

INTELLECTUAL PROPERTY OFFICE OF SINGAPORE
PATENT AGENTS QUALIFYING EXAMINATION 2007

PAPER D: KNOWLEDGE OF PATENT LAW AND PATENT PRACTICE IN SINGAPORE
4 October 2007, Thursday
1400 – 1800 hrs

Maximum Time: 4 Hours (includes reading time)

Maximum Marks: 100



INTELLECTUAL PROPERTY
OFFICE OF SINGAPORE

INSTRUCTIONS TO CANDIDATES

1. This Paper consists of 14 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 and/or drawings to the question(s) written or glued 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 PCT provisions.

End

PAPER D: KNOWLEDGE OF PATENT LAW AND PATENT PRACTICE IN SINGAPORE
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Question 1

You act as a patent agent for Speedy Pte Ltd. On 1 November 2006, you filed Singapore application no. 20061111.6 without claims on behalf of Speedy. The application 20061111.6
5 discloses a type of undersea communications cable comprising a new material X as the core, which allows the cable to support data transmission rates of more than 100 Gbits/s. The application 20061111.6 describes the chemical structure of substance X and how to produce it together with the process of manufacturing a cable using X as the core material. The application 20061111.6 includes a broad statement of invention:

10

An undersea communications cable comprising core material X.

On 4 October 2007 (today), you received a facsimile from the R&D director of Speedy with the following message:

15

“Dear Patent Agent,

Thank you for your reminders concerning the various deadlines.

20

Further to the filing of the application, our company has carried out further research on the performance of material X. We realised that under normal circumstances, the material performs very well but under severe weather conditions and when the length of the cable is more than 50km, there is signal degradation of up to 20%. However, our researchers found out that we can solve the problem by coating X with a protective agent Y and we intend to
25 have a public trial sometime early next year. Obviously, this breakthrough is very important to us and thus, please proceed to add a claim relating to this improvement as well as the previous idea to SG 20061111.6 to maintain our patent protection in Singapore.

30

By the way, you should be informed that one of our researchers, without our permission, wrote an article about our new discovery that Y can overcome the signal degradation and his article was published in a local newspaper in June this year. The article describes in detail the composition of agent Y and the process of coating X with Y. Needless to say, we were

PAPER D: KNOWLEDGE OF PATENT LAW AND PATENT PRACTICE IN SINGAPORE
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5 furious with this and have reprimanded the researcher. However, I remember that you informed me the filing of SG 20061111.6 secures a priority date for our invention and we are free to disclose the invention after the filing and any such disclosures will not prejudice the validity of our patent application. Thus, I believe the publication of the article is

inconsequential but I thought I should inform you nonetheless.

I will be leaving for a 3-week holiday this weekend and thus, if you have any query or require any information, please let me hear from you today.

10 Yours sincerely,
R&D director”

Please draft a letter in response to the facsimile providing your advice and recommendations to protect Speedy’s invention in Singapore. In your letter, please indicate the legal basis, where appropriate, as well as reasoning to support your advice and recommendations. You should also indicate the various deadline(s), if any. If there are information gaps, you should specify what they are and explain why you need them to the client. In your letter, you should provide one reason whether you can or cannot proceed with the client’s instruction to add the claims as instructed.

20 Note: No marks are awarded for preparing claims relating to the client’s invention. For avoidance of doubt, these are the 2 claims that the client wants to pursue:

(1) An undersea communications cable comprising core material X.

25 (2) An undersea communications cable according to claim 1 wherein the core material X is coated with coating agent Y.

(20 marks)

PAPER D: KNOWLEDGE OF PATENT LAW AND PATENT PRACTICE IN SINGAPORE
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Question 2

Your client T Systems Pte Ltd (T Systems) filed and was granted a patent for an invention ("the Patent"). Claim 1 of the Patent reads : "A device that accurately gives a reading of a person's IQ (Intelligence Quotient) by the biometric pattern of the person's thumb". The commercial embodiment of the Patent is a desk-top device consisting of a biometric reader for a thumb and a small LCD screen that will show the IQ of the person.

The device proved to be an instant hit. Parents bought the devices to test their children's IQ. Schools bought the devices to test their students. Employers bought the devices to test their current employees for promotion purposes and to test job applicants for consideration. Even couples were buying the devices to test the IQ of their partners for consideration for marriage.

It came to T Systems' attention that a local company, SS Pte Ltd (SS) (after the Patent had been granted for over a year) had been selling a device that purported to give a reading of a person's IQ by reading the biometric pattern of a person's thumbs. The differences were that the device had a stand that allows it to stand on the floor and it uses 2 biometric readers for both the right and left thumbs to be used simultaneously instead of one biometric reader as in T Systems' device.

A demand letter was sent by T Systems to SS to cease and desist from patent infringement. SS responded by stating the following:

- Their device is different from T Systems' device. It is a floor standing device, not a desk-top device. It does not infringe the Patent.

- Their device uses 2 biometric readers. It does not infringe the Patent.

- Biometric readers and IQ tests have been in the market for a long time and as such, the patent is invalid.

PAPER D: KNOWLEDGE OF PATENT LAW AND PATENT PRACTICE IN SINGAPORE
4 October 2007, Thursday
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- The inventor listed in T Systems' patent is said to be Sparky Fool, the Managing Director. In fact, the real inventor is Smarty Pants, the ex-Research and Development engineer at T Systems. The patent should be revoked as a result of this gross misrepresentation by T Systems in obtaining the grant of the patent.

5

- SS is aware that Smarty Pants claims that the patent in fact belongs to him. He came up with the idea for the invention whilst "toying" with various prototypes at the T Systems R&D center. He claims that he was not instructed to come up with the invention. Smarty Pants is willing to take this matter up in court.

10

- As a result of the above, the demand letter is a groundless threat.

Sparky Fool came to you for advice after receiving the reply letter from SS.

15 He told you that it is not true that Smarty Pants alone came up with the initial idea of the invention. Both he and Smarty Pants came up with the idea after discussing various projects that did not work. Smarty Pants however did most of the work in building the prototype and commercializing the device.

20 He agreed that biometric readers and devices that test the IQ of a person were already in the market but none of the biometric readers could tell the IQ of a person.

Advise T Systems on :

25 (a) Whether Smarty Pants' claim will succeed.

(2 marks)

(b) What would happen to the Patent if Smarty Pants succeeds in his claim ?

(3 marks)

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INTELLECTUAL PROPERTY OFFICE OF SINGAPORE
PATENT AGENTS QUALIFYING EXAMINATION 2007

PAPER D: KNOWLEDGE OF PATENT LAW AND PATENT PRACTICE IN SINGAPORE
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- (c) Assuming that Smarty Pants fails in his claim, is the listing of Sparky Fool as the inventor correct and can the Patent be revoked for the misrepresentation to IPOS ?
What remedial steps can T Systems take, if any.
(5 marks)
- 5
- (d) Whether SS's defence of non-infringement will succeed.
(4 marks)
- 10
- (e) On the facts of the case, what are the considerations the Court would look at if SS commences a groundless threat proceeding and what can T Systems do to counter such a groundless threat proceeding ?
(5 marks)
- 15
- (f) What are the consequences if the threats in the demand letter are found to be groundless in the groundless threats proceeding ?
(1 mark)
- 20
- 25
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PAPER D: KNOWLEDGE OF PATENT LAW AND PATENT PRACTICE IN SINGAPORE
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Question 3

Company B, which is in the construction industry, purchased the rights to a Singapore patent from Company A for the sum of \$1.5 million dollars in May 2004. The patent has a filing date
5 in Singapore of 29 July 1998, claims priority from a US application filed on 1 August 1997, and was valid and subsisting at the time of the assignment. Company B appointed a Singapore registered patent agent to represent them in the assignment and to advise on matters relating to the patent. Company B's agent applied to update their firm as the address for service for all matters relating to the patent and record the assignment at the Intellectual
10 Property Office of Singapore ("IPOS") and subsequently received the notice of the recordal of the assignment in June 2004.

Shortly thereafter, Company B found itself in dire financial difficulties as one of their multi-million dollar projects was cancelled. They told their agent not to incur any further costs in
15 relation to the patent. Later on, Company B was informed by their agent that IPOS had sent them a notice of reminder to renew Company B's patent. The agent warned Company B of the consequences of not renewing the patent. Company B, feeling aggrieved by what they perceived to be the agent's lack of sensitivity to their predicament, promptly discharged him from acting further for them.

20

It is now March 2007. Company B's fortunes have miraculously turned around with the astonishing upsurge of the property industry. They have also discovered that other parties have started to use the invention covered under the patent sometime earlier in the year. They thus wish to reinstate their patent rights. They now approach you for advice as they are
25 too embarrassed to seek help from their former agent.

(a) Advise Company B on whether their patent can be restored, and why.

(6 marks)

30 (b) What would be your advice if the notice of reminder to renew was sent by IPOS to Company A, instead of to Company B's agent.

(6 marks)

INTELLECTUAL PROPERTY OFFICE OF SINGAPORE
PATENT AGENTS QUALIFYING EXAMINATION 2007

PAPER D: KNOWLEDGE OF PATENT LAW AND PATENT PRACTICE IN SINGAPORE
4 October 2007, Thursday
1400 – 1800 hrs

Maximum Time: 4 Hours (includes reading time)

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(c) Explain what would be your advice if Company B was informed of the wrong deadline to renew the patent by the agent. Assume for the purposes of this answer that it is now early January 2007 instead of March 2007.

(3 marks)

5

(d) Assuming that restoration is still possible as at March 2007, advise on what papers, forms and fees need to be lodged to restore the patent.

(4 marks)

10 (e) Assuming the patent is restored, can Company B take any action against the third parties who have been infringing the said patent by using the invention without their authorization, and why.

(1 marks)

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PAPER D: KNOWLEDGE OF PATENT LAW AND PATENT PRACTICE IN SINGAPORE
4 October 2007, Thursday
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Question 4

Eve loved apples. Her PhD work was devoted to investigating how non-tropical apple trees may be cultivated in Singapore. She blended Fuji apples with certain crabapple varieties and successfully created a new hardy variety, known as Eve's cultivar, which could grow in the tropics. She obtained her PhD with flying colours. Her research was also showcased at a technology forum.

While celebrating at a party, her supervisor, Adam, noted that the fruit from Eve's cultivar was small and did not taste as good as a Fuji apple. Since apples and roses belong to the same family (ie, Rosaceae), he suggested that grafting flowers of Eve's cultivar onto the tropical Bermuda Mystery rose shrub may yield promising results. Their joint post-doctoral work over the ensuing months gave birth to a blossoming relationship and the "Eden Apple", a juicier and tastier apple than the Fuji apple.

Fired by the entrepreneurial spirit and romantic notions, Adam and Eve decided to set up an Eden Apple farm. The Eden Apple grew best on red soil. Being Singapore residents, they began their search for farm land in Singapore but no viable options were available. They finally found a large plot of land near Kluang (Johore, Malaysia) which had red soil.

They wanted to protect the Eve's cultivar, the Eden Apple and the processes surrounding the grafting of Eve's cultivar. They were introduced to Sid Nake, a business consultant and patent agent based in Singapore. Sid Nake drafted a specification for the inventions and used it to file a Malaysian patent application and a PCT application on the same day.

Unknown to them, Sid Nake had not passed Paper D of the IPOS Qualifying Examinations and was not registered as a Singapore patent agent.

Two years later, Adam and Eve received a copy of the Malaysian and PCT publications. They noted that Eve was not identified as applicant or inventor. Page 11 of the specification in the PCT application which described the composition of red soil was also missing. When contacted, Sid Nake explained that the idea of grafting was Adam's, and that Eve's cultivar was unpatentable anyway. Sid Nake brushed the missing page 11 of the PCT application off

PAPER D: KNOWLEDGE OF PATENT LAW AND PATENT PRACTICE IN SINGAPORE
4 October 2007, Thursday
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as a clerical oversight and assured that it would be rectified. They accepted Sid Nake's advice..

By then, the Eden Apple had become a huge success. Alas, good times were not to last.

5 Dogs at the Customs department were unusually attracted to Eden Apples. Excited that they could extend their market to pet food, Adam and Eve studied the phenomenon. To Eve's horror, they found that the combination of Eve's cultivar, Bermuda Mystery rose and red soil at Kluang somehow resulted in the presence of a highly addictive narcotic substance in the Eden Apple. It was addiction to the narcotic which drove up sales. Eve felt this to be
10 against her morals and wanted to abandon all patenting activity. However, Adam and Eve could not see eye to eye on this and their relationship fell apart.

Eve went to see Sid Nake (who had by then passed Paper D after 2 attempts) for help to rid the world of the "evil" patents, in particular, a Singapore patent stemming from the PCT application. Hearing that Adam and Eve were separated, Sid Nake declared his affections
15 for Eve. Eve left in disgust and comes to you for advice.

Based on the above facts

(1) Discuss what should have been done prior to filing simultaneous Malaysian and PCT applications and the ramifications of not doing so.
20 (3 marks)

(2) Disregarding the omission of page 11, identify the main ground on which Eve may revoke the Singapore patent.
25 (5 marks)

(3) Describe the options available to rectify the omission of page 11 during the Singapore national phase of the PCT application.
(6 marks)

30 (4) How would your answer to question 3 be different if the PCT application claims priority from the Malaysian application?
(3 marks)

INTELLECTUAL PROPERTY OFFICE OF SINGAPORE
PATENT AGENTS QUALIFYING EXAMINATION 2007

PAPER D: KNOWLEDGE OF PATENT LAW AND PATENT PRACTICE IN SINGAPORE
4 October 2007, Thursday
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(5) Eve was surprised that Sid Nake had only just passed Paper D and wishes to punish him. Briefly discuss the contravention of the Patents Act committed by Sid Nake.

(3 marks)

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PAPER D: KNOWLEDGE OF PATENT LAW AND PATENT PRACTICE IN SINGAPORE
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Question 5

Section A

- 5 Mr Able Lim, CEO of Inventorall Pte Ltd ("**Inventorall**") advises you that one of his employees, Bobby Chin, has developed a prototype for a new pen knife with multiple new functions ("**the Pen Knife**"). Last year, Inventorall filed a Singapore patent application on 29 June 2006 ("**the Singapore Application**") for the Pen Knife. The next day, the Pen Knife was launched on the market under the name "WONDERKNIFE" ("**the Product**").
- 10
- Eight months later, Mr Lim comes to your office for patent advice. He informs you that to stay competitive, there has been a further improvement to the Product, and this improvement has not yet been launched. They have incorporated a lighter in the Pen Knife which works so well that the flame does not extinguish even in the face of a strong wind.
- 15 Mr Lim advises that this new feature of the lighter is technically unrelated to the pen knife and is another function which is appended to the Pen Knife. For that reason, Inventorall is also able to market the Lighter on its own without the Pen Knife, but for now, they are going to launch the Pen Knife and Lighter together as one product.
- 20 After you advise on his options, Mr Lim decides that Inventorall wish to protect the features of the Product namely (a) Pen Knife, (b) Pen Knife with a lighter function and (c) a lighter alone ("**Three Features**"). He instructs Inventorall wants to have one patent application, namely a PCT application to cover each of these Three Features ("**PCT Application**"), and does not wish to file a demand for international preliminary examination. He has also
- 25 specifically instructs you that for strategic purposes, he does not wish to make any amendments in the international phase.
- 30

PAPER D: KNOWLEDGE OF PATENT LAW AND PATENT PRACTICE IN SINGAPORE
4 October 2007, Thursday
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Assume that you will proceed as instructed, that is, file the PCT Application with the Three Features . Would the inclusion of the Three Features give rise to any objection by the PCT Authority in the international phase? If so, what can be done, bearing in mind the instructions from Mr Lim.

5 (8 marks)

When should Inventorall file the PCT application?

(4 marks)

10 Section B

Assuming a PCT application has been filed for the Three Features, you now need to advise Inventorall regarding national phase entry for Singapore. The first Singapore application is still pending and is at the stage of the payment of grant fee, since the search and examination report has been received. The grant fee has not been paid yet.

15

Advise what the deadline will be for national phase filing in Singapore ("**PCT national phase application**").

(2 marks)

20

Mr Lim puts forward two a scenarios for your consideration:-

(a) Assume that the Singapore Application claiming for the Pen Knife and the PCT national phase application claiming the for the Three Features are both filed and eventually granted patents by the Intellectual Property Office of Singapore. The claims for the Pen Knife are identical in the Singapore Application and the PCT national phase application.

25

Is this permissible under the Patents Act? If your answer is no, how can you remedy this whilst the Singapore Application and PCT national phase application are still pending, so that Inventorall can have two granted patents, namely from the Singapore Application and the PCT national phase application?.

30

(4 marks)

INTELLECTUAL PROPERTY OFFICE OF SINGAPORE
PATENT AGENTS QUALIFYING EXAMINATION 2007

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- (b) Secondly, assume the PCT national phase application has been filed for the Three Features and is still pending. Can one or more of the Three Features be separated into different patent applications? What requirements must be met? Please note that you need
5 not discuss which claims should be separated or the merits of separating the features, as Mr Lim is only interested to know whether it is possible.

(2 marks)