

**THE JOINT EXAMINATION BOARD**

**EXAMINERS' COMMENTS**

**PAPER P3**

**PREPARATION OF SPECIFICATIONS  
FOR UNITED KINGDOM  
AND OVERSEAS PATENTS**

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### EXAMINERS' COMMENTS 1997 P3

The Examiners were saddened at the generally poor quality of the answers to paper P3 this year. This was noticeable in all aspects of the drafting exercise.

Starting with the claims, a typical reason for failure was that candidates managed to include in their cover a perambulator or supermarket trolley or the like having a wheel at each corner, without including anywhere in their suite of claims one which actually covered the invention. Some even managed to claim the prior art two wheeled porter's trolley, overlooking the fact that such a trolley can be manipulated up steps or kerbs by using one of the two wheels as a fulcrum, pivoting the trolley sideways and thus "walking" the other wheel up the step.

These were of the more serious faults. Other unnecessary limitations in claim 1 were a handle as such where a "handle portion" would have given the necessary breadth, specifying that the wheel axles or the supports therefor extended one further from the frame than the other when, to function adequately, all that was needed was that the "upper" wheels projected the further rearwards, or specifying that the frame comprised two elongate members with cross pieces.

It was interesting the lengths that candidates went to to avoid saying "wheels", with quite a number going for "ground engaging means". Perhaps this was in case the client wanted to put on the market a device which ran on skids - but then he'd have skids long enough to enable the pivoting action. "Wheel means" were surely adequate, especially if defined in the specification to include rollers etc. Again specifying that the wheel means were "rotatably mounted" seemed somewhat over the top.

An acceptable claim would have read:

"A trolley comprising a trolley body having a frame with a handle end and a base end and a base member projecting forward orthogonally to the frame at the base end thereof, first wheel means adjacent the base member, the arrangement being such that a load can be carried on the trolley body nestling between the frame and the base member and the trolley can be trundled along upon said first wheel means, and second wheel means mounted on the frame adjacent the first wheel means and projecting further from the frame than the first wheel means, whereby the second wheel means can be engaged upon the surface of a step or kerb and the trolley pivoted thereabout to enable the first wheel means to be raised onto the step or kerb."

Some candidates determined to have a separate independent claim to the third wheel means and some omitted the base member from the main claim. These approaches were acceptable. Some candidates introduced process or method claims. The Examiners did not believe that these served any purpose in the present case, but their inclusion was not a pass or fail issue, rather one of degree.

Turning now to the specification as a whole, one or two candidates sought to justify not drafting a whole specification on the basis that the definition of "preamble", which attracted a certain quantity of marks, did not extend to the consistency clause or beyond. Candidates were however asked for a whole specification and should have been mindful that another view was that the preamble included everything before the description of the drawings. Whilst candidates were not penalised for a narrower interpretation it will not have helped them if the specification did not support subsequent amendments to the claims.

It is important to bear in mind that these final examinations seek to realize real life situations. Candidates do not have to seek for tricks and red herrings but rather act just as if the question had just come over their office desk.

Far, far too many candidates opened their specifications with an introductory sentence as follows: "The present invention relates to trolleys, particularly to trolleys suitable for negotiating steps and kerbs."

Most trolleys have to do this one way or another; supermarket trolleys and prams by lifting or depressing the handle and two wheeled trolleys, as mentioned earlier, by using one wheel as the fulcrum for the other. An appropriate introduction, the Examiners believe, reads something like: "The present invention relates to trolleys, particularly to trolleys of the type known as porters' trolleys and having a frame with a base member orthogonal thereto and a pair of wheels whereby the trolley may be trundled around bearing a load."

As to the specific description the rule, which should not be forgotten, is that the description should be so full that the drawings are not necessary and merely aid in understanding. Rather a lot of candidates produced only a perfunctory description, relying on the drawings to speak almost entirely for themselves. Such an approach is not acceptable.

The Examiners were not particularly fussed at candidates electing to include a full description of the tri-lobal wheeled trolley. Some candidates simply had a general description of this piece of prior art in the preamble and did not include its drawing in the specification. On balance the Examiners thought the latter approach the more appropriate; it provided sufficient basis to discuss the merits of the invention.

Some candidates were rather free in discussing alternative constructions within their description of the principal embodiment. This is to be avoided where it reduces the specificity of that embodiment. The alternatives should be discussed in a separate paragraph or two, following the description of the operation of the principal embodiment.

A very small number of candidates allowed their imaginations to play a part, and suggested constructions and features which the client had not mentioned. The Examiners believe this entirely laudable and, given that they had also adequately covered the invention, such candidates were rewarded where their inclusions were realistic. Possibilities in this respect included that the "second wheel means" could have been detachable to serve as the "third" wheel means and that the trolley was constructed by being bolted together to make it suitable for the mail order/d.i.y market.

Candidates are once again reminded of the importance of attempting all those parts of the question for which a specific mark is available. Candidates omitting a part stack the odds very heavily against themselves. Also, whilst just sometimes a "note to the Examiner" can assist in interpretation, they don't actually earn marks as such, and the patent specification stands to be judged on its own merits - just as it will in prosecution and before the courts. Some candidates included notes lengthier than their answers. This was a waste of time.