

## ANSWER GUIDELINES TO QE 2013 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.

A penalty is given to any candidate who treats the WO2008/00001 as if it were prior art (unless he has given consideration to whether it can be made so by entering the national phase late, treats it as prior art only if this is permitted, and treats it as a novelty-only reference).

### (i) Construction

<p>“for a digital data storage device”</p>	<p>“For” means “suitable for”.</p> <p>Probably construed as shaped and size for storing a digital data storage device <u>of a conventional type</u>.</p> <p>Clearly “digital data storage device” includes an optical disk of any conventional kind. Doc B shows that it may also be a cassette for magnetic tape of the kind shown in Fig. 3 of Doc C, though strictly speaking Doc 3 only mentions audio (i.e. non-digital) cassettes.</p>
<p>Comprising</p>	<p>Storage case includes the features listed; other features can also be present</p>
<p>first and second sheets of rigid material</p>	<p>Repercussive effect of claims 4-6 indicate that additional features can be included on the first/second sheets</p> <p>How rigid is “rigid”? Note that the material has to be sufficiently flexible for the elements 28 to receive the CD, and to connect the elements 11, 20.</p> <p>Nevertheless, there is a clear difference between the patent and the paper or thin card prior art it refers to, and a judge would try to interpret the expression to be meaningful.</p> <p>One possible, though not entirely, satisfactory definition is provided by comparing the rigidity to that of a conventional data storage device. See page 3, lines 27-29.</p> <p>Note that in claim 1 is the “material” which is said to be rigid. Cf the infringing product where it is the walls which lend rigidity to a material which, at least in the region 3, is very flexible. How is this point construed?</p>

“hinged”	Does it require a pivot element? No. It covers systems with a pivot, but also covers systems in which the hinge is provided by flexible bridge section integral with the sides. Note the word “hinge” is used also in WO2008/00001 to describe the bridge section 3.
Relatively rotatable	“Relative” to what? Relative to each other
First/second configuration	Essentially, closed and open positions of the case.
“retention means”	Again shaped and sized for the <u>standard</u> digital data storage device.  Retention means are shown in the figures to be slots 27, tabs 28 and elements 29. However, the retention means are not limited to this configuration.
“can be placed onto”	The claim does not require the storage device to be present
“sandwich”	Has to be a clear enough definition to say whether the <u>whole</u> of the recording medium is sandwiched. It is not in Doc C, because some of the cassette is in the pocket
“Resilient projection”	Retention means are shown in the figures to be slots 27, tabs 28 and elements 29. The candidate should define “resilient” and “projection” – the latter could for example be reasonably interpreted as something which sticks out in any direction. Only tabs 28 are described as having “resilience”
“a central portion” of the first sheet (claim 2)	Define this clearly enough to decide whether the infringing product has the feature.
“document retention means” (claim 3)	Define this clearly enough to decide whether Doc C has anything which can play this role, e.g. the cassette itself
Incorrect dependency of claim 4 on claim 4	Mark is given for pointing out the error, and the other for pointing out that claim 4 should be dependent on claim 3
“storing” (claim 6)	Only covers the case when in use. Note also the use of “optical”

(ii) Infringement

Embodiment 1 – case holding one DVD; Embodiment 2 – case holding two DVDs

<u>Claim</u>	Is claim Infringed?
Claim 1	Yes?
Claim 2	Yes?
Claim 3	Yes for one of the two kinds of DVD case
Claim 4	Yes for one of the two kinds of DVD case
Claim 5	Yes for the other of the two kinds of DVD case
Claim 6	Yes when a DVD is inside, as in our client's shop

**(iii) Validity**

All claims novel over document A, but claim 1 is novel only because of the “rigid” feature.

All claims are novel over document B

<u>Claim</u>	Is claim novel over Doc C?
Claim 1	No
Claim 2	Yes
Claim 3	No? Can the cassette be regarded as a “retention means”?
Claim 4	Yes
Claim 5	Yes
Claim 6	Yes

<u>Claim</u>	Inventive over Doc C?
Claim 2	Yes
Claim 4	Yes
Claim 5	In combination with doc A?
Claim 6	In combination with prior art mentioned in SG10001?

**(iv) Misc issues**

(a) Threats

- is the letter an actionable threat?
- is it relevant that the recipient is an importer? Consider phrasing of the letter

(b) Can WO2008/00001 be made into prior art by entering the national phase late?

No. Since the chance of being able to enter the national phase late are so low, no marks are awarded for reconsidering the issue of patent validity in the case that WO2008/00001 does become prior art.

(c) Options: (i) threats action

(ii) Application for revocation, to be filed at patent office or court. This mark is only available if the candidate has found claim 1 invalid.

(d) If the patentee sues, what are the chances of interlocutory injunction

Delay in seeking action, since the same cases have been widely and visibly sold for several years.

(e) Calculation of damages?

The calculation can be based on the damages (the damage suffered by the patentee) or an account of profits.

For calculation of damages, the court would consider the number of articles, and the likely royalty of a fair license agreement.

Innocent infringement for past sales? Even though the potential infringer is a large company (which suggests it should be aware of patents in its field), the nature of its business makes it unlikely to track patents.

Low since the cases are just a minor part of the product being sold

Is it relevant that claim 6 claims the combination of the case and disk? In other words, can the damages be calculated based on the value of the disk plus the case (since after all the case will have much lower value than the disk)? This mark can also be earned by pointing out that the damages may be reduced (under Sec. 70(2)) if the patentee amends the patent to address document C.