Inputs from Member States and Regional Patent Offices to the Thirty-Eighth Session of the Standing Committee on the Law of Patents

Respondent Information

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Job title

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Disclaimer:

The information provided in response to this questionnaire is understood to be submitted on behalf of the Member State or regional organization concerned, through its competent authority and in accordance with its applicable official internal procedures.
It is assumed that the person completing and submitting the questionnaire is duly authorized to do so and that the information reflects the official position or practice of the Member State or organization, to the extent possible.

I confirm that I have read and understood the statement above and that I agree with its contents.

A. Prior Art

1. How is prior art defined under the applicable national or regional law?

The Patents Act 1994 section 14(2) states:
"the state of the art in the case of an invention is taken to comprise all matter (whether a product, a process, information about either, or anything else) which has at any time before the priority date of that invention been made available to the public (whether in Singapore or elsewhere) by written or oral description, by use or in any other way".

2. Against which date is prior art assessed under the applicable law?

Priority date (earliest filing date) of the claimed invention in current application as stated in the Patents Act 1994 section 14(2).

3. Which types of information may constitute prior art under the applicable law, and how is it determined whether such information is considered to form part of the prior art?

Examination Guidelines for Patent Applications at IPOS stated that all matter (whether a product, a process, information about either, or anything else) by written or oral description, by use or in any other way may constitute prior art. The information must have been made available to the public (whether in Singapore or elsewhere). Notably, the Patents Act 1994 does not place any requirements on the age of the disclosure, the location of the disclosure, the type of disclosure (paper or electronic), or the language of publication.

Communication to a single member of the public without inhibiting fetter is enough to amount to making available to the public. A document is available to the public even if a fee is required to view it. Furthermore, there is no need to show that the document has actually been read by a member of the public - a document is regarded as having been published provided it can be inspected as of right by the public.

See "Examination Guidelines for Patent Applications at IPOS" (version Oct 2023) Paragraphs 3.30 to 3.38 for further details. The Examination Guidelines is available at https://www.ipos.gov.sg/about-ip/patents/guides/.

4. Does the applicable law provide for any category of prior art that is taken into account for patentability purposes notwithstanding that it was not publicly available before the relevant filing or priority date (sometimes referred to as “secret prior art”)?

Yes

If yes, please indicate, where applicable, the types of information or documents concerned (for example, earlier-filed patent applications), the relevant date(s) for determining such prior art, as well as any limitations, exclusions, or special rules applicable to such prior art. : The Patents Act 1994 section 14(3) further states that the state of the art is taken also to comprise matter contained in a Singapore application for another patent which was published on or after the priority date of that invention, if that matter was contained in the application for that other patent both as filed and as published and the priority date of that matter is earlier than that of the invention. In other words, section 14(3) provides for Singapore applications that were not published at the priority date of the application to be taken into account for the purpose of determining novelty if the matter was contained in the application for that other patent both as filed and as published; and the priority date of that matter is earlier than that of the invention. See "Examination Guidelines for Patent Applications at IPOS" (version Oct 2023) Paragraphs 3.80-3.84 for more details. The Examination Guidelines is available at https://www.ipos.gov.sg/about-ip/patents/guides/.

5. Please provide any additional information that may be relevant to the understanding or application of prior art under the applicable law, including where applicable, any guidance (for example, patent office manuals or guidelines) or key judicial decisions in your jurisdiction with general relevance to applicants or interested parties, captured by patent office practice.

"Examination Guidelines for Patent Applications at IPOS" (version Oct 2023) Paragraphs 3.30-3.39, 3.73-3.84 and 3.110-3.128. The Examination Guidelines is available at https://www.ipos.gov.sg/about-ip/patents/guides/.

Please upload any document that may be relevant to the understanding or application of prior art under the applicable law.

6. Please indicate whether any legal provisions, including those applicable to utility models or any other similar system (where different from those applicable to patents of invention), are relevant to the subject matter of this section and, if so, kindly provide the relevant information and references.

The Patents Act 1994 sections 14(2) and 14(3).

B. Novelty

1. How is the requirement of novelty defined under the applicable national or regional law?

The Patents Act 1994 section 14(1) states: "An invention is taken to be new if it does not form part of the state of the art".

2. For the purposes of assessing novelty under the applicable law, are there any novelty-specific considerations regarding the relevant date or the scope of information taken into account, beyond those addressed in the Prior Art section of this survey?

Examination Guidelines for Patent Applications at IPOS states that there are two requirements for a prior art to anticipate the claimed invention: (1) prior disclosure (consideration of whether the prior art discloses all of the features of the claim in question) and (2) enablement (whether the skilled person in the art is able to perform what is disclosed in the prior art with the assumption that the skilled person is able to make trial and error experiments).

In addition, the prior art is also read through the eyes of the person skilled in the art, and as a consequence implicit features may also be taken into account for novelty purposes (i.e. implicit disclosure). On top of implicit disclosures, the prior art is considered to be anticipating the claimed invention if carrying out the directions in the prior art will inevitably result in something being made or done that would constitute an infringement of the claims (i.e. inherent disclosure).

See "Examination Guidelines for Patent Applications at IPOS" (version Oct 2023) Paragraphs 3.18-3.48 for more details. The Examination Guidelines is available at https://www.ipos.gov.sg/about-ip/patents/guides/.

3. Does the applicable law apply an absolute novelty requirement, or does it provide for any limitations or qualifications to novelty (for example, relative novelty or other restricted approaches), apart from any grace period mechanisms addressed separately in this survey?

The Patents Act 1994 section 14(1) prescribes an absolute novelty requirement by stating: "14(1) An invention is taken to be new if it does not form part of the state of the art.".

4. Apart from the approach described in question 3, are there any specific rules or contextual factors that affect what is taken into account as prior art for the purposes of assessing novelty under the applicable law?

The prior art is any matter that forms part of the state of the art as defined in sections 14(2) and 14(3) of the Patents Act 1994. There are no specific rules or contextual factors.

5. Please provide any additional information relevant to the requirement of novelty under the applicable law, to the extent not already addressed in questions 1 to 4, including, where applicable, any guidance (for example, patent office manuals or guidelines) or key judicial decisions in your jurisdiction with general relevance to applicants or other interested parties, captured by patent office practice.

See "Examination Guidelines for Patent Applications at IPOS" (version Oct 2023) Chapter 3. The Examination Guidelines is available at https://www.ipos.gov.sg/about-ip/patents/guides/.

6. Please indicate whether any legal provisions, including those applicable to utility models or any other similar system (where different from those applicable to patents of invention), are relevant to the subject matter of this section and, if so, kindly provide the relevant information and references.

The Patents Act 1994 sections 13(1)(a) and 14(1).

C. Inventive Step

1. How is the criterion of inventive step or non-obviousness defined under the applicable national or regional law?

The Patents Act 1994 section 15 states: "An invention is taken to involve an inventive step if it is not obvious to a person skilled in the art, having regard to any matter which forms part of the state of the art by virtue only of section 14(2) and without having regard to section 14(3)".

2. For the purposes of assessing inventive step or non-obviousness under the applicable law, what is the relevant date and what prior art or information is taken into account?

The relevant date is the priority date of the application and the prior art used for assessing inventive step comprises all matter (whether a product, a process, information about either, or anything else) which has at any time before the priority date of that invention been made available to the public (whether in Singapore or elsewhere) by written or oral description, by use or in any other way (i.e. state of the art as defined by the Patents Act 1994 section 14(2)).

3. What is the standard applied under the applicable law to determine whether an invention involves an inventive step or is non-obvious, in particular as reflected in the concept of the "person skilled in the art", focusing on how the standard is understood or applied, rather than its formal legal definition?

For the assessment of inventive step, the four-step approach set out in Windsurfing International Inc. v Tabur Marine (Great Britain) Ltd [1985] RPC 59 (i.e. "Windsurfing test"), which has been adopted in a number of Singapore Court decisions (e.g., V-Pile Technology (Luxembourg) SA & Ors v Peck Brothers Construction Pte Ltd [1997] SGHC 322; Merck & Co Inc v Pharmaforte Singapore Pte Ltd [2000] SGCA 39; Genelabs Diagnostics Pte Ltd v Institut Pasteur & Anor [2000] SGCA 60; Ng Kok Cheng v Chua Say Tiong [2001] SGHC 143; Peng Lian Trading Co v Contour Optik Inc & Ors [2003] SGCA 25; Trek Technology (Singapore) Pte Ltd v FE Global Electronics Pte Ltd & Ors & other suits [2005] SGHC 90; First Currency Choice Pte Ltd v Main-Line Corporate Holdings Ltd & Anor Appeal [2007] SGCA 50) is followed:

1) Identify the claimed inventive concept.

2) Assume the mantle of the normally skilled but unimaginative addressee in the art at the priority date and to impute to him what was, at that date, common general knowledge of the art in question.

3) Identify what, if any, differences exist between the matter cited as being "known or used" and the alleged invention.

4) Decide, without any knowledge of the alleged invention, whether these differences constitute steps which would have been obvious to the person skilled in the art or whether they require any degree of invention.

The person skilled in the art is taken to have the following characteristics (Ng Kok Cheng v Chua Say Tiong [2001] SGHC 143):

- possesses common general knowledge of the subject matter in question;
- has a practical interest in the subject matter of the patent or is likely to act on the directions given in it; and
- whilst unimaginative is reasonably intelligent and wishes to make the directions in the patent work.

The person skilled in the art can be a group or team of such persons.

See "Examination Guidelines for Patent Applications at IPOS" (version Oct 2023) Paragraphs 2.20-2.23, 4.18-4.21 for more details. The Examination Guidelines is available at https://www.ipos.gov.sg/about-ip/patents/guides/.

4. Are there any specific rules, limitations, or contextual factors that apply to the assessment of inventive step or non-obviousness under the applicable law?

No

Please indicate, where relevant, whether such rules or factors include geographic or territorial considerations affecting the relevance of prior art (for example, distinctions between domestic and foreign disclosures, uses, or publications, or territorial conditions applicable to particular categories of prior art) or any other particular considerations relevant to the assessment.

***Responses should be limited to such contextual factors asthey relate to the assessment of inventive step or non-obviousness, without restating general rules on what constitutes prior art.*:**

5. Please provide any additional information relevant to the requirement of inventive step or non-obviousness under the applicable law, to the extent not already addressed in questions 1 to 4, including, where applicable, any guidance (for example, patent office manuals or guidelines) or key judicial decisions in your jurisdiction with general relevance to applicants or interested parties, captured by patent office practice.

See "Examination Guidelines for Patent Applications at IPOS" (version Oct 2023) Chapter 4. The Examination Guidelines is available at https://www.ipos.gov.sg/about-ip/patents/guides/.

6. Please indicate whether any legal provisions, including those applicable to utility models or any other similar system (where different from those applicable to patents of invention), are relevant to the subject matter of this section and, if so, kindly provide the relevant information and references.

The Patents Act 1994 section 13(1)(b) and section 15.

D. Grace Period Mechanisms and Pre-Filing Disclosures

1. Does the applicable law provide for any mechanism under which certain disclosures made before the filing or priority date do not prejudice the patentability of an invention, in particular with respect to novelty and/or the legal effect on prior art?

Yes

If yes, please identify the relevant legal provisions (in primary and/or secondary legislation) and describe their operation.: The Patents Act 1994 sections 14(4) to 14(9) provide for certain matter to be disregarded for the purposes of section 14 – if the disclosure was made under certain circumstances, and within a 12-month "grace period" immediately preceding the date of filing the application for the patent. Any disclosure that is disregarded under sections 14(4) to 14(9) cannot be used for the assessment of novelty and of inventive step. Please refer to the Patents Act 1994 sections 14(4) to 14(9) or "Examination Guidelines for Patent Applications at IPOS" (version Oct 2023) Paragraphs 3.110 to 3.128 for further details. The Examination Guidelines is available at https://www.ipos.gov.sg/about-ip/patents/guides/.

2. What is the duration of the mechanism referred to in question 1, during which the covered disclosures do not prejudice the patentability of the invention?

As stated in the Patents Act 1994 sections 14(4) to 14(9), grace period is 12 months immediately preceding the date of filing the application for the patent. This means the date of filing the application in Singapore and not the date of filing the priority document (for example the basic document in a foreign country).

3. Where such a mechanism exists, which categories of disclosures are covered by it?

The Patents Act 1994 section 14(4) list the following circumstances (a)-(e) for which grace period could apply:

(a) the disclosure was due to, or made in consequence of, the matter having been obtained unlawfully or in breach of confidence by any person —
(i) from the inventor or from any other person to whom the matter was made available in confidence by the inventor or who obtained it from the inventor because he or the inventor believed that he was entitled to obtain it; or
(ii) from any other person to whom the matter was made available in confidence by any person mentioned in sub-paragraph (i) or in this sub-paragraph or who obtained it from any person so mentioned because he or the person from whom he obtained it believed that he was entitled to obtain it;
(b) the disclosure was made in breach of confidence by any person who obtained the matter in confidence from the inventor or from any other person to whom it was made available, or who obtained it, from the inventor;
(c) the disclosure was due to, or made in consequence of, the inventor displaying the invention at an international exhibition;
(d) the disclosure was due to, or made in consequence of, the inventor describing the invention in a paper read by him or another person with his consent or on his behalf before any learned society or published with his consent in the transactions of any learned society; or
(e) subject to sections 14(6) and (7), the disclosure was made to the public by the inventor, or by a person who obtained the matter directly or indirectly from the inventor, in any circumstances not described in paragraphs (a) to (d).

The Patents Act 1994 sections 14(4)(c), (d) and (e) are further detailed in "Examination Guidelines for Patent Applications at IPOS" (version Oct 2023) Paragraphs 3.110, 3.115-3.128. The Examination Guidelines is available at https://www.ipos.gov.sg/about-ip/patents/guides/.

While an intellectual property administrator may be considered a person who obtained matter constituting an invention "directly or indirectly from the inventor", the mechanism does not permit an inventor's (or joint inventors') own applications for intellectual property rights (e.g. patent applications, utility models, etc.) from being disregarded, unless under the very limited circumstances prescribed in the Patents Act 1994 sections 14(6) and 14(7).

The Patents Act 1994 sections 14(6) and 14(7) allow disregard of the disclosure by publication by an intellectual property administrator of an application/registration for an intellectual property right only if:

(i) the application was filed, without the consent of the inventor, by a person who obtained the matter directly or indirectly from the inventor or
(ii) if the publication was erroneous by reason that the application had been withdrawn, refused or abandoned before the date of the publication and consequently, the publication was not required under the law (whether of Singapore or elsewhere) or treaty governing the application.

If the publication by an intellectual property administrator of an application/registration for an intellectual property right was erroneous by reason that the publication occurred earlier than provided under the law (whether of Singapore or elsewhere) or treaty governing the application, the matter is to be treated as disclosed to the public on the date when the publication should have occurred under that law or treaty.

4. Are there any formalities or procedural requirements that must be fulfilled in order to rely on the mechanism identified in question 1?

Yes

Please describe any such requirements, where applicable, including, for example, the need to file statements, declarations or notices, to submit certificates or other supporting evidence, or to comply with any timing or notification requirements or any information relating to the burden of proof. **:** The Patents Act 1994 section 14(8) specifies that if the applicant intends to rely on any of the circumstances described in sections 14(4)(a)-(e) when requesting for an examination report, a search and examination report, a review of an examination report or a review of a search and examination report, or when responding to a written opinion issued by an Examiner, the applicant must file written evidence complying with the prescribed requirements in support of the reliance on those circumstances. The prescribed requirements are set out in Rule 8 of the Patents Rules. Rule 8(1)(a) requires that the supporting written evidence must be by statutory declaration or affidavit, and must enclose all supporting documents. In general, the onus is on the applicant to make out a sufficient prima facie case in the statutory declaration or affidavit (in which all supporting documents are to be enclosed) that one of the circumstances in sections 14(4)(a)-(e) is satisfied. Further information can be found in "Examination Guidelines for Patent Applications at IPOS" (version Oct 2023) Paragraphs 3.113-3.125. The Examination Guidelines is available at https://www.ipos.gov.sg/about-ip/patents/guides/.

5. Does the applicable law provide for prior user rights or other protections for third parties who may be affected by an invention that has benefited from a graced pre-filing disclosure?

Yes

If yes, identify the relevant legal provisions (including any provisions in primary and/or secondary legislation), and describe the conditions under which such rights or protections arise (for example, good-faith use of the invention prior to the filing or priority date), as well as how such rights or protections operate. **:** The Patents Act 1994 section 71 states: "Right to continue use begun before priority date 71.— (1) Where a patent is granted for an invention, a person who in Singapore before the priority date of the invention — (a) does in good faith an act which would constitute an infringement of the patent if it were in force; or (b) makes in good faith effective and serious preparations to do such an act, has the right to continue to do the act or, as the case may be, to do the act, despite the grant of the patent. (2) The right conferred by subsection (1) does not extend to granting a licence to another person to do the act. (3) If the act was done, or the preparations were made, in the course of a business, the person entitled to the right conferred by subsection (1) may — (a) authorise the doing of that act by any partner of that person for the time being in that business; and (b) assign that right, or transmit it on death (or in the case of a body corporate on its dissolution) to any person who acquires that part of the business in the course of which the act was done or the preparations were made. (4) Where a product is disposed of to another person in exercise of the rights conferred by subsection (1) or (3), that other person and any person claiming through that other person may deal with the product in the same way as if it had been disposed of by the registered proprietor of the patent."

6. Please provide any additional information that may be relevant, including, where applicable, any guidance (e.g. patent office manual/guidelines) or key judicial decisions in your jurisdiction with general relevance to applicants or interested parties, captured by patent office practice.

"Examination Guidelines for Patent Applications at IPOS" (version Oct 2023) Chapter 3, Section P. The Examination Guidelines is available at https://www.ipos.gov.sg/about-ip/patents/guides/.

Please upload any document that may be relevant to grace period mechanisms and/or pre-filing disclosures.

7. Please indicate whether any legal provisions, including those applicable to utility models or any other similar system (where different from those applicable to patents of invention), are relevant to the subject matter of this section and, if so, kindly provide the relevant information and references.

The Patents Act 1994 sections 14(4)-(9).

Submission of information concerning other aspects of national/regional patent law

E. Sufficiency of Disclosure

SCP_38_C._9304_-_Reply_to_E.pdf

F. Exclusions from Patentable Subject Matter

SCP_38_C._9304_-_Reply_to_F.pdf

G. Exceptions and Limitations to Patent rights

SCP_38_C._9304_-_Reply_to_G.pdf

Final review before submission

Confirmation of submission

I am aware that by clicking "Submit" below, my responses will be sent to the SCP Secretariat.