INTELLECTUAL PROPERTY OFFICE OF SINGAPORE

THE SECOND QUALIFYING EXAMINATION HELD IN NOV 2002

GUIDELINES TO PAPER D

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

Question 1

a)
1. Identify issue and give general discussion on Patent Agent Qualifying Requirements.
2. Mention of Section 105 & Patent (Patent Agents) Rules 2002.
3. Advise and explain to client on whether he qualifies as a patent agent in Singapore.

b)
1. Identify issue and give general discussion on the law on what would amount to a novelty defeating disclosure.
2. Mention of Sections 13, 14.
3. Advise and explain to client on whether his disclosure to his friends during coffee was novelty defeating and if so, what the consequences are and how they can be remedied.

c)
1. Identify issue and give general discussion on the law on what the Date of Filing Requirements are (minimum requirements).
2. Mention of Section 26 & rule 26.
3. Advise and explain to client on whether his letter indicating his name only and some drawings with accompanying text on the drawings would meet the Date of Filing requirements and if not, what are his options and if so, what other documents are required to be furnished.

d)
1. Identify issue and general discussion on the law on inventorship and ownership.
2. Mention of Sections 19, 24 & rule 18.
3. Advise and explain to client on whether his professor's contributions would entitle him to be named "inventor" in his patent application and if so, what does he have to do assuming that his patent application proceeds.

Question 2

a)
1. Identify issue and general discussion on PCT and clarify with client that there is no such "world patent" to date.
2. Advise and explain to client the advantages and disadvantages of using PCT.

b)
1. Identify issue and general discussion on who has the right to file in Singapore using PCT.
2. Mention of Section 85.
3. Advise and explain to client on whether he could use the PCT option and if not, what other alternatives would be available.

c)
1. Identify issue and general discussion on what further preliminary steps to take if the invention relates to micro-organism and the significance of such a deposit in terms of disclosure.
2. Mention of the Budapest Treaty.
3. Advise and explain to client on what he should do to meet these requirements (Depository procedures in brief and choosing International Depository Authorities).

d)
1. Identify issues and general discussion on PCT requirements and using Singapore as a Receiving Office.
2. Mention of PCT and Section 85.
3. Advise and explain to client on what main PCT timelines are: -

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- Filing Documents
- Filing of Fees
- International Search
- International Preliminary Examination
- Chapters I and II and their significance
- National Phase Entries

e) 1. Identify issue and general discussion on publication and its significance to a patent application.

2. Advise and explain to client as to the advantages and disadvantages of publishing his invention in a science journal (or for any publicly available source) during the times mentioned below:
   - before filing
   - after filing but before a Date of Filing is obtained.
   - after obtaining a Date of Filing but before the 18th month publication.

Question 3

a) 1. Identify issue and general discussion on falsely applying a patent number onto a product and its consequences.

2. Mention of Section 99 (unauthorised claim of patent rights) & 100 (unauthorised claim that a patent had been applied for).

3. Advise and explain to client as to whether he falls under any of the above provisions and if so, what he should do.

b) 1. Identify issue and general discussion on how the patent office would treat patent applications and when the patent applications are made publicly available through the official publication.

2. Mention of sections 27 and 108

3. Advise and explain to client as to what his options (file inspection) are, in the light of the fact that the patent application has not been published yet.

c) 1. Identify issue and general discussion on pre-grant opposition and its non-applicability to Singapore. Also discuss on what is available in Singapore alternatively.

2. Mention of Section 80.

3. Advise and explain to client to what his options are when it comes to challenging a patent in Singapore.

d) 1. Identify issue and general discussion on the possibility of an infringement action before it had proceeded to grant and the significance of the patent application not being published yet.

2. Mention of Section 76.

3. Advise and explain to client as to what his options are to avoid being sued for infringement.

e) 1. Identify issue and general discussion on the possibility of the letter being a Groundless Threat for patent infringement being issue by company X.

2. Mention of section 77.

3. Advise and explain to client as to whether the letter could amount to groundless threats and if so, what your clients' remedies are.

Question 4

a) Singapore

1. Chapter I entry into National Phase Article 22 PCT unamended.
2. New text not compatible with the National Law.
3. 20 months from Priority
4. 3 February 2004
5. Chapter II entry into National Phase Article 39 PCT
6. 30 months from Priority
7. 3 December 2004
8. Provided demand filed by 19 months from Priority Article 39 PCT
9. 3 January 2004

b) USA

1. Chapter I entry into National Phase Article 22 PCT Amended
2. 30 months from Priority
3. 3 December 2004
4. Chapter II entry into National Phase Article 39 PCT
5. 30 months from Priority
6. 3 December 2004
7. Provided demand filed by 19 months from Priority Article 39 PCT

c) European Patent Office

1. Chapter I entry into Regional Phase Article 22 amended
2. 31 months from priority
3. 3 January 2005
4. Chapter II entry into Regional Phase Article 39
5. 31 months from Priority
6. 3 January 2005

Question 5

a) 1. Addition of new subject matter not permitted

2. Mention of Section 84(2)

3 But if the new subject matter added no objection by the Singapore Registry of Patents, the application can still proceed to grant with the added matter. Note however, Section 84 and the consequences of amending the specifications which introduces new matter to the application.

b) 1. After grant amendment is generally possible under Section 38 and 83, but any amendment after grant is subject to Section 84(3).

2. No amendment is allowed if it extends the protection afforded by the patent.
3. 3rd parties may oppose the amendment under Section 38.

c)
1. Added matter during application is a ground of revocation under Section 80 (1) (d).
2. Application for revocation made on this ground cannot be defended.
3. In effect, a patent could not be enforced because counterclaim is likely to succeed.

d)
1. Advise to client not to add matter to the claim
2. Assess objection of the lack of clarity. Is it justified?
3. If not, no amended needed.
4. If justified, is there some other amendment which does not add new matter?

Question 6

a)
1. Renewals due annually from fifth year onwards from 5 November 1996.
2. Mention of Section 36 and Rule 51(1).
3. Renewal fee due on 5 November 2001 not paid.
4. Extension of 6 months to 5 May 2002 under Section 36(3) not paid.
5. Patent has lapsed.

b)
1. Consider restoration of patent under Section 39.
2. Application for restoration must be made within 30 months from the lapse, i.e. by 5 May 2004.
3. Applicant has to prove reasonable care taken under Section 39(4).
4. Patentee's illness may support this.
5. Require evidence from his medical practitioner.
6. Non receipt of reminder letters from IPOS is unlikely to carry much weight in the applicant's request for restoration.
7. Should have notified change of address unless unable to do so because of illness.
8. Application for restoration should be made as soon as possible and not wait until the end of the permitted period because of his intervening rights.

c)
1. Intervening Rights, under Section 39(9) refers to anyone who began etc between lapsing of patent and application for restoration may continue.
2. May include a competitor.
3 No action for infringement until patent is restored under Section 67.

Question 7

a)
1. Cannot bring proceedings to stop infringement until patent is granted
2 Mention of Section 67
3 Rights include the rights to damages can arise on publication of application
4 Mention of Section 76

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b)
1. Exclusive licensee can bring proceedings
2. Mention of Section 74
3 Non registration of licence can affect ability to recover damages
4. Mention of Section 75

c)
1. Advice to Managing Director of A is to record the licence in the register as soon as possible
2. Mention of Section 45
3 Send copy of published application to company Z after licence is recorded to ensure that Z is aware of the application
4. Mention of Section 69

d)
1. Make sure no actionable threat is issued
2. Mention of Section 77

e)
1. Prosecute the application to grant as soon as possible so that action for infringement can be started.
2. Since patent claims a process and Z are importing a product, the onus is on Z to establish that the imported product is not made by the patent process
3. Mention of Section 68