

EXAMINER'S COMMENTS – PAPER D

General

The questions were not constructed to challenge candidates with understanding the technology, rather the intention was to test the ability to construct a patent specification that was internally sound and which also excluded identified prior art.

An issue that caused concern in many candidates' answers was the issue of consistency between the various sections of a patent specification. In many cases the individual sections of candidates specifications appeared to have little or no connection between them.

The Background must indicate the problem(s) to be addressed or the advantages that are needed. What is the invention about? Is there a "long felt want" for a product to address a particular concern? Is the invention an improvement over known products? Is the invention in the idea of doing something? The Object of the Invention must then fit this Background. The broadened statement in the Summary of Invention section must then define an invention having the structural elements to answer the identified problem and provide the advantages claimed.

The Description should fully describe the invention. This means that the features of the invention that are required to for example answer the problem(s) identified in the Background need to be discussed in full. Alternatives and variations of features should also be described in order that broader claim scope can be justified. Generic terms for features should be used where they can be, but alternatives falling within those generic terms should be provided.

If the provisional says that a feature is essential, then making that feature optional in the complete specification will mean that priority will be lost for those claims that do not include the feature as an essential part. This can cause problems if there is intervening use or publication. If the feature is stated in the provisional as being so essential that the invention will not work without it, then allowing it to be optional in the complete raises inutility issues as well. The same issues arise if the client instructions you are given say that features are essential and those features are not stated as being essential in the provisional patent specification.

The Claims/Statements of Novelty then need to capture the invention and need to include those essential features that are needed to meet the problems or other issues identified in the Background/Object. Prior art must be excluded. Generic terms for features should be used where they have been provided in the Description.

It is one thing to draft patent specifications in sections and to be correct technically within each separate section. However part of the art of drafting is to connect the sections together conceptually so that the invention (or inventions) to which the patent specification is directed is clear to the reader, and so that the monopoly claimed is commensurate with the invention described.

Question 1

The main difficulty that candidates seemed to have with this question was drafting a Statement of Monopoly that excluded the prior art. Many candidates required only that the tool head had a hammer head and a second functional means. This clearly allowed the tool to include standard claw hammers. Others did not require the presence of a hammer head at all, even though the client's instructions clearly stated that the tool would always have a hammer head. In some cases all features on the crossbar of the tool appeared to be optional.

A further problem was a lack of specificity about where the claw was positioned. Candidates correctly tried to allow for the presence of an optional 3rd functional means (in addition to the hammer and the claw) but did not say that the claw had to be on the side of the tool head. Again, it allowed for the possibility that the claw could be at the end of the tool head opposite to the hammer, on the top of the tool head.

Candidates need to think about what it is that the client says that they have invented and not try to unreasonably invent for the client. There was a tendency for some candidates to be overly broad and try to include far fetched options. This needs to be tempered with the recognition that there are some features that have to be included because they are stated by the client as being essential.

The problems with the Statement of Novelty were complicated by what was generally a good approach to the Background section. Candidates identified problems that were to be addressed but then the Statement of Novelty did not provide coverage for a tool that would necessarily overcome those problems.

The Description was also generally well done. There was however a tendency for some candidates to follow the features of the tool rather than the Figures that showed the features. This can work in some cases but tends to cause confusion where alternatives are presented in different Figures. The use of reference numerals was also sometimes lacking.

It was also important to recognise that there was the possibility a kit-of-parts claim based on the interchangeability option. This not only needed to be covered in the Statements of Invention but also adequately described in the Description.

Question 2

A common problem was that the provisional specification provided was clear that two wires were essential to provide sufficient support for the edging work. Many candidates changed this to "one or more" wires. This means that those claims cannot retain priority from the provisional filing date. The use in the intervening period described in the Question then becomes an issue in relation to validity of the candidates claims. This also raises an issue of inutility for those claims that do not require two or more wires.

A similar issue arose with the need for the wires to be parallel. Quite often the parallel nature of the wires was retained as an essential feature in the description but then was not included as essential in the claims. Some candidates did this for the two wire requirement as well (ie the need for two or more wires was retained in the description but this was then not reflected in the claims).

Again it seemed that the tendency was for the candidates to draft the various sections of the specification without reference to other sections.

It is important to provide some indication that the need for fair basis is recognised. It is not sufficient to simply copy over the text of the provisional specification without adjustment. Some candidates who wrongly or rightly broadened the claims beyond the provisional description needed to go back and provide basis for the broadened claims in the description.

Drafting claims was done reasonably well (although the "1 or more wires" and claim priority date issue was a problem for many) but candidates generalised features of the edging (or used other general terms) without having amended the description to provide support for that generic term. For example, the description of the complete specification retained the narrow reference to wire

while the claims referred to “connecting means” or similar terms. The use of “timber” and “edging means” is another example.

For example a claim requiring one connecting means, without a definition of the connecting means in the Description excluding rope, allowed the prior art that used rope looping around the front of the timber pieces to fall within the scope of the claim. This prior art also had the connecting means being longer than the edging.

The use of a general reference to the use of connecting means (or similar term) in the main claim could possibly be interpreted as being restricted to the use of two or more wires if the description retained the reference to the essential nature of this. However, where this was done, most candidates included dependent claims saying that there could be two or more connecting means. This meant that the main independent claim was not so restricted as it needed to be broad enough to include options wider than the two or more option. Therefore the main claim included the one wire option. Similar comments apply to the “parallel” nature of the wires as well.

A number of candidates did not include a dependent claim to connecting wires in the zig-zag shape despite this being the client’s preferred embodiment.

Most candidates handled the inclusion of the new information quite well. Some recognised that independent claims could be included to cover the edging including the new information (ie the grooves).