

Introduction

The question concerned a specialised form of Frisbee-type flying disc toy. Candidates appeared to have little difficulty in identifying significant differences between feature of the invention and the prior art given, and the question was on the whole well answered.

The allocation of marks in this paper continues to provide candidates who make a poor choice of amendment with the opportunity to pass, provided that they provide cogent and well-structured comments in the UKIPO letter and sensible advice in the memo.

Candidates are advised to allocate the time as far as possible to enable them to provide reasonably thorough answers to each section.

Claim 1

Many candidates included the upstanding rim in claim 1, as expected. The function of this element is to space the body portion vertically from the position it would have been in in the absence of the rim (and thus perhaps give rise to a shape more like that shown in D2, but flexible). In order for this advantage to emerge from claim 1, however, something needs to be said about how the body portion and rim interact. In principle, from the existing wording, the body could be attached only to the base of the rim, which even if the rim were upstanding would not lead to the described advantage of a larger recess. For claim 1 to be effective, some connection should be demonstrated between the rim, already present in claim 1, and its function to “space” the body from the (upper surface of the the) ring. Without this link between the rim and the spacing, it is unlikely that the amendment would confer novelty over D1.

Most candidates deleted or softened the limitation “flat” in the third-last line of page 1, as expected. It would seem acceptable to remove the word entirely, on the basis of the alternatives given on page 7 lines 16-17 and the lack of emphasis on the flat configuration, but the more cautious approach of including “arched or domed” as alternatives within the claim was acceptable, although attracting fewer marks. The mention of the disc being “domed” on page 4 line 28 seems to be a more general statement about the overall shape rather than that of the disc.

Some candidates deleted the limitation to “plastics” in line 6 of claim 1. This was felt by the examiners to be at risk of going a step too far, since the paragraphs describing the frame (bottom of page 4, last complete paragraph of page 5, passage bridging pages 6 and 7) rather assume plastics. However, the defect, if it is such, would be easily curable.

Some candidates included the limitation that the rim is integral with the ring. The examiners thought this was unnecessary but relatively harmless, and so it lost only a couple of marks.

A more serious additional amendment that the Examiners considered to be unduly limiting was to require that the rim extend vertically and/or is cylindrical. This would exclude the embodiment described at page 7 lines 25, where the rim is described as being inclined. A claim including this additional limitation did not attract full marks.

Dependent claims

Additional claims were expected to the angle of inclination (or not) of the rim, the flat or domed shape of the disc (assuming claim 1 broadened) and the possible reversible construction of the (tubular) ring. On the latter point, the possibility of dismantling the ring only really makes sense if

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the disc body or cover 12 can be removed from the frame. A claim to a method of manufacture (including the inverting step) was plausible, if of minor importance.

Response

In the letter to the Patent Office, unlike the situation in the EPO, there is no immediate notification of a missed deadline for answering an examination report. Under S117B and R109 there is a two-month extension available as of right for replying to an examination report; it is not specified there what the Comptroller should do if no such request is made, as in the present case, though the MPP says “further extensions are at the comptroller’s discretion and may be subject to conditions”. In line with the Patent Office’s generally user-friendly approach it seems reasonable to hope that, in circumstances such as those given, being explained to the IPO (perhaps with the promise of evidence being sent on request), discretion would be exercised in the applicant’s favour, particularly since the deadline does not lie far back and the compliance term cannot end earlier than February 2019. It seems highly unlikely that at this stage the application would already be treated as having been refused, opening the way for reinstatement under S20A, but such a request made early would perhaps be allowed.

When adducing support for amendments, care is sometimes needed if extracting features from a passage. For instance, the description of the rim as integral with the ring is in the same sentence as the rim being perpendicular (page 7 lines 20-22), so one would have to justify any separation of these two features. Also it is useful to refer to the drawings if relevant.

On novelty, could the cross-sectional shape of the (rigid) ring of D2 be considered to be made of a ring and an integral rim? This should be considered, even if then dismissed, despite the UKIPO Examiner not raising a novelty objection over D2. A comment in the Notes would indicate awareness of the issue.

Some candidates asserted that D1 did not show a “rim”; but the Examiner’s point needs answering that the reinforcement or the skirt, or both, could be considered as some kind of rim. The point is that in the invention the rim is vertical or upstanding, and the disc body is attached to the upstanding edge (though this need not be stated explicitly, and indeed support for such wording is not so easy to find).

It is possible to argue that claim 1 is already novel over D1 on the basis that the skirt in D1 is not a “rim”, or that the ring in D1 does not “stretch” the body portion. However, these distinctions seem tenuous and vulnerable to obviousness objections, not least because ‘stretch’ does not necessarily mean that the body must be taut (the ring could act to stretch the body from a crumpled configuration to a flatter configuration, without it being stretched to the point of being taut). Moreover relying on the “flat” distinction risks losing the proposed domed version.

Report to client

As often seems to be the case, this section tended to be the least well answered, possibly as a result of a shortage of time. The Examiners are particularly looking for reasoning for the choices made in the response, on the basis of what the client's needs seem to be, and consideration of other possibilities. For instance, if it is felt that claim 1 could be defended at least on the grounds of novelty, whether it is worth pursuing this route. A number of candidates defended their choice of amendment to claim 1 (correctly) on the basis that it was novel and arguably inventive, but without referring to what the client's letter said.

Many candidates continued to take a fairly formulaic approach to the Notes, with relatively few candidates providing the client with *advice* or reasoning for the approach taken (as opposed to re-stating conclusions from the letter to the Patent Office).

Concluding remarks

Candidates occasionally comment that the examination papers are not realistic. This is true in a way. For instance, candidates are expected to concede points on the prior art that they might not in real life, or one might not reveal all the weaknesses in one's arguments when reporting to the client (this is one reason why only notes are asked for). However, in the examination the point is to demonstrate what one knows.

As a rule, candidates are advised to think carefully before making amendments that simply tidy up the claim, because of unforeseen internal validity problems in future.