

INTELLECTUAL PROPERTY OFFICE OF SINGAPORE
PATENT AGENTS QUALIFYING EXAMINATION 2015

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

**9 October 2015, Friday
1330 – 1730 hrs**

Maximum Time: 4 Hours (includes reading time)

Maximum Marks: 100



INSTRUCTIONS TO CANDIDATES

1. This Paper consists of 12 pages, including this cover page.
2. Type/Write your answers in English. Answers in any other language will not be marked.
For candidates who opted out from laptop examination: Answers in illegible handwriting will not be taken into consideration.
3. One hardcopy of the question paper is provided, for your reading and for your use (optional) when answering the question(s) in the Answer Script/Answer Booklet(s). For candidates who opted out from laptop examination: You are given two hardcopies of the question paper.
4. Only your answers and/or drawings to the question(s) typed/written or indicated/glued in the Answer Script/Answer Booklet(s) provided by the Examination Secretariat will be considered. Candidates should not change the format of the Answer Script or type in the margin. For candidates who opted out from laptop examination: You are to write on one side of each sheet in the Answer Booklet(s).
5. In the following question(s) to this Paper, you are to assume that the dates mentioned (including the deadlines that are or would be due) are not excluded days. Where relevant, you are also advised to include in your answers supporting references, for example, the Patents Act & Rules and the Patent Cooperation Treaty (PCT) provisions.

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QUESTION 1

Ese Gee, 50, is a blacksmith and has been experimenting on improving his craft throughout his career. Over the course of many years, he developed a forging technique resulting in a new breakthrough product. It enjoyed outstanding anti-corrosion and durability properties. It was also extremely malleable during forging allowing for the sharpest edges to be made, and when set, the hardness was diamond-like. He read out his prepared notes of and demonstrated his technique in the 2008 Zarazoga World Expo in Spain in a session among experts in the field. At the end of the session, a fellow peer suggested that he consider filing a patent, which he did within 6 months, and a patent was granted as from 2012 in Singapore and elsewhere for the forging technique.

Am Wai, 58, is very enterprising and had a friend who attended the same 2008 session where Ese Gee demonstrated his technique. Although his friend was very uncomfortable about it when sober, after a lengthy session at the bar and other inducements, Am Wai teased sufficient information from his friend. Am Wai launched his product line of knives called Angrist at the end of 2011 to cutting success and glowing endorsements by almost every celebrity chef worth his/her salt.

(a) Identify the possible acts of infringement that Am Wai may have committed.

(2 marks)

(b) If Ese Gee issues a letter of demand to Am Wai on the basis of your answer to (a), what could Ese Gee be sued for?

(2 marks)

(c) If Ese Gee is unable to determine the technique used to make Angrist, how can he prove that there might be infringement of his patent?

(2 marks)

(d) If there is infringement, what rights does Ese Gee have against Am Wai for the Angrist products dating back to its launch and even before?

(4 marks)

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QUESTION 1

(e) From the facts, how may Ese Gee's patent be attacked? How may the attack be defended? **(7 marks)**

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(f) Can Am Wai do anything to have Ese Gee's patent re-examined? **(2 marks)**

(g) What if Am Wai says that he is ignorant about Ese Gee's patent? **(1 mark)**

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QUESTION 2

- 5 (a) Your friend Joe, who is based in Japan, has approached you with his patent portfolio previously managed by a part-time employee in Joe's Singapore office. Joe complains that the employee is prone to taking month-long holidays without notice and has been uncontactable for the past month. Today's date is **10 April 2015**.

10 You have reviewed the portfolio and under a main folder titled "Paris Convention applications", you come across two loosely bound sets of papers.

15 For the first set of papers, you note that there is a complete patent specification in English with Joe's email instructions to file a Paris Convention application in Singapore claiming priority to a Japanese patent application with a filing date of 10 March 2014. In the email, Joe has also set out his intentions, in bold print, that the patent application be given special attention within this portfolio. Joe informs you that the patent application in Singapore was never filed.

20 For the second set of papers, you see Joe's previous email instructions to his employee to file a Paris Convention application in Singapore claiming priority to two Japanese patent applications with filing dates of 10 December 2013 and 20 December 2013 respectively. Upon closer review of the set of papers, you note that there is a notification from the Intellectual Property Office of Singapore stating a filing date of 1 December 2014 has been accorded. You discover that the priority claim to the Japanese application filed on 10 December 2013 is missing from the Patents Form 1 filed for this patent application. You are satisfied that there has been no request for early publication of the application, and that the application has not yet been published.

- 25 (i) For the first set of papers, Joe wants to know whether a Singapore patent application can be filed claiming the priority as indicated. Provide your advice to Joe. (Note: You are not required to discuss specific patents forms or official fees, if any.)
- 30 **(6 marks)**

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QUESTION 2

- (ii) Provide your advice to Joe regarding rectifying the omission of the priority claim for the Singapore patent application from the second set of papers. (Note: You are not required to discuss specific patents forms or official fees, if any.)

(4 marks)

- (b) Still within the same day, you next find a full PCT (Patent Co-operation Treaty) application filed with the Japanese Patent Office (in the Japanese language) relating to a simple mechanical invention. The PCT application has no priority claim and has a filing date of 10 December 2013. In a folder containing this PCT application, you find the following as well:

- the PCT publication in the Japanese language,
- the International Search Report and its English translation. There is only one cited document in English and the cited document is attached to the International Search Report. The International Search Report shows that all the claims have been searched,
- PCT Article 19 amendments in Japanese submitted previously and a complete English translation of the PCT Article 19 amendments, and
- a signed translator's verification for the English translation of the PCT Article 19 amendments.

Due to financial constraints, Joe has yet to translate the entire PCT application as filed. Due to these financial constraints, Joe informs you that no other patent applications arising from the PCT application, national phase or otherwise, will be filed. Joe also informs you that the PCT Article 19 amendments will be the only amendments for the PCT application and these amendments should not be disregarded in Singapore.

- (i) Discuss whether or not it is possible that a Singapore PCT national phase application can be filed using only the current documents available. You should provide any relevant legal provisions to support your answer.

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QUESTION 2

Please assume that Joe does not intend to expressly request the Registrar to proceed earlier with the national phase of the PCT application and wishes to file the Singapore PCT national phase application without any request for extension of time. (Note: You are not required to discuss specific patents forms or official fees, if any.) **(5 marks)**

(ii) After the Singapore PCT national phase application has been filed, Joe tells you that he was informed by his employee that it is possible to have rights conferred by publication of his application. He wishes to obtain such rights as soon as possible. What would be your advice to Joe? (Note: Please elaborate on the procedure if any but you are not required to discuss specific rights that are conferred on Joe by the publication of his application.)

(5 marks)

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QUESTION 3

Your client, Feeckle-mind Pte Ltd, a Singapore company, approached you one morning and requested that you assist them in filing a PCT application. They have drafted the patent specification on their own and only required your assistance in filing and prosecuting the PCT application. The PCT application will be the first filed application and there will not be any priority claims.

Their drafted patent specification contains 3 different embodiments of their invention, that is, “Embodiment 1”, “Embodiment 2” and “Embodiment 3”.

Before instructing you to proceed with the PCT filing on their behalf, they informed you of a change in their business strategy and that they wish to keep “Embodiment 3” a trade secret. “Embodiment 3” is only disclosed as an example in the description but is not part of the patent claims. The patent claims cover only “Embodiment 1” and “Embodiment 2”.

(a) They have asked for your advice on the appropriate time to amend the patent specification to delete “Embodiment 3” from the patent specification. Before proceeding with the PCT filing, advise Feeckle-mind Pte Ltd, if after the PCT application has been filed, they are able to file amendments to delete only “Embodiment 3” from the patent specification and by so doing, keep “Embodiment 3” as a trade secret. Please advise Feeckle-mind Pte Ltd on how to maintain “Embodiment 3” as a trade secret. Please explain your advice with reasons and where appropriate, with reference to the relevant legal provisions. **(4 marks)**

(b) After some contemplation, Feeckle-mind Pte Ltd, had a change of heart and decided not to keep “Embodiment 3” a trade secret anymore. You then proceeded to file the PCT application as originally drafted on 1 March 2014.

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QUESTION 3

5 The International Search Report (ISR) mailed on 1 August 2014 has been received and indicated that “Embodiment 2” covered by claim 10 lacked unity with the remaining claims 1-9. Therefore, for ease of prosecution in the International Phase, Feeckle-mind Pte Ltd has decided to delete all instances of “Embodiment 2” from the patent specification, that is, both from the description, figures and claim set.

10 Please advise Feeckle-mind Pte Ltd on the possible avenues and timelines for the amendments during the International Phase and provide your client with your recommendation. Please explain your advice and recommendation with reasons and where appropriate, with reference to the relevant legal provisions. **(9 marks)**

15 (c) The PCT application subsequently entered into the Singapore National Phase on 1 October 2015. The description and claims directed to “Embodiment 2” were previously deleted in the International Phase due to the lack of unity objection raised in the ISR. However, Feeckle-mind Pte Ltd, now feels that the lack of unity objection raised in the ISR was not well founded and wishes to file pre-grant amendments to the specification to reintroduce the previously deleted content relating to “Embodiment 2” back into the description, figures and claims.

20 Advise Feeckle-mind on the timelines to make any pre-grant amendments in Singapore and the considerations that need to be taken into account. Is Feeckle-mind’s proposal to reintroduce the previously deleted subject matter relating to “Embodiment 2” back into the specification possible at all? **(7 marks)**

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QUESTION 4

X and Y have been buddies. After completing National Service, X worked in a fast-food outlet as a delivery man for Boss while Y is currently unemployed. Y frequented the fast-food outlet for breakfast takeaways and during one of the visits remarked to X that the bread toast from the fast-food outlet lost the crisp within minutes of leaving the café. After much discussion, X and Y decided to improve the takeaway bag for bread toast and spent their free time developing a prototype for an improved bag design. With the approval of Boss, who is the owner of the fast-food outlet, improved takeaway bags were produced and used at the fast-food outlet for bread toast takeaways. Customers soon discovered that takeaway bread toast could be kept fresh and crispy much longer than before. Sales of bread toast increased. Delighted at the sales jump over the next three months, Boss paid X a special bonus for his initiative and continued use of the improved takeaway bag design.

(a) To prevent copying, Boss considered seeking patent protection for the improved takeaway bag but found out that X had already filed a Singapore patent application which listed X as the sole inventor-applicant. Boss is of the view that since X has accepted the special bonus, Boss should be entitled to the patent application. Boss also found out about Y's involvement and informed Y of the existence of the patent application.

What advice and recommended course of action would you give Boss regarding his entitlement to the patent application? **(6 marks)**

What advice and recommended course of action would you give Y? **(5 marks)**

(b) After negotiation among the parties in view of the facts in (a), the parties came to an amicable agreement (details not available). The Singapore patent application subsequently recorded Boss and Y as joint applicants. Z, who owns a chain of F&B outlets, heard about the improved takeaway bag design. As Z and Boss are competitors, Z approached Y for a non-exclusive licence to use the improved bag in Z's outlets. On the same day, Y agreed to the licence and received the licence fee from Z in cash.

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QUESTION 4

What advice would you give Z regarding the licence agreement? **(2 marks)**

- 5 (c) Unknown to the rest, X developed another improved design on his own. To prevent Boss and Y from finding out about his latest design, X planned to file a PCT application in Malaysia. X sought the services of Registered Singapore Patent Agent BM who drafted his earlier application. X also learned that earlier on in (a), it was Patent Agent BM who had revealed to Boss unpublished details of X's earlier patent application.

10 What advice would you give X? **(7 marks)**

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QUESTION 5

Joel was a research student with High Tech University and developed a new water filtration technique during his study. Shortly before his graduation, he went to IPOS on 30 June 2014 and submitted his scientific paper (which comprises of a detailed description of the new water technique) together with a completed hardcopy of Patents Form 1. When submitting the application, Joel indicated himself to be the inventor and applicant although no claim or payment was provided.

- 5
- 10 After graduating from High Tech University, Joel started work with Cool Water Pte Limited and further developed the technique. His second patent application on improvements of the technique was drafted by and filed by his in-house Patent Attorney, Kristopher, and filed with the IPOS on 28 June 2015, as an international application under the Patent Cooperation Treaty. The international application claims the priority date of the earlier Singapore filing date. Claims 1 to 10 of the International application cover the basic concept as described by the initial Singapore filing, whilst Claims 11 to 15 encompass the improvements. Last month, Joel received an International Search Report and Written Opinion confirming that the first group of Claims 1 to 10 is patentable. However, the Examiner has refused to examine the second group of Claims 11 to 15 because of the lack of unity between the two groups. Joel and his in-house Patent Attorney, Kristopher did not respond to the Written Opinion.
- 15
- 20

Kristopher and Joel found your name on the official register of Singapore Patent Attorneys. They are considering whether to engage your service and have the following questions:

- (a) Joel understands that Singapore is a member state of the Paris Convention. However,
- 25 can this initial Singapore patent filing serve as the basis for the priority claim?

(3 marks)

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QUESTION 5

(b) Cool Water Pte Ltd is currently applying for loans to fund Joel's invention. To secure a higher amount of the loan, Joel informs you that they need to obtain grant of Claims 1 to 10 immediately. Joel intends to have two separate Singapore patents based on one national phase entry of the International application – A first Singapore patent based on the national phase entry application for obtaining grant to Claims 1 to 10; and a second Singapore patent based on a divisional application of the national phase entry application for obtaining grant to all 15 claims possibly by overcoming the unity objection after requesting Singapore local Search and Examination of the divisional application.

Is Joel's proposal workable? **(5 marks)**

(c) Can the future Singapore national phase entry application be granted based on the IPRP (Chapter 1) of the PCT application? **(4 marks)**

(d) Since working with Cool Water Pte Ltd, Joel noticed that there were 2 patents previously filed by Cool Water Pte Ltd, which would be compatible with the inventions he has come up with. The first of these two patents was due for renewal on 15 April 2014, and the second one was due on 21 March 2015. On checking with Kristopher, Joel was informed that management decided at that crucial time that they were not interested in renewing the patents. However, since banks may lend a higher amount if more patents are available for protecting the technology, the management of Cool Water Pte Ltd now wishes to revive these two past patents. **Today is 21 September 2015.**

Is it still possible to renew/restore these two previously granted patents now? Please advise what action needs to be taken and by when (fees and forms are not required to be discussed). **(8 marks)**

End