INTELLECTUAL PROPERTY OFFICE OF SINGAPORE
PATENT AGENTS QUALIFYING EXAMINATION 2010

PAPER D: KNOWLEDGE OF PATENT LAW AND PATENT PRACTICE IN SINGAPORE
7 October 2010, Thursday
1330 – 1730 hrs

Maximum Time: 4 Hours (includes reading time) Maximum Marks: 100

INTELLECTUAL PROPERTY
OFFICE OF SINGAPORE

INSTRUCTIONS TO CANDIDATES

1. This Paper consists of 11 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 Patent Cooperation Treaty (PCT) provisions.

End

5

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Question 1

Your clients, ABC Pte Ltd, filed a PCT application on 6 July 2008, claiming priority to a US application filed on 7 July 2007, and subsequently filed national phase applications in Korea and Singapore on 6 January 2010. The International Preliminary Report on Patentability (IPRP) indicates that the application lacks unity of invention and discloses two inventions – Invention 1: claims 1-15; Invention 2: claims 16 to 25. The IPRP also indicates that only the claims of Invention 1 were searched, and that Invention 1 was considered patentable.

(a) Dee, one of the directors of ABC Pte Ltd, informs you that he is interested in pursuing both inventions. He heard from his friend (who had filed patents before) that he could delete claims 16 to 25 from the Singapore national phase application and file a Singapore divisional application for Invention 2. Advise Dee on the legal basis for filing a Singapore divisional application and the deadline to do so. A discussion on prosecution of Invention 1 is not required, and no additional points will be awarded. (2 marks)

(b) Dee eventually instructed that a divisional application be for Invention 2 on 30 June 2010. At the same time, Dee informed you that due to budgetary constraints, he does not wish to incur any further cost on this matter until at least after the middle of 2012. Dee would like to know what all the options are, and the respective deadlines, for obtaining grant of this divisional application, under such circumstances. (10 marks)

(c) Dee tells you that he is now considering some modifications to the specification, and would like to know whether they should amend the specification now or after the grant of the patent. Advise Dee, for pre-grant and post grant amendments respectively: (i) the time period for making amendments; and (ii) the scope of amendments allowed. (5 marks)

(d) Dee informs you that several years ago, before he joined ABC Pte Ltd, the company had in fact filed a Singapore patent application for another invention, handled through another patent agent. Dee shows you a copy of the Certificate, which indicates that the patent was filed in Singapore on 2 February 2006, and the patent was issued on 1 December 2009. Today is 3 August 2010. He is wondering when the deadline for renewal is. Advise Dee on whether he can still renew the patent, and if so, what the deadline would be. (3 marks)

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Question 2

Krispy Kling owns a patent in Singapore, having its priority date as 6 September 2002. The claims relate to a process by which a method utilizing various heat sources at pre-determined temperatures and in a certain determined sequence manipulates the crystalline structures in the moisture in food resulting in a new crispy edible membrane that stays crisp for two hours; and the membrane created by this process.

As the process is suitable to be used in a passenger aircraft pantry, Krispy tried to market the invention to Singapore's high-class airline, Temasek Airlines, but he was spurned. Krispy finally licensed the use of the patent to Windsor Airlines (based in the United Kingdom). Passengers who could now enjoy what appeared to be freshly fried crispy fish and chips instead of the usual soggy variety cheered. Windsor Airlines was rewarded by winning significantly more market share. Quick to catch on and being more nimble in responding to the market demand, budget Asian Air (based in Brunei) also secured a licence from Krispy, and their revenues grew.

Krispy recently learned that Temasek Airlines and Agung Air (based in Malaysia) have started to offer what appeared to be freshly fried crispy chicken instead of the usual soggy variety on their flights.

Krispy wrote letters to Temasek Airlines and Agung Air exhibiting his patent, claiming infringement in respect of their use of the patented process and threatening to start legal action. Both Temasek Airlines and Agung Air say there were unaware of the patent, denied infringement and threatened to sue for the making of groundless threats. Krispy has come to you for advice.

(a) Krispy says that he has flown on Temasek Airlines and Agung Air to check out their crispy fried chicken and he is very sure that the crisp is made by his process but he had no access to the pantry to be sure. Can this problem be overcome? (3 marks)

(b) Krispy says that Windsor Airlines and Asian Air would also like to join in a suit against Temasek Airlines and Agung Air because they have seen decreased revenues. He wants to know if this can be done. (2 marks)

(c) Based on the above facts, what possible defences (with respect to both liability and remedy) might Temasek Airlines and Agung Air argue? (8 marks)

(d) How vulnerable is Krispy to liability for the making of groundless threats? (2 marks)

(e) Krispy discloses that he started studying water crystals when he was younger and had actually filed a patent application 30 years ago in Japan. Krispy believes that the application was withdrawn. The application papers were kept secret in a safe, and it was inspiration from these papers that he crafted his patent specifications. Is there a problem? (3 marks)

(f) Some post-grant amendments to the claims were just allowed. Assuming that both the original granted claims and the amended claims would be infringed and that the amendments are valid, Krispy would like confirmation that his claim against Temasek Airlines and Agung Air will not be affected. (2 marks)

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Question 3

(a) Your client, Mr. Takashi, is a Japanese inventor and is currently residing in Japan. He called and informed you that he has a new invention and hopes to protect it in several countries. He has heard of the PCT application. He wants to file a PCT application in Singapore and he seeks your advice. Mr. Takashi desires to file the application in his own name.

Please advise Mr. Takashi whether he may file the PCT application directly with the Registry of Patents in Singapore as the receiving office (RO). If not, please advise Mr. Takashi of the alternatives for filing a PCT application. (5 marks)

(b)(i) Mr. Takashi informed you later on that he and his partner, Mr. Yama, filed a Japanese patent application for their invention. The Japanese patent application was filed on August 24, 2008. Additionally, a PCT application was filed in Japanese with the Japan Patent Office on July 24, 2009. The PCT application claims priority from the Japanese patent application. The PCT application was published in Japanese.

Mr. Takashi indicated that a company in Singapore is making and selling a product which is the same as the subject matter described in the Japanese and PCT patent applications. Therefore, Mr. Takashi and Mr. Yama wish to seek protection for their invention in Singapore and appoint you as their agent in Singapore.

Please advise Mr. Takashi as to the deadlines and requirements for national phase entry into Singapore? Please provide your recommendations including the documents and forms required and any time limit applicable for submission of documents. Official fees do not need to be stated. (8 marks)

(b)(ii) Mr. Takashi inquired if there is any way to avoid incurring costs of having the application searched and examined in Singapore. He sent you a copy of the International Preliminary Report on Patentability (IPRP) for your reference. The IPRP shows that all claims appeared to be novel, to involve an inventive step and to

be industrially applicable. However, there are certain observations on the PCT application. The IPRP states that "…in terms of utility, the invention, as in the claims cannot be worked and are not fully supported by the description." He also told you that the search and examination report of the Japanese application has not yet been established.

Furthermore, Mr. Takashi does not want any extensions of time.

Provide your recommendations and advice on the deadline(s) which need to be met and any risks under the recommended course of action. (7 marks)

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Question 4

David and Jonathan were choir-mates throughout their school years. David's powerful tenor complemented Jonathan's dramatic baritone exquisitely. After graduating from the School of Bioengineering, Jonathan took up a research assistant job in a leading university and ended up investigating a new commensal laryngeal bacterium which enhances immune response to upper respiratory tract infection.

David became an overnight sensation in the third season of "Singapore's Got Talent". Having achieved widespread acclaim, David aspired to sing the part of Alfredo Germont in Guiseppe Verdi's famous work, *La Traviata*. Unfortunately, the magical C5 note (ie, C one octave above middle C) simply eluded him. Refusing to accept his lot in life, he put his Bioengineering degree to good use. After many months of toil, he designed an intra-nasal prosthetic insert which when activated would apply certain pressure on the superior nasal concha thereby liberating the posterior ethmoid sinuses for improved reverberation to hit C5. However, the device could not produce a note strong enough for David to deliver the climactic operatic endings of *La Traviata*.

A chance meeting at a karaoke allowed them to update each other about their latest pursuits. Jonathan believed his research could address the device limitations. Before long, in his university laboratory, Jonathan isolated from the bacterium a new polypeptide which enriched vocal timbre when applied onto the larynx. The polypeptide may be administered directly or as a suspension of the bacterium via a gargle.

David and Jonathan saw that they had a killer product for a hot market of under-achieving singers. They set up a company which filed a Singapore patent application claiming the device, the polypeptide and the gargle.

Through creative marketing, including a Youtube video of them performing a duet from *La Traviata*, their business became a great success. Shortly thereafter, they sold the patent application to a powerful Beijing opera house for S$50 million. Last we heard, David and Jonathan were singing their way to the bank.

Jonathan's research supervisor at the university came to know about the above events in the news and reported it to the university. The university did not notice the supervisor's report on this until after the application was granted as a single patent.

(a) If the bacterium was not available to the public at the time of filing the patent application, how should the invention be disclosed in the patent specification? Assume that no potential infringement exists. (5 marks)

(b) Comment briefly on the parties' entitlement to the patent. No discussion on the process of entitlement proceedings is required. (8 marks)

(c) The university has now decided that it wants to own a patent only for the polypeptide. Discuss what action the university may bring before the Registrar. No discussion on the process of entitlement proceedings is required. (7 marks)

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Question 5

On their own, the client filed a Singapore patent application on 5 May 2007 and then filed applications in Taiwan, USA, China and Malaysia claiming priority from the Singapore application before the convention deadline expired. The client paid the examination fees on 15 Aug 2008 for search and examination of the Singapore patent application. A written opinion was issued and you took over representation of the Singapore application and filed a response on 23 June 2010. You are still waiting for the next communication from the Examiner/Singapore Patent Office.

The client writes to you today (5 Oct 2010) particularly concerned that the final examination report has not been issued. He recalled one of your earlier letters indicating that the grant fee deadline is 5 Nov 2010.

Please advise the client based on the following scenarios:

(a) What happens if the final examination report is issued after the grant fee deadline? Is it necessary to request an extension of time for extending this deadline and if not, what are the implications/risks of the extension of time that would be detrimental to the applicant's rights? Any way(s) to avoid the risks? Assume that the client wants to rely on the Singapore examination report and not the corresponding applications. (8 marks)

(b) The Singapore application only has a single main claim:

> Apparatus for desalinating sea water to produce drinking water.

The client advises you that the corresponding US application (US parent) has been granted with the following single claim:

> Apparatus for desalinating sea water to produce drinking water having a pH value of 7 at 25°C.

A US continuation was filed before grant of the US parent with the following single claim:

> Method for desalinating sea water to produce drinking water having a pH value of 7 at 25°C.

The client wants you to amend the Singapore claims to follow the granted US parent and rely on the US parent for grant, and not wait for the Singapore final examination report. At the same time, the client instructs you to file a Singapore divisional with a claim exactly the same as the claim of the US continuation, and then pay the grant fees of the Singapore application before the grant fee deadline of 5 Nov 2010. Would you be able to proceed with the instructions of amending the claims, and pay the grant fee before the deadline (assume that the Registry has advised you that the final examination will not be established before the grant fee deadline)? Any possible problem of filing the divisional? Any suggestions to overcome?
(You are not expected to advise on the forms to use, the amount of official fees, or the formalities of relying on the US patent for grant) (12 marks)

END