

INTELLECTUAL PROPERTY OFFICE OF SINGAPORE
PATENT AGENTS QUALIFYING EXAMINATION 2006

PAPER D: KNOWLEDGE OF PATENT LAW AND PATENT PRACTICE IN SINGAPORE
12 October 2006, 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 10 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

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Question 1

Your client, Mr Wright, is a manufacturer of ball placement machines for computer circuit boards. You have been approached to file a patent application for Mr Wright.

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Instead of gluing metallic balls onto circuit boards manually, Mr Wright was approached by a customer, Mr Ross, to build an automatic ball placement machine incorporating a camera mounted on the machine so that the ball placement can be done automatically. Mr Wright and Mr Ross did not sign any development agreement.

10

After building such a machine, Mr Wright decides to file a patent application for it before selling it to the customer. Assume that you have drafted the following claim for him:

“Apparatus for attaching metallic balls onto a circuit board, comprising (a) a glue applicator for depositing glue onto the circuit board, (b) a ball placement tool for mounting metallic balls onto the deposited glue, and (c) a camera mounted to the glue applicator **or** the ball placement tool.”

15

(a) Advise Mr Wright as to who is entitled to be granted a patent for the invention.

20

(5 marks)

(b) You filed a patent application in Singapore on behalf of Mr Wright on 1 Jan 2005 having the above claim only. On 1 Oct 2005, Mr Wright tells you that he discovered a further modification which was not disclosed in the patent specification as filed, ie. that the camera could be mounted on **both** the glue applicator **and** the ball placement tool. Mr Wright insists that he wants protection for this modification as it increases the processing speed. What would be the best way for him to protect this feature?

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(5 marks)

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(c) After filing the patent application in Singapore, Mr Wright was told by Mr Ross that Mr Ross had filed a patent application in Singapore on 1 Dec 2004 for a ball placement machine incorporating a camera. Mr Wright asks you whether this development might affect the patentability of his own patent application. Advise Mr Wright. Would it make a difference if the patent application was filed by Mr Ross in Malaysia only and not Singapore?

(4 marks)

(d) After undergoing Search and Examination, the patent application is granted in Singapore. Mr Wright then finds out that there is a European patent application published on 15 Dec 2004 that disclosed a camera mounted on a glue applicator **only**. In Mr Wright's patent specification, the preferred embodiment of the invention has the camera mounted on a ball placement tool **only**. Mr Wright wants to amend his claim to limit it to a camera mounted on the ball placement tool **only** in order to avoid the European publication. On what basis can Mr Wright do so?

(2 marks)

(e) Despite the amendment made in paragraph (d) above, Mr Wright wants to ensure that the amended claim is patentable under Singapore law notwithstanding the European publication. Advise him what he can do to obtain comfort that the amended claim is valid in the light of the European publication, and if so, on what basis.

(4 marks)

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Question 2

Part 1

5 Your client, Mr Lim of XYZ Pte Ltd, is an up and coming entrepreneur. He has come up with a couple of innovative products, and advises that last year, he filed a Malaysian patent application for one of the products in the name of his Malaysian company, ABC Sdn Bhd. The date of filing was 1 August 2005. Actually, he wanted to file the Malaysian application in the name of XYZ Pte Ltd, his Singapore company, but the company was not incorporated at
10 that time. XYZ Pte Ltd has since been incorporated.

He has heard of the Patent Cooperation Treaty (“PCT”) and been reading up on it. He wants to file a PCT application in Singapore, claiming priority based on his Malaysian application. He asks which company he can use to file the PCT application.

15 On the PCT application, he tells you that he is currently most interested in Singapore, Australia and Uganda (where his brother in law has started up a business), which are big markets for him. The PCT application was filed on 30 July 2006, claiming priority of the Malaysian application. He asks whether he has a choice to select the searching authority.
20 Please advise him which searching authorities were available to him, and which one you chose on the basis that he instructed you to select the one with the lowest official fee.

He asks what he needs to do in relation to his priority claim now that his PCT application has been filed. Also, what are the deadlines for him to enter into national phase for Singapore
25 under (a) Chapter I; and (b) Chapter II? For each of the countries Australia and Uganda, would the deadlines for entry into national phase under Chapter I be the same as or different from the deadlines for entry into national phase under Chapter II ? In what situation would entry under Chapter I be necessary?

30 Please advise Mr Lim of all relevant issues.

(15 marks)

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Part 2

You have entered national phase for Singapore in time but not for any other countries. Then Mr Lim told you to cease work. Time passes and Mr Lim calls you out of the blue on 5 30 January 2009. He tells you that he wants to secure grant in Singapore based on the documents that he has, as he does not want to incur costs in requesting examination. All you have on file is the PCT search report because no demand for international preliminary examination has been made earlier. Based on his new instructions, what prosecution route can he rely on, what documents are required and by when must he lodge 10 the necessary documents?

(5 marks)

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Question 3

Today is 5 December 2010.

- 5 (Assume that the relevant provisions of the Singapore Patents Act and Rules are identical to the provisions as at 30 June 06)

Your friend Tom comes to your office and shows you a number of documents which relate to a Singapore patent which he owns. He tells you that he has lost the rest of his file relating to this patent, including the Certificate of Grant. His previous patent agent handling this matter for him has retired this year, and he has been unable to contact him.

You peruse the documents and note the following. The patent is derived from a PCT International Application. It claimed priority from two Japanese applications dated 10 December 1999 and 25 January 2000. The International Application was filed on 23 June 2000. The Singapore application (national phase) was filed on 1 June 2002. The patent was issued on 12 December 2005. You also note that there is a letter dated 5 April 2009 from the previous patent agent informing Tom that the 2009 annuity has been paid.

- 20 (a) He wants to know if the patent is still valid, whether he needs to pay renewal fee this year, how much official fee he needs to pay, and what steps he needs to take now.

(14 marks)

- 25 (b) He also wants to know what he needs to do in future to maintain this patent, when his patent is valid until (assuming all renewal fees are timely paid), and when the renewal fee must be paid for the last year of the patent.

(6 marks)

Please advise Tom.

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PAPER D: KNOWLEDGE OF PATENT LAW AND PATENT PRACTICE IN SINGAPORE
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Question 4

SuperFlusher Pte Ltd is a toilet bowl manufacturer. SuperFlusher was recently granted a patent for an invention for toilet bowls that flush by voice activation. All the 5 claims in the patent are independent claims. The named inventor was Randy Poo.

Following the grant of the patent, SuperFlusher sent a letter to BigFlush with the following words:

10 “ *It has come to our attention that you have been selling toilet bowls that are voice activated.*

We wish to draw to your attention our recently granted patent no. 11111111. A copy of the patent is enclosed.

15 *If you wish to have a business collaboration with us, please call Mr Randy Poo at 67654321.*”

SuperFlusher recently received a reply from BigFlush’s lawyers as follows:

20 “*We act for BigFlush Pte Ltd. We refer to your letter to our client.*

We are instructed that your patent no.11111111 is invalid due to the following prior art:

-A brochure of a voice activated control for car doors

25

-A brochure of a voice activated shower

Copies of the brochures are enclosed.

30 *We are further instructed that Randy Poo is not the inventor of the invention. His brother Alfie Poo is the real inventor and since you have misrepresented to IPOS, we are instructed to commence proceedings revoke your patent under section 80(1)(f)(ii) of the Patents Act.*

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As such, our instructions are that your letter constitutes a groundless threat and our client will be commencing proceedings against you accordingly.

5 *We also place on record that our client was not aware of your patent until our client received your letter.”*

Randy Poo, the Managing Director of SuperFlusher approaches you for your advice. He tells you that having checked the brochures and inspected the products advertised in the brochures, he is confident that Claims 2 to 5 of the patent are definitely not anticipated but he is concerned about Claim 1 of the patent. Further, he tells you that he and his brother Alfy Poo had come up with the idea for the invention but his brother did not want to be listed as an inventor as he was not involved with SuperFlusher nor is he in the toilet bowl business.

15 a) Advise SuperFlusher on whether its patent can be revoked for misrepresentation to IPOS because of the non-disclosure that Alfy Poo was a co-inventor and whether there is any remedial step that SuperFlusher can take.

(4 marks)

20 b) Advise SuperFlusher on what BigFlush needs to prove for the groundless threats action and how SuperFlusher can defend against such an action.

(7 marks)

25 c) What would happen if the Court finds that Claim 1 is invalid ?

(6 marks)

d) Would your answer be different if Claims 2 to 5 are dependent claims of Claim 1 ?

(3 marks)

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

5 You are approached by a local company who has filed a patent application in Australia on 15th April 2005 and a corresponding application in Singapore on 14th April 2006. The Singapore application claims priority from the corresponding Australian application. The clients had instructed agents to handle the application in Australia but had filed the application in Singapore on their own. On 25th May 2006, the clients received a letter from the Singapore Patents Office, pointing out discrepancies between the title of the invention as stated on Form PF1 (2004) and as found in the attached patent specification. The clients would now like to appoint you as their agents in Singapore to sort out the problems with their Singapore application.

15 (a) You have reviewed the documents in their file records and note that the clients had attached the wrong patent specification for a different invention, to Form PF 1 (2004). Advise the clients if it is possible to replace the wrongly filed patent specification with the correct patent specification and discuss which form should be filed. If not, please explain why.

(8 marks)

20 (b) What other step(s) can the clients take to remedy the situation if the invention has not been disclosed in the meantime?

(3 marks)

25 (c) What would be your advice if, instead of attaching the wrong patent specification, the discrepancy was due to a typographical error made to the title of the invention at the time of completing Form PF 1 (2004).

(2 marks)

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- 5 (d) Due to budget constraints, the clients have asked if there is any way to avoid incurring the costs of having the application searched and examined in Singapore. Save for the applications filed in Australia and in Singapore, they have not filed for patent protection for the invention in any other part of the world. Provide your recommendation and advise on the deadline(s) which need to be met under the recommended course of action, assuming no extension of time is required.

(7 marks)