Examiners' Comments on Candidates' Overall Performance in QE2017 Paper B

- Most candidates displayed knowledge of the form in which claim amendments and responses are to be done in real-life patent prosecution.

- The crux of the solution – and hence also the determinant of a pass or failure – lies in the correct analysis of a priority issue posed at the beginning, pertaining to S.17(3). S.17(3) is especially relevant to the practice of filing multiple "provisional" applications, which then form the basis of priority claims in a non-provisional national or PCT application. The inclusion of a seeming red herring associated with this priority issue – a prior art document which was in a different technical field, seemingly to be disregarded, except that the way the claims were written do not preclude its consideration – provided the greatest challenge. Through daily patent prosecution work, candidates should be able to gradually acquire the knowledge needed to get through Paper B.

- Several candidates failed to spot the obvious legal issues of having three Singapore patent applications filed for the subject matter and therefore making D3 a valid prior art document. Candidates must be alert to legal issues flagged in the question paper and be acquainted with the provisions and regulations. There were candidates who encouraged the client to file divisional applications for the unsupported new device. In addition, many candidates did not spot that an optional feature had been included in the main claim and would have excluded an embodiment. Candidates who had spotted the above two issues had no issues passing the paper.

- It is disappointing to note that there are still candidates who did not address the client's questions (e.g. to D3 or the characters); or did not provide arguments beyond "does not disclose"; or did not provide justifications (such as on recommendations on not protecting the new vacuum device in the current application). Some candidates did not provide proper support for claim amendments. There were also candidates who presented more than two independent claims despite the client's explicit instructions not to do so. Candidates who did not pass this year's paper would be well advised to continue revision and training before trying again.

- Candidates should spend time doing the past year papers so that they get the trend of the paper. It is a norm to include dependency/clarity/antecedence issues in the claims but quite a lot of the candidates were not able to pick this up. In addition, for the response part, a fair number of the candidates were not able to explain the difference and analyse this difference between the prior art documents and the amended claims – merely stating what the prior art is, what the claims are and stating that the amended claims are different from the prior art without any analysis would not score points. Easy marks that could be scored from the letter to the client section were not scored. Also, there will typically be a question on impending infringement, whether a divisional application can be filed etc., candidates should be more aware of such possibilities and be more prepared for them.

- At least 30% of the candidates have yet to acquire sufficient knowledge on claim amendments and the skills in drafting a persuasive response against the objections in the Written Opinion (WO).

- Candidates must carefully distinguish the features of the proposed invention and those of the cited documents, otherwise, it is not easy to score marks either in filing the response or amending the claims. If the candidates can distinguish the features, I believe that most of them could respond the objections appropriately and score marks.

- If candidates have particular difficulties in assessing the technical features of the proposed invention in view of the cited documents, the candidates would have less chances to score marks in the paper. Therefore, candidates need to be advised to spend more time to assess the real issue before they start to amend the claims and draft the Response.