

Answer guidelines to QE 2005 Paper D

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

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

Question 1

- Renewal calculations start from date of filing.
- s36(1)
- International date of filing = date of filing under the Patents Act = 1 June 2001.
- s87(1)(a)
- First Renewal was technically due on 1 June 2005.
- r51(1)
- But as Grant was issued only in June 2005 and after the Renewal period (expiry of the period of 45 months from the date of filing).
- Renewal period is altered and Renewal can be made at any time up to the end of the period of 3 months from the date on which the patent is granted
- 14 September 2005 (3 months from Grant 14 June 2005).
- r51(2)
- Now is 10 November 2005, applicant is about 2 months late.
- But he is still within 6 months from the end of the prescribed period to pay and renew the patent and if the renewal fee and any prescribed additional fee are paid within this period, the patent shall be treated for the purposes of this Act as if it had never expired.
- s36(3)

Steps to take (if taken as soon as possible e.g. before 14 November 2005) >>>

- file PF15 & PF 16 for the 5th year (1 June 2005 to 1 June 2006) and
- pay fees >>> PF 15 (\$150) + PF 16 (\$50 not exceeding one month + \$100each succeeding month (but not exceeding 6 months))

What happens to patent if client waits till July 2006 to take action >>>

- The patent shall cease to have effect at the end of the prescribed period for the payment of any renewal fee if it is not paid within that period.

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- s36(2)
- Client can seek to restore patent under s39.
- But as restoration is discretionary and involves more fees, advise Mr. X not to wait and apply to renew now.

Question 2(a)

- s43(3)(c):
- Even if the patent application is still pending, licenses can be recorded against the patent application as a registrable transaction.
- s43(2):
- There is an advantage for the US company to record the licence with the Registry in the event that a third party acquires a right which is incompatible with the non-exclusive licence acquired by the US company.

Suggested rules and forms to be mentioned by candidate:

- r57 (1) Recordal on PF 24.
- r57(2) Accompanied by PF 41 by each person to the transaction, if necessary.
- r57(4) Where not accompanied by PF 41 and r57(3) does not apply, then a copy of the document which is duly certified or otherwise acceptable to the Registrar.

Question 2(b)

- s55 (1)
- Requirement for compulsory licence – anti-competitive practice
- Identify how courts may determine as an anti-competitive practice in s55(2)
- Market for the patented invention in Singapore ;
- That market is not being supplied or not being supplied on reasonable terms and the court is of the view that the proprietor of the patent has no valid reason for failing to supply that market with the patented invention, whether directly or through a licensee on reasonable terms.
- Market will be supplied as Company is selling so may not be possible for US company to satisfy condition, provided the supply is on reasonable terms.

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Question 2(c)

- s29(2)(c) (ii)
- Identify the route of relying on prescribed information under new law - corresponding US application.
- Lodge Form 11B
- r44(2)
- Copy of granted patent duly certified or otherwise acceptable to Registration or other documents setting out the final results of search and examination as to substance and a copy of the patent claims referred to in the final results.
- r44(1)(a)
- Any IPC symbol which has been or which in opinion of Applicant ought to be allocated.
- r44(1)(b)
- Deadline 42 months from date of filing of the application –
- r43(4)

BONUS:

Possible bonus marks for candidates who discuss the change in definition of corresponding application where there is no need to prove that the corresponding US application should be for the same or substantially similar invention. The fact that there is a priority claim is sufficient.

Question 3(a)

- s87(1)(a): The International Filing Date is the filing date of PCT National Phase application in Singapore.
- The filing date of the PCT National Phase is therefore 2 August 2004.
- The PCT National Phase application is governed by the Patents Act as amended by the 1 July 2004 amendments.
- It is possible to enter National Phase.

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- The PCT National Phase application contains the same claims as the Singapore application.
- Therefore, it is likely that the PCT National Phase application contains the same invention having the same priority date as the Singapore application.
- Both applications are filed by the same applicant AA.
- s30(3)(e) – post 1 July 2004 amendments – may apply.
- The Registrar may not grant a patent on the PCT National Phase application.
- Even if a patent is granted on the PCT National Phase application, possibility of revocation/partial revocation if a patent is also granted on the Singapore application.
- s80 (1)(g)
- AA need to ensure that there is no other application or earlier grant for a patent for the same invention having the same priority date filed by them when the PCT National Phase application is ready to proceed to grant.
- AA should allow their Singapore application to be deemed abandoned or withdraw the same before the PCT National Phase application proceeds to grant.

Question 3(b)

- It is possible, proceed by filing a Request for Search and Examination.
- S29(2)(b) – post 1 July 2004 amendment.
- Allows/does not preclude a PCT National Phase application to proceed by this route.
- r43(1)(a) – post 1 July 2004 amendment: Deadline is 21 month from the earliest declared priority date.
- 21 month - 2 May 2005.
- Urgent - Early National Phase entry of the PCT application must be requested before 2 May 2005 so that Request for Search and Examination may be filed by 2 May 2005.
- To enter early National Phase: File Form PF 37 + prescribed fee of S\$160.00 + a copy of the PCT application.

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BONUS:

A bonus point may be given if a candidate identifies any of the following ways to extend the 21 month deadline, but only if he has correctly provided the above required answer and has logically explained why the extension needs to be sought:

- Rule 108 (3) : between 2 May 2005 and 2 August 2005, extension of time as of right of up to three months
- Rule 108 (4) : after 2 August 2005, extension of time may be granted if the Registrar thinks fit
- Section 29(7) & Rule 47A : block extension

Question 4

GROUNDLESS THREATS

- Letter from A may constitute threat of infringement proceedings.
- s77(1)
- But B cannot bring proceedings for a threat to bring proceedings for an infringement alleged to consist of making a product.
- s77(4) and/or Bean Innovations v. Flexon.

ACTION FOR INFRINGEMENT IF PATENT APPLICATION FILED ON 1 MAY 2004

- Lack of Unity of Invention does not invalidate patent.
- s37
- Search and Examination ("S&E") under s29(1)(c) (pre-July 2004 Act).
- Requirement: For claims to **(b)** to be enforceable, US X/X must be a "corresponding application" such that it is in respect of the same or substantially the same invention as the Singapore patent application.
- s29(9) (pre-July 2004 Act).
- However, may request post-grant S&E to determine patentability.

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- Ground: Where the patent was granted on the basis of any prescribed information relating to a corresponding application and at least one claim in the application did not relate to any claim that was examined for novelty, inventive step and industrial applicability.
- s38A(1)(b)
- Request for post-grant S&E by filing Form 55, accompanied by, inter alia, a statement identifying ground under s38A(1) on which request is made, and explaining how the ground is satisfied.
- r52A

IF PATENT APPLICATION FILED ON 31 DECEMBER 2004

- If filed after 1st July 2004, subject to amendments under the Patents (Amendment) Act 2004.
- S&E under s29(2)(c)
- Registrar may refuse grant if claims not examined
- s30(3)
- Court may refuse relief for unexamined claims, thus must seek post-grant S&E first
- s69(3)

BONUS:

Cannot apply for post-grant S&E once legal proceedings commenced and may be put in issue. Therefore, advise Alpha to apply for post-grant S&E first, if post-grant S&E desired.
s38A(6)

Question 5(a)

- s31
- Amendments : general power to voluntarily amend.
- s84
- Discussion whether added subject matter if amend specifications to include metal.
- r49

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- Time for making amendment.
- File a fresh application claiming priority.
- s26(5) effect if late filing of drawings
- Change filing date r26.
- s107.
- Can drawings be filed as correction ? No correction unless obvious; here unlikely obvious.

BONUS:

Possible Revocation if add new subject matter s80(1)(d)/(e)

Question 5(b)

- Game – whether patentable; discuss requirements.
- s13
- Disclosure to friends and officers at SPRING – "made available to public", whether novelty defeating
- s14.
- *Inventorship – whether David can claim to be sole inventor
- s19.
- Advise right for Siva and Ahmad to have determination of entitlement to grant
- s20 (pre-grant)
- s47(post grant)
- *Right to mention as inventor.
- s24

*Inventorship issue is discussed twice, but emphasis is different, thus the citation is different.