

Introduction

Nearly all candidates seemed to find the paper approachable and to be able to draft a considered answer. The problem involved a squirrel-proof bird feeder with one piece of fairly close prior art (D1). There were a number of differences between the invention and D1, and good answers made a reasonable choice and justified it. Possible differences of the invention over D1 were:

- the feed holder protrudes (in the open position) from the bottom of the shroud, exposing the sidewall;
- the feed holder is made of mesh;
- the shroud has no holes (in the sidewall);
- the shroud has a pitched roof;
- the cap is at the bottom of the holder rather than the top;
- the shroud is longer than 25cm/ the reach of a squirrel
- the design is meant to repel squirrels rather than (heavy) birds;
- there are no perches.

In fact, most of the differences were interlinked: it is not very useful for the shroud to have a certain length if it also has apertures along that length. Nor can the feed holder be made entirely of mesh if the shroud has holes, for instance. A mesh feed holder is best since there is no scope for perches with a solid shroud. That does not mean that claim one should recite all these differences. This overview of interlinked features was not handled well by many candidates. Perhaps that reflects the limited time available.

Many candidates (when they discussed at all the alternatives considered and rejected for the amendment, something that the examiners were looking for) rejected the mesh as a distinguishing feature because it is known from the pedestrian D2 and admitted by the client himself that mesh feeders are known. The mesh feeder works particularly well with the blank shroud, because it is entirely exposed when the shroud is raised and completely protected when the shroud is down. This is not an ideal answer in the context of the question, because, as many candidates rightly pointed out, there is no support for a simple 'mesh', just a 'wire mesh', which arguably excludes the plastic version that the client is thinking of introducing. [Some candidates pointed to the citation of 'the mesh material' in lines 18-19 of page 6; this mesh material is the 'galvanised wire mesh material' of line 9, so can hardly be used to justify a broadening to any material].

Some candidates spotted further deliberate mistakes inserted by the examiners, in addition to the failed mistake of the units in claim 6: the Examination Report referred to a 'holder 2' instead of 'holder 12'; the 'food holder' in page 5 line 33 should be the 'shroud'.

There was no standout spelling point this year, though there was the occasional outbreak of 'squirells' and other wildlife. Some considered that the word 'movably' in the text was better spelt using the alternative 'moveably'.

Claim 1

A limitation to the 'whole sidewall exposed' feature seemed the broadest supported amendment. Some candidates appeared, from their novelty arguments, to be assuming that claim 1 already said this, but it needs stating to distinguish over D1. In practice, unless the shroud is aperture-less and at least 25 cm long (or thereabouts – a squirrel length is not so straightforward to define, and claims that relied on the length of a squirrel did not receive high marks), the feeder will not be squirrel-proof.

Advantages of such a configuration are its resistance to squirrels and the fact that the feeder is accessible to a number of birds at once (in D1 three birds on the feeder at once might bring the shroud down); and perhaps its simple construction.

The precise wording may be important – for instance, are the 'apertures' part of the 'sidewall'? That is, is any part of the 'sidewall' exposed in D1, when the apertures are aligned? Does the whole sidewall have to be exposed, or could it protrude in part only (assuming there is textual support)?

The clarity issue can easily be solved by using the wording on page four ('movably mounted with respect to the food holder'), or just 'movably mounted on the food holder'. There seems no need to incorporate claim 2 wholesale.

If one chose the mesh as the amendment to claim 1, the perforated sheet embodiment has to be deleted (from current claim 7), and most candidates who took this line did this.

Candidates are respectfully reminded that, although in a real-life response the claims would be attached to the Patent Office letter, for examination purposes it helps if the claims are first.

Dependent claims

Features that the examiners considered significant for possible inclusion in dependent claims are listed above in the introduction. Features related to the substance of claim 1 (for example, the length of the shroud, if the main feature is the exposed sidewall) are more useful than those that are peripheral (for example the mesh size).

Response

On support, many candidates cited specific passages from the description to justify a selected feature. Although there is only one main embodiment, and in most cases recital of an isolated feature is reasonable, more justification was needed at some points. For instance, page 7 lines 2-6 is the only passage that describes the roof, and it says, admittedly improbably given the drawings, that it is of 'wood or plastics'. In such instances, some justification for defining the shape and not the material in a claim, dependent or otherwise, is good practice.

Examiner's Report 2017

FD3 – Amendment of Specifications

On inventive step, nearly all candidates had a reasonable format to their arguments, though many were lacking on the technical front (see above). Some conflated the UK and EPO approaches, setting out first the CGK and the inventive concept, and then starting from D1 to show how the differences were not suggested.

Of those responses (the majority) using the 'Pozzoli' approach (fraying at the edges though it might be), quite a few had difficulty with the 'inventive concept', and summarised it, say, as 'providing a squirrel-proof feeder'. That is a statement of intent: the inventive concept must include the important features of claim 1 that go towards achieving that aim. Admittedly the participants in the Pozzoli case, including the judges, also had difficulty defining the 'inventive concept'.

For the avoidance of doubt, the Form 51/77 to appoint a new agent does not need to be signed by the client (unless perhaps there is some doubt in the matter, a rare occurrence).

Report

Once again, many candidates set this out as a letter to the client. There is nothing wrong with this as far as the examination is concerned, it means a more discursive style, whereas one can be briefer if allowed to use jargon for one's own (and the examiners') benefit. Also, there could be points worth noting for the 'file' that one might not say to the client.

The client memo was not handled well by many candidates, though possibly this reflects a shortage of time. Reference to the client's instructions is vital as, in the exam, this is the only input one gets as to the client's aims. If one chooses a different amendment to the one that the client appears to hint at (for example, whole sidewall accessible) then the memo should explain why. In the present case, one might defend a 'mesh' amendment even though the client is not optimistic about it.

Many candidates spent too much time discussing improbable divisionals and not enough discussing the best amendment to make to the present application.

Some candidates addressed such questions as design protection and infringement proceedings. These are not the subject of this paper.