



Correspondence Address: c/o 11 Keppel Road, #09-01 RCL Centre, Singapore 089057

Tel: (65) 6227 8986 • Fax: (65) 6227 3898

Review of Patent Agent Regime
The Patent Agent Unit
Intellectual Property Office of Singapore
Registry of Trade Marks & Patents
51 Bras Basah Road
#04-01 Plaza by the Park
Singapore 189554

Attention: Ms Lily Lee

BY HAND & EMAIL

18 July 2011

Dear Colleagues

With reference to your letter of 24 May 2011, we thank you for inviting us to comment on the Review of the Patent Agent Regime, which may have a significant impact on this Association and its membership.

The Association's Committee has prepared the following comments for your consideration after seeking feedback from our members. The following utilizes the numbering of your 24 May 2011 letter when making our specific comments:

(a) GCIP

Summary Points:

- **We do not believe significant changes should be made to the GCIP**
- **Admission to sit the Qualifying Examination should be made only to those candidates who have achieved a pass in the GCIP or equivalent**

A required pre-requisite to be registered as a patent agent is to have passed the GCIP (or equivalent such as that provided by the Queen Mary Intellectual Property Research Institute). We believe that such a pass should be a pre-requisite for sitting the qualifying examinations. Only in that way will candidates have the necessary basic training.

It is our belief that the GCIP does not give the candidates sufficient legal training to be able to pass paper D of the qualifying examinations. Many years ago this lack of legal training was recognized in Australia and a special subject that had to be passed before the candidate could sit the remaining papers. The special subject was An Introduction to Legal Principles. It was based on the first year subject for law students at Monash University. The subject was compulsory pre-requisite for all

candidates who did not also have a law degree (a technical degree being an essential requirement). The requirement for the pass in that paper was only removed when the requirement for the Graduate Diploma in Intellectual Property Law as the GDIP included the subject. That subject included, and still includes, topics such as statutory interpretation, interpretation of cases, how to conduct case-law research, and the development of the law. From a consideration of the detailed syllabus of the GCIP on the web site of the IP Academy as well as discussions with those who have recently completed the course, we are of the opinion that any amendment of the GCIP syllabus should consider more focus in relation to statutory interpretation, interpretation of cases, how to conduct case-law research, and the development of the law.

(b) The Qualifying Examinations

Summary Points:

- **The content and conduct of the qualifying examinations should not be changed**
- **Candidates should have passed the GCIP and have undertaken a minimum of 24 months full-time training with a qualified Singapore Patent Agent before being eligible to sit the examinations**
- **Infringement should not be removed from Paper C**

We believe the subjects and the spread of topics is essentially correct. However, we wish to address the suggestion regarding Paper C that the aspect of infringement be removed. With that we completely disagree. Patent infringement actions in Singapore are relatively rare. This is in part due to the advice given beforehand – parties in Singapore will not proceed with litigation if they are given competent advice from an experienced patent agent that they won't win. How many patentees will proceed if they are given competent advice from an experienced patent agent that their patent is invalid and/or not infringed? How many alleged infringers will proceed if they are given competent advice from an experienced patent agent that the patent is valid and infringed? Also, most freedom-to-operate searches are accompanied by advice on infringement and validity of the patents located. Even prior art searches (both official and unofficial) may ultimately involve an experienced patent agent giving advice on infringement if one or more of the prior art documents are Singapore patents still in force. So being examined on the candidate's ability to give correct validity and infringement advice is of vital importance, particularly as patent agents are often the only people involved with the matter who understand both the law and the technology.

We have considered the Joint Examination Board system of examinations in the UK as they are the nearest to the Singapore Qualifying Examinations. After discussions with a number of Singaporeans who have or are attempting the JEB examinations, either after being registered as a patent agent in Singapore or in parallel with them sitting the Singapore Qualifying Examinations, we have a number of conclusions:

(i) the standard in the JEB examinations is generally higher than the standard of the Singapore Qualifying Examinations. Singaporean patent agents who attempt the JEB examinations after registration as a patent agent in Singapore are having some difficulty passing the JEB examinations, even after some years of on-the-job experience. Yet the pass rate for the JEB examinations is higher than in Singapore. Therefore, the standard in Singapore should not be lowered but, if possible, should be raised to the JEB standard. With the Government's objective being a knowledge-based economy, this is vital;

(ii) we believe most candidates for the JEB examinations start sitting the examinations after at least one year of on-the-job training and normally after having completed the course at Queen Mary College. Quite often the experience is more than two years. Most candidates are working under the supervision of a Chartered Patent Attorney who has qualified after passing the same examination system. This is not the situation in Singapore;

(iii) the number of examiners used per subject is less, and examiners tend to stay with the one subject for several years. This leads to a consistent approach in the setting of the examination making it easier for candidates. It also gives a consistent approach to the marking of the answer scripts; and

(iv) candidates are given their marks, not just a pass or fail. Those who fail are therefore aware of what is required to pass next year – a mark of 20 means they need to completely re-evaluate who they are approaching the subject, and a mark of 48 means they have to work a bit harder and fine-tune their approach. Candidates are also able to obtain a clean copy of their answer scripts. Until recently this was upon request and payment of a fee. Now it is free and automatic. This assists them and their supervisor establishing where and why they went wrong, thereby enabling a better chance at passing the following year. Most candidates believe that having a clean copy of the answer scripts would be helpful as by the time the results are released, most candidates cannot remember what they'd written.

The EPO examinations require 3 years of training before being allowed to sit their examinations. We understand this is being changed to an even harder system where 2 years of training are required before a candidate can sit a first-level of examinations, and only after that is passed can candidates sit the final examinations. We are of the opinion that, like the EPO examinations, candidates should have a minimum period being supervised by a registered Singapore Patent Agent before they are eligible to sit the Singapore Board Examinations. Similarly, in Germany patent agent trainees have to pass a two years law course in order to be allowed to sit the German patent attorney examination.

The experience of several members of the Examination Committee marking answer scripts is that many candidates are sitting the qualifying examinations well before they have any chance of being able to pass. There seems to be a belief that the examinations are easy, and the candidate's ability in examinations will enable them to pass. This is clearly not correct. Examiners have commented that many candidates for paper D had insufficient knowledge of basic prosecution procedures in Singapore, basic PCT procedures, and so forth. One examiner commented that many candidates seem to believe that as paper D is an open book examination they will have time to work through the Act and the Rules

during the examination to try to find the answers to the questions. This is a recipe for failure and candidates need to be cautioned against such an approach.

Accordingly, in view of the current pass rates for the qualifying examinations and in taking comments from successful candidates, past examiners and based on the practice in Europe and Germany, **our strong recommendation is that the minimum period for a candidate to be eligible to sit the qualifying examinations in Singapore be that the candidate has undergone at least 24 months full-time supervision by a Singapore Patent Agent.**

(c) **The Internship**

Summary Point:

- **The internship period should be raised from 12 months to 24 months**

The internship period cannot in any way be equated to the similar internship period for lawyers to become advocates and solicitors. A lawyer has 4 years intensive theoretical training in various aspects of law. A trainee patent agent has the GCIP. That's all. The internship period is hardly sufficient to give trainees an introduction to the main aspects of patent law, let alone how to run a practice, correct letter writing (at which engineers and scientists are notoriously bad), and all the other information, knowledge and experience required to be a good patent agent.

But the GCIP gives only a basic introduction to patent law and practice. Most of the qualifying examinations are directed at problems to be solved or advice given. It is therefore vitally important that candidates have the necessary experience to be able to have any chance of success. One problem is that some candidates have sat the GCIP immediately after their graduation in engineering or science but without being employed by a patent agent. They do so to enhance their employment aspects. When they start work for a patent agent they assume they can immediately sit the qualifying examinations.

In the past it has been suggested by a senior officer of IPOS that it is not the role of the GCIP to give candidates the necessary knowledge to pass the qualifying examinations. That knowledge was to come from their work experience under the guidance of a qualified patent agent. If that is correct, all candidates should be required to have at least two years of experience under the guidance of a qualified patent agent before sitting the qualifying examinations.

Therefore, the pre-requisite for being registered as a patent agent of 12 months pupillage under a registered patent agent should be amended to 24 months and additional requirements be added that the 24 months all be on patent-related work, and at least half be satisfied before the candidate can sit the qualifying examinations. We note that in the UK, it is necessary to have completed at least two years practice under professional supervision before one becomes eligible for entry on the Register. That example should be followed.

Any trainee who sits the qualifying examinations within the first 12 months is, effectively, wasting their time and that of the examiners. They have insufficient knowledge and experience to have any chance of passing.

Most of the knowledge to be used to answer all four of the qualifying examinations is gained through practical experience during their normal work. This takes time to obtain.

Despite the UK not having many more training systems or courses and their examinations being significantly harder, their pass rates are better. The most logical reason for this is that the patent profession in the UK has learnt over many years that sitting the qualifying examinations early will result in failures. So they normally start sitting the qualifying examinations after at least a year of practical experience and in-house training. As that is not happening in Singapore, we believe it must be forced onto candidates for their own good, and the long-term good of the profession in Singapore.

The qualifications required to be registered as a patent agent in Singapore need fine tuning to best serve the interests of all those engaged in the Singaporean patent system, including inventors and their employers. It is in the public's interest to have patent agents in private practice who have a sufficient and established knowledge of the basics of all aspects of patent agency work. To do otherwise is to ignore the public interest.

The public interest is paramount. The public should be entitled to believe that a registered patent agent has a core of competency that enables them to perform all aspects of their work competently and professionally. This is why the Code of Conduct was introduced. To register as a patent agent a person who has shown a lack of knowledge of the basics in at least one aspect is to betray the trust the public has in the patent agent profession.

Submissions from other members

We also enclose in Annexure 1, a copy of comments made by the firm of Marks & Clerk Singapore LLP for your consideration. It should be noted that the comments of Annexure 1 are the views and opinions of Messrs Marks & Clerk Singapore LLP and not of ASPA.

Yours sincerely



Kristian J Robinson
President

Encl. Annexure 1 – Submissions from Messrs Marks & Clerk Singapore LLP

Annexure 1

REVIEW OF THE PATENT AGENT REGIME

Comments – Prepared by the partners of Marks & Clerk Singapore LLP.

5a. GCIP

- a. Daniel Poh attended the first GCIP course and definitely found the course structure and content to be relevant and useful to provide me with the fundamentals of IP law without which it would be impossible for him to embark in this career. We presume the GCIP course has evolved over the years to stay relevant but if the purpose and syllabus of the course are still similar to the first one Daniel attended, it is definitely appropriate in our view.
- b. If there should be more focus on patent matters, this should not be at the expense of the weightage of other IP rights. IP is not only about patents. Indeed, the GCIP is primarily to train patent agents but in order to excel in his work, a patent agent needs to have at least fundamental knowledge of the other IP rights, copyright, trade mark/secret, confidential information etc. and we view the other IP rights to be important too. Based on the first GCIP course, in our view the balance between patents and the other rights is about appropriate. Even if registered patent agents cannot practice matters such as copyright, they need to know that these rights exist and what they cover since often when advising a client such matters come up and it is important that a patent agent knows when a matter comes up on which ancillary advice from a lawyer is needed.
- c. Following on (b) above, if there is something which should be added (not at the expense of the other IP rights), a suggestion would be an extra module to familiarize students with formal and procedural matters of filing applications. The GCIP is focused on substantive or "Black Letter" Law. Thus, such a new module can focus on the formal and procedural matters such as what criteria to obtain a filing date in Singapore, examination and grant fee deadlines etc and the different routes for examination, extensions of time, PCT regulations etc i.e. more on the Rules. This will provide more structured training for the would-be patent agents on procedural matters, which can be very important. This may not exactly be a module to train Paper D (or the other papers) but to assist the students to understand the procedural aspects of patent prosecution which, from our understanding, is missing in the GCIP syllabus.

5b. QE

- a. In our view, the structure of the QE is fine but the syllabus and standard should be reviewed. Daniel Poh can speak from experience since he has had the privilege of sitting and passing both the SGQE and thereafter the UKQE.

Firstly, the structure of having papers A to D is appropriate and they are important to test a candidate's skill and knowledge to be a patent agent. We believe that Paper C is as appropriate as the other papers. Infringement actions may be rare in Singapore, but this does not mean that the skill to provide an infringement opinion is not important. If a patent agent is unable to provide an infringement opinion, who would be more qualified? Thus, it is recommended that the four papers remain.

It is probably due to the fact that patent agents have training to advise on patent infringement and validity that many cases do not get to court, one way or the other, in the first place. Also you can't draft a claim properly unless you know what it protects which requires a clear understanding of infringement and validity.

Secondly, the syllabus should be expanded. Currently, at least for Paper D, the candidates are not tested on basic foreign law (for example, basic US law or EP law and practice). From our experience, clients are more likely to file in US than in Singapore, and a patent agent should have some basic understanding of the important jurisdictions which most Singapore clients file in. Also, if one compares the UK practice paper and the Singapore paper D, you will no doubt appreciate the difference. The UK practice paper focused very much on the candidate's ability to apply their skill and knowledge to practical issues which they are likely to face in their daily work, rather than simply knowing where to find the relevant provisions in the Act and Rules, which appears to be the focus of SG Paper D. Thus, a review of the syllabus is recommended.

For Paper A, the current focus is on claims, especially the main claims, with little focus on the detailed description – as evident by the distribution of marks. In our view, preparing a good description is as important as preparing a good set of claims – remember that the claims must be supported by the description. Also, a good description can provide good fall-back positions during the prosecution of a patent application. Thus, a proposal is to revise the syllabus so that candidates are tested on preparing a proper description and marks for the detailed description should be raised accordingly.

Thirdly, the standard of the QE should be raised to a level to test candidates whether they possess the typical skills and knowledge of someone who has continuously worked in the profession for at least 3 years, not the current "1-year" period (see below). Expanding the syllabus as suggested above is likely to raise the standard but the difficulty of the papers will have to be adjusted accordingly.

To clarify, "3 years" of skill and knowledge is not actually a time limitation per se. From personal experience and observations from the cohort who

entered the profession around the same time as me, as trainees, we add zero value during the first year and it is on the second and third year (and depending on when one completes the GCIP), that one really starts to understand the work of a patent agent. On the third year onwards, with suitable hard work, he is very likely to have gained sufficient knowledge and skill to be a competent assistant to a qualified attorney. This is the reason for the “3-year” period. However, if a person is bright and works extremely hard, he might be able to obtain the necessary knowledge and skill less than this time frame and thus, this expectation should not be a time-limitation but rather as a guide for setting the difficulty level of the QE papers.

Also, the importance is not how many people gets on the Register each year but instead, those who passed are indeed qualified to practice.

- b. Currently, there is no minimum requirement. Anyone can sit for the papers! As a start, since the QE is to qualify patent agents and the GCIP is a prerequisite to be a patent agent, a first mandatory requirement should be that candidates must have completed the GCIP. Secondly, a candidate must have the basic prerequisite to be a patent agent in order to sit for the QE – science or engineering degree. This will ensure that no Tom, Dick or Harry will simply apply to sit for the QE. Further, making it compulsory to attend the GCIP course first ensures that the candidates would most likely have undergone some form of training prior to sitting for the QE.
- c. To answer this question, we should look at the current training regime and the trainees’ work exposure.

To begin, we must agree that there are patent agents with technical degrees and these are the patent agents who draft and prosecute patent applications on a day to day basis, and there are patent agents who are IP lawyers (without a technical degree). By prosecuting a patent application, this primarily means preparing a response to an office action as what is required in Paper B.

For the latter group, it is unlikely that they have experience in drafting and prosecuting a patent application and we will refer them as “IP lawyers” here. Depending on the technical complexity of a patent, it is also unlikely that an IP lawyer would be able to provide an infringement opinion as in Paper C.

Currently, trainees may be employed by:

- I. Law firms supervised by IP lawyers, or perhaps a foreign qualified patent attorney under the mentorship scheme;
- II. IP firms with a number of qualified patent agents; or

III. Companies as an in-house IP manager.

On the job training for Groups I and III trainees might be limited. For Group I, The IP lawyers are unlikely to have the skill and knowledge to coach the trainees on the skills of drafting, prosecution or how to interpret the claims of a patent. This is where the mentorship scheme comes in, you may add, but training someone takes a few years (as mentioned above) and the 2-year period may not be sufficient. Also, most of these firms have just 1 qualified attorney under the mentorship scheme and this places a constraint on the number of trainees which he/she can mentor for the mentorship to be effective. For Group III, from our understanding, it is highly unlikely there is a structured in-house training for such trainees and more often than not, they rely on external training programmes.

The opportunities for on-the-job training for Group II trainees are much better since such firms usually have a number of qualified patent agents who understands the profession and appreciates the difficulties of being a patent agent. However, times have changed considerably since 1995 when the current patent regime was started.

With the financial crisis two years ago, clients have emerged from the crisis looking at ways to reduce costs and nowadays, clients also want faster turnaround of work. There is also more competition among local firms, with more smaller IP firms being formed in the past 2-3 years. Thus, IP firms have to look at ways to perform work in a much more efficient and productive manner in order to remain competitive. On the job training of trainees is not an efficient process as the time to tutor a trainee usually is more time-consuming than if the work is done by the qualified attorney. As a result, this poses a constraint on how fast a trainee can gain the necessary knowledge to qualify as a patent agent.

In view of the above, a more structured training programme should be made available to potential candidates.

As far as we are aware, the IP Academy runs a training course to prepare candidates primarily for the UK QE since the exams were made available in Singapore (the course should also be relevant for the SGQE). The course is tutored by overseas and local patent attorneys and this does add a certain amount of overhead to the costs of running the course and it is no wonder the fees for the course are very expensive. From what we have heard, the course is not well attended, one possible reason might be the high course fees.

In our view the course run by the IP Academy is similar to courses run by private bodies in the UK (eg. JDD) which offers candidates an alternative to courses run by CIPA, which is the professional body for UK patent

attorneys, which is what is lacking currently in Singapore. CIPA is also the professional body which administers the UKQE (via the Joint Examination Board).

In Singapore, there are a number of IP associations (APAA, AIPLA, AIPPI, ASPA etc) but the only association primarily for Singapore patent agents would be ASPA, broadly the equivalent of CIPA of the UK. However, the regulatory body for Singapore patent agents is the responsibility of IPOS, not ASPA. Of course, the ideal is for ASPA to take over the regulation of Singapore patent agents but in our view, this ideal is a remote possibility at this stage. Thus, in the interim, IPOS and ASPA should work hand-in-hand to provide a structured training programme which is primarily aimed at SG QE and will be a cheaper alternative to the course run by IP Academy.

d. How to do this?

ASPA definitely has members who are qualified to train – note the number of ASPA members who are serving or who have served as examiner for the SGQE. However, ASPA is still a relatively small organization compared to the other IP associations which have strong links with counterpart organizations in other countries. Thus, ASPA lacks resources and funding.

It is easy to say that members of ASPA should serve as trainers pro bono but as suggested earlier, this is easier said than done in view of the existing competitive environment. In any case, the trainers should be compensated for their time (but not rewarded).

This is where IPOS can come in.

As the regulatory body for patent agents, IPOS collects yearly fees for renewing certification of qualified patent agents and also at the same time collects fees for conducting the SGQE. Such fees can be used to fund training programmes conducted by ASPA. There are easily 100 patent agents on the register and based on the yearly fee of S\$150 per agent, this translates to S\$15 000 in yearly fees which can be used to fund the training programmes. IPOS also have the facilities which can be used to conduct the courses.

Further, the courses should not be a one-off module over say 2/3 days. It should be over a period of time, say 2-3 months. A course which we can learn from is the SEAD drafting course. We understand there have been many critics of the course. From the course notes and material, we find that the course does provide a structured programme to equip candidates with the fundamentals of drafting which sometimes is lost during the hectic and stressful working environment which on-the-job

training cannot offer. With these fundamentals, it would help candidates progress much faster up the learning curve.

The proposal is not to bring back SEAD drafting but to learn from the merits of having such a course and to start sometime similar for the QE papers. With the expertise of ASPA members and the resources of IPOS, in our view, this is possible.

5c. Internship

- a. In our view, having a 1-year period internship as a gate to being a qualified patent agent is pointless – as mentioned, almost all trainees will require more than 1 year of training.

Often it is stated that passing the UK exams is the start of the learning process to becoming a patent attorney, not the end.

Currently, with the 1-year internship, a misconception seems to be that once a trainee has one year of training, he or she is ready to sit for the QE. Thus, it seems to suggest that the QE is set at a level aimed at someone who has just about a year's skill and knowledge.

However, the reality (again speaking from experience) is that a trainee without prior experience in IP would not add any value during the first year and after completing the GCIP and into the second or third year of continued exposure would he gain sufficient knowledge and skill to add value to the firm. Thus, there is no meaning to the 1-year internship period and the recommendation is for it to be abolished.

- b. As explained earlier, trainees can be employed by different firms/companies and thus, the quality and supervision of trainees varies greatly. In theory, trainees in IP firm with a number of qualified attorneys are likely to have more exposure and quality supervision but this also depends on the commitment of the firm. Thus, it is difficult to provide consistent quality training across the industry. As a result, providing a structured training programme as suggested above might be the way to go.
- c. We suggest abolishing the 1-year internship requirement as it serves no purpose but use the SGQE as the main gate to determine whether a person is ready to be "let loose" as a patent agent. As discussed earlier, the difficulty of the SG QE should be at a level to test someone who has received continuous training for about 3 years which is when he is likely to be a competent assistant.

- d. As an alternative to an internship, we recommend introducing a "threshold" to sit the SGQE. Due to the differing background of candidates we suggest three thresholds, being:
- i) A minimum time, say 2 or 3 years, between passing GCIP and sitting the QE's, and so they are forced into applying the foundation law principles in preparing for the QE's (similar to the EPO QE);
 - ii) At the time of applying to sit the exams, for each paper the candidates have to submit a declaration that they have;
 - drafted 5 or more specifications (to allow them to sit Paper A)
 - prepared responses to 20 or more WO's/OA's (to allow them to sit Paper B & D);
 - prepared opinions on infringement or validity for 5 or more patents (to allow them to sit Paper C);
 - iii) A declaration from the supervising patent agent that, in their opinion, they believe the candidate is capable of passing the exams based upon having met some subjective measure (perhaps with guidelines by IPOS or ASPA).
- e. Also providing a proper career path for patent agents is as important as training them. In particular allowing mixed partnerships of patent attorneys and lawyers, who often work together closely would allow patent attorneys to pursue full career paths in law firms as well as in bespoke patent attorney firms making the profession more attractive to talent.