INTELLECTUAL PROPERTY OFFICE OF SINGAPORE
PATENT AGENTS QUALIFYING EXAMINATION 2012

PAPER D: KNOWLEDGE OF PATENT LAW AND PATENT PRACTICE IN SINGAPORE
5 October 2012, Friday
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 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 Patent Cooperation Treaty (PCT) provisions.

End

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Question 1

XYZ Pte Ltd, a Singapore company, filed a PCT application on 3 March 2010 which was eventually published as WO 2011/66778. Subsequently, they filed national phase applications in the US, Japan and Singapore on 1 August 2012. The International Preliminary Report on Patentability (IPRP) indicates that the application lacks unity of invention and discloses 3 inventions (Invention 1: claims 1-10; Invention 2: claims 11 to 15; Invention 3: claims 16 to 20). All 3 inventions were searched.

(a) Zee, your ex schoolmate, just joined XYZ Pte Ltd, and has been tasked to manage this matter for the company. He approaches you to ask what all their options are, and the respective deadlines, for obtaining grant of the application in Singapore. He has also asked, specifically, whether they can rely on the results of the IPRP or the examination outcome of his US and Japan applications. (10 marks)

(b) After considering the various options, Zee informed you that he is interested in relying on the IPRP to obtain grant of the patent. He would also like to amend the claims to conform to that which they are proceeding with, in the US, before the payment of the grant fee.

(i) Advise Zee on the legal implications of the finding that the application lacked unity of invention, and the steps that he should take to address this issue. (5 marks)

(ii) Assuming that Zee can make the amendments now, advise Zee on the issues he should consider at this stage. (5 marks)

Please include all supporting references to the relevant provisions in the Patents Act and Rules, in your answers.

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Question 2

A) One morning, you arrived at the office and received an email from your client, Perfect Solutions Pte Ltd, saying that they approved of the patent application that you have drafted. The email also said that they want to file the PCT application immediately because they will be interviewed by the TV station this weekend to discuss their new software invention which would change everyone's lives! However, they said that their funds will only arrive about 2 weeks later and they cannot afford to pay you yet. They would like to meet you in the afternoon to negotiate if you can file the PCT application first and for them to pay the fees later.

In preparation for the meeting, please prepare notes to advise if it is possible to pay the PCT fees late. Your answer should name the type of fees payable, but there is no need to specify the amount. (4 marks)

B) Assume that you proceeded to file the PCT application and the PCT application named three inventors, with Perfect Solutions Pte Ltd as the applicant. A few weeks have passed and the client comes to you saying that they want you to do two things immediately:

i) they note that a passage in the Summary section of the PCT application does not correspond exactly to claim 1. From a previous meeting, you have informed them that that passage should be exactly the same. So they would like you to amend that page accordingly (for avoidance of doubt, the inconsistency between Claim 1 and the Summary section cannot be considered an obvious error).

You checked the file and noted that the International Search Report was just established two weeks ago and the PCT application has not been published.

Please advise the client if you are able to carry out his instructions, and if not, when is the earliest opportunity for you to do so during the international phase. Your answer should include to which International Authority you should be making the request. (B(i) 5marks)

ii) they have executed an assignment to transfer the rights of the PCT application to Imperfect Solutions Pte Ltd for a substantial sum. They want you to record the assignment immediately but do not wish to provide you with a copy of the assignment document.

Please advise the client if you are able to carry out his instructions, and if you need to submit any evidence. Your client will also want to know how he would know that the assignment has been recorded. Your answer should include to which International authority you should be making the request. (B(ii) - 4 marks)

C) With the assignment, Perfect Solutions Pte Ltd informed you that you should take instructions from Mr Clumsy, the CEO of Imperfect Solutions Pte Ltd. Weeks and months past and as a responsible patent attorney, you attempted to contact Mr Clumsy regarding upcoming deadlines and also sent reminders to him. However, you did not receive a reply and thus, no action was taken to enter the national phase of the PCT application.

Today, 5 Oct 2012, you received a facsimile from Mr Clumsy saying that they wish to get protection in Singapore based on the PCT application. You checked the history of the file and note that the 30-month deadline was 1 June 2012.

Advise the client if you can meet his wishes, and what he must do. Also, advise him of any implication even if he can file the Singapore national phase application late. Note that there are no marks allocated for mentioning or discussing the fees payable. (7 marks)

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Question 3

Alpha's business was the manufacture and exploitation of the patented weight loss product, LargestLoser. Alpha decided to sell his business to Beta, including all the manufacturing and distributions capabilities, but ownership of the patent remained with Alpha and he insists on this. As part of the transaction, Alpha signed a licence agreement with Beta with respect to the patent. The licence agreement was called "**Exclusive Licence to LargestLoser**" and dated 1 June 2012. The intention was for Beta to completely take over the business and to have full rights to the patent, however, just in case, the license agreement included a clause that Alpha retained the right to exploit the patent as well. Of course, Alpha did not exercise that right. There was no interaction with the Registry of Patents. The transaction completed smoothly and Beta took over the business seamlessly such that sales were never interrupted at all.

Beta has now come to you upon learning of an infringing product sold by Omega called MonsterLoser. Alpha would prefer to sip tea in the private island purchased with the proceeds of the sale, and does not wish to be involved.

(a) Please advise Beta on whether he has the right to sue for infringement, and if not, what can be done to ensure that he has the right. (5 marks)

(b) Assuming that Beta has a right to sue for infringement, Beta suspects that the MonsterLoser product might have actually been on the market since the beginning of 2012. Please advise Beta on whether Beta can sue for the sale as far back as that. (4 marks)

(c) Advise on the nature of damages, the applicable damages and measure of damages that Beta would be entitled (no marks will be awarded for discussing the other reliefs). Beta would also like to know whether he can recover the damages suffered by Alpha. (5 marks)

(d) Beta asks whether paying the damages will mean that Omega can continue with the infringement. Advise. (2 marks)

(e) Beta expects that Omega will claim ignorance. What do you need to ascertain from
5 the client and why? (4 marks)

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Question 4

Leticia hailed from humble beginnings. Through street smarts and clever spotting of examination questions, she obtained a science degree. She took up the job of a lowly technician for a centrifuge supplier due to the limited job market. To broaden her career choices, Leticia attempted the Patent Agents Qualifying Examinations on 3 occasions but has not been successful.

Her company assigned her to provide on-site technical support on centrifuges supplied to a research institute. Being a sweet-talking and outgoing sort, Leticia was well liked by the staff at the research institute. Leticia often helped Jacques, a research scientist to sort and compile his poorly organized research notes. Jacques was investigating the magnetic properties of anisotropic nanoelements having elliptical geometries. Months later, Jacques' research team achieved a breakthrough in determining optimal conditions which promoted the reconfiguration of these nanoelements into hollow tear-drop shapes with properties ideal for forming ultra-thin high tensile sheets. The potential was limitless. Leticia jokingly called these reconfigured nanoelements nano-nooses or simply "the noose" and the name stuck.

Leticia assured the research institute that she can help to patent the noose at a low cost. Leticia's GCIP friend, Adrianna, had become a registered patent agent and was running her own practice. Leticia approached Adrianna for help since she has yet to qualify and convinced Adrianna to charge the research institute a discounted fee for a PCT application for the noose if Leticia were to prepare all the necessary documents. The cost incurred by the research institute was indeed significantly lower than market rate and Leticia received a small fee from Adrianna for her efforts. The PCT application was filed with IPOS as receiving office. On the application form (PCT/RO/101), Leticia filled in both Adrianna's name and her name as agents. The form was signed by Adrianna.

Within 3 months of the PCT application, the research paper was published to great academic acclaim. Further research at that time disclosed a new application of the noose in relation to bullet-proof coatings. Leticia advised the research institute that the PCT application had to be re-filed to take into account the new capabilities of the noose.

Adrianna was instructed to re-file the PCT application and the same arrangement was made with Leticia.

A notice (PCT/IB/372) was submitted to IPOS to withdraw the existing PCT application. However, because Leticia was busy with her 4th attempt at the Patent Agents Qualifying Examinations, she could not find time to prepare the new PCT application. When queried by the research institute, Adrianna covered up for Leticia and assured that the new PCT application has been filed, in her mind thinking that a priority claim to the earlier PCT application would address any complications arising from Leticia's delay. 11 months and 28 days after the earlier PCT application, the research institute realized that the new PCT application had not yet been filed.

a) Discuss the offences Leticia may have committed. (7 marks)

b) Discuss the effectiveness of the PCT/IB/372 filed above. (5 marks)

c) As Adrianna was away on holiday at the relevant time, it was Leticia who signed and submitted the PCT/IB/372. Discuss. (3 marks)

d) Briefly discuss a basis under which the research institute may take the matter up with the Registrar of Patents against Adrianna and identify potential consequences. (5 marks)

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Question 5

Atley is a Singapore entrepreneur and inventor. He filed a patent application first in Singapore for a new laser marking apparatus for marking electronic packages. Shortly after filing the Singapore patent application, he filed a timely request for search and examination at IPOS.

Six months after filing the request for search and examination, his friend informed him about a brochure from a US competitor, Laser System Inc.'s ("LSI's"), concerning a similar laser marking apparatus. LSI also sold laser systems in Singapore. The disclosure in LSI's brochure was very detailed regarding the functions of LSI's competing laser marking apparatus. However, Atley realized at this point that the brochure for LSI's laser marking apparatus described a function of Atley's laser marking apparatus which was mentioned in but not claimed in Atley's Singapore patent application as filed. He had previously considered this function to be background information only and so did not see the need to claim it.

(a) (i) When can Atley amend the Singapore patent application to cover the function of the competing laser marking apparatus which had not been claimed? What are the consideration(s) before you would advise Atley to make the amendment prior to grant of the patent? (6 marks)

(ii) Would these considerations change if Atley wishes to defer amending the patent until after its grant? Should Atley amend the patent before or after its grant, and why? (3 marks)

Since the competitor was based in the US, Atley filed a corresponding US patent application within 12 months of the filing date of the initial Singapore patent application, claiming priority from the Singapore patent application. In this US patent application, Atley included only claims to the function which was not originally claimed in the Singapore patent application. The Singapore claims were not included in the US patent application.

About 18 months after the filing of the Singapore patent application, the patent application was published in Singapore. He read in an IP newsletter that his rights started from publication of his patent application. In an attempt to discourage the US competitor from further copying his invention and to gain recognition for his invention, Atley published on the website of his company, Atlee's Laser Equipment Pte Ltd, that a Singapore patent application had been filed for his laser marking apparatus invention, that the patent application had been granted by IPOS and that he would not hesitate to take infringement action against any competitor that copied his patent.

(b) What issues arise from Atley's perceptions and conduct in the above scenario? (Note: Damages need not be discussed) (6 marks)

A search and examination report was subsequently established in respect of the request for search and examination in Singapore based on the originally-filed claims. Despite his best efforts, Atley notes that the search and examination report was established on the basis that all the claims of the Singapore patent application lacked an inventive step, although the invention as claimed was novel and industrially applicable. Meanwhile, Atley informs you that the claims contained in the US patent application were allowed.

(c) What are the options now for Atley to proceed to obtain a patent for his invention in Singapore? Please note that you do not need to discuss any procedural issues dealing with timelines and extensions of time. (5 marks)

End