

ANSWER GUIDELINES TO QE 2015 PAPER D

For Questions 1 to 5, where the marks for citation is not specifically indicated in the marking schedule, Examiners should award 50% of the allocated marks for citation. Eg, if it is 1m answer with citation, 0.5m should be awarded for the correct answer and 0.5m for the correct citation.

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 |
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| 1(a) | A forging technique is a process, as such the patent is a process patent. Section 66(1) (b) and (c) provide that the following are possible identifiable acts of infringement: (i) use of the process; or | 1m 1m for (i) and (ii) |

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| | (ii) disposal of, offers to dispose of, use of any product obtained directly by means of that process or keeping any such product whether for disposal or otherwise are the possible acts of infringement. | |
| 1(b) | <p>Under section 77(1), the letter of demand is a threat of proceedings for infringement and Am Wai could bring proceedings for the making of groundless threats.</p> <p>Section 77(4) provides that groundless threat proceedings may not be brought for a threat to bring proceedings for an infringement alleged to consist of using a process. Accordingly, Ese could be sued for threats over the acts in answer (a)(ii), but not for (a)(i).</p> | <p>1m</p> <p>1m</p> |
| 1(c) | <p>Ese Gee can rely on section 68(1) as his patent is a process for obtaining a new product, where the burden of proving that a product is not made by the process shall be on Am Wai if a substantial likelihood exists that Angrist is made by the process and Ese Gee has been unable through reasonable efforts to determine the process actually used.</p> <p>Ese Gee should show that he has made reasonable efforts to determine the process used.</p> | <p>1m</p> <p>1m</p> |
| 1(d) | Under section Section 76(1), Ese Gee could have rights from the publication of his patent and until the grant of the patent, the same right as he would have had, if the patent had been granted on the date of the publication of the application, for damages in respect of any act which would have infringed the patent. | 2m |

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| | <p>However, section 76(3) provides that such right would apply only if there is infringement of both the patent as granted and the claims as published.</p> <p>If these conditions are satisfied, Ese Gee could claim damages for infringing acts committed from after the publication.</p> | <p>1m</p> <p>1m</p> |
| 1(e) | <p>Under section 14, an invention shall be taken to be new if it does not form part of the state of the art and the state of the art shall be taken to comprise all matter which has at any time before the priority date of that invention been made available to the public (whether in Singapore or elsewhere) by oral description, by use or in any other way – so the demonstration in Athens could arguably mean the patent is not novel.</p> <p>However, the disclosure of matter constituting an invention shall be disregarded if occurring 12 months immediately preceding the date of filing the application for the patent and</p> <p>(i) the disclosure was due to, or made in consequence of, the inventor displaying the invention at an international exhibition and the applicant states, on filing the application, that the invention has been so displayed and also, within the prescribed period, files written evidence in support of the statement complying with any prescribed condition; or</p> <p>(ii) the disclosure was due to, or made in consequence of, the inventor describing the invention in a paper read by him behalf before any learned society.</p> | <p>2m</p> <p>1m</p> <p>1m</p> <p>1m</p> |

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| | <p>A “learned society” includes any club or association constituted in Singapore or elsewhere whose main object is the promotion of any branch of learning or science.</p> <p>The disclosures in Athens 6 months before Ese Gee filed his patent could fall within these possible exceptions such that the invention remains novel.</p> | <p>1m</p> <p>1m</p> |
| 1(f) | <p>Under section 80(1)(a), Am Wai can apply to the Registrar for an order to revoke a patent for an invention on (but only on) the following ground that the invention is not a patentable invention.</p> <p>Under section 80(2) and (3), on such an application, the Registrar may cause the patent to be re-examined by an Examiner on</p> <ul style="list-style-type: none"> (i) payment of the prescribed re-examination fee; and (ii) on provision by the applicant for the revocation of the patent of such security for the costs or expenses of the proceedings as the Registrar may specify, <p>otherwise, the application for revocation shall be treated as having been abandoned.</p> | <p>1m</p> <p>1m</p> |
| 1(g) | <p>Under section 69(1), in proceedings for infringement of a patent, damages shall not be awarded and no order shall be made for an account of profits against a defendant who proves that at the date of the infringement he was not aware, and had no reasonable grounds for supposing, that the patent existed.</p> | <p>1m</p> |
| Total marks | | 20m |

Question 2

| S/N | Answer Guide | Mark |
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| 2(a) | <p>(i)</p> <p>Section 17(2A)(a)</p> <p>A declaration for obtaining a priority date should be made 12 months immediately following the date of filing of the specified earlier relevant application</p> <p>The Singapore patent application was not filed within 12 months from the filing date of the earlier Japanese patent application. Thus, no valid declaration has been made.</p> <p>Section 17(2B)</p> <p>The applicant may make a request to the Registrar for a late declaration of priority.</p> <p>Section 17(2A)(b) (read with Rule 9A(1)): The late declaration may be made in respect of a priority date 14 months before the date of application for the late declaration.</p> <p>Section 17(2C)</p> <p>For late filing of the patent application, where the applicant makes a request under subsection (2B), he shall indicate in the request whether his failure to file the application in suit within the period referred to in subsection (2A)(a) —</p> <ul style="list-style-type: none"> • occurred in spite of due care required by the circumstances having been taken; or • was unintentional. <p>Joe can make the request on the basis that it was his intention</p> | <p>1m</p> <p>1m</p> <p>1m</p> <p>1m</p> |

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| | <p>to file the Singapore application and the failure to file the application within the period of 12 months was unintentional.</p> <p>The facts show that the Singapore patent application can still be filed as the period of 2 months ends on 10 May 2015.</p> | 1m |
| 2(a) | <p>(ii)</p> <p>The current declared priority date is the filing date of the second Japanese application 20 December 2013, whilst the priority date of 10 December 2013 needs to be added.</p> <p>Rule 9(2)(a)(ii)</p> <p>A declaration for the purposes of section 17(2) may be made after the date of filing if it would cause the declared priority date of the application in suit to be brought forward to an earlier date.</p> <p>Rule 9(2)(b)(ii)</p> <p>The late declaration must be made within 16 months from the earlier priority date of 10 December 2013, i.e. by 10 April 2015.</p> <p>Advise Joe to file the late declaration of priority to bring forward the declared priority date to the filing date of the first Japanese application 10 December 2013.</p> | <p>1m</p> <p>1m</p> <p>1m</p> <p>1m</p> |
| 2(b) | <p>(i)</p> <p>Section 86(3)(a)(i)</p> <p>The national phase of the application begins when the prescribed period expires, provided where the application has been published in accordance with the Patent Co-operation Treaty in a language other than English, and the application is</p> | 1m |

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| <p>not in English, an English translation of the application has been filed at the Registry.</p> <p>Section 86(6)(a)(i)</p> <p>Where, during the international phase, the application is amended in accordance with the Patent Co-operation Treaty, the amendment shall be treated as made under this Act if, and shall be disregarded unless —</p> <ul style="list-style-type: none"> • when the prescribed period expires, where — <ul style="list-style-type: none"> ➤ the amendment is not in English; and ➤ if any copy of the amendment has been communicated to the Registry in accordance with the Treaty, that copy is in a language other than English, <p>an English translation of the amendment has been filed at the Registry</p> | <p>1m</p> |
| <p>The English translation of the PCT Article 19 amendments should be submitted so that the amendments will not be disregarded.</p> | <p>1m</p> |
| <p>Rule 86(6)</p> <p>Where an applicant is required to file a translation into English both of an application as originally filed and of the amendment to it, in accordance with paragraph (5), in order to satisfy the relevant conditions of section 86(3) and (6) and at the expiry of the applicable period referred to in paragraph (1), the prescribed fee has been paid and one but not both of the necessary translations has been filed —</p> <p>(a) the Registrar shall give notice to the applicant at the address</p> | <p>1m</p> |

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| | <p>furnished by the applicant in accordance with rule 31 requiring the applicant to file the required translation within 2 months from the date on which the notice is sent; and</p> <p>(b) the applicable period shall be treated in respect of that translation as not expiring until the end of the period specified in the notice given under sub-paragraph (a).</p> <p>The PCT application has been published in Japanese, but Joe does not have an English translation of the PCT application. It is possible to file the English translation of the PCT Article 19 amendments to satisfy the conditions of sections 86(3) and (6), and the English translation of the PCT application (the required translation) can be filed later.</p> | 1m |
| 2(b) | <p>(ii)</p> <p>Section 87(2) (read with Section 87(3)(b)(i))</p> <p>If the application is published in accordance with the Patent Cooperation Treaty, it shall be treated as published under section 27 when the national phase of the application begins or, if later, when published in accordance with the Treaty.</p> <p>If it is so published in a language other than English, on the publication of an English translation of the application in accordance with section 86(7).</p> <p>The PCT application has not been published under section 27, for the purpose of section 76, as the PCT publication is in Japanese.</p> <p>Section 86(7) (read with Rule 86(7))</p> | <p>1m</p> <p>1m</p> <p>1m</p> <p>1m</p> |

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| | <p>The Registrar shall on payment of the prescribed fee publish any translation filed at the Registry under subsection (3) or (6) following the filing of Patents Form 38 accompanied by the payment of the prescribed fee.</p> <p>Advise Joe to file Patents Form 38 with the prescribed fee of SGD 70.</p> | 1m |
| Total marks | | 20m |

Question 3

| S/N | Answer Guide | Mark |
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| 3(a) | One cannot keep “Embodiment 3” as a trade secret by filing amendments after the PCT application has been filed since the file will be open to public inspection after publication. | 1m |
| | Rule 94.1(b) of the PCT states that the International Bureau shall, at the request of any person but not before the international publication of the international application and subject to Article 38, furnish, subject to the reimbursement of the cost of the service, copies of any document contained in its file. | 1m |
| | Article 21 of PCT Treaty states that the international publication of the international application shall be effected promptly after the expiration of 18 months from the priority date of that application. | 1m |
| | Amendments to remove “Embodiment 3” should be carried out before the filing of the PCT application to avoid “Embodiment 3” being subsequently published after the PCT application is filed. | 1m |
| 3(b) | PCT Article 19(1): The applicant shall, after having received the international search report, be entitled to one opportunity to amend the claims of the international application by filing amendments with the International Bureau within the prescribed time limit. | 1m |
| | Amendments under PCT Article 19 can only be made to the claims. | 1m |

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| Rule 46.1: The time limit referred to in Article 19 shall be two months from the date of transmittal of the international search report to the International Bureau and to the applicant by the International Searching Authority or 16 months from the priority date, whichever time limit expires later. | 1m |
| The deadline for filing the Article 19 amendments to the claims only is 1 July 2015. | 1m |
| PCT Article 34(2)(b): The applicant shall have a right to amend the claims, the description, and the drawings, in the prescribed manner and within the prescribed time limit, before the international preliminary examination report is established. | 1m |
| PCT Rule 54b is 1(a) A demand may be made at any time prior to the expiration of whichever of the following periods expires later: (i) three months from the date of transmittal to the applicant of the international search report; or (ii) 22 months from the priority date. | 1m |
| The deadline for filing the Demand in this instance is 1 January 2016. [Alternatively, if a candidate identifies 1 Jan 2016 as a public holiday and states the deadline to be the next working day (i.e. 4 Jan 2016), they should also be awarded the same 1 Mark] | 1m |
| Since Feeckle-mind Pte Ltd wishes to amend the description as well as the claims, it is best that the desired amendments can be effected all in one go via Article 34 of the PCT. | 1m |

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| | It is therefore recommended that Feeckle-mind Pte Ltd files a Demand for International Preliminary Examination under PCT Article 31(1). | 1m |
| 3(c) | <p>In general, the Applicant may on its own volition, amend the description, claims, drawings and abstract at any time before payment of the fee for the grant of a patent.</p> <p>S31(1) when read with Rule 49 (2).</p> <p>But amendments may not be made during the relevant time following periods stated in Rule 49 (3).</p> <p>S84(2) : No amendment of an application for a patent shall be allowed under section 31 if it results in the application disclosing any matter extending beyond that disclosed in the application as filed.</p> <p>Yes, the proposed amendments to reintroduce the matter deleted during the PCT International Phase is possible.</p> <p>This is because the application as filed contains such subject matter and reintroducing it does not add matter beyond the application as filed.</p> <p>S85(1) when read together with S84(2)</p> | <p>1m</p> <p>1m</p> <p>1m</p> <p>1m</p> <p>1m</p> <p>1m</p> |
| Total marks | | 20m |

Question 4

| S/N | Answer Guide | Mark |
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| 4(a) | <p>Under s 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; ...</p> <p>Although X was an employee of the fast food outlet, X was a delivery man and was not assigned specific duty for improving takeaway bag design (since Boss recognized the improved bag was due to X's initiative).</p> <p>Under s 49(1)(b), invention belongs to employer if it was made in the course of the duties of the employee and, at the time of making the invention, because of the nature of his duties and the particular responsibilities arising from the nature of his duties he had a special obligation to further the interests of the employer's undertaking.</p> <p>Since X worked on the improved bag design outside working hours and because of his job designation, X does not have special obligation to further the interests of the employer's undertaking.</p> <p>Based on the circumstance, the Boss does not own X's improved takeaway bag design.</p> <p style="text-align: center;">*****</p> <p>S 41(6): Assignment of a patent or any such application, or any</p> | <p>1m</p> <p>1m</p> <p>1m</p> <p>***</p> <p>1m</p> |

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| | <p>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.</p> <p>Although Boss paid a special bonus to X, there was no signed written assignment from inventors. Hence, regardless whether the there was any agreement as to assignment of rights to Boss. There is no valid assignment. Based on the circumstance, Boss is not entitled to ownership of X's invention.</p> <p style="text-align: center;">*****</p> <p>Possible option for Boss:</p> <p>- Negotiate with X and Y for joint or sole ownership and follow up with signed written assignment.</p> | <p>1m</p> <p>***</p> <p>1m</p> |
| | <p>S 19(2)(a): A patent for an invention may be granted primarily to the inventor or joint inventors, subject to exceptions in s 19(2)(a) and (b).</p> <p>As the bag invention was jointly invented by X and Y, the application may be granted to X and Y.</p> <p>Y is entitled to own his invention.</p> <p style="text-align: center;">*****</p> <p>S 20(1) At any time before a patent has been granted for an invention (a) any person may refer to the Registrar the question whether he is entitled to be granted (alone or with any other persons) a patent for that invention or has or would have any right in or under any patent so granted or any application for such a patent; ...and the Registrar shall determine the question and may make such order as he thinks fit to give effect to the determination.</p> | <p>1m</p> <p>1m</p> <p>***</p> <p>1m</p> |

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| | <p>Y could consider requesting Registry determine his entitlement to the patent application.</p> <p>*****</p> <p>S 24(1): The inventor or joint inventors of an invention shall have a right to be mentioned as such in any patent granted for the invention and shall also have a right to be so mentioned if possible in any published application for a patent for the invention and, if not so mentioned, a right to be so mentioned in accordance with the rules in a prescribed document.</p> <p>S 24(3): Where a person has been mentioned as a sole or joint inventor in pursuance of 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 .</p> <p>Y could proceed to request Registrar to add his name as joint inventor of the patent application.</p> | <p>1m</p> <p>***</p> <p>1m</p> |
| 4(b) | <p>S 46(3): Subject to sections 20 and 47 and to any agreement for the time being in force, where two or more persons are proprietors of a patent, one of them shall not without the consent of the other or others grant a licence under the patent or assign or mortgage a share in the patent.</p> <p>*****</p> <p>Since patent application is jointly owned by Boss and Y, Y cannot unilaterally grant a licence to Z without consent from the fast-food outlet owner and hence the licence is void. Consent from Boss and Y owner are needed.</p> | <p>1m</p> <p>***</p> <p>1m</p> |

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| 4(c) | <p>s 34(1): Subject to this section, no person resident in Singapore shall, without written authority granted by the Registrar, file or cause to be filed outside Singapore an application for a patent for an invention unless —</p> <p>(i) an application for a patent for the same invention has been filed in the Registry not less than two months before the application outside Singapore; and</p> <p>(ii) no directions have been given under section 33 in relation to the application in Singapore or all such directions have been revoked.</p> <p>The facts suggest that X is likely to be a Singapore resident. In this circumstance, X would require permission from Registrar prior to filing a patent application outside Singapore. Otherwise, X would be committing an offence and liable to the penalties set out in s 34(3)</p> <p style="text-align: center;">*****</p> <p>PCT Rule 19.1: PCT application shall be filed with the national Office of or acting for the Contracting State of which the applicant is a resident or national</p> <p>Since/if X is resident/national in Singapore, X would not satisfy the residency requirements for filing the PCT application with Malaysia IP Office as receiving office.</p> <p>[Comments : to be given as a bonus mark if the candidate goes on to comment that the PCT application may be validly filed if the application is transmitted by the Malaysian IP Office to the International Bureau – PCT regulation 19.4]</p> <p style="text-align: center;">*****</p> <p>Code of Conduct set out in the Fifth Schedule of Patents</p> | <p>1m</p> <p>1m</p> <p>***</p> <p>1m</p> <p>1m</p> <p>***</p> |

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| <p>(Patent Agents) Rules 2001:</p> <p>10.—(1) Except with the consent of a client or as required by law or any order of any court of competent jurisdiction, a relevant patent agent shall not disclose (directly or indirectly) or use, and shall take reasonable care to prevent his employees and other staff, and any other person engaged by him to act on behalf of the client, from disclosing (directly or indirectly) or using —(a) any confidential information which he receives as a result of the retainer by the client; or the contents of any papers containing any instructions from the client.</p> | <p>1m</p> |
| <p>By revealing confidential information relating to the earlier patent application, the Patent Agent BM breached confidentially obligation under Code of Conduct</p> <p style="text-align: center;">*****</p> | <p>1m</p> <p style="text-align: center;">***</p> |
| <p>Rule 17 of Patents (Patent Agents) Rules 2001</p> <p>Disciplinary proceedings may be taken against any registered patent agent or registered foreign patent agent referred to in paragraph (1) who contravenes any provision of the Code of Conduct.</p> | <p>1m</p> |
| <p style="text-align: right;">Total marks</p> | <p style="text-align: center;">20m</p> |

Question 5

| S/N | Answer Guide | Mark |
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| 5(a) | <p>The earlier Singapore filing date is valid even though Joel did not provide claims or make payment.</p> <p>Section 26(1)</p> <p>The filing date or priority date is valid by providing at least following information:</p> <ol style="list-style-type: none"> 1. the documents indicate that a patent is sought; 2. the documents identify the applicant for the patent; and 3. the documents contain — <ul style="list-style-type: none"> (i) something which is or appears to be a description of the invention for which the patent is sought; or | <p>1m</p> <p>1m</p> <p>1m</p> |
| 5(b) | <p>There are overlapping claims 1-10 in both patent applications.</p> <p>Rule 46(1)(f)(ii)</p> <p>A Written Opinion would be issued in respect of claims 1-10 because there is an earlier grant of a patent for the same invention, with the same priority date, to the same applicant</p> <p>Claims 1-10 would have to be deleted from the patent application in response to the Written Opinion before the grant of the second patent application.</p> <p>Section 80(1)(g)</p> <p>Even if a Written Opinion is not issued in respect, a patent may be revoked under the Patents Act if the patent is one of 2</p> | <p>1m</p> <p>1m</p> <p>1m</p> <p>1m</p> <p>0.5m</p> <p>0.5m</p> |

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| | <p>or more patents for the same invention having the same priority date and filed by the same party of his successor in title.</p> <p>[Marks will be awarded by mentioning “<i>amendments to claims 1~15 are necessary during examination stage (supplementary or substantive examination) in order to avoid the double-patenting issue.</i>”]</p> | |
| 5(c) | <p>Section 29(1)(d)(i)(B)</p> <p>Joel may proceed to obtain grant after receiving the notice of eligibility to proceed to the grant by requesting Supplementary Examination based on the IPRP1 after Singapore national phase entry of the PCT application</p> <p>Section 29(1) and Section 29A(3)</p> <p>However, since not all claims have been examined during the international phase, claims 11~15 cannot be granted without search and examination.</p> | <p>1m</p> <p>1m</p> <p>0.5m 0.5m</p> <p>1m</p> |
| 5(d) | <p>Section 36(3) Rule 51</p> <p>The second patent (which expired on 21 March 2015) can be renewed because a late renewal is possible within 6 months from the date of renewal if the patent has lapsed for up to 6 months.</p> | <p>0.5m 0.5m</p> <p>0.5m</p> |

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| | The 6 months deadline is 21 September 2015. | 0.5m |
| | Section 39(1) and | 0.5m |
| | Section 39(5) | 0.5m |
| | Since the first patent (which expired on 15 April 2014) has lapsed for more than 6 months, it is at the Registry's discretion whether the lapsed patent can be renewed. | 1m |
| | Rule 53(1) | 1m |
| | Joel can apply to the Registrar within 18 months from the day on or before which it ceased to have effect for restoring the lapsed patent. | 0.5m |
| | The 18 months will end on 15 October 2015. | 0.5m |
| | Cool Water Pte Ltd needs to provide evidence indicating that the failure to pay the renewal fees was unintentional, such as by providing statutory declaration or affidavit for supporting the restoration. | 1m |
| | However, since the management intentionally let the first patent lapse, the first patent may not be restored. | 1m |
| Total marks | | 20m |

End