

## **Notes on Paper C – Tim Watkin – incorporating material from notes by Martin Schweiger**

The following notes are a summary of a talk given by Dr Tim Watkin at IPOS on 17 August 2007. They are not intended to be a complete guide to passing the exam. The comments do not necessarily reflect the views of the examination committee, or of the patent agent firm where Dr Watkin is a partner.

### **Structure of the answer:**

I suggest:

- (a) - Interpretation of each claim
  - Interpretation of each claim term which is unclear.
- (b) - Validity of each claim
  - novelty
  - inventive step
- (c) - Infringement of each claim
- (d) - Amendment
- (e) - Answers to legal issues.

This structure (a), (b), (c) is followed in many UK judgments. The order of steps (b) and (c) can be reversed.

This is not the only possible structure, however, and some examiners prefer it if section (a) is omitted, and instead, when doing step (b), an interpretation of each feature of the claim which needs to be interpreted is included in the attacks against that claims. Where identical interpretations are needed for an attack against a dependent claim, a short reference "... see interpretation above with respect to claim x" can be used.

### **a. Interpretation**

Many terms in the claim have an obvious meaning, and hardly require interpretation. Devote just a line or two to them.

The marking schedule is likely only to award marks for words which have a certain ambiguity. For example what does "top" mean in relation to an object which can be put any way up? What is a "side"?

In principle (this is stated in many UK judgements), the interpretation should take into account the way in which words are used in the body of the patent (i.e. words are used in context), but should not take into account the infringing article. Therefore, the infringing article should not be referred to in the interpretation section of your answer. The prior art should only be referred to exceptionally, perhaps as evidence of how a certain technical term was commonly understood in a given technical field. In other words, the interpretation of the patent is supposed to be carried out in a vacuum, hardly looking at the other documents.

However, in practice, there are very likely to be more marks on the marking schedule for claim terms which will turn out to be important in assessing validity and infringement. So, realistically, a candidate is well advised to read the references and description of infringing

product before tackling the interpretation section, so as to help him judge which claim limitation will be critical in the infringement/validity analysis, and then devoting more time to these terms than to others. For example, if the patent, the infringing product and the prior art are all floppy disks, then there are probably few if any marks available to analysing the claim term "disk".

If wording has been interpreted in a certain way in your answer, you must stick to that answer.

Example: A certain claim says "About 30%". Examples in the specification are 29%, 30.1%. You must take a view about what "about 30%" means, e.g. taking into account what will actually work in the context of the patent and perhaps the examples. Having decided on this, you must use the same interpretation when assessing both infringement and validity.

Please note that the interpretation part is not only an interpretation of some claim elements of D1 but often also an interpretation of the wording of the prior art.

## **b. Validity**

### **1. When attacking a claim, refer to all elements of the claim.**

Leaving one element out can mean that the whole attack is not valid.

### **2. Citing documents**

Examples:

a) The claim language says: "a pivoting element"

Suppose document D2 on page 2, line 19, describes a screw with a reference number 12 in Fig. 2, and the screw 12 providing a hinging function

The right citation for an attack would be:

"D2 discloses a pivoting element (Fig. 2: screw 12 + P2, L19)."

Note that both the figure and the text are cited, but the starting point is the claim language.

b) If a claim feature is disclosed on more than one line, e.g. 19 to 21, one would write

"D2 discloses a pivoting element (Fig. 2: "screw" 12 + P1. L19-21)

c) If it is disclosed on more than one page, e.g. page 1, line 31 to page 2, line 2, one would write

"D2 discloses a pivoting element (Fig. 2: "screw" 12 + P1, L31 - P2, L2)

Note that a good attack first cites the element of the claim in the language of the claim (here "pivoting element"). It also refers to a Figure in the reference document where the element is shown (here "Fig. 2"), it then cites the expression in the reference which is used for that element (here "screw") and it finally says where further information about that specific element can be found (here "P2, L19" as abbreviation for "page 2, line 19").

### 3. Sufficiency

Attacks against a claim on a basis that the subject matter is not sufficiently disclosed are not wanted. There is no penalty if such an attack is done but there are also no marks granted for such an attack.

### 4. Use abbreviations:

Document 1 = D1

Patent Claim 1 = PC1

Page = P

Line = L

Column = C

Priority date = PD

Filing date = FD

Section xx Subsection yy Singapore Patents Act = Sxx(yy)

Rule xx Subrule yy Singapore Patents Act = Rxx(yy)

You can directly use the above abbreviations in your exam paper, defining them the first time you use them, but without defining them again afterwards.

### 6. Common mistakes

There are many common mistakes which can lead to an immediate failure of the candidate because they show that the important concept of priority is not understood:

- misinterpreting the relevant priority date of a claim and therefore using a disclosure which is not prior art with respect to the right priority date of the claim
- using a S14(3) document for an inventive step attack

### 7. Scheme for an appropriate invalidity attack against a claim:

- a) state the claim number (if the claim refers to another claim, then state this also)
- b) evaluate the priority date of this claim
- c) state which attack you are riding:
  - novelty S14(2)
  - novelty S14(3)
  - inventive step S15
- d) state the reference numbers of the prior art documents that you are using (see above item 2 for the right way to cite the document)

examples:

#### Claim 1

Independent PC1 benefits from the PD 19.07.93

PC1 lacks novelty according to S14(3) because all of the features are disclosed in D4 which has a PD of 20.05.92 and was published on 18.11.93, only after the relevant date (here: PD) of claim 1.

D4 discloses a floppy disc (Fig. 1, p. 1, l. 19) comprising a cover jacket (Fig. 1, "pre-cut part", p. 1, l. 20-22 + l. 41-42 + claim 1 of D4) enclosing a magnetic recording disc (Fig. 2, "disc", p. 1, l. 19 + claim 1) and a cleaning sheet (Fig. 1, "fleece overlay", p. 1, l. 20-22 + l. 41-42). The cleaning sheet is interposed between the cover jacket and the magnetic recording disc. Interpretation: this feature is not explicitly mentioned in D4 but it can be

deducted from the wording in claim 1 of D4 which enumerates the different layers of the disc in the mounted state: "pre-cut part - cleaning sheet - disc - cleaning sheet - pre-cut part)

## 2. Claim 2

PC2 which depends on PC1 can only benefit from the filing date 11.07.94.

PC2 lacks inventive step in view of S15 over a combination of D4 and D3. D4 (published 18.11.93) and D3 (published 30.01.90) are prior art according to S14(2) for claim 2, the relevant date of which being the filing date 11.07.94.

D4 discloses all the features of PC1 as described previously (see above). There are two differences between the subject matter of PC2 and D4:

- there are provided indexing holes, and
- further second welded portions are provided adjacent the indexing windows,
- the further second welded portions are provided in an area upstream of said indexing windows with respect to disc rotation.

Thus the objective problem solved by these extra features is to provide a means for detection of the position of the disc in the cover jacket such that the reliable operation of the magnetic disc is not put in danger.

D3 comes from the same technical field ("floppy discs") as D4 discloses these features (solution) as there are indexing holes ("detection holes 10", page 1, line 42) with welds upstream of the disc rotation (page 1, lines 35 and 36). The welds provide a solution for the above mentioned problem by preventing the cleaning sheet fibres from coming off in the region of the indexing window during use, thereby ensuring a reliable operation of the magnetic disc.

### Additional Interpretations:

The welds of D3 surround the index hole completely instead of being provided only in an area upstream of said indexing windows. Nevertheless, these welds of D3 are within the meaning of PC2 because according to the wording of PC2, the welding portions around the indexing hole are not restricted to be "only" in the area upstream of the indexing hole.

It is also not stated in D3 whether the weld comprises one portion or even portions as required for PC2 but such a modification is simply a selection from possible techniques known to one skilled in the art. The resulting portions do not present a selection invention as D3 discloses a broader range of providing such welds, the welded portions according to PC2 just falling in this broader range.

The solution with the features of PC2 is not only a solution to which the person skilled in the art could come by taking into account the disclosure of D4. The person skilled in the art would necessarily come to this solution because D4 explicitly addresses the above mentioned features for solving the above mentioned problem (p. 1, l. 45-46).

## **8. Attack each claim combination separately for invalidity, evaluate each claim combination separately for infringement.**

Example: the infringed patent has three claims.

Claim 1: device with element A

Claim 2: device according to claim 1, comprising element B

Claim 3: device according to claim 1 or claim 2, comprising element C.

Four infringement evaluations must be done: A, AB, ABC, AC

And four invalidity attacks must be brought up: A, AB, ABC, AC

## **9. Matching a document with an element of the claim**

a) State clearly whether an element is explicitly or implicitly/inherently disclosed in a prior art document. If you find that an element is only implicitly/inherently disclosed then describe what led you to that opinion.

b) The preferred source for a disclosure in a prior art document is a detail in a figure together with the respective part of the figure description. Reference numbers are used as a backup only.

If a patent document is used as a prior art document, then common technical statements in other parts of the specification (e.g. claims, summary) can be combined with the technical teaching disclosure in a figure description.

## 10. Inventive step attacks

Use either

- a) Windsurfer (UK), or
- b) could-would or problem-solution (EP),

Use the same approach throughout the whole paper.

In either case state clearly which element of the claim comes from which document if you combine two or more documents. The fact that two teachings taken together provide all elements of a claim is not yet sufficient. This is only the starting point of an inventive step attack.

State also clearly at least one good reason why the person skilled in the art would want to combine the two documents in the way that you have been describing (see the example above under item 7 for a good could-would approach). A pure statement that the two documents just nicely fit together or purely citing advantages of such a combination is not sufficient. Combinations which do obviously not work or which the skilled person would not make because they are considered to be forbidden are also not considered to be appropriate.

### c) Infringement

To demonstrate infringement, you must show that all elements of a certain claim are present in the infringing product/method. This must use the same interpretation you settled on above. For example, if, with reference to a patent for a washing-machine, you decided that a reference to a "door" implied that the opening portion opens horizontally (i.e. unlike the cover of a top-loading washing machine) so that a certain claim to a washing machine with a door is novel over a top-loading washing machine, then you must be consistent in applying the same interpretation to infringement.

If an element is not present, the claim is not literally infringed.

However, in the case of a claim which is trying to express a certain inventive idea, there may still be non-literal infringement, even if the infringement does not exactly have all limitations of the claims. The classic test is the "Improver questions" (*Improver Corporation v Remington Consumer Products Ltd*).

1) Does the variant have a material effect upon the way the invention works? If yes, the variant is outside the claim.

2) Would this have been obvious at the date of publication of the patent to a reader skilled in the art? If no, the variant is outside the claim.

3) Would the reader skilled in the art nevertheless have understood from the language of the claim that the patentee intended strict compliance with the primary meaning to be an essential requirement of the invention? If yes, the variant is outside the claim.

Example: A patent is for the idea of supporting a wall by putting a metal structure next to it. The patent reads "A device for supporting a wall, the device having a vertical elongate member to be placed against the wall, and a support structure supporting the elongate member in a vertical condition". The infringement has a support member, but it is 2 degrees off vertical.

1. Does this difference, have a material effect.
2. If not, would this have been obvious to an expert?
3. Would the reader have understood "vertical" to mean *exactly* "vertical", or merely "upright"?

Note that it is unlikely that such an analysis will be required more than once per exam, if that.

#### d) Amendment

If the patent is invalid, then you should propose an amendment (unless it is clear from the exam instructions that this is not appropriate). It is not necessary to prepare a full amended claim set; just an indication of what feature would be added to which claim.

The amendment must still ensure that the patent covers the infringing article.

If any priority claim is necessary for validity, the amendment must be supported by the priority document.

No candidate for the 2006 paper proposed a reasonable amendment.

## General Remarks

### 1. The right answer

Examiners say that there is no right answer, and that they are prepared to award full marks to answers which disagree with their own. This is only partially true. Usually, there are a range of reasonable positions one can take in answering the question, but there are also positions which the examiner regards as so unlikely to be adopted by a court that they simply cannot be awarded marks.

If the patent has only one independent claim, the examiner is almost certain to believe that that independent claim is infringed.

If the patent has only one independent claim, and all other claims are entitled to priority, then the examiner almost certainly believes that the independent claim is invalid.

### 2. Tables

Many candidates find it useful to construct a table of the following kind:

Claim number, or claim element:	Features in D1?	Features in D2?	Features in infringing article?
1.A lamp	P1, L7	P1,L6	P1,L2
- the lamp	P1,L6	P3,L12	P2,L7

having a shade			
- the lamp having a cable	P2, l6	No	P2,L6
2. The shade being green	No	L3, L14	No

This means that, as a glance, it can be seen that claim 1 lacks novelty over D1, that claim 1 is infringed, that claim 2 is novel but perhaps lacks inventive step, and that claim 2 is not infringed.

**However, your answers should not be presented in the form of a table. There are no marks for this.**

**Similarly you will not get marks from presenting your answers on validity and inventive step in the form of a table.**

### 3. Legal Section

Since usually the patent will be invalid, you should be familiar with the procedure for amending it, and with what you can and cannot do until it is amended. This comes up frequently.

You should give realistic advice taking into account who the patentee/infringers are, e.g. who has money to fight the case.

You should take into account the objectives of your client. For example, in the 2006 paper, he was the patentee and might have been driven out of business “within weeks” by the infringer. Obviously an interlocutory injunction was required. Not a single candidate suggested obtaining one.

### 4. For preparing the SG QE Part C

It is extremely useful to do all the past papers several times until you have fully understood what was wanted.

Candidates may also find the following book useful, though the European paper C only tests analysis of validity, not patent infringement/enforcement. Furthermore, European paper C asks you to attack a patent, whereas Singapore paper C asks you to advise your client, which means giving balanced realistic advice, not making strongest case possible.

Chandler / Meinders

"C-Book, How to write a successful opposition and pass paper C of the European Qualifying Examination"  
ISBN 3-452-26087-9

Take part in a patent invalidity/infringement course as offered by ASPA or NUS extension

### 5. Time management is crucial

You have 240 minutes working time

Use not more than 50 minutes for the law questions and use 190 minutes for the infringement/invalidity part.

Split the 190 minutes up into time slots which you dedicate to specific attacks.

Do not start writing until you have fully read the paper and understood it.