

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

Examiner 1

General

Many candidates who failed had not identified all relevant issues associated with responding to a Written Opinion.

Many candidates also failed to answer the exam questions fully to earn all available marks.

The main tasks that were required in the exam were:

- 1) Draft a response to the Written Opinion including an amended set of claims; and
- 2) Write a letter of advice to the client.

Response to Written Opinion

- 1A) Amend the claims to overcome the examiner's novelty and inventiveness objections
- 1B) Provide support from the specification for the proposed claim amendments
- 1C) Amend the claims to overcome clarity issues (e.g. antecedence, dependency)
- 1D) Present analysis of the prior art
- 1E) Present supporting arguments as to why the amended claims are novel and inventive over the prior art
- 1F) Consider new independent method and device claims for additional protection

Letter of Advice to Client

- 2A) Report the Written Opinion to the client. Is the examiner correct or justified in his/her opinion?
- 2B) Answer the client's questions
- 2C) Explain strategy of the response
- 2D) Discuss claim amendments including clarity amendments
- 2E) Discuss any new claims
- 2F) Advise for risk and fall back positions



Specific Points - Amendments

Generally, the major claim amendments were performed well. However, some candidates failed to gain the easy 10 marks for correcting antecedence errors, claim dependency, and other minor clarity errors intentionally placed in the claim set.

There were some candidates did not explain or provide support from the specification for their claim amendments. Without this, marks could not be awarded as candidates did not demonstrate that they knew that claim amendments had to be supported by the specification.

All candidates failed to consider or add new independent method claims directed to horizontal movement. Up to 10 marks were awarded related to this issue as it would have broadened the scope of protection for the client significantly and been beneficial.

The new apparatus/device claim was not drafted well. Candidates may need to learn or practice how to re-cast a method claim into a device claim, and vice-versa. Generally, candidates who understood the present invention well were able to draft a superior new apparatus/device claim.

There were still some candidates that re-wrote the entire claim set by hand. This is unnecessary, and cutting and pasting would have saved valuable time.

Specific Points - Arguments

Many candidates did not consider the novelty of the present application over D1 and D2, nor consider the inventiveness of the present application over D1 and D2, and the combination of D1 and D2. In other words, there should have been a total of five considerations made by the candidate to be eligible for all 25 available marks. Many candidates severely handicapped themselves to only a maximum of 15 marks out of the total 25 available marks.

Some candidates still needed to be more thorough in their inventive step arguments. Many inventive step arguments were flimsy and generally not persuasive. It was not apparent whether candidates appreciated the higher threshold of inventive step than novelty in some

exam papers. Candidates are reminded to refer to the *Windsurfer* case for guidance on how to approach inventiveness and the *General Tire* case for novelty.

Many candidates failed to identify and discuss the potential unity of invention objection created by adding new independent claims. Although not critical due to the filing date of the patent application in the exam, it presented an easy way for candidates to earn some marks and demonstrate their appreciation of the effects their amendments may cause.

Only a few candidates correctly identified that the publication date of D2 is after the priority date of the present application. D2 cannot be considered for the purposes of inventive step. D2 can only be considered for the purposes of novelty if a corresponding Singapore application of D2 was filed. See sections 14(3) and 15 of the Patents Act. Also refer to the definition of “patent” for the term “another patent” in section 2 of the Act.

Specific Points – Advice Letter to Client

More work on the advice letter to the client is required. Many candidates did not place enough effort on this part where 30 marks were available. Candidates need to appreciate that many clients are not experienced with patents (as opposed to patent examiners), and thus require: explanation of any amendments to their patent application, explanation of the Written Opinion and the examiner’s comments, and the solution proposed by the patent agent. Simply telling a client to refer to the draft Response is not sufficient without some explanatory notes.

Candidates need to demonstrate good communication skills with the client and be able to express their proposed response and strategy to client clearly and intelligently. The advice letter to the client should not be overlooked or dismissed by candidates as merely a regurgitation of the response to the Written Opinion.



Examiner 2

Paper B this year, while somewhat lengthy in the amount of materials provided, was relatively easy in that the claim amendments were reasonably straight forward and the arguments for responding to the Written Opinion (WO) were provided in the Letter to Patent Agent from the Client.

A WO cited two prior art references, D1 and D2, to reject claims.

Reference D2 had a priority date before the priority date of the client's application, but was published after the client's application, making D2 applicable for novelty but not inventive step.

Method claims were provided and the client requested protection to a related device (capillary with roughened tip). Adding a new device claim raised an issue of unity of invention.

The Answer had three parts, (1) Claim amendments to overcome D1 and D2; (2) Response to Written Opinion; and (3) Letter to client reporting on Response and amendments.

Claim Amendments

Many candidates correctly amended claim 1 to include the subject matter of claim 2, which was required to overcome D1 and D2. The correct amended claim had 3 separate and distinguishable steps. Some candidates incorrectly combined two of the steps I believe because they do not understand the parts of a claim and how to positively recite elements such that those elements become limitations that can be used to distinguish the claimed invention from the prior art.

Antecedent bases errors and misnumberings were strewn about the claims, which were supposed to be corrected. Very few candidates corrected all of the errors.



Candidates were expected to draft a new apparatus claim. It was disappointing to see that some candidates did not understand the fundamentals of claim drafting. For example, a few candidates positively recited a “hole” in their claim. A hole is not an element, but is the absence of something and thus is supposed to be recited as part of an element, not as a separate element.

Response to Written Opinion

Candidates were expected to recognize that D2 was only relevant as regards novelty, but not for inventive step. Only about half the candidates spotted this issue.

In arguing novelty and inventive step, some candidates made only conclusory statements rather than developing a cogent argument. Some candidates argued that the invention was patentable based on limitations that were not claimed.

Most candidates provided support from the specification for the proposed claim amendments.

Adding a new device claim raised an issue of unity of invention. It was expected that candidates would spot the issue and make a statement in the Response as to why there was not a unity issue or to warn the client in the Client Letter that it could be an issue later.

Letter of Advice to Client

Like last year, most candidates seemed not to spend enough time or failed to recognize the importance of the letter to the client. Candidates were expected to explain their proposed response and claim amendments; explain the rejection and why it was wrong or right; discuss fallback positions or reasons for varying levels of claims; and warn the client of a potential unity of invention issue.

It seems that experienced practitioners place more importance on the letter to the client than the candidates. I believe this should be stressed in classes / tutorials in the future.