in other jurisdictions (such as the US, for example).

- Clarity/other issues

This section covered issues not already covered by the above headings, including requesting an extension of time for filing the response (two months as of right as per section 117B), requesting grant to be deferred if the application was in order to allow time for filing a divisional application, and for addressing the clarity objection to Claim 4 raised by the Examiner.

Client memo

Some 23% of marks were allocated to the client memo. As always, candidates were expected to provide an analysis of the new prior art, to comment on the Examiner's objections in the examination report, to give the attorney's own opinion (not just parroting the Examiner's view, though it is useful to state whether one agrees) on whether or not the claims required amendment, to provide a reasonable analysis of the options for amendment, and to provide an explanation of why a particular amendment was chosen, with particular reference to the client's commercial considerations. A competent attempt at this will usually achieve at least a pass in this section, but candidates may find this a useful approach in real life also.

Candidates who discussed ways of playing for time were felt to have an appreciation of the client's shortage of money. Sensible comments were called for about claims the Examiner did not object to (e.g. Claim 7, noting that hook-and-eye fastening is known from page 1 line 28). Some rightly pointed out that the Examiner's flagged objection to Claim 7 is not discussed in the succeeding paragraphs, but the reason for it seems clear enough.

A (non-exhaustive) list of additional points that could be covered includes:

- A two-month extension of time is available
- No medical certificate needs to be supplied as the extension of time is as of right
- A discussion of options for filing divisional applications given the lack of funds and the subject-matter to be covered
- An obvious appreciation of the client's commercial position (see also above point)
- Identification of areas where more information may be required from the client
- Identification of possibly contentious issues and areas where the Examiner may still raise objections

As in previous years, some candidates included all their notes and even the question papers. The Examiners have yet to encounter a case where this has been useful or attracted marks.