

Supplementary examination guidelines for patent applications

October 1, 2015

Executive summary

The Intellectual Property Office of Singapore (“IPOS”) amended the “Examination Guidelines for Patent Applications” (the “Guidelines”) with a full chapter on Supplementary Examination.

This article highlights:-

- The stringent standards for determining whether the foreign route may be relied upon for supplementary examination.
- The examination of medical claims for relatedness to a foreign application relied upon in the Singapore application.

Supplementary examination

In Singapore, an applicant may rely on the final search and examination results of certain foreign applications (referred to as the “foreign route”) instead of requesting for local search and examination. The application will then be subject to supplementary examination.

During supplementary examination only the following grounds are subject to examination:-

- whether each claim in the application is supported by the description of the invention;
- whether each claim in the application is related to at least one claim in the foreign application which has been examined and determined to have satisfied the criteria of novelty, inventive step and industrial applicability;
- whether the invention encourages offensive, immoral or anti-social behaviour;
- whether the invention is a method of treatment or diagnosis practised on the human or animal body;
- whether there is double patenting; and
- whether there is any added matter.

According to the Guidelines, if the foreign search and examination results contain a negative indication for novelty,

inventive step or industrial applicability, an application for supplementary examination will be refused by IPOS. Under the foreign route, the applicant may not amend the claims in the Singapore application and/or lodge submissions, for the purpose of “curing” the negative indication in the foreign results.

Foreign route

The foreign applications which may be relied upon are:-

- corresponding applications in prescribed patent offices; or
- a corresponding Patent Cooperation Treaty (“PCT”) application; or
- the related national phase application (i.e. the national phase (in a prescribed patent office) of a PCT application which has also entered national phase in Singapore).

A “corresponding” application is one which has a priority link with the Singapore application.

It has to fulfil one of the three criteria below:-

- The Singapore application claims priority from the corresponding application;
- The corresponding application claims priority from the Singapore application; or
- The corresponding application and the Singapore application claim priority from the same application.

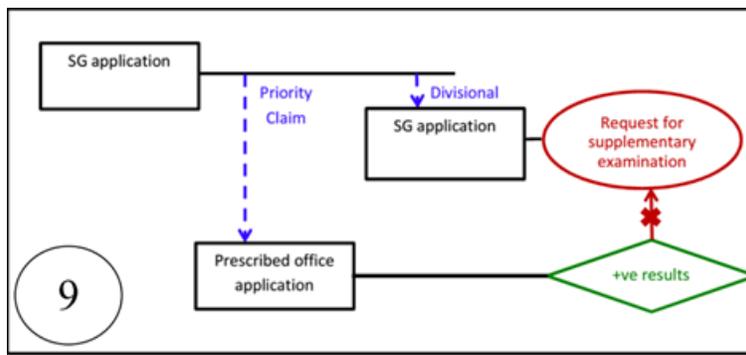
The Guidelines make it very clear that the legislation will be strictly construed in determining whether supplementary examination (i.e. the foreign route) is available.

We highlight two examples in this article:-

(a) If the parent application of a Singapore divisional application does not contain a priority claim, the foreign route is not available for the divisional application, and supplementary examination of the divisional application is not available.

While a Singapore divisional application is treated under the law as having the same filing date of the parent application, this is not the same as the divisional application claiming priority from the parent application. Hence, if the divisional application has no express priority claim, and the foreign application does not claim priority from the divisional application (even if the foreign application claims priority from the parent application), the divisional application cannot go through the foreign route.

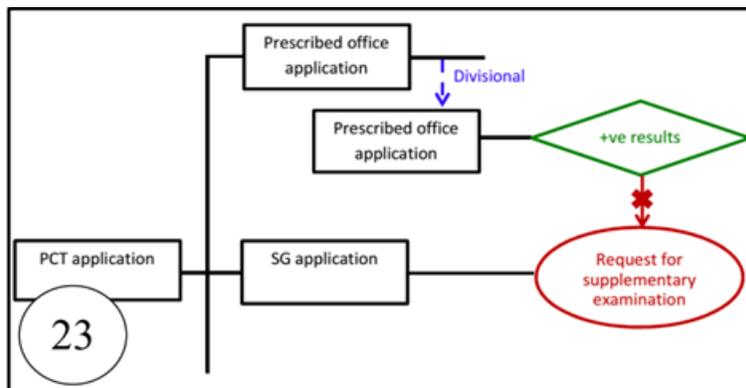
The figure below obtained from the Guidelines illustrates a case in which supplementary examination of a Singapore divisional application is unavailable:



(b) Where a PCT application with no priority claim enters national phase in Singapore and in a prescribed patent office, the divisional application of the national phase application in the prescribed patent office cannot be used in Singapore under the foreign route.

The Guidelines clarify that the foreign divisional application is not a related “national phase application” (see (c) under Foreign Route). Since the foreign divisional application has no priority claim, and the Singapore application does not claim priority from the foreign divisional application, the Singapore application cannot go through the foreign route.

The figure below obtained from the Guidelines illustrates a case in which the final results of a foreign divisional application may not be relied upon in supplementary examination:



Whether different types of medical claims are considered to be “related”

In a supplementary examination, the Examiner will examine whether each claim in the Singapore application is “related” to at least one claim that has been examined in the foreign results relied upon by the applicant.

In this regard, it is stated in the Guidelines that:-

1. method of medical treatment claims are not related to first medical use claims;
2. Swiss-style claims are not related to method of medical treatment claims; and
3. Swiss style claims are not related to European-style second medical use claims.

Note: The foreign route will not be available from 2017.

Your Key Contacts



Woon C. (Woon Chooi)

Yew

Senior Partner, Singapore

D +65 6885 3609

woonchooi.yew@dentons.com