

Examiners' comment on candidates' performances in QE 2006 Paper C

Examiner 1

Most candidates gave quite good answers to the interpretation and infringement sections. However far too many candidates did not consider the priority dates of the claims and document C and as a result failed to realize that document E was prior art for the claims of document C, not entitled to priority from document D. Consequently their advice to the client was fundamentally flawed. Candidates making such a serious mistake are not fit to practice as patent agents.

Examiner 2

In contrast to last year's paper, the technology this year was very simple and the paper short. The only unusual issue was the priority claim, and even that was designed to be as straightforward as possible (in a real situation there are sometimes several priority claims, and the priority documents are in foreign languages or use very different terminology from that of the patent in suit). The dismal proportion of successful candidates reflects the fact that many simply do not understand even the most fundamental issues, such as novelty.

Few candidates seemed to notice that one of the few differences between the client's product and the infringer's is that in the latter the corrugations are not on the handle. This difference should surely be mentioned in relation to claim 4.

Only one candidate pointed out that both claims 1 and 6 refer to the bag as having been roughened. This may suggest that the bag exists before the roughening (as in the client's embodiment, and not in the infringement). Although the examiners don't happen to agree with this view, the point is worth discussing.

The examiners are prepared to award marks to candidates who, for well-argued reasons, disagree with them. However, given that one of the functions of the exam is to test amendment ability, it is unlikely that the examiners will be able to award the available

marks to a candidate who considers that the main claim is valid, and stops there. Even if a candidate believes that the main claim is valid (which is unlikely to be the examiner's position) it would be sensible to give brief suggestions for how it might be amended if this belief proves incorrect, or to strengthen the patent.

Given the necessity of the priority claim this year, the only amendments which are worth considering are ones which are supported by the priority document (and which cover the infringement). The number of possibilities is therefore very small. Full marks could have been obtained here easily with just a few lines. Yet the majority of candidates scored zero – most failing even to suggest amending or deleting claims which they had found invalid – and only one suggested good amendments. (Annoyingly, that candidate failed the paper for missing the priority issue.)

Commencing one's answer with a 2 page general essay about claim construction (Improver, Catnic, Kirin-Amgen,) without reference to the facts of the question, is a complete waste of time.

Incredibly, not a single candidate pointed out that the fact that the client had known about documents E and F before the grant fee was paid, might be a bar to discretionary post-grant amendment over them! This alone might sink the patentee's case.

The client is afraid of being driven out of business "within months" due to a campaign starting "within the next few weeks". His question is how to stop this. It is difficult to envisage clearer clues to the issue of an interlocutory injunction. Very few candidates even mentioned it, let alone gaining the available marks for considering whether it is possible given the factual situation. Again, this indicates that candidates are taking this exam far too early in their training.