

## ANSWER GUIDELINES TO QE 2011 PAPER B

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:

The existing claim-set of the Application suffers from the problems that:

- claims 1 lacks novelty over Document 1
- claim 2 is probably not novel over Document 1 (“...our dispenser unit provides two conduits from the water tank, which respectively pass a cooler and a heater. Rather than providing a separate tap for each of the conduits...”), but even if it could be said to be novel it is hard to present as inventive, despite reversing the teaching of Document 1 to use a single tap unit.
- claim 3 is back-to-front, since it is in the contracted state of the lever that water can be dispensed in the third embodiment of the Application.
- In this incorrect form, claim 3 arguably lacks novelty over Document 1 also (at least if the expansion of the spring 8 in Document 1 when the lever is moved into positions A or B is regarded as giving the lever unit an “expanded state” as required by claim 3), but not much rides on this since incorrect claim 3 is not supported or valuable to Mr Tan.

Although the first embodiment of the Application contains many features which are not suggested by Document 1, such as a longitudinally moving closure element (“closure portion 72”), no advantages of such an arrangement compared to Document 1 are taught. For this reason it seems that the patent agent should concentrate on the 3rd embodiment, which is clearly inventive over Document 1, and which the client hopes to commercialize, and attempt to obtain the broadest possible valid claims directed to this embodiment.

In part 1 of the question, the best approach is to correct claim 3. Claims 1 and 2 are in this case replaced with dependent claims to the respective features. An additional independent claim is added for the tap unit which is an independent commercial product.

Part 2 of the question is designed to test two requirements of Section 30(3), for relying on a search and examination report issued under Section 29(6):

- a. that:
  - i. the [search and examination report] do not disclose any unresolved objection on the ground that the claim or claims in the application do not relate to one invention or to a group of inventions which are so linked as to form a single inventive concept; or
  - ii. if any such objection is disclosed, the applicant has satisfied the Registrar that the objection has been resolved;

- b. that each claim in the application at the time the prescribed documents for the grant of the patent were filed and the prescribed fee for the grant of the patent was paid is related to at least one claim in the application at the time the report was issued:
- i. which has been examined [in the search and examination report]; and
  - ii. which is referred to in the report;

Requirement (a) is understood to mean that in the case of a unity objection, all but one of the identified groups of claims is to be deleted. Requirement (b) means that at the time the grant fee is paid, each claim must be “related” to a claim examined in the search and examination report, which according to Section 2(4), means that every claim present in the Singapore patent application at the time the grant fee is paid must contain every limitation present in a claim examined in the search and examination report, although limitations can be rephrased to “differ in expression but not in content”. In other words, limitations can be added to the claims after the search and examination report is issued, but limitations cannot be removed.

In part 2 of the question, it is uncertain whether the errors in claim 3 can be corrected, given the need to meet the “related” test. The preferred approach is to protect the third embodiment by adding a limitation to claim 1. Claim 3 should be deleted, and claim 2 written to depend on claim 1. Alternatively, it is possible to add the limitation to claim 2. Alternatively, it is possible to argue that since the error in claim 3 is obvious, correcting it has no effect on the content of the limitation (as understood by a skilled reader), so that the corrected claim should still be regarded as “related” to the examined one. Since the law here has not been tested in court, it would be inappropriate to penalize this solution, which has the advantage that the resulting independent claim can be broader. Dependent claims should then be added for the features of former claims 1 and 2. No claim to the tap unit alone can be added, since this would not be related to the examined claims.

### Marking Schedule Outline

#### Part 1

A water dispenser having:  
 a dispenser unit for receiving a water bottle, the dispenser unit having a conduit for receiving water from the water bottle;  
 a tap unit controllable by a lever unit, the lever unit having an contracted ~~expanded~~ state in which it can control the tap unit to dispense water from the water bottle, and an expanded ~~contracted~~ state in which the lever unit is not operative to control the tap unit to dispense water from the water bottle, the lever unit being biased into the ~~contracted~~ expanded state.

Replace claim 1 with a dependent claim for feature of original claim 1

Replace claim 2 with a dependent claim for feature of original claim 2



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Add independent claim for the tap unit, such as:

A tap unit for a water dispenser unit for receiving a water bottle, the dispenser unit having an output port; the tap unit having:  
an input portion for attachment to the output port of the dispenser unit; and  
a lever unit for controlling the tap unit, the lever unit having a contracted state in which it can control the tap unit to enter an open configuration in which the tap unit can dispense water from the dispenser unit, and an expanded state in which the lever unit is not operative to control the tap unit to enter the open configuration, the lever unit being biased into the expanded state.

Add a dependent claim for the feature of original claim 1

Letter to examiner:

Support for correction of corrected claim 3  
Support for new independent claim

Novelty of corrected claim 3

Inventive step of corrected claim 3 and new inventive claim compared to Document 1.  
Specifically, the fact that it can be operated with one hand, which is useful when holding a cup with the other.

## Marking Schedule Outline

### Part 2

Possible main claim:

1. A water dispenser having:  
a dispenser unit for receiving a water bottle, the dispenser unit having a conduit for receiving water from the water bottle;  
a tap unit, the tap unit having an open configuration in which the tap unit permits water to flow from the conduit to a spout of the tap unit, and a closed configuration in which the tap unit does not permit water to flow from the conduit to the spout,  
the tap unit further comprising a spring for biasing the tap unit to the closed configuration;  
the tap unit further comprising a lever having an expanded state and a contracted state, the lever being biased into the expanded state, the lever being operative in the contracted state to configure the tap unit into the open configuration.

Wording based on page 3, lines 19-21

2. - add dependent claim for feature of claim 2  
- delete claim 3

Note:



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- explain that claims 2 and 3 have been deleted to overcome unity objection; since there is only one remaining independent claim, there must be unity
- explain claim 1 is related to original claim 1.

All the marks can be alternatively be awarded to a candidate who adds the limitation to claim 2 (instead of claim 1), adds a dependent claim for the feature of claim 1, and deletes claim 3.

All the marks under part 1 can alternatively be earned by amending claim 3 to correct it , adding dependent claims for the features of claims 1 and 2 and arguing in the note that claim 3 should be regarded as related because the content, as it would be understood by a skilled reader, has not changed.

No marks should be awarded, however, to a candidate who fails to explain in the note why corrected claim 3 might be regarded as still related, since such a candidate has probably just missed the issue completely. Instead, the candidate should suffer the penalty mentioned below for including unrelated claims.

For any of the following errors, marks will be deducted:

- leaving the unity problem unresolved
- including claims unrelated to the examined ones, especially a claim to the tap unit on its own.