INTELLECTUAL PROPERTY OFFICE OF SINGAPORE

Answer guidelines to QE 2010 Paper C

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

	General Marking Scheme **1. Infringement** **2. Validity** **3. Misc Issues**
1.Infringement	
1.1 Interpretation of claim terms The embodiments in SG1000 are similar to the infringing product, so there are relatively few terms in claims 1 and 2 which require interpretation. Mainly they relate to the undersea application of the Windy product.	<u>Claims 1 and 2</u> "For gripping a safety cable of a children's playground" " rider for a harness"/"for connection to a harness" <u>Claim 1</u> "Resilient means" <u>Claim 2</u> "along substantially the whole of the channel" "towards an opposing surface" - note that strictly speaking the teeth of the embodiments (and the Windy product) are urged towards a <u>gap</u> in the opposing surface. <u>Claim 3</u> "independently"
1.2 Comparison of interpreted claims to Windy Product	"For gripping a safety cable of a children's playground" "A rider for a harness"/"For connection to a harness." - In deciding whether to aware the marks above, consider whether the candidate interprets these limitations widely enough to cover the second application of the Windy product, to undersea robots? The marks cannot be awarded if the candidate has not even realized there is an issue here. "Resilient means" "along substantially the whole of the channel" - note that in the Windy product the teeth are spaced

	from the end of the housing. Marks are given for any relevant comments and conclusion which do not contain a clear error (such as referring to “equivalents”, which are not part of Singapore law). Among the issues which can be raised are that: • SG1000 gives no indication of why this feature is important, so perhaps a purposive construction would no require strict accordance with a literal reading of “whole”, especially in view of “substantially”. Fig 5(c) shows that the teeth do not extend exactly to the end of the channel. A possible reading of the claim is thus that the teeth extend along most of the channel. • The “channel’ could interpreted as the part of the housing where the teeth are present (a doubtful point, but not clearly wrong). • It might be useful to consider the “Improver questions”, though these are now seen as secondary after the 2004 Kirin-Amgen decision. Any one of these points, clearly made, would be enough to score marks. “towards an opposing surface” - see comment above about the slot in the Windy product’s housing Claim 3 is infringed if claim 2 is.
2. Validity	
2.1 Are the claims “related” to the allowed claims of US2? Note: since we have no case law to guide us, the marks can be gained for appreciation of the issue, and any sensible interpretation of the answer.	Marks can only be awarded if the candidate makes the point that to rely on US2, the claims of SG 1000 should be related to those of US2, and if not they may not be enforceable (it is not required to explain the basis in the statutes for this). Comparing the first 8 lines of the Singapore claims to the US claims, the only difference is that, at line 2, the US claims require that the channel is “elongate”. Is this a change of expression only? Neither Claim 1 nor Claim 2 of SG1000 is related to claim 1 of US2, since they are not limited to a “rubber element with a C-shaped cross-section” Claim 1 of SG1000 is not related to claim 2 of US2, since it is not limited to “a plurality of teeth”. All limitations of the last 2 lines of claim 2 of US2 are present in the last 3 lines of claim 2 of SG 1000, except the limitation that the teeth are urged “independently”. This means that claim 2 of SG1000 is not related to claim

	2 of US2. Claim 3, which depends on claim 2, recites this feature, so claim 3 is related to claim 2 of US2.
2.2 Claim 1 lacks novelty over publication of US1	Note: These marks can only be awarded if the candidate has understood the priority situation, for which the marks are awarded under heading 3.1 below. If the candidate gets this wrong, for example by using US1 as part of an inventive step attack against claim 2, then deduct marks.
Does claim 2 lack inventive step over a combination of D1 and the prior art described in the introductory part of the patent application	No?
Even if claim 2 is found to lack inventive step, is claim 3 is inventive?	Yes, since it discloses a feature which is not suggested by either D1 or the prior art described in the introductory part of the patent application.
3 Misc Issues	
3.1 The priority situation	SG1000 can validly claim priority only for material which was present in US2 but not in US1 (see Paris Convention Article 4, and Singapore patents act section 17(3))
	US1 was published before the filing date of SG1000, so it anticipates any claim which is not entitled to priority. This means that US1 is in effect a “novelty only” citation against SG1000.
3.2 Curing the problem of invalid reliance on US2 as related patent	Request post-grant search and examination, and request amendment as discussed below.
3.3 Amendment:	Several amendments are possible. For example, to delete claim 1, and amend claim 2 to say that the teeth are individually moved by respective springs (i.e. to combine claims 2 and 3, to mirror claim 2 of US2). Note that the amended claims must not increase the scope of the patent. Also, if the candidate has taken the view that claim 2 does not cover the Windy product (because of claim 2’s limitation “substantially the whole”), then the candidate must amend claim 1, not claim 2. Marks are only awarded to claims which are valid, infringed, and do not extend the scope of the patent.
3.4 A renewal fee is overdue	It should have been paid by 1 August 2010. Can be paid until 1 February 2011.

Marks will be deducted for candidates who make the mistake of revealing a fundamental misunderstanding of the priority issue, such as treating the publication of US1 as creating relevant prior art against claims 2 and 3 in Singapore.