

Answer Guidelines to QE 2009 Paper D

Note: The answer guidelines contain a non-exhaustive list of points that examiners expect candidates to cover 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	
Part (a) Compulsory Licence	
<ul style="list-style-type: none"> • Anyone can apply for the grant of a licence under a patent on the ground that the grant is necessary to remedy an anti-competitive practice • S 55(1) <p>(Comment: I have only awarded one mark for this because it only involves the identification of the section and is fairly simple. Otherwise, overall for this part, there would be too many points allocated for merely copying and identifying a section.)</p>	
<ul style="list-style-type: none"> • Quick Buck must show that there is a market for the patented invention in Singapore; and that market is not being supplied or being supplied on reasonable terms and the proprietor has no valid reason for failing to supply that market. The facts indicate that the market is not being supplied and there is a demand, therefore it may be possible for Quick Buck to obtain a licence from court. • S 55(2) 	
Part (b) Amended Additional Claim & Post-grant Search & Examination	
(b)(i) Amended Additional Claim	
<ul style="list-style-type: none"> • Under S 30(3)(b), it is a requirement that each claim in the application at the time the forms are filed and fee paid for the grant of the patent is related to at least one claim in the application at the time the report was issued, which has been examined and referred to in the report. 	
<ul style="list-style-type: none"> • We need to consider whether the Additional Claim is related to another examined claim in the report. A claim is related to another claim where the 2 claims are identical ; or each limitation in the second claim is identical to a limitation in the first claim or differs from a limitation in the first claim only in expression but not in content. • S 2(4)(a) • The claim, being an independent claim and directed to a different gene sequence may not be related to the other claims. As such, the grant of the 	

<p>patent arguably should not have been allowed as the Additional Claim may not be related to another examined claim.</p>
<p>(b)(ii) Amended Additional Claim & Post-grant Search & Examination</p>
<ul style="list-style-type: none"> There is a restriction on relief for infringement where a claim alleged to be infringed is not related to any claim in the application for the patent at the time the report was issued which has been examined and referred to in the report. The court may refuse to award damages, make an order for an account of profits or grant any other relief including an injunction S 69(3)(b) <p>(Comment: Candidates should not state that there is “no infringement” of the claim. If they do, only a maximum of 1 mark may be given as they have misunderstood the interpretation of this section.)</p>
<ul style="list-style-type: none"> If he wants to rely on the Additional Claim for infringement, one possibility is for Dr Livingstone to apply for post- grant search and examination on the basis that at least one claim in the application for the patent is not related to any claim examined and referred to in the examination report. S 38A(1)(a) <p>(Bonus Mark: If candidate raises issue of whether this would cure the initial defect in the grant of the patent given that the claim was not examined)</p>
<p>Part (c) Renewal</p>
<ul style="list-style-type: none"> A patent shall cease to have effect if the renewal is not paid within the prescribed period. S 36(2) Renewal due date was 1 June 2009
<ul style="list-style-type: none"> The deadline is 1 December 2009. There is a six-month grace period to pay the renewal fee and any prescribed additional fee. If the patent is renewed on or before 1 December 2009, the patent shall be treated as if it had never expired. S 36(3)
<p>Part (d) Use of Patented Invention By Government</p>
<ul style="list-style-type: none"> Subject to Sections 60, 61 and 62, the government may do anything in relation to a patented invention for a public non-commercial purpose or for national emergency or other circumstances of extreme urgency, and such acts will not be considered an infringement In this case, as the outbreak of the HX-09 virus has reached epidemic proportions and is lethal, and also affecting the economy, it is likely to qualify as a national emergency or other circumstances of extreme urgency. As the government has informed Dr Livingstone of the manufacture of the vaccine and will pay a reasonable remuneration, the use of the patented invention is not an infringement.

- S 56(1)

(Comment: No specific reference needs to be made to S 61 and 62 to gain points, but the candidate should mention the point on the remuneration and the notification as non-infringement under S 56(1) is subject to these requirements.)

QUESTION 2

(a)

- Acme's patent not granted yet. False representation that any product disposed of for value is patented is an offence (S 99(1))
- Punishment=Fine up to \$10,000 and/or imprisonment up to 12 months
- However, the offence is not a ground for invalidity (S 80(1))
- NW may continue an infringing act if, before the priority date of A's patent, effective and serious preparations were made to do the act
- S 71(1)(b)
- Since serious and effective preparations for manufacturing the devices were made before the priority date, and the devices were about to be delivered, NW may continue the infringing acts of manufacturing and importing the devices (Other infringing acts, such as disposing of, or offering to dispose of or using the devices may not continue if there were no serious and effective preparations to do these acts before the priority date -> 1 Bonus Mark)
- However, the confidential transaction between NW and the China supplier before the priority date will not constitute state of the art to invalidate A's patent (S 14(2))
- A pending patent application cannot be invalidated; a patent can only be invalidated after it is granted
- Application for invalidation must be before the Registrar (S 82(1)(d)) and not in Court

(b)

- In proceedings for infringement of a patent, damages shall not be awarded and no order shall be made for an account of profits against a defendant who proves that at the date of the infringement he was not aware, and had no reasonable grounds for supposing, that the patent existed. (S 69(1))
- The onus is on T to show he was not aware of the patent, or had reasonable grounds for supposing that patent existed, until Acme's infringement action
- Indication of patent pending insufficient in itself to impart knowledge of patent unless the patent number is also indicated (S 69(2))
- Notification of pending Singapore patent application may mean that the defence was no longer available as from March 2009 (Citation of First Choice Currency Pte Ltd v. Main Line Corporate Holdings Ltd -> 1 Bonus mark)

- It is a defence to infringement if the product is produced by or with the consent of any person licensed by the patentee
- S 66(2)(g)

(c)

- Infringing acts are to make, dispose of, offer to dispose of, use or import or keep product whether for disposal or otherwise (S 66(1)(a)) (This mark will also be awarded if this citation is stated with respect to section (a) above only)
- However, the making done for experimental purposes is not an infringement (S 66(2)(b))
- Cannot amend to extend scope of protection of claims after grant (s 84(3))
- Divisional application can only be filed before the conditions for grant of the patent application in S 30(2) and (3) are satisfied
- S 26(11)

QUESTION 3

The aim of this question is to test the candidate's understanding of the PCT Regulations, in particular the right to practice before a RO, restoration of priority, and early national phase entry into Singapore...in very practical aspects.

(a)

(i) No right of representation

PCT Rule 90.1(a) – person having the right to practise before the national office with which the international application is filed may be appointed as agent before the Receiving Office (RO).

I have no right to practice before the China patent office and thus, no right to represent InventProducts Pte Ltd before the China Patent Office acting as the RO

(ii) 2 ways to overcome (b):

I provide suggestions to Beijing subsidiary and

they file response; or

Instruct another China agent to take over representation of the PCT file, and respond to the notification from RO. If client takes the second option, needs to do it fast because of the deadline (see below)

(b) Deadline

Deadline to request restoration of priority is 14 months from 20 Aug 2008, or put in another way 2 months from the date on which the priority period expired (re: PCT Rule 26bis.3(e))

i.e. deadline is 20 Oct 2009.

It is not possible to request restoration of priority right if the applicant had requested for early publication and technical preparations for the publication have been completed – confirm with client.

(c) Chances of succeeding high?

PCT Rule 26bis.3 possible if failure to file the international application within the priority period:

- (i) occurred despite due care required by the circumstances having been taken; or
- (ii) was unintentional.

This is a rather open ended question and thus, the candidate is expected to discuss whether it is possible to satisfy these grounds based on the circumstances provided in the question, and the examiner should have an open mind to review the candidates' answers.

A possible answer might be:

- (i) “due care” i.e. if all reasonable care was taken under the circumstances to ensure that the priority period would not be missed.

The secretary simply recorded the deadline on a post-it note and overlooked to pass the message to her boss, and thus, it seems that she has not taken all reasonable care. Thus, unlikely to satisfy this criterion. (this could be sufficient to earn the mark).

[Other possible answers (included here to guide examiners)]

What about her boss, the managing director? Did he have knowledge of the deadline? Question said that she knows her boss wants to file a PCT application. Thus, what action did the managing director take? Did he ask Ms Wu about the deadline even though she went on maternity leave or he simply forgot about it or assumed that the deadline is not yet due? Did he seek advice from another firm?

If he did not take any care to ensure that he did not miss the deadline for filing the PCT application, it is unlikely to satisfy the due care criterion.

On the other hand, there seems to be always an intention of filing a PCT application. Confirm with Adrian Pan that this is correct. The secretary went on maternity and overlooked to inform her boss about the date, and it seems that failure to meet the deadline is likely to satisfy the less stricter “unintentional” criterion.

[Such an answer should be rewarded with the allocated 2 marks i.e. reasoning plus correct conclusion based on the reasoning.]

Implication is that for the national phase countries which adopt the stricter criterion of due care, the priority claim may not be restored even if it was “unintentional”.

(d) Early National Phase entry

It seems that the PCT application has not been published and thus, I will need the following for early national phase entry:

(i) a copy of the PCT application (Chinese language) and b) an English translation of the PCT application

i.e. need to prepare an English translation of the PCT application immediately.

(re: S 86(3)(b)(i))

(ii) The English translation will need to include the PCT Request and Abstract because the PCT application has not been published.

(re: rule 86(5)(a)).

(e) Priority of Singapore national phase entry

S 87(1)(b) gives effect to any adjustment in the priority period allowed by PCT Rule 26bis.3 and

thus, if the restoration of priority is allowed by the PCT Receiving office, the Singapore Patent Office will also allow the restoration.

In other words, no action is needed.

(f) To improve client's position

Provisional rights

The PCT application has not been published and even if it has been published, it will be in Chinese (i.e. non-English) and to have provisional rights from publication, I would suggest to Adrian to:

request publication of the English translation; or send a copy of the English translation to the suspected infringer

(re: S 87(3))

Examination request

The PCT application has just been filed and the International Preliminary Report on Patentability (IPRP) will be established much later – (re: PCT rule 69.2).

To expedite grant of the Singapore national phase application, I would suggest requesting local search and examination of the Singapore national phase application upon entry into the Singapore national phase.

Depending on which is established earlier, the client can then have an option of relying on either one for grant.

QUESTION 4

(a)

- S 26(1) –

An application is given a date of filing on the earliest date on which the

	<p>documents filed:</p> <ul style="list-style-type: none"> - Indicate a patent is sought - Identify the applicant - Contain something that appears to be a description - Prescribed information relating to priority claims, if any <ul style="list-style-type: none"> • The filing of PF1, drawings and cover sheet indicate that a patent is sought. The applicant is identified in PF1 (even though Kirk's name is wrongly included). The application did not claim priority. There are no prescribed information relating to priority claims to provide. • The cover sheet and serviettes arguably are something that appear to be a description.
OR	<ul style="list-style-type: none"> • The cover sheet and serviettes arguably are not something that appear to be a description. • All the requirements of S 26(1) are met, and the application is given a date of filing.
OR	<ul style="list-style-type: none"> • All the requirements of Section 26(1) are not met, and the application is not given a date of filing
<u>(b)</u>	<ul style="list-style-type: none"> • S 26(8)(a) & (b) – The drawing on the omitted serviette may be filed as a missing part. • The date of filing the application becomes the date of filing the missing part and is subject to the prior disclosure of the invention at the exhibition. • S 26(9)/Rule 26A(4)(a) – • if a priority claim is made on or before the filing date of the application, a request may be made within 3 months of the filing date of the application for the filing date not to be postponed. The request should be accompanied by: <ul style="list-style-type: none"> • a statement that the missing part is incorporated by reference to, and completely contained in, the priority application (S 26(9)(b)(ii)) • the priority date, priority number, priority country (S 26(9)(b)(ii)/Rule 26A(6)) • the certified priority document(s) and English translation(s), if relevant. If IPOS has a copy of the priority application and/or English translation, request IPOS to prepare a certified copy via PF2. (S 26(9)(b)(iii)/Rule 26A(7)) • Kirk must request that the filing date not be postponed, accompanied by the requisite items indicated above.

The request must be made by 2 June 2009.

(c)

- S 105(1) –
An individual cannot practise or act as a patent agent unless he is a registered patent agent, or an advocate and solicitor, who has in force a practising certificate.
- S 105(8) –
Contravention attracts a fine of up to \$5,000 and/or imprisonment for up to 12 months.
- S 105(15) –
A “registered patent agent” is one who has been issued a practicing certificate under the Patents (Patent Agents) Rules.
- S 105(4) –
A person is taken to practise or act as a patent agent if he applies for a Singapore application on behalf of someone else for gain.
- Kirk does not appear to be a registered patent agent or advocate and solicitor. By indicating on PF1 that he is the authorized representative and filing the Singapore application for \$500 on behalf of Spock, he may have practised or act as a patent agent and committed an offence under Section 105(1).

OR

(c)

- S 34(1) –
A person resident in Singapore cannot file a patent application outside Singapore without the Registrar’s written authorisation unless a corresponding application has been filed with IPOS not less than 2 months before the application outside Singapore, and no current directions under section 33 exists.
- S 34(4) –
A “person resident in Singapore” includes a person lawfully residing in Singapore
- S 34(3) –
Contravention attracts a fine of up to \$5,000 and/or imprisonment for up to 2 years
- Kirk is residing in Singapore (presumably lawfully). Kirk does not appear to have obtained the Registrar’s written authorisation.
- A foreign application may only be filed 2 months after the Singapore application. By filing the Malaysian application 1 week after the Singapore application, Kirk may have committed an offence under Section 34(1).

QUESTION 5

(a)

- Yes, correct.
- Deadline is 19 months from the priority date (R.45*bis*.1).
- 28 June 2010
- An International Searching Authority that has stated its preparedness to carry out supplementary international searches and which is not the International Searching Authority that carried out the main international search (R.45*bis*.9).
- The supplementary international search report will have to be established within 28 months from the priority date (R. 45*bis*.7).

(b)

- A demand may be made at any time prior to the expiration of whichever of the following periods expires later:
- three months from the date of transmittal to the applicant of the international search; or
- 22 months from the priority date (R. 54*bis*.1)
 - 28 September 2010
- In respect of some Offices, in order to secure the full effect of the demand – including the delaying of the national phase until 30 months from the priority date – it must be submitted before the expiration of 19 months from the priority date.
- 28 June 2010

(c)

- After receipt of ISR, applicant can amend claims within two months from the date of transmittal of the ISR to the IB and to the applicant by the ISA; or 16 months from the priority date (whichever time limit expires later).
- 28 March 2010
- Art 19(1), R.46.1
- Amendments to the claims only, not drawings and description. [Art 19(1)]
- The amendments cannot go beyond the disclosure in the international application as filed [Art 19(2)]
- The applicant may submit amendments under Article 34 at the time of filing the demand or until the international preliminary examination report is established.
- The applicant shall have a right to amend the claims, the description, and the drawings. The amendment shall not go beyond the disclosure in the international application as filed.

<ul style="list-style-type: none"> • Art 34(2)(b), R 66.1(b).
<p>(d)</p> <ul style="list-style-type: none"> • File a notice of intention to rely on an international preliminary report on patentability [S.29(2)(e)(ii) SPA] • PF11C – no official fee (R42A SPR) • Deadline is 42 months from declared priority date (R 43(4) SPR) • 28 May 2012