



Examiners' Comments on Candidates' Performances in QE 2009 Paper C

General Comments

1. Overall, there was a better standard this year than in previous years. Few, if any, candidates submitted answers which showed them to have no grasp of basic patent concepts.
2. A minority of the answers were well structured, reasoned and gave clear, helpful advice to the "client".
3. The majority did not give themselves the best chance of passing because of one or more of the following:
 - included lengthy discursive summaries of the law or of the question
 - gave disorganized answers providing useless or no advice.
 - made assertions not backed by reasons
 - did not answer all of the specific questions posed by "client"
 - wasted time by interpreting claim terms that had no bearing on infringement and/or validity.
 - did not generally display good time management.
4. Generally, amendment possibilities (an important issue) were not well-considered. (see paragraphs 19 & 20 below)
5. Future candidates and their supervisors should read carefully the advice on the IPOS web-site.
6. Nearly all candidates scored poorly on providing advice to the client. Candidates should therefore familiarize themselves with the Singapore Patents Act before sitting this examination.
7. Also, a small number of candidates showed a poor understanding of basic claim analysis by concluding that claim 1 was novel and then advising that its dependent claims lacked novelty.

Detailed Comments

8. It is not absolutely necessary to separate the interpretation of the claims from the other parts of the answer, but in the present examiners' view this does help a great deal. For one thing, it makes it easier to adopt a consistent interpretation when addressing different issues. It makes it less likely that candidates will forget to interpret any important word. It also makes it less likely that the examiners will overlook marks that candidates have earned.
9. Interpretation is not about giving examples of what a phrase covers (one candidate interpreted the term "simple action" in claim 1 by writing "Simple action



- = left, right, up, down"). It is about giving a definition to an intrinsically unclear term. For example, "simple action" is contrasted in patent SG1000 with the "compound action" of pressing a button more than once (see page 7, line 15 of SG1000), from which it appears that "a simple action" means a motion which is uninterrupted and in a single direction.
10. More generally, which words should be discussed during the interpretation section? Candidates should look for words which are capable of more than one meaning, particularly if those different meanings will impact on the validity/infringement analysis. There is no need to interpret "a plurality", for example, because this is clear.
11. To give another example, consider claim 2. There are two interpretation issues:
- (i) what do "left", "right", "up" and "down" mean, considering that the user can orientate the device in any direction? Presumably they are directions lying in the plane of the surface, and as perceived by a user facing the surface (i.e. the view shown in the figures 2 and 3 of D1). This issue is worth a few marks, but is not critical because there is only one reasonable interpretation.
- (ii) what does "or" mean? The word "or" means different things in different contexts. In the phrase "I will go to KL or Bintan at the weekend" it means that I will go to exactly one of these destinations. But in the phrase "KL or Bintan would make a good weekend destination", it means that both places are suitable. What does "or" mean in claim 2? The answer is critical for determining the relevance of Document A, in which one knob can be moved "left or right" and the other "up or down". So each knob can move either "left or right" or "up or down". Is this the same as "left, right, up or down"? In fact, in claim 2 "or" probably means that each key element can register motions in all four of these directions, since the key in the embodiments can be moved in all four ways. This is clearly how "or" is used at page 7, line 10 of D1.
12. All this must be spelt out. A candidate whose interpretation of claim 2 simply reads "normal meaning of movement in any one of the directions", has not said enough about either issue to earn any marks. He has not appreciated the ambiguity. Furthermore, his interpretation is as ambiguous as the original language.
13. Other contentious words or phrases that should be interpreted in this paper are: ~~"simple actions"~~, "array", "key elements" and "alphanumeric". Some candidates were inconsistent with their analysis by interpreting a word to have a defined scope and then contradicting their interpreted scope when assessing validity and infringement. Most candidates wasted time by interpreting nearly every word or phrase in each claim.
14. Candidates often talk about "narrow" and "broad" constructions, and then arbitrarily select one of them. This is not a helpful approach to interpretation. Instead, candidates should look in the specification to find a hint of what is meant, as in the discussions above. Remember that "purposive interpretation" is not just a buzzword to be applied at random. It means giving a reasoned



argument to establish what a skilled reader of the specification would have thought the author of the specification meant.

15. One or two candidates treated the whole paper as arguing a case (e.g. one candidate said he would not make a certain argument in relation to validity because it would undermine a position he had “argued earlier to avoid infringement”). This misunderstands the purpose of the paper, which is to give an impartial view of the situation: a prediction of the position a judge would take. In this sense, the present paper is different from Paper C of the European Qualifying Examination, reflecting the fact that in Singapore patent agents hardly ever act as advocates in contentious proceedings.
16. Some candidates disturbed the examiners by not taking a definite position (“Claim 4 may not be related to the others”). Similarly, it is not sufficient to state that a certain claim “arguably” lacks novelty. Almost anything is “arguable”. Candidates have to take a position on whether, on balance, it actually does lack novelty.
17. One or two candidates were apparently unaware of the problem of unrelated claims. Considering that most patent trainees are presumably engaged in prosecuting Singapore patent applications on behalf of foreign clients, it is concerning that they are unaware of this issue, which arises in a high proportion of cases, and which is perhaps the most unusual feature of the Singapore patent system.
18. Also, few candidates considered the possibility of the patentee requesting post-grant examination to address the problem. Easy marks. Furthermore, even if candidates decide, correctly, that claim 4 is not enforceable at present since it is not related to the examined claims (Sec 69(3)), this does not mean that candidates should ignore it from the point of view of infringement and validity relative to the citations, not least because the claim might be enforceable after the post-grant examination.
19. It is also worth candidates studying the issue of post-grant amendment. For obvious reasons, this issue comes up almost every year, yet few candidates this year pointed out that the circumstances suggested that this discretion would not be exercised, and almost no-one mentioned that the need for an amendment might have an effect on back-damages. Easy marks again.
20. There are usually a few marks on the marking schedule for suggesting an amendment. This year marks would have been awarded for suggesting one of several possible amendments (e.g. suggesting copying “associated with a plurality of respective alphanumeric characters” from claim 4 into claim 1). It would have taken only a few seconds to earn these marks, since the candidate did not have to write out the complete amended claim 1. However, do not suggest an amendment which excludes the infringing product.