IPOS
INTELLECTUAL PROPERTY
OFFICE OF SINGAPORE

Answer Guidelines to QE 2007 Paper D

Note: The answer guidelines contain a non-exhaustive list of points that examiners expect candidates to cover 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

Dear R&D director,

Application 20061111.6

It is possible to add claim 1 but not claim 2 because:

s84(2) of the SPA stipulates that any amendment that discloses any matter extending beyond that disclosed in the application as filed shall not be allowed (OR s25(5)(c) of the SPA stipulates that the claim or claims shall be supported by the description).

Application 20061111.6 as filed discloses core material X but does not disclose coating agent Y.

Thus, adding a claim to material X (Claim 1) is not a problem but adding a claim relating to X+Y (claim 2) would be considered adding new matter contrary to s84(2) (OR s25(5)(c)).

Recommendations:
In view of the above, I would recommend that you file a new Singapore application A claiming priority from 20061111.6 and describing in detail coating agent Y so that we can add both claims 1 and 2.

The deadline to file the new Singapore application A is 1 November 2007 and the application 20061111.6 can then be allowed to become abandoned.

Both claims of application A will be valid despite the publication in the local newspaper and my reasons are:

Validity of priority claim – Application A

s17 of the SPA (OR Art. 4 of the Paris Convention) requires that the claims of application A must be supported by matter disclosed in the SG 20061111.6 for the priority claim to be valid.

Therefore, as discussed earlier, since SG 20061111.6 discloses material X and how to

produce X, claim 1 above is supported by the matter disclosed in SG 20061111.6 and therefore, the priority date of claim 1 dates back to 1 November 2006.

However, there is no enabling disclosure of agent Y in SG 20061111.6 and thus, there is no support for claim 2 and consequently this claim is not entitled to the priority date of 1 November 2006.

Effect of publication for Application A

s14(1) and (2) of the SPA state that an invention shall be taken to be new if it does not form part of the state of the art and the state of the art comprises all matter that has been made available to the public before the priority date of the invention.

In view of the above, the publication of the paper in June 2007 in the local newspaper will form prior art to claim 2 but not claim 1 because the publication is later than the priority date of claim 1 but earlier than claim 2.

Please let me have a copy of the publication in the newspaper for my detail study but based on your letter, it seems that the paper discloses in detail agent Y and how to coat X with Y, and if this is correct, then I believe this is an enabling disclosure and that claim 2 will not be new.

However, s14(4) of the SPA provides a grace period of 12 months from the date of a disclosure if the disclosure was made in consequence of a breach of confidence such that any such disclosure shall be disregarded against the novelty of the invention.

It is trite law that an employee owns a fiduciary duty to an employer. You said that the researcher submitted the paper without the permission of the company and thus, this is likely to be regarded as a breach of his duties as an employee and would fall under s14(4). If we are to file application A by 1 November 2007, then the publication in the local newspaper will be saved by s14(4) and excluded as prior art against claim 2 of your application A because it will be within the 12 months grace period.

I look forward to receiving your instructions to file a new Singapore application A claiming priority from 20061111.6.

Yours sincerely,
Patent Agent

QUESTION 2

(a) Whether Smarty Pants' claim will succeed.

State the conditions in s49(1)(a) and (b) with regard to T Systems' rights as an employer to the employees' inventions

Given that Smarty Pants was at the relevant time, T Systems' R&D engineer, working on various prototypes, the invention belongs to T Systems.

(b) What would happen to the Patent if Smarty Pants succeeds in his claim?
If Smarty Pants succeed in his claim, the Patent may be revoked under s80(1)(b) Alternatively, Smarty Pants may ask for a determination of rights to the Patent after grant under s47 Under s47, the Patent may be transferred to Smarty Pants, Smarty Pants may be added as a co-proprietor or Smarty Pants may be entitled to file a fresh patent after the original Patent has been revoked or partially revoked.
(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.
For a patent to be revoked under s80(1)(f)(ii) for misrepresentation to IPOS, the misrepresentation must be material. It must have led IPOS to grant the patent. The fact that Smarty Pants was not listed as a co-inventor is not a material misrepresentation. The listing of Sparky Fool as the inventor is correct. But Smarty Pants must be included as a co-inventor. This may be done by filing form 23 to correct the error by adding Smarty Pants as a co-inventor.
(d) Whether SS's defence of non-infringement will succeed.
SS's defence of non-infringement will not work. SS's device infringes T Systems' Patent claim. Although SS's device is floor standing and has 2 biometric readers, it still comes within the claim in T Systems' Patent. SS's device still comes within T Systems' Patent claim because the claim has no limitation as to whether the device is desktop or floor standing, or that there should be at least 2 biometric readers Under s113, the extent of the invention is that specified in the claims of the patent and the extent of protection conferred by the patent shall be so determined. Whether SS's device is different in some respect to T Systems' commercial

embodiment of the Patent is irrelevant for infringement purposes.
(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 ?
Under s77(1), the Court will determine whether SS is an aggrieved person Since SS is selling the device, s77(4) does not prohibit SS from bringing the action The Court will review the contents of the letter from T Systems was a mere notification under s77(5) In this case, since it is a demand letter, demanding that SS cease and desist from infringing the patent, it is not a mere notification T Systems needs to prove that the Patent is valid and has been infringed to satisfy s77(2)(a) and (b)
(f) What are the consequences if the threats in the demand letter are found to be groundless in the groundless threats proceeding ?
Under s77(3), SS can ask for a declaration that the threats are unjustifiable, an injunction against the continuance of the threats and damages for any loss which it has sustained by the threats
QUESTION 3
(a) Advise Company B on whether their patent can be restored, and why.
Restoration only allowed if proprietor took reasonable care to see that the renewal fee was paid within the prescribed period. s39(5) As Company B had consciously decided not to maintain the patent, they would not be able to satisfy requirements of s39(5). Deadline for restoration is 30 months from the date it ceased to have effect. r53(1)(a) Deadline to apply for restoration had expired on 29 January 2007. Therefore too late to apply for restoration in March 2007.

(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.
The Registrar has a statutory duty to send a notice of reminder to the address for service on record r51(6) The notice should have been sent to Company B's agent's address as the address for service instead of to Company A Registrar has the discretion to direct that a time limitation be altered if there is an irregularity which consists of a failure to comply with a time limitation attributable in whole or in part to an error on the part of the Registry, and which it appears to the Registrar should be rectified. r100 But failure to comply with time limitation had nothing to do with the error as Company B had consciously decided not to maintain the patent. Therefore Company B cannot rely on r100 Therefore still not possible to restore the patent.
(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.
Company B must show that they had set up an effective renewal arrangement/system/procedure By appointing a qualified patent agent Company B has put in place a proper system for renewal and they can thus argue that they had taken reasonable care to see that the renewal fee was paid. Therefore, restoration under s39(5) is possible
(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.
PF 41 with fee of $ 10 to record your firm's address as the address for service. PF 19 with fee of $ 500 together with statutory declaration or affidavit setting out grounds for restoration and evidence in support

If restoration is allowed, file PF 20 with additional fee of $ 300 File PF 15 for unpaid renewal fees for 7th year ($ 160) plus 8th and 9th year ($ 270 x 2) = $ 700
(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.
No action can be taken against third parties who have begun in good faith to use the invention or made in good faith effective and serious preparations to do such an act covered by the patent, as such use commenced after it was no longer possible to renew the patent under s36(3) , and before publication of notice of the application for restoration – s39(10)
QUESTION 4
Discuss what should have been done prior to filing simultaneous Malaysian and PCT applications and ramifications of non-compliance
s34(1) A person resident in Singapore cannot file or cause to be filed a patent application outside Singapore without the Registrar's written authorization unless a Singapore application was filed at least 2 months earlier and no outstanding national security direction exists. If no written authorization was obtained for the Malaysian application, Adam, Eve and Sid Nake may all have committed an offence. An offence under s34 may be compounded under s33 of the Intellectual Property Office of Singapore Act read with Schedule 3 by the imposition of a fine of up to $1,000.
Disregarding the omission of page 11, identify the main ground on which Eve may revoke the Singapore patent.
s80(1)(a) read with s13(2) A patent may be revoked if the invention is not patentable. An invention which is expected to encourage offensive, immoral or anti-social behaviour is not patentable. s13(3) The fact that the behaviour is illegal (ie, drug abuse) alone does not make the invention unpatentable. The narcotic-laden Eden Apple could arguably encourage offensive, immoral and anti-social behaviour in the form of drug abuse and thus be unpatentable.

All surrounding facts must be considered. Whether the narcotic content in the Eden apple was an inevitable result of the invention or merely a result of extrinsic factors (eg, the red soil at Kluang) may be relevant.

Describe the options available to rectify the omission of page 11 during the Singapore national phase of the PCT application.

s26(8) read with r26A(1)(b)

Page 11 may be filed as a missing part using Form 56 anytime before payment of the grant fee. However, the filing date is postponed to the date the missing part is filed.

s84(1)

An amendment to include page 11 may be filed but additional matter not disclosed in the initial specification must be excluded. The specification needs to be examined to determine if details on the composition of red soil was additional matter.

s107(1) read with r91(2)

The omission of page 11 may be corrected provided that the correction is obvious in the sense that it is immediately evident that nothing else would have been intended than what is offered as the correction. Although it would be obvious that page 11 was omitted, whether nothing else but the content was intended will require analysis of the specification.

The Registrar also has the discretion to publish the correction for opposition (r91(3)).

How would your answer to question 3 be different if the PCT application claims priority from the Malaysian application?

s26(9) read with r26A

Assuming that national phase is entered very early in Singapore, the filing date will not be postponed provided page 11 and the following are filed within 3 months of the filing date:

- A request for s26(8) not to apply
- A statement that the missing part is incorporated by reference to and completely contained in the Malaysian application
- The date, filing number and country of the Malaysian application
- A certified copy of the Malaysian application

Eve wishes Sid Nake to be punished. Briefly discuss the contravention of the Patents

Act committed only by Sid Nake.

s105(1) read with s105(8)

Practising as a patent agent without having in force a practicing certificate as a registered patent agent or an advocate and solicitor is an offence punishable by up to $5,000 fine and/or 12 months' imprisonment (s105(8)).

As Sid Nake was not a registered patent agent when he prepared, filed and advised on the Malaysian, PCT and Singapore applications, he may be subject to criminal prosecution.

QUESTION 5

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.

If you file application with Three Features, then the requirement for unity of invention must be met.

r13 of PCT Regulations

The international application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept.

Where a group of inventions is claimed in one and the same international application, the requirement of unity of invention shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression "special technical features" shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art.

In this case, it would be difficult to establish a technical relationship between the pen knife and the Lighter as these are unrelated to each other.

If there is a lack of unity of invention issue, then the international searching authority will not establish a search report.

Article 17.3 PCT Treaty

The Applicant is invited to pay additional fees due for searching.

r40 PCT Regs

When should Inventorall file the PCT application?
Pen Knife is already disclosed to the public, so no longer novel. s14 PA Since Inventorall wants all Three Features including the Pen Knife, it needs to file the PCT application claiming priority on Singapore application by 29 June 2007 Article 8 PCT Treaty
Advise what the deadline will be for national phase filing in Singapore ("**PCT national phase application**").
National phase entry will be 30 months from priority date 29 December 2008 R86(1)
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?
If the Singapore application and PCT national phase application both proceed to grant, and contain identical claims, there may be an issue of double patenting. (s30(3)(e) PA
One way to remedy is to amend PCT national phase application so that the identical claim(s) to the Singapore Application is removed prior to grant. S31 of PA
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 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.
Applicant will need to file a divisional applications (a) before the earlier application

has been refused, withdrawn or treated as having been abandoned; and (b) before all the conditions in s30 (2) and (3) are satisfied s26(11) PA r27 Patent Rules