INTELLECTUAL PROPERTY
OFFICE OF SINGAPORE

Answer guidelines to QE 2004 Paper D

Note: The answer guidelines contain some points (non-exhaustive) that could be covered in the answer to this Paper.

S = Section (as in SPA)
R = Rule (as in SPR)
SPA = Singapore Patents Act
SPR = Singapore Patents Rules
SG = Singapore
PF = Patents Form

Date Format = DD/MM/YYY

Question 1

- Letter from A is actionable threat
- S 77
- Relief for threats
- Medical treatment is not patentable
- S 16(2)
- Research by X is excluded from infringement
- S 66(2(b)
- Obtaining a patent – not infringement
- S 66(1)
- Surrender of patent is not relief for infringement
- S 67 & S 40
- Compulsory licence under A's Patent
- On the ground that there is a market in SG and market is not being supplied
- S 55(2)(a) and (b)(i)
- Provided A has no valid reason for supplying market
- S 55(2)(c)
- Application for compulsory licence can be made at any time after grant (for medical device only)
- S 55(1)
- Obtaining a Patent – no defence to infringement
- Check novelty and/or inventive step of X's Patent in the light of A's Patent

Question 2

- Does Applicant have right to file PCT Application?
- Art 11 PCT
- If not, Application will not be given a filing date. Art 11.
- If yes, Application filed with wrong RO
- SG Patent Act S 85(5) & Art 11 PCT
- Application will be forwarded by IPOS to IB
- R 19.4 (a)(i) and (b) PCT
- Filing date is maintained. R 19.4(b) PCT
- Application filed after 01/01/2004 will receive written opinion with search report
- R 43bis 1 PCT & R 44

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- No dialogue between Applicant and Examiner
- If no demand filed, written opinion becomes IPRP (Chap 1)
- R 44bis PCT
- Demand can be filed 22 months from priority or 3 months from issue of written opinion, whichever later.
- R 54bis PCT
- Examination by IPEA if demand filed in time
- Applicant can enter into dialogue with IPEA
- IPEA issues IPRP (Chap II) = IPER
- Demand should be filed at IPEA
- If filed at a non-competent office, Demand will be forwarded to a competent office. R 59.3 PCT

Question 3

- WO 04/9876 is not a patent. Pending PCT Application.
- No infringement until patent granted.
- S 66
- PCT is not a grant procedure to obtain patent in SG. Must enter national phase within the appropriate time limit.
- S 86
- Need to monitor progress of Application
- Y is putting client on notice of Application
- Not a threat. S 77
- Publication of Application under PCT is publication for SG
- S 87(2)
- Right to claim damages from publication
- S 76
- Provided that specification is in English. If not, right only arises when translation of original filed
- S 87(3)
- Importation by client is infringement (if Patent granted)
- S 66
- Onus to prove non-infringement is on client
- S 68
- Parallel imports. No infringement if product is made by Y
- S 66

Question 4

Issue 1: Patent term extension

- Possibility of a term extension for Patent A.
- Possibility of a term extension for Patent B.

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(Note: To obtain the full 4 marks above, candidates should state the possibility of a term extension for both Patent A and Patent B expressly, or they should use the plural "patents" consistently (if they do not identify Patent A and Patent B). If a candidate refers to "patent" only, or "patent" and "patents" interchangeably, he should be taken to only have stated that only one patent has a possibility of extension, and only be given 2 marks.)

- Both patents' date of filing must be on or after 01/07/2004.
- Both patents' term must not have been previously extended for delays in HSA's marketing approval process.
- S 36A(1)(c)(ii)
- Rhynytyn is the 1st pharma product containing compound X as an active ingredient to obtain marketing approval.
- S 36A(1)(c)(i)
- Interval between date of marketing approval application and date marketing approval obtained on, excluding period attributable to the applicant, must exceed 2 years.
- S 36A(5)(b)
- Apply to HSA for timeline certificate.
- Apply to IPOS for term extension on PF54.
- R 51A(2)(a)
- Application to IPOS must be before 24/11/2014.
- R 51A(2)(a)(i)
- Before 6 months from end of 20 years; patent in force. R 51(2)(a)(ii) and (iii)

Issue 2: Parallel importation of patented pharmaceutical product

- The patented pharma product must not have been previously sold or distributed in SG by or with the consent (conditional or otherwise) of PrimeHealth or any person licensed by PrimeHealth to sell or distribute the patented pharma product in SG.
- S 66(2A)(a)
- Must prove that CAG's import into SG is a breach of contract between PrimeHealth and PrimeHealth's licensee in Thailand.
- S 66(2A)(b)
- Must prove that CAG had actual or constructive knowledge of the breach of contract.
- S 66(2A)(c)
- Consider sending CAG a written notice to ensure that it is deemed to have constructive knowledge.
- Written notice to contain particulars as prescribed in the Patents Rules.
- Prescribed particulars in R 75A.

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Question 5
1st Message

Issue 1: Obtaining national security clearance over the phone from the Registrar of Patents?

- Permission obtained through the phone is insufficient. Written authority required.
- Alternatively, they can file in SG first, S34(1)(a) and (b).
- S 34 only refers to "person resident in SG". It does not apply to any applications to be filed overseas.
- Reference is made to S 34.

Issue 2: If found guilty and convicted under S 34?

- Conviction under S 34 could result in the imposition of a fine not exceeding $5,000 or imprisonment for a term not exceeding 2 years or to both

Issue 3: Would client or Tom have committed an offence in SG given this fact situation?

- Client is a person resident in SG but he filed or caused to be filed outside SG, an application for a patent for an invention.
- Filing was made by Tom who is not resident in SG. No facts on whether client "caused to be filed" the US application.
- Client does not fall within the scope of S 34(1) of the Patents Act and did not commit an offence therein.
- Tom is a person resident in US.

Issue 4: Would it still be an offence if client withdraws US applications?

- The act of filing without complying with S 34 is an offence. Hence, withdrawing after filing would not make a difference as the said act of filing would still be an offence.

2nd Message

Issue 1: Can I enter national phase in SG now? How do I apply for Early National Phase entry into SG?

- S 86 & R 86.
- Deadline for national phase entry (Chap. I or II) – 30 months (R 86) – from facts, 30 months would be from 15/01/2004 – it would be early entry if Client wishes to

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enter National Phase in SG now.

- Early National Phase entry can be requested by Client and this would be under Chap. I.
- Pay prescribed fee ($160) using PF 37
- If the applicant wishes to enter National Phase early, he has to furnish a copy of the international application, if none has yet been sent to the Registry in accordance with the Patent Co-operation Treaty;
- Furnish any necessary translation of the international application into English.

Issue 2: Reliance on the ISR and Written Opinion (Chap. 1) in SG?

- Patents (Amendment) Act 2004 on S 30 read with the amendment on S 2 allows for a Written Opinion reliance
- But Patents (Amendment) Act 2004 on S 30 does not apply to client's application which was filed (filing date) before 01/07/2004.
- S 29(10) existing immediately before 01/07/2004 would apply
- Need to file PF 12 under R 42 existing immediately before 01/07/2004

3rd Message

Issue 1: Time for National Phase Entry into SG (Chap. II); Late? How Late?

- Patents (Amendment No.3) 2003 amended R 86 but the deadline for Chap. II national phase entry was not altered. It remains at 30 months from the relevant date. This case is likely to be a Chap. II entry as client had received an IPER.
- 30 months from relevant date (date of filing as there is no priority claim/earlier filings i.e. 25/01/2002) would have fallen on 25/07/2004. Late for national phase entry
- 4 months late

Issue 2: Late National Phase Entry into SG (Chap. II)

- Client can request to extend the deadline for national phase entry under R108(4) & R108(4A).
- If the request is made within the specified 42 months in R 108(4A), the extension shall be granted.
- If the request is made outside the specified 42 months in R 108(4A), R 108(4) applies and the extension may be granted.
- Need to file PF 46 and fees.
- Need to furnish statutory declaration or affidavit setting out the grounds for the request.
- For R 108(4A), the extension shall be granted if the Registrar is satisfied that the

delay giving rise to the request was unintentional.

- On facts, can submit that the delay was unintentional i.e. "oversight".

Question 6

Issue 1: Paris Convention and Priority Claim

- Explain Priority can be claimed because SG and US are both Signatory to Paris Convention as well as WTO and not because of USSFTA.
- Explain Art. 4 of the Paris Convention provides that any person who has duly filed in one of the contracting countries shall enjoy a right of priority for purpose of filing in the other contracting countries.
- Explain period of priority for patents and utility models is 12 months.
- Cite S 17(2)

Issue 2: Extension of Time for filing Convention Application (3 marks)

- The secretary's omission is irrelevant as no extension of time because of mistake.
- The deadline of 12 months is not extendible.
- R 108 (1) and (2) do not permit extension of time for claiming convention priority.

Issue 3: Patentability (novelty)

(i) Use

- As priority cannot be claimed, the issue is whether the invention has been disclosed such that it is no longer novel; elements of patentability (S 13).
- Discuss definition of prior art and how what forms part of the state of the art S 14(1) is crafted widely to capture disclosure whether oral or in writing, domestic or abroad.
- Discuss risk; "all matter made available to the public by use" therefore use in USA "falls within state of the art" will affect patentability and validity of patent.
- Discuss disclosure sufficient to enable person skilled in art to put innovation into practice.

(ii) Pending unpublished US patent application

- Consider S 14(3)
- Raise issue whether a pending patent application published after the SG filing date comprises matter in the state of the art so as to affect novelty and accordingly patentability.
- Discuss whether US pending application (i.e. foreign pending applications) are intended to be covered by this provision or only SG applications. Explain prior US application would not affect obtaining valid patent rights in SG even if the

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matter was contained in the prior application both as filed and as published because the US application is not an application for a patent under S 14(3) as this section only relates to SG patents according to the definition under S 2.

Issue 4: Foreigners filing Patents in SG (2 mark)

- SG law clear that <u>any</u> person may make an application in SG. Makes no distinction whether foreigner or local.
- Cite S 19(1)

Issue 5: PCT Filing Designating SG

- PCT R 26*bis* 1 allow addition/correction of priority claim within 16 months from priority. However PCT Filing still bound by Paris Convention/WTO deadline when claiming priority. Therefore can file addition of priority claim only if PCT application lodged within 12 months from Priority Date [PCT R 4.10(i)].
- In this case application still out of time even under PCT to claim priority.

<u>Question 7</u>
Issue 1:

- Application filed prior to 01/07/2004. Old deadlines apply, not fast-track. Patent (Amendment) Rules 2004, R 51
- Filing date 03/07/2002. Search Request overdue 03/11/2003 at 16 months (S 29(1)(a)).
- Extension of time may be sought (Registrar's discretion) (R 108(4)).
- Still have time to file combined Search and Examination by 03/11/2004 and must do so as soon as possible as 2 days from deadline. Warn client of urgent action required (S 29(1)(b)).
- Entitlement of Company to patent. Patent may be granted primarily to inventor unless in preference to this another person is entitled by law or contract. Confirm whether Mr. Teck was employed or whether any assignment. (S19(2)(b))
- Can refer for question to be determined S 20(1). Burden on referrer to establish rights. File PF2, filing fees S$450.00 with statement and relief XYZ Co. is seeking i.e. to be named applicant (R 10) Order made under r.12. Steps to notify Patent office and record company XYZ as applicant. Registrar may order application proceed in name of XYZ.

Issue 2: PCT

- Priority date 05/05/2002 and International Filing Date ('IFD') 05/05/2003. Valid priority claim.

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- Demand filed 05/10/2003 within deadline of 19 months (05/12/ 2003) to delay entry National Phase under Chap. II.
- National Phase Entry must be filed by 30 months i.e. 05/11/2004.
- (Articles 22 and 39 PCT).
- Again urgency noted as 4 days to deadline.
- National Phase Entry possible for China, SG, US and Australia.
- Taiwan and Malaysia not PCT countries, too late to file for grant. Must have filed with 12 months, claiming priority.

Issue 3: Block Extension

- SPA amended such that all patent application filed after 01/07/2004 on fast track unless file for block extension.
- Deadline for Request for Search is 13 months i.e. 07/08/2005 R 38 and deadline for Request for Examination or Request for combined Search and Examination is 07/04/2006 (21 months) R 43. File Grant by 42 months.
- Need to explain cost filing by filing block extension PF45A is $1,800 but will extend to both deadlines for file Search and Examination and Grant.
- PF45A must be filed by 39 months from filing date i.e. 07/10/2007 R 47A or by 21 months from filing date i.e. 07/04/2006 S29(7) . Deadline for PF45A is not extendible.
- (If the candidate discusses the inconsistency in these 2 provisions, we can accept the answer and award the full mark allocated.)
- If block extension applied for new deadlines for filing Request for Examination or Request for Combine Search and Examination is by 21 or 39 months – 07/10/2007, file Request for Grant by 60 months from filing date (07/07/2009).
- Any other extension S 108(1) – (3) still apply.

Issue 4: Patent Agency

- S 105 provides for situations when persons are entitled to act as patent agents.
- Ray can act for company XYZ for patent work if the work is undertaken by Ray Mann in the company as an employee S 105(10). Ray Mann will only run foul of S 105 if he undertakes to do patent work for a third party for gain (S 105(4)).