

QE 2018 PAPER C - ANSWER GUIDELINES

S/N	Category	Marks
1	Construction	34 marks
2	Infringement	13 marks
3	Validity – Novelty	23.5 marks
4	Validity – Inventive Step	8.5 marks
5	Advice and Miscellaneous Issues	21 marks
Total		100 marks

1. Construction (34 Marks)

Note:

If the candidate construes that the first and/or second discs have to be present, award zero mark for the entire section.

Claim	Feature	Meaning	Marks
1.1	A container for a plurality of discs	“container” = plain meaning; a non-ambiguous term, e.g. “container” or “box” in Doc B, “container” in Doc C, “holder” in Doc D	0
		“for” = suitable for.	1
		“a plurality of” = more than one.	0.5
		“discs” = plain meaning; e.g. CDs, DVDs, etc. A non-ambiguous term. See Docs B, C, D.	1
1.2	comprising a containment body which defines at least one recess for accommodating at least two discs	“comprising” = must include all the features listed in the claim but is not limited thereto	1
		“containment body” can be construed as a body with a hollow interior for housing items e.g. CDs. One example is the tray-like body in the embodiment of Fig. 1 of Doc. (NB: No need to mention the closure cover.)	1
		“recess” = depression in the containment body	2
		The entire phrase = two or more discs being housed/stored in one or more depression(s) in the containment body	1
		Each recess must be able to accommodate two or more discs	1

1.3	means for central retention to detachably retain at least one first disc in a first region of said at least one recess and at least one second disc in a second region of said at least one recess, the second region being arranged at a higher level than said first region	"means for central retention" = means for holding / retaining a disc in the recess by acting at the central hole of the disc	2
		"detachably" = the disc can be engaged and disengaged rather easily without causing damage to the disc or container	1
		"region" = 3-dimension space in the recess that would be occupied by a disc that is placed within the container	2
		"the second region being arranged at a higher level than the first region" = plain meaning	1
1.4	wherein said means for the central retention of said at least one second disc are arranged at said higher level and are spaced from a periphery of said first region	"means for the central retention of said at least one second disc are arranged at said higher level" = the central retention means for the second disc is arranged at the same level as the second region	1
		Since the first region and second regions are located at different levels, the central retention means for the second disc are not located at the same level as the central retention means for the first disc	1
		"periphery of said first region" = the edge of the first region	1
		Additional marks will be awarded for a discussion of the possible positions - that is, the central retention means of the second disc is positioned:	5

		<p>(i) at the periphery of the first region such that a part of the central retention means falls inside the first region and another parts outside (1 mark);</p> <p>(ii) (ii) such that the entire central retention means for the second disc falls inside the first region (see ref 6 in FIG. 5) (2 marks); or</p> <p>(iii) (iii) such that the entire central retention means for the second disc falls outside of the first region (2 marks).</p>	
		The figures in the patent show only position (ii), but the claim can be interpreted broadly to also cover the other 2 positions.	1
		<p>"spaced from..."</p> <ul style="list-style-type: none"> - Term refers to a space / gap in the x- and y-directions - If taken in the y, as a consequence of the second region being elevated above the first region. - If taken in the x, this means the retention means for the second disc is positioned with respect to the periphery in the plane of the first region. Although based on the definition in the x direction alone, position (i), i.e. at the periphery, might not meet the requirement "from", when the y-direction is accounted for, then the requirement "from" is met since the retention means can be at the 	3

		<p>periphery in the x-direction and yet spaced from the periphery in the y-direction.</p> <ul style="list-style-type: none"> - If candidate mentions that “spaced from” means a spacing in the y-direction – award 1 mark - If candidate mentions that “spaced from” means a spacing in the x-direction or does not mention either x or y (in which case it is assumed he/she means x) – award 2 marks 	
2	wherein the center distance of said first and second discs is shorter than the radius of each said discs	<p>This feature requires that when discs are stored in the container, the distance between the center of the first disc and the center of the second disc is shorter than the radius of one disc.</p>	2
		With reference to the 3 positions identified in integer 1.4, this restricts the possibilities to position (ii).	1
3	at peripheral edges of said at least one recess, sloping portions which are adapted to act as a centering element for said discs which can be mated with said central retention means.	<p>"peripheral edges" = inside the recess instead of outside</p>	1
		"at peripheral edges... sloping portions" = wall of the recess are sloping	1
		"sloping portions... adapted to act as a centering element..." = A reasonable discussion is expected to explain whether the vertical edges are included (2 marks), and whether the edges are sloping outwardly (see ref 15 in FIG. 4) or inwardly (which might not make any sense) (0.5 mark)	2.5
Total Marks			34

2. Infringement (13 Marks)

Claim	Feature	Meaning	Present Document B?	Marks
1.1	A container for a plurality of discs	<p>“container” = plain meaning; a non-ambiguous term, e.g. “container” or “box” in Doc B, “container” in Doc C, “holder” in Doc D.</p> <p>“for” = suitable for.</p> <p>“a plurality of” = more than one.</p> <p>“discs” = plain meaning; e.g. CDs, DVDs, etc. A non-ambiguous term. See Docs B, C, D.</p>	Present.	1
1.2	comprising a containment body which defines at least one recess for accommodating at least two discs	<p>“comprising” = must include all the features listed in the claim but is not limited thereto.</p> <p>“containment body” can be construed as a body with a hollow interior for housing items e.g. CDs. One example is the tray-like body in the embodiment of Fig. 1 of Doc. (NB: No need to mention the closure cover.)</p> <p>“recess” = depression in the containment body</p>	<p>Present.</p> <p>Product is a box (i.e. containment body with a recess) for storing at least one pair of discs (1 mark).</p>	1

Claim	Feature	Meaning	Present Document B?	Marks
		<p>The entire phrase = two or more discs being housed/stored in one or more depression(s) in the containment body.</p> <p>Each recess must be able to accommodate two or more discs.</p>		
1.3	means for central retention to detachably retain at least one first disc in a first region of said at least one recess and at least one second disc in a second region of said at least one recess, the second region being arranged at a higher level than said first region	<p>"means for central retention" = means for holding / retaining a disc in the recess by acting at the central hole of the disc</p> <p>"detachably" = the disc can be engaged and disengaged rather easily without causing damage to the disc or container.</p> <p>"region" = 3-dimension space in the recess that would be occupied by a disc that is placed within the container</p> <p>"the second region being arranged at a higher level than the first region" = plain meaning</p>	<p>Present.</p> <p>The respective space occupied by the respective disc are arranged at different levels (e.g. FIGS. 2 and 3).</p> <p>There are means, e.g. "<i>a pair of inserts for engaging the central apertures of discs</i>", see also the figures.</p> <p>Furthermore, the case can "<i>hold up to four disc firmly and easily in</i></p>	<p>1</p> <p>1</p> <p>1</p>

Claim	Feature	Meaning	Present Document B?	Marks
			<i>place without them moving or rubbing against each other by means of 4 inserts</i> ". This possibly implies that the discs can be engaged and disengaged rather easily.	
1.4	wherein said means for the central retention of said at least one second disc are arranged at said higher level and are spaced from a periphery of said first region	<p>"means for the central retention of said at least one second disc are arranged at said higher level" = the central retention means for the second disc is arranged at the same level as the second region</p> <p>Since the first region and second regions are located at different levels, the central retention means for the second disc are not located at the same level as the central retention means for the first disc.</p> <p>"periphery of said first region" = the edge of the first region</p>	<p>Present.</p> <p>The two inserts are not located at the same level since one insert projects further than the other so as to retain the discs in spaced, overlapping relationship.</p> <p>Candidate will need to discuss whether or not positions (i), (ii), and (iii) are included.</p> <p>Position (i) is possible; arguably one insert is at the periphery of the</p>	<p>1</p> <p>1</p>

Claim	Feature	Meaning	Present Document B?	Marks
		<p>Additional marks will be awarded for a discussion of the possible positions - that is, the central retention means of the second disc is positioned:</p> <ul style="list-style-type: none"> (i) at the periphery of the first region such that a part of the central retention means falls inside the first region and another parts outside (1 mark); (ii) (ii) such that the entire central retention means for the second disc falls inside the first region (see ref 6 in FIG. 5) (2 marks); or (iii) (iii) such that the entire central retention means for the second disc falls outside of the first region (2 marks). <p>The figures in the patent show only position (ii), but the claim can be interpreted broadly to also cover the other 2 positions.</p> <p>"spaced from..."</p>	<p>other region (conveniently the area occupied by the disc).</p> <p>Position (ii) is not possible. The minimum center distance can be at position (i) but not shorter than the radius.</p> <p>Position (iii) is possible and is, in fact, disclosed in Doc B which is the technical flyer of the DVD case that is being commercialized (1 mark).</p> <p>Conclusion: Product infringes claim 1 at least for position (iii) and position (i).</p> <p>Note: A different conclusion can also be reached, for example, candidate only considered</p>	<p>2</p> <p>1</p> <p>1</p>

Claim	Feature	Meaning	Present Document B?	Marks
		<ul style="list-style-type: none"> - Term refers to a space / gap in the x- and y- directions - If taken in the y, as a consequence of the second region being elevated above the first region. - If taken in the x, this means the retention means for the second disc is positioned with respect to the periphery in the plane of the first region. Although based on the definition in the x direction alone, position (i), i.e. at the periphery, might not meet the requirement “from”, when the y-direction is accounted for, then the requirement “from” is met since the retention means can be at the periphery in the x-direction and yet spaced from the periphery in the y-direction. 	position (ii) in the claim construction section, which means many marks are also lost in claim construction, infringement, and novelty sections.	
2	wherein the center distance of said first and second discs is shorter than the radius of each said discs	This feature requires that when discs are stored in the container, the distance between the center of the first disc and the center of the second disc is shorter than the radius of one disc.	<p>Absent.</p> <p>As analysed in 1.4 above, position (ii) is not possible.</p>	1

Claim	Feature	Meaning	Present Document B?	Marks
		With reference to the 3 positions identified in integer 1.4, this restricts the possibilities to position (ii).	Conclusion: Product does not infringe claim 2.	
3	comprising, at peripheral edges of said at least one recess, sloping portions which are adapted to act as a centering element for said discs which can be mated with said central retention means.	<p>"peripheral edges" = inside the recess instead of outside</p> <p>"at peripheral edges... sloping portions" = wall of the recess are sloping</p> <p>"sloping portions... adapted to act as a centering element..." = A reasonable discussion is expected to explain whether the vertical edges are included (2 marks), and whether the edges are sloping outwardly (see ref 15 in FIG. 4) or inwardly (which might not make any sense) (0.5 mark)</p>	<p>Absent.</p> <p>There is no sloping portion (vertical or otherwise) which is adapted to act as a centering element for the discs, to allow pushing and centering of a disc within the respective region.</p> <p>Alternatively (i.e. Present), if candidate construes that the periphery of the case acts as a sloping portion, then there must be a discussion whether the as-shown <u>vertical</u> walls of the case fall within the scope of "sloping" (1 mark).</p>	1

Claim	Feature	Meaning	Present Document B?	Marks
			<p>Conclusion: Product does not infringe claim 3.</p> <p>Alternative conclusion: Product infringes this feature when dependent on claim 1 only.</p>	
Total Marks				13

3. Validity – Novelty (23.5 Marks)

Claim	Feature	Present in Document C?	Marks	Present in Document D?	Marks
1.1	A container for a plurality of discs	Present. Clear that product is a container for discs.	1	Present. Clear that product is a container for discs.	1
1.2	comprising a containment body which defines at least one recess for accommodating at least two discs	Present. “tray-like body 10” implies a recess therein.	1	Present. “DVD case”, so it has a containment body and a recess therein for accommodating at least two discs. See Fig. 1, for example.	1
1.3	means for central retention to detachably retain at least one first disc in a first region of said at least one recess and at least one second disc in a second region of said at least one recess, the second region being	Present. [0006], [0008]: “coupling element 23” that acts axially; allows removal of either disc without difficulty There are different regions of different levels (e.g. FIG. 2).	1 1	Present. “hubs 6 and 7”, [0003], “resilience” facilitate retention and removal of discs. There are different regions of different levels (e.g. FIG. 3).	1 1

Claim	Feature	Present in Document C?	Marks	Present in Document D?	Marks
	arranged at a higher level than said first region				
1.4	wherein said means for the central retention of said at least one second disc are arranged at said higher level and are spaced from a periphery of said first region	<p>Present.</p> <p>Coupling element 23 on second region is arranged at higher level than that of first region. See the two ref 23 in FIG. 3, for example.</p> <p>Candidate will need to discuss whether or not positions (i), (ii), and (iii) are included.</p> <p>Position (i) is possible and arguably disclosed in Doc C; arguably one coupling element is at the periphery of the other region (conveniently the area occupied by the disc).</p> <p>Position (ii) is <u>not possible</u>. The minimum center distance can be at position (i) but not shorter than the radius.</p>	<p>0.5</p> <p>1</p> <p>2</p>	<p>Present.</p> <p>E.g. [0011]: Hub 6 and hub 7, which are arranged on boss 8 and boss 9, respectively, are arranged to support the discs in an overlapping manner. Boss 9 is raised above the base 2 to a greater extent than boss 8.</p> <p>Candidate will need to discuss whether or not positions (i), (ii), and (iii) are included.</p> <p>Position (i) is possible and arguably disclosed in Doc D; one hub can be at the periphery of the other region without any cut-away portion.</p>	<p>0.5</p> <p>1</p>

Claim	Feature	Present in Document C?	Marks	Present in Document D?	Marks
		Position (iii) is possible and disclosed in Doc C.	1	E.g. See [0008]: The hubs may be so close together that the edge of one disc lies adjacent the periphery of the central aperture of the other disc and vice versa.	
		Conclusion: Claim 1 is not novel, at least for positions (i) and (iii). Claim 1 is novel for position (ii).	1	Position (ii) is not possible. E.g. See [0012] of Doc D: Thus, referring to Figures 2 and 3, it can be seen that the edge of disc 12 extends into the cut-away portion of boss 9 and <u>hub 7</u> ; See [0008]: Each hub may even be provided with a cut-away portion so that the edge of each disc can extend <u>beyond the periphery</u> of the central aperture of the other disc.	1
				However, the scenario where the entire hub falls within the periphery of the other region is not possible (i.e. there cannot be a total cut-away of the boss!)	1.5

Claim	Feature	Present in Document C?	Marks	Present in Document D?	Marks
				Position (iii) is possible and disclosed in Doc D (1 mark).	1
				Conclusion: Claim 1 is not novel, at least for positions (i) and (iii). Claim 1 is novel for position (ii) only in the specific scenario where the means for central retention falls within the periphery of the first region.	1
2	wherein the center distance of said first and second discs is shorter than the radius of each said discs	Absent. Position (ii) is not disclosed. Conclusion: Claim 2 is novel.	1	Present. E.g. See [0012]. Conclusion: Claim 2 is not novel.	1

Claim	Feature	Present in Document C?	Marks	Present in Document D?	Marks
3	comprising, at peripheral edges of said at least one recess, sloping portions which are adapted to act as a centering element for said discs which can be mated with said central retention means.	<p>Present.</p> <p>There appears to exist a sloping portion (vertical or otherwise) which is adapted to act as a centering element for the discs, to allow pushing and centering of a disc within the respective region. See Fig. 2, ref 20.</p> <p>Conclusion: Claim 3 is novel at least when dependent on Claim 2.</p>	1	<p>Present.</p> <p>E.g. [0011]: Peripheral support ledges 10 <u>support</u> respective portions of the edges of engaged discs, again to hold them away from the surface of base 2. The supporting feature appears to serve the purpose as a centering element, regardless sloping or otherwise.</p> <p>Conclusion: Claim 3 is not novel.</p>	1
Total Marks			11.5	Total Marks	12

4. Validity – Inventive Step (8.5 Marks)

Validity – Inventive Step	Marks
<p>Claim 1</p> <p>Identify best starting point. Is a mosaic of Doc C and Doc D permitted?</p> <p>Possibly Doc C because structurally it resembles the embodiments of Doc A the most, despite the fact that Claim 1 is rendered not novel in light of Doc D.</p> <p>Doc C teaches at [0009] that the partial overlapping of the discs, while keeping them mutually spaced, allows to significantly reduce the overall size of the container and most of all to reduce its dimension ratio, hence suggesting to a skilled person looking to improve this reduced dimension by increasing the overlapped area.</p> <p>Difference between Doc C and the invention lies in:</p> <ol style="list-style-type: none"> 1. The means for central retention of the second disc does not fall entirely within the periphery of the first region. <p>Doc D provides a teaching on a cut-away portion to allow greater overlapping area, thereby reducing the center distance.</p> <p>With reference to FIG. 3 of Doc C, and applying the teaching offered in Doc D, would it be obvious to a skilled person in the art to introduce a cut-away portion of the second region of Doc C such that the means for central retention of the second disc will fall entirely within the periphery of the first region so that there is greater overlapping and thus a more enhanced reduction in the dimension ratio?</p> <p>Marks are to be awarded accordingly on how convincing the argument is put forth. Alternatively, the EP Problem-Solution approach may be used in the inventive step argument. Marks are to be awarded accordingly.</p>	6.5
<p>Claim 2 and 3 (1 mark each)</p> <p>A very brief discussion to state whether each of claims 2-3 is inventive. Very unlikely, since they are not novel in light of Doc D. Alternative answers are also acceptable, depending on the arguments put forth and how persuasive they are.</p>	2
Total Marks	8.5

5. Advice and Miscellaneous Issues (21 Marks)

S/N	Advice and Miscellaneous		Marks
A	What patentee is entitled to or can do?	<p>If infringed and patent is valid (partial or otherwise), who can he sue? Remedies? Interim actions? Possible amendments (e.g., incorporation of the limitations of claim 2 or claim 3 into claim 1) to strengthen position?</p> <p><u>OR</u></p> <p>If infringed but patent is not valid, what can he do to strengthen his position? Possible amendments?</p> <p><u>OR</u></p> <p>If not infringed but patent is valid (partial or otherwise), what can he do to strengthen his position? Possible amendments?</p> <p><u>OR</u></p> <p>If not infringed and patent is not valid, what can he do to strengthen his position? Possible amendments?</p>	5
B	Innocent infringement	<p>Infringement claimed "not to know anything".</p> <p>Impact of "innocent infringement" on the ability to recover monetary relief (s 69(1) Patents Act)</p> <p>Effect of marking the product with the word "Patented" together with patent number (s 69(2))</p>	<p>1</p> <p>1</p>
C	Possible defence	<p>Infringement claims that they had been selling their CD container "for a very long time".</p> <p>Given that the date of filing of the application is 1 Nov 2017 which is less than a year ago, there is no priority claim and Infringement has a previous similar patent. It is not unreasonable that Infringement may have made in good faith serious preparation to make and sell the product.</p>	3

		Therefore, prior user rights under Section 71 of the Patents Act may be a ground of defence available to Infringion.	
D	Infringion's letter	Reasonable discussion on whether groundless threat was made by Pattern E, and what remedy Pattern E might have, and what recourse Infringion might have.	3
E	Infringion's lapsed patent	Advice on whether the patent that has lapsed matters in terms of it being a prior art. Advice on whether the patent can be restored, on what conditions, and what action Infringion might take if patent is successfully restored.	2 2
F	Additional question on novelty grace period	Reasonable discussion as to whether the disclosure can be disregarded, and if so, what might be the impact on claim 1.	4
Total Marks			21

END