

Managing Intellectual Property

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Relief for infringement of partially valid patents

A partially valid patent refers to a situation where some claims in a granted patent are found valid while other (typically broader) claims are found invalid, for example, during infringement proceedings.

Under the infringement provisions in the Singapore Patents Act, section 70 provides relief for infringement of a partially valid patent, subject to certain circumstances. Specifically, section 70(2) states that when "it is found that a patent is only partially valid, the court or the Registrar shall not grant relief by way of damages, costs or expenses, except where the plaintiff proves that the specification for the patent was framed in good faith and with reasonable skill and knowledge, and in that event the court or the Registrar may grant relief in respect of that part of the patent which is valid and infringed, subject to the discretion of the court or the Registrar as to costs or expenses and as to the date from which damages should be reckoned".

Thus, the critical issue relates to "good faith and with reasonable skill and knowledge" of the patentee. This can be an important factor in considering which prosecution strategy to adopt in obtaining grant of a Singapore patent.

Singapore adopts a self-assessment system, whereby the onus is placed on the applicant at the time of grant to ensure that the claims are valid and patentable, thereby placing a higher requirement of due diligence on the applicant. Arguably, the Singapore search and examination regime is non-conclusive because reliance on a final examination report (whether a local or corresponding foreign examination report) comprising patentability objections does not prevent grant of a Singapore patent.

An applicant wishing to rely on a final examination report containing objections therefore should give consideration to the issue of obtaining relief for partially valid patents.

For example, it may be argued that if the applicant allows claims to issue despite being aware that the objections are valid, he is acting in "bad faith" and thereby potentially depriving himself of the relief afforded under section 70(2).

There is neither any definition in the Singapore Patents Act nor any Singapore cases the authors are aware of at this stage that shed light on what constitutes being "framed in good faith and with reasonable skill and knowledge". At this point, it should be mentioned that the phrase "framed in good faith and with reasonable skill and knowledge" also appears in section 69(4) of the Singapore Patents Act. Section 69(4) states that where an amendment of a patent specification has been allowed, no account of profits or grant of relief shall be awarded for infringement of the patent committed before the allowance of the amendment, unless the specification of the patent as published was "framed in good faith and with reasonable skill and knowledge". Interestingly, the wording in section 69(4) defines "the specification of the patent as published", while section 70(2) omits the words "as published". Thus, some ambiguity arises as to whether the framing of a patent specification in good faith and with reasonable skill and knowledge in relation to ascertaining relief begins at the time the patent is published or at the time of grant. The authors favour an interpretation where it is the time of grant that is relevant.

Some assistance as to how the phrase "framed in good faith and with reasonable skill and knowledge" is assessed with regard to the breadth of claims can be found in several UK cases, which are believed to apply in Singapore due to the closeness between UK and Singapore patent laws.

In *Page v Brent Toy Products Ltd* (1950) 67 RPC 4 at page 21, the agent who drafted the specification in suit said that he initially put in a "fairly broad claim" to "draw the Patent Office search report" and had modified the claim in accordance with what the report disclosed; and that this was the practice usually adopted by agents. The claim in question was held (although invalid) to have been framed in good faith and with reasonable skill and knowledge.

The patent in *Nutrinova Nutrition v Scanchem UK (No 2)* [2001] FSR 43 concerned a process for making a particular compound, but also included claims to the production of an intermediate compound. It was held that it was not bad faith to file the specification knowing of an arguable case of obviousness in respect of the claims to the intermediate compound. Although these claims were subsequently found to be obvious, the patent agents would have been failing in their duty had they not tried to cover what was a novel intermediate compound.

Thus, if there are valid objections, it is not recommended to simply proceed to pay the grant fee because of the potential issues in relation to obtaining relief for partially valid patents discussed above.

For Singapore applications with a filing date before July 1 2004, voluntary amendments should at least be filed to address such objections before paying the grant fee.

On the other hand, for Singapore applications with a filing date on or after July 1 2004, there is a requirement for examined claims before grant. Thus, a divisional application could be filed, which makes all the examination options under the Singapore search and examination regime available again. The applicant can then request substantive examination and address the objections raised by way of written submissions and/or claim amendments during prosecution; or the applicant can seek grant of the Singapore application through reliance on a positive corresponding foreign examination, that may occur after filing the divisional application, and conform the Singapore application claims accordingly.



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