INTELLECTUAL PROPERTY OFFICE OF SINGAPORE

PATENT AGENTS QUALIFYING EXAMINATION

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

28 November 2003, Friday

1400 – 1700 hrs

Maximum Time: 3 Hours + 15 Minutes of reading time **Maximum Marks: 100 Points**

LIGHTING UP YOUR CREATIVITY

INSTRUCTIONS TO CANDIDATES

1. This Paper consists of 6 sheets, including this cover sheet.

2. 15 minutes of reading time is provided. You are advised to spend this time reading the instructions and the question(s) before you attempt to answer the question(s).

3. In Paper D, you are required to answer 5 questions only.

4. Each question carries 20 marks. Questions answered in excess of five will not be marked.

5. Write your answers in English. Answers in any other language will not be marked.

6. Only your answers to the question(s) written or pasted in the Answer Booklet (that is provided by the Examination Secretariat) would be considered. Write only on one side of each sheet in the Answer Booklet and to commence your answer to each question (where applicable) on a fresh sheet.

7. 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 specified in Rule 99 of the Patent Rules. You are also advised to include in your all answers, supporting references to the relevant corresponding provisions to the Patents Act & Rules and the PCT provisions (where appropriate), as at 1 August 2003 (the date of the "Administrative Instructions on the Singapore Patent Agents Qualifying Examination, November 2003").

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QUESTION 1

Your client, who is selling X in Singapore has received a letter from A alleging that X has been made without A's consent and is an infringement of a Singapore Patent dated June 2000. X is imported into Singapore.

You check the facts and you reach the conclusion that X does fall within the claims of the Singapore Patent.

Your client tells you that he did not know about the Patent when he purchased the business of selling X in Singapore from the executors of the late Mr. B in February 2001. After the purchase your client was given a bundle of papers by the executors of Mr. B which included correspondence between Mr. B and the overseas supplier of X. The correspondence shows that Mr. B began preparations in March 2000 for selling X in Singapore but did not actually start selling X and there was no disclosure of X. The papers also show that Mr. B knew about the Singapore Patent but the executors did not draw attention to it when the business was sold to the client.

The register shows that the Singapore Patent is in force. No priority is claimed.

Advise your client giving reasons for your advice.

QUESTION 2

An International Application was filed at the Singapore Registry as Receiving Office on 27 October 2003 claiming priority of 23 August 2002 from a U.S. application. It has been realized that the claimed priority date needs to be corrected. The corrected date should be 30 October 2002. The client asks if this correction can be made.

In addition the client asked if it is possible to postpone the date of entry into the national phase in Singapore.

The International Search Report cites a category X item of prior art published on 1 December 2002.

Explain to the client what can be done giving your reasons.

QUESTION 3

A Singapore Patent Application has been filed by joint applicants P and Q on 10 March 1999. P and Q then file a Divisional Application on 30 July 2002.

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You are asked to advise P, what the times are for taking the following actions for the Divisional Application:

i. Filing a request for a search report
ii. Filing a request for an examination report
iii. Filing a request for a Certificate of Grant

You are also asked what the term will be of any patent granted on the Divisional Application.

P then says that he proposes to grant a license, without involving Q. The license will be for the invention that is the subject of the Divisional Application and P wants the following provisions included:

i. The license is to be without any time limit;
ii. The licensee must obtain raw material for making the invention from P; and
iii. The license is to be exclusive but P reserves the right to use the invention.

Advise P, giving the basis for your advice.

QUESTION 4

A friend of yours, Bob, who is also a registered patent agent, called you up on 13 June 2003 (Friday), and explained that he would be out of Singapore for a year starting from 16 June 2003 (Monday) and during his absence, he was entrusting a patent application to you belonging to one of his clients i.e. XYZ Pte. Ltd. Bob further mentioned that he had spoken to XYZ Pte. Ltd., on this temporary arrangement and had since obtained their consent.

The next day (14 June 2003), Bob handed his patent file on XYZ Pte. Ltd. over to you. You opened the file, and you discovered that the patent application was filed by Bob in Singapore as agent for XYZ Pte. Ltd. on 10 December 2001 (Monday) together with statement of inventorship. No priority claims were made in that application. You found a search request prepared dated 21 March 2003 (Friday), but it did not appear to have been sent to IPOS. Neither was there any record of payment for the search request, from IPOS.

Mr. Tan, the Managing Director of XYZ Pte. Ltd. called you that evening (14 June 2003) and asked you for an update of his company's patent application. He explained that he would still want Bob to continue prosecuting the file, but was agreeable to having you cover in Bob in his absence for 1 year. He wanted to know specifically what you planned to do for his patent application, as from following week onwards.

Mr. Tan recalled asking Bob to send a search request to IPOS some months back but he had not heard from Bob since and was wondering what the outcome of the search was. Mr. Tan also said in passing that his colleague, Phoebe claimed to have been actively involved in the invention creation process, and she was very unhappy to learn that she was not included in the inventor list that he had sent to Bob earlier. Mr. Tan disagreed with Phoebe's claims but he feared that she may pursue this issue directly with IPOS as she had been pestering him to include her as co-inventor. He thus asks you how Phoebe could have learnt that she was not in the list of inventors sent to IPOS (since he did not reveal to anyone apart from Bob and he has instructed Bob not to disclose the list to anyone apart from IPOS) and also whether she could on her own, enter her name in the list before IPOS and if so, what should he be expecting and whether he would be notified if this were to arise. Mr. Tan ended his conversation by saying that the patent application was very important to his company, and they had started the invention in Singapore as early as November 2001. In fact, he said they had exhibited the invention in an Exhibition on 18 November 2001 (Sunday) in Orchard Road. This Exhibition attracted a huge crowd and they received many interested purchase orders thereafter.

Please advise Mr. Tan of XYZ Pte. Ltd.

QUESTION 5

John asks you to file a patent application with IPOS on his invention as soon as possible. His invention relates to resilient pencil leads. You rush to prepare for this filing, and when completed, you write to inform him that you had successfully filed with IPOS as instructed. John replied "By the way, I do have some drawings with me that I had forgotten to hand to you earlier. I realized that the copy that I had sent to you originally contain even sheets of drawings. I had overlooked the fact that I had originally printed out on both sides of the sheets but when I photocopied the documents for filing, I copied only the even side of the sheets. I am faxing to you the odd side of the sheets right now and could you kindly arrange to have them inserted into my patent application with IPOS? I had also informed my friend, Marcus of the Singapore filing and he is very interested to have a share in this Singapore patent application. I would thus like to know what steps can be done to involve Marcus so that we would both have 50% rights to this patent." John ends the phone call by saying that he had earlier mentioned a feature of his invention to you before the patent application was filed, but after some experimenting at his end, he is thinking of changing the feature a little and he asks you whether this is possible, what the implications will be and what actions would have to be taken in this regard.

On a separate case, John returns on 13 October 2003 and seeks your advice over one of the patents that he had obtained from Singapore. The patent was granted on 1 December 2001 and dated 28 April 1997. It claimed priority from a U.S. application filed on 18 May 1996. John explained that he had received some notification from the Registry that the patent was due to be renewed but no renewal fees were received by the Registry. You proceed to check the patent status from the Singapore Registry and

note that fees due to maintain this patent for its 7th year was outstanding. John explained that this patent is still very important to him and he would like to know what can be done to "salvage" this situation and whether he would have lost any rights as a result of this non renewal even after it has been "salvaged". He regretted not appointing an agent to assist him in the renewal process earlier.

Please advise John on the above.

QUESTION 6

Your client Mr. Yu who is also a Scientist by training has just recovered from the SARS virus. During his illness the doctors from Tea Hospital who treated him managed to extract from his blood an unusual bacteria and it was discovered that the presence of the bacteria in Mr. Yu's body made Mr. Yu more resistant to the SARS virus. The doctors after extensive research developed a SARS immunisation kit which the doctors hope to patent.

Your client Mr. Yu now informs you he wants to file a world patent for this bacteria in his own name. He also tells you he has spoken to a few investors who are very interested to fund him and have already given him S$100,000-00. He tells you he filed a 'patent' at IPOS after that and paid the filing fee but was told he needs to lodge a "sample".

He did not understand this and now seeks your advice. You discover his "patent" application was a description of the SARS illness, how he was treated and the fact he had a bacteria in his body and he signed off as Mr. Yu, Patent Agent. Finally, he mentions the doctors are very angry with him for filing the Patent in his name and describing the bacteria. He says he wants to "include them in his application" because they cured him. He also wants to include the investors as applicants because they paid him. He says he will act as the doctors' and investors' patent agent and that you are to only represent him.

QUESTION 7

Gavin, a Singaporean businessman, visits his friend Ying from China who has been working in Singapore for 5 years. He sees a lock on her bag designed by Ying using just rope and wire. It is an interesting device because it is very simple and needs no key and can be easily carried around as individual components. Ying says she made the lock during her free time in Singapore. Gavin asks Ying whether she has heard of the Intellectual Property Office of Singapore (IPOS) and whether Ying wants to file a patent. Ying says she has no money but Gavin says he can fund it if she will file the patent in his name. Gavin will then share the profits of the sale of this lock with Ying. She agrees.

Ying however files the patent in her own name as applicant and inventor in China. She later informs Gavin and Gavin is very upset. Gavin seeks your advice. Gavin also tells you that he thinks that Ying may have shown the lock to a few lock manufacturers to be sure she can get buyers before filing the

patent. Gavin also wants to know if he can still file in Singapore, UK and other countries the same patent in his own name, as applicant and inventor, since Ying's patent was filed in China only. Ying has told Gavin that she can 'give' Gavin the Singapore and UK "patents" and she agrees to sign any relevant document.