

Annex C

Proposed New Re-examination Option

Re-examination is a process in which the patentee or a third party can request a patent to be re-examined to verify whether the subject matter it claims is patentable. It is similar to the concept of examination before grant, broadly speaking, but takes place after grant, with some differences. The proposed new re-examination option allows patents that should not have been granted to be revoked in a generally cost- and time-effective manner. It also allows patentees to evaluate and, possibly, strengthen their patent through amendment of claims. Re-examination could, consequently, reduce the cost of patent litigation or avoid it completely.

There are three main features of this re-examination option. It is (1) binding, (2) a post-grant process, and (3) *ex parte*.

1 When a re-examination request may be filed

We propose that a re-examination request may be filed any time after grant of the patent, and only if there are no other proceedings in which the validity of the patent may be put in issue whether in court or before the Registrar of Patents.

2 Persons who can file a re-examination request

2.1 We propose that both (i) the patentee; and (ii) a third party can file a re-examination request.

2.2 The Registrar cannot initiate re-examination on his own accord (apart from what the Registrar can already do under the current legislation).

2.3 A patentee may want to file a re-examination request to evaluate and, possibly, strengthen his patent through amendment of claims.

2.4 A third party may want to file a re-examination request to challenge a patent in a time- and cost-effective way and by tapping on the technical expertise of IPOS.

2.5 An agent can file a re-examination request without disclosing his clients' identity i.e. the requestor on record could be the agent.

3 Contents of re-examination request

If relying on prior art, the re-examination request must contain reasons why, and state clearly which part of, the prior art is relevant in relation to a specific requirement considered in examination. The claims in issue in the patent to be re-examined must also be specified.

4 Whether the patentee will know if a third party files a re-examination request

4.1 The patentee will know if a third party has filed a re-examination request because he is copied on the Registrar's letter forwarding relevant documents to the examiner.

4.2 Further, the patentee can also view the contents of the re-examination request in IP²SG.

4.3 The patentee should only file submissions and/or proposed amendments if the examiner issues a written opinion (see para 9.2.2 below).

5 Acceptance of re-examination request

5.1 We propose that re-examination requests be generally accepted by the Registrar unless the request in question is frivolous, vexatious or an abuse of the process; or if it is filed when

there are other proceedings in which the validity of the patent may be put in issue (whether in court or before the Registrar).

- 5.2 If a request is rejected for the above limited reasons, there will be no refund but the Registrar will inform the requestor in writing why the request is rejected.
- 5.3 A decision to reject a re-examination request is not appealable.

6 Grounds of re-examination

- 6.1 We propose that grounds of re-examination be limited to requirements which are considered during examination, except the requirement of unity of invention.
- 6.2 For avoidance of doubt, the requirement that the subject matter of the grant be a patentable invention under Section 13(1) of the Patents Act entails consideration of whether the subject matter is an invention or not. As such, a requestor for re-examination may submit that the subject matter is not an invention and the examiner may likewise re-examine the patent to consider whether the subject matter is an invention or not.
- 6.3 The examiner generally cannot raise other grounds not raised by the requestor, unless claim construction is affected e.g. if the claim in question lacks clarity such that it cannot be construed in order to assess novelty and inventive step (the latter grounds being raised by the requestor), the examiner will also re-examine the claim on the ground of lack of clarity.
- 6.4 The examiner can also, when considering proposed amendments by the patentee, consider whether the amendments fulfil all the applicable post-grant criteria.

7 Claims under re-examination

- 7.1 We propose that re-examination be generally limited to the claims identified by the requestor.
- 7.2 However, dependent claims can be expected to be affected by their independent claims even if the former are not specified by the requestor e.g. a patentee, in response to the examiner's written opinion, proposes amendments to an independent claim which affect the dependent claims.

8 Allowable types of prior art

- 8.1 We propose that only patent documents and printed or electronic publications (with clear date of publication) may be relied on in re-examination.
- 8.2 The requestor may not rely on prior use in his re-examination request.

9 Process

- 9.1 Re-examination is an *ex parte* process. As such, the requestor cannot take part in the process after filing the re-examination request. If the requestor finds an issue with the amended claim of a patent, he may file another re-examination request.
- 9.2 After the Registrar decides to accept the re-examination request, a senior examiner will re-examine the relevant claims.
 - 9.2.1 If the requestor's grounds challenging the patent are not made out, a positive re-examination report and a re-examination certificate will be issued. The matter ends.

9.2.2 Otherwise, the examiner would issue a written opinion, to which the patentee may respond via written submissions and, possibly, proposed amendments to the claims in issue.

9.2.2.1 The examiner will consider the patentee's written submissions and, if there are still outstanding issues, initiate an oral interview with the patentee to resolve the issues, if possible.

9.2.2.2 The examiner who conducted the re-examination will be the primary examiner. Two other examiners will be the secondary examiners. Together, these three examiners form the interview panel.

9.2.2.3 At the oral interview, the patentee has the opportunity to submit in the alternative e.g. as regards amendments.

9.2.2.4 The interview panel will consider the patentee's submissions and proposed amendments. If all the issues are resolved, a positive re-examination report and a re-examination certificate will be issued. If there are outstanding issues, a negative re-examination report will be issued.

9.2.2.5 If there is no appeal after a negative re-examination report is issued, or if the decision is upheld on appeal, the patent will be revoked from the date of the grant of the patent.

10 Res judicata

10.1 Would a requestor be pre-empted from raising the same issue and prior art in subsequent proceedings, if the Registrar issued a re-examination certificate after upholding the patent?

We propose the approach currently encapsulated in Section 72 of the Patents Act, such that the same grounds of challenge are not precluded in subsequent proceedings.

10.2 The impact, rather, is on costs. If, subsequently, a final order or judgment is issued in favour of the party relying on the validity as earlier certified, that party is entitled to costs or expenses as between solicitor and client other than the costs or expenses of any appeal in the subsequent proceedings.

11 Appeals

11.1 We propose that a patentee can appeal against a negative re-examination decision but a requestor cannot appeal against a positive re-examination decision.

11.2 Appeals are made to the High Court.

12 What happens if proceedings in which the validity of the patent may be put in issue (e.g. infringement action) commence after the re-examination request is filed and where re-examination is pending?

12.1 We propose that once a re-examination request is filed and if the re-examination is pending, any originating process for Court / Registrar of Patents proceedings in which the validity of the patent may be put in issue must indicate the fact that re-examination is pending before the Registrar (regardless whether the parties to the subsequent proceedings are the patentee or the requestor for re-examination). The fact of the re-examination may be known through the register or file inspection. The initiator of such proceedings in the Court is also required to inform the Registrar of Patents of such proceedings and submit a copy of the originating process document.

- 12.2 This gives the Court / Registrar notice that the proceedings before them need special consideration on how to deal with the sets of parallel proceedings.
- 12.3 Given that re-examination is a shorter, faster process than contentious, *inter partes* proceedings, the pending re-examination will generally proceed. *Ex parte* appeals from the re-examination outcome may be consolidated with the subsequent Court proceedings if the parties to the latter include the patentee.
- 12.4 There will be flexibility to 12.3 e.g. it is possible that, where the Court prefers, the re-examination before the Registrar will be stayed until a final order or judgment of the Court on the subsequent proceedings.