

Annex F – Proposed amendments to Guidelines on Patents Grace Period

Note: The proposed changes to the patent examination guidelines are indicated by the tracked changes in this document.

P. Exceptions to novelty: grace period

3.97 Sections 14(4)-(6) provide for certain matter to be disregarded for the purposes of [Section 14](#) – if the disclosure was made under certain circumstances, and within a 12-month “grace period”:

(4) 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 either —

- (a) the disclosure was due to, or made in consequence of, the matter having been obtained unlawfully or in breach of confidence by any person —
 - (i) from the inventor or from any other person to whom the matter was made available in confidence by the inventor or who obtained it from the inventor because he or the inventor believed that he was entitled to obtain it; or
 - (ii) from any other person to whom the matter was made available in confidence by any person mentioned in sub-paragraph (i) or in this sub-paragraph or who obtained it from any person so mentioned because he or the person from whom he obtained it believed that he was entitled to obtain it;
- (b) the disclosure was made in breach of confidence by any person who obtained the matter in confidence from the inventor or from any other person to whom it was made available, or who obtained it, from the inventor;
- (c) the disclosure was due to, or made in consequence of, the inventor displaying the invention at an international exhibition; or
- (d) the disclosure was due to, or made in consequence of, the inventor describing the invention in a paper read by him or another person with his consent or on

his behalf before any learned society or published with his consent in the transactions of any learned society-; or

(e) subject to subsections (5A) and (5B), the disclosure was made to the public by the inventor, or by a person who obtained the matter directly or indirectly from the inventor, in any circumstances not described in paragraphs (a) to (d).

(5) In subsection (4)(d), learned society includes any club or association constituted in Singapore or elsewhere whose main object is the promotion of any branch of learning or science.

(5A) Subsection (4)(e) applies to the disclosure of matter constituting an invention due to, or in consequence of, the publication by an intellectual property administrator (being a person who obtained the matter directly or indirectly from the inventor) of an application for an intellectual property right (being an application containing the matter, but not being the application for a patent mentioned in subsection (4)), or a registration of an intellectual property right pursuant to such an application, only if —

- (a) the application was filed, without the consent of the inventor, by a person who obtained the matter directly or indirectly from the inventor; or
- (b) the publication was erroneous by reason that —
 - (i) the application had been withdrawn, refused or abandoned before the date of the publication; and
 - (ii) consequently, the publication was not required under the law (whether of Singapore or elsewhere) or treaty governing the application.

(5B) For the purposes of subsection (4)(e), where —

- (a) the disclosure of matter constituting an invention is due to, or in consequence of, the publication by an intellectual property administrator (being a person who obtained the matter directly or indirectly from the inventor) of an application for an intellectual property right (being an application containing the matter, but not being the application for a patent mentioned in subsection (4)), or a registration of an intellectual property right pursuant to such an

application; and

- (b) the publication was erroneous by reason that the publication occurred earlier than provided under the law (whether of Singapore or elsewhere) or treaty governing the application.

the matter is to be treated as disclosed to the public on the date when the publication should have occurred under that law or treaty.

(5C) If the applicant relies on any circumstances described in any paragraph of subsection (4) when —

- (a) complying with section 29(1)(b) or (c), (3) or (9); or
(b) making a request under section 29B(1) for a review of an examination report issued under section 29(4) or a search and examination report issued under section 29(5),

the applicant must file written evidence complying with the prescribed requirements in support of the applicant’s reliance on those circumstances.

(6) In this section, references to the inventor include references to any proprietor of the invention for the time being.

3.98 Section 14(4) provides for circumstances in which disclosures made prior to the filing of a patent application are to be disregarded during the determination of the “state of the art”. Since Section 14(1) takes reference from Sections 14(2) and 14(3), and Section 15 takes reference from Section 14(2), in respect of the state of the art, any disclosure that is disregarded under Section 14(4) cannot be used for the assessment of novelty and of inventive step. The criteria for a disclosure to be disregarded under Section 14(4) in respect of a patent or a patent application are as follows:

- 1) The disclosure should be of “matter constituting an invention”;
- 2) The disclosure must be made within the period of **12 months** immediately before the **date of filing** the application for the patent; and
- 3) The disclosure should be due to the circumstances described in Sections 14(4)(a)-(e).

In effect, if the aforementioned criteria 1) to 3) are met, a disclosure of “matter constituting an invention” which would otherwise qualify as prior art may be disregarded from the state of the art.

3.99 In order for a disclosure to be of “matter constituting an invention”, the subject matter of said disclosure must be the same as or must correspond substantially to the invention in the application. Notably, Section 14(4) specifies that the disclosure must be made within the period of **12 months** before the date of filing the application. This means the date of filing the **application in Singapore** and not the date of filing the priority document (for example the basic document in a foreign country). Examiners should not disregard any disclosure of matter constituting an invention where the disclosure occurred before the abovementioned period. The circumstances described in Sections 14(4)(a)-(e) include: disclosures made as a result of a breach of confidence; or disclosures where the inventor revealed the invention at an international exhibition or before a learned society; or disclosures that were made to the public by the inventor, or by a person who obtained matter constituting the invention directly or indirectly from the inventor, in circumstances other than those aforementioned.

3.100 Section 14(5C) specifies that if the applicant intends to rely on **any** of the circumstances described in Sections 14(4)(a)-(e) when requesting for an examination report, a search and examination report, or an examination review report, or when responding to a written opinion issued by an Examiner, the applicant must file written evidence in support of such reliance. Rule 8(1)(a) requires that the supporting written evidence must be by statutory declaration or affidavit, and enclose all supporting documents.

3.101 In general, the onus is on the applicant to make out a sufficient *prima facie* case in the statutory declaration or affidavit (in which all supporting documents are to be enclosed) that one of the circumstances in Sections 14(4)(a)-(e) is satisfied.

3.102 Sections 14(4)(c) and 14(4)(d) provide for the disregarding of inventor-originated disclosures made at international exhibitions or before a learned society (see subsection i of this Section on “Learned society”), while Section 14(4)(e), which allows the disregarding of public disclosures of matter constituting an invention by the inventor, or by a person who obtained the matter directly or indirectly from the inventor, provides

for the disregarding of other forms of inventor-originated disclosures that do not fall within the circumstances in Sections 14(4)(a) to 14(4)(d). Where Section 14(4)(c) or 14(4)(d) is claimed, the written evidence that is filed by the applicant under Section 14(5C) should show that the disclosure was “due to, or made in consequence of, the inventor”, whereas if Section 14(4)(e) is claimed, the supporting written evidence should show that the disclosure was made to the public “by the inventor, or by a person who obtained the matter directly or indirectly from the inventor”.

3.103 Disclosures made by a joint inventor are to be treated as disclosures made by an inventor. In respect of a **printed publication**, it is apparent that a disclosure is by the inventor (or joint inventors) if said disclosure:

- a) Names the inventor (or joint inventor(s)) as an author; and
- b) **Does not** name additional persons as authors.

3.104 To explain this point, where the application does not name additional persons as joint inventors relative to the persons named as authors in the printed publication (e.g. the application names as joint inventors A, B, and C, and the printed publication names as authors A and B), it would be apparent that the disclosure is made by the inventor (or joint inventor(s)), and the printed publication should be disregarded as prior art during examination if it was published within 12 months immediately before the date of filing the application. If, however, the application names fewer joint inventors than the printed publication (e.g. the application names as joint inventors A and B, and the publication names as authors A, B and C), then it would *not* be readily apparent from printed publication alone, that the disclosure is by the inventor (or joint inventor(s)). In such a situation, for the printed publication to be disregarded as prior art for the purposes of Section 14(2), the applicant would need to submit supporting written evidence (that makes out a sufficient *prima facie* case) to demonstrate otherwise (pursuant to Rule 8(1)(a), the applicant must enclose all supporting documents in his statutory declaration or affidavit).

3.105 In respect of other kinds of disclosures (other than printed publications), the written evidence that is filed by the applicant under Section 14(5C) in respect of such disclosure should show that the disclosure was “due to, or made in consequence of, the inventor”

(where Section 14(4)(c) or 14(4)(d) is claimed), whereas if Section 14(4)(e) is claimed, the supporting written evidence should, on its face, show that the disclosure was made to the public “by the inventor, or by a person who obtained the matter directly or indirectly from the inventor”.

3.106 While an intellectual property administrator may be considered a person who obtained matter constituting an invention “directly or indirectly from the inventor” (because of Section 14(5A)), Section 14(4)(e) **does not permit** an inventor’s (or joint inventors’) own applications for intellectual property rights (e.g. patent applications, utility models, etc.) from being disregarded, unless under the very limited circumstances prescribed in Sections 14(5A) and 14(5B). These circumstances are likely to be rare, and hence an inventor’s (or joint inventors’) own earlier patent applications would normally form part of the state of the art under Section 14(2) or Section 14(3).

3.107 In any case, any disregarded disclosures, discovered by the Examiner or declared by the inventor/applicant, should still be documented during the course of search or examination of an application along with appropriate indication of the relevance of said disclosure to the prosecution of the application. For search reports, a disclosure that is likely to be disregarded at the examination stage may be indicated as an L-category citation. For written opinions (or examination reports), an appropriate comment may be made in Box V in respect of any disregarded disclosures.

3.108 The statutory declaration or affidavit filed for the purposes of Section 14(5C) should contain facts about the contents of the disclosure, the date of the disclosure, and the identity of the disclosing entity and its link to the inventor. These, and other related facts, must be laid out to the extent that allows the Examiner to establish that the disclosure is: 1) of matter constituting the invention in the application; 2) was made within the period of 12 months immediately before the date of filing the application; and 3) satisfies the link to the inventor in the relevant Section 14(4) ground that is claimed (e.g. if Section 14(4)(e) is claimed, the link to the inventor to be satisfied is “by the inventor or by a person who obtained the matter directly or indirectly from the inventor”).

3.109 In the case where the applicant claims the international exhibitions ground in Section

14(4)(c), the supporting written evidence must (i) state that the invention to which the applicant's application relates was in fact exhibited at an international exhibition; (ii) state the opening date of the exhibition and, where the first disclosure of the invention did not take place on the opening date, the date of the first disclosure; and (iii) enclose one or more supporting documents identifying the invention that was exhibited at the exhibition (Rule 8(1)(b)).

3.110 In the case of erroneous publications by a foreign intellectual property office, the supporting written evidence must enclose an acknowledgment from the foreign intellectual property office stating that the publication was erroneous and the reason for the publication being erroneous, and in a case mentioned in Section 14(5B), stating the earliest date that the publication ought to have been made under the law or treaty governing the erroneously published application (Rule 8(1)(c)).

3.111 For PCT national-phase (SG) entry applications, where applicants file a request for examination with IPOS, the Examiner will note that a disclosure at an international exhibition was made at the international phase and this fact is revealed in the international search report (Rule 33.1 of the PCT Regulations). While the Examiner may be aware of said disclosure at an international exhibition from the international search report, the applicant must still file the requisite written evidence under Section 14(5C) at the time of entering national phase.

i. Learned society

3.112 A learned society includes any club or association constituted in Singapore or elsewhere whose main object is the promotion of any branch of learning or science (Section 14(5)). This suggests that a “learned society” includes any body of persons seeking to promote and organize the development of specific subjects, usually by the provision of a forum for the exchange and discussion of ideas and the dissemination of information, usually through the publication of its proceedings. However, some caution should be exercised in how this provision is applied. For example a meeting organized by a government department, university department or company may in some instances not constitute a learned society. On the other hand a conference organized by the Royal Society of Chemistry or IEEE would generally be considered a learned society.

3.113 In *Ralph M. Parsons Co (Beavon’s) Application* [1978] FSR 226, it was considered that learned societies would disseminate the relevant learning without consideration of economic gain. Thus, a learned society would normally be a non-commercial body of persons, and is not typically associated with commercial exploitation. For a publication to be regarded as a “transaction” of a learned society, it has to be published under the auspices of and finally be the responsibility of the learned society. Therefore, a publication that occurs via a third party, such as a reporter, who is present at the conference, would not be regarded as a publication by the society.

3.114 In *Western Minerals Technology Pty Ltd v Western Mining Corporation Limited* [2001] APO 32, a conference organized by the Camborne School of Mines (CSM) was considered to be a conference organized by “an institution of higher learning, conducting teaching and research at the undergraduate and postgraduate level”. CSM was not regarded as a learned society as there was no evidence that it was “a society made up of persons seeking to promote and organize the study of specific subjects by the provision of a forum for discussion and a means of contact for those of a common interest”. The participants at the conference, which might comprise highly learned individuals, were not a consideration for the case. The Delegate considered the participants to represent an *ad hoc* group – “a wide range of people, for example from academia, research institutes, industry and consultancy” who had responded to “notices placed in international journals and the like”. The publication of the conference

proceedings in the journal *Minerals Engineering* Vol. 4, Nos.7-11, 1991, entitled Special Issue Material Engineering '91 was also clearly not by a learned society, but by Pergamon Press Plc, a publishing company.