INTELLECTUAL PROPERTY
OFFICE OF SINGAPORE

Examiner's comments on candidates' performance in QE 2004 Paper B

Compared to previous papers, this paper has more reading time and the issues are more clear-cut, and the paper more easily answered. That is, more reading time but less trying to determine what is disclosed, how things work, and what is required.

The paper was also prepared on the basis that those who know what they were doing, and knew the law and how to apply it, would be able to pass with time to spare. But those who didn't know what they were doing, and don't know the law and how to apply it, would clearly fail.

Generally, if a candidate made one major error, they could still pass. But two major errors made pass unlikely. The marking guide was structured to achieve this. We must ensure those who pass can be used by the public with a degree of confidence.

Even if a candidate ran out of time and couldn't complete one section of paper, if they did well in the other two sections they would pass. One candidate managed a pass even though there was no advice to the client. Only one candidate covered every point well and received good marks.

When it is realized that many candidates received exceedingly low marks, and total of about one third of candidates received less than the average mark, it is to be realized there is a problem in that many candidates are not receiving proper training at their workplace. Some many not be able to receive proper training as either they are not correctly supervised, or their supervisors do not have the training and/or experience to pass on to candidates.

Therefore, it is essential that a formal training programme be implemented as soon as possible not only to assist candidates to pass the examination, but also to assist them in doing the work correctly.

The objective of all candidates sitting this paper should have been to pass it. To pass it, the candidate should give the examiner what he is seeking – a set of claims that is inherently patentable.

The situation faced by the candidates (i.e. the problem to be solved by their answers) is one that is very common. The paper was prepared to be as realistic as possible. This meant, for example, formal drawings were prepared. This also facilitated candidates being able to quickly determine the amendments required and the options available. These were all clearly signposted in the paper.

The main signpost was that claims 3, 4 and 5 (all appended to claim 1) were all novel and inventive. Claim 7 (appended to claim 6, the other independent claim) was novel, as was claim 8. Claim 4 was dependent on claim 3, and claim 8 was dependent on claim 7. The feature of claim 3 was found in claim 7, but the feature of claim 5 was not.

Therefore, by combining claim 3 into claim 1 and the corresponding features from claim 7 into claim 6, all claims become inherently patentable and the lack of unity of invention objection was also resolved. However, many candidates missed that in doing so feature (f) of claim 6 had to be deleted otherwise there was duplication with the added feature (b) from claim 7. Also, the examiner's objection to claim 8 but not claim 3 was inconsistent as the features of the two claims are the same.

Many candidates missed the signpost. However, those that used claim 5 as the novel and inventive feature to be combined into claim 1, and also made the same amendment to claim 6, also resolved the unity objection. They received the same marks.

Several candidates totally missed the correction of the error – 10 marks that could be obtained very quickly.

Most candidates failed to advise their client that claims 1, 2 and 6 were not novel over the prior art. That meant easy marks went missing.

A few candidates even missed the Section 14(3)/Section 15 issue with regard to using document E for inventive step purposes.

The worst section of the answer papers was giving advice to client. Few candidates did this well. When preparing a response to a written opinion, the final say on what is to be filed is with the client. So sufficient reasoning must be provided to enable the client to make an informed decision. This is where most missed out – explaining why they were making certain proposals and the other options available.

That problem of a lack of explanation was also regularly found in many other areas of answer papers.

In considering each answer paper against the marking guide, the most common entry in the notes made at the time was "did not consider". Such a waste!

Several candidates proposed amendments not contemplated by the marking guide. If their proposals were properly thought out, explained, and supported by the disclosure of the specification, they were not penalized. To the contrary, some received extra marks for their innovative approach. However, some strayed and breached Section 84 by adding new matter due to claiming features not disclosed. This is a fatal flaw.

To be a patent agent requires a structured thinking and the ability to put thoughts into writing in a structured manner. Many papers were "jumping" back and forth between different issues, especially as far as the argumentation was concerned. 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.

In this context it is to be noted that many candidates did not clearly differentiate between novelty and inventive step. Some may argue 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.

Many candidates have judged document E correctly regarding inventive step, but nevertheless used that document when discussing the question of inventive step.

ADVICE is very important for patent agents and must be clear, concise, accurate, and must provide adequate reasoning to support options made and conclusions reached, and must be addressed at a level able to be understood by the client. There were only a few candidates who gave useful alternatives for claim amendments, let alone explanations why to go for one option over another.

As far as the unity issue is concerned, there was no really good answer in any of the papers. We did not find any clear explanation in any one of the papers that unity could be obtained only on cost of an "unnecessary" restriction of original claim 6 by feature (c) of claim 7. We have not seen clear advice to the client to either go for a more restricted claim 6 in the same application or to go for a broader claim 6 in a divisional application.

Some candidates amended claim 6 so as to overcome the unity objection, but nevertheless advised client to file a divisional application without mentioning that in consequence claim 6 does not need to be restricted by the feature (c) of claim 7. Others did not amend claim 6 so as to achieve unity, but nevertheless "argued" for unity, mostly in a wrong manner. Many candidates appear to have not really understood the concept of unity.

A very common mistake in the papers (which happens to all of us in the early days) 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! Obviously, such arguments miss the target and are irrelevant for patentability.

Most candidates seemed to not know how to write a letter of advice. Much time and trouble was spent on unimportant issues, and the important issues were ignored. During both tutorials it was made clear that candidates should cover the most important issues first and, if they had time, to go back and cover the lesser issues later. In this way the maximum marks were obtained first, and the lesser marks left until last. They were also advised to use "dot points" if necessary to save time, but this was rarely done.

To assist all candidates, a sample answer paper with amended claims is attached and which would have resulted in very high marks. It took less than an hour to write.