

**PROFESSIONAL STANDARDS BOARD FOR PATENT &
TRADEMARKS ATTORNEYS**

EXAMINATION FOR REGISTRATION AS A PATENT ATTORNEY

**TOPIC GROUP H, OCTOBER 2001
INTERPRETATION AND VALIDITY OF PATENT SPECIFICATIONS**

GENERAL REPORT

Extensive introductory comments have been provided in the General Report to candidates in the last 3 years, and it is strongly recommended by the Examiners that candidates who failed this year do read those as well as this Report since many of the general issues raised previously continue to be troublesome.

Candidates are reminded to read the question paper and accompanying documents thoroughly and carefully, and to highlight in some way issues which they think may become relevant in answering the paper. In this way important issues will hopefully not be overlooked. Additionally, this may help to identify issues which are not relevant. For example, although fastening means were claimed in X, nothing turned on this feature of claim 1 and minimal time needed to be spent on it. Given that much of B was taken up with details of the fastening means, valuable reading time could be saved by the early knowledge that the fastening means were not relevant to the interpretation of X.

A disappointing number of candidates also failed to identify all the possible CGK, immediately losing easily gained marks. Thus, too few candidates identified previous versions of hairclips as possible CGK. Both the client and X suggest they may be. X also highlights the use of rubber gloves – could this be CGK? If so, could it be relevant to the obviousness of the invention? Once hairclips generally have been identified as possible CGK, the obviousness question can potentially be asked in the light of the combination with A, giving the best possible chance, in the eyes of the Examiners, of invalidating claim 1 of X for lack of inventive step. Clearly, considerable further information would be required from the client or another PSA on the prior art hairclips to establish this argument, but candidates were reminded in the question paper that if they considered further information would be required to deal with an issue, they should explain so in their answer.

Candidates were also reminded in the question paper that marks are awarded more for the points selected for discussion and the reasoning displayed than the conclusions reached. However, a few still attempt to deal quickly with the prior art and infringement considerations by merely "ticking and crossing" whether features of the claims are present. Candidates must explain why features are considered to be or not be present, and often they will need to have carefully construed the meaning of features of the claims in order for their explanation to make sense.

The construction of the claims – ie. what do the claims encompass and exclude – is fundamental to the validity and the infringement exercise, yet candidates continue to have difficulties selecting issues for consideration and interpretation, and regularly fail to discuss opposing views to their own so do not reason their way to a sound conclusion. An important way of identifying at least some of the terms or phrases of the claims that will need construing is to have in mind the prior art and the infringement, as already discussed in relation to the fastening means.

Finally in this general discussion, candidates are reminded to write their answers clearly and to leave sufficient time to check their answers.

A detailed commentary on the paper follows in the hope, once again, that it will help candidates in the future to better identify the type of issues which need to be discussed when considering the validity and infringement of a patent. It is emphasised that this commentary is not a model answer – there is very seldom only one way of dealing with an issue in the work of a Patent Attorney. It is also emphasised that not every point highlighted in the commentary needed to be identified in order to pass the exam, but candidates must show the Examiners that they have an acceptable understanding of the law on validity and infringement and an acceptable ability to apply the law.

The Invention

Many candidates began their answers by identifying the field of the invention and those whom they considered could be persons skilled in the art (PSA). This is considered to be a

good approach given the importance of the PSA in many aspects of the validity and infringement exercises, and generally the PSA was characterised quite well.

However, several candidates failed to consider whether a hairdresser/stylist such as the client could be a PSA. The question paper clearly hinted that the client could be a PSA, although her inventiveness might present a problem to the Court given the simplicity of the subject matter of X.

Other candidates only mentioned the possibility of hairdressers/stylists being PSA, and did not consider whether a suitably experienced designer/manufacturer could fulfill the role.

One advantage of identifying at least a hairdresser/stylist as a PSA is the enhanced possibility of introducing the use of rubber gloves, as referred to in X, as CGK.

The discussion of the background to the invention was dealt with reasonably well by most candidates, although several failed to mention the involvement of rubber gloves in the invention, either as part of the background discussion or as part of the solution.

Most candidates made a reasonably good effort to ascertain what the invention is from the description. This and a proper analysis of the main claim are an integral part of the Section 40 consideration whether the claim defines the invention, ie is it fairly based. Several candidates analysed the description only under their Section 40 discussion. No distinction was made between these two approaches in marking the answer papers, provided the issues were properly covered.

The question in the description is whether the invention can be "a clip using rubber inserts on the clasp to secure the hair" as described at page 1, line 16 of X, or whether the object statements on page 2, the paragraph bridging pages 1 and 2 of X and other statements in X mean the invention must be considered to be much more restricted.

The suggestion that the invention is a clip using rubber inserts on the clasp to secure the hair, combined with the description of hair clips of the type with which the invention is concerned in the paragraph at page 1, lines 21-25, corresponds very broadly to the scope of claim 1, and

an argument can certainly be made that this provides the solution sought by the inventor and is the scope of the invention. Several candidates adopted this approach, and this was acceptable to the Examiners provided proper arguments were presented as to why the object clauses and other statements in X tending to narrow the invention should be disregarded.

However, in the eyes of the Examiners, the statement at page 1, line 27 of X that "specifically, the invention is directed to...", combined with the object clauses, make a relatively strong argument that the invention should be considered more narrowly. The question is, how narrowly?

There are six object clauses on page 2 of X, but the majority of these either will be met even if the invention is considered to be only rubber inserts on the clasp or are too general to assist in defining the invention. Only the object of providing a hair clip having an alternating sequence of rubber teeth which are in an interlocking mating relationship when the clip is in a closed position provides any real guidance, and this object had to be dealt with if the invention were argued to be merely the rubber inserts.

If the invention is construed as narrower than the rubber inserts, this one object clause can be used to help distinguish between the essential and inessential features in the paragraph bridging pages 1 and 2 of X. Thus, on this interpretation, the invention might be considered as a hair clip of the type defined in the paragraph at page 1, lines 21-26 of X, additionally having an alternating or staggered sequence of rubber teeth located at the inner surface of each metal clamping arm for more securely holding the hair strands between the clamping arms when the hair clip is in a closed position, the rubber teeth defining an interlocking mating relationship with each other when the hairclip is moved to the closed position. However, consideration must also be taken of the remainder of the description of X in defining the invention. From this, it is suggested at page 4, lines 1-2 of X, that the metal material of the arms may only be preferable. Many candidates concluded that metal arms were essential to the invention, without noting page 4, lines 1 and 2, but then failed to consider that none of the claims is fairly based in not defining this feature.

There is also a statement at page 3, lines 29-31 that the teeth may be constructed of any resilient rubber-like material, and some discussion is required as to whether rubber is an

essential feature in the light of this. If not, a conclusion needed to be reached as to how broad the material of the teeth could be. The better candidates dealt with this by considering the requirements for resilience and non-slip of the hair.

The statement at page 3, lines 29-31 goes on to make clear that the teeth may assume any desired undulating configuration, and from this it is clear that provided they still define the interlocking mating relationship in the closed position, the teeth do not need to "run at right angles to the length of each clamping arm" (from the paragraph bridging pages 1 and 2).

Once again, the better candidates noted from page 2, line 21 that although the drawings illustrate a preferred embodiment, the statement at page 3, lines 3-7 may further help in concluding what is the scope of the invention.

Construction Issues

The whole point of this part of the exercise is to determine what is the scope of the claims so as to enable conclusions to be reached on the validity and infringement issues.

Many candidates wasted a considerable amount of time, and tended to show they were not really on top of the issues, by analysing every term in claim 1. Candidates must show to the Examiners that they are able to pick out issues which are relevant to the overall consideration of the validity and infringement of the claims, analyse those issues appropriately and come to a reasonable conclusion. Once again, to do this, it is necessary to not only pick out ambiguous terms in the claims, but also to have in mind what the alleged infringement is and what the prior art discloses.

A clear example of this is the introductory term "hairclip" in the claims. The term would not need considering if all the prior art and infringement were clearly directed to hairclips of the type described in the background to X. However, prior art specification A is clearly not directed to a hairclip of this type, but to a hair clamp for use in straightening hair. Your client should be able to give some indication of whether the term hairclip could be construed to encompass the hair clamp of A, but, on the face of it, it does not. Only one candidate noted this issue.

The phrase "a pair of elongated curvilinear clamping arms" in clause (a) of claim 1 produced a surprising variation in interpretation. Looked at overall, the clamping arms clearly have a hinge of some sort at one end and a fastening means at the other end, and these ends may be considered to define the length of the arms. Elongated means that the arms are at least longer than they are wide, and the longer dimension is therefore from one end to the other end. A clear interpretation of this is needed in the light of A. The description could be used to help construe the arguably unclear requirement for the arms to be curvilinear. The term is only used in the detailed description, and the drawings clearly show that the only curve is along the length of the arms. This feature is also described at page 5, lines 4 and 5 with the hair strands described as being "disposed transversely to the longitudinal arc of the curvilinear clamping arms".

The phrase "oppositely disposed curvilinear inner surfaces" also presented considerable difficulty for many candidates. The inner surfaces of the arms are clearly those which would be contacted by the hair but for the resilient strip formation on each, and there is no reason to construe curvilinear any differently to the previous interpretation. Oppositely disposed inner surfaces would seem to merely mean that the inner surfaces generally face each other to receive the hair between them (as defined later in clause (a)), but several candidates concluded after such analysis that "oppositely disposed curvilinear inner surfaces" must mean either that one inner surface is concave and the other convex, or that both inner surfaces are concave without noting that both of these interpretations fall foul of claim 4. In both cases claim 4 would be redundant, in the first case because the feature has already been claimed in claim 1, and in the second case because the feature of claim 4 is excluded by claim 1.

On the face of it, the requirement for the pair of clamping arms to be "hinged together at one end thereof and being movable..." is clear. However, some consideration of the term "hinged together" is required in the light of A and Y. Many candidates made the mistake of simply looking up "hinged" in the nearest dictionary and simply stating that the phrase means that the arms are pivoted together about a point. This is certainly true of the preferred embodiment, as described at page 4, lines 8-10. However, page 4, lines 10-12 go on to say that "it should be understood that any suitable hinge mechanism may be used with the hairclip and still fall within the scope of the present invention."

The issue with Y is of course that the flexible band 16 does not restrict the movement of the clamping arms 12 and 14 to pivoting motion about a point. This could be argued to mean that hair cannot be clamped in the hairclip of Y in the same way as X, and a conclusion must therefore be reached on exactly what "hinged together" in claim 1 means. The Examiners did not distinguish between those candidates who referred to the various statements in the description and concluded that "hinged together" merely means that some arrangement was required which permitted the arms to be moved between the first and second positions, and those candidates who concluded that the hinge must be such as to provide the desired securing of fine hair and thereby prevent the arms moving apart at the one end. However, the issue was considered important by the Examiners and needed to be considered at length, with consistency being maintained, particularly in the consideration of Y.

The statement at page 4, lines 24-26 that the described hinge and fastening means are well known in the prior art and per se form no part of the instant invention are relevant to the discussion of the hinge and, more especially, the fastening means. Unless the term fastening means is construed narrowly, incorrectly in the eyes of the Examiners, in such a way as to exclude the fasteners in A, nothing turned on clause (b) of claim 1 and minimal time needed to be spent on it.

"Resilient strip formation" in clause (c) of claim 1 clearly did need considerable analysis, since it raises not only Section 40 issues but also prior art and infringement issues. The term "resilient" was generally dealt with quite well as meaning that the strip formation has a degree of give and rebound, but few candidates went on to thoroughly consider the "strip formation on" each of the inner surfaces. The better candidates concluded after considering the various options that this merely required the inner surfaces to each have a formation on them which has the overall shape of a strip, ie the formation is longer than it is wide. This is supported by the requirement for the formation to extend for substantially the distance between the one and opposite ends of the arms.

Finally on claim 1, those candidates who construed "comprising" generally did so well, using a pragmatic approach which allows other features to be included within the claim.

Turning to the dependent claims, candidates should always remember to look at the claim dependencies to ensure they are correct.

In claim 2, the resilient strip formation of claim 1 is defined quite narrowly. Some interpretation of the claim was required in order to clarify whether or not Y falls within the additional features of the claim. The main issue is "transversely extending" which to the Examiners clearly means that the teeth have some extent across the width of the strip of the resilient strip formation and across the width of the arms. Although only one resilient strip formation is referred to in claim 2, it is clear from claim 1 that this is the respective resilient strip formation on each clamping arm. Another issue is the requirement for the linear sloping sides of the teeth to be "extending from" the curvilinear inner surfaces. This feature is not shown literally in the described embodiment and it is therefore better, if possible, to construe the phrase as meaning extending away from. Only one candidate noted this.

It is difficult to see how the defined shapes of the teeth can provide the even tension on strands of hair engaged between the teeth when the clip is closed, unless the opposed teeth are in an interlocking mated relationship, but this feature is claimed in claim 3 and is therefore optional in claim 2. Nevertheless, an overall understanding of what is claimed in claim 2 must be reached since it seems unlikely that the shape of the teeth in Y will provide the same even tension on strands of hair even if those teeth do interlock. Some guidance on this might be required from the client.

In claim 3 there is clearly a dependency issue since the teeth are not defined in claim 1. Most candidates correctly concluded that the staggering of the teeth and the interlocking mating relationship is as between the teeth on the opposed resilient strip formations. The interlocking mating relationship clearly requires the apices of the teeth on one of the resilient strip formations to be closely received between the linear sloping sides of the teeth on the other resilient strip formation.

It is not clear why claim 4 is only dependent from claim 1 or claim 2, but most candidates had no difficulty in understanding the opposite curvature of the arms defined in the claim, ie that the upper arm is outwardly bound to the shape of the head, and that the lower arm is inwardly

bound. The better candidates noted that "the upper arm" would be readily construed by the PSA as the arm further away from the head.

Many candidates overlooked the dependency problems in claim 5, given that the teeth are only defined in claim 2. Most candidates had little problem construing the claim as requiring the teeth to be constructed of any resilient rubber-like material as described at page 3, line 30 of X, provided that rubber-like material resisted sliding of the hair through the closed clip.

Claim 6 is an omnibus claim which presented the usual range of interpretations. Of these, the interpretation that the hairclip must be as shown in the drawings is considered by the Examiners to be too narrow and wrong. A better approach is considered to be that the essential features of the hairclip, as defined in claim 1, are substantially as described with reference to the drawings.

Section 40

The issue of whether claim 1 defines the invention or is fairly based has already been covered in the discussion on the invention, but there is then the issue of whether of the subsidiary claims define the invention. Assuming the invention was identified from the description as a hairclip of the type described at page 1, lines 21 to 25 having teeth of a rubber-like material on each of the clamping arms which are in an interlocking mating relationship when the clip is closed, only dependent claim 5 could be fairly based, when it is dependent from claims 3, 2 and 1. Claim 6 is clearly fairly based.

Also to be considered is the question of whether each of the features claimed is disclosed in the description, and a discussion of the lack of disclosure of the resilient strip formation is required here. Also worth noting from claim 1 is that the feature of the resilient strip formations extending for substantially the distance between the hinged end of the clamping arms and the fastening means is only implicit in the drawings.

As noted above, the question may also be asked as to whether the even tension required by claim 2 can be achieved if the interlocking mating relationship of claim 3 is not provided. This is a problem for claim 2 on its own, which would of course be resolved if claim 1 were

amended to include the subject matter of claims 2, 3 and 5 in order to overcome the fair basis problem. Most candidates correctly dealt with the clarity problem in claim 4 concerning the antecedence for the "the upper arm", and the majority also dealt with the claim dependency problems which have already been noted.

A few candidates also correctly noted that there was no real basis for questioning other aspects of Section 40, including sufficiency, and whether the best method of performing the invention is described in X. Once again, utility was incorrectly raised by one candidate as a Section 40 issue.

Novelty

As an introductory issue, the Examiners recommend that candidates make clear in their answers that they are using the reverse infringement test to consider novelty issues since this is not always apparent from the answers. It should also be confirmed that the prior art documents were indeed published before the relevant priority date of the claims in X.

All possible documents and uses relevant to the novelty of X must also be identified. Thus, in X the inventor makes clear that she used a hairclip with rubber inserts on the clasp in the hair of her daughter before the filing date of X. Very few candidates questioned whether this might be a prejudicial prior use, although, from its style, it appears the specification may have been drafted in the USA in which case it is probable that the experimental use was also in the USA and therefore not relevant to validity in Australia, at least under the current law.

As noted already, A is directed to a hair clamp in which the full length of the hair is intended to be constrained within the clamp, or two or more superposed clamps, to straighten the hair. This is an entirely different function to the hairclip of X, and it must therefore be questionable whether the hair clamp of A could be considered as a hairclip. Evidence on this would be required from the PSA, but in the meantime the client should be questioned on it.

Nevertheless, candidates should not exclude the potential relevance of A merely on this basis, but should be go on to consider other aspects of the disclosure. A particular issue, which was overlooked by many candidates, is whether A discloses elongate curvilinear clamping arms,

each having the resilient strip formation on its inner surface. The issue here is clearly whether the clamping arms are elongate between the hinged end and the fastening end and whether the foam or rubber liner on each arm is in the form of a strip. Particularly in view of the different shapes illustrated in A for essentially the same embodiments, there is certainly some doubt as to whether A provides a clear and unambiguous signpost to the elongate and strip shapes.

Some candidates also correctly questioned whether the hair clamp in A has "arms" for securing the hair, and most candidates picked up the suggestion in the specification that the liner may be made of rubber to improve its ability to grip hair.

Most candidates had no difficulty with the hinge and fastening means in A, but a few were caught out by the suggestion that "the bottom of the device is somewhat concavely curved while the top is convexly curved". Although this statement on page 2 of A was clarified in the subsequent statements, those candidates failed to understand that the curvature referred to is of the end surface of the clamps, as clearly shown in Figure 2, not along the length of the arms.

Candidates were about evenly divided as to whether A shows the defined curvature of claim 4 in X. All the candidates correctly noted with regard to claims 2, 3, 5 and 6 in X that there is no suggestion of any teeth in A.

Turning to B, this clearly does disclose a hairclip of the type described at page 1, lines 21-25 of X. So B clearly has all of the features of clauses (a) and (b) of claim 1, but some discussion was required in relation to clause (c). The holder bar 73 is arguably a strip formation, but there is no suggestion of a strip formation on the arm 20 in B, and no suggestion that the holder bar 73 is resilient. On this basis, most candidates correctly concluded that B does not anticipate claim 1 of X. However, very few candidates noted the client's advice that the hairclip of B might have been on the market in Australia before the priority date of X so that it should also be considered from the point of view of a prior use. Probably, any analysis of such a prior use would come to the same conclusion as in relation to B, but it would give you as the client's adviser the opportunity to confirm that there is no resilient strip formation on each of the clamping arms.

The hairclip of B clearly has the arm curvature of claim 4, but it does not disclose teeth on both arms, and certainly not teeth of the type defined in the subsidiary claims.

Inventive Step

Once again, few candidates showed that they have a clear knowledge of the law of inventive step, and particularly of how to apply it. This continues to be a difficult area for candidates.

Of those who do seem to have some understanding of the law and how to apply it, some do themselves no favours by not considering all of the claims, particularly claim 1 when it has been found to be not novel. It must be recalled that the aim of this examination is to show the Examiners that candidates have the ability to apply the law. If candidates opt not to show this ability, they cannot be assessed on the issue. Even if candidates are clearly correct on the issue of novelty, clients generally want to know every avenue by which a patent can be attacked. Finally, it should be borne in mind that lack of novelty in a claim does not lead automatically to that claim lacking in inventive step. The question is whether the skilled person in the art would find the invention obvious in the light of the common general knowledge (CGK) at the priority date, whether that common general knowledge is taken on its own or, under some circumstances, with prior art information as defined in Section 7.

Many candidates overlooked stating that CGK must be established by way of evidence from the PSA and, as noted already, many candidates failed to identify from the question paper all of the possible CGK. As noted at the start of this report, X suggests that both hairclips generally and rubber gloves with their non-slip properties may be part of the CGK, and the client also supports the possibility of hairclips being CGK. In practice you would certainly ask your client about at least the hairclips, and particularly you would need to know whether they were essentially identical to the hairclip of X without the resilient strip formation on each clamping arm, or possibly with some other gripping device on the clamping arms. The client also suggests that combs may be part of the CGK, although these are probably not relevant to the obviousness question and minimal time needed to be spent on them.

Most candidates did pick up the client's indication that the hairclip of document B was enormously successful for a brief period, but many candidates did not question when this was and automatically assumed that such clips were part of the CGK. Of course, if the hairclip of B was only enormously successful after the priority date of X, it may not be part of the relevant CGK and evidence would be required to establish if and when it was part of the CGK. Most candidates who raised this issue correctly stated that for the purposes of the exam they were assuming the hairclip of B was available to ask the obviousness question.

A few candidates argued on the basis of some recent case law that the prior art referred to in X was automatically CGK. However, it is suggested that it is not appropriate to apply this case law unquestioningly and, if it is desired to use a particular piece of admitted prior art as CGK, it is best to attempt to establish this by evidence bearing in mind that the patentee of X will argue strongly against the mere suggestion that the admitted art is CGK.

There is no suggestion in the question paper that the hair clamp of A was CGK, and most candidates quickly dealt with the question of obviousness on the basis of CGK alone by finding that there was no suggestion in any of the CGK of using a resilient strip formation on a hairclip. Furthermore, even if rubber gloves were found to be part of the CGK of the PSA (presumably only a hairstylist PSA, not a hairclip manufacturer/designer PSA), there is no indication as to why the PSA would find it obvious to apply non-slip rubber to the well known hairclips, except hindsight.

The next consideration under inventive step was obviousness in the light of the CGK when combined with prior art information. Candidates were required to clearly identify the Section 7 (3) considerations necessary to apply this test and particularly to note the requirement that the prior art information could be a patent specification such as A or B provided it could be reasonably expected to have been ascertained by the PSA. The better candidates discussed this in some detail and raised the issue in the light of their particular PSA of whether it could be established that patent specifications are part of the art and/or that patent searching was conducted regularly. In this, candidates were assisted by the fact that the hairstylist client had conducted some patent searching, but there remains the issue of whether she is an acceptable PSA given that she is inventive.

The Examiners do not have a fixed view on whether A and B could be reasonably expected to have been ascertained but, given the doubt and the fact that if they could, both documents would have the potential to be understood and regarded as relevant, it was expected that candidates would go on to consider the obviousness question in light of the CGK and each of A and B anyway.

Combining B with the common general knowledge does not advance the obviousness question if the hairclip of B has already been considered as part of the CGK, so minimal time needed to be spent on B.

The question then turns to A. Since A proposes making the lining of rubber to improve its ability to grip hair, the obviousness question is not advanced by combining A with rubber gloves if they were considered to be part of the CGK. With regard to the hairclip of B, the problems identified by the client concerned the hinge, not the hair securing arrangement. Since the hair securing arrangement on B was apparently satisfactory, it is readily arguable that there is no reason for the PSA to combine the hairclip B with the rubber lining of A (ie to apply a rubber coating to the teeth and dimples of the hairclip B), except for hindsight.

A better possibility may be taking the common general knowledge hairclips which do not provide adequate gripping of fine hair (i.e. not B) and to improve them using the rubber lining features of A. Clearly, to support this argument more information would be required on the hairclips, and at least one counter to the argument that the combination is obvious is that if the problem of fine hair slipping through the CGK hairclips had long been known before the priority date, it could hardly be said to be obvious to overcome the problem by applying a rubber lining to the clamping arms. This counter argument may be supported by alternative hairclips with improved gripping such as B. Furthermore, even if claim 1 were found lacking in inventive step in the light of the combination of the CGK hairclips (without teeth), at least claims 2, 3, 5 and 6 are unlikely to be obvious since they go on to define the additional feature of the teeth on each arm.

Infringement

Several candidates reasoned that at least some claims of X were not infringed merely because those claims were invalid, and therefore did not consider the infringement of those claims. Not only is this clearly wrong in law, but it also does not help the client (or the candidate) if the candidate's reasoning on validity is incorrect.

The hairclip of Y clearly has a pair of elongated curvilinear clamping arms having oppositely disposed curvilinear inner surfaces and being movable between the open and closed positions, as well as fastening means at the free ends of the clamping arms to maintain the arms in their closed position. The major issue in Y, in relation to claim 1, is whether the hairclip has a resilient strip formation on each of the curvilinear inner surfaces and, depending on the interpretation given to "hinged together" in claim 1, whether the flexible band 16 satisfies this feature. The Examiners do not have a fixed view on whether or not the clamping arms in Y meet the requirement for them to be hinged together, but consistency was certainly required by candidates.

Many candidates noted the suggestion in Y that the teeth 24 and 36 may have a degree of give and concluded immediately that this satisfied clause (c) of claim 1 of X, without assessing whether the teeth in fact defined a resilient strip formation on each of the curvilinear inner surfaces as they had construed this phrase in interpreting claim 1. Nowhere in the question paper is there a suggestion that the teeth of Y form part of a strip formation on the arms, unless the phrase had been construed as merely meaning a formation extending in-line. A careful analysis of this issue was required.

A clear understanding of what is claimed in claim 2 of X was required to assess infringement of the claim. Issues against infringement were whether Y has transversely extending triangular shaped teeth with linear sloping sides and whether the arrangement of those teeth does provide an even tension on strands of hair engaged between them when the clip is closed.

Amendment

This year, candidates were requested to advise their client on what amendments the patentee might make to overcome any problems with A that they had identified. Many candidates, having concluded that claim 1 was lacking in fair basis, told the client that the patentee would merely include the subject matter of claims 2, 3 and 5 in the claim, without any analysis of whether this was really necessary. Assuming the patentee decided to restrict claim 1 in order to overcome a fair basis problem, all that is required to be added to claim 1 is the subject matter of the invention identified from the description, that is, arguably, the staggered rubber-type teeth and the interlocking mating relationship. However, the patentee would also have the option before the Patent Office of seeking to amend the description to overcome the fair basis problem without any limitation to claim 1. Whether or not this would be a viable option depends on the candidate's conclusion on whether claim 1 defined novel and inventive subject matter.

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