

## Introduction

The invention related to violin mutes, and mutes for instruments of the violin family, where the known mute sliding captive on the strings between tailpiece and bridge was improved by building in a magnetic coupling between mute and tailpiece to reduce rattling when the mute is not being used. The claim on file described this broadly as a retaining means, and this appeared to be anticipated by the main citation produced by the Examiner, which uses an elastic loop for a similar purpose. The client indicates that the magnetic version of this “retaining means” is what he is really interested in protecting, and nearly all candidates pursued this aim.

Before discussing the sections of the paper, the examiners would like to remind candidates that each of the three sections should start on a new sheet, preferably using a page break. Additionally, it is always helpful (despite the list of sections in the Instructions) to have the claims at the front of the answer paper, and to split the clarity/ novelty/ inventive-step arguments of UK IPO letter into identifiable sections.

Some candidates pointed out mistakes in the paper (reference to “page 12” in point 3 of the official letter (should be 11); reference to Figures 4 and 1 in lines 7 and 26 of page 7 of the application (should be 5 and 2 respectively); and reference numeral 6 wrong in Figure 4 of D1).

## Claim 1

Most candidates opted for a claim 1 in which this retaining means was magnetic. However, there were several hurdles to clear before arriving at a satisfactory claim.

A mute with a magnet in it would be novel but hardly inventive if it had no function. The function is provided by a magnet counterpart in/on the tailpiece, and the IPO Examiner had objected that original claim 1 did not provide enough details for the mute to work as desired. However, an important consideration was whether or not this counterpart should be explicitly included in the claim. Many candidates thought so, but since the mute can be made to work using a paperclip as the counterpart, it would be wise to avoid explicit inclusion. Some candidates while including the clip did nevertheless, commendably, discuss the question of indirect infringement. The Examiners felt that the best amendment to claim 1 included some requirement for the magnet-containing mute to be “configured to cooperate” with a retaining means, thereby overcoming the IPO Examiner’s clarity objection without unduly limiting the scope of the claims.

Candidates were expected to broaden the claims explicitly to cover other instruments of the violin family, but “string instruments” is probably a bridge too far. Possibly the Doctrine of Equivalents might be prayed in aid if the claim specifies only violins, but it is always more comfortable to have literal cover.

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Another formal change needed in claim 1 was to clarify the language referring to parts of the violin/ instrument: this can be done by specifying for example that the string passes through the channel in use, or the channel is configured to surround the string.

Some candidates went broader than a magnetic retaining means, in particular by specifying the nature of the interaction in functional terms, i.e. that the mute is held against the fingerboard in the rest position but is not affected by it when on the bridge. Such an amendment would no doubt be intended to cover the tacky-pad version. This aim has only tenuous support in the description and relies perhaps on the known properties of magnets rather than anything else. Attempts to justify various broadenings on the basis of the penultimate paragraph of description on page 8 were ambitious, since that passage merely supports alternatives to magnets, not alternative forms of magnet. For the most part, candidates attempting such a broad amendment ended up with a “free beer” claim. It is noted that the client memo clearly indicated that the tacky-pad version was not effective, and thus of little commercial interest.

A few candidates spotted that the magnet/counterpart locations could in principle be reversed (i.e. the magnet is in the clip and the mute contains simply a steel stud). This does demand a somewhat convoluted form of wording but was perhaps worth a try. At present the client is probably not interested since he has not perfected his clip, and if the clip is lost the “paperclip bodge” is not available, but the intention to cover all bases is good.

Many candidates noted that the tacky-pad version was apparently novel and inventive over the citations. Some attempted to include it in claim 1, either by generalisation as above or explicitly as an alternative to the magnet. Many rightly observed that it did not seem to the client to be an important variant.

In terms of wording, it seems safest to include the term “inbuilt” with the magnet, and also to retain the term “retaining means”, rather than eliminate it altogether in favour of the “magnet”. Also, if one restricts the meaning of the word “mute” to the item 1 alone, as seems sensible, there needs to be a name for what is claimed. Many candidates went for “mute system”, as in page 5 line 23, and this seemed a good way forward. Some forms of wording did not make clear how the “mute” was “retained” on the tailpiece, when the mute apparently included the magnet counterpart.

There were some attempts to distinguish over D2 on the basis that it does not show “loose” channels such as those in the invention (9), but this seems a frail distinction in the light of the passages 39 and 41 shown in D2. A channel width of 2-3mm probably helps in this regard, though those precise dimensions might be inadequate for some cello strings. It is somewhat more arguable that D1 does not show an arrangement that allows “unrestricted” movement between the rest and working positions, since the elastic restrains the mute in the longitudinal direction, and this perhaps leads to attempts to generalise as above.

## **Dependent claims**

In the dependent claims there were a number of marks to be gained by adding claims to useful features, though not all of these increase the distance from D2. Assuming that the mute alone was claimed in claim 1, a useful further claim is one to a kit of parts, i.e. with the counterpart; this is, one assumes, the form in which the mute product will eventually be sold.

An interesting diversion is afforded by the desire to claim the version where the counterpart is integrated into the tailpiece. It is not stated whether the client sells tailpieces, though it seems plausible, but it appears necessary to claim a mute and a tailpiece, or even a mute and a violin, a configuration of lesser importance no doubt.

A number of candidates added independent claims to the clip. This seems optimistic, since there is hardly any indication in the application that such a clip is inventive, so support is weak. Moreover it would, even if allowable, necessitate a further search. The same difficulties would arise if such claims formed the basis of a divisional application, though at least that would not slow down the parent. There were many bold proposals for divisionals in other directions also, but they did not seem persuasive, certainly not justifying the expense for a niche product.

In general, in accordance with UK practice, candidates should provide a set of amended claims marked up over the claims on file, rather than just a set of clean amended claims. The provision of a second set of clean claims here is probably unnecessary, unless the amendments are extensive; however, wholesale rewriting of the independent claim should, in general, be avoided.

## **Response**

In the letter to the UKIPO there were in many cases some very good and clear arguments.

While there is no need to agree with the Examiner about any of his objections, a few candidates stated (in the letter or in the notes) that the Examiner was wrong in his assessment of the newly submitted claim, which he had not yet seen. It is best to be clear about what is being asserted: whether or not previous claim 1 was novel, the one now being presented is new; and the Examiner's obviousness verdict on previous claim 3 is not accepted (for instance).

Not all letters to the UK IPO gave adequate support for the amendments made. For instance, where candidates had attempted to claim the mute broadly, for example by omitting the term "inbuilt", supporting arguments were expected but not always provided.

Most candidates scored highly by discussing novelty with regard to all three documents and in terms of the features disclosed and not disclosed by D1-D3 (which was worth doing even though the Examiner did not cite the latter two for novelty). On inventive step,

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many candidates, applying *Windsurfing/ Pozzoli*, reasonably identified such passages as page 5 lines 4-12 as representing the CGK; some were reluctant to identify D2 as such, though it appears to represent option 2 on page 5. It is an interesting question whether D3 is part of the CGK for the purposes of this invention. In any event some argumentation was expected, and in many cases received, about the inventive activity needed to go from a magnet that could hold a pencil (but not a violin bridge) to a device capable of holding a mute on an instrument made of wood.

Again, many candidates scored highly by discussing inventive step in relation to D1, D2 and D3 individually, then in various combinations.

### Report

Candidates are reminded that what was requested was “Notes on which you would base advice to your client”. Certainly no-one would be penalised for writing a letter, but this is likely to take more time than necessary, whereas making notes allows the use of shorthand in the form of patentese, which one would not normally inflict on a lay client. Some candidates wrote a short letter with an annexe, but this also seems long-winded. But in general most candidates gave a better account of themselves in the memo than in previous years (possibly because there was less time pressure this year), rightly explaining the choice of amendment and of wording.

On the whole it seemed an unnecessary expenditure of time simply to repeat (for example) novelty and inventive-step arguments already presented in the UK IPO letter.

Several candidates who did not score highly in the claims section redeemed themselves by presenting clear and thorough explanations of why the claims required amendment, what the options were, why certain amendments had been rejected or proposed, and what the fall-back positions might be if there were further objections.

Most candidates spotted that there was no support for the single-string version mentioned by the client. Those who did attempt it were not penalised if it was plain that the attempt was speculative and if the reserve position was in place. In general, candidates who make overly broad or speculative amendments can avoid losing too many marks by clearly presenting their fall-back strategy in the client notes, together with an explanation of the reasoning behind the amendment chosen. Where a candidate does not provide such explanations, it is often difficult to determine whether the candidate has misunderstood a fundamental point or deliberately opted for a bold strategy.