

Introduction

This year's examination saw an encouraging rise in pass rate for which successful candidates are to be congratulated. The Examiners felt that the paper was possibly more challenging than last year's, with less clear novelty, but this feeling was not born out by the scripts.

Successful candidates were the ones who showed experience and/or understanding of drafting claims. Unfortunately, a scattergun approach to claim drafting is still seen in a disappointingly large number of scripts. The mark scheme is a guide to Examiners on where and how to award marks but, unless a candidate demonstrates an understanding of the invention, a pass is difficult to achieve.

It is acknowledged that this year's paper was longer than is typical, but the amount of reading did not seem to disconcert candidates unduly. The Examiners try to provide the language that candidates need to draft the claims within the text to assist those for whom mechanical subject matter is not their field. There is a specific lexicon for mechanical drafting which pharma and bio trainees do not necessarily have at their fingertips, and if terms are offered to candidates for use in claims, they are present to avoid them having to work out what may be appropriate. In addition, the information is provided in a disorganised fashion to encourage candidates to think about what they are writing and to discourage cutting and pasting. This is a particular concern of the examining team going forward with the facility to copy and paste available in online examinations.

The invention

This year's invention was a receptacle lid incorporating an integral actuation mechanism that drives mechanical expansion and retraction of the lid via an expander. Two different embodiments were described, and candidates were expected to draft a main claim that encompassed both embodiments, together with a sensibly-nested set of dependent claims. It was appreciated that the balloon and pump embodiment was sparsely described but the majority of candidates included at least some of the specific claims suggested by the examiners based on the disclosure.

Main claim

For a pass, the examiners were looking for a claim that was novel over the Tupperware® tab which also enables a lid to expand and retract. It was considered that actuation or expansion "means" was not necessarily sufficient to provide novelty, unless the term "means" was defined in the specification because the term risked encompassing the Tupperware expansion tab.

If Claim 1 was deemed to lack novelty, appropriate marks were awarded to candidates who provided high ranking dependent claims which could be used in examination to overcome a novelty objection. If features required for Claim 1 novelty are provided towards the end of a (long) list of dependent claims, the specification needs to show very clearly that the candidate has understood the invention and is not merely throwing in everything in the hope of accruing sufficient marks to pass.

Additional marks were available for the clarity of Claim 1: such marks are used by examiners to reward a well drafted claim.

Dependent claims

As in previous years, the client letter provided all the subject matter suitable for dependent claim features, which simply needed to be picked out and ordered sensibly. Candidates who provided a considered and well-constructed set of dependent claims scored highly. Indeed, candidates are advised to spend time working out how the features fit together as it was possible to score half of the marks with ease. For example, the expander, with the options for walls, struts and connections therebetween, could have yielded six marks in total, and the balloon and pump with its options was worth up to five more marks. Achieving all of those marks required the candidate to separate the information, and think about how they should be ordered.

There was some tendency to draft dependent apparatus claims with solely method features, for which no marks could be awarded. The nature of an apparatus claim is that it claims apparatus unless the apparatus can only be described functionally.

Quite a number of candidates chose to include claims directed to features of the prior art, namely the rotatable tongue of the travel mug lid. Candidates should question whether the such feature(s) add patentability to a main claim in the event that the main claim is found to be unpatentable – this is the purpose of dependant claim features.

A worrying number of candidates also included claims directed to a method of closing a receptacle. While methods should always be considered, in the scenario of this paper, the person carrying out the method would be the consumer who has a right to quiet enjoyment and so cannot and would not be sued. The inclusion of method steps in the statements of invention is encouraged where and when appropriate, but care and consideration should be given to including such potentially unenforceable features in a claim set.

Introduction and background

The reason for the introduction and background section in a patent specification is to set the scene against which the invention has been devised. As a result, some appreciation and discussion of the drawbacks and pitfalls of the prior art is expected. A simple cut and paste of the information provided in the client letter is usually not sufficient to achieve all the marks available in this section.

Statements of invention

The purpose of Statements of invention is to provide a credible basis for inventive step arguments. Therefore, simple regurgitation of claim language is not sufficient. As with previous years, the examiners were looking for a link between the statements of invention and the claims to ascertain why a candidate has selected to claim such a feature. In this way, the candidate is able to demonstrate their understanding of drafting, as well as the invention. If there is no underlying or credible reason as to why a feature is included, candidates should question why the feature is being claimed. There are, occasionally, some wonderfully creative advantages for features which are appreciated and duly rewarded.

Specific description

The specific description for this paper was predominantly provided in the client letter and was generally tackled adequately. Good candidates described all the features and provided a clear description of the arrangement and workings of one embodiment, followed by highlighting the differences in the other embodiments.

A significant number of candidates still struggle to provide relational information for features, which has the effect of making the specific description hard to interpret and forces reliance on the figures for interpretation, which is not advisable in practice especially since the demise of omnibus claims.

Abstract

Like last year, abstracts were generally well written and seen in the majority of scripts. The 4 marks available are relatively static from year to year, so it is disappointing when candidates miss the simple things like use of reference numerals which are easily-gained marks. However, one point that is generally lacking from many abstracts is an adequate description of the field. Simple recitation of Claim 1 is not sufficient to garner maximum marks.