

## **Examiner's comments on candidates' performance in QE 2005 Paper B**

Exam paper B concerned analyzing an invention as disclosed in a specification including claims, reviewing a Written Opinion, analyzing cited prior art, and based on the results of the analyses, drafting an amendment and response to the Written Opinion (WO), as well as a letter to the client answering certain client questions and providing advice on how to respond to the WO.

The subject matter related to a bowl used for cooking, so the technology was low-tech and could be (or should have been) easily understood by all candidates. The goal of directing the examination paper to an easy technology was that the candidates are not lost in, and therefore have to spend much time with the understanding of the technology, but can concentrate on the substantial patentability issues involved.

Compared to earlier years' Paper B exams, in order to draft an amended independent claim, which is broad enough, it was necessary to add features to the independent claim from the description of the invention, since a simple addition of features of a dependent claim into the independent claim, like those of original claims 3 or 4, would have resulted in arguably patentable subject matter, but would have nevertheless unnecessarily restricted the scope of protection.

Credits were broken into three areas, claim amendments; draft response to WO (including prior art analysis and arguments); and client advice letter.

Every candidate amended the independent claim, however, some candidates failed to indicate that such an amendment was necessary. Namely that original claim 1 was anticipated by both references D1 and D2.

Even fewer candidates addressed the question of patentability of the original dependent claims 2 to 6.

Regarding the original claims 2, 3 and 4, and the corresponding objections in the Written Opinion (novelty of claim 2 and inventive step of claims 3 and 4) two issues were involved; one regarding the relevance of D2, the other regarding the "bain-marie" cooking function of the bowl as it was pointed out in the client's letter.

Most of the candidates spotted the issue that D2 should be taken into consideration with regard to the question of novelty and not inventive step, however, did not articulate the reasons why. Apart from a simple statement, very few candidates pointed out that the earlier application is also a Singapore application and that the priority claim is (with high probability) valid, since the application is a word-by-word translation of an earlier Italian application, as was stated at the beginning of the description of the application. Therefore, candidates did not seem to appreciate that D2 did not have any relevance, if it had had been a non-Singaporean application and could have been fully relevant – i.e. with regard to the inventive step, too – if the priority claim had not been valid. Furthermore, many candidates stated that D2 is relevant with regard to the novelty only, but have then

nevertheless argued for the inventive step of the claimed invention in the light of the disclosure of D2. Errors that could have been easily avoided!

Many candidates did not realize – whether in the amendments, the arguments or the client letter – that the intended use of the bowl according to the invention (“bain-marie” cooking) is irrelevant regarding the assessment of novelty over D2. Even worse, some candidates have made amendments in the independent claim to include this purpose of use without adding any structural features to the claim to support such use. Only one candidate explained quite clearly that as long as a reference – here D2 – discloses all technical features of the invention as claimed, the claimed invention is not new over this reference irrespective of the question whether the intended purpose of use of the claimed bowl is mentioned in the reference!

Regarding original claim 7 some candidates failed to notice that “omnibus claims” (i.e. claims purely making reference to the descriptions and/or drawings) are not allowed in Singapore, like in some other countries. In this regard it should be noted that the exception provided for in Rule 19(9) of Patents Rules should only apply under extreme circumstances and is, therefore, to be interpreted very narrowly. In the present case a reference to the drawing and/or description was clearly not necessary to enhance the clarity or conciseness of a claim.

Regarding amendments of the independent claim, the description and the original claims have provided several possibilities. One preferred feature to be added to the independent claim to achieve patentability was that the hollow body comprises in its region adjacent to and above the thermal base at least one step. However, other amendments were also accepted and marked with the same notes as long as they were new and inventive (with a corresponding good argument in the draft response) over the cited references, and did not unnecessarily limit the scope of protection.

Many candidates appeared to have wanted to delimit the independent claim with said feature, but failed to word the claim accordingly. What a waste! It cannot be over emphasized that correct claim wording is of utmost importance. As an example, some candidates amended claim 1 “almost” as said above, but left out the “adjacent” limitation. However, without the “adjacent to” limitation, such a claim 1 was not new over D2!

Some candidates limited the independent claim by the stainless steel feature of the bowl, which was only mentioned in the abstract. According to Section 84(2) in conjunction with S25(3) this amendment would not introduce new matter, however, can only be claimed, if this feature is supported by the description (S(25(5)(c))). Even though such an amendment was accepted, an accordingly worded new claim 1 unnecessarily restricted the scope of protection. Further, it should have been expected from the candidates to make some reference to S25(5)(c).

Regarding the arguments in the response letter, it should be noted again that a patent agent must have the ability to put thoughts into writing in a structured manner. Many candidates were “jumping” back and forth between different issues. The reader, the patent examiner, should be able to clearly understand the response

on its own without the need for additional thought to try to determine what was meant.

In this context it is to be noted that many candidates did not clearly differentiate between novelty and inventive step. Some may argue that inventive step would follow from novelty, or just repeat more or less the same arguments for both novelty and inventive step. That is clearly wrong.

As mentioned above, many candidates have judged document D2 correctly regarding inventive step, but nevertheless used that document when discussing the question of inventive step.

Like in previous years, a common mistake in the papers was that arguments regarding novelty/inventive step were presented in the response letter based on features of the "invention", but not on the claimed invention! Obviously, such arguments miss the target and are irrelevant for patentability.

The poorest part of all answer scripts was clearly the client advice letter. Candidates were expected to 1) answer the comments/questions posed by the client; and 2) to advise the client about different options for a new claim 1.

As to 1) candidates should have indicated in their letter to the client that (as already explained above) a) non-disclosure of the "bain-marie" function in the cited references is irrelevant as long as the novelty of the claimed subject matter is concerned, and b) claim 7 as originally worded is not allowed.

As to 2) candidates should have indicated at least some (we expected three) useful alternatives to word a new independent claim along with the pros and cons of the alternative solutions. Very few candidates gave alternatives and even if they did so, they failed to comment thereon. Candidates still "forget" that the final decision to which subject matter a new independent claim should be directed, is with the client. Patenting is not about overcoming the examiners' objection and to get a patent for something in which the client might not be interested. Patenting is about obtaining protection for what the client considers important based on his business decisions. One may draft the broadest possible claim and get a patent granted therefore. It may nevertheless be of no value to the client if it does not cover his actual products. Rather, based on his business, client may want to have the independent claim directed to another feature, even if a claim based thereon would comparatively be narrower.