Examiners' Report 2021
FD2 – Drafting of Specifications

Patent Examination Board

Introduction

This year's examination saw a disappointing drop in the pass rate with many more candidates than usual scoring below 40%, particularly below 30%.

In contrast to recent years, the mark distribution was weighted towards the claims to provide a more focussed examination of the skill being tested in this paper, namely claim drafting. In particular, 40 out of 100 marks were assigned to independent claims, for which candidates were expected to identify and draft independent claims to a device attachable to a screwdriver, a screw and, ideally, two different kit (or equivalent) claims.

Successful candidates provided independent claims that included all the essential features necessary for the device/screw to function. Broader independent claims were also duly rewarded, providing they included all essential features. Narrow claims were deemed acceptable only if they were accompanied by sensible reasoning within the specification, although this was rarely seen.

While the paper provided a lot of text to read, candidates were specifically instructed to cut and paste appropriate passages. While some modification to that copied text was inevitably required, it was minimal to encourage and allow candidates to spend most of their time drafting claims. There was little in the way of prior art and so the test was more on drafting claims that suitably protected all aspects of the device, screw and kits, rather than novelty/inventive step.

Candidates are reminded that the instructions on the front of this paper are *inter alia* "to prepare a complete patent specification that is ready for filing at the UK IPO". Therefore, Examiners expect to see the claims following the specific description, then the abstract and, lastly, figures. Suitable ordering of the sections necessary for filing should be straightforward in electronic format.

Questions

The invention

This year's invention related to a releasably tensioned device for attaching to a screwdriver to reduce the likelihood of slippage of a screwdriver tip out from the slot in the head of a screw. A screw adapted for use with the device was also described, as well as an indication that the client was interested in selling just the device, a screwdriver with the device, and both in combination with the specific screws.

Main claim

The Examiners thought that claims directed to the generalised structure of the described embodiments would provide acceptable coverage of the invention, provided they did not include undue limitations. However, candidates that attempted to claim more broadly or functionally were duly rewarded, provided the claim still had all the essential features. Attention was required for the claiming of features that were best described in terms of function **when in use**.

Candidates are advised to consider which features are essential for the functioning of an apparatus and to make sure all those features are included in the independent claim. In this paper, the Examiners felt that a tensioning mechanism was an essential part of the device. Candidates who omitted this feature from claim 1 but included it in a high-ranking dependent claim were rewarded because the Examiners considered that such answers suggested the candidates understood the need to draft broadly but provided a sensible fall-back position in case they had drafted too broadly. Inclusion of a tensioning mechanism low down in a set of dependent claims, particularly without reasoning to explain its importance, suggested a candidate hadn't appreciated all the essential features of the invention. For the screw claim, it was important to distinguish the extra side notches from the traditional slot(s) in the screwhead. A slot in the screwhead for engagement with a screwdriver was required since the screw is for use with a device that is attachable to a screwdriver.

An independent claim that does not provide the client with sufficient scope cannot be rewarded with marks unless suitable reasoning and/or back-up is provided in the statements of invention. An example in this paper was limitation of the screwdriver device to three or more arms. The client letter stated that a single "notch" on the screw would not work and that two arms on the device "was not stable". Thus, two arms should have been encompassed in the scope because there was nothing to suggest that such an arrangement did not work. Therefore, the preferred wording for the arms and notches was "a plurality". However, candidates were not penalised for claiming "one or more" arms, even though the Examiners considered that a single arm would require significant re-engineering of the device to enable it to work.

As in previous years, additional marks were available for the clarity of the screwdriver device claim: such marks are used by Examiners to reward a well drafted claim.

Dependent claims

There were a number of features suitable for inclusion in dependent claims this year, and most candidates identified them and achieved good marks. As in previous years, candidates who provided a considered and well-constructed set of dependant claims scored highly.

Candidates are reminded that the purpose of dependent claims is to add features that might be used to impart novelty and inventive step to a non-patentable independent claim.

Introduction and background

The majority of candidates achieved good marks for this section, possibly because all the information required was provided in the client letter: candidates were invited to cut and paste from the client letter, and many included additional comment which was duly rewarded. If text was wholly cut and pasted, it may not have made sense and so some adjustment was expected. For example, the client frequently stated "I" when explaining what had been done.

Candidates are reminded that the statement of field should set out the **technical field** of the invention rather than a description of the invention *per se*.

Statements of invention

It was pleasing to see an improvement in statements of invention this year, possibly because much information was provided in the client letter. There were many more claim features than marks awarded for this section and so Examiners awarded marks for the most pertinent features, as well as those that had particularly well drafted statements of invention.

It was also good to see the occasional explanation for a particular chosen scope of independent claims.

There has been a rise in the use of "In some embodiments ..." to introduce a feature, and candidates are advised to be careful about the circumstances in which such a preamble is used as it is not always appropriate.

Specific description

The Examiners were aware that there was more text than usual in this paper and so candidates were given specific instructions to cut and paste appropriate passages from the client letter while removing any less formal language. It was pleasing to see that many candidates didn't simply cut and paste but provided sensible and considered specific descriptions.

Unless directed otherwise or it clearly makes no sense to do so, candidates are advised to use all the figures provided and also to take care when labelling. Candidates do need to know the difference between reference lines with and without an arrowhead. Both were provided in the paper to test this knowledge.

Candidates are reminded that marks are awarded for a specific description that **specifically** describes the embodiments and methods. Relational information to provide a visual image of a device is required, not a simple list of features, so that interpretation may be derived from the specific description rather than the drawings.

Abstract

As in previous years, abstracts were seen in the majority of scripts and were generally adequately written. More marks are awarded for an abstract that provides a broad description of the invention in the context of the technical field, rather than simple regurgitation of Claim 1.