

Informal Sharing Session for Singapore Patent Agents Qualifying Examinations 2009

Tim Watkin
Marks & Clerk Singapore

PAPER A

Preparation of a Patent Specification

Topics

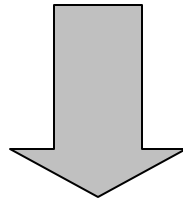
- Claim drafting
- Example problem: the fan (paper A 2007)
- Rest of application
- Why people fail

Paper A – Claim Drafting

- Independent Claims
 - Start with the independent claims. They usually determine whether you pass the exam!
 - Necessary to include multiple apparatus claims?
 - Consider what an infringer might do
 - Key and lock?
 - Necessary to include a Method Claim?
 - Useless if the only possible use of an inventive product is private and non-commercial → No marks!

Paper A – Independent Claim(s)

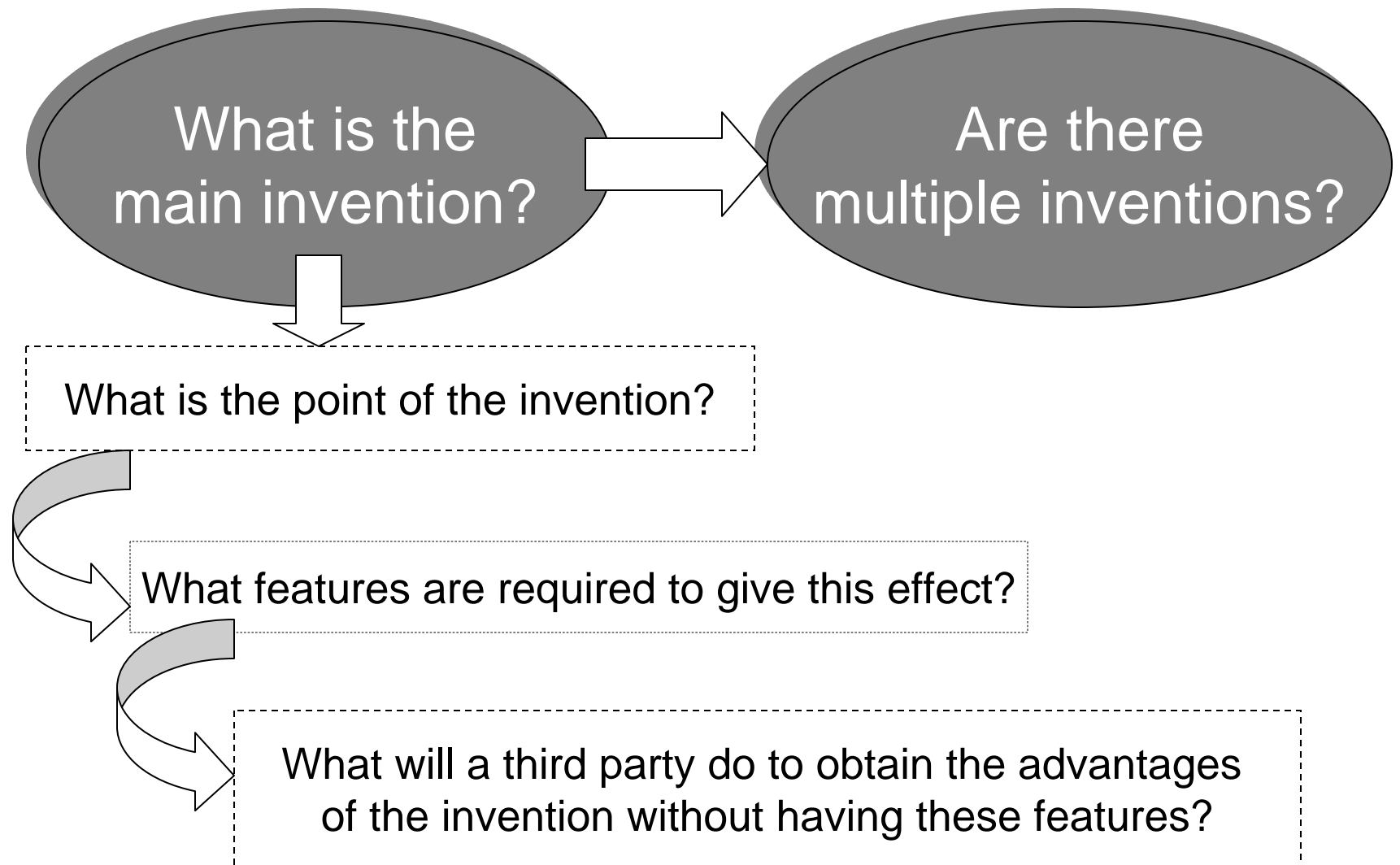
Phase 1
(Forming a mental picture of the invention)



Phase 2
(Expressing the invention in the form of a claim)

Phase 1

Forming a mental picture of the invention



Phase 2

Claiming the invention

Draft as broadly as possible

- BUT include all features necessary to give the inventive effect
- Treat the prior art mentioned as exclusive BUT do not take this to the point of absurdity
- If the client's letter does not use suitable vocabulary, devise some which is better (BUT remember to provide support in your description!)
- Give the field of the invention in the claim pre-amble to eliminate irrelevant prior art.

Phase 2

Claiming the invention

Check your claim

- Do the advantages to be achieved flow from the features named?
 - If you were someone who didn't know about the invention, what will you draw based on the features of your claim?
- Does your claim cover something obvious, even if not specifically mentioned in the prior art?
- How will you work around your claim?
 - Can the claims be avoided by selling integers (e.g. a plug and socket) separately? What is the commercial product? Who are the infringers?
- Do the claims cover the construction when empty, idle, placed on its side, upside down etc?
- Can the claim be made less pompous and more succinct?

Phase 2

Claiming the invention

Dangerous Limitations

- Claiming by result
 - i.e. claiming all arrangements which have a certain advantage (“free beer”)
 - Though functional claiming is acceptable
- Negative claiming
- Number claims
- Grammatical problems and ambiguities

The fan

- Prior art

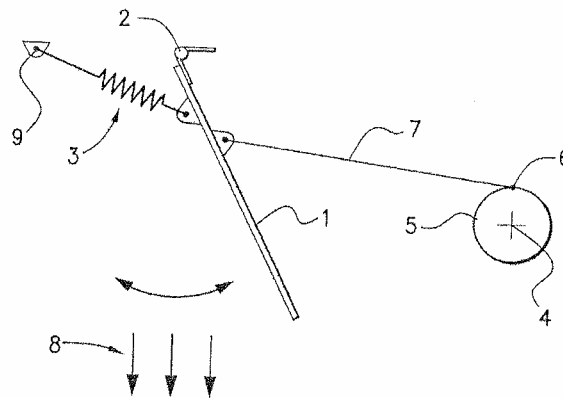
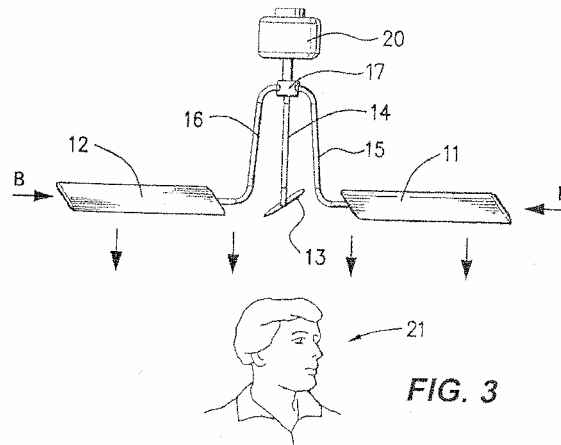
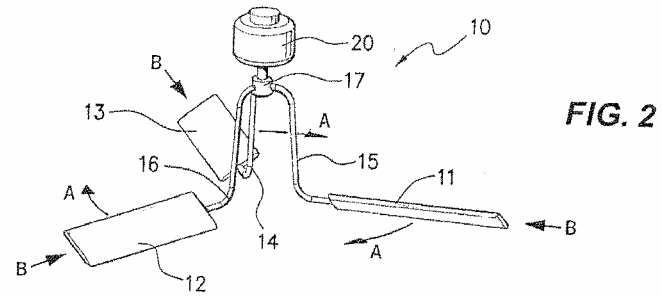


FIG. 1

The fan

- The invention



The Fan

- Acceptable functional claim:
 1. A fan having a plurality of blades, the blades extending from the hub and being angularly spaced out about an axis of the hub, the blades being arranged upon rotation of hub about the axis, to generate a flow of air along the axis.

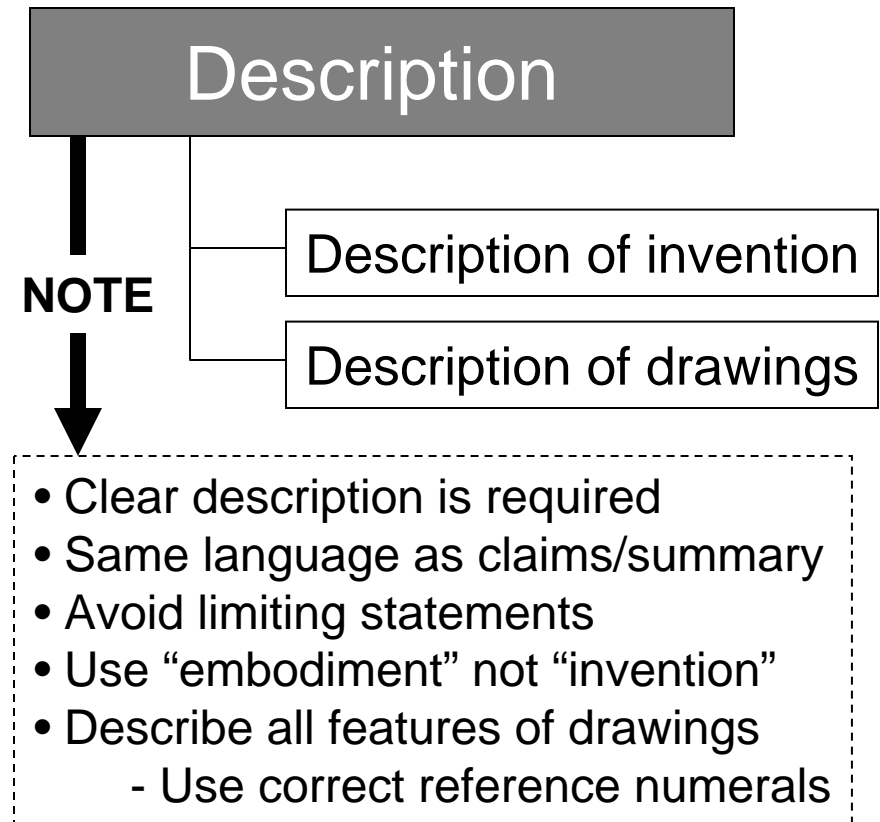
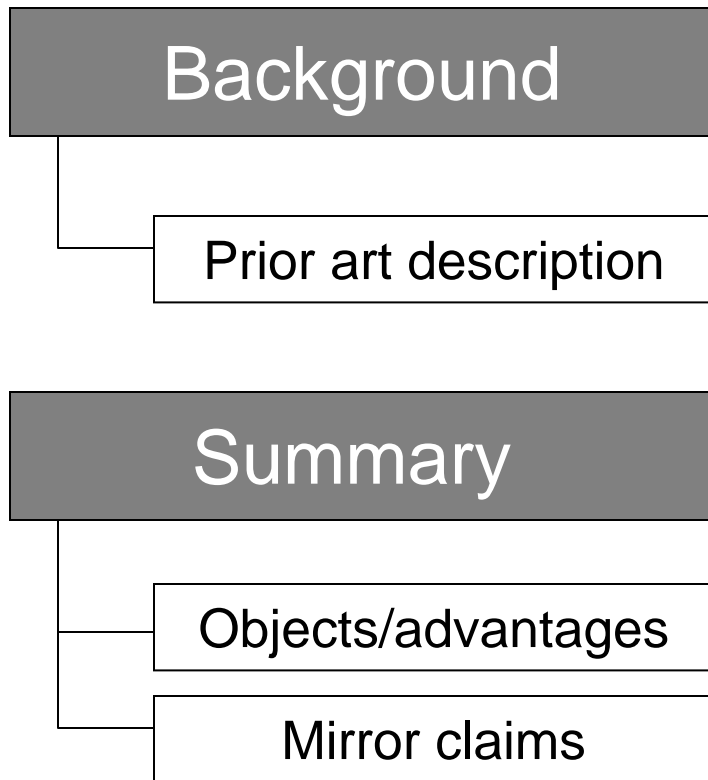
The Fan

- Acceptable structural claim:
 1. A fan having a plurality of blades, the blades extending from the hub and being angularly spaced out about an axis of the hub extending in an axial direction, each blade having a surface inclined both to the axial direction and to a circumferential direction around the axis [, whereby upon rotation of hub about the axis, the blades generate a flow of air along the axis].

Dependent Claims

- Marks are probably only available on the marking scheme for
 - features which are not in the prior art
 - features which achieve some sort of advantage, specified in the description
- Keep the number of dependent claims low.

Paper A – Description



Why people fail paper A

Most common (often fatal) errors:

- Claims cover prior art
- Claims do not cover all embodiments, or obvious variations.
- Claims do not cover actual commercial product (no contributory infringement)
- The Humpty Dumpty Fallacy

Claims do not cover obvious variations

- Paper A 2007:

“The number of blades may be higher than three (though less than two longitudinally-symmetric components doesn’t work,

Claims do not cover actual commercial product

- Paper A 2007:

“A motor 20 (a readily-available conventional product which my customers may buy from the manufacturers directly) is fixed to the ceiling,…”



The Humpty Dumpty Fallacy

`I don't know what you mean by "glory," ' Alice said.

Humpty Dumpty smiled contemptuously. `Of course you don't -- till I tell you. I meant "there's a nice knock-down argument for you!"“ '

`But "glory" doesn't mean "a nice knock-down argument,"" Alice objected.

`When *I* use a word,' Humpty Dumpty said in rather a scornful tone, `it means just what I choose it to mean – neither more nor less.'

`The question is,' said Alice, `whether you *can* make words mean so many different things.'

Lewis Carroll – Alice Through the Looking Glass (Chapter 6)

The Humpty Dumpty Fallacy in Action

1. A fan, having multiple blades fixed to a hub, wherein the fan produces a longitudinal flow of air when the hub rotates.
1. A fan, having multiple blades fixed to a hub, wherein the fan rotates continuously.

PAPER B

Amendment of a Patent Specification

Paper B – Amendment of a Patent Specification

Review the application, rejected claims and the prior art



Find the difference and amend the claims



Prepare response to written opinion



Prepare letter to client

Reviewing the application, rejected claims and the prior art

What is the invention?

- Do different claims of the application have different priority dates?

What is the prior art?

Check the **dates** of the prior art. Is the prior art relevant?

— To which claims? For inventive step, or just novelty?

— Look at the whole prior art and do not simply analyze the prior art claims

Finding the difference and amending the claims

Differences

- Features in the **claims** which are not in the prior art
- Different subject matter
- Different technical problem

Amending the claims

- Include at least one difference between the application and the prior art
- Add new claims if necessary
- Word the claims as broadly as possible but ensure support is present

Response to Written Opinion

List the rejections by the examiner

List the claim amendments

Identify support for the amendments

Explain how your claim amendments can overcome the prior art

Novelty (Preferably short)

Inventive step (Should be well argued)

} Focus on independent claims

Address other objections

Clarity, Unity etc.

Letter to Client

Opportunity to explain to the examiner why you have chosen the amendment!

Client's letter should include:

- 1) Options / alternatives to the current claim amendments, together with their pros and cons
- 2) Divisional required?
- 3) Answers to client's questions

Why people fail paper B

Most Common errors:

- Amended Claims cover prior art
- Amended Claims do not cover all embodiments and commercial products

e.g. Is there a clue in the paper to what the client or the competitor are actually selling? If so, ensure that it is within the claims.

- The Humpty Dumpty Fallacy

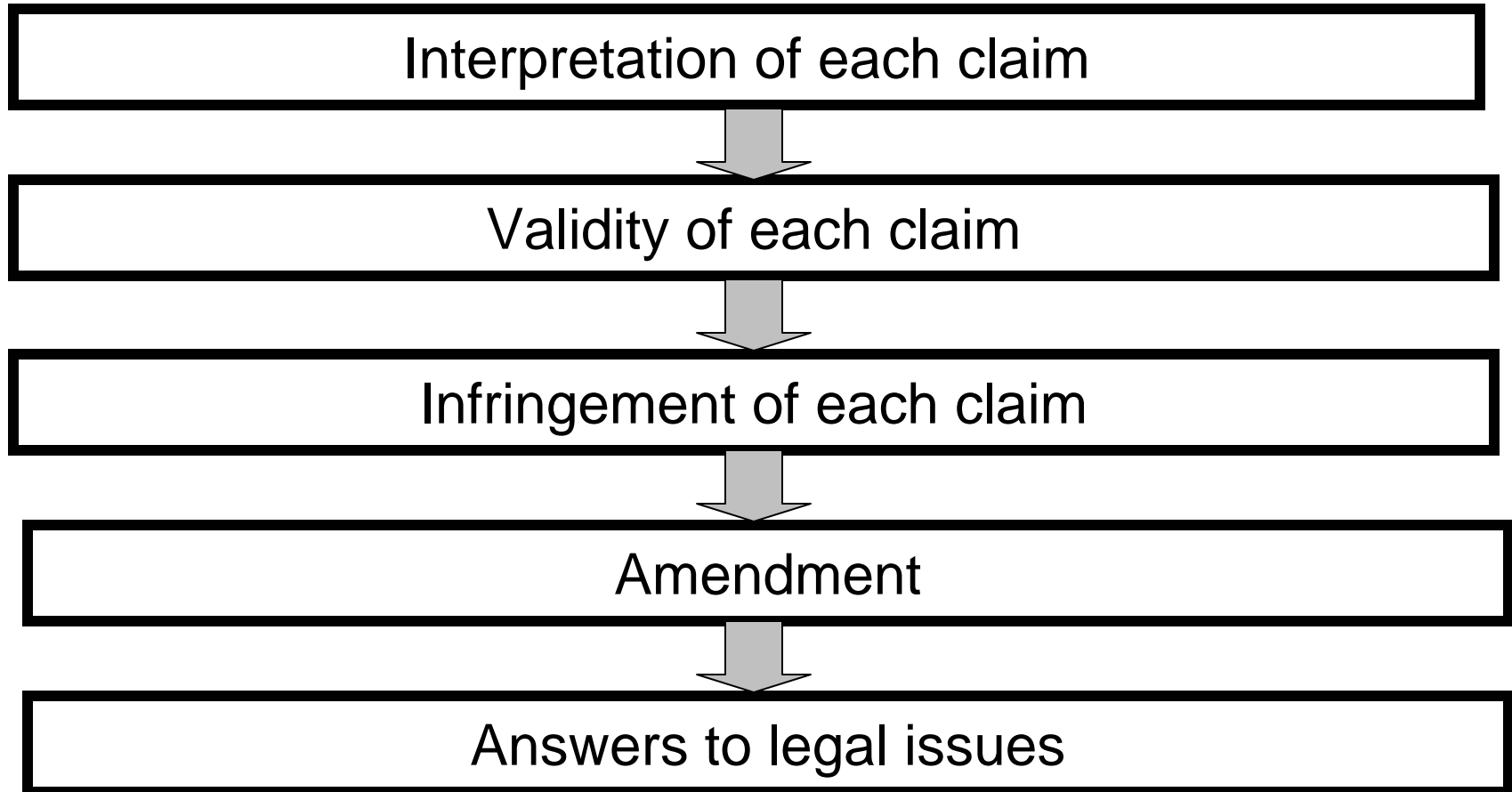
PAPER C

Amendment of a Patent Specification

Topics

- Structure of Answers
 - Interpretation
 - Validity
 - Infringement
 - Amendment
- General Remarks

Structure of Answers



Interpretation

What terms to take into account?

- Many terms have an obvious meaning and hardly require interpretation
- Marks are likely awarded only for words with a certain ambiguity

Principle vs. Practice (in examination)

- In principle: interpretation should take into account the way in which words are used in the body of the patent and not the infringing article
- In practice: there are likely to be more marks on the marking schedule for claim terms which are important in assessing validity and infringement

NOTE: Interpretations are binding for the whole paper

Validity

- Attack each claim combination separately for invalidity, evaluate each claim combination separately for infringement
- When attacking a claim, refer to all elements of the claim
- Match each element in the claim with a specific reference in a prior art document.
- Inventive steps attacks
 - Windsurfer (UK)
 - Could-would or problem-solution (EP)
- Attacks based on insufficient disclosure of subject matter: not wanted!

Infringement

Demonstrating infringement

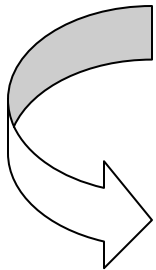
Must show all elements of a certain claim are present in the infringing product/method

Use the same interpretation as before

Infringement

Literal vs. Non-literal infringement

- If an element is not literally present, the claim is not literally infringed. But it may be on a purposive construction of a claim term.
- This purposive construction could emerge naturally from your construction of the claim term (e.g. what does “vertical” mean?).
- Alternatively, non-literal infringement may be found even when the variation is not suggested by a natural interpretation of a claim term



The “Improver questions”:

Improver Corporation v Remington Consumer Products Ltd

(but see *Kirin-Amgen v Hoechst Marion Roussel*, which emphasized that this is just an aspect of purposive construction)

Amendment

- If the patent is invalid, propose an amendment
 - Not necessary to prepare a full amended claim set
 - 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

General Remarks

- The right answer
- Using tables
 - Perhaps useful for yourself.
 - But do not present your answers in the form of a table
- Legal Section
- For preparing the SG QE Paper C
 - Do past year papers
- Time management
 - Remember! Only 240 minutes of working time!

THANK YOU!

- Website: <http://www.marks-clerk.com/>
- Email: mail@marks-clerk.com.sg