

PAPER D: KNOWLEDGE OF PATENT LAW AND PATENT PRACTICE IN SINGAPORE
9 October 2008, Thursday
1330 – 1730 hrs

Maximum Time: 4 Hours (includes reading time)

Maximum Marks: 100



INTELLECTUAL PROPERTY
OFFICE OF SINGAPORE

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 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

- A. Helio contacts your esteemed patent agency office for advice. He had learned of your formidable reputation from close and reliable sources. Helio explains that he is a scientist cum entrepreneur and he has been enjoying a very successful working relationship with Stasis Inc from the Windland Islands (“Stasis”), a small sovereign nation that has been experiencing a boom as a pharmaceutical research centre. After cooperating in many other markets with Stasis, and upon learning of the growing sick and ageing population in Singapore, Helio is ready to exploit the Singapore market with the following:
- 5
- 10
- “Patent W” – a product invention for battling bad breath using an innovative pharmaceutical ingredient with 2 tongue cleaning embodiments, a spatula form and a W-shaped scraper form
- 15
- “Patent X” – a product invention involving the use of fluoride for the prevention of tooth decay
- “Patent Y” – an improvement of Patent W with the additional ingredient of using fluoride
- 20
- “Patent Z” – an improvement of Patent W where with an additional ingredient the product is vaporized and can be administered unobtrusively without physical contact with the tongue
- (The term “Patents” will be used to refer to Patents W, X, Y and Z.)
- 25
- All of the Patents were filed through the PCT with a subsequent national phase in Singapore. Helio explains that for Patent Z, which he is most proud of, Helio was a co-inventor and the granted patent is held in both the names of Helio and Stasis. Patent W is granted in the name of Stasis alone. The application for Patent X had encountered serious objections and rejections in numerous jurisdictions such that to save money, the Singapore national phase
- 30
- was withdrawn. Patent Y is a pending application in the name of Stasis.

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Helio plans to import, warehouse and sell products covered by the foregoing Patents to hospitals by himself, and to clinics through a licensee. Please advise Helio on the following:

5 (a) Apart from a licence, Helio is so confident of success in Singapore that he is willing to invest in acquiring ownership of Patent Y for Singapore. He is also wondering, since half of Patent Z belongs to him, whether he needs to receive a licence for it from Stasis. Since they already have a successful model of exploitation in other markets, and in order to save costs (i.e., so that they do not need to pay you so much money), Helio is considering having the contract (which includes the assignment and licence) for Singapore be an oral one.

10 (4 marks)

(b) He understands that he is to receive an exclusive licence for Singapore with respect to Patent W so that he and Stasis can exploit the market together.

15 (2 marks)

(c) Stasis also manufactures a toothbrush product, which Helio regards as rather mediocre. However, Stasis' second daughter is the inventor of the toothbrush, and so for obvious reasons Stasis insists that as part of the licence terms, Helio must purchase 10,000 toothbrushes annually for sale in Singapore.

20 (1 mark)

(d) Helio will be importing the products from the Windland Islands and they will be sold in Singapore stamped with the word "Patented".

25 (2 marks)

(e) Finally, again to save money, Helio says that he does not intend to register the contract (which includes the assignment and licence) with the Intellectual Property Office of Singapore.

30 (2 marks)

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5 B. Helio did not like your advice and went away in a huff. It is now 2 months later after Helio signed the contract with Stasis, and Helio has been selling the spatula form and the no-physical contact product. Helio has recently learnt that there is an infringer in the market importing and selling products that clearly fall within the claims of Patents, W, X, Y and Z (“Infringer”). This includes the W-shaped scraper form. Helio has had frenzied discussions with Stasis about the situation. Stasis wishes to save money and so leaves Helio to take care of the problem himself.

Please advise Helio if he is entitled to take action against the Infringer without Stasis.

10

(4 marks)

15 C. Helio comes back again a week later. He explains that the Infringer has told him that the latter is a parallel importer selling genuine products sourced from the Foul Islands. When told of this, Stasis became furious because the Foul Island’s licensee is expressly prohibited in his licence from selling to parallel importers. Stasis now wishes to join in the infringement action.

(a) Please advise whether the Infringer has a defence as a parallel importer.

20

(2 marks)

(b) Please advise whether there are other difficulties in the infringement action if the terms of 1(c) above remained in Helio’s contract, and Helio imported and sold the products in Singapore stamped with only the word “Patented”.

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(3 marks)

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Question 2

(a) You were instructed by Adam to prepare a patent application for a device for removing dental plaque and stains, as well as a method for cleaning teeth which removed dental plaque and stains. The invention made use of N-monochloroglycine (NMG), which was a known industrial cleaner, but to Adam's knowledge, it had never been used in dentistry. Apparatus claim 1 of the patent claimed an "Apparatus for removing dental plaque and cleaning stains from teeth, comprising a brush coated with a material containing N-monochloroglycine." Method claim 2 of the patent claimed a "Method for removing dental plaque and cleaning stains from teeth, comprising contacting the teeth with a brush coated with a material containing N-monochloroglycine (NMG)." Advise Adam as to the patentability of the invention.

(3 marks)

(b) On Adam's instructions, you filed a patent application at the UK Intellectual Property Office (UKIPO) after getting security clearance from IPOS, thus obtaining a filing date of 1 October 2007 for the UK patent application. On 1 October 2008, you were instructed by Adam to file a corresponding patent application in Singapore claiming priority from the UK filing date. Since the Singapore patent application was to be filed on the same day and because your new secretary was not familiar with PF 1, the Singapore patent application did not claim the priority date of 1 October 2007 from the UK patent application. Furthermore, in her hurry, she forgot to photocopy one page of drawings attached to the patent specification, and she did not file the page of drawings.

It is now 15 October 2008. How may Adam claim the priority of the UK patent application and file the drawing that was overlooked?

(10 marks)

(c) A request for a Search and Examination Report was filed in Singapore. A Written Opinion was issued in which the Examiner cited prior art which disclosed a brush coated with a material containing NMG. Therefore, the Examiner opined that the claims lacked novelty and inventive step. However, Adam pointed out to you that the brush in the prior art

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5 had a conventional round cross-section, whereas his patent application disclosed not just a brush, but a brush with a 3-sided cross-section. Adam told you that the 3-sided cross-section was advantageous over the prior art as it reached farther in between the teeth, resulting in more thorough removal of plaque and cleaning of stains. Therefore, you amended the claims to insert the words, "... wherein the scalpel comprises a triangular cross-section" at the end of both claims 1 and 2.

10 Thereafter, the Examiner issued an unfavourable Examination Report in which he concluded that claims 1 and 2 are now novel, but that claiming a brush with a triangular cross-section still lacked an inventive step. Meanwhile, the UKIPO issued a favourable Examination Report wherein the UK patent application was allowed after an amendment to insert, "... wherein the scalpel comprises a cross-section having two straight sides and a curved side", instead of the amendment which you made. Adam is confident that the claims which have been allowed in the UK are definitely patentable, and does not wish to waste money
15 requesting for another Search and Examination Report. On 1 October 2010, he asks you to just amend the claims according to the allowed UK claims, and then pay the fee for grant thereafter with the further-amended claims.

20 Discuss whether and how a valid patent may be granted to Adam in the circumstances set out in section (c).

(7 marks)

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Question 3

Bobo Tan (Bobo) was a salesman for Eazypay Pte Ltd (Eazypay). His job was to sell handheld wireless credit card payment devices (CCD) to restaurants. The device allows a customer to pay for their meals with a credit card at the customers' table instead of the waiter bringing the credit card to the cashier. Eazypay owns the patent in Singapore and various countries for the invention that led to the CCD device. He worked at Eazypay for 5 years. At a sales presentation to a chain of restaurants, one of the restaurant managers asked if the device could also allow the customer to use his cash card to pay for the meal. He told the restaurant manager that the Eazypay device could not do so.

He then checked and discovered that although there were separate wireless devices that could allow customers to pay by credit card or by cash cards, there was no wireless device that allows customers to do both with the same device. He felt that an invention that could lead to a device that could perform both functions, a dual function device (DFD) would be in demand. He did not provide this feedback to Eazypay.

Without informing Eazypay's management, he looked around for a company that could help him develop the DFD. He found such a company in Paycash Pte Ltd (Paycash). After office hours, Bobo developed the DFD with the help of some funding from Paycash. Bobo also obtained technical assistance from Eazypay's research and development team (R&D team) to develop the DFD, again, without informing Eazypay's management.

Once the DFD was ready, Bobo resigned from Eazypay and joined Paycash. Paycash's Managing Director, Cando Chan (Cando) then told Bobo that a patent should be filed for a wireless device that allows customers to pay by credit card or by cash card. Paycash filed the patent under its name and named Cando as the sole inventor. The patent was granted.

After Bobo left Eazypay and a month after Paycash's patent was granted, Eazypay's R&D team that worked with Bobo also came up with their own wireless device that allows customers to pay by credit card or cash card. Eazypay then launched their new device in the market. Almost immediately, Eazypay received a letter from Paycash's lawyers, informing

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Eazypay of Paycash's patent and requesting that Eazypay obtain a licence from Paycash. In the same letter, Paycash's lawyers also pointed out that "others have obtained a licence from Paycash and avoided costly and unnecessary litigation". The letter was copied to Eazypay's major customers.

5

Eazypay is aware that Bobo has joined Paycash and has uncovered the fact that Bobo was developing Paycash's invention of a wireless device that allows payment by credit card or by cash card when Bobo was employed by Eazypay and with the technical assistance of Eazypay's R&D team. Unfortunately, because Bobo was only a salesman, Bobo signed a very simple employment contract with Eazypay, with no confidentiality clause nor clauses on ownership of intellectual property.

10

Specifically, advise Eazypay on the following:

15 a) What arguments might Eazypay use to argue that Eazypay is the rightful owner of the invention for a wireless device that allows payment by credit card or by cash card, to the exclusion of Paycash?

(7 marks)

20 b) Assuming that Eazypay feels very strongly that the invention belongs to Eazypay and want to recover the patent from Paycash, what kind of order can Eazypay try to obtain and where should proceedings be commenced?

(3 marks)

25 c) Assuming that Eazypay does not want to recover the patent from Paycash nor does it want to take a licence from Paycash, aside from waiting for Paycash to commence a patent infringement action, what concrete steps can Eazypay take to counter the letter from Paycash's lawyers and what are the possible pitfalls?

(10 marks)

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Question 4

- Troy has a natural talent for singing. In a freak accident, he discovered a novel voice warming-up technique which enabled his vocal-range to extend over 4 octaves. Troy
- 5 decided to use this new-found ability to embark on a singing career. As the technique involved certain embarrassing activities, Troy always practiced in seclusion and secrecy. He chose only to take his girlfriend, Gabriella, a postgraduate musicology student, into his confidence.
- 10 Within 2 years, Troy became a musical sensation in Singapore and Malaysia. With success came magnanimity. Troy wanted to share his technique with the world by filing a patent for it. He approached a friend, Sharpay, an engineer who has a number of patents to her name, for help. Sharpay warned Troy about the high costs of engaging patent agents and assured him that she has seen enough patents to know how to draft and prosecute them at a much
- 15 lower consultancy fee. Troy was only too grateful for Sharpay's advice.
- Sharpay drafted a specification for Troy's invention and filed it in a PCT application. She was sensible enough to indicate the Intellectual Property Office of Singapore as the Receiving Office. Unfortunately, she omitted to include any claims. She also forgot to send
- 20 payment by cheque.
- On the day the patent application was filed, Troy took Gabriella out to a posh restaurant to celebrate. While enjoying the dessert in the romantic candlelight, Gabriella revealed that she was inspired to focus on vocal techniques in her dissertation which briefly described Troy's
- 25 technique in an illustration. The dissertation was submitted and published one month ago. To safeguard Troy's interest, she had filed a patent for Troy's invention in Singapore six months ago. She could have filed it in Troy's name but used her name instead out of convenience. She had been waiting for a good opportunity to tell Troy.
- 30 Troy appreciated Gabriella's transparency and forgave her. He just wanted to ensure that valid patent protection is granted for his invention. Troy sought Sharpay for guidance. The matter was obviously beyond Sharpay's competence but she did not want to show her

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ignorance. So, she threw a tantrum about Troy not trusting her. Troy had no choice but to seek alternative help. As your firm of patent agents handled Gabriella's application, Troy comes to you for advice.

- 5 a) Assuming that no further action is taken in relation to Troy's application, briefly describe the events that will occur as a consequence of Sharpay's failure to pay the fees for Troy's application?
(4 marks)
- 10 b) On what basis can Troy's application come to be regarded as a Singapore patent application?
(2 marks)
- 15 c) Assuming that Section 14(4) of the Patents Act does not apply, describe what Troy may do to achieve valid patents for his invention despite Gabriella's patent application and Gabriella's dissertation?
(10 marks)
- 20 d) Discuss how Sharpay may have contravened the Patents Act and the consequences she will likely face.
(4 marks)

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Question 5

5 A. Your clients, a Singapore company, had filed a patent application in Korea on 9 October 2007. They subsequently filed patent applications in the United States of America and Denmark on 18 February 2008 in respect of the same invention. Your clients have now come to you and instructed you to file a patent application in Singapore claiming priority from their Korean application. The search and examination results for your clients' Korean and US applications appear rather unfavourable but they received a positive search and examination report for the Danish application.

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Advise your clients on whether there is any legal impediment to the filing of the patent applications outside Singapore first. They also wish to know all the possible ways they may proceed to grant in Singapore and the dates by which action must be taken, and also requested your recommendation of an appropriate route to grant which they should take. They are however concerned about the costs which they have spent and therefore they wish to keep costs minimal. At the same time, they hope to have as much time as possible to consider their options and to observe market response to their new product. Please advise, stating the reasons for your recommendations.

(14 marks)

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B. Assume that your clients eventually filed a request for search and examination for their Singapore application and the Registrar of Patents then issued a Written Opinion with only an objection raised on the ground that there is lack of unity of invention. Only the first invention was searched. Due to cost concerns, your clients decide not to file any response to the Written Opinion and instructed you to pay the grant fee straightaway.

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Please advise your clients on the issues they should consider if no response to the Written Opinion is filed and the grant fee is then paid, as well as the appropriate steps you believe they should take and the time limits applicable, if any.

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(6 marks)

Please include in all your answers to the above all supporting references to the relevant corresponding provisions in the Patents Act & Rules.