

INTELLECTUAL PROPERTY OFFICE OF SINGAPORE
PATENT AGENTS QUALIFYING EXAMINATION 2013

PAPER D: KNOWLEDGE OF PATENT LAW AND PATENT PRACTICE IN SINGAPORE

**4 October 2013, 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. Type/Write your answers in English. Answers in any other language will not be marked.
For candidates who opted out from laptop examination: Answers in illegible handwriting will not be taken into consideration.
3. One hardcopy of the question paper is provided, for your reading and for your use (optional) when answering the question(s) in the Answer Script/Answer Booklet(s). For candidates who opted out from laptop examination: You are given two hardcopies of the question paper.
4. Only your answers and/or drawings to the question(s) typed/written or indicated/glued in the Answer Script/Answer Booklet(s) provided by the Examination Secretariat will be considered. For candidates who opted out from laptop examination: You are to write on one side of each sheet in the Answer Booklet(s).
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

When Sally was a trainee Patent Agent, she was asked solely to assist in writing up technical specifications for incorporation into draft patent specifications during her training, due to her strong literary and engineering background and her firm's heavy workload. Unfortunately, she did not have time to participate in the filing of patent applications which she helped to prepare. Sally recently passed her Qualifying Examinations and became a registered Patent Agent. Being of an entrepreneurial spirit, she soon started her own patent practice, Sally Patent Agency.

(a) Her first client was David, who approached her to file a patent application at the Intellectual Property Office of Singapore ("IPOS") in the name of his company, ACC Sdn. Bhd. ("ACC"). He was both a co-founder and director of ACC. The patent application was based on an invention developed by ACC's Malaysian employees, and for which a Malaysian patent application was filed first. Sally did not think of asking David for the details of the Malaysian patent application. As Sally was unfamiliar with patent filing procedure, she left it to her staff, Carol, to conduct the filing. Carol had worked for 3 years previously as a clerical assistant to a Singapore Patent Agent, and had assisted in filing dozens of patent applications in Singapore. The patent application was filed at IPOS together with Patents Form 1, the full patent specification and the filing fees about a month before the expiry of the Paris Convention deadline. The Paris Convention deadline has now expired.

It was only after the Paris Convention deadline expired that Sally reviewed the documents filed and did some research on filing a Paris Convention application in Singapore because Carol had resigned by then. She discovered that Carol had not submitted certain information at the time of filing. What other forms and related information apart from the aforesaid might/should Carol have also submitted at the time of filing under the Patents Act and Rules? (Note that it is not necessary to address the late filing of documents or to correct errors in the filing.) Please also provide the deadlines for providing such information, and bear in mind that David had not decided on which search and examination option to select at the time of filing.

(9 marks)

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(b) David disclosed to Sally that, shortly before the Malaysian patent application was filed, he attended a scientific seminar inviting speakers and delegates from all over the world, during which he gave a talk disclosing the invention. Is there anything Sally needs to do now to ensure that the invention is not invalidated by the disclosure? **(4 marks)**

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(c) After the grant of the patent application, a third party filed a motion in the Singapore High Court seeking only a declaration that the granted patent is invalid. Until he received notice of the motion filed, David had never heard of this third party before. David asks for Sally's advice, and for her to represent ACC in the invalidation proceedings. Being hungry for work, Sally accepts gratefully. Please comment on the merits of the motion filed by the third party. **(3 marks)**

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(d) Based on the above facts, did Sally contravene any provisions of the Code of Conduct? **(4 marks)**

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QUESTION 2

Environment Solutions Pte Ltd is a medical supplies company ("**the Company**"). The founder, Mr Hazy has developed a novel surgical mask which traps minute particles, and protects against airborne viruses more effectively than existing surgical masks in the market ("**the Invention**").

Mr Hazy filed a patent application on **15 July 2012** in Singapore in the name of the Company ("**the Singapore patent application**"). He recalls this date as it is also the date of incorporation of the Company. However, as he has been very busy with his business, he has forgotten to check up on the Singapore patent application. He was also distracted by a bitter dispute with his ex-Partner, Crafty, who has since left the Company.

He is still trying to locate his file with all the correspondence and the patent application as filed. Recently, an investor has expressed interest in buying over the Company, but on the condition that there is patent protection over the Invention.

Today is 1 August 2013. Mr Hazy has come to see you, as the patent agent he instructed earlier is no longer contactable. He has no idea of the status of the Singapore patent application. He instructs you that from his hazy recollection, he only filed in Singapore as he was short of funds at that time.

a) He wants to know today, the scope of protection of the Invention in the Singapore patent application. Are you able to obtain a copy of the patent specification from the Intellectual Property Office of Singapore? **(2 marks)**

b) Mr Hazy is very cautious and likes to cover all bases. As a precaution, he asks whether you can file and obtain grant of a second patent application in Singapore and for the same Invention with identical claims ("**a Second Application**"), in the name of the Company, in case you cannot locate the earlier application filed. You can assume that a Second Application would be filed afresh, with no priority claim.

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Putting aside issues of novelty and prior art, advise Mr Hazy whether it is permissible to obtain grant of a Second Application for the same Invention, and inform him of the relevant provisions in the Patents Act (covering pre-grant and post-grant). **(5 marks)**

- 5 **c)** The next day, Mr Hazy comes to see you excitedly as he has located his file, with full details of his Singapore patent application. It is indeed filed in the name of the Company, but in the course of looking through the papers, he is dismayed to find that Crafty is listed as an inventor. He asks whether he can remove Crafty's name as inventor from the Singapore patent application since he is no longer involved in the Company. Mr Hazy admitted that
- 10 Crafty did contribute significantly to the invention, and without this, the surgical mask would never have been effective in trapping the minute particles.

Fortunately, Mr Hazy was careful to obtain an assignment of rights in the Invention from Crafty to the Company, but because of the bad blood between them, he wants to remove all

15 traces of his name from the Singapore patent application.

Please advise in your opinion, whether Crafty may be removed as inventor from the Singapore patent application. Mr Hazy also wants to know which form must be filed with the Intellectual Property Office of Singapore to remove Crafty's name, and whether he can do so

20 without alerting Crafty of this request.

[Note to candidates: No discussion is required on procedure under the Patent Rules].

(4 marks)

- d)** Upon review of Mr Hazy's voluminous papers, you discover that the previous patent
- 25 agent had also filed another application for the Invention using the same specification in United States, also on 15 July 2012 ("**the US application**"). Section 34 security clearance was also obtained prior to the filing of the US application, and no reference is made to the Singapore patent application on the US application form.

30 Mr Hazy wants to rely on the US application for the prosecution of the Singapore patent application as he believes it will carry more weight and assist his Singapore patent application.

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Based on the above facts, please advise as follows:

- i. Whether Mr Hazy can use the US application in the prosecution of the Singapore patent application. **(2 marks)**
- ii. What prosecution options are available for the Singapore patent application, and what are the applicable deadlines? **(7 marks)**

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Please do not consider options which involve any extension of time. You do not need to refer to the form or fees to be paid.

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QUESTION 3

Naeve's Singapore business started making and selling Kling in 2003. Kling is a non-stick film that can be applied to pots and pans. In 2006, Naeve sought to retire but his good friend
5 Heng wanted to continue with the business, so Naeve sold the business to Heng. Heng continued the business until 2007, then because of price pressures caused by the dumping of competitive products from desperate rivals in Shenzhen brought on by the global financial crisis, Heng changed the production line to a different product.

10 In 2013, Heng realized that Kling was super-easy to apply on computer and mobile devices to render the screens bubble-free, smudge-proof, scratch-proof, non-reflective, shatter-proof and unbelievably smooth to touch. Heng then re-started production of Kling and the market response was euphoric. Consumers realized that the tactile feel of the Kling-treated screens was like a newborn's soft skin and very pleasing. Heng sells all his stock to Ranjit, a
15 wholesaler, who then re-sells to retailers.

In 2009, a process patent was granted to Dollah by IPOS with a priority date in 2006 and which was published in 2008 ("**Patent**"). The Patent claims cover what is performed by Heng in manufacturing Kling.

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(a) Leaving aside any attack on the validity of the Patent, did Heng, Ranjit and the retailers infringe the Patent? Does it matter that Heng stopped production between 2007 and 2013?
(8 marks)

25 Heng also entered into two license agreements. First, there was a license agreement with Su Wai solely to manufacture Kling in Singapore. Heng supplied all the raw materials to Su Wai and Heng retained legal title to all the produce. This was to meet the incredible demand because Heng could not ramp up his own production fast enough.

30 Second, Heng entered into a license agreement with Nu Vic. Nu Vic was allowed to manufacture and sell Kling in Vietnam. Nu Vic also has a retail website hosted in Vietnam

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where he takes international orders. Nu Vic has delivered some orders in Singapore to customers in Singapore.

- (b)** Leaving aside any attack on the validity of the Patent, did Su Wai and Nu Vic commit acts of infringement of the Patent? **(12 marks)**
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QUESTION 4

(a) Xeanon Inc had filed a PCT international application on 20 October 2011, designating Singapore, and claiming priority from their application in the USA filed on 26 November 2010. Xeanon Inc then filed an application for entry into the Singapore national phase on 29 April 2013. Applications for entry into the national/regional phases of India, Korea, China, Europe and Japan were also filed. As Xeanon Inc is now observing the Singapore market response to their new product, which is the subject matter of the patent sought, they wish to have as much time as possible and delay prosecution of their Singapore national phase application so they may consider all their options. Bearing in mind Xeanon Inc's intentions, please advise them on the various ways in which they may progress their Singapore application towards grant, also stating clearly the applicable deadlines. **(14 marks)**

(b) Vivien had secured grant of a Singapore patent some years ago. In recent years, however, as she has been working in Beijing, she has found patent annuities tracking to be quite a challenge. During a short home break in Singapore this month, she found a letter from the Registrar of Patents notifying that the renewal fee for her patent was overdue. Vivien's Singapore patent was filed on 7 June 2000 and granted on 3 July 2002. Vivien vaguely recalls that the last time she paid the renewal fee for her patent was in 2011. As she did not return to Singapore in 2012, she believes that the 2012 renewal fee was probably not paid. Please advise Vivien today on whether she can still pay the renewal fees now since she thinks there is some grace period for late payment or advise her as to how she may try to maintain her patent in force. **(6 marks)**

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QUESTION 5

5 **(a)** ASER, a Taiwanese company, approaches you for assistance in first filing a PCT application for one of their inventions. All the inventors are Taiwanese nationals and resident in Taiwan. Please advise how ASER can be named as an applicant on the PCT application form. **(4 marks)**

10 **(b)** You filed a PCT application for ASER on 1 Jun 2013 with no claim to priority. The International Search Report mailed on 1 Oct 2013 has been received. ASER now tells you that they wish to amend the description and claims of the PCT application. Please advise ASER on the possible avenues for amendment during the international phase, provide your recommendations with reasoning and advise on the deadline for proceeding. Please also cite the relevant legal provisions. **(8 marks)**

15 **(c)** The amendments have been filed and it is now 1 Feb 2014. ASER now tells you that they wish to effect national phase entry in Singapore as soon as possible as they would like to obtain a Singapore patent for their invention soon. Please advise on the documentation that should be furnished to the Intellectual Property Office of Singapore, citing the relevant legal provisions. **(8 marks)**

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End