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“PUBLIC CONSULTATION ON PROPOSED AMENDMENTS TO SINGAPORE’S PATENTS LEGISLATION”

ASPA MEMBERS' FEEDBACK

Dear Sir,

Thank you for your email of November 4, 2016 seeking feedback on the proposed amendments to Singapore’s patent legislation from the members of our association. The feedback we received from our members is set out below.

1. There is concern that having a grace period regime that is not in line with other major jurisdictions may send a wrong and/or confusing message to the public. There could potentially also be a misuse of the provision to extend the period of protection.

Another member expressed strong reservation about the introduction of the grace period as it will encourage reckless behavior on the part of local applicants. If a local inventor is told that Singapore has a grace period, he or she will (possibly or even probably) think it is okay to tell the world, before even considering filing a patent application.

The problem is that if the invention turns out to be successful, it might only eventually be patentable in a small number of countries.

There are many commercially important territories in the world where there is no grace period; these include the European Patent Office, for example.

A small number of countries do have grace period provisions; this is the exception rather than the rule. The problem is that the rules for governing such disclosures in those countries which have a grace period

provision are not harmonized. There is therefore absolutely no guarantee that a disclosure covered by a grace period provision in one country would be excepted in another.

Finally, the grace period provisions in many countries require the disclosure to have been made within a certain period before the filing date - not the priority date - in order to be considered not part of the state of the art. Unless one is very careful, or is well advised and files in time, he/she might very well find that he/she falls outside the grace period provision in those countries.

The expectation that it is okay to disclose before filing would cause serious problems, were the invention to be sought to be protected around the world. It would increase the expense of both local and foreign prosecution. There is a good possibility that a prior disclosure before filing in Singapore would prevent the invention from being protected in many overseas territories. In an extreme scenario, the inventor might end up with protection only in Singapore.

The above is not simply theoretical. As an example, the Massachusetts Institute of Technology (MIT) obtained a patent for the RSA public key cryptography system, but only in the United States. The reason is that they relied on the US grace period provision, the algorithm having been made public 2 weeks before the filing date of the patent application. Most people use public key crypto every day, probably multiple times, and certainly whenever one visits an SSL protected site. It's therefore a hugely important invention. However, no other patent was obtained anywhere outside the US, likely because of the prior disclosure.

Is this something we want to happen to local inventions?

At the end of the day, the aim of any piece of legislation is to change the behavior of people, in some way that there is an overall benefit to society. In view of the above concerns, there is a high risk that there will not be any benefit to society in the grace period proposal.

For these reasons, the commentator believes that the grace period provisions should not be introduced into the Patents Act in Singapore.

Another commentator added that such a change in the legislation may result in a drop in the number of patent filings in Singapore, as inventors may rely on the grace period to wait-and-see if their invention gets traction in the market, and if not, they are likely to forego filing a patent application(s) for the invention.

2. Nevertheless, if the intention is to have a general grace period such that any disclosure in the 12 months prior to filing is to be disregarded for novelty/inventive step, it is unclear why the provisions 14(4) (a) to (d) are being retained. A suggestion has been made to repeal s 14(4)(a)-(d) and replace this with a single s 14(4) which simply states:

“For the purposes of this section, the disclosure of matter constituting an invention shall be disregarded in the case of a patent or an application for a patent if occurring later than the beginning of the period of 12 months immediately preceding the date of filing the application for the patent and the disclosure was made to the public by the inventor, or by a person who obtained the matter disclosed directly or indirectly from the inventor.”

3. Disclosures subject to S.14(4)(e)

The new exception added to S.14(4) reads as follows:

- (e) the disclosure was made to the public by *the inventor*, or by a person who obtained the matter disclosed directly or indirectly from the inventor, in circumstances other than the circumstances described in paragraphs (a), (b), (c) or (d). (emphasis added)

While S.14(6) clarifies that references to "the inventor" also includes references to any proprietor, the exception in S.14(4)(e) should also apply to any disclosures made by a joint inventor.

4. Concerning Section 14(5B)(b) of the Act in conjunction with Rule 8(2)(d), it is doubtful that an acknowledgement from a foreign IP office would in general be available. What happens then?

5. Written evidence required under S.14(5C)

Regarding the requirement of "supporting written evidence complying with the prescribed requirements", it would be helpful for additional guidance to be provided, either in the Act or in the Examination Guidelines, on what evidence would be sufficient to comply with the requirements.

Additionally, it is also unclear from Section 14(5C) in conjunction with Rule 8(1) when any of the grounds in Section 14(4) should be claimed. According to one understanding, such a claim should be made without undue delay as soon as the Applicant becomes aware of such a disclosure (that is at the earliest of Rule 8(1) (a) to (d) when applicant is aware of the disclosure). Further guidance on this point is therefore desirable.

6. Creation of an "intervening disclosure" problem

Other jurisdictions have addressed the challenges that arise when the grace period is tied to the inventor's own disclosure prior to filing. For example, in the United States, a similar grace period was created by the Leahy-Smith America Invents Act (AIA). The situation can be summarized by the following hypothetical:

- Inventor 1 publishes a paper describing an invention on July 1, 2016,
- Inventor 2 independently publishes a paper describing an identical invention, independently invented, on September 1, 2016, and
- Inventor 1 files a patent application for the invention on or before July 1, 2017

Under the Proposed Amendments, Inventor 1's publication would *not* be considered part of the state of the art, as it falls within the S.14(4)(e) exception. However, Inventor 2's publication *would* be considered part of the state of the art.

This outcome effectively eliminates the intended grace period for Inventor 1. Also, an independent inventor, upon seeing a publication of their invention by a third party, would have an incentive to publish a disclosure of the same invention in hopes of creating novelty-destroying prior art for the third party's later patent application.

IPOS should consider whether it wants to create some "shielding provisions" so that, in the above hypothetical, Inventor 1's publication should shield its later patent application from any intervening disclosures of the same invention and to what extent.

Any consideration of shielding provisions should also address whether they are to apply only to S.14(2) or also S.14(3).

However, based on another comment received and looking at this from a different perspective, in the US, the changes came from a switch over from the first to invent practice to the first (inventor) to file practice. Therefore, it is understandable that from the US perspective, nothing should be relevant after the first inventor's publication. However, in SG, the starting point is absolute novelty. The patentability requirements still have to be measured from the first effective filing date (filing date or priority date, if applicable). The changes only address "own" publications, but not independent third party publications which would still remain relevant and there are some who believe this is correct.

7. Section 29(10) and (11) of the Act

A comment was made that if no written opinion is issued the prosecution route can be switched at any time before the report (exam, search and exam, or supplementary exam) is issued. This is a deadline which is neither known nor can be influenced by applicant, and therefore not practical. A deadline which can be clearly monitored would be preferred.

Another comment was made that under the proposed changes, it states that the switch can be made at any time before the examination report is issued. What happens then in cases where the request to switch route and the examination report cross? Will the request to switch route be rejected? Would it be possible to amend the language of the provision to also allow for the switching of prosecution routes in the event the request to switch route and the examination report cross?

There was also a request for clarification on the effects of switching route. Where there's a request for a local search and examination made initially, in the event there's a request to switch to proceed by way of a supplementary examination, what becomes of the search report and any written opinions that may have been issued up to that point in time? Do they form part of the prosecution record? Or will it be the case that the prosecution record is expunged of search and examination procedure since it was never completed and no examination report will ever be established?

Thank you for giving our association the opportunity to comment on the planned amendments.

Best regards.

Yours sincerely,



Adam Bogsch
President
Association of Singapore Patent Attorneys