Examiner's comments 2017—Paper E

Unlike in previous years, the candidates couldn't readily be separated into those who understood the law/process and passed, and those who didn't. A significant number of candidates clearly understood what they were supposed to do, but gave incomplete answers or missed key issues and failed as a result. This is presumably due to poor time management, and is a real shame, as parts of these failing papers were done very well.

The main issues noted with this year's paper were as follows:

- As noted above, many candidates appear to have managed their time poorly. This is a perennial problem, which can be assisted by attempting multiple practice papers under exam conditions.

- One consequence of poor time management is that many candidates didn't have time for the relatively easy last two questions in the paper. These could have netted candidates valuable marks.

- This paper had several marks available for invalidity grounds relating to specification requirements such as utility, lack of support, and clear/complete enough disclosure. Almost without exception the candidates missed these issues. In most cases these should have been easy marks for candidates—for example, marks were available for noting that the consistory clause for claim 1 referred to cutaway portion, but claim 1 didn't. Candidates should always review consistory clauses against the claims, and check for compliance with object statements.

- Many candidates only looked at infringement/validity of claim 1. Although this was where the bulk of the marks lay, candidates missed valuable marks by not dealing with all the dependent claims. A common characteristic of the passing papers was that the candidates had attempted every question, and commented on every claim, even if only briefly. A note on this—no marks will be given for a claim chart that just has ticks and crosses for infringement/validity of dependent claims. Claim charts are fine as a summary, but must be backed up with analysis.

- Dependent claims must be considered in the alternative. No marks were given where a candidate concluded that a dependent claim was novel and inventive because the independent claim was, or a dependent claim wasn't infringed because the independent claim wasn't infringed.

- Some candidates wasted valuable time reciting the law, or setting out preliminary steps that would be undertaken in practice (conflict checks, FTO searches etc). While these matters are obviously important in a real life situation, candidates should leave them until the end and mention them only if they have time, as they are not worth any significant marks. While nominal marks may be given for knowing what the relevant cases are and how they are relevant, the real marks are given for applying the law to the scenario.

- Almost every candidate discussed mosaicing the two prior art documents, but only a few appear to understand how mosaicing works. Arguably, until we have a judgment from the High Court stating otherwise, the applicable law on mosaicing for inventive step is the line of UK decisions following on from *Technograph Printed Circuits Ltd v Mills & Rockley (Electronics) Ltd* [1972] RPC 346 which held that:

'[I]t is permissible to make a "mosaic" out of the relevant documents, but it must be a mosaic which can be put together by an unimaginative man with no inventive capacity.'

That is—you can only mosaic prior art documents together when you can prove that's what the (non-inventive) skilled person would do. Mosaicing documents for inventive step remains very rare in practice in patent contentious cases in New Zealand. If candidates want to mosaic prior art documents, they need to support this with a statement of the applicable law and a reasoned argument as to why the documents would be read together by the skilled person.

- Just a minor gripe—some candidates used acronyms generously throughout their papers, obviously to save time. This is fine, but candidates should define any acronyms or abbreviations at the beginning of their answer to assist whoever is marking the paper. For example, examiners who are not familiar with US patent law will likely not have any idea who the PHOSITA is (thank goodness for Google…).