

## INTELLECTUAL PROPERTY OFFICE OF SINGAPORE

### Examiners' Tips to Candidates taking the Singapore Patent Agents Qualifying Examination<sup>1</sup>

#### **General Comments**

The purpose of the Examination is to assess whether the candidate being examined is fit to practise in Singapore as a Patent Agent, advising the public concerning patents and related matters. The public are entitled to expect sound advice on such matters from a Patent Agent entered on the Register including individuals who are registered in consequence of passing the Qualifying Examination.

It is important, therefore, that candidates should present answers which reveal their ability to act as responsible Patent Agents. Advice or suggestions given as part of an answer should be complete and cover all aspects of the issues involved for that is what the public are entitled to expect when they seek advice from a patent agent. An incomplete or incorrect answer could in real life leave the client unprepared for serious consequences. Answers which only deal with some of the issues present in a question will only receive poor marks.

In addition, candidates should never recommend a course of action that might lead a client into trouble or cause the client to act illegally.

There is no set way to write an answer to any of these Papers. However, if candidates recognize the importance of the reasoning, the answer will have the same logical flow as the analysis on which it is based. Candidates are expected to clearly and logically set out their reasoning, opinion and conclusions on all the issues identified in each Paper.

Candidates should not, as part of their answer, ask the Examiners questions. For example some candidates offer more than one answer to a question and then invite the Examiners to choose the one they like best. This is of little help to a client and very few marks, if any will be given for this kind of answer. It is for the candidates to make up their minds which is the correct answer. This does not mean that candidates should not consider, for example, arguments both for and against infringement or validity in Paper C but having done that candidates should then assess which arguments are likely to prevail in court. That is what the clients expect.

Similarly, Examiners will not attempt to read the candidates' minds. Credit will only be awarded for what is written in the answers scripts.

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<sup>1</sup> Comments from the various Examiners have been collated to form this document.

## **Paper A – Preparation of a Patent Specification Drafting**

### 1. Scope of the Paper

In this paper the candidate is asked to draft a patent specification which gives the best possible protection for the invention the client has made but at the same time is valid over the known prior art (in the question) and also meets the other requirements of Singapore Patent law, that is: the claims define the invention, clarity of the claims, claims supported by the description, unity, and sufficiency.

### 2. Assessment of Answer

If the claims drafted by the candidate are invalid for lack of novelty the candidate will almost certainly fail the paper because it is impossible for the Examiners to award marks for the claims in such circumstances. If the claims are open to objections of failure to define the invention, lack of clarity, non-unity or lack of support and /or the specification lacks sufficiency then marks will be lost. The amount of lost marks depends on the seriousness of the objection.

On the other hand if the claims are seriously restricted that will also cause a loss of marks because an unnecessary restriction is a loss of monopoly rights to which the client is entitled. Three or more unnecessary restrictions will lead to a fail.

So the candidate must find the “window” between validity on the one hand and unnecessary restriction on the other hand. If the candidate is in doubt as to the correct scope of the claims it is better to ensure novelty by accepting a slight restriction. This may cause the loss of a few marks but that is better than drafting claims which lack novelty which will normally result in a fail. As indicated in the opening comments, candidates should not offer claims of different scope and then invite the Examiners to choose the one they like best.

The bulk of the marks in this paper are awarded for the independent claim or claims since they will largely determine the extent of protection the client will receive. Candidates should bear this in mind when managing the time they spend on the different parts of the answer, namely independent claim(s), dependent claims and description.

### 3. Answer

Candidates should always consider whether it is possible to claim the invention in more than one category – that is product and process. Sometimes, it may be possible to claim different aspects of the invention independently so as to give the client the best possible protection. For example, suppose the invention is a vacuum cleaner with a novel form of connection to a dust collecting bag. It may be possible to claim the connection per se and the combination of vacuum cleaner, connection and bag. In such circumstances, the candidate should consider whether the independent claims lack unity. If the candidate considers that unity is lacking a note to that effect should be included in the answer.

With regard to the dependent claims, these should provide good fall back positions in the event that the independent claims should fall at some future time. Dependent claims should be limited to the most important of the optional features of the invention. If a candidate claims a large number of optional features, the Examiners cannot tell if the candidate appreciates which of the optional features are significant and which are trivial, thus marks may not be awarded.

As for the description this must, as far as the information in the question permits, meet the legal requirement of sufficiency and support the claims. Candidates are not expected to “invent” additional subject matter to add to the information supplied in the question. However, they may find it necessary to describe something shown in the drawing but not specifically described in writing in the question.

## **Paper B**

### 1. Scope of the Paper

This paper tests the ability of the candidates to work out how to amend an Application to deal with an objection of lack of novelty and possibly an objection of lack of inventive step (and occasionally other objections).

### 2. Assessment of Answer

The amendment should render the Application valid and at the same time give the applicant the best possible protection that is available, taking into account any wishes of the applicant. If the amendment leaves the Application invalid for lack of novelty, the candidate will probably fail. On the other hand if the amendment unnecessarily restricts the claims there will be a loss of marks. Three or more serious restrictions will probably lead to a fail.

Candidates should also pay regard to the other requirements of Singapore Patent law and in particular added matter. If the amendment proposed by the candidate introduces new subject matter, that will be viewed as extremely bad practice and will definitely lead to a fail.

### 3. Answer

Candidates should remember that the whole specification including the drawings and not just the claims can serve as a basis for the amendment. Frequently candidates will find that there are several potential amendments each of which will render the Application valid by overcoming the objections in the written opinion. But they should try to identify the amendment that gives the best protection to the client and also, as far as possible, meets the wishes of the client that may be included in the question, usually in the form of a letter from the client.

The reply to the objections in the written opinion should not only give the basis for any amendments proposed but should also explain why the amendment deals with the objections that have been made.

## **Paper C - Infringement and Validity of Singapore Patent**

### 1. Scope of the Paper

This paper tests the ability of the candidates to interpret the claims of a granted Singapore Patent and advise on the issues of infringement and validity.

### 2. Assessment of Answer

The marks are not always distributed evenly amongst the different sections of the answer (see below for sections (a) to (f)). Nevertheless candidates should manage their time so that they deal with all the sections. Failure to cover all sections will seriously prejudice the marks that can be awarded.

In patent litigation one does not expect unanimity of opinion amongst judges on appeal. In the marking of this Paper, Examiners will not penalize a candidate merely because a conclusion reached differs from the conclusion reached by the Examiners. However, if reasoning applied by the candidate is missing, incorrect or inconsistent, the candidate will receive a low assessment even if his/her conclusion agrees with that of the Examiners.

### 3. Answer

Normally the answer can be divided into six sections:

- (a) Interpretation (or construction)
- (b) Infringement
- (c) Novelty
- (d) Inventive step
- (e) Amendment, and
- (f) Advice to the client.

In dealing with the first section, candidates need to analyze those parts of the claims which require interpretation. The selection of terms for interpretation may cause problems. They usually fall into one of the following classes:

- i) terms which have more than one meaning and are relevant to the scope of the claim,
- ii) terms whose meanings are clear and which are relevant to the scope of the claim, or
- iii) terms which are not relevant to the scope of the claim.

Terms falling in the first two classes should always be considered. In the case of terms falling in the first class, the alternative constructions should be explained. Reasons should be given for the construction that is selected for use in the subsequent considerations of infringement and validity. For terms in the second class, the meaning should be stated.

Provided that the interpretation has been fully and logically considered, the infringement section should be straight forward: Does the alleged infringement have the features of each claim? The conclusion itself is not so important. It is the reasoning by which the conclusion is reached which carries the bulk of the marks.

As to novelty and inventive step the Examiners are again looking for the reasoning that leads to a conclusion rather than the conclusion itself. Further, it is important that the candidates refer to the specific parts of the prior art documents on which they rely. It is not enough to say that a feature is known without indicating where. Each prior art document should be considered separately, and in all allowable combinations.

In the amendment section, candidates should be looking for the possibility of the patentee

improving his position by amendment to maintain the patent valid but at the same time still catch the infringement.

Finally, the advice to the client is the most important. The client needs to know what he can and cannot do. If a number of different parties are involved in the infringement, the client will need to know which of them can be sued. He also needs advice on the likely outcome of the various courses of action that are possible. All this helps the Examiners to assess whether the candidate is fit to practise as a patent agent.

## **Paper D - Knowledge of Patent Law and Patent Practice in Singapore**

### **1. Scope of the Paper**

This paper presents the candidate with a number of legal problems of a kind that can be expected in real life and upon which advice might be requested. The questions are not difficult. Indeed the questions are really rather easy provided that the candidate is properly prepared.

Proper preparation requires a sound knowledge of the Singapore Patents Act and Rules, the PCT and the PCT Regulations, the Paris Convention, the Budapest Convention and TRIPs. Although the examination is an open book examination, that does not mean that such knowledge is not essential in order to pass the paper. Candidates who attempt this paper in the belief that preparation is unnecessary because they can look up the answer during the examination will usually fail. There is insufficient time in the examination to conduct legal research to find an answer. Candidates need to know what provisions of the law are relevant to the questions and to use the "open book" facility to confirm the precise nature of the provision and the number of the Section, Rule or Article as the case may be.

### **2. Assessment of Answer**

In some questions, there is insufficient information to reach a final conclusion. Candidates must therefore consider the different possibilities that can result from those facts which are known. Far too many candidates fail to do this and assume facts which are not stated in order to reach a conclusion. This leads to a loss of marks.

Candidates should read the questions carefully (not to miss key issues/facts and important "clues") and also realize that all the information in the question should be used. If the answer presented does not use all the information in the question then the candidate has missed something and inevitably marks are lost.

Candidates should also bear in mind that each question carries 20 marks which means that there is likely to be at least 20 different points which the examiners are looking for in the answer. For example, if the question calls for a time limit to be identified, there is likely to be a mark for stating the legal basis for calculating the time limit and a second mark for stating what the time limit actually is. It is no good if a patent agent knows which legal provision regulates a time limit but unable to work out the actual date when the time limit ends which is the information the client needs.

### **3. Answer**

Candidates are expected to be familiar in the calculation of deadlines (problems with candidates in identifying the correct date to base calculations on e.g. from date of filing or the priority date).

Time management is particularly important in Paper D. There are 36 minutes for each question that is to be answered. If the candidate uses more time than that to answer a question, it is likely that there will not be enough time to give a good answer to all the other questions. When answering a question most of the available marks are gained in the first 20 to 25 minutes. Thereafter increasingly more time is normally needed to get the remaining marks. It is better to stick fairly closely to the 36 minute time limit rather than exceed it in the chase for one or two additional marks.