

Public Consultation on Proposed Amendments to Singapore's Patents Legislation

1. Introduction

- 1.1 The Intellectual Property Office of Singapore ("IPOS") is seeking feedback on proposed amendments to Singapore's patents legislation. The period of public consultation is 27 October 2016 to 15 November 2016.

2. Background

- 2.1 The bulk of the legislation changes for which feedback is sought relate to the broadening of the grace period for patent applications.
- 2.2 As background, under the current Section 14 of the Patents Act (Cap. 221) ("Act"), applicants are given an opportunity to patent their invention notwithstanding that it has been disclosed prior to the filing of the patent application. This applies only to limited situations where the disclosure was due to a breach of confidence, or made at a recognised international exhibition or to a learned society, and if it occurred within 12 months prior to the date of filing of the patent application in Singapore. In all other situations, the disclosure would result in loss of the ability to obtain a patent in Singapore.
- 2.3 As the innovation and business landscapes have evolved significantly over time, situations necessitating early disclosure of the invention are becoming more common and unavoidable. It is thus timely to review the grace period provision in order for the Singapore patent regime to continue to remain relevant.
- 2.4 The objective of the proposed changes is to provide a limited safety net for patent applicants or inventors in instances where the invention has been publicly disclosed prior to the filing of a patent application, so that Singapore patent rights can still be obtained. Even with the proposed changes, all individuals and businesses are **strongly encouraged** to keep their inventions secret until an application for a patent has been filed. This is because not all jurisdictions worldwide have a broad grace period,¹ and even for those jurisdictions that do provide for a broad grace period,² the requirements to be satisfied differ. Also, it should be borne in mind that third parties can still claim prior user rights. Therefore, applicants and inventors should bear in mind the **basic principle** of not disclosing to others the invention before filing a patent application, and to enter into confidentiality agreements if there is a need to tell others about the invention.
- 2.5 Other changes for which feedback is sought relate to proposed amendments to Section 29 of the Patents Act concerning the withdrawal of an initial request for search and examination, examination or supplementary examination accompanied with the filing of a fresh request for examination under another examination route.

3. Proposed Changes to Broaden the Grace Period for Patent Applications

- 3.1 It is proposed to broaden the scope of Section 14(4) of the Patents Act so that all disclosures of the invention by the inventor or by a person who obtained the matter disclosed directly or indirectly from the inventor will be graced if the disclosure had been made within the 12 month period immediately preceding the date of filing of the patent application in Singapore.

¹ There is no broad grace period in countries that are party to the European Patent Convention.

² It is noted that some of the major jurisdictions, such as the United States of America, Japan and the Republic of Korea, also provide for broad grace periods.

- 3.2 This will allow inventors or applicants who have inadvertently disclosed the invention due to lack of knowledge of the patentability requirements, or for the purpose of sourcing for funds or to secure early buyer/market interest, to retain the ability to obtain patent rights in Singapore. It will also benefit academics and researchers who have disclosed the invention at a public event or in a scientific or technical journal before a patent application has been filed.
- 3.3 For third party who does in good faith an act that would constitute infringement before the priority date of the invention, or if he makes in good faith effective and serious preparations to do such an act, they may continue to do so under Section 71 of the Patents Act. This is in line with the policy objective of not encouraging public disclosures prior to the filing of the patent application, and that the broadened grace period is meant just to be a limited safety net for the obtaining of patent rights in the event public disclosures are made.
- 3.4 It is possible for information contained in an application or registration for an intellectual property right to form part of the state of the art for a patent application.
- 3.4.1 In the case where the application of the intellectual property right was filed without the consent of the inventor by a person who obtained the information directly or indirectly from the inventor, it is proposed to disregard the information contained in the application or registration if the requirements in paragraph 3.1 are met.
- 3.4.2 In the case where the information contained in an application for an intellectual property right is published erroneously by the Registrar of Patents, the Registrar of Designs, the Registrar of Plant Varieties, the Registrar of Trade Marks or a foreign intellectual property office on a date earlier than the date the information ought to have been published in accordance with the applicable written law, it is proposed that the information is to be treated as having been published on such date the information ought to have been so published, and 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), it is proposed that the information is to be treated as if it had not been published.
- 3.5 Under the current Section 14(4)(c) read with Rule 8 of the Patents Rules, a patent applicant who wishes the disclosure of the invention at an international exhibition to be graced is required to inform the Registrar of Patents on the same day of filing the patent application. He is also required to file a certificate issued by the authority responsible for the exhibition stating that the invention was in fact exhibited there.
- 3.6 It is proposed to amend both Section 14 of the Patents Act as well as Rule 8 of the Patents Rules, so as to require patent applicants to submit a statutory declaration when claiming any of the grounds in the broadened Section 14(4) *prior to grant* in relation to the following purposes: (a) search and examination of a patent application; (b) examination of a patent application; or (c) a review of an examination report or a search and examination report. This requirement to submit a statutory declaration will apply to both national patent applicants as well as applicants of an international application for a patent (Singapore), and the requirement to submit the certificate from the exhibition authority (for international exhibitions) will be removed. This is intended to reduce confusion for applicants, remove the need to obtain a certificate from the authority responsible for the international exhibition and improve operational efficiency for the processing of patent applications. Under the proposed amendments, the applicant may submit the statutory declaration when making a request for a search an examination of a patent application, when making a request for examination of a patent application, when making a request for a review of

an examination report, or when making a response to a written opinion. This ensures that the applicant has the ability to claim the grace period prior to grant of the patent, whilst maintaining examination efficiency.

- 3.7 It would be possible to claim any of the grounds in the broadened Section 14(4) *post-grant* in proceedings before the Registrar and in proceedings before the Courts, and in this regard, the usual legal rules that apply to hearings before the Registrar and to Court procedures found in the Patents Rules and elsewhere would apply (under which the person who wishes to claim grace under any of the grounds in Section 14(4) would have to produce evidence to the Registrar/Court to substantiate the ground being claimed).

4. Other changes to the Patents Act

- 4.1 In addition to the above, it is proposed to make changes to Section 29 of the Patents Act in relation to (a) the closure of the supplementary examination route; and (b) the withdrawal of an initial request for search and examination, examination or supplementary examination accompanied with the filing of a fresh request for examination under another route.
- 4.2 Regarding (a), after extensive consultations with a wide range of stakeholders including law firms, patent firms, IP associations and companies, it has been decided that a closure of the supplementary examination route will increase the quality of patents granted in Singapore. We would however welcome feedback related to the legislative amendments implementing the closure.
- 4.3 Regarding (b), under the current Section 29(10), an applicant may, instead of responding to a written opinion, withdraw an initial request for examination or search and examination and file a new request for supplementary examination. Under the current Section 29(11), an applicant may, instead of responding to a written opinion, withdraw an initial request for supplementary examination and file a new request for examination or search and examination.
- 4.4 It is proposed to amend Section 29(10) and Section 29(11) so that an applicant may withdraw the initial request for search and examination, examination or supplementary examination *at any time* before the examination report or search report or supplementary examination report is issued. In the case where a written opinion has been issued by an Examiner and the applicant chooses not to respond to the written opinion, the applicant has until the expiry of the period for providing a response to the written opinion³, to withdraw the initial request for search and examination, examination or supplementary examination. Otherwise, the written opinion would be treated as the examination report or supplementary examination report.
- 4.5 Alternatively, the applicant can choose to respond to the written opinion, and in so doing, the applicant maintains the ability to withdraw the initial request for search and examination, examination or supplementary examination, up to the point where the examination report or supplementary examination report is issued. Where no written opinion has been issued, the applicant has until the point where the examination report or search report or supplementary examination report is issued, to withdraw the initial request for search and examination, examination or supplementary examination.

³ With regard to a first written opinion or further written opinion issued in respect of an examination report or a search and examination report, under Patents Rule 46(4) and Patents Rule 46(5), the period for providing a response is 5 months after the date of the Registrar's letter forwarding the opinion. With regard to a written opinion issued in respect of a supplementary examination report, under Patents Rule 46(4A), the period for providing a response is 3 months after the date of the Registrar's letter forwarding the written opinion.

5. Conclusion

- 5.1 A copy of the proposed draft amendments to the Patent Act and Patents Rules can be found in Annex A and Annex B respectively. We welcome feedback on the proposed legislation changes. **Please note that the proposed draft Patents Act and Patents Rules changes are still undergoing the legislative drafting and vetting process and hence are not finalised.**
- 5.2 Your views are important and will help us in improving the patent regime. The feedback should be submitted in electronic or hardcopy form, with the subject "Public Consultation on Proposed Amendments to Singapore's Patents Legislation" to:
- Intellectual Property Office of Singapore (IPOS)
51 Bras Basah Road #01-01, Manulife Centre
Singapore 189554
Email: ipos_consultation@ipos.gov.sg
- 5.3 IPOS reserves the right to disclose feedback or suggestions and make them available to the general public, in whole or in part, through its website or other means. However, the identity of the respondents will not be disclosed, if so requested.
- 5.4 Please submit your feedback by **15 November 2016**. Thank you.