

THE JOINT EXAMINATION BOARD

PAPER P3

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

NOVEMBER, 2001

EXAMINERS* COMMENTS

P3 2001 EXAMINERS* COMMENTS

Claims

Imagine this conversation between a Patent Attorney and his balloon manufacturer client after the client has looked at the draft patent specification and claims:

Client: "I'm a bit puzzled. The first nine of these claims appear to me to cover your standard vehicle inner tube, and you don't mention a balloon as such until claim 13."

Attorney "Ah well, ..."

It is the view of the Examiners that extremely well known items do not have to be cited as prior art in question P3, and we would expect Candidates* papers to distinguish either altogether, or very early on, between the invention(s) the client is interested in and such very well known items. **The question is intended to be realistic to our practice.** Of course, if a candidate is aware of a particular piece of prior art — always assuming he*s not aware of a total anticipation - he may bring it to the attention of the Examiners in a note, and it shouldn't do him any harm. One candidate did this, noting that inflatable boats and footballs often included non-return valves. More about notes to the Examiners below. A lot of candidates presented a string of claims covering a tyre valve and an inner tube incorporating it.

In the case where your Client is a manufacturer, as in this question, the first objective has to be the protection of his operation. The possibility of his finding a licensee for various aspects of his patent is a secondary consideration, and one which he may never intend to bring into play. The very last thing you or he want to happen is for 13 months down the line him to come to you complaining that someone is stealing his business by getting around his patent claims, especially if they are doing so with a product every bit as good but cheaper to make.

If your patent covers a particular kind of valve, with a dependant claim to a balloon having that valve, **then you may be at risk of just this eventuality.** Only a very few candidates appreciated that one wall of the valve might be the balloon wall itself.

In these circumstances the Examiners believe that the wisest main claim is basically to **a balloon having a non-return valve**, and the few candidates who coined such a claim tended to sail through the paper. It may not have been claim 1. It may have been one of a plurality of independent item claims. In the present case the possibility of using independent item claims at this stage in the patenting process has to be a weapon in the attorney*s armoury.

Many candidates recognised that the valve could be made separately and supplied to a balloon manufacturer. A set of claims to a valve per se is useful to cover this possibility but unless accompanied by claims to a balloon were insufficient by themselves.

Most candidates clearly did not appreciate the full significance of the kink in the bonding of the valve walls. The Examiners have not been hard on the non-mechanicals taking the paper, and this point is made more for their general education. However, the paper does say that the kinking assists in holding the two valve walls together and it does not take much imagination to appreciate this. This feature implies that the valve might not rely exclusively on internal balloon pressure to close it, and the candidates who made balloon internal pressure causing closure of the valve a feature of their main claim in that way were considered to have one unnecessary restriction to that claim. Rather a lot of candidates mentioned the fact that the opening at the inner end of the valve was smaller than that at the outer than they did of the kink, and did not mention the kink in a claim.

It will be valuable and important to have claims relating to the kind of balloon and valve material and to the means, e.g. glues or heat seals, by which they are constructed.

Most candidates included method claims. A few included apparatus claims. Very few had both method and apparatus claims. As indicated above these, while useful and acceptable, were of secondary importance. The Examiners did however consider carefully whether the candidates who made method or apparatus claims their sole independent claims had passed the question on the basis of “product by process”.

Specific Description

Turning now to the Specific Description, there were quite a few candidates who used the words “preferably” and “may” in ways which showed they did not understand how “specific” the description should be. The Examiners expected to see a straight description of the principal embodiment in first “construction” then “use” terms, then preferably a similar discussion of method and apparatus examples, followed by any indications of alternatives which might clearly be there or have occurred to the candidate.

Many candidates used the wrong approach in the specific description by beginning with a detailed description of the valve and then explaining how it was incorporated in a balloon. The best answers opened by setting the scene with a general overview of the balloon construction, followed by a detailed description of the valve, operation of the valve as part of the balloon and an explanation of the manufacturing operation.

Many candidates also placed far too much reliance on the drawings to support a poor technical description. Candidates should remember that the specific description is not intended merely to clarify parts of the drawings, but instead should be a self-contained detailed description which is **complemented** by the drawings.

It should also be remembered that 20% of the available marks were apportioned to the description and that in several cases a good answer to this part of the question made the difference between a pass and a fail.

Abstract

In the Abstract, use of expressions such as “The present invention relates to... and “is described” is unnecessary. In the light of the discussion above about protecting the client*s business, the Examiners expected to see the word “balloon” in the Abstract. Often it was not there. Candidates should also pay attention to the length of the abstract. A lengthy abstract did not score highly.

Examination Technique

A few candidates presented a whole patent specification, including the “Preamble” before the “Specific Description”. This was surprising given that some candidates could not complete the answer asked for in the time. A Preamble was not asked for, and was accordingly not considered at all in marking the paper.

Most candidates appear to have heeded the advice given previously, to write on every other line and to write only one claim per page. This assists in legibility and gives the candidate space for repentance! The Examiners were perturbed at the one or two candidates whose spelling was atrocious. One cannot rely on the PC*s spell checker facility to see to all this and ours is a profession in which competence in the English language is cherished.

Notes to the Examiner

Turning again to “notes to the Examiner”, quite a few candidates presented in such notes the reasoning to their claims. Any notes should be **brief**. Candidates* time is generally spent far more productively in actually producing a better answer rather than justifying a poorer answer.

For very much the most part Candidates should understand that their claims and the other items asked for in the question will be considered on exclusively their own merits. One exception is the instance mentioned above - where the candidate is aware of prior art the Examiner has not cited - and the Examiners would still urge that the wisest way of dealing with such knowledge is to include both claims that cover such art and claims distinguished from it. The other exception goes: “Rats! I*ve two minutes left and I*ve realised that my main claim should be to a balloon having a non-return valve instead of what I have put!”

Now that *could* make the difference between failing and passing!

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