

Introduction

The attorney is here presented with a dilemma in that, in order to cover the client's invention(s) from all sides, hard choices have to be made. On the face of it, the conversion kit idea for a bin is new but, in its simplest form, it consists of little more than a tube so a struggle to obtain a patent could be expected. On the other hand, the combination of tube and deodorant housing, though it seems clearly novel and inventive, only covers the upper end of the client's expected market.

Many candidates realised that a kit claim (which is well supported) is called for; most also retained or adapted a claim to a bin construction. However, only a small number of candidates handled well the decision-making and discussion surrounding claiming a kit or claiming a bin.

Candidates typically included the housing in claim 1 but, nevertheless, passed with a reasonable score generally due to a well set out response and a reasonable memo to the client, including a divisional to a bin with a tube, or similar.

Many of the candidates who went for the broadest possible claim – that is a conversion kit without the bin – failed to include some type of attachment means and so this resulted in a claim to a solitary tube, which hardly seems defensible. Candidates could regain some marks by discussing in the memo the fact that this was the effect and therefore that these claims may be overbroad, or more searches and probably limitation to other features may be required.

As ever, the response was generally handled quite well, but not the memo.

Each year there is a word that attracts maverick spellings, even though it is present in the examination paper. This year it was clearly 'deodorant'.

Claim 1

Most candidates picked up from the client's comment about retrofitting that a claim to a conversion kit (that is a tube to be fitted to a bin) should be claimed. Most then went for the combination of tube and deodorant housing. Though most went through available options in the memo, many did so without explanation as to why the eventual choice fulfilled the client's requirements (as opposed to merely being likely to lead to grant). Higher marks were given if this choice was explained – for instance, by saying that a claim to an unadorned tube would be difficult to defend.

However, in the circumstances it seems worth making the attempt. There is clearly no time pressure: in terms of the application, it was filed in 2012 so the compliance term expires at the earliest in mid, more likely late, 2016. From the client's point of view, he does not even have a manufacturer, and he has funding. If a claim to a conversion kit, not necessarily including the housing, could be achieved, then a divisional might not be necessary.

Some distinguishing feature defining more than a mere tube is needed, but the inclusion of a form of 'attachment means' seems at least to set the ball rolling. Some generalisation such as 'attachment means' is desirable, but is not easy from the disclosure, so good backup in the dependent claims is advisable (for example a set of fasteners, as page 7 line 14 for the first embodiment at least).

There is then a further question of whether the 'attachment means' has to be releasable or detachable. This is of less concern in a claim to a bin conversion kit, because a closed tube with attachment means is different from D1; however, a bin with a permanently fixed tube is hardly

functionally different from what D1 discloses. A claim to a bin with a detachable tube is new and arguably inventive, but it does not cover a tube kit with 'single-shot' attachment means. This may be of lesser concern to the client, but at least the pros and cons should be discussed in the memo. They rarely were.

ALTERNATIVE:

To claim the housing version, something more is needed than merely having the housing 'located at or near' one end of the tube (as in current claim 2). In order to run the argument that the setup is advantageous because the deodorant is largely idle until the bag is removed, the claim must in some way say that the air is drawn down the tube, through the housing and past the deodorant. This is best done by saying that the tube fits into the housing (page 5/20). Claims that did not do this were considered less sound, but some degree of amelioration is achieved by the functional limitation that 'when a bin liner is removed, air is drawn down the tube and through the housing'.

It may also be questioned whether specifying that the housing is 'at or near' the end of the tube, following the wording of original claim 2, sufficiently distinguishes over a notional combination of D1 and D2: if, following D2 (or following the prior art mentioned by the client), albeit in a less preferred manner, one puts the basket in the bottom of a bin of the kind shown in D1, it may well end up 'near' the lower end of the duct. This hardly brings out the advantageous configuration of the inventor where the incoming air forced through the tube is directed immediately over the deodorant block. Hence such a claim attracted fewer marks.

Some candidates, broadening claim 1 to a kit, then deleted much of the descriptive wording about the bin. Although the bin itself is no longer part of the claim, it is thought advisable to retain that wording because it gives a reference point when explaining in the claim where the tube is to be fitted.

A number of candidates went for the perforations in the tube, either in the main claim or, more commonly, in the divisional. There is no indication that this is of any interest to the client (and it does not cover one of the embodiments)

Dependent/other claims

In parallel to this, there is then the question of claiming a bin with an attached tube. Can this be distinguished from D1? Certainly, if the tube is detachable (D1 could be said to show a tube, but it is not present if detached, just a panel).

A backup claim to bin + kit was thought advisable, but not 'a bin comprising a kit' – wording such as 'a bin construction including a bin and a tube' would cover it. At least for a main claim to a tube + housing, the bin claim can be a dependent claim.

The deodorant block itself need not be included in claim 1 but a dependent claim could be added.

A few marks were available for added dependent claims to minor features, for correcting the dependency of claim 9 and making the omnibus claim refer separately to the two embodiments. It seems reasonable to add a claim to the tube being telescopic or in sections, but hard to conceive a useful claim that the tube 'can be cut to size'.

Response

There was no great problem in defending the novelty and inventiveness of a tube/housing combination except that, as noted above, if claim 1 does not state that the two are connected, or at least that air flows through the tube and over the deodorant (recess), there is a question mark over inventive step. However, the argument was not always set out systematically. The main obstacle is the combination of D1+D2, calling for the riposte that the mere collocation of these two disclosures merely results in separate tube and housing and does not give the desired effect of economical distribution of deodorant. It did not seem useful to state, for instance, that D1 does not suggest the use of deodorant (which is arguably common general knowledge).

When defining the tube/housing kit claim, it seems worth discussing whether it covers insertion of the kit upside-down (that is to have the housing at the top of the tube), and why this is still inventive despite D2.

Although such a claim is relatively easy to distinguish from D1 because of the presence of the housing, many candidates omitted to include the other main distinction that the tube is a free-standing component, unlike the duct in D1.

A few candidates said that they disagreed with the examiner but nevertheless amended claim 1. This does not seem logical.

If one changes the wording of claim 1 from that given in the existing claims, or even the entire text, this has to be justified in the response letter (and explained in the memo).

Report

Many candidates wrote a letter to the client. This does not lose marks, but it is pointed out that in a set of notes one can record things one would not put in an actual letter (e.g. because of worries about US discovery), and thereby demonstrate one's reasoning and understanding more effectively.

Few candidates picked up significant marks for the memo – often repeating the 'what I have done' information from the response to the IPO without including they 'why I have done this', 'what are the alternatives' and 'what are the prospects of success' elements that a client would want to see. Additionally, better answers picked up marks for discussing the infringement of the various types of claim (kit / bin).

There seems little point in suggesting a divisional that is in effect a dependent claim of the main application, such as a bin construction incorporating the conversion kit of [claim 1 of the parent].

Marks were given for discussion of whether the amendment still covered both the client's embodiments.

A number of candidates worried about whether the present application was published. Its application number begins 12, so it must have been published by early 2014.