

## Examiners comments

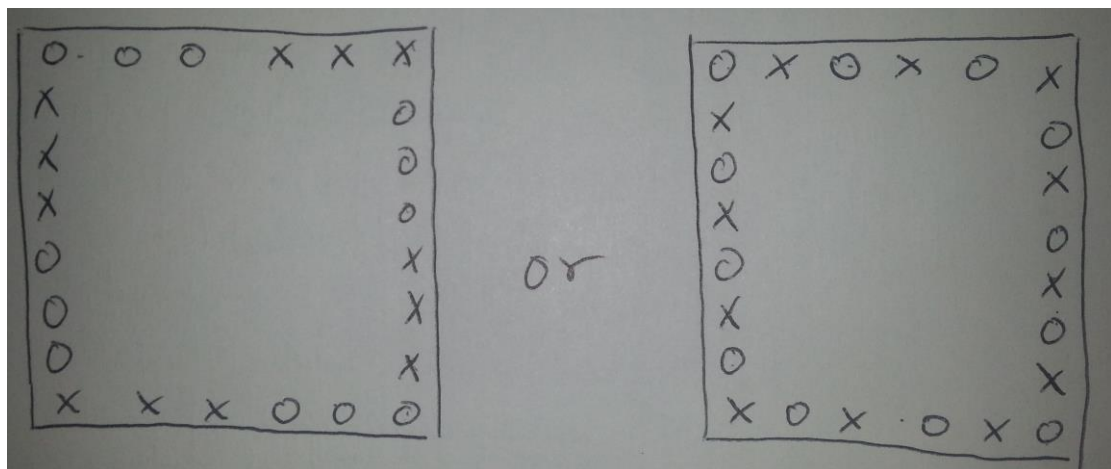
### Drafting Exam 2013

The drafting exam this year took a different approach to previous years. Rather than presenting the candidates with two questions about separate inventions, this year there was just one invention and two parts to the question. The first part required candidates to draft a complete specification. The second part asked the candidates to write a letter to their client to explain the content of the specification and to ask their client for any further information that may be required to be able to file the complete specification.

Many candidates only addressed the first aspect of the second part and forgot about other things that could be useful to have from the client or that were important to clarify with the client. As an example, the question should have lead candidates to realize that their client may not be the sole inventor.

Some would refer to the nature of the invention as “simple mechanical”. In reality, it was not simple but many candidates failed to see beyond the inventor’s explanation of his invention as set out in the question. Making the assumption that your client has come up with a simple mechanical invention will usually be fatal to getting broad claims drafted that cover all the variations that may offer design around solutions. Many candidates merely cut and pasted the drawings from the question into their answer without any additional drawings of their own. Spending some time thinking and sketching potential alternatives would have made candidates realize that the shape of the sheet needn’t be rectilinear in order to make it useful for many of the six purposes to which the sheet could be put.

Likewise some lateral thinking would have made candidates realise that the zips could be substituted with press domes or other male/female or other complementary like fasteners. One candidate claimed this aspect very well setting out that alternating fastening regions were provided at the perimeter of the sheet. This covering both alternatives as set out below.



The invention was a multipurpose sheet that the inventor designed primarily for use as a poncho. However, candidates that only claimed a poncho lost significant marks. A number of candidates had very narrow field of use limitations in their

main claim. Just because the inventor says that it's a poncho that has many other uses, does not mean that the scope of protection should be limited to a poncho. A competitor could otherwise make a sheet that could be used for all purposes other than a poncho and they would not infringe the patent.

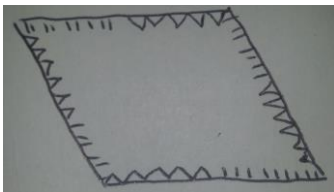
Some candidates claimed the invention as a multipurpose sheet. This was a good approach. Unfortunately some then went on to limit the scope by saying that the sheet had an aperture. Some claimed it even narrower by saying a "central aperture". These candidates clearly had the poncho in mind because again, the sheet could be useful for 5 other purposes that do not require an aperture in the sheet.

Those that claimed the aperture in a dependent claim scored better. But then some failed to realize that the aperture could be a zipped slit or the like, rather than a hole requiring a separate cap to close it.

Some candidates limited their independent claims to a waterproof sheet. Weather proof was a better term to use if it was going to be used at all. This lost marks.

Many candidates did not claim a plurality of the sheets for use together to form a tent or ground sheet. This would have been a good additional claim to have in there. More so that a method claim that some candidates opted for.

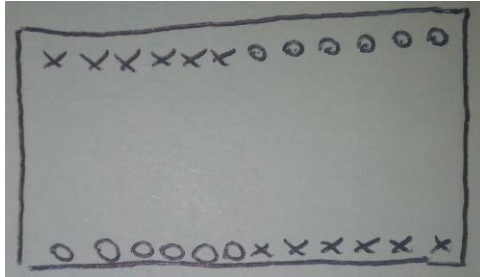
Candidates that claimed the sheet as perpendicular sided were marked down. This limits the shape of the sheet to square or rectangular. A parallelogram shape could work also for many of the sheet's uses. A four sided sheet would have been a better term to use. Or the term quadrilateral. To cover a square, rectangular, parallelogram, trapezoid and rhombus as examples. Doing some sketches would have led candidates to realize that these shapes could work for many of the 6 applications of the sheet. A parallelogram like that below would work.



Some candidates claimed the sheet as being at least 4 sides. This is fine but it would have been important to demonstrate in the detailed description how a 6 or 8 sided version could be made to work to ensure that there is internal fair basis for making such broad claim language stick. In fact only one candidate did an excellent job at explaining the concept of the sheet's functionality. This candidate described more than just what was shown in the drawings of the question. This candidate identified the broader principle of its function. This was really good from the point of view of setting out strong internal fair basis for broad claim interpretation. Most candidates merely repeated much of text of the question for their detailed description. Hence having only one example of a sheet. Whilst fine for sufficiency purposes it does not do much for internal fair basis and broad claim interpretation.

As far as taking account of the prior art, the US prior art was the most relevant.

Some candidates decided to limit the protection to there being fasteners on all sides of the sheet rather than just two opposed sides as shown in the prior art. But there was an alternative way and broader way to get around this prior art and that was to claim fasteners on at least two opposed sides where, at each side, two different kinds of fasteners were presented to allow a side to fasten onto itself and onto an opposed side. As shown where:



Some nice broad language for claim 1 could have been:

A 4 sided sheet with at least two opposed edges presenting alternating complementary fastening means capable of joining together when (a) the sheet is folded to bring each of said opposed edge onto itself and (b) the sheet is folded to bring said opposed edges together.

Unfortunately many candidates limited their claims by talking of folding the sheet in half or through the middle. These are very narrow geometrical terms.

A number of candidates had good claims to the sheet itself and also included claims to the sheet for use as a poncho, sleeping bag etc. This was good.

Candidates that had a poncho or other field of use limitation scored very poorly. Likewise those that limited their scope to square or rectangle sheets, a waterproof sheet, a sheet with a hole in it and the use of zips for fasteners scored very poorly.

Most candidates did well explaining each section of the patent specification. But a good number missed out covering off other aspects. A letter sending the draft specification to the client could encourage the client to review specification and ask if they can think of other variations to their invention described. This also provided an opportunity to explain the claim strategy adopted and possible alternative approaches. Claim interpretation could have been explained and the client could have been encouraged to read the claims. It should cover inventorship especially as the facts made it clear that it may not have been just your client that came up with all the uses for the sheet. The letter could also have covered who the patent applicant should be and asked if any agreements existed that involve the inventor(s) and the invention. The letter should ask for the full name, citizenship and address of inventor(s). Citizenship to ensure that no foreign filing permit is required from elsewhere prior to filing in NZ first. The letter could also have mentioned that further searching could be warranted. It could also have covered that filing a provisional may be a better option. It should also remind the client to keep invention secret until the application was filed.

