

Intellectual Property Office of Singapore  
Registry of Patents

Circular No. 3/2021: Introduction of Amendments to the Patents Rules and Electronic Filing and Service of Documents

## **Introduction of Amendments to the Patents Rules and Electronic Filing and Service of Documents**

(Circular No. 3/2021, dated 10 September 2021)

### **Amendments to the Patents Rules**

1. Amendments will be made to the Patents Rules (“PT Rules”) to:
  - (a) Enhance dispute resolution processes, and
  - (b) Streamline patent operational processes.
2. These amendments will take effect on 1 October 2021. A summary of the key amendments is provided below.

### **Enhancements to Dispute Resolution Processes**

3. Amendments will be made to implement two new patent processes first introduced in the Intellectual Property (Dispute Resolution) Act 2019, namely:
  - (a) Formalised Pre-Grant Third Party Observations
4. A new Rule 45A of the PT Rules will be introduced to provide for the process of dealing with third party observations on the question of whether an invention is a patentable invention.
  - (b) Re-Examination After Grant
5. A new Rule 52A of the PT Rules will be introduced to provide for the process of re-examination after grant.
6. Please refer to **Annex A** for further details of the two new patent processes.

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## Streamlined Operational Processes

7. Various amendments will be made to the PT Rules to streamline patent operational processes, including:

### Notification of Statement of Inventorship of Right to the Grant of a Patent

8. As inventors are generally aware of their inclusion in a patent application, IPOS will no longer notify inventors when they have been mentioned in an application first filed in Singapore.<sup>1</sup> Rule 18(2) of the PT Rules will be deleted to reflect the new practice.
9. The full list of amendments made to the PT Rules can be accessed [here](#).

## Electronic Filing and Service of Documents

10. The COVID-19 pandemic has accelerated the digitalisation of operations for businesses and IP Offices worldwide. In tandem with the legislative amendments to the PT Rules, IPOS will shift towards greater digitalisation of our filing and communications procedures to provide better convenience to our customers.
11. The default mode of filing and/or service of documents on the Registrar for transactions relating to Patents, Trade Marks, and Registered Designs is through our electronic online system, IP<sup>2</sup>SG.<sup>2</sup> Timing with the implementation of the above new processes, IPOS will no longer accept the filing and/or service of documents via alternative filing modes such as FormSG if these actions can be done via IP<sup>2</sup>SG. However, forms or requests which are unavailable on IP<sup>2</sup>SG may still be submitted via FormSG.
12. To update on this new practice, two new Practice Directions, [IP<sup>2</sup>SG Practice Direction \(No. 1 of 2021\)](#) and [Registries Practice Direction \(No. 1 of 2021\)](#) have been published and will take effect on 1 October 2021.
13. If you have any enquiries on this Circular, please email us at [ipos\\_enquiry@ipos.gov.sg](mailto:ipos_enquiry@ipos.gov.sg).

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<sup>1</sup> The practice is currently only applicable for applications where the applicant is not the sole inventor or the applicants are not the joint inventors of the invention.

<sup>2</sup> IP<sup>2</sup>SG is IPOS's one-stop e-filing portal for businesses to transact and communicate with IPOS. IP<sup>2</sup>SG also allows businesses to manage their filings and registrations in one convenient location. Customers with a valid Singpass ID and an authorised Singapore mailing address can easily create an IP<sup>2</sup>SG account to begin transacting on IP<sup>2</sup>SG. Foreign-based corporate entities who wish to create a Corppass account may refer to the Corppass website ([www.corppass.gov.sg](http://www.corppass.gov.sg)) for more details.

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## Annex A

### Formalised Pre-Grant Third Party Observations

The purpose of the third party observations process is to give the public an opportunity to notify the Registrar of any written state of the art information that might be relevant for assessing the patentability of the patent application. A person who submits the third party observation does not become a party to any proceedings under the Patents Act.

The existing pre-grant third party observations process will be formalised, to allow observations to be considered for examination when they are submitted at any time after the date of publication of the application and before the issuance of the relevant examination report, search and examination report or supplementary examination report. Third party observations that are considered for examination will be published on the Patents Open Dossier.<sup>3</sup>

Third party observations must be submitted through IP<sup>2</sup>SG via the ad-hoc correspondence module and observations should preferably be accompanied by any relevant prior art documents. The document type “Third Party Observations” will allow these supporting documents to be furnished. There is no fee and official form for this service. If you wish for your identity to be kept confidential, third party observations may be submitted via a registered patent agent.

Where a third party observation is assessed to impact patentability and so results in a written opinion, the patent applicant may formally respond to the written opinion using PF13A.

### Re-Examination After Grant

Re-examination after grant is a process in which a request can be made to re-examine a granted patent. A person may request for a patent to be re-examined, with accompanying reasons and documents. If the Registrar finds that an alleged ground is made out and not resolved by the patentee, the patent may be revoked. It also allows patentees to evaluate and strengthen their patent through amendments which will be subject to an examination process. The grounds for re-examination are generally limited to requirements which are considered during examination. The re-examination request may be filed any time after the 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.

A request for re-examination should be filed via Patents Form 36 with the prescribed fee. The request must state the reasons supporting the non-validity of the granted patent, and accompanied with relevant prior art documents if appropriate. The patentee will be notified if there is a request for re-examination.

If the Examiner issues a written opinion, the patentee will be given an opportunity to provide written submissions and propose amendments via Patents Form 13A. If the Examiner reviews

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<sup>3</sup> Only applicable for patent applications lodged on and from 14 February 2014.

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the specification of the patent and finds the patent valid nonetheless, no action by the patentee is needed. As re-examination is an *ex parte* process, the applicant seeking re-examination cannot participate in the process after filing the request (unless it is the patentee) and would only be notified when a re-examination examination report is issued.

The request for re-examination, written opinion, and examination report in relation to the re-examination process will be published on the Patents Open Dossier. Similarly, to maintain confidentiality of the identity of the requestor for re-examination, the requests for re-examination may be submitted via a registered patent agent.

For more information on third party observations and re-examination after grant, please refer to the [Examination Guidelines for Patent Applications at IPOS](#).

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