INTELLECTUAL PROPERTY OFFICE OF SINGAPORE

Answer Guidelines to QE 2010 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

(a)

A divisional application may be filed at any time after filing of the parent application but before the parent application has been refused, withdrawn or abandoned and before all the conditions for grant are satisfied . S26(11)SPA, R27(1)(b) SPR, R27(1A) SPR.

(b)

Fast Track

1. File prescribed information relating to corresponding application by 42 months from actual filing date of the divisional
[S29(2)(c)(ii); R43(4)(b)]

The deadline is 30 December 2013

Slow Track

File block extension of time by non extendible deadline of 39 months from actual filing date of the divisional [S29(7); R47A(1)(a)(i)]

The deadline is 30 September 2013

2. Request search and examination by 39 months from actual filing date of the divisional application [S29(2)(b) SPA; R47A(2)(b)]

The deadline is 30 September 2013
3. Request examination together with search report of corresponding application by 39 months from actual filing date of the divisional application [S29(2)(c)(i); R47A(2)(b)]

The deadline is 30 September 2013
4. File prescribed information relating to corresponding application by 60 months from actual filing date of the divisional application [S29(2)(c)(ii); R47A(3)(b)]

The deadline is 30 June 2015

(c)

Pre-grant

(a) general power for applicant to amend the application of his own volition any time before payment of grant fee except
(i) after filing of request for search and before receipt of the search

report
(ii) after filing search and examination request and before receipt of the report
(iii) after filing request for examination and before receipt of that report
S31(3), R49(1), R49(2)

(b) no amendment allowed if it results in application disclosing any matter extending beyond that disclosed in the application as filed [s.84(2)]

Post grant

(a) general power for proprietor to amend the application anytime after grant [S.38]
(b)
- no amendment allowed if it results in specification disclosing any additional matter; or extends the protection conferred by the patent. [s84(3)(a) and (b)]

(d)

A patent shall cease to have effect at the end of the prescribed period if the renewal fee is not paid by then. S36(2).

The certificate was issued after 45 months from the date of filing, and hence the renewal deadline is 3 months from the issuance of the certificate. [R51(2)]. Renewal deadline is 1 March 2010.

There is a six-month grace period to pay the renewal fee (on payment of additional fee), whereby the patent will be treated as if it never expired. The deadline is 1 September 2010. [s.36(3)]

QUESTION 2

(a) s 68(1): In any proceedings for the infringement of a patent, where the subject-matter of the patent is a process for obtaining a new product, the burden of proving that a product is not made by the process shall be on the alleged infringer if the product is new or a substantial likelihood exists that the product is made by the process and the proprietor of the patent has been unable through reasonable efforts to determine the process actually used

If Krispy shows that the membrane can be found on the freshly fried crispy chicken, Krispy may argue that the membrane is a new product obtained by a process such that the burden shifts to Temasek Airlines and Agung Air

(b) s74(1): The holder of an exclusive licence under a patent shall have the same right as the proprietor of the patent to bring proceedings in respect of any infringement

Windsor Airlines and Asian Air are not exclusive licensees and so have no right to

	sue [*Note that because there are two licensees, they cannot be exclusive. There is no need to ask Krispy if the licences are exclusive.]*
(c)	<u>Relevant Aircraft</u> s 66(2)(d) provides a defence for the use of a product or process in the body or operation of a relevant aircraft which has temporarily or accidentally entered or is crossing Singapore (including the air space above it and its territorial waters) or the use of accessories for such a relevant aircraft; and 66(6) provides that "relevant aircraft" means an aircraft registered in, or belonging to, any country, other than Singapore, which is — (a) a party to the Paris Convention; or (b) a member of the World Trade Organisation The defence does not apply to Temasek Airlines as it would fly aircraft registered or belonging to Singapore The defence may apply to Agung Air as its aircraft would be registered or belong to Malaysia (a party to the Paris Convention and a member of the WTO) if use of the process occurs only when the aircraft is temporarily entering or crossing Singapore If candidates discuss whether the use of the process in the pantry of the aircraft would constitute "use of accessories" – the conclusion is not important.] <u>Innocence</u> s 69(1): 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 Arguably the 'defence' does not apply to Temasek Airlines as Krispy was trying to license the patent to Temasek Airlines for some time but was spurned The 'defence' might apply to Agung Air, but would cease to apply from the date Krispy's letter to Agung Air was received
(d)	s 77(4): Groundless threat proceedings may not be brought for a threat to bring proceedings for an infringement alleged to consist of making or importing a product for disposal or of using a process As the threat relates to the use of a process, groundless threat proceedings may not be brought
(e)	s 14(2) & (3): The state of the art shall be taken to comprise all matter which has at any time before the priority date of that invention been made available to the public (whether in Singapore or elsewhere); and a published application for another patent which was published on or after the priority date of that invention, if the following conditions are satisfied: (a) that matter was contained in the application for that other patent both as filed and as published; and (b) the priority date of that matter is earlier than that of the invention

	Searches will have to be made to see if the old Japanese application was published If it was published, it will need to be studied to see to what extent the Japanese application discloses Krispy's patent
(f)	s 69(4): Where an amendment of the specification of a patent has been allowed under any of the provisions of this Act, the court or the Registrar shall not, in proceedings for an infringement of the patent committed before the decision to allow the amendment, award any damages, make an order for an account of profits or grant any other relief (including, in proceedings before the court, an injunction) unless the court or the Registrar is satisfied that the specification of the patent as published was framed in good faith and with reasonable skill and knowledge Krispy must prove that that the specification of the patent as published was framed in good faith and with reasonable skill and knowledge, otherwise he will not be entitled to any remedy even if there is infringement

QUESTION 3

(a)
Issue 1 – Whether Mr. Takashi can file his PCT application directly with IPOS.

Article 10 of the PCT states:

"*The international application shall be filed with the prescribed receiving office, which will check and process it as provided in this Treaty and the Regulations*"

Rule 19.1(a) of the PCT Regulation states:

"…
(i) with the national Office of or acting for the Contracting State of which the applicant is a resident;
(ii) with the national Office of or acting for the Contracting State of which the applicant is a national; or
(iii) irrespective of the Contracting State of which the applicant is a resident or national, with the International Bureau."

Therefore when applying the above-mentioned rules, IPOS can only be the RO for citizens or residents of Singapore.

Based on the facts given, Mr. Takashi is neither a Singapore resident nor a Singapore citizen thus he is not eligible to file a PCT application directly with IPOS.

Issue 2 – Whether there are any alternative methods for Mr. Takashi to successfully file his PCT application.

Applying the above-mentioned rules, Mr. Takashi, a resident of Japan, may file his PCT application with Japan Patent Office as the RO as per Rule 19.1(a)(ii).

Alternatively, the PCT application may be filed directly with the International Bureau as per Rule 19.1(a)(iii).

(b)(i) Issue 1 – What are the deadlines and requirements for national phase entry in Singapore?
Article 22(1) of the PCT states: "*The applicant shall…not later than the expiration of 30 months from the priority date…*" Article 39(1) of the PCT states: "*If the election of any Contracting State has been effected prior to the expiration of the 19th month from the priority date, the provisions of Article 22 shall not apply to such state and the applicant…not later than the expiration of 30 months from the priority date.*"
Applying the above-mentioned rules, Mr. Takashi and Mr. Yama have until February 24, 2010 to enter national phase in Singapore.
Issue 2 – What are the required forms and fees for entry into Singapore?
According to Rule 86 of the Patent Rules, Patent Form 37 (entry into national phase under S.86(3) is required. According to Rule 90 of the Patent Rules, Patent Form 41 (declaration of authorization where an agent is appointed) is required
According to Rule 18 of the Patent Rules, Patent Form 8 (statement of inventorship and right to the grant of a patent) is required. No fees are charged for this form. However, where an application is an international application for a patent in Singapore, qualification may be given to the application as per Rule 18(3).
A copy of the published international application and any amendments made under Art.34 (e.g. description, claims, drawings, abstract). These documents will have to be translated into English. However, according to Rule 51bis.3 of the PCT Regulations, applicants may be allowed a period of not less than two months to comply with formality requirements such as providing a verification of translation of an international application. This is further supported by Rule 86(6)(a) of the Patent Rules which states that applicants are required to submit the required translation within two months from the date on which the Registrar's notice was sent to comply with formalities.
According to S.86(7) and Rule 86(7) of the Patent Rules, Patent Form 38 (request for publication of translation) is required This request is to be made as soon as possible to secure the rights conferred by the publication.
Advising client of the possibility of obtaining provisional rights due to potential infringer in Singapore.
(b)(ii) **Options available for this application:**
(1)

S.29(2)(e)(ii)

Mr. Takashi may rely on the positive IPRP results since all claims are novel, contain inventive steps and are industrially applicable. This option requires him to submit prescribed information by February 24, 2012 (i.e. 42 months from priority date of August 24, 2008).

Risk:

S.80(1)(c)

Mr. Takashi's patent application could be revoked as the specification of the patent does not fully disclose the invention clearly and completely to be performed by a person skilled in the art. This is indicated by the observations made by the Examiner in the IPRP which states that the claims are not fully supported by the description.

(2) Rule 41 of the Patents Rules which lists out the respective applicable patent offices.

Mr. Takashi may rely on the search and examination results of the corresponding Japanese patent application. This option requires him to submit prescribed information by February 24, 2012 (i.e. 42 months from priority date of 2 2008).

Risk: Prosecution of the Japanese patent application may delay and its search and examination report may not be issued on time for Mr. Takashi to rely on this option. This may require a block extension, which is contrary to Mr. Takashi's wishes.

QUESTION 4

(a)
Patent Rules Fourth Schedule paragraph 1(1)
If the performance of an invention requires the use of a micro-organism which is not available to the public at the time of filing the application, and which cannot be described in the specification in a manner which enables the invention to be performed by a skilled addressee, …

Patent Rules Fourth Schedule paragraph 1(2)
… a culture of the micro-organism must have been deposited with an international depositary authority able to furnish a sample of the micro-organism by the patent application date.

In view of the inclusion of the polypeptide and gargle associated with the micro-organism in the patent application, David/Jonathan should deposit a culture of the micro-organism at an international depository authority by the time of the application.

The specification must also indicate the name of the international depositary authority, the date when the culture was deposited and the accession number of the deposit.

Patent Rules Fourth Schedule paragraph 1(3)
If the specification does not so indicate as originally filed, it must do so by the earliest of 16 months from the priority date or before the applicant requests for early publication.

(b)

Section 19(2)(a)
A patent may be granted primarily to the inventor or joint inventors

David and Jonathan are joint inventors and are primarily entitled to become co-patentees

Section 19(2)(c)
The successor of person primarily entitled to be a patentee or (*b*) or any person so mentioned and the successor or successors in title of another person so mentioned

If the company is the assignee from David and Jonathan, it will be entitled to become the patentee in place of David and Jonathan

Section 49(1)
An employee's invention belongs to the employer under certain conditions (eg, if it was made in the course of the employee's normal or assigned duties if an invention might reasonably be expected to result from the duties)

Section 50(4)
The effect of Section 49(1) may be modified by agreement in relation to the right to an invention.

Depending on the duties of Jonathan in the university in relation to the work relating to the bacterium, the polypeptide and the gargle, and the agreement between Jonathan and the university …

… all or some or none of Jonathan's contribution to the subject matter of the patent may belong to the university which may entitle the university to thereby become a co-patentee with the company.

(c)
Section 47(1)
A person claiming proprietary interest in a patent may refer a question of proprietorship to the Registrar. The Registrar shall make a determination and make such orders as it deems fit to effect the determination.

Section 47(5)(a)
Unfortunately, the Registrar's discretion does not extend to ordering a transfer of the patent on the ground that it was granted to someone not so entitled.

Therefore, the university cannot request for transfer of the patent to the university whether partially or completely.

Section 47(4)
However, if there is a concurrent revocation action on the ground that the patent was granted to someone not so entitled, and the revocation so succeeds, the Registrar may order the rightful proprietor to file a new patent application which will be treated as having been filed on the same date as the revoked patent.

Revocation may be conditional in that some subject matter becomes excluded from the patent. If so, the Registrar may order the new application by the rightful proprietor to cover the excluded subject matter.

Section 47(5)(b)
No order for a new application may be made if the reference was made after 2 years from the grant date, unless a registered proprietor knew at the time that he was not entitled to the patent.

Based on the above, the university should within 2 years from grant of the patent, at the same time (1) refer the question of proprietorship for the polypeptide and (2) apply to revoke the patent partially in relation to the polypeptide on the ground that that part of the patent was granted to someone not so entitled.

QUESTION 5

(a)
What will happen If the final examination report is not issued by the grant fee deadline of 5 Nov 2010, there is no need to request extension of time.
The practice of the Registry is to treat this as a procedural irregularity under rule 100(2) and grant an automatic extension of time of 3 months from the date of mailing of the final examination report (not the date of establishment of the final examination report).

Implications/risks If the final examination report is issued after the grant fee deadline, any extension of time under rule 100(2) will be more than 3 months from the original grant fee deadline of 5 Nov 2010. As a result, under rule 109(1), the Registry will publish this fact in the patents journal and this will give rise to third party rights under rule 109(3), which might be detrimental to the client's interest.

Suggestion to avoid risk
Since none of the pending applications has been allowed, and if the final examination report cannot be mailed before the grant fee deadline, an option is to file a divisional application, request withdrawal of the examination request and to abandon the parent application to avoid the third party rights from accruing.

(b)
Can amend the claims? Rule 49(2)(b) - it is not possible to amend the claims at this stage because the final search and examination report has not been established.

How to amend? The only option is to write to the Registry to request withdrawal of the search and examination request and if the withdrawal is granted, then rule 49(2) does not apply, and we will be able to make the suggested amendments.

Problem with divisional With regard to the divisional, this may cause a double-patenting issue because the method claim and apparatus claim overlap in the sense that both claims contain the same patentable feature.

If the divisional application is filed before the grant fee payment, this will be pending when the grant fees for the parent is paid and the condition in section 30(3)(e) may not be satisfied and, the Registrar is not supposed to grant the parent application .

Suggestions
It is possible not to include the claims at time of filing the divisional and file the claims two months later)Rule 26(5)(b)) but the divisional will not be allowed to proceed to grant with the method claim, again because of section 30(3)(e).

The proposal would be for a Singapore divisional to be filed before the grant fee deadline incorporating both the US apparatus and method claims, and request local search and examination.