

Examiners' Report on Paper A/1992 (Electricity/Mechanics)

1. The task for candidates in this paper is to draft the claims and introductory part of the description of a patent application for the subject-matter presented in the letter of the client. The client's letter began with an acknowledgement of a known chandelier (Document I) comprising arms detachably mounted on a central support structure and it identified certain disadvantages of the known device. The client's stated object was to seek protection for an improved design of chandelier and the purpose of the improvement was indicated in a general way, namely to enable easier mounting of the arms onto the central support structure.
2. The instructions to candidates require the drafting of claims offering the broadest protection possible, so that it is at least conceivable to draft a main claim not restricted to chandeliers. On the other hand, a main claim directed to subject-matter not concerned with the ease-of-mounting aspect emphasised by the client, would be inconsistent with the client's express wishes. Hence what the candidate was expected to do was to draft a main claim based on Document I, expressing its main features in the broadest possible way, and to characterise the claim by the features of the improved design which facilitated mounting. Most candidates recognised that the horizontal direction of insertion of the electrical connector was the essential innovation in this respect. However, there are some difficulties in drafting a satisfactory broad claim to the horizontal insertion requirement. If it is first stated that the support structure has a vertical axis, the claim would protect the chandelier in its installed state but would not clearly cover the unassembled apparatus in the form in which it would be made and sold. On the other hand, if the claim does not state

that the support's axis is vertical, the requirement for a horizontal insertion of the electrical contacts carried by the arm is not an adequate distinction from the known Document I structure when lying on its side. These difficulties can be overcome by making it clear that the support structure has a defined axis which will become vertically oriented in the installed state and specifying that the direction of insertion of the electric contacts of the arm is perpendicular to the axis defined. A claim along the lines of Claim 1 as presented in Paper B would provide a possible solution.

3. Many candidates lost marks because, in an attempt to claim broadly, they failed to make an adequate distinction from the Document I device lying on its side. Others erred in the opposite direction by imposing quite superfluous restrictions on the claim (e.g. the support structure having a hollow stem, the arms having a particular type of hook-and-notch suspension means or the arms being provided with lamps - forgetting that the lamps as such have nothing to do with the invention and would in practice be provided separately).
4. The instructions to candidates required the drafting of claims for one application only but left open the possibility of proposing further claims to subject-matter which could become the subject of a separate application. Thus a candidate who considered that the particular form of connector proposed, suitable for distributing power to a plurality of outlets, could be protected in its own right, should have drafted a second independent claim for the connector per se and indicated that this would in practice be made the subject of a separate application. Credit was given to candidates who made such a proposal.

5. Generally speaking, a candidate is not required to provide notes in support of his solution but he may do so if (a) it appears relevant, and (b) the notes are brief. Where a second independent claim is presented a note is indeed appropriate in view of Article 82: such a note should refer to that article and either propose a separate application or indicate the reason why the requirement as to unity is not infringed by the second independent claim.
6. Another of the instructions to candidates is to assume that the given prior art is exhaustive and warns against using any special knowledge the candidate may have of the subject-matter of the invention. However, it should be borne in mind that general common knowledge does not fall into the category of "special". Some candidates, in attempting to claim the connector construction per se, defined it in such broad terms as to read onto a conventional domestic electric power socket. Such claims lost marks because they included within their scope a device which is manifestly not new.
7. As to dependent claims, the instructions state that they should be "so drafted as to enable you to fall back on them should the independent claim(s) fail". This means of course that if Claim 1 as proposed is subsequently objected to as lacking in novelty or in inventive step, then a feature which could overcome that objection would be derivable from the appendant claims.

Some candidates lost marks because of a tendency to write so-called "picture claims" - i.e. claims which are narrowly descriptive of the applicant's disclosed construction. Such claims would provide exceedingly restrictive protection and are considered valueless as regards the need to establish a

good fall-back position. The appendant claims presented to candidates in Paper B are considered to be at an appropriate level of generalisation. It is however emphasised that these particular dependent claims are not presented as a preferred solution to Paper A but as the starting point for the Paper B exercise.

8. All the above points are in explanation and amplification of matters which are explicitly mentioned in the instructions to candidates. The Examiners regretfully observe that many candidates did not seem to have read those instructions with sufficient care.
9. Other matters not specifically mentioned in the instructions also call for some comment. This is best done by enumerating certain faults which entailed loss of marks, namely:
 - (a) The claims as a whole did not provide protection for both of the embodiments described viz. the arrangement of Figs. 1 to 3 and the arrangement of Fig. 4.
 - (b) Both embodiments were claimed, each independent of the other, but the requirements of the Convention as to unity (Article 82) were not apparently considered.
 - (c) Either the locking means or the connector per se was claimed sufficiently broadly to cover its use in both embodiments (and possibly other contexts also) NOT as a second invention meriting separate protection but as the primary or even the only invention. This solution is in flat contradiction to the client's stated desire to protect primarily his chandelier as re-designed for easier mounting.

- (d) The description did not provide an adequate statement of invention. In European practice (as distinct from certain national practices) it is usually appropriate first to acknowledge a state of the art document disclosing the features of the first part of the two-part claim proposed, then to identify a problem not solved by the cited prior art and to present the claimed solution. Attention is drawn to Rule 27(1)(c) in this respect. Some candidates lost marks because they failed to identify the problem or the solution or both, others lost marks because, despite an acceptable presentation of a problem and its solution (e.g. identification of the disadvantages overcome by the invention), they did not take the trouble to ensure that the elements necessary to obtain the solution were in fact present in their claim. A discrepancy of this kind (the description implies that a certain feature is essential, whereas its absence from the main claim indicates that it is not essential) does not satisfactorily meet the requirement that the description provides support for the claims.
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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	24			
	14			
Description: (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.