

## **Introduction**

This year's paper was an exercise in invention-spotting, which is a skill that this paper seeks to test as an essential part of the unique skill set of a patent attorney.

Candidates who had sufficient knowledge or experience of claim drafting were duly rewarded, while those who adopted a scattergun approach in the hope of hitting the right target, or those who appeared to set about drafting claims without taking the time to think about what the invention was, were not. For example, the information provided by the client was very clear that the client's product was a laminate. A Claim 1 directed to a product was expected. While method claims are usually valuable, candidates who opted for a method as a Claim 1, leaving insufficient time to draft good product claims, raised concerns with the marking examiners as to whether the candidates had understood the invention, which was a laminate having heat-sensitive layers in a specific order. Many candidates appeared to think that printing on both sides of an existing laminate layer was the invention. While this may have been novel, such an arrangement would not have been inventive.

Candidates who appreciated the specific ordering of layers of the laminate generally achieved enough to pass. The Examiners were looking for the inclusion of thermal transfer, the application of heat or a temperature sensitive adhesive. The candidates who spotted this feature generally did well. Marks allocated to Claim 1 were awarded to candidates who included all the necessary features in high-ranking dependent claims, providing the features were accurately claimed and supported by an appropriate understanding of the invention in the specification.

Alarm bells should have rung for those candidates who found themselves writing a second set of product claims, typically directed to a substrate including the laminate, with identical features to the first set of product claims. With more and more patent offices introducing excess claims fees, there is usually a broader and more efficient way of claiming the product and all its optional features and indeed there was with this paper.

Only a very small handful of candidates correctly observed that the figures related only to one specific embodiment. While an understanding of figures is required for all technical fields, more description in place of figures was provided in an attempt to assist candidates who do not routinely come across figures in their day-to-day practice.

The increase in the total number of marks available in this year's paper reflected what was felt to be a straight forward exercise in claim drafting, once the invention had been understood, with appropriate dependent features needing to be listed. As a result, more thought was expected for statements of invention, particularly to support novelty over the prior art, together with the drafting of a full and complete specific description. Candidates should be focussing on preparing a full and complete specification rather than fretting about which section requires the most marks and so is the best to tackle properly to pass, not least because the mark scheme is balanced so candidates need to achieve sufficient marks in all areas to be able to pass.

Candidates are reminded that they do not need to submit their notes or musings with their answer pages. Notes pages and notated question papers add bulk to the script, which pages are neither considered nor read by the marking examiners.

## **The invention**

The invention was a laminate with a specific order to its heat-sensitive components, as well as methods of making and attaching the laminate.

## **Main claim(s)**

Candidates were expected to draft Claim 1 as a product claim directed to a laminate having a carrier sheet adjacent to a varnish layer which, in turn, is adjacent to a heat sensitive adhesive. Additional marks were awarded for inclusion of the varnish layer being separable from the carrier sheet upon the application of heat.

There was scope for an independent claim directed to a method of protecting a security document including the application of heat to melt the adhesive and release the varnish layer from the carrier sheet.

An additional independent claim to a method of making the laminate was also expected.

## **Dependent claims**

The paper set out a clearly identifiable list of optional features which most candidates spotted for the laminate. Candidates are cautioned against using method language in apparatus claims because such language can impart a lack of clarity to a claim. In addition, there was scope to claim such features via suitable method claims. No marks were awarded for laminate features that were either clearly obvious (e.g. weight of paper) or already known from the prior art (e.g. invisible inks).

The client's letter provided specific optional features for either the method of making the laminate or the method of application to a substrate. Only a few candidates appreciated the differences, with many candidates repeating method claims for the two different methods suggesting a lack of either understanding or organisation of information provided.

No marks were awarded for omnibus claims, in keeping with the law change, although a surprising number of candidates included such claims.

## **Introduction and background**

A concise title related to what has been claimed as the invention, followed by a credible description of the field of invention, is expected. The field of invention should not be a mere recitation of an overly detailed title, or indeed, just the title itself. As in previous years, too many candidates know that a title and field are necessary and do not know their purpose which often shows in the answer provided. Candidates should be familiar with the Patents Rules (particularly Rule 12), which will guide them to something of merit in both these essentials.

Description of the state of the art needed regurgitating, which almost all candidates did.

## **Statements of invention**

Candidates are, yet again, reminded that the role of the statements of invention is to provide support for inventive step arguments during prosecution. Simple recitation of claim features is a waste of a candidate's time and attracts no marks. In marking, the Examiner are looking to see whether the candidate has a) understood the invention and b) understood the reason for the inclusion of particular features.

Marks are awarded for what the feature does and why it is advantageous. Some very obvious assistance was provided in the paper.

## **Specific description**

This section was generally poorly constructed with candidates providing a disorganised description of the product and its methods of use. Information in the paper is necessarily jumbled up to dissuade candidates from cutting and pasting, or copying verbatim, although a surprising number of candidates do just that.

A lot of information was provided in this year's paper from which candidates were expected to draw a specific description, particularly in view of the lack of figures. As already stated, the figures provided were to illustrate a specific embodiment, a point that was missed by most candidates. Candidates who collated the different snippets of information and organised them into discrete descriptions of the laminate and the methods achieved high marks.

## **Abstract**

This section was generally well done with candidates providing a title that matched the one given at the top of the specification. Marks were generally lost for failure to include a statement of the field.