JULY / AUGUST 2008 Singapore: Patent pitfalls for foreign applicants

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Since 1995, the Singapore patent system has moved away from a re-registration system to the present examination system. However, applicants could still rely on allowed foreign applications for grant through a two-stage process. An applicant would first furnish details (country of filing, filing dates and application numbers) of all corresponding applications within 16 months of the priority date. Subsequently, the applicant would furnish prescribed information in the form of granted patents or documents setting out the final results of the search and examination of any one of the corresponding applications before 28 months of the priority date.

Further changes with regards to the requirements for examination and grant of applications were introduced in July 2004. Although generally attempting to move towards a local examination system, the requirements to rely on foreign corresponding applications for grant were eased and the two-stage process was abandoned. The first step of furnishing details of all corresponding applications was removed under the new provisions. To rely on an allowed foreign application for grant, under Section 29(c)(ii) of the Singapore Patents Act, an applicant need only furnish prescribed information prior to the deadline to pay the grant fee, which is 42 months from the priority date (or 60 months under the slow track block extension).

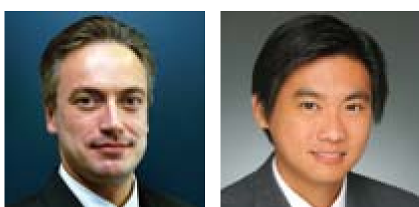
Importantly, the new provisions require applicants to make the claims of the application conform to those in the foreign corresponding application. Previously, applicants relying on a corresponding application for grant did not, somewhat paradoxically, need to ensure the claims were in conformity. Under Section 30(3) of the new provisions, for Singapore applications filed on or after July 1 2004 to proceed to grant, each claim in the application must have been examined either locally, or must be related to claims examined by prescribed patent offices (for example, the IPEA, USPTO, EPO). This practically means that the application must have its claims conformed to those in the corresponding application relied upon for grant.

As these applications (filed on or after July 1 2004) now approach their grant deadlines, the new requirements for conforming claims have raised new issues and potential pitfalls. This is because in filing amendments to conform the claims to those in the corresponding application to obtain grant, those amendments are subject to the additional requirement of not adding new matter, under Section 84 of the Singapore Patents Act. Therefore, while the application must be amended to proceed to grant, the granted patent may be vulnerable to revocation if the amendment is adding new matter under Singapore Patent Law.

There are differing interpretations of added subject matter across jurisdictions. A strict approach to the exclusion of added subject matter is adopted by Singapore Courts as they tend to follow United Kingdom precedent. Amendments allowed in the US, for example, may not be allowed in Singapore. In the US, the current test for new subject matter is "whether a person of ordinary skill in the art would recognize that the applicant possessed what is claimed... as of the filing date of the earlier filed application", ("possession test"), as set out in *Noelle v Lederman, 355 F3d 1343, 1358 (Fed Cir 2004).*

In contrast, the UK decision of *Bonzel v Intervention (no 3)* [1991] RPC 553, (which 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), sets out a stricter test for additional subject matter in that the courts must: ascertain through the eyes of the skilled addressee what is disclosed, both explicitly and implicitly, in the application; do the same in respect of the patent as granted; and compare the two disclosures and decide whether any subject matter relevant to the invention has been added by the proposed deletion or addition.

Therefore, it is recommended that applicants ensure the amendments do not contain additional subject matter under the (strict) test followed by the Singapore Court, and if possible, rely on granted UK or EPO patents as basis for their amendments. In the event of uncertainties, or if such UK or EPO patents are not available, it may be recommended that local examination of the amended claims be requested, if there is a concern that the conforming amendments from other jurisdictions could constitute added matter. Should the deadlines to request local examination have lapsed, it would still be possible to file divisional applications to ensure local examination can be requested.



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