

Qualifying Examinations 2010
Informal Session
Paper A
Drafting

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18 August 2010

You are normally given

- two copies of Invention Disclosure
- details of known, relevant prior art.
These may form part of invention disclosure.

You need to draft the specification

- claims must be novel and inventive over the prior art [Sections 13 to 15]
- claims must not be overly restricted
- claims must be capable of industrial application [Section 16]
- S25(5) R19(5)-(9)

If you use second copy of Invention Disclosure for your description, do so carefully and intelligently.

- many candidates have lost marks by not being careful
- last year there was an error in the Invention Disclosure
- sometimes the inventor makes inappropriate remarks (e.g. “essential”)

- it may be excessively limited by not including broadening language (e.g. biasing means such as a spring)
- inappropriate language may be used
- may cause problems with claim language
- support
- inconsistent terminology

It is not intended that you use the Invention Disclosure alone as your description

- use some of it to save writing time

Have consistency between title, field and introduction to independent claims

- don't have to be exactly the same
- must be consistent

What form of independent claims are necessary?

- Apparatus
- Method
- Consider what infringer might do

If both, ensure unity (usually).

But don't include second, independent claim unless actually required.

You must carefully consider the Administrative Instructions for the QEs on the IPOS web site:

- all of it
- particularly Annex II

Consider several past papers

- prepare answer under quasi examination conditions
- then compare with Answer Guidelines and Examiners' Comments
- have your answers checked by a patent agent with at least 5 years PQE
- IP Academy patent practice modules

There are only three ways to develop the necessary skills to be able to pass this examination: practice, practice and more practice.

- past papers and/or clients' inventions
- need to do several to have any chance
- must hone your drafting technique and skills
- each invention is unique or it is not patentable.

When drafting claims:

- be careful when using very broad language
 - it may read on too many irrelevant products/processes
 - support problems
 - novelty and inventive step problems

- avoid potential “in use” language, should infringe when “on the shelf”
- consistency in terminology
- what features are important to the invention
 - what has the client said is important to him?
 - but is it important to the invention vs product/process?
 - what is novel?
 - what is inventive step?

Start with main independent claim

- 50% of all marks
- do not rush it
- take your time
- what is the main invention
 - what is the purpose?
 - advantage?

- list these features but not as claims
- what can someone do to design around these features?
- can the features be broadened to stop the design around?
- if so, what changes need to be made to the description?

Include in main claims all features necessary to achieve the main advantage.

But maintain

- breadth
- novelty
- inventive step
- consistency

Then try to draw a picture of the claim

- it should look like the drawings
- if not, revisit your claim language

What will your client be selling?

- what will competitors sell?
- what is the principal commercial feature?
- can any components of the product be made and sold separately
- look at your claims with the eyes of an examiner and potential infringers

Dependent claims

- do not add dependent claims that only add a feature of no importance
- feature should be important
- preferably novel
- or, when added to claim 1, will assist with inventive step considerations
- should be for fall-back considerations

Dependencies must be accurate

- watch for antecedents
- consistency in claim language
e.g. claim 1 introduces “a first driver”
and “a second driver” but claim 2 uses
“the driver”

Objects/advantages may be used but:

- keep to a minimum
- keep very general
- may be used against you by a competitor

e.g. “to address these problems”
rather than “to solve these problems”

Summary should not be broader than the claims. Use claim language.

In description refer to “embodiment”,
“preferred embodiment” or “exemplary
embodiment” but not “invention”.

Common mistakes

- Covering prior art
- Not broad enough to avoid design arounds
- Not covering all embodiments
- Missing key issues in question
- Dependant claims inadequate
- Unclear / imprecise terms
- Forgetting drawings

Read “Fundamentals of Patent Drafting”
by Paul Cole, CIPA (2006).

Everything you are given in the question paper is needed to answer the question.

Everything you need to answer the question is in the question paper.

Good Luck!