

INTELLECTUAL PROPERTY OFFICE OF SINGAPORE
PATENT AGENTS QUALIFYING EXAMINATION 2009

PAPER D: KNOWLEDGE OF PATENT LAW AND PATENT PRACTICE IN SINGAPORE
8 October 2009, Thursday
1330 – 1730 hrs

Maximum Time: 4 Hours (includes reading time)

Maximum Marks: 100



INSTRUCTIONS TO CANDIDATES

1. This Paper consists of 10 pages, including this cover page.
2. You are required to answer all 5 questions. Each question carries 20 marks.
3. Write your answers in English. Answers in any other language will not be marked. Answers in illegible handwriting will not be taken into consideration.
4. Only your answers to the question(s) written in the Answer Booklet(s) provided by the Examination Secretariat will be considered. You are to write on one side of each sheet in the Answer Booklet(s). Answer one question per Answer Booklet.
5. 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.

End

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Question 1

Note to candidates: A discussion of the patent forms and fees is not required, and additional points will not be awarded.

5

Dr Livingstone, a renowned scientist, lives in the jungles of Malaysia, devoted to his research on tropical diseases in his state of the art laboratory. Many years ago, a deadly influenza virus, HX-09 swept through his community which killed many inhabitants of his community. Dr Livingstone successfully developed a vaccine.

10

Knowledgeable about patents, Dr Livingstone wisely filed a patent application in Singapore with a filing date of 1 June 2005. The application was for a vaccine comprising various sequences of antigens isolated from the influenza strain. The examination report issued by the Intellectual Property Office of Singapore pursuant to Section 29 (6) of the Patents Act was positive as to novelty, inventive step and industrial applicability of all the claims. However, prior to payment of the grant fee, Dr Livingstone discovered upon closer reading of the claims, that the claim to a particular modified gene sequence (different from the other gene sequences claimed) in the HX-09 virus was not included. It was however, mentioned in the patent specification. As the modification to the sequence might increase the efficacy of the vaccine by 100% he instructed the patent agent to add this in as an additional independent claim ("**the Additional Claim**") just before paying the grant fee. The patent agent duly did so, paid the grant fee and the patent for the vaccine was granted with all the claims including the Additional Claim, to the relief of Dr Livingstone.

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Dr Livingstone happily went back to his laboratory. Being absent-minded and far too busy, he forgot all about his patent and took no further action. Absorbed in his work, he ignored all correspondence from his patent agent about renewals.

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Last year, a representative from a Singapore company, Quick Buck Pte Ltd contacted Dr Livingstone. They were interested in a licence of the patent from Dr Livingstone as they had received enquiries as to whether they could supply the vaccine for the HX-09 virus from a number of companies. The vaccine was not available on the market through other sources.

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Dr Livingstone refused as he felt the licence fee offered was too low, and he did not trust the people from Quick Buck. After Quick Buck's final offer was refused, the company threatened that they would take him to court and force him to give a licence to them.

- 5 (a) Can Quick Buck force Dr Livingstone to license the patent to them if their offer for remuneration was reasonable? (3 marks)

- 10 (b) (i) Discuss whether the Additional Claim ought to have been granted. (6 marks)

- (ii) In the event that Dr Livingstone needs to take action against Quick Buck Pte Ltd for infringement of his patent, is the Additional Claim fully enforceable? You may assume that the grant is in order, the patent is in force and the Additional Claim is patentable. 15 (4 marks)

- (c) Today is 30 November 2009. Dr Livingstone, who had forgotten about this patent all these years, was suddenly worried. He has a vague recollection of a renewal deadline. Can he still renew his patent, and if so, what is the deadline to do so? 20 (3 marks)

Consider the situation where there is an outbreak of HX-09 in Singapore. The virus is easily transmitted and lethal, giving rise to an epidemic. The economy has come to a standstill, and the hospitals were overflowing with patients infected with the virus. A government 25 official from the Ministry of Health informs Dr Livingstone that they have started manufacturing the vaccine patented by Dr Livingstone and they will pay him a reasonable remuneration.

- (d) Dr Livingstone asks you whether the manufacture of the vaccine by the Government 30 constitutes an infringement of his patent. (4 marks)

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Question 2

- (a) Acme Ltd filed a patent application for a novel wrist-worn mobile phone device having an organic light-emitting diode (OLED) screen on 1 March 2008. Acme obtained a positive search and examination report on 1 June 2009 indicating that all the claims were new, involved an inventive step and were capable of industrial application. Acme immediately published on its corporate web-site the news that it has been granted a Singapore patent for the new mobile phone device.
- 5
- 10 Separately, Novelty Watches Pte Ltd had an idea for the same wrist-worn mobile phone device. Early in 2007, it had developed a prototype of the mobile phone device having an OLED screen in-house which read on the claims of Acme's patent. As the prototype was successful, Novelty Watches engaged a factory in Tuas on a confidential basis in 2007 to manufacture the mobile phone device for sale in Singapore. A first batch of 100 devices was delivered to Novelty Watches at the end of March 2008.
- 15

- On 1 July 2009, before the patent was granted, Novelty Watches discovered Acme's announcement of its patent grant on Acme's web-site. Novelty Watches wants to apply to Court to invalidate Acme's patent immediately and seeks your advice on the next day.
- 20 Advise Novelty Watches on the above matters.

(9 marks)

- (b) Timor has been selling a similar mobile phone device since January 2009. On March 2009, at a customer's premises, Acme's sales representative showed him a brochure indicating that Acme has a patent pending in Europe, and verbally informed him that a corresponding Singapore patent application was also filed. Acme's Singapore patent was granted on 1 October 2009. The claims were not amended throughout the patent application process. Immediately after Acme's patent was granted, Acme sued Timor for patent infringement, claiming damages as from the date of publication of Acme's patent. In his defence, Timor protested that he was not aware of Acme's patent until Acme's infringement action.
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After checking with his source, Timor discovered that he had been importing the mobile phone devices from Europe from Acme's authorized European agent. Advise Timor.

(6 marks)

- 5 (c) Sola has read Acme's patent and his start-up venture is making prototypes of the mobile phone devices as described therein to understand more about Acme's patent and how it works. One of Sola's employees involved in the work left to join Acme. In an effort to please his new employers, he told Acme's managing director about Sola's intentions. Acme wants to sue Sola for infringement of Acme's patent and put an immediate stop to any
- 10 further allegedly infringing activities by Sola.

- Sola's mobile phone uses the previous-generation light-emitting diode (LED) screen instead of an OLED screen. Although the disclosure in Acme's patent includes embodiments of both LED and OLED screens, due to a miscommunication between Acme and its patent agent,
- 15 the patent agent thought Acme was only interested in claiming OLED screens, which were the latest technology. As a result, only OLED screens were claimed. Acme discovered this just when it was about to start a patent infringement action against Sola. Acme wants to either amend the patent claims or to file a divisional application before commencing legal action to cover the LED screen concept. Advise Acme.

20 (5 marks)

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Question 3

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Adrian Pan, the managing director of InventProducts Pte Ltd, a Singapore company with a Beijing subsidiary in China, came to you for advice last year. You are a Singapore registered patent agent but from your work experience, you also know a bit about China Patent Law. Because one of the inventors resides in China, your advice was for them to file in China first, according to China requirements. Thus, after you obtained the necessary security clearance from the Singapore patent office, they filed a China patent application on 20 Aug 2008 through a China patent agent who runs his own firm.

10

Today, 8 October 2009, you received an e-mail from Adrian saying that he wants to meet you later to discuss very urgent matters. In his e-mail, he said that his Beijing subsidiary filed a PCT application on 28 Aug 2009 themselves claiming priority from the China application so that they will have international protection. The specifications of both applications are the same and in the Chinese language. Just like the China priority application, the PCT application named three inventors, Freedom Fang who is the Chinese inventor residing in China, Bruce Wayne and Peace Ho, both residing in Singapore, with InventProducts Pte Ltd and her Beijing subsidiary as co-applicants.

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He said that their Beijing subsidiary just received a notification from the China patent office acting as the Receiving office saying that the PCT application was filed out of time. He tells you that it is imperative that the PCT application must claim valid priority from the China application because of an intervening disclosure made by his Beijing subsidiary. He wants you to take over representation of the PCT application immediately and to sort the mess out. His Beijing subsidiary did not use the China patent agent who filed the China priority application because the China patent agent had fallen sick and there was no one in his office to look after the work. Before he went on his sick leave about 5 months ago, the China patent agent told Ms Wu Fang Fang, a secretary at the Beijing subsidiary, verbally over the telephone that if she wants to file a PCT application, she must do so within 12 months of the

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filing of the priority China application. Ms Wu knew that her boss, managing director of the Beijing subsidiary, wants to file a PCT application because of his plan to obtain patent protection in many PCT states. Thus, she wrote the date down on a post-it note and pasted the note on her notice board beside her desk, with the intention of informing her boss later that day. However, she forgot and went on maternity leave a few days later. She came back to the office from her maternity on 25 Aug 2009 and saw the post-it note. Immediately, she told her boss and they filed a PCT application on 28 Aug 2009 themselves and indicated in the PCT Request that priority is claimed from the China patent application.

- 10 In his e-mail, Adrian Pan also wants you to obtain immediate patent protection in Singapore because of a competitor's products which fall within the scope of the current claims. He also tells you that no amendments have been made to the PCT application.

- 15 How would you advise Adrian Pan at the meeting later today? You should at least address the following issues:-

(a) representation of the PCT application

(3 marks)

(b) the deadline that needs to be borne in mind to restore the priority claim at the PCT-RO

20 (2 marks)

(c) the likelihood of restoring the priority claim at the PCT-RO

(4 marks)

(d) what documents are needed to enter the Singapore national phase immediately

(4 marks)

- 25 (e) assuming priority is restored by the Receiving Office, what steps need to be taken in Singapore

(2 marks)

(f) what options are available in relation to the Singapore national phase application to improve the clients' position in relation to the potential infringement action, assuming there are no corresponding foreign applications to rely on

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(5 marks)

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Question 4

Kirk and Spock were close friends. They grew up and went to school together in Malaysia. Spock left Malaysia at 18 to help run the family latex business in Indonesia following a family
5 tragedy. Kirk became a registered patent agent in Malaysia but did not practice actively because there wasn't sufficient work in his hometown. Kirk decided to go boldly where no man in his hometown had gone before. He moved to Singapore 15 years ago and has been in the import-export business since.

10 A chance meeting on the streets led to a long chat over coffee. Spock confided in Kirk that a worker in his Malaysian latex factory had devised a new vulcanisation process which potentially halves production costs. Spock scribbled some notes and drawings on 4 pieces of serviettes to illustrate the process. Kirk told Spock, "Old friend, you're lucky I'm a qualified
15 patent agent. For old times' sake, I'll file it for you in Singapore for \$500. The Singapore government is generous with grants."

Six months later, Spock telephoned Kirk for an update on the patent application. Kirk assured that a patent application was being filed that very same day. In fact, Kirk had forgotten all about it and had lost one of the serviettes (which contained one drawing). On 2
20 January 2009, he submitted over the counter at IPOS a single cover sheet containing the words "A new vulcanisation process – please see drawings", A4-sized photocopies of the other 3 serviettes.

A month later, Spock requested Kirk to file a corresponding application in Malaysia, which
25 Kirk promptly did, incorporating all requisite drawings and descriptions. The Malaysia application has been accorded a filing date of 2 February 2009.

Kirk also realised that he omitted to include PF1 in the over-the-counter submission at IPOS. On 2 March 2009, Kirk approached IPOS and they helped him to locate the documents he
30 had submitted earlier. On that day, he supplemented the earlier documents with a PF1 indicating the following salient information:

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-
- Applicant: Spock & Kirk
 - Inventor: Spock (Kirk did not have the details of Spock's worker)
 - Agent: Kirk
 - Address for service: Kirk's home address
 - 5 - Signature: Kirk signed off as authorised representative
 - Declaration of priority: Malaysia, 2 February 2009

He still forgot the missing drawing!

10 Subsequently, Spock disclosed the invention at an exhibition and requested Kirk to file corresponding applications worldwide. Kirk realises that international applications and the further prosecution are out of his depth. He found your firm of patent agents on IPOS's website and comes to you for help.

- 15 (a) Discuss whether the documents submitted over the counter by Kirk on 2 January and 2 March 2009 together meet the requirements for obtaining a date of filing a patent application in Singapore as at 2 March 2009.

(5 marks)

- 20 (b) Assuming that the documents submitted at IPOS met the requirements for obtaining a date of filing a Singapore patent application as at 2 March 2009, describe what may be done in relation to the Singapore application to include the missing drawing.

(10 marks)

- 25 (c) Discuss ONE offence which Kirk may have committed under the Patents Act.

(5 marks)

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Question 5

Your client, ABC Pte Ltd, filed a PCT application on 28 November 2008 and has just received the International Search Report which was transmitted on 28 August 2009. The client is interested in entering national phase in several countries, and would like to take measures at the international phase, to ensure that the national phase filings will be as smooth as possible.

(a) He heard that there is a new procedure under the PCT to have a further search done by another search authority at the international phase. He would like to know if this is correct, and if so:

- by what date he should file the search request
- which authority carries out the additional search
- when the report will be established

(5 marks)

(b) The client also asks if there is a possibility to request for examination at the international phase. Advise by what dates examination has to be requested.

(4 marks)

(c) On reviewing the International Search Report, the client informs you that he needs to make some amendments to the claims, drawings and description. Advise whether such amendments are possible at the international phase and if so, explain:

- when the amendments may be made
- the scope of the amendments allowed

(7 marks)

(d) One of the countries of which the client wishes to enter national phase is Singapore. He wants to know the least costly method of obtaining the patent in Singapore and the deadline to proceed as such.

(4 marks)

THE END