

Q180**Content and relevant of industrial applicability and/or utility as requirements for patentability.****Submitted by: Winnie Tham and Jason Chan, Working Committee for AIPPI Singapore****1. What is the situation in your country?**

1.1 *Does your country know industrial applicability or utility as an additional requirement for patentability besides novelty and inventive step?*

1.2 *How does this comply with TRIPS?*

Singapore does recognize industrial applicability as an additional requirement for patentability besides novelty and inventive step and therefore is in compliance with TRIPS.

2. Industrial applicability

2.1 *How is industrial applicability defined?*

Under the Patents Act, in order for an invention to be patentable, it must possess novelty, inventive step and be capable of industrial application. Therefore, industrial applicability is an additional requirement for patentability.

Industrial applicability is defined as an invention shall be taken to be capable of industrial application if it can be made or used in any kind of industry, including agriculture. However, it is specifically provided that a method of treatment of the human or animal

body by surgery or therapy or of diagnosis practised on the human or animal body shall not be taken to be capable of industrial application. Such methods are not patentable. A product consisting of a substance or composition from being treated as capable of industrial application merely because it is invented for use in any such method.

There are no statistics available to indicate how many applications are refused for lack of industrial applicability.

2.2 What is the relevance of industrial applicability and how does it affect granting proceedings?

If an invention is not industrially applicable, it would not qualify as a patentable invention and therefore can affect the grant of a patent. Under the Singapore patents system however, it is possible to obtain a grant of a patent despite a negative examination report. To that extent, it is possible for a patent to be granted even if the invention does not possess industrial applicability.

2.3 How is industrial applicability treated in proceedings concerning the validity of patents?

Notwithstanding the above, a patent may be revoked on the basis that an invention is not patentable. Being a requirement for patentability, the lack of industrial applicability subjects the patent to the possibility of revocation.

3. Utility

3.1 How is utility defined?

3.2 *What is the relevance of utility?*

Utility is not defined as a specific requirement of patentability under the Patents Act.

There has been some discussion on the relevance of utility in patents law in Singapore, particularly in the case of Merck & Co Inc v Pharmaforte Singapore Pte Ltd. This case was first heard at the High Court, and then went on appeal to the Court of Appeal.

The case dealt with a chemical compound Lovastatin with a dimeric impurity of 0.2% or less than other products in the prior art. However, the evidence showed that the enhanced purity did not possess any known benefit to the performance of the drug either as to toxicity or therapeutic benefits. In the High Court decision of the case, the learned Judge held that a useful test within a novelty inquiry is to assess the utility of the patented product. Notwithstanding that there is no statutory requirement for utility, it was noted that there were clearly cases which imposed the requirement of utility. In such an enquiry, the question to consider is whether subsequent inventors would be obstructed from future dealings with the subject. The Judge decided that the relevant claims would prevent any manufacturer from selling Lovastatin where the dimer was 0.2% or less, even if manufactured by a different process. Given that the difference in purity did neither harm or good, the court held that the invention cannot be "useful" and therefore found that the claims in question were invalid. Hence, in the High Court decision, "utility" was viewed as a relevant criteria in determining novelty of an invention.

In the Court of Appeal decision, the judges followed the position in the pre-1949 UK Patents Act, which similarly did not contain a requirement for utility. They found that

although there was no provision allowing revocation on the basis of inutility, the court was not precluded from considering the question of utility in determining patentability. The court quoted the following passage from Alsop's Patent (1907) 24 RPC 733 which it felt was pertinent:-

*"In considering the validity of a patent for a process it is, therefore material to ascertain precisely what the patentee claims to be the result of the process for which the patent has been granted; the real consideration for which he gives for the grant is the disclosure of a process which produces a result, and not the disclosure of a process which may or may not produce any result at all. If the patentee claims protection for a process for producing a result and that result cannot be produced by the process, in my opinion the consideration fails. Similarly, if the patentee claims a process producing two results combined and only one of these results is in fact produced by the process, there is a partial failure of consideration ... and such partial failure of consideration is sufficient to avoid the patent ... Objections to patents on [this ground] are sometimes treated as objections for want of utility, and when so treated **the well known rule is that the utility of an invention depends upon, whether by following the directions of the patentee, the result which the patentee professed to produce can in fact be produced.** Want of utility in this sense must be distinguished from want of utility in the sense of the invention being useless for any purpose whatsoever. In the case of an invention not serving any useful purpose at all, the patent would no doubt be void, but not entirely for the same reason. It would probably be void at common law on the ground that the King's prerogative could not be properly exercised unless there were some consideration moving to the public, and the public could not be benefited by the disclosure of something absolutely useless."*

It further quoted with approval the old English case of Lane Fox v Kensington & Knightsbridge Electric Lighting Co Ltd [1892] 3 Ch 431 where Lindley LJ opined:

The utility of the alleged invention depends ... on whether by [directions in the complete specification] the effects which the patentee professed to produce could be produced ... Utility is often a question of degree, and always has reference to some object. Useful for what? It is a question which must be always asked and the answer must be, useful for the purposes indicated by the patentee.

Taking this interpretation, the court held that the fact that the compound with a lesser dimer impurity is of the same efficacy as a statin with a higher degree of dimer impurity does not render it as being of no utility. Nonetheless, whether or not there is a new use or further advantage is an argument that should be considered under novelty or inventive step, rather than utility.

To summarize, Singapore does appear to recognize “utility” as an implicit requirement, although it is not specifically mentioned in the legislation.

3.3 *How is utility treated in proceedings concerning the validity of patents?*

There is no specific ground of revocation on the basis of inutility. However, it may be regarded as being relevant to the issue of whether the specification enables the invention to be understood clearly and completely in order for it to be carried into effect

by a person skilled in the art (known also as "sufficiency of disclosure"). The lack of sufficiency is a ground of revocation under the Patents Act.

CONCLUSION

Industrial applicability is a requirement for patentability under the Patents Act in Singapore. The concept of "utility" is also required. It would seem reasonable to require that there is "utility" in inventions in the sense that the results which the patentee professes to produce in fact can be produced. In this way, the "contract" formed by the grant of a patent is honoured. This requirement is implied in, or covered under the requirement that a specification discloses the invention clearly and completely enough for it to be performed by a person skilled in the art.