INTELLECTUAL PROPERTY
OFFICE OF SINGAPORE

Answer guidelines to QE 2004 Paper B

Note: The answer guidelines contain some points (non-exhaustive) that could be covered in the answer to this Paper.

A. Prior Art Analysis & Arguments

1. Claim 1 is neither novel nor inventive over Document D as it discloses all features claimed.

2. Claim 2 is neither novel nor inventive over Document D as it discloses the 90º angle.

3. Claim 3 is novel and inventive over Document D as none of the features in claim 3 are disclosed in Document D.

4. Claim 4 is dependent on claim 3 and it is therefore novel and inventive over Document D.

5. Claim 5 is novel over Document D and is probably inventive over Document D due to the different segment sizes and the described advantages that it gives.

6. Claim 6 is neither novel nor inventive over Document E as all features of claim 6 are disclosed in Document E.

7. (a) Claim 7 in clauses (a) and (b) introduces additional features that make claim 6 consistent with claim 1. These features are not disclosed in Document E. Therefore, it is valid over Document E.

   (b) But are they inventive over the combination of Documents D and E? Document E refers to Document D so there is a prima facie case that it is a valid combination. However, by virtue of Section 15 of the Patents Act even though Document E refers to Document D, Document E cannot be used for inventive step considerations. As such it is not a permitted combination. Therefore, features (a) and (b) of claim 7 are novel and inventive over Document E, and Document D when considered separately.

   (c) Feature (c) of claim 7 is novel and inventive over Documents D and E, both separately and in combination for the same reasons as for claim 3. It also gives unity of invention.

8. Claim 8 is dependent on claim 7 and is therefore novel and inventive.

B. Amendments

1. Combine claim 3 into claim 1 to create a valid claim;

2. Make old claim 4 new claim 2, and old claim 2 as new claim 3 with the angle corrected to 90º; and change dependencies/appendices;

3. Renumber old claim 5 as new claim 4 with changed dependencies/appendices;

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4. Renumber old claim 6 as new claim 5 and combine with features (a) and (b) of old claim 7 to give validity, and optionally[1] feature (c) of old claim 7 to give unity; and

5. Renumber old claim 8 as new claim 6 with changed dependencies/appendices.

Correction of Error

The correction of the error raises:

(a) The obviousness of the error; and

(b) The obviousness of the correction.

All references for the first cutting wheels 40 are for 9º. However, on page 5 line 5 there is a reference to 90º. The 90º angle is therefore supported by the description. The drawings show 90º. The prior art Document D also refers to 90º so it is an angle known to a person skilled in the art. Given the functional statements in the description and the extent of the disclosure the error is obvious and so is the solution so the correction should be allowed.

C. Advice to Client

An alternative to claim 3 is claim 5 but as the features are in consequence of the moveability, they are lesser features and are not as suitable for combining into claim 1.

Unity:
For the objection to lack of unity of invention to be overcome under Singapore law the inventive concept of the original claims 1 and 6 must be the same due to the special technical features being the same.

Proposed claim 5 does not have this unless feature (c) of original claim 7 is included.

The options available to the client are to restrict proposed claim 5 by adding the feature of old claim 7(c) thus providing the same special technical feature in both independent claims; divide claims 7 to 10 (Section 26(6)); or ignore the issue and risk Section 30(3) problems later.

Candidates are to discuss if the amendment with 7(c) is overly restrictive.

[1] If marks have been awarded to the candidates for this answer in Section B, none will be awarded if the same answer appears in Section C.