

PAPER D: KNOWLEDGE OF PATENT LAW AND PATENT PRACTICE IN SINGAPORE
5 December 2019, Thursday
1330 – 1730 hrs

Maximum Time: 4 Hours (includes reading time)

Maximum Marks: 100



INSTRUCTIONS TO CANDIDATES

1. This Question Paper consists of 12 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 (3 pages);
 - c. Question 2 (2 pages);
 - d. Question 3 (2 pages);
 - e. Question 4 (2 pages); and
 - f. Question 5 (2 page).

END

INTELLECTUAL PROPERTY OFFICE OF SINGAPORE
PATENT AGENTS QUALIFYING EXAMINATION 2019

PAPER D: KNOWLEDGE OF PATENT LAW AND PATENT PRACTICE IN SINGAPORE
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Question 1

(A) Your local client, Kama, has a patent application (A) first filed for an invention in Australia on 27 August 2018. Application (A) contains 15 claims. Examination was requested early and was expedited. A first search and examination report issued by the Australian Patent Office 4 months later contains the following results:

“Claims 12 to 15: Not searched as they constitute a separate invention.

Novelty: YES for claims 1 to 11.

Inventive Step: NO for all claims.

Industrial Applicability: YES for all claims.”

Claim 11 reads: “A product made by the method of claim 1”.

- i. Kama is interested to file an international patent application (B) in Singapore, selecting the Intellectual Property Office of Singapore (IPOS) as International Search Authority (ISA). He would like the Australian search results to be considered for application (B). Discuss what should be done.

(4 marks)

- ii. Subsequently, you filed international patent application (B) in Singapore claiming priority to application (A). An International Search Report (ISR) and a Written Opinion (WO) were issued for application (B) by IPOS. The WO contains the same results as the one issued by the Australian Patent Office for application (A) except that claim 11 is found to be not novel and does not involve inventive step.

Kama is not interested in claim 11 as his invention is in the method and the product is the same as those already available in the market. However, he has a query. In the past, he came across another international patent application examined by the US Patent & Trademark Office (USPTO) with a claim having identical wording as claim 11 and the claim was not objected by the USPTO in a Written Opinion. Since all international patent applications are governed by the same Patent Cooperation Treaty (PCT), he cannot understand why there is such inconsistent practice between IPOS and USPTO as International Search Authority in regard to claims having the wording of claim 11.

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Kama wants to pursue original claims 1 to 10. A demand under Chapter 2 was filed for application (B) with inventive step arguments but without any amendments. Unfortunately, an adverse International Preliminary Report on Patentability (IPRP) Chapter 2 maintaining inventive step objections to claims 1 to 10 was subsequently issued despite filing further arguments without amendments to a second written opinion that was issued. After the IPRP was issued, Kama is concerned that national examiners will decide not to grant him patents because of the adverse IPRP after entering national phase of application (B).

Address Kama's query on the inconsistent practice and concern on the adverse IPRP, with reference to the PCT.

(3 marks)

iii. A notice of allowance was received a week ago for application (A) after deleting claims 12 to 15 and amending claim 1 to incorporate features taken from the description. A divisional application (C) was filed in Australia for claims 12 to 15 shortly after the first search and examination report was issued by the Australian Patent Office for application (A). Patent examination was requested and expedited for application (C). The claims of application (C) were not objected and a notice of allowance was issued yesterday for application (C).

Today, Kama indicates that he wants to proceed with the filing of a first national phase application (D) based on application (B) in Singapore. Kama wants protection for all claims of application (B), and he is cost-conscious.

Discuss when application (D) should be filed and what steps Kama should take (and corresponding deadlines) after filing application (D). In your answer, you are not required to identify the specific forms to be used and the prescribed documents to be submitted.

(8 marks)

INTELLECTUAL PROPERTY OFFICE OF SINGAPORE
PATENT AGENTS QUALIFYING EXAMINATION 2019

PAPER D: KNOWLEDGE OF PATENT LAW AND PATENT PRACTICE IN SINGAPORE
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- (B) On 2 February 2020, you filed a national phase application (X) in Singapore for another client, Louis. It contains 3 claims and is based on an international patent application (Y) filed on 2 September 2017 with no priority claim. An IPRP (Chapter I) indicating that claims 1 and 2 have novelty, inventive step and industrial applicability was issued for application (Y).
- 5 However, the IPRP (Chapter I) indicates that claim 3, which reads: “An apparatus as shown in Figure 1”, was not examined. Shortly after filing, Louis instructs fast processing for application (X) if possible and he is cost-conscious. There is no corresponding application filed yet.
- 10 Discuss what steps Louis should take (and corresponding deadline) after filing application (X). In your answer, you are not required to identify the specific forms to be used and the prescribed documents to be submitted.

(5 marks)

PAPER D: KNOWLEDGE OF PATENT LAW AND PATENT PRACTICE IN SINGAPORE
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Question 2

Mr. Kim and his family, who are from Korea, enjoy hosting Korean barbeque parties in their Marine Parade home. Mr. Kim, who works as an information technology manager in an iron pots-and-pans manufacturing factory, also loves experimenting with iron plates in his garage and he has come up with a process invention for making an improved iron plate which looks just like any normal iron plate but could cook meat very quickly and at the same time, retain its juiciness.

Mr. Kim engaged an external vendor to manufacture a prototype for the iron plate under a non-disclosure agreement.

Mr. Kim was very excited to show-off the improved iron plate and he invited his boss, Mr. Wok, to his Marine Parade home for a Korean barbeque feast on New Year's Day in 2018. He used his improved iron plate for the first time on this occasion. On seeing the iron plate, Mr. Wok encouraged Mr. Kim to send photographs of his improved iron plate to a pots-and-pans magazine, with the hope of increasing publicity for the factory. Mr. Kim did just as his boss suggested and the magazine published the photographs 2 weeks later.

Subsequently, Mr. Kim left the factory and remained in Singapore to concentrate on his new endeavour. He decided to file a patent application in Korea through his friend who was a Korean patent attorney. The Korean application with claims directed to the process was filed on 1 February 2018 in the name of Mr. Kim. Since he treats Singapore as his home, Mr. Kim then went on to file a Singapore application claiming priority to the Korean patent application. The Singapore patent application has a filing date of 14 January 2019.

In the meantime, Mr. Wok really liked Mr. Kim's improved iron plate and thought that it is a wonderful product to increase sales in his factory. As such, he started working with his factory to manufacture iron plates with similar improvements in mid-June 2019 and the product was launched in Singapore around August 2019. His iron plate proved to be a huge hit and had sales of \$100,000 within 3 months of launch.

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PATENT AGENTS QUALIFYING EXAMINATION 2019

PAPER D: KNOWLEDGE OF PATENT LAW AND PATENT PRACTICE IN SINGAPORE
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Mr. Kim now wants to commercialise his process. Mr. Kim comes to you today with a Certificate of Grant dated 1 September 2019 issued in Singapore. The Singapore patent was granted on the Singapore application as originally filed.

- 5 (a) Identify any potential issues with Mr. Kim first filing the application in Korea instead of Singapore, and briefly suggest his course of action to address those issues.
(4 marks)
- 10 (b) Advise Mr. Kim on the forum and the grounds on which he can enforce his rights against Mr. Wok.
(4 marks)
- 15 (c) Since Mr. Kim is no longer working in the factory, there appears to be no way he can get information on how Mr. Wok's iron plate was made. Advise Mr. Kim of his position.
(1 mark)
- 20 (d) If infringement is determined, what remedies can Mr. Kim expect to be awarded from a Singapore Court and from when can such remedies be calculated?
(3 marks)
- (e) Will your advice to Mr. Kim in (d) above be different if Mr. Wok can show that he never knew that a Singapore patent application existed?
(1 mark)
- 25 (f) Leaving aside any issues over ownership, advise Mr. Kim on whether his patent can be attacked, and if so, how. Assess the merit of any attack.
(7 marks)

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Question 3

Mew, a prolific inventor and a budding patent agent, owns a family of patents and patent applications in Singapore, Europe, Japan, and China. The granted Singapore patent 11201400222Y has a date of filing of 15 February 2014 and was granted on 8 August 2017.

- 5 A divisional of the Singapore patent was lodged on 31 July 2017 with an identical specification and no further action was made towards the divisional application.

10 It is now 5 December 2019 and Mew, overworked and burnt-out, has decided to take a one-year sabbatical to trek the Saharan desert. Since internet connection is a problem in the desert, she realized she may not be able to attend to her patents and patent applications consistently. As such, she would like you to be the appointed SG patent agent. On her way to the airport to catch a flight to Morocco, Mew instructed you to amend the claims of the divisional Singapore patent application to read:

- 15 1. A composition comprising a compound X.
 2. A composition comprising a compound Y.

Mew noted that the parent Singapore patent 11201400222Y was granted with two claims:

- 20 1. A composition comprising a compound X.
 2. A composition consisting of between 1 to 100 grams of compound X.

- (a) Please advise Mew on issues she should consider at this stage. In particular, on whether the proposed amendments to the divisional application can be entered and provide a recommended course of action. You are not required to advise Mew on the Patents Forms or Fees to be filed.
- 25

(10 marks)

INTELLECTUAL PROPERTY OFFICE OF SINGAPORE
PATENT AGENTS QUALIFYING EXAMINATION 2019

PAPER D: KNOWLEDGE OF PATENT LAW AND PATENT PRACTICE IN SINGAPORE
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Mew returned from her year-long sabbatical sunburnt but refreshed. She has informed you that she is considering initiating a legal action against Company P, which is infringing her SG patent 11201400222Y by selling a composition consisting of 50 grams of compound X.

- 5 Upon reviewing her files, you note that the corresponding patents in Europe, Japan, and China were all granted last week with one claim:
1. A composition consisting of between 1 to 100 grams of compound X.
- 10 According to the file history, the claim in the corresponding patents in Europe, Japan, and China were amended due to a prior art published on 1 January 2012 disclosing a composition comprising 111 grams of compound X that was cited by the respective patent offices but was not cited in Singapore.
- 15 (b) Please advise Mew on issues she should consider before starting any legal action against Company P and provide a recommended course of action. You are not required to advise Mew on the Patents Forms or Fees to be filed.

(10 marks)

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Question 4

(A) David, a Thai national contacted you on 12 October 2019 to file a Singapore patent application for his invention. A patent application for the same invention had already been filed in Thailand (T1) on 20 October 2018. You responded to David on the same day with a quote for the filing of a Singapore application but did not hear back from him and did not pursue this enquiry further.

- i. On 1 November 2019, David contacted you again enquiring about the status of his Singapore patent application. Upon checking of the junk folder of your email inbox, you realised that he had in fact emailed you on 15 October 2019 to file the Singapore application with the necessary information/documentation.

Is it possible to file the Singapore application with valid claim to priority of the Thai application?

(7 marks)

- ii. Assume that you have received David's filing instructions and the Singapore application was duly- filed on 15 October 2019 claiming priority to the Thai application (T1). David informed you on 1 December 2019 that there should be a total of two priority claims for the Singapore application. He had forgotten to mention his second Thai application (T2) filed on 25 October 2018 and the filing date of the first Thai application (T1) was not 20 October 2018 but in fact 20 September 2018. How may these errors be rectified? Indicate the form(s) and official fee(s) (if applicable)

(6 marks)

(B) You received instructions on 1 December 2019 from Alice to file a patent application no later than 10 December 2019. The Singapore application is to claim priority to a GB application GX201800011 with a filing date of 10 December 2018. In her email, Alice indicated that she would be uncontactable for the entire month of December as she would be away at a retreat. You reviewed the documents and it appears that the last 10 pages of the description are missing. Alice did not provide you with a copy of the GB application and it has not yet been published.

INTELLECTUAL PROPERTY OFFICE OF SINGAPORE
PATENT AGENTS QUALIFYING EXAMINATION 2019

PAPER D: KNOWLEDGE OF PATENT LAW AND PATENT PRACTICE IN SINGAPORE
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- i. Explain the process/steps to file the application in accordance with instructions received. Indicate the form(s) and official fee(s) (if applicable).

(5 marks)

- 5 ii. Will there be any issue if Alice still remains uncontactable for a further 5 months after December?

(2 marks)

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Question 5

Your client, Quickheal Pte. Ltd. ('Quickheal'), a Singapore company, approached you for help today, 5 December 2019. Quickheal informed you that they have recently developed an improved compound (A1) that expedites wound healing. Quickheal intends to obtain patent protection in Singapore immediately to protect all aspects of their technology and provided you with a detailed write-up of the recent development in the Chinese language. The subject matter of the invention sounded familiar to you, so you conducted checks on your internal docket and file management system and note the following information:

- 10 - One utility model application and one invention patent application were filed in China in the name of Quickheal's subsidiary company in China. Both applications were filed in Chinese and have not been published.
- 15 - The subject matter of the invention patent application relates to a compound (A) that expedites wound healing. This application has a date of filing of 5 December 2018 and there is no priority claim.
- 20 - The subject matter of the utility model application relates to a mechanical patch suitable for use with the compound (A) that expedites wound healing. This application has a date of filing of 5 June 2019 and there is no priority claim.
- 25 - All necessary national security clearances have been obtained for all aspects of Quickheal's technology.
- 25 (a) Please respond to Quickheal's instruction and advise on their options and requirements to obtain patent protection in Singapore as intended. In your answer, you are not required to identify the specific forms to be used.

(12 marks)

INTELLECTUAL PROPERTY OFFICE OF SINGAPORE
PATENT AGENTS QUALIFYING EXAMINATION 2019

PAPER D: KNOWLEDGE OF PATENT LAW AND PATENT PRACTICE IN SINGAPORE
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- (b) Quickheal called you at 11.59pm on the same day and said that they would now like to extend the protection in China, Malaysia, Indonesia, Philippines, Australia, New Zealand, Japan and South Korea with minimal fees and their preference is to use IPOS for the filings where possible. Late declaration of priority is not an option for Quickheal. Please advise Quickheal.

(8 marks)

END