

## **Annex A - Amendments to the Patents Act**

Note:

- (i) The tracked changes indicate the proposed changes to be made to existing legislation. Please note that the wording of the proposed amendments is subject to change after legislation drafting by the Attorney General's Chambers.
- (ii) The proposed amendments are intended to come into operation on such date as the Minister may, by notification in the Gazette, appoint.

### **Section 14 and 15 Patents Act**

#### **Novelty**

14.—(1) An invention shall be taken to be new if it does not form part of the state of the art.

(2) The state of the art in the case of an invention shall be taken to comprise all matter (whether a product, a process, information about either, or anything else) which has at any time before the priority date of that invention been made available to the public (whether in Singapore or elsewhere) by written or oral description, by use or in any other way.

(3) The state of the art in the case of an invention to which an application for a patent or a patent relates shall be taken also to comprise matter contained in an application for another patent which was published on or after the priority date of that invention, if the following conditions are satisfied:

- (a) that matter was contained in the application for that other patent both as filed and as published; and
- (b) the priority date of that matter is earlier than that of the invention.

(4) For the purposes of this section, the disclosure of matter constituting an invention shall be disregarded in the case of a patent or an application for a patent if occurring later than the beginning of the period of 12 months immediately preceding the date of filing the application for the patent and either —

- (a) the disclosure was due to, or made in consequence of, the matter having been obtained unlawfully or in breach of confidence by any person —
  - (i) from the inventor or from any other person to whom the matter was made available in confidence by the inventor or who obtained it from the inventor because he or the inventor believed that he was entitled to obtain it; or
  - (ii) from any other person to whom the matter was made available in confidence by any person mentioned in sub-paragraph (i) or in this sub-paragraph or who obtained it from any person so mentioned because he or the person from whom he obtained it believed that he was entitled to obtain it;

(b) the disclosure was made in breach of confidence by any person who obtained the matter in confidence from the inventor or from any other person to whom it was made available, or who obtained it, from the inventor;

~~(e) the disclosure was due to, or made in consequence of, the inventor displaying the invention at an international exhibition and the applicant states, on filing the application, that the invention has been so displayed and also, within the prescribed period, files written evidence in support of the statement complying with any prescribed condition; or~~

(c) the disclosure was due to, or made in consequence of, the inventor displaying the invention at an international exhibition;

(d) the disclosure was due to, or made in consequence of, the inventor describing the invention in a paper read by him or another person with his consent or on his behalf before any learned society or published with his consent in the transactions of any learned society; or-

(e) the disclosure was made to the public by the inventor, or by a person who obtained the matter disclosed directly or indirectly from the inventor, in circumstances other than the circumstances described in paragraphs (a), (b), (c) or (d).

(5) In subsection (4)(d), “learned society” includes any club or association constituted in Singapore or elsewhere whose main object is the promotion of any branch of learning or science.

(5A) Where any information contained in an application for, or a registration of, an intellectual property right is published by the Registrar, the Registrar of Designs, the Registrar of Plant Varieties, the Registrar of Trade Marks or a foreign intellectual property office, subsection (4)(e) applies to such information if the application was filed, without the consent of the inventor, by a person who obtained the information directly or indirectly from the inventor.

(5B) For the purposes of subsection (4)(e), where any information contained in an application for an intellectual property right is published erroneously by the Registrar, the Registrar of Designs, the Registrar of Plant Varieties, the Registrar of Trade Marks or a foreign intellectual property office —

(a) on a date earlier than the date the information ought to have been published in accordance with the applicable written law, the information is to be treated as having been published on such date the information ought to have been so published; or

(b) when the information ought not to have been published, the information being in respect of an application for an intellectual property right that had been withdrawn, refused or abandoned, the information is to be treated as if it had not been published.

(5C) The applicant must file supporting written evidence complying with the prescribed requirements if any of the grounds in subsection (4) is claimed when submitting any prescribed document in relation to the following purposes:

(a) a search and examination of a patent application;

(b) an examination of a patent application; or

(c) a review of an examination report or a search and examination report.

(5D) In this section —

“foreign intellectual property office” means —

(a) any national or regional office outside Singapore that performs functions similar to those that are performed by the Registry, the Registry of Plant Varieties established under section 7 of the Plant Varieties Protection Act (Cap. 232A), the Registry of Designs established under section 51 of the Registered Designs Act (Cap. 266) or the Registry of Trade Marks established under section 64 of the Trade Marks Act (Cap. 332);

(b) the International Bureau; or

(c) the International Bureau within the meaning of section 2(1) of the Registered Designs Act or section 2(1) of the Trade Marks Act;

“Registrar of Designs” means the Registrar of Designs mentioned in section 49 of the Registered Designs Act and includes a Deputy Registrar of Designs and an Assistant Registrar of Designs;

“Registrar of Plant Varieties” means the Registrar of Plant Varieties mentioned in section 5 of the Plant Varieties Protection Act and includes a Deputy Registrar of Plant Varieties and an Assistant Registrar of Plant Varieties;

“Registrar of Trade Marks” means the Registrar of Trade Marks mentioned in section 62 of the Trade Marks Act and includes a Deputy Registrar of Trade Marks and an Assistant Registrar of Trade Marks.”.

(6) In this section, references to the inventor include references to any proprietor of the invention for the time being.

(7) In the case of an invention consisting of a substance or composition for use in a method of treatment of the human or animal body by surgery or therapy or of diagnosis practised on the human or animal body, the fact that the substance or composition forms part of the state of the art shall not prevent the invention from being taken to be new if the use of the substance or composition in any such method does not form part of the state of the art.

## **Notes**

The amendments to Section 14 of the Patents Act described above, would also apply to Section 15 of the Patents Act. This is because Section 15 has a cross reference to Section 14(2), and because of the words “For the purposes of this section” in Section 14(4).

The proposed subsection (5B) refers to “any information contained in an application for an intellectual property right”. Such “information contained in an application for an intellectual property right” may be published before registration takes place (as in the case of patents, trade marks and plant variety rights) or after registration takes place (as in the case of designs).

The proposed subsection (5B) contains the phrase “when the information ought not to have been published”. This phrase applies where Rule 29(4) of the Patents Rules has been complied with (i.e. the application is withdrawn by filing Form CM9, or the application is treated as having been abandoned or refused, earlier than one month preceding the expiration of the time period applicable under Rule 29(1) or 29(2)).

- (i) As publication may proceed where either of the acts in Rule 29(4)(a) or 29(4)(b) takes place within the one month that precedes the expiration of the time period applicable under Rule 29(1) or 29(2), in such event, the Registrar would not regard such information in the application to be “published erroneously” and the phrase in the proposed subsection (5B) “when the information ought not to have been published” would also not apply.

## **Section 29 Patents Act**

Search and examination

29.—(1) The applicant in an application for a patent (referred to in this subsection as the application in suit) shall comply with one of the following paragraphs within the period prescribed for that paragraph:

- (a) file a request in the prescribed form for a search report;
- (b) file a request in the prescribed form for a search and examination report;
- (c) file the prescribed documents and a request in the prescribed form for an examination report, where the applicant relies on the final results of —
  - (i) a search in one corresponding application, corresponding international application or related national phase application; or
  - (ii) a search during the international phase of the application in suit (if the application in suit is an international application for a patent (Singapore) that has entered the national phase in Singapore under section 86(3));

(d) if the initiation date of the new application mentioned in section 20(3), 26(11) or 47(4) in the case of an application to which either of these provisions applies, or the date of filing of the application in suit in any other case, is before the prescribed date, file the prescribed documents and a request in the prescribed form for a supplementary examination report, where —

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

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

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

(ii) each claim in the application in suit is related to at least one claim in that corresponding application, corresponding international application or related national phase application, or in the application in suit during its international phase, as the case may be; and

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

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

(a) cause the application to be subjected to a search by an Examiner; and

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

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

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

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

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

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

(a) cause the application to be subjected to —

(i) a search by an Examiner; and

(ii) an examination by an Examiner; and

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

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

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

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

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

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

(9) ~~The~~ Unless the request under subsection (1)(b), (c) or (d) or (3) for the examination report, search and examination report or supplementary examination report is withdrawn under subsection (10) or (11), the applicant shall, before the examination report, search and examination report or supplementary examination report is issued under subsection (4), (5) or (6), as the case may be —

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

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

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

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

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

(10) Despite subsection (1), where an applicant has filed a request for an examination report under subsection (1)(c) or (3), or a request for a search and examination report under subsection (1)(b), the applicant may —

(a) withdraw that request —

(i) in a case where a written opinion was issued by an Examiner and the applicant has not responded to the written opinion, before the expiry of the prescribed period mentioned in subsection (9)(a); or

(ii) in any other case, at any time before the examination report or search and examination report is issued under subsection (4) or (5); and

(b) if the initiation date of the new application mentioned in section 20(3), 26(11) or 47(4) in the case of an application to which either of these provisions applies, or the date of filing of the application in suit in any other case, is before the prescribed date, file a request for a supplementary examination report under subsection (1)(d) within the period prescribed for that request.

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

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

~~(b) within the prescribed period, file a request for a search and examination report under subsection (1)(b) or a request for an examination report under subsection (1)(c).~~

(11) Despite subsection (1), where an applicant has filed a request for a supplementary examination report under subsection (1)(d), the applicant may —

(a) withdraw that request —

(i) in a case where a written opinion was issued by an Examiner and the applicant has not responded to the written opinion, before the expiry of the prescribed period mentioned in subsection (9)(a); or

(ii) in any other case, at any time before the supplementary examination report is issued under subsection (6); and

(b) file a request for a search and examination report under subsection (1)(b) or a request for an examination report under subsection (1)(c) or (3) within the period prescribed for that request.”

(12) The application shall be treated as abandoned —

(a) if the applicant fails to comply with subsection ~~(4)~~ (1)(b), (c) or (d) or (3);

(b) where subsection (10) applies, if the applicant fails to file a request for a supplementary examination report under subsection (1)(d) within the prescribed period referred to in subsection (10)(b); or

(c) where subsection (11) applies, if the applicant fails to file a request for a search and examination report under subsection (1)(b) or a request for an examination report under subsection (1)(c) or (3) within the prescribed period referred to in subsection (11)(b).

**Notes**

The phrase” the date of filing of the application in suit in any other case” in the proposed amendments to Section 29(1)(d) and Section 29(10)(d) refers to:

- (a) In the case of PCT applications, the date of filing accorded under the PCT under Section 85(1) Patents Act
- (b) In the case of national patent applications, the date of filing in accordance with Section 26(1) Patents Act.

In the proposed amendments to Section 29(1)(d) and Section 29(10)(b), there is the phrase “is before the prescribed date”. The “prescribed date” (i.e. the date on which closure of the route in Section 29(1)(d) will start to commence) will be gazetted by the Ministry of Law in future in the Government Gazette.