INTELLECTUAL PROPERTY OFFICE OF SINGAPORE

PATENT AGENTS QUALIFYING EXAMINATION

**PAPER D: KNOWLEDGE OF PATENT LAW AND PATENT PRACTICE IN SINGAPORE**
**25 November 2004, Thursday**
**1400 – 1730 hrs**

Maximum Time: 3 Hours + 30 Minutes of reading time **Maximum Marks: 100**

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LIGHTING UP YOUR CREATIVITY

**INSTRUCTIONS TO CANDIDATES**

1. This Paper consists of 10 sheets, including this cover sheet.
2. 30 minutes of reading time is provided. You are not allowed to write in the Answer Booklet(s) during this reading time.
3. You are required to answer 5 questions only.
4. Each question carries 20 marks. If more than 5 questions have been answered, only the first 5 answers will be marked.
5. Write your answers in English. Answers in any other language will not be marked.
6. References to dates in the questions are in the format of DD/MM/YYYY.
7. Only your answers to the question(s) written or glued in the Answer Booklet(s) 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.
8. 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. Where relevant, you are also advised to include in your answers supporting references, for example, the Patents Act & Rules and the PCT provisions.

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**Question 1**

Your client X comes to you with the following problem:

X is a research organization currently investigating treatment of diabetes by diet control. X is also developing a device for patients to check their blood/sugar level as a way of monitoring their treatment of diabetes. X has obtained a Singapore Patent 9876 for their device which is at a prototype stage.

X has received a letter from company A reading as follows:

"We are the proprietors of Singapore Patent 5432 granted in July 2003. The patent is in force. Our Patent claims and covers the treatment of diabetes. In particular the patent claims a pharmaceutical product which can be used to treat diabetes. Also claimed is a device for testing the blood/sugar level of diabetic patients.

We have studied your Singapore Patent 9876 which was granted later than ours, has a priority date which is also later than ours and it confirms that you are infringing our Patent. We demand that you stop infringement at once and surrender your patent to us failing which we shall seek an injunction and damages."

X tells you that as far as he is aware A has only sold the pharmaceutical product covered by their patent but not the device for testing blood/sugar levels.

Explain the position to X and the options available to him.

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**Question 2**

You receive the following letter from a client:

"Thank you for reporting the filing of my PCT Application at the Singapore Registry on 01/11/2004. When I asked you to go ahead with that filing I forgot to tell you that I am not a citizen or resident of the Republic of Singapore. Will that affect the Application?

I believe that some sort of examination will be made of my PCT Application. Can you please explain this to me? Please also let me know if a request for examination must be filed and if so, by what date."

Prepare notes on the matters you will need to explain to the client.

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**Question 3**

Your client has received the following letter from Company Y:

"We are the proprietors of International Patent WO 04/9876 which has just been published. The patent designates Singapore and is concerned with a process for making a new product P with a pharmaceutical indication.

We note that you are importing P into Singapore. Accordingly we draw your attention to the existence of our Patent."

Your client does not understand this letter and asks you to explain it.

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**Question 4**

On 02/11/2014, Mr Lee, the Business Development Manager of PrimeHealth Pharmaceutical Company ("PrimeHealth"), approaches you for advice on the company's two Singapore patents related to its best-selling drug, Rhynytyn. These two patents were granted in 2010. Rhynytyn is used to treat inflammation of the nasal passage. He informs you of the following facts.

PrimeHealth holds a patent in Singapore (Patent A) for a compound X, which is the active ingredient in Rhynytyn. Subsequently, PrimeHealth discovered that Rhynytyn could also be used to treat sweaty palms. PrimeHealth holds another patent in Singapore (Patent B) for this second medical use of the active ingredient X for the treatment of sweaty palms. PrimeHealth had applied to the Health Sciences Authority ("HSA") on 22/02/2011 for a product licence to market Rhynytyn in Singapore to treat inflammation of the nasal passage as well as to treat sweaty palms. On 24/05/2014, the HSA granted the product licence.

In October 2014, PrimeHealth discovered that a medical supplies company, CheapAndGood Inc, had managed to purchase Rhynytyn in Thailand and was importing it into Singapore for sale.

Mr Lee would like your advice on how PrimeHealth can extract maximum benefit from these two patents that it holds and what steps it needs to take to do so.

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**Question 5**

You, a registered patent agent with a valid practising certificate, have just returned to your office after a heavy and long lunch and when you checked your office telephone mail box for messages, you find 3 voice messages requiring your urgent attention and they are as follows. Please go through each voice message in detail and prepare a written response to each message corresponding to the issues raised.

> **1st message:** Hi, I am your client A. I was talking to my friends on filing patent applications overseas and they mentioned something about a need to obtain national security clearance over the phone from the Registrar of Patents prior to any filing of patent applications overseas. Are they correct? Anyway, I rushed home immediately to check my records. I found that I had entered into an agreement with my friend Tom, a US resident and inventor, where the full rights to a patent application in the US (filed on 28/01/2004) had been assigned to me, I am pretty sure that Tom had made this filing without obtaining any clearances first from IPOS. In buying over this US patent application from Tom, would I, a Singapore resident, have committed an offence in Singapore? How about Tom? If I had committed an offence, can you advise me on the possible consequences I can expect if found guilty and convicted and also whether it would still remain an offence if I withdraw the US application?

> **2nd message:** Hi, I am your client B. I filed an international application at the International Bureau of the PCT and was given an international filing date of 15/01/2004. I just received an International Search Report and a Written Opinion and I do not wish to request for any PCT examination. By the way, I have no other patent filings. Can I enter national phase in Singapore now? If

so, how do I apply for National Phase entry into Singapore? Can I rely on these documents in Singapore? Please advise me on what I should do if I am unable to rely on the Written Opinion.

**3rd message:** Hi, I am your client C. I just recalled that I have a PCT application dated 25/01/2002. I have no prior filings elsewhere. I remember receiving a PCT gazette publication of this application and an International Preliminary Examination Report. Today is 25/11/2004 and I realized that due to an oversight on my part, I am late for national phase entry into Singapore. Can you confirm that this is so, and find out, to date, how long the delay is? Can I still enter national phase in Singapore now? If so, how?

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**Question 6**

Your client had filed a US Patent Application on 01/09/2003. He comes to you on 15/09/2004 and would now like to file an application in Singapore. He asks if he can claim priority as he has been told about some convention or United States - Singapore Free Trade Agreement ("USSFTA") which allows you to do that. He asks you for advice on how this USSFTA or convention priority works. He claims he would have come to you earlier except for an oversight due to a clerical error in recording the dates by his secretary. His secretary had recorded the US Filing date as 01/10/2003 instead of 01/09/2003.

He further informs you that there may have been a small amount of use in USA sometime in November/December 2003. However, he informs you there has been no printed publication of the invention.

He also wants to know whether there will be any problems filing a patent in Singapore since he is not resident in Singapore. He asks if filing a PCT application designating Singapore would be better for claiming priority. Advise the client as to what can be done and give your reasons.

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**Question 7**

The in-house legal Counsel Ray Mann of a large technology company XYZ comes to you to seek your advice. Ray has just been appointed as previously all legal paper work was handled by the CEO of the company who is not a legally trained person.

Ray has found several papers related to patents and is in your office today, 01/11/2004 and asks you let him know what needs to be done.

Ray provides you with the following documents and information:-

(a) A Singapore pending application, 20020307, dated 03/07/2002 with no priority claim. There is a formal notification from IPOS on 08/12/2002 informing the applicant that the application has been examined in accordance with Section 28 of the Singapore Patents Act and satisfies the formal requirements of the Singapore Patents Act and Rules. No further action has been taken on this application to date. The application appears to have been filed in the name of the inventor, one Mr. Teck Kee Boi. Ray informs you Mr. Teck is no longer with company XYZ and asks what can be done.

(b) An international application, PCT/SG02/0055 filed on 05/05/2003 designating all contracting states was filed to cover process for manufacturing widget AAA and widget AAA. There is a priority claim from a Singapore Patent Application 20020505 which has filing date 05/05/2002. This Singapore Patent Application 20020505 has since been abandoned. Demand was filed on 05/10/2003 but no International Preliminary Examination Report is in the file. Ray says widget AAA is made in China and sold in Singapore, US, Taiwan, Australia and Malaysia, and company XYZ wants patents in all these countries.

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(c) A national patent application describing Widget BBB was filed on 07/07/2004 without claim to priority and issued Singapore Patent Application No. 20040707. Ray says company XYZ is not sure whether widget BBB is marketable and his company wants to delay incurring costs for prosecution as long as possible. Ray wants to know, what the deadlines are and how long he can delay the deadlines.

(d) Ray also tells you that company XYZ wants to save costs and wants him to act as their Patent Agent as well as legal counsel and only engage you to advise company XYZ as and when needed.

Write notes on the points you need to explain to Ray and include all relevant references to the Patents Act and Rules and PCT provisions where appropriate. Please give exact dates for deadlines.