

What is in this Guide?

This round of amendments generally aligns our patent system with two significant changes to the Regulations under the Patent Cooperation Treaty (or PCT) to which Singapore is a party. These changes in the PCT Regulations came into force on 1 April 2007. They relate to:-

- Late declaration of priority under section 17, i.e. restoration of right of priority
- Treatment of description not included in application as filed, i.e. incorporation by reference of description
- Treatment of parts missing from the specification as filed, i.e. incorporation by reference of missing parts

In addition to the PCT related changes, IPOS also took into account the feedback of patent users wherever possible and introduced amendments that would clarify or simplify filing requirements and procedures.

Purpose of this Guide

The purpose of this Guide is to provide users with an overview of the April 2007 amendments to the Patents Act and Rules.

Do take note that this Guide is neither exhaustive nor authoritative. Please refer to the Patents Act and Rules for details.

Feedback if any

This Guide is prepared by the Patent Quality Management Unit (PQMU).

If you have any suggestions or feedback in relation to this Guide, please drop us an e-mail (ipos_enquiry@ipos.gov.sg) and attention it to this Unit.

Patents Quality Management Unit (PQMU)
IPOS



Guide to Patents Law Amendments

Statutes (Miscellaneous Amendments) Act 2007

Patents (Amendment No. 2) Rules 2007

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1. DECLARATION OF PRIORITY

Getting Started

1.1 In addition to the Patents Act and Rules, you are advised to have before you the following documents before you proceed to read the rest of this section in this Guide:-

- Statutes (Miscellaneous Amendments) Act 2007
- Patents (Amendment No. 2) Rules 2007
- Patents Form 57

Basic Concepts

Sections
17(2);
17(2A)(a)

1.2 Filing the application in suit within 12 months

In general, an applicant must file his Singapore patent application (application in suit) within 12 months from the date of filing of the earlier relevant application (or where there is more than one relevant application, the earliest of them) which is the subject of a priority declaration in the application in suit. The “priority date” of an invention to which an application for a patent relates will then be the date of filing of that earlier relevant application (or where there is more than one relevant application, the earliest of them).

Further, the term “declared priority date” is defined in the Rules and is used in the calculation of time periods referred therein.

Rule 9(1)

1.3 Making a declaration of priority under section 17(2)

A declaration of priority for the purposes of section 17(2) shall be made by the applicant at the time of filing the Singapore patent application.

1 What's new? – Late Declaration of Priority under section 17(2B) (Restoration of Right of Priority)

Section 17(2A)(b) 1.4 In general, applicants must file their application in suit within 12 months from the date of filing of the earlier relevant application which is the subject of a priority declaration in the application in suit.

Rules 9A(1); 86(3A); 117(6)

With the Apr 2007 amendments in place, applicants will have a chance to make a priority declaration on the earlier relevant application even though they failed to file the Singapore patent application within the 12 month period referred to in section 17(2A)(a). It should be noted that in the PCT, this feature is known as the restoration of Right of Priority.

This feature is also available for applications before IPOS as a PCT receiving and as well as a national office.

(Refer to paragraph 1.2 for basic concepts)

Section 17(2B) 1.5 This new feature provides applicants with a limited safety net – making it possible for applicants to “restore” a priority declaration of an earlier relevant application made when the application in suit is filed after 12 months but within 14 months from the date of filing of the earlier relevant application (or where there is more than one relevant application, the earliest of them) which is the subject of a priority declaration in the application in suit.

Rule 9A(1)

Rules 9A(2); 86(3A) 1.6 Briefly, to benefit from this feature, applicants have to:-

- file Patents Form 57,
- file the Patents Form within 14 months from the declared priority date (for national filings) or within 1 month from the date the national phase entry of the application begins (for PCT applications),
- pay a fee of \$250/-, and
- state the reason for the failure to file the Singapore patent application within the required time period under section 17(2A)(a).

Sections
17(2C),
17(2D)

1.7 The reason for the failure to file the Singapore patent application within the required time period must either:-

- be unintentional or
- have occurred in spite of due care required by the circumstances having been taken by the applicants.

For PCT applications, Singapore has notified the International Bureau (IB) that either of these two criteria would be available for applicants to choose in respect of requests for restoration of the right of priority made before Singapore as the receiving Office and as the designated Office.

Rule
9A(3)

1.8 Note that such a request for restoration can only be made for national filings if the application has not been published under section 27 of the Patents Act. If a request was made previously for an early publication of the Singapore patent application, this request has to be withdrawn.

For PCT national phase entries, this non-publication requirement does not apply.

(For more information on the requirements specified by the various patent offices [e.g. fee payable] on the restoration of right of priority in relation to PCT applications, please refer to the WIPO website at www.wipo.int.)

1.9 Example

Step 1

Details of Singapore patent application as filed:-

- Declared priority date = NIL
- Date of filing = 4 Apr 2007

Step 2

Applicant requests to restore a priority claim on 10 Apr 2007 (earliest priority date will be 4 Mar 2006) to the patent application.

Step 3

Details of Singapore patent application after the request for restoration of priority (on 10 April 2007) is made successfully and the request is approved by the Registrar:-

- Declared priority date = 4 Mar 2006
- Date of filing = 4 Apr 2007

Rules
9A(5);
9A(6);
102

1.10 In the event where the reason given for the failure to file the Singapore patent application on time is deemed not satisfactory by the Registrar, the registry will send a notification to the applicants. Applicants are required to reply within 2 months from the date of the registry's notification by making observations or by filing evidence to overcome the Registrar's said objection.

(Refer to the Patents Rule 102 for details on what constitutes as an evidence)

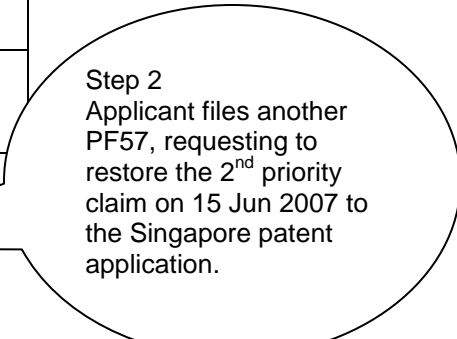
1.11 Restoring a priority claim is not restricted to the earliest priority claim of the application in suit. It is possible to request for permission to make a late declaration of any priority claim as long as the request satisfies the conditions referred to in section 17(2D) of the Patents Act.

1.12 Example

Step 1

Details of Singapore patent application as filed:-

Date of Filing	4 Apr 2007
1 st Priority Details (Restoration earlier sought under PF 57 and restored)	4 Mar 2006 0123,4567; US
2 nd Priority Details (Yet to seek restoration)	5 Mar 2006 0123,4568; US



Step 2
Applicant files another PF57, requesting to restore the 2nd priority claim on 15 Jun 2007 to the Singapore patent application.

Step 3

The request to restore the 2nd priority claim would not be allowed as PF57 (which is filed on 15 Jun 2007) is filed beyond the prescribed period of 14 months.

Details of Singapore patent application now:-

Date of Filing	4 Apr 2007
1 st Priority Details (Restoration earlier sought under PF 57 and restored)	4 Mar 2006 0123,4567; US
2nd Priority Details (Yet to seek restoration)	5 Mar 2006 0123,4568; US

Take Note!

Rule
108(2) 1.13

! Applicants must be careful not to miss the 14 month period to file the application in suit and they should comply with all the requirements given under section 17(2D) if a request for the restoration of right of priority is made. This period is not extendable.

1.14

! All relevant deadlines will be affected when a request for restoration of priority claim is allowed.

Transitional and Savings Provisions

1.15

These new features will apply to an application for a patent that qualifies for a date of filing on or after 1st April 2007, and section 17 of the Patents Act and rule 9 of the Patents Rules in force immediately before that date shall continue to apply to an application for a patent that qualifies for a date of filing before that date.

The said transitional and savings provisions apply equally to PCT national phase entries as section 87(1)(a) states that *“Where an international application for a patent (Singapore) is accorded a filing date under the Patent Co-operation Treaty - that date or, if the application is re-dated under the Treaty to a later date, that later date shall be treated as the date of filing the application under this Act”*.

1.16 Example

Step 1

Details of Singapore patent application as filed:-

Date of Filing	4 Mar 2007
----------------	------------

Step 2

Applicant files PF57, requesting to restore the priority claim on 10 Apr 2007 to the Singapore patent application. Priority date given on PF57 – 1 Mar 2006

Step 3

The request to restore the right of priority would not be allowed as the date of filing of this application is before 1 Apr 2007.

2

What's new? – Declaration of Priority made after the date of filing (Addition of Priority Claim)

Rule 9(2) 1.17 Notwithstanding the general principle in rule 9(1), it is now possible to make a declaration under certain circumstances, after the date of filing.

(Refer to paragraph 1.3 for basic concepts)

Rules 9(2); 108(2) 1.18 To make such a declaration successfully, it has to be done:-

- on Patents Form 57
- with a fee of \$120/-

within 16 months from the declared priority date. The 16 months time period is not extendable.

(Basic concept paragraph 1.2 - Note that in general, the application in suit is still required to be filed within 12 months from the declared priority date.)

- Rule 9(4) 1.19 Such a declaration can only be made if the application has not been published under section 27 of the Patents Act. If a request was made previously for an early publication of the Singapore patent application, this request has to be withdrawn.

Take Note!

- Rule 9(2) 1.20 **!** Declaration of priority via Patents Form 57 after the date of filing of the Singapore patent application can only be used for the earliest priority claim.

- 1.21 **!** All relevant deadlines will be affected when the declaration of priority is added to the Singapore patent application.

- 1.22 A right of priority to an earlier application can be restored **only** if the earlier application has been declared in accordance with rule 9. If the said application is the intended earliest relevant application and it was not declared when filing the application in suit, you will need to, at the same time as making the request for restoration, make a declaration after the date of filing under rule 9(2).

- 1.23 Example

(A) Application in suit is filed within 12 months from declared priority date

Step 1

Details of Singapore patent application as filed:

- Declared priority date = NIL
- Date of filing = 4 Apr 2007

Step 2

Applicant makes a declaration of priority on 10 Apr 2007 (earliest priority date = 4 Apr 2006) to the patent application. Fee payable for this case would be \$120.

Step 3

Details of Singapore patent application after the declaration of priority (on 10 April 2007) is made successfully:-

- Declared priority date = 4 Apr 2006
- Date of filing = 4 Apr 2007

(B) Application in suit is filed within 14 months from declared priority date

Step 1

Details of Singapore patent application as filed:-

- Declared priority date = NIL
- Date of filing = 4 Apr 2007

Step 2

Applicant files PF57, making a declaration of priority and requesting to restore the priority claim at the same time on 10 Apr 2007 (earliest priority date = 4 Mar 2006). As 2 items are selected in PF57, total fee of (\$120 + \$250) \$370 is payable.

Step 3

Details of Singapore patent application after the declaration of priority and restoration of the priority claim is made successfully and approved by the Registrar:-

- Declared priority date = 4 Mar 2006
- Date of filing = 4 Apr 2007

Transitional and Savings Provisions

- 1.24 These new features apply to an application for a patent that qualifies for a date of filing on or after 1st April 2007, and rule 9 of the Patents Rules in force immediately before that date shall continue to apply to an application for a patent that qualifies for a date of filing before that date.

3

What's new? – Correction of Priority Claim

- Rule 9(3) 1.25 With the Apr 2007 amendments, the correction of a mistake in a declaration affecting the declared priority date within the period prescribed, will involve less administrative steps.

Rules 9(3); 108(2) 1.26 To do so, applicants would have to

- file Patents Form 57
- pay a fee of \$120/-

within 16 months from the declared priority date so changed. The 16 months time period is not extendable.

(Basic concept paragraph 1.2 - Note that in general, the application in suit is still required to be filed within 12 months from the declared priority date.)

Rule 9(4) 1.27 Such a correction under this rule can only be made if the application has not been published under section 27 of the Patents Act. If a request was made previously for an early publication of the Singapore patent application, this request has to be withdrawn.

1.28 Example

Step 1

Details of Singapore patent application as filed:-

- Declared priority date = 10 Apr 2006
- Date of filing = 4 Apr 2007

Step 2

Applicant makes a request to correct declaration of priority on 10 Apr 2007 from 10 Apr 2006 to 15 Apr 2006.

Step 3

Details of Singapore patent application after the request to correct the declaration of priority (on 10 April 2007) is allowed:-

- Declared priority date = ~~10 Apr 2006~~ 15 Apr 2006
- Date of filing = 4 Apr 2007

Rule 91 1.29 If the applicants miss the 16 months deadline and still wish to correct a mistake in a declaration, they may file Patents Form 23. Submissions are required to show and prove that an error has occurred.

Rule 91 1.30 For mistakes that are not related to the declared priority date, applicants may file Patents Form 23 to request for a correction. There is a need to provide submissions to prove that an error has occurred.

1.31 Example

When to use PF57 and when to use PF23?

(A) PF57

Step 1

Details of Singapore patent application as filed:-

Date of Filing	4 Apr 2007
1 st Priority Details	4 Apr 2006 0123,4567, US
2 nd Priority Details	4 May 2006 0124,4567, US

Step 2

Applicant files PF57, requesting to correct the declared priority date (to 5 Apr 2006) on 10 Apr 2007 to the patent application.

Step 3

Details of Singapore patent application after the request to correct the declaration of priority (on 10 April 2007) is allowed:-

Date of Filing	4 Apr 2007
1 st Priority Details	4 5 Apr 2006 0123,4567, US
2 nd Priority Details	4 May 2006 0124,4567, US

For this example, PF57 should be used.

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(B) PF23

Step 1

Details of Singapore patent application as filed:-

Date of Filing	4 Apr 2007
1 st Priority Details	4 Apr 2006 0123,4567, US
2 nd Priority Details	4 May 2006 0124,4567, US

Step 2

Applicant files PF23, requesting to correct the 2nd priority date (to 5 Apr 2006) on 10 Apr 2007 to the patent application.

Step 3

Details of Singapore patent application after the request to correct the 2nd priority date (on 10 April 2007) is allowed:-

Date of Filing	4 Apr 2007
1 st Priority Details	4 Apr 2006 0123,4567, US
2 nd Priority Details	4 May 2006 <u>5 Apr 2006</u> 0124,4567, US

For this example, PF23 should be used.

1.32 The table below summarises when the applicants should use PF57 to correct the declared priority date:-

For applications with filing date before 1 Apr 2007	For applications with filing date on or after 1 Apr 2007		
	If request to correct made within 16 months		If request to correct made after 16 months
For all cases	If application published	If application not published	For all cases
	PF 23	PF 23	PF 57

Take Note!

1.33 **!** All relevant deadlines will be altered when a request to correct the declared priority date is allowed.

1.34 Example

Application in suit is filed within 14 months from declared priority date

Step 1

Details of Singapore patent application as filed:-

- Declared priority date = 4 Apr 2006
- Date of filing = 4 Apr 2007

Step 2

Applicant files PF57, requesting to correct the declared priority date and to restore the priority claim at the same time on 10 Apr 2007 (earliest priority date = 4 Mar 2006). As 2 items are selected in PF57, total fee of (\$120 + \$250) \$370 is payable.

Step 3

Details of Singapore patent application after the requests to correct the declared priority date and to restore the right of priority are allowed:-

- Declared priority date = ~~4 Apr 2006~~ 4 Mar 2006
- Date of filing = 4 Apr 2007

Transitional and Savings Provisions

1.35 These new features apply to an application for a patent that qualifies for a date of filing on or after 1st April 2007, and rule 9 of the Patents Rules in force immediately before that date shall continue to apply to an application for a patent that qualifies for a date of filing before that date.

Frequently Asked Questions

Q1: Can I request for the restoration of right of priority for more than one earlier relevant application?

A1: Yes, if one can meet the requirements.

Q2: If I want to correct my Declared Priority Date (DPD) within 16 months, why do I have to file PF 57 when under the pre-Apr 2007 provisions, I could have filed PF 23?

A2: PF 57 is required only where the correction relates to the DPD. And because it relates to the DPD, it provides certainty to applicants, as they know that their request will be granted if requirements are met, as opposed to a PF 23 where the Registrar will look at the merits of the request under rule 91.

This is similar to the PCT international phase provisions as well which says that a mistake is not rectifiable under PCT rule 91 if the mistake is in a priority claim or in a notice correcting or adding a priority claim under Rule 26*bis*.1(a), where the rectification of the mistake would cause a change in the priority date [See PCT rule 26.1*bis* read with PCT rule 91.1(g).]

Q3: What if I want to request for the restoration of right of priority for more than one earlier relevant application? Do I pay multiple fees?

A3: Yes. File one PF 57 for each priority claim. Multiple fees apply.

Q4: Why would the new provision only allow one to add a declaration of a priority claim which would alter the DPD? What if one wishes to make another declaration but that declaration would not alter the DPD?

A4: Rule 9(1) provides that in general any declaration of priority has to be done at the same time the application in suit is filed. This has always been the case.

The new rule 9(2) will provide for a limited scenario where one can make a declaration later, but only if the requirements are met. This feature is new and it serves as a safety net to applicants where the DPD would be altered.

Q5: Why doesn't IPOS incorporate the request for restoration into PF 1(2004)?

A5: For OIS (on-line filing) PF 57 is linked with PF 1(2004).

Q6: Why are the applicants given only 3 months to file description (as an element) or missing part?

A6: These are new features designed to give applicants an added option (for missing element) and a second chance (for missing part). However, a balance has to be sought and uncertainty to the public needs to be minimized, as the application should be put in order as soon as possible. Otherwise, with incomplete documents in the patent file, the processing of the documents has to be put on hold.

For information, under the PCT it is 2 months; under the Patent Law Treaty (PLT) a minimum of 2 months is provided.

Q7: For PF 57, why is there a requirement that the application must not be published?

A7: Once the application is published, the DPD will be made known to the public. Also other search authorities may have done their search based on the incorrect DPD. Hence to avoid these possibilities from occurring, the requirement of non-publication is included.

Likewise, under the PCT, request for restoration and addition/correction cannot be made if a request is made for early publication, unless the early publication request is withdrawn before preparation for publication is completed.

Q8: What kind of evidence is the Registry looking for when we file a request for restoration?

A8: On the interpretation of words “due care” and “intentional”, these words are extracted from the PCT amendments which will come into force on 1 Apr 2007. The new PCT rule 26.3**bis** will apply to receiving Offices (includes IPOS) and IPOS (as receiving Office) will be guided by the receiving Office guidelines from the PCT. As a national office, IPOS can also refer to the PCT guidelines as well when deciding whether the requirements of “due care” or “unintentional” are met.

If one were to apply the ordinary meaning on “unintentional”, it would suggest the establishment of an intention to file the application in suit within the 12 month period mentioned in section 17(2A)(a) and that failure to do so was unintentional.

Unintentional: e.g. letter showing instructions to the agent from the applicant or correspondences to the agent from the applicant which indicate the applicant’s intention to file the Singapore patent application within 12 months and that the failure to do so was unintentional.

As for the requirement of “... due care...”, if one applies the ordinary meaning, this suggests failure occurring despite having exercised due diligence (e.g. having a tracking and alert system in place) – that is to say, diligence expected of applicants to ensure filing the application in suit within the 12 month period mentioned in section 17(2A)(a).

Due care: e.g. detailed explanation of the kind of system put in place by the applicants/ agents to monitor relevant timelines relating to their patent applications with proper reminder mechanism and that the failure to do so occurred in spite of due care required by the circumstances having been taken by the applicants. This should preferably be supported by print-outs (from the system).

Q9: Why is the transitional for restoration of priority for SG National Phase entry cases different from that provided for under PCT Rule 49ter.2?

A9: Essentially, this is so as to provide consistent treatment of non PCT (section 17, which has a transitional of Filing Date on or after 1 Apr 2007) cases and PCT national phase entry cases. This also provides a clean slate across the board as the new provisions will only apply to applications with a Filing Date on or after 1 Apr 2007.

IPOS had earlier informed PCT of the incompatibility of PCT Rule 49ter.2 in 2006 with the Singapore patent laws and this notification of incompatibility will continue to apply.

Q10:- I had filed an application in suit and it is more than 12 months but within 14 months from an earlier relevant application that is the subject of priority declared in the application in suit (only 1 earlier relevant application has been declared). I realized subsequently that there were clerical errors (the correction sought will cause a change to the declared priority date) to the priority declaration made earlier. What should I do in addition to applying to restore the right of priority?

A10: A right of priority to an earlier application will be restored when the details of the earlier relevant application have been correctly declared in accordance with rule 9. If for example, there is an error in the date of filing of the earlier relevant application, you will need to, at the same time as the request for restoration, request for a correction to the date of declared priority application under rule 9(3).

Overview – PF57

	Restoration of right of priority	Addition of priority claim	Correction of priority claim	Addition of priority claim and Restoration of right of priority	Correction of priority claim and Restoration of right of priority
Use	<ul style="list-style-type: none"> ▪ When the Singapore patent application is filed beyond the prescribed period of 12 months from the date of filing of the earlier relevant application; and ▪ The applicant still wishes to claim priority on this earlier relevant application 	<ul style="list-style-type: none"> ▪ When the applicant did not make a priority claim (declaration of priority) at the time of filing the Singapore patent application; and ▪ It relates to the earliest priority claim 	<ul style="list-style-type: none"> ▪ When the applicant wants to correct the earliest priority claim 	<ul style="list-style-type: none"> ▪ When the applicant wishes to make a priority claim (declaration of priority) after the date of filing of the Singapore patent application; and ▪ It relates to the earliest priority claim ▪ Due to this addition, the Singapore patent application is now filed more than 12 months from the date of filing of this earlier relevant application 	<ul style="list-style-type: none"> ▪ Used when the applicant wants to correct the earliest priority claim; and ▪ Due to this correction, the Singapore patent application is now filed more than 12 months from the date of filing of this earlier relevant application
Priority Period	<ul style="list-style-type: none"> ▪ The Singapore patent application is filed within 14 months (but more than 12 months) from the declared priority date 	<ul style="list-style-type: none"> ▪ The Singapore patent application is filed within 12 months from the declared priority date 	<ul style="list-style-type: none"> ▪ The Singapore patent application is filed within 12 months from the declared priority date as changed 	<ul style="list-style-type: none"> ▪ The Singapore patent application is filed within 14 months (but more than 12 months) from the declared priority date 	<ul style="list-style-type: none"> ▪ The Singapore patent application is filed within 14 months (but more than 12 months) from the declared priority date as changed
When to file request?	<ul style="list-style-type: none"> ▪ PF57 needs to be filed within 14 months from the declared priority date 	<ul style="list-style-type: none"> ▪ PF57 needs to be filed within 16 months from the declared priority date 	<ul style="list-style-type: none"> ▪ PF57 needs to be filed within 16 months from the declared priority date as changed 	<ul style="list-style-type: none"> ▪ Request for restoration needs to be filed together with the request for an addition of priority claim 	<ul style="list-style-type: none"> ▪ Request for restoration needs to be filed together with the request for a correction of the earliest priority date

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	Restoration of right of priority	Addition of priority claim	Correction of priority claim	Addition of priority claim and Restoration of right of priority	Correction of priority claim and Restoration of right of priority
				<ul style="list-style-type: none"> ▪ PF57 needs to be filed within 14 months from the declared priority date 	<ul style="list-style-type: none"> ▪ PF57 needs to be filed within 14 months from the declared priority date as changed
Publication	For national filings only:- <ul style="list-style-type: none"> ▪ No early publication or ▪ Request for an early publication is withdrawn 	<ul style="list-style-type: none"> ▪ No early publication or ▪ Request for an early publication is withdrawn 	<ul style="list-style-type: none"> ▪ No early publication or ▪ Request for an early publication is withdrawn 	<ul style="list-style-type: none"> ▪ No early publication or ▪ Request for an early publication is withdrawn 	<ul style="list-style-type: none"> ▪ No early publication or ▪ Request for an early publication is withdrawn
Fee Payable	<ul style="list-style-type: none"> ▪ \$250/- 	<ul style="list-style-type: none"> ▪ \$120/- 	<ul style="list-style-type: none"> ▪ \$120/- 	<ul style="list-style-type: none"> ▪ \$370/- (\$120/- + \$250/-) 	<ul style="list-style-type: none"> ▪ \$370/- (\$120/- + \$250/-)
Others	<ul style="list-style-type: none"> ▪ State reason for the failure to file the Singapore patent application within the said 12 month period ▪ Such failure should be unintentional or have occurred in spite of due care required by the circumstances having been taken 	-	-	<ul style="list-style-type: none"> ▪ State reason for the failure to file the Singapore patent application within the said 12 month period ▪ Such failure should be unintentional or have occurred in spite of due care required by the circumstances having been taken 	<ul style="list-style-type: none"> ▪ State reason for the failure to file the Singapore patent application within the said 12 month period ▪ Such failure should be unintentional or have occurred in spite of due care required by the circumstances having been taken

2. DATE OF FILING

Getting Started

2.1 In addition to the Patents Act and Rules, you are advised to have before you the following documents before you proceed to read the rest of this section in this Guide:-

- Statutes (Miscellaneous Amendments) Act 2007
- Patents (Amendment No. 2) Rules 2007
- Patents Form 1 (2004)
- Patents Form 56

(A) Date of filing application

Basic Concepts

Section 26 2.2 The date of filing of a patent application in Singapore shall be the earliest date on which the documents filed at the registry satisfy the following conditions:-

- indication that a patent is sought;
- identification of the applicant for the patent; and
- description of the invention



What's new? – Incorporating Description in the application by Reference to an earlier relevant application

Section 26(1) 2.3 With the new Apr 2007 amendments, instead of filing the description of the invention on the day a patent application is initiated, the applicants would still be able to obtain a date of filing for the Singapore patent application if they:-

- (a) make a reference to an earlier relevant application declared in accordance with section 17(2);
- (b) provide the date of filing of this earlier application and the country it was filed in; and
- (c) make a statement that the description is incorporated in the application by reference to, and is completely contained in, the earlier application, as filed.

2.4 ⚙ Patents Form 1 (2004) has been updated accordingly to help applicants who wish to make use of this new feature. By filling up the relevant portion in this form, the applicant would have complied with the relevant procedural requirements to obtain a date of filing.

2.5 Example

Applicant does not have a description to enclose with the patent application when he initiates it with IPOS but he wishes to get a date of filing as soon as possible. Hence, he decides to proceed under section 26(1)(c)(ii).

The application also contains 2 priority declarations.

Under paragraph (4) of PF1(2004):-

4. DECLARATION OF PRIORITY UNDER SECTION 17(2) (see note 5)

A. Country/country designated

File number Filing Date

This information is provided to meet the requirements under section 26(1)(c)(ii)(B) (Statement under section 26(1)(c)(ii)(C) is to be made in paragraph 9)

B. Country/country designated

File number Filing Date

This information is provided to meet the requirements under section 26(1)(c)(ii) (Statement under section 26(1)(c)(ii)(C) is to be made in paragraph 9)

Indication here tells the registry that the applicant is incorporating the description in the application by reference to the 2nd priority claim. See para 2.3(a).

Indications here inform the registry of the date of filing and country in which the 2nd priority claim is filed. See para 2.3(b).

Under paragraph (9) of PF1(2004):-

9. STATEMENT UNDER SECTION 26(1)(c)(ii)(C) (see note 10)

The description of the invention for which the patent is sought is incorporated in the application by reference to, and contained in, the earlier relevant application, as filed

Check this box. See para 2.3(c)

Under paragraph (10) of PF1(2004):-

(A) The application consists of the following number of sheets

i.	Request	<input type="text" value="4"/>	Sheets
ii.	Description	<input type="text" value="0"/>	Sheets
iii.	Claim(s)	<input type="text" value="2"/>	Sheets

No description has been filed.

Take Note!

- 2.6 **!** This new feature does not replace the need to file drawings, if any. If no drawings are filed on the date of filing of the application in suit, any drawings filed later may be treated as a part missing from the application.
- Sections 26(6);
26(7)
- Rules 26(3);
26(4);
108
- 2.7 If the Singapore patent application has a date of filing under section 26(1) by reason only that the documents filed to initiate the application satisfy the conditions in section 26(1)(a), (b) and (c)(ii), the applicants shall have to:-
- (a) within 3 months from the date of filing (for national filings) or 3 months from the initiation date (for divisional applications);
 - (b) file a written notice confirming that the description is incorporated in the application by reference to the earlier relevant application;
 - (c) file the description of the invention on Patents Form 56; and
 - (d) file a copy of the earlier relevant application and its English translation, if any. Note that only this requirement is extendable.
- 2.8 **✪** Patents Form 56 is designed in such a way to help applicants who wish to make use of this new feature to only file a single form while complying with several procedural requirements at the same time.

2.9 Example

Under paragraph 4 of PF56

4. NOTICE UNDER SECTION 26(7) OR REQUEST UNDER SECTION 26(9) OR 28(9)* (Note: Only one checkbox may be crossed.)

- In accordance with section 26(7)(a), I/we confirm that the description of the invention for which the patent is sought is incorporated in this application by reference to the earlier relevant application referred to in section 26(1)(c)(ii)(C).
- In accordance with section 26(9)(b), I/we request the Registrar for section 26(8)(b) not to apply to this application. I/we hereby make a statement that the missing part filed under section 26(8) with this request is incorporated in this application by reference to, and is completely contained in, the earlier relevant application, as filed.
- In accordance with section 28(9)(b), I/we request the Registrar for section 28(8) not to apply to this application. I/we hereby make a statement that the missing part filed under section 28(8) with this request is incorporated in this application by reference to, and is completely contained in, the earlier relevant application, as filed.

Check this box. See para 2.7(b)

Under paragraph 5 of PF56

5. INFORMATION ON THE EARLIER RELEVANT APPLICATION REFERRED TO IN SECTION 26(1)(c)(ii), 26(9) OR 28(9)* (see note 4)

Country/country designated

DD MM YYYY

File number

08/123,457

Filing Date

Indicate the file number if this was not previously given. See example under para 2.5

Under paragraph 6 of PF56

6. DOCUMENTS ENCLOSED*

- Description of the invention referred to in section 26(7)(b).
- Missing part of the application referred to in section 26(8).
- The drawing or part of the description of the invention referred to in section 28(8).
- A copy of the earlier relevant application.
- A copy of the English translation of the earlier relevant application or part of that earlier relevant application in which the missing part of the application for a patent is referred to, if the missing part of that earlier relevant application in which the missing part of the application for a patent is referred to is not in English.

Ensure that a copy of the description is enclosed with this form. See para 2.7(c).

Take Note!

Section 26(12) 2.10

! Care must be taken to ensure that all the requirements are complied with within the specified time period as failure to do so would result in the Singapore patent application treated as

having been abandoned.

2.11 Example

Step 1

The applicant relies on the new feature of incorporation by reference to obtain a date of filing:-

- Date of filing = 4 Apr 2007

Step 2

Applicant files PF56 with description on 4 Jul 2007. However, no extension of time is sought thereafter for late filing of the earlier relevant application required under rules 26(3) and 26(4)

Step 3

For this case, the application shall be treated as abandoned since the applicant fails to file a copy of the earlier relevant application within the prescribed period.

2.12 Transitional & Savings Provisions

The amendments will apply to an application for a patent that is initiated on or after 1st April 2007, and section 26 of the Patents Act and rule 26 of the Patents Rules in force immediately before that date shall continue to apply to an application for a patent that qualifies for a date of filing before that date.

(B) Missing Parts

Basic Concepts

- Sections 2(1); 26
- 2.13 Any drawing or part of the description of the invention that is filed after the date of filing of the Singapore patent application would result in the date of filing being changed to the date when the drawing or part of the description is filed at the registry.
- “Missing part” in relation to an application for a patent means:-
- (a) any drawing; or
 - (b) any part of the description of the invention for which the patent is sought, which was missing from the application at the date of filing of the application.

② What’s new? – Incorporating missing parts in the application by reference to an earlier relevant application

- 2.14 Applicants who discover after filing the patent application with IPOS, that a drawing or part of the description is missing, can now proceed to file that missing part and still retain the original date of filing accorded to the patent application, if they comply with the necessary requirements.
- Sections 26(8); 26(9)
Rule 26A
- 2.15 What are these necessary requirements?
- (a) The Singapore patent application must contain a priority claim. Such a declaration of priority must have been made on or before the date of filing of the Singapore patent application.
 - (b) The following must be complied with within 3 months from the date of filing of the Singapore patent application (within 3 months from the initiation date for divisional application):-
 - I. The missing part is filed on Patents Form 56.
 - II. A request to the Registrar for section 26(8)(b) not to


apply to the application.

III. A statement is made that the missing part referred to in section 26(8) is incorporated in the application by reference to, and is completely contained in, the earlier relevant application, as filed.

IV. Furnish the information prescribed under section 26(9)(b)(iii).

V. File the required documents under rule 26A(7).

Rule 108 2.16 Only items (b)(IV) (when it relates to the file number of the earlier relevant application) and (V) under paragraph 2.15 above are extendable.

2.17  Patents Form 56 is to be used for applicants who wish to make use of this new feature. By filling up the relevant portion in this form, the applicant would have complied with several of the relevant procedural requirements to retain their date of filing. Refer to the example below.

2.18 Example

Under paragraph 4 of PF56

4. NOTICE UNDER SECTION 26(7) OR REQUEST UNDER SECTION 26(9) OR 28(9)* (Note: Only one checkbox may be crossed.)

- In accordance with section 26(7)(a), I/we confirm that the description of the invention for which the patent is sought is incorporated in this application by reference to the earlier relevant application referred to in section 26(1)(c)(ii)(C).
- In accordance with section 26(9)(b), I/we request the Registrar for section 26(8)(b) not to apply to this application. I/we hereby make a statement that the missing part filed under section 26(8) with this request is incorporated in this application by reference to, and is completely contained in, the earlier relevant application, as filed.
- In accordance with section 28(9)(b), I/we request the Registrar for section 28(8)(b) not to apply to this application. I/we hereby make a statement that the missing part of the description of the invention filed under section 28(8) with this request is incorporated in this application by reference to, and is completely contained in, the earlier relevant application, as filed.

Check this box. See para 2.15(b)

Under paragraph 5 of PF56

5. INFORMATION ON THE EARLIER RELEVANT APPLICATION REFERRED TO IN SECTION 26(1)(c)(ii), 26(9) OR 28(9)* (see note 4)

Country/country designated

DD MM YYYY

File number Filing Date

Indicate the priority claim which you are relying on. Take note that this priority claim must have been already declared in your application.

Under paragraph 6 of PF56

6. DOCUMENTS ENCLOSED*

- Description of the invention referred to in section 26(7)(b).
- Missing part of the application referred to in section 26(8).
- The drawing or part of the description of the invention referred to in section 28(8).
- A copy of the earlier relevant application.
- A copy of the English translation of the earlier relevant application of every part of that earlier relevant application in which the missing part of the application for a patent / the description of the invention that is missing from the application for a patent is contained.

Ensure that a copy of the missing part is enclosed with this form. See para 2.15(b).

Rule 26A(7) 2.19 If the earlier relevant application is not in English, an English translation of that document is required to be filed with the registry. Applicants would only need to provide the English translation of every part of that earlier relevant application in which the missing part of the Singapore patent application is contained.

Section 26(8) 2.20 If the applicants fail to comply with all the relevant requirements given under paragraph 2.15 and they do not withdraw the missing parts before the end of the prescribed period, the missing parts shall be treated as included in the application and the date of filing will be altered to be the date on which that missing parts are filed at the registry.

Rule 26A(1)(b) 2.21 For applicants who wish to file the missing part and yet do not wish to rely on the new feature to incorporate the missing part in the application by reference, they should lodge this missing part under the cover of Patents Form 99.

Patents Form 56 is relevant only when, the applicants wish to retain the date of filing.

2.22 Transitional & Savings Provisions

These features apply to an application for a patent that is initiated on or after 1st April 2007, and section 26 of the Patents Act and rule 26 of the Patents Rules in force immediately before that date shall continue to apply to an application for a patent that qualifies for a date of filing before that date.

(C) Non-English description

Basic Concepts

Section 26 2.23 It is possible to obtain a date of filing for the Singapore patent application when the documents filed at the registry to initiate an application for a patent include something which is or appears to be a description and is in a language other than English.

3 What's new? – Requirements relating to Non-English Description

Rules 19(10); 19(11); 108 2.24 When a copy of the non-English description is filed with the registry, the Registrar shall send a notification to the applicants for an English translation of that document. Applicants are required to file the necessary document within 2 months from the date of said notification. This time period is extendable.

2.25 Patents Form 99 has to be used when applicants file the English translation of the description with the registry.

TAKE NOTE!

Rule
19(12) 2.26

! Applicants should have regard to the requirements under rule 19(11) as the failure to meet them would result in the Registrar refusing the application.

Transitional & Savings Provisions

2.27 These features will apply to an application for a patent that is initiated on or after 1st April 2007, and rule 19 of the Patents Rules in force immediately before that date shall continue to apply to an application for a patent that is initiated before that date.

3. PRELIMINARY EXAMINATION

Getting Started

3.1 You are advised to have before you the following documents before you proceed to read the rest of this section in this Guide:-

- Statutes (Miscellaneous Amendments) Act 2007
- Patents (Amendment No. 2) Rules 2007
- Patents Form 56

Basic Concepts

3.2 Prior to the Apr 2007 amendments, section 28 consists only of details relating to the formalities examination procedure of a patent application in Singapore.

Section
28

With the implementation of the Apr 2007 amendments, section 28 now contains more features. As such, this section has been renamed from “Examination as to form” to “Preliminary examination” and details on what this stage covers are given below.

Section
28(3)

Preliminary examination is the stage where the registry determines:-

Rule
34(1)

- whether the declaration of priority for the purposes of section 17(2) specifies a date of filing for an earlier relevant application which is more than 12 months before the date of filing of the Singapore patent application.
- whether the application complies with all the formal requirements; and
- whether any drawing or part of the description of the invention is missing from the application.

Section
28(1)

- Preliminary examination would commence as soon as:-
- the application has a date of filing;
 - the application has not been withdrawn or treated as abandoned;
 - the filing fee has been paid;
 - one or more claims filed under section 26(12)(a); and
 - where the application makes use of the new feature to incorporate by reference the description in the application, all relevant conditions satisfied.

Section
28(2)

- Unless otherwise provided, any drawing or part of the description of the invention that is filed after the date of filing of the Singapore patent application would result in the date of filing to be changed to the date when the drawing or part of the description is filed at the registry.

1

What's new? – Any Drawing or Part of the Description that is Missing from the application

3.3 As explained earlier under section 2 of this Guide, applicants can on their own volition, file a “missing part” of the application on a later date and yet retain the original date of filing, provided that certain requirements are met.

(Refer to paragraphs 2.13 – 2.22 for details)

3.4 Unlike section 2 of this Guide which covers the case whereby the applicants initiate the filing of a “missing part” with the registry, applicants who are not aware that there is a drawing or part of the description missing from their application but are informed by the registry during preliminary examination, would still be able to retain the original date of filing when they file the drawing or part of the description on a later date, provided that certain requirements are met.

TAKE NOTE!

3.5 Difference between the term “Missing Part” and “Any drawing or part of the description that is missing from the application”.

! The term “missing part” is used in Section 26 when applicants file on their own initiative, a drawing or part of the description that is originally missing from the application without any notification from the Registrar that something in the patent specification is missing.

! The term “any drawing or part of the description that is missing from the application” is used in Section 28 when the Registrar notifies the applicants that something in the patent specification is missing, and the applicant is given an opportunity to make right his documents.

In both instances, the date of filing accorded earlier could be re-dated to a later date if the requirements are not met.

Rules
34(2);
34(5)

3.6 In the event when the Registrar determines that the drawing or part of the description of the invention is missing from the application, he shall inform the applicant accordingly.

Applicants would have to comply with the relevant requirements within 3 months from the date of the Registrar’s notification if they wish to include the drawing or part of the description in the application and yet retain the original date of filing.

Rules
34(6);
34(7);
34(8)


3.7 The following requirements have to be complied with within the prescribed time period:-

- a) The missing drawing or part of the description is filed on Patents Form 56.
- b) A request to the Registrar for section 28(8)(b) not to apply to the application.
- c) A statement is made that the missing drawing or part of the description referred to in section 28(8) is incorporated in the application by reference to, and is completely

contained in, the earlier relevant application, as filed.

d) Furnish the information prescribed under section 28(9)(b)(iii).

e) File the required documents under rule 34(8).

3.8  Patents Form 56 is to be used for applicants who wish to make use of this new feature. By filling up the relevant portion in this form, the applicant would have complied with several of the relevant procedural requirements to retain their date of filing. Refer to the example below.

3.9 Example

Under paragraph 4 of PF56

4. NOTICE UNDER SECTION 26(7) OR REQUEST UNDER SECTION 26(9) OR 28(9)*

(Note: Only one checkbox may be crossed.)

- In accordance with section 26(7)(a), I/we request the Registrar for section 26(8)(b) not to apply to this application. I/we hereby make a statement that the drawing or part of the description of the invention filed under section 26(8) with this request is incorporated in this application by reference to, and is completely contained in, the earlier relevant application, as filed.
- In accordance with section 26(9)(b), I/we request the Registrar for section 26(8)(b) not to apply to this application. I/we hereby make a statement that the drawing or part of the description of the invention filed under section 26(8) with this request is incorporated in this application by reference to, and is completely contained in, the earlier relevant application, as filed.
- In accordance with section 28(9)(b), I/we request the Registrar for section 28(8)(b) not to apply to this application. I/we hereby make a statement that the drawing or part of the description of the invention filed under section 28(8) with this request is incorporated in this application by reference to, and is completely contained in, the earlier relevant application, as filed.

Check this box. See para 3.7

Under paragraph 5 of PF56

5. INFORMATION ON THE EARLIER RELEVANT APPLICATION REFERRED TO IN SECTION 26(1)(c)(ii), 26(9) OR 28(9)* (see note 4)

Country/country designated

DD MM YYYY

File number Filing Date

Indicate the priority claim which you are relying on. Take note that this priority claim must have been already declared in your application.

Under paragraph 6 of PF56

6. DOCUMENTS ENCLOSED*

<input type="checkbox"/>	Description of the invention referred to in section 26(7)(b).
<input type="checkbox"/>	Missing part of the application referred to in section 26(8).
<input checked="" type="checkbox"/>	The drawing or part of the description of the invention referred to in section 26(7)(a).
<input checked="" type="checkbox"/>	A copy of the earlier relevant application.
<input type="checkbox"/>	A copy of the English translation of the earlier relevant application, or of every part of that earlier relevant application in which the missing part of the application for a patent / the drawing or part of the description of the invention that is missing from the application for a patent is contained.

Ensure that a copy of the missing drawing or part of the description is enclosed with this form. See para 3.7

Rule 34(8) 3.10

If the earlier relevant application is not in English, an English translation of that document is required to be filed with the registry. Applicants would only need to provide the English translation of every part of that earlier relevant application in which the drawing or part of the description of the invention that is missing from the Singapore patent application is contained.

Section 28(8) 3.11

If the applicants fail to comply with all the relevant requirements given under paragraph 3.7 and they do not withdraw the missing drawing or part of the description before the end of the prescribed period, that drawing or part of the description shall be treated as included in the application and the date of filing shall be the date on which that document is filed at the registry.

3.12 Transitional & Savings Provisions

These features apply to an application for a patent that is initiated on or after 1st April 2007, and section 26 of the Patents Act and rule 34 of the Patents Rules in force immediately before that date shall continue to apply to an application for a patent that qualifies for a date of filing before that date.

Frequently Asked Questions - Sections 2 and 3

Q1: How do you define ‘completely contained’?

A1: “Completely contained” like the terms “unintentional” or “in spite due care” are terms used in the new PCT provisions as well. Guidelines for PCT receiving Offices are expected to be made available by the International Bureau of the PCT.

In any event, as a national office, we see the term “completely contained” as being identical to the description/part of the description/drawing(s) in the earlier relevant application as filed. Concept-wise, this should be the case. For example, an applicant who is not furnishing a description but wants a date of filing to be accorded, he has to state that the description is incorporated in the application by reference to the earlier relevant application.

This position was also taken by one patent user group to our Jul 2006 consultation.

If there are minor differences, applicants can always submit their case before the Registry as to how it meets the criteria of ‘completely contained’.

Q2: If I have a missing drawing and a missing part of the description, can I make a single request for the date of filing not to change, i.e. file one PF 56 for both? Or I need to file one PF 56 for each part?

A2: One PF 56 will cover both, as long as both the missing drawing and part of description are filed together.

Q3: Why include a new provision that expressly requires an English translation of a non English description filed to initiate an application [rule 19(10) to (12)]? Moreover, the provision that allows the Registrar to refuse the application if no English translation is filed with the prescribed period

seems harsh.

A3: Under the pre-1 Apr 2007 rule 112(2), there is no time period to file an English translation of the description nor is there a clear consequence of not filing the translation. The status of the application is in limbo. By introducing a time period (which is extendable) and the consequence of a failure to file a translation, there is now an element of certainty. UK has a similar feature.

Q4: With regards to a verification document of an English translation, what does it mean by “made in accordance with the Registrar’s requirements”?

A4: The verification document should contain the name of translator, a statement that he/she is well versed in English and the relevant foreign language, and a reference to the document being translated.

Rule
34(2)

Q5: Can I file a drawing that is originally missing from the application without relying on the new feature to incorporate the missing drawing into the application by reference?

A5: For applicants who wish to file a drawing or part of the description that is missing from the application and yet do not wish to rely on the new feature on incorporation by reference, they can lodge said drawing or part of the description under the cover of Patents Form 99. The date of filing of the application would be altered to the date when the registry receives said documents.

Overview to Sections 2 and 3 of this Guide

	Missing Description	Missing Parts (Where the Original Date of Filing is retained)	Drawings or parts of the specification missing (Where the Original Date of Filing is retained)
Section 17(2) Priority Declaration	Section 26(1)(c)(ii)	Section 26(9)(a)	Section 28(9)(a)
Statement of Incorporation	Section 26(1)(c)(ii)	Section 26(9)(b)(ii)	Section 28(9)(b)(ii)
Confirmation of Incorporation	Section 26(7)(a)	-	-
Request for the later Date of Filing not to apply	-	Section 26(9)(b)(i)	Section 28(9)(b)(i)
Filing the missing description etc. ▪ Patents Form 56	Section 26(7)(b) Rule 26(4)(c)	Section 26(9)(b)(iv) Rule 26A(2)	Section 28(9)(b)(iv) Rules 34(3)
Furnishing further Information/Documents ▪ Priority application a. Date of Filing b. Country of filing c. Filing Number d. Copy of priority application Translation where necessary	Section 26(1)(c)(ii)(B) Section 26(7)(c) Rules 26(1), 26(4) NB: Filing Number of Priority application is not required.	Section 26(9)(b)(iii) Rules 26A(6), 26A(7)	Section 28(9)(b)(iii) Rules 34(7), 34(8)

4. OTHER AMENDMENTS

Getting Started

4.1 You are advised to have before you the following documents before you proceed to read the rest of this section in this Guide:-

- Statutes (Miscellaneous Amendments) Act 2007
- Patents (Amendment No. 2) Rules 2007

(A) PCT National Phase Entry

Basic Concepts

Section 86(3) 4.2 To make a successful Patent Cooperation Treaty (PCT) national phase entry into Singapore, applicants have to ensure that they comply with the following requirements:-

- Request to make a national phase entry within the prescribed time period
- Payment of a prescribed fee
- Provide a copy of the relevant translation, if any.



What's new?

Section 86(3) 4.3 Early national phase entry requirements

Prior to the Apr 2007 amendments, for early national phase entry requested expressly by the applicant, he will also be required to:

- file at the Registry a copy of the application, if none has yet been sent to the Registry in accordance with the Patent Co-operation Treaty; and any necessary translation

of the application into English

With the 2007 amendments in place, applicants are no longer required to furnish a copy of the application (regardless of whether the application is in English or not) when they expressly request to make an early national phase entry as long as the application has been published in English according to the PCT .

4.4 Prior to the 1st Apr 07 amendments, where during the international phase the application is amended in accordance with the PCT, the amendment shall be treated as made under this Act if —

- when the prescribed period expires, any necessary translation of the amendment into English has been filed at the Registry; or
- where the applicant expressly requests the Registrar to proceed earlier with the national phase of the application, there is then filed at the Registry —
 - (i) a copy of the amendment, if none has yet been sent to the Registry in accordance with the Treaty; and
 - (ii) any necessary translation of the amendment into English,

otherwise the amendment shall be disregarded.

Section 4.5
86(6)

With the April 2007 amendments in place, applicants who expressly request the Registrar to proceed earlier with the national phase of the application would not be required to file a copy of such amendments, if these amendments have been communicated to the registry in accordance with the Patent Co-operation Treaty.

Applicants would only need to furnish an English translation of the amendments if said translation has not been communicated to the registry.

Transitional & Savings Provisions

- 4.6 This amendment is applicable to an international application for a patent (Singapore) that enters the national phase of the application in Singapore on or after 1 April 2007, and sections 86(3) and 86(6) of the Patents Act in force immediately before that date shall continue to apply to an international application for a patent (Singapore) that enters the national phase of the application in Singapore before that date.

(B) Amendment of rules 46, 47, 48, 52, 52A and 91**Basic Concepts**

- 4.7 Any request for amendment or correction of a document shall be accompanied by a copy of that document with the proposed amendment or correction indicated therein in the following manner:
- (a) by striking through any text, figure or other matter to be replaced or deleted; and
 - (b) by underlining any replacement text, figure or other matter.

② What's new?

- 4.8 Prior to 1st Apr 2007, the application for amendment of a document had to be accompanied by a copy of that document with the proposed amendment indicated therein in the following manner:
- (a) by striking through any text, figure or other matter to be replaced or deleted; and
 - (b) by underlining any replacement text, figure or other matter.

- 4.9 In addition, prior to the Apr 2007 amendments, the words “replacement sheet”, followed by the date of signing of the Patents Form 13, had to be stated at the top right-hand margin of each sheet of the copy of the document referred to.
- Rule 48 4.10 With the 2007 amendments in place, applicants are no longer required to indicate the words ‘replacement sheet’ and date of signing Patents Form 13. This will streamline the process.
- Rules 46; 4.11 The same change is also applicable to proposed amendments/ corrections filed under Patents Forms 13A, 17 and 23.
52; 52A; 91
- Rule 47 4.12 As for the specification that is filed to comply with rule 47, it is no longer a requirement to indicate on the top right hand margin of the document the date of signing Patents Form 14/ Patents Form 14 (2004).
- 4.13 Transitional & Savings Provisions
- These changes would be applicable to Patents Forms 13, 13A, 14/ 14 (2004), 17 and 23 that are filed on or after 1 April 2007.

(C) Request for examination report

Basic Concepts

- Rule 42 4.14 A request for examination report under section 29(2)(e)(i) has to be filed together with the prescribed documents within the prescribed time period. Failure to do so within the required time period would result in the request to be treated as having been abandoned.

(Refer to rule 42 for details)

③ What's new?

4.15 Prior to the 1 Apr 2007 amendments, a request for an examination report under section 29(2)(e)(i), made on Patents Form 12/ Patents Form 12 (2004) had to be accompanied, inter alia, by “the original or a copy of the international preliminary report on patentability in respect of that application, if available”.

Rule 42 4.16 With the 2007 amendments in place, the need to file the International Preliminary Report on Patentability (IPRP), if available, has been removed. This will streamline the process.

4.17 Transitional & Savings Provisions

This amendment would be applicable to Patents Form 12/ Patents Form 12 (2004) that is filed on or after 1 April 2007.

(D) Alteration or Correction of Name, Address or Address for Service

Basic Concepts

Rules 56(1); 56(2) 4.18 A request to alter the name of the applicant or agent on record has to be made on Patents Form 23.

4

What's new?

4.19

Prior to the Apr 2007 amendments	Name	Address	Address for Service
Alteration	Rule 56(1)	Rule 56(3)	Rule 56(3)
Correction	-	Rule 56(3A)	Rule 56(3A)

Prior to the Apr 2007 amendments, whilst the alteration of a name was specifically provided for in rule 56, the correction of a name was not. Further, the fee schedule required the payment of a fee for each patent or application for each alteration of name or each correction of address.

Rule 56; 1st Schedule 4.20

Apr 2007 amendments	Name	Address	Address for Service
Alteration	Rule 56(1)	Rule 56(3)	Rule 56(3)
Correction	Rule 56(3)	Rule 56(3)	Rule 56(3)

With the Apr 2007 amendments in place, a request to alter or correct the name or address e.g. of the applicant, inventor or agent on the registry's record, can now be done by filing a single Patents Form 23 and paying a single set of prescribed fees in respect of one or more patents or applications for patents.

4.21 Note that if the correction of the name or address of the applicant, inventor or agent is on a particular patents form (wherein said name or address is correctly reflected on the registry's record), then the request for correction should be made for that patents form. See example below.

4.22 Example

Step 1

- Applicant indicated his name incorrectly on Patents Form 10. However, his name is correctly reflected on record for his application.

Step 2

- Applicant makes a request to correct his name on Patents Form 10. As this error is made on a particular form, he would indicate his request as shown:-

(D) Correction of errors in patents and applications

(Note: Only one checkbox may be crossed.)

I/We request for the correction of an error of translation or transcription or of a clerical error or mistake

<input checked="" type="checkbox"/>	in the following Patents Form filed at the Registry:	DD MM YYYY
Patents Form	<input type="text" value="10"/>	Submission Date <input type="text" value="06062006"/>
<input type="checkbox"/>	in the specification of a patent or of an application for a patent	
<input type="checkbox"/>	in any other document filed in connection with the patent or such an application	

Rule 56;
1st
Schedule

4.23 As for the request to alter or correct the address for service with the registry, it is still a requirement to pay for each of such alteration or correction in respect of each patent or patent application. No changes have been made in this regard.

4.24 Transitional & Savings Provisions

This amendment would be applicable to Patents Form 23 that is filed on or after 1 April 2007.

(E) Translations

Basic Concepts

- 4.25 Unless otherwise provided in the Patents Act or Rules, any document that is in a language other than English, would have to be lodged together with its English translation.

5 What's new?

Rule 112(4) 4.26 Where the Registrar is of the opinion that an English translation is inaccurate, the applicants would have to file another English translation of the document within 2 months from the date of Registrar's notification.

Rule 112(5) 4.27 When the Registrar requires, the applicants would have to file the original verification document of the English translation within 2 months from the date of Registrar's notification.

Rule 112(7) 4.28 In general, the provisions under rule 112 would not apply to any document or part of a document translated into English under the Patent Co-operation Treaty.

4.29 Transitional & Savings Provisions

Rule 112 would apply to any document that is first filed in or furnished to the Registry on or after 1st April 2007.

Patents Quality Management Unit (PQMU) Intellectual Property Office of Singapore

51 Bras Basah Road #04-01

Manulife Centre Singapore 189554

Tel: (65) 63398616 Fax (General): (65) 63390252

Fax (Patents): (65) 63399230

<http://www.ipos.gov.sg>

ipos_enquiry@ipos.gov.sg (attention: Patents Quality Management Unit)