



## Examiners' Comments on Candidates' Performances in QE 2008 Paper C

### Insufficient Preparation

1. Most of the candidates gave very poor answers and as a result could not be seen as fit to advise clients on the issues of validity and infringement. Far too many candidates seemed to appear completely unprepared and not to have any idea how to approach the major topics in the paper.

### General Remarks

2. The Examiners noted that those candidates who have passed the paper C have taken into account the remarks for the candidates which have been put on the IPOS homepage before the QE.

3. Still too many candidates show that they lack practice. The priority problem of patent claim 1 is a well-known standard problem that is common in patent practice. Candidates should know the solution by heart without looking into the law text. The same applies to this year's amendment problem. It was very difficult to pass this year's paper C without correctly evaluating the priority of claim 1 and the priority of the element "alarm device".

4. Time management plays also a crucial role for the interpretation of the claim elements. While an interpretation is only necessary where there is a literal difference between the wording of the claim and the prior art or between the wording of the claim and the infringing device, some candidates have dedicated up to one third of their answer papers.

5. It was not necessary to interpret clear expressions such as "to project out of", "within", "retractable", etc. Candidates thereby often wasted time which was obviously lacking for the rest of the paper.

6. Candidates should also mind that it not helpful to interpret a claim element without telling why one needs to interpret this element. At least a short remark, such as "I do this interpretation for matching element "xxx" of claim 2 with the wording of document D5 at page yy, line zz", would be helpful when the interpretation of the claim elements is collectively presented before the evaluation of infringement and invalidity.

7. While UK judgments follow generally a structure where the all interpretations are collectively presented before the evaluation of infringement and invalidity, it seems that - for the purpose of the QE - it is worth thinking of including the interpretation of each feature which needs to be interpreted into the evaluation of infringement and invalidity.

8. Among the law issues of this years' QE, the evaluation of the relevant dates of the claims 2-4 took not longer than five minutes but it brought in valuable marks on the candidate's account.

### Basic Working Techniques

9. Apart from poor time management, the lack of basic working techniques seems to be a problem. Some candidates did not state all elements of the claims when assessing infringement. Other candidates failed to collect marks in the infringement section because they did not properly cite from where they were taking the relevant disclosure in D4.

### **Time Management**

10. The candidates all found it challenging to complete their answers in the time available. Many of the candidates however clearly did not use the time available well.

11. This year's paper C offers many issues for which easy marks could be obtained. The best candidates managed to address most of the issues in the examination paper, even if time pressure meant that they could not provide complete arguments for each issue. Quality is more important than a lengthy answer.

12. The infringement analysis was generally the best part of the candidates' answers while the analysis of the validity of D1 was the worst part of most candidates' answers.

13. The law questions posed in the letter to the candidate, when answered, were generally answered well.

### **Candidates' Performance**

14. As with previous years, most candidates invested too much time in interpreting and reciting every element for every claim. This is unnecessary and only elements that require interpretation scored marks. For instance, the elements that required interpreting were essentially: "0.12 wt % Chrome", "camming surface" "plunger", "beveled" and "means responsive to pressure".

15. The candidates who scored the highest marks justified their conclusions; however, very few candidates used case law such as the Improver test or Windsurfer test in their reasoning and conclusions.

16. Many candidates lost marks as they did not identify the priority dates for every claim nor did they attempt to discuss the inclusion of the "alarm device" into claim 2.

17. It is noticeable that the candidates in their vast majority were able to provide well structured scripts dealing with the key issues without undue repetitions. Among these issues, the candidates were expected to show that they were fit to practice, in particular to demonstrate their ability to apply correctly the concepts of priority, novelty, inventive step, amendment, infringement and more generally the rights associated with a patent. It is useful to remind the candidates that their work is rated according to the quality of their argumentation rather than the conclusions, even if it is appreciated that candidates take clear positions. The candidates should also refrain from dealing with questions that are not asked, as the majority of candidates did.

18. Assessing and using priority issues requires: (1) to know which law is applicable, i.e. SG Patent Act and Paris Convention, (2) to apply it correctly, i.e. to review carefully which priority is claimed, and whether it is valid, different criteria being applying to a first or to a subsequent application, (3) to draw the correct conclusions with respect to which documents may be

considered as prior art and effectively consider these documents when dealing with novelty and inventive step. The candidates should definitely develop these skills.

### **Specific Issues**

19. Novelty is apparently more straightforward, and many candidates have dealt with it correctly, displaying successfully their ability to retrieve the claim features in the various documents, but it also requires candidates to discuss interpretation, preferably by focusing on the really critical features.

20. Inventive step was more difficult as the patent showed 4 claims and therefore each one of them should have been attacked, leaving space for argumentation, which was often lacking.

21. The issues of amendments were this year involved with the issues of priority and as such only half of the candidates dealt with them correctly.

22. The same detailed analysis as for novelty helped the candidates to deal with infringement, generally well, even if some candidates failed to identify clearly the issue of non literal infringement.

23. The law questions were an easy way to score marks for the candidates who dealt with them in all their aspects: for instance the unity issue referred not only to requirements for a grant, but also to pre-grant procedure, misrepresentation, and post-grant procedure; dealing with threats to clients could include dealing with groundless threats and possibility of licensing.