INTELLECTUAL PROPERTY
OFFICE OF SINGAPORE

QE 2017 PAPER D – ANSWER GUIDELINES

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

S/N	Answer Guide	Mark
1(a)	Under section 66(1)(b), the use of a patented process is an act of infringement. If Tobey used the process in 2017, it would be such an act.	2 marks
	The offer for use of the process is an act of infringement. If what Tobey offered in 2016 was the use of the process, it would be such an act.	1 marks
	Under section 74(1), Andrew as the holder of an exclusive licence has the same right as the proprietor to sue for infringement in respect of an act committed after the date of the licence, and references in the Act to the proprietor is construed accordingly.	2 marks
	Under section 67(1), Andrew could claim for an injunction, an order to deliver up, damages, an account of profits and a declaration that the patent has been infringed.	2 marks
	However, under section 67(2), Andrew cannot receive both damages and an account of profits.	1 mark
	Further, under section 74(2), it is important that the damages or account of profits must be in relation to Andrew as an exclusive licensee, and not Tom as the proprietor.	2 marks
	Further, under section 76(1) and (3), the act of infringement in 2016 may be subject of damages if the act would, if the patent had been granted on the date of publication, have infringed the claims of the published application.	2 marks
	Since Andrew has no business exploiting the patent, he may not be able to recover any damages.	1 mark

	Alternative answer: Since Andrew has no business exploiting the patent, to prove damages, he may need to adduce evidence from an expert or practice in the trade, to support a finding of a reasonable royalty.	
	Andrew may have to rely on an account of profits, from when the profits started to accrue in 2017, of potentially $2,500 per transducer.	1 mark
	However, it seems that Andrew did not do anything with the exclusive licence, so under section 75, if Andrew did not register the exclusive licence under section 43 within 6 months of the licence, he may be disentitled to damages or an account of profits unless he can prove that it was not practicable to register eithin the 6 months and that it was registered as soon as practicable thereafter.	2 marks
	As there is little information on the process used by Tobey, Andrew could take steps to rely on section 68(1) by taking reasonable efforts to determine the process actually used by Tobey. This could potentially put the burden of proof on Tobey to show non-infringement if Andrew can successfully argue that there is a new product is made by the process (the coating); or a substantial likelihood exists that the coating is made by the patented process.	2 marks
1(b)	Tobey is not able to sue Andrew under section 77(4) since the alleged infringement concerns the use of a process.	2 marks
		20 marks

Question 2

S/N	Answer Guide	Mark
2(a)	Section 49(1) – An invention made by Venture's employees is taken to belong to Venture where the invention is made in the course of the normal duties of the employees. Venture is jointly entitled to invention with Kung.	1 mark
	Section 46(1) – Where a patent is granted to 2 or more persons, each co-owner is entitled to an equal undivided share in the patent.	1 mark
	Section 46(2)(a) – Where 2 or more persons are proprietors of a patent, then each of them shall be entitled to do in respect of the invention for his own benefit, any act which would amount to an infringement of the patent without the consent of or the need to account to the other proprietor.	1 mark
	Section 46(5) – Where a patented product is disposed of by Venture to a customer, that customer and any other person claiming through the customer shall be entitled to deal with the product in the same way as if it had been disposed of by a sole registered proprietor.	1 mark
	Section 46(3) – Venture shall not, without the consent of Kung, grant a licence under the patent to its other collaborators to use the method of the invention without the consent of Kung.	1 mark
2(b)	Section 19(1) or Section 19(2) – A patent for an invention may be granted to joint inventors. If Venture and Kung are joint inventors, the patent should be granted to them jointly.	1 mark
	Venture should obtain an assignment from Kung if the patent is to be granted in Venture's sole name.	1 mark

	Section 41(6) – An assignment of any right in a patent or any such application shall be void unless it is in writing and is signed by or on behalf of the assignor.	1 mark
	Section 24(2) read with Rule 18(1A) – Where the applicant is not the sole inventor, a statement should be made on PF8 indicating the derivation of the applicant's right to be granted the patent.	1 mark 1 mark
2(c)	Section 34(1) – No person resident in Singapore shall file or cause to be filed outside Singapore an application for a patent without written authority granted by the Registrar.	1 mark
	The patent application was filed within a short time, and it is unlikely that such written authority was obtained.	1 mark
	As Venture is resident in Singapore and caused the patent application to be filed by Samuel, Venture could be liable.	1 mark
	As Samuel is resident in Singapore and filed the patent application, Samuel could be liable.	1 mark
	Section 34(3) – Any person who files or causes to be filed an application for the grant of a patent in contravention of section 34 shall be guilty of an offence. Section 103 – The Registrar may compound the offence by collecting a sum of money from a person reasonably suspected of having committed the offence.	0.5 mark 0.5 mark

2(d)	Since the invention has been publicly disclosed in the road show, the invention would not be new if priority cannot be claimed from the Malaysian patent application.	1 mark
	Section 17(2) – Samuel should file a declaration claiming the priority date of the Malaysian patent application.	1 mark
	Section 17(2B) – Since the declaration is made after 12 months immediately following the date of filing of the Malaysian patent application, a request should be made for making a late priority declaration.	1 mark
	Section 17(2C) – Request should indicate in the request whether the late filing occurred in spite of due care required by the circumstances having been taken, or was unintentional.	1 mark
	Rule 9A(2) – File PF 57 and pay the prescribed fee of $250.	1 mark
Total marks		**20m**

Question 3

S/N	Answer Guide	Mark
3(a)	As SG Patent 1 has a filing date of 1 June 2012, the renewal fee for the 5th year was due 1 June 2016 (Rule 51(1)).	0.5 mark
	Renewal fee can be paid within a further 6-month period, i.e by 1 December 2016 (Section 36(3)).	0.5 mark
	But since no renewal fee was paid, SG Patent 1 has ceased to have effect (Section 36(2)).	0.5 mark
	Where a patent has ceased to have effect by reason of a failure to pay any renewal fee, an application for the restoration of the patent may be made to the Registrar within the prescribed period (Section 39(1)).	0.5 mark
	The prescribed period is 18 months from the day on which it ceased to have effect (Rule 53(1)(a)).	0.5 mark
	As less than 18 months have passed since 1 June 2016, it is possible to file an application for restoration of SG Patent 1 by 1 December 2017.	0.5 mark
	To file an application for restoration of patent, Glen's company has to file a statutory declaration or affidavit setting out the grounds of the application and supporting evidence (Rule 53(1)(b)).	1 mark
3(b)	In respect of claims 1 to 5, Glen's company has the opportunity to file a request for an examination report before the prescribed period of 36 months after priority date, i.e. by 2 February 2019 (Section 29(3) and Rule 43(1)(a)(ii)).	1 mark

	In respect of claims 6 to 10, Glen's company can file a request for a supplementary search report within 2 months from the issuance of the search report, i.e. by 2 August 2017 (Rule 45(2)).	1 mark
	Although the deadline to file the request for a supplementary search report has passed, an extension of time of up to 6 months is available (Rule 108(3)(a)), i.e. an extension of up to 2 February 2018 is possible.	1 mark
	Even if a supplementary search report is requested for SG Patent Application 2, a divisional application is still required if claims 6 – 10 are to be pursued.	1 mark
	Alternatively, Applicant can cancel claims 6 to 10 from SG Patent Application 2 and file a divisional application (Section 26(11)) without requesting for a supplementary search report, and the divisional claims will be searched and examined in the divisional application.	1 mark
3(c)	Glen's company has the opportunity to respond to the first Written Opinion within 5 months of IPOS letter, i.e. by 3 December 2017 (Section 29(9), Rule 46(4)).	1 mark
	Alternatively, provided Glen's company has not filed a response to the first Written Opinion Glen's company may withdraw the request for search and/or examination report by 3 December 2017; and file a request for supplementary examination report, relying on a corresponding application, within 54 months of the filing date of 3 March 2014, i.e. by 3 September 2018 (Section 29(1)(d), Rule 43(3)(a)(ii)).	1 mark 1 mark
	The UK and KR patents fall within the definition of a corresponding application (Section 2(1), Rule 41).	1 mark

	Glen's company cannot rely on the German patent as the German Patent Office is not one of the prescribed offices in Rule 41.	1 mark
3(d)	SG Application 4 has been withdrawn and the withdrawal cannot be revoked (Section 25(8)).	1 mark
	However, as the withdrawal application was filed more than one month before expiration of 18 months from the filing date, SG Application 4 would not have been published (Rule 29(4)).	1 mark
	Assuming the subject matter of SG Application 4 has not been disclosed, Glen's company can consider filing a new patent application to pursue the same.	1 mark
3(e)	Filing fee has to be paid within one month from the date of filing (Rule 19(2)) i.e. by 25 October 2017. Assuming that the file fee has not been paid timely, SG Application 5 is now lapsed.	1 mark
	The deadline to pay the filing fee is not extendable (Rule 108(2)(b)).	1 mark
	Assuming the subject matter of SG Application 5 has not been disclosed, Glen's company can consider filing a new patent application to pursue the same.	1 mark
Total marks		**20m**

Question 4

S/N	Answer Guide	Mark
4(a)	Section 86(3)(b)(i): In view of the copycat products, the owner can request an early & immediate national phase entry of the international patent application into Singapore.	1 mark
	Rule 86(1)(a), (2): before expiry of the official due date 25 April 2018 by filing PF37 and paying official fees S$200.	1 mark
	Section 29(1)(d)(i)(B): Although there are various local prosecution routes, given the client's urgent need to take action in Singapore proceeding by way of Supplementary Examination and relying on the IPRP would likely be the fastest way to obtain a granted patent in Singapore.	1 mark
	Section 26(11): One or more Singapore divisional applications may be filed before obtaining patent grant of their paremt application if the applicant intends to expand the scope of protection in Singapore beyond what is allowed by the Examiner of EPO.	1 mark
	Section 29 (1)(d)(ii) and Section 29(1)(d)(iii): A claims table will have to be prepared to show that each claim in the application in suit is related to the application in suit during its international phase.	1 mark
	Section 29A(1), Section 30: If the Supplementary Examination report contains no unresolved objection, a Notice of Eligibility to Grant will be issued.	1 mark
	Rule 47(1): The applicant has to satisfy the requirements for grant of patent and pay the grant fee within 2 months of the date of the Notice of Eligibility.	1 mark

4(b)(i) (a)	Issues to check: Article 10, PCT Rule 19.1(a), since the applicant is not a citizen or resident of Singapore, he cannot file the international patent application in Singapore by using IPOS as RO.	1 mark
4(b)(i) (b)	– PCT Rule 19.2, the nationality or residence requirement can be met if at least one of the applicants meets it. – if he intends to assign the rights in the inventions to a Singapore entity or to a person who is a citizen or resident of Singapore, or include a co-applicant that is either national or resident in Singapore, then it is possible to file the application with the Singapore RO. – Article 10, PCT Rule 19.1(a), you may alternatively act as his agent by filing the PCT application with the International Bureau as the Receiving Office.	1 mark 1 mark 1 mark
4(b)(ii)	Article 19, PCT Rule 46: The applicant can file amendments by deleting claims 11~20, before 20 Dec 2017, or before completion of technical preparations for international publication.	1 mark
	However if claims 11 – 20 are deleted, protection for the invention as defined by those claims will potentially not be available outside of Malaysia.	1 mark
	Deleted claims may be reintroduced via filing claim amendment or a divisional filing after entering national phase of the present international application.	1 mark
	PCT Rule 45bis: Alternatively, the applicant may request Supplementary Search to the remaining claims 11 – 20 prior to the expiration of 22 months from the priority date (i.e. before 20 April 2018).	1 mark

	This will preserve the applicant's right to potentially obtain patent protection for the invention covered by said claims 11 – 20.	1 mark
	However, due to unity of invention requirements, it is likely that the application will have to be divided into two applications after entering the national phase.	1 mark
	PCT Article 31, Rule 54bis.1(a): The applicant may further file a Demand for International Preliminary Examination (PCT Demand) within 03 months from the transmittal date of the ISR and WO (i.e. 20 Oct 2017), or 22 months from the priority date (i.e. 20 June 2016), whichever is later. The official due date is 20 April 2018 as 22 months from the priority date), NOT 20 Jan 2018 (i.e. 03 months from ISR mailing date) in the present case.	1 mark 1 mark 1 mark
Total marks		**20m**

Question 5

S/N	Answer Guide	Mark
5(a)	When did the trials between Easyconnect and the potential customers begin?	1 mark
	• Were the potential customers under a duty of confidence to Easyconnect? • Did the potential customers sign an NDA with Easyconnect? • Were the potential customers aware that whatever information they obtained from Easyconnect was confidential? • Were the trials conducted in public? (*These are different variations for the same mark*)	1 mark
	• Were the trials conducted in an enabling manner? • Can a skilled person in the field of electronics present at the trials work the invention? (*Again, these are different variations for the same mark*)	1 mark
5(b)(i)	– Priority date of invention as defined by C1 enjoys the benefit of the earlier filing date of **15 December 2014** of SG'1A, because the C1 subject matter is supported by matter disclosed in SG'1A under section 17(2)	2 marks
	- However, priority date of invention as defined by C2 is the filing date of SG'1B of **1 December 2015** under section 17(1), because the C2 subject matter was disclosed only in SG'1B and not in SG'1A	2 marks
	<u>C1</u> - Since priority date of C1 predates Easyconnect's trials, novelty and inventive step of C1 cannot be attacked by Easyconnect's trials under sections 14 and 15	2 marks

	C2 - Since priority date of C2 is later than Easyconnect's trials, novelty and inventiveness of C2 may be compromised by Easyconnect's trials - Novelty and inventiveness of C2 may be attacked if Easyconnect's trials constitute prior disclosure	1 mark 1 mark
5(b)(ii)	<u>CGK</u> - Common general knowledge known to the skilled person at the respective priority dates of C1 and C2 may compromise validity of Smartconnect's patents - NFC technology and electrical cables that are well-known at the time of Smartconnect's inventions may be relied upon to attack inventiveness of C1 and C2 under section 15	1 mark 1 mark
	<u>Added matter</u> - Amendment of the claims section of SG'1B to include the LED feature in C2 likely constitutes added matter under section 84, due to its apparent lack of support in the description of SG'1B as filed	2 mark
	<u>Double patenting</u> - Identical invention with the same common priority date and filed by the same party constitutes a ground for revocation under section 80(1)(g) *Both criteria of common priority date and common applicant must be mentioned to gain the full mark* - Both SG'1A and SG'1B comprise a claim with a common 15 Dec 2014 priority date and are filed by Smartconnect	1 mark 1 mark

5(c)	- Including the sensor + lighting features in the PCT application after filing constitutes added matter, because these features were not disclosed in the PCT application as originally filed	1 mark
	- Additional sensor and lighting features per se may no longer be novel under section 14 due to the publication of Smartconnect's SG'1B patent	1 mark
	- Easyconnect should not attempt to file a new patent application to protect the additional sensor and lighting features per se to avoid incurring unnecessary costs	1 mark
Total marks		**20m**

End