

INTELLECTUAL PROPERTY OFFICE OF SINGAPORE
THE FIRST QUALIFYING EXAMINATION HELD IN MAR 2002
MODEL ANSWER TO PAPER D

Notice: The model answer below contains some points (not-exhaustive) that
could be covered in the answer to this Paper.

QUESTION 1

1. Task: Write notes on the points you need to explain to the widow.
 2. The following is a guide to your answers.
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In this question 1, a general issue arises and this should be addressed as follows:

- Identify appropriate locus standi of client to continue prosecution

Right to continue prosecution

As the inventor is deceased, steps should be taken to determine whether the rights to the patents or patent applications have been bequeathed to your client and whether she has the relevant documents to support her claim. A discussion on whether section 43 and its corresponding rules would apply should also be made.

1(a)

2 main issues arise in this question:

- Possible office actions that have been missed
- Possible office actions to look out for

Note also the importance of recording the relevant dates in your diary, during the prosecution of patent applications and patents. This would assist in the monitoring the relevant time lines to which the applicants have to comply with.

Search & Examination

Identify which deadline has expired and the various options available and cite the relevant provisions under section 29 and its corresponding rules. Discuss also on the possibilities of seeking extension of time, and the consequences of non-compliance.

Steps to support Priority claims

A discussion on the priority claim requirements should be made citing the corresponding provisions in the Rules to section 17. The discussion should also include what happens when the deadline has expired and there has been non-compliance. Explain to the widow of the consequences of non-compliance, and also the possibility of seeking extensions of time, if available.

1(b)

2 main issues arise in this question:

- Possible options for PCT national phase entries (includes the need to file a Demand and/or enter National Phase)
- Possible options on the International Search Report

Possible options for PCT national phase entries

Discussions on Articles 22 and 39 of PCT would be required. This should include consideration of deciding which of the PCT designated country (or countries) of interest, should National Phase (Chapter I) entry be made, for the PCT application and which should continue by filing a (Chapter II) Demand by the 19th month and making the necessary elections. Discuss also on the advantages and disadvantages of choosing Chapter I or II entries.

Note also the changes made to Article 22 of the PCT (with effect from 1 Apr 02) and its significance. Note also that some PCT member states (including Singapore) had notified to the PCT that their national laws were not compatible with the changes and the changes would not apply.

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Possible options on the International Search Report

Discuss the significance of the “Y” reference and also on possible steps that could be taken..

1(c)

1 main issue arises in this question:

- Possible options upon receiving written opinion

If amendments are to be made :

Identify the provisions in the Rules corresponding to sections 31 and 84 and include mention of the relevant time periods, whether there is a possibility to seeking extensions of time to respond to the written opinion and the consequences of non-compliance.

If written arguments are to be made :

Identify the provisions in the Rules corresponding to sections 31 and 84, and include mention of the relevant time periods and whether there is a possibility to seeking extensions of time to respond to the written opinion and also on the consequences of non-compliance.

If no action is taken

Explain what would happen if the applicants do not wish to respond to the written opinion at all, and indicate the corresponding rules that would apply.

1(d)

1 main issue arises in this question:

- Renewal requirements

Renewal requirements

To indicate when the 4th anniversary would fall on, bearing in mind the principles in section 36 and its corresponding rule (s). A discussion on what the status of the patent is and what needs to be done (e.g. Forms & Fees applicable) to renew (explain why renewal is still possible) the patent, would be required.

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QUESTION 2

1. Task: Explain, with reasons, the advice you would give
 2. The following is a guide to your answers.
-

4 main issues arise in this question which covers 2 inventions i.e. the original invention and the improvement:

- Ownership
- Patent Infringement
- Patentability of inventions
- Advice to clients on whether he should sign

Ownership

There should be a discussion as to the ownership of the 2 inventions and whether sections 47 and 49 apply and an explanation should be given to support your views.

Patent Infringement

There should be a discussion as to whether the original patent could have been infringed by the employer, applying section 66 to the facts.

Patentability Issues

There should be a discussion as to whether the improvement to the original invention is patentable in the first place as one can argue that it is a method of treatment falling under section 16.

Discuss also on a possible solution of the improved invention to be drafted e.g. to claim a known product for a new use pursuant to section 14, in order to overcome the section 16 objection.

Should your client sign?

Your answer should also address the question as to whether your client should sign the document. Note that it includes the original invention and the improvement and so your response should cover both cases.

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QUESTION 3

1. Task: Advice the clients giving reasons for your advice.
 2. The following is a guide to your answers.
-

3 main issues arise in this question:

- Patent Infringement & the identification of possible infringing acts
- Prior Use Defence
 - Before the priority date
 - Does “infringing act” in good faith or
 - Makes in good faith, effective and serious preparations to do that act
- Compulsory Licence

N.B. Date of patent = Date of Filing

Patent Infringement & the identification of possible infringing acts

Identification on the possible infringing acts should be made to allow a discussion to follow as to whether they are in fact infringing and if so, whether there are any defences available. They are namely, the importation of “X” into Singapore before the date of the patent & the manufacture of “X” after the priority date of the patent.

Prior Use Defence

A discussion of this prior use defence pursuant to section 71 is required, where the relevant key features to note in that section should be raised. It is also necessary to apply the key features onto the facts to see whether the facts fall within the ambit of section 71. In addition, one should explain what the defence entails, and which of the 2 “infringing acts” would be allowed to continue pursuant to section 71.

Can Mega Corp stop your clients from making compound “X” on Singapore?

After the above discussions, your response should also include your supported views as to whether Mega Corp can stop your clients from making compound “X” on Singapore, and if so, how.

Compulsory Licence

A discussion over the possibility of a compulsory licence being sought pursuant to section 55 is required.

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QUESTION 4

1. Task: What advice do you give the clients? Give appropriate reasons for your advice.
 2. The following is a guide to your answers.
-

3 main issues arise in this question:

- Avoidance of restrictive conditions
 - possible defences
 - consequences of “void conditions”
- Right to institute Patent Infringement proceedings
- Groundless Threats
 - Identify “Threats” that are actionable
 - Discuss whether the “Threats” are groundless
 - What if “threats” are groundless? What if they are not?

Avoidance of restrictive conditions

A discussion on the significance of the licence agreement having the condition that your clients are required to purchase from Chemico some of the raw materials for manufacture of the detergent composition should be made. Is that an offending condition under section 51? If so, how would that affect the patent and what possible remedial actions could be taken before bringing infringement proceedings?

Right to institute Patent Infringement proceedings

A discussion as to who is entitled to institute patent infringement proceedings is required, relying on the provisions under sections 67 and 74 and applying to the facts. This should also include a discussion on whether section 43 and its corresponding rules would apply, and the following consequences as mentioned under section 75 (if applicable) in the event where such transactions are not registered as such.

Groundless Threats

A discussion of the key features of section 77 is required, and the application of this provision to the facts should be made to determine whether they fall within the ambit of section 77. This discussion should also include the consequences in the event that groundless threats are found.

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QUESTION 5

1. Task: Explain to the clients what options are available and what the financial consequences are. Give appropriate reasons for your advice.
 2. The following is a guide to your answers.
-

2 main issues arise in this question:

- Entitlement to file PCT application, in SG as a receiving Office & if not, what alternative actions could be taken
 - Competent PCT receiving Office to file application
 - Competent agents to act before the PCT offices
- Strategies to be taken on filing a PCT application, in relation to:
 - filing and designation of states
 - search and examination – demand & elections; competent international search and examination authorities
 - delaying national phase entry – chapter I or II national phase entry

Competent PCT receiving Office to file application

A discussion on what the PCT receiving Office requirements under section 85 are and whether they would apply to the facts. In the event where the Registry of Patents in Singapore is not competent, discuss also on what other options that your clients could take, in filing a PCT application.

Competent agents to act before PCT Offices

A discussion as to who can act as agents under rule 90 of the PCT is required.

Filing Strategies

A discussion on designations and rule 4.9 of the PCT should be made, explaining also the designation fees payable, and the consequences of not designating or paying the designation fees on time.

Search & Examination Strategies

A discussion on how the choice of PCT receiving Office could affect the choice of selecting the competent International Search and Preliminary Examination Authorities (ISA & IPEA) is required, and how this could be applied onto the facts.

Chapter I or II national phase entry

Discussions on Articles 22 and 39 of PCT would be required. Discuss also on the advantages and disadvantages of choosing Chapter I or II entries.

Note also the changes made to Article 22 of the PCT (with effect from 1 Apr 02) and its significance. Note also that some PCT member states (including Singapore) had notified to the PCT that their national laws were not compatible with the changes and the changes would not apply.

Financial Consequences

Note also that it is necessary to mention about the possible financial implications/consequences to the various options or routes proposed to your client.

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QUESTION 6

1. Task: What advice do you give? Support your advice with reasons.
2. The following is a guide to your answers.

2 main issues arise in this question:

- Sections 29(1)(c) & 29(4)
 - Were the prescribed details of all corresponding PCT (not designating SG)/corresponding applications furnished?
 - Section 80 (Revocation proceedings)
- Is the PCT application novelty destroying?

Sections 29(1)(c) & 29(4)

A discussion of the key features in section 29 together with its corresponding rules is required. This should be followed by a discussion whether the facts fall within the ambit of the relevant provisions. This should include discussions on whether the EPO application no. 1212 could have been considered a corresponding application under section 29 and whether it should have been identified as such, and if not, what the consequences (section 80) could be.

PCT application & novelty destroying?

A discussion on the relevancy of International application No. PCT/IB99/987 and whether this could be novelty defeating under section 80 should be made. This should include a discussion on whether section 14(3) applies to this, and the significance of this provision read with section 15.

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QUESTION 7

1. Give reasoned advice to your client.
2. The following is a guide to your answers.

3 main issues arise in this question:

- Groundless Threats
 - Identify “Threats” that are actionable
 - Discuss whether the “Threats” are groundless
 - What if “threats” are groundless? What if they are not?
- Infringement proceedings & possible defences; Revocation proceedings
- Unauthorised claims to patent rights

Groundless Threats

A discussion of the key features of section 77 is required, and the application of this provision to the facts should be made to determine whether they fall within the ambit of section 77. This discussion should also include the consequences in the event that groundless threats are found.

Infringement Proceedings & possible defences; Revocation proceedings

A discussion of the key features in bringing infringement proceedings and the possible defences available under sections 67, 69 and 74 should be made, applying to the facts. It is also important to identify and discuss the issue of whether company Z has the locus standi to institute infringement proceedings against client and in any event, the possibility that the patentee on record may institute similar proceedings against client. Discuss also on whether client has grounds under section 80 to revoke patent.

Unauthorised claims to patent rights

A discussion whether a case against company Z for making unauthorised claims to patent rights under section 100 could be raised.