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Notes in relation to the Discussion

Held on 2 February 2010, Tuesday, 4.00pm at Anson II (Level 2), M Hotel Singapore

In relation to Amendments of the Patents (Patent Agents) Rules

And the Code of Conduct

A. Amendments to the Rules other than the Code of Conduct

1) In relation to the amendment to Rule 10 and in particular in circumstances under which a practising certificate ceases to be in force under (2)(B), and with reference to the composition of offences under Section 103, if there has been an error in relation to Section 34 and a request for composition has made under Section 103, the Registrar may issue a notice to the applicant requesting a fine. Upon the person paying that fine no further proceedings can be taken against them. However, the patent agent in Singapore is normally not mentioned and thus there is a continuing exposure for the patent agent due to the reference to “caused to be filed”.

It was felt that it would be appropriate for the IPOS practice to change so that the composition under Section 103(3) extends to the Singapore patent agent.

2) All the references are to cancellation of a practicing certificate. How can a person's name be removed from the Register of Patent Agents? As far as was able to be determined Rule 20(6) is the only provision. What happens when the person who is registered as a patent agent happens to die? Or those who are fully retired and who no longer wish to remain on the Register (particularly if they are no longer capable of acting)? We believe it is important to include voluntary cancellation, and the power to remove on death. In this way the Register of Patent Agents will not be cluttered by persons who have no longer any interest in remaining on the register.

It is also suggested that there be an annual fee payable to retain one's name on the Register of Patent Agents. In this way all a patent agent would need to do – whether in private practice or in-house – was get qualified and pay their annual fee. If they implemented this then perhaps the practicing certificate would even become redundant. It was acknowledged that none of those qualified overseas was required to have a practicing certificate. The only reason for it is to distinguish between those who are required to have professional indemnity insurance as those who are not so required. This is easily overcome in the form by a simple declaration.

At present those in private practice have to file a form and pay a fee for a practicing certificate. There could be an appropriate line added to the form, and maybe an extra fee payable, for that to include maintaining their registration as a patent agent. For those not requiring a practicing certificate but who

are practicing in Singapore, a separate form would need to be filed and a fee paid. In that way many of those who have long ago left Singapore and returned to their home countries, who have left the profession, or who have retired, will face a decision whether or not they want to remain on the Register of Patent Agents in Singapore. If not, they will not pay the fee and their name will be removed from the Register of Patent Agents. This will again prevent cluttering of the Register for an indefinite period of people who have no interest in ever again practising as a patent agent in Singapore.

B. Code of Conduct

1) General

(a) It was felt that many of the provisions should also apply to those who do not have a practising certificate. For example, the provisions of Clauses 2(1), 2(4), 3(1), 3(2), 5(1) to 5(3), and 12(2). It would be relatively simple to divide the Code into two portions where portion A contains all provisions applicable to all patent agents, and a second part for those provisions that relate solely to patent agents in private practice (i.e. those that relate to their relationship with their clients) and which would therefore only relate to those who have a practising certificate. For example, an in-house patent agent may be handling a revocation action with the other party being represented by a patent agent having a practising certificate. The in-house patent agent would not be bound by the code. This may lead to inconsistencies.

(b) It was also felt that the practice of Registrar in having the Register of Patent Agents distinguish between those who have a practising certificate and those who are without a practising certificate by using bold as against plain fonts were not quite clear. It will be far clearer to the public if the Register could be in two parts – Part A would be those patent agents having in force a current practising certificate and therefore able to act for the public; and a Part B for those patent agents who do not have a practising certificate and therefore are not entitled to act for the general public.

(c) There is a significant amount of work that is being performed for Singapore entities by patent firms not based in Singapore, and that are based overseas. Those firms are not bound by this Code. Our members are aware of several instances where Singapore-based applicants engage US-based attorneys for drafting and filing in the US. Often there are breaches of S34. This may be very harmful to the applicants and possibly to the Republic of Singapore. They come to Singapore, work in Singapore, and leave. There needs to be a general provision that the Code applies to all persons who are conducting patent work in Singapore for and/or behalf of clients in Singapore or elsewhere. In this way foreign firms who do the work for Singaporean applicants are also bound by this Code. However, the foreign firms may be acting in contravention of Section 105.

(d) It is also felt that any decision of the Disciplinary Committee should be subject to appeal. As has recently been seen, a decision of the Disciplinary Committee was reinforced by criminal action taken against the party. As the decision of the Disciplinary Committee may be to remove the patent agent's name from the Register on a permanent basis, it is depriving the person of their livelihood. There should be the ability to have an appeal to a prescribed court in the event that the patent agent concerned feels that the decision is wrong at law or in fact. The

Disciplinary Committee has only three members and only one of those three members has legal training.

(e) It needs to be clearly stated in the Code, or any guidelines to the Code, that the “reasonable man” test should be applied when interpreting the Code. However, in Clause 11 there is reference to “reasonable steps”. The fact that “reasonable” is deliberately used in Clause 11 but is used nowhere else implies that it was intended not to be used anywhere else. As such, there may need to be a general, overriding statement that the “reasonable man” test is to be applied whenever the Code is being interpreted.

(f) Throughout the Code there is use of “qualification” and “expertise” and their grammatical equivalents. At times it is felt that the two are used in an interchangeable manner. One patent agent might have qualifications but no expertise and another patent agent may have expertise but no qualifications. A further patent agent may have qualifications in one area of technology and expertise in another. Qualification does not mean expertise, and expertise does not mean qualification. For example, in Clause 2(5) a patent agent lacking certain expertise must recommend that a file be transferred to a patent agent who is qualified. The initial patent agent may be qualified but lack expertise; and the one recommended may also be qualified and lack expertise!

(g) What is meant by “technical expertise”? This may relate to expertise in the techniques required to do the work. When dealing in patent matters, one must not only have expertise in patent law, and expertise in the technology, but also must have expertise in the forms, procedures, deadlines, fees, and so forth. This could be considered as being the technique of doing the work and thus be the technical expertise. Alternatively, it was felt “technical expertise” meant expertise in the technology of the invention. However, is this required to be at the level of an expert? It is generally accepted that the level of “expertise” required was to have a sufficient level of knowledge and understanding of the technology to be able to professionally deal with the matter in hand.

(h) The reference is always to having the requisite expertise (including technical expertise). Therefore, the requisite expertise may include many different forms of expertise that are required, one of which is technical. This may require explanation by way of a guideline. We are in favour of a reasonably broad interpretation of “technical expertise”. As expertise can be obtained by experience as well as qualifications, a patent agent may have fairly narrow formal technical qualifications, but may practice across a broad range of subject matter by virtue of having a technical education and training and applying that across a broad range of technologies, many of which are relatively simple to understand. Naturally professionalism is required and a patent agent should not handle work where they are unable to understand the technology and the language of the technology.

(i) Rule 2 of the Patent Agent Rules defines patent agency work to be any of the following:

- (i) applying for, or obtaining, a patent in Singapore or elsewhere;
- (ii) preparing specifications or any other documents for the purposes of the Act or the patent law of another country; or
- (iii) giving advice (other than advice of a scientific or technical nature) about a validity, or infringement of a patent.

Given that it relates to “or elsewhere” and, also, the “patent law of another country” as well as the requirements for the patent agent to have qualifications and/or expertise, it is felt that there is a significant need for there to be an appropriate qualification able to be attained by Singapore patent agents in foreign patent law and practice. We acknowledge that expertise on foreign law is what foreign attorneys are for, but there needs to be a basic level of understanding of the major issues as they apply to those countries in which our clients regularly file.

It establishes by qualification their ability to be able to deal with the procedures and formalities in filing patent applications in another country and prosecuting those applications to grant. Many countries have a foreign law component in their qualifying examinations. Singapore does not. When the writer passed the qualifying examinations in Australia, one subject required to be passed was “The Patent and Trade Mark Law of Countries other than Australia”. Therefore, by virtue having passed that qualifying examination the writer may be understood as having qualifications enabling the writer to deal with the procedural and formal issues in relation to a foreign application. As a Singapore patent agent has not passed a similar examination, it may be considered they have a lack of requisite qualifications. Therefore, in view of the requirements of the Code, it is strongly recommended that the qualifying examinations be expanded to include a foreign law paper. Due to the number of patent agents with foreign origin, and patent agents who have considerable experience in filing and prosecuting applications in other countries, we believe that setting and marking such an examination paper will not be difficult. It should be directed at a basic knowledge of core issues and does not require a detailed knowledge of all of the detailed aspects in all countries. Furthermore, in view of the requirements of the Code, there may need to be some control over any suggestion that a patent agent has obtained the necessary expertise merely by attending a number of conferences in other countries.

(j) There are also instances where not one patent agent but two or even three may be required to be involved in a matter due to the complexity of the technology. For example, the writer was involved in a matter where the inventors were three professors from different disciplines. Naturally, as the patent agent leading the drafting of the specification it was my responsibility to ensure that everything was correct.

(k) Some clients may have in-house patent agents, or personnel having considerable experience and expertise in patent matters. They should be able to waive those requirements of the Code they understand. Naturally, prudence dictates that the waiver be in writing. Also, can we give clients general advice once only and rely on that for all subsequent cases?

2) Individual Clauses

2(3) It is intended that this clause requires not only qualifications to practice but qualifications and expertise to handle the matter? The only qualifications to practise are for the patent agent to be on the Register of Patent Agents and to have in force a practising certificate.

2(4) There are many aspects of the work that we do that require knowledge of the technology of the invention. Whether this is required to be competence or expertise is an interesting question. It is noted that the Professional Standards Board’s Code of Conduct for patent attorneys in Australia uses the word “expertise”. It is believed the wording in the requirements for advocates and solicitors in

Singapore is “competence”. However, if “technical expertise” is taken to mean at least some significant degree of competence in the technology of the invention this may precluded patent agents who hold legal qualifications but no technical qualifications from being able to do patent agency work that requires an interpretation of the specification and/or claims. This would include drafting, amendment, validity opinions, infringement opinions, determining the sufficiency of the description and the best mode of performing the invention, determining inventorship, support for the claims by the description, related claims, double patenting, and compliance with the requirements of Section 30. It was suggested that advocates and solicitors who are also patent agents but who have no technical qualification may be better off not renewing their practising certificate. They could rely on being intellectual property lawyers specializing in patent law and practice, but not call themselves patent agents. What is the point of maintaining a register of patent agents having very stringent standards which must be met, both to gain entry thereto and maintain entry thereon when others can do the same work but not be bound by this Code. Is this what is intended?

2(5) This seems to imply that patent agents without a technical qualification cannot rely on the technical qualification of employed staff who are not Registered Patent Agents. This is particularly so when read in conjunction with 2(1) and 2(4). Is this what is intended? However, the drafting, amendment, and validity and infringement papers of the qualifying examinations relate to simple mechanical technologies. It may therefore be justifiable for a patent agent who does not have the relevant qualifications or expertise to be able to handle applications in those areas as they have dealt with them with demonstrated capabilities in the qualifying examinations. This is also one area where there may be a need for a client waiver.

Also, the wording “any requisite expertise” may mean that if the patent agent is required to have, for example, three areas of expertise to deal with the matter but has only two of them, they must make the recommendations for a transfer to the client as they lack just one area of expertise; or may mean they need to lack all three areas of expertise before they must make a recommendation for transfer to their client. What is intended?

3(1) Many firms have a structure whereby the non-professional support staff are employed by a service company that provides support services to the patent agent firm under a contract of service. In this case, the support staff are not employees of the patent agent but are employees of a firm contracted to the patent agent agency. Although not covered by 3(1)(a) it will, no doubt, be covered by 3(1)(b). In relation to 3(1)(b) there was some concern over “impliedly sanctioned” and exactly what that meant. It was felt that it may be best to keep it broad by having “which is sanctioned by him”; and have guidelines qualifying in what way it may be sanctioned.

3(2) How active is “actively supervise”? For trainee patent agents, patent executives and the like, lawyer patent agents do not have the requisite technical background to ‘actively supervise’ trainee patent agents. If the trainee confuses terminology (e.g. absorb vs. adsorb; continuous vs. continual) could the lawyer patent agent detect and correct the error? We believe not.

4 There was considerable discussion on the “shall ensure” and the onus is it again places on the patent agent to ensure that the qualifications of appointed firms are exactly what they say. If a person, for example, in The Philippines or Indonesia represents that they are qualified to handle patent work and they are admitted to practise before the relevant patent office (if required) should we be required to go behind their representations to us? Naturally we can check websites but should we also check to

see if there is a Register of Patent Agents/Attorneys in that country and they are registered? If such a register exists, there may be language difficulties in considering any relevant database. This is particularly so in countries where patent work is mainly handled by lawyers without technical expertise. Can we rely on memberships of relevant organizations such as APAA, FICPI and so forth? It was felt that the words "shall ensure" should be "shall take reasonable steps to ensure".

5 The word "at all times" seemed to be overly broad and implied that this is something that operates twenty-four hours a day, seven days a week, fifty-two weeks of a year. Should that wording be limited to be "at all relevant times" or similar wording that states that it is only where they are doing patent agency work that this applies?

5(2) What is required to be understood should include all of those areas that are contained in the syllabus of Paper D of the qualifying examinations. There should be consistency. For example, it is felt they should include at least PCT and the Paris Convention. Also, should not "practices" be "published practices"? It again raised the issue whether we should start considering some form of requirement for continuous professional development. However, the overlying impression of the meeting was that if you do not keep up with these items you deserve the fate that awaits you.

5(4) What many local clients (particularly individual inventors and SMEs) want is recommendations as they have no expertise in patent matters. This sub-clause may be to their detriment as we can't make recommendations as if we do, we have to provide detailed advice. How detailed should that advice be? What are the implications of doing so? E.g. before national phase entry do we have to explain the procedures, costs and timings for over 130 countries? Should it be enough to give a reasonable understanding by a reasonable man of what is likely to happen, about when and about how much over a reasonable period? Should we try to foresee all possible implications of filing in all PCT countries? Can we charge for it?

5(5) If a patent agent is required to provide a detailed estimate of the costs for acting in a matter, if requested, how detailed, and how far into the future is the estimate required to go? This needs clarification. The reasonable man test again? The advice may have to include many hypothetical situations. Can we charge for it as the client asks for it? Again, it doesn't apply to those without a practising certificate.

5(6) It may be considered an unnecessary increase in cost to have an overseas agent do the work that could be less expensively performed in Singapore. However, that may conflict with Clause 2. It is also somewhat timely that on Wednesday, 3 February 2010 there were articles in the press in Singapore about two lawyers who were convicted of inappropriate activity, one being overcharging. The overcharging seems to have been by a factor of about 3.

When dealing with such issues will the Disciplinary Committee refer to decisions of Disciplinary Committees in similar professions in Singapore (such as the legal profession) or would decisions of disciplinary tribunals in jurisdictions having similar patent agency professions and practice requirements (such as the Code of Conduct) be considered? Or would it be a mixture of both?

5(8) The information to the client should cover a sufficient time to enable the client to be able to deal with overseas agents or to engage another patent agent in Singapore who could take up the work and be able to quite quickly and easily attend to any urgent matters. However, the practice of IPOS for Singapore applications if the patent agent withdraws is to continue to forward all correspondence to that agent until a new PF41 is filed. Can the withdrawing agent file a PF41 giving the applicant's name and

address? That would work for a Singapore applicant but would not work for an applicant based overseas.

6 What is meant by touting. One member believed that “cold calling” was considered to be a form of touting. Another member advised that after reading books on business development he never come across even the suggestion that a service provider introducing himself to a service user was in any way unprofessional or unethical. It should, however, be handled with care and in the best possible taste.

Yet many overseas patent firms approach Singapore entities to do their patent work for them by cold calling. Are they therefore not guilty of touting? Should not action be taken against them? They can do it but we can't?

8(1) We have not been able to determine if there is any applicable accounting standards made or formulated by the Accounting Standards Council under Accounting Standards Act. The Accounting Standards Council was invited to our discussion but did not attend. Their website has been considered and we cannot find any reference to any relevant standard. As we could not determine the answer to this question, is IPOS able to advise if such a standard does exist?

8(2) It should be subject to any written waiver obtained from the client.

9(1) What happens if the law and the interest of the client are in conflict? A guideline is required to determine priority when there is a conflict.

9(3) One difference between a legal profession and a patent attorney profession is that when we file a patent application it is eventually published. Anyone can search international databases under the name of a firm and find out the clients they represent and the cases filed. This sub-clause seems to prevent us from listing the clients we represent even though that is publicly available data. The European Patent Attorney code of conduct allows a European Patent Attorney to make reference to a client with the client's permission. Should there not to be a guideline to say that if information is in the public domain then it is useable?

9(4) This does not include responses that may be significantly limiting the claims in the client's patent application.

9(5) It is believed that in Singapore within the legal profession, when transferring files, lien of the transfer is protected by the receiver. However, the patent profession in many countries does not transfer the files until all outstanding issues with the client are resolved. For example, if the client owes the patent firm money the patent firm will not transfer the files to another party until those monies are paid, or there has been an agreement with the client. Should the practices of the patent agent profession in Singapore represent or reflect those of the legal profession in Singapore, or should they reflect the practices of the patent profession in other countries?

12 In reference to “or any other person” can be interpreted in two ways: any other person of the same genus as the Registrar, the Registry and the office; or literally any other person. If it is the former then it would include foreign patent offices, the International Bureau, and other such organisations. In general we do not deal with foreign general we do not deal with foreign patent offices – but we deal with the International Bureau. If it is the latter, it is excessively broad and would include, for example, our relationships with our staff in our office.

In 12(3) the use of the “lead to a wrong conclusion”, “create a false impression” and “omit or

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conceal relevant information” may include a patent agent not disclosing relevant prior art to the Registrar or PCT examiner. A duty of candor applies under US law on US patent attorneys (they must reveal everything to the US patent office which is material to patentability) but it is not Singapore law. This is broader than even US law. It is a higher duty than to our clients; and a higher duty than would apply to lawyers in practice. Again, guidelines may be used to restrict interpretational problems.

Your further advice is awaited.

A handwritten signature in black ink, appearing to read "K. Callinan", followed by a period. The signature is written in a cursive, flowing style.

Keith Callinan
President