

INTELLECTUAL PROPERTY OFFICE OF SINGAPORE  
PATENT AGENTS QUALIFYING EXAMINATION 2011

**PAPER D: KNOWLEDGE OF PATENT LAW AND PATENT PRACTICE IN SINGAPORE**  
**13 October 2011, Thursday**  
**1330 – 1730 hrs**

Maximum Time: 4 Hours (includes reading time)

Maximum Marks: 100



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**INSTRUCTIONS TO CANDIDATES**

1. This Paper consists of 11 pages, including this cover page.
2. You are required to answer all 5 questions. Each question carries 20 marks.
3. Write your answers in English. Answers in any other language will not be marked. Answers in illegible handwriting will not be taken into consideration.
4. Only your answers to the question(s) written in the Answer Booklet(s) provided by the Examination Secretariat will be considered. You are to write on one side of each sheet in the Answer Booklet(s). Answer one question per Answer Booklet.
5. In the following question(s) to this Paper, you are to assume that the dates mentioned (including the deadlines that are or would be due) are not excluded days. Where relevant, you are also advised to include in your answers supporting references, for example, the Patents Act & Rules and the Patent Cooperation Treaty (PCT) provisions.

End

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**Question 1**

Ryan is an independent researcher. He invented an apparatus for automatically making electrical connections between electronic devices using copper wires. Conventionally, expensive gold wires were used because they were relatively stable when heated, but the much-cheaper copper wires had a tendency to oxidize and degrade when heated in atmospheric air. Ryan's apparatus was adapted to prevent oxidation of copper wires from occurring so as to preserve wire quality. Based upon published patent specifications that he found on the Internet for similar inventions, Ryan prepared a patent specification including claims and filed an initial patent application at IPOS on 1 November 2009. The apparatus proves to be commercially successful. On 1 October 2010, Ryan filed a corresponding patent application in Korea (where the machine was especially well-received) at the Korean Intellectual Property Office ("KIPO").

(a) The patent application claimed an apparatus for making wire connections which blows an inert gas, such as nitrogen, onto the wire while the wire is being connected. On 1 January 2011, after manufacturing various prototypes of the machine, Ryan discovered for the first time that the inert gas environment could be improved by making the wire connections inside an enclosed heat tunnel where the inert gas is contained. Ryan amended his patent application in Singapore to include claims to the heat tunnel feature. Meanwhile, after the initial patent application in Singapore was filed and while waiting for funding to produce the apparatus, Ryan approached several potential investors to pitch his invention, but the heat tunnel had not yet been discovered when those marketing pitches were made. Explain to Ryan the effects of his actions and what he should do.

(7 marks)

(b) The patent application for the apparatus is granted by the KIPO without amendment. With a view to cost savings, Ryan would like to know if he could somehow take advantage of the grant of the Korean patent in Singapore to obtain the grant of the Singapore patent application including the heat tunnel. Advise Ryan accordingly.

(3 marks)

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5 (c) Just after Ryan filed his initial patent application, Don also filed a separate patent application a month later for an apparatus for making wire connections in an environment consisting of an inert gas. Ryan soon learnt about this. He also discovered from speaking to other researchers that Don had independently come up with the invention claimed in Ryan's initial patent application before Ryan started work on the said apparatus, as Don had disclosed the invention to them at that time. Later, Ryan and Don got into a dispute about who had a stronger claim to the patent rights in the invention. Comment on Ryan's and Don's relative rights and the validity of both patent applications under Singapore law.

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(5 marks)

15 (d) After arguing over the matter for some time, Ryan and Don agreed that Don would buy the rights to all of Ryan's patents in Singapore only. At Don's request, Ryan prepared a written assignment to assign the Singapore patents that he owned, signed the assignment before a witness and immediately submitted the assignment document to IPOS on Don's behalf for registering the assignment. Comment on the issues to look out for in the assignment and its recordal, and on the consequences if the assignment were not properly or timely registered.

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(5 marks)

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**Question 2**

Your new client, Popular Drugs, is a small Singapore-based drug company. They are keen to manufacture in Singapore a topical cream with a product name “Clean Face”. The composition of “Clean Face” includes the active ingredient Facoxycline and is effective in treating acne. Popular Drugs is hoping to start selling “Clean Face” in Singapore and the region in the next year or so. Clinical trials in Singapore are currently being planned to acquire data in order to support an application for marketing approval with the Health Sciences Authority.

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Popular Drugs believe that there may be a Singapore patent for Facoxycline. A quick search on the Registry’s database reveal Singapore patent no. SG10100 which includes claims directed towards the active ingredient itself. The Registry’s record for SG10100 shows that the Singapore patent was filed on 1 August 1995 and is currently in force.

15

In developing “Clean Face”, Popular Drugs found that the product works best when the active ingredient Facoxycline is present in an amount of less than 5% of the total composition. Your client tells you that current topical creams in the market comprise Facoxycline in excess of 50% and a disadvantage of such creams is that they dry the skin of users. They believe “Clean Face” is likely to be a big commercial success and its composition should qualify for a patent. Popular Drugs disclosed that they filed a patent application with the Registry just prior to meeting with you. The application identified Popular Drugs as sole applicant and, in their haste to file the application, no description of “Clean Face” accompanied the application.

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25

Popular Drugs also disclosed that its researchers worked closely with an external group of researchers employed by a university. There is no agreement in place between the Popular Drugs and the university. Being a small company, Popular Drugs’ business strategy is to eventually license the ensuing patent to larger companies that have the ability to manufacture and distribute “Clean Face” within and outside Singapore. A potential licensee has been lined up and has expressed interest to eventually own the rights to the Singapore patent.

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The client would like you to advise on:

(a) the impact SG10100 has on their plans to carry out clinical trials in Singapore.  
(7 marks)

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(b) whether their patent application satisfies the filing requirements and, if not, what must be done to rectify any deficiencies because they do not want the patent application to go abandoned.  
(5 marks)

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(c) if they should consider any issues that may interfere with Popular Drug's capacity to grant licenses before negotiation with the potential licensee begins.  
(8 marks)

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**Question 3**

This morning you received an email from a client with the following content:

5 Dear Patent Agent,

I have just been informed of a third party PCT publication (WO 2009/12345) that was published in the Chinese language on 1 June 2009. WO 2009/12345 was filed on 10 December 2008 and it claims priority back to a China patent application CN112233 filed on 10 20 December 2007. WO 2009/12345 is the only convention application which claims priority from CN112233 and it was not amended during the international phase. After obtaining a filing date, CN112233 was subsequently abandoned for failing to request examination and was never published.

15 Both CN112233 and WO 2009/12345 are identical in content and provide an enabling disclosure for the claimed invention and have the following one claim:

Claim 1:

20 A water bottle having a resealable cap, the cap including a straw hole; and a straw extending out from the straw hole.

As you know, I have a Singapore patent application SG201001122-0 which is a national phase of a PCT application WO 2009/12555 which claims priority back to a US provisional filed on 25 December 2007. The PCT application was filed on 10 December 2008 and 25 national phase entered on 5 May 2010.

SG201001122-0 has a main claim which is identical to the one claim of WO2009/12345.

30 The US provisional provides an enabling disclosure to support what is claimed in WO 2009/12555.

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Please advise me on:

(a) Can CN112233 and WO 2009/12345 be used against the novelty of SG201001122-0?  
(16 marks)

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(b) What about inventive step?  
(4 marks)

If your answer is dependent on circumstances of WO 2009/12345, please discuss the  
10 various circumstances.

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**Question 4**

Your client, Enosen, is engaged in cutting-edge research relating to the production of bio-fuels from micro-plankton. They have recently released a press statement that trials have  
5 been successful, commercial production started and sales orders may now be taken in Singapore. Enosen complains that they received an email, a copy is reproduced below.

----- Forwarded message -----2002401

From: Agung Omar

10 Date: Fri, Apr 29, 2011 at 1:37 AM

Subject: Intellectual Property Infringement

To: info@enosen.com

Dear Sir,

15

We hold International Intellectual Property Rights for all bio-fuels harvested from micro-plankton and this has been gazetted since 2009 and patented worldwide by the World Intellectual Property Organization (WIPO) to belong to us and we do not give any consent to your company.

20

Whatever your claims, any attempt to sell your product are illegal and are Intellectual Property infringement.

If you do not stop, we will take immediate international legal action.

25

DV8

----- End message -----

(a) Please advise on the claim that there is a worldwide patent by WIPO.

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(2 marks)

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(b) Can independent steps be taken to find out more details about DV8's alleged Intellectual Property Rights, and if so, what can be done?

(1 mark)

5 (c) Enosen wants to know whether they are exposed in countries where they have no plans, and what they should do in countries where they plan to do business. Please advise.

(6 marks)

10 (d) Enosen is afraid of an immediate infringement action by DV8 in Singapore, please advise on the remedies available to DV8 and Enosen's exposure to such remedies if, assuming that there is infringement, DV8 sues Enosen now.

(6 marks)

15 (e) Enosen is afraid that the email may affect their fund-raising efforts at this critical time. Enosen wants to know if they can instead take action against DV8. Please advise on what can be done and the remedies available.

(5 marks)

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**Question 5**

5 A famous adventure trip through the jungles of Java Island introduced Gloria to Kopi Luwak (coffee made from beans ingested and processed by the digestive system of *paradoxurus hermaphrodites*, the Asian palm civet cat). After returning from her vacation, she met with some old classmates. One of them, Jean, disclosed that some cats at her workplace, the Society for the Prevention of Cruelty to Cats (SPCC), love cappuccinos.

10 An ambitious master plan was hatched that day between Gloria and Jean. After months of experimenting with beans fed to and collected from cats at the SPCC, they finally devised a process for producing beans that surpass the aroma and taste of Kopi Luwak. They turned to their old university lecturer, Professor Starbuckovsky, for advice. Starbuckovsky, who was also a Singapore registered patent agent, prepared and filed a Singapore patent application for them for the process.

15 Gloria and Jean launched their coffee as “Kopi Kucinta” and it took the world by storm. They were courted by many suitors, both commercial and amorous. They finally fell in love with a business proposal of debonair coffee tycoon, Aik Chong, and granted him a licence to manufacture and sell Kopi Kucinta under the patented process so long as it remains  
20 patented.

25 Five years later, the patent had achieved grant and Kopi Kucinta was the hottest drink on earth with Aik Chong contributing over 90% of sales. Aik Chong was unhappy that revenue was disappearing as royalties to Gloria and Jean who spent most of their time adventuring and playing with cats. Aik Chong comes to see you with the objective of getting out of the licence, and yet carrying on the Kopi Kucinta business.

30 (a) Your investigations indicate that the renewal fee for the patent was due by 1 December 2010 and was not paid by 2 June 2011. Advise Aik Chong on the ramifications. No discussion of forms and fees and licence terms is required.

(7 marks)

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(b) Further enquiry leads to the discovery of the following:

i. An independent method claim of the patent was amended post-grant after leave was given by the Registrar. The amended portion is as follows:

5                   “... characterized in that said at least one coffee bean is ingested by an  
Asian ~~palm civet~~ cat, naturally defaecated as faeces by said Asian ~~palm~~  
~~civet~~ cat, isolated from said faeces of said Asian ~~palm civet~~ cat, ...”;

ii. The following statement exists in the background section of the patent specification:

10                   “... Mammals are not known to ingest coffee beans ...”

Disregarding issues of novelty and inventive step, advise Aik Chong on the ramifications of the above. No discussion of procedural details is required.

(9 marks)

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(c) Starbuckovsky has returned to Russia, Gloria has moved to Java Island, and Jean has relocated to Guangzhou to join the cause of the Chinese Animal Protection Network in opposing the eating of cat meat. Advise on the ramifications the situation presents to initiating any action Aik Chong may wish to take against the patent.

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(4 marks)

**End**