

Intellectual Property (Dispute Resolution) Bill

Bill No. 17/2019.

Read the first time on 8 July 2019.

A BILL

intituled

An Act to amend the Arbitration Act (Chapter 10 of the 2002 Revised Edition) and the International Arbitration Act (Chapter 143A of the 2002 Revised Edition) to clarify that intellectual property disputes may be arbitrated, and to make amendments to the Copyright Act (Chapter 63 of the 2006 Revised Edition), the Geographical Indications Act 2014 (Act 19 of 2014), the Patents Act (Chapter 221 of the 2005 Revised Edition), the Plant Varieties Protection Act (Chapter 232A of the 2006 Revised Edition), the Registered Designs Act (Chapter 266 of the 2005 Revised Edition), the State Courts Act (Chapter 321 of the 2007 Revised Edition) and the Trade Marks Act (Chapter 332 of the 2005 Revised Edition), relating to intellectual property dispute resolution and certain other related matters and the composition of offences.

Be it enacted by the President with the advice and consent of the Parliament of Singapore, as follows:

Short title and commencement

1. This Act is the Intellectual Property (Dispute Resolution) Act 2019 and comes into operation on a date that the Minister appoints by notification in the *Gazette*.

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PART 1

AMENDMENTS TO ARBITRATION ACT

New Part IXA

2. The Arbitration Act (Cap. 10) is amended by inserting, immediately after section 52, the following Part:

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“PART IXA

ARBITRATIONS RELATING TO INTELLECTUAL PROPERTY RIGHTS

Interpretation of this Part

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52A.—(1) In this Part, unless the context otherwise requires, “intellectual property right” or “IPR” means —

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- (a) a patent;
- (b) a trade mark;
- (c) a geographical indication;
- (d) a registered design;
- (e) a copyright;
- (f) a right in a protected layout-design of an integrated circuit;
- (g) a grant of protection in respect of a plant variety;
- (h) a right in confidential information, trade secret or know-how;
- (i) a right to protect goodwill by way of passing off or similar action against unfair competition; or
- (j) any other intellectual property right of whatever nature.

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(2) In this Part, a reference to an IPR includes an application for the registration of an IPR if the IPR is protectable by registration.

(3) In this Part, “IPR dispute” includes —

- (a) a dispute over the enforceability, infringement, subsistence, validity, ownership, scope, duration or any other aspect of an IPR; 5
- (b) a dispute over a transaction in respect of an IPR; and
- (c) a dispute over any compensation payable for an IPR.

(4) In this section, “registration”, in relation to an IPR, includes the grant of the IPR. 10

IPR disputes may be arbitrated

52B.—(1) The subject-matter of an IPR dispute is capable of settlement by arbitration as between the parties to the IPR dispute. 15

(2) Subsection (1) applies whether the IPR dispute is the main issue or an incidental issue in the arbitration.

(3) An IPR dispute is not incapable of settlement by arbitration only because a law of Singapore or elsewhere —

- (a) gives jurisdiction to decide the IPR dispute to a specified entity; and 20
- (b) does not mention possible settlement of the IPR dispute by arbitration.

(4) In subsection (3), “specified entity” means any of the following entities under the law of Singapore or elsewhere: 25

- (a) a court;
- (b) a tribunal;
- (c) a person holding an administrative or executive office;
- (d) any other entity. 30

Effect of award involving IPR

52C.—(1) This section applies if an award deciding an IPR dispute is made in arbitral proceedings.

(2) The fact that a person is a third-party licensee or third-party holder of a security interest in respect of the IPR does not of itself make the person a person claiming through or under a party to the arbitral proceedings for the purposes of section 44(1).

(3) However, subsection (2) does not affect any right or liability between a third-party licensee or third-party holder of a security interest and a party to the arbitral proceedings whether —

- (a) arising in contract; or
- (b) arising by operation of law.

(4) In this section —

“third-party holder of a security interest”, in relation to an IPR in dispute in arbitral proceedings, means a person who —

- (a) is a holder of a security interest in respect of the IPR granted by a party to the arbitral proceedings; but
- (b) is not a party to the arbitral proceedings;

“third-party licensee”, in relation to an IPR in dispute in arbitral proceedings, means a person who —

- (a) is a licensee (whether or not an exclusive licensee) of the IPR under a licence granted by a party to the arbitral proceedings; but
- (b) is not a party to the arbitral proceedings.

Setting aside award involving IPR

52D.—(1) For the purposes of section 48(1)(b)(i), the subject-matter of a dispute is not incapable of settlement by arbitration under this Act only because the subject-matter relates to an IPR dispute.

(2) For the purposes of section 48(1)(b)(ii), an award is not contrary to public policy only because the subject-matter in respect of which the award is made relates to an IPR dispute.

Judgments entered in terms of award involving IPR

52E.—(1) This section applies if —

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- (a) an award deciding an IPR dispute is made in arbitral proceedings; and
- (b) a judgment in terms of the award is entered under section 46.

(2) Section 44(1) applies in relation to the judgment as if the reference in that section to an award made by an arbitral tribunal pursuant to an arbitration agreement were a reference to the judgment.

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(3) In this section, “award” includes a declaratory award.

Validity of patent may be put in issue in arbitral proceedings

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52F. Section 82(2) of the Patents Act (Cap. 221) does not prevent a party from putting the validity of a patent in issue in arbitral proceedings.”.

PART 2

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AMENDMENTS TO COPYRIGHT ACT

Amendment of section 7

3. Section 7(1) of the Copyright Act (Cap. 63) is amended by inserting, immediately after the definition of “Copyright Tribunal” or “Tribunal”, the following definition:

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““Court” means the High Court;”.

Miscellaneous amendments

4. The Copyright Act is amended —

(a) by inserting, immediately after the word “action” in section 119(1), the words “in the Court”;

(b) by deleting the word “court” wherever it appears in the following provisions and substituting in each case the word “Court”:

Sections 119(2), (2A), (4) and (5), 120(1) and (2), 120A(1), (2), (3), (6) and (7), 124, 126, 127 and 130(1A), (1B) and (2);

(c) by deleting the word “court” wherever it appears in the following provisions and substituting in each case the word “Court”:

Sections 140C(a), 140H(3)(b), 140I(2), (4) and (7) and 140IA(1) and (2);

(d) by deleting the words “A court” in section 140I(5) and substituting the words “The Court”;

(e) by deleting the words “a court” in sections 140K(1) and 140L(1) and substituting in each case the words “the Court”;

(f) by deleting the word “court” in section 140LA(3)(b)(ii) and (iii)(B), (4) and (5) and substituting in each case the word “Court”;

(g) by deleting the word “court” wherever it appears in the following provisions and substituting in each case the word “Court”:

Sections 140LB(2)(b), 140LG(2)(b) and 140LI(1) and (2);

(h) by deleting the words “a court” in section 140LL(1) and substituting the words “the Court”;

(i) by deleting the words “High Court” wherever they appear in sections 169(1), (2), (3), (4), (5) and (6) and the section

heading and 175(2)(b) and (c) and substituting in each case the word “Court”;

- (j) by inserting, immediately after the word “action” in section 192(1), the words “in the Court”;
- (k) by deleting the words “a court” in section 192(2) and substituting the words “the Court”; 5
- (l) by deleting the words “the court” in section 192(2) and substituting the words “the Court”;
- (m) by deleting the words “High Court” in the definition of “flagrantly infringing online location” in section 193A(1) and substituting the word “Court”; 10
- (n) by deleting the word “court” wherever it appears in the following provisions and substituting in each case the word “Court”:
 - Sections 193B(1), 193C(1), 193D(1) and (6), 193DB(1), (2) and (3) and the section heading and 193DC; 15
- (o) by deleting the words “High Court” wherever they appear in sections 193DDA(1), (2) and (3), 193DDB(3) and 193DDC(1) and (2) and substituting in each case the word “Court”; 20
- (p) by inserting, immediately after the words “bring an action” in section 200(1), the words “in the Court”;
- (q) by deleting the word “court” in section 200(1) and substituting the word “Court”;
- (r) by deleting the words “High Court” in the definition of “flagrantly infringing online location” in section 246(1) and substituting the word “Court”; 25
- (s) by deleting the word “court” wherever it appears in the following provisions and substituting in each case the word “Court”: 30
 - Sections 252A(1), 252B(1), 252C(1) and (6), 252CB(1), (2) and (3) and the section heading and 252CC;

- (*t*) by deleting the words “High Court” wherever they appear in sections 252CDA(1), (2) and (3), 252CDB(3) and 252CDC(1) and (2) and substituting in each case the word “Court”;
- 5 (*u*) by inserting, immediately after the word “action” in section 253(1), the words “in the Court”;
- (*v*) by deleting the word “court” wherever it appears in sections 253(2), (2A), (3), (3A), (4) and (5) and 254(1), (2), (3), (6) and (7) and substituting in each case the word “Court”;
- 10 (*w*) by inserting, immediately after the word “brought” in section 260(2), (3) and (4), the words “in the Court”;
- (*x*) by deleting the word “court” wherever it appears in section 261(1), (2), (4) and (5) and the section heading and substituting in each case the word “Court”;
- 15 (*y*) by inserting, immediately after the word “brought” in section 261C(2), the words “in the Court”; and
- (*z*) by deleting the word “court” wherever it appears in section 261F(1), (2) and (4) and the section heading and substituting in each case the word “Court”.
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PART 3

AMENDMENTS TO GEOGRAPHICAL INDICATIONS ACT 2014

Amendment of section 32

- 25 **5.** Section 32 of the Geographical Indications Act 2014 (Act 19 of 2014) is amended by inserting, immediately after subsection (2), the following subsection:

30 “(3) An appeal does not lie to the Court of Appeal from a decision of the Court on appeal from a decision of the Registrar for any matter under this Act or the rules made under this Act unless leave to appeal is given by the Court or the Court of Appeal.”.

Amendment of section 76

6. Section 76 of the Geographical Indications Act 2014 is amended —

(a) by inserting, immediately before the words “the Court” wherever they appear in subsection (1), the words “the Registrar or”; and 5

(b) by deleting subsection (2) and substituting the following subsection:

“(2) Where a certificate is given under subsection (1) and in subsequent proceedings before the Registrar or the Court — 10

(a) the validity of the registration is again questioned; and

(b) the registrant obtains a final order or judgment in the registrant’s favour relying on the validity of the registration as found in the earlier proceedings, 15

the registrant is entitled to be indemnified as to the registrant’s costs as between solicitor and client in the subsequent proceedings unless the Registrar or the Court directs otherwise.”. 20

Amendment of section 81

7. Section 81(1) of the Geographical Indications Act 2014 is amended by deleting “\$2,000” in paragraph (b) and substituting “\$5,000”. 25

PART 4

AMENDMENTS TO INTERNATIONAL ARBITRATION ACT

New Part IIA

8. The International Arbitration Act (Cap. 143A) is amended by inserting, immediately after section 26, the following Part: 30

“PART IIA

ARBITRATIONS RELATING TO
INTELLECTUAL PROPERTY RIGHTS**Interpretation of this Part**

5 **26A.**—(1) In this Part, unless the context otherwise requires,
“intellectual property right” or “IPR” means —

- (a) a patent;
- (b) a trade mark;
- (c) a geographical indication;
- 10 (d) a registered design;
- (e) a copyright;
- (f) a right in a protected layout-design of an integrated
circuit;
- (g) a grant of protection in respect of a plant variety;
- 15 (h) a right in confidential information, trade secret or
know-how;
- (i) a right to protect goodwill by way of passing off or
similar action against unfair competition; or
- 20 (j) any other intellectual property right of whatever
nature.

(2) In this Part, a reference to an IPR is a reference to such an IPR whether or not the IPR is registered, or subsists, in Singapore.

25 (3) In this Part, a reference to an IPR includes an application
for the registration of an IPR if the IPR is protectable by
registration.

(4) In this Part, “IPR dispute” includes —

- 30 (a) a dispute over the enforceability, infringement,
subsistence, validity, ownership, scope, duration or
any other aspect of an IPR;
- (b) a dispute over a transaction in respect of an IPR; and

(c) a dispute over any compensation payable for an IPR.

(5) In this section, “registration”, in relation to an IPR, includes the grant of the IPR.

IPR disputes may be arbitrated

26B.—(1) The subject-matter of an IPR dispute is capable of settlement by arbitration as between the parties to the IPR dispute. 5

(2) Subsection (1) applies whether the IPR dispute is the main issue or an incidental issue in the arbitration.

(3) An IPR dispute is not incapable of settlement by arbitration only because a law of Singapore or elsewhere — 10

(a) gives jurisdiction to decide the IPR dispute to a specified entity; and

(b) does not mention possible settlement of the IPR dispute by arbitration. 15

(4) In subsection (3), “specified entity” means any of the following entities under the law of Singapore or elsewhere:

(a) a court;

(b) a tribunal;

(c) a person holding an administrative or executive office; 20

(d) any other entity.

Effect of award involving IPR

26C.—(1) This section applies if an award deciding an IPR dispute is made in arbitral proceedings. 25

(2) The fact that a person is a third-party licensee or third-party holder of a security interest in respect of the IPR does not of itself make the person a person claiming through or under a party to the arbitral proceedings for the purposes of section 19B(1).

(3) However, subsection (2) does not affect any right or liability between a third-party licensee or third-party holder of a 30

security interest and a party to the arbitral proceedings whether —

- (a) arising in contract; or
- (b) arising by operation of law.

5 (4) In this section —

“third-party holder of a security interest”, in relation to an IPR in dispute in arbitral proceedings, means a person who —

10 (a) is a holder of a security interest in respect of the IPR granted by a party to the arbitral proceedings; but

(b) is not a party to the arbitral proceedings;

“third-party licensee”, in relation to an IPR in dispute in arbitral proceedings, means a person who —

15 (a) is a licensee (whether or not an exclusive licensee) of the IPR under a licence granted by a party to the arbitral proceedings; but

(b) is not a party to the arbitral proceedings.

Recourse against award involving IPR

20 **26D.**—(1) For the purposes of Article 34(2)(b)(i) of the Model Law, the subject-matter of a dispute is not incapable of settlement by arbitration under the law of Singapore only because the subject-matter relates to an IPR dispute.

25 (2) For the purposes of Article 34(2)(b)(ii) of the Model Law, an award is not in conflict with the public policy of Singapore only because the subject-matter in respect of which the award is made relates to an IPR dispute.

Recognition and enforcement of award involving IPR

30 **26E.**—(1) For the purposes of section 31(4)(a), the subject-matter of the difference between the parties to a foreign award is not incapable of settlement by arbitration

under the law of Singapore only because the subject-matter relates to an IPR dispute.

(2) For the purposes of section 31(4)(b), it is not contrary to the public policy of Singapore to enforce an award only because the award is in respect of a subject-matter that relates to an IPR dispute.

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Judgments entered in terms of award involving IPR

26F.—(1) This section applies if —

- (a) an award (whether made in or outside Singapore) deciding an IPR dispute is made in arbitral proceedings; and
- (b) a judgment in terms of the award is entered under section 19 or 29.

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(2) Sections 19B(1) and 29(2) apply in relation to the judgment as if —

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- (a) the reference in section 19B(1) to an award made by an arbitral tribunal pursuant to an arbitration agreement were a reference to the judgment; and
- (b) the reference in section 29(2) to a foreign award were a reference to the judgment.

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(3) In this section, “award” includes a declaratory award.

Validity of patent may be put in issue in arbitral proceedings

26G. Section 82(2) of the Patents Act (Cap. 221) does not prevent a party from putting the validity of a patent in issue in arbitral proceedings.”.

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PART 5

AMENDMENTS TO PATENTS ACT

Amendment of section 20

9. Section 20 of the Patents Act (Cap. 221) is amended —

- 5 (a) by inserting, immediately before the word “alone” in subsection (1)(a), the word “either”;
- (b) by deleting the word “whether” in subsection (6) and substituting the word “either”; and
- 10 (c) by deleting the words “involves matters which would more properly be determined” in subsection (7) and substituting the words “involves a matter which would be more conveniently dealt with”.

New section 32

15 10. The Patents Act is amended by inserting, immediately after section 31, the following section:

“Observations by third party on patentability

20 32.—(1) Where an application for a patent has been published, any other person may make observations in writing to the Registrar on the question whether the invention is a patentable invention, stating reasons for the observations, and the Registrar must, subject to subsection (2), consider the observations in accordance with the rules.

25 (2) The observations must be received by the Registrar before the Registrar sends to the applicant in the application for the patent —

- (a) a copy of an examination report under section 29(4);
- (b) a copy of a search and examination report under section 29(5); or
- 30 (c) a copy of a supplementary examination report under section 29(6).

(3) A person does not become a party to any proceedings under this Act before the Registrar by reason only that the person makes observations under this section.”.

New section 38A

11. The Patents Act is amended by inserting, immediately after section 38, the following section: 5

“Re-examination after grant

38A.—(1) Any person may, at any time after a patent is granted, file a request for the Registrar to conduct a re-examination of the specification of a patent for an invention on any of the following grounds: 10

- (a) the invention is not a patentable invention;
- (b) the specification does not disclose the invention clearly and completely for it to be performed by a person skilled in the art; 15
- (c) the matter disclosed in the specification extends beyond that disclosed —
 - (i) in the application for the patent, as filed; or
 - (ii) where the patent was granted on a new application filed under section 20(3) or 47(4) or section 116(6) of the Patents Act (Cap. 221, 1995 Ed.), or in accordance with section 26(11), in — 20
 - (A) the earlier application made under this Act; 25
 - (B) the application made under the United Kingdom Patents Act 1977; or

(C) the application under the European Patent Convention designating the United Kingdom filed at the European Patent Office,

5 as the case may be, from which the filing date and the right of priority has been derived, as filed;

(d) an amendment has been made to the specification of the patent under section 38(1), 81 or 83 which —

10 (i) results in the specification disclosing any additional matter; or

(ii) extends the protection conferred by the patent;

15 (e) an amendment has been made to the specification of the application for the patent under section 31 which results in the specification disclosing any matter extending beyond that disclosed in the application as filed;

20 (f) a correction has been made to the specification of the patent or of the application for the patent under section 107 which should not have been allowed;

(g) the patent is one of 2 or more patents for the same invention having the same priority date and filed by the same party or the party's successor in title.

(2) Every request under subsection (1) must be —

25 (a) filed in the prescribed manner;

(b) accompanied by the prescribed fee; and

(c) accompanied, at the time the request is filed, by —

(i) reasons to substantiate the ground specified in the request; and

30 (ii) any document that the person considers to be relevant for the purposes of the re-examination.

(3) The Registrar may reject any request that fails to comply with any requirement in subsection (2).

(4) The Registrar must not grant a request under subsection (1) if the Registrar is of the view that the request is frivolous, vexatious or an abuse of the process. 5

(5) No request under subsection (1) may be filed where there are pending before the court or the Registrar any proceedings in which the validity of the patent may be put in issue.

(6) Where proceedings before the court or the Registrar, in which the validity of the patent may be put in issue, are filed after a request under subsection (1) is made, the Registrar may make such order or give such direction as the Registrar thinks fit concerning the request. 10

(7) Where the Registrar grants a request under subsection (1), the Registrar must cause the specification of the patent to be re-examined by an Examiner so as to determine whether the ground specified in the request is made out. 15

(8) If it appears to the Examiner during the re-examination of the specification of the patent that —

(a) the ground specified in the request; or 20

(b) based on any document submitted under subsection (2)(c)(ii), any other ground mentioned in subsection (1),

is made out, the Examiner must give the proprietor of the patent a written opinion to that effect, and the Registrar must, upon receiving the written opinion, send the proprietor a copy of the written opinion. 25

(9) The proprietor of the patent must respond to the written opinion in the prescribed manner and within the prescribed period. 30

(10) Upon receiving the re-examination report prepared by the Examiner, the Registrar must send to the proprietor of the patent a copy of the report.

(11) Where the re-examination report issued under this section contains one or more unresolved objections (being an objection mentioned in the written opinion), the Registrar must make an order revoking the patent.

5 (12) An order under subsection (11) may be —

(a) an order for the unconditional revocation of the patent; or

10 (b) where one of the grounds mentioned in subsection (1) has been established, but only so as to invalidate the patent to a limited extent, an order that the patent should be revoked unless within a specified time the specification is amended under section 83 to the satisfaction of the Registrar.

15 (13) A decision of the Registrar or on appeal from the Registrar does not estop any party to any civil proceedings in which infringement of a patent is in issue from alleging invalidity of the patent on any of the grounds mentioned in subsection (1), whether or not any of the issues involved were decided in the decision.

20 (14) A decision of the Registrar to revoke a patent under this section has effect from the date of the grant of the patent.

25 (15) A person does not become a party to any proceedings under this Act before the Registrar by reason only that the person files a request under subsection (1), unless the person is the proprietor of the patent.”.

Amendment of section 47

12. Section 47 of the Patents Act is amended —

(a) by deleting the word “whether” in subsection (4) and substituting the word “either”;

30 (b) by inserting, immediately after the word “entitled” in subsection (5)(b), the words “(either alone or with other persons, as the case may be)”;

- (c) by deleting the words “more properly be determined” in subsection (8) and substituting the words “be more conveniently dealt with”; and
- (d) by deleting subsection (9) and substituting the following subsection: 5

“(9) The court must not determine a question whether a patent was granted to a person not entitled to be granted the patent —

(a) in the exercise of any such declaratory jurisdiction in an action for a declaration; 10
or

(b) in the exercise of jurisdiction pursuant to a reference under this section,

if the action or the reference (as the case may be) was commenced or made after the end of the period of 15
2 years beginning with the date of the grant of the patent, unless it is shown that any person registered as a proprietor of the patent knew at the time of the grant or, as the case may be, of the transfer of the patent to the person that the person was not entitled (either 20
alone or with other persons, as the case may be) to the patent.”.

Amendment of section 67

13. Section 67 of the Patents Act is amended —

- (a) by deleting subsections (3), (4) and (5) and substituting the following subsection: 25

“(3) In this Act, unless the context otherwise requires, any reference to a plaintiff includes a reference to the proprietor of the patent.”; and

- (b) by deleting the words “or the Registrar” in subsection (6). 30

Amendment of section 69

14. Section 69 of the Patents Act is amended —

- 5 (a) by deleting the words “or the Registrar may, if it or he” in subsection (3) and substituting the words “may, if the court”;
- (b) by deleting the words “, in proceedings before the court,” in subsections (3) and (4); and
- (c) by deleting the words “or the Registrar” wherever they appear in subsection (4).

10 **Amendment of section 70**

15 15. Section 70 of the Patents Act is amended —

- (a) by deleting the words “or the Registrar” wherever they appear in subsections (1), (2) and (3); and
- (b) by deleting the words “its or his” in subsection (3) and substituting the words “the court’s”.

Amendment of section 72

20 16. Section 72(2) of the Patents Act is amended by deleting the words “or the Registrar for infringement of the patent or” and substituting the words “for infringement of the patent or before the court or the Registrar”.

Amendment of sections 74 and 75

17. Sections 74(2) and 75 of the Patents Act are amended by deleting the words “or the Registrar” wherever they appear.

Amendment of section 76

25 18. Section 76 of the Patents Act is amended —

- (a) by deleting the words “or before the Registrar” in subsection (1);
- (b) by deleting the words “or the Registrar” wherever they appear in subsection (4); and

- (c) by deleting the words “it or he” wherever they appear in subsection (4) and substituting in each case the words “the court”.

Amendment of section 78

19. Section 78 of the Patents Act is amended —

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- (a) by deleting the words “or the Registrar” in subsection (1);
and
(b) by deleting subsection (2).

Amendment of section 80

20. Section 80 of the Patents Act is amended —

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- (a) by inserting, immediately before the words “the Registrar” in subsection (1), the words “the court or”;
- (b) by inserting, immediately after the word “entitled” in subsection (1)(b), the words “(either alone or with other persons)”;
- (c) by inserting, immediately before the words “the Registrar” in subsection (2), the words “the court or”;
- (d) by inserting, immediately before the word “Registrar” wherever it appears in subsection (3), the words “court or the”;
- (e) by inserting, immediately after the word “entitled” in subsection (4)(b), the words “(either alone or with other persons, as the case may be)”;
- (f) by deleting the word “Registrar” in subsection (5)(b) and substituting the words “court or the Registrar, as the case may be”;
- (g) by inserting, immediately before the words “the Registrar” in subsection (8), the words “the court or”;
- (h) by inserting, immediately after the word “application” in subsection (9), the words “to the Registrar”; and

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(i) by inserting, immediately after subsection (10), the following subsection:

“(11) Where an application is made to the Registrar under this section, the Registrar may at any stage of the proceedings refer the application to the court.”.

Amendment of section 81

21. Section 81 of the Patents Act is amended by inserting, immediately after the word “patents” in the section heading, the words “on own initiative”.

Amendment of section 82

22. Section 82 of the Patents Act is amended —

(a) by inserting, immediately before paragraph (a) of subsection (1), the following paragraph:

“(aa) in a request for re-examination of the specification of a patent under section 38A;”;

(b) by inserting, immediately after the word “before” in subsection (1)(d), the words “the court or”;

(c) by inserting, immediately after the word “entitled” in subsection (4)(b), the words “(either alone or with other persons, as the case may be)”;

(d) by inserting, immediately after the word “entitled” in subsection (6), the words “(either alone or with other persons)”;

(e) by deleting the words “67(3), 76, 78 or” in subsection (7).

Amendment of section 83

23. Section 83 of the Patents Act is amended by inserting, immediately after the word “proceedings” in the section heading, the word “, etc.”.

Amendment of section 90

24. Section 90 of the Patents Act is amended —

(a) by inserting, immediately after paragraph (c) of subsection (1), the following paragraphs:

“(ca) a decision under section 38A(4) not to grant a request for re-examination; 5

(cb) a decision under section 38A not to revoke a patent;”; and

(b) by deleting the words “67, 80, 81 or 83” in subsection (3)(a) and substituting the words “80, 81 or 83, or was a decision to revoke a patent given under section 38A”. 10

Amendment of section 103

25. Section 103 of the Patents Act is amended —

(a) by deleting subsection (1) and substituting the following subsection: 15

“(1) The Registrar or any person authorised in writing by the Registrar may compound any offence under this Act that is prescribed as a compoundable offence by collecting from a person reasonably suspected of having committed the offence a sum not exceeding the lower of the following: 20

(a) one half of the amount of the maximum fine that is prescribed for the offence;

(b) \$5,000.”; and 25

(b) by deleting subsection (4) and substituting the following subsection:

“(4) All sums collected under this section must be paid into the Consolidated Fund.”.

PART 6

AMENDMENTS TO PLANT VARIETIES PROTECTION ACT

Amendment of section 48

5 **26.** Section 48 of the Plant Varieties Protection Act (Cap. 232A) is amended by inserting, immediately after subsection (2), the following subsection:

10 “(3) An appeal does not lie to the Court of Appeal from a decision of the Court on appeal from a decision of the Registrar for any matter under this Act unless leave to appeal is given by the Court or the Court of Appeal.”.

Amendment of section 52

27. Section 52 of the Plant Varieties Protection Act is amended —

(a) by deleting subsection (1) and substituting the following subsection:

15 “(1) The Registrar or any person authorised in writing by the Registrar may compound any offence under this Act that is prescribed as a compoundable offence by collecting from a person reasonably suspected of having committed the offence a sum not exceeding the lower of the following:

20 (a) one half of the amount of the maximum fine that is prescribed for the offence;

(b) \$5,000.”; and

25 (b) by deleting subsection (3) and substituting the following subsection:

 “(3) All sums collected under this section must be paid into the Consolidated Fund.”.

PART 7

AMENDMENTS TO REGISTERED DESIGNS ACT

Amendment of section 43

28. Section 43 of the Registered Designs Act (Cap. 266) is amended by deleting subsections (1) and (2) and substituting the following subsections: 5

“(1) If in any proceedings before the Registrar or the Court the validity of the registration of a design is contested, and the Registrar or the Court finds that the registration of the design is valid, the Registrar or the Court may certify the finding and the fact that the validity of the registration was so contested. 10

(2) Where a certificate is given under subsection (1) and in subsequent proceedings for infringement of the design or for revocation of the registration of the design before the Registrar or the Court — 15

(a) the validity of the registration is again questioned; and

(b) the registered owner obtains a final order or judgment in the registered owner’s favour relying on the validity of the registration as found in the earlier proceedings, 20

the registered owner is entitled to the registered owner’s costs as between solicitor and client unless the Registrar or the Court directs otherwise.”.

Amendment of section 62

29. Section 62 of the Registered Designs Act is amended by inserting, immediately after subsection (2), the following subsection: 25

“(2A) An appeal does not lie to the Court of Appeal from a decision of the Court on appeal from a decision or order of the Registrar under this Act unless leave to appeal is given by the Court or the Court of Appeal.”. 30

Amendment of section 68

30. Section 68 of the Registered Designs Act is amended —

(a) by deleting subsection (1) and substituting the following subsection:

5 “(1) The Registrar or any person authorised in writing by the Registrar may compound any offence under this Act that is prescribed as a compoundable offence by collecting from a person reasonably suspected of having committed the offence a sum not exceeding the lower of the following:

10 (a) one half of the amount of the maximum fine that is prescribed for the offence;

(b) \$5,000.”; and

15 (b) by deleting subsection (4) and substituting the following subsection:

“(4) All sums collected under this section must be paid into the Consolidated Fund.”.

PART 8

AMENDMENTS TO STATE COURTS ACT

20 **Amendment of section 19**

31. Section 19(3) of the State Courts Act (Cap. 321) is amended by deleting the word “and” at the end of paragraph (c), and by inserting immediately thereafter the following paragraph:

25 “(ca) any jurisdiction to hear and try an action in passing off; and”.

Amendment of section 52

32. Section 52(1A) of the State Courts Act is amended by inserting, immediately after paragraph (a), the following paragraph:

“(aa) the action is in passing off;”.

PART 9

AMENDMENTS TO TRADE MARKS ACT

Amendment of section 75

33. Section 75 of the Trade Marks Act (Cap. 332) is amended by inserting, immediately after subsection (3), the following subsection: 5

“(4) An appeal does not lie to the Court of Appeal from a decision of the Court on appeal from a decision of the Registrar for any matter under this Act or the rules made under this Act unless leave to appeal is given by the Court or the Court of Appeal.”. 10

Amendment of section 102

34. Section 102 of the Trade Marks Act is amended by deleting subsections (1) and (2) and substituting the following subsections:

“(1) If in any proceedings before the Registrar or the Court the validity of the registration of a trade mark to any extent is contested and it is found by the Registrar or the Court that the registration of the trade mark is wholly or partially valid, the Registrar or the Court may give a certificate to that effect and the fact that the validity of the registration was so contested. 15

(2) Where a certificate is given under subsection (1) and in subsequent proceedings before the Registrar or the Court — 20

(a) the validity of the registration is again questioned; and

(b) the proprietor obtains a final order or judgment in the proprietor’s favour relying on the validity of the registration as found in the earlier proceedings, 25

the proprietor is entitled to the proprietor’s costs as between solicitor and client unless the Registrar or the Court directs otherwise.”.

Amendment of section 105A

35. Section 105A of the Trade Marks Act is amended — 30

(a) by deleting subsection (1) and substituting the following subsection:

“(1) The Registrar or any person authorised in writing by the Registrar may compound any offence under this Act that is prescribed as a compoundable offence by collecting from a person reasonably suspected of having committed the offence a sum not exceeding the lower of the following:

(a) one half of the amount of the maximum fine that is prescribed for the offence;

(b) \$5,000.”; and

(b) by deleting subsection (4) and substituting the following subsection:

“(4) All sums collected under this section must be paid into the Consolidated Fund.”.

PART 10

SAVING AND TRANSITIONAL PROVISIONS

Transitional provisions relating to amendments to Arbitration Act

36.—(1) Section 2 applies to arbitral proceedings to which the Arbitration Act applies that are commenced on or after the date of commencement of that section, but the parties may in writing agree that that section applies to arbitral proceedings commenced before that date.

(2) Despite subsection (1), where the arbitral proceedings were commenced before the date of commencement of section 2, the law governing the arbitration agreement and the arbitration is the law which would have applied if that section had not been enacted.

(3) For the purposes of subsections (1) and (2), arbitral proceedings are taken as having commenced on the date of the receipt by the respondent of a request for the dispute to be referred to arbitration or, where the parties have agreed in writing that any other date is to be taken as the date of commencement of the arbitral proceedings, then on that date.

Saving and transitional provisions relating to amendments to Copyright Act

37.—(1) Despite section 4(*a*) and (*b*), sections 119, 120, 120A, 124, 126 and 127 of the Copyright Act as in force immediately before the date of commencement of section 4(*a*) and (*b*) continue to apply to or in relation to any action for infringement of copyright brought under section 119 of that Act before that date. 5

(2) Despite section 4(*b*), section 130 of the Copyright Act as in force immediately before the date of commencement of section 4(*b*) continues to apply to or in relation to any action brought under Part V of that Act before that date. 10

(3) Despite section 4(*c*) and (*d*), sections 140H(3) and 140I of the Copyright Act as in force immediately before the date of commencement of section 4(*c*) and (*d*) continue to apply to or in relation to any action for infringement of copyright instituted before that date. 15

(4) Despite section 4(*c*), section 140IA of the Copyright Act as in force immediately before the date of commencement of section 4(*c*) continues to apply to or in relation to any application made before that date to a court for an order of compensation under section 140IA of that Act. 20

(5) Despite section 4(*e*), section 140K(1) of the Copyright Act as in force immediately before the date of commencement of section 4(*e*) continues to apply to or in relation to any action for infringement of copyright brought before that date in respect of seized copies of copyright material. 25

(6) Despite section 4(*e*), section 140L of the Copyright Act as in force immediately before the date of commencement of section 4(*e*) continues to apply to or in relation to any expenses incurred in relation to any action taken in accordance with an order of court, if the order arose from an action for infringement of copyright brought or instituted before that date. 30

(7) Despite section 4(*f*), section 140LA of the Copyright Act as in force immediately before the date of commencement of section 4(*f*)

continues to apply to or in relation to any action for infringement of copyright instituted before that date in respect of detained copies.

5 (8) Despite section 4(*g*), section 140LG of the Copyright Act as in force immediately before the date of commencement of section 4(*g*) continues to apply to or in relation to any action for infringement of copyright instituted before that date in respect of seized copies.

10 (9) Despite section 4(*g*), section 140LI of the Copyright Act as in force immediately before the date of commencement of section 4(*g*) continues to apply to or in relation to any application made before that date for an order of compensation under section 140LI of that Act.

15 (10) Despite section 4(*h*), section 140LL of the Copyright Act as in force immediately before the date of commencement of section 4(*h*) continues to apply to or in relation to any expenses incurred in relation to any action taken in accordance with an order of court, if the order arose from an action for infringement of copyright instituted before that date in respect of seized copies.

20 (11) Despite section 4(*j*), (*k*) and (*l*), section 192 of the Copyright Act as in force immediately before the date of commencement of section 4(*j*), (*k*) and (*l*) continues to apply to or in relation to any action brought before that date for a breach of duty under Part IX of that Act.

25 (12) Despite section 4(*n*), sections 193B, 193C, 193D, 193DB and 193DC of the Copyright Act as in force immediately before the date of commencement of section 4(*n*) continue to apply to or in relation to any action brought before that date against a network service provider for infringement of copyright.

30 (13) Despite section 4(*p*) and (*q*), section 200 of the Copyright Act as in force immediately before the date of commencement of section 4(*p*) and (*q*) continues to apply to or in relation to any action brought before that date for an unjustifiable threat of legal proceedings in respect of an infringement of copyright.

(14) Despite section 4(*s*), sections 252A, 252B, 252C, 252CB and 252CC of the Copyright Act as in force immediately before the date of commencement of section 4(*s*) continue to apply to or in relation to

any action brought before that date against a network service provider for an unauthorised use of a performance.

(15) Despite section 4(*u*) and (*v*), sections 253 and 254 of the Copyright Act as in force immediately before the date of commencement of section 4(*u*) and (*v*) continue to apply to or in relation to any action for an unauthorised use of a performance brought before that date.

5

(16) Despite section 4(*w*) and (*x*), sections 260 and 261 of the Copyright Act as in force immediately before the date of commencement of section 4(*w*) and (*x*) continue to apply to or in relation to any action under section 260(2), (3) or (4) of that Act brought before that date.

10

(17) Despite section 4(*y*) and (*z*), sections 261C(2) and 261F of the Copyright Act as in force immediately before the date of commencement of section 4(*y*) and (*z*) continue to apply to or in relation to any action brought before that date for a contravention of section 261C(1) of that Act.

15

Saving and transitional provisions relating to amendments to Geographical Indications Act 2014

38.—(1) Section 5 does not apply to or in relation to any decision of the Registrar of Geographical Indications arising from an application, opposition, request for qualification or other proceeding made or filed before the date of commencement of that section.

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(2) Section 6 does not apply to or in relation to any proceedings commenced before the date of commencement of that section before the Registrar of Geographical Indications.

25

(3) Despite section 7, section 81 of the Geographical Indications Act 2014 as in force immediately before the date of commencement of section 7 continues to apply to or in relation to any offence under that Act committed before that date.

30

Transitional provisions relating to amendments to International Arbitration Act

39.—(1) Section 8 applies to arbitral proceedings to which the International Arbitration Act applies that are commenced on or after

the date of commencement of that section, but the parties may in writing agree that that section applies to arbitral proceedings commenced before that date.

5 (2) Despite subsection (1), where the arbitral proceedings were commenced before the date of commencement of section 8, the law governing the arbitration agreement and the arbitration is the law which would have applied if that section had not been enacted.

10 (3) For the purposes of subsections (1) and (2), arbitral proceedings are to be taken as having commenced on the date of the receipt by the respondent of a request for the dispute to be referred to arbitration or, where the parties have agreed in writing that any other date is to be taken as the date of commencement of the arbitral proceedings, then on that date.

15 **Saving and transitional provisions relating to amendments to Patents Act**

40.—(1) Despite section 9(c), section 20(7) of the Patents Act as in force immediately before the date of commencement of section 9(c) continues to apply to or in relation to any reference of a question made under section 20(1) of that Act before that date.

20 (2) Section 10 applies to any application for a patent that has been published, whether published before, on or after the date of commencement of that section.

(3) Section 11 applies to any patent, whether granted before, on or after the date of commencement of that section.

25 (4) Despite section 12(c), section 47(8) of the Patents Act as in force immediately before the date of commencement of section 12(c) continues to apply to or in relation to any reference of a question made under section 47(1) of that Act before that date.

30 (5) Section 12(d) does not apply to any proceedings of the High Court pursuant to a reference made under section 47(1) of the Patents Act before the date of commencement of section 12(d).

(6) Despite section 13, section 67 of the Patents Act as in force immediately before the date of commencement of section 13

continues to apply to or in relation to any reference made under section 67(3) of that Act before that date.

(7) Despite section 14, section 69 read with section 67(4)(a) of the Patents Act as in force immediately before the date of commencement of section 14 continues to apply to or in relation to any reference made under section 67(3) of that Act before that date.

5

(8) Despite section 15, section 70 read with section 67(4)(a) of the Patents Act as in force immediately before the date of commencement of section 15 continues to apply to or in relation to any reference made under section 67(3) of that Act before that date.

10

(9) Despite section 16, section 72(2) read with section 67(4)(a) of the Patents Act as in force immediately before the date of commencement of section 16 continues to apply to or in relation to any reference made under section 67(3) of that Act before that date.

(10) Despite section 17, sections 74(2) and 75 read with section 67(4)(a) of the Patents Act as in force immediately before the date of commencement of section 17 continue to apply to or in relation to any reference made under section 67(3) of that Act before that date.

15

(11) Despite section 18, section 76 read with section 67(4)(a) of the Patents Act as in force immediately before the date of commencement of section 18 continues to apply to or in relation to any reference under section 67(3) of that Act made by an applicant for a patent before that date.

20

(12) Despite section 19(a), section 78 of the Patents Act as in force immediately before the date of commencement of section 19(a) continues to apply to any proceedings before the Registrar for a declaration of non-infringement commenced under section 78 of that Act before that date.

25

(13) Despite section 19(b), section 78(2) of the Patents Act as in force immediately before the date of commencement of section 19(b) continues to apply to any declaration made by the Registrar under section 78(1) of that Act —

30

(a) before that date; or

(b) in any proceedings mentioned in subsection (12).

(14) Section 20(i) does not apply to any application for revocation of a patent made under section 80(1) of the Patents Act before the date of commencement of section 20(i).

5 (15) Despite section 24(b), section 90(3) of the Patents Act as in force immediately before the date of commencement of section 24(b) continues to apply to or in relation to any reference made under section 67(3) of that Act before that date.

10 (16) Despite section 25(a), section 103(1) of the Patents Act as in force immediately before the date of commencement of section 25(a) continues to apply to or in relation to any offence under that Act committed before that date.

Transitional provisions relating to amendments to Plant Varieties Protection Act

15 **41.**—(1) Section 26 does not apply to or in relation to any decision of the Registrar of Plant Varieties arising from an application or other proceeding made or filed before the date of commencement of that section.

20 (2) Despite section 27(a), section 52(1) of the Plant Varieties Protection Act as in force immediately before the date of commencement of section 27(a) continues to apply to or in relation to any offence under that Act committed before that date.

Saving and transitional provisions relating to amendments to Registered Designs Act

25 **42.**—(1) Section 28 does not apply to or in relation to any proceedings commenced before the date of commencement of that section before the Registrar of Designs.

30 (2) Section 29 does not apply to or in relation to any decision or order of the Registrar of Designs arising from an application or other proceeding made or filed before the date of commencement of that section.

(3) Despite section 30(a), section 68(1) of the Registered Designs Act as in force immediately before the date of commencement of

section 30(a) continues to apply to or in relation to any offence under that Act committed before that date.

Saving and transitional provisions relating to amendments to State Courts Act

43.—(1) Section 31 does not apply to or in relation to any action in passing off for which a writ of summons or other originating process or counterclaim was filed in the District Court before the date of commencement of that section. 5

(2) Section 32 does not apply to or in relation to any action in passing off for which a writ of summons or other originating process or counterclaim was filed in the Magistrate’s Court before the date of commencement of that section. 10

Saving and transitional provisions relating to amendments to Trade Marks Act

44.—(1) Section 33 does not apply to or in relation to any decision of the Registrar of Trade Marks arising from an application, opposition or other proceeding made or filed before the date of commencement of that section. 15

(2) Section 34 does not apply to or in relation to any proceedings commenced before the date of commencement of that section before the Registrar of Trade Marks. 20

(3) Despite section 35(a), section 105A(1) of the Trade Marks Act as in force immediately before the date of commencement of section 35(a) continues to apply to or in relation to any offence under that Act committed before that date. 25

Additional saving and transitional provisions

45. For a period of 2 years after the date of commencement of any provision of this Act, the Minister may, by regulations, prescribe such additional provisions of a saving or transitional nature consequent on the enactment of that provision as the Minister may consider necessary or expedient. 30

EXPLANATORY STATEMENT

This Bill seeks to amend the Arbitration Act (Cap. 10) and the International Arbitration Act (Cap. 143A) to clarify that intellectual property disputes may be arbitrated, and to make amendments relating to intellectual property dispute resolution and other related matters and the composition of offences to several Acts.

Part 1 contains amendments to the Arbitration Act.

Part 2 contains amendments to the Copyright Act (Cap. 63) to make the High Court the exclusive forum to hear civil proceedings for most copyright matters.

Part 3 contains amendments to the Geographical Indications Act 2014 (Act 19 of 2014).

Part 4 contains amendments to the International Arbitration Act.

Part 5 contains amendments to the Patents Act (Cap. 221) for the following main purposes:

- (a) to provide in the new section 32 for a process to make observations on the patentability of an invention in a patent application;
- (b) to provide in the new section 38A for a process to file a request for the Registrar to conduct re-examination of the specification of a patent;
- (c) to give the High Court original jurisdiction under section 80 to revoke a patent, where the application for revocation does not arise in any of the contexts specified in section 82(1)(a), (b), (c) or (e);
- (d) to remove the Registrar's jurisdiction in section 67 to determine the question whether a person has infringed a patent;
- (e) to remove the Registrar's jurisdiction in section 78 to make a declaration that an act does not, or a proposed act would not, constitute an infringement of a patent.

Part 6 contains amendments to the Plant Varieties Protection Act (Cap. 232A).

Part 7 contains amendments to the Registered Designs Act (Cap. 266).

Part 8 contains amendments to the State Courts Act (Cap. 321) to remove the jurisdiction of the District Court and the Magistrate's Court to hear and try an action in passing off.

Part 9 contains amendments to the Trade Marks Act (Cap. 332).

Part 10 contains saving and transitional provisions.

Clause 1 relates to the short title and commencement.

PART 1

AMENDMENTS TO ARBITRATION ACT

Clause 2 inserts a new Part IXA in the Arbitration Act, containing new sections 52A to 52F.

The new section 52A provides the definitions of “intellectual property right” or “IPR”, “IPR dispute”, and “registration”, which are used in the new Part IXA.

The new section 52B(1) clarifies that the subject-matter of an IPR dispute is capable of settlement by arbitration as between the parties to the IPR dispute. The resulting arbitral award binds only the parties to the IPR dispute, and does not affect third parties.

The new section 52B(2) clarifies that the new section 52B(1) applies whether the IPR dispute is the main issue or an incidental issue in the arbitration.

The new section 52B(3) clarifies that an IPR dispute is not incapable of settlement by arbitration only because a law of Singapore or elsewhere —

- (a) gives jurisdiction to decide the IPR dispute to a specified entity; and
- (b) does not mention possible settlement of the IPR dispute by arbitration.

The new section 52B(4) defines “specified entity” as used in the new section 52B(3).

The new section 52C(2) clarifies that the fact that a person is a third-party licensee or third-party holder of a security interest in respect of the IPR does not of itself make the person a person claiming through or under a party to the arbitral proceedings for the purposes of section 44(1).

The new section 52C(3) clarifies that the new section 52C(2) does not affect any right or liability between a third-party licensee or third-party holder of a security interest and a party to the arbitral proceedings whether arising in contract or arising by operation of law.

The new section 52C(4) defines the terms “third-party holder of a security interest” and “third-party licensee” as used in the section.

The new section 52D(1) clarifies that for the purposes of section 48(1)(b)(i), the subject-matter of a dispute is not incapable of settlement by arbitration under the Act only because the subject-matter relates to an IPR dispute.

The new section 52D(2) clarifies that for the purposes of section 48(1)(b)(ii), an award is not contrary to public policy only because the subject-matter in respect of which the award is made relates to an IPR dispute.

The new section 52E clarifies the effect of —

- (a) an award deciding an IPR dispute being made in arbitral proceedings; and

(b) a judgment in terms of the award being entered under section 46.

The new section 52E(2) clarifies that in this case, section 44(1) applies in relation to the judgment as if the reference in section 44(1) to an award made by an arbitral tribunal pursuant to an arbitration agreement were a reference to the judgment. As a result, the judgment is final and binding on the parties (*in personam* and not *in rem*) and on any person claiming through or under them and may be relied upon by any of the parties by way of defence, set-off or otherwise in any proceedings in any court of competent jurisdiction. The judgment does not affect third parties.

The new section 52E(3) clarifies that in the new section 52E, “award” includes a declaratory award.

The new section 52F provides that section 82(2) of the Patents Act does not prevent a party from putting the validity of a patent in issue in arbitral proceedings.

PART 2

AMENDMENTS TO COPYRIGHT ACT

Clause 3 inserts a new definition of “Court” in section 7(1), which provides that the term “Court” used in the Copyright Act means the High Court.

Clause 4 makes miscellaneous amendments throughout the Copyright Act, principally to make the High Court the exclusive forum to hear civil proceedings for most copyright matters. Clause 4(g) and (h) amends the new sections 140LB, 140LG, 140LI and 140LL as inserted by section 25 of the Intellectual Property (Border Enforcement) Act 2018 (Act 34 of 2018) when that section is brought into operation.

PART 3

AMENDMENTS TO GEOGRAPHICAL INDICATIONS ACT 2014

Clause 5 amends section 32 to provide that a decision of the High Court on appeal from a decision of the Registrar of Geographical Indications (the Registrar), is not appealable to the Court of Appeal unless leave to appeal is given by the High Court or the Court of Appeal.

Clause 6(a) amends section 76(1) to provide that the Registrar may give a certificate of validity of contested registration, if in a proceeding before the Registrar the validity of the registration of a geographical indication is contested, and the geographical indication is found to be validly registered.

Clause 6(b) replaces section 76(2) to provide that where a certificate of validity of contested registration is given under section 76(1), and in subsequent proceedings before the Registrar or the High Court —

- (a) the validity of the registration is again questioned; and
- (b) the registrant obtains a final order or judgment in the registrant's favour relying on the validity of the registration as found in the earlier proceedings,

the registrant is entitled to be indemnified as to the registrant's costs as between solicitor and client in the subsequent proceedings unless the Registrar or the High Court directs otherwise.

Clause 7 amends section 81(1)(b) to increase the maximum composition amount to \$5,000.

PART 4

AMENDMENTS TO INTERNATIONAL ARBITRATION ACT

Clause 8 inserts a new Part IIA in the International Arbitration Act, containing new sections 26A to 26G.

The new section 26A provides the definitions of “intellectual property right” or “IPR”, “IPR dispute”, and “registration”, which are used in the new Part IIA.

The new section 26B(1) clarifies that the subject-matter of an IPR dispute is capable of settlement by arbitration as between the parties to the IPR dispute. The resulting arbitral award binds only the parties to the IPR dispute, and does not affect third parties.

The new section 26B(2) clarifies that the new section 26B(1) applies whether the IPR dispute is the main issue or an incidental issue in the arbitration.

The new section 26B(3) clarifies that an IPR dispute is not incapable of settlement by arbitration only because a law of Singapore or elsewhere —

- (a) gives jurisdiction to decide the IPR dispute to a specified entity; and
- (b) does not mention possible settlement of the IPR dispute by arbitration.

The new section 26B(4) defines “specified entity” as used in the new section 26B(3).

The new section 26C(2) clarifies that the fact that a person is a third-party licensee or third-party holder of a security interest in respect of the IPR does not of itself make the person a person claiming through or under a party to the arbitral proceedings for the purposes of section 19B(1).

The new section 26C(3) clarifies that the new section 26C(2) does not affect any right or liability between a third-party licensee or third-party holder of a security interest and a party to the arbitral proceedings whether arising in contract or arising by operation of law.

The new section 26C(4) defines the terms “third-party holder of a security interest” and “third-party licensee” as used in the section.

The new section 26D(1) clarifies that for the purposes of Article 34(2)(b)(i) of the Model Law, the subject-matter of a dispute is not incapable of settlement by arbitration under the law of Singapore only because the subject-matter relates to an IPR dispute.

The new section 26D(2) clarifies that for the purposes of Article 34(2)(b)(ii) of the Model Law, an award is not in conflict with the public policy of Singapore only because the subject-matter in respect of which the award is made relates to an IPR dispute.

The new section 26E(1) clarifies that for the purposes of section 31(4)(a), the subject-matter of the difference between the parties to a foreign award is not incapable of settlement by arbitration under the law of Singapore only because the subject-matter relates to an IPR dispute.

The new section 26E(2) clarifies that for the purposes of section 31(4)(b), it is not contrary to the public policy of Singapore to enforce an award only because the award is in respect of a subject-matter that relates to an IPR dispute.

The new section 26F clarifies the effect of —

- (a) an award (whether made in or outside Singapore) deciding an IPR dispute being made in arbitral proceedings; and
- (b) a judgment in terms of the award being entered under section 19 or 29.

The new section 26F(2) clarifies that in this case, sections 19B(1) and 29(2) apply in relation to the judgment as if —

- (a) the reference in section 19B(1) to an award made by an arbitral tribunal pursuant to an arbitration agreement were a reference to the judgment; and
- (b) the reference in section 29(2) to a foreign award were a reference to the judgment.

As a result, the judgment is final and binding on the parties (*in personam* and not *in rem*) (and on any person claiming through or under them in a case mentioned in the new section 29F(2)(a)) and may be relied upon by any of the parties by way of defence, set-off or otherwise in any proceedings in any court of competent jurisdiction. The judgment does not affect third parties.

The new section 26F(3) clarifies that in the new section 26F, “award” includes a declaratory award.

The new section 26G provides that section 82(2) of the Patents Act does not prevent a party from putting the validity of a patent in issue in arbitral proceedings.

PART 5

AMENDMENTS TO PATENTS ACT

Clause 9(a) inserts in section 20(1)(a) the word “either” in the phrase “(alone or with any other persons)” to clarify the meaning of the phrase “entitled to be granted”. Under the amended section 20(1)(a), any person may refer to the Registrar of Patents (the Registrar) the question whether the person is entitled to be granted (either alone or with any other persons) a patent. This does not change the meaning or intent of section 20(1)(a).

Clause 9(b) replaces in section 20(6) the word “whether” in the phrase “(whether alone or with any other persons)” with the word “either” to clarify the meaning of the phrase “entitled to be granted”. As amended, section 20(6) refers to the situation where it is alleged on a reference that any person other than the inventor or the applicant for the patent has become entitled to be granted (either alone or with any other persons) a patent for the invention, or has or would have any right in or under any patent so granted or any application for such a patent. There is no change to the meaning or intent of section 20(6). These amendments are being made for consistency with a similar set of amendments being made to sections 47(4), (5)(b) and (9), 80(1)(b) and (4)(b) and 82(4)(b) and (6).

Clause 9(c) amends section 20(7) such that when a question is referred to the Registrar under that section, the Registrar may decline to deal with it if it appears to the Registrar that the question involves a matter which would be more conveniently dealt with by the High Court.

Clause 10 inserts a new section 32 to provide for a process to make observations on the patentability of an invention in a patent application.

The new section 32(1) provides that where an application for a patent has been published, any other person may make observations in writing to the Registrar on the question whether the invention is a patentable invention, stating reasons for the observations. The Registrar must, subject to the new section 32(2), consider the observations in accordance with the rules.

The new section 32(2) provides that the observations must be received by the Registrar before the Registrar sends to the patent applicant a copy of an examination report under section 29(4), a copy of a search and examination report under section 29(5), or a copy of a supplementary examination report under section 29(6).

The new section 32(3) provides that a person does not become a party to any proceedings before the Registrar by reason only that the person makes observations under the new section 32.

Clause 11 inserts a new section 38A to provide for a new process to file a request for the Registrar to conduct a re-examination of the specification of a patent. This provides for a new process through which a patent may be revoked

under grounds similar to the grounds of revocation under section 80(1). This process is *ex parte*, unlike an application for revocation under section 80 which is an *inter partes* process. Unlike section 80, the new section 38A option enables a person to challenge the validity of a patent specifically through re-examination of the specification by an Examiner.

The new section 38A(1) provides that any person may, at any time after a patent is granted, file a request for the Registrar to conduct a re-examination of the specification of a patent for an invention on any of the grounds in the new section 38A(1)(a) to (g).

The new section 38A(3) provides that the Registrar may reject any request that fails to comply with any of the formal requirements for filing a request set out in the new section 38A(2).

The new section 38A(4) provides that the Registrar must not grant a request under the new section 38A(1) if the Registrar is of the view that the request is frivolous, vexatious or an abuse of the process.

The new section 38A(5) provides that no request under the new section 38A(1) may be filed where there are pending before the High Court or the Registrar any proceedings in which the validity of the same patent may be put in issue.

The new section 38A(6) provides that where proceedings before the High Court or the Registrar, in which the validity of the same patent may be put in issue, are filed after a request under the new section 38A(1) is made, the Registrar may make such order or give such direction as the Registrar thinks fit concerning the request.

The new section 38A(7) provides that where the Registrar grants a request under the new section 38A(1), the Registrar must cause the specification of the patent to be re-examined by an Examiner so as to determine whether the ground specified in the request is made out.

The new section 38A(8) provides that if it appears to the Examiner during the re-examination of the specification of the patent that the ground specified in the request is made out, or that based on any document submitted under the new section 38A(2)(c)(ii) any other ground mentioned in the new section 38A(1) is made out, the Examiner must give the proprietor of the patent a written opinion to that effect. The Registrar must, upon receiving the written opinion, send the proprietor a copy of the written opinion.

The new section 38A(9) provides that the proprietor of the patent must respond to the written opinion in the prescribed manner and within the prescribed period.

The new section 38A(10) provides that upon receiving the re-examination report prepared by the Examiner, the Registrar must send to the proprietor of the patent a copy of the report.

The new section 38A(11) provides that where the re-examination report issued under that section contains one or more unresolved objections (being an objection mentioned in the written opinion), the Registrar must make an order revoking the patent.

The new section 38A(12) provides that such an order for revocation may be —

- (a) an order for the unconditional revocation of the patent; or
- (b) where one of the grounds mentioned in the new section 38A(1) has been established, but only so as to invalidate the patent to a limited extent, an order that the patent should be revoked unless within a specified time the specification is amended under section 83 to the satisfaction of the Registrar.

The new section 38A(13) provides that a decision of the Registrar or on appeal from the Registrar does not estop any party to any civil proceedings in which infringement of a patent is in issue from alleging invalidity of the patent on any of the grounds mentioned in the new section 38A(1), whether or not any of the issues involved were decided in the decision.

The new section 38A(14) provides that a decision of the Registrar to revoke a patent under that section has effect from the date of the grant of the patent.

The new section 38A(15) provides that a person does not become a party to any proceedings before the Registrar by reason only that the person files a request under the new section 38A(1), unless the person is the proprietor of the patent. This makes the section 38A process an *ex parte* process, where the requesting party is not involved after filing the request.

Clause 12(a) replaces in section 47(4) the word “whether” in the phrase “(whether alone or with other persons)” with the word “either” to clarify the meaning of the phrase “not entitled to be granted that patent”. There is no change to the intent or meaning of section 47(4). As amended, section 47(4) refers to the situation where the Registrar finds, on a reference under that section, that either —

- (a) the patent was granted to a person not entitled to be granted that patent alone; or
- (b) the patent was granted to a person not entitled to be granted that patent with other persons.

Clause 12(b) inserts in section 47(5)(b) the words “(either alone or with other persons, as the case may be)” after the word “entitled” to clarify the meaning of the phrase “not entitled to the patent” in section 47(5).

Clause 12(c) amends section 47(8) such that when a question is referred to the Registrar under that section, the Registrar may decline to deal with it if it appears to the Registrar that the question would be more conveniently dealt with by the High Court.

Clause 12(d) deletes and substitutes section 47(9). The new section 47(9) is different from the existing section 47(9) in 2 ways. First, the words “(either alone or with other persons, as the case may be)” have been inserted after the word “entitled” to clarify the meaning of the phrase “not entitled to the patent”. There is no change in meaning, as the meaning of the amended phrase is consistent with the interpretation of the original phrase “not entitled to the patent” in the existing section 47(9) given by the Court of Appeal in *Cicada Cube Pte Ltd v National University Hospital (Singapore) Pte Ltd* [2018] SGCA 52 @ ¶57.

Second, the new section 47(9) sets out the 2 scenarios under which the High Court may possibly exercise jurisdiction to determine a question whether a patent was granted to a person not entitled to be granted the patent, and provides for a different time bar to apply to each scenario. Under the new section 47(9), the High Court must not determine a question whether a patent was granted to a person not entitled to be granted the patent —

- (a) in the exercise of any declaratory jurisdiction to determine any question in an action for a declaration; or
- (b) in the exercise of jurisdiction pursuant to a reference to the Registrar under section 47,

if the action or the reference (as the case may be) was commenced or made after the end of the period of 2 years beginning with the date of the grant of the patent, unless it is shown that the proprietor of the patent knew at the time of the grant or transfer of the patent that the proprietor was not entitled (either alone or with other persons, as the case may be) to the patent.

In particular, the time bar applicable to the scenario in the new section 47(9)(b) represents a change from the existing position in law in the decision of the Court of Appeal in *Cicada Cube Pte Ltd v National University Hospital (Singapore) Pte Ltd* [2018] SGCA 52 @ ¶37 & 44.

Clause 13 amends section 67 to remove the Registrar’s jurisdiction to determine the question of whether a person has infringed a patent, as referred by that person and the proprietor of the patent by agreement.

Clauses 14, 15, 16, 17 and 18 make related amendments to sections 69, 70, 72, 74 and 75, and 76, respectively, that are consequent on the amendments being made by clause 13 to section 67.

Clause 19 amends section 78 to remove the Registrar’s jurisdiction to make a declaration that an act does not, or a proposed act would not, constitute an infringement of a patent.

Clause 20(a) amends section 80(1) to give the High Court original jurisdiction to revoke a patent, where the application for revocation does not arise in any of the contexts specified in section 82(1)(a), (b), (c) or (e). Clause 20(c), (d), (f), (g) and (h) makes related amendments to section 80(2), (3), (5)(b), (8) and (9).

Clause 20(b) inserts in section 80(1)(b) the words “(either alone or with other persons)” after the word “entitled” to clarify the meaning of the phrase “not entitled to be granted that patent”. There is no change to the meaning or intent of section 80(1)(b). Under the amended section 80(1)(b), the court or the Registrar may, on application of any person, by order revoke a patent for an invention on the ground that either —

- (a) the patent was granted to a person who was not entitled to be granted that patent alone; or
- (b) the patent was granted to a person who was not entitled to be granted that patent with other persons.

Clause 20(e) inserts in section 80(4)(b) the words “(either alone or with other persons, as the case may be)” after the word “entitled” to clarify the meaning of the phrase “not entitled to the patent”, in line with the clarificatory amendment made to section 80(1)(b) by clause 20(b).

Clause 20(i) inserts a new section 80(11) to provide that where an application is made to the Registrar under section 80, the Registrar may at any stage of the proceedings refer the application to the High Court.

Clause 21 makes a clarificatory amendment to the heading of section 81.

Clause 22(a) amends section 82(1) by inserting a new paragraph (aa) to provide that the validity of a patent may be put in issue in a request for re-examination of the specification of a patent under the new section 38A.

Clause 22(b) makes a related amendment to section 82(1)(d) consequent on the amendments made by clause 20 to section 80.

Clause 22(c) inserts in section 82(4)(b) the words “(either alone or with other persons, as the case may be)” after the word “entitled” to clarify the meaning of the phrase “not entitled to the patent”, in line with the clarificatory amendments made to section 80(1)(b) and (4)(b) by clause 20(b) and (e).

Clause 22(d) inserts in section 82(6) the words “(either alone or with other persons)” after the word “entitled” to clarify the meaning of the phrase “not entitled to it”. There is no change to the meaning or intent of section 82(6). The ground for the reference under section 47(1) can be that either —

- (a) the patent was granted to a person not entitled to be granted that patent alone; or
- (b) the patent was granted to a person not entitled to be granted that patent with other persons.

Clause 22(e) makes a related amendment to section 82(7) that is consequent on the amendments to sections 67, 76 and 78 made by clauses 13, 18 and 19, respectively.

Clause 23 amends the section heading of section 83 to clarify the scope of that section.

Clause 24(a) amends section 90(1) to provide that the following decisions of the Registrar are not appealable to the High Court:

- (a) a decision under the new section 38A(4) not to grant a request for re-examination;
- (b) a decision under the new section 38A not to revoke a patent.

Clause 24(b) amends section 90(3)(a) to delete the reference to section 67 (related amendment arising from clause 13) and to provide that the High Court's decision on appeal from the Registrar's decision to revoke a patent made under the new section 38A, is appealable to the Court of Appeal (but only with leave of the High Court or Court of Appeal).

Clause 25(a) replaces section 103(1) with a standard provision for the composition of offences. The maximum composition amount is increased to the lower of half the maximum fine prescribed or \$5,000.

Clause 25(b) amends section 103(4) to provide that all sums collected under section 103 must be paid into the Consolidated Fund.

PART 6

AMENDMENTS TO PLANT VARIETIES PROTECTION ACT

Clause 26 inserts a new section 48(3) to provide that a decision of the High Court on appeal from a decision of the Registrar of Plant Varieties, is not appealable to the Court of Appeal unless leave to appeal is given by the High Court or the Court of Appeal.

Clause 27(a) replaces section 52(1) with a standard provision for the composition of offences. The maximum composition amount is increased to the lower of half the maximum fine prescribed or \$5,000.

Clause 27(b) amends section 52(3) to provide that all sums collected under section 52 must be paid into the Consolidated Fund.

PART 7

AMENDMENTS TO REGISTERED DESIGNS ACT

Clause 28 replaces section 43(1) and (2). The new section 43(1) additionally provides that the Registrar of Designs (the Registrar) may give a certificate of validity of contested registration, if in a proceeding before the Registrar the validity of the registration of a design is contested, and the design is found to be validly registered.

The new section 43(2) provides that where a certificate of validity of contested registration is given under the new section 43(1), and in subsequent proceedings before the Registrar or the High Court —

- (a) the validity of the registration is again questioned; and
- (b) the registered owner obtains a final order or judgment in the registered owner's favour relying on the validity of the registration as found in the earlier proceedings,

the registered owner is entitled to the registered owner's costs as between solicitor and client unless the Registrar or the High Court directs otherwise.

Clause 29 inserts a new section 62(2A), to provide that a decision of the High Court on appeal from a decision or order of the Registrar of Designs, is not appealable to the Court of Appeal unless leave to appeal is given by the High Court or the Court of Appeal.

Clause 30(a) replaces section 68(1) with a standard provision for the composition of offences. The maximum composition amount is increased to the lower of half the maximum fine prescribed or \$5,000.

Clause 30(b) amends section 68(4) to provide that all sums collected under section 68 must be paid into the Consolidated Fund.

PART 8

AMENDMENTS TO STATE COURTS ACT

Clause 31 amends section 19(3) to remove the jurisdiction of the District Court to hear and try an action in passing off.

Clause 32 amends section 52(1A) to remove the jurisdiction of the Magistrate's Court to hear and try an action in passing off.

PART 9

AMENDMENTS TO TRADE MARKS ACT

Clause 33 inserts a new section 75(4) to provide that a decision of the High Court on appeal from a decision of the Registrar of Trade Marks (the Registrar), is not appealable to the Court of Appeal unless leave to appeal is given by the High Court or the Court of Appeal.

Clause 34 replaces section 102(1) and (2). The new section 102(1) additionally provides that the Registrar may give a certificate of validity of contested registration, if in a proceeding before the Registrar the validity of the registration of a trade mark is contested, and it is found by the Registrar that the registration of the trade mark is wholly or partially valid.

The new section 102(2) provides that where a certificate of validity of contested registration is given under the new section 102(1), and in subsequent proceedings before the Registrar or the High Court —

- (a) the validity of the registration is again questioned; and
- (b) the proprietor obtains a final order or judgment in the proprietor's favour relying on the validity of the registration as found in the earlier proceedings,

the proprietor is entitled to the proprietor's costs as between solicitor and client unless the Registrar or the High Court directs otherwise.

Clause 35(a) replaces section 105A(1) with a standard provision for the composition of offences. The maximum composition amount is increased to the lower of half the maximum fine prescribed or \$5,000.

Clause 35(b) amends section 105A(4) to provide that all sums collected under section 105A must be paid into the Consolidated Fund.

PART 10

SAVING AND TRANSITIONAL PROVISIONS

Clauses 36 to 45 contain saving and transitional provisions.

EXPENDITURE OF PUBLIC MONEY

This Bill will involve the Government in extra financial expenditure, the exact amount of which cannot at present be ascertained.
