

THE JOINT EXAMINATION BOARD

EXAMINERS' COMMENTS

PAPER P3

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

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P3 2000 EXAMINERS' COMMENTS

The main claim offered by most candidates this year should have been the subject of their claim 2, 3 or even 4. A good main claim was one to a device having (lobes) which were movable between a stowed configuration in which the device could enter and leave an opening and an extended configuration in which it could not. Subsidiary claims could then be drawn to pivotal attachment of the (lobes), pivotal attachment with the pivot axis transverse the device axis, and extension under gravity.

This approach would seem demanded in a question in which such detail is given of the prior art. Most candidates appeared to have made their starting point the client's device and not the prior art, with the client's device "on the horizon", and more or less claimed what they saw and not what they might be able to justify as an invention.

Granted there is little enough to go on to sustain the utility or sufficiency of the various realizations possible under such a broad claim, other than those closer to the inventor's example, but the next year, or subsequent prosecution, would deal with that, either by providing an example or by requiring a retreat.

Quite a few candidates provided method claims. These are not thought particularly necessary in this instance. "Use" claims however could be of value and one or two candidates presented quite useful ones. The claiming strategy of many candidates accordingly suggested that they were more interested in showing the Examiners that they could construct a method claim than that they appreciated what suitable claims might be in this instance.

Turning to the Specific Description, quite a few candidates, for reasons of time constraint or otherwise, simply pasted a copy of a part of the question to their answer. Now in the Specific Description the Examiners are looking for an assimilation of time honoured and internationally accepted presentation. The items of the specific embodiment should first be set out, numbered with reference to the drawings, and their spatial relationship described. Then, in a new paragraph, the *modus operandi* of the specific embodiment is described. In these two paragraphs care is to be taken to relate the specific embodiment to the Claims or the Preamble, but no alternatives to this embodiment should be suggested until a third section of the Specific Description. The question extract was decidedly not in this form. Moreover quite a lot of candidates did not obey the rules set out above.

As to the Preamble most candidates presented reasonably well precursors to their claims and arguments to demonstrate their novelty and indeed invention over the prior art. What seemed to give quite a few candidates difficulty was the opening paragraph. Was this a closure or a safety device without a context, or did the invention relate to liquid containers or pressurized containers? The Examiners suggest that this paragraph should fairly deliberately point in the direction of the invention and its likely field of use. "A safety device for a pressurized (liquid) container" was the term they preferred to see.