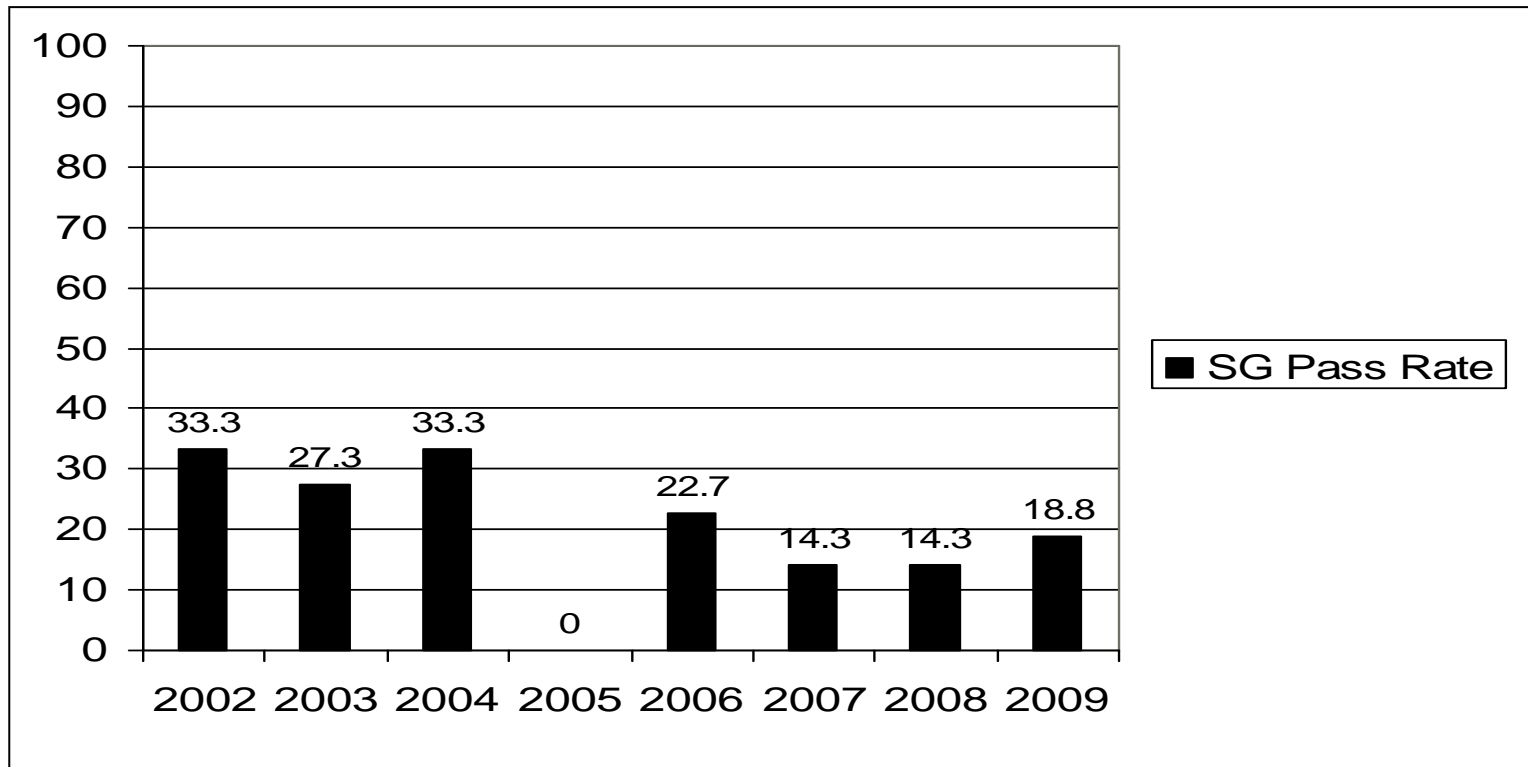


Qualifying Examinations 2010
Informal Session
Paper C
Infringement & Validity

Blayne Peacock
Partner
Marks & Clerk Singapore LLP
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Difficult paper + unprepared candidates = low pass rates



Marks are given for reasoning, not conclusion.

Devise a technique for answering.

Practice. Practice. Practice.

Apply and hone your technique.

Attempt several past papers under quasi exam conditions and have them considered by patent agent experienced in this sort of work. Also consider the Answer Guidelines and Examiner's Notes – all on the IPOS web site.

Read the paper carefully. The examiners usually provide substantial hints of the issues to address. Learn to spot these hints. Everything you need to answer the question is given to you; and everything given to you is needed to answer the question.

Write on every second or third line to ensure you have enough space if you change your mind.

You are writing a judgement so you must read all the cases in the Administrative Instructions, Annex II, on the IPOS web site.

What is Expected of You?

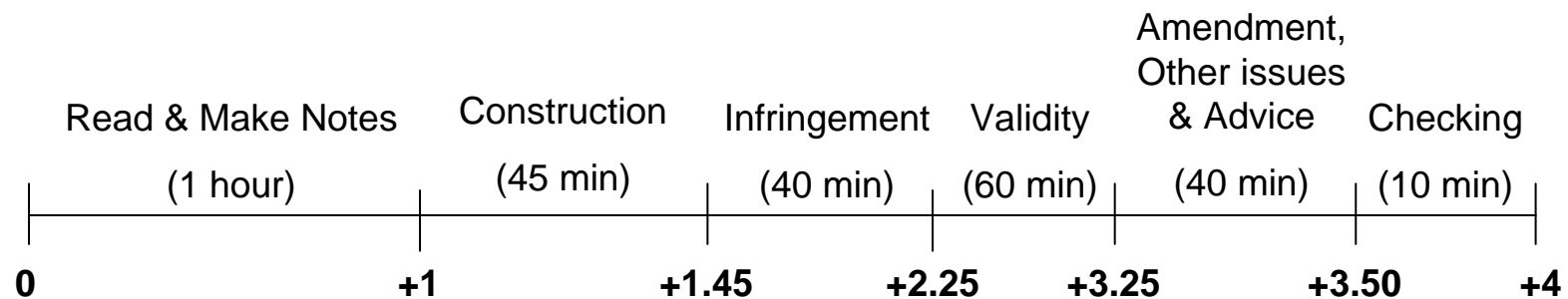
You must typically include:

- Construction
 - Infringement
 - Validity
 - Amendment (if required)
 - Advice to Client
- 40%
- 40%
- 20%

All in four hours!

You must manage your time so that they deal with all the sections. Failure to cover all sections will seriously prejudice the marks that can be awarded. Validity will vary year-to-year.

One approach a previous candidate took:



1. Read instructions

- Make sure you know what is expected of you.

2. Read letter

- Establish the scenario.

3. Read claims

- Get an idea of the claims without any context.
- Make notes as you go along.

4. Read alleged infringement & prior art

- Understand relationship of features.
- Update your notes accordingly.

5. Read patent description

- Identify any definitions, explanations, correspondence between general terms and embodiments, changes in terminology etc.
- Update your notes accordingly.

6. Claims tables are a useful tool in summarizing your conclusions but as they contain no reasoning they earn no marks.
7. Do not recite legal tests or discuss legal principals unless required for a tricky issue.

Example claims table

	Y	A	B
1.1	Yes	?hair clamp?	Yes
1.2	Yes	? Elongate?	Yes
1.3	?opposed?	yes	Yes
1.4	? Hinge?	Yes	Yes
1.5	Yes	Yes	Yes
1.6	? Resilient strip?	Yes	? One side only?

s80

- a) Patentability (always)
- b) Entitlement
- c) Sufficiency
- d) Added matter
- e) Non allowable amendment / correction
- f) Fraud / misrepresentation
- g) Double patenting



All are possible

Construction

Determines the scope of the claims.

Underpins the rest of your answer.

How to decide which terms to construe?

- Measure claim against alleged infringement & prior art.
- Ask 'Will it make a difference to my assessment later?'
- The actual construction must be without reference to alleged infringement & prior art. Reference must come from specification.

Make notes on your answers for things to deal with later as you go. Cross them out as you deal with them.

Construction

Another way to decide which terms to construe:

- A: Term with unclear meaning and relevant to the claim scope. Requires construction. Summarise the alternative constructions. Give reasons for construction selected based on purposive construction/improver protocol.
- B: Term with clear meaning and relevant to the claim scope. State the meaning of the term briefly.
- C: Term not relevant to the claim scope. No need to spend time on these terms.

Construction

How to locate Type A & B terms?

- Anything that is not clearly found in the alleged infringement or prior art.
- Anything in your first read of the claim that you find unclear.

How to locate Type C terms?

- Anything that is clearly found in the alleged infringement and prior art.

How to Start the Paper

CLAIMS

1. A fire-resistant door ^{1.1}leaf suitable for closing-off an opening in a marine bulkhead, ^{1.2}comprising two panels with a core region between the panels, ^{1.3}characterised in that the core region contains a membrane (11) of relatively high flexural rigidity ^{1.4}whilst the panels (12) each exhibit a thermal conductivity which is lower than that of the core membrane (11) and are each thicker than the core membrane.

What is this?

Clarity?

Slight antecedence
issue?

Construction – Type B

Claim 1: Independent apparatus claim

1.1 ‘A separating apparatus for separating liquid from solid material...a liquid expressing means’

“Separating apparatus” seems clear and means a device that separates. ‘For’ requires apparatus to be suitable for separating liquid from solid material.

“Solid material’ defined as... at page 2 line 3. Claim covers these materials.

“Liquid expressing means” covers any means suitable for expressing the liquid. ‘Expressing’ is construed to cover the drawing out or pushing out of the liquid through the screen because this is shown in the description (page 4 lines 6-9).

Construction – Type A

1.2 ‘means for moving ... in a cyclical movement’

This is read to cover a means capable of moving or rotating the sweeping means and compression means. ‘Cyclical’ has two possible meanings here – one is that it covers a movement in a circular path, while the other relates to interval-based movements. Figure 3 and page 4 shows use of a circular path and this suggests that patentee intended to cover ‘circular path’ meaning. This is therefore the interpretation chosen.

1.3 ‘heat and/or pressure’

This term covers three possibilities: heat alone, pressure alone or both heat and pressure. ‘Heat’ and ‘pressure’ would take their ordinary meaning. Description (page 5 lines 9-13) only mentions use of both heat and pressure.

Construction

Claim 2: Dependent on claim 1

2.3 'the transfer medium'

[AMEND]

There is no antecedence for this term. To give effect to the term, for claim 1, this term is construed to mean 'the transfer paper' because this term is referenced in claim 1.

2.4 'heat and pressure thereto'

The term 'or' is absent, which means this term only covers application of heat and pressure. 'Thereto' is construed to refer to the adhesive layer (i.e. the heat and pressure must be applied on the adhesive layer) because this is consistent with the reference to adhesive layer before this phrase and the description in page 5.

Construction

Construction is not about giving examples of what the term means. Instead it is about giving a definition to an intrinsically unclear term.

Not only broad vs narrow, but also use of different words in same places, different places for same words, repercussive effect etc.

Do not waste time with introductions.

Consider all elements, construe only the important ones.

Look out for typos, antecedence issues, repercussive effects for easy marks.

Infringement

If construction done right, this section is relatively easy.

The big question: Does the alleged infringement have the features of each claim as you have construed it?

Consider each claim separately. Within each claim consider each feature separately.

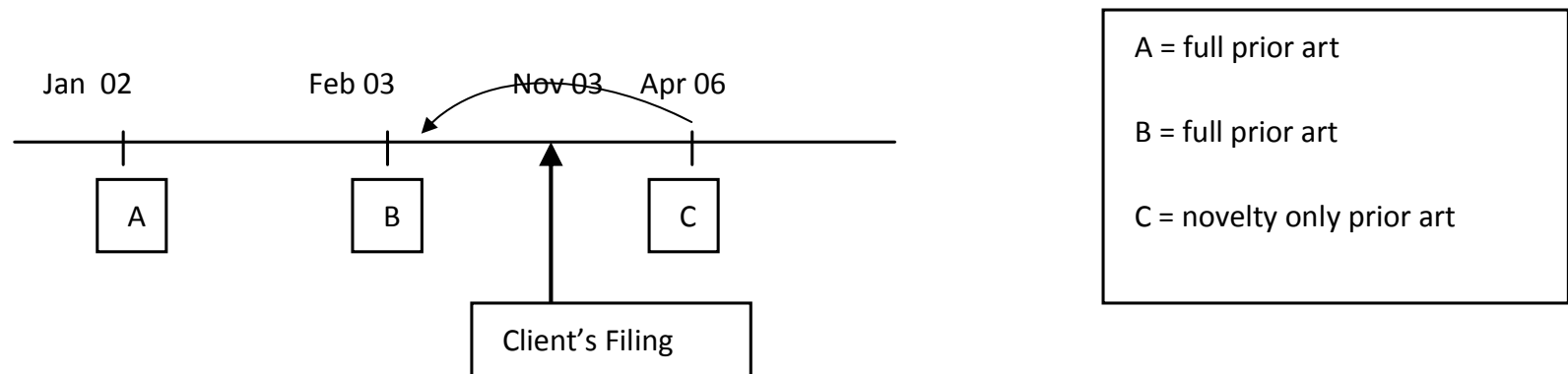
It is your reasoning that is important.

Purposive construction.

No contributory infringement.

Validity

Draw a timeline in rough sheet. Be clear about relevance of prior art documents.



Where fact suggests priority issue, check each claim for priority entitlement before deciding on relevance of prior art.

Validity – Novelty

Novelty assessment is pretty straightforward. Much like infringement.

The big question: Do the prior art documents clearly and unmistakably disclose the features of each claim as you have construed them? [General Tire case].

Assess all claims against each item of prior art.

Validity – Inventive Step

No need to recite the law. Instead, apply it. Consider Court of Appeal decision in Muhlbauer AG v Manufacturing Integration Technology Ltd.

The only test for inventive step that has been used by the Singapore courts is the Windsurfing test. Not Pozzoli. Not problem/solution. Not KSR.

Assess with reference to applicable prior art individually and in combination.

Explain why the combination is permitted or not permitted.

Validity – Inventive Step

Substantiate your arguments with sound technical reasoning:

For Validity	Against Validity
Different technical field/problem.	Same technical field/problem
Difficulties in making the required adaptation/combination	Express reference
Teaching away	Structural/functional equivalence
Surprising results, technical prejudice, commercial success	Mere workshop design / CGK

Validity – Inventive Step

Normally some claims are novel and so this is where the inventive step arguments should focus.

What if claims found not novel?

- Do not just say not novel, so not inventive. You will be throwing away all marks for inventive step assessment!
- Instead, figure out one possible feature that may be considered novel.
- Explain how it may be considered novel.
- Proceed to assess inventive step on that basis.

Very much as you would do if responding to an examiner's objection to lack of inventive step.

Amendment

Purpose: overcome invalidity while ensuring infringement.

If there are invalid claims, briefly propose amendment.

The amended claim should still cover the alleged infringement. If no amendments are available that cover the alleged infringement, you will need to advise the client accordingly with a suitable explanation.

Where possible, comment on post-grant amendment issues:

- Discretionary
- Cannot add matter or broaden claimed scope
- Effect on back-damages

Amendment

Simple amendment is to incorporate a dependent claim into the independent claim.

Do not overlook possibility of adding something from the description into the claim instead.

Be wary of adding matter via intermediate generalization.

Don't write amended claim in full.

Specify what the amendment will be.

Advice

Purpose: Provide advice as to summary of infringement situation, position of client, repercussions, actions to take.

Do not waste time by reciting sections/forms/fee.

Easy marks available provided:

- (i) you have left sufficient time for this section,
- (ii) you are generally aware of what an advice section should contain, and
- (iii) you apply the facts to give tailored advice rather than regurgitating paragraphs of memorized advice.

Advice - Example (Client is Infringer)

Summary:

All claims are infringed but only claim 5 is valid and infringed.

X, who sells the product, infringes product claims 1-4. Y, who makes the product for X, infringes method claim 5.

Position of Client:

The letter indicates that A is aware of your activities and may be looking to initiate patent infringement action.

Advice - Example (Client is Infringer)

Repercussions:

The risk of continuing with your activities is that you can be sued for patent infringement. If patentee is successful, an injunction may be granted to stop you from continuing, and cost and damages or account of profits may be granted against you.

[Discuss availability of back-damages, and any restriction on relief (e.g. innocent infringer, related-claim, post-grant amendment)]

A may also seek an interim injunction to stop you immediately.

[Discuss likelihood of interim injunction]

Advice - Example (Client is Infringer)

Actions to Take:

For valid claims: (i) obtain licence, or (ii) design-around.

For invalid claims: (i) initiate dialogue and negotiate with patentee, (ii) inform patentee of prior art, (iii) apply for declaration of non-infringement (iv) apply for revocation of patent (v) post grant amendment (vi) groundless threats (vii) post grant search and examination.

Advice uncertainty of any prior art. Investigate or watching search. Perform searches to locate more damaging prior art. Patent own technology.

Advice - Example (Client is Patentee)

Actions to Take:

Can seek interim injunction to stop X selling. [Consider factors influencing interim injunction: delay, adequacy of financial compensation after trial]. Unlikely to obtain in this case since three months have elapsed since you discovered X's activity.

Amend patent for validity first.

Then initiate infringement proceeding. Certificate of contested validity.

Invite X to take out licence once patent amended.

Good Luck!