

THE JOINT EXAMINATION BOARD

EXAMINERS' COMMENTS

PAPER P3

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

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Examiners' Comments

This paper was one of those to exercise the drafter's skill at producing independent claims. The **principal** three areas for such claims were apparatus, process and product. Quite a few candidates only selected **one or two of these, and even then many chose to make their** process claims dependent on their apparatus claim⁸ or *vice versa*. **One or two** candidates produced sets of claim⁸ to **striving** materials but even then did not cover each of the other three areas.

Very frequently candidates drafted a whole patent specification, **some** even including an Abstract. **This** was not what the Examiner⁸ had asked for and accordingly the **Examiners** did not look into the unrequested material to assist in determining whether a candidate should pass or fail. **By** contrast, one or two candidates who endeavoured to **limit** themselves to what was asked for **ran Out of time!**

One or two candidates rightly observed that there was novelty in both 'combing' liquid borne fibres and in **combing** fibres, which might have been "dry" with a vibrating comb. Some explained, rightly, that **given** that minimisation of fibre damage was also important, the more appropriate starting point was **combing liquid borne fibres**.

Many candidates limited the vibration in claim 1 to longitudinally of the channel forming means. **This** the **Examiners** deemed **a little on** the narrow **side**, and would have preferred that **specifying** the direction of vibration was relegated to a dependent claim.

Obviously, the Examiners believed that main claims to a screw thread were **excessively** narrow. Claims to 'means defining channels' were regarded as about ideal; the word "**bar**" also **begs** questions about alternatives, while "teeth" **are** also not as necessary as 'channels' **since** it is the latter that actually do the work. One or two candidates rightly developed the idea **which** might lie behind the **use** of a screw thread, namely a **faired** entrance to the channels,

One or two candidates rightly addressed the problem of **relative** motion; that is to say does the bed **move** past the channels or do the channels move along the bed? In the present case it would seem that motion of the bed was the preferred option.

Was it a necessary integer that the fibres be removed from the liquid, or the liquid from the fibres, or that the fibres, with or without liquid be removed from the bed? The liquid and or the bed could at some point in the development of the invention form part of the fibre **reinforced** product **and the** candidate would not have **been particularly** pleased with himself or herself when presented with either of these possibilities after second filing when thus far there was no reasonable support for such an embodiment.

One or two candidates **employed** the word "system" in their answers. Because "**system**" can **describe** both apparatus and method it is inexact and should be avoided,

A rather high proportion of candidates let themselves down badly, **i.e.** failed themselves, in their **specific** descriptions. A good specific description should:

1. be susceptible of understanding without the aid of the **drawings**;
2. **particularly where** there will be both process and apparatus claims, separate construction from mode of operation;

3. rarely include **alternatives** or the word 'preferably' in the description of any particular embodiment.

Good marks were going to be awarded for describing well apparatus, process and product embodiments.

A number of candidates made mention in "notes to the **Examiner**" that they would have to ensure that **metric** measurements were **used** throughout. The Examiners were not particularly fussed in this matter. **The** opportunity to do this would usually present itself **during** prosecution, **it is a** much more serious matter to open one's account with a narrow claim which **could** not be broadened and which the Agent did not **see** could have been broader. Similarly quite a few Candidates wrote a lot of notes to the **Examiner**. Generally candidates would do well to avoid this and let their specifications and claims speak for themselves.

Comment used to be made about the standard of handwriting and spelling. The Examiners **were** pleased to note no particular difficulty in reading scripts, and applauded the fact that most **candidates** wrote on alternate lines and, in many cases, started each **claim** on a new page,