

P4 2013 Examiners' Comments

General Comments

The structure and requirements for this year's paper was similar to previous years: a test of amending claims in view of the Examiner's objections and the client's commercial needs, and replying to the Examiner's objection and reporting back to the client. There is no fixed "right answer", although there may be more favoured approaches, and the reasoning for any decision is often worth more marks than the decision taken. In real life one would explain decisions taken, to a client or boss. For this paper the emphasis to give one's reasoning cannot be stressed enough. Failure to do so is the most significant single cause for not being awarded marks. Without reasoning written down, the Examiners do not know if the candidate understands the point or not. This is a point made every year, and everyone must know it, but perhaps under the pressure of the Exam it is just not followed through as often as it could be.

The paper is not designed to have any traps or pitfalls but to be as close to real life as possible, testing for the "safe pair of hands" needed to practice as a Patent Attorney.

The extra typed claims pages were given to aid the candidates. The Examiners of the paper like these too, so candidates are encouraged to use them, saving valuable time. The paper is not meant to be a speed-writing test; as seen in previous years, the longest papers did not receive the highest marks and the papers with the higher marks were characteristically concise and to the point, giving reasoning throughout.

Time management is, however, important because the memo section, which is understandably often done last, is typically worth a good proportion of the marks, and it is the first few marks of any section that are the easiest ones to gather. The memo allows any aspect of reasoning to be put down showing understanding of the points of the paper. Finishing the memo also just looks better too as it helps round the answer off. This is especially important if the candidate is on the pass/fail border.

Claim 1

There were a large number of options to find an amendment to claim 1 that conferred novelty, even if one conceded the examiner's objection on this score. However, some care had to be taken. The reasoning written down, later in the answer, was awarded more marks than a "correct" amendment without reasoning. Most of the proposed amendments seen by candidates could be argued to convey novelty and inventive step but often lacked proper and full reasoning. Without the reasoning the Examiners could not know if the candidate understood the points of the paper. Many candidates did not take due account of the fact that the existing set of claims is directed only to a fence section. Properties of the fence when assembled did not necessarily confer novelty on a single section. Most notably, though it is correct to say that D1 shows "joining rods" (integral pins 30) that are not "separate" from the section, as in the invention, that is not to say that separate rods could not be used with the fence section of D1.

Thus, although the embodiment of D1 shown in the drawings does not have recesses on both vertical edges, the alternative described on page 14 lines 37 (which the IPO Examiner mentioned and most candidates discussed) has recesses on both edges of the all-female sections. Although most candidates did discuss this point and received the marks, many missed this point or failed to mention it at all. A single such section on its own may fulfil the relevant criteria of claim 1 even if "recesses" is amended to "grooves". One could, for instance, take a plurality of such female sections and couple them together with separate joining rods, even if might lead to a staggered fence profile. D1 obviously does not envisage this, but the point is that one may take the view that it discloses sections which could be used in this way (novelty), even if it does not suggest it (inventive step). The

Examiners believed there was argumentation for and against this point (i.e. whether the all-female sections of D1 would destroy novelty or not) and were looking for discussion of the points, regardless of the final decision. Consistency of that view throughout the answer gained more marks than inconsistency, again regardless of what view was taken.

There could be other differences between D1 and a partially amended claim 1 of the application. For instance, it is arguable that D1 shows female hinge parts 24a with only one finger per hinge segment (unless one considers the whole end part of the fence section to be a “hinge segment”). Whether such a distinction, if relied on, is enough for inventive step would need to be discussed.

If claim 1 as amended did not specify that the grooves faced alternately (i.e. towards the mid-plane, page 4 lines 21-22), or that the fingers trapped the rod (page 5 line 30), or similar, then care needs to be taken in arguing inventive step over D1 in particular. Some candidates usefully argued that the “hinge” language of necessity implies some kind of trapping – for instance, the half-round grooves cannot all face the same way, since otherwise the rod would fall out, and this would not be a hinge. This line of argument could achieve marks worthy of a pass. Many candidates did however attempt to amend claim 1 to specify the facing direction of the grooves. Many who did this did not use wording that was properly supported.

It would seem favourable in claim 1 to specify that the grooves are no more than half-round. Exactly half-round might be too specific. “No more than the radius of the joining rod” suffers from the fact that the joining rod is not part of the claim. Most candidates did amend along the lines of the groove shape/size but again many did not use wording that was properly supported.

Some work had to be done to clarify the meaning(s) of the word “alternately”. On the basis of page 5, line 28 it would seem advisable to remove the word from claim 1 and relegate it to a dependent claim; the “alternate” facing of the fingers/grooves towards the mid-plane (page 4 line 21) would also need to be incorporated at a suitable point.

Candidates needed to appreciate what would be infringed by different claim types. A claim to a fence would not be directly infringed by the sale of a fence section or possibly (depending on how the claim was formulated) by a kit of parts or the like. The only direct infringement would (at best) be by the end-user, which is a generally undesirable state of affairs. (Nevertheless, in the dependent claims there were certain features which could only adequately be protected by a claim to a fence or a kit of parts and the like.)

The Examiners favoured the approach where claim 1 was “A fence section”, “suitable” for receiving a joining rod rather than a claim 1 having the limitation including a joining rod, as that would have been more likely to be “A fence”, or kit, and not a fence section *per se*. If claim 1 had the joining rod included as a limitation, would somebody infringe selling only a fence section without the rod? Or importing a fence section without the joining rod? These are questions that could be hopefully avoided by drafting claim 1 to a fence section only, without the rod *per se* being a limitation. Removing features already listed in a claim is in theory possible if there is the correct support for doing so, and this is not added subject matter (though of course the Examiners wanted to see a proper justification in the letter to the patent office).

Claim 1 was worth 20% of the total marks.

Subclaims

It was expected that candidates would address the clarity objection from the office action, as well as providing useful fall-back positions.

Similar considerations to claim 1 above mentioned apply to dealing with claim 6, with the joining rod extending below the fence sections. Since the previous claims say nothing about the required

properties of the joining rod, apart from the fact that it must fit in the grooves/recesses, its length is indeterminate. The length of the joining rod (and hence its capacity to extend into the ground) cannot therefore be specified unless the joining rod is actually included in the claimed object. It seems broadly that the rod is a separate article from the fence section (page 5, line 29, though an alternative interpretation is just about possible), so claim 6 needed to be amended to include at least the rod. A pair of sections with at least one rod would be adequate, or a whole fence or a kit of parts. Ditto claim 7.

The following features were thought to be useful to include in additional subclaims:

- Any horizontal plane contains only one finger (p.5, l.26) (alternative to “there is no plane perpendicular to the axis of the joining rod that contains connecting fingers from both segments”)
- The segments have a different number of fingers (p. 6, l.6)
- Recesses in fingers face alternately
- Radius and/or clearance allowing hinging (page 5 line 19)
- 3 and/or 4 finger pairs
- Unit is moulded plastic
- Anchor blocks (many candidates appeared to believe that if a feature is used to propose a divisional claim, that same feature cannot be used as a dependent claim. Dependent claims are fall-back positions, so if the feature is good enough for a divisional then it is good to use as a dependent claim, particularly if the client cannot afford the suggested divisional or feels it is not worth the extra expense.)
- Omnibus claim. Most candidates did attempt to add an omnibus claim but some used poor wording, such as “... as substantially described” (invert the order of the first two words, since otherwise you are implying you did not fully describe the invention). It also did not make sense to claim a fence section with reference to Figure 4 (for example) which showed only a joining rod and anchor block. (This is essentially a matter of finesse, however, as only one mark or so will be at stake for an omnibus claim.)

10% of the total marks were given for the dependent claims.

Divisional

This year there was no clear requirement for a divisional and thus this could have been argued either way. Points were awarded for discussing the pros and cons of filing a divisional, more so than merely providing the text of a proposed divisional claim. A favourable choice for a divisional would be the anchor blocks, but a divisional claim to (what effectively boiled down to) just a block with a hole in it was not thought to have a high chance of success.

Marks were not awarded merely for saying that a divisional application could be filed, though presentation of a suitable claim (e.g. directed to a fence assembly including joining rods and anchor blocks, or possibly to a broader version of a claim 1 rather drastically narrowed in the parent application to secure speedy grant), or discussion of why no divisional would be useful or justified, attracted marks.

There were up to 5% of the total marks for this.

Letter to IPO

35% of the total marks were available for this section.

An explanation of the amendments was expected, as was showing the support (even if very brief), for any and every amendment. The clarity issues were expected to be dealt with whether by amendment or sound argument. Consideration of timing, accelerated prosecution, and so on, could be mentioned.

The discussion of support was not always adequate, even if the right passages were adduced. In particular, the removal of any features from Claim 1 should be justified.

Some candidates admitted the Examiner's objections in the response letter, in many cases not seeming at any point to have fully considered the objections and (in particular) the allegation of anticipation by D1, which was far from conclusive (see the arguments about novelty over D1 below). Admitting the objections is generally not advisable, though one might concede some points in the letter to the client, at least as making life easier.

Although there should be no unnecessary concessions in the letter to the Patent Office, the response should be realistic to achieve grant, addressing all points. It was expected to deal with the second embodiment of D1 in which male/male fence sections alternate with female/female fence sections. The client letter mostly focussed on D1 but D2 may be more pertinent for novelty – it differs by having holes rather than grooves. Candidates were expected to make this point.

In the response letter, many discussions of novelty were sketchy. All the distinctions need to be made.

Inventive-step arguments are not just a rehash of novelty arguments, and such answers would fail this section. Most candidates did give good inventive-step arguments. Good arguments could possibly flow when thinking of how the different inventions would work in practice. With D1 it could be argued that it would be a complete departure from its teaching to use separate rods with non snap-fit grooves/recesses. An important advantage of the present invention was the ability to remove and replace a single fence section at a time; thus it was expected to focus on amendments or features that allowed this. Could one cut bits away from D2 and end up with claim 1? No, it would fall apart, and more would be needed, such as opposite-facing grooves.

Another advantage of the present invention was that it overcame tolerance problems of D2. Thermal contraction/expansion in D2 caused problems fitting rods into holes, possibly causing D2 connectors to split.

If the combination of D1 and D2 was considered, it could be argued that it does not lead to opening out the recesses even further, to be half round for example.

D1 can be considered CGK, judging by the client's letter (though, it is suggested, not for the sole reason that it was cited in the application). D2 possibly not, since a similar construction was considered and rejected by the applicant. But D2 is, in European terms, the closest prior art available.

As in past years, many candidates seemed to expect prior-art documents to include their own inadequacies, and that, if they did not, that was evidence of inventive step in the application under consideration. No patent application explains how it fails to solve a problem.

There was a common misunderstanding regarding the 'inventive concept' of Pozzoli/Windsurfer, in that this was often specified to be a general advantage arising from the features of Claim 1, rather than more concrete features. The Pozzoli/Windsurfer test requires a direct comparison between the 'state of the art' and the aforementioned inventive concept (before deciding whether the differences constitute steps which would have been obvious to the person skilled in the art). Thus, describing the inventive concept in terms of a nebulous advantage suggests that the candidate does not understand or is unable to apply the relevant test.

Candidates often indulged in a detailed speculation of how a skilled man would modify D1 or D2, or what range of embodiments he would produce when trying to combine the two documents. This can put potentially dangerous admissions on record and can sabotage an inventive-step argument, for

example if straying beyond the technical content of the prior-art documents in question (so as to suggest that additional technical features are either implied or obvious), or explaining that a skilled man 'would' do something in a particular way (which is of course tantamount to an admission of obviousness). On the other hand, demonstrating that two pieces of prior art are technically incompatible is a strong inventive-step argument. A fine line must be walked in this regard.

Historically (for better or worse), candidates have been permitted to use the European problem/solution approach in place of the UK test, and this was true in the case of the present paper. The problem/solution test first requires an identification of the closest prior art: D2 is arguably closer than D1, with more technical features in common with the claim (at least as unamended), but that is in some ways a good reason to argue that D1 is closer. Next, the 'objective technical problem' to be solved must be identified: there are a few ways to go here, but the key consideration is that the point of novelty of the claim must relate to the chosen problem/solution. For example, in some cases reasonable inventive-step arguments were put forward in respect of technical features which were not included in Claim 1; this is viewed as a serious deficiency. Lastly, it must be explained why the claimed invention, starting from the closest prior art and the objective technical problem, would not have been obvious to the skilled person. In this regard, it should be noted that 'non-obviousness' requires a lower standard of proof than 'inventiveness'.

Memo to client

30% of the total marks were assigned for this section. Candidates were expected to explain why any amendment was needed or not, explaining how the prior art compared to the present claims. Likewise for the clarity objection. It was expected to list out some of the possible amendments and then show why a particular amendment was chosen due to reasons of patentability and/or commercial interest. It is also the place where a candidate can explain anything done in their answer to demonstrate to the Examiners their level of understanding, and that the key points of the paper were recognised.

Many candidates glossed over the implications of particular claim types in terms of catching potential infringers. For example, where the claims were amended to a fence as assembled, or the like, then the only direct infringers would be end users who assembled the fence.

Likewise it was not enough to say "I have added dependent claims as fall-back positions", without explaining how at least some of them could save claim 1 if it did not survive another onslaught by the Examiner. You would want to explain to a client why you added such dependent claims, to show you are looking after their interest or at least help explain the bill.

Some discussion of the prospects is valuable, especially if one has gone for a rather broad claim 1 but is prepared to include, say, the alternately-facing layout of the grooves as a backup. If going with a broad claim, risking another objection from the Examiner, then it really is essential to explain why you are taking this risk. An explanation could make the difference between an Examiner (of this paper) going with your approach (or at least giving you the benefit of doubt), or possibly assuming you are unaware of the risk and marking accordingly.

Also a point almost universally ignored in the memo was that D1 was known at the time of drafting the claims, and in a real-life scenario the client might be expecting an explanation of why the claims apparently failed to distinguish over this document.