Examiners' Comments on Candidates' Overall Performances in QE2013 Paper C

- Many candidates treated the construction section of the claim as being an exercise in spotting the claimed features in the embodiments of the invention. (For example, one candidate wrote: "retention means= the assembly of 6 V-shape slots.") This is not right. The candidate is supposed to give a definition of each unclear term in the claim. Such as "I construe 'retention means' as any mechanism which is capable of holding the data storage device in a fixed position relative to the first of the rigid sheets".

  The paper was directed to a storage case "for a digital data storage device". Almost all candidates correctly indicated that "for" meant suitable for, but few (if any) discussed what (if anything) is implied by the expression as a whole, i.e. what properties a case has to have in order to be "suitable for storing a digital data storage device". The examiner's view is that a court would interpret the term as meaning that the case is sized to fit a digital data storage device of a conventional type. Presumably a hypothetical digital data storage device could be constructed of almost any size and shape, but interpreting the limitation to cover any such devices renders the term meaningless, and a court would not wish to do this.

  The other difficult wording in the claim was "rigid" – the core of the inventive concept. Again many candidates just identified the corresponding feature of the embodiment (one candidate wrote "Rigid material=molded plastic"). This is not right. Presumably the box covered by the patent could be made of many materials (metal? thick, inflexible cardboard?) while obtaining the same inventive feature. The patent itself says (in the "Summary of the invention" section) that the core of the invention is a storage case of "sufficiently rigid material that forces applied to the CD case are not transmitted to a CD within the case unless the force is sufficiently great as to break the case".

  The infringement section was well done overall, but few candidates pointed out that there are two versions of the potentially infringing article, and they infringe different claims. This is important, because if one version only infringes claims which are invalid, the client might be able to avoid the patent by using only that version.

  The WO reference would only have been prior art if had it entered the national phase in Singapore. Candidates who overlooked this, and treated it as prior art, gave completely wrong conclusions to the paper, and were penalized. This point of law has come up in many previous qualifying examinations.

  The advice section was particularly badly answered. It is really worth studying the section of the law relating to infringement actions etc., because the same issues come up year after year, and easy marks can be obtained here.

First, was there a groundless threat? If so, can an action be brought? It is relevant that that the client is doing both importation and retailing of the cases?

Second, can an interlocutory injunction be obtained? Given the delay in seeking the injunction (the client has been selling these cases for 4 years!), and the fact that the patent is just for the case: mere packaging for the main product, i.e. the DVDs themselves.

Thirdly, if the patent is successfully enforced, damages or account of profits could be awarded. How would be damages be calculated, given that a DVD case presumably provides a low proportion of the value of the complete product which is retailed (i.e. the DVD case plus the DVD itself)? Note that the question asks "What factors would be taken into account in calculation of damages?"

Finally, a few marks were available for pointing out that it is now too late to make the WO reference into prior art by entering the national phase.

- This was a fairly straightforward Infringement & Validity paper. The subject matter was simple and should not have presented any technical issues to the candidates.

  Candidates need to have additional basic training before attempting the SG Final Paper C.

  Unfortunately, 5 candidates were caught out by the issue of whether a PCT application which did not enter the national phase in SG could be used to attack validity, including 2 who would otherwise have passed. This is very disappointing, but a brief revision of the law for both of these candidates should mean they are able to pass a future paper.

- Quite a number of candidates made the fundamental error of considering the PCT as prior art.

  As this is an exam, candidates need to know the exam techniques such as stating the obvious. Otherwise marks allocated for those point cannot be given.

  As usual, time management is still an issue

- This paper is generally easier than previous years' examinations. Most candidates scored well in the claim construction and infringement sections. Many did not provide any analysis for inventive step. Most candidates did not score well in the miscellaneous issues section.