

Examiners' Report on Paper A/1991 (Electricity/Mechanics)

1. The exercise presented to candidates required them to draft claims and an introduction to the description for a single European application and, if they thought that any of the proposed claims should in fact be made the subject of a separate application, they were to indicate this, but "without further elaboration in this respect". It was clearly the wish of the client that protection should be sought for a device which was an improvement on the prior art anti-drooling arrangements known from Document I, which had been found in practice to have certain disadvantages. This should have provoked candidates to suggest a main claim along the lines of the one which was subsequently presented to them as Claim 1 in Paper B. However, there were certainly other possibilities and in principle any claim directed to a device as known from Document I, characterised by mechanical features not disclosed or suggested by that document, would be accepted as a good solution if the features of distinction were such as to contribute to the overcoming of the defects in the known device as pointed out in the client's letter.
2. A main claim, however ingeniously constructed, which would not give effective protection to what the client intended to have protected, lost marks for non-attention to the client's expressed wishes. Some of the claims proposed were much too broad (e.g. heating device comprising an inlet and an outlet for material, a melting chamber and a spring, but with no indication whatever as to the location or function of the spring, so that it was not really an adequate technical definition) or were in functional terms of such vagueness that the reader is informed only of the problem to which the invention is addressed but not of the means (or at least the principle) employed to solve the problem. Of course, it was correct to cast the claims as broadly as possible (e.g. it was not necessary to restrict to a glue gun or to the use of a helical spring) and also permissible to draft in functional terms (e.g. resilient means so disposed as to exert a return

force on the melting chamber). At the other extreme, candidates who put too many restrictions into the claim lost marks, particularly when such features really had nothing to do with the solution to the problem concerned. For example, claims essentially directed to the PTC heating aspect were sometimes unduly overloaded with features related solely to the mechanical structure of other parts of the device or vice versa.

3. The best candidates had noticed that the use of PTC resistors, arranged in a particular manner, was not of the essence as regards the basically mechanical solution to the problem but did at least give rise to the possibility of manufacturing the heater in cartridge form and the papers from the client specifically stated that such a cartridge could be made and sold separately. Thus, in accordance with the client's implied wishes, some attempt should have been made to obtain separate protection of this electrical aspect of the case, e.g. claiming that aspect independently. In that case, of course, the candidate would indicate that, because of Article 82, he would propose to make that claim the subject for a separate application. Candidates who made such a proposal were therefore evaluated as better than those candidates who did not. It is not recommended that candidates in Paper A should routinely propose the filing of multiple applications for different aspects: however, where - as in this year's test - there is a clear indication in the papers from the client that his device has a significant element which may be marketed separately from the rest of the device, a candidate should consider whether to try to claim that element independently.

4. Candidates should bear in mind that the appendant claims are expected to provide a fall-back position in case the main claim fails. Such sub-claims should, of course, be directed to significant further features of distinction from the given state of the art. Multiplicity of sub-claims to quite trivial features (such as a mere statement that there is a removable nozzle, without reference to the manner or purpose of the removability) are in practice of little value as a fall-back position and points were lost by some candidates for proposing very large numbers of claims to trivial features at the expense of, for example, a claim to the ribbed structure. Some candidates gave too little attention to the need to ensure a logical pattern of appendancy. Other candidates, whilst appreciating that the mechanical and electrical aspect could be claimed separately, presented no claim to both aspects in combination. However, that combination is certainly disclosed and could and should have been claimed. It is pointed out that EPO practice does not regard it as an offence against Article 82 to claim invention A in one application, independent invention B in another and the combination of A plus B in one or other (but, of course, not both) of those applications.
5. The instructions required candidates, in their introduction to the description, to provide support for all the claims. In this connection it is appropriate to define the problem solved by and/or the advantages provided by the subject-matter of the independent claim(s). Time should not, however, be given to any too elaborate discussion of the advantages of the features of the appendant claims.
6. If, as in the present exercise, it is felt appropriate to claim one aspect of the invention independently of another, but that Article 82 precludes this, then the candidate's best course is to propose a claim to the second aspect but state that he would in practice make it the subject of a separate application.

7. The committee members who mark the papers take great care to determine the wording proposed by candidates, but in some cases poor handwriting made this task extremely difficult. Attention is therefore drawn to paragraph 4.5 of the published general instructions to candidates, according to which "scripts that cannot be read cannot be marked".

EXAMINATION COMMITTEE I

Candidate's answer-paper No.

Report by examiner No.

FORM, for use by individual examiners, in PAPER A (Electricity/Mechanics)

Schedule of marks

Category	Maximum possible	Individual marks awarded	Where grades awarded are not identical	
			Revision of marks/grade (if any)	Remarks*
Claims: - Scope of protection = independent claim or claims = dependent claims - formal requirements	22			
	12			
	4			
Description: (Title, field and prior art, problem and/or discovery, solution and advantages)	10			
TOTAL	48			
CORRESPONDING GRADE				

Translation of marks into grades

	Grade
0 - 11	7
12 - 17	6
18 - 23	5
24 - 29	4
30 - 35	3
36 - 41	2
42 - 48	1

* to be filled in if both the following requirements are fulfilled:

(a) the grades awarded by the two individual examiners before their discussion differ by two grades or more;

(b) the marks awarded by at least one of the two individual examiners have been changed during their discussion.

If remarks are to be filled in, they should briefly explain **why** the examiner has changed his marks.