

Introduction

The background to this year's paper was a situation which many of the candidates may not have encountered in practice, a request for a declaration of non-infringement. The client letter set out the recent history, the client's view as to the merits and a clear direction that the client wanted the attorney to take '...we must do all we can to stop them entering the domestic market...'.

Although the background situation was one which the candidates may have been unfamiliar there has been a significant amount of recent case law about new entrants to the UK market 'clearing the way' by seeking revocation of 'blocking' patents and so this was not considered to be a situation which would faze or discomfort candidates.

The patent to be construed was a modest document. The invention was easy to understand and seemed to pose candidates no more difficulty than in previous years. No specialised technical expertise was required to understand the nature of the invention.

Although the patent contained two independent Claims, the main Claim only had four dependent Claims and those dependent Claims did not have multiple dependencies.

This year there were two potential infringing devices and two pieces of prior art. As the two potential infringements shared so many common features it was not considered that this represented an undue burden to candidates. The two pieces of prior art were simple documents with clear references to the points of interest.

Overall, it was thought that the amount of materials to consider and digest was appropriate and there seemed little evidence this year that candidates had failed to attempt all sections (on the grounds that candidates seemed able to provide a response in all sections).

This year's paper allowed the best candidates to demonstrate that they were able to understand the salient points, apply a consistent thought process, and provide sound advice points to help satisfy the client's aims.

The candidates which passed the paper clearly satisfied the assessment criteria whereas those that fell short did not do so.

Anecdotally, it appeared to the examiners that many candidates were either taking the examination without adequate preparation, too early, or both. These candidates clearly did not meet the requirements of the assessment criteria.

As before, candidates are reminded that if they do not attempt all of the sections, or if they provide a cursory attempt on, say, inventive step, they are unlikely to meet the assessment criteria and pass the paper.

Whilst the overall standard of handwriting was higher this year than in many previous years, candidates are again reminded that it is difficult to award marks if the answer script is not clearly written and legible.

Construction

The patent to be construed was a recently-granted UK patent with two independent Claims, Claim 1 and Claim 6.

Unfortunately, too many candidates appear to consider construction as an opportunity to simply re-state the terms of the Claims in different words. Such an approach is not construing the Claim. The best candidates gave a clear exposition as to what each important integer meant in the context of the patent and the technical field in which it belongs.

For example, Claim 1 included 'a housing'. Few candidates actually considered and explained what was the purpose of the housing in the context of an 'insect trap'. Again, with regards 'the screen' few candidates considered and explained the purpose of the screen and instead adopted a construction which was consistent solely with the figures and the specific description. The examiners wanted the candidates to explain what the features were and what they meant in context.

Many candidates were able to provide a clear understanding of and rationale for the 'passive source', despite this feature having to be contextualised in terms of the background section of the patent.

The point of greatest contention in this year's paper was 'a source of electrical power to electrify the screen'. The majority of candidates considered that a 'plug' was a source of electrical power – it is not! However, where candidates maintained that construction throughout the paper they only failed to obtain the marks available in relation to that aspect of Claim 1. The client's patent gave a clear reason why a dedicated source of power was used. The reference to the trap 'also being connect[able] to the mains power supply' was in addition to the dedicated power supply and was not an alternative. If the Claims clearly disclose features it is likely that was the patentee's intention!

Overall candidates scored reasonably well on construction of Claim 1.

Claim 2 was dealt with well, in general.

The construction of Claim 3 was dealt with satisfactorily. The 'angled' feature clear required a purposive construction to determine what was meant. Many candidates resorted to drawings. Whilst this can be helpful, what is preferred is for the candidates to use clear and concise language to explain their positions.

Many candidates were of the opinion that Claim 4 added nothing to Claim 1. The best candidates recognised that Claim 1 did not specify where the screen was located within the housing and that Claim 4 required a specific location. (As an aside, document C of the prior art clearly showed an embodiment whereby an 'electrified screen' did not interrupt an insect fly path).

Claim 5 was generally dealt with satisfactorily.

Whilst many candidates scored reasonably well in respect of the construction of Claim 6, typically only the best candidates gave satisfactory explanation for 'flat' and its purpose, 'secured to' and whether this could mean, for example, integral with and which

component (or both) was electrically conductive.

Infringement

All candidates who made a serious attempt at the paper recognised that there were two potentially infringing articles.

However, a surprisingly large (and perhaps worryingly large) number of candidates thought that sale of an article intended to be used for research purposes was exempt from infringement. For the avoidance of doubt, such sales are not exempt!

It was clear that there was a threat of potential infringement (offering for sale at the exhibition in January) and that such a threat is capable of being restricted by way of injunction by the patentee.

However, the proposed devices of Insects Away did not comprise a dedicated power source, clearly inviting candidates to consider infringement pursuant to S.60(2).

At the sake of repetition, candidates who failed to properly construe Claim 1 of the patent as to the power source, were NOT penalised in the infringement section, as long as their answers were consistent with their construction.

On the whole, it was a relatively simple task to determine that both articles infringed Claim 1. Some candidates failed to find infringement of the second embodiment principally because of a limited construction with regards to the electrified screen.

Of course, if candidates were able to support their conclusions marks were awarded. However, where the points of construction are incorrectly applied, or where an opposite view was taken in the infringement section it is impossible to award marks.

Candidates generally scored well on Claim 2 and were able to provide clear infringement findings.

The same was true of Claim 3, although many candidates failed to be awarded marks due to a limited or inconsistent application of their construction regarding 'screen' and 'angled' with regards embodiment 2.

Claim 4 was generally well answered but again a limited or inconsistent application of the construction hampered many candidates with regards embodiment 2.

Analysis of infringement of Claim 5 and Claim 6 generally gave candidates little trouble.

It was expected that each of Claims 1 to 5 would be found to be infringed (under S.60(2) or, less preferably, S.60(1)) but that Claim 6 would not be found to be infringed at all.

Novelty

There were two documents to be considered for novelty purposes. Document C was a US patent and document D was a very short editorial from a magazine or periodical.

Surprisingly, many candidates did not note that Document C was cited in the patent and was specifically referred to in the client's letter. It was thought that this, at least, may have led some candidates to consider their construction in greater depth (with regards the dedicated power source point at least).

Candidates are again reminded that it is essential to apply their construction consistently across each section of the paper. Examiners do not expect to see a different application in, say, infringement and in, say, novelty. Indeed candidates that do that fail to be awarded marks.

With regards document C, the best candidates considered that Claim 1 was novel over a single point, that of the dedicated power supply. As to the 'passive source' document C gave a clear and concrete teaching as an alternative within the specific description, that the UV lure could be replaced with food or a source of carbon dioxide. At least one of which alternative lures are considered to be 'passive' within the context of the Claim.

The patent was also considered to be novel over document D, in terms of the 'housing', location of the 'screen' and the source of power. Due to a poor construction many candidates thought that document D disclosed a housing. Whilst not fatal this usually indicated a poor and incomplete construction and/or an incorrect application of the construction.

Of Claim 2, only document D disclosed pheromones. Again, regarding Claim 3, neither of documents C or D disclosed mesh angled with respect to a housing.

Claim 4 required a clear exposition of the term 'interrupts' and 'fly path' in the construction section to be applied to document C. Many candidates failed to do so.

Claim 5 was attempted generally well.

Claim 6 was considered to be novel over both documents but marks were awarded for finding that Claim 6 was anticipated by document D, as long as there was a consistent application of construction (especially in relation to 'flat', 'secured' and 'electrically conductive').

Inventive Step

There were 21 marks available for inventive step this year. This is more than in many previous years. Candidates must be able to provide a coherent and appropriate analysis of inventive step to satisfy the assessment criteria in this regard. Unfortunately, and as with many (if not all) previous years, many candidates again failed to demonstrate that they were able to do so.

That said, the candidates who gave a good or reasonable account of themselves in this section were those that tended to meet the assessment criteria and pass the paper.

The starting point for an inventive step analysis is a clear statement of the test to be applied. That should not be a task which is beyond candidates!

The skilled person would seem to be a designer of fly traps. This did not appear to be controversial.

It was clear that the contents of Document D might well be CGK – it is described as ‘the essential guide’ and talks about a device which is likely to take the fly trap world by storm! Other CGK was defined in the background sections of the patent (and possible the background to document C) but not document C itself.

Even where candidates have found Claim 1 anticipated an indication of likely points of difference between Claim 1 and the prior art and a brief discussion of whether that feature was inventive would have scored marks which were not awarded by simply stating ‘Claim 1 is anticipated so there is no need to consider inventive step...’, or some such.

If the examiner's expectations were met, candidates would have found Claim 1 to be novel and would have considered if it was obvious or not to have provided the device of Document C (as the most likely starting point) with a dedicated power source. The use of ‘other power sources for remote areas’ was clearly suggested in doc C and thus this feature was considered to be obvious. Even if candidates did not pick up on the food or source of carbon dioxide feature in document C in terms of novelty, it was available to make that argument in terms of inventive step.

Regarding Claim 2, the inventive feature related to the selection of pheromones as a lure. This is clearly disclosed in document D. However, many candidates failed to pick up on the point that Document C separated the trap (grid 39) and the lure (UV light) whereas in document D the trap (adhesive) and lure (pheromone) were combined. Examiners were looking for a cogent argument as to why one would extract the pheromone from the trap/lure combination of doc D and apply it to doc C, and thereby render Claim 2 obvious.

Again, a cogent argument as to why one would take the undulatory mesh and utilise it in the trap of doc C was required to gain full marks with respect to Claim 3. Many candidates did not do so.

Claims 4 and 5 again required an understanding of the purpose of the various features and argumentation as to why the features were not inventive.

To gain marks with respect to Claim 6 candidates were expected to select Document D as the appropriate starting point and to consider the points of difference and then provide

cogent argumentation as their implementation or not to support a conclusion. The examiners considered it unlikely that Claim 6 would be found to be obvious.

Sufficiency

There was only one point available for sufficiency and no substantive issues.

Correcting the obvious errors in the Claims was awarded marks (irrespective of where in the answer these appeared).

Amendment

The examiners were expecting the candidates to put themselves in the shoes of the patentee so as to best protect the patentee's business. Clearly, this may require compromise and where candidates did so a clear rationale for the amendment offered and how it might impact the patentee's position was expected.

It was considered likely that all of Claims 1 to 5 could be considered unpatentable and so an amendment from the description may have been necessary.

For example, an amendment as to the baffles would have captured embodiment 2 but not embodiment 1. As a compromise this would seem to be appropriate due to the potential market size for the embodiment 2 device as compared to that for embodiment 1.

Candidates were awarded for sensible answers which were supported by their conclusions on novelty and inventive step.

Advice

The advice section is the crux of the paper. It is an opportunity for candidates to bring some disparate points together and to demonstrate that they have understood the commercial context in which the task is posed.

Too many candidates troop out boiler-plate answer and points in this section. These will not be awarded marks unless they are pertinent to the situation in hand.

For example, checking if renewals had been paid indicated a lack of attention to detail (the client's patent was not old enough to require renewals).

The examiners were ideally looking for a clear exposition of S.60(2) and what it meant in this context.

There should have been an explanation of the procedure for declarations of non-infringement.

Also, an analysis of how and where to amend the patent would have helped the client.

Examiner's Report 2015
FD4 (P6) – Infringement and Validity

Saying that you will apply to amend in the UKIPO under s.27 would have been sub optimal because of the advertisement and opposition steps, which may well have eaten up the period between the examination and the exhibition in January.

This was a paper where seeking interim relief should have been considered, based on the client's instruction.

The examiners were prepared to award marks for sensible and appropriate points, especially those which demonstrated that candidates understood the commercial context.

On the whole this section was not answered well. However, an analysis of poorly scoring papers indicated that candidates had enough time to write many pages of points, it was simply that the points written down were not ones which the examiners could reward.