

## **Examiner's comments 2019—Paper E**

The standard of the papers this year was generally good, as reflected in the high pass rate. However, it was a shame to see the same mistakes being made, resulting in fails for candidates who clearly know what they're doing.

Passing papers invariably shared the same characteristics:

- All questions had been attempted, including the two 'easy' questions at the end of the paper.
- All claims had been analysed for infringement/validity, not just independent claims.

Candidates who don't do these things will almost certainly fail this paper.

The main comments/issues regarding this year's paper are as follows:

- Candidates are generally dispensing with a recitation of the law, or a discussion of the preliminary steps that would be undertaken in practice. This is a good trend, as you get few if any marks for this and it wastes valuable time.
- The trend in 2017 and 2018 was mosaicing, and the trend in 2019 answers seemed to be doctrine of equivalents, with one candidate confidently asserting that we would have a doctrine of equivalents in New Zealand before long. New Zealand patent case law remains fairly orthodox, and candidates should make sure they are familiar with the key established principles. There may be marks available for working recent legal developments into an answer, but only where candidates correctly apply case law.
- As is often the case, most candidates did not pick up the issues relating to specification requirements such as utility, lack of support, and clear/complete enough disclosure. While some of these are 'extra for experts' issues, candidates should always review consistency clauses against the claims, and check for compliance with object statements.
- Several candidates only looked at infringement/validity of the independent claims, even though directed to consider all claims. Although significant marks are allocated to the independent claims, candidates missed many valuable marks by not dealing with all the dependent claims.
- Dependent claims must be considered in the alternative. No marks were given where a candidate concluded that a dependent claim was novel and inventive because the independent claim was, or a dependent claim wasn't infringed because the independent claim wasn't infringed.
- No marks will be given for a claim chart that just has ticks and crosses for infringement/validity of dependent claims. If candidates use a claim chart, they should ensure that it includes some discussion and that they identify the relevant integers(s) of the patent/prior art. This may earn them valuable marks if they run out of time for a substantive discussion.
- Most candidates do not give sufficient attention to the disclosure in the patent specification when considering the scope of the claims and reviewing the prior art. Advantage/object statements are particularly important. For example, an object of the patent in this case was that the speakers could be removed and the

glasses would retain 'aesthetically pleasing side pieces'. Candidates should have noted this in discussing the meaning of the word 'removable' in the patent claims.

- When considering inventive step, candidates should discuss why the skilled person would be motivated to take the disclosure of the prior art document and develop it into the claimed invention. They should look to the disclosure in the patent, to the background sections of the prior art, and to the exam question fact scenario for guidance as to the CGK, and possible drivers for innovation.