



Association of Singapore
Patent Attorneys

Intellectual Property Office Of Singapore
51 Bras Basah Road
#01-01, Manulife Centre
Singapore 189554

Attention: Ms Chung Ka Yee

29 January 2016

Dear Ka Yee,

Re: Feedback on Proposed Changes to Chapter 8 Of The Examination Guidelines For Patent Applications

We write in response to the email of 23 December 2015 regarding proposed changes to Chapter 8 of the Examination Guidelines For Patent Applications ("Guidelines").

This submission is made by the Association of Singapore Patent Attorneys (ASPA) on behalf of its members. ASPA is the only professional organisation dedicated solely to the representation of the patent profession in Singapore. Our members are engaged in patent work in Singapore and are either registered with IPOS as patent attorneys or are currently undergoing training to qualify as patent attorneys. ASPA also has members who are also qualified to practice in other jurisdictions/regions, such as, for example, United Kingdom, USA, EPO, and Australia. Our members represent clients from Singapore and as well as foreign applicants from the major industrialised countries, in nearly every sector of industry where research takes place.

As patent practitioners, our members are expected to be aware of the provisions governing patent examination in Singapore. Because of this, our members have a keen interest with regard to the proposed changes to the Guidelines. We believe that a review of the Guidelines is timely and are glad that we have the opportunity to provide feedback pertaining to the proposed changes to the Guidelines. Our feedback is as follows:

Para 8.3

We submit that the proposed Guidelines recite a definition of "invention" which has no legal basis. Correspondingly, relying on a questionable definition of "invention" in order to justify the exclusion of subject matter which would otherwise be patentable is undesirable.

Paras 8.6/8.7

We submit that the proposed Guidelines which provide guidance on the patentability of computer-implemented inventions (CIIs) are inconsistent with the Patents Act. We refer to our email submissions on 8 May 2015 which we sent to Mr Dexter Teo and Mr Wong Chee Leong pertaining to the "Guidelines Relating to Supplementary Examination, Patentable Subject Matter and Computer-Implemented Inventions". The main thrust of our earlier submissions is the lack of legal basis with regard to the proposed Guidelines at that juncture. A copy of that email is enclosed.

We also enclose a scan of a portion from the book "A Guide to Patent Law in Singapore" by Alban Kang, the late Isabel Chng and Simon Seow. We wish to highlight the following passage at page 67 of Chapter 3:

"3.2.2 The Singapore Patents Act 1994 was amended in 1995 to bring the law into conformity with TRIPS. Specifically, s13(2) was deleted which had contained a statutory prohibition to exclude from patentability certain types of subject matter.

3.2.3 The effect of this amendment is that there is no doubt that software is patentable subject matter. There is also a strong implication that pure business method patents (business methods not restricted to a computer implementation) are patentable subject matter. As a general rule, a business method is patentable if it defines a specific business process rather than a general business strategy. IPOS has been willing to grant patents for business methods which are novel, inventive and industrially applicable." (emphasis added)

We note the late Isabel Chng and Simon Seow both previously held the position of Registrar of Patents. In addition, we note that the patentability of software and business methods has typically not been raised as an issue by IPOS since the deletion of s13(2) of the Patents Act.

If what has changed is policy (as opposed to statute or judicial interpretation), then the proper avenue to implement this is by a change in the legislation. If the Government feels that there should be exclusions to patentability, the Patents Act should be amended to make this explicit. Merely amending the Guidelines only causes uncertainty for innovators, third parties and patent attorneys who need to provide advice for such issues. That is most undesirable.

However, while the proposed Guidelines provide an illustration with regard to the definition of "integral", we note that "a computer-implemented business method may be considered an invention" if the

claimed technical features interact with the steps of the business method (i) to a material extent and (ii) in such a manner as to address a specific problem.

Firstly, we are concerned by the uncertainty of the use of "may" in the quoted statement. Could it be possible to provide an example(s) when a computer-implemented business method is not considered an invention even if the claimed technical features interact with the steps of the business method (i) to a material extent and (ii) in such a manner as to address a specific problem?

It is helpful, however, that an example of what is defined by "material extent" is provided in the Guidelines as "material extent" can be subject to various interpretations.

Para 8.8

We note that there is mention of "maintaining consistency with international patent norms". We are curious with regard to the inclusion of such a statement which is contrary to the view of the Singapore courts, as the courts have maintained that decisions made at the EPO (for example) only have persuasive value to the Singapore courts, but are not binding (Main-Line Corporate Holdings Ltd v DBS Bank Ltd [2012] SGHC 147).

Furthermore, there are a number of jurisdictions around the world where business methods and computer related inventions are clearly regarded as patentable.

Finally, the TRIPS agreement, which is an international agreement governing intellectual property matters between signatory nations (including Singapore) makes clear that patents should be available for any inventions, whether products or processes, in all fields of technology.

For these reasons, we do not believe that the proposed guidelines would achieve the stated aim of "maintaining consistency with international norms".

Paras 8.12/13

We submit that there appears to be some doubt in relation to what is meant to be considered patentable under 8.12 in light of the comments in 8.13. In the first sentence of 8.12 it is stated that naturally occurring material or microorganism is not patentable as it would represent a mere discovery. Thus, a claim to "A microorganism X" or "An isolated microorganism X" is not patentable. However, it could be considered patentable if "a new use of that material and microorganism is found, then the use could be claimed, as well as the new isolated material or microorganism" (emphasis added). This sentence now indicates that the use could be claimed, e.g. "The use of the microorganism X for Y". However, this sentence also states that the new isolated material or microorganism could be claimed. However, the isolated material or microorganism is not new as it is still a naturally occurring biological material or microorganism. For example, a naturally occurring microorganism producing an antibiotic is still not new only because it is claimed in a patent application. However, what makes such an antibiotic

producing microorganism patentable subject matter is the fact that no one knew about it before and its technical use is made available to the public for the first time. This appears to be confirmed in 8.13 where reference is made to Kirin-Amgen v. Hoescht Marion Roussel [2005] RPC 9 where the Court allowed a claim directed to isolated erythropoietin and the process of making it.

Based on this understanding, we wonder whether 8.12 should be construed as “However if a new use of that material or microorganism is found, then the use could be claimed, as well as the new isolated material or microorganism.” That would clarify that the material or microorganism per se is patentable and not a mere discovery because there is a technical use to it that is exploited for the first time.

Conclusion

We submit that IPOS, in the course of providing the Guidelines, should interpret the law by providing guidance with reference to statutory law as well as to the facts and holding of case law, and should not redefine or create an extension of the law to achieve any particular objectives. Doing so would be against IPOS' best interests, as it may lead to circumstances where the validity of the Guidelines is challenged in Court. That would be very undesirable.

We trust that our submissions are clear and useful for your needs. However, we are happy to elaborate on any of the points if needed. If you have any questions or queries in relation to this submission, please do not hesitate to contact us.

Yours faithfully,



Desmond Tan
Secretary
Association of Singapore Patent Attorneys (ASPA)

Encls.

**A GUIDE TO
PATENT LAW
IN SINGAPORE**

**General Editor:
Alban Kang
with ATMD, Isabel Chng
and Simon Seow**

**Singapore
Sweet & Maxwell Asia
2005**

WHAT IS A PATENTABLE INVENTION?*

INTRODUCTION

3.1.1 Under the Patents Act, a patentable invention must satisfy the following conditions:¹

- (a) the invention is new;
- (b) it involves an inventive step; and
- (c) it is capable of industrial application.

3.1.2 The above conditions are almost universal conditions found in all patent regimes around the world. While the statutes have set out the parameters of what constitute a patentable invention, case law has helped define the meaning of the words of the statute. Also since the Singapore Patents Act is modelled after the UK and Australian Patents Acts, both English and Australian cases are of relevance in the interpretation of the Singapore Patents Act.

PATENTABLE SUBJECT MATTER

Subject matter that is patentable

3.2.1 Generally speaking, man-made inventions and new compositions of matter are proper subjects of patent protection in Singapore. That is, inventions in all fields of technology that are capable of industrial application are patentable inventions. Section 16(1) clarifies the phrase 'capable of industrial application' by stating that an invention shall be taken to be capable of industrial application if it can be made or used in any kind of industry, including agriculture.

* The editor would like to thank James Wan and Dermond Tan who helped prepare the first draft of this chapter.

1 Section 13(1) of the Patents Act 1994.

3.2.2 The Singapore Patents Act 1994 was amended in 1995² to bring the law into conformity with TRIPS.³ Specifically, s13(2) was deleted which had contained a statutory prohibition to exclude from patentability certain types of subject matter.⁴

3.2.3 The effect of this amendment is that there is no doubt that software is patentable subject matter. There is also a strong implication that pure business method patents (business methods not restricted to a computer implementation) are patentable subject matter. As a general rule, a business method is patentable if it defines a specific business process rather than a general business strategy. IPOS has been willing to grant patents for business methods which are novel, inventive and industrially applicable.

3.2.4 Chemical substances that are isolated by means of extraction, purification or other methods from living organisms existing in nature are patentable if they are shown to be useful. If these chemical substances are able to treat a disease, they are patentable as therapeutic drugs. Similarly, DNA and proteins are patentable if they are shown to be useful.

3.2.5 The rationale for granting a patent was succinctly set out by Lord Hoffmann in *Kirin-Amgen Inc v Hoescht Marion Roussel Ltd*:⁵

An invention is a practical product or process, not information about the natural world. That seems to me to accord with the social contract between the state and the inventor which underlies patent law. The state gives the inventor a monopoly in return for an immediate disclosure of all the information necessary to enable performance of the invention. That disclosure is not only to enable other people to perform the invention after the patent has expired. If that were all, the inventor might as well be allowed to keep it a secret during the life of the patent. It is also to enable anyone to make immediate use of the information for any purpose which does not infringe the claims. The specifications of valid and subsisting patents are an important source of information for further research, as is abundantly shown by a reading of the sources cited in the specification of the patent in suit.

3.2.6 The Patents Act does not expressly include or exclude the patenting of life forms as patentable inventions. Thus, it can be inferred that animals are potentially patentable inventions. It will be interesting to see whether

2 Patents (Amendment) Act 1995 (Act 40 of 1995). See also discussion, "History of Patent Law in Singapore" in Chapter 2.

3 Trade Related Aspects of Intellectual Property Rights. See discussion in Chapter 2.

4 See ¶3.2.7 below.

5 [2004] UKHL 46 at para 77. It has been about eight years since the House of Lords delivered a major decision on patent law, the last one being *Biogen Inc v Medeva plc* [1997] RPC 1. In 2000, the House of Lords delivered judgment on the meaning of "repair" under the Patents Act 1977. See *United Wire Ltd v Screen Repair Services Ltd* [2001] FSR 24.