



Examiners' Comments on Candidates' Performance in QE 2007 Paper B

Overall Performance

1. Overall, not enough candidates drafted very many additional claims. Nor did many candidates recognize that pivotal movement vs. sliding movement of the tools was a patentable difference between the invention and the cited art.
2. The advice letters to the client were generally okay and certainly better than prior years.
3. In the draft responses to the Search Report / Written Opinion, most candidates just made bald statements rather than cohesive arguments to distinguish the claims from the cited art so there is room for improvement here.

General Remarks

4. The exam paper B concerned analyzing the invention as originally claimed and disclosed in the specification, analyzing the cited prior art and the Written Opinion, and based on the results of the analyses, drafting an amendment and response to a Written Opinion (WO), as well as a letter to the client answering certain client questions and providing advice on how to respond to the WO.
5. The subject matter related to a multi-functional tool, so the technology was low-tech and could be easily understood by all candidates. The goal of directing the examination paper to an easy technology was that the candidates are not lost in, and therefore have to spend much time with the understanding of the technology, but can rather concentrate on the substantial patentability issues involved.
6. Like in some earlier years' Paper B exams, in order to draft an amended independent claim, which is broad enough, it was necessary to include features into the independent claim from the description of the invention, since a simply addition of features of a dependent claim into the independent claim would have not likely resulted in a patentable subject matter, and would have in any case unnecessarily restricted the scope of protection.
7. Credits were broken into three areas, claim amendments; draft response to WO (including prior art analysis and arguments); and client advice letter.
8. The overall performance of the candidates was significantly better than in the previous years, what is a positive trend. Nevertheless, some candidates still showed poor to very poor performance.

Claim Amendments

9. Every candidate amended the independent claim, however, some candidates failed to even indicate that such an amendment was necessary at all, namely that original claim 1 was anticipated by both references D1 and D2.
10. Even less candidates addressed the question of patentability of the original dependent claims 2 to 5. Errors which could have been easily avoided!
11. Regarding amendments of the independent claim the description and the original claims have provided several possibilities. One preferred feature to be added to the independent claim to achieve patentability was that the blades are movable laterally between the first position and the second position. However, other amendment were also accepted and marked with the same notes as long as they were new and inventive (with a corresponding good argumentation in the response letter) over the cited references, and did not unnecessarily limit the scope of protection. Such another possible amendment was adding “the plurality of buttons” feature to claim 1.
12. Many candidates appeared to have wanted to delimit the independent claim with said feature, but failed to word the claim accordingly. It cannot be overemphasized that correct claim wording is of outmost importance. As an example, some candidates amended claim 1 “almost” as said above, but did not recite the feature positively (e.g. “wherein each blade is associated with / actuated by a corresponding button”: an amendment which does not make the “button” part of the tool!).
13. Also in this year, some candidates limited the independent claim by a feature (s) of the tool which were not disclosed in the application as filed, thereby breaching Section 84 by adding new matter.

Structured Writing

14. Regarding the arguments in the response letter, it should be noted again that a patent agent must have the ability to put thoughts into writing in a structured manner. Many candidates were “jumping” back and forth between different issues. The reader, the patent examiner, should be able to clearly understand the response on its own without the need for additional thought to try to determine what was meant.
15. In this context it is to be noted also in this year that many candidates did not clearly differentiate between novelty and inventive step. Some have simply argued that inventive step would follow from novelty, or just repeat more or less the same arguments for both novelty and inventive step. That is clearly wrong.
16. Like in previous years, a common mistake in the papers was that arguments regarding novelty / inventive step were presented in the response letter based on features of the “invention”, but not on the claimed invention according to the amended claim 1! Obviously, such arguments miss the target and are irrelevant for patentability.

17. Only few candidates have provided good client advice regarding foreign filings. In particular, candidates oftentimes did not think about the possibility of filing a PCT application. Further, even if stated that Taiwan is not a PCT country, most candidates advised to file in Taiwan under the Paris Convention which is clearly wrong, since Taiwan is not a member of that convention. Priority claim in Taiwan is possible under WTO only.
18. Candidates should have indicated at least some useful alternatives to word a new independent claim along with the pros and cons of the alternative solutions. Very few candidates gave alternatives and even if they did so, they failed to comment thereon. Some of the candidates even missed to claim what client already stated as important in his letter.

Range in Candidate Performance

19. The overall performance of the candidates was mixed. The top candidates demonstrated a very good ability in the reply to the written opinion, the drafting of claims, as well as the replies to the client. The overall basis showed that about one third of the candidates were well prepared for the examination. However, many candidates also wrote irrelevant answers.

Detailed Comments

20. Response to Written Opinion

Most of the candidates did not check whether all the novelty and inventive step objections of the written opinion were valid, and did not realize that claim 5 as originally filed was not supported by the description. However, they generally provided a good basis for the amendments they had carried out in the claims. The indication by some candidates of the line numbers within the paragraphs of the application as originally filed that formed the basis for such amendments was particularly appreciated. At the opposite end of the spectrum, the basis for amendments provided by some candidates was not precise enough. The arguments of the candidates in favour of the novelty of the invention as claimed after amendment were usually precise, but sometimes lacked the discussion with respect to document D2. Inventive step was most of the time extensively discussed, but somehow in an unstructured way, no matter the type of inventive step reasoning which was adopted. In general, the overall performance of this question was good.

21. Claim amendments

The candidates performance on this question was in general not satisfactory. Even if all the candidates could draft novel claims, most of them introduced too many limiting features to distinguish the invention from the prior art. For instance, it was not necessary to have simultaneously in the independent claim a locking mechanism and a plurality of buttons for respectively releasing and extending each blade. Some candidates did not make it clear whether a button was triggering the movement of all the blades or each button was triggering movement of an associated blade. A few candidates tried to draft several independent claims, which led them to have one of these claims being either too broad or not really independent. The candidates were in general able to redraft the previously filed dependent claims by improving them in

a few aspects but not in all the aspects they were expected to. They also generally demonstrated a good ability to draft completely new dependent claims. Most candidates however failed to recognize the need to solve the situation due to the non-supported claim 5.

22. Letter of Advice to Client

This question was answered very well by some candidates who took the opportunity to answer all the questions and provide explanations as well as alternatives to the client. Quite many candidates however failed to discuss the role of the written opinion and to present all the options to the client in view of his activities abroad. Also, the key ring feature was discussed only by a few candidates. Not many candidates did get a high score on this question, perhaps due to a lack of time. Some candidates were able to save precious time by referring in the letter to the client to the discussion on the issues of novelty, inventive step and amendments which was in the reply to the written opinion.