

Paper B

Slide information prepared by Keith Callinan of Marks & Clerk

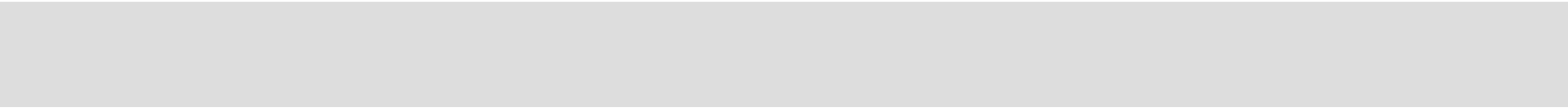
Kristian Robinson

Director

August 2010

Paper B

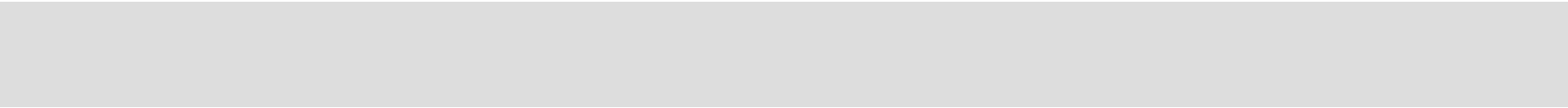
- Normally given:
- specification of patent/patent application
- written opinion
- two citations
- advice from client



Amendment is required – if you believe no amendment is required to overcome written opinion OR examiner is correct and invention is totally unpatentable **YOU ARE WRONG**

Check facts

- watch dates
- priority date vs publication date
- S.15 and impact on S.14(3)
- for inventive step check reasonableness of the combination
- identify all prior art documents including self-admitted prior art in the specification

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- if for post grant amendment watch S.84(3)
 - S.84(2)
 - » “application for patent”
 - vs S.84(3)
 - » “specification of a patent”
 - See S.25(3)
 - » specification does not include the abstract, the application does

Timeline

- Quickly read everything first to work out what it is about. Do not start writing but maybe highlight important facts and points.
- Carefully read everything making notes as you go.
- This should take about 1 hour. That gives 3 hours for writing.
 - » 1 hour for claims
 - » 1 hour for submissions
 - » 40 mins for letter to client
 - » 20 mins for checking

Timeline

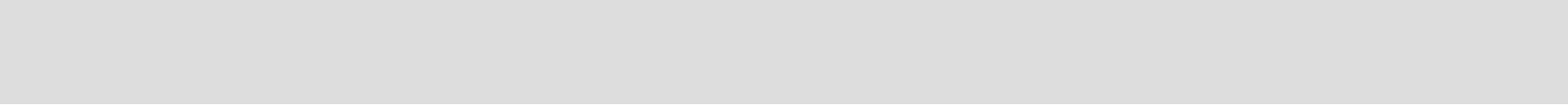
- Take note of what the examiner wants as it may vary from year-to-year.
- The examiner is looking for you to demonstrate that you have sufficient mastery/knowledge of the subject to be let loose on the public.

Your duty is to your client

- You should try to obtain the broadest, valid claims
- excessive limitations in the claims = fail
- claims not valid = fail
- submissions must be accurate and must not mislead or deceive the examiner
- letter to the client should contain sufficient explanation to enable him to understand:
 - » what is being done
 - » the consequences of taking the action
 - » and should give the due dates and the consequences of non-compliance. It must address and answer all his queries.
- letter to client may refer to submissions in letter to IPOS.

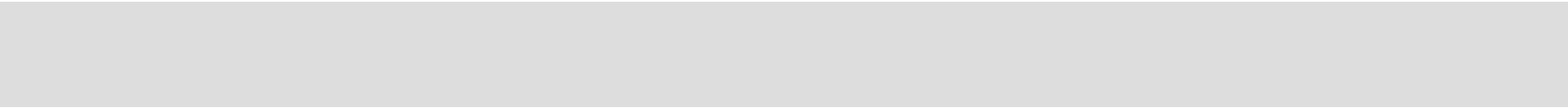
Your duty is to your client

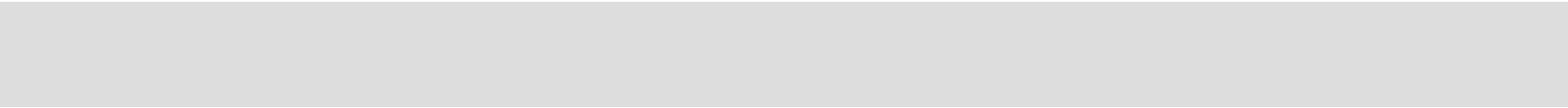
- Do not rely on client's comments without checking them
- Do not believe the written opinion particularly in relation to the prior art
- Check everything
- Work out what you believe is the true invention and don't inherently rely on existing claims.

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- Everything you need to produce a perfect answer is given to you
 - Everything given to you is required to be used to give the perfect answer

Novelty

- briefly state the law – 1 sentence
- General Tire v Firestone
- must be clear and unambiguous direction in the prior art to do what the patentee claims
- reverse infringement test

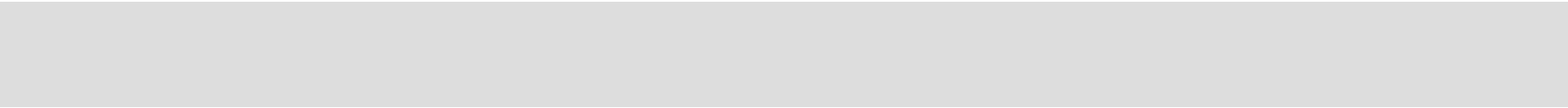
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- watch variations in language/terminology
 - » e.g. gear vs sprocket
 - explain why each citation is or is not relevant to each claim on novelty
 - each citation is considered separately
 - be concise & brief
 - use the words of the citations and claims.

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- when in doubt try using a claims table
 - this can also assist with inventive step
 - but is not a substitute for a reasoned argument
 - merely helps you sort out the issues

| Claim | Feature | D1 | D2 |
|--------------|---|--|--|
| 1 | A self-propelled vehicle comprising an engine a pair of front wheels a drive train a rear axle a pair of rear wheels | yes yes yes yes yes yes | yes yes yes yes yes yes |
| 2 | the engine is operatively connected to the drive train for driving the rear wheels | yes | no |
| 3 | the drive train is also separately connected for driving the front wheels | no | yes |
| 4 | further comprising a selector operatively connected to the drive train for selectively controlling the operative connection to at least one of the front wheels and the rear wheels | no | no |

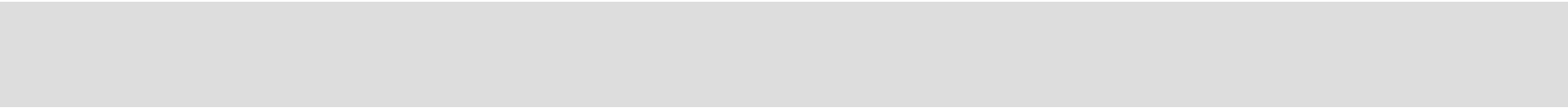
Inventive step

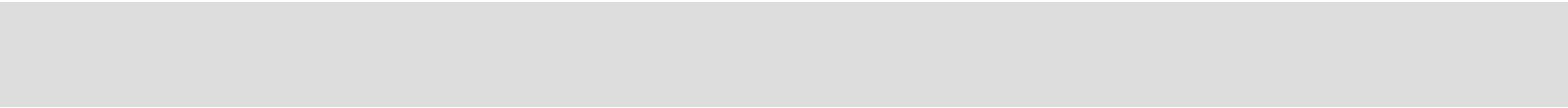
- briefly state the law – 1 or 2 sentences
- Windsurfing vs Tabur Marine
 - (a) what is the inventive step?
 - (b) what was the state of the art relevant to the inventive step, at the priority date?
 - (c) in what respect does the step differ from the state of the art?
 - (d) would that step be obvious to a person skilled in the art?
- Sabaf vs MFI
 - » mere collocation of integers
 - » not confirmed by Singapore courts but should be followed

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- consider the combination of the citations – permissible?
 - consider combination relative to each claim and explain
 - be concise and brief
 - use the words of the citations and claims
 - advantages of the result obtained – but does this apply to all embodiments?
 - Windsurfing is the correct test
 - NOT KSR

For amendment:

- consider claims and description for additional feature
- watch for support – explain where the feature is found if it is from the description
- no support statement required if combining claims
- ensure no new matter added
- new matter &/or lack of support may happen via “back door” if a limitation is removed
- must be consistent with submissions (a common error)
- ensure a functional relationship exists between integers in the claims

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- consider claims table
 - what is the relationship between the integers of claim 1?
 - none!
 - a mere collocation of parts
 - therefore invalid
 - functional relationship needs to exist between the various integers.

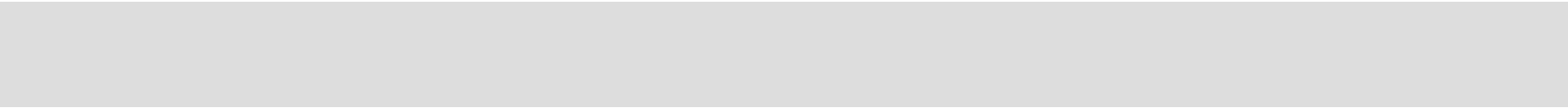
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- Do amendments first – approx 1/3 marks
 - Then submissions – approx 1/3 marks
 - Then letter to client – approx 1/3 marks
 - Don't hesitate to use dot points in letter to client if short of time

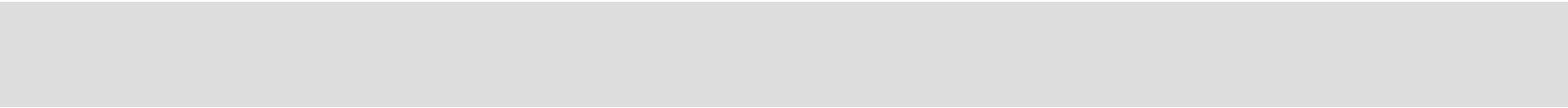
To maximise your chances to pass Paper B

- read the information on the IPOS web site
- read the cases referred to in syllabus (part of the administrative instructions)
- download and answer all past papers under quasi examination conditions
 - » have experienced patent agent/attorney mark your answers paper
 - » then consider examiners' comments and any model answers

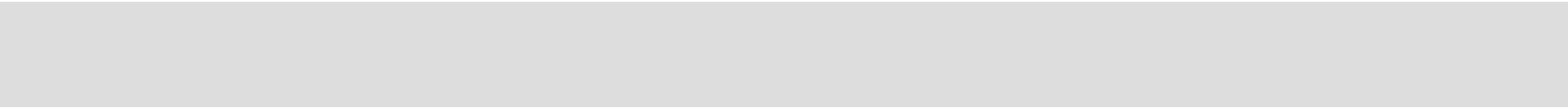
To maximise your chances to pass Paper B

- consider doing the same for GB's JEB papers and EPO papers
- you are best served to be sitting the paper after a few years of practical experience gained from prosecuting Singapore patent applications as part of your work

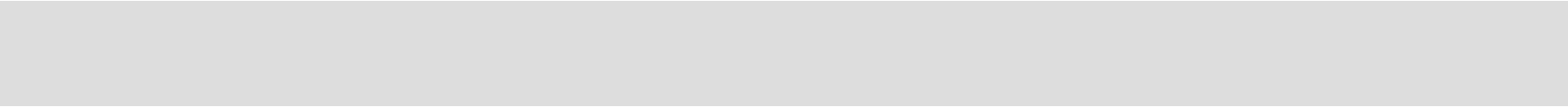
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- every invention is unique
 - if not unique it is not patentable
 - therefore every case is unique and requires unique solutions
 - you must learn the techniques for solving the problems and finding solutions
 - cannot be taught
 - self-learning



Every time you open a file at work for the prosecution of a Singapore patent application, picture yourself in an examination room and this is the beginning of the Qualifying Examination for Paper B.



When you are in the examination room for Paper B picture yourself at work and this is just another prosecution of a Singapore patent application.



Keep
It
Short
Simple
And
Succinct for
Success

Any Questions?

Kristian Robinson

Director

krobinson@ecsf-asia.com

Slide information prepared by Keith Callinan of Marks & Clerk