

Paper E - Feb 2017 - Examiner's Comments

It is very important that candidates answer all questions and plan their time such that they can devote enough time to each question. It is appreciated that time is tight in this exam, but this only serves to reinforce that good time planning is essential. It is highly unlikely that a pass will be achieved without all questions being answered substantively. It was noted that a significant number of candidates this year passed the infringement question 1, but produced a very poor answer for validity, meaning that despite it being likely that the candidate has the skills to pass, there was not enough in their answer to do so.

A significant additional problem noted this year was that many candidates wasted significant time rewriting or summarising the question and/or explaining to the examiners what they were going to do. The examiners know what needs doing as they wrote the paper. There are absolutely no marks available for rewriting or summarising any part of the paper, nor indeed for setting out the legal tests that the candidate is applying. The marks in this question are for practical, accurate, sensible and logical application of the legal tests to the facts given.

Q1

It was expected that comment would be made on the following in respect of claim 1:

- a) 'a surface' – an unusual term in the circumstances. Covers framing? Interior or exterior surface (object clause says interior)?
- b) Order of method steps. As claimed. Does spec support any other order? Do all steps have to be performed concurrently, simultaneously, by the same person?
- c) 'securing', particularly regarding the layer of metal: covers temporarily holding in place by hand? Structural feature of claim, or method step to which purposive construction could be applied?
- d) 'layer' of metal – covers mesh (probably - see claim 2)? Covers plastic (probably not, even with a purposive construction)? Covers non-structural/non reinforcing aluminum foil (highly arguable using purposive construction – spec is not explicit about purpose of metal, but might have a structural/reinforcing purpose, and/or be a mesh to allow the first layer of plaster to secure the metal mesh to the underlying foam)?
- e) 'second layer' – an entire layer, or just part (probably the latter – purpose is to ensure a smooth finish)?
- f) 'applying a second layer' – when does this occur: after first layer dry? Before installation? Contributory infringement if supplied without 2nd layer?

For some claims, such as claims 5 and 6 for example, the facts presented were arguably insufficient to form a definitive view. This paper is intended to replicate the real world as far as possible and sensible candidates asked the client questions in this respect.

Contributory infringement, which is an explicit provision of the 2013 Act, was an important part of this question as Bob arguably was not fulfilling all method steps himself but arguably was supplying

essential elements of the invention. This is also commercially important because Bob's customers could also be infringers which is clearly undesirable.

Q2

D1 was highly relevant and arguably novelty destroying, depending on how the method steps of claim 1 were interpreted. A sketch of the D1 construction would have looked very similar to that of the product produced by claim 1, with a question as to when claim 1 required each method step to take place. There was also a question as to whether the final touch-up stage of D1 constituted application of a second layer as per the claims.

D2 disclosed metal fibre reinforcement but not a metal layer as claimed. D2 did disclose the concept of layering a wall lining with foam and 1st and 2nd outer layers and so was at least relevant to inventive step.

D3 was relevant and arguably novelty destroying. Because of claim 2, claim 1 would likely cover the metal layer being a mesh. Discussion was expected as to whether the overlapping wires of D3 constituted a mesh performing the same function as the metal layer of claim 1. Again, at the least this document was highly relevant to inventive step.

Other grounds as per Section 92 of the 2013 Act might have included:

- lack of clarity regarding 'surface' (does this cover the framing itself or a separate sheet element);
- support/lack of clarity regarding the difference between the scope of the object clause and the claims in respect of 'interior'; and
- whether or not the best mode was described – the specification is relatively brief, suggesting that perhaps this was not the case.
- Entitlement should always be questioned.

There was also a question as to possible prior use/prior secret use regarding the panel installed by Install Inc, depending on when this use first started.

D1 to D3 seemed to lead to quite an easy and strong lack of inventive step attack. The construction of D1 could be argued to be identical to that claimed, albeit with some of the method steps being used to form an initial panel, with subsequent method steps being applied later. D2 and D3 at the least disclose layering of plaster layers with foam, and arguably metal layer reinforcement in D3. All documents relate to the same field. Very few candidates made sensible or useful arguments here, and so lost significant marks.

Q3

There were no easy amendments here that appeared to be both valid and to catch Bob. This in itself is worth noting as it is commercially useful to the client. Marks were awarded for sensible suggestions that at least arguably did both. Claim 5 appeared novel, but investigation would be required to determine if this would catch Bob. Claim 6 also appeared novel, but is this really inventive (very likely standard practice)?

The question specifically asked what requirements need to be met for a post grant amendment – few candidates understood the requirements of s.85 and Regulation 87 and so lost easy marks.

Q4

Few candidates mentioned possible copyright in the franchise drawings, and indeed whether Bob had copied from those drawings or from the installed product. S.74 should also have been mentioned.

Q5

Easy marks were available in this question merely by summarising the infringement position for each variant, summarising the validity position, identifying all infringers, and outlining the possible routes for attacking a patent under the 2013 Act.