

Examiners' Comments on Overall Performance of Candidates in QE2020 Paper C

Although the 2020 Paper C wasn't a difficult paper, I'm still pleased with the overall performance of the candidates in handling this paper.

Some important general pointers for Paper C include an ability to flag out parts of the claim language that require a more thorough and in-depth analysis and interpretation. As to claim interpretation, the candidates should apply a "purposive" interpretation of the claim language to be applied in the later infringement and validity assessments, instead of its "literal" meaning.

For example, with regard to the phrase "closed at a heel end portion" in claim 1, what does it mean for the plate spring to be "closed" at the heel end portion? Also, where does "heel end portion" of the shoe main body reside – and is there any significance in use of the term "end" in "heel end portion", as opposed to "heel portion"? These are relevant and important questions to be considered in respect of claim interpretation.

Occasionally, some candidates tend to focus only on obvious parts of the allegedly infringing and/or prior art devices, as described, for mapping with the claim features of the patent in suit.

For example, with regard to the "plate spring" feature of claim 1, some candidates focus only on obvious parts of the prior art devices as described, for mapping with the "plate spring" feature in claim 1 – Doc C: spring 26; Doc D: leaf spring 4 – and overlooked other parts of the prior art devices that might potentially map with the "plate spring" feature in claim 1 – Doc C: sole 12; Doc D: lead spring 4 and lower sole 3.

Consequently, valuable marks were not gained in the validity assessment. Candidates are reminded that the same terms used in the claim language of the patent may not necessarily be used in describing the alleging infringement device and/or the prior art devices. Instead, candidates will need to analyse – through a purposive interpretation of the claim language, as to whether or not the claim language reads onto the infringing device and/or the prior art devices.

For the infringement and validity assessments, candidates should provide more thorough reasoning to substantiate findings of infringement and validity. They should also be clear about the respective tests for novelty and inventive step – for example, the common general knowledge of the notional person of ordinary skill in the art should be applicable only for an inventive step assessment instead of a novelty assessment.

Finally, time management is critical for Paper C. Some candidates obviously ran out of time to finish the final Client Advice section and precious marks (that could have led to a pass) were lost as a result.

Overall performance of the candidates is surprisingly good this year, perhaps they seriously took into consideration individual feedback from the examiners in past attempts.

For candidates who did not manage a Pass, most of them fared poorly in the Construction, Inventive Step and Advice to Client sections.

For the Construction section, certain simple terms, such as "closed", "heel end", "toe portion" 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 (and not simply arrive at a conclusion). When candidates fail to recognize that these terms are ambiguous when the specification is taken as a whole, many marks will be lost. Marks are also lost when candidates do not provide a discussion on why they were inclined to construe in a certain manner.

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. Recitation of the law gains very little marks, if any.

There were a number of candidates which appear to have quite good fundamentals (as can be seen from the initial sections of the paper) but appeared to have run out of time so that they didn't have a chance to pick up the low-hanging fruit in the later sections.

Generally, the first 3 sections (Construction, Infringement and Novelty) hinge heavily on being thorough in the Construction section, so as not to miss out on available marks.

There will also be some claim terms for which additional marks will be awarded for more in-depth analysis / discussion. This is often tied to the features for which it may not be entirely clear whether the feature is present in the alleged infringing product and/or the prior art. This year, for example, additional marks were available for discussion of what "closed at heel end portion" means, but few candidates picked up these marks.

Many candidates do not seem to be well-prepared for the Inventive Step section as there was often little analysis beyond general statements to be effect that the feature was not present, and a skilled person would not think to introduce it. There needs to be some reasoning to support this conclusion. For instance, are there any features in the prior art invention which suggest that it might be useful to add such a feature might, or is there teaching away? The analysis and even the conclusion do not have to be the same as what's provided in the marking scheme, as long as it makes sense.

The Advice section is the one for which the most advance preparation can be made, as the same issues tend to be similar from year to year. Candidates can have a look at past year papers to identify some of these issues. Then it'll largely be a matter of "plug and play" to score well for this section.

Common understanding on original / dictionary meaning of technical terms

While "purposive construction" is the general rule to follow in claim construction, candidates should firstly exercise common understanding based on the original meaning of technical terms as a start. This is particularly the case with respect to the term "running shoe" in which, "running" should be understood to mean "structured suitable for running under normal circumstances e.g. running safely / less risk of falling down / injury" i.e. shoes not meant for / not having suitable/necessary structure for safe running (e.g. sandals, slippers) should be excluded. Very few candidates spotted this out.

Time management

Many candidates did fairly well in the claim construction and infringement analysis sections but wrote less at later parts of the paper e.g. inventive step discussions and advice letter hence resulting in marks lost. Suggest proper time control and time allocation planning in future attempts;

Detailed reasoning for supporting the conclusions

Many candidates give conclusions correctly but lack sufficient / detailed discussions to support the analysis which is an important part of the answers and with substantial marks allocated;

Inventive step vs inventive concept

Some candidates were unable to differentiate “inventive step” from “inventive concept” under the inventive step section.