

Examiners' Comments on Overall Performance of Candidates in QE2018 Paper A

The overall performance of the paper is poor despite the question involving a simple invention. This year's paper aimed to test the candidate's ability to come up with appropriate language in the independent claims on their own that accurately captures the essence of the invention while at the same time steering clear of the prior art documents. It is also important that the independent claims encompass all of the main embodiments that the client has described. Only a few candidates managed to do that.

Most of the candidates also failed to tie the language that they have used in the independent claims with the language used in the client's own description of the embodiments. This is especially important when it was the candidate's intention to impart a broader/different meaning than what was *prima facie* offered by the language used in the independent claims. In some cases, failure to do can result in the independent claims being construed too broadly such that they read on the prior art or too narrowly such that they exclude some of the main embodiments.

To obtain a passing mark for this paper, candidates are required to include the main essential working features in the independent claims that capture all of the client's main embodiments but at the same time not encroaching into the prior art. While such a concept seems straightforward, the majority of the candidates struggled to come up with the appropriate language that satisfies these requirements.

Overall, the performance had been disappointing this year, with once again a technically not difficult paper yielding nevertheless a low pass rate.

Most candidates had clear difficulty in deriving the structural differences between the invention and Prior Art A in a manner so as to cover the various embodiments. While the paper did not include an explicit phrase or term to define the distinctive movement of the door(s) of the present invention, the relevant feature(s) could be derived quite readily on the basis of the very specific disadvantage described for Prior Art A and considering the movement arrows shown for the various embodiments, which were clearly in a plane parallel to the wall onto which the device was configured to be mounted.

This ability to identify and formulate the essential feature(s) that distinguish a client's invention from the prior art is, arguably, the most crucial ability required of a patent attorney. Accordingly, candidates that could not demonstrate this ability had not yet reached the requirement to pass Paper A.

On the positive side, most candidates correctly followed the stipulations in the paper regarding the requirement to present two independent claims (directed at a guard for mounting to an electrical point, and to an electrical point integrated with a frame/door) and regarding the overall number of claims.

On the other hand, dependent claims were often poorly drafted, which was neglectful considering that 20 marks could be earned through properly drafted dependent claims, which also reflects the importance of dependent claims in real-life situations.

This paper presented a key challenge where the exact wording of the inventive concept was not mentioned in the question paper. This is not uncommon in the real world where patent agents often have to derive a broad inventive concept based on the embodiments provided by the clients. Nevertheless, the examiners recognised the apparent difficulty and had balanced this with a

relatively simple invention with many illustrative embodiments. In addition, clear instructions were provided in the question on the number of claims required.

A good number of candidates were able to identify the feature wherein the door(s) or protective cover(s) have to move in a plane/direction substantially parallel to a referenced surface between a first position and a second position. However, referencing the exact surface is important. Some candidates were unable to secure a passing mark because the referencing is incorrect, technically unsupported, and/or could be anticipated by the prior art. In particular, referencing to an 'opening' is vague without further structural limitations.

One candidate did not submit a detailed description. The examiners cannot over-emphasize the importance of a detailed description providing the necessary basis to meet the requirements of support and enablement. Unclear terms in the claims may also be construed in light of the description and this could make a difference between a pass or a fail grade.

Several candidates appreciated that for the independent claim to cover all embodiments, it would have to define the door movement as being on a plane. However, the door movement of Prior Art A is also on a plane. To pass this paper, a clear referencing of the door movement of the present invention was critical to distinguish against that of Prior Art A.

Some of these candidates referenced the door movement against the opening. Such a reference is unclear because an opening is simply a void with no structure and allows for an interpretation that the candidate means the plane on which the depth of the opening lies. Under such an interpretation, the defined door movement would not be clearly distinguished against that of Prior Art A.

The stated dependency of several dependent claims also led to implementations which were not supported by the original disclosure or were technically infeasible. For example, a claim directed at the pivotal door being dependent on a claim defining that the frame had slots results in an embodiment where the frame has slots through which the pivotal door would slide. There was no disclosure for such an embodiment nor was it considered technically feasible.

The question paper also asked for the description to have disclosure that fully supports the claim language. Ideally, candidates should have revised the description to explain how each of the different door movements was considered to lie on a plane. Few candidates undertook such a revision and instead simply just replicated the claim language under the summary of invention section.