

INTELLECTUAL PROPERTY OFFICE OF SINGAPORE
PATENT AGENTS QUALIFYING EXAMINATION 2018

PAPER D: KNOWLEDGE OF PATENT LAW AND PATENT PRACTICE IN SINGAPORE
25 October 2018, Thursday
1330 – 1730 hrs

Maximum Time: 4 Hours (includes reading time)

Maximum Marks: 100



INTELLECTUAL PROPERTY
OFFICE OF SINGAPORE

INSTRUCTIONS TO CANDIDATES

1. This Question Paper consists of 11 pages, including this cover page.
2. Type your answers in English. Answers in any other language will not be marked.
3. You are given one hard copy of the Question Paper. The soft copy of the Question Paper is also provided in the given laptop.
4. Only answers typed or indicated in the Answer Script template provided by the Examination Secretariat will be considered. Candidates should not change the given format of the Answer Script or type in the margin.
5. The information provided in the Question Paper may be obtained from actual situations or modified therefrom for the purpose of this examination.
6. For the purpose of the examination, you are to assume that the dates mentioned in the questions are not excluded days. Where relevant, you are advised to include in your answer script the supporting references, for example, the Patents Act, the Patents Rules or the Patent Cooperation Treaty (PCT) provisions.
7. The documents provided in this Question Paper are:
 - a. Cover Page (1 page);
 - b. Question 1 (2 pages);
 - c. Question 2 (2 pages);
 - d. Question 3 (2 pages);
 - e. Question 4 (1 page); and
 - f. Question 5 (3 pages).

END

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QUESTION 1

Rock and Roll are serial inventors. In one invention, they came up with a new surface treatment method. In 2000, they obtained a patent in Singapore where the claimed method
5 was to be applied to ship anchors. Treated drag anchors demonstrated hyper-increased friction when used on the sea bed allowing for smaller and lighter anchors, potentially saving material and fabrication cost and time. It was not exploited, sitting among a stack of patents.

In April 2017, Roll passed away. Roll's son, Soul, inherited all of Roll's assets in January 2018.

10 Rock was badly shaken by Roll's passing, and the renewal fee for the patent was not paid in February 2018.

On 13 May 2018, Reggae sailed into Singapore on board his Jamaican-registered vessel, the Island, anchoring off East Coast Park, and entering the country on a 30-day tourist visa to
15 enjoy the vibrant night-life.

It is 31 May 2018, and Rock seeks your advice. He had learnt that in 2013, the Island was built in South Africa and equipped with an anchor that would infringe the patent. The anchor of the Island was made in Taiwan by a company that Rock has no ties with. Reggae is the
20 third owner of the Island, having just bought it. Singapore was the third stop in his maiden round-the-world voyage. The invention is not protected in Taiwan, South Africa or Jamaica. Rock had also managed to contact Soul, who is touring with his band in Europe. Soul has totally ignored his inheritance, as they remind him of his beloved father, so he has immersed himself in his music.

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QUESTION 1

Where applicable, citation of provisions in the Patents Act and Rules is required.

- 5 a) How does the non-renewal affect a patent infringement lawsuit?
(4 marks)
- b) Identify the acts by Reggae that may constitute an infringement of the patent.
(2 marks)
- 10 c) Citing a basis from the facts set out, what arguments can Reggae make with respect
to a patent infringement lawsuit?
(6 marks)
- 15 d) How does Soul's disinterest affect a patent infringement lawsuit?
(8 marks)

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QUESTION 2

Richard has invented a pillow which introduces a new way of pain relief for the neck by being adapted to allow a person with neck-ache to sleep face-down, while ensuring that the user's spine is straight. Up to now, the conventional wisdom has been to make pillows where the users lie on their backs.

- a) Richard has been asked by potential investors to demonstrate his pillow to them today, and he wants to file the patent application at IPOS before meeting them. However, he cannot get hold of a patent agent. He is concerned that he does not know how to draft the claims for a patent application. What can Richard do for himself to protect the patentability of his invention?

(6 marks)

- b) A patent application is successfully filed at IPOS. One month later, the product is launched in the market. Just before the expiry of one year from this initial filing date, Richard wants to file a patent application in China for the same invention. However, Richard still has not paid the filing fee by that time. What matters of Singapore law should Richard note in relation to the aforesaid for the purposes for filing the China patent application?

(3 marks)

- c) Assume that the patent application has been granted in Singapore two years later with only the below claim 1. Another company has appeared on the market with a pillow structure that enables a person to sleep face-down. As it is being sold at half the price of Richard's pillow, Richard has discovered that his pillow sales have dropped dramatically, and he is starting to incur losses. Richard comes to you for advice.

Claim 1 of the patent application drafted by Richard's patent agents reads as follows:

1. A pillow structure including:
a cylindrical pedestal portion;
a substantially circular top pillow portion arranged on top of said pedestal portion.

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QUESTION 2

Richard argues that he is the inventor of a pillow adapted to allow a person to sleep face-down, and the competing product is an infringement. He claims to be able to call an expert from the National University of Singapore to confirm that there is infringement of the “face-down” concept. However, he is unable at your meeting to produce a sample of the infringing product to show you. Please render advice to Richard on the general legal principles under Singapore law for determining the scope of a patent claim and whether there is infringement. Please cite the relevant Singapore case authorities where applicable.

(5 marks)

d) It is only later that Richard is able to produce a sample of the competing pillow. You find that the competing pillow is oval in shape, and its pedestal portion is not cylindrical in that its vertical cross-section does not have straight walls on each side. Instead, its vertical cross-section has curved walls. Richard points out to you that the description in the patent specification mentions the possibility that the pillow structure of the top portion and pedestal may instead have other shapes.

Please set out the applicable tests for determining whether there is infringement by the competing pillow under Singapore law. You do not need to analyse whether there is infringement in this case; and please cite the relevant Singapore case authorities where applicable.

(6 marks)

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QUESTION 3

Mr Mao owns a durian plantation in Malaysia, but he resides in Singapore and distributes durians from his plantation to several durian shops in Singapore under his company, Durian King Pte. Ltd. ("Durian King"). Mr Shan works as a junior client relationship executive in Durian King and his responsibility is to handle complaints and maintain good client relations. One day, Mr Wang, one of Durian King's clients, remarked to Mr Shan that if only durians did not have the pungent smell, customers would likely buy more as they do not have to worry about the pungent smell associated with durians which is the reason for the prohibition of durians on public transportation in Singapore.

Mr Shan discussed the idea of durians without the pungent smell with Mr Mao. Mr Mao felt it was a great approach and suggested that a starting point may be to look at how durian seeds are prepared before the seeds are planted. As they were shorthanded, Mr Mao told Mr Shan to focus on his responsibility and they can revisit this when they have more resources in the R&D team. As Mr Shan was very passionate about the idea, he decided to spend his free time carrying out many experiments on durian seed preparation and developed a new and inventive process for preparation of durian seeds which resulted in durians without a pungent smell. Mr Mao was delighted to know that Mr Shan had found such a process and immediately filed a Singapore patent application directed to the new process of durian seed preparation and the durian fruit obtained from the processed durian seed. The Singapore patent application listed both Mr Mao and Mr Shan as joint inventors and joint applicants. The new durians without a pungent smell were very well received by customers and sales increased significantly for Durian King.

- a) Mr Shan is of the view that he should be the sole inventor and sole applicant of the Singapore patent application. He confronted Mr Mao about it, but Mr Mao thinks otherwise. What advice and recommended course of action would you give to Mr Shan regarding inventorship and entitlement to the patent application?

(10 marks)

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QUESTION 3

b) The patent application was subsequently granted to Mr Shan and Mr Mao and is in force. Mr Hong Xia has his own durian plantation in Malaysia and is a competitor of Durian King. Mr Hong Xia checked the Patent Registry of Malaysia and realised that there was no corresponding patent filed in Malaysia. He happily used the patented process in Malaysia to produce durians without a pungent smell in his plantation. He would like to sell the durians in Singapore and would like to get a licence. What issues would arise?

(2 marks)

c) After the patent was granted, Mr Mao decided to sell the new durians directly to customers instead of distributing the new durians to durian shops to get a higher profit margin from the sales. The new durians got very popular and Mr Mao dominated the market as they were the only ones who can produce the new durians without a pungent smell. The owners of a number of Singapore-based durian plantations approached Mr Mao to obtain their own licences to use the patented process but Mr Mao flatly refused all of them. Is there any step that these plantation owners can consider taking to obtain a licence?

(3 marks)

d) Unknown to Mr Mao, Mr Wang was the person who designed the experiments and came up with the new process while Mr Shan merely executed the experiments based on Mr Wang's directions. Mr Shan had promised Mr Wang that he will sell the new durians to Mr Wang at a special rate if Mr Wang agreed to keep his contribution a secret. Mr Wang agreed. However, Mr Shan did not honour his promise and when Mr Mao stopped distributing the new durians to Mr Wang, sales dropped significantly for Mr Wang. What courses of action are available to Mr Wang under the Patents Act?

(5 marks)

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QUESTION 4

5 a) Your client, Andrew, filed patent applications in Singapore and Australia. Today, Andrew informed you that his Australian patent application has been granted and that you are to advance his Singapore patent application to grant based on the Australian patent to avoid having to go through substantive examination. You checked the file contents and noted that his Singapore patent application claims priority to his Australian patent application which was filed on 1 November 2015 and his Australian and Singapore patent applications relate to the same subject matter. You also noted
10 that the Intellectual Property Office of Singapore (IPOS) issued a Search Report on 15 June 2017 which cited Category “A” documents, much to Andrew’s delight. Please respond to Andrew on his instruction and advise on his options.

(13 marks)

15 b) Yesterday, you filed a Singapore patent application naming your client, Ben, as inventor. Today, you received a call from Ben who was distraught as his invention was published in a magazine interview article three days ago. He actually forgot the scheduled publication date of the article and therefore failed to instruct you to file the Singapore patent application prior to the publication date. Upon checking the article,
20 you ascertained that it describes the invention and includes drawings of the invention provided by Ben. Please advise Ben of the impact of the magazine interview article.

(7 marks)

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QUESTION 5

- Sarah is a local mathematics tutor and had developed a new way to teach arithmetic to students. She sought assistance from a local patent firm, IP2U Pte Ltd (“IP2U”) and an initial
- 5 patent application was filed in Singapore on 23 July 2017 containing only descriptions, drawings and abstract. Eager to protect her invention in Malaysia, a Malaysian patent application was filed the next day on 24 July 2017 with an expanded description and claims urgently prepared for her new teaching method and accompanying teaching toolkit. No claims were filed for Sarah’s initial Singapore application and it was eventually abandoned at IPOS.
- 10 A PCT application, PCT/SG2018/00999 was filed on 20 July 2018 with the same patent specification as the Malaysian patent application, claiming priority to both the Singapore and Malaysia patent applications.
- Tom, the only patent agent in IP2U who had been handling Sarah’s patent applications
- 15 informed Sarah last week that he would be retiring in Sweden by end of the year and that she would need to seek patent assistance from other patent professionals. Noticing that your name appears immediately below Tom in the register of patent agents in Singapore, Sarah contacted you for help.
- 20 During your first meeting with Sarah this week, she explained that she has stopped teaching and is now focused on developing and commercialising her invention. Several improved versions of the accompanying teaching toolkits (“Improved Kits”) have since been developed but production costs of the Improved Kits are much higher as these kits requires precise machining that can only be carried out in the USA. The primary markets of her original
- 25 invention would be Singapore, Malaysia, Indonesia, USA, South Korea, China, Taiwan, Vietnam and Australia. Due to the elevated costs of manufacturing the Improved Kits, she thinks that the Improved Kits would be more suitable for the Singapore, USA, South Korea, Taiwan and Australia markets.

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QUESTION 5

Extract from the Register of Patent Agents in Singapore:

Registration No.	Name of Patent Agent	Date of Registration	Regime (T/N)	Term of Practising Certificate	Contact Address
SGPA/1610/0607	Mr. Tom Thumboo	2-Oct-2016	N	1 Apr 2017 – 31 Mar 2018 11 Oct 2016 – 31 Mar 2017	IP2U Pte Ltd 268 Jalan Rendang Singapore 654321
SGPA/1705/0608	Dr Smartypants Chin	14-May-2017	N	1 Apr 2018 – 31 Mar 2019 30 May 2017 – 31 Mar 2018	DreamIPFirm Pte Ltd 716 Jalan Sotong Singapore 123456

- 5 a) Explain the documentation necessary for you to take over representation of Sarah's PCT application and the basis therefor.
(2 marks)
- 10 b) What issues and/or shortcomings are there in connection with filing of the Malaysia patent application as well as the PCT application?
(5 marks)
- c) Discuss any potential offences with Tom acting as Sarah's agent.
(2 marks)
- 15 d) Provide recommendation(s) to ensure adequate protection of all Sarah's inventions in the primary markets.
(6 marks)

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QUESTION 5

- 5 e) After reviewing the PCT request form, you noticed the PCT application only claimed priority of the Singapore application and Form CM12 had been filed. Explain if it is possible to add the claim of priority of the Malaysian application for PCT/SG2018/00999 now and the process and basis to do so.

(3 marks)

- 10 f) Advise Sarah of the deadlines for national phase entry of PCT/SG2018/00999 for her primary markets.

(2 marks)

END