

2005 PAPER E
INTERPRETATION AND CRITICISM
EXAMINER'S COMMENTS

The pass rate for this paper was a disappointing 32% (cf., 55% for 2004).

The main issues identified by the examiner were:

1. Failure to recognise or understand the inventive concept

The inventive concept of the hip replacement system under consideration can generally be described as the provision of a contact point that shifts radially outwardly along the “liner” as the hip joint moves beyond the predetermined motion limit.

The answers of many candidates did not show any real understanding of this. Time spent actually understanding the invention is probably time well spent.

Clues to the inventive concept were provided by the statement of invention in paragraph [07] and by claim 9. It is surprising how many candidates did not refer to the statement of invention at all. Most candidates simply accepted the broadest claims (claims 1, 3 and 8) as defining the inventive concept, whereas they were actually missing the inventive concept.

2. Failure to “interpret” the claims

The examiner's comments for the 2004 paper include:

A significant number of candidates have obviously been coached to copy out the claim, assigning a reference number or letter to each phrase or what they perceive to be an element of the claim. They then used reference numbers for further discussion.

This approach should be used with caution.

....

The more substantive trap is that some candidates appeared to believe that this process of assigning code numbers to phrases was an adequate effort at interpretation. It is not. For one thing, many candidates assigned a single code number to quite long phrases which actually contained a number of elements. It was not clear from this mechanical process whether the candidate appreciated that there were several different elements in that phrase. Furthermore, some candidates did not then provide any real discussion as to the interpretation of the words and phrases of the claim. It was difficult to assign many

marks to what in some cases appeared to be little more than copying out the claim and recognising where there were commas.

These comments are very relevant this year. Many candidates seem to have adopted a formulaic approach of dividing up each claim and “discussing” each integer. However, these “discussions” frequently contain no real substance. Simply applying a formula is not enough to pass.

In some cases, the claim analysis approached interpretation from the wrong angle. As an example, some candidates referred to the alleged infringement to determine the meaning of the word “liner” in the claims of Patent B, instead of referring to specification B itself.

Most candidates interpreted “liner” to mean that the acetabular cup had to have a multilayer structure, the liner being just one of the components of that structure. One reason for that approach is given in the preceding paragraph. Another reason is because of what might seem to be the natural meaning of the word “liner”, being something that lines something else. That is not an impossible interpretation to make but in the present case it has the very awkward consequence that none of the claims of Patent B then cover the embodiments of the invention described in Patent B. Even though the word “liner” is used in the description with reference to embodiments of the acetabular cup of the invention, none of these embodiments have a multilayer structure. That should have suggested that “liner” as used in the specification and claims might have a special meaning, for example, in the nature of a surface.

3. Failure to recognise grounds of invalidity

The inventive concept was clearly described in the specification (especially in paragraph [07] and in claim 9), but had been omitted from the other independent claims, claims 1, 3 and 8. The very broad scope of claims 1, 3 and 8 raised validity issues such as inutility, insufficiency and lack of fair basis. These grounds were commented on by very few candidates.

Another ground that could have been considered with respect to the meaning of “liner” is the ground of ambiguity, though there is probably enough in the description of the invention to resolve the ambiguity.

The description of the invention indicates an object is to minimize dislocations of the hip joint. That point also features in independent claim 9. However, independent claims 1, 3 and 8, refer to dislocations being “prevented”. That presents an inconsistency with the description and gives rise to either insufficiency and lack of fair basis issues. Very few candidates recognised this.

A few candidates commented that claim 9 did not relate to an “invention” under the Act because it was a method claim broad enough to include the treatment of humans within its scope.

While most candidates recognised the “main” grounds of invalidity, such as prior publication and obviousness in view of prior publication, much of the discussion lacked substance (as with the answers to the infringement question). A number of grounds of invalidity received very little attention. For example, only about a third of candidates discussed obviousness in view of prior use, even though marks were allocated to this ground.

Some candidates misunderstood one or more of the prior art specifications. That made it difficult for those candidates when assessing those specifications in respect of prior publication and obviousness in view of prior publication.

4. Failure to deal adequately with amendments

The amendment question was mostly poorly done. Candidates should have recognised its importance given that 20 marks were allocated to it.

Some candidates did little more than recite the section 40 restrictions on amendment after acceptance, and not always accurately. Deciding on what, if any, amendments could or should be made is difficult if applicable grounds of invalidity have not been recognised.

If amendments can be made to cure defects in the claims but the amended claims do not then cover the alleged infringement, that can and should be stated – as it was by some candidates. The patentee might still prefer to have a narrower but valid patent than no patent at all.

5. Failure to use legal tests correctly

Most candidates referred to the usual legal tests from cases such as *Catnic*, *General Tire v Firestone* and *Windsurfer v Tabur Marine*. Not all candidates got them right. A greater problem is that often candidates do not actually apply the tests to the facts to obtain their answers. Candidates often resorted to simple assertions instead.

6. Failure to allocate time correctly

In general, candidates scored best marks for question 1 and most poorly for question 3. This suggests that many candidates ran out of time. It is always good exam technique to allocate sufficient time to each question (although the examiner recognises this is often easier said than done!).

Conclusion

When reading through an examination paper, it does become apparent to the examiner whether or not the candidate ‘knows what he or she is doing’. Understanding the invention is very important, as is keeping an open mind for issues other than novelty and inventive step.

Congratulations to those candidates to pass Paper E this year. To those that did not, do not be too discouraged – the paper is one that can be passed, with training, practice and determination.