



## Best Script of Paper D

### Question 1

#### (a) Entitlement

S19(2) states that the patent should be granted preferentially to the inventor or inventors, or their successors in title, etc.

Therefore need to determine who the inventor is. Unclear from the question → need to ask client who originated the idea.

S2(1) defines inventor as actual deviser of the invention.

No development agreement implies no provision for ownership; i.e. no obligation for either party to assign to another.

#### Was there an employment?

Under S49, employer owns the invention if it was made in the course of normal duties (or specially assigned duties) and these are such that an invention would normally be expected to result from their being carried out, or if employee has role to further interests of employer (any duties).

Unclear from question whether  
R employed W - unlikely  
W employed R - unlikely

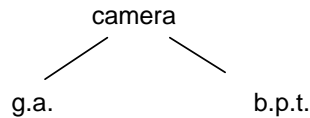
But need to consider whether either or both are employed by 3<sup>rd</sup> parties, in which case they would be owners.

e.g. if Mr W invented as part of a job in which he worked for an employer to design equipment, then employer would own invention.

In absence of any contract and any employment situation, if Mr W came up with idea, he is inventor and entitled to be granted patent. If Mr R came up with invention, he is owner of invention and entitled. If they jointly came up with invention, then they jointly own invention and would be entitled to grant as joint applicants.



(b) New modification of 1 Oct 05  
is that camera can be mounted on both glue applicator and ball placement tool.



Claim on file – (c) says camera mounted on either.

A potential infringing article with camera mounted on both would arguably fall under both limbs of (c) of existing claim, as it would be a camera mounted on a glue applicator (specified in (c)) and a camera mounted on the ball placement tool (i.e., specified in (c)).

As such, no absolute need to cover this new “embodiment” – save client money.

However: need to establish whether mounting on both the g.a. and the b.p.c. results in any additional technical benefit over and above mounting on g.a. and b.p.c. separately. Client says increases processing speed.

If so, then need to seriously consider a new filing to specifically disclose this new embodiment.

Also possible issue of lack of support or insufficiency (S25(5)(c)) (S25(7)) if claims cover an embodiment which is not specifically described. Risk of revocation S80(1)(c)).

Therefore, advise to file “top up” application.

Can base on presently filed specs + disclose new embodiment.

File PF 1 + pay \$160 – Rule 19.

(1) Can claim priority from 1.1.05 case – Rule 9(1)  
- Section 17(2) within 12 months

(2) or can keep both pending and file PCT, or foreign etc., by 1.1.06 claiming priority from both.

for (1)

Prosecute 2<sup>nd</sup> case to grant – will cover both original embodiments and 1.10.05 embodiment.

Need to include a claim that specifically recites mounting of camera on both g.a. and b.p.t

i.e. as existing Claim 1, but (c) to read

“and, (c) a camera, which is mounted on both the glue applicator and the ball placement tool” - as independent claim preferably.



(c)

1 Dec 04	Ross
1 Jan 05	Wright

Ross' 1 Dec 04 application is potentially citable for novelty only over Wright's application.

S14(3) – state of the art includes matter in an application if the priority date of that matter is earlier than that of application suit. Ross' priority date is earlier.

Ross 1 Dec 04 is unpublished on 1 Jan 05 (it is not due be published until 1 Jun 06 – S27).

Therefore, it is co-pending → citable for novelty.

For it to be citable, matter must be in application as filed and as published.

Therefore, need to monitor Ross' application and examine contents when published in Jun 06 to identify disclosure, and possible novelty destroying material.

Novelty only not inventive step – S15 excludes S14(3) matter.

Advice is that Ross' application may affect novelty, but it would depend on disclosure.

Therefore, may need to amend during prosecution (esp as we know of Ross – need to be clear of S80(1)(f)).

Embodiment in which camera mounted on both g.a. and b.p.t. would appear to be inventive, (and novel over Ross – assuming no disclosure there).

#### Application filed in Malaysia

Not citable under S14(3) “application for another patent” has to be construed as an application made under the Act – local application or PCT national phase – definition of “patent” in S2(i).

MY application won't be published until 7 Jun 06 – so not citable as prior art at all. Wright is in better position if MY application.



(d) grant

EP 15 Dec 04 published

EP published before 1 Jan 05 filing / priority date (assume no earlier filing)

Citable for novelty under S14(2) – all matter made available to public

Citable for inventive step under S15.

Need to examine EP to see if actually a problem and whether we need to amend.

Post grant amendment possible under S38.

File PF 17 fee \$100 - Rule 52

Any time after grant

Will be published

May be opposed by any one – Rule 52(2) – Form 18

if so, need to continue by filing Form 3.

Amendment discretionary, subject to “clean hands” – equity

Need to show we are acting diligently, that we seek to amend as soon as we are aware of potential invalidity → ASAP.

Cannot amend if proceedings in which validity of patent may be contested are existing – S38(2)

Does not appear to be the case

Amended patent: Restrictions on Relief

Need to warn client that S70(1) applies if we don't amend now and seek to sue on partially invalid patent.

Also need to tell client of S69 – Court may not award for infringement before application to amend published.

→ seek to amend ASAP.



(e) We can request post grant search and examination under S38A

If local exam, under S38A(1)(a)(ii)

Can argue that the Examiner did not consider all relevant art; including EP.

Need to file PF 55

- fee depends on office

file statement explaining that we have found EP prior art

file copy of EP (+ translations into English if needed).

identify ground of S38A(1)(a)(ii)

Explain novelty of amended claim over EP.

Submit inventive step arguments.

Examiner will search and examine and may send written opinion – S38(8)

- no possibility of reply



## Question 2

Malaysia joined PCT 16 Aug 2006

(a)	ABC	1.8.05	MY
	↓	XYZ	SG

PCT application to be filed in Singapore.

Singapore Registry competent to receive PCT applications in which at least applicant or inventors is a Singapore resident or national - Section 85(5)

Therefore, SG IPOS can only receive application filed by XYZ (or if any of inventors is Singapore resident or national, as PCT would designate US and applicants = inventors in US).

Therefore, need to assign MY application from ABC to XYZ and file PCT in SG, claiming priority from MY application.

File by 1 Aug 06 (12 months Article 8, Rule 4.10.(a)(i))

MY filed 1 Aug 05 → PCT must be filed by 1 Aug 06 to claim priority – MY not PCT Contracting State until then. Therefore, not possible to file in ABC's name in MY as R.O.

**Comment:** The script said "until then" when the correct answer should have been "until 16 Aug 06".

(b) Choice of ISA

PCT applications filed at Singapore registry can use:

European Patent Office

Australian Patent Office

Austrian Patent Office

as ISAs

I would choose Australian Patent Office as it has the lowest fee

**Comment:** The script said "Australian Patent Office" when the correct answer should have been "Austrian Patent Office".



(c) Priority Claim

Need to file certified copy of MY application at SG IPOS as Receiving Office  
- Rule 17.1 PCT

Rule 17.1(a) – need to submit to RO by 16 months from priority date i.e. by 1.12.06

Therefore, need to obtain copy from MY Registry, perhaps via MY attorney, then file at IPOS.

SG National Phase Deadline

Chapter 1: 30 months from priority date

1 Jan 2008            S86(3)  
                              R86(1)(a)(i)

Same for Chapter II

1 Jan 2008            S86(3)  
                              R86(1)(a)(ii)

AU National Phase

Chapter I deadline = Chapter II deadline = 31 months from priority date 1 Feb 2008.

For Uganda

Ch I = 20 months    1 Apr 07

Ch II = 30 months   1 Jan 08

Need to enter under Chapter I if no demand is filed

by 3 months from WO (ISA) or 22 months from priority date if later.

Therefore, enter Uganda national phase at 20 months if no Demand and AU and SG by 31 months and 30 months respectively.



Part 2

30 Jan 09

MY → PCT → SG  
Ch (I)

No local examination

Can file prescribed info on PCT application (or national phase of PCT)  
Section 29(2)(d)(ii) or S29(2)(e)(ii)

for S29(2)(d)(ii)

need to file certified copy of "granted patent" – unclear what this is as PCT does not grant

or final results of search and exam + copy of claims + IPC symbols + form 11B

Under S29(2)(e)(ii)  
(preferred)

File form 11C – no fee      Rule 42A

Deadline: 42 months from priority date      Rule 43(4)

due 1 Feb 2009

Can be extended if we request using PF 45A (Rule 47A – no fee under amended rules) to  
60 months (1.8.10) if we request by 1.11.08 – too late.

Need to file request for grant

PF 14      Rule 47(3)

no fee      Section 30

Rule 47(1) → by 42 months – 1 Feb 09

Need to take action ASAP.

Need to make sure IPRP was issued.

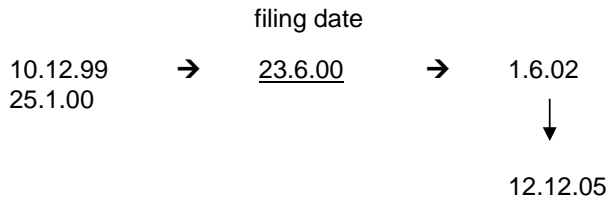
- file only has search report, but ISA will also have issued WO (ISA) at same time.

WO (ISA) becomes IPRP

Check with client and with WIPO/ISA that IPRP issued.



**Question 3**



Today : 5 Dec 2010

Section 36(2) + Rule 51(1)

Renewal fee has to be paid from anniversary of date of filing for following year.

Date of filing is PCT filing date for S86(3) applications

- Section 85(1)
- Section 87(1)(a)

Therefore, renewals calculated from 23.6.00

	23.6.01	1		
	02	2		
	03	3		
	04	4	first due for	5 <sup>th</sup> year
	05	5		6 <sup>th</sup>
	06	6		7 <sup>th</sup>
	07	7		8 <sup>th</sup>
	23.6.08	8	due for	9 <sup>th</sup>
	23.6.09	9	due for	10 <sup>th</sup> yr ✓
Letter 5.4.09	23.6.10	10	due for	11 <sup>th</sup> yr
			NOT PAID	

Renewal fee can only be paid within 3 months ending on anniversary Rule 51(1).

Therefore, letter dated 5 Apr 09 must be to say that renewal fee for 10<sup>th</sup> year, due on 9<sup>th</sup> anniversary i.e. 5 Apr 09 has been paid.

**Comment:** The script said "5 April 09" when the correct answer should have been "23 Jun 09".

Today = 5 Dec 2010. Assume no other renewal fee paid since last.

Renewal fee for 11<sup>th</sup> year was due on 10<sup>th</sup> anniversary 23 June 2010 – Rule 51(1).

Not paid: but S36(3) provides for 6 month grace period. Therefore, renewal fee and additional fee due by 23 Dec 2010.

Therefore, can pay now – need to take action ASAP.

- File PF15 - Rule 51(3)
- Pay \$350 - 1<sup>st</sup> Sch #16(c)



File PF16 - Rule 51 3A  
Pay  $\$50+100+100+100+100+100 = \$550$   
1<sup>st</sup> Sch #17A (a) + (b)

Answer to Tom's question: is patent still valid? is

No: S36(2) provides that patent ceased to have effect on 23 June 2010, as renewal due by then wasn't paid.

However S36(3) provides that if we pay renewal fee + additional fee by 23 Dec 2010, patent is treated as if it has never expired. Registrar has discretion to withhold relief under S69(3)(a) for any infringing act done between 23 June 2010 and date renewal + additional fee are paid.



(b) To maintain patent, Tom needs to make sure future renewals are paid in time.

23.6.10      10      due for 11<sup>th</sup> year  
[assume paid]

Fee	Due	For
\$350	23.6.2011	due for 12 <sup>th</sup> year
\$350	23.6.2012	due for 13 <sup>th</sup> year
\$450	23.6.2013	due for 14 <sup>th</sup> year
\$450	23.6.2014	due for 15 <sup>th</sup> year
\$450	23.6.2015	due for 16 <sup>th</sup> year
\$550	23.6.2016	due for 17 <sup>th</sup> year
\$550	23.6.2017	due for 18 <sup>th</sup> year
\$550	23.6.2018	due for 19 <sup>th</sup> year
\$950	23.6.2019	due for 20 <sup>th</sup> year

Provide Tom with Schedule (above) setting deadline by which renewal fee must be paid and sums due.

Advise him he can pay from 3 months until anniversary i.e. from 23<sup>rd</sup> March until 23<sup>rd</sup> June. File PF 15.

If he misses, he can pay renewal fee + additional fee up to 23<sup>rd</sup> Dec of the year. File PF 16 + pay additional fee.

If he misses this, he needs to see us urgently, in case we can file for restoration S39 – within 30 months of lapse (anniversary) – Rule 53.

#### When patent is valid until

Section 36(1) - end of period of 20 years from filing date – assuming renewals are paid.

end of 20 years from PCT S87(1)(a)

is      23 June 2000  
      + 20 years  
      - 1 day  
      22 June 2020

→ 20 year period excludes anniversary

→ last day patent is in force is 22 June 2020

Renewal fee for last year of patent must be paid by 23 June 2019



#### Question 4

- (a) Section 80 provides for revocation if
- (f) patent was obtained
  - (i) fraudulently
  - (ii) on any misrepresentation

No definition of “fraudulently” or “misrepresentation” in Act

My view is that for S80(f) to bite, the misrepresentation must be gross, i.e. of such a scale that it would have materially affected the outcome of the prosecution. For example, if applicant deliberately concealed a piece of prior art and sought to obtain broader claims than what he is entitled to.

In this case, all that has happened is that a co-inventor has been left out, not (as BigFlush alleges) that a wholly irrelevant inventor has been named. It would appear that Alfy Poo asked not to be included.

I would submit that this situation does not materially affect the grant, and is not a gross misrepresentation.

Note, we do not operate under US law, where ownership of the invention and declaration thereof is crucial in a first to invent system.

Nevertheless, because of uncertainty, we should take steps to correct error in inventors on register.

Apply Section 107(1) which allows for correction of errors of transcription or clerical errors, on PF 8 (presumably).

Rule 91: file form 23, pay \$12 fee

- file copy of PF 8 with Alfy Poo’s name and details underlined and derivation of right by Superflusher.

Request for correction will be advertised and may be opposed (Rule 91(5)).

Alternatively, treat as correction of register under R58

- Rule 58(1) – file PF 23 + pay \$12 fee

and specify that we want to add Alfy Poo as an inventor for the patent



(b) Groundless Threats

For BigFlush to succeed in a threats action, it has to show it is a “person aggrieved” - S77(1)

BigFlush has to e.g. show it has suffered damages, loss of sales, loss of market confidence, that its customers are not buying from it as a result of the threat, etc.

There must be a threat of proceedings for infringement (S77(1))  
i.e., S77(2) must be demonstrated by BigFlush

SuperFlush can defend against this if it shows that whatever actions which are the subject of the threat are in fact infringements, S77(2)(a).  
There is no threat if patent is shown to be invalid (S77(2)(b)).

BigFlush can obtain relief set out in S77(3) if it succeeds.

SuperFlushers' Defences

Show Absence of Threat

Letter is carefully worded. It does not mention any legal proceedings, it does not say SuperFlush is contemplating suing.

Show ordinary person receiving letter would not have perceived a threat. All letter says is to ask for business collaboration – this is hardly a threat, more a friendly overture

Invoke S77(5).

Letter draws attention to 111111 patent ONLY.

S77(5) specifically says mere notification of patent existence is not a threat of proceedings.

We need to argue that this is all the letter is intended to do and this would have been understood by an ordinary recipient.

Note: Letter mentions that it has come to SF's attention that BF has been “selling” toilet bowls.

“Sale” is not included in actions for which it is OK to allege as infringing activities without it being a threat (S77(4) – making and importing only).

→ SuperFlush cannot rely on this as a defence.

However, B.F. would have to show that the letter, read as a whole, and under ordinary business practice, would have been seen as a threat.

In my opinion, it would be difficult for B.F. to prove this.



(c) Court finds Claim 1 invalid

In first place, I would not advise SuperFlush to sue without first amending its patent – to delete Claim 1 (Section 38 – Rule 52(1) – Form 17).

However

Patent has 5 claims  
Claim 1 is invalid  
Claims 2-5 are valid

S70(1) provides for restriction as relief available for partially valid patent.  
Court may grant relief on the part of the patent that is valid, i.e. Claims 2-5.

We need to show that specification was framed in good faith and with reasonable skill and knowledge. Patent agent who drafted specification may be called to give evidence to show this – S70(2). Otherwise, plaintiff will be denied damages, and costs/expenses.

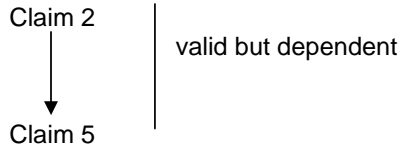
If we show reasonable skill and knowledge in framing specification Court has discretion to grant relief for Claims 2 to 5, with respect to amount of costs or expenses and date when these should be awarded from S70(2).

Court may direct that an amendment to delete Claim 1 is entered – S70(3).

Note: Big Flush says in letter it was not aware of patent until it received our letter. If it can successfully prove this, then Section 69(1) further restricts relief. Court will not award damages or account of profits for any infringing acts committed in ignorance, until time defendant is aware of patent. i.e., Big Flush is only liable for any acts after date of letter, if it can show it was not previously aware of patent.



(d) Claim 1 independent – invalid



If Claims 2-5 are the only claims not anticipated, and Claim 1 independent is invalid, there is no valid claim in the patent.

There is nothing to sue on, and hence no damages to be claimed, according to S70.

In this case we definitely need to amend the patent to incorporate the subject matter of any of Claims 2 to 5 into Claim 1 to allow a set of valid claims on which we can sue.

→ Apply to amend Claims under S38.

Rule 52(1): file form 17, fee \$100

Incorporate features of any of Claims 2 to 5, preferably feature which is clearly present in infringing article, into Claim 1.

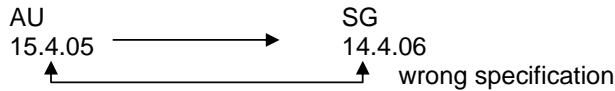
Remaining claims can be left dependent on Claim 1, or rewritten as independent claims.

Note: amendment will be published and may be opposed – Rule 52(2).

Need to show clean hands, as amendment is discretionary and judged on principles of equity → should do so as soon as we know of relevant prior art (from Big Flush letter) → file request for amendment without delay



### Question 5



#### (1) Appointment of Agent

We will need to appoint ourselves as agent for the client – file PF 41 fee \$10.

#### (2) Possible Section 34 situation

It appears that AU application was first filed outside Singapore. S34 provides that a person resident in SG commits a crime if he causes an application for an invention to be first filed outside SG, without written authorization from the Registrar.

Need to check with client whether they obtained S34 clearance beforehand. Also whether the residence requirements were fulfilled (for example, did the client acquire application by assignment after it was filed?)

Although AU agents filed, S34 catches a person if he “caused to be filed” overseas – arguably, this includes client if it was a local SG company at that time. Not enough info for conclusion; therefore, need to discuss with client. Warn him of possible sanctions – fine \$500 + prison of 2 years or both – and the fact that no possibility for retrospective license, once crime is committed by foreign filing.

#### (a) Replacement of Specification

S26(c) provides a date of filing to the specification and the description therein.

There is no explicit provision for substitution of an incorrect specification in the Act and Rules.

Only possibilities are (i) amendment (Section 31) (ii) correction (Section 107) and (iii) re-dating by filing missing drawings (Rule 26(3) and (4)).

#### (iii) Redating of Missing Drawings

File missing drawings – get new filing date – R26(4)(a). Does not apply here - entire spec is wrong.

#### (ii) Correction

Possible for obvious errors to be corrected.

- must be obvious error was made
- nothing else would have been intended other than what is being offered as correction
- Rule 91(2)

Unclear that either applies.



E.g. it could easily have been the title that was entered incorrectly in Form 1. Also, it could have been any of a number of specs that could replace.

→ tests fail. Correction not possible

(if it were, would have had to file Form 23, \$12).

(i) Amendment

S31(3) provides general power to amend application before grant of own notification.

- file form 13, pay no fee
- Rule 48

But Rule 49 says can only amend at certain times, and specifically not after filing request for search or exam.

Does not appear that these have been filed – so are in position to request amendment.

However, S84(2) applies. Any amendment cannot result in disclosure of matter extending beyond application as filed.

Question says specification for different invention filed by mistake.

Therefore, almost certain to add subject matter.

Consequences

Amendment will not be allowed S84(2)

Patent if granted is invalid and may be revoked S80(d)(i)

Therefore,

Conclusion

No possibility for spec to be replaced.



(b) Other steps

Advise client to file new application with correct specification.

Will get new filing date – S26(c)

Too late to claim priority from AU application.

S17(2) and Paris Convention provide for 12 month period for priority claim.

This period R9(1) is not extendible R108(2).

If invention has not been disclosed, later priority date (i.e., date of new filing) should be OK - claims should still be novel.

May want to withdraw incorrectly filed application If not commercially useful to keep alive (i.e. may wish to further develop) before filing.

To file new spec, need Patents Form 1, \$160 – Rule 19

Include new specification

Make sure title is correct

S29(2)(a)

Need to file search request by 13 months

- Form 10      Rule 36

pay \$1,600      Rule 45(2)

and examination request by 21 months

- Form 12      Rule 42(1)

- \$1,050      Rule 43(1)

S29(2)(b)

or combined search and exam

- by 21 months

- form 11      Rule 37

- \$2,300      Rule 43(1)

Cannot rely on Australian Search and exam/grant as it is no longer related by priority (i.e corresponding)

Section 2(1) – Rule 41

Need to make sure inventors designated by 16 months



(c) Typo in Form

Section 107(1) allows Registrar to correct any error of transcription or clerical error in any document filed in correction with a patent application. This includes PF 1.

Rule 91(1) provides for filing of PF 23 – cost \$12

Rule 91(1A) – need to file replacement PF1 with wrong title struck through and new title added underlined.

(1B) says – put “replacement sheet”

Advice

If only wrong title, then seek to correct the title as outlined above immediately to respond to letter from patent office. Correction should be allowed.



(d) Client has pending SG application claiming priority from AU application.

Need to decide how to prosecute.

Check if claims filed – if not, then due by latest of 1 month from filing or 12 months from priority.

→ due 14 May 2006; if not filed, seek extension under R 108(3)

- file PF 45, pay \$200 per month

if over 3 months, need to rely on R108(4) and file PF46 then PF47 etc.

#### Inventorship

PF8 due by 16 months from priority

15.8.2006 Rule 18

#### Prosecution

Can rely on prosecution of corresponding Australian application – S2(1) and Rule 41

Under Section 29(2)(c)(i)

- file AU search report

- file cited docs (& translation) in English

- file PF12 + pay \$1050

- Rule 42(1)

by 21 months i.e. 15 Feb 07 – Rule 43(1)

Grant by 42 months (15 Nov 08)

OR

Under Section 29(2)(c)(ii)

[this is cheapest – would recommend]

file prescribed info an Australian grant

- certified copy of AU patent

- or final search and exam results + copy of claims

- + IPC symbols Rule 44(1) + form 11B

by 42 months – Rule 43(4)

15 Nov 08

Need to file request for grant

File form 14

- under Section 30 and Rule 47(3)

by 42 months from priority date, i.e. 15 Nov 08

- need to make sure no unresolved unity of invention

issue on AU case

- Section 30(3)(a)



- need to make sure each claim in SG is related to at least one AU claim that has been examined for novelty, inventive step, and industrial applicability.  
S30(3)(c) – if under S29(2)(c)(ii)