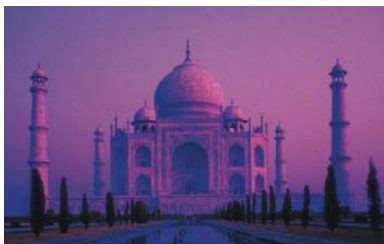




## Indian Patent Law Amendments

On 23 March 2005 the Patent (Amendment) Bill 2005 (the "Amendment Bill") was passed by the Indian Government to amend the Indian Patents Act 1970. The long-awaited Amendment Bill replaces an Ordinance promulgated by the President of India in December 2004 in an attempt to ensure that India complies with the provisions of the TRIPS Agreement prior to 1 January 2005.



The Amendment Bill was passed amidst a flurry of debate, lobbying, opposition and activism. Passing the Amendment Bill was a delicate balancing act for the Indian Government which was under pressure from its coalition partners (the Left Parties) which were concerned about the effect of the new laws on India's poor population. The key features of the new laws are summarised below.

### Patent protection for Pharmaceutical Products

The most significant change effected by the Amendment Bill was the introduction of a product patent regime that, *inter alia*, allows pharmaceutical products to be protected under Indian patent law.

Prior to 1 January 2005, drugs, medicines, food substances and substances prepared or produced by chemical processes were exempt from patent protection in India. Processes for the manufacture of these substances could, however, be patented. This allowed India's generic drug industry to flourish, as generic manufacturers became adept at adopting modified production processes for drug manufacture and thereby avoid infringing existing patent rights in India.

It is expected that, under the new provisions for direct patent protection of pharmaceutical products, generic drug manufacturers in India will be forced to compete according to international patent standards although the compulsory licensing provisions discussed below should be noted.

*Continued >*

## Launch of National Intellectual Property Day in Malaysia

The Malaysian Government has chosen the third day of March every year to be "National Intellectual Property Day". This initiative is aimed at creating IP awareness, as well as to encourage creative thinking and promote the creation of inventions, trade marks and designs.

The inaugural event was launched by the Prime Minister of Malaysia, Y.A.B. Dato' Seri Abdullah Bin Haji Ahmad Badawi, on 3 March 2005, in a glittering event at the historical state of Malacca. The Prime Minister emphasised that the Government will promote numerous IP activities in order to create valuable rights that can be commercialised and, thereby generate income for the country, hence the chosen tagline "Intellectual Property - Current Economic Spinner".

The Prime Minister also announced that The Intellectual Property Corporation of Malaysia, commonly known by its Malay acronym "PHIM", will soon be changing its name to Malaysian Intellectual Property Office (MyIPO).

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## Indian Patent Law Amendments *continued*

### Modified “New Use” provision

The Amendment Bill also declared that a “mere” new use of a known substance was unpatentable. This may be interpreted as a relaxation of the old law in which a patent could not be obtained for “a new use of a known substance.” Some observers interpret this as a provision for Swiss-style “use” claims in India.

Like the United Kingdom, Singapore and some European countries, methods of treatment cannot be patented in India. However, these countries allow patents on second medical use claims drafted in the so-called “Swiss-style” format. The case for Swiss-style use claims was being pushed by the pharmaceutical lobby in India and some feel that the “mere new use” provision may be a step in this direction. Whether this is really the case will become clear only when applications are examined under the new patent regime.

### Compulsory licensing provisions

Notwithstanding the introduction of product patents in India, the Amendment Bill contains several compulsory licensing provisions that favour generic manufactures. A compulsory license may be granted under the following scenarios:

- to mainly supply the Indian market;
- to remedy an anti-competitive practice; or
- to supply drugs to countries having insufficient pharmaceutical manufacturing capacity of their own if the drug addresses a public health problem.

India has been the main supplier of generic AIDS cocktail drugs to countries such as South Africa and in all likelihood will continue to be so under the new patent regime. These compulsory licensing provisions have left pharmaceutical companies wary of how effective the new regime will really be.

### Provisions for the patenting of software

The Amendment Bill also introduced provisions for the patenting of software “embedded in hardware” to cater to the demands of India’s booming software industry. This means that software can be patented if it is combined with hardware or has a technical application.

### Abolition of the Mailbox/Exclusive Marketing Rights provision

Prior to 1 January 2005, product patent applications were routed through a special mailbox. This was a mechanism to delay examination of such applications until the new laws came into effect. This interim regime granted so-called exclusive marketing rights (EMRs) to patentees. Under the present Amendment Bill, applications for EMRs made before 1 January 2005 will be treated as requests for examination. Moreover, the rights of patentees who applied for a food or drug patent before 1 January 2005 will begin from the date of grant of the patent and not from the date of publication.

### Opposition provisions

The Amendment Bill also strengthens the opposition provisions in the existing patent laws by allowing both pre-grant and post-grant opposition of patents. The patent application would however have to be published before it can be opposed. While this provision might delay the patent grant process, it is expected that the quality of issued patents will improve.

Besides the substantive changes highlighted above, the Amendment Bill also introduces several procedural amendments to streamline the patent examination and grant process in India. These include:

- a reduction in the time taken to examine applications;
- a simplified grant procedure; and
- publication of an application before the 18-month period if the Applicant requests it.

By implementing the Amendment Bill, it would appear that India has made progress in meeting its obligations under the TRIPS Agreement. However, the road ahead for India’s IP landscape is full of challenges as patent examiners and practitioners grapple with the new regime. In the long run, it is a milestone that will potentially reap huge benefits for Indian patent holders.

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Heidi, a UK Chartered Patent Agent and European Patent Attorney, recently joined ECSF as a Senior Associate. Prior to joining ECSF, she worked for two of the UK’s premier patent firms in London and Nottingham. Heidi specialises in biotechnology and has extensive experience in drafting patent applications, prosecution work, opposition / revocation work, and providing infringement and validity advice. She has drafted and prosecuted applications for numerous jurisdictions and in a wide range of technologies in the biotechnology area.

Heidi studied Biological Sciences at Trinity College, Oxford University where she was awarded a First Class Honours degree and the R.A. Knox Memorial prize for the best first class performance in a Final Honours School. Courses studied included: cell biology; biochemistry; genetics; cellular and molecular plant physiology; microorganisms; pathogens and parasites; and green plants.

Heidi has obtained prizes for the highest mark in two of the UK foundation level intellectual property examinations. She has also taught on a foreign patent law revision course for the past two years.



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Nathan graduated from the National University of Singapore in 1996. He was admitted as an Advocate and Solicitor of the Supreme Court of Singapore in March 2001 and admitted to the Roll of Solicitors of England & Wales in April 2005.

Prior to joining the firm, Nathan was a Deputy Public Prosecutor/State Counsel with the Attorney-General’s Chambers from 1996 to 2001, where part of his work involved the prosecution of criminal offences under the various Singapore intellectual property statutes. Nathan also had 2 years of practice in commercial litigation in a leading law firm in Singapore. In 2002–3, Nathan spent a year in London and obtained a Masters of Law (Merit Award) from King’s College London, specialising in Intellectual Property law.

Nathan has also contributed to the Singapore Academy of Law Journal and various other intellectual property publications.



## Impact of Deficient/Incomplete International Preliminary Examination Reports on the Validity of Singapore Patent Applications

Under the Singapore Patents Act as applicable to international patent applications entering into the Singapore National Phase via PCT Chapter II with international filing dates before 1 July 2004, a patent application may proceed to grant provided that the Patent Office receives a copy of the International Preliminary Examination Report (IPER).

In relation to international patent applications, mere issuance of an IPER does not guarantee that an application is patentable. Some examples of such circumstances are cited below.

In some cases, a deficient or incomplete IPER may be issued on the basis of non-establishment of an International Search Report. It is understood that an International Search Report may not be established for applications that deal with, for example, methods of doing business. In other words, an international application may be issued with an IPER even without its claims searched and examined.

Another example of an IPER for an application that may not be patentable will be an established IPER containing outstanding objections with regards to, for example, unity of invention.

For an international application entering the Singapore National Phase via PCT Chapter II relying on an IPER such as those mentioned above, according to the wording of the law, upon receipt of the IPER by the Patent Office, the application may proceed to grant. Subsequent grant of the patent is regardless of whether there are any outstanding objections or issues in the IPER. It is clear that such patents may not be valid and may be challenged in later proceedings.

The Singapore Patents Act has since been amended such that, as applicable for international applications entering the Singapore National Phase via PCT Chapter II with international filing dates on or after 1 July 2004, each claim of an application must be related to at least one claim which has been examined and referred to in the international preliminary report on patentability (IPRP). The amended Singapore Patents Act also requires the IPRP not contain existing Unity of Invention objections, in order for an application to proceed to grant.

However, while the Singapore Patents Act has been amended to remove the ambiguity in the law regarding valid granted patents for international applications entering the Singapore National Phase via PCT Chapter II with international filing dates on or after 1 July 2004, there are numerous pending cases with international filing dates before 1 July 2004 and relying on deficient or incomplete IPERs. These international applications may have either entered into the Singapore or in the process of entering into the Singapore.

Measures are recommended for these international applications in order to ensure that subsequent granted patents may be valid, rather than being faced with invalidity issues that may arise from mere reliance on deficient or incomplete IPERs.

There are some measures which may be taken for such applications with international filing dates before 1 July 2004 entering the Singapore National Phase via PCT Chapter II, namely, requesting for local search and examination, filing divisional applications, or requesting post-grant search and examination.

For an application or divisional application requesting local search and examination, an obvious advantage will be ensuring that the application is at least examined. Objections during local examination may be overcome by filing arguments, amendment or deletion of objected material as well as filing of divisional applications. A request for a local search and examination may thus increase the likelihood of obtaining a valid patent in Singapore compared to a patent containing unexamined claims.





# Singapore: Highlights of Amendments to The Copyright Act

More amendments to the Singapore Copyright Act came into effect on 1 January 2005, to implement Singapore’s obligations relating to copyright under the United States–Singapore Free-Trade Agreement.

Some of the major changes are highlighted below.

### Anti-circumvention measures

A copyright owner can bring a civil action against anyone who does any of the acts which circumvent Technological Protection Measures (TPM); sells or lets for hire any circumvention device; or offers any circumvention service.

Criminal liability attaches to anyone who does the above-mentioned acts wilfully and to obtain a commercial advantage or profit.

Liability for circumvention of TPMs is independent of whether copyright infringement occurs.

### Enhanced protection of Rights Management Information (RMI)

Prior to the latest amendments, the rights owner could bring an action against any person who alters or removes RMI only where that person had the intent to mislead or infringe. The amendments have broadened the causes for civil action to include:

- distribution or importation for distribution of altered RMI
- distribution, importation for distribution, or communication of works where the RMI has been altered or removed.

### Exclusive right to transmit on the Internet

With the Internet now a popular medium of communication, the exclusive right to transmit on the Internet has been conferred on copyright owners. This right is defined as “the making available of a work or other subject-matter (on a network or otherwise) in such a way that members of the public (whether in or outside Singapore) may access the work or subject-matter from a place and at a time individually chosen by them.” This definition appears broad enough to make unauthorised hyper-linking an infringement, as hyper-linking arguably amounts to “making available” a copyright work/subject matter to the public.

### Rights of Performers

The rights of performers are expanded to include the rights to prohibit subsequent exploitation of a recording of a performance. The new rights are:


- right to prohibit indirect recordings of performances;
- right to prohibit publication of recordings of performances if they are unpublished; and
- right to prohibit the posting of recordings of performances on the Internet

The right to object to false attribution (previously available only to authors of copyright works) is now also extended to performers.

For granted patents relying on deficient or incomplete IPERs, post-grant search and examination may be requested. A Written Opinion, if issued, will allow the patentee to put on record written submissions or carry out allowable and validating post grant amendments to the patent.

In view of the above, requesting for search and examination, either before or after grant of a patent application that has an international filing date before 1 July 2004 and, which is based on an incomplete or deficient IPER, may result in a stronger patent even though the law provides for grant of such a patent upon only mere receipt of an IPER for the application.

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**Statutory damages**

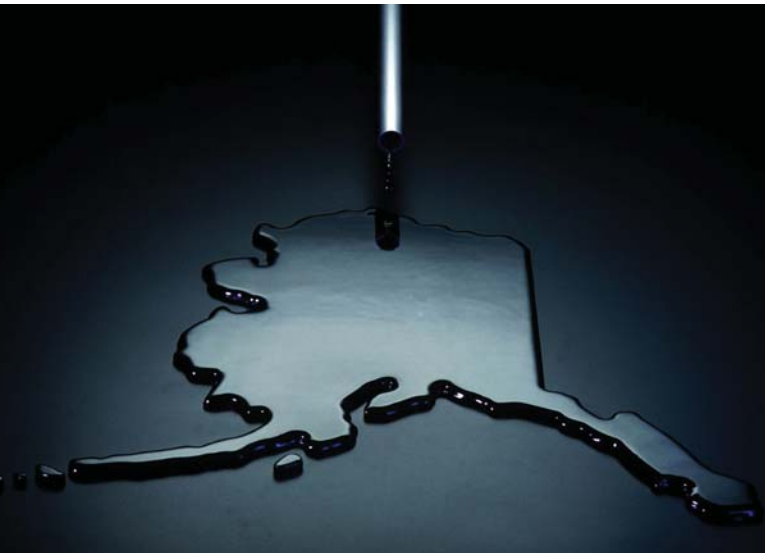
A plaintiff in a civil action can now elect for an award of statutory damages in lieu of damages or an account of profits.

**Border enforcement measures**

Border measures have been improved through the introduction of less onerous notification requirements for Customs enforcement action, as well as provisions permitting ex officio measures such as the examination and detention of infringing copies of copyright material, without prior request by the copyright owner.

**New criminal offences**

Prior to the amendments, the Singapore Copyright Act only criminalised commercial importation, commercial distribution, commercial sale or commercial manufacture of infringing copyright material. The advent of the Internet has made it easier for parties to carry out infringements on a wider scale. To protect copyright owners against these new forms of infringement, a new provision now makes large-scale infringements that do not involve any profit motive or distribution (e.g. unauthorised uploading and downloading of copyright material on the Internet) a criminal offence.



**New fair dealing regime**

A more flexible fair dealing regime replaces the previous regime, which only covered research or private study, criticism or review, and reporting of current events. Under the new regime, the list of specified acts remains but the list is non-exhaustive.

**Internet service provider liability**

The 2005 amendments also seek to balance the interests of Internet service providers (ISPs), copyright owners and website owners. In particular, the courts are precluded from granting monetary relief for any copyright infringement by ISPs in the course of hosting and transmitting material. However, this immunity applies only if ISPs comply with certain administrative requirements like the taking down of infringing content upon



being notified by the copyright owner in writing, and the putting back of that same content upon counter-notice by the website owner, unless the ISP receives either an order of court not to do so or a court judgment/ declaration that the posting of the material on the network amounts to infringement of the copyright material.

To prevent abuse, the making of any false notice or counter-notice is made a criminal offence.

**Presumption of copyright**

It is now easier for plaintiffs to prove copyright ownership. Where the defendant, in good faith, puts at issue whether copyright subsists or whether the plaintiff is the copyright owner, an affidavit from the plaintiff stating that

- (i) at the time of making the affidavit, copyright subsisted in the work/subject-matter, and
  - (ii) he is the owner of the copyright, and
  - (iii) the copy of the work/subject-matter annexed thereto is a true copy thereof
- shall be prima facie proof. The burden then shifts to the defendant to prove otherwise.

The 2005 amendments bring Singapore’s copyright legislation up to speed with the current developments in the information technology sphere, and seek to fairly balance the rights of copyright owners with the public interest in the sharing and dissemination of knowledge and information.

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events



**Building, Managing and Commercialising your Strategic Intellectual Property Portfolio** by Rob McInnes

**Intellectual Property of Singapore (IPOS) "Make your Mark" competition 2004**  
**Brand Name Education Foundation (BNEF) & ECISF as one of the sponsors**



Winner of "Make Your Mark" competition, Raffles Secondary School



Judges of "Make Your Mark" competition

(from right) Ms Lee Li Choon, Director, Registry of Trademarks, IPOS; Mr Jovan Tay, Group Managing Director, Brandz Group Pte Ltd; Ms Liew Woon Yin, Director General, IPOS - Chief Judge; Mr Soh Kar Liang, Director of ECISF; Ms Tan Lai Wan, Head (Marketing), Ngee Ann Polytechnic School of Business & Accountancy

**TM Satys' Found to be Confusingly Similar to TM SOTHYS**

In an opposition action under the 1992 Edition of the Singapore Trade Marks Act (Cap 334), the Singapore Registrar refused registration of Satys' on the grounds that it was confusingly similar to SOTHYS.

The Applicants applied to register "Satys" in class 3 with regard to "Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices".

The Opponents are the proprietors of the trade mark registration "SOTHYS" for "Cosmetics, cosmetic articles, cosmetic powders, cosmetic creams; preparations for the care of the skin; beauty masks; cosmetic preparations for the eye-lashes; preparations for use in suntanning and sun-screening; depilatory wax" in class 3.

The Registrar found that that while visually the marks are not identical, they are nonetheless very similar because they share many common letters at key points at the beginning, the middle and at the end in each mark. The differences in the applied mark are in the second letter "A" instead of "O", the apostrophe at the end of the mark and the additional letter "H", all of which are in essence non-substantive differences.

Phonetically, the Registrar found that there is a real risk that the two marks would be confused. There was no evidence to find that the word "Satys" in such mark would be pronounced very differently from "SOTHYS" in the local context.

On the evidence submitted, the Registrar found that the Opponents had sufficiently discharged their burden of proof that the SOTHYS mark had acquired sufficient reputation through use in Singapore. Due to the Opponent's reputation in the SOTHYS mark, the registration of Satys' would cause confusion or deception as consumers are likely to wonder if the Applicant's goods, especially those that relate directly to cosmetics and beauty care, came from the same source as that of the Opponents.

Although not all goods claimed in the Applicant's mark relate directly to cosmetics or beauty care, the Opponents argued that allowing the Applicant's mark to proceed to registration would deny them the right of expansion of SOTHYS with regard to those goods claimed by the Applicant. The Registrar decided that brand extension is commonplace and it was a valid contention that consumers would be misled into thinking that any goods sold under Satys' are related to the Opponents.

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