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## AMENDMENTS TO PATENT ACT & RULES

In a recent survey conducted by the Global Intellectual Property Center (“GIPC”) on protection and enforcement of Intellectual Property (“IP”) rights, Singapore was ranked fourth in the world, close behind established IP regimes such as the US, UK and France<sup>1</sup>. This ranking affirms the efforts of Singapore and its policies in ensuring higher quality of its IP services. It further encourages the implementation of its 10-year Master Plan<sup>2</sup>, which aims to develop Singapore into a Global IP Hub in Asia.

The amendments to the Patent Act<sup>3</sup> and Patent Rules<sup>4</sup> reflect the recommendations made under the 10-year Master Plan. With effect from 14 February 2014, the Amended Patent Act and Patent Rules will come into force, bringing about a big shift in the application procedure of patents in Singapore. By moving away from the “self-assessment scheme” to a “positive-grant scheme”, patents will no longer be granted in Singapore unless a positive examination result is achieved. This change not only aligns the patent regime of Singapore to those in more established patent offices, it also raises the quality of patents

in general and strengthens business confidence in Singapore’s patent application process and enforcement.

This Article aims to address the changes made in the Patent Act and Patent Rules. In order to bring effect to the change from “self-assessment scheme” to the “positive-grant scheme”, a major part of the amendments in the Patent Act and Patent Rules lies in the application procedure of patents. In view of the increase in patent applications and transactions in Singapore, the patent agent regulatory regime is also liberalised to allow foreign-qualified patent agents to undertake offshore work in Singapore. Nevertheless, Singapore has also been developing its own qualified patent agents to cope with the demand for a bigger talent pool. This will also enable local examination to be conducted in-house, instead of outsourcing the work to other IPOs under the current patent laws.

## CHANGES IN THE APPLICATION PROCEDURE

The existing dual-track system of “fast-track” and “slow-track” will be replaced with a single prosecution track. With the removal of the dual-track system, the timeline has also changed for the different types of applications, namely, applications that request for local search and examination reports, and those that request for local examination report based on foreign search results. **Diagram A** on Page 4 of this Article shows the new timeline for the different routes available.

The timeline for filing a request for search report remains at the 13th month from the filing date, or priority date, of the application.

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However, the filing of a request for examination report based on earlier search report (Route A), combined search & examination report (Route B) and examination based on final search results of a corresponding application, corresponding international application or related national phase application (Route C) is now 36 months from the filing date, or priority date, of the application. The option for applicants to rely on search and examination results of a corresponding application, corresponding international application or related national phase application remains, however, applicants can now only rely on final positive search and examination results. Moreover, it is now mandatory for applicants to request for a supplementary examination report (Route D) at 54 months from the filing date, or priority date, of the application.

During the local examination stage, written opinions will be issued by the Examiners to the applicants. Under Routes A, B & C, applicants continue to have 5 months from the date of Registrar's letter forwarding the written opinion to respond, and the Examination Report will be issued within 18 months from date of the Registrar's first letter. In comparison, under Route D, applicants will have 3 months from the date of Registrar's letter forwarding the written opinion to respond, and the Supplementary Examination Report will be issued within 6 months from the date of the Registrar's first letter. If the written opinion contains any unresolved objections, rendering the results of the Examination Report or Supplementary Examination Report to be negative, a Notice of Intention to Refuse will be issued by the Registry to the applicants. Applicants can choose to file for a Review of Examination Report, together with amendments for specifications and written

submissions, within 2 months from date of the said Notice. If the results of the review of examination report remains negative, the patent application will be refused. However, if the written opinion or review of examination report contains no unresolved objections, a Notice of Eligibility to Proceed to Grant will be issued, and applicants have 2 months from the date of Notice to apply for grant. Thus, it is now mandatory that all patent applications under the "positive-grant scheme" will have to undergo examination, and the patents will only be granted upon positive examination results.

Under the two-track system in the current patent regime, Applicants have the option to request for a block extension of time in order to facilitate the examination proceedings of the application. This option for block extension of time has been removed, and replaced with an extension of time as-of-right and discretionary extension of time in the new patent regime. Discretionary extension of time must be requested before the expiry of the maximum period of the as-of-right extension, and is only applicable if the Applicant has exhausted the as-of-right extension of either 6 or 18 months, depending on the relevant rules applicable.

From the above listed changes, we can see how the application process has been amended to create an environment of stronger protection for patents. Some further efforts to improve the enforcement of rights of patents are discussed below.

#### **LOCAL IN-HOUSE EXAMINERS**

Under the previous Patents Act, requests for search and examination at the Intellectual Property of Singapore ("IPOS") were fully

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outsourced to patent offices in other countries such as the Hungarian, Danish and Austrian Intellectual Property Offices. With the “positive-grant scheme”, IPOS has been training and establishing domestic patent search and examination capabilities. This is another way to develop patent experts in Singapore and to align Singapore’s patent regime with the more established Offices such as the US, UK, Japan and France.

### **FOREIGN PATENT AGENTS**


The patent agent sector will be liberalised to allow a larger talent pool in patent services in Singapore. Following the amended Patent Act and Patent Rules, foreign qualified patent agents may be registered with IPOS and will be allowed to carry on business activities in Singapore. Foreign firms and partnerships may also take on patent-related businesses in Singapore as foreign patent agents, if one of the director or partner is a registered foreign patent agent with IPOS.

Singapore will now allow foreign patent agents to:

- “(a) apply and obtain patents at any place other than IPOS;*
- (b) prepare specifications or other documents for the purposes of patent law of any country other than Singapore, or an international application for a patent which, on its date of filing, designate any country other than Singapore (whether or not it also designates in Singapore); and*
- (c) give advice (other than advice of a scientific or technical nature) about the validity, or infringement of patents under the patent law of any country other than Singapore. “ (under s.105A of the Patent (Amendment) Act 2012)*

### **NEW INTEGRATED IT SYSTEM**

IPOS will soon launch its new integrated electronic filing portal, namely the IP2SG, which is set to make the filings easier and at the same time promote the fast and efficient processing of the submissions.

In summary, the amendments of the Patent Act and Patent Rules are intended to support, enhance and strengthen the protection and enforcement of patents, and is set to change the overall quality of the patents granted in Singapore. 

#### **Sources:-**

<sup>1</sup>Global Intellectual Property Center, ‘Charting the Course: GIPC International IP Index’ (Second Edition 2014), Page 28  
<[http://www.theglobalipcenter.com/wp-content/themes/gipc/map-index/assets/pdf/Index\\_Map\\_Index\\_2ndEdition.pdf](http://www.theglobalipcenter.com/wp-content/themes/gipc/map-index/assets/pdf/Index_Map_Index_2ndEdition.pdf)> accessed 30 January 2014 ;

<sup>2</sup>IP Steering Committee of Singapore, ‘Intellectual Property (IP) Hub Master Plan: Developing Singapore as a Global IP Hub in Asia’ (2013)  
<<http://www.ipos.gov.sg/Portals/0/Press%20Release/IP%20HUB%20MASTER%20PLAN%20REPORT%20%20APR%202013.pdf>> accessed 05 February 2014 ;

<sup>3</sup>Patent (Amendment) Act 2012 ;

<sup>4</sup>Patent (Amendment) Rules (20 January 2014 draft version)

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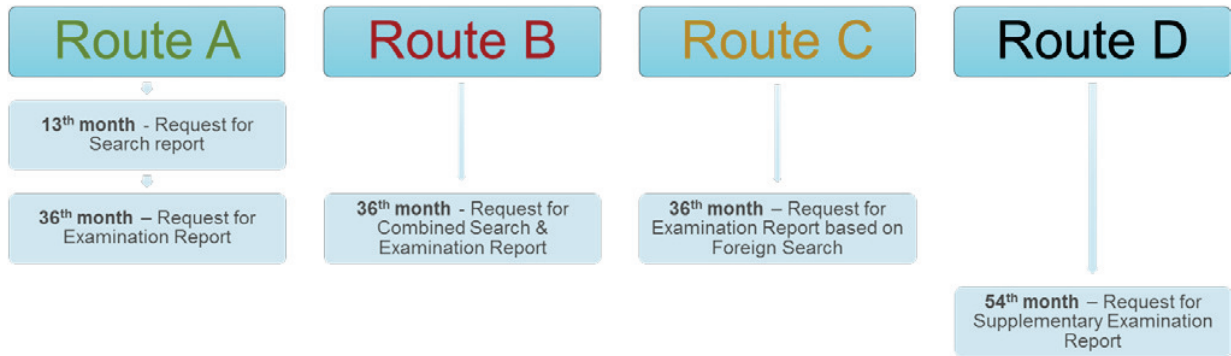
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**DIAGRAM A – NEW TIMELINE FOR DIFFERENT ROUTES**



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