

Patents (Amendment) Bill

Bill No. 13/2012.

Read the first time on 14th May 2012.

A BILL

intituled

An Act to amend the Patents Act (Chapter 221 of the 2005 Revised Edition).

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 may be cited as the Patents (Amendment) Act 2012 and shall come into operation on such date as the Minister may, by notification in the *Gazette*, appoint.

5 **Amendment of section 2**

2. Section 2(1) of the Patents Act is amended —

(a) by inserting, immediately after the definition of “European Patent Office”, the following definition:

10 “ “examination” means an examination conducted by an Examiner in relation to an application for a patent to determine such matters as may be prescribed;”;

(b) by deleting the definition of “Examiner” and substituting the following definition:

15 “ “Examiner” means any person, organisation, entity or foreign or international patent office or organisation appointed by the Registrar for the purpose of referring any question or matter relating to patents (including the conduct of any search, examination or search and examination, in relation to an application for a patent, whether before or after the patent is granted), and includes any Deputy Registrar of Patents, and any Assistant Registrar of Patents or public officer to whom the Registrar has delegated, under section 5(1), any of the Registrar’s powers or functions under this Act;”;

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(c) by deleting the definition of “international preliminary report on patentability”;

(d) by deleting the definitions of “marketing approval” and “medicinal product” and substituting the following definitions:

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 “ “marketing approval”, in relation to a pharmaceutical product, means —

(a) a product licence under section 5 of the Medicines Act (Cap. 176) granted before the date of commencement of section 2(d) of the Patents (Amendment) Act 2012; or

(b) a registration under Part VII of the Health Products Act (Cap. 122D) granted on or after the date of commencement of section 2(d) of the Patents (Amendment) Act 2012; 5

“medicinal health product” means any health product within the meaning of the Health Products Act that is prescribed as a medicinal health product; 10

“medicinal product” means —

(a) a medicinal product within the meaning of the Medicines Act; or 15

(b) a medicinal health product;”;

(e) by inserting, immediately after the definition of “register”, the following definition:

“ “registered foreign patent agent” means a person whose name is entered in the register of foreign patent agents kept in accordance with the rules made under section 104;”;

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(f) by inserting, immediately after the definition of “Registry”, the following definitions:

“ “related national phase application”, in relation to an application for a patent (being an international application for a patent (Singapore) that has entered the national phase in Singapore under section 86(3)) (referred to in this definition as the application in suit), means an application for protection treated as filed with any prescribed patent office (being an international application for a patent (Singapore) that has entered the national or regional phase in the country or jurisdiction the patent office of which is 25 30

that prescribed patent office) which is derived from the same international application for a patent (Singapore) (being an international application for a patent (Singapore) that is not subject to any priority claim) as the application in suit;

“related national phase patent”, in relation to a related national phase application, means a patent granted in respect of the related national phase application by the prescribed patent office in which the related national phase application was treated as filed;”;
and

(g) by inserting, immediately after the definition of “scientific adviser”, the following definitions:

““search” means a search conducted by an Examiner in relation to an application for a patent to discover such matters as may be prescribed;

“supplementary examination” means a supplementary examination conducted by an Examiner in relation to an application for a patent to determine such matters as may be prescribed;”.

Amendment of section 25

3. Section 25 of the Patents Act is amended —

(a) by deleting the word “An” in subsection (8) and substituting the words “Subject to subsection (9), an”; and

(b) by inserting, immediately after subsection (8), the following subsection:

“(9) A request to withdraw an application for a patent shall be made in such manner as may be prescribed.”.

Amendment of section 26

4. Section 26(11) of the Patents Act is amended by deleting the words “and before the conditions in section 30(2) and (3) are satisfied” and substituting the words “, but before the applicant satisfies the condition under section 30(c), or the application is

refused, withdrawn, treated as or taken to be withdrawn, or treated as abandoned or as having been abandoned”.

Amendment of section 28

5. Section 28 of the Patents Act is amended —

(a) by deleting subsection (4) and substituting the following subsection: 5

“(4) If the Registrar determines under subsection (3)(a) that not all the formal requirements have been complied with, then the Registrar shall notify the applicant accordingly, and the applicant shall, within the prescribed period — 10

(a) make observations on the Registrar’s determination; and

(b) subject to section 84, amend the application in the prescribed manner, so as to comply with all the formal requirements.”; 15

(b) by deleting the words “period specified by the Registrar” in subsections (5) and (6)(a) and substituting in each case the words “prescribed period”; and

(c) by inserting, immediately after subsection (10), the following subsection: 20

“(11) Where an application for a patent complies with all the formal requirements under this section within the prescribed period, the Registrar shall send a notification to the applicant.”. 25

Repeal and re-enactment of section 29 and new sections 29A and 29B

6. Section 29 of the Patents Act is repealed and the following sections substituted therefor:

“**Search and examination** 30

29.—(1) The applicant in an application for a patent (referred to in this subsection as the application in suit) shall comply with one

of the following paragraphs within the period prescribed for that paragraph:

- (a) file a request in the prescribed form for a search report;
- (b) file a request in the prescribed form for a search and examination report;

- (c) file the prescribed documents and a request in the prescribed form for an examination report, where the applicant relies on the final results of —

- (i) a search in one corresponding application, corresponding international application or related national phase application; or

- (ii) a search during the international phase of the application in suit (if the application in suit is an international application for a patent (Singapore) that has entered the national phase in Singapore under section 86(3));

- (d) file the prescribed documents and a request in the prescribed form for a supplementary examination report, where —

- (i) the applicant relies on the final results of —

- (A) any search and examination as to the substance of one corresponding application, corresponding international application or related national phase application; or

- (B) any search and examination as to the substance of the application in suit during its international phase (if the application in suit is an international application for a patent (Singapore) that has entered the national phase in Singapore under section 86(3));

- (ii) each claim in the application in suit is related to at least one claim in that corresponding application, corresponding international application or related national phase application, or in the application in

suit during its international phase, as the case may be; and

- (iii) according to those results, each claim in the application in suit appears to satisfy the criteria of novelty, inventive step (or non-obviousness) and industrial applicability (or utility).

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(2) Where the applicant has complied with subsection (1)(a), the Registrar shall —

- (a) cause the application to be subjected to a search by an Examiner; and
- (b) upon receiving the search report prepared by the Examiner, send the applicant a copy of that report.

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(3) Upon receiving the search report under subsection (2)(b) from the Registrar, the applicant shall, within the prescribed period, file a request in the prescribed form for an examination report.

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(4) Where the applicant has complied with subsection (1)(c) or (3), the Registrar shall —

- (a) cause the application to be subjected to an examination by an Examiner; and
- (b) upon receiving the examination report prepared by the Examiner, send the applicant a copy of that report.

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(5) Where the applicant has complied with subsection (1)(b), the Registrar shall —

- (a) cause the application to be subjected to —
 - (i) a search by an Examiner; and
 - (ii) an examination by an Examiner; and
- (b) upon receiving the search and examination report prepared by the Examiner, send the applicant a copy of that report.

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(6) Where the applicant has complied with subsection (1)(d), the Registrar shall —

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- (a) cause the application to be subjected to a supplementary examination by an Examiner; and

(b) upon receiving the supplementary examination report prepared by the Examiner, send the applicant a copy of that report.

5 (7) If it appears to an Examiner during the examination of an application under subsection (4) or (5) that one or more of the matters prescribed for the purposes of this subsection apply, the Examiner shall give the applicant at least one written opinion to that effect, and the Registrar shall, upon receiving the written opinion, send the applicant a copy of the written opinion.

10 (8) If it appears to an Examiner during the supplementary examination of an application under subsection (6) that one or more of the matters prescribed for the purposes of this subsection apply, the Examiner shall give the applicant one written opinion to that effect, and the Registrar shall, upon receiving the written
15 opinion, send the applicant a copy of the written opinion.

(9) The applicant shall, before the examination report, search and examination report or supplementary examination report is issued under subsection (4), (5) or (6), as the case may be —

20 (a) respond in the prescribed manner, within the prescribed period, to the written opinion under subsection (7) or (8), as the case may be; and

(b) subject to section 84, amend in the prescribed manner, within the prescribed period, the specification of the application in accordance with the prescribed conditions.

25 (10) Notwithstanding subsection (1), where an applicant who has filed a request for an examination report under subsection (1)(c) or (3), or has filed a request for a search and examination report under subsection (1)(b), does not respond to a written opinion issued under subsection (7), he may —

30 (a) within the prescribed period referred to in subsection (9)(a), withdraw that request; and

(b) within the prescribed period, file a request for a supplementary examination report under subsection (1)(d).

(11) Notwithstanding subsection (1), where an applicant who has filed a request for a supplementary examination report under subsection (1)(*d*) does not respond to the written opinion issued under subsection (8), he may —

- (*a*) within the prescribed period referred to in subsection (9)(*a*), withdraw that request; and 5
- (*b*) within the prescribed period, file a request for a search and examination report under subsection (1)(*b*) or a request for an examination report under subsection (1)(*c*).

(12) The application shall be treated as abandoned — 10

- (*a*) if the applicant fails to comply with subsection (1);
- (*b*) where subsection (10) applies, if the applicant fails to file a request for a supplementary examination report under subsection (1)(*d*) within the prescribed period referred to in subsection (10)(*b*); or 15
- (*c*) where subsection (11) applies, if the applicant fails to file a request for a search and examination report under subsection (1)(*b*) or a request for an examination report under subsection (1)(*c*) within the prescribed period referred to in subsection (11)(*b*). 20

Eligibility for grant of patent, etc.

29A.—(1) Where an examination report issued under section 29(4), a search and examination report issued under section 29(5) or a supplementary examination report issued under section 29(6) does not contain any unresolved objection, the Registrar shall issue to the applicant a notice of eligibility to proceed to the grant of a patent. 25

(2) Where the Registrar has issued to the applicant a notice under subsection (1) —

- (*a*) the applicant shall satisfy the conditions under section 30(*a*) and (*c*) within the prescribed period; and 30
- (*b*) if the applicant fails to comply with paragraph (*a*), the application shall be treated as abandoned.

(3) Where an examination report issued under section 29(4), a search and examination report issued under section 29(5) or a supplementary examination report issued under section 29(6) contains one or more unresolved objections, the Registrar shall issue to the applicant a notice of intention to refuse the application for a patent.

(4) Where the Registrar has issued to the applicant a notice under subsection (3) —

(a) the applicant may, within the prescribed period, apply for a review of the examination report, search and examination report or supplementary examination report, as the case may be, in accordance with section 29B(1); and

(b) if the applicant fails to apply for the review under paragraph (a), the application for a patent shall be refused.

Review of examination report, etc.

29B.—(1) A request for a review of an examination report issued under section 29(4), a search and examination report issued under section 29(5) or a supplementary examination report issued under section 29(6) shall be made by filing —

(a) the prescribed form for the request within the prescribed period; and

(b) written submissions to overcome the unresolved objections in the examination report, search and examination report or supplementary examination report, as the case may be.

(2) At the time the request under subsection (1) is made, the applicant may, subject to section 84, amend in the prescribed manner the specification of the application to overcome one or more unresolved objections in the examination report, search and examination report or supplementary examination report, as the case may be.

(3) Upon completing the review of the examination report, search and examination report or supplementary examination report, as the case may be, the Examiner shall prepare an examination review report.

- (4) The examination review report shall specify —
- (a) whether the Examiner agrees or disagrees with the examination report, search and examination report or supplementary examination report, as the case may be;
 - (b) where the applicant has amended the specification of the application under subsection (2), whether each unresolved objection in the examination report, search and examination report or supplementary examination report, as the case may be, has been overcome in the amended specification; and
 - (c) the reasons for the Examiner’s decision under paragraph (a) and, where applicable, paragraph (b).
- (5) Upon receiving the examination review report, the Registrar shall send the applicant —
- (a) a copy of that report; and
 - (b) either —
 - (i) a notice of eligibility to proceed to the grant of a patent, if the Registrar is satisfied by that report that there is no unresolved objection; or
 - (ii) a notice of refusal of the application for a patent, if the Registrar is satisfied by that report that there are one or more unresolved objections.
- (6) Where the Registrar has sent the applicant a notice under subsection (5)(b)(ii), the refusal of the application for a patent shall take effect upon the expiry of the prescribed period.”.

Repeal and re-enactment of sections 30 and 31

7. Sections 30 and 31 of the Patents Act are repealed and the following sections substituted therefor:

“Grant of patent

30. The Registrar shall grant the applicant a patent if all of the following conditions have been satisfied:

- (a) all the formal requirements have been complied with;

(b) the applicant has received a notice of eligibility to proceed to the grant of a patent under section 29A(1) or 29B(5)(b)(i); and

(c) the prescribed documents for the grant of the patent have been filed.

General power to amend application before grant

31.—(1) Subject to subsections (2), (3) and (4), the applicant may, of his own volition or otherwise, amend the application or the specification thereof.

(2) The applicant shall not be entitled to amend the application or specification unless —

(a) he has made a request to do so to the Registrar —

(i) in the prescribed manner; and

(ii) within the prescribed period; and

(b) the request is accompanied by the prescribed documents.

(3) The applicant may only amend the application or specification in accordance with the prescribed conditions and subject to section 84.

(4) If the applicant fails to comply with any requirement under subsection (2) or (3), the Registrar shall —

(a) refuse the applicant's request to amend the application or specification; and

(b) inform the applicant of the refusal.”.

Amendment of section 35

8. Section 35(2) of the Patents Act is amended by deleting the words “(including the prescribed information under sections 29 and 30)”.

Amendment of section 36A

9. Section 36A of the Patents Act is amended —

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

“(b) where the patent was granted on the basis of any prescribed documents referred to in section 29(1)(d) relating to one corresponding application or related national phase application, that —

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(i) there was an unreasonable delay in the issue of the corresponding patent or related national phase patent (as the case may be); and

(ii) the patent office that granted the corresponding patent or related national phase patent (as the case may be) has extended the term of the corresponding patent or related national phase patent (as the case may be) on the basis of such delay;”;

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(b) by deleting subsections (2) and (3) and substituting the following subsections:

“(2) A delay by the Registrar in granting a patent shall not be treated as an unreasonable delay under subsection (1)(a) unless such requirements as may be prescribed are satisfied.

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(3) Where the proprietor of a patent has made an application under subsection (1)(a) and has satisfied the Registrar that there was in fact a particular type of unreasonable delay by the Registrar in granting the patent, the Registrar shall extend the term of the patent by such period as may be prescribed for that type of unreasonable delay.”;

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(c) by deleting subsections (5), (6) and (7) and substituting the following subsections:

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“(5) A curtailment of the opportunity to exploit a patent, the subject of which includes a substance which is an active ingredient of any pharmaceutical product, caused by the process of obtaining marketing approval for a

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pharmaceutical product, being the first pharmaceutical product to obtain marketing approval which uses the substance as an active ingredient, shall not be treated as an unreasonable curtailment under subsection (1)(c) unless such requirements as may be prescribed are satisfied.

(6) Subject to subsections (7), (8) and (9), where the proprietor of a patent has made an application under subsection (1)(c) and has satisfied the Registrar that there was in fact an unreasonable curtailment of the opportunity to exploit the patent under subsection (1)(c), the Registrar shall extend the term of the patent by such period as may be prescribed.

(7) The Registrar shall not extend the term of the patent under subsection (6) unless the applicant has procured and submitted to the Registrar a certificate from the relevant authority stating such matters as may be prescribed.”; and

(d) by deleting subsections (13) and (14).

Repeal of section 38A

10. Section 38A of the Patents Act is repealed.

Amendment of section 39

11. Section 39 of the Patents Act is amended by deleting subsection (5) and substituting the following subsection:

“(5) If the Registrar is satisfied that the failure of the proprietor of the patent to pay any renewal fee within the prescribed period, or to pay that fee and any prescribed additional fee within the 6 months immediately following the end of that period, was unintentional, the Registrar shall by order restore the patent on payment of any unpaid renewal fee and any prescribed additional fee.”.

Amendment of section 40

12. Section 40 of the Patents Act is amended by deleting subsection (2).

Amendment of section 41

13. Section 41(6) of the Patents Act is amended by deleting the words “parties to the transaction” and substituting the words “assignor or mortgagor”.

Amendment of section 42

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14. Section 42 of the Patents Act is amended —

(a) by deleting subsection (7); and

(b) by deleting the words “or the rules made by virtue of subsection (7)” in subsection (8).

Amendment of section 43

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15. Section 43 of the Patents Act is amended —

(a) by inserting, immediately after the words “mortgage of” in subsection (3)(b) and (c), the words “, or grant of any other security interest in,”; and

(b) by inserting, immediately after subsection (4), the following subsection:

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“(5) Provision may be made by rules as to the amendment, alteration or removal from the register of any particulars in the register relating to any transaction, instrument or event referred to in subsection (3).”.

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Amendment of section 45

16. Section 45(4) of the Patents Act is amended by deleting the words “and sealed with the seal of the Registry”.

Amendment of section 54

17. Section 54(5) of the Patents Act is amended by deleting the words “a period specified by the Registrar” and substituting the words “the prescribed period”.

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Amendment of section 69

18. Section 69 of the Patents Act is amended by deleting subsection (3) and substituting the following subsection:

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“*(3)* In proceedings for infringement of a patent, the court or the Registrar may, if it or he thinks fit, refuse to award any damages, make an order for an account of profits or grant any other relief (including, in proceedings before the court, an injunction) in respect of an infringement committed during any further period specified under section 36(3), but before the payment of the renewal fee and any additional fee prescribed for the purposes of section 36(3).”.

Amendment of section 95

19. Section 95 of the Patents Act is amended —

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

“*(a)* between a person and any of the following:

(i) a registered patent agent or a registered foreign patent agent;

(ii) a partnership entitled under Part XIX to describe itself as a firm of patent agents or as a firm of foreign patent agents; or

(iii) a body corporate entitled under Part XIX to describe itself as a patent agent or as a foreign patent agent; or”;

(b) by inserting, immediately after the words “his patent agent” in subsection (1)*(b)*, the words “or a registered foreign patent agent”;

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

“(2) In this section —

“legal proceedings” includes proceedings before the Registrar;

“patent” includes any patent or other protection for an invention granted in any country or jurisdiction other than Singapore.”; and

- (d) by inserting, immediately after the word “agents” in the section heading, the word “, etc.”.

Amendment of section 96

20. Section 96(3) of the Patents Act is amended by deleting “40(2),” in paragraph (c).

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Amendment of heading to Part XIX

21. The heading to Part XIX of the Patents Act is amended by inserting, immediately after the words “PATENT AGENTS”, the words “AND FOREIGN PATENT AGENTS”.

Amendment of section 104

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22. Section 104 of the Patents Act is amended —

(a) by inserting, immediately after the words “as patent agents” in subsections (1) and (2)(e), the words “or as foreign patent agents”;

(b) by inserting, immediately after the words “a register of patent agents” in subsection (2)(a), the words “and a register of foreign patent agents”;

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(c) by inserting, immediately after the words “as a patent agent” in subsection (2)(b), the words “or as a foreign patent agent”;

(d) by inserting, immediately after the words “the register of patent agents” in subsection (2)(d), the words “and the register of foreign patent agents”;

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(e) by inserting, immediately after the words “professional conduct of registered patent agents” in subsection (3), the words “, registered foreign patent agents”;

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(f) by deleting the words “their practice” in subsection (3) and substituting the words “the practices of registered patent agents and registered foreign patent agents”;

(g) by inserting, immediately after the words “registered patent agents” in subsection (3)(a) and (b), the words “and registered foreign patent agents”; and

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- (h) by inserting, immediately after the words “patent agents” in the section heading, the words “and foreign patent agents”.

Amendment of section 105

23. Section 105 of the Patents Act is amended —

- 5 (a) by inserting, immediately after the words “this section” in subsection (4), the words “and section 105A”;
- (b) by deleting the words “in Singapore or anywhere else” in subsection (4)(a) and substituting the words “at the Registry or any other place”;
- 10 (c) by inserting, immediately after the words ““patent agent”” in subsections (5)(a) and (b), (6)(a) and (7)(a) and (b), the words “or “patent attorney” ”;
- (d) by inserting, immediately after the words ““patent agents”” in subsection (6)(b), the words “or “patent attorneys” ”;
- 15 (e) by deleting subsection (9) and substituting the following subsection:
- “(9) Where subsection (5), (6) or (7) would be contravened by the use of the words “patent agent” or “patent attorney” in reference to an individual, a partnership or a body corporate, it is equally contravened by the use of any other expression in reference to that person, or that person’s business or place of business, which is likely to be understood as indicating that that person is entitled to be described as a “patent agent” or “patent attorney”.”;
- 20 (f) by inserting, immediately after the words “as a patent agent” in subsections (10) and (10A)(b) and (c), the words “or as a foreign patent agent”;
- (g) by deleting the word “any” in subsection (10A)(c) and substituting the word “every”; and
- 30 (h) by inserting, immediately after the definition of “director” in subsection (15), the following definition:

“ “patent” includes any patent or other protection for an invention granted in any country or jurisdiction other than Singapore;”.

New section 105A

24. The Patents Act is amended by inserting, immediately after section 105, the following section: 5

“Foreign patent agents

105A.—(1) Notwithstanding anything in section 105, an individual may carry on a business, practise or act as a foreign patent agent if, and only if, he is a registered foreign patent agent. 10

(2) Notwithstanding anything in section 105, a partnership may carry on a business, practise or act as foreign patent agents if, and only if, at least one partner thereof is a registered foreign patent agent.

(3) Notwithstanding anything in section 105, a body corporate may carry on a business, practise or act as a foreign patent agent if, and only if, at least one director thereof is a registered foreign patent agent. 15

(4) For the purposes of section 105 and this section, a person is taken to carry on a business, practise or act as a foreign patent agent if, and only if, the person does, or undertakes to do, on behalf of someone else, any of the following in Singapore for gain: 20

(a) applying for or obtaining patents at any place other than the Registry;

(b) preparing specifications or other documents for the purposes of — 25

(i) the patent law of any country other than Singapore; or

(ii) an international application for a patent which, on its date of filing, designates any country other than Singapore (whether or not it also designates Singapore); or 30

(c) giving 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.

5 (5) Except as permitted under subsections (1) to (4), a registered foreign patent agent —

(a) shall not carry on a business, practise or act as a patent agent; and

(b) shall not purport to carry on a business, practise or act as a patent agent.

10 (6) Notwithstanding anything in section 105, if an individual is a registered foreign patent agent, he —

(a) may carry on a business under any name or other description which contains the words “foreign patent agent” or “foreign patent attorney”; and

15 (b) may in the course of a business otherwise describe himself, hold himself out or permit himself to be described or held out as a “foreign patent agent” or “foreign patent attorney”.

20 (7) Notwithstanding anything in section 105, if at least one partner of a partnership is a registered foreign patent agent, the partnership —

(a) may carry on a business under any name or other description which contains the words “foreign patent agent” or “foreign patent attorney”; and

25 (b) may in the course of a business otherwise describe itself, hold itself out or permit itself to be described or held out as a firm of “foreign patent agents” or “foreign patent attorneys”.

30 (8) Notwithstanding anything in section 105, if at least one director of a body corporate is a registered foreign patent agent, the body corporate —

(a) may carry on a business under any name or other description which contains the words “foreign patent agent” or “foreign patent attorney”; and

(b) may in the course of a business otherwise describe itself, hold itself out or permit itself to be described or held out as a “foreign patent agent” or “foreign patent attorney”.

(9) No person (other than an individual, a partnership and a body corporate referred to in subsections (6), (7) and (8), respectively) shall — 5

(a) carry on a business under any name or other description which contains the words “foreign patent agent” or “foreign patent attorney”; or

(b) describe himself, hold himself out or permit himself to be described or held out as a “foreign patent agent” or “foreign patent attorney”. 10

(10) Any person who contravenes subsection (5) or (9) shall be guilty of an offence and shall be liable on conviction to a fine not exceeding \$5,000 or to imprisonment for a term not exceeding 12 months or to both. 15

(11) Where subsection (9) would be contravened by the use of the words “foreign patent agent” or “foreign patent attorney” in reference to an individual, a partnership or a body corporate, it is equally contravened by the use of any other expression in reference to that person, or that person’s business or place of business, which is likely to be understood as indicating that that person is entitled to be described as a “foreign patent agent” or “foreign patent attorney”. 20

(12) In this section — 25

“director”, in relation to a body corporate whose affairs are managed by its members, means any member of the body corporate;

“patent” includes any patent or other protection for an invention granted in any country or jurisdiction other than Singapore.”. 30

Amendment of section 106

25. Section 106 of the Patents Act is amended by inserting, immediately after the words “the register of patent agents” in paragraph (c), the words “or the register of foreign patent agents”.

5 **Amendment of section 115**

26. Section 115(4) of the Patents Act is amended by inserting, immediately after the words “registration of patent agents”, the words “and foreign patent agents”.

Repeal and re-enactment of section 116

10 27. Section 116 of the Patents Act is repealed and the following section substituted therefor:

“Fees

15 **116.**—(1) There shall be paid in respect of applications, grants, registrations and other matters under this Act such fees as may be prescribed.

(2) All fees collected shall be paid into the funds of the Office.

(3) Subsection (2) shall not apply to fees paid under section 85 which are to be forwarded to the International Bureau.”.

Savings and transitional provisions

20 **28.**—(1) Subject to subsections (2) and (3), sections 2(a), (c), (f) and (g), 4 to 9 and 18 (referred to in this subsection and subsections (2) and (3) as the relevant provisions) shall not apply to any application for a patent that is filed before the date of commencement of the relevant provisions, or to any patent granted pursuant to any such application,
25 and the definition of “international preliminary report on patentability” in section 2(1), and sections 26(11), 28, 29, 30, 31, 35(2), 36A and 69(3), of the Patents Act in force immediately before that date shall continue to apply to every such application for a patent and every such patent as if the relevant provisions had not been
30 enacted.

(2) The relevant provisions shall apply to —

(a) every new application for a patent made, on or after the date of commencement of the relevant provisions, under section 20(3) or 47(4) of the Patents Act which is treated as having been filed on a date that is before the date of commencement of the relevant provisions, and to every patent granted pursuant to any such application; and 5

(b) every new application for a patent filed, on or after the date of commencement of the relevant provisions, under section 26(11) of the Patents Act which is treated as having as its date of filing a date that is before the date of commencement of the relevant provisions, and to every patent granted pursuant to any such application. 10

(3) The relevant provisions shall apply to every international application for a patent (Singapore) that enters the national phase in Singapore under section 86(3) of the Patents Act on or after the date of commencement of the relevant provisions, and to every patent granted pursuant to any such application. 15

(4) Section 3 shall not apply to any request made before the date of commencement of that section for the withdrawal of an application for a patent, and section 25(8) of the Patents Act in force immediately before that date shall continue to apply to every such request as if section 3 had not been enacted. 20

(5) Section 10 shall not apply to any request made before the date of commencement of that section for a search and examination report in respect of any claim or claims in the specification of a patent, and section 38A of the Patents Act in force immediately before that date shall continue to apply to every such request as if section 10 had not been enacted. 25

(6) Section 11 shall not apply to any patent that lapsed before the date of commencement of that section, and section 39(5) of the Patents Act in force immediately before that date shall continue to apply to every such patent as if section 11 had not been enacted. 30

(7) Sections 12 and 20 shall not apply to any notice given before the date of commencement of those sections by a person to the Registrar 35

of the person's opposition to the surrender of a patent under section 40 of the Patents Act, and sections 40(2) and 96(3)(c) of that Act in force immediately before that date shall continue to apply to every such notice as if sections 12 and 20 had not been enacted.

5 (8) Section 17 shall not apply to any application made before the date of commencement of that section under section 54(1) or (3) of the Patents Act, and section 54(5) of that Act in force immediately before that date shall continue to apply to every such application as if section 17 had not been enacted.

10 (9) For a period of 2 years after the commencement of this subsection, the Minister may, by order published in the *Gazette*, prescribe such other provisions of a savings or transitional nature consequent on the enactment of this Act as he may consider necessary or expedient.

EXPLANATORY STATEMENT

This Bill seeks to amend the Patents Act (Cap. 221) for the following main purposes:

- (a) to modify certain procedures relating to applications for and grants of patents;
- (b) to provide for the registration of foreign patent agents;
- (c) to make certain changes that will follow as a result of the impending transfer of the regulatory regime for certain medicinal products from the Medicines Act (Cap. 176) to the Health Products Act (Cap. 122D); and
- (d) to streamline certain registry procedures and processes.

The Bill also makes certain miscellaneous housekeeping amendments to the Patents Act.

Clause 1 relates to the short title and commencement.

Clause 2(a) and (g) amends section 2(1) by introducing new definitions for the terms "examination", "search" and "supplementary examination" used in the re-enacted section 29 and new sections 29A and 29B (inserted by clause 6).

Clause 2(b) replaces the definition of "Examiner" in section 2(1) with one that enables the Registrar of Patents (the Registrar) to appoint any person, organisation, entity or foreign or international patent office or organisation to be an Examiner for

the purposes of the Act. The new definition of “Examiner” includes any Deputy Registrar of Patents, and any Assistant Registrar of Patents or public officer to whom the Registrar has delegated, under section 5(1), any of the Registrar’s powers and functions under the Act.

Clause 2(c) deletes the definition of “international preliminary report on patentability” in section 2(1), which will be redundant as a consequence of the repeal of sections 29 and 30 and the deletion of section 69(3) by clauses 6, 7 and 18, respectively.

Clause 2(d) replaces the definitions of “marketing approval” and “medicinal product” in section 2(1), and introduces a new definition for “medicinal health product” in section 2(1). These changes will follow as a result of the impending transfer of the regulatory regime for certain medicinal products from the Medicines Act to the Health Products Act.

Clause 2(e) amends section 2(1) by introducing a new definition for the term “registered foreign patent agent” used in the amended sections 95(1) and 104(3) (by clauses 19(a) and (b) and 22(e), (f) and (g)) and the new section 105A (inserted by clause 24).

Clause 2(f) amends section 2(1) by introducing new definitions for the terms “related national phase application” and “related national phase patent”. The term “related national phase application” is used in the definition of “related national phase patent” and the re-enacted sections 29(1)(c) and (d) and 36A(1)(b) (inserted by clauses 6 and 9(a)). The term “related national phase patent” is used in the re-enacted section 36A(1)(b) (inserted by clause 9(a)).

Clause 3 inserts a new section 25(9), and makes a consequential amendment to section 25(8), to require a request to withdraw an application for a patent to be made in such manner as may be prescribed.

Clause 4 amends section 26(11) —

- (a) to make changes consequential to the repeal and re-enactment of section 30 (by clause 7); and
- (b) to enable a new application referred to in section 26(11) to be filed before the application for a patent referred to in section 26(11) is refused, withdrawn, treated as or taken to be withdrawn, or treated as abandoned or as having been abandoned.

Clause 5(a) deletes and substitutes section 28(4) to require the applicant in an application for a patent to do the following within a period prescribed by rules (instead of a period specified by the Registrar):

- (a) make observations on the Registrar’s determination; and
- (b) amend the application in the prescribed manner, so as to comply with all the formal requirements.

Clause 5(b) makes amendments to section 28(5) and (6)(a) that are consequential to the amendment of section 28(4) (by clause 5(a)).

Clause 5(c) inserts a new section 28(11) to provide that where an application for a patent complies with all the formal requirements under section 28 within a period prescribed by rules, the Registrar has to notify the applicant. The new section 28(11) replaces the existing section 29(1), which will be repealed by clause 6.

Clause 6 repeals and re-enacts section 29, and inserts new sections 29A and 29B —

- (a) to streamline the procedures for search and examination, and to provide for a supplementary examination, in an application for a patent;
- (b) to enable the Registrar to issue to the applicant in an application for a patent a notice of eligibility to proceed to the grant of a patent, or a notice of intention to refuse the application for a patent; and
- (c) to provide for the review of an examination report, a search and examination report or a supplementary examination report.

Clause 7 repeals and re-enacts sections 30 and 31 —

- (a) to simplify the procedure for the grant of a patent; and
- (b) to restate the general power of the applicant in an application for a patent to amend the application or the specification thereof.

Clause 8 makes an amendment to section 35(2) that is consequential to the repeal and re-enactment of sections 29 and 30 (by clauses 6 and 7).

Clause 9(a) deletes and substitutes section 36A(1)(b) —

- (a) to make changes consequential to the repeal and re-enactment of section 29 (by clause 6); and
- (b) to enable the term of a patent granted on the basis of any prescribed documents referred to in the new section 29(1)(d)(i) (inserted by clause 6) relating to one related national phase application to be extended on the ground that —
 - (i) there was an unreasonable delay in the issue of the related national phase patent; and
 - (ii) the patent office that granted the related national phase patent has extended the term of the related national phase patent on the basis of such delay.

Clause 9(b) and (c) deletes and substitutes section 36A(2), (3), (5), (6) and (7) to enable certain matters relating to patent term extension to be prescribed instead of being set out therein.

Clause 9(d) deletes section 36A(13) and (14) as a consequence of the deletion and substitution of section 36A(2), (5) and (7) by clause 9(b) and (c).

Clause 10 repeals section 38A to abolish the right to request for a search and examination report in respect of any claim in the specification of a patent that has been granted.

Clause 11 deletes and substitutes section 39(5) to enable the Registrar to restore a lapsed patent if the Registrar is satisfied that the failure of the proprietor of the patent to pay any renewal fee, or to pay that fee and any prescribed additional fee, on time was unintentional. Presently, the Registrar must be satisfied that the proprietor took reasonable care to see that any renewal fee was paid, or that that fee and any prescribed additional fee were paid, on time, before the Registrar can restore a lapsed patent.

Clause 12 deletes section 40(2) to abolish the right of a person to give notice to the Registrar of his opposition to the surrender of a patent under section 40.

Clause 13 amends section 41(6) to replace the existing requirement for any assignment or mortgage of a patent, any application for a patent, or any right in a patent or any such application to be signed by or on behalf of all the parties to the transaction with a requirement for it to be signed by or on behalf of the mortgagor or assignor (as the case may be).

Clause 14 deletes section 42(7), and makes a consequential amendment to section 42(8), to abolish the right to apply for or obtain an uncertified copy of an entry in the register of patents or an uncertified extract from that register.

Clause 15(a) amends section 43(3)(b) and (c) to extend the application of section 43 (in so far as it applies to security transactions) beyond the mortgage of, to the grant of any other security interest in, a patent or an application for a patent, or a licence or sub-licence under a patent or an application for a patent. A person who claims to have acquired any property in a patent or an application for a patent by virtue of any transaction, instrument or event to which section 43 applies is entitled, as against any other person who claims to have acquired that property by virtue of an earlier transaction, instrument or event to which section 43 applies if, at the time of the later transaction, instrument or event —

- (a) the earlier transaction, instrument or event was not registered in the register of patents;
- (b) the person claiming under the later transaction, instrument or event did not know of the earlier transaction, instrument or event; and
- (c) in the case of an application for a patent which has not been published, the Registrar had not been given notice of the earlier transaction, instrument or event.

Clause 15(*b*) inserts a new section 43(5) to expressly empower the making of rules to provide for the amendment, alteration or removal from the register of patents of any particulars in that register relating to any transaction, instrument or event referred to in section 43(3). Section 43(3) lists the transactions, instruments and events to which section 43 applies.

Clause 16 amends section 45(4) as the Registry of Patents (the Registry) will no longer seal any certified copy of an entry in the register of patents or any certified extract from that register.

Clause 17 amends section 54(5) to provide for the period within which the proprietor of a patent is to pay the sum referred to in section 54(5) to be prescribed instead of being specified by the Registrar.

Clause 18 deletes and substitutes section 69(3) to make changes consequential to the repeal and re-enactment of sections 29 and 30 (by clauses 6 and 7).

Clause 19(*a*) and (*b*) amends section 95(1) to extend the privilege from disclosure in legal proceedings in Singapore under section 95(1) to a communication with respect to any matter relating to patents —

- (*a*) between a person and a registered foreign patent agent, a partnership entitled to describe itself as a firm of foreign patent agents or a body corporate entitled to describe itself as a foreign patent agent; or
- (*b*) for the purpose of obtaining, or in response to a request for, information which a person is seeking for the purpose of instructing a registered foreign patent agent.

Presently, such privilege applies only to a communication with respect to any matter relating to patents —

- (*a*) between a person and a registered patent agent, a partnership entitled to describe itself as a firm of patent agents or a body corporate entitled to describe itself as a patent agent; or
- (*b*) for the purpose of obtaining, or in response to a request for, information which a person is seeking for the purpose of instructing his patent agent.

Clause 19(*c*) deletes and substitutes section 95(2) to introduce an extended definition of the term “patent” for the purposes of section 95. In the context of section 95(1) (as amended by clause 19(*a*) and (*b*)), “patent” includes any patent or other protection for an invention granted in any country or jurisdiction other than Singapore, and not just a patent as defined in section 2(1).

Clause 19(*d*) makes a technical amendment to the section heading of section 95, as a consequence of the amendment of section 95(1) (by clause 19(*a*) and (*b*)).

Clause 20 makes an amendment to section 96(3)(*c*) that is consequential to the deletion of section 40(2) (by clause 12).

Clause 21 amends the heading to Part XIX to refer to foreign patent agents, as a consequence of the changes made by clauses 22, 23 and 24.

Clause 22 amends section 104 to enable the Minister to make rules for the registration of individuals as foreign patent agents, including rules for the keeping of a register of foreign patent agents and rules to regulate the professional conduct of registered foreign patent agents and their practices.

Clause 23(a) amends section 105(4) so that the circumstances, specified in section 105(4), in which a person is taken to carry on a business, practise or act as a patent agent, will apply not only for the purposes of section 105 but also for the purposes of the new section 105A (inserted by clause 24).

Clause 23(b) amends section 105(4)(a) to clarify that a person is taken to carry on a business, practise or act as a patent agent if he applies for or obtains, or undertakes to apply for or obtain, on behalf of someone else, patents at the Registry or any other place.

Clause 23(c) and (d) amends section 105(5)(a) and (b), (6)(a) and (b) and (7)(a) and (b) —

- (a) to expressly prohibit an individual from carrying on a business under any name or other description which contains the words “patent attorney”, or in the course of business otherwise describing himself, holding himself out, or permitting himself to be described or held out as a “patent attorney”, unless the individual is a registered patent agent who has in force a practising certificate;
- (b) to expressly prohibit a partnership from carrying on a business under any name or other description which contains the words “patent attorney”, or in the course of business otherwise describing itself, holding itself out, or permitting itself to be described or held out as a firm of “patent attorneys”, unless at least one partner is a registered patent agent who has in force a practising certificate; and
- (c) to expressly prohibit a body corporate from carrying on a business under any name or other description which contains the words “patent attorney”, or in the course of business otherwise describing itself, holding itself out, or permitting itself to be described or held out, as a “patent attorney”, unless at least one director is a registered patent agent who has in force a practising certificate.

Clause 23(e) deletes and substitutes section 105(9) to make textual changes that are consequential to the amendments made by clause 23(c) and (d).

Clause 23(f) makes amendments to section 105(10) and (10A)(b) and (c) that are consequential to the insertion of a new section 105A by clause 24.

Clause 23(g) makes a technical amendment to section 105(10A)(c).

Clause 23(*h*) amends section 105(15) by introducing an extended definition of the term “patent” for the purposes of section 105. In the context of section 105, “patent” includes any patent or other protection for an invention granted in any country or jurisdiction other than Singapore, and not just a patent as defined in section 2(1).

Clause 24 inserts a new section 105A —

- (a) to enable a person to carry on a business, practise or act as a foreign patent agent if, and only if —
 - (i) in the case of an individual, he is a registered foreign patent agent;
 - (ii) in the case of a partnership, at least one partner is a registered foreign patent agent; or
 - (iii) in the case of a body corporate, at least one director is a registered foreign patent agent;
- (b) to specify what constitutes carrying on a business, practising or acting as a foreign patent agent;
- (c) to prohibit a registered foreign patent agent from otherwise carrying on a business, practising or acting as a patent agent, or purporting to do so; and
- (d) to prohibit the use, by any person (other than an individual who is a registered foreign patent agent, a partnership at least one partner of which is a registered foreign patent agent, or a body corporate at least one director of which is a registered foreign patent agent), of the terms “foreign patent agent” and “foreign patent attorney”, and of any other expression in reference to that person, or his business or place of business, which is likely to be understood as indicating that he is entitled to be described as a “foreign patent agent” or a “foreign patent attorney”.

Clause 25 amends section 106(*c*) to provide that the Intellectual Property Office of Singapore, any officer of the Registry and any Examiner will not incur any liability by reason of an incorrect entry in the register of foreign patent agents.

Clause 26 amends section 115(4) to provide for the particulars of application for and the registration of foreign patent agents to be contained in the journal published by the Registrar.

Clause 27 repeals and re-enacts section 116 to align that section with section 77(1), (3) and (4) of the Trade Marks Act (Cap. 332).

Clause 28 contains savings 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.
