

2018 FD3 – Amendment of Specifications  
Final Mark Scheme

<p><b>Claims</b></p> <p>Marks are awarded for the claim set as a whole including main, dependent and any divisional claims</p>	35 Marks
<p><b>Claim 1:</b></p>	24 marks
<p>Specify that the rim 20 is upstanding so that the disc body is spaced from the (upper) surface/plane of the ring 18 when in the disc-shaped configuration</p> <p>Reduced maximum mark if the amendment lacks clarity/novelty, e.g.:</p> <ul style="list-style-type: none"> <li>- Spacing without linking the rim to this spacing</li> <li>- Lacks clarity – up to 12 out of 18</li> <li>- Lacks novelty – up to 6 out of 18</li> </ul> <p>Reduced maximum mark if unnecessary limitations included, e.g.:</p> <ul style="list-style-type: none"> <li>- Made of vinyl – 6 out of 18</li> <li>- Rim is perpendicular/cylindrical – 10 out of 18</li> </ul> <p>Remove “flat”</p>	18
<p><b>Subclaims, other claims</b></p>	Up to 11 marks
<p>Amendment of existing claims:</p> <ul style="list-style-type: none"> <li>- Correct dependency of claim 7 to “claims 1 to 5”;</li> <li>- Split “vinyl” from claims 6 and 7 to form new dependent claim;</li> </ul> <p>Add dependent claims to useful features, e.g.:</p> <ul style="list-style-type: none"> <li>- Rim is inclined inward/ up to 45°/perpendicular/cylindrical wall (e.g. page 7, line 25; page 7, line 22 or page 6, line 20)</li> <li>- Rim integral (e.g. page 6, line 19)</li> <li>- Reversible connection of tube (e.g. page 6, line 33)</li> <li>- Disc is flat (assuming removed from claim 1) (e.g. page 7, line 16)</li> <li>- Disc is domed (e.g. page 7, line 17)</li> <li>- Material reversibly attached to frame – provided consistent with existing dependent claims (e.g. page 7, line 2)</li> <li>- Dependent claims suitable for correcting any deficiencies in candidate’s amendments to claim 1, e.g. linking between rim and spacing</li> </ul> <p>Add new method claim for manufacturing process</p>	1 1 3 1 2 1 1 1 2 2

<b>Letter to IPO:</b>	34 marks
Explain lateness of response, ask for discretionary extension	4
Explain amendments (3 marks) and their support (5 marks)	8
Novelty of claim 1 over D1 (5 marks, including what is a “rim”, and where is the circular fabric member attached to the “rim”) and D2 (2 marks)	7
Additional novelty of dependent/other claims (e.g. by virtue of dependency or otherwise)	1
Inventive step of claim 1:	
o using structured approach (PS or Pozzoli but not a mixture of the two approaches)	2
o discussion of prior art, e.g.:	
▪ CGK includes flexible flying discs (e.g. page 4 of the application, D1 page 11);	2
▪ D1 aim is to improve aerodynamics by spoiler 14, somewhat different aim though billowing effect may be comparable (therefore upstanding rim not needed). construction aims to create skirt, rim (if present) a mere by-product;	5
▪ If starting from D2, how to make foldable? Unlikely starting-point.	2
▪ Combination of D1 + D2 – does not arrive at (amended) claim 1.	2
Additional IS of dependent/other claims (e.g. by virtue of dependency or otherwise)	1

<b>Notes for client report:</b>	31 marks
Discuss compliance period and expiry of deadline – explain that the late filing of the response has a reasonable chance of being allowed at the Comptroller’s discretion (despite the wording of Section 117B).	3
Discuss why an amendment is required, taking into account the objections in the examination report and the comments from the client.	4
Explain what is done in the response and why:	
o Explain choice of main amendment against alternatives (printing? sewing? materials?), including	10
▪ why alternative routes not chosen and possible benefits of those routes;	
▪ specific wording chosen, whether adequate support;	
▪ D1 not really similar but distinction needs clarifying;	
▪ Discussion of relevance of D2, referencing client’s point about flexibility.	
o Discuss broadening of claim 1 to cover proposed domed disc, whether broadening affects distinction over prior art (esp. D1);	5
o Discuss likely path of application and possible further amendments if needed	3
Discussion of dependent claims and/or fall-back positions	2
Reference client’s plans	4
o Discuss to what extent the new ideas are covered, e.g. new padded version	
o Discuss whether a new application (not divisional) for the improvement may be useful	
o Different materials planned so not limited claim 1 in this way even though it might distinguish over prior art (and possibly broadened claims 6 and 7 also).	