

QE 2018 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

Question 1

S/N	Answer Guide	Mark
a)	Section 36(3) allows for the renewal to still be made during the period of 6 months from February 2018 if the renewal fee and any prescribed additional fee are paid.	1 mark
	If so, the patent shall be treated as if it had never expired, and an act which would constitute an infringement of it if it had not expired shall constitute such an infringement. (Section 36(3)(b))	1 mark
	However, under section 69(3), in proceedings for infringement of a patent, the court may, if it thinks fit, refuse to award any damages, make an order for an account of profits or grant any other relief (including, an injunction) ...	1 mark
	... in respect of an infringement committed during any further period specified under section 36(3), but before the payment of the renewal fee and any additional fee prescribed for the purposes of section 36(3).	1 mark
b)	Section 66(1)(c) as the invention is a process	1 mark
	Reggae has (i) used; (ii) imported; and (iii) kept in Singapore a product obtained directly by means of that process. Note: only award 0.5 mark for 2 of the 3 points; and award 1 mark for all 3 points.	1 mark

c)	Reggae can cite section 69(1) that damages shall not be awarded and no order shall be made for an account of profits if he proves that at the date of the infringement he was not aware, and had no reasonable grounds for supposing, that the patent existed.	1 mark
	Reggae can argue that because the patent was not exploited for 18 years, he had no reasonable grounds for supposing the patent existed <u>AND/OR</u> Reggae argues that as the third owner, he did not know of the installation of the anchor by the previous owners.	1 mark
	Section 66(2)(e), there is no infringement if the act complained of consists of the use, exclusively for the needs of a relevant ship, of a product or process in the body of the ship or in its machinery, apparatus or other accessories, in a case where the ship has temporarily entered the territorial waters of Singapore <u>AND/OR</u> Section 66(2)(d) there is no infringement if it consists of the use of a product or process in the body or operation of a relevant aircraft, hovercraft or vehicle which has temporarily or accidentally entered or is crossing Singapore (including the air space above it and its territorial waters) or the use of accessories for such a relevant aircraft, hovercraft or vehicle <u>AND/OR</u> Section 66(2)(a) which must be for both private and non-commercial use.	1 mark
	Under sub-section (6), a “relevant ship” / “vehicle” means a ship / vehicle belonging to a country which is a party to the Paris Convention and/or a member of the World Trade Organisation.	1 mark
	Reggae can argue that the anchor falls within such a need of the Island, <u>AND/OR</u> the body or operation of Island ...	1 mark
	If Jamaica is a member of the Paris Convention <u>AND/OR</u> the WTO, the exception would be applicable to its ships.	1 mark

	<p>OR if Section 66(2)(a) is cited, provide explanation for why it is a private and non-commercial act. Reggae is a private tourist / on holiday / tourist visa.</p> <p>Note: The total marks for Question 1 c) is 6 marks. This current mark will not be awarded if full 6 marks are awarded for answers related to Section 66(2)(d) and/or (e).</p>	OR 1 mark
d)	Section 73(2), while Rock can commence infringement proceedings, Soul will need to be made a party to proceedings.	1 mark
	Where Soul is made a defendant, Soul will not be liable for any costs or expenses unless he enters an appearance and takes part in proceedings.	1 mark
	Section 43 applies where under subsection (3), the death of Roll as one of the proprietors of the patent and the vesting by an assent of personal representatives of the patent.	1 mark
	This means that Soul's inheritance in January 2018 is a registrable transaction.	1 mark
	Since Soul has totally ignored his inheritance, such registration has not likely been made.	1 mark
	Section 75, unless the registrable transaction is registered within the period of 6 months beginning with its date, the court or the Registrar shall not award Soul damages or order that he be given an account of the profits in respect of such a subsequent infringement occurring before the event is registered.	1 mark
	Soul is still within the window to register the event.	1 mark

	If because of Soul's touring, the deadline is not met, the effect of late registration may be avoided if the Registrar is satisfied that it was not practicable to register the transaction, instrument or event before the end of that period and that it was registered as soon as practicable thereafter.	1 mark
Total		20 marks

Question 2

S/N	Answer Guide	Mark
a)	Section 13(1) – A patentable invention is one that (a) is new	1 mark
	Section 14(1) & (2) – An invention shall be taken to be new if it does not form part of the state of the art, which is taken to comprise all matter (whether a product, a process, information about either, or anything else) which has at any time before the priority date of that invention been made available to the public (whether in Singapore or elsewhere) by written or oral description, by use or in any other way.	1 mark
	Richard should obtain a filing/priority date before the disclosure, if his disclosure is not conducted under an obligation of confidentiality.	1 mark
	Section 26(1)(c) – The documents filed at the Registry to initiate the application must satisfy the following conditions: (a) the documents indicate that a patent is sought; (b) the documents identify the applicant for the patent; and (c) the documents contain (i) something which is or appears to be a description of the invention for which the patent is sought.	1 mark
	Claims are not required.	1 mark
	Alternatively, Richard should ask the potential investors to sign a non-disclosure agreement to maintain the confidentiality of the invention during the disclosure.	1 mark
b)	Rule 19(2) – Where a document containing an indication that a patent is sought in pursuance of an application is filed with the Registrar without the filing fee, the filing fee shall be paid to the Registry within one month from the date of the filing of the document.	1 mark

	However, even if the application is treated as abandoned, a filing date may be validly retained in order to claim priority from the Singapore filing date as long as the documents filed at the Registry to initiate the application satisfy the conditions in Sections 26(1)(a) - (c).	1 mark
	As China is a country that is a party to the Paris Convention, Richard may claim priority from the Singapore filing date.	1 mark
c)	Section 113 – An invention for a patent for which an application has been made or for which a patent has been granted shall, unless the context otherwise requires, be taken to be that specified in a claim of the specification of the application or patent, as the case may be, as interpreted by the description and any drawings contained in that specification, and the extent of the protection conferred by a patent or application for a patent shall be determined accordingly.	1 mark
	In ascertaining the true construction of a patent specification, the claims themselves are the principal determinant.	0.5 mark
	What is not claimed in the patent is deemed to be disclaimed.	0.5 mark
	It is thus necessary to conduct a feature-by-feature comparison between the allegedly infringing product and the language of claim 1.	1 mark
	The “doctrine of equivalents”, where a patent is infringed if the defendant’s product performs substantially the same function in substantially the same way as the invention disclosed in the patent so as to achieve the same results as that invention, is not applicable in Singapore.	1 mark

	<p><i>Lee Tat Cheng v Maka GPS Technologies Pte Ltd</i> [2018] SGCA 18 (although any other Singapore case which advances this proposition should earn a mark).</p> <p>Note: There is no need to cite the case reference in full.</p>	1 mark
	<p>The construction of these principles requires the court to assume the mantle of the person skilled in the art.</p> <p>Note: It is not sufficient to just say “person skilled in the art”.</p>	1 mark (bonus)
d)	An invention is not to be broadened by the description, even if it mentions the possibility of other shapes.	1 mark
	The different shape may be a “variant” of the claimed shape, and purposive construction should be adopted. The question in purposive construction is what the person skilled in the art would have understood the patentee to mean by the language of the claim used.	1 mark
	For purposive construction, to determine what the words used in the patent claims would convey to the notional skilled person at the date of the patent application, one should ask the questions expounded in <i>Improver Corporation and others v Remington Consumer Products Limited and others</i> [1990] FSR 181.	1 mark
	<p>(a) Did the variant have a material effect on the way the invention worked?</p> <p>(b) Would the fact that the variant had no material effect on the way the invention worked have been obvious at the date of publication of the patent to a person skilled in the art, supposing that he was told of both the invention and the variant and was asked whether the variant would obviously work in the same way?</p>	1 mark

	(c) Would a person skilled in the art nevertheless have understood from the language of the claim that the patentee intended that strict compliance with its primary meaning was an essential requirement of the invention?	
	There would be infringement if the answers to the questions are: (a) No; (b) Yes; (c) No.	1 mark
	<i>Lee Tat Cheng v Maka GPS Technologies Pte Ltd</i> [2018] SGCA 18 (although any other Singapore case which sets out the test for purposive construction should earn a mark).	1 mark
Total		20 marks

Question 3

S/N	Answer Guide	Mark
a)	<u>On Inventorship</u> Section 2(1) – An inventor in relation to an invention means the actual deviser of the invention.	0.5 mark
	The patent application filed is directed specifically to the new process steps of durian seed preparation which Mr Mao did not participate in, Mr Mao ought not to have been mentioned as a joint inventor. Mr Shan should be the sole inventor.	1 mark
	Section 24(3) – Where a person has been mentioned as a sole or joint inventor under this section, any other person who alleges that the former ought not to have been mentioned may at any time apply to the Registrar for a certificate to that effect, and the Registrar may issue such a certificate.	0.5 mark
	Mr Shan may apply to the Registrar for a certificate to be issued in this regard.	1 mark
	<u>On Entitlement</u> Section 49(1)(a) – Invention belongs to employer if it 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.	1 mark
	Although Mr Shan is an employee of Durian King, he was a junior client relationship executive and Mr Mao did not specifically assign the duty of finding a way to produce durians without a pungent smell to Mr Shan (in fact, Mr Mao told Mr Shan to focus on his responsibility).	1 mark

	Mr Shan worked on the new process for durian seed preparation outside working hours.	1 mark
	Even if Mr Shan's invention belonged to Durian King, Mr Mao personally does not have any entitlement to the new process, since Mr Mao and Durian King are different legal entities.	1 mark
	Section 19(2)(a) – A patent for an invention may be granted primarily to the inventor or joint inventors, subject to exceptions in Section 19(2)(b).	0.5 mark
	The new process invention was invented by Mr Shan alone and the patent application should be granted to Mr Shan only.	1 mark
	Section 20(1)(b) – any of 2 or more co-proprietors of an application for a patent for that invention may so refer the question whether any right in or under application should be transferred or granted to any other person.	0.5 mark
	Mr Shan may make a request to the Registrar to determine his entitlement to the patent application.	1 mark
b)	Section 46(3) – one co-owner shall not without the consent of the other grant a licence under the patent or assign or mortgage a share in the patent.	1 mark
	For Mr Hong Xia to distribute the new durians in Singapore, he will have to obtain a licence under the patent from both Mr Mao and Mr Shan OR Mr Hong Xia will have to obtain a licence under the patent from at least either Mr Mao or Mr Shan, such licensor co-owner having obtained the consent of the other co-owner.	1 mark

c)	Section 55(1) – Any interested person may apply to the court for the grant of a compulsory licence on the ground that the grant of licence is necessary to remedy an anti-competitive practice.	0.5 mark
	Section 55(2) – Any person will have to prove that: (i) there is a market for the patented invention in Singapore; (ii) that the market is not being supplied or is not being supplied on reasonable terms; and (iii) court is of the view that 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.	0.5 mark
	The other interested durian plantation owners may apply to the court for the grant of a compulsory licence but need to show that there is an anti-competitive practice,	0.5 mark
	such as showing there is a market for the new durians as the new durians are very popular among customers,	0.5 mark
	and that Mr Mao is supplying the market at premium prices as compared to previous prices when distributing to durian shops,	0.5 mark
	and refuses to grant licences when approached.	0.5 mark
d)	Section 47(1) – Mr Wang can claim a proprietary interest in the patent by referring to the Registrar the question as to: (a) who is or are the true proprietor or proprietors of the patent; (b) whether the patent should have been granted to the person or persons to whom it was granted; or (c) whether any right in or under the patent should be transferred or granted to any other person or persons.	1 mark

	Section 24(1) [Note: section can be mentioned in (a) as well] – Mr Wang can seek to be named as inventor in view of his contributions; he designed the experiments and came up with the new process.	1 mark
	Section 24(3) – Mr Wang can also seek to remove Mr Mao and Mr Shan as inventors since they are not the actual devisers of the invention.	1 mark
	Section 80(1)(b) – Mr Wang can apply to the Registrar for an order to revoke the patent on the ground that the patent was granted to a person who was not entitled to be granted that patent OR Section 80(1)(f) – Mr Wang can apply to the Registrar for an order to revoke the patent on the ground that the patent was obtained fraudulently / misrepresentation / non-disclosure or incorrect disclosure of material information.	1 mark
	Section 47(4) – As Mr Wang has made an application under Section 80, the Registrar may give him the opportunity to make a new application for a patent for the whole of the matter comprised in the specification of that patent if Mr Wang is the one who came up with the entire new process and Mr Shan merely executed experiments based on direction of Mr Wang. Such a new application shall be treated as having been filed on the date of filing the application for the patent to which the reference relates.	1 mark
Total		20 marks

Question 4

S/N	Answer Guide	Mark
a)	Priority date: 1 November 2015 36-month: 1 November 2018 54-month: 1 May 2020	
	Although Andrew's Australian patent is a corresponding patent under s2(1),	1 mark
	and the 54-month deadline of 1 May 2020 to proceed with s29(1)(d) for requesting a supplementary examination report has not expired,	1 mark
	Andrew is unable to proceed directly under s29(1)(d) in view of the following:	1 mark
	(I) As a search report under s29(1)(a) has issued, the next step is to file a request for examination report under s29(3)	1 mark
	(II) Failure to comply with s29(3) will result in Singapore patent application being treated as abandoned	1 mark
	Cite s29(12)(a)(ii)	1 mark
	Andrew may consider taking one of the following options (I) or (II):	
	(I)	
	- File a request for examination report under s29(3) by 1 November 2018	1 mark
	- Withdraw the above request before responding to an issued Written Opinion or before issuance of examination report if no Written Opinion has issued.	1 mark
	- File a request for supplementary examination report under s29(1)(d) before 1 May 2020	1 mark
	- Cite s29(10)(a) and (b)	1 mark
	(II)	
	- File a divisional application by 1 November 2018	1 mark
	- Cite s26(11)	1 mark

	- In the divisional application, applicant can proceed with s29(1)(d) based on the Australian patent.	1 mark
b)	The magazine interview article will form the state of the art as it was published prior to the filing date of the Singapore patent application.	0.5 mark
	Cite s14(2).	0.5 mark
	The disclosure resulting from publication of the magazine article can be disregarded under s14(4)(e) due to the following:	1 mark
	Based on the information in the question, publication of the article took place within 12 months immediately preceding the filing date of the Singapore patent application;	1 mark
	article contents were obtained from the inventor; and	1 mark
	there does not appear circumstances described in s14(4)(a) to (d).	1 mark
	In order to rely on the “grace period”, Ben has to file written evidence in support of Ben’s reliance on the circumstances provided under s14(4)(e).	0.5 mark
	Written evidence has to be filed at the relevant time as prescribed in s14(5C).	0.5 mark
	The written evidence must be by statutory declaration or affidavit, and must enclose all supporting documents.	0.5 mark
	Cite rule 8(1)(a)	0.5 mark
Total		20 marks

Question 5

S/N	Answer Guide	Mark
a)	PCT Rule 90.1(a)	0.5 mark
	PCT Rule 90.4 (a) & (b) Note: award 0.5 mark if Rule 90.4 or 90.4(a) or 90.4 (b) cited	0.5 mark
	Submit POA (signed by Sarah) appointing candidate as agent	0.5 mark
	to IPOS (RO) or directly to IB. Note: award 0.5 mark as long IPOS (RO) or IB is mentioned	0.5 mark
b)	<u>Malaysia Application</u> Section 34(1) No mention whether written authority had been issued for the Singapore application prior to filing the Malaysia application.	1 mark
	Sarah and Tom would be committing an offence and liable to the penalties set out in s34(3). Note: award 0.5 mark for each party Sarah and Tom being mentioned in conjunction with citation of the act.	1 mark
	<u>PCT Application</u> PCT Art 17(2)(a)(i) Rule 39.1(iii) Note: award 0.5 mark if art is cited; and award 0.5 mark if Rule is cited	1 mark

	Method of teaching is considered to be a method of performing purely mental acts. PCT claims directed towards method of teaching will not be searched and consequently not examined by the ISA.	1 mark
	List of PCT member states There is presently no patent protection for Sarah's invention in Taiwan as Taiwan is not a member of the PCT.	1 mark
c)	SPA Section 105(1) and (4) Note: both are to be cited for mark to be awarded	0.5 mark
	SPA Section 105(8) – he is guilty of an offence liable to a fine not exceeding \$5,000 or to imprisonment not exceeding 12 months or to both. Note: award mark if the correct section is cited or the summary of the section is provided	0.5 mark
	Tom does not appear to have a valid PC since 1 April 2018. For the period of 1 April 2018 till present where he continued to act for Sarah in respect of her PCT and Malaysia patent applications, he is guilty of an offence.	1 mark
d)	SPA 17(2A), 2B & Rules 9A Note: award 0.5 mark for citing SPA 17(2A); and award 0.5 mark for citing Rules 9A	1 mark
	It is now about 15 months from date filing of the Singapore and Malaysia applications, which is after the relevant 12 months and 14 months deadline for priority claim.	1 mark

	<p>For the Improved Kits,</p> <p>File new Singapore patent application with no priority claim.</p> <p>Within 12 months of filing Singapore patent application for the Improved Kits, either:</p> <ul style="list-style-type: none"> • file PCT application and a domestic patent application for Taiwan <u>AND/OR</u> • domestic patent applications for USA, Korea, Taiwan and Australia. <p><u>OR</u> file PCT directly with domestic Taiwan application</p> <p><u>OR</u> file domestic applications for all territories</p> <p>Note: award full mark for mentioning either one option</p>	1 mark
	<p>Enter national phase in the primary markets by the relevant deadlines for the PCT application(s) as the case may be.</p> <p>Note: only award 0.5 mark if candidate does not address the Improved Kits</p>	1 mark
	<p>SPA Rule 29(1) & PCT Art 21(2)(a)</p> <p>Note: award 0.5 mark for each correct citation</p>	1 mark
	<p>Sarah's original invention has not yet been published, hence a Taiwan patent application can still be filed for her original invention without loss of novelty.</p>	1 mark
e)	PCT Rule 26bis.1(a)	1 mark

	It is now about 15 months from the priority date and within 4 months from the international filing date. It is thus possible to add the claim of priority of the Malaysia application by submitting a notice to the receiving Office or the International Bureau with details of the Malaysia application as set out in Rule 4.10.	1 mark
	PCT Rule 17 – A certified copy of the Malaysia application should be submitted to the International Bureau or to the receiving office by 23 November 2018.	1 mark
f)	<p>Time Limits for Entering National/Regional Phase under PCT Chapters I and II</p> <ul style="list-style-type: none"> • 23 Jan 2020 for Singapore, Malaysia, US, China (30 months deadline) • 23 Feb 2020 for Indonesia, South Korea, Vietnam, Australia (31 months deadline) <p>OR award 1 mark for identifying that the time limits is both 30 or 31 months without specifying the countries; and award 0.5 mark for specifying each correct date.</p> <p>Note: If wrong countries are identified under the specific deadlines/dates, award maximum 1 mark award for Question 1 f)</p>	<p>1 mark</p> <p>1 mark</p>
Total		20 marks

END