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3 July 2009

Dear Sir/Mdm,

CONSULTATION PAPER ON THE PROPOSED CHANGES TO THE PATENT SYSTEM 2009

Invitation

You are invited to submit written comments on the proposed changes to the Patents System which are set out in the enclosed consultation document and summarised in Annex A.

Information for persons making submissions to this Paper

2. Please submit your comments/suggestions in the template in Annex B and email it to IPOS at IPOS_iplawfeedback@ipos.gov.sg when completed. It is recommended that the submission be saved in the MS Word format for easy collation.
3. The closing date for submission is 14 August 2009.
4. In submitting your feedback, you agree that unless your representations are clearly marked "Confidential", IPOS may disclose and make available the representations to the general public, in whole or in part, through its website or other means.
5. Thank you.

INTELLECTUAL PROPERTY OFFICE OF SINGAPORE

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Encl. Annex A: Proposed Changes to the Patent System 2009
Annex B: Feedback Template



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Proposed Changes to the Patent System 2009

INTELLECTUAL PROPERTY OFFICE OF SINGAPORE
JULY 2009

Proposed Changes to the Patent System 2009

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Glossary of Terms Used

Term	Meaning
Claims correspondence table	A table referencing the claim numbers of two sets of claims with an explanation how the two sets of claims are related. (see <i>Related claims</i>)
Deadline	A deadline is the last day for the prescribed requirements to be satisfied and an applicant can take action to satisfy said requirements earlier to expedite the application prosecution.
International preliminary report on patentability (IPRP)	An international preliminary report on patentability (Chapter I of the Patent Co-operation Treaty) or an international preliminary report on patentability (Chapter II of the Patent Co-operation Treaty). (Section 2 of the Singapore Patents Act)
Mixed examination report/results/IPRP	At least one examined claim or a part of an examined claim is objected to by the examiner.
Negative examination report/results/IPRP	All examined claims are objected to by the examiner.
Positive examination report/results/IPRP	There is no outstanding objection from the examiner.
Prescribed information	Information that indicates the result of the corresponding application or corresponding international application and any symbol of the International Patent Classification allocated to the application. (Rule 44 of the Singapore Patents Rules)
Related claims	A claim is related to another claim if – (i) the 2 claims are identical; or (ii) each limitation in the second claims – (A) is identical to a limitation in the first claim; or (B) differs from a limitation in the first claim only in expression but not in content; and more than one claim may be related to a single claim. (Section 2(4) of the Singapore Patents Act)

1 Introduction

- 1.1 The Singapore (SG) Patents Act and Patents Rules came into force in 1995. Prior to that, it was a simple system of re-registration of patents granted in the United Kingdom. Since its establishment, the Patents legislation has undergone a series of changes and enhancements in alignment with Singapore's economic development and trends in patent protection.
- 1.2 As part of our on-going review, IPOS is reviewing several aspects of the patent system, specifically on changes to the self-assessment regime, changes to the application process, and changes to processes relating to extension of time, restoration, renewal reminder, and second or subsequent new medical use claims. This consultation paper seeks feedback on these proposed changes and issues related to the proposed changes.
- 1.3 Feedback received will be studied for suitable changes to be implemented.

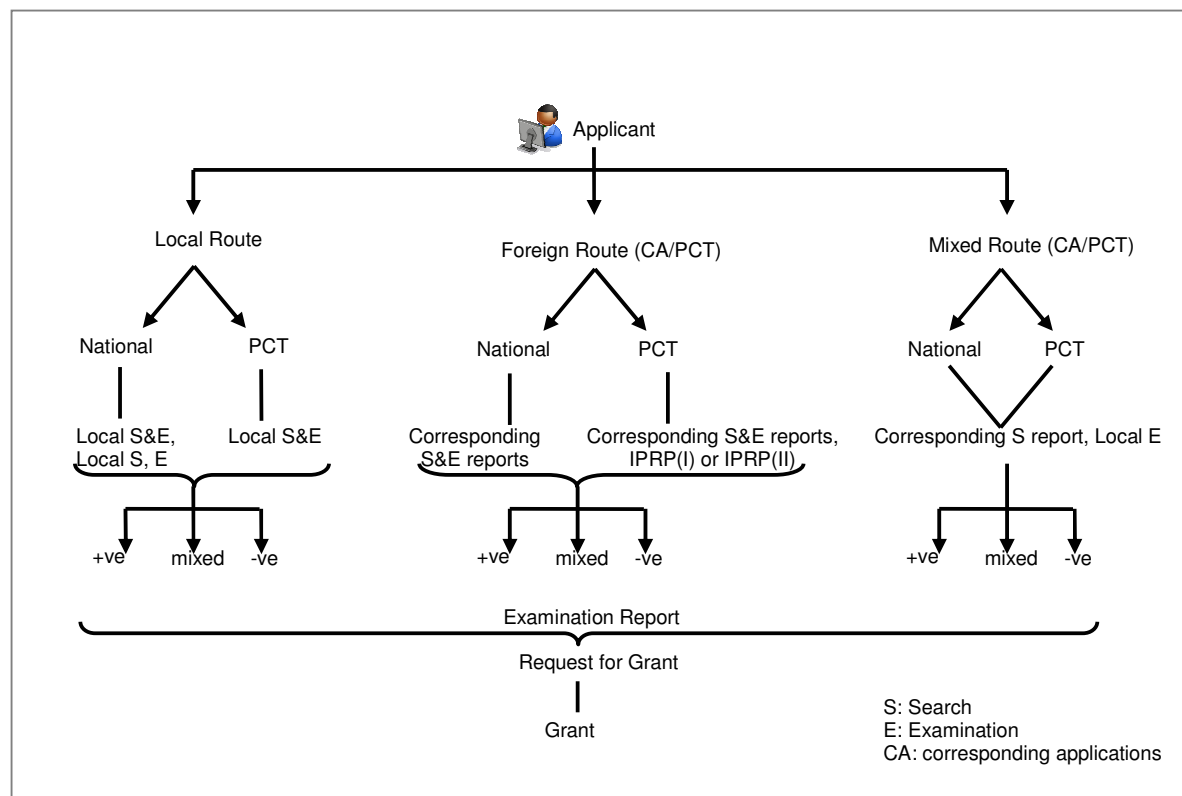
2 Proposed Changes to the Patent Self-Assessment (PSA) Regime

2.1 The Self-assessment Regime

2.1.1 Singapore's patent system is unique in terms of the patent application processes. While the criteria for what amounts to a patentable invention under the Patents Act is similar to other patent systems, several search and examination routes are available to applicants to choose from. These options allow flexibility as applicants decide on their patent prosecution strategy.

2.1.2 A key feature of the existing patent system is its self-assessment nature in that a patent grant will not be refused on the ground that the invention is assessed to be not patentable. Some patent offices share similar features of self-assessment, for example, Switzerland and the Netherlands. Prior to grant, the applicant bears the responsibility and onus of ensuring that his claims for patent protection meet the criteria of patentability, and take the necessary steps to amend the application, where necessary, to meet any objections raised by the examiner. The search and examination reports are open for public inspection and scrutiny by interested parties. Challenges to the patentability of the invention are provided for after the patent is granted. Figure 1 is an overview of the current patent system.

Figure 1: An overview of the current patent system.



- 2.1.3 The nature of self-assessment allows the applicant to decide whether to proceed to grant, a decision normally vested with the patent office in other patent systems.
- 2.1.4 According to the grant statistics for year 2008, a high percentage of grants were issued based on positive examination reports. Only a minority of 13% were granted with mixed/negative examination reports. This is evidence that a self-assessment regime has fared reasonably well for Singapore in that applicants have exercised good judgment to only request for grant with positive examination reports even when the system allows otherwise. They are cognizant of the fact that a weak patent will hamper their enforcement actions and devalue their inventions. Nevertheless, there have been occasions when IPOS received requests from both IP owners and third parties to consider moving away from the self-assessment regime.
- 2.1.5 The patent system supports Singapore's national economic policies by awarding monopoly rights in exchange for the disclosure of the inventions. In light of Singapore's push to be an innovation, research and development hub in various technological fields, notwithstanding that the minority of patents are granted based on a mixed/negative report, it is timely, to consider amending the patent system to grant patents only when the examination report is positive.
- 2.1.6 This will create a more robust system wherein only inventions meeting the official assessment of patentability proceed to grant. The main considerations of the review are:
- a positive examination grant system provides greater certainty from the business and enforcement perspective for both the patentee and third parties, and
 - a positive examination grant system can potentially increase the quality and standards of Singapore granted patents.
- 2.1.7 To adopt a positive examination grant system will necessitate a change in the search and examination processes (the local route, the mixed route and the foreign route) so that only applications with positive outcomes can proceed to grant. The proposed changes are outlined below.

2.2 Proposed PSA Changes: Local & Mixed Routes

- 2.2.1 **Current:** Under the local route, an applicant files an application directly with IPOS and files a request for a search and examination report. The search & examination work is conducted by one of IPOS' outsourced examiners. Among the Singapore patent applications which proceeded to grant in 2008, 26% utilised this route.
- 2.2.2 Under the mixed route, an applicant files an application with IPOS (or a PCT application entering national phase into Singapore) relying on the search results of the corresponding application or corresponding international application or its international search report, and files a request for an examination report. The examination is conducted by one of IPOS' outsourced examiners. Among the Singapore patent applications which proceeded to grant in 2008, 25% utilised this route.

2.2.3 Figure 2 shows the current search & examination processes and the set of timelines for local/mixed route applications (national or PCT applications).

Figure 2: Current search & examination processes and timelines for local/mixed route applications

Action	Deadline	Applicant	IPOS	Comments
Application	0 month			
Search				
Fast track	13 months			Search is not applicable to PCT national phase entry applications.
Slow track	Not available			
Search & Examination/ Examination				
Fast track	21 months	Request for an examination report		Informal dialogue with examiner is available. Extension of time is not allowed for reply.
Slow track	39 months			
			Issue office action (WO/ ER)	
		Reply to WO within 5 months		
			Examiner has discretion to issue further WOs	Informal dialogue with examiner is available. Extension of time is not allowed for reply.
		Reply to further WO within 5 months		
	18 months			
Fast track	39 months		Issue ER	
Slow track	57 months			
Grant				
Fast track	42 months	Pay grant fee		With positive, mixed or negative ER
Slow track	60 months			

WO: written opinion

ER: examination report

For PCT applications, the local examination in Singapore will take into consideration amendments made under Article 19/ Article 34 of the Patent Co-operation Treaty (subject to the meeting of the requirements in section 86 of the Patents Act).

2.2.4 **Proposed:** For applications with positive examination reports, the impact is minimal. The search and examination process for such applications will largely remain status quo.

2.2.5 **Hearing:** Where the examination report is mixed/negative, an additional avenue is proposed for the applicant to overcome objections by the examiner. This comes as a form of a hearing process in the event that objections cannot be overcome in the normal course of examination. Currently informal dialogue facilities are available for applicants to seek clarifications from the examiners on the objections raised in the written opinion and/or to discuss how objections can be overcome. This is done via

email or telephone-conference between the examiner and the applicant, and facilitates the obtaining of a positive examination report.

- 2.2.6 For an application where the examiner intends to issue a mixed/negative examination report, the examiner will indicate in writing an intention to issue mixed/negative report supported with reasons, and offer applicant an opportunity for hearing. The applicant may request for a hearing. If a request for a hearing is not filed within 1 month, the application shall be treated as having been abandoned.
- 2.2.7 Upon a request for a hearing, a hearing officer, an independent examiner from the same examination office, will be appointed to hear the case. The applicant may choose to proceed by means of written submissions, telephone-conference or video conference and a hearing fee will be imposed. A hearing via telephone-conference or video-conference will be conducted with the patent applicant or his representative in IPOS and the hearing officer present in his office.
- 2.2.8 The outcome of the hearing will be either a) examiner's objections maintained (written grounds of refusal of application), or b) examiner's objections overruled (a positive examination report will be issued). If the applicant is not satisfied with the refusal, he may proceed to file an appeal to the court. The applicant may also file a divisional application as long as the application is pending.
- 2.2.9 Other related changes to the local/mixed route are:
 - a) The deadline to establish the examination report is extended from 39 months to 41 months (or 57 months to 59 months for slow track applications) to provide more opportunities for informal dialogue/submissions to overcome the objections.
 - b) Amendments cannot be filed prior to grant after a positive examination report is issued. This ensures that the specification for grant will be the specification as examined.
- 2.2.10 Figures 3(a) and 3(b) show the proposed search & examination processes and timelines for local/mixed route applications (national and PCT applications).

Figure 3(a): Positive examination report via local/mixed route

Action	Deadline	Applicant	IPOS	Comments
Application	0 month			
Search Fast track Slow track	13 months Not available			Search is not applicable to PCT national phase entry applications.
Search & Examination / Examination Fast track Slow track 20 months	21 months 39 months	Request for an examination report		
			Issue office action (WO/ ER)	Informal dialogue with examiner available. Extension of time is not allowed.
		Reply to WO within 5 months		
			Examiner has discretion to issue further WOs	
		Reply to further WO within 5 months		Informal dialogue with examiner available. Extension of time is not allowed.
Fast track Slow track	41 months 59 months		Issue positive ER	
Grant Fast track Slow track	42 months 60 months	Pay grant fee for positive ER		If grant fee not paid application treated as having been abandoned.

WO: written opinion

ER: examination report

For PCT applications, the local examination in Singapore will take into consideration amendments made under Article 19/ Article 34 of the Patent Co-operation Treaty (subject to the meeting of the requirements in section 86 of the Patents Act).


 status quo

Figure 3b): Mixed/negative examination report via local/mixed route

Action	Deadline	Applicant	IPOS	Comments
Application	0 month			
Search Fast track Slow track	13 months Not available			Search is not applicable to PCT national phase entry applications.
Search & Examination / Examination Fast track Slow track 20 months	21 months 39 months	Request for an examination report		Informal dialogue with examiner available. Extension of time is not allowed.
			Issue office action (WO/ ER)	
		Reply to WO within 5 months		
			Examiner has discretion to issue further WOs	
		Reply to further WO within 5 months		
Fast track Slow track	41 months 59 months		Intention to issue mixed/ negative ER. Invitation to request for a hearing.	If ER is mixed/negative, the grant deadline at 42/60 months does not apply.
Hearing Fast track Slow track	42 months 60 months	File request for a hearing within 1 month		If request for a hearing not filed, application treated as having been abandoned.
		Issue hearing date		
	x months	Hearing		By an independent examiner
	y months		Issue ER + written decision (if required) 1) positive ER 2) negative/mixed ER	Application is refused.
Grant	y+1 months	1) Pay grant fee		1) If grant fee not paid, application treated as having been abandoned. 2) Application is refused. Applicant may file divisional application or appeal to the court.

WO: written opinion

ER: examination report

For PCT applications, the local examination in Singapore will take into consideration amendments made under Article 19/Article 34 of the Patent Co-operation Treaty (subject to the meeting of the requirements in section 86 of the Patents Act).

 status quo

Invitation 1

1. What are your views about the proposed hearing process? What do you think are the implications of the additional time to grant?
2. In the current practice, do you encounter any difficulty when trying to establish an informal dialogue with the examiner? If so, please suggest how this can be improved.
3. It is proposed that there will be no opportunity to amend the specification once the examination report is issued. This ensures the specification for grant is the specification as examined. What are your views on this? Do you have other suggestions?
4. What are your views about the overall proposed changes to the local/mixed routes? Are they sufficient in supporting a positive grant system?

It would be helpful to the Registry if such comments and feedback are accompanied by comprehensive reasons and, where available, examples or situations in support.

2.3 Proposed PSA Changes: Foreign Route (prescribed information and International Preliminary Report on Patentability)

2.3.1 **Current:** A foreign route application is an application which proceeds to grant relying on search and examination reports conducted by a patent office prescribed under rule 41 of the SG Patents Rules (“PPO”) or by the PCT international search or examination authorities (“PCT authorities”). Such an application is either an application filed directly with IPOS with prescribed information or a PCT application entering national phase into Singapore relying on the international preliminary report on patentability (Chapter I or II) (IPRP). Among the Singapore patent applications which proceeded to grant in 2008, 49% utilised this route.

2.3.2 Under the foreign route and relying on prescribed information, an application is filed directly with IPOS relying on search and examination results of a corresponding application or corresponding international application. With the corresponding search and examination results, the applicant can proceed to grant. Please refer to Figure 4 for the deadline to grant.

2.3.3 Under the foreign route and relying on IPRP, a PCT application enters national phase into Singapore and the application proceeds to grant relying on the IPRP. Please refer to Figure 4 for the deadline to grant.

Figure 4: Deadline to grant for foreign route applications

Action	Deadline	Applicant
Application	0 month	
Grant		
Fast track	42 months	Furnish prescribed information, IPRP(I) or IPRP(II) and pay grant fee
Slow track	60 months	

2.3.4 For foreign route (prescribed information and IPRP) applications, applicants may amend the specification before grant. For applications relying on prescribed information, the claims in the Singapore application are usually amended to conform to the claims in the prescribed information. For PCT applications, amendments can be made under Article 19 of the PCT, Article 34 of the PCT and/or during national phase. Applicants are to ensure the amendments are within the disclosure in the application as filed (section 84 of the SG Patents Act). At the point of making a request that a certificate of grant be issued, applicants are required to declare that each of the amended claims put forth for grant is related to at least one examined claim referred to in the prescribed information or IPRP (section 30 of the SG Patents Act).

2.3.5 **Proposed - Prescribed Information:** Patents to be granted only to applications relying on positive examination results from a PPO or the PCT authorities and the claims put forth for grant are related to the examined claims referred to in the prescribed information.

2.3.6 If the examination results from the PPO or the PCT authorities are mixed, an application cannot rely on it for grant. To continue prosecuting the application in Singapore, the applicant may:

- file a request for a search and examination report,
- file a request for an examination report, or
- delete the claim(s) in the Singapore application corresponding to the claim(s) or part(s) of the claim(s) in the prescribed information found to be not patentable so the Singapore application proceeds to grant only with the claims corresponding to the claims in the prescribed information found to be patentable.

Alternatively, the applicant may file a divisional application as long as the application is pending.

2.3.7 If the examination results from the PPO or the PCT authorities are negative, an application cannot rely on it for grant. To continue prosecuting the application in Singapore, the applicant may:

- file a request for a search and examination report, or
- file a request for an examination report.

Alternatively, the applicant may file a divisional application as long as the application is pending.

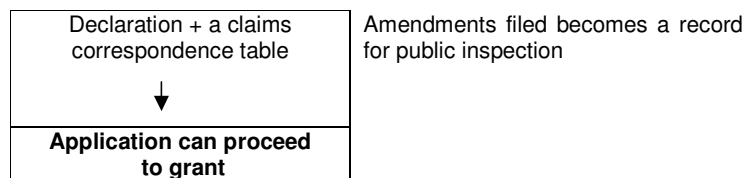
2.3.8 Where the claims in the Singapore application are related to the examined claims referred to in the positive examination results from the PPO or the PCT authorities because they are identical (section 2(4)(a)(i) of the SG Patents Act) without the need for amendments, the application can proceed to grant. It will not be necessary to check if the two sets of claims are related.

2.3.9 Where the claims in the Singapore application are related to the examined claims referred to in the positive examination results from the PPO or the PCT authorities because they have identical limitations or have different limitations only in expression but not in content (section 2(4)(a)(ii) of the SG Patents Act), without the need for amendments, the applicant is required to prepare a claims correspondence table explaining how the two sets of claims are related. It will be necessary to check if the two sets of claims are related.

2.3.10 Where the claims in the Singapore application are not related to the examined claims referred to in the positive examination results from the PPO or the PCT authorities, the applicant has to file voluntary amendments to amend the claims in the Singapore application to be related to the examined claims referred to in the prescribed information. The applicant is also required to prepare a claims correspondence table explaining how the two sets of claims are related. It will be necessary to check if the two sets of claims are related and if the amendments fall within the disclosure of the application as filed.

- 2.3.11 The applicant has one opportunity to file voluntary amendments to the specification and that is at the time of furnishing the prescribed information for the purposes of complying with the related claim requirement and other requirements in the Patents Act and/or the Patents Rules. The process in paragraph 2.3.10 will then apply.
- 2.3.12 Below are the three possible methods to check the related claims requirement and/or the allowability of amendments.
- 2.3.13 Method 1: The applicant files a declaration at the time of furnishing the prescribed information that the two sets of claims are related and if the applicant files amendments to the claims, he has to include in the declaration that the amendments fall within the disclosure of the application as filed. He also has to file a claims correspondence table. The amendments are allowed, the claims are deemed related and the application can proceed to grant.
- 2.3.14 Please see Figure 5 for the process of Method 1.

Figure 5: Method 1 - Declaration



- 2.3.15 Method 2: The applicant submits a written explanation at the time of furnishing the prescribed information that the two sets of claims are related. If the applicant files amendments to the claims, he has to include in the written explanation that the amendments fall within the disclosure of the application as filed. He also has to file a claims correspondence table. In addition, if the Registrar is not satisfied that the requirements are met, the Registrar may direct the applicant to file a request for a claims allowability report with a fee. The claims in the Singapore application will be assessed by an examiner whether they are related to the examined claims referred to in the positive prescribed information (or IPRP). If there are proposed amendments, the proposed amendments will be assessed by the examiner whether they are within the disclosure of the application as filed.
- 2.3.16 If the examiner approves the proposed amendments and the claims, the amendments are allowed, claims deemed related. A positive claims allowability report will be issued and the application can proceed to grant.
- 2.3.17 If the examiner does not approve the proposed amendments and/or the claims, the examiner will indicate in writing an intention to refuse the proposed amendments supported with reasons, and offer applicant an opportunity for hearing. The applicant is given a deadline to request for a hearing or to take the necessary action to remove all objections stated and to put the application in order for acceptance. If the applicant does not take either of the actions by the expiry of the deadline, the application shall be treated as having been abandoned.

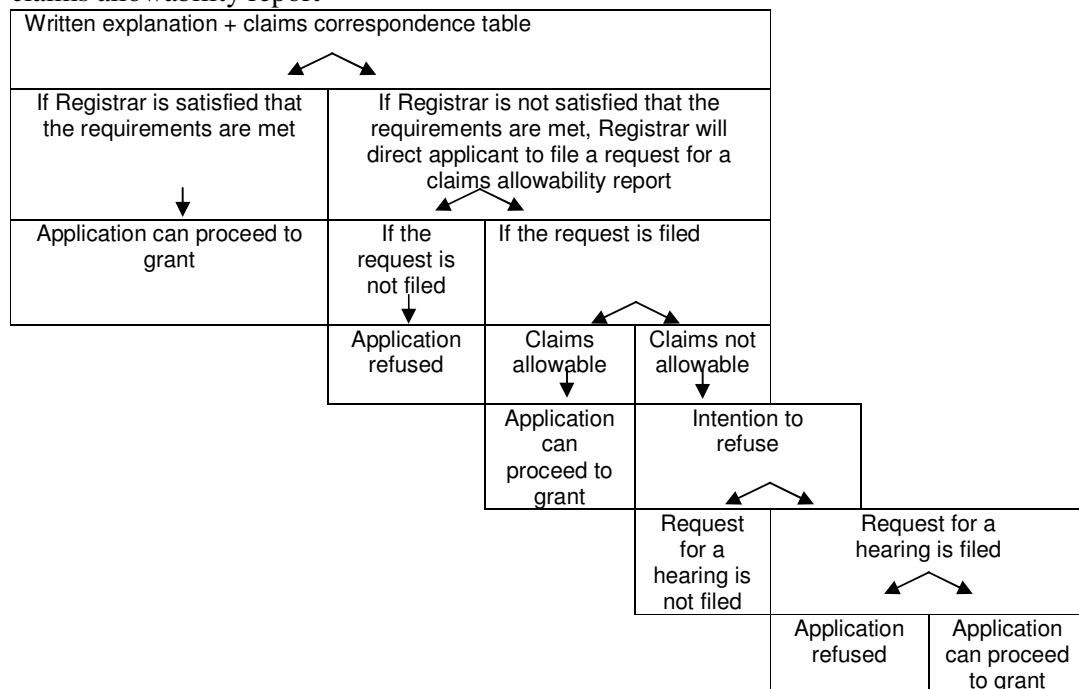
2.3.18 Upon a request for a hearing, a hearing officer, an examiner from the same examination office, will be appointed to hear the case. The applicant may choose to proceed by means of written submissions, telephone-conference or video conference and a hearing fee will be imposed. A hearing via telephone-conference or video-conference will be conducted with the patent applicant or his representative in IPOS and the hearing officer present in his office.

2.3.19 The outcome of the hearing will be either a) examiner’s objections maintained (a negative claims allowability report will be issued), or b) examiner’s objections overruled (a positive claims allowability report will be issued). If a negative claims allowability report is issued, the application will be refused. If a positive claims allowability report is issued, the application can proceed to grant.

2.3.20 If the applicant is not satisfied with the refusal, he may appeal to the court. The applicant may also file a divisional application as long as the application is pending.

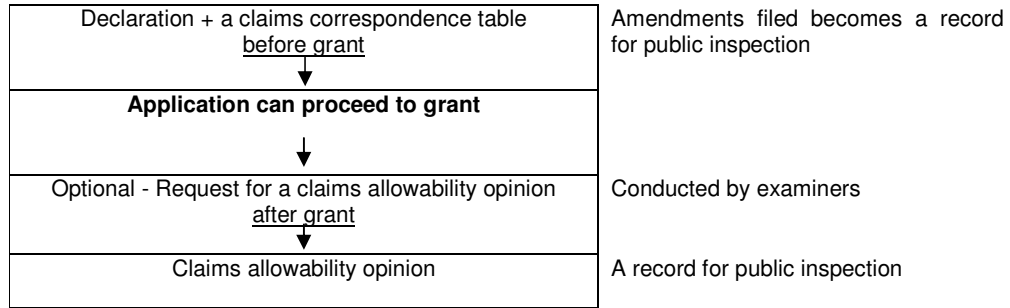
2.3.21 Please see Figure 6 for the process of Method 2.

Figure 6: Method 2 - Written explanation and possible direction to file a request for a claims allowability report



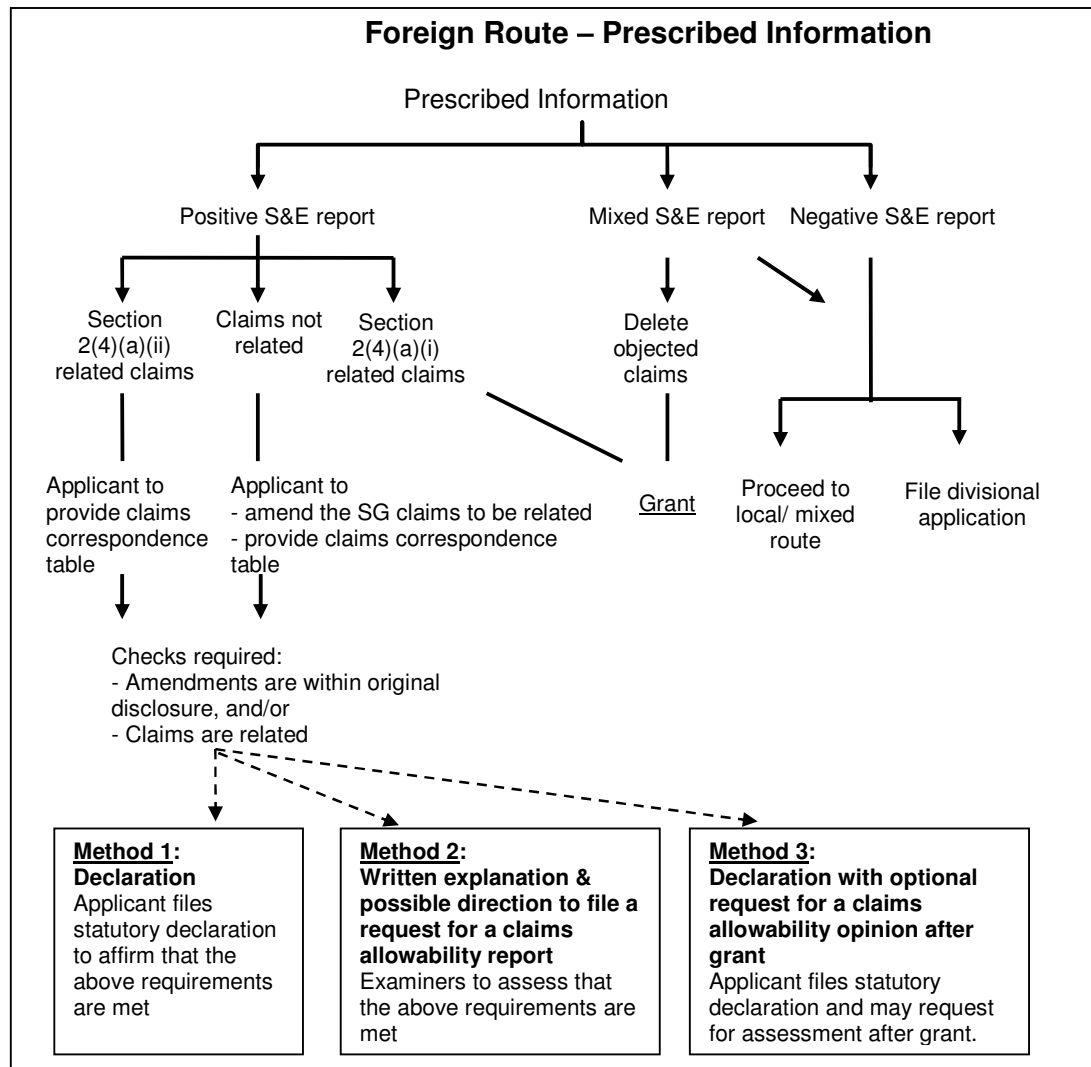
2.3.22 Method 3: The application proceeds to grant based on Method 1 and Method 2 becomes an option available to request for a non-binding claims allowability opinion after grant (this is different from the claims allowability report mentioned in Method 2). A fee will be imposed for this request. The non-binding claims allowability opinion becomes a record for public inspection. Please see Figure 7 for the process of Method 3.

Figure 7: Method 3 - Declaration and optional post-grant claims allowability opinion



2.3.23 The possible paths and methods for claims allowability checks available to an application relying on prescribed information are summarised below.

Figure 8: Summary of Proposed Foreign Route (Prescribed Information)



Invitation 2

1. Do you support the adoption of Method 1, 2 or 3? Given the option of your choice, will the prescribed information route still be attractive to applicants vis-à-vis other routes?
2. For an applicant who has a mixed examination results and has to amend the claims in the Singapore application (as opposed to a mere deletion of objected claims), how do you suggest the application proceed in Singapore besides proceeding to request for a search & examination report or for an examination report or file a divisional application?
3. For all methods, should there be an option for an applicant to request for a claims allowability report before grant?
4. What are your views about the proposed changes to the prescribed information route?

It would be helpful to the Registry if such comments and feedback are accompanied by comprehensive reasons and, where available, examples or situations in support.

2.3.24 **Proposed - IPRP:** Similar in approach as the prescribed information route, foreign route applications relying on IPRP will be allowed grant in Singapore only when the IPRP Chapter I or II are positive and the claims put forth for grant are related to the examined claims referred to in the positive IPRP.

2.3.25 If the IPRP is mixed, an application cannot rely on it for grant. To continue prosecuting the application in Singapore, the applicant may:

- file a request for a search and examination report,
- file a request for an examination report, or
- delete the claim(s) in the Singapore application corresponding to the claim(s) or part(s) of the claim(s) in the prescribed information found to be not patentable so the Singapore application proceeds to grant only with the claims corresponding to the claims in the prescribed information found to be patentable.

Alternatively, the applicant may file a divisional application as long as the application is still pending.

2.3.26 If the IPRP is negative, an application cannot rely on it for grant. To continue prosecuting the application in Singapore, the applicant may:

- file a request for a search and examination report, or
- file a request for an examination report.

Alternatively, the applicant may file a divisional application as long as the application is still pending.

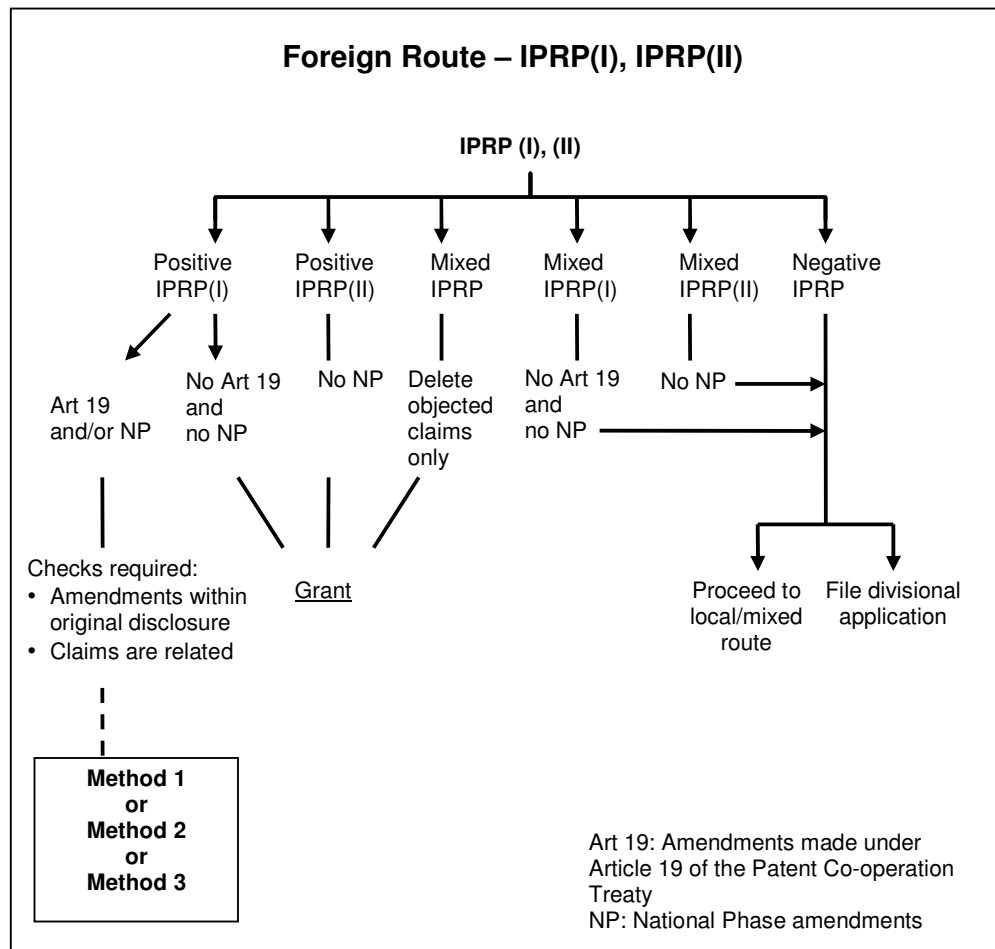
2.3.27 If the IPRP (I) is positive and no amendments have been made at international or national phase or IPRP(II) is positive and no amendments have been made at national phase, the application may proceed to grant. It will not be necessary to check if the claims in the Singapore application and the claims referred to in the IPRP are related.

2.3.28 If the IPRP is positive and amendments are made under Article 19 of the Patent Co-operation Treaty and/or during national phase entry, it will be necessary to check if the two sets of claims are related and if the amendments fall within the disclosure of the application as filed. The same three methods discussed from paragraphs 2.3.12 to 2.3.22 are proposed.

2.3.29 The applicant has one opportunity to file voluntary amendments to the specification and that is at the time of filing the notice to rely on IPRP for the purposes of complying with the related claim requirement and other requirements in the Patents Act and/or the Patents Rules. The process in paragraph 2.3.28 will then apply.

2.3.30 The possible paths and claims allowability checks available to an application relying on IPRP are summarised below.

Figure 9: Summary of Proposed Foreign Route (IPRP)



Invitation 3

1. Do you support the adoption of Method 1, 2 or 3? Given the option of your choice, will the foreign route relying on IPRP still be attractive to applicants vis-à-vis other routes?
2. For an applicant who has a mixed IPRP and has to amend the claims in the Singapore application (as opposed to a mere deletion of objected claims), how do you suggest the application proceed in Singapore besides proceeding to request for a search & examination report or for an examination report or file a divisional application?
3. For all methods, should there be an option for an applicant to request for a claims allowability report before grant?
4. What are your views about the proposed changes to the foreign route relying on IPRP route?

It would be helpful to the Registry if such comments and feedback are accompanied by comprehensive reasons and, where available, examples or situations in support.

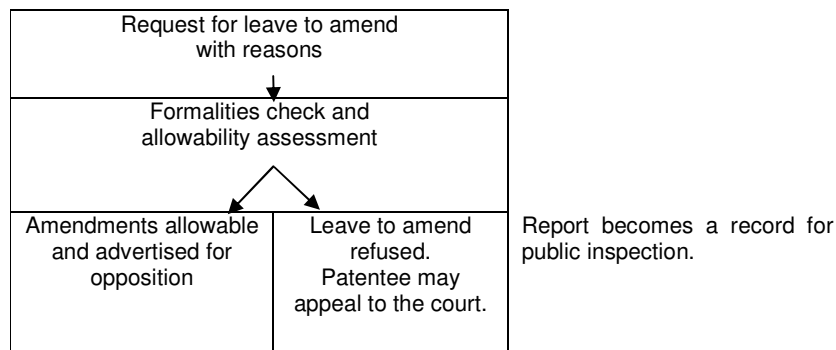
2.4 Proposed PSA Changes: Post-Grant Amendments

2.4.1 **Current:** Post-grant amendments are limited to amendments which do not disclose additional matter or extend the scope of protection conferred by the patent (section 84(3) of the Patents Act). Amendments filed are advertised and if there are no objection lodged by third parties the amendments will be accepted.

2.4.2 **Proposed:** It is proposed that all post-grant amendments be examined. The patentee files a request for leave to amend with reasons for the post-grant amendments and details of the amendments including a claims correspondence table. The amendments will be subjected to formalities check and assessment of allowability. If the outcome of the allowability opinion is positive, the amendments are deemed allowable and the amendments will be advertised for opposition. In the absence of objection by third parties, the amendments will be accepted. If the outcome of the allowability opinion is negative, the amendments are deemed not allowable. The report then becomes a record for public inspection. The patentee may appeal to the court.

2.4.3 Please see Figure 10 for the process on post-grant amendments.

Figure 10: Proposed process on post-grant amendments



Invitation 4

1. What are your views about the proposed mandatory post-grant amendments allowability opinion for amendments filed after grant?

It would be helpful to the Registry if such comments and feedback are accompanied by comprehensive reasons and, where available, examples or situations in support.

2.5 Proposed PSA Changes: Post-grant Search & Examination

- 2.5.1 **Current:** A post-grant search and examination report of a patent may be requested by any party on the grounds that the claim(s) is not related to the examined claim(s) or the examiner did not consider all the relevant prior art in the examination report. In the request, the requestor may make observations in relation to the patent and enclose any document considered relevant for the purpose of the examination.
- 2.5.2 Upon receipt of the request and if the requestor is not the patentee, IPOS notifies the patentee. During the examination period, patentee may respond to the written opinion and propose amendments. Upon completion, the examination report will be sent to both the requestor and patentee.
- 2.5.3 The examination report is a non-binding opinion and becomes a record for public inspection.
- 2.5.4 **Proposed:** To facilitate the examination work, the patentee will be allowed to make observations before the commencement of the examination.

Invitation 5

1. What are your views about maintaining the grounds for requesting for a post-grant search and examination?
2. What is your view about the proposed minor process change in allowing patentee to make observations?

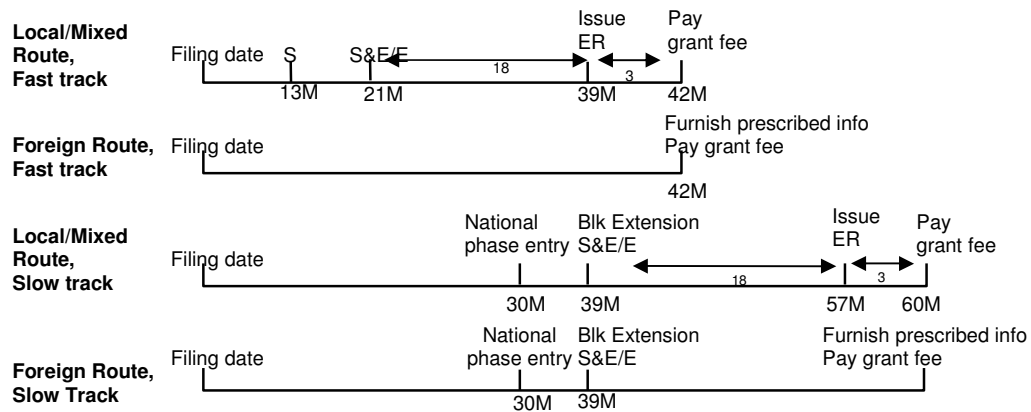
It would be helpful to the Registry if such comments and feedback are accompanied by comprehensive reasons and, where available, examples or situations in support.

3 Other Proposed Changes: Patent Application Process

3.1 In light of the changes discussed in Section 2 of this paper, the application process will invariably be modified to cater for the proposed changes. This section discusses 2 possible options of modifying the application process. Proposed Process Option 1 adopts a minimal-change approach where all the filing routes and fast-slow tracks are retained, and timelines undergo adjustments to meet certain requirements of a positive grant system. Proposed Option 2 takes a clean slate approach where on top of fitting in the requirements for a positive grant system, existing filing routes, fast-slow tracks and timelines are reviewed. In doing so, a new streamlined framework of processing applications is conceptualized.

3.2 **Current:** Below is the current set of timelines

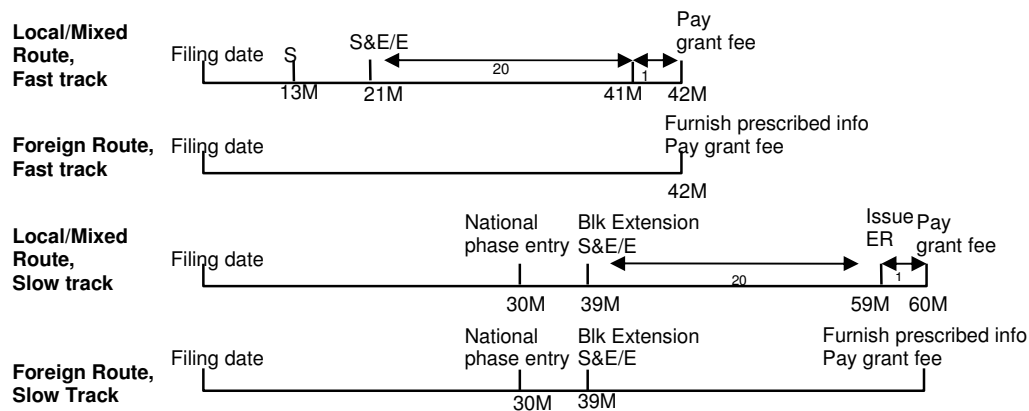
Figure 11: Current Timelines



3.3 Under a positive grant system, an applicant has to obtain a positive examination report within the given time, or extended time where an extension of time has been obtained.

3.4 **Proposed Process Option 1:** As discussed earlier, the deadline for filing a request for search & examination report or for an examination report will be changed to 20 months (paragraph 2.2.9). With the deadline to pay grant fee remaining fixed at 42 months (60 months for slow track), the applicant has 1 month from the issuance of the examination report to pay grant fee. Process Option 1 proposes only a minor adjustment to deadlines. Below diagram illustrates the proposed Process Option 1.

Figure 12: Proposed Process Option 1

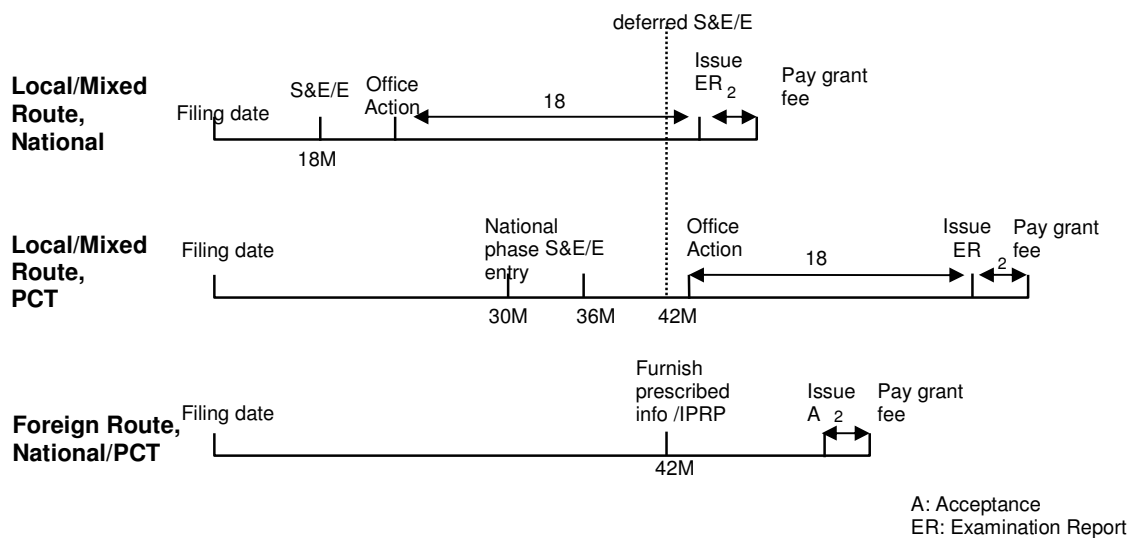


- 3.5 **Proposed Process Option 2:** This option works on the premise that the 20 months provided for the search & examination process in the proposed Process Option 1 is not sufficient. Hence more time is needed to overcome objections by the examiner, in the case of a mixed or negative written opinion. It is important to note in this review that while the applicant requires as much time as necessary to overcome the objections, it is equally important to ensure that this be carried out in an efficient and fair manner to ensure certainty to the public.
- 3.6 Process Option 2 also includes a comprehensive review of the search & examination routes, application processes and deadlines.
- 3.7 The proposed Process Option 2 is outlined as follow:
- The 2-track system will no longer apply.
 - The timelines for local/mixed route-national applications are:
 - The deadline to request for a search and examination report or for an examination report will be brought forward to 18 months instead of the current 21 months. This deadline will coincide with the 18th month publication.
 - If the applicant wishes to commence search & examination/examination at a later time, he may file a request for deferred search & examination report or for a deferred examination report by 42 months.
 - The entire search & examination process must complete within 18 months from the date of the first written opinion. At the end of this 18-month period, the examiner issues the positive examination report or the intention to issue a mixed/negative report and offer an opportunity for hearing. Upon issuance of the positive examination report, applicant has 2 months to pay grant fee. As such, the current deadline to pay grant fee at 42 months will no longer apply.
 - The option to request for a search report will be discontinued. Past filing statistics has shown that the demand for this service has been low.
 - The timelines for local/mixed route – PCT applications are:
 - The deadline to request for search and examination report or for an examination report is 36 months.

- If applicant wishes to commence search & examination/examination at a later time, he may file a request for deferred search & examination report or for a deferred examination report by 42 months.
 - The entire search & examination process must complete within 18 months from the date of the first written opinion. At the end of this 18-month period, the examiner issues the examination report (positive) or the intention to issue a mixed/negative report and offer an opportunity for hearing. Upon issuance of the positive examination report, applicant has 2 months to pay grant fee. As such, the current deadline to pay grant fee at 42 months (or 60 months for slow track) will no longer apply.
- d) For foreign route applications, the deadline to furnish prescribed information, IPRP(I) or IPRP(II) is 42 months. Upon acceptance by IPOS, the applicant has 2 months to pay grant fee.

3.8 The proposed changes in Process Option 2 are summarised below.

Figure 13: Proposed Process Option 2



Invitation 6

1. What are your views about the proposed Process Options 1 and 2?
2. Do you support the adoption of Process Option 1 or 2?

It would be helpful to the Registry if such comments and feedback are accompanied by comprehensive reasons and, where available, examples or situations in support.

4 Other Proposed Changes: Extension of time (including Protection and compensation of persons affected by extension of time)

4.1 Proposed Change 1: Increase automatic extension of time from 3 months to 6 months

4.1.1 **Current:** The present extension of time (EOT) system is multi-situational – there is a different EOT process for different situations.

4.1.2 For times or periods that can be extended with a fee (rules 108(3), (4) and (6) of the SG Patents Rules), they can be

- (i) automatically extended by up to 3 months if there was no previous extension. An official form is required. This must be done before the end of the extended period.
- (ii) be extended or further extended only if the Registrar allows. An official form is required. A statutory declaration or affidavit setting out the ground for the request must be furnished. If the Registrar allows the extension, a further official form and fee need to be filed.

4.1.3 For times or periods that can be extended without the requirement of a fee (rule 108(1) of the SG Patents Rules), they can be extended only if the Registrar allows. Request is made to the Registrar in writing. There is no official form required.

4.1.4 **Proposed:** It is proposed that for automatic EOT, blocks of 3-month up to a maximum of 6 months be given, instead of the current up to 3 months EOT. This will simplify the EOT system to make it easier procedurally for applicants to request and obtain EOTs and for Registry officers to process EOTs.

4.1.5 Consequential amendment will be required of rules 109(1) and (2) where the period of extension is more than 6 months, instead of the current 3 months.

Invitation 7

1. We welcome views over the proposal to increase automatic EOT period from 3 months to 6 months.
2. We welcome views over the proposal to allow automatic EOT requests in blocks of 3 months.

It would be helpful to the Registry if such comments and feedback are accompanied by comprehensive reasons and, where available, examples or situations in support.

4.2 Proposed Change 2: Limiting specific time limits to automatic EOT only (applicable only if the proposal in Section 3 of this paper is implemented)

4.2.1 **Current:** Currently, there is no limit to the EOT sought for the time limits specified in rule 108(3) of the SG Patents Rules.

4.2.2 **Proposed:** It is proposed to allow only automatic EOT up to the maximum of 6 months (and no discretionary EOT) for the periods prescribed for (i) filing a request for a search & examination report or for an examination report, (ii) filing a request for a deferred search & examination report or for a deferred examination report, and (iii) meeting the requirements for grant. This will ensure that third parties are not burdened by an overly lengthy application process as a pending application creates uncertainty of the patent protection that may eventually be accorded to patentees.

4.2.3 For (i), the application will not be treated as having been abandoned if the request for a search and examination report or for an examination report is not filed by this period or as extended as there are other search and examination options available later down the application timeline (e.g., deferred search & examination, and furnishing of prescribed information).

4.2.4 For (ii), if the request for a deferred search & examination report or for a deferred examination report is not file or the prescribed information is not furnished by this period or as extended, the application shall be treated as having been abandoned.

4.2.5 For (iii), if the conditions for grant are not met by this period or as extended, the application shall be treated as having been abandoned.

Invitation 8

1. We welcome views over the proposal to allow only automatic EOT up to the maximum of 6 months (and no discretionary EOT) for the periods prescribed for (i) requesting examination/search and examination report, (ii) requesting deferred examination/search and examination report, and (iii) meeting the requirements for grant.

It would be helpful to the Registry if such comments and feedback are accompanied by comprehensive reasons and, where available, examples or situations in support.

5 Other Proposed Changes: Restoration

5.1 Proposed Change 1: Change criterion for restoration from “reasonable care” to “unintentional”

- 5.1.1 **Current:** A patent owner in the restoration of a lapsed patent must satisfy the Registrar that he took reasonable care to see that any renewal fee was paid within the prescribed period or that that fee and any prescribed additional fee were paid within the 6 months immediately following the end of that period.
- 5.1.2 Section 39(5) of the SG Patents Act is in pari materia with section 28(3) of the UK Patents Act 1977 (as amended by the Copyright, Designs and Patents Act 1988) and quoting a comment of Aldous J in *Continental Manufacturing & Sales Inc’s Patent* (1994 RPC 535) which was a decision on UK section 28(3), he said that “the words ‘reasonable care’ do not need explanation. The standard is that required of the particular patentee acting reasonably ensuring that the fee is paid”.
- 5.1.3 Aldous J in *Ament’s Application* 1994 RPC 647 also on UK section 28(3) said that “I have come to the conclusion that a patentee who merely establishes inability to pay does not establish that he has taken reasonable care to see that the fee is paid. To establish that, he must go further and show that he wanted to pay and that he had taken reasonable care to ensure that he was in a position to pay.”
- 5.1.4 In the UK, the provision was amended on 1 January 2005 by the Regulatory Reform (Patents) Order 2004 and the criterion for restoration has been changed from “reasonable care” to “unintentional”.
- 5.1.5 This “unintentional” test is said to be generally far less stringent than that of “reasonable care”.
- 5.1.6 As to what is envisaged behind the test of “unintentional”, the UK case of *Matsushita Electric Industrial Co. v Comptroller General of Patents* [2008] EWHC 2071 (Pat), provides some guidance when Justice Mann held that a mere assertion that the failure to pay the renewal fee was unintentional is not sufficient to enable the Comptroller to determine that the requirements of section 28(3) are fulfilled. Hence, some evidence above and beyond a bald assertion of the law is required.
- 5.1.7 To ensure that our laws remain relevant and current, we reviewed the requirements in a few jurisdictions and we found a variety of tests and to illustrate, we list some of them as follow:- restoration if it is shown that the failure was unintentional or unavoidable, or due to reasons not attributable to the original patentee or that non payment was due to accident, mistake or other unforeseeable circumstances.
- 5.1.8 **Proposed:** In Singapore, we are inclined to take a similar approach as in the UK, where the criterion for restoration has been changed in 2005 from “reasonable care” to “unintentional”. We propose to change the criterion for restoration from “reasonable care” to “unintentional”.

Invitation 9

1. We welcome views over the proposal to change the criterion for restoration from “reasonable care” to “unintentional”.

It would be helpful to the Registry if such comments and feedback are accompanied by comprehensive reasons and, where available, examples or situations in support.

5.2 Proposed Change 2: Change period to seek restoration from 30 months to 20 months

5.2.1 **Current:** An application for the restoration of a lapsed patent may be made at any time within 30 months from the day on which it ceased to have effect.

5.2.2 This “30 months” period was introduced on 1 Apr 1997 via the Patents (Amendment) Rules 1997 thereby deleting the previous period of “12 months”. One reason for this change then was to provide sufficient time for restoration of lapsed patents that were registered under the Registration of UK Patents Act (now repealed) [RUKPA] and transitioned over to the Patents Act (Chapter 221).

5.2.3 In the same vein as mentioned above, in order to ensure that our laws remain relevant and current, we also reviewed the requirements in a few jurisdictions and we found that the period provided for restoration ranged from 6, 12, 24 to 30 months from the date of expiry to pay the renewal fees.

5.2.4 However, from a survey conducted on the profile of restoration requests that we had received in the last 3 years, notwithstanding that patentees currently have 30 months to seek restoration of lapsed patents in Singapore, many had done so within 18 months.

5.2.5 **Proposed:** Hence, we see 20 months to be a reasonable period for seeking restoration. In this proposal, after the 6-month late renewal period, patent owners will have 14 months where they can apply to restore the lapsed patent.

Invitation 10

1. We welcome views over the proposal to replace the current “30 months” requirement with “20 months”.

It would be helpful to the Registry if such comments and feedback are accompanied by comprehensive reasons and, where available, examples or situations in support.

6 Other Proposed Changes: Renewal Reminder

- 6.1 **Current:** It is only after the period for payment of a renewal fee has expired and if the fee still remains unpaid, that the Registrar is required to send, not later than one month from the last date for payment, to the proprietor of the patent a notice reminding him that payment is overdue and of the consequences of non-payment.
- 6.2 This after expiry notice may not prove to be effective as it is sent only after the reminder due date has passed and the proprietor wishing to renew during the 6-month grace period is required to pay any outstanding renewal fees plus its corresponding late fees.
- 6.3 **Proposed:** To give the proprietor more time to prepare for the renewal of the patent, it is proposed that the reminder notice be sent to him before the period for payment of a renewal fee has expired. This notice will be sent by the Registrar not earlier than 6 months nor later than one month before the period for payment of a renewal fee has expired, notifying him of the imminent expiry of the period and of the consequences of non-payment.

Invitation 11

1. We welcome views over the proposal to provide for a pre-expiry renewal notice instead.

It would be helpful to the Registry if such comments and feedback are accompanied by comprehensive reasons and, where available, examples or situations in support.

- 7 Other Proposed Changes: Second or Subsequent New Medical Use Claims**
- 7.1 **Background:** Section 14(7) of the SG Patents Act mirrors section 2(6) of the UK Patents Act 1977 before it was amended via the UK Patents Act 2004. In turn, the UK provision shares its roots with a corresponding article in the European Patent Convention.
- 7.2 As one reads this provision, one will invariably notice that it provides an exception as to what is conventionally known to be the test for novelty. Very simply put, it says that in the context of a medical use, an invention can be new notwithstanding that the invention consists of a known product if the use of that product in the medical use context is new.
- 7.3 This leads us to section 16(2) of the SG Patents Act (UK & EPC share similar features) which prevents an invention of a method of treatment of the human or animal body by surgery or therapy or of diagnosis practised on the human or animal body, from being capable of industrial application. This exception to patentability finds support in Article 27(3)(a) of the Agreement on Trade Related Aspects of Intellectual Property Rights (TRIPS) which says that “Members may also exclude from patentability: diagnostic, therapeutic and surgical methods for the treatment of humans or animals”.
- 7.4 **Current:** Hence, what we see in patent legislation in general, is an attempt to balance the interests of both the patent holders as well as the public at large. On one hand, there is a need to encourage medical research with regards to methods of medical treatment on humans and animals but on the other hand, we should be cautious not to unduly restrain the practice of those who perform such medical treatments.
- 7.5 With this balance in mind, case law in UK and Europe prior to the relatively recent amendments have interpreted the SG section 14(7) equivalent to allow for a known product to be patented on the basis of its new medical use (i.e. first medical use), even though that use is itself unpatentable. In addition, with the emergence of second or subsequent new medical uses, judges started recognizing novelty in them if the patent claims are drafted in a certain manner (also known as “Swiss-type claims”). This however spurred a proliferation of case law and some questioned whether such an interpretation had the necessary legislative support.
- 7.6 This concern was addressed in one of the amending provisions found in the UK Patents Act 2004 and in the Explanatory Notes which was released, the amendment to UK section 2(6) as it was then was explained as follows:
19. New section 4A(3) and (4) is concerned with the patentability of inventions consisting of a known substance or composition for use in a method of treatment or diagnosis, and corresponds to Article 54(4) and (5) EPC 2000. While these subsections do not extend the availability of patent protection in respect of an invention consisting of a substance or composition for use in a method of treatment or diagnosis, they simplify and clarify the manner in which patent protection may be obtained for such inventions.

20. To be patentable, an invention must be new. Existing section 2(6), which corresponds to Article 54(5) EPC, provides for the patentability of an invention consisting of a known substance or composition for use in a method of treatment or diagnosis when the substance or composition is first used in any such method. The invention is considered to be new if the use of the substance in any such method is unknown. New section 4A(3) has the same effect, so that such an invention is considered novel where the substance or composition is first used in a method of treatment or diagnosis.

21. Where the substance or composition is subsequently used in a method of treatment or diagnosis which is different from the method in which it was first used, the courts have held, on the basis of existing section 2(6), that the subsequent use may be regarded as new but only if the invention is claimed in the form "Use of X for the manufacture of a medicament to treat Y", where X is the known substance and Y is the medical condition in question. This is known as the Swiss form of claim, since it was first used in the Swiss Patent Office before becoming embodied in EPO practice.

22. New section 4A(4) enables patent protection to be obtained for the second or subsequent use of a substance or composition in a method of treatment or diagnosis by a direct claim in the form "Substance X for use in treatment of disease Y". The second or subsequent use, that is, the "specific use" of a known substance or composition in a method of treatment or diagnosis, is treated as new if that specific use was previously unknown. Where patent protection is sought for a substance or composition for specific use in a method of treatment or diagnosis, the Swiss form of claim will still be possible, but inventions may now be claimed in the simpler form.

- 7.7 The above provides a nutshell of the position in Europe where we see a delicate balance being achieved thereby encouraging medical research without compromising public interest.
- 7.8 In the US however, we see a different approach taken whilst maintaining that delicate balance at the same time. Inventions relating to medical treatment are not barred from patentability. Hence, medical treatment in the US can be the subject of patent protection. To ensure that the public's interests are not derogated, the US Patents Code exempts a medical practitioner's performance of a medical activity from patent infringement.
- 7.9 **Proposal:** In Singapore, as we review our patent laws to ensure that they remain relevant and current, we are exploring a few options and they include whether we should follow the European approach or the US approach in respect of medical use inventions.
- 7.10 Given our ancestral roots and legislative background including the case law to which we are familiar with, the European approach may be the way to go. This said, we might wish to take this opportunity to consider (with Singapore's biotech, healthcare

and medical hub initiatives in mind), whether it is necessary to move away from our comfort zone and consider instead the US approach.

- 7.11 Another possibility is that we remain status quo. If the amendments in the UK Patents Act 2004 on medical treatment codified the European practice existing then, one questions whether the practice can continue to apply to provisions prior to the UK 2004 amendments, similar to our current Section 14(7).
- 7.12 Yet another possibility is not to allow patent protection for second or subsequent new medical uses. This stems from fears that such protection may encourage activities akin to the advent of “evergreening” practices, where the patent term is extended by obtaining new patents relating to modifications of the original product, thereby extending the patent holder’s monopoly. One may argue that we can leave it to case law to determine as to what extent second or subsequent new medical uses are allowable but the flipside to this argument is that uncertainty arises in the absence of any written laws to the contrary.

Invitation 12

1. We welcome views over whether Singapore should :-
 - (a) follow the European approach,
 - (b) follow the US approach,
 - (c) remain status quo, or
 - (d) not to allow patent protection for second or subsequent new medical uses.

It would be helpful to the Registry if such comments and feedback are accompanied by comprehensive reasons and, where available, examples or situations in support.

IPOS takes a long term view on whether it should build its own local S&E capability, a subject matter that is reviewed regularly. It should be noted that the consideration of building Singapore’s own local search and examination capability is not part of this public consultation. Any feedback received will be used for future review on the subject.