INTELLECTUAL PROPERTY OFFICE OF SINGAPORE

Answer Guidelines to QE 2012 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.

General Instruction:

SPA = Singapore Patents Act

SPR = Singapore Patents Rules

S = Section (as in SPA)

R = Rule (as in SPR)

SG = Singapore

PF = Patents Form

Art = Article

- Citation of section, rules etc. carries only a small portion of the total marks. No candidates can pass merely by reciting whole chunks of section and rules.
- If a candidate provides an explanation and analysis to the question but does not state the legal basis that leads to the explanation and analysis, then the candidate will be penalised up to half the marks awarded for that question.
- Examiners should always bear in mind that what is being judged is the fitness of the candidate to advise the public and this may influence borderline cases one way or another.

QUESTION 1

(a)

Fast Track

1. Yes, may rely on the IPRP. File a notice to rely on the IPRP by 42 months from the PCT filing date
[s29(2)(e)(ii); R43(4)(a)]

The deadline is 3 September 2013.

Slow Track

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

The deadline is 3 June 2013.

2. Request search and examination by 39 months from PCT filing date [S29(2)(b) SPA; R47A(2)(a)]

The deadline is 3 June 2013.

3. Request examination together with a copy of the International Search Report and a copy of each of the documents referred to in the ISR, by 39 months from PCT filing date [S29(2)(e)(i); R47A(2)(a)]

The deadline is 3 June 2013.

A "Corresponding Application" refers to an application filed with a prescribed patent office that (a) forms the basis for a priority claim in the application in suit; or (b) is subject to a priority claim based on (i) the application in suit; or (ii) an application which is also the basis for a priority claim in the application in suit. [Section 2 (1)].

As the PCT application does not have a priority claim, the US and Japan applications cannot qualify as "Corresponding Applications". Hence, it is not possible to rely on the outcome of the US and Japan applications.

(b) (i)
It is one of the conditions for grant that the IPRP does not disclose any unresolved objections on the ground that there is lack of unity of invention. [S30(3)(a)]

Advise Zee to amend the claims, by deleting claims 11 to 20.

Advise Zee to file two separate divisional applications for Inventions 2 and 3.

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) (ii)

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

It is a condition of grant that if the applicant relies on an international preliminary report on patentability that each claim in the application at the time the prescribed documents for the grant of the patent were filed and the prescribed fee for the grant of the patent was paid is related to at least one claim in the application at the time the report was issued

(i) which has been examined; and
(ii) which is referred to in the report.

[S30(3)(b)]

A claim is related to another claim if –

(i) the two claims are identical; or
(ii) each limitation in the second claim –
    (A) is identical to a limitation in the first claim; and
    (B) differs from a limitation in the first claim only in expression but not in content

[s.2(4)]

QUESTION 2

A) Possible to file PCT international application first and pay PCT fees later.

3 fees payable:

(1) transmittal fee

Legal basis – PCT Regulations Rule 14.1(c)

(2) international filing fee

Legal basis – PCT Rule 15.3

(3) International search fee

Legal basis – PCT Rule 16.1(f)

All 3 fees must be paid within 1 month of the receipt of the international application by the receiving office.

B) Amendment of description

- Not possible to amend description at this stage, can only amend the claims
- PCT Article 19(1)

When can you amend description?
- Earliest possible opportunity to amend description is at time of filing a Demand for International Preliminary Examination, under Art. 34(2).

The authority to write to is the International Preliminary Examination Authority for amending the page.

B) Assignment

Possible to record the assignment under PCT Rule 92bis.

- Need to file with the International Bureau a request for recordal of change in person of applicant (or a request to record the assignment from Perfect Solutions to Imperfect Solutions)
- No evidence/supporting documentation is needed
- Once change effected, the IB will issue a notification (IB/306) to confirm the change.

C)
Still possible to file request for extension of time to enter national phase late:

Patents Rules, Rule 108(4)

- Since it is still within 42 months of the priority date, the Registrar would grant the extension if he is satisfied that the delay was unintentional.
- Rule 108(4A)

- File PF46 together with statutory declaration to provide the evidence
- Rule 108(4)(b)

- If extension granted, the implication is that as the extension of time would be more than 3 months, third party rights may accrue under 109(3).

QUESTION 3
a) Section 2(1) & 74(1) "exclusive licence" means a licence from the proprietor of or applicant for a patent conferring on the licensee to the exclusion of all other persons including the proprietor 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 of the patent committed after the date of the licence Beta has no right to sue for infringement because the agreement is not an exclusive licence in substance and thus Beta is not an exclusive licensee Solution is to either amend the licence or execute a fresh licence such that there is no reservation of right to the proprietor
b) Section 41(7): an exclusive licence granted under any patent may confer on the licensee the right of the licensor to bring proceedings for a previous infringement Yes it is possible and it will depend on the terms of the licence because the right to sue for past infringement can be expressly granted in the exclusive licence Section 75: provides penalty that exclusive licensee will not be awarded damages for a subsequent infringement occurring before the date of recordal of the license unless the license is recorded with the Singapore Patent Registry within 6 months of its date Advise Beta to register the licence within the time
c) Damages is compensatory in nature It is to put the injured party as far as possible in the same position as he would have been if he had not sustained the wrong

Section 74(2) states that damages is assessed by taking into account the loss suffered or likely to be suffered by the exclusive licensee so far as it constitutes an infringement of the rights of the exclusive licensee

The damages suffered by Alpha is not recoverable by Beta

The measure of damages is the profit which would have been realized by Beta (as a manufacturer) if the sales had been made by him

d)
Damages does not 'frank' the infringing article as legitimate because it does not condone any subsequent infringements

e)
Section 69(1): No award of damages or account of profits will be given who proves that at the date of infringement, he was not aware and had no reasonable grounds for supposing that the patent existed

The word 'patent' or 'patented' is insufficient unless the number of the patent is also stated

You need to ask whether the patent number is stated on the product or on its packaging

You need to ask whether notice has otherwise been given to the infringer of the patent

QUESTION 4

a)
Section 105(1), (4) & (8)

A person cannot act as a patent agent unless he is a registered patent agent who has in force a practicing certificate.

Doing the following in Singapore on behalf of someone else for gain is taken to be acting as a patent agent:

- Applying for a patent in Singapore or anywhere

- Preparing documents for the purposes of the doing so

Contravention is an offence carrying a fine of up to $5,000 and/or up to 12 months imprisonment

Circumstances which indicate Leticia has committed the offence are:

Leticia is not a registered patent agent and received a fee in preparing the PCT application.

She identified herself as a patent agent on PCT/RO/101.

Filing and signing PCT/IB/372

b)
PCT Rule 90bis.1 & Rule 90.4 or 90.5

The PCT application may be withdrawn within 30 months from the priority date. Withdrawal is effective on receipt of the PCT/IB/372 to the IB or RO.

An applicant may appoint an agent by signing the PCT/RO/101 request, or a separate power of attorney.

An RO may waive the requirement to submit a power of attorney. Singapore has waived the requirement to submit a power of attorney.

However, such waiver does not apply to the submission of any notice of withdrawal. The withdrawal is potentially defective as no power of attorney was filed.

c)
PCT Rule 90.1(a)

Only a person having the right to practice before the RO may be appointed as “agent”.

The PCT/IB/372 is potentially defective because Leticia does not have the right to practice

before the RO and could not have been appointed as agent.

d)

Rule 15A & Schedule 5 of the Patents (Patent Agents) Rules 2001

A registered patent agent with a practising certificate in force must comply with the Code of Conduct. Disciplinary proceedings may be taken against Adrianna for has contravening the Code of Conduct.

Adrianna may potentially have contravened the Code of Conduct (candidate is required to identify only 1 of the following):

- Paragraph 3(1)(b) – A registered patent agent is responsible for any work sanctioned by him. Adrianna sanctioned Leticia's work and is responsible for Leticia's work
- Paragraph 4 – A registered patent agent who engages any other person to act on behalf of a client must ensure that person is qualified and has the requisite expertise. Adrianna in engaging Leticia to act on behalf of the research institute must ensure that Leticia is qualified and has requisite expertise
- Paragraph 5(3) – A registered patent agent shall not be fraudulent or deceitful.

  Or

  Paragraph 12(1) – A registered patent agent should not engage in any conduct or practice which is misleading or deceptive to any person.

  Adrianna lied to the research instituted that the new PCT application has been filed when it hasn't

- Paragraph 7(a) – A registered patent agent should not permit his professional independence and integrity to be undermined by a referrer.

  Or

  Paragraph 7(b) – A registered patent agent should not pay any commission or other consideration, or otherwise reward the referrer.

Adrianna paid Leticia a service fee for the referral of the research institute

A complaint may be made against Adrianna under Rule 17(1) of the Patents (Patent Agents) Rules (candidate is require to identify only 1 of the following):

- Paragraph (b) – fraudulent or grossly improper conduct in carrying out his professional duties

- Paragraph (d) – allowed any person who is not a registered patent agent to carry out any patent agency work in his name where that person is not under his direct or immediate control or supervision

- Paragraph (g) – conduct unbefitting a member of the profession

The disciplinary committee may reprimand, suspend up to 12 months, cancel Adrianna's registration as a patent agent or make such other appropriate order.

QUESTION 5

a)

(i) Voluntary amendments may generally be made at any time before payment of fee for grant

s 31(3) read with Rule 49(2)

However, amendments may not be made after filing of a request for search and examination report, and before receipt of the report – Atley must wait for issuance of the written opinion or search and examination report

Rule 49(2)(b)

The amendment must not introduce new matter extending beyond that disclosed in the patent application as filed

s 31(3) read with s 84(2)

(ii)After grant, applications to amend may be made to the Registrar, but the amendment must not result in the specification disclosing any additional matter or extend the protection conferred by the patent s 38(1) read with s 84(3) Hence, since the addition of a claim could be extending the scope of protection, the amendment should be made pre-grant
b) As from the publication, the applicant shall have the same right to damages as he would have had if the patent had been granted on the date of the publication of the application, but the applicant is only entitled to bring proceedings after the patent has been granted. s 76(1) and s 76(3) Atley has committed the offence of making an unauthorised claim to patent rights because publication of the patent application does not mean that patent application has been granted s 99(1) No groundless threats action from the threat to “take infringement action” because there is no specific party aggrieved by the threat s 77(1)
c) Self assessment – may pay the fee for grant although the claims do not meet the requirements for patentability because conditions for grant have been met – search and examination report has been received s 30(2)(b)(ii) Cannot rely on the US grant without amendment under s 29(2)(d)(ii) because the

Singapore and US claims are different s 30(3)(c) May amend the claims to correspond to the US granted claims to rely on the US grant under s 29(2)(d)(ii) **OR** File a divisional application and amend the claims to correspond to the US granted claims to rely on the US grant under s 29(2)(d)(ii)