

Examiners' Report on Paper B/1992 (Electricity/Mechanics)

1. Attention is drawn to the footnote to the candidates' instructions for Paper B. It is emphasised that the claims presented in B do not necessarily constitute the only or best solution to the task previously set in A. Rather, these claims are designed as the starting point for a new exercise comprising: (a) revising the claims of the application to the extent considered necessary in the light of the official communication and the further prior art (Doc. II) cited, and (b) defending the thus revised text by argument. The candidates' instruction is to assume that it is the given claims which were filed; he may and indeed should forget what he himself had proposed for Paper A, particularly since in respect of Article 123(2) the documents as presented in Paper B provide the "as-filed" text whose content should not be inadmissibly extended.

2. As regards the need to amend the claims, there are many possibilities. One or two candidates argued to maintain the given Claim 1 with little or no amendment; one or two others tended to the opposite extreme of largely abandoning the given Claim 1 and substituting an alternative solution. Most however proposed one or more of the following solutions:
 - (i) The mechanical connection of the arms being displaced from the electrical connection and the requirement for horizontal insertion of the electrical connector being met by making the mechanical connection a pivotal one;

 - (ii) The electrical connection being secured in place by the releasable locking means of Fig. 4;

(iii) The electrical connection being assured by insertion of the contacts carried by the arms into the contact-receiving structure comprising a floating relationship between conductive plates and an insulating spacer.

There were several variants of each of these possible solutions. In the following the term "pivoting solution" will be used for (i), "locking means solution" for (ii) and "connector solution" for (iii). No single claim appeared suitable to cover these three solutions satisfactorily.

3. Candidates who adopted the pivoting solution in a way which effectively abandoned protection for the applicant's Fig. 4 embodiment had to be given lower marks than candidates who proposed the pivoting solution for the main application and attempted to protect Fig. 4 in some way in a divisional application. Some candidates went further: they elected to file two divisional applications so that each of the possibilities (i), (ii) and (iii) above would be separately protected. A few candidates even proposed three or more divisional applications but did not thereby gain marks; indeed, such candidates sometimes gave the impression that they could not decide what to claim and therefore set down as many possibilities as they could think of in the hope that one of them would be the "correct" solution. Such an approach does not find favour with the examiners. Candidates who proposed a divisional application should have demonstrated that this was necessary in order to avoid loss of protection.

4. The candidate's instructions are to defend his amended claims by argument. This does not mean that the objections set out in the official communication have to be refuted one by one; rather, it is a matter of positively justifying the new claims proposed. This has to be done in the form of a letter of response to the EPO and the introductory part of that letter should preferably contain a general statement of the amendments proposed. For example, "new Claim 1 consists of the subject-matter of original claims 1, 2 and 4 with the added requirement that the mechanical connection is a pivotal connection."

5. As to the argumentation, it had to be established that the subject-matter claimed is new and inventive. An appropriate way to do this is to use the so-called problem/solution approach, which consists of the following four steps:
 - a) Specify which one of the cited documents discloses the subject-matter considered to be the nearest prior art.

 - b) Show that the invention has features of distinction from the nearest prior art (thus establishing novelty) and, in relation to those features, state a problem which is solved by the invention but not solved, or not satisfactorily solved, by the nearest prior art. It may well be appropriate in this connection to specify the advantages of the inventor's solution in terms of the technical effects thereof.

 - c) Specify clearly the essential technical features of the inventor's solution and ensure that they are in the claim.

- d) Show that the further document or documents cited as prior art, considered in combination with the nearest prior art, do not suggest the claimed combination of features.
6. In step c) above, the final (underlined) phrase is emphasised since, regrettably, quite a few candidates presented arguments which did not comply with that condition. It is pointed out that an argument in favour of the inventiveness of something which is not actually claimed is of dubious relevance and may therefore gain few points, however well it may be presented.
7. The instructions require such argumentative defence only in respect of the main claim. Subordinate claims do not need to be defended. If a second independent claim is proposed (whether or not for a divisional application), the justification for it should be briefly indicated but it does not need to be argued in detail. If there is a second independent claim which is not to be divided out, the reason why Article 82 is considered to be satisfied should be indicated. If any of the independent claims (main claim, second independent claim or divisional claim) omit one or more of the features of the invention as broadly claimed in the application as filed, then the omission of that feature may or may not be allowable with regard to the practice under Article 123(2) or Article 76. At least a brief justification for omitting the feature should therefore be provided in the argumentation of the candidate in such cases.
8. Paper B is not intended to be a test in drafting divisional applications. If however a candidate considers that a divisional application should be proposed, he or she should make clear what subject-matter is envisaged for the main

claim for the divisional. Merely stating "I would file a divisional application for the connector per se" is not sufficient. On the other hand, the drafting of an elaborate set of subordinate subclaims for a divisional application is a waste of the candidate's time.

9. Finally, it is noted that the overall performance in Paper B this year was better than in some past years. Nevertheless there are still too many candidates who exhibit weaknesses in argumentation. Although the problem/solution line of argument is not necessarily, and not always, the best in a particular case, candidates would be well advised to demonstrate to the examiners that they can handle this classic form of argumentation. It is hoped that the points (a) to (d) set out in paragraph 5 above will be helpful to prospective future candidates in this respect.

EXAMINATION COMMITTEE I

Candidate Number No.

Report by examiner No.

StudentBounty.com

FORM, for use by individual examiners, in PAPER B

Schedule of marks

Category	Maximum possible	Individual marks awarded	Where grades awarded are not identical	
			Revision of marks/grade (if any)	Remarks*
Claims:	24			
Argument	24			
TOTAL	48			
CORRESPONDING GRADE				

Translation of marks into grades

	Grade
0 - 11	7
12 - 17	6
18 - 23	5
24 - 29	4
30 - 35	3
36 - 41	2
42 - 48	1

* to be filled in if both the following requirements are fulfilled:
 (a) the grades awarded by the two individual examiners before their discussion differ by two grades or more;
 (b) the marks awarded by at least one of the two individual examiners have been changed during their discussion.
 If remarks are to be filled in, they should briefly explain **why** the examiner has changed his marks.