

Answer Guidelines to QE 2007 Paper C

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

Below, detailed comments on the questions have been stated. Candidates should note that marks could have already been achieved by evaluating the priority dates of the four claims, by assessing infringement of Claim 1 and by riding a novelty attack against this Claim 1. Only one single interpretation of the claim wording was necessary for this.

<p>1. Law questions in the letter to the candidate</p>
<p>a) claims 1 and 2 benefit from the 1 September 2004 priority claim 4 benefits from the priority of the filing date of 1 September 2005</p>
<p>b) claim 3:</p> <p>candidate must discuss S80(1)(f)(ii) as possible ground of revocation: “any misrepresentation”, applicant possibly filed a wrong described document for the grant of the patent S30(2)(c), R47(4A), PF14, declaring that the filed documents comply with S30(3)(b), S2(4) Patents Act with respect to the examined wording “... the switch assembly comprises a sensor for detecting an environmental measurement value” and the wording “motion sensor” in the granted claims.</p> <p>Have in mind that the patent owner could instead have chosen the more secure wording “... the switch assembly comprises a sensor for detecting an environmental measurement value in the form of a motion sensor”.</p> <p>The following chain of provisions would be wrong: S80(1)(f)(ii), S30(2)(c), R47(4A), PF14, S30(3)(c), S2(4) because we have a national Singapore search and examination (see letter to candidate).</p> <p>An analysis of S2(4) is expected, what is :</p> <ul style="list-style-type: none"> - The “claim” - The “another claim” - What is “limitation”, what is “in expression”, what is “content”? - Identifying the concrete difference between the limitations in the granted claim 3 and the limitations in the examined claims. - Identifying whether the difference is only in expression as mentioned in or also in content. <p>There is no case law on this question. There is also no international comparison possible as the above-mentioned set of regulations is uniquely known under Singapore law. If the answers are properly presented and the underlying problem is fully discussed, both answers “invalid” or “not invalid” received marks.</p> <p>Candidate must also discuss whether the claim 3 is forbidden added subject matter S80(1)(d)(i).</p>

c) document D4 (Mr. di Rubare's talk) is prior art only for claim 4 which only benefits from a priority of the filing date

d) compensation to Mr. di Rubare?

S76(1) Damages since publication of D1, therefore assessed on the 100,000.00 S\$ profit from April 2006 to June 2007.

S69(1) No damages if infringer is not aware of the patent.

Under Section 69 it is not enough for a defendant to establish that he was not aware of the existence of the patent. He must also show that he had no reasonable grounds for supposing that the patent existed. Section 69 is generally interpreted as meaning that to gain the benefit of this provision a defendant should have at least made some effort, for example by a search, to find out if there is a patent for the product he is proposing to put on the market. To do nothing and just claim not to have known there was a patent may not be sufficient.

The S69(1) defence is only possible if the client should not have known of the existence of the patent; if the client were a large company, case law would not accept ignorance as a defence. So there should be marks for pointing out that it is relevant how large Securistick is. The client's letter says that they are small.

Examiner's Comment.

Creative answers on "what can we do?" will be rewarded, e.g. suggestion to approach the patent owner with a licensing request.

2. Infringement

candidate must check all four claims on the SECURISTICK device

Claim 1:

This is intended to be a simple ice-breaker.

Claim 2:

"Switch assembly", the Securistick manual is silent about that feature, the Examiners want to see how the candidate copes with this problem.

"disposed within". The Securistick manual tells "at the outer surface", is it equivalent to "within"?

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.

Both results "infringed" and "not infringed" have been accepted if the above mentioned issues are covered by the answer.

Claim 3:

Easy, see last line of D6. Answer must be in line with the answer to claim 2, if not then negative bias for the candidate.

Claim 4:

The Securistick Manual is in fact silent about the material of the pad. It states "DYCEM2005" and it is true that the Dycem Ltd. Announced in their patent application D3 that they intend to name the material therein with the trademark "DYCEM2005" but this has nothing to say. Extra evidence would be needed if one would like to rely on that information.

However, in the letter to the candidate the infringer admits expressly that he is using the material of claim 3.

Result: all four claims are infringed or claims 1 and 4 are infringed.

3. Invalidity

claim 1

D2 can be used for a novelty attack S14(1)+(2) against claim 1, despite not showing the feature "for a door" of claim 1 (interpretation required)

discussion for the feature "for doors": The only hint towards a door in D2 is the remark "The brace prevents entry to a room by pass keys" in the abstract. One could say that the element "door" is implicitly/inherently disclosed in D2.

The candidate should also say that the feature "for doors" is not limiting because this feature means "usable for doors" and he may also say that D2 does not state anything that the security brace therein is not useable for doors.

A good answer refers to the embodiments in the figures and not to the wording of claim 2 of D2.

claim 2

inventive step attack S15 using D2 + D5

claim 3

discussion of S2(4) with S82(1)(a), S30(3)(b) - see law questions above

none of the documents describes a motion sensor

claim 4

Document D3 cannot be used for an inventive step attack against claim 4, S15 + S14(3).

Inventive step attack S15 using D2 (electrical length adjustment + remote control) + D4 (D2 " propylene glycol adipate" + hint on material in D1 "... but high molecular weight plasticisers, such as chainstopped poly (propylene glycol adipate) or poly (1,3-butane diolazellate), are preferred, because of their lower volatility."

The expressions "DYCEM" and "DYCEM2005" in the documents D1 to D6 have no specific meaning with respect to the elements of claim 4.

Good candidates would emphasize that this is not an inventive step attack out of three documents, because the element "high molecular weight plasticiser" is inherently/implicitly disclosed in D4.

Good candidates would mention that extra evidence should be provided for D4, such as the names of the participants at the talk on the public trade fair.

D4 says "woven" and not "fibre" as in claim 4, so some discussion/interpretation is needed here.

There was an ambiguous wording on p3 of D4: "The surfaces 54 and 56 are preferably covered with a non-abrasive material, such as an elastomeric pad 60 made from DYCEM material to prevent scratching of the door surface when put in place and removed." This wording cannot be combined with D3.

BTW, There is a second ambiguous wording in D5: "Preferably, suction cup 26 is made of a very flexible plastic (DYCEM material) ..." This wording cannot be combined with D2 and D5.

4. Amendment

There was no amendment part this year.