

Answer guidelines to QE 2009 Paper C

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

Note: No marks will be awarded for the citation of provisions or reference to patent forms and fees.	
Interpretation	Claim 1 “key elements” “array” “simple actions” “on the surface”
	Claim 2 “left”, “right”, “up”, “down” “or”
	Claim 3 “alphanumeric characters” (the interpretation should make the point that there is no limitation of one character per “simple motion”, since this issue has a bearing on whether the claim is novel over document A). Note that the examiners consider that this term does not require that there are both letters and numerals, but this point is arguable and marks are not removed for candidates who take the other view.
	Claim 4 “for use in a mobile telephone” “associated”
Infringement	Claim 1 Yes?
	Claim 2 Yes?
	Claim 3 Yes?
	Claim 4

	Yes?
Validity	<p>Claim 1</p> <p>Lacking novelty over A?</p> <p>Lacking novelty over B too (i) if national phase entered with extension (as it should be), or (ii) if B is full prior art.</p>
	<p>Claim 2</p> <p>Lacking novelty over A, since one knob moves left and right, and the other up and down? It is the examiners' belief that forward/backward meet "up"/"down" requirement, but a candidate who argues convincingly otherwise is not penalized.</p> <p>Lacking novelty over B?</p>
	<p>Claim 3</p> <p>Lacking novelty over A since there is no mention in claim 3 that there are <u>respective</u> characters per key, and document A shows characters. However, the marks can also be awarded to a candidate who argues that there is novelty (though not inventive step) over A because "alphanumeric" implies the presence of both letters and numerals.</p> <p>Valid over B in case (i),</p> <p>but in case (ii) validity depends upon whether B can be combined with the conventional phone described in the patent (no?)</p>
	<p>Claim 4</p> <p>Apart from the issue of the claim not being related to the examined ones (which is dealt with in the "legal issues" section below), claim 4 is valid probably, since novel over A and B, and hard to combine any of these with the conventional phone.</p>
Advice to Client (including 'Amendment & Advice on Amendment')	Claim 4 is not related to examined claims, hence no damages can be awarded in respect of the patent unless the problem is cured, (Sec 69(3))
	Fairlie should enter national phase for document B to make it prior art
	By paying the grant fee with unrelated claim 4 in place, there was a misrepresentation: a possible ground for revocation. (Sec.80(1)(f), see also the declaration in relation to Sec. 30(3)(b) required on form PF14)
	<p>This can be perhaps be cured by requesting post-grant examination. (Sec. 38A(1)(a)(i))</p> <p>So, Fairlie should apply for revocation before IPOS quickly thus closing the re-examination option. (Sec. 38A(6))</p>

	In this case, Fosco would have to apply for discretionary amendment during the revocation proceedings, to cure validity problems
	There are many possible amendments, such as deleting claim 4, and adding to claim 1 the feature “simple actions associated with a plurality of respective alphanumeric characters” from claim 4.
	Good chance that discretionary amendment would be refused due to: misrepresentation and knowledge of document A before grant
	Damages might run from publication of the application leading to SG1000 But could be jeopardized due to: (i) Sec 69(3) as discussed above; (i) Request for post-grant amendment; (iii) Also, due to ignorance of the patent (Sec. 69(1)). But should the large company Fairlie with a history of conflicts with FosCo, have been monitoring Fosco’s patents? (See the cases referred to under part 62.03 of the CIPA Guide to the Patents Act, 6 th edition, where it is written: “A company with a research and development department, or its own in-house patent department, would seem rarely to be able to take advantage of the provision because of the presumption that departments ought to take steps to become aware of patents in their field of interest”)