



INTELLECTUAL PROPERTY
OFFICE OF SINGAPORE

PUBLIC CONSULTATION

CHANGES TO SIMPLIFY INTELLECTUAL PROPERTY
PROCESSES AND IMPROVE USER EXPERIENCE WITH
DIGITAL INITIATIVES

**INTELLECTUAL PROPERTY OFFICE OF SINGAPORE
AUGUST 2020**

INTRODUCTION

The Intellectual Property Office of Singapore (IPOS) is conducting a public consultation on the proposed changes to simplify and streamline intellectual property (“IP”) processes and improve user experience with digital initiatives. The consultation period is from **17 August 2020 to 14 September 2020**.

As part of IPOS’ continuous effort to ensure a top-class IP regime in Singapore, IPOS has identified areas where changes can be considered for processes relating to the obtaining, maintaining and recording of Patents, Registered Designs, Trade Marks, Geographical Indications and Plant Varieties Protection rights and transactions in Singapore.

The proposed changes are focused on simplifying and harmonising procedures across all IP. In proposing changes in the identified areas, IPOS also takes into account the need to maintain a fair balance between the interests of IP rights owners and third parties.

Consequential amendments may be made to the Patents Act and Rules, Trade Marks Act and Rules, Trade Marks (International Registration) Rules, Registered Designs Act and Rules, Registered Designs (International Registration) Rules, Plant Varieties Protection Act and Rules and Geographical Indications Act and Rules arising from the proposals.

The consultation paper is organised into 4 sections:

- [A: Simplifying and Streamlining Patents Processes](#) (3 sets of questions)
- [B: Simplifying and Streamlining Trade Marks Processes](#) (2 sets of questions)
- [C: Simplifying and Streamlining Common Processes](#) (3 sets of questions)
- [D: Improving User Experience and Service with Digital Initiatives](#) (1 set of question)

CALL FOR SUBMISSIONS

We seek your feedback on the proposed changes. Please provide your feedback via [FormSG](#). In your submission, please indicate your name, your email address, the name of your organisation (if applicable) and your designation in the organisation (if applicable).

You are welcome to provide your comments on any or all of the questions that are relevant to you.

Should you have any queries on the public consult, please contact us at IPOS_Consultation@ipos.gov.sg.

Please note that, unless otherwise requested, written comments submitted may be made publicly available. When you make a submission, unless stated otherwise, you have consented to your personal information being published.

CLOSING DATE FOR SUBMISSIONS

The consultation period will end on 14 September 2020. Please provide your feedback no later than 14 September 2020 as an extension of the consultation period is not possible. IPOS reserves the right not to consider any submissions received after 14 September 2020.

A: SIMPLIFYING AND STREAMLINING PATENTS PROCESSES

1. Examiner-initiated informal communication

Current situation

- 1.1 At any time before the examination process is concluded, examiners may initiate informal communication (in the form of email correspondence, phone or face-to-face interviews) for national Patent applications to discuss certain issues with the application or to make minor clarifications. Non-exhaustive examples of minor clarifications include errors in claim numbering, inconsistent terms in claims and wrong claim dependencies.
- 1.2 If amendments to the specification are required following an informal communication and there is no opportunity to submit them as a response to a written opinion,¹ IPOS has to issue a written opinion for the applicant to submit the amendments. The prescribed time period for the applicant to respond would be 5 months.²

Proposed changes

- 1.3 Instead of relying on the issuance of a written opinion, a new process will be introduced for the Registrar to invite the applicant to submit amendments within a stipulated period of 2 months. The period begins from the date of the Registrar's letter forwarding the invitation and will not be extendable. The period of 2 months takes into account the time for correspondence between the applicant and his/her representative to determine the way forward on the application while ensuring that patent prosecution can conclude within a reasonable amount of time.
- 1.4 If the applicant fails to respond to the invitation, the examiner may determine whether a written opinion should be issued, or to conclude the prosecution with an examination report.³ Where a written opinion is issued, the applicant will have (5 minus 2) months to respond, calculated from the date of issuance of the formal written opinion.

¹ Either no written opinion has been issued or there is no or little time to respond to an earlier issued written opinion.

² Rule 46(4) of the Patents Rules.

³ Subject to considerations such as whether the applicant is given at least one opportunity to respond to the objection(s) raised and whether there is sufficient time remaining for the applicant to respond to the written opinion and for the examiner to draw up the examination or search and examination report (as the case may be) pursuant to Rules 46(6) and 46(8) of the Patents Rules.

Question A1

- a) Are you supportive of this proposed process? Please elaborate with reason(s).
- b) If supportive, is 2 months a reasonable period for an applicant to submit the response following an examiner-initiated informal communication? If no, please propose a period and provide us with the rationale.

2. Examination review

Current situation

- 2.1 When filing an examination review request, an applicant has the following options:
- filing written submissions and a set of amendments (including amended claims);⁴ or
 - filing written submissions only with no amendments.⁵
- 2.2 During the examination review, the examiner is required to agree or disagree with the objections raised in the earlier examination report, and to assess whether the amendments, if they have been made, overcome the objections in the earlier examination report.⁶ An estimated 80% of applicants file a set of claim amendments with their examination review request.⁷
- 2.3 It has been observed that when claim amendments were filed with the examination review request which rendered the scope of the claims under consideration to be different, a review of the earlier examination report was not relevant since the earlier examination report was based on the previous set of claims. To proceed with the review of the claim amendments and earlier examination report would require separate and additional efforts and generally, such a review would have had no bearing on the assessment of the amended claims.

Proposed changes

- 2.4 If an applicant files amendments with the examination review request, the examiner will review the application based on the amended claims only.
- 2.5 If an applicant files written submissions only, the examiner will proceed to review the earlier examination report.

⁴ Section 29B(2) of the Patents Act.

⁵ Section 29B(1) of the Patents Act.

⁶ Section 29B(4) of the Patents Act.

⁷ Based on filing figures in 2017 to 2019.

Question A2

- a) Are you supportive of this proposed change? Please elaborate with reason(s).
- b) What are your considerations when deciding if you wish to submit amendments and written submissions or only written submissions during the examination review stage?
- c) Based on the current examination review process, where an applicant files written submissions and amendments during the request for an examination review, it is apparent that the applicant intends to amend the application to overcome the objections in the earlier examination report. While the examiner has to provide an opinion on whether he agrees/disagrees with the earlier examination report during the examination review, what are the applicant's reason(s) for seeking this opinion?

3. Publication of translation of international application

Current situation

- 3.1 When an applicant requests an entry into national phase in Singapore via Patents Form 37, the English translation must be furnished for a non-English Patent Cooperation Treaty (“PCT”) application in order for the application to fulfil the criteria for entry into national phase.⁸
- 3.2 Once the notification of filing date of the national phase entry application that has been published under the PCT has been accorded, the journal entry will reflect the basic bibliographic data of the application⁹ and the Registrar will make available the English translation on the Patents Register without the filing of Patents Form 38 (Payment of fee for publication of translation of international application).

Proposed changes

- 3.3 For all published PCT applications, applicants will need to request the publication of English translation of the PCT applications at the same time as making the national phase entry in Singapore (i.e., the functions of Patents Forms 37 and 38 will be integrated).¹⁰
- 3.4 This gives third parties access to the English translation of the PCT applications, bringing their awareness to the potential infringement of pending Patent applications. For applicants, the act of publication of the English translation shall be the initiation date for calculation of payments for (i) use by the Government and authorised parties¹¹ and (ii) damages in respect of any infringing act of the Patent¹² for proceedings before the Registrar or in the court.

Question A3

a) Are you supportive of this proposed change? Please elaborate with reason(s).

b) If supportive, how do you think the process can be further simplified?

⁸ Section 86(3) of the Patents Act.

⁹ In journal section under *Applications for Patents Filed*.

¹⁰ The journal entry will reflect that the application is published under *Applications for Patents Filed* and *Translations filed in accordance to Sections 86(3) or (6) of the Patents Act* simultaneously.

¹¹ Section 56 of the Patents Act.

¹² Section 76 of the Patents Act.

B: SIMPLIFYING AND STREAMLINING TRADE MARKS PROCESSES

1. Partial refusal mechanism for national applications

Current situation

- 1.1 A national application may be objected in its entirety even if only some of goods and/or services in the application are found to be objectionable. An applicant has to respond to the Registrar's examination report in writing or lodge an amendment form in time in order for the application to be further reviewed. In the event the applicant fails to respond and reinstate the application within the stipulated deadlines, the entire application will become treated as withdrawn and can no longer be reinstated.

Proposed changes

- 1.2 With the introduction of the “partial refusal” mechanism to national applications, a partially refused application may still proceed to publication as the objectionable portion(s) stated in the Registrar’s first examination report will be removed after the stipulated deadlines. This means that the applicant who does not respond to the Registrar's examination report can simply allow the stipulated deadlines to lapse without performing any action. This will result in the application proceeding to registration without the objectionable portion(s). This is in contrast to the current system, where non-action on the part of the applicant will result in the entire application being treated as withdrawn and no longer capable of reinstatement.
- 1.3 The “partial refusal” mechanism has been in place for international registrations designating Singapore and subsequent designations designating Singapore filed via the Madrid Protocol. Such “partial refusal” mechanism in national applications has also been executed in the Trade Mark regimes of other jurisdictions,¹³ and is not solely novel to Singapore’s regime.
- 1.4 Under the proposed regime, if the Registrar partially refuses a national application, the objectionable portion(s) of the application will be clearly laid out in the first examination report. Depending on the nature of the objection(s), the applicant may have the following options to pursue his partially refused application:

¹³ Examples of other foreign jurisdictions include the China National Intellectual Property Administration, European Union Intellectual Property Office, Hong Kong Intellectual Property Department and the United States Patent and Trademark Office.

	Option	Expected Process and Implications
1	Respond to the Registrar's objection(s) within 4 months of the examination report by way of written submissions .	Where the objection(s) pertains to substantive issues such as those under Section 7 and/or Section 8 of the Trade Marks Act, the submissions will be reviewed on whether they are sufficient to overcome the objection(s). In the event that the objection(s) is maintained, the Registrar will issue another examination report. The usual deadlines apply.
2	Respond to the Registrar's objection(s) within 4 months of the examination report by way of amendments .	<p>Where the partial refusal pertains to the specification of goods and/or services, the applicant may:</p> <p>(i) <u>Reword the objectionable goods and/or services by way of an amendment form and fee</u>: If the amendment is acceptable, the application will proceed to the next processing stage. Otherwise, another examination report will be issued on the maintained objection(s); or</p> <p>(ii) <u>Delete the objectionable goods and/or services by way of an amendment form and fee</u>: The application immediately proceeds to the next processing stage, thereby resulting in time savings.</p> <p>Where the partial refusal pertains to other issues, the applicant may remove the objectionable portion(s), or amend as directed by the Registrar by way of form and fee.</p>
3	Divide out the objectionable goods and/or services and separately deal with them in a separate application. The applicant can then address the objectionable portion(s) by adopting either Options 1 or 2 above within the stipulated deadlines.	The applicant enjoys time savings by allowing the non-objectionable portion(s) to proceed to registration more expeditiously. This option also allows the applicant to continue pursuing protection of the objectionable portion(s) in a separate application with the filing date preserved.

	The application that contains only the non-objectionable portion(s) will proceed to the next processing stage.	This option however comes at a cost (division fee is charged per separate application created from the original application).
4	Choose not to respond. Allow the stipulated response and reinstatement deadlines to lapse, and the application will proceed to next processing stage (e.g., publication) with the objectionable portion(s) removed.	The applicant enjoys cost savings as the objectionable portion(s) will be automatically removed without the need for an amendment form and fee.

- 1.5 The options have different trade-offs and should therefore be weighed by the applicant. If the applicant requires further review of his application, he should make a response accordingly using Options 1, 2 or 3. Otherwise, he can save on the amendment fees required for the removal of the objectionable goods and/or services, but will have to wait for the stipulated response and reinstatement deadlines (currently at least 10 months after the date of examination report) to lapse before the Registrar can proceed to delete the objectionable portion(s) to move to the next stage of processing (i.e., Option 4).
- 1.6 The “partial refusal” mechanism is envisaged to reduce further costs incurred by the applicant in pursuing a fresh application (if earlier application lapses) and to allow non-objectionable goods and/or services in a partially refused national application to be protected without requiring an active response from the applicant.

Question B1

- a) Do you agree with the adoption of the “partial refusal” mechanism for the national Trade Mark regime? Please elaborate with reason(s).
- b) What is/are the key priority you consider in the course of Trade Mark registration? (e.g., speed, cost, specificity in relation to objectionable goods and/or services, clarity in examination decisions)
- c) If you have a partially refused application, will you be more inclined to (i) proceed with an amendment as proposed by the Registrar; (ii) initiate an amendment form (and relevant fee) to remove the objectionable goods and/or services; or (iii) wait for the stipulated deadlines to lapse and automatically proceed to the next processing stage? Please provide reason(s) for your option.

d) If objectionable goods and/or services are stated upfront in the examination report in a partially refused application, will you be more inclined to divide out the objectionable portion(s) of the application? Please provide reason(s) for doing/not doing so.

2. Series of Trade Marks

Current situation

- 2.1 “Series of Trade Marks” is a regime provided for under the Trade Marks Act.¹⁴ The series mark regime is a business-friendly regime that allows applicants to enjoy cost savings when filing for variations of their marks. Applicants also need not pay additional fees for the efforts spent on examining such applications, regardless of the number of series marks claimed. However, when the marks filed in an application do not constitute a series of Trade Marks (i.e., there appears to be visual, aural, and/or conceptual differences which substantially affect the identity of the mark(s) in the series), an objection will be raised against the application. This issue may be exacerbated in cases where a large number of marks are filed in an application, as there may be a higher probability that some marks would not constitute as a series of marks.
- 2.2 Such objections may arise from a misunderstanding or misinterpretation of the requirements for a series of marks. In order to resolve these objections, applicants may incur additional costs in their Trade Mark applications by having to remove the objectionable mark(s) in the series. These objections tend to result in a protraction of the examination process as applicants would have to spend more time to correspond with the examiner to further clarify the series mark claim. In some cases, such applications can also become treated as withdrawn due to non-response.

Proposed changes

- 2.3 To achieve a more expeditious acceptance of marks and reduce the negative consequence of applications becoming treated as withdrawn due to a non-response to series mark objection(s), IPOS is considering the following measures to the regime:

¹⁴ This is provided for in accordance to Section 17 of the Trade Marks Act. A series of Trade Marks refers to a number of Trade Marks which resemble each other as to their material particulars and which differ only as to matters of a non-distinctive character not substantially affecting the identity of the Trade Mark.

- Restriction on the number of series marks

This proposal involves limiting the maximum number of marks allowed in a series mark application (e.g., up to a maximum of 4).¹⁵ Applicants who wish to file for additional marks beyond the maximum number will have to do so via a separate application. Our statistics showed that approximately 89% of all series marks filed between 2015 and 2019 consisted of 2 to 3 marks. Therefore, capping the number of marks in a series to 4 seems realistic and reasonable. A lower number of marks in the series is likely to reduce the probability that certain mark(s) would not qualify as a series, thereby reducing the likelihood of a series mark objection. The proposed measure will also halt an excessive number of marks being claimed in a series, thereby enabling applicants to exercise their claim prudently.

- Restriction on the type of series marks

An alternative or additional proposed measure is to limit the types of marks acceptable as series. For example, a series of marks may only be accepted where marks differ in their colour, capitalisation, and/or the positioning of the various elements of the mark.

Question B2

- a) Do you generally vary the use of your Trade Marks (such as differences in colour, capitalisation, or positioning of elements) in the course of trade? If so, how?**
- b) Are you supportive of the proposals to limit the maximum number and/or type of marks that can be filed in a single application? Please elaborate with reason(s).**
- c) Which part of the Trade Marks Registry’s Work Manual Chapter on “[Series of Marks](#)” do you find most useful and relevant for reference? Which part(s) do you find the most complex? Do you have any suggestion(s) on how the Chapter can be improved to better the understanding of the requirements for series marks?**

¹⁵ The Hong Kong Intellectual Property Department and the Intellectual Property Office of the United Kingdom allow for a limit of up to 4 and 6 marks in a series of marks, respectively.

C: SIMPLIFYING AND STREAMLINING COMMON PROCESSES

1. Relief measures for Trade Mark and Registered Design applications

- 1.1 When an application to register a Trade Mark/Registered Design becomes treated as withdrawn as a result of non-compliance with IPOS' deadline in an examination report/written notice, the applicant can currently lodge a reinstatement request together with the omitted act, all within 6 months after the deadline to respond to the examination report/written notice ("reinstatement period").

Current situation

Trade Marks

- 1.2 When a Trade Mark application becomes treated as withdrawn as a result of non-compliance with IPOS' deadline in an examination report, IPOS will not cite it against later conflicting marks which are filed during the reinstatement period until it has been reinstated.¹⁶ This means that later conflicting marks have earlier rights over Trade Mark applications which are treated as withdrawn. A Trade Mark application that is treated as withdrawn may not be reinstated if a citation objection is raised and the applicant is unable to overcome the citation objection.
- 1.3 The current practice may bring uncertainty to applicants as the approval to reinstate a Trade Mark application that is treated as withdrawn is not definite and is subject to various considerations.

Registered Designs

- 1.4 Currently, the Registrar could potentially register two designs which are identical. This can occur in the scenario when a prior application of the identical design has unresolved deficiencies and is subsequently treated as withdrawn as a result of non-action on the deficiencies raised. An applicant of the prior application has 6 months to file a reinstatement request and resolve the earlier deficiencies raised. During this time, the later application of the identical design can be registered as it would still fulfil the criteria of a new design.¹⁷

¹⁶ Please refer to [Trade Marks Circular No. 6/2013](#) (dated 7 June 2013).

¹⁷ Section 5(2) of the Registered Designs Act.

- 1.5 Even after the later application is registered, the earlier application which becomes treated as withdrawn can be registered when it is reinstated with the earlier deficiencies resolved. The later filed application will not destroy the novelty of the earlier filed application.
- 1.6 An applicant currently has 3 months to respond to deficiencies, failing which the Registered Design application will be treated as withdrawn. In this instance, the applicant has another 6 months to file a reinstatement request for the Registered Design application which is treated as withdrawn. The reinstatement period of 6 months appears to be unnecessarily long and increases the possibility of registration of identical designs. Moreover, during this reinstatement period, the applicant can further request an extension of time to file for reinstatement, further prolonging the registration process.
- 1.7 There is a need for a more balanced time frame for applicants to provide their written responses alongside their reinstatement requests for the prior applications, while not delaying the processing of applications with identical design.

Proposed changes

Trade Marks

- a. To replace the current post-deadline relief measure of “reinstatement” in relation to Trade Mark applications which are treated as withdrawn with the “continued processing” measure, a measure that is currently adopted by the Geographical Indications Registry;¹⁸
- b. The applicant may, via Form CM13, request to continue the processing of a Trade Mark application within 2 months after the date the application was treated as withdrawn;¹⁹ and
- c. During this 2-month period, the Trade Mark application that is treated as withdrawn will continue to be cited against later filed conflicting marks.

¹⁸ Under Rule 86 of the Geographical Indications Rules.

¹⁹ Such request has to be made via Form CM13, together with the omitted act and requisite fee, within the proposed deadline. Failure to do so will cause the application to lapse and can no longer be reinstated.

Registered Designs

- a. To shorten the current period to reinstate, via Form CM13, an application for the registration of design that is treated as withdrawn from 6 months to 2 months; and
 - b. Requests to extend the 2-month reinstatement period (via Form CM5) will not be allowed.
- 1.8 The proposed changes for Trade Marks serve to provide greater certainty to both applicants and third parties in terms of the citability of treated as withdrawn Trade Mark applications, while those for Registered Designs reduce the chances of identical designs being registered. These changes are envisaged to also provide a balanced timeframe for applicants to submit their CM13 requests yet spur them to actively attend to IPOS' stipulated response deadlines. Trade Mark and Registered Designs applications are also envisaged to be able to proceed to the next application stages more expeditiously under the proposed changes.

Question C1

- a) **Are you supportive of the proposed changes? Please elaborate with reason(s).**
- b) **Would you have any refinements to the proposed changes? If yes, please elaborate.**

2. Amendments, corrections, rectifications

- 2.1 In the case of *Novartis (Singapore) Pte Ltd v Bristol-Myers Squibb Pharma Co [2017] SGHC 322*, the Singapore High Court provided legal interpretations for provisions under the Patents Act and Rules relating to correction of errors. One observation arising from this decision was that where the register contains an error and the error originates from a form that is filed with the Registry, any request to correct the error should be made to that form, and upon approval of the request, the correction will be reflected in the register. Another observation was that it is good practice for the Registrar to advertise the proposed correction (i.e., correction of priority details), so that third parties can have the opportunity to oppose the correction.

Current situation

- 2.2 Under the current Patents legislation, the Registrar does not have the power to advertise any proposed correction affecting the register.²⁰ Hence, third parties do not have the opportunity to oppose a correction before it is approved by the Registrar. This statutory power is also not available for the other IP, except for Geographical Indications.²¹
- 2.3 Notwithstanding the above, the Trade Mark legislation provides a process for third parties to request rectification of any information in the register,²² and the proprietor of that Trade Mark is able to oppose the rectification request before it is approved.²³

Proposed changes

- 2.4 Taking guidance from the case, it is proposed to
- a. give the Registrar the power to advertise any proposed correction affecting the register (whether or not the error originates from a form) for Trade Marks, Registered Designs, Patents and Plant Varieties Protection before the Registrar decides on the proposed correction. Existing procedures allowing for changes to be applied and effected through the International Bureau for Madrid and Hague applications as well as the procedure referred to in para 2.3 will remain; and

²⁰ Rule 58 of the Patents Rules.

²¹ Rule 49(4) of the Geographical Indications Rules.

²² Rule 57(1A)(b) of the Trade Marks Rules.

²³ Rule 58(1) of the Trade Marks Rules.

- b. for the Registrar to exercise this discretion for corrections that may impact third parties, including but not limited to those relating to priority details and name of applicant which results in a change in IP ownership.
- 2.5 For the proposed correction that will be advertised, third parties will have the opportunity to oppose the correction using existing opposition mechanism.²⁴ IPOS is mindful that the period for opposition should take into account that there is sufficient time for third parties to review the proposed correction and put in any opposition, and yet does not overly protract the overall timeline for processing of the application.
- 2.6 For correction of priority details in a published Patent application, the considerations as laid out in the Patents Circular No. 4/2018 still apply.²⁵
- 2.7 The proposed changes can help promote greater transparency and certainty to the overall prosecution process.

Question C2

- a) Do you agree that the proposed corrections relating to priority details and name of applicant which result in a change in IP ownership should be advertised? Please elaborate with reason(s).**
- b) Are there any other proposed corrections that you think should be advertised? Please elaborate with reason(s).**
- c) Is 2 months a reasonable period for advertisement? If no, please propose a period and provide us with the rationale.**

²⁴ Rules 91(5) to (8) of the Patents Rules.

²⁵ Please refer to paragraph 7 of the [Patents Circular No. 4/2018](#).

3. Application for registration of transactions for IP rights

- 3.1 Registrable transactions of IP rights refer to transactions where a person claims to be entitled to an interest in or under a registered IP. More commonly known registrable transactions would include the assignment of an IP, the grant of a licence and the granting of a security interest, where applications of such registrable transactions could be done via Form CM8, CM6 and CM7 respectively. Such transactions, when recorded on the register, allow parties to be aware of the kind of rights that exist under an IP, and which entity possesses those rights.
- 3.2 Recordal of the transactions on the register within a stipulated time as governed under the respective IP Acts²⁶ will also allow a proprietor to be awarded with damages or order to be given an account of profits in respect of an infringement occurring if the transaction, instrument or event is applied to be registered or is registered (as the case may be).

Current situation

- 3.3 The current process of recording a registrable transaction in respect of a Trade Mark, a Registered Design or a Patent with IPOS involves the following steps:
1. Requestor to validate the recordal at point of completing application form
 - The requestor will need to validate that the recordal is authorised by all relevant parties to that transaction. There are currently two forms of validations available for the recordal of registrable transactions:
 - a. Submit a copy of the documentary evidence or statutory declaration establishing the transaction; or
 - b. The application needs to be authorised by the following means:
 - (i) in the case of an application made outside of IP²SG, the application form must be signed by or on behalf of the relevant parties to the transaction; or
 - (ii) in the case of an application made via IP²SG, the requestor must declare that he is authorised by the relevant parties to

²⁶ Section 39(4) of the Trade Marks Act, Section 34(4) of the Registered Designs Act and Section 75 of the Patents Act.

file and validate the application for the registration of the transaction, and that the requestor understands that he may be liable for criminal prosecution for making a false declaration in this application.

- The relevant parties²⁷ for the purposes of various registrable transactions under each IP regime are as follows:

	Assignment	Security interest	Licence	Vesting of an assent
Trade Marks	Assignor and assignee	Grantor	Grantor	Personal representative of an assent
Registered Designs				Personal representative and beneficiary of an assent
Patents	Assignor			

2. [Only for assignment records] Sending of pre-recordal notice by Registrar

- Once IPOS receives an application to record an assignment, IPOS will send a pre-recordal notice to the current proprietor on record (or the representing master agent on record), copying the requestor.²⁸

3. Registrar to record the registrable transaction

- If the application is in order and has no objections raised from the parties who received the pre-recordal notice, the Registrar will proceed to record the transaction. The Registrar will also send a confirmation letter to the requestor, copying the current proprietor (or the representing master agent on record relating to the application) on record and to the subsequent proprietor (or the representing master agent on record).

²⁷ Rule 55(2) of the Trade Marks Rules, Rule 37(2) of the Registered Designs Rules and Rule 57(2) of the Patents Rules.

²⁸ Pre-recordal notice will be sent to the relevant address for service on record. It will not be sent if the requestor of the assignment request is the current proprietor on record (or the representing master agent on record).

Proposed changes

3.4 The proposed process is as follows:

1. Requestor to validate the recordal at point of completing application form

- To streamline the process, the requestor will only need to make a declaration via IP²SG that there is authorisation by all relevant parties to that transaction, or that the documentary evidence establishing the transaction has been verified by the requestor. For the latter, documentary evidence or any other supporting evidence (e.g., statutory declaration) establishing the transaction need not be submitted unless the Registrar subsequently requests.
- To facilitate requestors in seeking authorisation from the relevant parties, it is proposed to streamline the definition of “relevant parties” for the purposes of various registrable transactions across the Trade Marks, Registered Designs and Patents legislation to the following:

	Assignment	Security interest	Licence	Vesting of an assent
Trade Marks, Registered Designs and Patents	Assignor	Grantor	Grantor	Personal representative and beneficiary of an assent

2. Registrar to record the registrable transaction

- If the application is in order, the Registrar will proceed to record the transaction. The Registrar will also send a confirmation letter to the requestor, copying the current proprietor (or the representing master agent on record relating to the application) on record and to the subsequent proprietor/grantee (or the representing master agent as the case may be).

Question C3

- a) Are you supportive of the proposal to streamline the definition of “relevant parties” across the Trade Marks, Registered Designs and Patents legislation? Please elaborate with reason(s).
- b) Do you have any refinement(s) to the proposed changes? If yes, please elaborate.

D: IMPROVING USER EXPERIENCE AND SERVICE WITH DIGITAL INITIATIVES

1. Use of Artificial Intelligence technologies in decision making

1.1 Artificial Intelligence (“AI”) and computerised decision making has opened up possibilities in improving productivity and timeliness of decision making. At the same time, this frees up the time taken by officers to deal with more complex matters. IPOS is preparing for a future when a fully computerised system can be used to assess IP applications independently.

Use of AI in other IP Offices²⁹

1.2 AI has already been deployed for use in IP administration. For example, the World Intellectual Property Organization (“WIPO”) is using AI for the translation of patent documents, searching of similar trade marks and for patent classification. Furthermore, there are more than 20 offices which are exploring the use of AI for IP administration, such as in the field of patent prior art search, customer service, and trade mark classification. For instance:

- Australia has amended their IP legislation to provide that decisions made by a computer system and overseen by the Commissioner are deemed decisions of the Commissioner, in Australia’s Intellectual Property Laws Amendment (Productivity Commission Part 1 and Other Measures) Act 2018.
- Estonia has published a vision paper in February 2020 seeking proposals to revolutionise its public service in the age of AI.
- New Zealand consulted their stakeholders in May 2019 on potential approaches to legislative amendments to allow a computer system to make discretionary decisions.

Use of AI in IPOS

1.3 IPOS has recently adopted AI technology for the trade mark image search function on IPOS’ mobile e-filing platform, *IPOS Go*. As IPOS continues to harness technologies to offer faster and more efficient services for our customers, IPOS is considering the possibility of a future where a computer could be used to make complex decisions independently.

²⁹ Information from WIPO’s compilation https://www.wipo.int/about-ip/en/artificial_intelligence/ip_administration.html and https://www.wipo.int/about-ip/en/artificial_intelligence/policy.html

Future Use of AI in IPOS

- 1.4 Apart from taking into account the baseline considerations and measures recommended by the Model AI Governance Framework,³⁰ IPOS recognises the need for specific enablers for the adoption of AI in IP administration. These include legislative amendments to allow delegation of the Registrar’s decision-making powers to a computer and putting in place adequate safeguard measures for independent decisions issued by computers. Examples of operational safeguards would include the conducting of rigorous testing of the computer before deployment and regular reviews of the computer’s decisions. Examples of legislative safeguards include granting the Registrar with the powers to reverse erroneous computer decisions and introducing a channel for applicants to appeal to human officers regarding the computer’s decisions.
- 1.5 To illustrate, IPOS has prepared two possible scenarios in which a computer could be used to make certain independent decisions on IP applications and registrations. We wish to seek feedback on any potential concerns and suggestions on safeguards that should be put in place. It should be noted that the following examples are meant to illustrate how AI technologies could be used for decision-making. They are not exhaustive and may not be the specific applications which IPOS may eventually deploy AI technologies for.

Examples

Assessing Extension of Time Requests

- 1.6 Extension of Time requests are commonly filed whenever applicants require more time to respond to the Registrar’s letters. The Extension of Time requests considered here could be:
- A request made to further request an extension of time in relation to a Patent application;³¹ or
 - The third or any subsequent request made to request an extension of time in relation to a Trade Mark application or a Registered Design application.³²

³⁰ The Model AI Governance Framework, first released by the Personal Data Protection Commission Singapore (“PDPC”) in 2019, provides detailed and readily implementable guidance specifically to address key ethical and governance issues when deploying AI solutions, and aims to promote public understanding and trust in technologies. The framework covers the principle that AI decision-making should be **explainable, transparent and fair**.

³¹ Rule 108(5) of the Patents Rules. The applicant will need to satisfy the Registrar that he has continuing underlying intention to proceed with the application before the extension of time is allowed.

³² Rule 77(2)(a) of the Trade Marks Rules and Rule 57(4)(a) of the Registered Designs Rules. The applicant will need to satisfy the Registrar that there is a good and sufficient reason for the extension.
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- 1.7 The situations above require an Extension of Time request to be accompanied by the grounds for the request. An AI technology could be used to assess the reasons provided by the applicant in support of his Extension of Time request and make a judgement on its acceptability. This would help to improve the speed and efficiency of processing such requests. In the event that the AI technology determines that the reasons for such an Extension of Time request are not acceptable, the applicant will still be provided with the opportunity to write in to appeal the decision. The appeal will subsequently be reviewed by a human officer.

Determining the Registrability of Certain Trade Marks

- 1.8 Another example is the use of an AI technology to determine the registrability of single and/or simple word marks, to allow applicants to be notified of the outcome of their applications in an expedited fashion. In this scenario, the outcome of an examination would be determined by the computer, rather than a human examiner. For example, a word mark could be compared to the goods and/or services for which it is claimed for, and also take reference to dictionaries and/or encyclopaedias to determine if the application would warrant an objection.³³
- 1.9 Marks that are deemed to be acceptable by the AI technology will subsequently be checked by a human examiner before the mark proceeds to publication. This is similar to IPOS' current practice, where a second examiner assesses the acceptance of a mark to ensure that the decision made is in line with the Registry's examination standards and practices.
- 1.10 Conversely, if the AI technology assesses that an application is not acceptable, a deficiency letter will be sent to the applicant without human review. Nevertheless, the applicant who receives a deficiency letter will still have the opportunity respond to it if he wishes to dispute the objections raised. Subsequent responses for the application will then be handled by a human examiner. The AI's decisions will also be regularly reviewed by human examiners to ensure that they conform to the Registry's standards and practices.

³³ Absolute grounds objection under Section 7 of the Trade Marks Act.

Question D1

- a) Are the safeguard measures described in each example above sufficient? If not, what are your concerns, and what other operational and/or legislative safeguard measures would you deem necessary in the adoption of decision making by AI?
- b) While IPOS will carry out due diligence and conduct rigorous testing before rolling out AI solutions, are there other specific areas you think that should be paid attention to? If so, please elaborate on the reasons and also possible measures.

END