

**INTELLECTUAL PROPERTY COMMITTEE
OF THE LAW SOCIETY OF SINGAPORE**

COMMENTS ON THE PATENTS (AMENDMENT) BILL

Section 38A

This sections deals with examinations of claims that were not examined prior to grant. No time period is set for requesting further examination. Was this deliberate? Should not the patentee be under an obligation to request for examination within a specific time frame?

Section 66(2B)

The phrase “prescribed information” appears to refer to something different and not to the prescribed information required in prosecuting a patent application referred to in section 29. This phrase may therefore cause some confusion.

Section 25(5) / Section 80

Article 16.7.4 of the USSFTA provides that “ a patent may only be revoked on grounds that would have justified a refusal to grant the patent.....”. However section 80 as amended is still much narrower than grounds for refusal to grant a patent. Eg: Section 24 (4) and (5) are requirements for a grant of a patent, even under the new section 38A. However noncompliance with section 25 (5) is not a ground for revocation although it is a ground for refusal to grant. In this respect, the proposed amendments to section 80 do not comply with Article 16.7.4 of the USSFTA. Should not non-compliance with section 24(5) be a grounds for revocation also?

Section 80(1) (e)

Under this sub-section, a patent can be revoked where “an amendment or correction has been made to the specification ...which should not have been allowed.” This change can be highly prejudicial to the patentees as compared to the present position where a patent can only be revoked if an amendment extends beyond the protection conferred by the patent

Under the Rules “no correction shall be made therein unless the correction is obvious in the sense that it is immediately evident that nothing else would have been intended than what is offered as the correction is clear on the face that nothing else is intended.” (Rule 91(1)). To the extent that corrections, by definition do not add any new matter and are verified by the Registrar before they are allowed to be made, it is queried whether this should be a ground for

revocation? If the Registrar makes an error, should the patent be then vulnerable to revocation?

Further the words “should not have been allowed” is very broad, and the patent could fall for any number of reasons which makes no difference to the scope of the patent conferred by the patent. Eg: if an amendment is filed instead of an correction, would the whole patent be revoked on that basis that a correction should have been filed instead?

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Section 80(1)(f)

Under this section a patent can be revoked where “the patent was obtained....on any nondisclosure or inaccurate disclosure of any prescribed material information, whether or not the person under a duty to provide the information knew or ought reasonably to have known of such information or inaccuracy.” This provision appears more draconian than the present provision, since knowledge of non-disclosure is not material. ANY non-disclosure or inaccuracy may fall within this provision.

Furthermore, the “prescribed material information” is not defined anywhere in the Act. The explanatory notes state that this is allowed under Article 16.7.4 of the USSFTA. Article 16.7.4 of the USSFTA states that “non-disclosure or misrepresentation of prescribed, material particulars” and not prescribed material information. Does it mean “material particulars of prescribed information?” Moreover, since prescribed information includes a translation of the same, does it mean that any error in the translation could make the patent invalid?

Information on corresponding applications is something that is searchable on international patent databases, and there is no prejudice to anyone if any corresponding application is left out or is wrong. It would appear that the amendment is too strict on errors and non-disclosures.

22 April 2004
