

P3 2012 Examiners Comments

General

Candidates are advised to refer to the book by Iain Russell on How to Pass P3, as well as the Fundamentals of Patent Drafting by Paul Cole.

This paper requires a complete specification, it is not simply an exercise in invention spotting and claim drafting. The paper is part of a set of papers – P3, P4 (Amendment) and P6 (Interpretation) which require a related set of skills.

Thus, although the bulk of the marks on this paper are attributed to the claims, candidates must spend sufficient time on the description (and abstract) to have a good chance of passing. The interpretation of the claims, particularly the independent claim(s), is affected by what is in the description. A poorly written description can leave the examiners puzzling over the intended scope of a claim (and will cause difficulties in real life as well, of course).

As well as playing an important role in helping with the interpretation of the claims, the specific description often provides basis for later amendments to the claims. It is difficult, sometimes impossible, to amend claims based only on what can be seen in the drawings. A good specific description does not require constant reference to the drawings in order to follow it. It should not just be a list of parts, but describe how they are arranged, fit together and operate (see the paper by Eric Micklethwaite reproduced in Paul Cole at page 167).

The Invention

The idea is from the cap on a bottle of NurofenTM tablets. The examiners were expecting an independent claim which focussed on the invention as being a two part cap made up of an outer cap enclosing an inner cap (to prevent operational access to the inner cap), with axial movement of the outer cap engaging the inner cap for undoing the cap.

Issues mentioned by the client are:

1. Can't squeeze and twist (second paragraph)
2. Forcing cap (second paragraph)
3. Desirable to fit 'ordinary' bottle (final paragraph)

The advantage, found by the client, is that it is much easier to push and twist than squeeze and twist (client letter, fourth paragraph). Also, there is no resistance when simply twisting in the undoing direction (fifth paragraph), and the cap (can) fits on a normal bottle neck (sixth paragraph).

Most candidates identified the invention as being the feature of requiring/using axial movement to engage the cap parts to undo the cap, but many lacked the structural features to go with this (see Iain Russell's book on P3).

Main Claim

Examples of main claims which formed the basis for a good pass were:

A safety cap for a bottle, the safety cap comprising:
an inner cap;
an outer cap, the outer cap surrounding the inner cap;
means for urging the outer cap and the inner cap axially apart;
wherein the safety cap is opened from the bottle when the outer cap is displaced axially toward the inner cap and rotated.

A safety closure, comprising:
an inner cap having a thread; and
an outer cap arranged coaxially around the inner cap
the inner and outer caps having mutually interlocking engagement portions resiliently biased into a disengaged configuration,
wherein relative axial force between the inner and outer caps causes the engagement portions to engage, thereby preventing relative rotation of the inner and outer caps.

Neither claim might be described as perfect, and both claims contain terms which require a degree of interpretation based on what is contained in the description. For example – in the first claim, what does ‘surrounding’ mean, in the second claim what does the thread do, and is it an essential limitation?

A main claim along the following lines could have led to a pass, if supported by dependent claims, and a good description and abstract:

A (two part) safety cap,

inner part screws onto bottle neck to close it,

outer part (snap) fitted on to inner part to enclose it,

one way drive means between inner & outer caps for screwing cap onto bottle,

engageable drive means between inner and outer caps for unscrewing the cap, the engageable drive means being normally disengaged and being engaged by axial pressure on the outer cap.

The interpretation of such a claim depends on what is in the description, but, taking it at face value, questions which a candidate might ask about the scope of the claim are:

A (two part) safety cap, (Safety caps are the field of interest and so it is reasonable to limit to this and broader wording risks a wide ranging search – but is it clear from the candidate’s description what a ‘safety cap’ is, as this will imply certain limitations? If not, does the rest of the claim define a safety cap, and achieve the improvement/ advantage/solution set out by the candidate. It is not immediately apparent how the invention might be implemented with a single part, and subject to

what the candidate's description says, three or more parts are not necessarily excluded by specifying two parts).

inner part screws onto bottle neck to close it, (the reference to a bottle might be limiting although sufficient to cover the markets of interest to the client (medicine and possibly bleach) – cf. screw top 'cans', although some definitions of bottle do not exclude cans. 'Container' might be better. 'Screw top' might exclude a bayonet fitting, but there is no suggestion of anything other than screw tops from the client, and the fit to existing bottles is a benefit – client letter, final paragraph).

outer part (snap) fitted on to inner part to enclose it, (a key feature here is 'enclose' – if the outer part does not enclose – i.e. stop access to – the inner part, is it going to work as a safety cap? What does the description say? Snap fitting is unnecessarily limiting (cf. a metal outer cap which could be turned around the inner part – client mentions metal inner part).

one way drive means between inner & outer caps for screwing cap onto bottle, (in effect a ratchet which is there all the time. Is it necessary to mention a closure mechanism at all? It is probably implicit in any definition of a re-usable cap – otherwise the cap could not act as a closure.)

engageable drive means between inner and outer caps for unscrewing the cap, the engageable drive means being normally disengaged and being engaged by axial pressure on the outer cap. (The 'undoing' drive must be normally disengaged, client letter, fifth paragraph. Axial pressure is the key feature of the invention –client letter, fourth paragraph).

Two Part Cap per se: this would be novel, if two separate parts – but what is the invention?

Cap with separate opening and closing means – why is this novel, and what problem does it solve?

Axial pressure to open – yes, this is novel, and solves problem 1 – but a good claim would need some structure.

Safety cap which fits ordinary bottle – depending on how it is presented, something this broad is probably a 'free beer' claim. There is no clear suggestion that the idea of fitting a safety cap on an ordinary bottle is an invention, and this problem has been posed by the medicine people.

A 'pithy' claim of the types listed above might be able to get *some* marks, based on quality of drafting of the supporting text and novelty. But the dependent claims will be very important and should provide the structure which will probably be needed in a granted claim.

A single independent claim was expected. Multiple independent claims lead to multiple searches. (There is a comment alluding to a quick, useful, IPO search at the end of the client's letter).

Dependent Claims

There are many opportunities for dependent claims, and recognising that features can be swapped between the two parts. The dependent claims must add useful limitations to the main claim. As well as various optional features alluded to above, we have:

Snap fit

Rib on lower rim of outer part

First drive

Ratchet (though is this synonymous with one way drive?)/free movement in 'undoing' direction.

Ribs and projections

Ribs on inner part, etc.

Second drive is teeth (note, in the embodiment, second drive can work in either direction).

Disengagement means is a spring.

Is the projections

Outer part looks like a 'normal' cap (can this be defined in a meaningful way)

Nos./Relative nos. of teeth/projections/ribs/orientations

Cap and bottle with 'normal' screw thread

Medicine bottle

Introduction and Background

Prior art must be accurately described (if described at all). It is important not to imply that the prior art discloses or teaches any more than it actually does. It is probably necessary to make some reference to the prior art to set out the advantages of the invention or the problem- solution, but a specific description (i.e. referenced drawings) of the prior art is less necessary and might be omitted.

Statements of Invention / Advantages

Preferred features are set out in this section. The benefits of the independent/dependent claims should be set out and be consistent with the claim wording. Candidates should also have in mind their intended interpretation of their claims.

Specific Description

Candidates who simply repeat the client's description will score low marks. The device contained a lot of structure which is apparent from the drawings but not specifically mentioned by the client. This structure might become important during prosecution and, as noted above, relying on what is shown in the drawings as support for claim amendments is a risky exercise.

The purpose of the specific description is to satisfy S72(1)(c). Because of its specificity, it is not the primary source for amendment later. It should not be littered with 'preferred' features (see Iain Russell at page 24). In practice, these will have limited use for amendment later because they are not independent or separable from the other features of the embodiment being described.

A good specific description can be read without reference to the drawings (Paul Cole, P167, as noted above).

The terminology in the claims must be reflected in the description.

Abstract

These continue to gain low marks. It is not clear whether candidates have received no training in writing abstracts (because the patent office will rewrite them anyway), or run out of time and so scribble out the abstract in a hurry. Given that it is worth five marks, perhaps it should be written as soon as claim 1 has been drafted.