

PATENT ATTORNEY EXAMS 2005

Examiners' Comments on Candidates' Answers

Paper (a)(i)

Overall standard

- 1) Overall standard was disappointing, even with a liberal approach to the allocation of marks.

Questions involving fact situations

- 2) Where the question involved considering a fact situation and advising a client, many candidates floundered. Many simply tried a restatement of any law that might be relevant, most of which was not.
- 3) Most candidates answered questions not involving fact situations adequately, such as Question 3 on terminology, Question 6 on patentability, Question 7 on the differences in opposition and revocation (S41 and S42). Other statutory issues were generally handled adequately.

Day to day practice

- 4) Those candidates that did pass had a sufficient grasp of the fundamentals of patent law, but most clearly require more experience to deal with the issues that can arise in day to day practice.
- 5) Questions 1, 2, 4(b) and 8 were deliberately structured to test candidates' depth of knowledge and ability to analyse the issues involved in day to day practice.

Identification of part of question being answered

- 6) Many candidates did not specifically answer the questions of Questions 1 and 2 in the sequence in which they were stated. This was problematic when allocating marks for answers identified as relating to particular parts of the question. This could have caused unnecessary failure for some candidates, but with liberal marking the candidate was given credit for showing the relevant knowledge even though it was not directly on the point of the question that the candidate had identified.

Paper (a)(ii)

Poor statements of novelty

- 1) Few candidates were able to confidently provide even standard statements of novelty. Few candidates were able to provide a clear statement catering for the more complex situations – the set of Question 1, the computer icon of Question 3, and the extrusion

of Question 4.

Taking a shotgun approach

- 2) Identifying all relevant issues is important. But taking a shotgun approach is not. There is no need to recite lists of basic criteria over which there is no issue. Doing so obscures consideration of the real issues. Candidates would also run out of time to adequately address the real issues.
- 3) An issue is something over which there can be some doubt. An issue should be discussed with reference to the facts provided in the question. Repeating the legal test or the relevant legal concept with an affirmative or a negative does not constitute discussion. For example, the following is effectively worthless:

“To be registrable the features of a design must not be dictated solely by function. The features of the design are not dictated solely by function.”

- 4) This was particularly common in Questions 1 to 5, where many candidates repeated every possible ground of invalidity in each answer.

Pre-answering the later part of the same question

- 5) Many of the questions included multiple parts. Many candidates repeated large parts of their answer for several parts of the same question. Clearly the Examiner was looking for discussion of different issues. This was a particular problem in Questions 4, 9 and 11.

Not answering the question

- 6) The law should be applied to any facts given, a discussion provided, followed by an appropriate answer or advice. Reciting the relevant law is not enough. This was a problem for many candidates across the paper. Exam questions do not necessarily require consideration of the facts. In this paper, only Question 10a is in this category.
- 7) Candidates must look for all of the actual issues (or solutions/options) that are within the scope of the question. There is often be more than one actual issue raised that is within the ambit of the question. Full marks were not given for identifying only one of the issues. This was a particular problem in Questions 3 and 8a, and in Questions 10c, 11a, 11b, 12a, 12c, and 5b.

Answering all parts of the question

- 8) Candidates should ensure all parts of a question are answered. Many candidates answered only the first part of Question 2b, or failed to consider the opponent's s2 ground, or one or more of the documents (i) to (iii) in Question 10c.