

## **Annex E**

### **Draft proposed Patents (Amendment No. 2) Rules 2017**

Note:

- (1) This annex does not contain all of the provisions of the Patents Rules. For the full text of the Patents Rules, please refer to Singapore Statutes Online at [statutes.agc.gov.sg](http://statutes.agc.gov.sg)
- (2) Please note that the wording of the draft Rules in this Annex is subject to change after legislation drafting by the Attorney General's Chambers.
- (3) The proposed Rules amendments are intended to come into operation on such date as may be gazetted via subsidiary legislation in the Government Gazette.

PATENTS ACT  
(CHAPTER 221)  
PATENTS  
(AMENDMENT NO. 2)  
RULES 2017

In exercise of the powers conferred by section 115 of the Patents Act, the Minister for Law, after consulting with the Intellectual Property Office of Singapore, makes the following Rules:

#### **Citation and commencement**

1. These Rules are the Patents (Amendment No. 2) Rules 2017 and come into operation on 2017.

#### **Amendment of rule 2A**

2. Rule 2A(3) of the Patents Rules (R 1) is amended by inserting, immediately after sub-paragraph (b), the following sub-paragraph:

“(ba) whether each claim of the invention disclosed in the application constitutes an invention;”.

#### **Note in relation to proposed amendments to Rule 2A(3) of the Patents Rules**

For greater clarity, the proposed amendments to Rule 2A(3) are as follows (the tracked changes below indicate the proposed changes). Please note that the wording of the proposed amendments is not yet finalised, and the wording is subject to change after legislation drafting by the Attorney General's Chambers.

Rule 2A(3) of the Patents Rules

(3) For the purposes of the definition of “supplementary examination” in section 2(1), the matters to be determined by an Examiner when conducting a supplementary examination in relation to an application for a patent (referred to in this paragraph as the application in suit) are —

(a) whether each claim in the application is supported by the description of the invention;

(b) whether, at the time the prescribed documents referred to in section 29(1)(d) are filed, each claim in the application in suit is related to at least one claim which —

- (i) is set out in the prescribed documents relating to the corresponding application, corresponding international application or related national phase application referred to in section 29(1)(d), or to the application in suit during its international phase; and
- (ii) has been examined to determine whether the claim appears to satisfy the criteria of novelty, inventive step (or non-obviousness) and industrial applicability (or utility);

(ba) whether each claim of the invention disclosed in the application constitutes an invention;

(c) whether the invention is an invention referred to in section 13(2) that is not patentable;

(d) whether the invention is an invention referred to in section 16(2) that is not to be taken to be capable of industrial application;

(e) whether there is —

(i) any other application for a patent for the same invention, with the same priority date, filed by the same applicant or his successor in title; and

(ii) any earlier grant of a patent for the same invention, with the same priority date, to the same applicant or his successor in title; and

(f) whether the application discloses any additional matter referred to in section 84(1) or (1A) or any matter referred to in section 84(2).

### **Deletion and substitution of rule 8**

3. Rule 8 of the Patents Rules is deleted and the following rule substituted therefor:

**“Written evidence in support of circumstances in section 14(4), etc.**

8.—(1) The supporting written evidence mentioned in section 14(5C) filed by an applicant for a patent must comply with the following requirements:

- (a) The supporting written evidence must be by statutory declaration or affidavit, and must enclose all supporting documents;
- (b) Where the applicant wishes to rely on the circumstances described in section 14(4)(c), the supporting written evidence must —
  - (i) state that the invention to which the applicant’s application relates was in fact exhibited at an international exhibition;
  - (ii) state the opening date of the exhibition and, where the first disclosure of the invention did not take place on the opening date, the date of the first disclosure; and
  - (iii) enclose one or more supporting documents identifying the invention that was exhibited at the exhibition.
- (c) Where the applicant claims that the publication by a foreign intellectual property office of an application for an intellectual property right containing matter constituting the invention to which the applicant’s application relates, or a registration of an intellectual property right pursuant to such an application, was erroneous for the reason mentioned in section 14(5A)(b) or (5B), the supporting written evidence must enclose an acknowledgment from the foreign intellectual property office —
  - (i) stating that the publication was erroneous and the reason for the publication being erroneous; and
  - (ii) in a case mentioned in section 14(5B), stating the earliest date on which the publication ought to have been made under the law or treaty governing the application.

(2) For the purposes of section 2(2), a statement may be published in the journal that an exhibition described in the statement falls within the definition of international exhibition in section 2(1).

(3) In this rule, “foreign intellectual property office” has the same meaning as in section 14(8).”.

**Note in relation to proposed amendments to Rule 8 of the Patents Rules**

The new proposed Rule 8(1)(a) (as shown above) applies when the applicant claims any of the grounds under Section 14(4)(a) to 14(4)(e) of the Patents Act (as amended by the Patents (Amendment) Act 2017).

The new proposed Rule 8(1)(b) (as shown above) applies when the applicant claims the international exhibitions ground in Section 14(4)(c) of the Patents Act (as amended by the Patents (Amendment) Act 2017). The proposed amendments remove the following two requirements for an applicant claiming the international exhibitions ground:

- (a) the requirement to inform the Registrar in writing on the same day of filing the application for the patent, that the invention has been displayed at an international exhibition (as seen in the current Rule 8(1) of the Patents Rules); and
- (b) the requirement to obtain a certificate from the international authority responsible for the international exhibition (as seen in the current Rule 8(2) of the Patents Rules).

The new proposed Rule 8(1)(c) (as shown above) applies where the applicant claims that the publication by a foreign intellectual property office of an application for an intellectual property right containing matter constituting the invention to which the applicant's application relates, or a registration of an intellectual property right pursuant to such an application, was erroneous for the reason mentioned in section 14(5A)(b) or (5B) (the new Section 14(5A)(b) and Section 14(5B) of the Patents Act can be seen in Section 2(c) of the Patents (Amendment) Act 2017).

The new proposed Rule 8(2) (as shown above) replicates the provision in the existing Rule 8(5) of the Patents Rules.

The new proposed Rule 8(3) (as shown above) states that the term "foreign intellectual property office" as used in the new proposed Rule 8 has the same meaning as in section 14(8) (the new Section 14(8) of the Patents Act can be seen in Section 2(e) of the Patents (Amendment) Act 2017).

The new proposed Rule 8 (as shown above) deletes the current Rule 8(6) of the Patents Rules. The new proposed Rule 8(1), 8(2) and 8(3) (as shown above) shall also apply to international applications for a patent (Singapore).

For the savings and transitional provisions, please refer to the draft Rule 8(2) at the end of this Annex – "Rule 3 does not apply to or in relation to any application for a patent the date of filing of which is before the date of commencement of rule 3."

The text of the current Rule 8 of the Patents Rules is extracted below for ease of reference.

#### Current text of Rule 8 of the Patents Rules

##### International exhibitions

8.—(1) An applicant for a patent who wishes the disclosure of matter constituting an invention to be disregarded in accordance with section 14(4)(c) shall, within the same day of filing the application for the patent, inform the Registrar in writing that the invention has been displayed at an international exhibition.

- (2) The applicant shall, within 4 months from the day of filing the application, file a certificate, issued by the authority responsible for the exhibition, stating that the invention was in fact exhibited there.
- (3) The certificate shall also state the opening date of the exhibition and, where the first disclosure of the invention did not take place on the opening date, the date of the first disclosure.
- (4) The certificate shall be accompanied by an identification of the invention, duly authenticated by the authority.
- (5) For the purposes of section 2(2), a statement may be published in the journal that an exhibition described in the statement falls within the definition of international exhibition in section 2(1).
- (6) In the case of an international application for a patent (Singapore), the application of this rule shall be subject to rule 86(4).

### **Amendment of rule 43**

4. Rule 43 of the Patents Rules is amended by inserting, immediately after paragraph (3), the following paragraph:

“(4) The prescribed date mentioned in section 29(11A) is 1 January 2020.”.

### **Note in relation to proposed amendments to Rule 43 of the Patents Rules**

The text of the new Section 29(11A) can be found in Section 3(c) of the Patents (Amendment) Act 2017.

For greater clarity, the proposed amendments to Rule 43 are as follows (the tracked changes below indicate the proposed changes). The closure of the supplementary examination route will commence from 1 January 2020.

#### **Rule 43 of the Patents Rules**

Period for filing request for search and examination report, request for examination report or request for supplementary examination report

43.—(1) Subject to paragraph (2), the period prescribed for filing a request for a search and examination report under section 29(1)(b) or a request for an examination report under section 29(1)(c) or (3) shall be —

- (a) subject to sub-paragraph (b), 36 months after —
  - (i) the declared priority date of the application; or
  - (ii) where there is no declared priority date, the date of filing of the application; or

(b) where a new application is filed under section 20(3), 26(11) or 47(4), 36 months after the actual date of filing of the new application.

(2) Where the Registrar sends the applicant a copy of the search report under section 29(2)(b) at any time later than one month before the expiry of the period prescribed under paragraph (1)(a) or (b), as the case may be, the period prescribed for filing a request for an examination report under section 29(3) shall be one month from the date of the Registrar's letter forwarding the copy of the search report sent under section 29(2)(b).

(3) The period prescribed for filing a request for a supplementary examination report under section 29(1)(d) shall be —

(a) subject to sub-paragraph (b), 54 months after —

(i) the declared priority date of the application; or

(ii) where there is no declared priority date, the date of filing of the application; or

(b) where a new application is filed under section 20(3), 26(11) or 47(4), 54 months after the actual date of filing of the new application.

(4) The prescribed date mentioned in section 29(11A) is 1 January 2020.

#### **Amendment of rule 46**

5. Rule 46(1A) of the Patents Rules is amended by inserting, immediately after sub-paragraph (b), the following sub-paragraph:

“(ba) the invention defined in any claim does not constitute an invention;”.

#### **Note in relation to proposed amendments to Rule 46(1A) of the Patents Rules**

For greater clarity, the proposed amendments to Rule 46(1A) are as follows (the tracked changes below indicate the proposed changes). Please note that the wording of the proposed amendments is not yet finalised, and the wording is subject to change after legislation drafting by the Attorney General's Chambers.

#### **Rule 46(1A) of the Patents Rules**

(1A) If during a supplementary examination under section 29(6)(a), the Examiner is of the opinion that —

(a) any claim in the application is not supported by the description of the invention;

(b) at the time the prescribed documents referred to in section 29(1)(d) are filed, any claim in the application in suit is not related to at least one claim which –

(i) is set out in the prescribed documents relating to the corresponding application, corresponding international application or related national phase application referred to in section 29(1)(d), or to the application in suit during its international phase; and

(ii) has been examined to determine whether the claim appears to satisfy the criteria of novelty, inventive step (or non-obviousness) and industrial applicability (or utility);

(ba) the invention defined in any claim does not constitute an invention;

(c) the invention is an invention referred to in section 13(2) that is not patentable;

(d) the invention is an invention referred to in section 16(2) that is not to be taken to be capable of industrial application;

(e) there is –

(i) any other application for a patent for the same invention, with the same priority date, filed by the same applicant or his successor in title; or

(ii) any earlier grant of a patent for the same invention, with the same priority date, to the same applicant or his successor in title; or

(f) the application discloses any additional matter referred to in section 84(1) or (1A) or any matter referred to in section 84(2),

the Examiner shall notify the Registrar in writing of that opinion and shall state fully the reasons for his opinion.

### **Amendment of rule 86**

6. Rule 86(4) of the Patents Rules is deleted and the following paragraph substituted therefor:

“(4) In the case of an international application for a patent (Singapore), where an English translation of a document or part of a document is required by the Act or

these Rules to be filed before or at the time limit for entering the national phase, verification of the translation, as required under rule 112 and permitted by rule 51 bis 1(d) of the Regulations under the Patent Co-operation Treaty, may be given to the Registrar at any time before the end of 2 months from that time limit.”.

**Note in relation to proposed amendments to Rule 86 of the Patents Rules**

The proposed amendments to Rule 86(4) of the Patents Rules removes the current Rule 86(4)(a) and 86(4)(b) of the Patents Rules. The new proposed Rule 8(1), 8(2) and 8(3) (as shown above) shall apply to international applications for a patent (Singapore).

For ease of reference, the existing Rule 86(4) of the Patents Rules is extracted below:

**Current Rule 86(4) of the Patents Rules**

(4) In the case of an international application for a patent (Singapore) –

(a) rule 8(1) shall not apply if the applicant, on filing the application, states in writing to the receiving Office that the invention has been displayed at an international exhibition;

(b) rule 8(2), (3) and (4) may be complied with at any time before the end of 2 months from the time limit for entering the national phase;

(c) [Deleted by S 366/2004]

(d) where an English translation of a document or part of a document is required by the Act or these Rules to be filed before or at the time limit for entering the national phase, verification of the translation, as required under rule 112 and permitted by rule 51 bis 1(d) of the Regulations under the Patent Co-operation Treaty, may be given to the Registrar at any time before the end of 2 months from that time limit.

For the savings and transitional provisions, please refer to the draft Rule 8(4) at the end of this Annex – “(4) Despite rule 6, rule 86(4) of the Patents Rules as in force immediately before the date of commencement of rule 6 continues to apply to or in relation to any international application for a patent (Singapore) the date of filing accorded under the Patent Co-operation Treaty of which is before that date.”

**Amendment of rule 108**

7. Rule 108 of the Patents Rules is amended —

(a) by inserting, immediately after “(5)” in paragraph (2)(a), the words “(except as provided in paragraph (7))”; and

(b) by inserting, immediately after paragraph (6), the following paragraph:

“(7) Where —

(a) after receiving the search report under section 29(2)(b) of the Act from the Registrar, the applicant does not file a request for an examination report under section 29(3) within the period prescribed in rule 43; and

(b) the time prescribed under paragraph (4)(a) for filing a request for an extension of the period prescribed in rule 43 expires before, or within 3 months after, the date of commencement of section 3(f) of the Patents (Amendment) Act 2017,

the time prescribed in paragraph (4)(a) for requesting an extension of the period prescribed in rule 43 is extended to the end of 6 months after the date of commencement of section 3(f) of the Patents (Amendment) Act 2017.”.

#### **Note in relation to proposed amendments to Rule 108 of the Patents Rules**

The amendments to Rule 108 of the Patents Rules seek to implement the new Section 29(13) Patents Act arising from Section 3(f) of the Patents (Amendment) Act 2017.

For greater clarity, the proposed amendments to Rule 108 are as follows (the tracked changes below indicate the proposed changes).

The proposed date of commencement of Section 3(f) of the Patents (Amendment) Act 2017 will be sometime in the second half of 2017.

#### **Rule 108 of the Patents Rules**

Extension of time limits in general

108.—(1) Subject to paragraphs (2), (3) and (4) and rule 108A, any time or period prescribed by these Rules for doing any act or taking any proceedings, and any time or period specified by the Registrar under these Rules, may, on written request by a party made no later than 6 months after the first expiry of the time or period, be extended by the Registrar if he thinks fit, upon such notice to the parties and upon such terms as he may direct.

(2) Any time or period prescribed in any of the following provisions shall not be extended:

(a) paragraphs (1), (3), (4) and (5) (except as provided in paragraph (7));

(b) rules 8(1), 9(1), (2) and (3), 9A(1) and (2)(a), 19(2), 26(5), 26A(1) and (5)(a), 28(a), (b), (c) and (d), 29(4), 34(2), 46(4), (4A) and (5)(c), 49, 51(1),

(2) and (2A), 51A(1) and (2), 52(2), 53(1), 73(1), 74(1), 75, 85(1), 86(3A), 88(8)(a), 88A(11), 91(3) and (5) and paragraph 4(2) of the Fourth Schedule;

(c) rule 26(3) (except so far as it relates to the filing of the documents prescribed under rule 26(4)(a) and (b));

(d) rule 26A(4) (except so far as it relates to the furnishing of the information prescribed under rule 26A(6)(b) and the filing of the documents prescribed under rule 26A(7)); and

(e) rule 34(5) (except so far as it relates to the furnishing of the information prescribed under rule 34(7)(b) and the filing of the documents prescribed under rule 34(8)).

(3) Any time or period prescribed in any of the following provisions shall be extended for a total period not exceeding 6 months, beginning immediately after the first expiry of the time or period for which the extension is sought, upon filing Patents Form 45 no later than 6 months after the first expiry of the time or period for which the extension is sought:

(a) rule 8(2), 9A(5), 9B(1) or (4), 9C(1), 17(3), 28(e) or (g), 45(2), 46A(2) or (5), 51A(3), 53(4), 67, 68, 84(1), 86(4)(b), 88(1) or 112(4) or (5)(b) or paragraph 1(3) of the Fourth Schedule;

(b) rule 26A(4) (so far as it relates to the furnishing of the information prescribed under rule 26A(6)(b) and the filing of the documents prescribed under rule 26A(7)); or

(c) rule 34(5) (so far as it relates to the furnishing of the information prescribed under rule 34(7)(b) and the filing of the documents prescribed under rule 34(8)).

(4) Any time or period prescribed in any of the following provisions shall be extended for a total period not exceeding 18 months, beginning immediately after the first expiry of the time or period for which the extension is sought, upon filing Patents Form 45 no later than 18 months after the first expiry of the time or period for which the extension is sought:

(a) rule 18(1), 19(11), 26(2), 28(f), 34(1A), 38, 42(3), 43, 47(1) or 86(1), (6), (8) or (8A); or

(b) rule 26(3) (so far as it relates to the filing of the documents prescribed under rule 26(4)(a) and (b)).

(5) Without prejudice to paragraphs (3) and (4), the Registrar may, if he thinks fit, allow any time or period prescribed in any provision listed in paragraph (3) or (4) to

be further extended, upon such terms as he may direct, if all of the following requirements are satisfied:

(a) a request to further extend the time or period is made on Patents Form 45

—  
(i) in the case of a time or period prescribed in any provision listed in paragraph (3), no later than 6 months after the first expiry of the time or period; or

(ii) in the case of a time or period prescribed in any provision listed in paragraph (4), no later than 18 months after the first expiry of the time or period;

(b) the time or period has already been extended —

(i) in the case of a time or period prescribed in any provision listed in paragraph (3), by 6 months; or

(ii) in the case of a time or period prescribed in any provision listed in paragraph (4), by 18 months;

(c) the request is accompanied by a statutory declaration, or an affidavit, setting out the grounds for the request.

(6) A single request may be made under paragraph (5) for the extension of more than one time or period in the same proceedings if the extensions are to be made to a common date (but not otherwise).

(7) Where —

(a) after receiving the search report under section 29(2)(b) of the Act from the Registrar, the applicant does not file a request for an examination report under section 29(3) within the period prescribed in rule 43; and

(b) the time prescribed under paragraph (4)(a) for filing a request for an extension of the period prescribed in rule 43 expires before, or within 3 months after, the date of commencement of section 3(f) of the Patents (Amendment) Act 2017,

the time prescribed in paragraph (4)(a) for requesting an extension of the period prescribed in rule 43 is extended to the end of 6 months after the date of commencement of section 3(f) of the Patents (Amendment) Act 2017.

## **Saving and transitional provisions**

8.—(1) [Placeholder for savings and transitionals for Rule 2, please see the note in the box below]

(2) Rule 3 does not apply to or in relation to any application for a patent the date of filing of which is before the date of commencement of rule 3.

[(3) Placeholder for savings and transitionals for Rule 5, please see the note in the box below]

(4) Despite rule 6, rule 86(4) of the Patents Rules as in force immediately before the date of commencement of rule 6 continues to apply to or in relation to any international application for a patent (Singapore) the date of filing accorded under the Patent Co-operation Treaty of which is before that date.

Made on 2017.

### **Note on the savings and transitional provisions**

For the savings and transitionals for Rules 2 and 5 (which seek to amend Rule 2A(3) and 46(1A) of the Patents Rules), we intend to have provisions that are similar to those seen in Sections 28(1), 28(2) and 28(3) of the Patents (Amendment) Act 2012. These are the savings and transitional provisions that relate to the current Section 29 of the Patents Act. Section 6 of the Patents (Amendment) Act 2012 was the provision that gave birth to the current wording of Section 29 of the Patents Act).

The references to “[relevant provisions]” below are to Rule 2 or Rule 5.

### **Proposed Subparagraphs (1), (2) and (3)**

- (1) Subject to subparagraph (2) and (3) below, [relevant provisions] shall not apply to:
  - (a) any application for a patent that is filed before the date of commencement of the relevant provisions,<sup>1</sup> or to any patent granted pursuant to any such application, and
  - (b) [provisions of the Patents Rules] in force immediately before that date shall continue to apply to every such application for a patent and every such patent as if the relevant provisions had not been enacted.
- (2) The [relevant provisions] shall apply to —

<sup>1</sup> For national applications, this refers to the filing date accorded under Section 26(1) Patents Act, and for international applications for a patent (Singapore), this refers to the date that has been accorded under the PCT under Section 87(1)(a) Patents Act.

- (a) every new application for a patent made, on or after the date of commencement of the [relevant provisions], under section 20(3) or 47(4) of the Patents Act which is treated as having been filed on a date that is before the date of commencement of the [relevant provisions], and to every patent granted pursuant to any such application; and
  - (b) every new application for a patent filed, on or after the date of commencement of the [relevant provisions], under section 26(11) of the Patents Act which is treated as having as its date of filing a date that is before the date of commencement of the relevant provisions, and to every patent granted pursuant to any such application.
- (3) The [relevant provisions] shall apply to every international application for a patent (Singapore) that enters the national phase in Singapore under section 86(3) of the Patents Act on or after the date of commencement of the [relevant provisions], and to every patent granted pursuant to any such application.