

## Answer guidelines to QE 2006 Paper D

Note: The answer guidelines contain some points (non-exhaustive) that could be covered in the answer to this Paper.

SPA = Singapore Patents Act  
SPR = Singapore Patents Rules  
s = Section (as in SPA)  
r = Rule (as in SPR)  
SG = Singapore  
PF = Patents Form

### **QUESTION 1**

#### **(a) Entitlement to Invention**

An "inventor" is the actual deviser of the invention

s2

Patent is granted to an inventor or joint inventors

s19(2)

It can be argued that the customer is the inventor as he came up with the concept, and Mr Wright only put the concept into practice

#### **(b) New Patent Application**

Patent cannot be amended because there is new matter

s84(2)

File a new patent application claiming priority of the 1 January 2005 application

s17(2)

But new matter will not have benefit of the 1 January 2005 priority date

#### **(c) Prior Singapore Application**

State of the art includes matter contained in another patent application filed earlier. Prior Singapore application may affect novelty.

s14(3)

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If application was in Malaysia, such application does not form state of the art if application was unpublished at the time of Mr Wright's patent application.

s14(2)

### **(d) Post-Grant Amendment**

Post-grant amendment is available as amendment does not introduce new matter or extend protection conferred by the patent.

s84(3)

### **(e) Post-Grant Search and Examination**

Mr Wright may apply for Post-Grant Search and Examination

s38A

Ground: Examiner did not consider all the relevant prior art before preparing the Search and Examination Report

s38A(1)(a)(ii)

## **QUESTION 2**

### **Part 1**

IPOS can only be the receiving office for citizens or residents of Singapore.

Because the priority application is filed in the name of the non-Singapore company, it would be necessary for such Malaysian company to assign the priority application to the Singapore company, whether the PCT application is filed:

(i) jointly in the names of both the non-Singapore company as well as the Singapore company, in which case the assignment would be partial; or

(ii) only in the name of the Singapore company, in which case the assignment would be for the whole application.

Article 9 of the PCT and Rule 18 of PCT Regulations

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Searching is compulsory. Competent searching authorities for Singapore are AU, AT, EP and KR, but KR is not applicable in this case, because the priority date is 1 August 2005 which is before 2 June 2006.

Cheapest is AT at S\$410

Rule 4.14 *bis* of PCT Regulations

Submit priority document not later than 16 months from the declared priority date. The date of submission is therefore 1 December 2006.

r17 of PCT Regulations

Time lines for entry into national phase

For Singapore: Article 22 Chapter I is 30 months - 1 February 2008

For Singapore: Article 39 Chapter II is 30 months – 1 February 2008

For Uganda – incompatible with Article 22 Therefore for Uganda - Deadline for Chapter I and II are different

For Australia – entry into national phase under Chapter I or II is the same.

Chapter I entry is necessary where a contracting state has not been elected and Article 39 (1) does not apply [would also accept wording, if demand for international preliminary examination has not been filed]

### **Bonus Mark**

Bonus mark if candidate advises that the deadline for Uganda may be the same under Chapter I and Chapter II if it is designated as part of the ARIPO regional entry into national phase.

### **Part 2**

A notice of intention to rely on an international preliminary report on patentability under section 29 (2) (e) (ii) using Patents Form 11C

r42A, SPR.

s29(2)(e)(ii), SPA

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Deadline to lodge Patent Form 11C is 42 months from the declared priority date. In this case, the deadline would be 1 February 2009.

r43(4), SPR

#### **QUESTION 3**

**(a)**

International Filing Date is the date of filing in Singapore.

s87(1)(a)

Renewal due date is calculated from the date of filing, i.e. 23 June 2000.

s36(1) and r51(1)

Tom would have been required to pay this year's renewal fee before 23 June 2010.

The deadline of 23 June 2010 has expired for more than 5 months.

The patent has ceased to have effect because the renewal fee was not paid.

s36(2)

However, Tom is still able to pay the renewal fee and the prescribed additional fee within 6 months from the end of the prescribed period for paying the renewal fee, i.e. by 23 December 2010.

If the above step is taken, the patent would be treated as if it had never expired.

s36(3)

The renewal fee to be paid is for the 11<sup>th</sup> year, i.e. the official renewal fee is S\$350.00.

The prescribed additional fee is S\$550.00.

Advise Tom to immediately arrange for the relevant forms to be filed together with the accompanying fees (PF 15 - renewal fee; PF 16 - prescribed additional fee).

**(b)**

Thereafter, to keep the patent in force, renewal fees are payable in the 3 months ending with the 11<sup>th</sup> and each succeeding anniversary of the date of filing.

r51(1)

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Maximum period that the patent can be kept in force is 20 years from the date of filing

s36(1)

i.e. patent is valid until 23 June 2020, if renewal fees are timely paid.

Renewal fee for the 20<sup>th</sup> year must be paid in the 3 months ending with the 19<sup>th</sup> anniversary of the date of filing, i.e. the last renewal fee is payable in the 3 months before the expiry of 23 June 2019.

### **QUESTION 4**

#### **(a)**

For a patent to be revoked under s80(1)(f)(ii) for misrepresentation to IPOS, the misrepresentation must be a material misrepresentation that led IPOS to grant the patent.

The fact that Alfy Poo was not listed as a co-inventor was not a material representation that would have led IPOS to grant the patent.

The remedial step to be taken is for SuperFlusher to file Form 23 to correct the error by adding Alfy Poo as a co-inventor.

s80(1)(f)(ii)

#### **(b)**

The allegation is that the letter is a demand letter and since the patent is alleged to be invalid, BigFlush, being a “person aggrieved”, is entitled to bring an action against SuperFlusher for groundless threats.

s77(1)

SuperFlusher will have to argue that the wording of the letter is such that there are no threatening words used in the letter.

It is simply a letter notifying BigFlush of SuperFlusher’s patent and inviting business collaboration.

s77(5)

Even if the words in the letter were found to be threats, SuperFlusher can still go on to prove that BigFlush is indeed infringing SuperFlusher’s patent and that SuperFlusher’s patent is valid.

s77(2)

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**(c)**

If Claim 1 is found to be invalid but the other independent Claims 2 to 5 are found to be valid, SuperFlusher can claim for damages and costs for the Claims found to be valid and infringed.

s70(1)

For SuperFlusher to succeed in its claim for damages and costs for the Claims found to be valid and infringed, SuperFlusher has to prove that the specification for the patent was framed in good faith, with reasonable skill and knowledge.

If SuperFlusher is able to prove this, the court or Registrar may grant damages and costs for the Claims found to be valid and infringed.

But subject to the court and Registrar's discretion on costs and expenses and as to the date when damages should be reckoned.

s70(2)

**(d)**

If Claims 2 to 5 are dependant on Claim 1, Claims 2 to 5 can still be found to be valid with the additional features in each claim.

But Claims 2 to 5 are only infringed if BigFlush's toilet bowls use the additional features in Claims 2 to 5.

As a condition for relief under s70(3), the court or Registrar may direct amendments to the specification of the patent.

### **QUESTION 5**

**(a)**

Registrar may correct errors or mistakes *in* the specification or application for a patent or document filed in connection with the application, not mistakes in the filing of an entirely wrong specification.

The mistake here was the filing of an entirely wrong specification.

Hence, not possible to correct by way of Form PF 23.

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s107

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No amendment shall introduce new matter not disclosed in the application as filed. Replacement of specification by way of amendment introduces new matter.

Hence, not possible to amend by way of PF 13.

s84(2)

### **Bonus Mark**

Not possible to correct because correction is not obvious as it is not immediately evident that nothing else would have been intended other than the correct specification

r91(2)

### **(b)**

If invention has not been disclosed in the meantime, advise the client to re-file the application in Singapore.

But no longer possible to claim priority based on the Australian application as priority date is now considered out of time

s17

### **(c)**

File Form PF 23 to correct the typographical error in the title in Form PF 1 (2004).

r91

### **(d)**

Rely on the outcome of the Australian application by submitting the prescribed information

Prescribed information consists of:-

(1) a certified copy of the patent granted in Australia or

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documents setting out the final results of a substantive search and examination of the Australian application and a copy of the claims referred to in the final results

Also need to submit the IPC symbols allocated to the Australian application

Deadline for submitting prescribed information is 42 months from the declared priority date. The deadline is 15 October 2008.

s29(2)(c)(ii)

r44

r43(4)