Examiner's Report 2014
P6 – Infringement and Validity of UK Patents

Patent Examination Board

Introduction

This year's paper sought to bring out many of the issues which may be faced by an attorney when advising a client on infringement and validity. This year the issues included a client with an incorrect impression of a situation (*i.e.* prior user rights) and most unusually for this paper, a European patent which was within the opposition period.

The subject matter of the invention was simple and, it is submitted, should not have caused any candidate difficulty in understanding the underlying technical principles.

The number of Claims to be construed was few and the dependencies of those Claims was limited. Moreover, there were only two pieces of prior art to consider.

All-in-all the amount of material to be considered was less this year than in many previous examinations and the examiners noticed that fewer people seem to run into time difficulties this year, as compared to previous years.

Overall, the paper appeared to enable good candidates to score well and properly distinguished between those that satisfied the assessment criteria and those that did not.

Those candidates who did not satisfy the assessment criteria typically failed to gain marks throughout the paper, did not maintain a consistent position between construction and novelty for example, consistently 'hedged their bets' or simply missed out entire sections or portions thereof.

Candidates are reminded that those who fail to provide appropriate advice on, for example, inventive step are unlikely to pass the paper.

Candidates are also reminded that if handwriting is eligible it is difficult to award marks.

Questions

Construction

The patent to be construed was a European patent, with claim 1 formulated in the two-part form. Although this was the first time this Claim form has been used that did not appear to cause undue difficulty to any candidate.

Unfortunately, too many candidates appear to consider construction as an opportunity to simply re-state the terms of the Claims in different words. This is not construing the Claim. The best candidates gave clear exposition as to what each important integer meant in the context of the patent and the technical field to which it belongs.

The paper required a clear and cogent construction of the key integers in the main Claim, in particular to the 'cavity', 'secured together at their peripheries', 'heat conducting material', 'extends across', 'sealed in'. As would have been expected, it was construction of the characterising portion which was key to providing a satisfactory answer, although non-characterising parts also came to bear on questions of infringement, novelty and inventive step.

In general the construction of claim 2 was dealt with satisfactorily but few candidates directed themselves appropriately to what the overlapping ranges may or may not mean.

Claim 3 was generally construed OK but surprisingly few candidates picked up on the lack of antecedence of 'wax'.

Claim 4 was generally construed satisfactorily but very few if any candidates picked up one the lack of antecedence for "phase change material" nor considered the effect of the different dependencies and how that might affect into what the elongate members extend.

On the whole, Claim 5 was not construed well. Typically the better candidates construed 'thermal bridge' and the implication for the orientation of the panel appropriately.

Infringement

Surprisingly most candidates did not refer to the actual product to be sold as described in Table 1. For the avoidance of doubt, it is not an infringement of a patent to write about an infringing article in a document!

The information in the Table provided the necessary link between the activities described by the client in his letter (*e.g.* stockpiling for sale) and the description of the article in the draft patent application. On the whole, the best candidates specifically referred to the Table.

On the whole, infringement was not difficult to find. Although the arrangement of the phase change materials was different in the patent and the infringement (and hence the principal flow of heat was intended to be different) the Claims of the patent were silent on this point.

It was expected that all of the Claims would be found to be infringed.

To be awarded marks, candidates must use their construction to determine if the particular feature within a claim is present in an (alleged) infringement.

Novelty

There were two documents to be considered for novelty. Although document D contained separate descriptions of particles and fibres, candidates were expected to use their judgement and not consider the individualised components from the point of view of novelty and rather concentrate their efforts on the tile which was described later in the document. A passing comment was all that was required to give the examiner's comfort that the candidate had noted the point.

Depending on the construction of "thermally conducting member" in the patent Document C may or may not have anticipated Claim 1. Marks were awarded for either conclusion as long as it was on all fours with construction.

Claim 1 was clearly novel over Document D, not least because of the requirement that Glauber salts were used. Candidates who conflated the general description in Document D and the specific description to find the Claim anticipated were, mercifully, few and far between. Application of the previous construction to document D seemed to provide more of a challenge than the application to document C.

With regard to Claim 2, very few candidates considered the purpose of the various PCMs and said anything about the likely intrinsic properties of PCMs used to regulate the temperature of a room (i.e. that they might change phase at or about room temperature)

Claim 3 seemed to present few problems to candidates with regards to document C. With regards Claim 4 very few candidates considered the implication that the mat of document D was formed from a single fibre.

Claim 5 seemed to be answered well by few candidates, principally because the construction had not been addressed in sufficient detail or with sufficient thought.

To be awarded marks, candidates must use their construction to determine if a particular feature within a claim is present in an (alleged) anticipation.

Inventive Step

There were 18 marks available for inventive step this year. Candidates should be able to provide a coherent inventive step analysis. As with previous years, those candidates who were able to provide a reasonable IS analysis scored higher marks overall.

Candidates who provided cogent reasoning which accorded with their construction could obtain marks in this section.

It was clear that document C could be said to form common general knowledge – it was an extract from the go-to text book. However, CGK seemed like a poor prospective starting point as compared to document D which specifically mentioned the heat conducting nature of the fibre sheath.

Once document D had been selected as the closes prior art the question to ask was would it have been obvious to change a Glauber salt to a wax-based PCM. The answer is yes. Document D states that both are used in interior cladding panels. The CGK states that paraffin waxes are the cheapest PCMs. There is no inhibition to changing Glauber salts to waxes and an incentive to do so.

Claim 2 followed a similar pattern. The CGK tells you that performance of a tile may be enhanced by having waxes which melt at different temperatures. The issue then is what temperature do you select for the melting point.

Again, Claim 3 would appear to follow a similar pattern to Claim 2, the use of different waxes is said to be beneficial. In making the tile of document D using different waxes in the particles and within the fibre is not considered inventive.

With Claim 4, the principal issue was understanding the single fibre point with regards document D. This was not well answered on the whole.

Claim 5 was likely to be considered obvious over document D, when supported by construction of the 'thermal bridge' integer.

Sufficiency

On the whole the two points available were not obtained.

Amendment

The examiners were looking for candidates to put themselves in the shoes of the patentee to determine how best to improve the patentee's position in light of the attacks on the patentability of the patent.

Whilst many candidates found some of the independent Claims to be valid and simply sought to introduce those as limitations to the main Claim, this was seen as sub-optimal because there was a risk of those Claims being found invalid.

The examiners considered that the most appropriate amendment for the patentee to make was to introduce the subject matter of "heat conducting member is a flat sheet…" into the main Claim. This was discussed in the patent as being of technical benefit and would have captured the client's product.

Advice

The advice section was not answered well on the whole. The question provided many opportunities for candidates to consider various points, for example S.64 UKPA, A.99 EPC, what happens if the patentee sues, potential design-around, client's patent position, cross licensing and so on.

Points were awarded for candidates who provided sensible and appropriate steps which could be taken to improve the client's position and provided clear warnings as to the risks involved in continuing on the route to commercialisation.