INTELLECTUAL PROPERTY OFFICE OF SINGAPORE
THE SECOND QUALIFYING EXAMINATION HELD IN NOV 2003
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. Check Register to determine if Singapore Patents is in force.
2. Importation and sale in Singapore is infringement.
3. Section 66(1)(a)
4. Can client claim to be innocent infringer? Onus on client to establish this. Section 69(1).
5. If so, no damages for infringement.
6. But does not prevent injunction.
7. To claim benefit of this, infringement must stop as soon as aware of patent (cannot divide infringement into part innocent and part not).
8. Client became aware of patent when papers handed over by B's executors.

(b)
1. Does client have right to continue? Section 71.
2. B preparing to sell before priority date of patent.
3. Right can be transmitted on death, Section 71(3)(b).
4. What was in purchase contract?

(c)
1. Threats, Section 77.
2. If client has right to continue.
3. May not be able to bring action for groundless threats against A.

d)
1. Actionable threat.

1. Does client have any claim against executors for not disclosing details of patent at the time of purchase by client of business?
2. Possibly in spite of caveat.

Question 2

a)
1. Correction of priority date possible. Rule 26*bis* PCT.

1. Application is correct by later of 16 months from earliest priority date or 4 months from filing date. 16 months from earliest priority date, 23 December 2003 (4 months from filing date 27 February 2001) Rule 26*bis* 1(a) PCT.
2. Application can be made to Singapore Registry as Receiving Office or to International Bureau.
3. Time limits calculation from priority date will be changed to corrected date (if not already expired). Rule 26*bis* 1(c) PCT.
4. File certified copy of US application.

c)
1. To postpone entry into national phase from 20 months (30 June 2004) to 30 months (30 April 2005). File demand at IPEA by 19 months from priority date, i.e. 30 May 2004. Article 39(1)(a) PCT.

d)
1. Extensions under Rule 108 of Singapore Patents Act of 3 months and discretionary.
2. Another possibility is to withdraw priority claim under Rule 90*bis* (3) PCT.

3. Must be done before 30 months from priority, i.e. 30 May 2004 at appropriate IPEA (or Receiving Office or International Bureau if demand not yet filed).

4. Effect is to recalculate time limits from filing date. So entry into National Phase under

   Chapter I will be 27 June 2005.

   Chapter II will be 27 April 2006.

e) 1. But dropping the priority date means that Category X citation new relevant to priority because published before filing date.

Question 3

a) 1. Request for search. Rule 38(2).

   16 months from filing date of Divisional application, i.e. 30 November 2003.

2. Request for examination. Rule 43(2).

   28 months from filing date of Divisional application, i.e. 30 November 2004.

3. Request for grant. Rule 47(2).

   54 months from filing date of Divisional application, i.e. 30 January 2007.

b) 1. Extendable by 3 months. Rule 108(3).

2. Discretionary extensions. Rule 108(4) – (6).

3. Term – 20 years from filing date of Parent application. Section 26(6), 10 March 2019.

b) 1. Comments on Licence Terms.

   (i) Licence can be determined on 3 months' notice when patent ceases. Section 52.

   (ii) Restrictive condition. Void, section 51. Existence of licence with such a condition is a defence to infringement.

   (iii) An exclusive licence will exclude P. Section 74. P needs consent of Q to grant licence. Section 46(3).

Question 4

a) **Taking Over**

1. Qualified to act as agent.

2. Patents Form 41 but limit to 1 year.

b) **Search**

1. Deadline expired.

2. Determine if request was in fact filed.

3. Solutions suggested – extend time or file Patents Form 11 instead if clients agree.

4. Extension of time (Rule 109).

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c) **Inventorship**

1. How Phoebe would have learnt that she was not identified as an inventor – did not receive Patents Form 8 (Rule 18(2)).
2. Patents Form 7 (Section 24 and Rule 17).
3. Who would be notified by IPOS?
4. What XYZ Pte Ltd can do?
5. What IPOS would do after a decision has been made.

c) Prior Disclosure

1. Clarify with applicant on:
   - What has been disclosed.
   - Type of exhibition.
2. Discuss whether this falls under Section 14 as a novelty defeating disclosure.

Question 5

a) **Late Drawings**

1. Section 84.
2. Section 26, Rule 26.
3. Section 107, Rule 91.
4. Possible implications arising from the various options available i.e. opportunity to re-date filing date, remove drawing references or request for correction.

b) **Co-applicant**

1. Assignment and recordal of transaction (Sections 41 and 43).

c) **Amendment**

1. Section 84.
2. Rule 49.
3. File another application claiming priority over the first filing.

d) **Renewals**

1. Section 36.
2. Rule 51.
3. Patents Form 41.
4. 7th year = 28/4/03 to 28/4/04
5. Renewal fees due plus late renewal fees (By 28/10/2003)
6. Rights restored after fees paid

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Question 6

a) **Patent Agency**

1. Explain and advice client of law relating to Patent Agents qualification and consequence of falsely representing himself as patent agent in the application.
2. Discuss whether he can act for the doctors and investors as patent agent. Give reasons.
3. Identify ability to prepare and file patent for your own invention. Mention Section 105 and the Patents (Patent Agents) Rules 2001.
4. Explain to client no such 'world patent' to date but a filing system in place. Explain how the PCT application is filed, in particular how countries are designated and steps required and the difference between international and national phase.

b) **Patentable Subject Matter**

1. Identify issue of patentable subject matter i.e. whether bacteria is a patentable invention.
2. Mention Section 13, Section 14(7) and 16.

c) **Inventors**

1. Identify issue of whether Mr Yu qualifies as an "inventor".
2. Mention Section 19.
3. Identify issue of doctors' role of inventors.
4. Mention Section 20 and Section 24: determination of entitlement to grant; right to be mentioned as inventor.

d) **Patent Filing Requirement**

1. Identify whether what was submitted qualifies as a patent application so as to meet filing date requirements.
2. Mention Section 26 and Rule 26.
3. Advise and explain to client what can/needs to be done and what needs to be furnished.
4. Identify issue of deposit under the Budapest Treaty and explain procedure in brief how the bacteria should be deposited to comply with disclosure requirements.

e) **Disclosure**

1. Identify issue and general discussion on law relating to novelty defeating disclosure. Explain whether discussion with investors destroys novelty. Mention Section 13 and 14.

f) **Filing Strategy**

1. Discuss possibility of withdrawing first application filed by Mr Yu and filing a fresh application properly. Student should note withdrawal cannot be revoked. Section 25(8). Implications of approach should be discussed.

Question 7

a) Restrictions on Filing Abroad

1. Identify issue on restriction by Singapore residents filing abroad, i.e. whether Patents Act not complied with and consequences.

2 Mention Section 34 and compounding offence.

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b) **Patentable Subject**

1. Identify requirements of patentability and whether invention of rope and wire qualify as novel, inventive and of industrial application.
2. Identify issue of disclosure of invention.
3 Discuss Ying's disclosure to lock manufacturers and consequences on patent as filed. Discuss disclosure in terms of lock being exposed to all by use of lock on Ying's bag.
4. Mention Section 13 and 14.

c) **National Filing**

1. Identify issue of what a national application in China means and whether applications may be filed in Singapore and UK now. Discuss options.
2. Discuss Paris Convention and priority claim from China application.
3 Discuss PCT filing in Singapore designating Singapore, United Kingdom and other countries and whether Gavin would qualify.

d) **Right to File**

1. Identify issue of whether Gavin has right to file patent in his own name. Discuss assignment of patent.
2. Mention Section 41 and requirements for transactions in writing.

e) **Inventorship**

1. Identify problem of Gavin describing himself as inventor as opposed to being just applicant. Discuss consequences in brief.
2. Mention Section 19 and 24.