

Managing Intellectual Property™

www.managingip.com

Singapore IP Focus 2006



Singapore's law of patent revocation
Amica Law LLC

Singapore's Registrar of Patents has wide powers to revoke a patent once it has been granted. **Winnie Tham** and **Jason Chan** of **Amica Law LLC** explain what the rules mean for IP applicants and challengers alike

Singapore's law of patent revocation

Since Singapore set up an independent patent system on February 23 1995, the number of granted patents has increased steadily. For example, in 1995, there were 1,750 patents compared to 7,680 patents in 2005. As the system matures, there is increasing interest in proceeding with patent revocation in Singapore, usually as part of a concerted global strategy.

Since there is no pre-grant opposition procedure in Singapore, a patent can only be challenged after grant. The power to revoke patents is given to the Registrar of Patents and can be found in Section 80(1) Patents Act. The relevant grounds for revocation are:

- 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 extends beyond that disclosed in the application for the patent as filed, or if filed pursuant to an earlier application or a UK application, then those relevant applications.
- An amendment or a correction has been made to the patent or application which should not have been allowed.
- The patent was obtained fraudulently, or there was misrepresentation or non-disclosure or inaccurate disclosure of any prescribed material information.
- The patent is one of two or more patents for the same invention having the same priority date and filed by the same party or successor in title (otherwise known as double patenting).

In this article, we focus on some of the grounds for patent revocation, best practices in prosecution and the revocation proceedings.

Ensure your invention is patentable

What may be surprising is that revocation for non-patentability remains possible even though Section 30 of the Singapore

Patents Act permits the grant of claims in applications which do not meet the patentability requirements of novelty, inventive step and industrial applicability. Singapore has, in part, a so-called self-assessment system, which requires only that claims or related claims be examined, but not necessarily allowed. Nonetheless, patentees should strive to ensure the final set of claims for grant is in good order.

Due to the structure of our patent prosecution system it is possible for a patentee to rely on an examination report which is unfavourable or deficient (but is sufficient for grant). In such cases, the patentee usually makes further voluntary claim amendments or additions after the establishment of the report. At that time, it would be advisable for the patentee to place other validating material on record to support the amendments

Winnie Tham



Winnie Tham is a director of Amica Law LLC and has more than 13 years' experience in intellectual property. She handles all aspects of IP protection, prosecution and management in Singapore and overseas, including advising on legal aspects and strategies for protection for new inventions, products and designs, and drafting commercial IP agreements in connection with mergers and acquisitions of companies involved in real estate, life sciences and the food and beverage industry.

Winnie has a Bachelor of Laws (Hons) and a Bachelor of Science degree with a major in pharmacology and a minor in biochemistry. She is a registered patent agent and an advocate and solicitor of the Supreme Court of Singapore. Winnie has also been called to the Bar of the Supreme Court of Victoria, Australia. She sits on the editorial team for the Asian Patent Attorney's Association and is a member of the Patent Examination Committee of the Board of Patent Examiners. Winnie has been consistently recommended as one of Singapore's leading IP lawyers by the *Asia Pacific Legal 500* (2001/2002, 2002/2003, 2003/2004, 2004/2005 and 2005/2006).

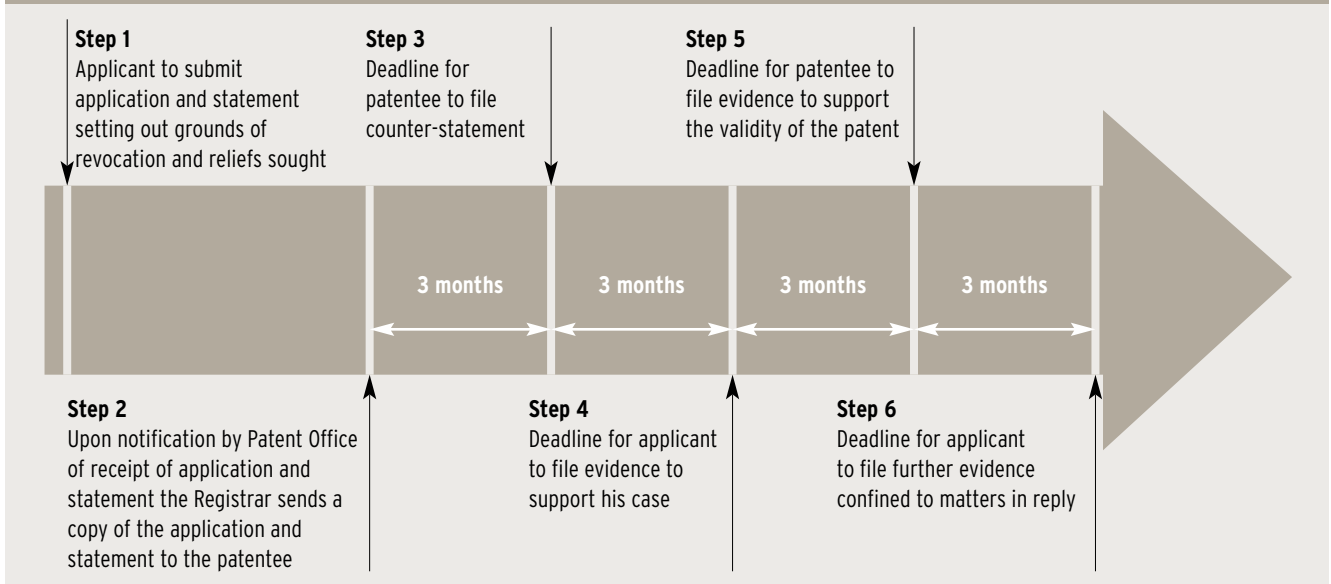
Jason Chan



Jason Chan is a director with Amica Law LLC. He has more than 14 years' experience in IP and technology disputes and has been involved in several significant IP cases in Singapore, including recent infringement cases involving copyright in movies and a patent for an electronic storage device. He manages anti-piracy programmes for major consumer product companies and frequently advises on legal issues relating to telecommunications laws and agreements, IT, software, database and privacy, and internet and domain name disputes.

Jason is an advocate and solicitor of the Supreme Court of Singapore, as well as a registered patent agent. He is certified under the Federation Internationale des Conseils en Propriete Industrielle (FICPI) South East Asia Patent Drafting program. He regularly conducts IP courses and is active in AIPPI Singapore and APAA Singapore.

Overview of revocation timelines



or additions. Also, where there is any doubt over the final set of claims, a post-grant search and examination procedure is available for a more definitive opinion. Adopting these steps should help reduce the risk of the patent being revoked for lack of patentability.

Check for entitlement

This ground of revocation may only be applied for by a person who has been found by the court in an action for a declaration or under Section 47 proceedings to determine entitlement to be the true owner. It is important to note that the applicant for revocation has up to two years from the date of

grant to file the revocation. If you are out of time, you need to prove that the patentee knew at the time of the grant or of the transfer of the patent to him that he was not entitled to the patent.

As a result, if there is an ownership issue, it is best to move quickly in the application for revocation, as time is required to obtain the requisite order or declaration.

Sufficiency of disclosure

A patent may be revoked if the specification does not disclose the invention clearly and completely in a way that allows it to be performed by the skilled addressee. While there is no

MOVING YOU. AHEAD



AMICA LAW LLC

AMICA LAW LLC is a practice formed by experienced specialists in intellectual property and technology, together with a team of lawyers, patent agents, technical specialists and paralegals.

Amica Law combines the depth of experience and domain knowledge of an established practice, with the energy, flexibility and responsiveness of a new independent law corporation.

Amica Law's practice covers all aspects of intellectual property and technology, including patents, trade marks, copyrights, trade secrets and designs.

30 Raffles Place #18-03/04 Caltex House Singapore 048622
www.amicalaw.com

PATENTS, TRADE MARKS & DESIGNS
Jo-Ann See - joann.see@amicalaw.com
Winne Tham - winnie.tham@amicalaw.com

LITIGATION & ENFORCEMENT
Jason Chan - jason.chan@amicalaw.com

TECHNOLOGY & LICENSING
Wilson Wong - wilson.wong@amicalaw.com

requirement that the specification(s) be absolutely clear and complete in every detail, they must be sufficient to enable a skilled addressee to make or perform the invention using his stock of common general knowledge, without having to undertake further research or trials.

The need for careful preparation of the specifications is also important in the context of amendments. This is because although a patent can be amended, any amendment resulting in disclosure of additional matter or extension of the protection of the patent is prohibited. What this means is that it

Due to the structure of our patent prosecution system it is possible for a patentee to rely on an examination report which is unfavorable or deficient

becomes critical that the original specifications, including any drawings and abstract, already contain language and matters that can be used to provide clear and sufficient support for the amendments.

Make proper disclosure of information

The issue of proper disclosure was discussed in a recent case in Singapore (*Trek Technology (S) Pte Ltd v FE Global Electronics* [2005] SGHC 90), where the defendants sought to argue that the patent should be revoked because of the following alleged misrepresentation, namely that the invention was not developed by the patentee but by an employee of a company related to the patentee.

The Court found that it must be demonstrated that the misrepresentation had actually deceived or materially induced the Registrar into granting the patent before the court will revoke the patent. In short, the misrepresentation must be such as to have resulted in or contributed to the grant of the patent. The Court also found that the ground of misrepresentation (Section 80(1)(f)(ii)) extends to all types of inaccuracies that lie in a patent application or certificate of grant, including mis-

A patent may be revoked if the specification does not disclose the invention clearly and completely in a way that allows it to be performed by the skilled addressee

representation about ownership. The Court opined that under Singapore's regime of limited assessment, it is essential that patentees ensure any information provided in a patent application leading up to the entry into the international or national phases and ultimately to grant, must be accurate. This would mean that even the listing of inventors should be accurate.

In a case involving a Singapore patent granted based on a corresponding US application (*Contour Optik Inc v Pearl's*

Optical Co Pte Ltd [2002] SGHC 238), the defendant successfully argued that as the scope of the US application was narrower than the Singapore patent and rendered the invention disclosed in the former to be substantially different from the invention disclosed in the latter, the patentee had furnished false material information. This case demonstrates the need for careful scrutiny of information disclosed in patent applications, since what may be permissible or immaterial in one country may not be so in another.

It is also important to note that the reference to prescribed material information is particularly relevant to those applications filed prior to July 1 2004 that rely on corresponding applications in Australia, Canada, New Zealand, the UK, the US and the European Patent Office. By reason of the broad nature of the term "material information" and the threat of revocation for non-disclosure or misrepresentation, patent applicants should remember that all relevant corresponding applications have to be all disclosed to the Patent Office, even though the applicant need only rely on one corresponding application.

Procedure for revocation

The application to revoke a patent is made by way of a prescribed form (Patents Form PF35), accompanied by a statement setting out fully the grounds of revocation, the facts and the relief which the applicant seeks. A copy of the application and the statement will be provided to the patentee by the Patent Office.

Within three months from receipt of the application and the statement, the patentee has to file a counter-statement setting out fully the grounds upon which the application is contested. At this time, it is permitted to file an application to amend the specification of the patent. Since the counter-statement forms the pleaded case of the patentee, it is critical that the statement be sufficiently comprehensive. If amendments are sought, then the proposed amendments must comply with the statutory requirements (ie that the amendments do not result in disclosure of additional matter or extension of the patent's protection). If no counter-statement is filed, the application for revocation will proceed without the patentee, but the Registrar will treat each specific fact set out in the statement as conceded, except insofar as it is contradicted by other documents in the Registrar's possession.

The applicant for revocation may, within three months of receiving the counter-statement and a copy of the amendment (if any), file evidence in support of the case. Within three months thereafter, the patentee may file evidence in support of the validity of the patent. As the period of three months may be insufficient to prepare a proper response, it is prudent for patentees to prepare evidence in advance, once notified of the revocation proceedings. Within three months from receipt of the patentee's evidence, the applicant may file further evidence confined to matters strictly in reply. No further evidence shall be filed by either party, without leave. The Registrar is at liberty to give further directions on subsequent procedure. Thereafter, a hearing date will be set down.

It is apparent that proceedings for revocation move rather quickly. For both parties, it is important that they gather and assess evidence as early as possible, and if non-

English language documents are to be relied on, verified translations should be obtained in advance.

Re-examination

One important feature of the patent revocation procedure in Singapore is that the Registrar may require the applicant for revocation to request a re-examination of the patent. This occurs where the revocation is based on the grounds that the invention is not patentable or that the specification does not disclose the invention clearly and completely for it to be performed by a skilled addressee, or that matter disclosed in the specification extends beyond that disclosed in the application as filed. The applicant has no choice in this. Upon the direction, the request and fee (around \$600) has to be paid by the applicant within two months, otherwise the application for revocation will be treated as abandoned. The examiners come from the Australian, Austrian and Danish patent offices. They take into account the statement by the applicant, any amendment of the specification, counter-statement by the patentee and the evidence filed. Thereafter, they will recommend to the Registrar whether or not the patent should be revoked.

As an aside, the Registrar may on her own initiative, revoke a patent. However, Section 81 of the Patents Act requires her to give the patentee an opportunity to make observations and amend the specification if necessary.

Jurisdiction and costs

Revocation is usually commenced at the Intellectual Property Office of Singapore or in the High Court if it is by way of a defence in infringement proceedings, groundless threat of infringement, declaration of non-infringement or a dispute relating to government use. The remedies available to the applicant are unconditional or partial revocation of the patent,

and the order is effective from the date of the grant of the patent.

Where the applicant for revocation discontinues or withdraws the application for revocation, the applicant bears the costs and expenses of the proceedings. If the patentee surrenders the patent, then the Registrar considers whether reasonable notice was given to the patentee before the applicant commenced revocation. Otherwise, the Registrar may award to any party such costs as she may consider reasonable.

One important feature of the patent revocation procedure in Singapore is that the Registrar may require the applicant for revocation to request a re-examination of the patent

Finality of decision

It is interesting to note that a decision of the Registrar or on appeal from the Registrar is not necessarily conclusive. In particular, the decision of the Registrar itself can be appealed to the High Court, and thereafter to the Court of Appeal. However, it is also provided specifically in the Patents Act that a decision of the Registrar or on appeal from the Registrar does not prevent any party in civil proceedings from raising invalidity of a patent in which infringement is an issue.

As the patent regime matures, it is expected that revocation proceedings will increase. While the prosecution system is relatively flexible, it remains important that applicants bear in mind the possible grounds for revocation when they prosecute their patent applications to avoid complications.