INTELLECTUAL PROPERTY OFFICE OF SINGAPORE

Answer Guidelines to QE 2012 Paper C

Note: The answer guidelines contain a non-exhaustive list of points that examiners expect candidates to cover in the answer to this Paper.

General Instruction:

Construction

Claim 1

Claims	Issues of construction
1. A case for a mobile phone or other hand held electronic device,	A case for a mobile phone. This sets the field of the invention. Needs to be interpreted in view of prior art of Document C – a wallet. Construe "for" to be "suitable for". What does a case "suitable for" a mobile phone mean. Can it be broad enough to cover eg any housing which can hold a mobile phone (ie this would include prior art document C) or would it be limited only to standard mobile phone cases? Seems sensible to construe the term "case" in combination with the term "for" to obtain a broad meaning.
configured to closely conform to the shape of the device	The case should conform to the shape of the device. What does closely mean? How close? Page 1, line 37-38 "The case is moulded or formed to hold a phone snugly enough that the phone will not fall out of the case" Construe to mean that the case conforms closely enough that a phone would not fall out of the case. A user would need to actively remove a phone from the case. Configured to closely conform to – note repercussive effect of the term "flexible material" of claim 5 means that this claim includes flexible and inflexible material. Page 3, line 25-31 provides that **in one embodiment** the case is formed from flexible resilient material – ie this confirms that the claim need not be so restricted. "the shape" – no antecedent basis for this term. Means the general 3D form of the device.
and having	Apertures and cutouts – all the documents given refer to such

apertures and cutouts in registration with corresponding elements of the device,	apertures and cutouts. Page 1, line 38-42 “Phones are designed to have access elements, or ports, to allow cables to be connected to the phone. For example, headphones, battery chargers and the like may need to be connected to the phone. Accordingly, the case of the present invention provides for access elements that match with corresponding elements of the device.” Does not need very much interpretation. Simply means that there are gaps or holes that match with corresponding ports in the device. “In registration with” – lining up with. The gaps or holes line up with corresponding elements of the device
in which the case comprises an outer wall configured to conform to the device	An outer wall configured to conform to the device (note - does not say “closely”). What does “outer wall” mean? This is described further on page 4, line 11-13 “If desired, a separate pocket may be formed such as schematically shown in FIG 4, by covering recess 12a as in FIG1, with a wall 12c, wherein cards and bills may be contained between such wall and **outer wall** 12” The outer wall conforms to the device. Does it need to follow the exact shape of the device? The word closely is not included, although it is included in the claim wording above. Generally assume that the outer wall of the case surrounds the device and provides housing for the device as well as the pocket element.
and a pocket element within the wall	A pocket element within the wall (the outer wall). Repercussive effect of claim 2 means that the pocket element should be able to hold articles other than credit cards. Does the pocket element need to extend entirely within the wall? No, not necessarily. Also note that on page 4, line 15, the pocket is described as “an enclosing pocket” but as such wording is not used in claim 1, the pocket does not seem to be limited to pockets that are fully

	enclosing. Note that a case could be slipped off a phone and money or cards put inside, and then the card put back on the case. It should be considered here (or in the novelty section) whether the space between the phone and the outer wall can be considered a "pocket element"?

Claim 2

2. A case according to claim 1,	Claim 2 depends on claim 1. Includes all the features of claim 1. Shorthand "2+1"
in which the pocket element is configured to house a credit card	Configured to house a credit card – is it limited to credit card sized objects? Doesn't really matter because all documents refer to credit cards. However, refer to page 2,line 28-30 "Advantageously, the pocket element is able to house at least one credit, debit or ATM card, or similar sized article, for example an ID card, or paper currency." Card does not need to have a magnetic strip – could also include "chip" type cards. Specification states that card is within the pocket element and is held so that it is not visible. Should this claim be construed so narrowly? See page 3, lines 13-17: "Ideally, the pocket is such that the card is completely hidden from view in the case, and this allows additional security for the user against an increased risk of theft of both a credit card and phone, compared to a phone on its own. This also has an advantage that the cards are also held more securely in the slot and are less likely to fall out". Use of the word "ideally" does not seem to be limiting. Therefore, this claim need not be limited only to pockets in which items are fully hidden from view.
and in which the pocket element has a slot for insertion and removal of the card.	Pocket element has a slot allowing for insertion and removal of card. This would appear to require a dedicated slot into which a card can be inserted and removed from the pocket. The slot opening is described in more detail on page 2, line 33-38. It may be positioned eg. on the side or rear of the case.

Claim 3

3. A case according to claim 1 or 2,	Claim 3 depends on claim 1 or claim 2. Shorthand: 3+1 and 3+2+1
in which the case includes a magnetically protective element, capable of protecting a card having a magnetic strip.	Magnetically protective element to be included. Examples of magnetically protective elements are not given (potential to raise as a lack of sufficient disclosure issue – see later) We know from the client's letter that "non-magnetising" material, such as "aluminium" can provide protection for the magnetic strip of a credit card (page 1, line 22-24). This could be included in the scope of "magnetically protective material". How much of the case needs to be protective? If the case is made of aluminium entirely, then would this be a protective element? It would seem to be the result.

Claim 4

4. A case according to claim 2 or 3,	Claim 3 depends on claim 2 or claim 3. Shorthand: 4+2+1 and 4+3+1. Does not include the possibility of 4+1, but 1 does not refer to a slot, so this is correct. However, the dependency of 4+3+1 is incorrect, because only claim 2 refers to a slot.
in which the slot comprises a a reinforced end	Reinforcement is described in more detail on page 3, lines 10 and 11. Reinforcement is provided "to protect the case from damage caused by repeated insertion and removal of a card from the pocket"

Claim 5

5. A case according to any of claims 1 to 3,	Claim 5 depends on claim 3 or claim 1. Shorthand: 5+3+1 and 5+1
in which the case is formed from flexible	Defined in spec as eg silicon rubber (page 3, lines 25-31), but this could in theory cover thin metal casing such as used the infringement

resilient material,	
allowing a card or other object to be held snugly in the pocket element.	The material allows the card to be held snugly and yet is flexible. What does “in the pocket” mean? Fully inside or partially? No real guidance is given. Candidate should make a decision either way, with reasonable argumentation

Infringement

Claim 1

Claims	Infringement
1. A case for a mobile phone or other hand held electronic device,	Yes, present - Infringement is a case for a mobile phone – client letter p1, line 8 /Document A line 7.
configured to closely conform to the shape of the device	Neither the client letter, nor document A, describe in words whether the case closely conforms to the shape of the device snugly enough so the phone will not fall out of the case. However, it seems this is inevitable from the figure in Document A and the wording in document A that this is a “protective case” for a mobile phone – line 7. Present.
and having apertures and cutouts in registration with corresponding elements of the device,	Not described explicitly in the client letter or in Document A. However, figure shows a gap or hole in the case that lines up with a camera lens on a mobile device and a gap along the side of the case that conforms to the side buttons of the device. Present.
in which the case comprises an outer wall configured to conform to the device	The outer wall may be the wall on the outside of the case, covering the credit card. Can be seen in the figure of Document A – on the pocket holding the credit card. Present.

and a pocket element within the wall	Present. Client letter states that the HandyCase "incorporated a secret compartment for storing credit cards or similar sized valuable objects or identity cards", p1, line 8-10.. and page 1, line 13-15, the case "allows storage of a credit card or ID card or similar"

Claim 2

2. A case according to claim 1,	Depends on claim 1, which is infringed.
in which the pocket element is configured to house a credit card	Present. Client letter p1, line 13-15 "the beauty of our phone case is that it allows storage of a credit card or ID card or similar…"
and in which the pocket element has a slot for insertion and removal of the card.	Does the pocket element have a slot? If construed to be any dedicated opening to the pocket into which a card can be inserted and removed, then this is present – see Document A, figure, which shows the card being held in a pocket on the rear face of the phone case, and having an opening at the top of the pocket (as shown in the figure) into which the card could be inserted and removed. Present/ not present, according to reasoning

Claim 3

3. A case according to claim 1 or 2,	Depends on claim 1, which is infringed. Depends on claim 1+2, also infringed (dependent on conclusions reached)
in which the case includes a magnetically protective element, capable of protecting a	Present. Document A, line 7-9 "The case is formed from non-magnetising material such as aluminium to provide protection for the magnetic strip of the credit card"

card having a magnetic strip.	

Claim 4

4. A case according to claim 2 or 3,	Depends on claim 1+2, infringed (dependent on conclusions reached) Depends on claim 1+2+3, infringed (dependent on conclusions reached) Depends on claim 1+3, infringed (dependent on conclusions reached)
in which the slot comprises a reinforced end	The slot has “edges that are made thicker”, page 3 of 23, l 30-31. Infringed?

Claim 5

5. A case according to any of claims 1 to 3,	
in which the case is formed from flexible resilient material,	No guidance is given in either the client letter or document A. Candidate may decide that flexible resilient material does not include metal within its scope. Not infringed. Candidate may decide that lightweight non-magnetising material such as aluminium would be flexible and resilient. Infringed.
allowing a card or other object to be held snugly in the pocket element.	The card is “stored snugly with the phone” (client letter, page 1, line 17-18)

Novelty

Candidate’s construction should be reviewed to confirm whether it is being followed consistently.

Claim 1

Claims	Document C	Document D
1. A case for a mobile phone or other hand held electronic device,	Doc C , para [0001]"a wallet or handbag for storing personal items, particularly… with an external phone pocket for providing quick unobstructed access to a mobile phone" Present.	Present – "snap-on leather finish case … keeps your mobile phone … safe"
configured to closely conform to the shape of the device	Does the case itself, ie the wallet or handbag, closely conform to the device? Or is it enough that the external phone pocket conforms to the shape of the device? Candidate's reasonable answers to be considered. In para [0005] the pocket is further described "The wallet/handbag 10 is further provided with a front external pocket 21 which is sized and arranged to **snugly receive** a mobile phone 40." Feature seems to be present.	Present – see figure and also that the case is "snap-on"
and having apertures and cutouts in registration with corresponding elements of the device,	Page 2, line 22-26 "The front external pocket 21 may be provided with openings (not shown) through which cables can be attached to a mobile phone held therein. For example, openings may be provided through which a headphone cable can connect to a headphone socket of the mobile phone, allowing a user to,	Present "Allows easy access to all buttons controls and ports"

	for example, listen to a telephone call or music whilst the mobile phone is held in the pocket." Present	
in which the case comprises an outer wall configured to conform to the device	What is the outer wall? Again, check that interpretation is being followed consistently. It seems the outer wall is the "front wall 12", in order to come to the conclusion that the wallet part of the handbag is the pocket and the mobile phone carrying pocket is the case. However, it is reasonable if the opposite conclusion is reached – provided this is followed consistently through the dependent claims. Present/not present	There is only one wall configured to conform to the device
and a pocket element within the wall	Present. Either front compartment 20 or rear compartment 30	Absent – there is no separate pocket element other than the physical space between the phone and the case; or Present – there is a pocket of physical space between the phone and the case

Claim 2

2. A case according to		

claim 1,		
in which the pocket element is configured to house a credit card	[0008] "The front compartment 20 may also be provided with an insert 100 having a first end portion 103 which is sized and arranged for removable placement within the first pocket 22, and a second end portion 104 having a plurality of insert pockets 105 which are sized and arranged to receive credit card-type items (not shown)." Present	Absent – there is no pocket element specifically configured to hold a credit card; Or Present – a credit card can be held between the phone and the case
and in which the pocket element has a slot for insertion and removal of the card.	[0008] the insert in the first pocket 22 has a "plurality of insert pockets 105 which are sized and arranged to receive credit card-type items (not shown)." Present?	Absent – there is no dedicated slot to allow insertion and removal of a card. This is only achievable by snapping off the phone cover

Claim 3

3. A case according to claim 1 or 2,		
in which the case includes a magnetically protective element, capable of protecting a card having a magnetic strip.	Not disclosed. Page 2, line 1 to 5 describes the pocket as being formed of "substantially entirely of a substantially elastic yet resilient material such as, but not limited to, a nylon-type material". For the "pocket", para [0004] describes the material to	The case includes a metal lining. Why? Is this a magnetically protective element? We know from the client that aluminium is magnetically protective. However, claim 1 is only considered not novel if the card is inserted into the "space between

	be leather or PVC-type material. **Not present.**	the phone and the case". Claim 3+1 is novel. Claim 3+2 is novel through dependency on claim 2.

Claim 4

4. A case according to claim 2 or 3,		
in which the slot comprises a reinforced end	Not described. **Not present.**	No dedicated card slot. Absent.

Claim 5

5. A case according to any of claims 1 to 3,		
in which the case is formed from flexible resilient material,	For the "pocket", para [0004] describes the material to be leather or PVC-type material. This is likely to be flexible and, possibly, resilient.	Leather finish case with an optional inbuilt lining. Page 31 "Hard plastic case with genuine or faux leather finish" Is this likely to be flexible and resilient. It is able to snap on and off so must have some degree of flexibility and resilience.
allowing a card or other object to be held snugly in the pocket element.	Are the cards held snugly in the "pocket" or compartments 20 or 30?	Present: a card could be held snugly between the case and the phone; or Absent: there is no dedicated card pocket. Check consistency, if consistent and well-reasoned, either conclusion seems acceptable.
	Conclusion: novel when	

	dependent on claim 3, not novel when dependent on claim 1 or 2?	

Inventive Step

Claim 1	If the candidate finds the case is novel over Document D because of the absence of a pocket, an argument can be presented that the case is not inventive over a combination of Document D and Document C. However, a mere combination may be too simplistic – combining C and D could lead to many devices (according to which features you select from each), and only some of which would have the features of claim 1, so therefore the features of claim 1 are not inevitable. Another argument is hinted at by the client in the letter, line 35-36 – anyone could take a standard phone case and slip a credit card inside. If it is known to take a mobile phone and a credit card and to slip the card inside the case, then is it not an obvious step to combine the two by adding a pocket element to a case? Worth checking with the client whether they have any documentary evidence of prior art incorporating a credit card in a known mobile phone case.
Claim 3	Combination of Doc C and D to provide the element of magnetically protective material to the disclosure of Doc C. Would a mere combination lead to the claim? What is the motivation? Does not appear to be any: Doc D does not give any reason for the metal lining, which could simply be to give additional protection to the phone. Some metallic elements are not magnetically protective (though candidates are not expected to know this)

Advice

Advice will depend on the conclusions reached by the candidate. Threats - are the actions of PhoneMe actionable threats, particularly their letters to the retailers?
SoShiok were not previously aware of the PhoneMe patent-- **defence of innocent infringement**. Candidate should discuss whether this a valid defence

Claim 1 at least appears to be infringed. Candidate should let client know the actions and any consequences that PhoneMe could take, including a potential injunction, interim injuction.
Infringement actions are expensive, should not advice a small company to take on a large company without advising them on potential costs
Client may have a defence for lack of novelty and/or inventive step. If inventive step alone, should inform client that this is subjective and the judge/registrar may not agree. Conducting further prior art search to locate more relevant prior art?
What can the client do to improve their position? Inform PhoneMe of the relevant prior art? Any design around?
Possibility of license negotiation especially since sales of HandyCase started before PhoneMe patent was granted. Prior art Doc C and Doc D to be used as possible bargaining tool to secure reasonable licensing terms in return for not taking revocation action.
Possible back dating of damages – due to marketing of HandyCase after publication date and before grant date of PhoneMe patent.