

INTELLECTUAL PROPERTY OFFICE OF SINGAPORE
PATENT AGENTS QUALIFYING EXAMINATION 2014

PAPER D: KNOWLEDGE OF PATENT LAW AND PATENT PRACTICE IN SINGAPORE
10 October 2014, Friday
1330 – 1730 hrs

Maximum Time: 4 Hours (includes reading time)

Maximum Marks: 100



INSTRUCTIONS TO CANDIDATES

1. This Paper consists of 12 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. Candidates should not change the format of the Answer Script or type in the margin. 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

Eenie's first job was to be employed in Mr Goe's new start-up selling chicken feet under the brand name, "Roosters". When Eenie's younger sibling, Meenie, was of age to enter the job market, Eenie convinced Meenie to work for Mr Goe as well.

Mr Goe had in the meantime attended an intellectual property seminar at IPOS and had decided that employees should have a written appointment contract, and the contract should have a clause where employees assign any invention made that is related to the business to Mr Goe. So Meenie was issued with a letter of appointment. Eenie never received a similar document.

From time to time, Eenie, Meenie and Mr Goe discussed and tweaked the chicken feet recipes, but no particular improvement of note was achieved.

Eventually, the youngest and most indulged of the siblings, Miney, grew up and the siblings discussed whether Miney should also join Mr Goe's business. Miney wanted to remain independent and procrastinated.

One day, while the siblings were at home together and a little tipsy, they came up with some fairly wild ideas. One of the ideas involved using the dryer, and they concocted a process to create chicken feet that had a thin, crispy and puffy skin with a juicy and gelatinous interior. It was amazing.

When they brought it to Mr Goe, Mr Goe wisely decided to file a patent application.

(a) Who should be the owner of the patent application? **(8 marks)**

(b) If the letter of appointment did not have Meenie's signature, does this change your answer? Why? **(3 marks)**

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- (c) Unfortunately, Miney was a tad too indulgent in imbibing food and passed away. Miney's estate was willed to be shared by the remaining siblings. What happens to the ownership of the patent application? Is it registrable? What is the nature of the ownership share? **(6 marks)**

5

- (d) The patent was granted and sales went through the roof. An entrepreneur, Toh, saw vast untapped demand and proposed to obtain a licence to open more sale outlets. However, after some negotiation, Toh felt that the price for the licence was way too high. Short of agreeing to the price sought, is there anything else Toh can do to get a piece of the pie? **(3 marks)**

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QUESTION 2

John Oh entrusted Jane to file a Singapore patent application for him in 2011. She was obviously young but John liked her enthusiasm and decided to work with her. Now that it
5 has been almost 4 years and he has been given no assurance that the patent will soon be granted, he is having serious doubts if he made the right choice. Anyway, John recently found out that Jane left her patent firm around middle of last year.

John brought his own records on the patent application and has instructed you to take over
10 the patent application from Jane's previous firm. After looking through John's records, you have noted the following:

- i. The patent application was filed with the Singapore Registry on 12 April 2011 with
15 priority claimed from a US application filed on 13 April 2010.
- ii. An email from Jane to John dated 5 July 2011 read:

Dear John,

We note that priority was claimed from your US patent application that was filed on
20 13 April 2010.

Kindly let me know when the search report or examination report on the US application is available as you may be able to use these to obtain grant of your
25 Singapore application.

Yours sincerely,

Jane Seah

Right Choice IP Pte. Ltd

- 30 iii. An email dated 10 December 2011 from Jane to John in which Jane asked John to instruct her by 10 January 2012 if he wanted her to file request for search and

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examination. It stated that if he did not instruct by then, she would assume he did not wish to file the request at this time.

- iv. An email dated 3 March 2013 from Jane to John asking if search report or examination
5 report on the US application were available.
- v. A letter dated 10 June 2013 from Right Choice stated that unless John instructed
10 otherwise before 13 July 2013, they would file request for search and examination for the Singapore application.
- vi. A letter from Right Choice stating that request for search and examination has been filed
on 13 July 2013 with the Singapore Registry.

John told you he did not understand why Jane asked about the US application. As he had
15 not received any news of developments in the US application, he did not reply to Jane's queries.

John has asked for your answers to the following:

- 20 (a) Why did Jane mention filing request for search and examination at the end of 2011 and what did Jane mean by "she would assume he did not want to file the request *at this time*"? **(2 marks)**
- 25 (b) What is the significance of the 13 July 2013 date in Right Choice's letter of 10 June 2013 and why was the tone so different – they said they would file the request if he did not instruct otherwise? What additional form and fee must have been filed for the request for search and examination filed in July 2013 to be in order? **(2 marks)**
- 30 (c) What form must you file with the Registry to take over the application? **(1 mark)**

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- (d) Why did Jane ask for the search report or examination report of the US application in March 2013? **(5 marks)**

5 Today is 10 October 2014. John said he just heard that the US application has been examined by the USPTO. He has made some amendments and believes that grant may be issued within the next 12 months.

- 10 (e) What information/documents must John obtain on the US application in order to obtain grant of the Singapore application? By when? **(3 marks)**

- (f) If John fails to obtain the information/documents on the US application in time, can he file a divisional application? By when? **(1 mark)**

- 15 (g) Briefly discuss the differences in procedures, timelines and information when using the US final examination results in the divisional application as compared to using the US final examination results in the current Singapore application (if it were available in time)? For this question, assume the Singapore application is in exact conformance with the US application. **(6 marks)**

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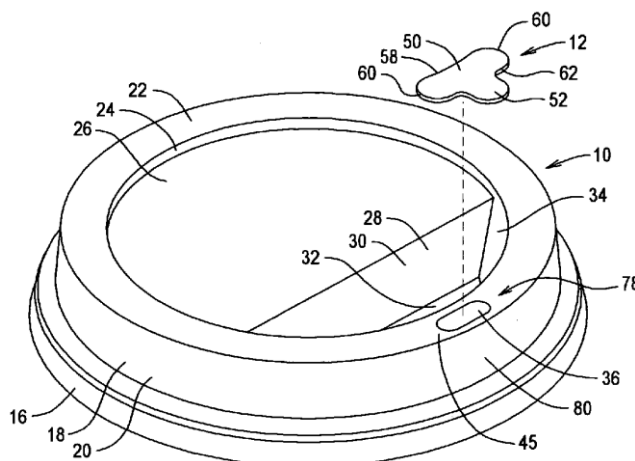
Maximum Marks: 100

QUESTION 3

- i. A company called BTH Supplies Pte Ltd (“BTH”) comes to see you to discuss an issue with a competitor company. The following information was given by the client to you.

Background Facts

- ii. BTH is a company that manufactures disposal beverage containers for commercial use by food and beverage outlets.
- iii. It obtained an exclusive licence from a US company for making and selling the coffee cup lid in Singapore and duly registered the licence within the prescribed time of 6 months. The coffee cup lid is protected by a Singapore patent (“the Patent”) owned by the US company.
- iv. The Patent only has 1 claim and was filed on 2 January 2012, published on 2 June 2012 and granted on 2 December 2013. There is no priority claimed nor priority filing.
- v. The drawing of the invention is reproduced below:



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- vi. BTH sells its coffee cup lid under the brand “ProtecTop”. The lid was first sold in the US in early December 2011 by the Patentee. BTH was the first company to sell the ProtecTop lid in Singapore in June 2012.
- 5 vii. BTH supplied the ProtecTop coffee cup lid to over 150 food and beverage outlets in Singapore and Malaysia. It has become one of the more important products for the company and generated S\$500,000 in sales in 2013. The cups have the SG patent number embossed on the lid.
- 10 viii. BTH pays a 3% licence fee to the Patentee for the right to use its Patent.

The Problem

- ix. BTH recently came across a competitor company called EasyCup Pte Ltd which is making and selling a coffee cup lid that has features similar to its ProtecTop product. A picture of EasyCup’s product (called “FoamAroma”) appears below.
- 15



- 20 x. BTH found out from sources that EasyCup started making and selling the FoamAroma cup back in June 2011 in Singapore in small quantities.
- xi. BTH is concerned about the competition from EasyCup, especially since the price for the FoamAroma cup is lower. BTH suspects that EasyCup knows of the existence of
- 25

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the Patent because its former sales manager joined EasyCup and is now its sales director.

5 xii. BTH have notified the Patentee about the matter. The Patentee has confirmed that the FoamAroma cup is almost identical to the Patent. It has asked BTH to obtain advice from a local patent firm to find out the following, on the assumption that the FoamAroma cup reads on Claim 1 of the Patent:

10 (a) Has Easycup committed any acts of infringement by its commercial activities in Singapore? **(2 marks)**

(b) What options and remedies are available against EasyCup and its distributors to stop the infringement **(2 marks)**

15 (c) What rights are conferred by the publication of the Patent? **(2 marks)**

(d) Based on the information above, what are the ways that Easycup can resist an action for patent infringement **(6 marks)**

20 (e) What is the risk, if any, if BTH instructs a law firm to issue a letter to EasyCup to demand that it stops the sale of the FoamAroma lid and pay damages? **(2 marks)**

(f) If legal proceedings can be filed in the name of BTH or whether it has to be filed in the name of the US patentee **(1 mark)**

25

(g) Assuming that a patent infringement action is successful,

- 30 • Who is entitled to claim damages from Easycup for infringement of the Patent?
- What damages are claimable by BTH?
- Can Easycup avoid damages by claiming innocence?

(5 marks)

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QUESTION 4

Mr Tan approaches you today, 10 Oct 2014, for assistance with his patent portfolio. He first filed a Singapore patent application on 7 Apr 2011 and later on a PCT application claiming
5 priority from the Singapore patent application. He subsequently entered the PCT national phase in the United States. He has requested search and examination in respect of his Singapore patent application and filed a response to a written opinion just last week. He has also received an International Preliminary Report on Patentability (Chapter I) with all claims found novel and inventive, but with a lack of unity of invention objection. The claims in
10 respect of which the IPRP was established are the same as those pending in his Singapore patent application. Yesterday, he received a Notice of Allowance in respect of his United States patent application. The claims as allowed in the US are not of the same scope as those pending in his Singapore patent application. Mr Tan has informed you that he does not wish to file a divisional application. Please advise Mr Tan on all his options in relation to his
15 Singapore patent application, citing the relevant legal provisions, and provide your recommendation for proceeding.

(20 marks)

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QUESTION 5

Ever since Astrid accidentally flicked her braids into Hiccup's drippy nose in kindergarten, they have been best friends. Hiccup's obsession with braids grew over the years. By the
5 time he was 21, he had won several international braiding medals.

Astrid on the other hand went on to pursue more mundane post-doctoral studies on electro-conductive nanostructure compositing at NUS. In her research, she spent frustrating months grappling with the spontaneous deconstruction of carbon nanotubes at high temperatures.
10 Hexagonal boron nitride (h-BN) was thermally stable but an unsuitable substitute due to poor electrical conductivity.

Astrid was scheduled to present her work at a public symposium on Sunday (6 July 2014). To relax her mind, she went with Hiccup on a romantic cruise from Singapore to Penang
15 returning on 6 July 2014. During the cruise, Astrid succumbed to her worries. To console her, Hiccup dropped an unintentional pearl of wisdom – "Life is like a braid, all paths are intertwined" – which gave Astrid a vision of intertwining nano-braids of carbon and h-BN nanotubes having both thermal stability and electro-conductivity.

The idea took further shape as drawings and notes on the back of a napkin. They christened the nano-braid concept, the "Night Fury" (after the colours of carbon and h-BN), and agreed to pursue further research together. Astrid and Hiccup successfully submitted an online patent application to IPOS on Friday night (4 July 2014) for the Night Fury nano-braid accompanied only by a photograph of the napkin in their joint names.
20

Upon disembarking in Penang on Saturday morning (5 July 2014), Astrid and Hiccup found Gobber, a patent agent with offices in both Penang and Singapore to prepare a more complete patent specification. Gobber assured that he will submit the full application in Malaysia on Monday (7 July 2014) and his partner in Singapore, Toothless, will do the same
25
30 for Singapore on Tuesday (8 July 2014). These applications were filed as promised. Below is an extract of the PF1 lodged by Toothless:

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c. The official correspondence will be sent to the address for service in Singapore as indicated in this box.

Agent UEN/ Company Code	<input type="text"/>
Agent Name	<input type="text"/>
Representative or C/O Name	Gobber Toothless & Co
	Address for Service in Singapore
	Block/ House <input type="text"/>

Astrid and Hiccup had no further contact with Gobber and Toothless. On 1 August 2014, Toothless found that his Singapore patent application omitted to claim priority. He immediately submitted PF 13 to amend his PF1 to claim priority from the earlier Singapore and Malaysian applications.

Months later, Hiccup and Astrid developed a technically feasible Night Fury nano-braid prototype. Since you are now their neighbor in Punggol, they approach you to prepare a PCT application taking into account their latest work.

(a) Advise Astrid and Hiccup on the potential offences they may have committed.

(4 marks)

(b) Comment briefly on the online filing on 4 July 2014.

(5 marks)

(c) Comment briefly on the effect of the amendments filed on 1 August 2014.

(6 marks)

(d) You find out that Gobber is registered as a foreign patent agent with IPOS. Toothless is not registered with IPOS. Comment on the ramifications.

(5 marks)

End