

**P4 – Amendment of Specifications for United Kingdom, Patents/Applications in Prosecution, Revocation proceedings or Otherwise
Mark Scheme 2014**

Assessment task outline

A United Kingdom patent application comprising the attached specification (identified as GB 1312321.8) has been filed at the UK Intellectual Property Office without any claim to priority.

The UK Intellectual Property Office has now issued the attached Official Letter. You have received brief comments from your client in a letter, which is also attached.

Your task is to prepare:

1. A letter to the UK Intellectual Property Office in response to the Official Letter.
2. A set of amended claims, if considered necessary.
3. An outline memorandum for your client. This should:
 - a) explain the actions you have taken and why;
 - b) provide full reasoning for your actions;
 - c) outline future actions that your client could take to secure full protection of their commercial interests.
 - i. This advice should take into account that further information may be needed.
 - ii. It should only relate to the invention(s) outlined in the client's letter to you.

The memorandum should be restricted to patent matters. You are NOT required to consider other matters such as copyright or design protection.

Note the following:

- a) You are NOT required in this examination to make any amendments to the description of the client's patent application.
- b) You should accept the facts given to you and base your answer on those facts. In particular you should NOT make any use of any special knowledge that you may have of the subject-matter concerned, and you must presume that the prior art referred to is exhaustive.
- c) If you submit any amended claim set and/or divisional claims(s) please number the pages so as to readily identify the claims or claim sets.

Answer

Claim 1

- a) Broaden to inflation device alone (for example at p5, lines 18-19)
- b) Specify that the abutment is adjustable by the user to set the limit of travel of the actuator to set a predetermined volume as desired

Both amendments	Max available
<ul style="list-style-type: none">• Broadening and freely adjustable abutment (for example at p7 lines 18-19, p7 line 26)	25
<ul style="list-style-type: none">• Any limitation to the adjustable abutment	21
<ul style="list-style-type: none">• Combinations of limitations will decrease the marks available further – for details please see individual amendment details below	

Broadening Amendment	Max available
<ul style="list-style-type: none">• To inflation device (for example at p5, lines 18-19, p4 line 9)	10
<ul style="list-style-type: none">• Tubes & vessels	7
<ul style="list-style-type: none">• To 'tube' (medical tube / used in a body cavity / catheter, for example at p4, lines 26-28, 8 line 37-39)	5

Patentability Amendment	Max available
<ul style="list-style-type: none">• Freely adjustable	15
<ul style="list-style-type: none">• Any additional limitation (e.g. longitudinal slot p7, lines 16-17), wedge,	12

Other	
<ul style="list-style-type: none">• If argue novelty from air vs fluid/liquid (so no amendment)	0

General	
<ul style="list-style-type: none">• Amendments which are not based on the description are not awarded marks for that part	0

Total: 25 marks

Sub-claims

- a) Ensure appropriate dependent claims (to device with a catheter etc.). Expect all or some of below.
 - Use/method claim (use of the device to clean... for example at p5, line 26)
 - Inflation device & catheter (assuming amendment to device only in claim 1)
 - Adjustable fallback positions – sliders, slots, scale & slider, frame & slider

No changes to dependent claims	0 marks
Use claim(s)	Max of 2 marks
Device & catheter	Max of 3 marks
Suitable / commercially useful fallback	Max of 3 marks
Spacer still present	1 mark

Marks are reduced accordingly for overly narrow dependent claims (too many limitations at once).

- b) Correct Omnibus claim **1 mark**

Total: 10 marks

Response

Explanation of and support for amendments

8 marks

- For full marks expect discussion on why the reference provides basis
- If no discussion beyond page / line reference – maximum half of the available marks
- If no broadening of claim 1 to ‘device’ – maximum 5 marks
- Unexpected claim amendments – marks awarded if suitably justified (e.g. number of environments)

Novelty argument –some discussion of the following points was expected

10 marks

- Structure and discussion of conclusion
- Does D1 disclose an abutment?
- Are the ratchet steps moveable? But not moveable to stop / define volume of air?
- Fluid vs air
- Any other reasonable novelty arguments

Inventive step argument

15 marks

- Some system for IS analysis (Pozzoli or PSA)
 - If Pozzoli
 - Discussion of prior art – including that described in the application – 1 mark
 - Comment on the skilled person – 1 mark
 - Identification of the inventive concept / technical difference – 2 marks
 - If PSA
 - Determining the closest prior art
 - Identifying the objective technical problem
- Argument consistent with features in claims
- Abutment – function of the abutments, incentive to change
- Fixed volume bulbs for each catheter
- Controllability, precision – user defined

Formal items

2 marks

- Delay / notice for divisional
- Timing of response

Total: 35 marks

Report

Clear references to issues raised by the client and explanation of strategy for response <ul style="list-style-type: none">• Likelihood of success / merit of position• Discussion of fallback options / next steps	7 marks
Infringement / scope <ul style="list-style-type: none">• Broadening:<ul style="list-style-type: none">○ Non-ETT devices for medical uses○ Just inflator device w/o catheter attached○ Who would infringe / scope of claims• Non-broadening to plumbing uses<ul style="list-style-type: none">○ An argument that it is suitable for 'any tube' may be acceptable if well set out○ Discussion of both options will be awarded marks only if there is a clear conclusion○ If they claims have been broadened, but the candidate comments in the memo that they do not believe it is allowable then this does not attract any marks.○ No new application to plumbing was expected based on the current description – not novel. However, a good discussion of possibilities may gain some marks (e.g. if there are differences in the device)	10 marks 8 marks
Divisional <ul style="list-style-type: none">• To the spacer with the device (without the device it is too broad, essentially just a tube)• Timing of filing – comment to the client• A proposal to file without an example of a claim did not attract many marks	5 marks

Total: 30 marks