A Short Guide
Patents – Singapore
A patent grants the right to prevent others from exploiting an invention in a particular jurisdiction. It is a form of monopoly. As with any commercial tool, you should only consider a patent if it would be commercially useful.
'Marks & Clerk has a laser focus on patents. It is stocked with people who have the greatest technical understanding'

IAM Patent 1000 2016 guide, Singapore section

An invention is patentable in Singapore if it is:

- new (novel)
- involves an inventive step
- industrially applicable

Novelty of an invention is assessed on a worldwide basis and this comprises anything that is in the public domain before the filing or priority date of a patent application under a first-to-file system.

However, certain disclosures are excluded from destroying the novelty of the invention: for example, disclosures committed in consequence of acts done by, or in abuse of the rights of, the applicant or their predecessor in title or in consequence of a paper being read before or published by a learned society during a one-year period preceding the filing date of the application are disregarded.
Non-patentable inventions
The Singapore Patents Act does not have a list of excluded subject matter, except for inventions the publication or exploitation of which would be generally expected to encourage offensive, immoral or anti-social behaviour. However, the definition of an invention has not yet been considered by the Singapore courts. Therefore, although for example, business methods are not specifically excluded from patentability in Singapore, it is not clear to what extent these would be considered inventions and, thus, if they are ultimately patentable.

Further, a method for treatment of the human or animal body by surgery or therapy, or a diagnostic method practiced on the human or animal body shall not be considered to be capable of industrial application. It is believed that second medical use claims of Swiss-style form are allowable in Singapore.

First-filing requirement
No resident in Singapore can file or cause to be filed any patent application outside Singapore without written authority from the Registrar, unless a patent application for the same invention has already been filed at the Singapore Patent Office not less than two months before the application outside Singapore, and no directions restricting publication of the Singapore patent application have been issued by the Registrar or all such directions have been revoked. Contravention of this requirement in principle carries a heavy jail term not exceeding two years.

Filing options
A patent application in Singapore may be filed as a national patent application for which Convention priority may be claimed or as a national phase entry of a PCT application.

The deadline for filing an application claiming priority is 12 months from the priority date, which in some circumstances may be extended. The deadline for filing a PCT national phase application whether via Chapter I or Chapter II is 30 months from the PCT filing date, or priority date if priority is claimed and this period is extendable by up to 18 months as of right upon payment of monthly extension fees.

No documents signed by the applicant or inventors are needed for filing patent applications in Singapore.

Preliminary examination
After an application has been accorded a filing date, it will be examined in accordance with the formal requirements. In the event of non-compliance, the applicant will be given an opportunity to respond and/or amend the application within a specific time period to address the objection.

Filing Formalities
National applications
This explanation applies only to national patent applications filed after 14 February 2014.

The minimum requirements for filing a national Singapore patent application:
(i) Identification of the applicant
(ii) Specification and drawings if appropriate – these can be informal but must be legible
(iii) The priority date and country of filing (if priority is claimed)
(iv) If the invention relates to a microorganism, deposit of the culture needs to have been made with any international depositary authority

The filing formalities are completed when the following further documents have been filed by the deadlines noted:
(a) A4 formal copies of the specification together with formal drawings – documents suitable for filing in UK or Australia should be acceptable
(b) The priority number (if not previously supplied)
(c) Name, address and nationality of the inventor(s), how the applicant is entitled (by virtue of employment or assignment, for example) and confirmation that the inventor(s) were not resident in Singapore at any time during the period of invention.
(d) In the case of a microorganism, the name of the international depositary authority, the date the culture was deposited, the accession number of the deposit

The deadline for filing (a) is set by the Singapore Patent Office in an official action after filing, and normally a deadline of at least two months is given to meet any objections raised in the official action. This deadline is extendable with the consent of the Registrar.

The deadline for filing (b)-(d) is 16 months from filing or priority, if claimed.

PCT applications
For PCT applications entering the national phase in Singapore, the filing deadline is 30 months from filing or priority, if claimed. The following are required to obtain a filing date:
(a) The front page of the PCT application as published with details of any subsequent bibliographic changes, or equivalent information
(b) Item (6) below, if the PCT application is not in English

The following are also required later in the application process:
(1) A full copy of the PCT application as published
(2) A copy of the search report together with a copy of the International Preliminary Report on Patentability (IPRP – chapter I)
(3) Forms PCT/IB/306 from WIPO confirming any bibliographical changes (such as change of applicants) made during the International Phase of the application
(4) If the applicant is a US company, the State of Incorporation
(5) If International Preliminary Examination of the application has been requested, a copy of the IPRP (chapter II) if this has issued, together with any annexed pages
(6) If the PCT application is not in English, separate translations of (i) the application as originally filed, of (ii) any amendments to the claims filed under Article 19 and (iii) any amendments to the specification filed under Article 54 (usually annexed to the IPRP issued under Chapter II)

The translations must be filed when the application for entry to the national phase is made. These translations should preferably be under cover of a signed verification by the translator. However, the translations may be filed initially in unverified form (for example, using a fax copy) with verified versions following within two months of the deadline for entry to the national phase.

(7) If the names and addresses of the inventors were provided on the PCT request, there is no need to file a declaration of inventorship in the national phase. However, if these details were not provided – for example, if the inventor’s complete addresses were not provided – it is necessary to file a declaration of inventorship within two months of the deadline for entry to the national phase, and so the information noted above in paragraph (c) for national applications will be required.

(8) Copies of the citations raised in the International Search Report (ISR), if local examination needs to be requested

Extensions of Time
For both national applications and PCT national phase entries, most deadlines may be extended upon payment of a fee. Please contact us for further information.

In Singapore, we have won the Managing Intellectual Property award for ‘Singapore Prosecution Firm of the year’ for three consecutive years.
Search and Examination

The options for search and examination of any patent application in Singapore are complicated. Generally, unless there is a specific option an applicant wishes to adopt on a particular case, we will advise on what we consider the best option in the circumstances.

National applications

There are several options (routes 1 to 5), depending on the existence of corresponding applications filed in prescribed jurisdictions and their status at the time examination has to be requested. Corresponding applications are applications that share one or more of the priority claims of the Singapore application or that claim priority from the Singapore application and have been filed in any of the following prescribed jurisdictions:

- Australia
- Canada (if in English)
- New Zealand
- United Kingdom
- United States of America
- Japan
- Republic of Korea
- Europe (applications filed at the European Patent Office in English)
- PCT applications

The various search and examination routes are:

Routes N1 and N2 – Local search and examination:

With these local examination routes, no reliance is placed upon corresponding foreign applications and the routes differ only at the time a search is requested. With route N1, a search is requested separately by a deadline of 13 months from the filing date, or priority date if priority is claimed, with examination being subsequently requested by a deadline of 36 months from the filing or priority date. With route N2, search and examination are requested together by a deadline of 36 months from the filing or priority date. Of the options available, these routes are the most straightforward, but are the most expensive. Route N1 is only recommended if the applicant specifically desires a separate search before making a decision as to whether or not examination should be requested, since it is cheaper to request search and examination together by route N2 than separately by route N1.

Route N3 – Local examination using a foreign search:

Instead of requesting a local search, it is possible to rely on the search of a corresponding foreign application in one of the jurisdictions noted above if it is issued by the deadline of 36 months from the filing or priority date. Examination based on the foreign search report could save on costs. For this option, a copy of the foreign search report, a copy of each of the citations raised and a patent family list for those citations not in English are required.

Route N4 – Supplementary/Modified examination based on a foreign search:

It is possible to rely on acceptance of a corresponding foreign application in one of the jurisdictions noted above (except New Zealand) instead of requesting search and examination. If this route is chosen, there will be no need to request search or examination by the deadlines set in routes N1 to N3. Instead, any action can be deferred until closer to a deadline of 54 months from the priority or filing date, at which point it is necessary to file either documents showing the conclusion of examination as to substance of the corresponding foreign application or a copy of the patent either certified or in a form otherwise acceptable to the Registrar.

Route N5 – Reset prosecution deadlines:

The disadvantage of route N4 is that at the time a decision is made as to whether or not to request examination, an applicant may not know that a corresponding application will be accepted by the deadline of 54 months from priority. If, by that deadline, a corresponding application has not been accepted, the only way that prosecution of the Singapore application can continue is by filing a divisional application, resetting the deadlines for search and examination and allowing more time for the corresponding application to be accepted. This is route N5. All deadlines for the divisional application are reset from its actual date of lodgement and all routes N1 to N5 become available for this divisional case.

This makes it possible to request normal search and examination of the divisional case, if prosecution of foreign applications is not progressing.

PCT national phase applications

The options to prosecute a national phase application in Singapore are:

Route M1 – Supplementary/Modified examination based on the IPRP:

This route relies on the IPRP and is recommended if the IPRP is positive. It is the most straightforward and cost-effective.

Routes M2 and M3 – Local examination with foreign search or a foreign search:

These two routes are very similar to the corresponding routes, N2 and N3, discussed for national applications. Route M2 is the most expensive in view of the higher official fees payable and is recommended if the ISR does not cover all the claims that the applicant wishes to prosecute. On the other hand, if the ISR covers all the desired claims, route M3 is recommended – that is, to request examination based on the ISR, representing a cost saving over route M2. It is also possible to request examination based on the foreign search report through route M3. To proceed with route M3, a copy of the search report (together with an English translation if it is not in English), a copy of each of the citations raised and a patent family list for those citations not in English are required.

Route M4 – Supplementary/Modified examination based on a foreign allowance:

This is similar to route N4 for national applications with the deadline for filing documents showing conclusion of examination or a copy of the patent of a prescribed corresponding application within 54 months of the filing date or priority date. Allowance of national phases of the same PCT application in prescribed countries may also be used for route M4 even if there is no priority claim.

Route M5 – Reset prosecution deadlines:

As with route N5 for national applications, if no prescribed corresponding application is allowed within 54 months, it is possible to continue prosecution by filing a divisional application, resetting the deadlines for search and examination and allowing more time for the corresponding application to be accepted. The prosecution options available to the divisional application are exactly those explained above for national applications.

Through our network of Asia offices (Singapore, Kuala Lumpur, Hong Kong and Beijing) and our strong links with other firms in the region, we can manage and execute filing programmes across the whole of Asia and further afield.
Examination Procedure

Local/Normal examination

Once local (search and) examination is requested, the application is examined for all aspects of patentability and, following this examination, if the examiner has any objections, a first written opinion will issue giving an unextendable deadline of five months for response. The applicant’s response is then considered by the examiner and, if the examiner has any further objections, they may issue a further written opinion (although this is not required) with a similar response period, and the applicant may then respond to the further objections the examiner has. The examination procedure concludes with the issuance of a final examination report which may be positive (i.e., the examiner finds all the claims to be patentable) or negative (i.e., the examiner has some outstanding objections to the patentability of the invention).

Supplementary/Modified examination

Where reliance is placed on acceptance of a corresponding foreign application, (through route N4 for national applications and routes M1 and M4 for PCT national phase applications), it is necessary to request supplementary examination when submitting the documents showing conclusion of examination of the corresponding application. Unlike the local/normal examination – which takes place, for example, under routes N1 to N3 for national applications and routes M2 and M3 for PCT national phases – in which the application is examined for all aspects of patentability, including novelty and inventive step, supplementary examination is a limited examination confined to certain aspects of Singapore patent law, which may be different to those examined in respect of the corresponding application on which reliance is placed. Supplementary examination only examines for (a) added matter and unallowable amendments, (b) whether the claims of the Singapore application are related to those of the corresponding application as accepted, (c) whether the claims relate to methods of medical treatment, (d) double patenting, (e) support for the claims in the description, and (f) determining that the invention as claimed is neither offensive nor anti-social.

Following supplementary examination, if the examiner has any objections, a single written opinion issues. A period of three months is allowed for response to the written opinion and the examiner then concludes the supplementary examination procedure and issues a supplementary examination report (which will issue immediately if the examiner has no objections). The report will either be positive (i.e., all claims are found patentable) or negative (i.e., the examiner has some outstanding objections).

Grant

Examination procedures conclude with the issuance of an examination report and until February 2014, it was possible to pay grant fees even if there were objections outstanding in the examination report. However, the Singapore Patents regime has now changed from one of “self-assessment” to one of “positive grant” and it is now only possible to obtain a patent if all objections to patentability are overcome. Once the examination report issues, if it is positive, a notice of eligibility will now issue giving a deadline of two months from which the grant fees must be paid.

However, if the examination report is negative, a notice of intention to refuse the application will issue. A two-month period follows in which the applicant may request a review of the decision and submit any arguments to address the objections raised in the examination report. It is also allowable to make amendments at this stage, but only to address the objections outstanding. The application for review is sent to a different examiner who considers the matter and issues a review report. If the report is positive, a notice of eligibility will issue, as noted above, and the grant fees may be paid. If the review report is negative, a notice of refusal will issue. The notice of refusal may be appealed to the Singapore High Court by filing a notice of appeal within six weeks of its date of issue for substantive issues, or within 14 days for any procedural matter.

The notice of refusal does not have effect immediately, but two months from its date of issue. It is possible to file a divisional application to recommence prosecution of the application in a similar manner to a US continuation application at any time up until the date the notice of refusal has effect. The applicant may also file a divisional application instead of following the procedure for applying for review of the examination report.

After the grant fees are paid, the Patents Registry subsequently issues the patent certificate.

Renewal fees are due after the fourth year on the anniversary of filing and can be paid up to six months late with a fine. If the patent certificate does not issue by the time the first renewal fee is due, payment of that renewal fee is deferred until the patent certificate actually issues at which time a three-month extension period is granted for paying the outstanding renewal(s).

Revocation

A patent may be revoked in the Singapore courts on any of the following grounds:

- the invention is not patentable
- the patent was granted to a person who was not entitled to be granted the patent
- the specification of the patent does not disclose the invention clearly and completely for it to be performed by a skilled person
- the matter disclosed in the specification of the patent extends beyond what was originally disclosed
- an amendment or correction has been made to the specification which should not have been allowed
- the patent was obtained
  - (i) fraudulently
  - (ii) on any misrepresentation
  - (iii) on any non-disclosure or inaccurate disclosure of any prescribed material information, whether or not the person under a duty to provide the information knew or ought reasonably to have known of such information or the inaccuracy
- double patenting

Infringement

Where a patent is granted for a product, the owner of the patent has exclusive rights to stop others from making, importing, offering for sale, selling or using the patented product, or keeping such a product whether for disposal or otherwise. Where a patent is granted for a process, the owner of the patent has exclusive rights to stop others from using or offering for use in Singapore the patented process, or making, importing, offering for sale, selling or using a product obtained directly by means of the patented process, or keeping such a product whether for disposal or otherwise.

There is no contributory/secondary infringement in Singapore.

Remedies for infringement include:

- (a) injunction
- (b) delivery-up or destruction of infringing articles
- (c) damages
- (d) account of profits derived by the infringer from the infringement
- (e) a certificate of contested validity

A defendant may plead ignorance of the existence of the patent, as a defence against an award of damages or account of profits. It is therefore advisable for patent owners to give due notice of their patent(s). This is generally done by clearly indicating the details of the patent on the product or packaging.

There are certain acts exempted from infringement. For example, it is not an infringement if an act is done for experimental purposes. A patent owner also cannot stop the import or sale of patented non-pharmaceutical products that have been put on the market by the patent owner or their licensee. Special exemptions also apply to a patented pharmaceutical product. More information on these exemptions is available on request.