

## Answer Guidelines to QE 2007 Paper B

Note: The answer guidelines contain a non-exhaustive list of points which examiners expect candidates to cover in the answer to this Paper.

### QUESTION 1

D1 - the rejection for lack of novelty for claims 1-4 is correct, but not for claim 5. However, this feature is only disclosed in the SG patent application in the claims so the candidate should comment that the specification and drawings should be amended to include this feature and that this is not new matter because the claims are part of the specification.

But,

D1 doesn't teach, suggest or disclose multiple switches for actuating the blades;

D1 doesn't teach the blades having a sliding movement between the retracted and extended positions; rather, D1 teaches the blades pivoting about an axis;

D1 doesn't teach or disclose 2 bulbs.

D2 - the rejection for lack of inventive step for claims 1-4 is correct but not for claim 5, but see the comment above regarding claim 5 that the key ring is not shown in the drawings nor disclosed in the detailed description.

But,

D2 doesn't teach plastic housing (silent on housing, but says can be like Swiss army knife, which has plastic face). Good if candidate mentions this but not required to have specific knowledge of this fact.

D2 teaches the blades pivoting about an axis instead of sliding between retracted and extended.

Therefore, amend claims to include sliding/retracting of blades; and switch activated blades. Then argue patentability based on these features.

#### *Examiner's Comment.*

Bear in mind that candidates should cite support in specification for comments and claim amendments.

### QUESTION 2

- Claim 5 is not shown in the drawings nor disclosed in the detailed description so the claim should be cancelled or the specification should be amended to describe this feature.

- putting the dimensions in claim 3 is unduly limiting on the claims that depend therefrom.

- new claim for two bulbs (see below).

- claim 1 needs to include switches and/or how the blades slidably extend/retract.

- fix two antecedent bases in claim 1.

- comment on and/or change "consisting" to --comprising-- in claim 2.

- no switch defined prior to claim 4, which recites other switch, so have to define switch before claim 4.

- new claim with plural switches or a claim to a release switch.

- new claim directed to features client specifies as most important, plastic housing and ceramic blades.

1. (amended) A multi-function tool, comprising:  
a housing having a centrally located opening on a longitudinal end thereof;  
and  
a plurality of blades disposed within the housing wherein the blades are individually movable between ~~a~~ the first, retracted position and ~~a~~ the second, extended position in which a selected one of the blades extends from the housing by way of the opening;  
wherein the housing is formed of plastic the blades are movable laterally between the first and second positions.

Alternative amendment to claim 1:

at least one switch for moving the blades, individually, between the first and second positions.

Not required to remove plastic from claim 1, but preferred.

2. (amended) The multi-function tool of claim 1, wherein the blades ~~consist of~~ comprise a knife, a scissors and a screw driver.

Not a required amendment.

3. (original) The multi-function tool of claim 2, wherein the housing is rectangular in shape and has dimensions of 8cm x 4cm x 2cm.

4. (amended) The multi-function tool of claim ~~3~~ 6, further comprising a flashlight having at least one bulb located proximate to the opening, a power source disposed within the housing for illuminating the at least one bulb, and a switch disposed on housing proximate the other switch for electrically connecting the power source and the at least one bulb.

5. CANCELLED (or amend spec) The multi-function tool of claim 6, wherein the housing includes an integral ring formed on or within a surface thereof for allowing a key ring to be attached thereto.

6. (new) The multi-function tool of claim 1, further comprising at least one switch for moving the blades, individually, between the first and second positions.

7. (new) The multi-function tool of claim 6, wherein the at least one switch for moving the blades includes one switch for each blade.

8. (new) The multi-function tool of claim 4, wherein the at least one bulb comprises two bulbs located on opposite sides of said opening.

9. (new) The multi-function tool of claim 1, wherein the housing is formed of plastic and the blades are formed of ceramic.

### QUESTION 3

1. Discuss the written opinion and the response to the written opinion
2. Discuss the claim amendments and the new claims.
3. Issues raised in Letter to Client

- Filed in SG on 5 Jan 2007 and client will sell in HK, China, Malaysia and Indonesia. Therefore, file corresponding applications in China, Malaysia, Indonesia via Paris or PCT (Taiwan is not a PCT country so file via Paris; HK you get with China).

4. Key ring feature not shown or described in application. Cannot add new matter. Is it important? File a new application that includes this feature?

5. Bypassing airport security with a blade should not be a selling point. Potential liability of aiding and abetting terrorism. Not expected to know law but maybe state that you could look it up or consult with an attorney.