

## **Examiner's comments – Paper E**

Not helped by V's insistence on presenting two versions of her hunting blind, the exam had a lot to get through in a short time. In summary: several claim terms were important for deciding infringement, there was no clear validity challenge unless you considered the claim to be very broad, and copyright was a key issue.

A number of terms in claim 1 were couched in functional language with broad scope. Deciding which parts of V1 or V2 satisfied these integers required looking at how the integers related to each other.

However the key question for V1 was whether the netting cover was draped over the umbrella canopy. If you construed canopy very broadly to not require a covering, then this feature could be present in V1. Otherwise “draped” must cover the hanging walls. This wouldn't be the natural meaning of draped, and you should have resorted to purposive construction. Even then the language is too clear to extend to the hanging walls. This interpretation could be supported later in considering the relevance of D5.

For V2 the key question becomes whether the net skin on the umbrella is an umbrella canopy. The draped cover is clearly present.

With two embodiments to consider, you needed to give some consideration to the dependent claims to ensure you didn't miss some easy marks. Missing these could be fatal.

If you construe the claim as indicated above validity was fairly clear cut. D7 is not available for any purpose (s59). None of D4 to D6 show a cover draped over an umbrella. Hard to construct an obviousness argument out of this, particularly as only D4 is likely to be common general knowledge.

If you construed the claim more broadly to capture V1, then D5 would be very relevant. If you decide D5 is not for mounting on a cylindrical support, then you will be drawn to argue that the claim is obvious as a combination of D5 and D6. However it will be hard to construct an obviousness argument out of this, particularly as only D4 is likely to be common general knowledge.

Regarding copyright you could consider similarity of V1 to D2, ownership of copyright in D2, causal connection in relation to V2 and D2, and expiry of copyright in relation to D4.

A few key notes on purposive construction, s59 and obviousness.

### **Purposive construction**

Many candidates failed to apply Catnic correctly. The test relates to the individual feature, and the purpose and effect of that feature not to the invention as a whole. Similarly the test will not usually stretch the claim scope beyond the maximum possible breadth of the written words – as this will usually indicate that the variant was intended to be excluded.

Examining the fact situations of Catnic and Improver, and other cases that have applied purposive construction, is a useful aid to understanding the uses and limitations of the doctrine. Candidates had to apply Catnic and Improver questions to the facts of the question.

## **Section 59**

This really was a minor point in the exam. Just a reminder that a document is excluded under s59(1) if it is publication of an application filed more than 50 years prior to the filing date of the NZ complete specification. The date of availability in NZ has no bearing. D7 was clearly excluded.

## **Obviousness**

Very few candidates handle obviousness well. This is not surprising as it is a difficult area and never clear. However there was a disturbing tendency to conclude that the claims would be obvious over combinations of obscure patent documents.

Many candidates recited Technograph as support for mosaicing and the diligent searcher test. These candidates should read the whole decision in Technograph.

Mosaicing and the diligent searcher test are obiter musings of Lord Reid. In the same judgment the diligent searcher test is explicitly rejected by Lord Diplock. All of the Lords agreed that the invention was inventive – refusing to entertain combining the teachings of multiple unrelated documents.

Remember these simple guides:

- The invention includes all of the claim integers.
- All documents are available, no matter how obscure.
- Your skilled addressee must identify the common general knowledge (which would rarely include the finer teachings of obscure patents).
- Your skilled addressee should consider only one document at a time in conjunction with his common general knowledge. For example the options that the document may open up to adapt things in the CGK, or the options that the CGK might open up to adapt or modify what is disclosed in the document. You should aim for the most compelling case, and you should weigh this against the strongest counter arguments.
- “Mosaicing” disparate documents is hindsight.