

Answer Guidelines to QE 2013 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)

Patents Form 41 – Declaration of authorization when agent is appointed

To be filed on the first occasion Sally acts on behalf of the applicant – r. 90(2)

Patents Form 8 – Statement of Inventorship

Identify the inventors and indication of derivation of rights

s. 24(2), and r. 18(1A)

Within 16 months from priority date - r. 18(1)

Provide application or file numbers of priority applications

s. 17(2)

Within 16 months from declared priority date – r. 9B(1)

<p>b)</p> <p>s. 14(4): Paper read before learned society less than 12 months before filing is disregarded – disclosure was made shortly before Malaysian filing 11 months ago</p> <p>s. 14(5): “Learned society” should be a club or association constituted in Singapore or elsewhere</p> <p>A seminar attended by speakers and delegates may not comprise a club or association</p> <p>Sally need not do anything as the disclosure is automatically disregarded if the disclosure is made before a learned society</p>
<p>c)</p> <p>s. 80(1) sets out the only instances where validity of a patent may be put in issue</p> <p>Cannot seek declaration of validity of a patent only</p> <p>s. 82(2)</p> <p>In the circumstances, the third party may only apply for revocation of the granted patent under s. 80</p>
<p>d)</p> <p>Patent Agent must supervise unqualified personnel, even if personnel is experienced</p> <p>Rule 3(2), Patents (Patent Agents) Rules, Fifth Schedule</p> <p>Patent Agent may not act for client before the Court. Sally should refer the matter to another person if it is outside her expertise</p> <p>Rule 2(1) & 2(5), Patents (Patent Agents) Rules, Fifth Schedule</p>
<p style="text-align: center;"><u>QUESTION 2</u></p>
<p>a)</p> <p>A copy of the specification is not available to the public as the application has not been published. The 18 month period has not yet expired.</p> <p>Section 27(1), Rule 29(1)</p> <p>OR</p> <p>Prior to publication, it is possible to obtain a copy of the patent specification from IPOS with the consent of the Applicant.</p> <p>Section 108(2)</p>
<p>b)</p> <p>Provisions under pre-grant: It is a condition of grant that there is no other patent application or earlier grant of a patent for the same invention having the same priority date filed by the same applicant or his successor in title</p>

Section 30(3)(e)

Provision under Post grant_ A patent may be revoked under the Patents Act if the patent is one of 2 or more patents for the same invention having the same priority date and filed by the same party of his successor in title.

Section 80(1)(g)

However, in this case, a Second application will be filed on a different date and therefore will **not** have the same priority date as the earlier application. Technically, It may be possible to obtain the grant of a Second Application, putting aside issues of novelty and prior art.

c)

An inventor has the right to be mentioned in any patent granted for the invention.
(Section 24(1))

It would depend on whether the ex- Partner contributed to the Invention. If he did contribute to the invention, he cannot be removed as inventor. From the facts provided in the question, since the ex-Partner has contributed to the Invention significantly, it is not likely that his contribution can be excluded from the claims and therefore he must be named as inventor.

(i)

If Mr Hazy insists on removing his ex-Partner's name, then he may apply to remove the name of the inventor using Form 7.

Rule 17(1)

It is not possible for Mr Hazy to apply to remove Crafty as inventor without alerting him. Upon receipt of the application, the Registrar shall send the application and statement of facts to every application and inventor. Hence, Crafty will be informed of the application. (Rule 17(2))

d)

Can the US application be used in SG Prosecution?

Section 29(2)(c) read with Section 2(1) of the Patents Act

Mr Hazy cannot rely on the US application in the prosecution of the Singapore patent application as there is no priority link between the US and Singapore patent application and therefore they do not qualify as corresponding applications.

Prosecution options available on the Singapore patent application

Option 1: File request for search and examination separately

Section 29(2)(a)

File request for search report

Deadline to request search report is 13 months from the date of filing ie 15 August 2013

Rule 38

Section 29(4)

File request examination report

Deadline to request examination is 21 months from the date of filing ie 15 April 2014

Rule 43 (1)(a)

Option 2: File request for combined search and examination

Section 29(2)(b)

Request search and examination

Deadline to request examination is 21 months from the date of filing ie 15 April 2014

Rule 43 (1)(a)

QUESTION 3

a)

Section 71(1)(a) provides that a person who in Singapore before the priority date of the invention does in good faith an act which would constitute an infringement of the patent has the right to continue to do the act or, as the case may be, to do the act, notwithstanding the grant of the patent.

Section 71(1)(a) would apply to Naeve.

Section 71(3)(b) provides that if the act was done in the course of a business, the person entitled to the right conferred by subsection (1), ie., Naeve, may assign that right to any person who acquires that part of the business in the course of which the act was done.

Section 71(3)(b) would apply to the sale of Naeve's business and right to Heng in 2006, and cover Heng.

Section 71(4) provides that where a product is disposed of to another in exercise of the rights conferred by subsection (1) or (3), that other and any person claiming through him may deal with the product in the same way as if it had been disposed of by the registered proprietor of the patent.

Section 71(4) would apply to Ranjit and the retailers who would claim their right from Heng.

It does not matter that Heng stopped production between 2007 and 2013 because of the words "he has the right to continue to do the act or, as the case may be, to do the act" in section 71(1)(a).

Heng, Ranjit and the retailers did not infringe the Patent.

Note: No marks if 'defence' of innocence is discussed – because such 'defence' is only

to remedy, not infringement. No marks if the exclusive rights are discussed because it is superfluous here – it should only be discussed in answer for (b). No marks if rights-from-publication is raised because publication only took place in 2008, so the issue does not arise from the production in 2007, and irrelevant to 2013.

b)

Section 71(2) provides that the right conferred by section 71(1) shall not extend to granting a licence to another person to do the act.

Neither Su Wai nor Nu Vic can rely on Heng's right under section 71 to avoid infringement.

Section 66(1)(b) provides that there is infringement where a person uses the process or he offers it for use in Singapore when he knows, or it is obvious to a reasonable person in the circumstances, that its use without the consent of the proprietor would be an infringement of the patent.

Su Wai manufactured Kling in Singapore, and as such he committed the acts of using the process or offering to use the process in Singapore.

Nu Vic did not commit any act of infringement under section 66(1)(b) because the manufacture took place in Vietnam.

If Su Wai and Nu Vic were unaware of the Patent, they can argue that it is not obvious to a reasonable person in the circumstances that use without the consent of the proprietor would be an infringement.

The reasonable circumstance they can raise is the prior production by Naeve and Heng.

Further, as Nu Vic is based in Vietnam, Nu Vic has an additional reasonable circumstance to raise.

Section 66(1)(c) provides that there is infringement if a person disposes of, offers to dispose of, uses or imports any product obtained directly by means of a patented process or keeps any such product whether for disposal or otherwise.

As Su Wai never had title to the produce of his manufacture, Su Wai did not commit any act set out in section 66(1)(c) / **(alternate answer or bonus)** Su Wai is arguably an agent of Heng, and not a 'licensee' as defined in the Patents Act, and as such the protection afforded to Heng would apply.

As Nu Vic's retail website takes international orders, including from Singapore, there is arguably an act of offering to dispose in Singapore.

As Nu Vic has delivered some orders to customers in Singapore, there is an act of disposing in Singapore.

QUESTION 4

a)

The routes to grant which Xeanon Inc may adopt are available under the fast track or the slow track. However, since Xeanon Inc wish to have as much time as possible, they are advised to proceed by any of the routes under the slow track.

Xeanon Inc may also consider filing a divisional application, in order to have more time to adopt a route to grant.

[* **Note to Examiner:** This bonus point will only be given if candidate mentions filing of divisional application in addition to proceeding by slow track. Otherwise, no point will be given.]

To transfer to the slow track, Xeanon Inc must file a request for block extensions of time by 39 months i.e. 26 February 2014

- Section 29(7), Rule 47A(1)(a)(i)

This deadline is non-extendible.

- Rule 108(2)(a)

After transferring to the slow track, Xeanon Inc may proceed by any of the following routes:

(1) File request for search and examination by 39 months i.e. 26 February 2014

- Section 29(2)(b), Rule 47A(2)(a)(i)

(2) File request for examination together with copy of International Search Report (or Search Report of a corresponding application) and cited documents, by 39 months i.e. 26 February 2014

- Section 29(2)(c)(i), Rule 47A(2)(a)(i)

(3) File Notice of Intention to Rely on the IPRP by 60 months i.e. 26 November 2015

- Section 29(2)(e)(ii), Rule 47A(3)(a)(i)

(4) File prescribed information relating to a corresponding application by 60 months i.e. 26 November 2015

- Section 29(2)(c)(ii), Rule 47A(3)(a)(i)

A “corresponding application” has been defined in Section 2(1) as an application filed with any prescribed patent office that is subject to a priority claim based on an application which is also the basis for a priority claim in the application in suit.

Since national phase applications have been filed in Korea, Europe and Japan, and each of these claims priority from the same US priority application as claimed in the Singapore national phase application, each will qualify as a “corresponding application”. Hence, Xeanon Inc is able to rely on the Korean application or the European application (provided it is filed in English) or the Japanese application to proceed to grant, by filing prescribed information relating to any one of these applications.

b)

Rule 51(1) – renewal application and fee must be filed by the 4th or succeeding anniversary of the date of filing.

Section 36(2) – patent shall cease to have effect at the end of the prescribed period for payment of renewal fee if not paid within that period.

Renewal fees should be paid on or before 7 June 2004 & 7 June of each succeeding year until expiry. As the renewal fee for 2012 was not paid, the patent would have lapsed after 7 June 2012.

Section 36(3) – renewal fee and additional prescribed fee can be paid within 6 months

after lapse of the patent.

However, as it has been more than 6 months since the patent lapsed, it is not possible for Vivien to pay the renewal and additional prescribed fees now.

Section 39(1) - Vivien can try to apply for restoration of the patent.

Rule 53(1) - The restoration application must be filed within 30 months from the day the patent ceased to have effect.

In this case, application must be filed before 30 months from 7 June 2012 i.e. by 7 December 2014.

Section 39(5) - Vivien must show that she took reasonable care to see that any renewal fee was paid within the prescribed period or that the renewal fee and additional fee were paid within the 6 month grace period.

QUESTION 5

(a)

PCT Article 9(1): Any resident or national of a Contracting State may file an international application.

Taiwan is not a PCT Contracting State therefore ASER cannot file on its own a PCT application.

PCT Rule 18.3: If there are two or more applicants, the right to file an international application shall exist if at least one of them is entitled to file an international application.

Accordingly, the PCT application can be filed naming ASER as a co-applicant together with another co-applicant who is a resident or national of one of the Contracting States.

The other party should be applicant for one of the states where it is unlikely that national phase will be completed

(b)

PCT Article 19(1): The applicant shall, after having received the international search report, be entitled to one opportunity to amend the claims of the international application by filing amendments with the International Bureau within the prescribed time limit.

PCT Article 34(2)(b): The applicant shall have a right to amend the claims, the description, and the drawings, in the prescribed manner and within the prescribed time limit, before the international preliminary examination report is established.

Amendments under PCT Article 19 can only be made to the claims.

Since ASER wishes to amend the description as well as the claims, the desired amendments can only be effected via Article 34 of the PCT.

ASER will therefore have to file a Demand for International Preliminary Examination under PCT Article 31(1): On the demand of the applicant, his international application shall be the subject of an international preliminary examination.

PCT Rule 54bis1(a) A demand may be made at any time prior to the expiration of whichever of the following periods expires later: (i) three months from the date of transmittal to the applicant of the international search report; or (ii) 22 months from the priority date.

The deadline for filing the Demand in this instance is 1 Apr 2015.

(c)

ASER will have to submit Patents Form 37
and indicate on the form that early national phase entry is being requested

SPR 86(2)

PCT Article 21(2)(a): The international publication of the international application shall be effected promptly after the expiration of 18 months from the priority date of that application.

The PCT application has not yet been published since it has only been about 8 months since filing.

SPA 86(3)(b)(i): The national phase of the application begins when the applicant expressly requests the Registrar to proceed earlier with the national phase of the application, pays the prescribed fee and where, at the time of the request, the application has not been published in accordance with the Patent Co-operation Treaty, file at the Registry a copy of the application.

SPA 86(6)(b)(i): Where, during the international phase, the application is amended in accordance with the Patent Co-operation Treaty, the amendment shall be treated as made under this Act if, and shall be disregarded unless where the applicant expressly requests the Registrar to proceed earlier with the national phase of the application, there is then filed at the Registry a copy of the amendment, if none has been communicated to the Registry in accordance with the Treaty.

ASER will therefore have to submit with the Patents Form 37: (a) a copy of the PCT application
and (b) a copy of the amendments that were filed during the international phase