

Singapore

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Patent enforcement proceedings

1 Lawsuits and courts

What legal or administrative proceedings are available for enforcing patent rights against an infringer? Are there specialised courts in which a patent infringement lawsuit can or must be brought?

Patent infringement proceedings may be brought before the High Court of Singapore and a claim may be made:

- (i) for an injunction restraining the defendant from the act of infringement;
- (ii) for an order for him or her to deliver up or destroy any infringing product or any article in which that product is inextricably comprised or any material and implement mainly used in the creation of the infringing product;
- (iii) for damages in respect of the infringement;
- (iv) for an account of the profits derived by the defendant from the infringement; and
- (v) for a declaration that the patent is valid and has been infringed by the defendant.

The proprietor of a patent and any other person may also, by agreement with each other, refer to the Registrar of Patents the question of infringement.

If the matter is brought before the Registrar, then a claim may be made only for remedies (iii) and (v) above.

A specialist IP court has been established within the High Court with four designated IP judges, each with substantial expertise and experience in handling IP cases.

IP cases that involve broader commercial disputes may still be heard by other judges.

2 Trial format and timing

What is the format of a patent infringement trial?

Patent infringement proceedings are started by a prospective plaintiff with the filing of a writ of summons. The endorsed writ will have to be served on the named defendant in accordance with prescribed rules within its validity period.

The plaintiff will have to file its statement of claim, setting out its claim against the defendant. The defendant will then have to file its defence, and any counterclaim against the plaintiff.

Thereafter, the process for discovery and exchange of affidavit evidence will follow. When that is completed, parties and the courts may then set a trial date, where the matter will be substantively presented by the parties and examined in court.

Disputed issues are decided by a judge and a patent infringement trial typically lasts between 18 months to three years.

Evidence to be adduced in trial

In principle, all evidence (including documentary evidence) has to be adduced by way of affidavit.

Any fact required to be proven at trial by witness evidence must still be proved by the examination of witnesses in open court, unless the court orders or the parties agree otherwise.

Expert witnesses

It is often the case in patent litigation proceedings that experts are appointed by the court or called by parties to report on any question of fact or opinion where specialised skill or knowledge is required. Expert evidence is particularly relevant in assessing issues that must be read through the eyes of 'a person skilled in the art', such as disputes over novelty, inventive step and enabling disclosure.

As a general rule, the notional skilled person should be taken to be the workperson or technician who is aware of everything encompassed in the state of the art and who has the skill to make routine workshop developments, but not to exercise inventive ingenuity or think laterally. His or her level of skill will depend on the scope of the subject matter of the patent in question.

This notional person is deemed to possess the common general knowledge of the subject matter in question.

It is through the eyes of the skilled addressee that the patent will fall to be interpreted. And it is by the standards of this person that the question of inventive step is to be judged.

The addressee is deemed to be unimaginative and un inventive but is equipped nevertheless with a reasonable degree of intelligence and with a wish to make the directions in the patent work.

Role of expert witnesses

The function of an expert witness is, inter alia, to explain words or terms of science or art appearing in the documents that have to be construed by the court, to give expert assistance to the court, for example, as to the laws of science or the working of a technical process or system, or to inform the court as to the state of public knowledge with regard to the matters before it. An expert cannot assist the court in its interpretation of a document, as it is a matter for the court to read the language of the document, to analyse the facts and apply the law to the facts.

Independence of the expert witnesses

It is desirable that an expert should have no actual or apparent interest in the outcome of the proceedings. However, it is also recognised that there are fields in which only a limited number of experts are available and that those who are pre-eminent may have direct work experience in the field or with competitors who might at first sight be thought to threaten their independence. When these situations arise, such cases should be dealt with very carefully.

The mere fact that the witnesses are not independent witnesses without an interest in these proceedings because they may be related in one way or another with the patentee, does not disqualify them as witnesses.

However this does mean that their evidence has to be scrutinised with greater care because of the increased likelihood of bias.

The relevant test for determining whether the evidence of an expert should be discounted is one of actual partiality rather than apparent partiality.

Cross-examination of witnesses

Cross-examination of all witnesses, including expert witnesses, is permitted in litigation proceedings in Singapore. The withdrawal of an expert witness from cross-examination results in his or her evidence bearing no weight at all. Order 38, rule 1(2) of the Rules of Court makes it clear that a witness's affidavit will not be received in evidence if he or she is not cross-examined, except with leave of court.

3 Proof requirements

What are the burdens of proof for establishing infringement, invalidity and unenforceability of a patent?

The standard of proof in civil proceedings is 'on the balance of probabilities'.

Infringement

In infringement proceedings, the initial burden of proof is on the patent owner to prove that his or her patent has been infringed, to the requisite standard of proof.

However, the burden is reversed if the patent is a process for obtaining a new product. The burden of proving that a product is not made by the process shall be on the alleged infringer if the product is new or a substantial likelihood exists that the product is made by the process and that the patent owner has been unable, through reasonable efforts, to determine the process actually used.

In considering whether a party has discharged the burden imposed upon him or her, the court shall not require him or her to disclose any manufacturing or commercial secret if it appears to the court that it would be unreasonable to do so.

Invalidity

In invalidity proceedings, the initial burden is on the party seeking invalidation to prove that the patent is invalid to the requisite standard of proof.

For example, bare assertions made by an expert witness that the patent in suit is obvious in light of the prior art are insufficient to discharge the burden of proof to establish the obviousness. The expert must provide reasons and explanation on why and how the prior art would obviously have led a skilled person in the art to the patented invention.

For establishing invalidity of a patent on the grounds of insufficiency, the burden of proof is not discharged if the expert only highlights the ambiguities in the text of the patent specification. The expert must provide solid evidence to prove that those ambiguities will render the patented invention unworkable from the point of view of a person skilled in the art.

4 Standing to sue

Who may sue for patent infringement? Under what conditions can an accused infringer bring a lawsuit to obtain a judicial ruling or declaration on the accusation?

Civil proceedings may be brought in the court by the proprietor of a patent in respect of any alleged patent infringement. The holder of an exclusive licence under a patent shall have the same right as

the proprietor of the patent to bring proceedings in respect of any infringement of the patent committed after the date of the licence.

In a situation where there are two or more joint proprietors of a patent, one of two or more joint proprietors of a patent may without the concurrence of the others bring proceedings in respect of any alleged patent infringement.

However, in so doing, the other proprietors must be made parties to the proceedings.

An accused infringer may seek a declaration that an act does not, or a proposed act would not, constitute an infringement of a patent from the court or the Registrar, notwithstanding that no assertion to the contrary has been made by the proprietor, if it is shown that:

- that person has applied in writing to the proprietor for a written acknowledgment to the effect of the declaration claimed, and has furnished him or her with full particulars in writing of the act in question; and
- the proprietor has refused or failed to give any such acknowledgment.

5 Inducement, and contributory and multiple party infringement

To what extent can someone be liable for inducing or contributing to patent infringement? Can multiple parties be jointly liable for infringement if each practises only some of the elements of a patent claim, but together they practise all the elements?

The Singapore Patents Act does not contain any specific provision for liability for inducing or contributing to patent infringement by someone else per se. However, the Act does provide that where the invention is a patented process, a person may be sued for patent infringement if he or she offers the process for use in Singapore when he or she knows, or it is obvious to a reasonable person in the circumstances, that its use without the consent of the patent owner would be an infringement of the patent.

Indirect or secondary patent infringement is governed by the common law position on joint tortfeasorship on proof of a common design to procure or to actually participate in acts of infringement.

6 Joinder of multiple defendants

Can multiple parties be joined as defendants in the same lawsuit? If so, what are the requirements? Must all of the defendants be accused of infringing all of the same patents?

Multiple parties may be joined as defendants in the same lawsuit as joint tortfeasors.

At common law, a person may be a joint tortfeasor with another, or others, in respect of patent infringement pursuant to a common design, in two possible ways:

- by procuring the other to infringe by inducement, incitement or persuasion, or
- by actual participation in the infringing act or acts.

The joint tortfeasor must be so involved in the commission of the act of infringement so as to make him or her liable for infringement.

However, the mere act of selling or supplying an article that the vendor knows will be used for infringing purposes is not sufficient to constitute infringement as a joint tortfeasor under common law.

The mere fact that two entities are closely related, for example, by shareholding, common management or otherwise, is not sufficient for a finding that the two entities are liable for infringement as joint tortfeasors.

Some other evidence of procurement or participation in furthering the common design of infringement is necessary.

7 Infringement by foreign activities

Notwithstanding the above-mentioned laws and policies, how much discretion do the authorities have to approve or reject transactions on national interest grounds?

Activities that take place outside Singapore may cause a party to be held liable under the limb of 'offering to dispose of' an infringing product if it is understood that the offer is being made to the public of Singapore.

Otherwise, infringing activities outside Singapore will not support an allegation of infringement in Singapore.

8 Infringement by equivalents

To what extent can 'equivalents' of the claimed subject matter be shown to infringe?

The 'purposive construction' approach is adopted by the Singapore courts where a patent should be construed in order to determine what the person skilled in the art would have understood the patentee to mean by using the language of the claims.

The 'doctrine of equivalents' is not applicable in Singapore.

9 Discovery of evidence

What mechanisms are available for obtaining evidence from an opponent, from third parties or from outside the country for proving infringement, damages or invalidity?

The court may, at any time, order any party to a cause or matter to give discovery by making and serving on any other party a list of the documents that are or have been in his or her possession, custody or power, unless the court is satisfied that discovery is not necessary, or not necessary at that stage of the cause or matter.

The documents that a party to a cause or matter may be ordered to discover are:

- the documents on which the party relies or will rely; and
- the documents that could adversely affect his or her own case, adversely affect the other party's case or support the other party's case.

Discovery is done by making and serving on any other party a list of the documents that are or have been in a party's possession, custody or power. The other party will then be allowed to inspect and make copies of the said documents.

Pre-action discovery is also available but permitted only in very limited circumstances, namely, only when the potential plaintiff does not have sufficient facts to commence proceedings.

The person applying for discovery will do so by originating summons supported by an affidavit, which must fulfil certain requirements. The High Court may then make an order on its terms for the discovery of documents before the commencement of proceedings or by a person who is not a party to the proceedings. The documents available for discovery are limited to certain criteria.

Other methods of obtaining evidence from an adverse party or from third parties include pre-action interrogatories.

10 Litigation timetable

What is the typical timetable for a patent infringement lawsuit in the trial and appellate courts?

Patent infringement proceedings typically last between 18 months to three years.

11 Litigation costs

What is the typical range of costs of a patent infringement lawsuit before trial, during trial and for an appeal?

The costs of a patent infringement lawsuit are generally significant and will depend on many factors such as the kinds of parties involved, the complexity and merits of the case, the type of evidence required, the cost of expert witnesses required and the length of the trial.

A typical range of costs is approximately as follows:

- costs up to stage before trial: S\$80,000 to S\$150,000;
- during trial: about S\$30,000 to S\$40,000 per day of trial; and
- appeal to the Court of Appeal: S\$40,000 to S\$100,000.

12 Court appeals

What avenues of appeal are available following an adverse decision in a patent infringement lawsuit?

Type of proceedings	Avenue of appeal
Before the Registrar of Patents, Intellectual Property Office of Singapore (IPOS)	Judge of the High Court
Before a Registrar of the High Court	Judge of the High Court in chambers
Begun in, or appealed, to the High Court	Court of Appeal

An appeal against an order, determination, award or other decision of the Registrar of Patents must be made by filing an originating summons, which must state the grounds of appeal and what is appealed. The originating summons must also be served on the Chairman of the IPOS and every party to the proceedings within 28 days after the date the order, determination, award or other decision appealed against was issued to the appellant.

An appeal against a judgment, order or decision of the High Court must be made by filing a notice of appeal in the prescribed form within 14 days after the judgment, order or decision appealed against was given or made, or for appeals to the Court of Appeal, within one month from the date on which the order in chambers appealed against was pronounced or the appellant first had notice of it, the refusal of an application appealed against was made or the judgment or order (not in chambers) appealed against was pronounced. In certain cases, the notice of appeal must be accompanied with security for the respondent's costs of appeal.

Appeals for some matters may be brought to the Court of Appeal only with leave, while certain matters are not appealable to the Court of Appeal. Any judgment or order of a district court exercising civil jurisdiction to which the parties have already consented in writing may not be appealed against.

13 Competition considerations

To what extent can enforcement of a patent expose the patent owner to liability for a competition violation, unfair competition, or a business-related tort?

A patent owner may be liable for any anti-competitive behaviour under the Competition Act, which prohibits:

- agreements between undertakings, decisions by associations of undertakings or concerted practices that have as their object or effect the prevention, restriction or distortion of competition within Singapore; and
- any conduct on the part of one or more undertakings that is an abuse of a dominant position in any market in Singapore.

The Singapore Patents Act contains certain prohibitions against 'tie-in' and 'tie-up' clauses in contracts entered into or granted before 1 December 2008 (ie, before the full enactment of the Competition Act).

'Tie-in' clauses are used by the patent owners in contracts to unreasonably require a person looking to work the patented invention or seeking a supply of the patented product, to acquire anything other than the patented product from him or her. In such contracts or agreements, the patent owner is extending its monopoly beyond the market of its patent.

Under the Singapore Patents Act, the relevant 'tie-in' clause or clauses would be void and the existence of a contract made by or with the consent of the patent owner containing such a clause or clauses would also constitute a defence for any person when sued for infringement by the patent owner.

'Tie-up' clauses prohibit the termination of the contract even after the expiration of the patent rights. In such contracts, the patent owner is extending the monopoly in excess of the term of his or her patent.

Under the Singapore Patents Act, any contract for the supply of a patented product or licence to work a patented invention may be terminated, to the extent the contract or licence relates to the product or invention, at any time by either party giving the other party three months' written notice, notwithstanding that the contract prohibits such a termination. Further, the court may vary the terms and conditions of the contract if it is satisfied that it would be unjust to require a party to continue to comply with all the terms and conditions of the contract or licence after the patent ceases to be in force.

Further, the courts may grant a compulsory licence for a patent on the grounds that the grant of the licence is necessary to remedy an anti-competitive practice. The courts would grant such a licence if the market for the patent is not being supplied or is not being supplied on reasonable terms and the patent holder has no valid reason for failing to supply this market, whether directly or through a licensee, on reasonable terms.

14 Alternative dispute resolution

To what extent are alternative dispute resolution techniques available to resolve patent disputes?

Alternative dispute resolution (ADR) techniques are generally voluntary or by consent or contract. They are strongly promoted and encouraged by the government in Singapore. In recent years, ADR techniques have significantly increased in importance as a means of dispute resolution in a wide range of disputes.

However, ADR techniques are currently not commonly used in patent-related matters. One reason may be that the injunctive reliefs, which are very important in patent-related matters, are more appropriately ordered by the court instead of being awarded by an arbitrator.

At present, Singapore is building its IP ADR capabilities. In 2011, the IPOS signed a Memorandum of Understanding with the World Intellectual Property Organisation (WIPO), which allows parties to resolve IP disputes that involve ownership and validity of IP rights registered in Singapore via mediation at the WIPO's Arbitration and Mediation Centre in Singapore. This mediation centre was set up in 2010 as the first office outside Geneva.

IPOS is also looking to set up a team of IP expert adjudicators to resolve IP disputes filed with IPOS.

Scope and ownership of patents

15 Types of protectable inventions

Can a patent be obtained to cover any type of invention, including software, business methods and medical procedures?

The Singapore Patents Act provides that a patent can only be granted (thus protected in Singapore) if the 'invention' constitutes a 'patentable subject matter' that is new, involves an inventive step and is capable of industrial application.

The Singapore Patents Law was amended in 1995 to repeal a list of excluded matters that included a 'scheme, rule or method for performing a mental act, playing a game or doing business, or a program for a computer'. With the repeal, such excluded matters (ie, software and business methods) are impliedly patentable subject matter under Singapore law.

A business method patent has been the subject of litigation in Singapore courts and the question of whether business methods are considered patentable subject matter was not raised in that case. Implicitly therefore, it appears that business method patents are patentable in Singapore.

Methods of treatment of the human or animal body by surgery or therapy or of diagnosis practised on the human or animal body are not permitted in Singapore because they are deemed to lack industrial applicability.

However, presenting patent claims pertaining to methods of medical treatment as first or second, or both, medical use claims are permitted under Singapore law.

16 Patent ownership

Who owns the patent on an invention made by a company employee, an independent contractor, multiple inventors or a joint venture? How is patent ownership officially recorded and transferred?

Employee's invention

An invention made by an employee shall be taken to belong to his or her employer if:

- the invention was made in the course of the normal or assigned duties of the employee and the circumstances were such that an invention might reasonably be expected to result from the carrying out of his or her duties; or
- the invention was made in the course of the duties of the employee and, at the time of making the invention, the employee had a special obligation to further the interests of the employer's undertaking.

Any other invention made by an employee shall be taken for those purposes to belong to the employee.

Others: independent contractor, multiple inventors or joint venture

The patent for an invention is primarily owned by the inventors or joint inventors.

These rights are assignable to other parties. Appropriate provisions ought to be made in the contracts governing these relationships and transactions.

Assignment or transfer of rights to a patent or patent application may be formally recorded on the register of patents by the filing of the prescribed forms.

Defences

17 Patent invalidity

How and on what grounds can the validity of a patent be challenged? Is there a special court or administrative tribunal in which to do this?

A patent may be revoked on the following grounds:

- the invention is not a patentable invention (ie, it is not novel, not inventive, not industrially applicable or would encourage offensive, immoral or anti-social behaviour);
- the patent was granted to a person not entitled to be granted that patent;
- the specification of the patent does not disclose the invention clearly and completely for it to be performed by a person skilled in the art;

- the matter disclosed in the specification extends beyond that disclosed in the application as filed (ie, it discloses ‘additional matter’);
- an amendment or correction has been made to the specification of the patent or patent application, which should not have been allowed;
- the patent was obtained fraudulently, on any misrepresentation, or on any non-disclosure or inaccurate disclosure of any material information concerning corresponding applications; and
- the patent is one of two or more patents for the same invention having the same priority date and filed by the same party or his or her successor in title (ie, there has been ‘double patenting’).

The list above is an exhaustive list. The court has constantly rejected attempts to invalidate or revoke patents on grounds outside the list above, such as a ‘lack of clarity and conciseness’ in the patent claims.

18 Absolute novelty requirement

Is there an ‘absolute novelty’ requirement for patentability, and if so, are there any exceptions?

Singapore has an ‘absolute novelty’ requirement for patentability.

The exceptions are:

- disclosures made in breach of confidence;
- disclosures by the inventor at ‘international exhibitions’, (with written evidence in support thereof duly filed in compliance with prescribed conditions); and
- disclosures by or with the consent of the inventor before a ‘learned society’ (‘learned society’ being defined to include a club or association whose main object is the promotion of any branch of learning or science).

The above exclusions operate only in the event that the disclosures are made within the preceding 12 months prior to the filing date of the patent application.

There is also a special exception for ‘first medical use’ of a known substance. The fact that a substance is known does not destroy the novelty of the use of this substance in a method of medical treatment if the use of the substance in such a method does not form part of the state of the art.

The exception does not extend to second or subsequent medical use of a known substance.

19 Obviousness or inventiveness test

What is the legal standard for determining whether a patent is ‘obvious’ or ‘inventive’ in view of the prior art?

The four-step test for inventiveness set out in the English Court of Appeal decision of *Windsurfing International Inc v Tabur Marine (Great Britain) Ltd* [1985] RPC 59 (the *Windsurfing* test) was applied in *Trek Technology* [2005] 3 SLR(R) 389 and may be formulated as follows:

- identify the inventive concept embodied in the patent in suit;
- the court then assumes the mantle of the normally skilled but unimaginative addressee in the art at the priority date, imputing to him or her what was, at that date, common general knowledge in the art in question;
- identify what, if any, differences exist between the matter cited as being ‘known or used’ and the alleged invention; and
- the court then asks itself the question whether, viewed without any knowledge of the alleged invention, those differences constitute steps that would have been obvious to the skilled man or woman or whether they require any degree of invention.

The notional skilled person with the common general knowledge of the art is deemed to be unimaginative and uninventive but is equipped nevertheless with a reasonable degree of intelligence and with a wish to make the directions in the patent work.

A set of Draft Examination Guidelines for Patent Applications has recently been released by the Intellectual Property Office of Singapore (IPOS).

These Draft Guidelines also reference the modified *Windsurfing* test, also known as the *Pozzoli* approach and expressly provides that examiners may use the *Pozzoli* approach when formulating an inventive step objection, even though this approach has not been formally adopted by the Singapore courts.

The *Pozzoli* approach is summarised as follows:

- identify the notional ‘person skilled in art’ and identify the relevant common general knowledge of that person;
- identify the inventive concept of the claim in question or if that cannot be readily done, construe it;
- identify what, if any, differences exist between the matter cited as forming part of the ‘state of the art’ and the inventive concept of the claim or the claim as construed; and
- viewed without any knowledge of the alleged invention as claimed, do those differences constitute steps that would have been obvious to the person skilled in the art or do they require any degree of invention?

20 Patent unenforceability

Are there any grounds on which an otherwise valid patent can be deemed unenforceable owing to misconduct by the inventors or the patent owner, or for some other reason?

Singapore does not consider patents unenforceable where there is misconduct by the inventors or the patent owner. However, when a Singapore patent is found to have been obtained fraudulently, on any misrepresentation or on any non-disclosure or inaccurate disclosure of any prescribed material information, the said patent will be revoked.

A patent, however, may be unenforceable under the following conditions, where:

- a person enters with the patent owner into a contract that has a ‘tie-in’ clause (see question 13);
- the acts are carried out privately and for non-commercial purposes;
- the acts are carried out for experimental purposes;
- the acts consist of the extemporaneous preparation of a medicine for an individual in accordance with a prescription given by a registered medical or dental practitioner or consists of dealing with a medicine so prepared;
- the acts consist of the use of a patented product or process in the body or operation of or the use of accessories for a relevant aircraft, hovercraft or vehicle that has temporarily or accidentally entered or is crossing Singapore (including the air space above it and its territorial waters);
- the acts consist of the use, exclusively for the needs of a relevant ship, of a patented product or process in the body of the ship or in its machinery, tackle, apparatus or other accessories, in a case where the ship has temporarily or accidentally entered the territorial waters of Singapore;
- the acts consist of the use of an exempted aircraft that has lawfully entered or is lawfully crossing Singapore or of the importation into Singapore, or the use or storage, of any part or accessory for that aircraft;
- parallel importation;
- the acts are carried out in support of an application for marketing approval for pharmaceutical products;
- prior use before the priority date of the patent;
- grant of a compulsory licence by the High Court to remedy an anti-competitive practice; and

- use by the Singapore government for public non-commercial purposes, or for, or during, a national emergency or other circumstances of extreme urgency.

21 Prior user defence

Is it a defence if an accused infringer has been privately using the accused method or device prior to the filing date or publication date of the patent? If so, does the defence cover all types of inventions? Is the defence limited to commercial uses?

A person, who in Singapore before the priority date of the invention and in good faith carries out an act or makes effective and serious preparations to carry out such an act, which would constitute an infringement of the patent if it were in force, can do or continue to do that act notwithstanding the grant of the patent.

This defence does not, however, extend to granting a licence to another person to do the act.

This covers all types of inventions and is not limited to commercial uses.

Remedies

22 Monetary remedies for infringement

What monetary remedies are available against a patent infringer? When do damages start to accrue? Do damage awards tend to be nominal, provide fair compensation or be punitive in nature?

The monetary remedies available against a patent infringer are damages and an account of profits.

However, in respect of the same infringement, only one monetary remedy, meaning either damages or an account of profits, can be awarded to the patent owner.

Punitive damages are not available in patent infringement disputes.

The quantum of monetary remedies is generally assessed by the court at a separate, later stage after the completion of the liability assessment.

23 Injunctions against infringement

To what extent is it possible to obtain a temporary injunction or a final injunction against future infringement? Is an injunction effective against the infringer's suppliers or customers?

Usually, the grant of an injunction relates to the item or items alleged to infringe the patent. However, the courts have the discretion to determine the extent of the relief granted. It may be possible in some circumstances, where the exclusion of certain items not specifically covered in the injunction requested by the patent owner would render the injunction ineffective against future infringement by the infringer of the patent, that the court may grant an injunction that is broader in scope so as to cover these certain other items.

It will be a contempt of court for any third party (including the infringer's suppliers or customers) who has been notified of an injunction to knowingly aid, abet, assist in or permit a breach of an injunction order. To act in contempt of court will render the third party liable to a fine or imprisonment at the discretion of the court).

24 Banning importation of infringing products

To what extent is it possible to block the importation of infringing products into the country? Is there a specific tribunal or proceeding available to accomplish this?

At present, statutory border enforcement measures for IP rights are only provided for in the Copyright Act and the Trade Marks Act. There are no specific provisions for patents.

However, it is possible to obtain an injunction on the infringing product when it has entered Singapore.

25 Attorneys' fees

Under what conditions can a successful litigant recover costs and attorneys' fees?

The award of attorney's fees is at the discretion of the courts. Generally, part of the attorney's fees may be recovered from the losing party unless there are special circumstances, such as serious improper conduct on the part of the successful litigant during the course of the litigation.

26 Wilful infringement

Are additional remedies available against a deliberate or wilful infringer? If so, what is the test or standard to determine whether the infringement is deliberate?

There are no additional or specific remedies against a deliberate or wilful infringer in Singapore.

27 Time limits for lawsuits

What is the time limit for seeking a remedy for patent infringement?

The Limitation Act in Singapore provides that an action in contract or to recover any sum recoverable by virtue of any written law (ie, in contravention of the Patents Act) must not be brought after the expiry of six years from the date on which the cause of action accrued.

28 Patent marking

Must a patent holder mark its patented products? If so, how must the marking be made? What are the consequences of failure to mark? What are the consequences of false patent marking?

It is not compulsory for a patent holder to mark its patented products. However, it is recommended to do so to inform the general public of the patent so that an infringer cannot rely on a plea of innocent infringement under the Singapore Patents Act: where the infringer at the date of the infringement, is not aware and had no reasonable grounds to suppose that the patent existed.

Under the plea of innocent infringement, damages will not be awarded and no order will be made for an account of profits against an infringer who proves that at the date of the infringement he or she was not aware and had no reasonable grounds for supposing, that the patent existed.

Accordingly, a product should be marked with the patent number.

It is an offence to falsely mark a product as a patented product and also to mark a product to represent that a patent has been applied for when no patent application has been made or any such application has been refused, withdrawn or treated as having been abandoned.

Licensing

29 Voluntary licensing

Are there any restrictions on the contractual terms by which a patent owner may license a patent?

'Tie-in' in a contract will be void and the existence of a contract made by or with the consent of the patent owner containing such a clause would also constitute a defence for any person when sued for infringement by the patent owner.

'Tie-up' clauses prohibit the termination of the contract even after the expiration of the patent rights. In such contracts, the patent

owner is extending the monopoly in excess of the term of his or her patent.

Under the Singapore Patents Act, any contract for the supply of a patented product or licence to work a patented invention may be terminated, to the extent the contract or licence relates to the product or invention, at any time by either party giving the other party three months' written notice, notwithstanding that the contract prohibits such a termination. Further, the court may vary the terms and conditions of the contract if it is satisfied that it would be unjust to require a party to continue to comply with all the terms and conditions of the contract or licence after the patent ceases to be in force.

30 Compulsory licences

Are any mechanisms available to obtain a compulsory licence to a patent? How are the terms of such a licence determined?

Any interested person may apply to the court for the grant of a licence under a patent on the ground that the grant of the licence is necessary to remedy an anti-competitive practice.

The courts would grant such a licence if the market for the patent is not being supplied or is not being supplied on reasonable terms and the patent holder has no valid reason for failing to supply this market, whether directly or through a licensee, on reasonable terms.

Patent office proceedings

31 Patenting timetable and costs

How long does it typically take, and how much does it typically cost, to obtain a patent?

It usually takes from two to five years to obtain a Singapore patent.

The typical cost to file and register a patent would be approximately from S\$5,000 to S\$7,000 (excluding drafting costs).

32 Expedited patent prosecution

Are there any procedures to expedite patent prosecution?

The following Patent Prosecution Highway (PPH) programmes are available in Singapore to expedite patent prosecution:

- PPH (IPOS-USPTO) extended (with the United States Patent and Trademark Office);
- PPH (IPOS-JPO) extended (with the Japan Patent Office);
- PPH (IPOS-KIPO) (with the Korean Intellectual Property Office); and
- PPH (IPOS-SIPO) (with the State Intellectual Property Office of the People's Republic of China).

There are no extra official fees for expediting patent prosecution process under the PPH.

Additionally, the IP offices of nine ASEAN countries including Singapore have established a work-sharing programme under the ASEAN Patent Examination Co-operation (ASPEC).

The purpose of this programme is to share search and examination results between the participating offices to allow applicants in participating countries to obtain corresponding patents faster and more efficiently.

There are no extra official fees for expediting patent prosecution process under ASPEC.

33 Patent application contents

What must be disclosed or described about the invention in a patent application? Are there any particular guidelines that should be followed or pitfalls to avoid in deciding what to include in the application?

The specification of an application shall disclose the invention in a manner that is clear and complete for the invention to be performed by a person skilled in the art.

Rules 19 to 23 of the Singapore Patents Rules provide guidelines as to what the specification for a patent application should have.

34 Prior art disclosure obligations

Must an inventor disclose prior art to the patent office examiner?

There is no requirement to disclose prior art to the patent office examiner.

However, the patent specification should indicate the background art as far it is known to the applicant.

35 Pursuit of additional claims

May a patent applicant file one or more later applications to pursue additional claims to an invention disclosed in its earlier filed application? If so, what are the applicable requirements or limitations?

It is possible to file divisional applications to pursue additional claims to an invention disclosed in an earlier filed application, subject to the claims not adding any new matter that go beyond the subject matter of the earlier application as filed.

Divisional applications may be filed before the grant fee is paid or before the application is refused, withdrawn, treated as or taken to be withdrawn, or treated as abandoned or as having been abandoned.

36 Patent office appeals

Is it possible to appeal an adverse decision by the patent office in a court of law?

A decision of the Registrar made under the Singapore Patents Act or Patent Rules may be referred to the court, unless it is a decision:

- made under section 25(7) of the Patents Act regarding the adequacy of an abstract filed with a patent application;
- made under section 27(3) of the Patents Act to omit any matter from a specification;
- to give directions under sections 33(1) and (2) in relation to the restriction or prohibition of the publication of information prejudicial to the defence of Singapore or to public safety; and
- made under the Patent Rules, which makes it excepted from a right of appeal.

However, a decision of the court that was made on appeal from a decision of the Registrar cannot be referred to a Court of Appeal, except if the decision of the Registrar was made under certain prescribed sections of the Patents Act or where the ground of appeal is that the decision of the court is wrong in law and only if leave of appeal is given by the court or the Court of Appeal.

37 Oppositions or protests to patents

Does the patent office provide any mechanism for opposing the grant of a patent?

There is no mechanism for opposing the grant of a patent.

38 Priority of invention

Does the patent office provide any mechanism for resolving priority disputes between different applicants for the same invention? What factors determine who has priority?

The Singapore Patent Office applies the 'first to file' principle and does not provide for any mechanism to resolve priority disputes between different applicants for the same invention. Therefore, the party who first filed the application (or who has the earliest convention priority date) is the party entitled to the patent.

Update and trends

Singapore's patent regime has recently undergone changes in which prosecution and grant processes have been affected. These changes came into effect on 14 February 2014 and generally affect:

- divisional, convention and domestic applications filed on or after 14 February 2014; and
- national phase applications entering Singapore on or after 14 February 2014 (New Patent Applications).

The key changes to the Singapore's patent regime include the following.

All New Patent Applications will have to undergo local substantive examination process. Previously, Singapore patent applications did not need to undergo a local substantive examination process in order to obtain a patent grant. However, under the new regime, all New Patent

Applications will have to undergo a local substantive examination process before a grant for a patent can be requested; the previous prosecution options have been modified accordingly. The deadlines for these modified prosecution options have also changed, whereby, most notably, the dual-track system under the old regime was removed.

The self-assessment system has changed to a positive grant system. Under the self-assessment patent system (which is the old regime), patent applications did not need to fully satisfy the patentability criteria under Singapore law in order to obtain a patent grant. With the recent change to a positive grant system, all New Patent Applications must now receive positive reports from the examiner (ie, containing no unresolved objections), together with a Notice of Eligibility to Proceed to Grant, before a grant can be requested.

39 Modification and re-examination of patents

Does the patent office provide procedures for modifying, re-examining or revoking a patent? May a court amend the patent claims during a lawsuit?

It is possible to amend the specification of a patent after it has been granted, subject to the Registrar's approval. However, no post-grant amendment will be allowed if the amendment results in the specification disclosing any additional matter or extends the protection conferred by the patent.

Procedures for filing an application for a post-grant amendment are set out in Rule 52 of the Singapore Patents Rules.

Pursuant to the change in the law effective from 14 February 2014, there is no longer any avenue for post-grant examination of a Singapore patent.

Procedures for revoking a patent are set out in Rule 80 of the Singapore Patents Rules.

During a proceeding, the court or Registrar may direct or allow the proprietor of the patent to amend the specification. However, such amendments will not be allowed if the amendment results in the specification disclosing any additional matter or extends the protection conferred by the patent.

40 Patent duration

How is the duration of patent protection determined?

A patent, once granted, will continue in force for a period of 20 years commencing on the date of filing the patent application.



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