

News

Leading the Field

We are very pleased to announce the following:

Chambers Asia Pacific 2017 – ranked for Intellectual Property in Singapore;

Acquisition International -2016 Intellectual Property Awards - Best IP Disputes Firm Singapore;

Finance Monthly Law Awards 2016 – Winner, Information Technology Lawyer of the Year Singapore

Corporate Intl Global Award 2016 - Patent Law Firm of the Year in Singapore

Corporate Intl Global Award 2016 - Boutique Multi Disciplinary Law Firm of the Year Singapore; and

M&A Today – Global Awards 2016 – IT Law Firm of the Year -Singapore.

Daniel Lim has been ranked in Chambers Asia Pacific 2017 as a leading individual for Intellectual Property Litigation.

Joyce A. Tan has been ranked as a Market-Leading Lawyer in Singapore by AsiaLaw Leading Lawyers 2017, a leading trademark attorney in the World IP Review Leaders Patent and Trademark Volumes and the World Trademark Review for the year 2017, a leading TMT Lawyer in Who's Who Legal: Technology, Media and Telecommunications, and a leading individual for both Technology, Media, Telecommunication and Intellectual Property (Non-contentious).

Patentability of Software in Singapore

Background

When the Singapore Patents Act was enacted in 1994, it included a list of statutory exclusions from patentability:

- (a) a discovery, scientific theory or mathematical method;
- (b) a literary, dramatic, musical or artistic work or any other aesthetic creation whatsoever;
- (c) a scheme, rule or method for performing a mental act, playing a game or doing business, or a program for a computer; and
- (d) the presentation of information.

The exceptions including the one for 'programs for a computer' was shortly *removed* in 1996.

Current Position

There is therefore no prohibition against patenting computer-implemented inventions (CII).

In practice, the Intellectual Property Office of Singapore (IPOS) has issued examination guidelines in 2016 and the following points are relevant:

- Notwithstanding the *removal* of their prohibition from the Act, it remains that discoveries, scientific theories and mathematical methods, aesthetic creations, rules or methods to play games or do business, and presentation of information are not patentable.
- The exclusion for business methods is narrowly interpreted.
- To determine whether the claims define an "invention," an examiner should take into account the substance rather than the form of the claims to identify *the actual contribution* which is made by the claimed subject matter, with respect to the problem to be solved, how the claimed subject matter works, and its advantages. These are examined with reference to the skill and knowledge of a person skilled in the art.
- Claims related to presentation of information through software that are characterized only by source code, and not by any technical features, are unlikely to be considered an invention on the basis that the actual contribution would be a mere presentation of information.

- For CII, examiners determine the extent to which the computer (or other technical features) contributes to the invention defined in the claims. It must be established that said computer (or other technical features) is integral to the invention.
 - Claims are viewed favourably if the various technical features (e.g. servers, databases, user devices etc.) interact with the *steps of the business method (i) to a material extent; and (ii) in such a manner as to address a specific problem*. In an example, a claim may recite known hardware components for implementing a business method, but if the overall combination of the hardware provides, for example, a more secure environment for performing transactions, then the hardware would be regarded to interact with the business method to a material extent to address a specific problem. The actual contribution, in this case, is likely to be the use of that combination of hardware for the business method.
 - However, if the technical features recited in the claim are such that they are no more than the workings of a standard operating system, in particular, the use of a *generic computer or computer system* to perform a *pure business method*, then such an interaction would not be viewed favourably. The claimed subject matter would not be considered an "invention" by merely including the term "computer-implemented".
- how much contribution is "actual contribution"; and
 - what is the test to determine "actual contribution"
 - The examples provided refer only to subject matter directed towards business methods and ignores the variety of other CII for example subject matter directed towards software and firmware.
 - The guidelines for CII are unclear, for example:
 - the term "generic computer or computer system" has not been defined;
 - there is a no clear description of what is meant by "pure business method", as opposed to 'impure' business methods; and
 - the test to determine whether technical features interact with business methods is based on the vague phrase "material extent".

Relevant Case Law

There is one case that indicates that Singapore is not averse to business method patents: *First Currency Choice Pte Ltd v Main-Line Corporate Holdings Ltd [2008] 1 SLR 335*.

The patent covered a method of determining the operating home currency of a payment card at the point of sale between the merchant and the cardholder by automatically extracting a series of digits known as the "identifier code" from the payment card number (which is also known as the "Primary Account Number" ("the PAN")) and comparing the identifier code with a table known as the "Bank Reference Table" ("BRT"). The BRT, a table specially constructed by the respondent, stored a portion of the PAN and an associated currency code for each bank listed in the table. The Invention was a business method that extracted information from a card, compared the data with a reference table and allowed the cardholder to be charged in the home currency while overseas.

While the court assessed obviousness and sufficiency, and upheld the patent, the court did not address whether computer programs or CII were patentable subject matter as it was not an issue placed before the court.

It is observed that:

- The analysis for determining contribution of subject matter is essentially an analysis to determine inventive step.
- The guidelines fail to clarify:
 - whether the subject matter should be tested for actual contribution before or after determining whether the invention is novel, inventive and industrially applicable;
 - what is the "actual contribution" to human knowledge;

CONTACT

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