

Managing Intellectual Property

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Including a disclaimer in Singapore patents

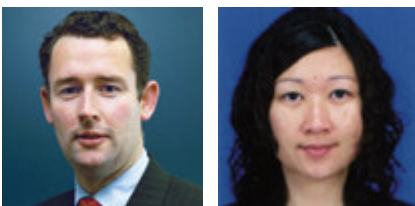
Singapore courts tend to adopt a strict approach to the exclusion of added subject matter when amending a patent or patent application. Hence, does a disclaimer, introduced into a patent claim in order to restore novelty over the prior art by excluding from its scope one or more particular examples in the prior art, constitute unallowable added subject matter under Singapore law if such a disclaimer has no basis in the application as originally filed?

There is as yet no case law in Singapore on whether a disclaimer, which does not have basis in the application as filed, would constitute added subject matter when introduced into a patent claim and therefore be unallowable. In such instances where there are no local case laws, Singapore courts will likely seek guidance from equivalent UK or European decisions. Indeed, in the seven reported patent infringement and validity decisions reported in Singapore to date, Singapore courts have all followed judicial precedent established in the UK. For example, regarding the question of "added matter", the leading UK decision of *Bonzel v Intervention* (No 3) [1991] RPC 553 was followed by Singapore Courts in *Trek Technology (Singapore) Pte Ltd v FE Global Electronics Pte Ltd and Others and Other Suits* (No 2) [2005] 3 SLR 389.

Concerning the allowability of an amendment of a patent claim to include an unsupported disclaimer, two recent decisions by the Enlarged Board of Appeal of the European Patent Office are G0001/03 (Disclaimer/*PPG*) and G0002/03 (Disclaimer/*Genetic Systems*) [2004] EPOR 33 set out certain criteria for assessing the allowability of an unsupported disclaimer. According to these two decisions, a disclaimer which does not have basis in the specification as filed may only be allowable under limited circumstances, namely, to restore novelty over a prior art document which constitutes an "accidental disclosure", or to remove subject matter which is excluded from patentability for non-technical reasons. A prior art document is considered to be an "accidental disclosure" if it is so unrelated to and remote from the claimed invention that the person skilled in the art would never have taken it into consideration when making the invention. In other words, a prior art document is an "accidental disclosure" if a person skilled in the art would not have considered it to be relevant to the solution of the problem because it is in a technical field that is so unrelated and remote from the claimed invention.

In addition to the requirement for the prior art to constitute an accidental disclosure, an amendment by way of a disclaimer should not remove more than is necessary to restore novelty by disclaiming the excluded subject matter, make any technical contribution to the claim, or enable the patent applicant to adjust the scope of the claims.

In summary, when assessing the allowability of incorporating an unsupported disclaimer in a Singapore patent application, the criteria set out by the Enlarged Board of Appeal decisions mentioned above are expected to be applicable, particularly in relation to the requirement for the novelty destroying prior art to be an accidental disclosure.



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