

Intellectual Property Office of Singapore

Registry of Patents

Circular No. 4/2024: Pilot Initiative – No Extension of Time Fee to File a Request for a Search and/or Examination Report

Pilot Initiative – No Extension of Time Fee to File a Request for a Search and/or Examination Report
(Circular No. 4/2024, dated 19 August 2024)

IPOS has received feedback that applicants welcome having more time to consider how best to proceed with the search and/or examination of their Singapore patent applications. This takes into account applicants' global patenting strategies and IP commercialisation developments.

2. To better support applicants in their IP filings, IPOS is piloting an initiative where eligible applicants may obtain – at no cost¹ – an additional 18 months to file requests for search and/or examination reports.

3. This initiative is for applicants who intend to file requests for search and examination reports under section 29(1)(b), and requests for examination reports under section 29(1)(c) or section 29(3) of the Patents Act 1994. Under the Patents Rules, the period prescribed for filing a request is 36 months (rule 43(1)) (“period prescribed”), but this duration shall be extended by up to 18 months by the filing of Patents Form 45 within 18 months after the end of the period prescribed (rule 108(4)).

4. To benefit from this pilot initiative, applicants must:

- ensure that the period prescribed for the application expires between 1 September 2024 and 31 August 2026 (both dates inclusive);
- select the new option in Patents Form 45 to extend the period prescribed by 18 months; and
- ensure compliance with all the relevant provisions.

5. On approval, the period prescribed will be extended by 18 months, at no cost. Where an applicant had already obtained a previous extension (of less than 18 months), a request under this pilot initiative will allow the period prescribed to be extended at no cost, up to the maximum extension of 18 months.

Continued Flexibility to Leverage Patent Acceleration Programmes

6. Applicants who prefer to receive earlier search and/or examination reports from IPOS and use the reports to advance their corresponding patent applications overseas may continue to tap IPOS' suite of acceleration programmes with SG IP FAST, the ASEAN Patent Examination Co-operation (ASPEC), Collaborative Search and Examination (CS&E) with Vietnam and the Patent Prosecution Highway (PPH).

¹ The official fees for filing a request for extension of time (Patents Form 45) will be waived for the duration of this pilot initiative. Official fees for Patents Form 11 (Request for a Search & Examination Report) or Patents Form 12 (Request for an Examination Report) are not waived.



7. It is also possible that applicants obtain positive outcomes from corresponding applications during the extended period, which can be used to leverage PPH programmes² for acceleration at IPOS. Applicants relying on positive outcomes from corresponding applications generally require fewer office actions and have a higher grant rate. For such applicants relying on PPH, IPOS endeavours to produce a first written opinion within 10 months of the PPH request.

8. Please see responses to frequently asked questions in the **Annex** for more information on the pilot initiative. Details on our acceleration programmes are available at: <https://www.ipos.gov.sg/about-ip/patents/how-to-register/acceleration-programmes>.

9. If you have any enquiries on this Circular, please send an email to ipos_enquiry@ipos.gov.sg.

10. Thank you.

² IPOS has PPH arrangements with more than 30 partners, including the patent offices of China, Japan, Korea, and the United States, and the European Patent Office.



Annex – Frequently Asked Questions

Q1: Which are the periods prescribed that can be extended at no cost under the pilot initiative?

A1: The period prescribed that can be extended under the pilot initiative is the duration for filing a request for a search and/or examination report under section 29(1)(b) of the Patents Act 1994 (Patents Form 11), section 29(1)(c) or section 29(3) of the Patents Act 1994 (Patents Form 12). As mentioned in the circular, the period prescribed is 36 months (rule 43(1)). This period prescribed can be extended for 18 months (rule 108(4)) under the pilot initiative.

In addition, the pilot initiative is limited to where the period prescribed expires between 1 September 2024 and 31 August 2026 (both dates inclusive).

The initiative is not applicable to a request for a search report under section 29(1)(a) (Patents Form 10).

Q2: Rule 108(4) of the Patents Rules provides for an extension of up to 18 months. Is the pilot initiative applicable to the full 18 months extension or only a part thereof?

A2: The pilot initiative is applicable to a request for an extension of time of 18 months, pursuant to rule 108(4) of the Patents Rules.

If the period prescribed (rule 43(1)) had been previously extended by less than 18 months, a request under this pilot initiative will result in the maximum extension of 18 months being given.

For example, where the period prescribed for filing Patents Form 11 had been previously extended by 3 months, the subsequent request under the pilot initiative will extend the period prescribed for a further 15 months.

Please note that the relevant provisions continue to apply, i.e., the extension begins immediately after the expiry of the period prescribed, and Patents Form 45 must be filed no later than 18 months after that expiry.

Q3: Rule 108(4) of the Patents Rules allows for an extension of time of up to 18 months to be requested after the expiry of the period prescribed for filing a request for a search and/or examination report, provided that the request is filed no later than 18 months after the expiry of the period prescribed. Can a request for an extension of time made after the expiry of the period prescribed benefit from the pilot initiative?

A3: We would encourage applicants to request for an extension of time before the expiry of the period prescribed to prevent the application from being treated as abandoned. That said, under the pilot initiative, an applicant who decides to apply for an extension of time after the expiry of the period prescribed will be able to do so at no cost.



Q4: IPOS previously extended the period prescribed for my application to file a request for search and examination by 3 months, such that the period prescribed now expires on 1 October 2024 instead of 1 July 2024. Since the extended period expires on 1 October 2024, which falls between 1 September 2024 to 31 August 2026, am I eligible for the pilot initiative?

A4: No, the pilot initiative is only applicable for applications where the period prescribed for filing a request for a search and/or examination report expires between 1 September 2024 and 31 August 2026 (both dates inclusive).

Q5: IPOS has extended the period prescribed to request for search and/or examination report by 18 months under this pilot initiative. Would I be eligible for any further extension of time?

A5: Any further extension of time beyond the 18 months is discretionary and must be requested before the end of the 18 months (see rule 108(5) of the Patents Rules). As there is a fee for requesting for a further extension of time, applicants may wish to file the request for a search and/or examination report (i.e., Patents Form 11 or 12) earlier, such as before the 17th month, for contingency purposes.

Q6: The period prescribed for my application to file a request for a search and examination report expires on 1 September 2024. IPOS had approved, before the start of the pilot initiative, an extension of the period prescribed under rule 108(4) of the Patents Rules by 3 months to 1 December 2024. Can I withdraw and seek a refund of the previous request and file a new request for an extension of time under the pilot initiative instead?

A6: No, it is not possible to obtain a refund for the request for extension of time that has already been approved. However, it is possible to request for extension of time for the remainder period (i.e., 15 months), at no cost.

Q7: The period prescribed for my application to file a request for a search and examination report expires on 1 September 2024. I have already filed Patents Form 11 to request for a search and examination report. Can I withdraw and seek a refund for the Patents Form 11 and request for an extension of time under the pilot initiative instead?

A7: Yes, it is possible to withdraw Patents Form 11 and obtain a refund for the request for a search and examination report, provided that IPOS has not started the search and examination. You may write to IPOS to enquire on the status of the application.

Q8: I have been using IPOS as the office of first examination. Are there programmes to facilitate receiving IPOS' search and examination reports earlier to accelerate my patent applications in other countries?

A8: IPOS continues to maintain patent acceleration programmes with other countries. Applicants who would like to use IPOS as the office of first examination can still choose IPOS as an International Search Authority (ISA) for PCT applications or leverage on IPOS' acceleration programmes for national applications, such as SG IP FAST. Providing applicants the flexibility to proceed with the search and/or examination in Singapore based on their needs will help IPOS allocate our examination resources accordingly.

