

ANSWER GUIDELINES TO QE 2015 PAPER B

Note: The answer guidelines contain a non-exhaustive list of points that examiners expect candidates to cover in the answer to this Paper.

S/N	Category	Mark
1	Claim Amendments	35m
2	Response	35m
3	Letter to Client	30m

S/N	Answer Guide	Mark
1	Claim Amendments (35m)	
1.1	Present an amended claim 1	1m
1.2	Amended claim 1 does not merely append any of the original dependent claims but includes a substantive feature from within description	2m
1.3	Amended claim 1	17m
	<p>a) <u>Embodiment 2 amendments – adhesive stopper with integrated adhesive reservoir</u> To achieve full marks, incorporate</p> <ul style="list-style-type: none"> - claim 2,3,10 and - amend along the lines of FIG. 4 and FIG. 5 <p>e.g. “adhesive stopper comprises an assembly of an adhesive stopper 5 having an integrated reservoir of heat activated adhesive 32 and a releasable threaded rod 4.”</p> <p>Deductions Minus up to 8 marks for over broad or over narrow amendments to Claim 1:</p> <ul style="list-style-type: none"> - Over broad to the point of being unsupported e.g. Adhesive stopper with adhesive reservoir without releasable threaded rod – not supported , sole embodiment disclosed in the description requires a threaded rod , no other mechanisms described : - 3 - Over narrow, e.g. addition of other dependent claim features e.g. protruding ribs, articulated feet 	

	<p>A proportion of the marks may be awarded to candidates who presented an amendment based upon a combination of claims 2, 10 or 2, 3, 10 without integrated adhesive reservoir. The number of marks awarded depended on whether the candidate provided a reasoned argument in support of their amendment and/or whether they included a dependent claim(s) that included the features of FIG. 4 and FIG. 5</p> <p>No marks for: Any amendment to Claim 1 that does not achieve at least novelty over D1 or D2, or if no amendments are presented.</p> <p>b) <u>Embodiment 1 or other amendments</u> No marks for: Mere incorporation of dependent claims 4-9, 11 in any combination with argumentation against lack of inventive step since the features are disclosed / suggested by D1 and D2.</p> <p>Max 3 marks (due to the fact that these features are disclosed/suggested in D1): For adopting client's suggestion to include:</p> <ul style="list-style-type: none"> - there are grooves on our puller to enable lateral displacement of the supports - a wing nut to tighten the adaptor to the puller <p>c) <u>Any other possible solution</u> Amendments incorporating any supported feature that is also novel & inventive may get full marks at marker's discretion.</p>	
1.4	<p>Addition of new claims per client instructions(12 marks) and fixing clarity issues (3 marks):</p> <ul style="list-style-type: none"> - there are grooves on our puller to enable lateral displacement of the supports : 1 mark - a wing nut to tighten the adaptor to the puller : 1 mark - Independent claim for adhesive cartridges per FIG. 4, 5 : 5 marks - Independent claim for method of repair: 5 marks <p>Method claim relying on light reflection (either a) or b) below may get full marks under this section):</p> <p>a) Broad method claim not limited to that carried out by the dent puller of claim 1 set out in a divisional application; to get full marks, candidate needs to advise in the client letter the pros</p>	15m

	<p>and cons presented by this approach e.g. broad claim but additional costs, prior art to be considered ; in the absence of advice, maximum 3 marks</p> <p>b) Limited method claim coupled to the dent puller of claim 1 hence no need for divisional ; to get full marks, candidate needs to advise in the client letter the pros and cons presented by this approach e.g. narrower claim, but avoid further costs by achieving unity of invention; in the absence of advice, maximum 3 marks</p> <p>- Antecedent clarity issues: 3 marks :</p> <p>Claim 5 is unclear because the term “bridge” is not supported in the description. (1 mark)</p> <p>Claims 8 to 10 are unclear because there is no antecedent basis for the claimed features in claim 1 from which claims 8 to 10 depend. (1 mark if all corrected, else 0.5 marks)</p> <p>Claim 11 is unclear as the claimed feature is not supported in the description or drawings. (1 mark)</p> <p>Deductions Hot melt adhesives formulation given by client (new subject matter) deduct 3 marks if candidate includes it.</p>	
2	Response (35m)	
2.1	<p>Support</p> <p>Point out literal support for each amendment under 1.3 and 1.4 : 4 marks for Claim 1 set, 1 mark each for new independent claims</p>	6m
2.2	<p>Novelty of amended claim 1</p> <p>Answer needs to state</p> <ul style="list-style-type: none"> - The novelty-giving feature (1) - The absence of such features in each of D1 (2) , D2 (2) - Dependent claims are accordingly novel (1) <ul style="list-style-type: none"> • Answers based on Embodiment 2: full marks possible • Answers based on novel dependent claims or other novel 	7m

	<p>features: 3 marks max</p> <ul style="list-style-type: none"> Answers based on non-novel dependent claims: 0 marks 	
2.3	<p>Novelty new independent claims: D1, D2 Adhesive cartridge: 2.5 marks Method : 2.5 marks</p>	5m
2.4	<p>Inventive step Amended claim 1</p> <p>Answer needs to state:</p> <ul style="list-style-type: none"> Inventiveness over each of D1(3), D2(3) and D1, D2 in combination (4) Problem solution or Windsurfer approach are both accepted – approach must be applied and full analysis provided <ul style="list-style-type: none"> ➤ Full marks against each document given only if reasoned explanation is given of (a) new technical advantages accorded by novel/inventive feature, (b) why it is to be considered there is absence of teachings or teachings away based on the prior art documents. ➤ No marks for “amended Claim is neither taught nor suggested” without further substantiation <p>Inventiveness of the rest of dependent claims based on an inventive amended claim 1 : 1 mark)</p> <ul style="list-style-type: none"> Answers based on Embodiment 2: full marks possible Answers based on newly added features not in dependent claims: 5 marks max Answers based on non-inventive dependent claims: 0 marks 	11m
2.5	<p>Inventive step new independent claims D1, D2 , D1+D2 Adhesive cartridge: 3 marks Method : 2 marks</p>	5m
2.6	<p>Clarity & support issues Statement about the amendments made to resolve examiner’s objection</p>	1m
3	Letter to Client (30m)	
3.1	<p>Explain the Office Action, e.g. the need to file a response, the relevance of D1 and D2 : date for filing a response (2 marks) and technical content of examiner’s objections (2 marks),</p>	5m

	Act/Rules provisions for responding (1 mark)	
3.2	Explain reasons for needing to fix clarity, support issues	2m
3.3	<p>Explain inability of the two client suggested features to achieve patentability on their own, hence not in amended claim 1</p> <ul style="list-style-type: none"> - there are grooves on our puller to enable lateral displacement of the supports (found in D1, “leg 36 is slidably attached towards each end of bridge bar 10”) - a wing nut to tighten the adaptor to the puller (found in D1 as part 28) 	2m
3.4	Explain the patentability in relation to amended Claim 1 as proposed	2m
3.5	<p>“Other than selling the puller-and-adaptor device, we are also hoping to sell consumables in the form of adhesive cartridges – it would bring customers back to us regularly if they want our proprietary adhesive. I notice the claims didn’t talk about this as well – clearly I need protection for the adhesive cartridges, independently of the puller-and-adaptor.”</p> <ul style="list-style-type: none"> - Present new independent claim for adhesive cartridge - Explain limitations on the scope of added independent claim - limited to FIG. 4 	6m
3.6	<p>“Regarding adhesives: our lab has now worked out an outstanding hot melt adhesive formulation: 40–50% of EVA copolymer for good strength, 20–30% of tackifier resin, and 20–30% of paraffin wax. Please ensure that we claim this as well”</p> <ul style="list-style-type: none"> - Explain inability to add new subject matter at this stage. - Suggestion protecting the adhesive formulation in a new application 	4m
3.7	<p>“In recent months, we have been in discussions with mechanic shops and to our surprise, they are keen to become licensed repair shops that utilize our method of repair based on our puller-and-adaptor device, in consideration of a small annual fee, which in all honesty is a miniscule sum in comparison to the potential number of puller-and-adaptor and adhesive cartridges I can sell, but imagine the publicity it can generate for us. It will be excellent if we could include claims that we can license under such a business model. We mentioned this possibility to the</p>	7m

	<p>previous patent attorney, about the use of LED lighting to cast a reflected image on the dent during repair, but evidently he didn't claim that as well.</p> <ul style="list-style-type: none"> - Explain the new independent method claim; - referencing 1.4: <ul style="list-style-type: none"> a) For broad method claim not limited to that carried out by the dent puller of claim 1 set out in a divisional application <ul style="list-style-type: none"> - candidate needs to advise in the client letter the pros and cons presented by this approach e.g. broad claim but additional costs, prior art to be considered ; in the absence of advice, maximum 3 marks b) For narrow method claim coupled to the dent puller of claim 1 hence no need for divisional - candidate needs to advise in the client letter the pros and cons presented by this approach e.g. narrower claim, but avoid further costs by achieving unity of invention; in the absence of advice, maximum 3 marks - General discussion about the licensing prospects of such a method claim 	
3.8	2 additional marks for any other valid point presented in the client letter.	2m
Total marks		100m

End