

Examiner's comments about Paper D 2018

The comments below refer to the answers prepared by candidates for the 2018 exam. These comments relate to common mistakes and areas for improvement.

The main claim should cover both versions of the product described by the inventor

The question described a roller with a soft foam body and a wire in the middle. The question also described an alternative embodiment: using new materials that are soft and flexible, but also hold their shape after they have been bent or twisted. If the rollers were made from one of these new materials, they wouldn't need a wire. If your main claim required a wire, then the other version of the product would be outside the scope of the claim. The main claim should be broad enough to cover both versions, with dependent claims to each version.

The main claim shouldn't be easy for a competitor to work around

All candidates drafted claims that were novel over the prior art, but the scope of the claims was often too narrow or used terminology that was too specific. After you've done a first draft of your claim, you should read through the claim carefully and think if there are any features that could be removed or modified by a competitor to avoid infringement. As an example, the question also described an option of the roller that incorporates silk. Most candidates drafted an independent claim directed to a roller with a piece of silk material. You need to think about whether a competitor could make the same product with a different type of material. Could the material be cotton or polyester? It probably could be, so your main claim should refer to material, or textile, with a dependent claim to silk material.

The main claim should include the alternatives described in the detailed description

Your detailed description should provide support for the claims and describe the preferred version of the invention in detail. When you can think of alternative features, you should describe them in the description section. They can be simple alternatives. For example, you could describe alternative shapes for the cross-section of the roller.

Some candidates included alternatives in their detailed descriptions, which is good to see - but those alternatives were outside the scope of the claims. In this situation, you need to amend the claim to make sure the alternatives are inside the scope of the claims.

It's often necessary to use different terminology in the description compared to the claims. You just need to make sure that the connection between the description and claims is clear.

Include some dependent claims that have an intermediate scope of protection

When you're drafting your dependent claims, don't go straight to the specific features of the preferred version of the invention. You should try to think about claims that have an intermediate scope. For example, if you have a dependent claim that is directed to the hair roller having a wire embedded in the roller body, you could have an earlier claim that refers to a relatively rigid and formable member that is embedded in the roller body.

After you've drafted your dependent claims, make sure they each have the correct dependency and antecedent for each feature.

Protecting more than one invention

It is acceptable to include two or more independent claims that do not have unity with each other. Another option is to include claims directed to a first concept and then include statements of invention directed to the other concepts. Either option gives the client the opportunity to file one or two divisional applications. You can then explain the approach you have taken in the letter to your client.

Title, field of the invention, and background

The background, brief description of the drawings, summary of the invention, and object of the invention were done well by most candidates. Here are some tips to get full marks for these sections:

Check that your title and field of the invention is consistent with the claims. For example, if you have product and method claims, your title and field should also refer to the product and the method. As an example, if you have some claims that are directed to a hair roller and other claims that are directed a method of using a hair roller, then your title could be 'A hair roller and method of using a hair roller', and not 'An apparatus for curling hair'.

The background section can be quite short. A good background will describe the prior art from the question and not give away the invention. For example, the background shouldn't describe hard plastic rollers as being uncomfortable and then suggest that foam rollers would be comfortable.

The letter to the client should include useful information

Many candidates wrote a lot of information to the client about parts of the specification that aren't as important as other parts. The letter to the client is an opportunity to explain the terminology used in the claims and the process used when the specification was prepared.

Standard paragraphs and summary of the invention

There was no allocation in this paper for standard paragraphs, such as including a definition of 'comprising'. Don't memorise a holdall clause, or the definition of comprising to re-write in the exam. Although these are important in real life, you're not expected to know these paragraphs off by heart!

A few candidates wrote out the statements of invention in full. Since your time is limited, you can save time by including a short reference to the claims in the summary of the invention section. It is not necessary to write the claims out word for word in the summary of the invention section.

Mark allocation

Claims	45
Detailed description, including alternative embodiments, brief description of the drawings, summary, background, and object	40
Letter to the client	15

Generally, candidates that scored above 50% in the claims, also scored above 50% in the paper overall. For most candidates, their overall mark was similar to the mark they received for the claims.