



INTELLECTUAL PROPERTY  
OFFICE OF SINGAPORE

## **PUBLIC CONSULTATION**

INTELLECTUAL PROPERTY (AMENDMENT) BILL 2021

**INTELLECTUAL PROPERTY OFFICE OF SINGAPORE**  
**JULY 2021**

## **INTRODUCTION**

1. The Intellectual Property Office of Singapore (“**IPOS**”) is seeking feedback on the Intellectual Property (“**IP**”) (Amendment) Bill 2021 (the “**Bill**”) and corresponding amendments to the respective IP subsidiary legislation. The drafts are attached as **Annex A and Annex B** respectively.
2. The period of public consultation is **from 15 July 2021 (Thursday) to 5 August 2021 (Thursday)** (the “**Consultation Period**”).

## **BACKGROUND**

3. Following the public consultation on the proposed changes to simplify and streamline IP processes and improve user experience with digital initiatives in August 2020 (“**August 2020 Public Consultation**”) <sup>1</sup>, suggestions received from stakeholders have been considered to further shape IPOS’ policies.
4. IPOS now wishes to introduce legislative changes to the various IP legislation<sup>2</sup>, *inter alia*, to implement the intended policies.
5. IPOS invites you to provide your feedback on the Bill and corresponding amendments to the respective IP subsidiary legislation (collectively, the “**Proposed Amendments**”).
6. At this point in time, we are not seeking views on the policy positions which are set out in the August 2020 Public Consultation or any refinements that we have made to those positions in the course of preparing the draft Bill, save where otherwise indicated in this paper below. We are also not seeking views on proposed amendments to the IP subsidiary legislation which are not related to the Bill.

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<sup>1</sup> Public Consultation: Changes to Simplify Intellectual Property Processes and Improve User Experience with Digital Initiatives, August 2020.

<sup>2</sup> The relevant IP legislation which will be amended are as follows: the Patents Act and Rules, the Trade Marks Act and Rules, the Trade Marks (International Registration) Rules, the Registered Designs Act and Rules, the Geographical Indications Act and Rules and the Plant Varieties Protection Act and Rules.

## **FORMAT OF PAPER**

7. This public consultation paper is organised into five sections:
  - (a) Section I: Patents
  - (b) Section II: Trade Marks
  - (c) Section III: Registered Designs
  - (d) Section IV: Plant Varieties Protection
  - (e) Section V: Amendments which are common to more than one IP (hereafter referred to as “**Cross-IP Amendments**”)
8. Each of these sections sets out a list of the main changes to each IP regime, together with a description of the proposed legislative amendments sought to effect these changes.
9. As you review the proposed legislative amendments, please consider the following general questions:
  - (a) Is there any ambiguity or lack of clarity in how a proposed change or provision is framed, whether in terms of scope of application, definition or other technical aspects of the provision? If so, how may these be addressed?
  - (b) Does any of the proposed changes result in consequences which may impact existing provisions which have not been adequately catered for? If so, what are these consequences and how may they be addressed?
10. In addition to the general questions, where relevant, specific question regarding a particular change or proposed amendment may be asked within each section. We invite you to respond to them as well.
11. As this public consultation is to seek feedback on the Proposed Amendments only, it is not necessary to provide comments to legislative amendments that are beyond the scope of the Proposed Amendments.
12. We emphasise that the Proposed Amendments set out in **Annex A and Annex B** are merely drafts for the purposes of this public consultation paper, and are subject to change as they will continue to undergo the legislative drafting and vetting process after the Consultation Period.

## **SUBMISSION OF COMMENTS**

13. Please provide your feedback via [FormSG](#). In your submission, please indicate your name, email address, the organisation you represent (if applicable) and your designation in the organisation (if applicable).
14. We welcome your comments on any or all of the questions.

15. We will consider your comments and where possible, incorporate them in the finalised Bill for introduction in the Parliament.
16. IPOS reserves the right to make public all or part of any written submission. Commenting parties may request for confidentiality for any part of the submission that is believed to be proprietary, confidential or commercially sensitive. Any such information should be clearly marked.
17. Please contact us at [IPOS\\_Consultation@ipos.gov.sg](mailto:IPOS_Consultation@ipos.gov.sg) if you have any queries on the public consultation.

#### **CLOSING DATE FOR SUBMISSION**

18. As the Consultation Period will end on 5 August 2021, please provide your feedback by **5 August 2021**. IPOS reserves the right not to consider any submissions received after 5 August 2021.

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## **SECTION I: PATENTS**

These are the changes proposed for the Patents regime:

- A. Introducing express provisions in respect of submission of sequence listing;
- B. Removing the obligation to furnish prescribed documents in certain prescribed circumstances during the patent prosecution process;
- C. Clarifying existing provisions;
- D. Inviting amendment to an application in lieu of a written opinion;
- E. Refining the examination review process;
- F. Removing the form and accompanying fee for publication of international patent application in English; and
- G. Providing express power for Registrar to make documents for published patent applications available to the public.

### A: Introducing express provisions in respect of submission of sequence listing

- A.1 The proposed amendments will specify that when a patent specification discloses a sequence listing, the furnishing of a sequence listing shall be mandatory. The format of the sequence listing shall be specified in the Practice Directions.
- A.2 If the sequence listing is not provided or not provided in the format as indicated in the Practice Directions issued by the Registrar, the Registrar may invite the applicant to furnish the sequence listing presented in a manner that complies with the Practice Directions for the purposes of search but the sequence listing does not form part of the application. However, this does not prevent the applicant from amending the description of an application for a patent in relation to a sequence listing.
- A.3 To give effect to the above, the following amendments are proposed:
  - (a) Amendment of s25 of the Patents Act;
  - (b) Amendment of r2 of the Patents Rules to introduce the definition of “sequence” and “sequence listing”; and
  - (c) Introduction of new r19A to the Patents Rules.

B: Removing the obligation to furnish prescribed documents in certain prescribed circumstances during the patent prosecution process

- B.1 If the document in respect of the earlier relevant application has been previously filed at the Registry, applicants need not provide a copy of the earlier relevant application or its English translation, when making a request to:
- (a) Incorporate the description in the patent application by reference;
  - (b) File the missing parts; or
  - (c) Support the declaration of a claim of right of priority.
- B.2 To give effect to the above, the following amendments are proposed:
- (a) Amendment of s26 and s28 of the Patents Act; and
  - (b) Amendment of r9B, r9C, r26, r26A and r34 of the Patents Rules.
- B.3 If the Registrar had earlier sent a copy of the final result of the search or final result of the international search report (as the case may be) in English language to the applicants, applicants need not provide the copy of the search result, when making a request for an examination report.
- B.4 To give effect to the above, the following amendments are proposed:
- (a) Amendment of s29 of the Patents Act; and
  - (b) Amendment of r42 of the Patents Rules.

C: Clarifying existing provisions

- C.1 The proposed amendment in s 29(1) of the Patents Act will clarify the application of s29(1)(a) of the Patents Act in relation to divisional applications<sup>3</sup>.
- C.2 To give effect to the above, the following amendment is proposed:
- (a) Amendment of s29 of the Patents Act.

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<sup>3</sup> Read with s26(11) of the Patents Act and r45(3) of the Patents Rules.

D: Inviting amendment to an application in lieu of a written opinion

- D.1 At any time before the examination process is concluded, if the Examiner is of the opinion that the matter could be resolved by a notice to the applicant inviting amendment to the application (the “notice”) without a written opinion, the notice will be issued in lieu of a written opinion. The notice is only applicable in relation to a request for a search and examination report and a request for an examination report.
- D.2 The response to the notice must be made within the prescribed period of two months (an extension of which, under r108 of the Patents Rules, will not be allowed) and in the prescribed manner. The Examiner may issue a written opinion or a further written opinion but only after the prescribed period of two months has expired or after the applicant responds to the notice, whichever is earlier.
- D.3 To give effect to the above, the following amendments are proposed:
- (a) Amendment of s29 of the Patents Act;
  - (b) Amendment of r51A and r108 of the Patents Rules; and
  - (c) Introduction of r46AA to the Patents Rules.
- D.4 For more information, please refer to pages 4 and 5 of the August 2020 Public Consultation [here](#).

E: Refining the examination review process

- E.1 During an examination review, if an applicant amends the specification for the purpose of overcoming all unresolved objections in the earlier examination report, it is proposed that the Examiner will not be required to agree or disagree with the objections raised in the earlier examination report. The Examiner will only need to assess whether the amendments have overcome the objections in the earlier examination report.
- E.2 To give effect to the above, the following amendment is proposed:
- (a) Amendment of s29B of the Patents Act.
- E.3 For more information, please refer to pages 6 to 7 of the August 2020 Public Consultation [here](#).

F: Removing the form and accompanying fee for publication of international patent application in English

- F.1 Applicants will no longer be required to file a form and pay a fee for the publication of English translation of a non-English international patent application that has entered national phase in Singapore<sup>4</sup>. Subject to the 18-month publication period or any request

<sup>4</sup> This applies to an international patent application that has entered the national phase in Singapore on or after the commencement date of the Bill.

for early publication, the Registrar will publish the English translation automatically if the English translation has been filed at the Registry. The proposed amendments will make it clear that certain rights of a granted patent are conferred from the date the patent application is published<sup>5</sup>.

F.2 To give effect to the above, the following amendments are proposed:

- (a) Amendment of s86 of the Patents Act; and
- (b) Amendment of r86 of the Patents Rules.

F.3 For more information, please refer to page 8 of the August 2020 Public Consultation [here](#).

G: Providing express power for Registrar to make documents for published patent applications available to the public

G.1 IPOS launched the Patents Open Dossier (the “POD”) in 2017 to provide the public with easier access to certain patent documents<sup>6</sup>. The proposed amendment will make it clear that IPOS can now make such documents publicly available without any request being made<sup>7</sup>, except where certain restrictions apply (for e.g. where documents are to be treated as confidential).

G.2 To give effect to the above, the following amendment is proposed:

- (a) Amendment of s108 of the Patents Act.

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<sup>5</sup> For example, to bring proceedings in the court or before the Registrar for damages in respect of any act which would have infringed the patent pursuant to s76 of the Patents Act.

<sup>6</sup> Examples of documents include search reports, examination reports, written opinions, written submissions in response to written opinions, examination review reports, and amendments and corrections to specifications or abstracts. This is applicable for applications lodged on or after 14 February 2014.

<sup>7</sup> This will be in addition to existing provisions for IPOS to permit documents to be inspected by any person upon formal request and payment of fee.



## **SECTION II: TRADE MARKS**

These are the changes proposed for the Trade Marks regime:

- A. Clarifying the period that an expired mark is regarded as an earlier trade mark;
- B. Introducing partial refusal mechanism for national trade mark applications; and
- C. Implementing “continued processing” for trade mark applications that are treated as withdrawn.

### A: Clarifying the period that an expired mark is regarded as an earlier trade mark

- A.1 The proposed amendments are to clarify that insofar as a registered trade mark is eligible to be renewed and/or restored, it would be regarded as an earlier trade mark. This clarifies that a trade mark would continue to be regarded as an earlier trade mark if the time period to renew or restore the registration has been extended, such as in special circumstances<sup>8</sup>.
- A.2 The proposed amendments will also clarify that an earlier trade mark that is an international trade mark (Singapore) will continue to be regarded as an earlier trade mark until IPOS receives the notification in case of non-renewal from the International Bureau.
- A.3 To give effect to the above, the following amendments are proposed:
  - (a) Amendment of s8 of the Trade Marks Act; and
  - (b) Introduction of new r17A to the Trade Marks (International Registration) Rules.

### B: introducing partial refusal mechanism for national trade mark applications

- B.1 The proposed amendments are to introduce the “partial refusal” mechanism to national trade mark applications. Under the “partial refusal” mechanism, the Registrar may allow a partially refused national trade mark application to proceed to publication even if no response is provided by the prescribed period. This means that only the goods and/or services which do not meet the requirements for registration will be treated as withdrawn, while the remaining goods and/or services can proceed to publication.
- B.2 To give effect to the above, the following amendments are proposed:
  - (a) Amendment of s12, s13, s15 and s17 of the Trade Marks Act; and
  - (b) Amendment of r19, r24 and r26 of the Trade Marks Rules.

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<sup>8</sup> Pursuant to r77C of the Trade Marks Rules.

B.3 For more information, please refer to pages 9 to 11 of the August 2020 Public Consultation [here](#).

C: Implementing “continued processing” for trade mark applications that are treated as withdrawn

- C.1 A trade mark application will be treated as withdrawn if the applicant fails to comply with the deadline to respond to the Registrar’s written notice. In contrast to the current practice where reinstatement can be requested within six months, the trade mark applicant will now be able to file a request within two months from the date the application is treated as withdrawn to continue the processing of the application. The request must be accompanied by the document or thing, the omission of which, led to the lapsed deadline. The two-month period cannot be extended.
- C.2 To give effect to the above, the following amendments are proposed:
- (a) Amendment of s108 of the Trade Marks Act;
  - (b) Amendment of r77 and r77B of the Trade Marks Rules; and
  - (c) Introduction of new r77AA to the Trade Marks Rules.

### **SECTION III: REGISTERED DESIGNS**

These are the changes proposed for the Registered Designs regime:

- A. Clarifying legislation in respect of set of articles and non-physical products; and
- B. Introducing express legal effect to disclaimer.

#### A: Clarifying legislation in respect of set of articles and non-physical products

- A.1 Definition of “article” includes any set of articles while definition of “non-physical product” includes any set of non-physical products. These two definitions, however, do not cover “sets of articles and non-physical products”.
- A.2 For references to “articles and non-physical products”, proposed amendments are made to cover “sets of articles and non-physical products”.
- A.3 To give effect to the above, the following amendments are proposed:
  - (a) Amendment of s12, s13, s26 and s66 of the Registered Designs Act.

#### B: Introducing express legal effect to disclaimer

- B.1 Currently, an applicant or a proprietor may voluntarily indicate a disclaimer to restrict rights conferred to a registered design. The proposed amendments seek to remove any ambiguity as to the legal effect of such a disclaimer. The Registrar may issue Practice Directions to specify the requirements in relation to how disclaimer would be presented. A disclaimer in respect of a registered design shall be entered in the Register.
- B.2 To give effect to the above, the following amendments are proposed:
  - (a) Introduction of new s30A to the Registered Designs Act; and
  - (b) Amendment of r14 and r31 of the Registered Designs Rules.

## **SECTION IV: PLANT VARIETIES PROTECTION**

These are the changes proposed for the protection of plant varieties regime:

- A. Amending the definition of “Examiner”;
- B. Extending of period to furnish information, document or propagating material for examination;
- C. Shifting of technical information from the Act to the Rules in respect to Plant Varieties Protection Journal;
- D. Maintaining the term of grant of protection via late payment of annual fee and clarifying existing provision in relation to when annual fee is due; and
- E. Providing an option for breeder to conduct a Distinct, Uniform, Stable (the “DUS”) test and submit the results.

### A: Amending the definition of “Examiner”

- A.1 The definition of “Examiner” will be amended to include person, organisation or entity (including an international plant variety office or organisation, or a plant variety office or an organisation of a country or territory other than Singapore) appointed by the Registrar for the purpose of referring any question or matter relating to the examination of a plant variety for a grant of protection.
- A.2 To give effect to the above, the following amendment is proposed:
  - (a) Amendment of s2 of the Plant Varieties Protection Act in relation to the definition of “Examiner”.

### B: Extending of period to furnish information, document or propagating material for examination

- B.1 The Registrar or the Examiner may extend the period for an applicant to furnish requested information, document or propagating material to the Registrar or the Examiner (as the case may be) for the purpose of examination.
- B.2 To give effect to the above, the following amendment is proposed:
  - (a) Amendment of s17 of the Plant Varieties Protection Act.

C: Shifting of technical information from the Act to the Rules in respect to Plant Varieties Protection Journal

- C.1 The Registrar will be able to determine the frequency of journal publication instead of having it set at a regular interval.
- C.2 To give effect to the above, the following amendment is proposed:
- (a) Amendment of s15 of the Plant Varieties Protection Act
- C.3 Rules relating to information to be published in the journal will be shifted from the Act to the Rules.
- C.4 To give effect to the above, the following amendments are proposed:
- (a) Amendment of s15 of the Plant Varieties Protection Act
  - (b) Amendment of r16 and r78 of the Plant Varieties Protection Rules.

D: Maintaining the term of grant of protection via late payment of annual fee and clarifying existing provision in relation to when annual fee is due

- D.1 Currently, to maintain the term of grant of protection, a proprietor may request for extension of time (discretionary) not exceeding four months to make payment for annual fee. To maintain the term of grant of protection, proposed amendments will be made to allow a proprietor to make late payment of annual fee (as of right) six months from that anniversary of the date of the grant of protection. Extension of time for annual fee payment will no longer be available.
- D.2 To give effect to the above, the following amendments are proposed:
- (a) Amendment of s24 of the Plant Varieties Protection Act;
  - (b) Amendment of r47, r49 and r66 of the Plant Varieties Protection Rules; and
  - (c) Deletion of r48 of the Plant Varieties Protection Rules.

E: Providing an option for breeder to conduct a Distinct, Uniform, Stable (the “DUS”) test and submit the results

- E.1 Typically called “breeder testing”, it is one of the cooperation modes endorsed by the International Union for the Protection of New Varieties of Plants (“UPOV”). This mode gives an applicant the option to cooperate with the Registrar and the Examiner to support the examination process. The breeders will conduct a **D**istinct, **U**niform, **S**table (the “DUS”) test and submit the results to the Registrar or the Examiner to verify the test results. The Registrar or the Examiner will then conduct independent examination based on the DUS test results to ensure that the plant varieties satisfy the requirements for grant.

- E.2 For purpose of examination, propagating materials of the candidate variety need not be given to the Registrar or the Examiner unless upon request. “Breeder testing” will complement the examination process of plant varieties<sup>9</sup>.
- E.3 To give effect to the above, the following amendments are proposed:
- (a) Amendment of s17 of the Plant Varieties Protection Act; and
  - (b) Introduction of new s18A to the Plant Varieties Protection Act.
- E.4 IPOS only intends for these proposed amendments to come into force at a later date together with their implementing procedures, the latter being under review at this stage.

Question

In this regard, please provide us with your suggestions for the matters to be included in relation to (i) procedure from application-to-grant of protection for a plant variety and (ii) information and materials to be submitted to the Registrar or Examiner for the purpose of examination.

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<sup>9</sup> Pursuant to s17 of the Plant Varieties Protection Act.

## **SECTION V: CROSS-IP AMENDMENTS**

The proposed changes are:

- A. **[In relation to Trade Marks and Registered Designs]** Mandating the provision of priority application number for a claim of right of priority;
- B. **[In relation to Patents, Trade Marks, Registered Designs, Geographical Indications and Plant Varieties Protection]** Empowering the Registrar to advertise or publish proposed corrections for opposition purposes;
- C. **[In relation to Patents, Trade Marks, Registered Designs, Geographical Indications and Plant Varieties Protection]** Shifting of provisions stipulating time periods from the Act to the Rules; and
- D. **[In relation to Patents and Trade Marks]** Standardising the references of “company” or “corporations”.

**Cross-IP Amendments**

	Relevant IP	Item	Summary of proposed changes	Changes to the IP Acts and Rules
A.	Trade Marks and Registered Designs	Mandating the provision of priority application number for a claim of right of priority	<p>To provide greater certainty to applicants and third parties on the validity of an application which has a claim of right of priority, it is proposed that the priority application number be provided when such a claim is made.</p> <p>The priority application number must be furnished within a prescribed or specified period, or the claim of right of priority will be disregarded. (The period to furnish the priority application number differs between Trade Marks and Registered Designs.)</p> <p>Relief measures in the form of extension of time and reinstatement requests will be available for a claim of a right of priority in the Registered Designs legislation. No relief measure will be provided for a claim to right of priority in the Trade Marks legislation.</p>	<p><b>Trade Marks Act (“TMA”) and Trade Marks Rules (“TMR”)</b></p> <ul style="list-style-type: none"> <li>• Amendment of s10</li> <li>• Amendment of r18, r42 and r77</li> </ul> <p><b>Registered Designs Act (“RDA”) and Registered Designs Rules (“RDR”)</b></p> <ul style="list-style-type: none"> <li>• Amendment of s12</li> <li>• Amendment of r19, r28 and r31</li> </ul>



	Relevant IP	Item	Summary of proposed changes	Changes to the IP Acts and Rules
B.	Patents, Trade Marks, Registered Designs, Geographical Indications and Plant Varieties Protection	Empowering the Registrar to advertise or publish proposed corrections for opposition purposes	<p>IPOS proposes to give the Registrar the discretion to advertise or publish, for opposition purposes, a proposed correction to the name or other particular of an applicant or owner of an IP, or any information pertaining to a priority application under such an IP, before the Registrar decides on the proposed correction.</p> <p>Upon advertisement or publication of the proposed correction, third parties will have the opportunity to file a notice of opposition against the proposed correction within two months.</p> <p>For more information, please refer to pages 18 and 19 of the August 2020 Public Consultation <a href="#">here</a>.</p>	<p><b>Patents Act (“PA”) and Patents Rules (“PR”)</b></p> <ul style="list-style-type: none"> <li>• Introduction of new r58A</li> </ul> <p><b>TMA and TMR</b></p> <ul style="list-style-type: none"> <li>• Amendment of s14, s25, s67 and s108</li> <li>• Amendment of r57 and r84</li> <li>• Introduction of new r22A</li> </ul> <p><b>RDA and RDR</b></p> <ul style="list-style-type: none"> <li>• Amendment of s15, s57, s72A and s74</li> <li>• Amendment of r33 and r65</li> <li>• Introduction of new r24A</li> </ul> <p><b>Geographical Indications Act (“GIA”) and Geographical Indications Rules (“GIR”)</b></p> <ul style="list-style-type: none"> <li>• Amendment of s47, s54 and s84</li> <li>• Amendment of r49 and r93</li> <li>• Introduction of new r18A</li> </ul>

	Relevant IP	Item	Summary of proposed changes	Changes to the IP Acts and Rules
				<p><b>Plant Varieties Protection Act (“PVPA”) and Plant Varieties Protection Rules (“PVPR”)</b></p> <ul style="list-style-type: none"> <li>• Amendment of s41 and s54</li> <li>• Amendment of r45</li> <li>• Introduction of new r17A</li> </ul>
C.	Patents, Trade Marks, Registered Designs, Geographical Indications and Plant Varieties Protection	Shifting of provisions stipulating time periods from the Act to the Rules	For purposes of enabling IPOS to be more nimble in responding to business trends and needs, the indicated provisions which stipulate time periods will be shifted from the Act to the Rules.	<p><b>PA and PR</b></p> <ul style="list-style-type: none"> <li>• Amendment of s36</li> <li>• Amendment of r92, r51 and paragraph 2 of the Fourth Schedule</li> </ul> <p><b>TMA</b></p> <ul style="list-style-type: none"> <li>• Amendment of s19</li> </ul> <p><b>RDA</b></p> <ul style="list-style-type: none"> <li>• Amendment of s21</li> </ul> <p><b>GIA</b></p> <ul style="list-style-type: none"> <li>• Amendment of s51</li> </ul>

	Relevant IP	Item	Summary of proposed changes	Changes to the IP Acts and Rules
				<b>PVPA and PVPR</b> <ul style="list-style-type: none"> <li>• Amendment of s14</li> <li>• Amendment of r13</li> </ul>
D.	Patents and Trade Marks	Standardising the references of “company” or “corporations”	References of “company” or “corporation” are proposed to be amended to the term “body corporate”, for the purpose of adopting a consistent reference within the Patents and Trade Marks legislation and with the other IP legislation (i.e., Registered Designs, Geographical Indications and Plant Varieties Protection).	<b>PA</b> <ul style="list-style-type: none"> <li>• Amendment of s102</li> </ul> <b>TMA</b> <ul style="list-style-type: none"> <li>• Amendment of s2</li> </ul>

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