

Examiner Tips and FAQs for Patent Agent Qualifying Examinations

This compilation consolidates comments from various Examiners.

General Comments

The purpose of the Examination is to assess the candidate's proficiency to practise in Singapore as a registered Patent Agent, providing sound advice to the public concerning patents and related matters.

Therefore, it is important that candidates present answers which demonstrate their ability to act as responsible Patent Agents. Advice or suggestions given as part of an answer should be complete in that it covers all aspects of the issues involved, and consider all possible angles, as that is what the public is entitled to expect when they seek advice from a Patent Agent. An incomplete or incorrect answer could reflect inability to properly advise clients in real life, which could pose serious consequences for the clients. Answers which only deal with some of the issues present in a question will receive poor marks. In addition, candidates should never recommend a course of action that might the client to act illegally. If the recommended course of action may compromise the client's position, the client needs to be advised of the potential consequences so that he can weigh the pros and cons and make an informed decision.

There is no standard way to present an answer to any of these Papers. Candidates are expected to set out their reasoning, opinion, and conclusions clearly and logically on all the issues identified in each Paper.

Candidates should take a clear position in their answers. Candidates should not, as part of their answer, ask the Examiners to choose from more than one answer to a question. This is akin to providing multiple options to a client without proper guidance. In a real-life context, this is of little help to a client. Whilst offering alternate answers may be helpful to flesh out the candidate's thought process, the candidate must ultimately conclude as to the most appropriate alternative. Very few marks, if any, will be given if no conclusion is drawn.

Similarly, Examiners will not attempt to read the candidates' minds. Credit will only be awarded for what is written in the answer scripts.

Paper A – Preparation of a Patent Specification

1. Scope of the Paper

In this paper, the candidate is asked to draft a patent specification which gives the best possible protection for the client's invention but at the same time is valid over the known prior art (in the question). It should also meet the other requirements of Singapore Patent law, that is: the claims define the invention, clarity of the claims, claims supported by the description, unity, and sufficiency.

2. Assessment of Answer

If the claims drafted by the candidate are invalid for lack of novelty, the candidate will almost certainly fail the paper because it is impossible for the examiners to award marks for the claims in such circumstances. If the claims are open to objections of failure to define the invention, lack of clarity, lack of unity or lack of support and/ or the specification lacks sufficiency, then marks will be lost. The number of lost marks depends on the seriousness of the objection.

On the other hand, if the claims are seriously restricted, that will also cause a loss of marks because an unnecessary restriction is a loss or narrowing of monopoly rights to which the client is entitled. Three or more unnecessary restrictions will lead to a fail.

So the candidate must find the balance between validity on the one hand and unnecessary restriction on the other hand. If the candidate is in doubt as to the correct scope of the claims, it is better to ensure novelty by accepting a slight restriction. This may cause the loss of a few marks but that is better than drafting claims which lack novelty and will normally result in a fail. As indicated in the General Comments, candidates should not offer claims of different scope and then invite the Examiners to choose the one they like best.

The bulk of the marks in this paper are awarded for the independent claim or claims since they will largely determine the extent of protection the client will receive. Candidates should bear this in mind when managing the time they spend on the different parts of the answer, namely independent claim(s), dependent claims, and description.

3. Answer

Candidates should always consider whether it is possible to claim the invention in more than one category - that is product and process. Sometimes, it may be possible to claim different aspects of the invention independently to give the client the best possible protection. For example, suppose the invention is a vacuum cleaner with a novel form of connection to a dust collecting bag. It may be possible to claim the connection per se and the combination of vacuum cleaner, connection, and bag. In such circumstances, the candidate should consider whether the independent claims lack unity. If the candidate considers that unity is lacking, a note to that effect should be included in the answer.

With regard to the dependent claims, these should provide good fall-back positions in the event that the independent claims should fall at some future time. Dependent claims should be limited to the most important of the optional features of the invention. If a candidate claims a large number of optional features, the Examiners cannot tell if the candidate appreciates which of the optional features are significant and which are trivial, thus marks may not be awarded.

As for the description, this must as far as the information in the question permits, meet the legal requirement of sufficiency and support the claims. Candidates are not expected to "invent" additional subject matter to add to the information supplied in the question. However, they may find it necessary to describe something shown in the drawing but not specifically described in writing in the question.

Frequently Asked Questions for Paper A

Q1: For the drafting of patent specification paper, is there a required or preferred drafting style, since different drafting styles are required from different national patent offices?

A1: No. The Examination Committee does not require or prefer any particular drafting style. As long as the patent specification discloses the invention in a manner which is clear and complete for the invention to be performed by a person skilled in the art, any drafting style is acceptable.

Q2: Will there be a heavy loss of marks if the candidate does not have sufficient time to draft the description for Paper A?

A2: Yes, some marks will be lost. Time management is essential in an examination. A patent application without description will be considered as incomplete.

Paper B – Amendment of a Patent Specification

1. Scope of the Paper

This paper tests the ability of the candidates to amend an Application to overcome objection directed to lack of novelty and inventive step (as well as other objections such as lack of support, clarity etc).

2. Assessment of Answer

The best amendment should render the Application valid and at the same time give the applicant the best possible protection that is available, taking into account any wishes of the applicant. If the amendment leaves the Application invalid for lack of novelty, the candidate will fail. On the other hand, if the amendment unnecessarily restricts the claims, there will be a loss of marks. Three or more serious restrictions will probably lead to a fail.

Candidates should also give regard to the other requirements of Singapore Patent law and in particular added matter. If the amendment proposed by the candidate introduces new subject matter, that will be viewed as extremely bad practice and will definitely lead to a fail.

3. Answer

Candidates should remember that the whole specification including the drawings and not just the claims can serve as a basis for the amendment. Frequently, candidates will find that there are several potential amendments which will render the Application valid. They should try to identify the amendment that gives the best protection to the client and meets the wishes of the client that are included in the question paper, which usually comes in the form of a letter from the client. The amendment must be presented in track changes format (that is, strike through for deletion and underline for additions) although marks are not deducted for not doing so, this will make the marking of the answer script easier. For the purpose of the examination, providing a clear version of the amended claims is not required.

The reply to the objections in the written opinion should not only give the basis for any amendments proposed but should also explain why the amendment deals with the objections raised in the Written Opinion. Any reply against the novelty and/or inventive step objection(s) has to correspond to the amendment made as any deviation from the amendment means that the candidate is not sure whether the amendment is indeed novel and inventive. Additionally, the reply must include detailed comments against the other objection(s) such as lack of support, clarity etc and explain why the amendment is now supported, clear, etc. It should be noted that the Inventive Step section should apply the Windsurfing/ Pozzoli approach as that is the approach used in the Examination Guidelines (and Windsurfing used by the Singapore Courts).

The reply to the client should address the questions raised by the client and advising the client on what to do. As this is not Paper D, recitation of the relevant Patents Acts/Rules and Patent Forms is not needed. However, if the client queries about timeline, the timeline must be provided (although the

statute is not required). Recitation of paragraph numbers from the Examination Guidelines is also not needed.

Frequently Asked Questions for Paper B

Q1: Is it important to include features for dependent claims?

A1: Only if the question asks for it such as when the client asks for additional features to be added.

Q2: Do we have to provide both a marked up and clear versions of the amendments?

A2: Marked up version of the amendments must be provided while clear version is not necessary. While marks will not be deducted if the marked-up version is not provided, this will make the marking of the answer script easier.

Q3: What approach should we use for the Inventive Step section of the response to the Written Opinion?

A3: The Windsurfing/ Pozzoli approach must be used as the problem-solution approach of the European Patent Office or the teaching-suggestion-motivation approach of the US Patent Office may lead to a different conclusion from the Windsurfing/ Pozzoli approach. The Windsurfing approach is used in Singapore Courts while both the Windsurfing and Pozzoli approach are used in the Examination Guidelines.

Paper C – Infringement and Validity of Singapore Patent

1. Scope of the Paper

This paper tests the ability of the candidates to interpret the claims of a granted Singapore Patent and advise on issues of infringement and validity, as well as strategies for either tackling an infringement or defending an allegation of infringement.

2. Assessment of Answer

The marks are not always distributed evenly amongst the different sections of the answer (see below for sections (a) to (f)). Nevertheless, candidates should manage their time so that they deal with all the sections.

In the marking of this Paper, Examiners will not penalize a candidate merely because a conclusion reached differs from the conclusion reached by the examiners. Candidates are expected to consider the various possible positions that may be put forward by the different parties in litigation. Candidate should therefore provide reasoned discussion to support their conclusions and advice.

In general, marks are awarded for answers that show the candidates' ability to identify the relevant issues based on a correct application of the law, articulate consistent and logical reasoning, and provide guidance to the client.

3. Answer

Normally the answer can be divided into six sections:

- (a) Interpretation (or claim construction)
- (b) Infringement
- (c) Novelty
- (d) Inventive step, and
- (e) Advice to the client (strategies client can consider – e.g., amendment, action for infringement, risk of challenge to patent for lack of novelty or other validity issues, negotiations, etc.)

In dealing with the first section, candidates need to analyse the possible meaning of the claims. Claim terms usually fall into one of two classes:

- i) terms which have more than one meaning and are relevant to the scope of the claim; and
- ii) terms whose meanings are clear and which are relevant to the scope of the claim.

In the case of terms falling in the first class, the alternative constructions should be proffered and the candidate should ultimately conclude as to the most likely interpretation drawing support from the specification. For terms in the second class, the meaning should be stated. It is insufficient to simply

state that the dictionary meaning will apply; that dictionary meaning should be explicitly set out in a few simple words. The construction section is perhaps the most important section in the paper, as it will pave the way for a proper analysis of infringement and validity.

Provided that the interpretation has been fully and logically considered, the infringement section should be straight forward: Does the alleged infringing product/method have the features of each claim? The conclusion itself is not so important. It is the reasoning by which the conclusion is reached which carries the bulk of the marks.

As to novelty and inventive step, the Examiners are again looking for the reasoning that leads to a conclusion rather than the conclusion itself. Further, it is important that the candidates refer to the specific parts of the prior art documents on which they rely. It is not enough to say that a feature is disclosed/taught without indicating where in the specification the disclosure/teaching is found. A brief explanation should also be provided.

In the amendment section, candidates may be required to look at the possibility of the patentee improving his position by making amendments to maintain the patent's validity and, at the same time, whether the amended claims would still be infringed; or, if the client is an alleged infringer, the possibility of challenging the patent for lack of novelty or inventive step, and possible work-around solutions that could avoid infringement.

Finally, the advice to the client is important. It should demonstrate a candidate's ability to recommend next step(s) in view of the findings on infringement and validity. The client needs to know what he can and cannot do. If several parties are involved in the infringement, the client will need to know which of them can be sued. He also needs advice on the likely outcome of the various courses of action that are possible.

Paper D – Knowledge of Patent Law and Patent Practice in Singapore

1. Scope of the Paper

This paper presents the candidate with several legal problems that can be expected in real life and upon which advice might be requested. The questions are not difficult, provided that the candidate is properly prepared.

Proper preparation requires a sound knowledge of the Singapore Patents Act and Rules, the PCT and the PCT Regulations, the Paris Convention, the Budapest Convention and TRIPS. Although the examination is an open book examination, that does not mean that such knowledge is not essential to pass the paper. Candidates who attempt this paper in the belief that preparation is unnecessary because they can look up the answer during the examination will usually fail. There is insufficient time in the examination to conduct legal research to find an answer. Candidates need to know what provisions of the law are relevant to the questions and to use the "open book" facility to confirm the precise nature of the provision and the number of the Section, Rule or Article as the case may be.

2. Assessment of Answer

In some questions, there is insufficient information to reach a final conclusion. Candidates must therefore consider the different possibilities that can result from those facts which are known. Many candidates fail to do this and assume facts which are not stated in order to reach a conclusion. This leads to a loss of marks.

Candidates should read the questions carefully (not to miss key issues/facts and important "clues") and also realize that all the information in the question should be used. If the answer presented does not use all the information in the question, then the candidate has missed something and inevitably marks are lost.

Each question carries 20 marks, which means that there is likely to be at least 20 different points which the examiners are looking for in the answer. For example, if the question calls for a time limit to be identified, there is likely to be a mark for stating the legal basis for calculating the time limit and a second mark for stating the time limit. It is no good if a patent agent knows which legal provision regulates time limit but unable to work out the actual date when the time limit ends, which is the information the client needs.

3. Answer

Candidates are expected to be familiar in the calculation of the deadlines (problems with candidates in identifying the correct date to base calculations on e.g., from date of filing or the priority date).

Time management is particularly important in Paper D. There are 48 minutes for each question that is to be answered. If the candidate uses more time than that to answer a question, it is likely that there

will not be enough time to give a good answer to all the other questions. When answering a question, most of the available marks are gained in the first 20 to 25 minutes. Thereafter, increasingly more time is normally needed to get the remaining marks. It is better to stick closely to the 48 minutes time limit rather than exceed it in the chase for one or two additional marks.

Frequently Asked Questions for Paper D

Q1: Will marks be allocated for citation?

A1: Candidate must show understanding of the issue and how the citation applies. Generally, no marks will be given for citation given in isolation.

Q2: How in-depth must a citation be and must one write down the entire content?

A2: It is important to give the precise citation and paraphrase the content to show the correct understanding of it and how it is related to your answer.

Frequently Asked Questions on the administration of the Patent Agents Qualifying Examination

Q1: What is the profile of the Examiners who make up the Examination Committee?

A1: The Examination Committee consists of a wide range of respected and experienced patent agents from diverse technical and national backgrounds. Such a varied composition ensures a broad and all-rounded approach to the Patent Agents Qualifying Examination.

Q2: Are past QE Papers and model answers available for candidates' practice?

A2: Yes, all past QE Papers and their accompanying answer guidelines are available on IPOS' website for candidates' learning. The answer guidelines have been prepared by the examiners themselves with the aim of providing candidates a clear idea of what is required of them.

With effect from QE 2022, examples of passing scripts will also be published for reference. It is important to note that the scripts have not been revised for accuracy and should not be regarded as model answer.

Q3: How are the marks being allocated for each Paper?

A4: Please refer to the Administrative Instruction for candidates for a brief description of each Paper. The Administrative Instruction for candidates is published on IPOS' website.

Q4: How does one prepare for the examinations?

A4: In addition to being familiar with the law and Administrative Instructions, it is important to practice past year papers and compare them with the answer guide, both of which are available on IPOS' website.

One should also practise under exam conditions to improve time management, as emphasised by the Examiners. Apart from practising under exam conditions, one should also approach a certified Patent Agent to mark through the answers of the practice paper that they did. This will not only give them an estimation of their marks, it will also help them to identify areas of improvement.

Q5: I am a biochemist by training. With my non-engineering background, will I be disadvantaged if the invention in the examination question is of a mechanical engineering nature?

A5: This is unlikely as the technology behind each examination question is generally simple and should be easy to understand.

Q6. Will sheets of blank paper be provided to allow me to plan my answer?

A6: Yes. Loose sheets of blank paper would be provided to you for rough use. Laptops will be provided by IPOS to conduct the Singapore Patent Agents Qualifying Examination. The use of laptops is required for all candidates.

Q7: Is the list of reference materials (C4, Administrative instruction for the candidates) allowed into the examination hall an exhaustive list.

A7: Yes, it is an exhaustive list. Please keep strictly to what is on the list.

Q8: Would I be allowed to bring materials not listed in the Administrative Instructions on the QE when attempting Paper D?

A8: No.

Q9: Would I be allowed to bring a dictionary (e.g. a language dictionary, scientific dictionary) to be used in the examination?

A9: Yes.

Q10: Can I cross reference and how do I do that?

A10: Yes, highlighting or pasting non-annotated post-its are permitted. However, annotation is not allowed. Please refer to the Administrative Instructions for candidates that are published on IPOS' website.

Q11: During the conduct of the examination, would each candidate have his/her own desk?

A11: Yes, the Examination Secretariat will provide tables for candidate's sole use. If this is not possible, adjustments will be made to ensure that candidates are provided the maximum amount of space possible during the conduct of the examination.

Q12: Why is there no procedure for appeal on the results of Singapore Patent Agent Qualifying Examination?

A12: Each answer script goes through a thorough marking process. It is first independently marked by two Primary Examiners. Where both Examiners do not agree on a Pass or Fail grade on an answer script, they will be requested to reconsider their recommendations. If their recommendations still differ after reconsideration, the answer script is sent to a Secondary Examiner for secondary marking. After that, the recommendation of the Secondary Examiner, together with the recommendations of the

Primary Examiners, is forwarded to the Examination Board for its decision. The decision of the Examination Board is final.

Q13: Can I inspect my answer scripts after the release of the examination results?

A13: No. A softcopy of your answer script will be sent to you together with your result slip.

Q14: Why is the time taken to release the examination results so long?

A14: The marking of QE scripts is a demanding and painstaking process which requires the examiners' complete concentration. Answer scripts undergo two to three rounds of marking before the final results are deliberated on by the Examination Board to ensure fairness and consistency in the marking. This thoroughness in procedure is time-consuming, but it has been set up to ensure that every script receives a fair and independent assessment.

Q15: Why is the passing rate of the Singapore Patent Agents Qualifying Examination so low?

A15: The Examiners are of the view that the candidates in general, are not sufficiently prepared for the examination. Many do not appear to have the requisite training and exposure to drafting and the necessary practical experience/skills (this includes handling patent applications on a daily basis, including drafting and responding to the examiner, as well as regularly being involved in infringement matters) which are tested in the examination. This lack of training and exposure is revealed in the answers provided by the candidates.

With effect from 2023, candidates will be required to pass the corresponding modules in the Graduate Diploma in IP and Innovation Management (GDIPIM) or the Master of IP and Innovation Management (MIPIM), conducted by the Singapore University of Social Sciences (SUSS) prior to enrolling in QE. Candidates are also encouraged to attempt QE after undergoing a minimum one year internship in patent agency work. Together, this will provide the candidates with the knowledge and practical work experience to attempt QE.

Q16: Am I allowed to enrol for more than one paper per year?

A16: Yes.

Q17: Is it possible to bring in the Patents Act and Patents Rules from before-2014?

A17: Yes, however it is advisable for candidates to bring the latest Patents Act and Patents Rules.