

Notes on Paper A – Tim Watkin

The following notes are a summary of a talk given by Dr Tim Watkin at IPOS on 17 August 2007. They are not intended to be a complete guide to passing the exam. The comments do not necessarily reflect the views of the examination committee, or of the patent agent firm where Dr Watkin is a partner. Furthermore, the notes relate to exam technique, not to how a patent application should be written in real life.

1. Start with the main claim(s) – the exam is passed or failed largely on this claim.

The independent claim(s) may be drafted in two phases:

First phase (mental picture)

- what is the main invention?
 - (a) what is the point of the invention?
 - (b) what features are required to give this effect.

Do not hurry steps (a) and (b)

- (c) list these features on paper, not aiming for claim language.
 - (d) what would a third-party do to obtain the advantages of the invention without having these features?

- are there multiple inventions, and if so are they independent? (see below)
- is there some clue to this in the inventor's write-up?
- if so, perform the second phase for each invention identified.

Second phase (saying what you mean)

- for some papers the difficulty is expressing a complex idea clearly. Sometimes, there is exactly one English word which is the key to the paper, e.g. "incrementally".
- some papers require a sophisticated understanding of how something mechanical works, e.g. the bicycle suspension in 2004.

How broadly to draft?

- Include all features necessary to give the inventive effect, but otherwise draft as broad as possible
- Treat the prior art mentioned as exclusive, but do not take this to the point of absurdity, e.g. writing a claim which reads onto any metal rod, just because no rod is mentioned as prior art.
- If the client's letter does not use suitable vocabulary, devise some which is better. Clients are often inconsistent in their terminology, or use extravagant words to describe their invention.

Give the field of the invention in the claim pre-amble. This eliminates a great deal of irrelevant prior art. For example, suppose the invention is a bicycle clip as shown:



One possible claim might read:

- Apparatus comprising a resilient elongate element having two ends urged towards a predetermined mutual spacing by resilience of the middle section.

However, this wording covers:



or even



Instead say, for example,

- An trouser-leg clip for holding a trouser leg of a cyclist in a folded configuration during cycling, the clip having...

Check your claim.

- Put yourself in the position of someone who didn't know the invention, and draw a picture of it from the claim. Do the advantages to be achieved flow from the features named?

- How would you work around it?

- Does it cover something obvious (even if not specifically mentioned in the prior art)?

- Can the claims be avoided by selling subordinate integers (e.g. a plug and socket) separately? What is the commercial product? Who will the infringers be?

- How would you criticize the claim if someone else had written it?

- Do the claims cover the construction when empty, idle, placed on its side, upside down, etc?
- Can the claim be made less pompous and more succinct?

Dangerous limitations:

- claiming by result “A bed which can be folded in half”.
 - but functional limitations are fine
 - “A bed having one or more blankets, each blanket formed of a water-resistant material”.
 - "A bed having:
 - a frame;
 - a soft surface supported on the frame; and
 - means for supporting the frame above a floor.
- negative claiming: “A bed which does not have a mattress”.
- number claims: “An alloy of tin comprising at least 10% copper”.
“A chair with four legs”.
- grammatical problems and ambiguities.
 - “A bed having a mattress and pillows which are soft”.
 - “A bed which has a mattress, having a soft surface”.
 - “A bed having a mattress and pillows, the pillows are soft and the mattress is hard”.

2. Method claim?

For some inventions a method claim is critical, and even the only way to claim something. For others, the only possible use of an inventive product is private and non-commercial, so a method claim is useless, and there are likely to be no marks on the marking schedule for it. To decide whether to include a method claim, consider what the infringer is going to do? A method claim will only be of use if the infringer the client needs protection against is going to carry out the steps of the method.

3. Unity

If there are more than two main independent ideas, then you must draft an independent claim for each of them. Note that in most years this is not required. When it is not required, it actually loses marks.

Multiple independent claims (especially in the same category, e.g. both apparatus claims) may mean that the patent lacks unity. This is acceptable when it is necessary to give the client adequate protection, but you must make a note to say that you realise there is a lack of unity, and what options exist to solve the problem, e.g. file divisional applications later, or file multiple applications immediately.

Sometimes, when this situation applies, the instructions to candidates give you hints as to what the examiners are expecting, e.g. that a full claim-set should be provided for only one of the concepts, and that any other major claim should be either just sketched out, or only a main claim is required, not sub-claims.

Note that including multiple independent claims is not a way of hedging your bets about the required scope of the main claim! As mentioned above, when there is no good reason for multiple independent claims, they are penalized.

4. Sub-claims

Marks are probably only available on the marking schedule for sub-claims to features which are not in the prior art.

Marks are only available for features which achieve some sort of advantage. A sub-claim is worthless if it has no chance of being upheld when the independent claim is not. For example, "A floppy disk according to claim 1 in which the cover is plastic."

Keep the number of sub-claims low; less than 10 normally.

5. Remainder of the patent application

There may be some marks for the description of the prior art.

Objects/ advantages should be very included but kept very general. For example, the sentence "The object is to obtain 100% efficiency" is dangerous. Better are: "The object is to improve the efficiency" and "Certain constructions may achieve an efficiency approaching 100%".

The summary section should include paragraphs which mirror corresponding claims, giving the advantage associated with each.

There should be no limiting statements about the invention which are narrower than the broadest claim.

The description of the drawings should be clear, have correct reference numerals, and refer to the "embodiment", not the "invention". It should almost always use the same language as the claims/summary, so that correspondence is clear. All features of the drawings should be described.

Obviously, this should be based on the inventor's description, but re-write the inventor's description if there is anything wrong with it.

6. Practising for the exam

- Do past papers, but have them checked by an experienced, technically-qualified patent agent.
- Do not do these past papers quickly. This is training you to do it badly!

Useful book:

"Fundamentals of patent drafting", by Paul Cole, CIPA (2006), incorporating two classic papers by Micklethwait and Daley.

7. Time management is crucial

You have 240 minutes working time.

Do not start writing until you have fully read the paper and understood it.