

Introduction

The invention concerned an accessory for a bicycle, specifically a lightweight device for a bicycle with no mudguards, to catch spray from the road and prevent it hitting the rider, that can be lifted clear of the wheel when not needed. Candidates seemed to cope well with the technology.

Claim 1

Nearly all candidates opted for a claim 1 in which there was at least one row of bristles or flexible wiping arrangement, and at least one channel or passage, through the body for diverting water. However, many variations were possible, some better than others.

For instance, one question is, should claim 1 be limited to two or more groups/rows of bristles? This gives an easy distinction over both prior-art documents. The text indicates that it is effective to have more than one row (page 5 lines 19ff.), but also that the invention has some effect with only one; it therefore seems best to not restrict to two or more rows.

Then there are the questions about the relation between the channel(s) and group(s): where are the channels located, and must they correspond (one-to-one) to the bristles? Many candidates appeared to appreciate that locating the channels “between” the groups is unclear when there may only be one group, and that “below” needs to be there (cf. “below and between”; lines 29 of both page 4 and page 5). As to the correspondence (one channel for each group), it was felt that this does not need to be stated in the claim, though it would be hard to point to explicit disclosure of any other arrangement, and indeed the point does not seem important since having, say, several channels below one row of bristles would appear to have no functional advantage.

Many candidates, rightly intending to broaden the “bristles” feature of existing claim 1, replaced it with “flexible wipers” or “flexible wiping arrangements”. However, the true correspondence is between a row of bristles and a “flexible wiper”, as at page 5, line 1.

A common amendment to the claim was to change “consisting of” to “comprising”; this was felt to be reasonable.

Most candidates dealt well with the clarity point, e.g. by specifying the relationships between the unit and the bicycle “in use”, or that the unit is “configured” to be attached etc.

Dependent claims

Most candidates also provided a useful amplification of the set of dependent claims, e.g. specifying bristles (if broadened in claim 1), adding features concerning the number and angle of the bristles, adding a claim to a bicycle, and so on. Here it may be noted that claim 4 could be amended to be a bicycle claim, since it is hard to see what feature of the unit makes it “configured” to be attached in the way stated.

The L-shaped reflector is another feature of interest, and could in principle form the basis of a divisional application to a unit with such a reflector (but without mentioning channels). Some candidates attempted to claim a reflector on its own, usually as the main claim of such a divisional application. This would not seem to have basis, and is of dubious breadth.

Response

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

As to novelty, including the channels gave a basis for sound novelty arguments, though often these could have been more systematic. If the unslit part of “shield” 44 of D1 is taken to correspond to the “body” of Claim 1, and the fingers 50 to the “bristles” (etc), then there is nothing in D1 to correspond to “channels in the body below the bristles”.

In D2, many candidates rightly pointed to the slot 2 in D2, but some did not fully explain why this did not correspond to the passage in (revised) claim 1. A claim 1 which included the function of diverting water/mud gave the best arguments for an inventive distinction.

It seems highly likely that the “bristles” in D1 are angled in use (and see Figure 3), so this feature would not appear to distinguish.

Merely listing the features of amended claim 1 and then saying “D1/D2 does not disclose these features” is not considered by the examiners to constitute an argument.

A few candidates need reminding that there is no fee for requesting an extension of the normal term for replying to an examination report in the UKIPO.

On inventive step, it helps to clarify whether one is using the Windsurfer-Pozzoli approach or the EPO’s problem-and-solution approach. In Pozzoli the “inventive concept” of step (2) is not the same as “solving the problem”. It is also not sufficient as an argument to explain that “the invention solves the problem by ...”

For IS, as with novelty, assertions such as “D1/D2 does not disclose or suggest the features of claim 1” are not awarded marks. Most candidates discussed the combination of documents.

In the memo, some candidates appeared to have cut and pasted from their novelty and inventive step arguments. This is unlikely to be awarded marks, though an assessment of

the strength of those arguments shows awareness.

Report

Candidates are reminded that what is requested is “Notes on which you would base advice to your client”. Marks are not deducted for producing a letter, but this is likely to take more time than necessary, and also notes can include points that underlie the response, that one might not pass on directly to the client.

The report should preferably refer to the matters mentioned in the client’s letter, and explain how they have been addressed, or why they have not been, if they cannot be fulfilled. For instance, the client says that his design is “more robust” than Flexi-Guard’s, which is true, but that cannot form the substance of a claim distinction. Likewise, the fact that the D2 design is used with a mudguard, while the present invention is not, cannot of itself be used to make a distinction (though it can be relevant for inventive-step arguments): the task is to find the related or underlying features that do distinguish.

Most candidates did of course recognise that the push-pull variant is covered by claim 1, even as amended, and also that it is not possible to mention the presence of a light as well as, or instead of, a reflector (though a few candidates appeared to believe that such a course would be possible in a divisional application; disclosure/support requirements are of course the same for a divisional as for its parent).