

## **Updated Guidelines on the Assessment of Patent Post-Grant Amendments**

[Circular No. 1/2016, with effect from 30 June 2016]

In the decision of *Ship's Equipment Centre Bremen GmbH v Fuji Trading (Singapore) Pty Ltd & Ors* [2015] SGHC 159 and more recently in *Warner-Lambert Company LLC v Novartis (Singapore) Pte Ltd* [2016] SGHC 106, the Singapore High Court affirmed the guidelines for patent post-grant amendments set down in *Smith Kline and French Laboratories limited v Evans Medical Limited* [1989] FSR 561.

2 Following these cases, the Registry of Patents has reviewed and updated the practice on the assessment of patent post-grant amendments under Section 38 of the Singapore Patents Act. In addition to the requirements under Section 84 of the Singapore Patents Act, the amendments will also be assessed based on the following criteria:

- (1) Whether relevant matters are sufficiently disclosed;
- (2) Whether there was any unreasonable delay in seeking amendments; and
- (3) Whether the patentee has gained an unfair advantage obtained by delaying amendments which are known to be needed.

3 To facilitate the assessment, the application for post-grant amendment should set out fully the reason(s) for amendments, including the circumstances leading to the amendments and any evidence in support thereof.

4 The additional criteria above will apply to all pending and new requests for post-grant amendments. An updated version of IPOS' patent examination guidelines will be released at a later date.

5 If you have any enquiries, please contact Ms Tay Shu Wen (tay\_shu\_wen@ipos.gov.sg).