

Examiners' Comment on Overall Performance of Candidates in QE2019 Paper C

Claim construction is an important element in Paper C, which requires a thorough discussion of ambiguous claim language. This involves a definition of what the claim language would mean to a person of ordinary skill in the technical art in suit, followed by determining possible variations relating to the claim language and whether each of these variations fall inside or outside of the claim language.

As the candidate didn't provide a sufficiently adequate discussion of unambiguous claim language for this paper, valuable marks were lost in the process. The candidate is also advised to manage time properly, to ensure that every section of the paper is adequately addressed to gain precious marks.

Overall performance of the candidates is weak, particularly for the Construction, Inventive Step and Advice to Client sections.

For the Construction section, certain commonly known terms, such as "spine width", "fold", are deliberately made ambiguous and therefore they will need to be analysed heavily, and candidates are invited to discuss the scope defined by these terms. When candidates fail to recognize that these terms are ambiguous when the specification is taken as a whole, many marks will be lost.

Inventive Step arguments are poorly presented and are not well-developed in general.

For the Advice to Client section, certain key issues (such as availability of post-grant amendments, groundless threats) are apparent and candidates ought to have identified these issues and made references to the facts on hand in order to score well. Mere identification of such issues will attract very low marks.

For this year's paper, there were a number of key construction issues which the candidates were expected to spot, and many marks were allotted to these issues across the construction, infringement and novelty sections. This being the case, if a candidate missed too many of the key issues when construing the claims, then it would be difficult for him/her to pass as this would have a knock-on effect on the following sections.

For the infringement and novelty analysis, candidates should also bear in mind that they are expected to briefly discuss why each of the claim integers are said to be present or not present. A number of candidates simply stated "Yes" or "No" without any explanation and no marks could be awarded notwithstanding that the conclusions were correct.

For the inventive step analysis, the 12 marks (out of the total of 17 marks for this section) were allotted to the analysis for Claim 1. To be awarded the bulk of the marks, a candidate was expected to provide a reasoned analysis for why the skilled person would or would not combine the teachings of the two prior art documents (Document C and Document D). This would involve discussing possible motivations for combination, but also whether there is teaching away. Some examples of the possible analysis are provided in the Marking Schedule.

Unfortunately, this section was generally poorly done as most of the candidates discussed what each of the documents disclosed then simply stated, with no or few supporting reasons, why the invention was or was not obvious.

For the advice section, there were the usual issues to be spotted and discussed.

Very low passing rate – main failure are insufficient / incorrect interpretation of technical terms, their combination and comparison with alleged infringing products and prior art documents. Key issues are missed by majority of candidates.

Most candidates do well at novelty analysis but not at inventive step discussions, some even have incorrect approach in dealing with inventive step issues.

The expected discussion in particular with respect to the most relevant case “Hitachi” and related post-grant opposition is not satisfactory as only seen in very small number of candidates’ answers.