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PATENTS ACT
(CHAPTER 221)

PATENTS
(AMENDMENT) RULES 2021

In exercise of the powers conferred by section 115 of the Patents Act, the Minister for Law, after consulting with the Intellectual Property Office of Singapore, makes the following Rules:

Citation and commencement

1. These Rules are the Patents (Amendment) Rules 2021 and come into operation on 1 October 2021.

Amendment of rule 6

2. Rule 6(1) of the Patents Rules (R 1) is amended by deleting the words “within one month” and substituting the words “within 8 weeks”.

Amendment of rule 7

3. Rule 7 of the Patents Rules is amended —

(a) by deleting paragraph (4) and substituting the following paragraph:

“(4) When a bill of costs has been taxed, the Registrar must make the Registrar’s certificate for the amount of the taxed costs.”; and

(b) by inserting, immediately after paragraph (5), the following paragraph:

“(6) Paragraphs (3) and (5) do not apply to any taxation of costs or expenses of a party who is entitled under section 72(2) to the party’s costs or expenses as between solicitor and own client.”.

Amendment of rule 18

4. Rule 18 of the Patents Rules is amended by deleting paragraph (2).

Amendment of rule 19

5. Rule 19 of the Patents Rules is amended by inserting, immediately after paragraph (9), the following paragraph:

“(9A) The applicant making the request under paragraph (1) may, at the time of making the request, provide the information mentioned in section 24(2).”.

Amendment of rule 45

6. Rule 45 of the Patents Rules is amended by deleting the rule heading and substituting the following rule heading:

“Search procedure where 2 or more inventions claimed or new application filed under section 26(11)”.

New rule 45A

7. The Patents Rules are amended by inserting, immediately after rule 45, the following rule:

“Observation by third party on patentability

45A.—(1) If the Registrar receives an observation in writing on the question of whether an invention is a patentable invention under section 32(1), the Registrar must give written notice of this fact to the applicant in the application for the patent.

(2) The Registrar must send a copy of the observation to an Examiner who is carrying out an examination of the application under section 29(4)(a) or (5)(a)(ii) or a supplementary examination under section 29(6)(a), and the Examiner must take the observation into consideration.”.

New rule 52A

8. The Patents Rules are amended by inserting, immediately after rule 52, the following rule:

“Re-examination after grant

52A.—(1) A request for the Registrar to conduct a re-examination of the specification of a patent under section 38A(1) must be made on Patents Form 36, and be accompanied by —

- (a) the prescribed fee;
- (b) a statement —
 - (i) identifying each ground under section 38A(1) on which the request is made; and
 - (ii) explaining how that ground or grounds is or are satisfied; and
- (c) any document mentioned in section 38A(2)(c)(ii).

(2) Where any document mentioned in section 38A(2)(c)(ii) that is filed is in a language other than English, the Registrar may require the person who filed the request to provide, within the time specified by the Registrar —

- (a) an English translation of the whole or any part of that document; and
- (b) a copy of a document verifying, to the Registrar’s satisfaction, that the translation corresponds to the original text of that document or part of that document.

(3) If the person fails to comply with paragraph (2)(a) or (b) within the time specified by the Registrar, the request is treated as having been abandoned.

(4) Where the Registrar grants a request under section 38A(1), the Registrar must forward to an Examiner —

- (a) the request;
- (b) the statement mentioned in paragraph (1)(b); and
- (c) each document mentioned in paragraph (1)(c).

(5) The proprietor of the patent may, within 2 months after the date on which the Registrar sends the proprietor a copy of the Examiner's written opinion under section 38A(8), request an interview with the Examiner, and the Registrar must grant such a request.

(6) The Registrar may, in any particular case, grant a request for an interview with the Examiner that is made after the period mentioned in paragraph (5).

(7) If the proprietor of the patent wishes to respond to the written opinion given under section 38A(8), the proprietor must file a response in Patents Form 13A, containing —

- (a) written submissions on the Examiner's written opinion; or
- (b) an application to amend the specification of the patent, with the amendment indicated by —
 - (i) striking through any text, figure or other matter to be replaced or deleted; and
 - (ii) underlining any replacement text, figure or other matter,

and where the proprietor wishes to make written submissions and apply to amend the specification of the patent, the proprietor must do both at the same time.

(8) The proprietor of the patent must file the response mentioned in paragraph (7) with the Registrar within 3 months after the date on which the Registrar sends to the proprietor a copy of the written opinion.

(9) If the proprietor of the patent fails to respond to the written opinion within the period mentioned in paragraph (8) —

- (a) the Registrar must inform the Examiner accordingly; and
- (b) the written opinion is treated as the re-examination report mentioned in section 38A(10).

(10) Where an application to amend the specification of the patent has been filed by the proprietor under paragraph (7)(b) and it appears to the Examiner that the proposed amendment would resolve any objection mentioned in the written opinion, the Examiner must state so in the re-examination report and specify in the report the objection that would be so resolved.

(11) The Registrar may direct the proprietor of the patent to file with the Registrar, within the time specified by the Registrar —

- (a) in a case where paragraph (10) applies — a specification incorporating the amendment mentioned in paragraph (10); or
- (b) in a case where the Registrar makes an order mentioned in section 38A(12)(b) — a specification incorporating any amendment (including any proposed amendment mentioned in paragraph (10)) relating to the order to the satisfaction of the Registrar.”.

New rule 62A

9. The Patents Rules are amended by inserting, immediately after rule 62, the following rule:

“Certificate of contested validity of patent

62A.—(1) This rule applies where the court or the Registrar has certified under section 72(1) that a patent is found to be wholly or partially valid in any proceedings before the court or the Registrar (as the case may be), and the fact that the validity of the patent was contested in the proceedings.

(2) If the certificate is given by the court, the proprietor of the patent may file a written request with the Registrar to add to the entry of the patent in the register a note that the certificate has been given in the course of the proceedings, and a copy of the certificate must be filed together with the written request.

(3) The Registrar must, on receipt of the request mentioned in paragraph (2) and the copy of the certificate, add the note to the entry of the patent in the register.

(4) If the certificate is given by the Registrar, the Registrar must add to the entry of the patent in the register a note that such certificate has been given in the course of the proceedings.”.

Amendment of rule 80

10. Rule 80 of the Patents Rules is amended by deleting paragraph (4) and substituting the following paragraphs:

“(4) In the case of an application for revocation of the patent specifying a ground mentioned in section 80(1), the application for the revocation of the patent must be granted if the proprietor of the patent fails to file the counter-statement in accordance with paragraph (3).

(4A) An order for the revocation of a patent made under paragraph (4) may be set aside by the Registrar, on the application of the proprietor of the patent, on any terms that the Registrar thinks fit.

(4B) An application under paragraph (4A) must be made within 14 days after the date of the Registrar’s notification of the order for the revocation of the patent made under paragraph (4).”.

Deletion and substitution of heading

11. The Patents Rules are amended by deleting the heading “AMENDMENT OF PATENTS IN INFRINGEMENT OR REVOCATION PROCEEDINGS” before rule 85 and substituting the following heading:

“AMENDMENT OF PATENTS IN INFRINGEMENT,
RE-EXAMINATION OR REVOCATION PROCEEDINGS”.

Amendment of rule 88B

12. Rule 88B(6) of the Patents Rules is amended by deleting the words “appear at” and substituting the word “attend”.

Amendment of rule 89

13. Rule 89 of the Patents Rules is amended by deleting paragraph (2) and substituting the following paragraph:

“(2) After consulting the parties to the dispute mentioned in paragraph (1), the Registrar may direct that the hearing not be held in public.”.

Amendment of rule 96A

14. Rule 96A of the Patents Rules is amended by deleting the word “malfunction” in paragraphs (3)(e) and (4)(a) and substituting in each case the words “interruption in the operation”.

Deletion of rule 96K

15. Rule 96K of the Patents Rules is deleted.

Amendment of rule 108

16. Rule 108 of the Patents Rules is amended —

- (a) by inserting, immediately after “52(2),” in paragraph (2)(b), “52A(8),”; and
- (b) by inserting, immediately after “47(1)” in paragraph (4)(a), the words “or (2)”.

Amendment of rule 110

17. Rule 110 of the Patents Rules is amended —

- (a) by deleting paragraph (1) and substituting the following paragraph:

“(1) Where, on any day, there is an interruption in —

- (a) the postal service of Singapore;
- (b) the operation of the Registry; or

(c) the operation of the electronic online system,

the Registrar may issue practice directions to declare that day as one on which there has been an “interruption” and, where any period of time specified in the Act or these Rules for the making, filing, giving, sending or serving of any notice, application or other document expires on a day so declared, the period is extended to the first following day (not being an excluded day) which is not so declared.”;

- (b) by deleting the words “such a declaration” in paragraph (4) and substituting the words “a declaration under section 17(2)”;
- (c) by inserting, immediately after the words “the declaration” wherever they appear in paragraph (4), the words “under section 17(2)”;
- (d) by deleting the word “certified” wherever it appears in paragraphs (4) and (5) and substituting in each case the word “declared”;
- (e) by deleting the words “give, make or file” in paragraph (6) and substituting the words “make, file, give, send or serve”;
- (f) by deleting the words “giving, making or filing” in paragraph (6)(a) and (i) and substituting in each case the words “making, filing, giving, sending or serving”; and
- (g) by inserting, immediately after the words “postal services in Singapore” in paragraph (6), the words “(in the case of where a party is authorised or required to give, send or serve a document on another party)”.

Amendment of First Schedule

18. The First Schedule to the Patents Rules is amended —

- (a) by deleting items 7, 11, 12, 13, 15, 17, 18, 53, 57, 66 and 71;

(b) by inserting, immediately after item 33, the following item:

“33A. Request for re-examination 3,200 Patents
of the specification of a Form 36”; and
patent under section 38A

(c) by deleting paragraph (b) of item 44.

Amendment of Second Schedule

19. The Second Schedule to the Patents Rules is amended —

(a) by inserting, immediately after the word “Registrar” under the column “*Description of Form*” in the item relating to Patents Form 36, the words “or for re-examination of specification of patent under section 38A”; and

(b) by deleting the item relating to Form HC2.

Amendment of Third Schedule

20. Item 10 of the Third Schedule to the Patents Rules is amended by deleting the words “, and obtaining the Registrar’s certificate or order”.

Amendment of Fourth Schedule

21. The Fourth Schedule to the Patents Rules is amended —

(a) by deleting the words “rule 1(3)(c)” in paragraph 2(1)(a) and substituting the words “paragraph 1(3)(c)”;

(b) by deleting the words “Patent Co-operation Treaty” in paragraph 3(4)(a) and substituting the words “Budapest Treaty”;

(c) by deleting the words “rule 2(3)” in paragraph 3(4)(b) and substituting the words “paragraph 2(3)”;

(d) by deleting the words “rule 2(1) or 3(4)” in paragraph 4(1)(a)(i) and substituting the words “paragraph 2(1) or 3(4)”.

Saving and transitional provisions

22.—(1) Despite rule 2, rule 6(1) of the Patents Rules as in force immediately before 1 October 2021 continues to apply to or in relation to any order of costs made before that date by the Registrar.

(2) Rule 3(b) does not apply to any taxation proceedings before the Registrar commenced before 1 October 2021.

(3) Despite rule 4, rule 18(2) of the Patents Rules as in force immediately before 1 October 2021 continues to apply in relation to any Patents Form 8 that is filed under rule 18 of the Patents Rules before that date.

(4) Rule 7 applies to any application for a patent that has been published, whether published before, on or after 1 October 2021.

(5) Rule 8 applies to any patent, whether granted before, on or after the 1 October 2021.

(6) Rule 9 applies to a certificate given under section 72(1) of the Act by the court or the Registrar in any proceedings in which the validity of a patent to any extent is contested, whether the proceedings are commenced before, on or after 1 October 2021.

(7) Despite rule 10, rule 80(4) of the Patents Rules as in force immediately before 1 October 2021 continues to apply to or in relation to any application to the Registrar for the revocation of a patent made before that date.

(8) Rule 16(b) does not apply to or in relation to any notice of eligibility to proceed to the grant of a patent sent by the Registrar to the applicant under section 29B(5)(b)(i) of the Act before 1 October 2021.

(9) Rule 17(e), (f) and (g) does not apply to a case where the period of time specified in the Act or the Patents Rules for a person to send or serve any notice, application or other document has expired before 1 October 2021.

*[G.N. Nos. S 501/2009; S 730/2010; S 586/2011;
S 210/2013; S 81/2014; S 162/2014; S 739/2014;
S 673/2016; S 146/2017; S 573/2017; S 432/2020]*

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