

Examination Guidance

Knowledge and Experience for Final Diploma Examination FD3 Amendment of Specifications (P4)

Introduction

This guidance has been prepared to assist candidates in preparing for the PEB qualifying examinations. They are intended to identify the knowledge and experience candidates should attain prior to sitting the examination.

Different candidates will have widely different opportunities for training and gaining experience, depending on the pattern of work in their firms or companies. Using these guidelines will help candidates to identify areas where the knowledge and experience gained in the workplace will have to be supplemented through tutorials, seminars, training courses, private study or other means.

It is unlikely that candidates with less than three years' experience in the profession, including at least a year acting mainly on their own responsibility, will have sufficient experience to address this paper.

Overview

This examination is a test of the competence to respond to patentability objections by argument and amendment while ensuring that the patent claims remaining in an application (or proposed for a divisional application) not only meet the requirements for patentability (including e.g. clarity) and amendment but are still of commercial value to the applicant.

While the precise materials may change from year to year, typically the paper is made up of at least: one patent text, one office action, prior art documents or relevant extracts and instructions from the client or other indicating the commercial interest in the invention covered by the patent text. The time allowed for this paper is 3 hours.

Guidance

As part of their answer, candidates are expected to:

- (a) Amend Claim 1 to fix any errors and to address any concerns in the examination report or client letter;
- (b) Correct and expand the dependent claim set, if possible, to provide additional and useful fallback positions;
- (c) Propose an independent claim for a divisional application (if appropriate);

- (d) Prepare a response to the UKIPO that includes a summary of the basis for any amendments, a novelty analysis, and an inventive step analysis, and that deals with any other items specifically raised in the paper (e.g. extensions of time); and
- (e) Provide a memo to the client which **explains** the actions taken (not only describes what has been done), answers the client's questions, and (importantly) identifies any potential weaknesses in the response that the client should be aware of.

Candidates are expected to comment on the relevance of all documents to the patentability of the claims, whether this is in the response to the UKIPO or in the memo to the client. Either a Pozzoli/Windsurfing analysis or the EPO problem–solution approach to inventive step will gain marks but it is important that the candidates do not confuse the two approaches in their argumentation.

Prior to this examination candidates should:

1. Accumulate the appropriate level of knowledge and experience.
 - Responded to 30 official actions from the UK and/or European Patent Office
 - Reviewed, and responded to at least some of, 10 written opinions from an IPEA
 - If opportunity made available, considered and advised (client or supervising attorney) on amendment in preparation for or during European opposition proceedings on at least 1 occasion
 - Prepared and filed one or (preferably) more divisional applications
2. Have read the significant case law on novelty, inventive step, clarity and amendment issues (including the filing of divisionals) as indicated in the relevant sections of or as reported in:
 - Case Law of the Boards of Appeal of the European Patent Office
 - CIPA Black Book
 - Reports of Patent, Design and Trade Marks Cases
 - Official Journal of the European Patent Office
3. Be familiar with examination principles of novelty, inventive step, clarity and amendment (including the filing of divisionals) in the UK and European Patent Offices as indicated in:
 - The Patent Office Manual of Patent Practice
 - Guidelines for Examination in the European Patent Office

In particular candidates should be familiar with the tests used by the EPO and the UKIPO respectively when assessing inventive step and the exclusion of certain subject matter from patentability.

4. Be competent in drafting practice as examined in Paper FD2.

Feedback from Examiners

Examiners' comments for each past paper are available on the PEB website.

Candidates tend to perform adequately on:

- Assessment of novelty
- Relevance of publication dates in novelty & inventive step assessment

Candidates would benefit by giving more attention to:

- Practising arguments in support of inventive step
- Being alert to prosecution/amendment differences between UK and European practice (eg differences on extension procedures)
- Looking for the points in the question stated to be of practical importance to the client
- Setting time management for the paper such that enough time is allowed for the client report
- Ensuring that the client report provides a full explanation to the client of the action taken with particular attention to covering the areas of practical importance to client.

In particular, candidates who concentrate on the practical issues in the question tend to score good marks. Thus if a client needs the claims to cover a new product (his own or a third party product) on the market, but the relevant claims are worded too broadly for patentability, eg from the objections/prior art located by the Examiner, then the claim amendment(s) selected have both to be patentable (be clear; be novel; support a reasonable inventive step argument; not add subject matter, etc.) but ALSO still cover the product. Thus Candidates who move beyond merely identifying a difference, writing a response and just reporting the facts in isolation of what is important to the client, will gain more of the marks available in this paper than those who do not.

Since this paper tests skills in prosecution techniques geared to a commercially relevant situation, candidates need to ensure that their time management is good and allows adequate time to write a client report which indicates the steps taken; how the client's position is still protected; and the practical consequences of the position taken in response (eg if the amended claims might lead to a lack of unity objection, the client has to be advised that divisional costs may need to be borne in

the future if objection is raised and the client wishes to pursue all of the claims). Candidates can test for themselves by practising past papers whether they tend to spend too long on any one part of the answer and whether certain techniques will help to free time for the client report, eg reducing the time taken on the amendment section by only rewriting the claims that have been amended and marking the remainder as 'unchanged'.