

Examiners' Comments on Candidates' Performances in QE 2009 Paper B

1. The vast majority of candidates missed the point that, based on the disclosure, it was necessary for the inner portions of the limbs to be joined together to avoid the dogs "lapping". As a consequence of this, many candidates failed to include the specific limitation in the claim of the inner portions being joined to one another. This was despite citing the passage of specification where this was disclosed as basis for an amendment in which this feature was not included. Also, some of these candidates sought to argue the benefits of this feature in submissions on inventive step, even when it was not included in their claim 1. It is only possible to argue technical benefits arising from features actually included in the claims.
2. Too many candidates replaced the term objected to on grounds of clarity ("to moderately consume...") with another term which was equally unclear, when all that was required was simply to remove the offending term.
3. Too many candidates (around one-third) mistakenly proceeded on the basis that, as D2 was a design patent, the skilled person could take from that a teaching relating only to its appearance/aesthetic features. It would have been surprising to see this from just one candidate, and extremely surprising to see it from so many.
4. Several candidates stated that a claim is anticipated if a prior art document discloses the essential features of a claim. That is also an incorrect approach. For a citation to be anticipatory, it must disclose each and every feature of a claim; no consideration is made as to whether a claim element is essential or inessential.
5. A few candidates advised a client to file a divisional application to claims appearing in this application, without any consideration as to whether this would lead to double patenting or not.
6. At least two candidates discussed the possibility of amending claim 6 to include a feature from claim 1 as a way of overcoming the lack of unity objection. Such a combination was not disclosed in the application as filed and any such amendment would have added matter to the application impermissibly.