

## Introduction

This year's question paper asked candidates to advise an individual as to whether her product ("the Guttergate") infringes or would infringe a patent held by another company (TV Builder Supplies Ltd (TVBS)).

Unusually, the client had had a prior relationship with TVBS and the background to the paper highlighted the nature of the previous engagements between the client and TVBS.

TVBS has a European patent application (Document B) which is soon to be granted. The client has provided a write up of her developments (Document A) and two prior art documents (Documents C and D), one of which (Document C) appears to have provided at least some of the incentive for the client to develop her product.

The underlying technology related to different ways in which clothing might be modified to ensure that water splashing on the clothing does not wet the legs of the user. In short a drain portion is provided at a lowermost portion of the clothing to capture the water run-off.

The patent application was a short document with two pages of specification and six claims. There was one independent claim; two claims (Claims 3 and 6) were in the multiple dependency category.

In this paper the client write up (Document A) outlined two different products, the Draingate and the Guttergate. However, and as stated in the client letter, the Draingate project was abandoned at least in part because the client had realised that manufacture of the Draingate was going to be prohibitively expensive. There was no evidence that any Draingate products had been sold, or offered for sale, and so it was expected that candidates would concentrate their infringement advice on the Guttergate product, where there was clear evidence of potentially infringing activity.

The two prior art documents were both earlier patent documents and were both full prior art. These together provided three separate potential novelty attacks, as follows: the single embodiment of Document C; the *integral* embodiment of Document D (for example as shown in Figures 1 and 3); and the *attachable* embodiment of Document D (line 30 page 18). Document C comprised a three page specification and two pages of drawings, whereas Document D was a two-page specification with a single page of drawings.

The feedback from the candidate survey indicated that the subject matter of the examination was more accessible than the previous year's question paper.

The candidate survey indicated that many found the examination time pressured. The Examiners considered that, with the reduced complexity of subject matter, lack of multiple dependencies, single infringement and simple prior art documents, candidates would have had sufficient time.

It is impossible to determine if those who suggested that there was time pressure had analysed both of the client's embodiments for infringement purposes.

However, the candidates who scored the highest marks appreciated that the client required advice based primarily on the activity which was actually occurring in the marketplace – production and marketing of the Guttergate – and focused the majority of their time on that, rather than expending examination time on a hypothetical course of action which the client had not pursued (production and marketing of the Draingate).

Again this year a spare set of claims was provided for use by the candidates. The line spacing was increased in line with candidates' feedback. Most candidates used the spare set of Claims. It is helpful to the examiners if the annotated spare set of Claims are provided as the first sheet of a candidate's answer script.

Again this year the standard of candidates' handwriting was generally acceptable and most candidates used alternate lines for their answers. This is welcomed by the Examiners because it tends to make the scripts more legible, especially where amendments have been made to the answer.

The pass mark was 50% and the overall pass rate was 35.3%.

Candidates are reminded that the mark scheme is an indication of the Examiners' preferred answer and does not detail all possible responses that can attract marks. An answer which is fairly based on the information provided, and which is internally consistent, will be awarded marks.

## **Construction**

The patent application to be construed had a single independent claim and 5 dependent claims.

Candidates are reminded that the construction section is the bedrock on which the rest of the paper sits. This is the section for candidates to explain what the terms of the claims mean and what each means in the context of the patent application (or patent). The basis for the construction should be arrived at from the materials available.

Several candidates this year failed to provide the required support from the materials available or simply recited the claim language in different terms without actually explaining what the terms mean.

Many candidates failed to apply their construction consistently across the succeeding sections of the paper. This inevitably led to candidates failing to obtain available marks in those sections.

Claim 1 was a product claim to “an item of outerwear”. This appeared to present little difficulty to candidates, although some candidates failed to conclude whether or not this imparted some weatherproofing given the disclosure in the patent.

The points of Claim 1 with which many candidates appeared to wrestle were “for covering at least a major portion of the user's upper torso”, “terminate over the user's legs”; “secured to the lowermost edge” and “at or towards the rear”.

These points were important for patentability and infringement considerations. The examiners required a clear construction of these terms and the application of that construction.

On the whole candidates were able to pick up the majority of the marks available.

The construction of Claim 2 was reasonably well presented, although some candidates did not mention the effect of the drain conduit.

Many candidates failed to mention or distinguish the spigot from the hose.

Claim 3 was not well construed by many candidates.

The Examiners preferred construction required an explanation that the “upturned portion” retained its form in both the first and second conditions.

Claim 4 was reasonably well construed. Many candidates noticed that there was something of a discrepancy between the wording of Claim 1 (“secured”) and the wording of Claim 4 (“not secured”) and suggested what the wording of Claim 1 means in context.

Again, Claim 5 did not appear to pose any difficulties to most candidates. A few that did not pick up all of the available marks failed to provide adequate support for “discontinuous”.

Claim 6 did not appear to pose any problems. Most candidates recognised that Claim 1 was broader than the coat/jacket of Claim 6. Very few, if any, candidates discussed if a jacket was capable of terminating over a user’s legs.

On the whole candidates performed reasonably well on this section with a mean score of 11.5 from the available 17.5 marks.

## **Infringement**

As stated above, this year there was a single infringement to consider, the GutterGate embodiment. It is this that the client is selling and it is of this that TVBS appears to have complained.

There seemed to the Examiners no reason for considering infringement of the DrainGate embodiment. Marks were available for saying why that embodiment was not going to be considered. Candidates who did a full infringement analysis of the DrainGate embodiment could only obtain those marks for that analysis.

When considering the GutterGate embodiment, it was clear that it did not fulfil the first feature of the claims (that is, it is not itself an item of outerwear).

For most candidates this made them consider infringement under s.60(2) UKPA. Unfortunately, there were a few candidates that did not.

Marks were available for a discussion of the requirements under s.60(2) UKPA including the date of first sale and the date of publication of the patent application.

Once it had been realised that supply of the Guttergate embodiment was not an infringement under s.60(1) UKPA it was necessary to consider the Guttergate in use. Some candidates lost marks by failing to explain how the Guttergate was to be installed on a coat and what features the coat would then have, in use.

On the whole the majority of candidates were able to demonstrate that the Guttergate embodiment, when installed on a coat, would infringe the claims of the patent application.

Claim 2 appeared to pose little problem for candidates.

In considering Claim 3 many candidates did not consider the multiple dependency, especially when it impacted because of the position taken on Claim 2. This led to a reduction of the marks available for dependencies.

Claims 4, 5 and 6 appeared to pose little problem to candidates.

Marks were available for discussing direct infringement (s.60(1) UKPA) by people/businesses supplied with the Guttergate and any defences that they may avail themselves of.

Some candidates said they would analyse the DrainGate embodiment for infringement to see if shifting to production of the DrainGate was a viable strategy to suggest to the client, but the client's letter already explained that they had explored the production of DrainGate and abandoned it as being commercially unfeasible.

Candidates are reminded that they should provide explicit support for their answers. Ticks alone do not do that. Available marks cannot be awarded the marks if no support is provided by candidates.

It is helpful to the Examiners if conclusions are provided at the end of the infringement section.

The Examiners' view was that all of the claims would be infringed under s.60(2) UKPA.

This year there were 18 marks available for the infringement section. The mean mark was 8.6.

## **Novelty**

The two prior art were prior published. If this is the case it should be stated by candidates as this is a pre-requisite for any consideration of novelty.

The two prior art documents represented three separate embodiments to be considered under novelty, one for Document C and two for Document D. Much of the subject matter of the embodiments for Document D was common between the two embodiments and so the Examiners did not expect each to be set out in complete detail.

Document C was, in some regards, the progenitor of the client's invention, having been invented by her mother many years ago. It relates to an apron.

## Examiner's Report 2019 FD4 – Infringement and Validity

The Examiners considered that the single point of difference between Claim 1 of the patent application and the disclosure of Document C was that the majority of the user's upper torso was not covered by the apron of Document C.

Some candidates sought to argue that a major portion was covered by the apron of Document C but this was often inconsistent with the construction section or the construction section had provided no confirmatory conclusion.

Document D disclosed a cyclist's coat with an integral or attachable gutter. Many candidates failed to appreciate that there were two embodiments and so did not achieve all of the marks available.

The Examiners preferred that both embodiments of Document D failed to disclose releasable securing means and so Claim 1 was differentiated from Document D on that basis. Some candidates suggested that the arms of the cycling coat provided "means to releasable secure". As long as this was based on the application of a fair construction it was awarded marks.

On the whole the Examiners preferred that Claim 1 was not anticipated by either Document C or D.

Novelty of Claim 2 over Document C appeared to cause candidates some difficulty due to misapplication of their construction. The spouts of Document C were either integral or separately attached pieces. The Examiners were looking for a clear explanation of which was relied on and how it related to the construction applied.

The analysis of Claim 3 with respect to Document C also appeared to cause some difficulty. The claim language requires that the upturned portion is present in both the first and second conditions, whereas there is no upturned portion in Document C when the male/female fasteners are released from one another.

The candidates who appreciated that there were two embodiments in Document D were able to score well for this claim, although they were few and far between.

Similarly for Claim 3, Claims 4 and 5 were answered well by those candidates who appreciated the disclosure of Document C and who saw there were two embodiments in Document D.

Claim 6 appeared to pose little difficulty for candidates.

As will be appreciated from the above, the Examiners expected that the claims were not anticipated by either Document C or D.

Marks were available for considering the DrainGate disclosure to determine if the disclosure to TVBS formed part of the state of the art.

Again, a section at the end of the novelty section setting out conclusions is helpful to the Examiners.

The mean score for this section was 13.4, whereas 26 marks were available. This is a lower proportion than in previous years.

## Inventive Step

This year there were 23 marks available for the inventive step analysis, similar to last year.

Marks were available for stating the relevant date for assessing the state of the art, providing an appropriate Pozzoli argument and for discussing if patents were to form part of the skilled person's common general knowledge.

Candidates were able to set out the Pozzoli test but seemed to have difficulty in applying it, especially in relation to common general knowledge.

Some candidates stated that because Document C was old it would have been common general knowledge. There was absolutely no evidence in the materials available that Document C represented common general knowledge. Some candidates sought to mosaic Documents C and D in formulating an inventive step attack (for example where neither Document was said to be CGK). Candidates should be mindful of "mosaicking" documents and, if they decide to do so, should provide justification for the proposed combination.

Candidates are reminded that patents rarely form part of the skilled person's common general knowledge, especially in low-tech, slowly moving technical arts.

The test is as follows:

- *Identify the inventive concept of the claim in question or if that cannot readily be done, construe it;*
- *Identify what, if any, differences exist between the matter cited as forming part of the "state of the art" and the inventive concept of the claim or the claim as construed;*
- *Viewed without any knowledge of the alleged invention as claimed, do those differences constitute steps which would have been obvious to the person skilled in the art or do they require any degree of invention?*

Candidates who applied the test correctly were able to score very well on this section. Unfortunately most candidates did not.

Of the 23 marks available, the mean mark was 7.2.

The Examiners expected that candidates would apply the Pozzoli test to each claim and arrive at a conclusion based on the most promising starting point and the common general knowledge. Marks were awarded for appropriate discussion of inventive step points. Unfortunately, many candidates were not able to identify the inventive concept of each claim.

For Claim 1 it was possible to use either Document C or Document D, although Document D appeared a better bet. The Examiners preferred that Claim 1 lacked an inventive step.

For Claim 2, it appeared that it was inventive over Document C or D, although this appeared arguable.

Again for Claim 3 it was possible to start from either document (as long as it was consistent with the approach taken for earlier claims). Most candidates failed to consider the dependency of Claim 3 and so failed to attract all of the marks.

Most candidates attempted to set out the inventive concepts of Claims 4 and 5. It was the application of the test which caused candidates to miss available marks.

Claim 6 appeared to offer little difficulty.

## **Sufficiency**

There were no sufficiency points to raise this year.

This section was worth 0.5 marks.

## **Amendment**

The potential for saving amendments was discussed by many candidates.

However, candidates again showed a tendency to suggest minor corrections to typos in the claims, of a nature which would not be expected to materially change the overall scope of protection of the claims or improve their patentability. Candidates who scored higher tended to suggest amendments which could be expected to overcome major patentability issues such as lack of novelty or inventive step. The best candidates realised that the patentee would prefer to use amendments which still resulted in at least some of the claims being infringed by the GutterGate, and anticipated these accordingly, offering comment on how the amendments would affect the infringement situation.

To be awarded all of the points candidates should state the impact *vis-à-vis* infringement any saving amendment will have.

Depending on construction and conclusions there appeared to be many amendments that were available to TVBS which would still have been infringed by the client.

Of the 3 marks available, the mean was 0.7.

## **Advice**

The advice section is the candidates' opportunity to display that they understand the patent position in the commercial setting of the paper.

It should allow candidates to draw together the points from the previous sections to provide the client with advice to further its position.

It was clear from the client's letter that the client was not prepared to cave in to TVBS and so the advice should have been suitably couched, and provided with caveats or explanations if the candidate was advising against confrontation.

**Examiner's Report 2019**  
**FD4 – Infringement and Validity**

Marks were awarded for any sensible and appropriate points which furthered the client's aims, and which were soundly based on the materials at hand.

Many candidates advised of the potential for an inventorship/entitlement action and the paths for seeking that, along with stays at the EPO.

Candidates were also alive to the possibility of opposition at the EPO and what would happen if the client was sued.

Unfortunately, although most candidates appeared to have time to write several points, many of these did not attract marks because they were either incorrect, contradictory or were not based on the materials to hand.

There were 12 marks available. The mean mark was 3.6.