

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

A number of candidates surprisingly are not aware that D2 is a category "P" prior art document and actually assessed it for inventive step as well. This is very basic knowledge that all patent attorneys should be aware of.

A number of candidates are also not aware that patents are jurisdictional and even advised the client to enforce the Singapore application against the supplier in Europe!

A majority of candidates did not provide full reasoning for the clarity and support objections. This is a loss of marks as Examiners are looking for reasoning why certain amendments (which can include deletions) can address the clarity objections. This is not mentioned at all and candidates just provide a general sweeping statement that the amendments address the clarity/support objections, without going into the how, which will not score any marks.

The quality of the answer scripts, and pass rate, appears to be consistent with previous years' examinations with a handful of candidates who manage to barely obtain sufficient marks to pass while the majority probably needs more time and practice to better equip themselves with the skills necessary in responding to objections raised by a patent examiner in a Written Opinion.

In general, the 2019 Paper B is considered to be an easy paper. The desired feature can be found in the description as a whole sentence. One possible trap for candidates was the use of the word "adhesive". There is a hint in the description that adhesive lamination is not the only way used for the lamination. Marks would be deducted for such a narrow feature used but nevertheless, some candidates still managed to pass with such an amendment.

As for the other major points being looked for by the examiners, for the response, it is surprising that many candidates failed to identify that there are two different variations in D3. Most candidates lost marks for discussing only one D3 embodiment. There were also candidates who failed to identify D2 as a document that should not be used for inventive step analysis. For some who did identify the document, these candidates lost marks for not properly discussing why D2 was such a document (i.e. did not discuss priority date, publication date etc.). For the clarity section, many candidates did not put in the effort to address these objections. Simply mentioning that the objections are now moot would not earn any marks. Many candidates also did not seem to appreciate the essential steps for the method claim.

As for the letter to the client, it is surprising that some candidates did not know the deadline for filing a request for review of the examination report and a few candidates did not seem to know such an option existed. It was also very surprising that some candidates mentioned that the client can sue the European supplier using the Singapore application. These candidates should fail and should revise on basic patenting concepts. There were also candidates who urged the client to file the European application despite the priority period having passed. There were also candidates who suggested that a divisional application be filed to cover the new additional matter.

In addition, it has to be mentioned that a letter to the client should discuss why certain amendments are being made (rationale) and how the amendments would contrast against the prior art documents (the differences). Many candidates lost marks by omitting such discussions and concentrated on the infringement question.

On the whole, candidates are advised to practise more papers before attempting again.

Quite a substantial number of candidates have understood between the invention and prior art. However, a few candidates went on to limit Claim 1 by introducing unnecessary features, excluding an embodiment. Some candidates even use D2 for inventive step assessment, which can result in immediate failure. Nevertheless, most candidates have demonstrated coherence in their amendment, response to Examiner and letter to the client.