

## CHANGES TO PATENTS REGIME

This is a follow up from our previous update to the pending changes to the Singapore patents regime. The changes summarised herein took effect from 30 October 2017.

### **Broadening of grace period provision**

The broadened grace period provision in Singapore affords inventors greater leeway in disregarding their prior public disclosures of the invention. However, the grace period provision may not be available or as broad in other jurisdictions, and it will be prudent for inventors to seek legal advice before their public disclosure. The broadened provision is applicable for patent applications filed, and inventor disclosures, from 30 October 2017 onwards.

Important aspects of the broadened grace period provision include:

- (1) The public disclosure must not be more than 12 months before the filing date of the Singapore patent application.
- (2) The public disclosure must be from the inventor or by a person who obtained the subject matter of the invention directly or indirectly from the inventor.
- (3) The provision does not exclude the inventor's earlier validly filed and pending patent (or utility model or other IP rights) applications which have been published.
- (4) Patent applicants who wish for the disclosure to be disregarded may do so when making a request for examination, responding to the Written Opinion, or requesting for a review of the examination report. Applicants wishing to rely on this provision must still provide relevant supporting documents.

### **Patentability of Natural Products and Processes**

The Intellectual Property Office of Singapore (IPOS) Examination Guidelines has been amended to further distinguish between a discovery and an invention, and will affect all pending and new patent applications. Isolated or purified material or microorganism from nature will be considered a discovery and not an invention, i.e. non-patentable subject matter. Only a new use of the isolated or purified material or microorganism is patentable. This is a departure from the current guidelines, whereby it is possible to patent the isolated or purified material or microorganism itself as long as a new use is shown.

Isolated material or microorganism which has been modified, and is clearly distinguished from the naturally occurring material or microorganism will be patentable. However, the extent of modification that is required is not immediately apparent.

# PATENT UPDATE

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Similarly, a claim directed at a naturally occurring process in nature would not be patentable subject matter, but a new application of such a naturally occurring process is patentable subject matter. Two examples which were considered patentable were provided: a process of growing plants with a particular trait comprising a selection step with technical steps to distinguish the invention from the natural process; and an in vitro diagnostic method based on novel biomarkers.

Although the amended Examination Guidelines is meant to bring Singapore's patent practice in line with other countries patent practices, the examination guidelines are not consistent with a single jurisdiction and could pose potential pitfalls for the unwary applicant.

### **Supplementary Examination Route**

The supplementary examination route allows patent applicants to rely on the positive examination results of certain patent offices<sup>1</sup> to expedite the grant of the Singapore patent application. In this route, the examiner does not conduct substantive examination on the novelty and inventiveness of the claims, and is only able to raise objections to certain issues.

IPOS has included patentable subject matter as an additional ground of objection. This ensures consistency across different examination routes and prevent claims containing unpatentable subject matter from being granted.

This helps prevent patent owners from being caught in a bind, as a recent Court of Appeal decision in Singapore held that post-grant amendment of "obviously invalid" patent claims to cure the invalidity confer patent protection where none existed previously. The proposed amendments thus extend the scope of patent protection and are not allowable. The patent in question contains only method of treatment claims which are excluded from patentability in Singapore, as such the patent had no valid claims.

### **Post-Grant Amendments**

The additional guidance to post-grant amendment provided in the Court of Appeal decision<sup>2</sup> is also reflected in the revised Examination Guidelines.

<sup>1</sup>Australia, Canada, Japan, New Zealand, Republic of Korea, United Kingdom, United States of America and European Patent Office (the corresponding Canadian and European application must be in English), or a PCT IPRP

<sup>2</sup>Warner-Lambert Company LLC v Novartis (Singapore) Pte Ltd [2017] SGCA 45



## **Switching Between Examination and Supplementary Examination Routes**

Applicants are allowed to switch between the two examination routes at any time before the examination report or supplementary examination report is issued, and offers more flexibility and potential cost savings to applicants.

## **Application To Be Treated As Abandoned**

A patent application in which a search report has been issued, but no request for examination is made after 54 months (including an 18 month extension as of right) from the declared priority date (or filing date if there is no priority) shall be treated as abandoned.

