



YUSARN AUDREY

PATENTS IN SINGAPORE:
REGISTRATION, INFRINGEMENT AND REVOCATION



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I. INTRODUCTION

This brochure is intended to provide some useful information regarding the registration and protection of patents in Singapore based on the prevailing laws.

II. THE PATENT APPLICATION / REGISTRATION PROCESS IN SINGAPORE

A. Brief Overview Of Application / Registration Process

A patent is an exclusive legal right protecting inventions such as devices, methods, processes, compositions and systems. Patents are territorial rights and only have legal effect in the jurisdiction where they are registered. Therefore, Singapore patents cannot confer overseas protection and similarly, foreign registered patents cannot confer protection in Singapore unless a Singapore patent for the same invention has also been obtained.

To obtain a Singapore patent, a patent application will have to be lodged with the Intellectual Property Office of Singapore ("IPOS"). An applicant will have to provide a specification comprising a description which describes the invention and provides at least one embodiment of the invention, any drawings that supplement and assist with the understanding of the description by illustrating the invention, claims that define the matter for which protection is sought, and an abstract that summarizes the invention.

The applicant will also have to indicate how the rights to the invention were derived from the inventor(s), for example via assignment or contract(s) of employment.

If the invention relates to and/or uses a micro-organism, the name of the international depository authority, the date when the culture of the micro-organism has been deposited and the accession number of the deposit has to be included in the specification.

After the patent application has been filed and the requisite fees have been paid, the patent application will be accorded a filing date. The filing



date is important at least for the purposes of assessing the patentability of the invention against prior art.

The patent application will be published as soon as possible after the expiration of 18 months from the filing date.

Once the patent application is filed, it will be examined / reviewed by IPOS for formality. Once a patent application has complied with all the formal requirements, the patent application may proceed to the examination stage. This process is conducted by IPOS's Search and Examination Unit, which has been awarded the internationally recognized *ISO 9001:2008* certification for Quality Management System.

B. Examination Process

Singapore patent law provides for three routes to comply with substantive examination requirements:-

- Local Route: the application undergoes either a search-then-examination process or a combined search-and-examination process.
- Foreign Route: a supplementary examination is conducted based on the final search and examination results of a corresponding foreign patent application, related foreign national phase application or corresponding international application.
- Combination Route: the application undergoes an examination based on the search results of a corresponding foreign patent application, related foreign national phase application or corresponding international application.

Local Route

Under the Local Route, a local examiner will substantively search and examine patent applications according to requirements under Singapore patent law, which includes, *inter alia*, novelty, inventive step, industrial application, clarity, and enablement.



Patent applications which go through the Local Route typically result in robust Singapore patents because of the substantive nature of the search and examination process. It is relatively more expensive to proceed under this route. A combined search-and-examination will, however, be cheaper than a search-then-examination.

Foreign Route

An applicant who wishes to proceed under this route may either request for a supplementary examination based on:-

The final search and examination results ("Final Results") of a corresponding foreign patent application or related foreign national application; OR the International Preliminary Report On Patentability ("IPRP") of a corresponding international application, or the international application from which it derives, if the Singapore application is a Singapore national phase application.

The foreign route requires the following conditions to be met:-

- each claim in the Final Results or IPRP relied upon appear to satisfy the criteria of novelty, inventive step (or non-obviousness) and industrial applicability (or utility); and
- each claim in the Singapore application is related to at least one claim set out in the Final Results or IPRP of the corresponding international application, international application from which it derives, corresponding foreign patent application or related foreign national phase application.

Under supplementary examination, the Examiner will not re-examine the claims and the cited prior art documents to determine if they satisfy the criteria of novelty and inventive step (or non-obviousness). However, the Examiner will conduct a supplementary examination to determine that:-

- the claims relied upon are supported by the description;
- the claims of the application are related to the claims relied upon in the IPRP or the final search and examination results relied upon;



- there is no double patenting;
- there is no added subject matter;
- the invention would not encourage offensive, immoral or anti-social behaviour; and
- the invention is not a method of treatment of the human or animal body by surgery or therapy or of diagnosis practised on the human or animal body.

The foreign route is typically the most cost effective route because no official fees are payable. Applicants who wish to take advantage of the foreign route may wish to do so expeditiously to minimize costs. However, as the claims are not substantially examined based on requirements under Singapore law, the patents obtained may be relatively less robust.

IPOS plans to close the foreign route to streamline the Singapore patent regime. Consequently, Singapore applications filed after an Implementation Date, presently 1 January 2020, will have to be substantially examined by a local examiner for compliance with Singapore patent law in order to obtain grant.

Combination Route

Under the combination route, the applicant files an examination request based on:-

- the International Search Report (ISR) and any supplementary search reports issued for a corresponding international application or the international application from which the Singapore application derives, if the Singapore application is a Singapore national phase application; or
- the final search results of a corresponding foreign patent application or related foreign national phase application.

A 'corresponding application' and 'related national phase application' are defined as follows:



A “corresponding foreign application” is a foreign application which is:-

- linked by priority to the Singapore application; and
- filed before the patent offices of Australia, Canada (if filed in the English language), Japan, New Zealand, Republic of Korea, the United Kingdom, the United States of America; or the European Patent Office (if filed in the English language).

A “corresponding international application” is a PCT application which is linked by priority to the Singapore application.

A “related foreign national phase application” refers to a national/regional phase application which is:-

- derived from the same PCT application as that of the Singapore application, where the PCT application is not subject to any priority claim; and
- filed before the patent offices of Australia, Canada (if filed in the English language), Japan, New Zealand, Republic of Korea, the United Kingdom, the United States of America; or the European Patent Office (if filed in the English language).

IPOS’ Examination Efficiency - For patent applications that are first filed at IPOS, a first search and examination report can be obtained in about 60 days, a significantly short amount of time in view of the time taken by other IP Offices.

With this accelerated search and examination process, businesses and innovators can have a fast and comprehensive assessment on the merits of their invention, and advance their business interests early to compete in global markets.



C. Patent Prosecution Highway and Worksharing

To further aid businesses and innovators, IPOS continuously makes efforts to establish links with key global partners to create platforms for cooperation. These efforts have led to the establishment of:-

- ASEAN Patent Examination Co-operation ("ASPEC")
- Global Patent Prosecution Highway ("GPPH") network
- Other Patent Prosecution Highway ("PPH") networks
- Patent Cooperation with Cambodia
- Singapore as International Searching Authority ISA and International Preliminary Examining Authority IPEA

D. IPOS as receiving office for PCT applications and making a PCT request and application in Chinese

Applicants who are nationals or residents of Singapore can file a PCT application with the IPOS as a receiving Office of the International Bureau.

In particular, as of 1 September 2015, Singapore was the first in the ASEAN region to be appointed as an ISA. Applicants who select IPOS as the ISA can expect quality examination reports because the examiners, 95% of whom are PhD holders, have deep technical expertise. In addition, IPOS's examiners can conduct searches in English and Chinese. This is advantageous because of the growing number of patent applications filed in China that can serve as prior art.

With effect from 1 January 2017, IPOS announced that applicants can file a PCT International application using Chinese as a language. This includes filing a PCT Request Form (PCT/RO/101) through Singapore as the receiving office. International applications filed in Chinese will have the search and examination conducted in Chinese at the IPOS in its capacity as the International Searching Authority and International Preliminary Examining Authority. The final International Preliminary Report on Patentability will be issued in Chinese. However, applicants may indicate by way of a cover letter to IPOS should they wish to receive the final report in English.



With the ability to file an International application using Chinese, potential applicants now have the opportunity to delay incurring translation costs, obtain IPRP for their international applications at the IPOS and use IPOS' existing patent prosecution highway routes to file corresponding patent applications in regions such as China or ASEAN.

Furthermore, where the IPOS benefits from an earlier search, for example, a search conducted on a Singapore priority patent application, up to 75% of the international search fees may be refunded, depending on the extent to which IPOS benefits from the earlier search.

E. Patent re-registration in Cambodia

The Singapore patent proprietors can now re-register their Singapore patent with the Ministry of Industry and Handicraft ("MIH") of Cambodia, subject to the following conditions:-

- the Singapore patent must be in force at the time of lodgement of the re-registration request;
- the Singapore patent must have a filing date on or after 22 January 2003; and
- the Singapore patent must meet the Cambodian requirements for patentability.

F. Patentable subject matter and Industrial applicability

The Singapore Patents Act ("the Act") does not provide a list of subject matter that are excluded from patent eligibility.

However, the Patents Act provides for certain specific exclusions to patentability where a method of treatment of the human or animal body by therapy or surgery or of diagnosis performed on the human or animal body is considered *not to be capable of industrial application*.

Notwithstanding the above, a substance or composition can be considered industrially applicable even if its intended purpose is for use in an excluded method of treatment.



G. Caution in using supplementary examination based on EPC 2000 format for medical use claims

While Singapore accepts the first and second medical use claims (in the form of Swiss Style format), it does not presently accepts the EPC 2000 format. Applicants who wish to consider supplementary examination under the Foreign Route should be cautious if the corresponding foreign application is a UK or EP patent application and comprise claims in the new EPC second medical use format. This is because claim relatedness is a requirement under the Foreign Route, and Swiss-style claims in a Singapore patent application will not be considered related to the new EPC second medical use claims in the corresponding UK or EP patent application.

Where a patent application comprises EPC 2000 format claims, the Applicant should consider the local examination route or the combination route, and amend the claims to swiss-style claims (where supported in the description) before requesting for search and/or examination.

Singapore also prohibits the patentability of an invention where the publication or exploitation of which would be generally expected to encourage offensive, immoral or anti-social behaviour is not a patentable invention. However, the aforementioned behaviour shall not be regarded as offensive, immoral or anti-social only because it is prohibited by any law in force in Singapore.

H. Patentable subject matter revisited (in the eyes of Examiner)

The Act does not provide a list of subject matter that are excluded from patent eligibility, However, IPOS has released an Examination guideline in 2016 indicating that invention will be assessed on a case by case basis based on whether the technical features of the claims sought (in a patent application) are expressed in structural, functional or mathematical terms.

In addition, IPOS will based its examination relating to patentable subject matter on the '*actual contribution*' of the invention in accordance with *Aerotel/Macrossan test in Aerotel Ltd v Telco Holdings Ltd & Ors Rev 1 [2007] RPC 7 (Aerotel/Macrossan)*.



The 'actual contribution' test is particularly relevant to computer implemented inventions. In this regard, it must be established that a computer (or other technical features), as defined in the claims, is integral to the invention in order for the actual contribution to comprise said computer (or technical features)

III. PATENT INFRINGEMENT IN SINGAPORE

A. General Rights Conferred On Granted Patents Under The Patents Act (Cap. 221)

The proprietor of a granted patent in Singapore has the right to stop any person, who without the consent of the proprietor of the patent performs the following:-

- where the invention is a product, the third party makes, disposes of, offers to dispose of, uses or imports the product or keeps it whether for disposal or otherwise;
- where the invention is a process, the third party uses the process or he offers it for use in Singapore when he knows, or it is obvious to a reasonable person in the circumstances, that its use without the consent of the proprietor would be an infringement of the patent;
- where the invention is a process, the third party disposes of, offers to dispose of, uses or imports any product obtained directly by means of that process or keeps any such product whether for disposal or otherwise.

B. Procedure for initiating infringement proceedings

If a patent has been infringed, only the patent proprietor or the holder of an exclusive licence under a patent, as the case may be, can initiate proceedings against the infringer.

Steps should be taken to ensure that the rightful owner or successor in title, as the case may be, register any assignment and/or exclusive license with the Intellectual Property Office of Singapore before proceedings is initiated.



Where the action is initiated by an exclusive licensee, the proprietor of the patent need not be made a party to the proceedings. However, if the proprietor is made a defendant, he shall not be liable for any costs or expenses unless he enters an appearance and takes part in the proceedings.

Infringement proceedings, in the form of civil proceedings may be initiated with the High Court of Singapore (the Court) as the Court of first instance. Unlike countries which adopt bifurcated proceedings, the Singapore Court also determines whether the patent is valid (usually raised as a defence by the alleged infringer) when an infringement proceedings is brought before the Court.

The following list of claims may be made against the infringer:-

- for an injunction restraining the defendant from any apprehended act of infringement;
- for an order for him to deliver up or destroy any patented product in relation to which the patent is infringed or any article in which that product is inextricably comprised or any material and implement the predominant use of which has been in the creation of the infringing product;
- for damages in respect of the infringement;
- for an account of the profits derived by him from the infringement; and
- for a declaration that the patent is valid and has been infringed by him.

The court is prohibited from, in respect of the same infringement, both award the proprietor of a patent damages and order that he shall be given an account of the profits. In this regard, the party initiating the infringement proceeds should weigh the damages and account of profits based on vis a vis, the royalty expected to be received if the alleged infringer were to obtain a license.



Case law has established that damages may be calculated based on:

- lost profits on sales which the patentee would otherwise have made;
- lost profits on the patentee's own sales to the extent that he was forced by the infringement to reduce his own price; or
- what the patentee would have charged the defendant for a licence based on the "accepted royalty rate", which can be based on expert evidence in the trade

C. Interlocutory injunction

Depending on the circumstances of the case, it may be possible to launch an interim step in the form of an interlocutory injunction. An injunction is a direction from the Court compelling a person to do something or to refrain from doing something. In cases involving the infringement of a patent, the proprietor or exclusive licensee may try and seek such an injunction to ensure that the alleged infringer does not continue infringement while parties await for the trial to take place (which could be some time down the road).

The application for an interlocutory injunction will be assessed based on balance of convenience between parties. The Court will seek to balance on the one hand the rights of patent holders and the potential prejudice to the alleged infringer. To convince the court may require strong and good evidence on a balance of probabilities.

Another factor to consider would be whether damages is an adequate remedy.

In certain unique instances where the likelihood of destruction of evidence is high, an application for a search order type of injunction that allows the patent holders to raid the premises of the alleged infringer to seize and preserve evidence (eg. documents, letters and image harddisks) may be made. However, the right holder must show that he has a very strong case and show real possibility that the alleged infringer will destroy the relevant evidence.



D. Turning the table - Groundless threat proceedings

While it is common before infringement proceedings are initiated before the High Court to send one or more *cease and desist* letters, the proprietor or exclusive licensee should be aware of the risks of groundless threat as a remedy against infringement proceedings.

In particular, a 'party aggrieved' by the *cease and desist* letter may instead initiate proceedings against the proprietor or exclusive licensee, as the case may be. In such cases, the party aggrieved by the *cease and desist* letter becomes the plaintiff.

In recent case law developments, a 'party aggrieved' has to show a real (as opposed to fanciful) *commercial interest* which has been interfered with. Specifically, this would mean that only those who are affected by such threats *due to the nature of their business* are covered. The court's finding on the requirement of "commercial interest" would narrow prospective cases of groundless threats as the court has made it clear that the nature of the business would be taken into account in determining whether person's real commercial interests has been interfered with.

On another note, the mere notification of existence of patent does not constitute a threat of proceedings.

Notification may be advisable as a way to put the alleged infringer on notice so as to prevent the alleged infringer from claiming that he was not aware, and had no reasonable grounds for supposing that the patent exists, and in this regard seek to restrict the Court from awarding damages or an account of profits.

In the drafting of a notification, care must be taken to avoid any wording which may be interpreted or constitute 'threat' in the notification.

E. Burden of Proof

A patent proprietor has the initial burden of proof in an infringement proceeding, to prove that his patent has been infringed.



However, if the subject matter of the patent is a process for obtaining a new product, this burden of proof is reversed. The alleged infringer will have the burden of proving that the product is not made by the patented process, if the product is new or a substantial likelihood exists that the product is made by the process, and the patent proprietor has been unable through reasonable efforts to determine the process actually used.

In considering whether a party has discharged the burden imposed upon him, the party will not be required by the Court to disclose any manufacturing or commercial secret if it appears to the Court that it would be unreasonable to do so.

F. Contributory Infringement

There is no provisions for contributory patent infringement in Singapore.

However, the Act provides that where the invention is a process, a party can infringe the patent for that invention if he offers it for use in Singapore when he knows, or it is obvious to a reasonable person in the circumstances, that its use without the consent of the patent proprietor would be an infringement of the patent.

IV. REVOCATION

A. Post-grant action

There is no pre-grant opposition or revocation proceedings available in Singapore. As such, revocation of a patent is a post-grant action.

Patent revocation proceedings may only be initiated at IPOS. However, revocation of a patent may be used as a defence before the Court in infringement proceedings. A Singapore patent may only be revoked on any of the following grounds which is exhaustive:-

- the invention is not a patentable invention;
- the patent was granted to a person who was not entitled to be granted that patent;



- the specification of the patent does not disclose the invention clearly and completely for it to be performed by a person skilled in the art;
- the matter disclosed in the specification of the patent extends beyond that disclosed in the patent application as filed;
- an amendment or a correction has been made to the specification of the patent or the application for the patent, which should not have been allowed;
- the patent was obtained:-
 - (i) fraudulently;
 - (ii) on any misrepresentation; or
 - (iii) on any non-disclosure or inaccurate disclosure of any prescribed material information, whether or not the person under a duty to provide the information knew or ought reasonably to have known of such information or the inaccuracy;
- the patent is one of 2 or more patents for the same invention having the same priority date and filed by the same party or his successor in title (double patenting)

B. Post-grant amendment to claims

In patent revocation proceedings before IPOS, the proprietor may be given leave to amend the specification of the patent in question. No amendment of the specification of the patent in question during a patent revocation proceeding may be allowed if it results in the specification disclosing any additional matter, or extends the protection conferred by the patent.

Besides the aforementioned prohibitions, the Court has considered other factors on whether post-grant amendment is allowed. These factors include:



- whether the patentee satisfied its burden of establishing that the amendment should be allowed and full disclosure must be made of all relevant matters;
- whether there was no unreasonable delay in the making the amendments;
- whether the patentee had sought to obtain an unfair advantage from a patent, which he knows or should have known should be amended;
- whether the conduct of the patentee (and not the merit of the invention) discouraged the amendment of the patent.

Patent proprietors should therefore consider making post-grant amendments at the earliest opportunity when new prior art are discovered in, for example, other corresponding applications which may impact the validity of the granted Singapore patent.

V. CONCLUSION

There are various prosecution routes to obtain a patent grant in Singapore. Applicant should consider factors such as costs, desired strength of patent, and compatibility of laws between jurisdictions especially when relying on the search and examination result of a corresponding application to request for supplementary examination.

Singapore has made considerable progress in its patent regime. Applicant may make use of the relatively fast substantive examination, wide network of work-sharing mechanisms to its advantage in seeking protection in Singapore and ASEAN.

A PCT applicant using Singapore as Receiving Office may now make his request and file the patent specification in the Chinese language.

Patent proprietors or exclusive licensees, as the case may be, seeking enforcement of their patent rights should be aware of the mechanism and possible risks. In particular, they should ensure that the proper owner and/or exclusive licensee is properly recorded with IPOS before



enforcement, and minimize the risk of exposure to groundless threat proceedings brought against them.

In considering post-grant amendments, patent proprietors should be aware that they may be prohibited from making post grant amendments based on unreasonable delay.





IF YOU WOULD LIKE TO HAVE FURTHER INFORMATION ON THIS BROCHURE OR DISCUSS THE IMPACT OF THE SAME ON YOUR BUSINESS, PLEASE CONTACT:

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