

Answer Guidelines to QE 2014 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.

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)

A patent for an invention may be granted primarily to the joint inventors – s 19(2)(a). The joint inventors are Eenie, Meenie and Miney.

However, s 19(2)(b) set out exceptions that are in preference to s 19(2)(a): the patent may be granted to any person or persons who, by virtue of any enactment or rule of law, or by virtue of an enforceable term of any agreement entered into with the inventor before the making of the invention.

s 49(1)(a) set out an applicable enactment or rule of law that an invention made by an employee shall be taken to belong to his employer if the invention was made in the course of the normal duties of the employee or in the course of duties falling outside

his normal duties, but specifically assigned to him, and the circumstances in either case were such that an invention might reasonably be expected to result from the carrying out of his duties.

This applies to Eenie and Meenie as they were employees of Mr Goe, and it was part of the business and work that they discussed and tweaked the chicken feet recipe.

Further, Meenie had entered into such an enforceable term of any agreement entered into with the inventor before the making of the invention to assign the invention through the letter of appointment.

Miney was not an employee of Mr Goe. So the co-owners of the patent application are Mr Goe and Miney.

b)

A signature is only required for an assignment of a patent or any such application – s 41(6). In this case, the assignment is for any *invention*, so the formality of Meenie's signature is not required and there is no change to the answer for (a).

Alternative for (mark) is if candidate answers that there is no change and relies on s 49(1)(a) only.

c)

Either s 19(2)(c), that the patent may be granted to the successor or successors in title; **OR** s s 41(3), that any patent or any such application or right shall vest by operation of law in the same way as any other personal property and may be vested by an assent of personal representatives.

Eenie and Meenie are now co-owners with Mr Goe by virtue of Miney's will.

Under s 42(2)(b) read with s 43(3)(d), the death of Miney as one of the proprietors of the patent application and the vesting by an assent of personal representatives of a patent application or any such right is a registrable event affecting rights in or under

patent applications.

As co-owners now, Eenie, Meenie and Mr Goe each has an equal undivided share in the patent application – s 46(1).

d)

Toh could apply to court for the grant of a compulsory licence on the ground that the grant of the licence is necessary to remedy an anti-competitive practice: s 55(1) and (2).

An anti-competitive practice can be shown if there is a market for the patented invention in Singapore; that market is not being supplied or is not being supplied on reasonable terms; and the proprietor of the patent has no valid reason for failing to supply that market with the patented invention, whether directly or through a licensee, on reasonable terms.

Toh will have to prove that there is the untapped demand, that it is not being supplied, and that the high price sought for a licence is not reasonable.

QUESTION 2

a)

Rule 43(1)(a) - Request for search and examination of application to be filed within 21 months from declared priority date (i.e. by 13 January 2012).

Other prosecution options can be taken subsequently.

b)

13 July 2013 is the Slow Track deadline.

Rule 47A – Request for search and examination of application may be filed within 39 months from declared priority date (i.e. by 13 July 2013), but must be filed together with request under Section 29(7) to extend the 21month period to 39 months.

Form 45A

Fee of \$1,800

c)

Form CM1

d)

Other prosecution options:

Rule 41 – patent office of US is in the list of patent offices prescribed for the purposes of the definition of “corresponding application.

Section 29(2)(c)(i) – can file copy of the search report of the US application and request examination of the application [by 39-month deadline (13 July 2013) together with extension request].

Section 29(2)(c)(ii) – can file examination report of the US application [by 42-month deadline (i.e. by 13 October 2013)].

e)

Rule 44 – information “which is sufficient to indicate the result of the corresponding application”, which may be proof of the patent granted by the USPTO, or “other documents, to the satisfaction of the Registrar, setting out the final results of the search and examination as to the substance and a copy of the patent claims referred to in the final results” and the IPC symbol.

Rule 43(4) – positive examination results of the US application must be filed within 42 months from the declared priority date (i.e. by 13 October 2013), but with Form 45A filed, the 42-month deadline is extended to 60 months (i.e. 13 April 2015.)

f)

Yes. Section 26(11) - by 60-month deadline (i.e. by 13 April 2015)

g)

divisional application filed on or after 14 February 2014 will be subject to amended Patents Act and Patents Rules.

(per Rule 96(2)(b) of Patents (Amendment) Rules 2014 S81/2014, but point can be awarded even if specific rule not cited)

Rule 42A of amended Patents Rules:

- i. Form 12A instead of Form 11B,
- ii. Claims Table.

Rule 43(3) of amended Patents Rules – to file request for supplementary examination report within 54 months after actual filing date of divisional application.

Notes to Examiners:

No additional points to be awarded -

Rule 46(1A),(3),(4A) - Written opinion may be issued by Registrar to which applicant may file response in Form 13A with written submissions and/or amendments within 3 months after date of Registrar's letter forwarding written opinion. Assumption that the Singapore application is in exact conformance with the US application is meant to remove any objection as to relatedness, so that possibility of issue of written opinion need not be discussed here.

Rule 46(8) - Supplementary examination report will be issued within 6 months.

Rule 47(1) – file Form 14 to request for grant of patent within 2 months after date of notice of eligibility to proceed to the grant of patent.

QUESTION 3

a)

Candidate to Identify relevant section in PA on infringement and types of acts of infringement involved

- Relevant section: section 66(1)(a) PA
- Acts of infringement: making, selling, disposing, offering to sell, dispose, using, or keeping for sale or disposal.

** Candidate should identify minimally the acts of making and selling (or disposal) to get the mark*

b)

Candidate to identify options to stop infringement and relevant section in PA.

- Sue for infringement, apply for interlocutory injunction and send cease & desist letter

** Where candidate fails to identify all the options, examiner to award marks*

- Relevant section: Section 67- permanent injunction, declaration of validity, order for damages, disposal of infringing articles.

** Where candidate fails to cite section 67 or identify all the remedies, examiner to award marks*

c)

Candidate to identify relevant section in PA

- Relevant section: section 76(1) PA: right to claim damages for patent (as published) from date of publication (June 2012).
- Relevant section: section 76(3) PA:

d)

Candidate to identify section and grounds to resist infringement and explain basis

Relevant Section: Section 80(1) PA

- **Challenge patent for validity**

- ✓ **novelty** (sale of ProtecTop in US in Dec 2011 and FoamAroma in June 2011)

- *mark for each novelty destroying act*

- ✓ **inventive Step** (prior art: sale of FoamAroma cup in June 2011)

- **non-literal infringement** of claims

** no claim construction required. Candidate only needs to suggest possibility based on pictures.*

- **prior use:** Section 71: right of Easycup to continue use begun before priority date.

e)

Candidate to state that it is possible to issue and identify relevant section for groundless threats.

Relevant section: Section 77 PA

Exceptions in section 77(4): Easycup makes cups, so no groundless threats if the allegation/demands in the letter refers only to the act of making an infringing product.

f)

Candidate to identify section.

Relevant section: s74(1) PA – exclusive licensee has right to sue. No need to join in patentee.

Or

Relevant section: s74(3) PA – exclusive licensee has right to sue. No need to join in patentee.

g)

Candidate to identify section and explain.

Relevant section:

Section 67(1)(c) PA – patentee can claim loss of licence fee as damages.

Section 74(1) PA - BTH can claim damages as exclusive licensee.

The damages claimable by Patentee and BTH would be an amount to put Patentee and BTH as far as possible in the same position as they would have been if Easycup did not commit the infringement. For patentee, damage is loss of 3% licence fee. For BTH, damage is loss of sales.

Relevant section: 74(2) PA – BTH's loss of profits as a result of Easycup's infringing activities, or an account of the profits made by Easycup.

Relevant section: Section 69(1): Cannot claim innocence because of actual knowledge of Patent by the ex-employee .

Section 69(2) PA: Patent number imprinted on lid, so this section will not help Easycup avoid damages.

QUESTION 4

A first option would be to wait for issuance of the final examination report since a request for search and examination has been filed and a search and examination report is expected that can be used to meet the SGPA Section 30(2)(b) requirement.

As the statutory grant fee deadline of 7 Oct 2014 has passed and the final examination report has not been received, the Registrar will grant an extension of time under SGPR Rule 100 to pay the grant fees when the final examination report finally issues.

However, according to SGPR Rule 109, where the Registrar has granted an extension of time of more than 3 months under SGPR Rule 100 in such circumstances, the Registrar shall publish in the journal a notification of his decision and where such a notification has been published, a person who availed himself, or took definite steps by way of contract or otherwise to avail himself, of the invention and the subject of the application for the patent concerned by reason of the act or step in relation to which the extension was granted not having been done or taken within the time allowed shall have the right to continue to avail himself of the invention.

In other words, it is possible for third party rights to accrue if nothing is done at this juncture.

A second option would be to place reliance on the IPRP for grant under SGPA Section 29(2)(d)(ii) since all claims have been found novel and inventive in IPRP

However, the IPRP contains a lack of unity objection and according to SGPA Section 30(3)(a), one of the conditions for grant is that the IPRP must not disclose any unresolved lack of unity of invention objection or if any such objection is disclosed, the applicant must satisfy the Registrar that the objection has been resolved.

Therefore, some of the claims on file will have to be cancelled from the application to address the lack of unity objection before the grant formalities can be completed. However, this is not desirable as there would be loss of protection.

A third option would be to place reliance on the acceptance of the US patent application for grant of the Singapore patent application under SGPA Section 29(2)(c)(ii)

since the final results of search and examination that are required under SGPR Rule 44(1)(a)(ii) in the form of the US Notice of Allowance have been received.

However, because the claims as allowed in the US are not of the same scope as those pending in his Singapore patent application,

a request for a voluntary pre-grant amendment will need to be filed under SGPA Section 31(3)

to conform the pending claims to those as allowed in the US

in view of the related claims requirements under SGPA Section 30(3)(c).

The recommendation would be to go with the third option to prevent a possible accrual of third party rights if the first option is proceeded with and the loss of some protection if the second option is proceeded with.

However, the deadline of 7 Oct 2014 to file the prescribed information relating to the corresponding US patent application under SGPR Rule 43(4) and the statutory grant fee deadline of 7 Oct 2014 under SGPR Rule 47(1) have passed.

Therefore, a one-month extension of time has to be requested in respect of each of these deadlines under Rule 108(3) in order to proceed.

Additionally and in order to prevent the possible accrual of third party rights, the earlier filed search and examination request must also be withdrawn to prevent the grant of an extension of time of more than 3 months under SGPR Rule 100.

QUESTION 5

a)

Section 34(1)

No Singapore resident shall file a patent application outside Singapore unless a patent for the same invention has been filed at IPOS not less than 2 months before

The facts suggest that Astrid & Hiccup were residents of Singapore.

Therefore, they have contravened section 34(1) by filing a Malaysian application for the Night Fury nano-braid within 2 months of the Singapore application of 4 July 2014.

Section 34(3)

Any person who files an application in contravention of this section shall be liable on conviction to a fine not exceeding \$5,000 or to imprisonment for a term not exceeding 2 years or to both

Section 103(1) read with Section 2 Patents (Composition of Offences) Regulations

Offences under section 34(1) are compoundable by payment of a fine not exceeding \$2,000

b)

Section 25(3)

An application shall contain a request for the grant of a patent, a specification containing a description of the invention, a claim or claims and any drawing referred to in the description or any claim, and an abstract. Section 25(3) does not prevent an application from being initiated.

Section 26(1)

The date of filing shall be taken to be the earliest date on which the documents filed to initiate the application indicate that a patent is sought, identify the applicant, and contain something which appears to be a description of the invention.

The drawings and notes on the napkin arguably contain something which appears to be a description of the invention and identified Astrid and Hiccup as applicants.

Since an online application was successfully submitted, the documents filed to initiate the application would likely have indicated that a patent is sought.

Therefore, the date of filing accorded to the Singapore application should be 4 July 2014.

c)

Section 17(1), (2), (2A)

The priority date of an invention to which an application relates is the date of filing the application or the date of a relevant earlier application filed if the application was filed within 12 months of the relevant earlier application.

Since priority was not claimed in the 2nd Singapore application before the amendments, its priority date would have been 8 July 2014.

Rule 9(1)

As a general rule, a declaration of priority must be made at the time of filing the application.

Rule 9(2)

A declaration may be made after the filing date if it is made within 16 months from the claimed priority date on Form 57 together with the prescribed fee. The applicants must also not have requested for early publication, or such request must have been withdrawn.

Since the declaration was made by way of amendment but not on Form 57 with a prescribed fee, the declaration is ineffective and the priority date remains as 8 July 2014.

d)

Section 105(1) and (4)

An individual shall not apply for patents or prepare patent specifications on behalf of someone else in Singapore for gain unless he is a registered patent agent, or an advocate and solicitor, who has in force a practising certificate

OR

Section 105(2) and (4)

A partnership shall not apply for patents or prepare patent specifications on behalf of someone else in Singapore for gain unless at least one partner is a registered patent agent, or an advocate and solicitor, who has in force a practising certificate.

Section 105(8)

A person who contravenes this section is guilty of an offence liable to a fine not exceeding \$5,000 or to imprisonment not exceeding 12 months or to both.

Gobber and Toothless are not registered patent agents but carried on business, practice or acted as a patent agent in Singapore. They have likely committed an offence under Section 105(1), unless either Gobber or Toothless is an advocate and solicitor who has in force a practicing certificate.

OR

Gobber and Toothless are not registered patent agents but carried on business, practice or acted as a patent agent in Singapore. Gobber Toothless & Co has likely committed an offence under Section 105(2), unless either Gobber or Toothless is an advocate and solicitor who has in force a practicing certificate.

Sections 105A(1) and (4)

A registered foreign patent agent may apply for patents outside of Singapore on behalf of someone else in Singapore for gain.

It did not matter that Gobber is a registered foreign patent agent. Only registered patent agents or an advocate and solicitor, who has in force a practising certificate, may apply for patents or prepare patent specifications on behalf of someone else in Singapore for gain.