



INTELLECTUAL PROPERTY
OFFICE OF SINGAPORE

QE 2019 PAPER B - MARKING SCHEDULE

S/N	Category	Mark
1	Claim Amendments	35 marks
2	Response	35 marks
3	Letter to Client	30 marks
Total		100 marks

S/N	Answer Guide	Mark
1	Claims Amendments	(35 marks)
1.1	<p>Amendments to independent claims</p> <p><u>Answer 1</u></p> <p>In order to achieve full marks, amended claim 1 must have the feature whereby the embedding of the security feature is one that occurred during the manufacture process of the blank material AND reasoning provided why this claim should not be considered as one directed to the product <i>per se</i> but as a product that possesses the characteristics derived from the manufacturing process (for example, the embedding fixes the security feature in place since it was adhered in place during the manufacture process, which is in comparison to D3 where the security feature is slidable and not fixed in place) (referring to paragraph 2.74 of the Examination Guidelines).</p> <p>Alternate answer: If candidates added a claim directed to a method for forming a blank and reformulated the “blank” claim as a product-by-process claim referring to the “method for forming a blank” claim, this will score 10 marks and will be assessed purely based on the formulation of the product-by-process claim, no marks will be awarded for the “method for forming a blank” claim. However, if the “method for forming a blank” claim does not result in a blank that has the embedding feature in, then the “blank” claim will not get any marks.</p> <p><u>Answer 2</u></p> <p>In order to achieve full marks, amended claim 1 must have the feature whereby the security paper substrate and backing substrate (or plurality of substrates) are laminated into an integral sheet and whereby the security feature is embedded into the integral sheet.</p>	<p>(29 marks total)</p> <p>14 marks</p> <p>OR</p> <p>10 marks</p> <p>14 marks</p>

	<p>Both features (ie laminated...+embedded..) must be present to score the full 14 marks. If only one feature is used, then not all the essential features are captured and candidate will not score anything (0 marks). It is also to be noted that if candidates state "laminated..." but instead of "embedded...", states that the security feature is formed as part of the integral sheet, this is too broad and cannot overcome D3 as this can be construed as having a surface security feature rather than one that is embedded.</p> <p>If candidates does not have the laminated+embedded feature but provide an amendment directed to the lamination using adhesive or that the security feature is embedded within the adhesively laminated security paper substrate and backing substrate, this will be regarded as being too narrow and will go against the client's wish of having a broad claim.</p> <p>Any inclusion of features that will result in loss of embodiments such as providing a window, protective film, etc will score 0 marks here. In addition, deleting feature such as "repeatedly verifiable without causing damage ... or a permanent change to the security feature itself" will score 0 marks as this will not overcome D2. These two points apply even if candidates have the "laminted+embedded" feature. At paragraph [0020] of the description, lamination "generally involves the use of an adhesive" with the word "generally" explicitly included/provided to mean that other processes may be possible for lamination, for example, pressure and/or heat type of lamination bonding processes.</p> <p><u>For Answers 1 and 2</u></p> <p>Amending the term "it" in claim 1 to "said at least one security feature".</p>	<p>0 marks</p> <p>OR</p> <p>5 marks</p> <p>0 marks</p> <p>3 marks</p>
	<p>For method claim 10, not only should the embedding feature be</p>	<p>2 marks</p>

	<p>included (2 marks), but the steps of “cutting” (4 marks) and “assembling” (4 marks) to complete the method and thereby form the counterfeit resistant security package must also be added.</p> <p>The phrasing of the embedding feature should be consistent with amended claim 1. To introduce the integral sheet as “an integral sheet”, rather than “said integral sheet” (if copying from claim 11) (1 mark).</p> <p>Similarly to claim 1, the term “it” should be amended to “said at least one security feature”.</p>	<p>4 marks</p> <p>4 marks</p> <p>1 mark</p> <p>1 mark</p>
1.2	<p>Following amendments will score points (non-exhaustive):</p> <p>Addressing each of the antecedent issues identified by the Examiner in claims 4, 5, 6, 11 and 15</p> <p><u>Answer 1:</u></p> <p>Claim 4: amending dependency to refer to claim 3. Additionally broadening to add in “one or two security paper substrate”.</p> <p>Claim 5: amending dependency to refer to claim 3 or 4.</p> <p>Claim 6: Amending dependency of claim 6 to refer to any one of claims 3 to 5.</p> <p>Claim 11: amending “said integral sheet” to “an integral sheet”</p> <p>Claim 15: amending dependency to refer to claim 12 (or to claim 12 or 13).</p> <p><u>Answer 2:</u></p> <p>Claim 4: Update dependency in view of deletion of claim 3. Additionally broadening to add in “one or two security paper substrate”.</p>	<p>(6 marks total)</p> <p>1 mark</p> <p>1 mark</p> <p>1 mark</p> <p>1 mark</p> <p>1 mark</p> <p>1 mark</p> <p>OR</p> <p>1 mark</p> <p>1 mark</p>

	Claim 5: Update dependency in view of deletion of claim 3.	1 mark
	Claim 6: Amending dependency of claim 6 to multiple dependency or no change. (mark only given if candidate also states that this objection is rendered moot in view of incorporation of claim 3 into claim 1).	1 mark
	Claim 11: Deleted in view of incorporation into claim 10 (mark only given if candidate also states that this objection is rendered moot in view of deletion of claim 11).	1 mark
	Claim 15: amending dependency to refer to claim 10 (as renumbered) (or to claim 10 or 11).	1 mark

2	Response	(35 marks)
2.1	Support	(8 marks total)
	Point out literal support for each amendment under 1.1 and 1.2 : Claim 1: (Answer 1) 2 marks for the addition of the embedding feature (supported by paragraphs [020], [022] and [028]). (Answer 2) 2 marks for how the backing substrate and security paper substrate are laminated into an integral sheet ^[1] and how the security feature is embedded within the integral sheet ^[1] . (supported by paragraph [020]). If candidates state “plurality of substrates laminated” together, candidate must cite claim 3 as support, failing which, candidate will score 0 marks for the support for the “laminated into an integral sheet” feature instead of 1 mark.	2 marks
	Claim 1: 1 mark for amending “it” to “at least security feature”, support from paragraphs [009] and/or [017].	1 mark
	Claim 4: adding “or two”, support from paragraph [021].	1 mark
	Claim 10: 1 mark for embedding and 1 mark for amendment of “it”.	2 marks

	Claim 10: “cutting” step, supported by paragraph [022].	1 mark
	Claim 10: “assembling” step, supported by paragraph [022].	1 mark
2.2	Identification of D2 as a category P document ^[1] and explanation why (publication of D2 is after priority date of application ^[1] , priority date of D2 is before priority date of application ^[1] , D2 is a Singapore application ^[1]). D2 is only relevant for novelty purposes only and not for inventive step ^[1] .	5 marks
2.3	<p>Novelty assessment</p> <p>Candidates need to show that they understand the differences between the prior art documents and the present application. The distinguishing feature lies in the embedding of the security feature during the manufacturing process, or that the substrates are laminated together with the security feature embedded within the laminated sheets.</p> <p>D1 does not have the security feature embedded in the integral sheet; instead D1’s security feature is applied onto the surface of the parcel.</p> <p>In D2, the package material has to be destroyed in order to remove the tear tape in order to view the indicia and match it with the gasket. Therefore, although the tear tape of D2 is embedded within the package, this feature of claim 1 being the “at least one authenticating security feature which is repeatedly verifiable without causing damage to the material, or causing damage or a permanent change to the security feature itself” is not disclosed in D2.</p> <p>D3 provides two embodiments of the security device, one is a tape which has the security device attached thereon and the tape is the one that is adhered to the substrate (paragraphs [007] and [010] of</p>	<p>(10 marks total)</p> <p>1 mark</p> <p>1 mark</p> <p>4 marks</p>

	<p>D3). The second embodiment is where the tape is embedded between the fluting and the inner or outer lining of the package (paragraph [011] of D3). For Answer 1, the tape of D3 is not embedded within the package <i>during manufacture of the fluted board</i> (which can be regarded as corresponding to the integral sheet) and is embedded after the fluted board is obtained. For Answer 2, the tape of D3 is not embedded between the laminated security paper substrate and backing substrate (forming the integral sheet) so as to be fixed in place. To the contrary, the tape of D3 is slidable within the fluted board (paragraph [012] of D3). Candidates must be able to identify both embodiments of D3 and provide reasoning against both embodiments to score the full marks here.</p> <p>Therefore, since none of D1 to D3 disclose a blank in which the security feature is embedded within the material of the blank during manufacture of the blank (Answer 1) or embedded between the laminated security paper substrate and backing substrate (Answer 2), claim 1 is novel over D1 to D3.</p> <p>The method used in D1 to D3 is also different from the method of claim 10 (D1: security feature painted/sprayed onto surface of package; D2: the security feature cannot be repeatedly verifiable; D3: the tape is added only after the integral sheet is made/procured and is not added during manufacture of the integral sheet) or that D3 does not have the step relating to “laminating” and “embedding”.</p>	<p>1 mark</p> <p>3 marks</p>
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2.4	Inventive step	(7 marks total)
	<p>Need to consider D1 and D3 singly and in combination. Marks will only be given for a discussion on D1 and/or D3.</p>	
	<p>Windsurfer approach – approach must be applied and full analysis provided</p>	
	<ul style="list-style-type: none"> • Full marks against each document given only if some technical explanation is given of (a) new technical advantages accorded by inventive feature, (b) why it is to be considered there is absence of teachings or teachings away based on the documents. 	
	<p>Understanding that the inventive concept lies in the embedding of the security feature during the manufacture step (Answer 1) or the security feature embedded between the laminated security paper substrate and backing substrate (Answer 2). As the security feature is embedded within the material (as compared to being on the surface), this can be protected from the problems associated with such surface-based security features as stated in paragraph [004]. Therefore, such embedded security features cannot be removed easily, can still be read (see paragraph [033] on reading embedded security features) and will not be easily torn away.</p>	1 mark
	<p>Objective of D1: To have a surface security device which is invisible to the naked eye and can only be seen under UV light. This is done by avoiding the use of labels.</p>	1 mark
	<p>Objective of D3: To attach holograms easily to a security package. The tape is applied either on the surface of the security package or threaded/embedded within the security package to provide for a covert security device.</p>	1 mark

	<p>D1 does not teach or suggest modifying the surface UV readable security feature to be embedded (whether during manufacture or embedded between laminated substrates). Not possible to modify this feature of D1 as the UV readable security feature must be present on the surface.</p>	1 mark
	<p>D3 does not teach or suggest embedding the security feature during manufacture of the integral sheet. In D3, the packaging material is bought from commercial sources and it is explicitly mentioned that this is to avoid unauthorized reproduction of the hologram. Therefore, a person skilled in the art would not modify D3 to form the security device when forming the packaging material. (Answer 1)</p> <p>D3 does not teach or suggest having the security feature embedded between substrates. The effect of this is to fix the security in place. However, in D3, paragraph [012] actually teaches away from the present application because it is stated that the tape should be slidable to allow the tape to be removed easily or lined up with the holes. Therefore, the tape of D3 cannot be fixed in place and must be able to move. This is an opposite teaching to the present application and a person skilled in the art would not have arrived at the present application upon reading D3. (Answer 2)</p>	1 mark
	<p>The combination of D1 and D3 would also not teach or suggest the embedding during manufacture feature since D1 is directed to surface security devices and cannot be combined with D3. In any case, none of D1 and D3 teach the embedding of the security feature during the manufacture process since both teaches the application of the security feature after the packaging material is made. Therefore, this feature is not taught or disclosed in the combination of D1 and D3. (Answer 1)</p> <p>The combination of D1 and D3 would also not teach or suggest the security feature embedded within substrates since D1 is directed to</p>	2 marks

	<p>surface security devices and cannot be combined with D3. In addition, the security device of D1 cannot move and is fixed in place while the embedded tape of D3 is able to move in place. This again provides for an impermissible combination argument. Therefore, D1 and D3 cannot be combined together against the present application. (Answer 2)</p> <p><u>General comments:</u></p> <ul style="list-style-type: none"> • Answers based on non-inventive dependent claims: 0 marks • If candidate states “amended Claim is neither taught nor suggested” without further substantiation: 0 marks • Arguments based on features not in claims: 0 marks 	
2.5	<p>Clarity and support</p> <p>Clarity issues addressed – “it” explained in claims 1 and 10^[1]. Dependency updated and antecedent issues (of claims 4, 5, 6, 11 and 15) addressed by characterizing the relevant terms in the amended claims^[3].</p> <p>Providing an explanation that claim 10 is now complete due to the addition of the “cutting” and “assembling” steps</p>	<p>(5 marks total)</p> <p>1 mark</p> <p>3 marks</p> <p>1 mark</p>

3	Client Letter	(30 marks)
3.1	<p>Explanation of the status of the application</p> <p>Application is not dead and can be continued as long as a <u>Request for Review of Examination Report is filed^[2] within 2 months from 6 October 2019 (or 6 December 2019)^[1]</u>. The Request must be filed <u>using arguments and optionally amendments^[2]</u>. In view that amendments are required to overcome the Examiner's objections, the <u>Request will include both arguments and amendments^[1]</u>.</p> <p>Note: a long discussion of what the Review process is and what forms are needed for filing is not required and will not score marks.</p>	<p>(6 marks total)</p> <p>2 mark</p> <p>1 mark</p> <p>2 mark</p> <p>1 mark</p>
3.2	<p>Explanation of the amendments made</p> <p>Short explanation required here. Simply explaining the rationale behind the amendment (2 marks) and how the embedding feature is different from D1 to D3 (summarizing the arguments used in the response) (1 mark for each prior art, last 1 mark for combination of D1+D3) with statements directed to the clarity and support observations (2 marks here) is sufficient to score marks.</p>	<p>(8 marks total)</p> <p>2 marks</p> <p>4 marks</p> <p>2 marks</p>
3.3	<p>European supplier</p> <p>Patent is based on <u>jurisdiction^[1]</u>. Since the only other corresponding application is in the United States which implies that there is <u>no application filed in Europe^[1]</u>, there is <u>nothing that the client can do against the European supplier in Europe^[1]</u>.</p> <p>In Singapore however, <u>since the patent is not yet granted, the client cannot sue the supplier now^[1]</u>. Only when the patent is <u>granted can the client start infringement proceedings against the supplier^[1]</u>.</p>	<p>(7 marks total)</p> <p>1 mark</p> <p>1 mark</p> <p>1 mark</p> <p>1 mark</p> <p>1 mark</p>

	<p>The client can send <u>a letter to put the supplier on notice^[1]</u> but <u>care must be taken not to threaten the supplier^[1]</u>.</p>	<p>1 mark</p> <p>1 mark</p>
3.4	<p>Metallic discs feature</p> <p>Since claims are directed <u>broadly to “at least one authenticating security feature”^[1]</u> and <u>is not limited to the type of security feature^[1]</u>, the <u>metallic discs security feature will be within the scope of the claims^[2]</u>.</p> <p>Since client wants to claim the metallic disc but there is <u>no support in the specification^[1]</u> to claim the metallic discs, <u>not possible to add a claim into the current application^[1]</u> in view of <u>potential added matter^[1]</u>.</p> <p>Not possible to file a divisional application as well.</p> <p>Only way to proceed is to file the metallic discs as a separately new application.</p>	<p>(9 marks total)</p> <p>1 mark</p> <p>1 mark</p> <p>2 marks</p> <p>1 mark</p> <p>1 mark</p> <p>1 mark</p> <p>1 mark</p>

Claims

Answer 1:

1. A blank for a counterfeit resistant security package made from a substantially rigid material comprising at least one authenticating security feature which is repeatedly verifiable without causing damage to the material, or without causing damage or a permanent change to the security feature itself, wherein said at least one security feature forms an integral part of the material of the blank such that said at least one security feature ~~it~~ cannot be separated from the material without the destruction of the material and/or the at least one security feature, and wherein said at least one security feature is embedded within the material of the blank during manufacture of the blank material.

2. The blank for a counterfeit resistant security package according to claim 1, wherein the at least one security feature is encodable.

3. The blank for a counterfeit resistant security package according to claim 1 or 2, wherein the material of the blank comprises a plurality of substrates laminated together to form an integral sheet.

4. The blank for a counterfeit resistant security package according to ~~any one of claims 1 to 3~~, wherein said plurality of substrates comprises one or two security paper substrate.

5. The blank for a counterfeit resistant security package according to any one of ~~claims 1 to 4~~ 3 or 4, wherein said plurality of substrates comprises one backing substrate.

6. The blank for a counterfeit resistant security package according to any one of claims 3 to 5, wherein said plurality of substrates are laminated together by means of an adhesive.

7. The blank for a counterfeit resistant security package according to any one of claims 1 to 6, wherein the at least one security feature has unique identifier.

8. The blank for a counterfeit resistant security package according to claim 7, wherein said unique identifier is a randomly generated unique identifier.

9. A counterfeit resistant security package comprising a container made from a blank according to any one of claims 1 to 8.

10. A method of making a counterfeit resistant security package comprising the steps of:

forming a sheet of substantially rigid material comprising at least one authenticating security feature which is repeatedly verifiable without causing damage to the material, or

without causing damage or a permanent change to the security feature itself. wherein said at least one security feature is embedded within the substantially rigid material during said forming step such that, ~~wherein~~ said at least one security feature forms an integral part of the material of the blank such that said at least one security feature ~~it~~ cannot be separated from the material without the destruction of the material and/or the at least one security feature;

cutting at least one blank from said sheet of substantially rigid material; and
assembling a counterfeit resistant security package from said blank.

11. The method according to claim 10, further comprising the step of laminating a plurality of substrates together to form ~~said an~~ integral sheet of said material.

12. The method according to claim 11, further comprising the step of making a security paper containing said at least one security feature to form a first substrate.

13. The method according to claim 11 or 12, further comprising the step of providing a backing substrate as a second substrate.

14. The method according to claim 12, wherein said at least one security feature is encoded with a randomly generated unique identifier before said at least one security feature is added onto or within into the security paper.

15. The method according to claim ~~44~~12, wherein said security feature is encoded with a randomly generated unique identifier after addition onto or within said security paper.

16. The method according to claim 15, wherein said unique identifier is generated by applying a plurality of offset strings of letters to a web of security film material, slitting the web to form a plurality of security threads out of register with the strings of letters and incorporating one or more of said security threads into the security paper substrate, such that the thread is exposed at intervals in windows in a surface of the material.

Answer 2:

1. A blank for a counterfeit resistant security package made from a substantially rigid material comprising at least one authenticating security feature which is repeatedly verifiable without causing damage to the material, or without causing damage or a permanent change to the security feature itself, the blank comprising a plurality of substrates laminated together to form an integral sheet and wherein said at least one security feature is embedded within said integral sheet to forms an integral part of the material of the blank such that said at least one security feature ~~it~~ cannot be separated from the material without the destruction of the material and/or the at least one security feature.

2. The blank for a counterfeit resistant security package according to claim 1, wherein the at least one security feature is encodable.

~~3. The blank for a counterfeit resistant security package according to claim 1 or 2, wherein the material of the blank comprises a plurality of substrates laminated together to form an integral sheet.~~

~~4.3.~~ The blank for a counterfeit resistant security package according to claim 1 or 2~~any one of claims 1 to 3~~, wherein said plurality of substrates comprises one or two security paper substrate.

~~5.4.~~ The blank for a counterfeit resistant security package according to any one of claims 1 to ~~4~~3, wherein said plurality of substrates comprises one backing substrate.

~~6.5.~~ The blank for a counterfeit resistant security package according to any one of claims 1 to 4, wherein said plurality of substrates are laminated together by means of an adhesive.

~~7.6.~~ The blank for a counterfeit resistant security package according to any one of claims 1 to ~~6~~5, wherein the at least one security feature has a unique identifier.

~~8.7.~~ The blank for a counterfeit resistant security package according to claim ~~7~~6, wherein said unique identifier is a randomly generated unique identifier.

~~9.8.~~ A counterfeit resistant security package comprising a container made from a blank according to any one of claims 1 to ~~8~~7.

~~10.9.~~ A method of making a counterfeit resistant security package comprising the steps of

forming a sheet of substantially rigid material comprising at least one authenticating security feature which is repeatedly verifiable without causing damage to the material, or without causing damage or a permanent change to the security feature itself,

laminating a plurality of substrates together to form an integral sheet and embedding wherein said at least one security feature within said integral sheet to forms an integral part of the material of the blank such that said at least one security feature ~~it~~ cannot be separated from the material without the destruction of the material and/or the at least one security feature

cutting at least one blank from said sheet of substantially rigid material; and assembling a counterfeit resistant security package from said blank.

~~11. The method according to claim 10, further comprising the step of laminating a plurality of substrates together to form said integral sheet of said material.~~

~~12.10.~~ The method according to claim ~~11~~9, further comprising the step of making a security paper containing said at least one security feature to form a first substrate.

~~13.11.~~ The method according to claim ~~11~~9 or ~~12~~10, further comprising the step of providing a backing substrate as a second substrate.

~~14.12.~~ The method according to claim ~~12~~10, wherein said at least one security feature is encoded with a randomly generated unique identifier before said at least one security feature is added onto or within into the security paper.

~~15.13.~~ The method according to claim ~~14~~10, wherein said security feature is encoded with a randomly generated unique identifier after addition onto or within said security paper.

~~16.14.~~ The method according to claim ~~15~~13, wherein said unique identifier is generated by applying a plurality of offset strings of letters to a web of security film material, slitting the web to form a plurality of security threads out of register with the strings of letters and incorporating one or more of said security threads into the security paper substrate, such that the thread is exposed at intervals in windows in a surface of the material.

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