

## P3 2013 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.

In their comments on the 2012 paper, the examiners noted that 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. We reiterate the point.

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. This is quite different to the allocation of marks in EQE Paper A. 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 can provide basis or support 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).

Having studied the client's disclosure in sufficient detail to draft the claims, it should be possible to draft a specific description without reference back to the client's written disclosure. This may help to ensure that wording in the description relates to that used in the claims, mentions all the features specified in the claims, and that the description is not simply a slavish repetition of the client's written disclosure.

### The Invention

The client has developed a *'shield which will sit tightly inside the back box to keep the plaster out'*. However, subject to how you might interpret the word 'tightly', this seems to be known from the Protectabox. With the client's device, *'the plasterer can plaster up against the shield wall, so he gets a better finish as well'* (as keep the plaster out). The Protectabox *'fell out of the back box as soon as the plasterer brushed up against it'*. The client uses a stabiliser which *'pushes the shield walls out tight against the back box to hold it (the shield) in place and stop the walls caving in when the plasterer plasters up against them'*. Thus the stabiliser provides reinforcement which has two overlapping or related functions – to hold the back box in place and to stop the shield walls caving in.

The client makes the point that the shield could be screwed to the back box to hold it in place – but the stabiliser is still used *'to reinforce the shield walls'*. (And screwing the shield to the back box would, presumably, be more time consuming if it had to be done every time).

A further benefit of the stabiliser is that the shield walls can be made more flexible.

Thus, the examiners were expecting a main claim directed to a removable shield which is to be fitted in the back box and projects outwardly from the box to keep plaster out of the back box, and a stabiliser which reinforces the shield walls / to retain the shield in the back box / prevent deformation of the shield walls during plastering. But, as noted above, claim wording needs to distinguish over the Protectabox.

In more detail, we might have:

A shield for preventing ingress of material into a back box (*there does not seem to be any need to go broader than back boxes*),

the shield comprising a frame and a stabiliser (*are these separate parts?*),

the shield being resilient/flexible/ a spring fit (*if it does not flex in some fashion, can it be urged into a tight fit against the box walls?*),

the frame (in use) forming an extension of the box walls (*is it clear, somewhere, that the frame is not necessarily/essentially co-planar with the box walls*),

the stabiliser inside the frame (*if it is not clear that this is a separate part, then does its location distinguish over the prior art?*),

the stabiliser urging the frame against the back box/reinforcing the walls of the frame to .....

Main claims which led to a good mark (when supported by the description), included:

1. A shield for protecting an electrical back box, the shield comprising  
a frame member having walls for insertion into a back box  
a detachable stabiliser,  
wherein, in use, the frame member protrudes from the back box to protect the opening of the back box,  
and the stabiliser, when fitted to the frame member, acts to push the walls of the frame member against the walls of the back box so as to hold the frame member in place.
2. A shield for protecting a back box from ingress of building material, the shield comprising  
a wall extension part arranged to form an extension of the walls of an electrical back box, a rear portion of the wall extension part being arranged to be received in the back box and a front portion being arranged to protrude from the back box to prevent ingress of building material, and

a support means arranged to be inserted into the wall extension part to urge the wall extension part against the side walls of the back box, thereby securing the wall extension part in place.

3. A shield arrangement for protecting an electrical back box from ingress of building material, the shield arrangement comprising

a flexible shield frame arranged to fit within the back box so as to partially protrude along a wall of the back box, and

a shield stabiliser arranged to be inserted within the shield frame so as to push the shield frame against the wall of the back box.

4. A shield for preventing ingress of building material into a cavity, the shield comprising:

a frame member having two pairs of opposed side walls defining an opening there between, the frame member being configured to be inserted into and protrude from the cavity, and

an insert member configured to fit inside the opening of the frame member and exert a force on the inside surfaces of the opposed side walls, such that the opposed side walls are forced into engagement with the sides of the cavity to retain the shield in the cavity.

Dependent Claims could cover the following features:

Legs on frame

Legs in corners to straddle lugs and openings in back box

Legs trimmed to fit

Frame has attachment for fixing to back box

Frame has flexible corners

Frame has fold/crease/score line

Frame has shoulder

Shoulder is double frame material

Stabiliser has flanges folded from/integral to body of stabiliser

Stabiliser has one or more holes or grip means

Holes defined by 3 sided cut giving a flap to cover holes

Made from plastic

Made from cardboard

Omnibus claim

## Introduction and Background

Prior art must be described accurately (if it is described at all). If the drawing is used, it should be labelled as prior art. It is important not to imply that the prior art discloses or teaches any more than it actually does. It is probably helpful 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 generally less necessary and might be omitted.

In the present case, there are some uncertainties around the prior art. Does the inwardly extending rim provide reinforcement of the side walls – although presumably not in the vicinity of the back box rim, where the plastering takes place. The frame member provides an extension to the walls of the back box, and so might sit on the walls (cf. the shoulder of the client's device). If these issues impact on the scope you choose for claim 1, then your description of the prior art will be important.

If you are wrong in your interpretation of the prior art, then do you have a dependent claim which provides a good fall back position?

## 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. This will help the examiners in their assessment of the intended scope of the claims. Candidates should also have in mind their own intended interpretation of their claims.

Some candidates seem reluctant to commit themselves to a particular interpretation of their main claim. If the scope of the claim itself is not clear, it is difficult to award marks.

## Specific Description

Candidates who simply repeat the client's description will score low marks. The device and its use contained 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).

In the present case, the shield extends outwards from the rim of the back box – away from the wall – so that the plasterer can plaster up against it (*the plasterer can plaster up against the shield wall...*). Many borderline candidates did not mention this feature, of the shield extending outwards, at all. It is not written in the client's description, but it is apparent from the drawings, and it is a feature which might be required in the claims during prosecution, if not on filing, in order to amplify the function of the device.

Mentally speculating on alternatives is a sound approach to testing the scope of your claim, but the examiners do not award marks for listing alternatives not mentioned in the client's

description and drawings, and, in practice, there is a danger of anticipating the client's next development.

### **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.