

Singapore's Inputs in response to Circular C. 9260

Part 1 (Deadline: 31 March 2025)

Pursuant to the decision of the thirty-sixth session of the Standing Committee on the Law of Patents (SCP), Singapore would like to provide the following inputs to the International Bureau of the World Intellectual Property Organisation (WIPO) for the preparation of the documents and a new webpage:

(i) Exception regarding farmers' and/or breeders' use of patented inventions

The Patents Act 1994 ("SPA") does not provide exceptions regarding farmers' and/or breeders' use of patented inventions.

For information only, there are exceptions regarding farmers' and/or breeders' use of plant varieties in the Plant Varieties Protection Act 2004 ("SPVPA"). Sections 31(1)(c) and 31(2) of the SPVPA provide that: -

Exceptions to infringement of grant of protection

31.—(1) It is not an infringement of a grant of protection in respect of a protected variety for any person to do —

...

(c) any act for the purposes of breeding any other plant variety and, except in the case of an essentially derived or other plant variety to which the grant of protection is extended by virtue of section 29(1), any act that requires the grantee's authorisation under section 28(1) in respect of such other variety.

(2) It is not an infringement of a grant of protection for any person engaging in farming activities to use, for propagating purposes and for the purpose of safeguarding agricultural or horticultural production, on the person's own holdings, harvested material from the protected variety where —

(a) the genera or species within which the protected variety is classified has been prescribed for the purposes of this section as exempt from the rights of a grantee; and

(b) the harvested material —

- (i) has been obtained by purchase or otherwise with the authority of the grantee concerned; or
- (ii) having been obtained in accordance with sub-paragraph (i), has subsequently been propagated or grown on those holdings.

Section 31 and the provisions referred to therein are provided in Annex I.

(ii) Study on Substantive and Procedural Requirements Regarding Voluntary Division of Patent Applications by Applicants

Singapore allows an applicant to file a new application i.e., divisional application, in respect of any part of the matter contained in an earlier application, i.e., parent application. A divisional application may be filed in accordance with section 26(11) of the SPA of the applicant's own

volition or to address a lack of unity objection under section 25(5)(d) of the SPA (see rule 27(1) of the Patents Rules (“SPR”)).

Pursuant to section 26(11) of the SPA, a divisional application can be filed at any time while a parent application is pending, i.e., after the parent application has been filed and:

- (i) before the parent application satisfies the condition under section 30(c), or
- (ii) before the parent application is refused, withdrawn, treated as or taken to be withdrawn or treated as abandoned or as having been abandoned.

A divisional application will be treated as having, as its date of filing, the date of filing of the parent application. Hence, the divisional application's patent term is the same as the parent application's patent term. The divisional application would generally inherit priority claims by a declaration of priority under section 17(2) of the SPA.

A (first) divisional application may serve as the parent application for a further (second) divisional application. However, the first divisional application must be pending at the time that the second divisional application is filed. The parent application of the first divisional application need not be pending for the second divisional application to be derived from the first divisional application.

As prescribed by section 25(3) of the SPA and rule 19A(1) of the SPR, the following documents must be submitted when filing a divisional application:

- (i) a request for the grant of a patent;
- (ii) a specification containing a description of the invention, a claim or claims, and any drawing referred to in the description or any claim;
- (iii) an abstract; and
- (iv) a sequence listing, if applicable.

A statement of inventorship should also be submitted when filing a divisional application, if the divisional application was filed later than 16 months from (see rule 28(f) of the SPR):

- (i) the date of filing of the parent application, where there is no declared priority date;
- (ii) the declared priority date of the parent application, where there is one.

Rules 27(2) and (3) of the SPR provide further guidance on divisional applications under section 26(11) of the SPA. Where possible, the description and drawings of the earlier application and the new application shall respectively relate only to the matter for which protection is sought by that application. Where it is necessary for an application to describe the matter for which protection is sought by another application, it shall include a reference by number to that other application.

A divisional application must not disclose any additional matter extending beyond that disclosed in the parent application (i.e., no new matter), pursuant to section 84(1) of the SPA.

In addition, the claims in a divisional application must define a different invention from the claims in the parent application, even if they are based on the same disclosure. This is to prevent “double patenting” of the same invention. “Double patenting” is a ground for objection in relation to patent applications (rule 46(1)(f) of the SPR, read with section 29(7) of

the SPA) and a ground for revocation in relation to granted patents (section 80(1)(g) of the SPA).

Double patenting will apply if the patent applications or granted patents (as applicable) are for the same invention, i.e. claims are identical in scope. In most cases, this will occur if the claims are coterminous or if the claims use different terminology but are otherwise identical in substance.

Double patenting may also apply where two claims differ in that one contains a specific feature while the other defines a more generic group for the corresponding feature without any indication in the specification of practising across the generic group. For example, claim 1 in application “A” and claim 1 of application “B” define identical features, except that claim 1 in application “A” further defines a specific feature and claim 1 in application “B” further defines a more generic group of the specific feature. An objection of double patenting may arise between applications “A” and “B” in such situations if the specific feature is the only one disclosed in the specification of application “B” and there is no basis for reading the specification as constituting a more generic group. However, if application “B” discloses that there is more than one means of performing a particular step or the specific feature as selected from a generic group, then no objection should be taken.

When dealing with co-pending patent applications for the same invention, an Examiner will flag any potential double patenting issues to the applicant while continuing with the examination of both applications. It will be up to the applicant how they wish to proceed with the applications in order to avoid double patenting. It is possible for the applicant to respond to the Examiner’s double patenting objection in the application in suit by stating his preference to address the double patenting issue in the co-pending application(s) that has not yet been granted. If such a statement is present, the Examiner may allow the application in suit to proceed to grant, and the double patenting issue may then be dealt with in the examination of the co-pending application(s).

More details are provided in para. 6.91 – 6.118, 9.41 – 9.43 of the Examination Guidelines for Patent Applications at IPOS (Oct 2023 version). A copy of the guidelines is available at https://www.ipos.gov.sg/docs/default-source/resources-library/patents/guidelines-and-useful-information/examination-guidelines-for-patent-applications.pdf?sfvrsn=47d67c59_15.

The relevant provisions of the SPA and the SPR are provided in Annex II.

(iii) Document updating Sections V and VI of Annex to document SCP/35/7 (Artificial Intelligence (AI) and Inventorship).

There are no new developments in Singapore.

(iv) Compilation of legislative and policy measures adopted by Member States relating to Standard Essential Patents to be presented on a dedicated page of the SCP website.

The Intellectual Property Office of Singapore (“IPOS”) and the Competition and Consumer Commission of Singapore (“CCCS”) conducted a review and in 2022, provided an update of the CCCS’ Guidelines on the Treatment of IP Rights. The review focused largely on the interplay between the competition regime and the different intellectual property rights, including SEPs, licensing and franchising agreements. The revised guidelines, which provides more clarity to

definitions on IP rights and guidance to issues relating to SEP and FRAND within the framework of Singapore's Competition Act 2004, is available at <https://www.cccs.gov.sg/-/media/custom/ccs/files/legislation/ccs-guidelines/revised-guidelines-jan-2022/9-cccs-guidelines-on-the-treatment-of-ip.pdf>.

Part II (Deadline: 30 April 2025)

In order to maintain the information collected through the activities of the SCP up to date, Singapore would also like to provide updates on topics (iii) and (v).

(iii) International worksharing and collaborative activities for search and examination of patent applications

Under "Collaborative Search and Examination"

(available at <https://www.wipo.int/patents/en/topics/worksharing/collaboration.html>)

Intellectual Property of Singapore (IPOS) Collaborative Search and Examination Pilot Programme with IP Viet Nam (IPVN) and Directorate General of Intellectual Property of Indonesia (DGIP).

The pilot programme provides innovators with comprehensive prior art search and examination results based on the combined expertise of IPOS with either IPVN or DGIP. It is designed to speed up the patent search and examination process for innovators interested to obtain patent protection in these countries. Applicants can expect to receive the CS&E report within 10 months from the request date, at no additional official fee.

Under "Acceptance of Equivalent Search and Examination Carried Out by Other Offices"

(available at <https://www.wipo.int/en/web/patents/topics/worksharing/acceptance-equivalents>)

Singapore with Cambodia and Lao PDR: Under the respective bilateral cooperation agreements, applicants are able to re-register their granted Singapore patents, or submit an IPOS-issued search and examination report to the Ministry of Industry, Science, Technology & Innovation (MISTI) of Cambodia and the Department of Intellectual Property (DIP) of Lao People's Democratic Republic (Lao PDR).

(v) Expedited examination programs

(available at <https://www.wipo.int/scp/en/expedited-examination-programs.html>)

The SG IP FAST pilot programme concluded on 31 December 2024. Following its conclusion, IPOS is reviewing our suite of programmes to better meet the evolving needs of innovators and enterprises in Singapore's dynamic IP landscape.

Annex I – Section 31 and relevant provisions of SPVPA

Exceptions to infringement of grant of protection

31.—(1) It is not an infringement of a grant of protection in respect of a protected variety for any person to do —

- (a) any act privately and for a non-commercial purpose;
- (b) any act for any experimental or research purpose; or
- (c) any act for the purposes of breeding any other plant variety and, except in the case of an essentially derived or other plant variety to which the grant of protection is extended by virtue of section 29(1), any act that requires the grantee's authorisation under section 28(1) in respect of such other variety.

(2) It is not an infringement of a grant of protection for any person engaging in farming activities to use, for propagating purposes and for the purpose of safeguarding agricultural or horticultural production, on the person's own holdings, harvested material from the protected variety where —

- (a) the genera or species within which the protected variety is classified has been prescribed for the purposes of this section as exempt from the rights of a grantee; and
- (b) the harvested material —
 - (i) has been obtained by purchase or otherwise with the authority of the grantee concerned; or
 - (ii) having been obtained in accordance with sub-paragraph (i), has subsequently been propagated or grown on those holdings.

Scope and nature of grant of protection

28.—(1) Subject to sections 31 and 32, a grantee in respect of any protected variety is entitled to prevent a person from doing any of the following acts in respect of the propagating material of the protected variety without the authorisation, by way of a licence or otherwise, of the grantee:

- (a) production or reproduction;
- (b) conditioning for the purpose of propagation;
- (c) offering for sale;
- (d) selling or other forms of marketing;
- (e) export;
- (f) import;
- (g) stocking for any of the purposes specified in paragraphs (a) to (f).

(2) The grantee may give an authorisation subject to conditions and limitations.

(3) A grant of protection is personal property and may be assigned or transmitted in the same way as other personal property.

(4) An assignment of a grant of protection under subsection (3) is not effective unless it is in writing and signed by or on behalf of the assignor.

(5) Subject to subsection (6), a licence granted by a grantee in respect of any protected variety is binding on every successor in title to the grantee's interest —

(a) except any person who, in good faith and without any notice (actual or constructive) of the licence, has given valuable consideration for the interest in the grant of protection; or

(b) unless the licence provides otherwise, and any reference in this Act to doing anything with, or without, the consent of the grantee is to be construed accordingly.

(6) Every person is deemed to have notice of a licence if the prescribed particulars of the grant of the licence are entered in the register under section 42.

(7) Subject to sections 31 and 32, the rights of a grantee under subsection (1) also apply to harvested material, including entire plants and parts of plants, obtained through the unauthorised use of propagating material of the protected variety unless the grantee has had a reasonable opportunity, before the harvested material was obtained, to exercise the grantee's rights in relation to the unauthorised use of the propagating material.

Essentially derived and certain other plant varieties

29.—(1) Where a grant of protection is made under section 21, that grant of protection also extends to —

(a) any plant variety which is essentially derived from the plant variety in respect of which the grant of protection was made (called in this section the original plant variety);

(b) any plant variety which is not distinct in accordance with section 22(1)(b) from the original plant variety; and

(c) any plant variety the production of which requires the repeated use of the original plant variety.

(2) For the purposes of this section, a plant variety is to be treated as being essentially derived from the original plant variety if —

(a) it is predominantly derived from the original plant variety or from a plant variety that is itself predominantly derived from the original plant variety;

(b) it retains the expression of the essential characteristics that result from the genotype or a combination of genotypes of the original plant variety;

(c) it is clearly distinguishable from the original plant variety; and

(d) except for the differences which result from the act of derivation, it conforms to the original plant variety in the expression of the essential characteristics that result from the genotype or a combination of genotypes of the original plant variety.

Annex II – Sections 17, 24, 26, 29(7) and 80 of the Patents Act 1994 (“SPA”), rules 18, 27, 28(f) and 46 of the Patents Rules (“SPR”)

SPA

Priority date

17.— (1) For the purposes of this Act, the priority date of an invention to which an application for a patent relates and also of any matter (whether or not the same as the invention) contained in the application is, except as provided by the provisions of this Act, the date of filing the application.

(2) Where in or in connection with an application for a patent (called in this section the application in suit) a declaration is made, whether by the applicant or any predecessor in title of the applicant, complying with the relevant requirements of the rules and specifying one or more earlier relevant applications for the purposes of this section made by the applicant or a predecessor in title of the applicant, and the application in suit has a date of filing, within the period mentioned in subsection (3)(a) or (b), then —

- (a) if an invention to which the application in suit relates is supported by matter disclosed in the earlier relevant application or applications, the priority date of that invention, instead of being the date of filing the application in suit, is the date of filing the relevant application in which that matter was disclosed or, if it was disclosed in more than one relevant application, the earliest of them; and
- (b) the priority date of any matter contained in the application in suit which was also disclosed in the earlier relevant application or applications is the date of filing the relevant application in which that matter was disclosed or, if it was disclosed in more than one relevant application, the earliest of them.

Mention of inventor

24.—(1) The inventor or joint inventors of an invention have a right to be mentioned as such in any patent granted for the invention and also have a right to be so mentioned if possible in any published application for a patent for the invention and, if not so mentioned, a right to be so mentioned in accordance with the rules in a prescribed document.

(2) Unless an applicant for a patent has already given the Registry the information mentioned in this subsection, the applicant for a patent must, within the prescribed period, file with the Registry a statement —

- (a) identifying the person or persons whom the applicant believes to be the inventor or inventors; and
- (b) where the applicant is not the sole inventor or the applicants are not the joint inventors, indicating the derivation of the applicant’s or the applicants’ right to be granted the patent,

and, if the applicant fails to do so, the application is treated as having been abandoned.

(3) Where a person has been mentioned as a sole or joint inventor under this section, any other person who alleges that the former ought not to have been mentioned may at any time apply to the Registrar for a certificate to that effect, and the Registrar may issue such a certificate.

Date of filing application

26.— (1) Subject to the provisions of this Act, the date of filing an application for a patent is taken to be the earliest date on which the documents filed at the Registry to initiate the application satisfy the following conditions:

- (a) the documents indicate that a patent is sought;
- (b) the documents identify the applicant for the patent; and
- (c) the documents contain —
 - (i) something which is or appears to be a description of the invention for which the patent is sought; or
 - (ii) where a declaration under section 17(2) is made in or in connection with the application —
 - (A) a reference to an earlier relevant application specified in the declaration;
 - (B) such information on the earlier relevant application as may be prescribed; and
 - (C) a statement that the description of the invention for which the patent is sought is incorporated in the application by reference to, and is completely contained in, the earlier relevant application, as filed.

...

(11) Where, after an application for a patent has been filed, but before the applicant satisfies the condition under section 30(c), or the application is refused, withdrawn, treated as or taken to be withdrawn, or treated as abandoned or as having been abandoned —

- (a) a new application is filed by the original applicant or the original applicant's successor in title in accordance with the rules in respect of any part of the matter contained in the earlier application; and
- (b) the conditions in subsection (1)(a), (b) and (c)(i) or (ii) are satisfied in relation to the new application (without the new application contravening section 84),

the new application is treated as having, as its date of filing, the date of filing of the earlier application.

Search and examination

29.— ...

(7) If it appears to an Examiner during the examination of an application under subsection (4) or (5) that one or more of the matters prescribed for the purposes of this subsection apply, the Examiner

must give the applicant at least one written opinion to that effect, and the Registrar must, upon receiving the written opinion, send the applicant a copy of the written opinion.

Power to revoke patents on application

80.—(1) Subject to the provisions of this Act, the court or the Registrar may, on the application of any person, by order revoke a patent for an invention on (but only on) any of the following grounds:

- (a) the invention is not a patentable invention;
- (b) the patent was granted to a person who was not entitled (either alone or with other persons) to be granted that patent;
- (c) 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;
- (d) the matter disclosed in the specification of the patent extends beyond that disclosed —
 - (i) in the application for the patent, as filed; or
 - (ii) where the patent was granted on a new application filed under section 20(3) or 47(4) or section 116(6) of the Patents Act (Cap. 221, 1995 Revised Edition), or in accordance with section 26(11), in —
 - (A) the earlier application made under this Act;
 - (B) the application made under the United Kingdom Patents Act 1977; or
 - (C) the application under the European Patent Convention designating the United Kingdom filed at the European Patent Office, (as the case may be) from which the filing date and the right of priority has been derived, as filed;
- (e) an amendment or a correction has been made to the specification of —
 - (i) the patent; or
 - (ii) the application for the patent, which should not have been allowed;
- (f) the patent was obtained —
 - (i) fraudulently;
 - (ii) on any misrepresentation; or
 - (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;
- (g) the patent is one of 2 or more patents for the same invention having the same priority date and filed by the same party or the party's successor in title.

Procedure where applicant is not inventor or sole inventor

18.—(1) Subject to rules 28 and 86(8) and (8A), the period prescribed for the purposes of section 24(2) shall be —

- (a) where there is no declared priority date, 16 months from the date of filing of the application for a patent; or
- (b) where there is a declared priority date, 16 months from the declared priority date.

(1A) A statement filed under section 24(2) shall be made on Patents Form 8.

(2) [Deleted by S 688/2021 wef 01/10/2021]

(3) Where the application is an international application for a patent (Singapore), the requirements of paragraph (1) shall be treated as having been complied with if the provisions of rules 4.1(a)(iv) and 4.6 of the Regulations under the Patent Co-operation Treaty have been complied with, whether or not there was any requirement that they be complied with.

New applications under section 26(11)

27.— (1) Subject to paragraphs (2) and (3), a new application for a patent which includes a request that it be treated as having as its date of filing the date of filing of an earlier application may be filed in accordance with section 26(11) —

- (a) of the applicant's own volition; or
- (b) to comply with the requirements of section 25(5)(d)

(2) Where possible, the description and drawings of the earlier application and the new application shall respectively relate only to the matter for which protection is sought by that application.

(3) Where it is necessary for an application to describe the matter for which protection is sought by another application, it shall include a reference by number to that other application.

Extension of period for filing new applications

28. Where a new application is filed under section 20(3), 26(11) or 47(4) —

...

(f) after the expiry of the period referred to in rule 18(1), the requirement under section 24(2) read with rule 18(1A) shall be complied with on the initiation date; ...

Written opinion of Examiner, etc.

46.—(1) For the purposes of section 29(7), the prescribed matters are the following:

- ...
- (f) there is —

- (i) any other application for a patent for the same invention, with the same priority date, filed by the same applicant or the applicant's successor in title; or
- (ii) any earlier grant of a patent for the same invention, with the same priority date, to the same applicant or the applicant's successor in title.