

Managing Intellectual Property

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Latest amendments to the Patents Act

In line with changes made to the Patent Cooperation Treaty (PCT) as of April 1 2007, the Singapore Patents Act and Rules have been amended. The amendments make it possible, for patent applications filed on or after April 1 2007 in Singapore, to extend the convention deadline up to two months and correct a missing part of a patent specification, without losing the priority date, subject to filing relevant documents before a specific time period.

The Intellectual Property Office of Singapore has proactively amended the Patents Act and Rules so that they are in concurrence for both local applications filed on or after April 1 2007 and PCT applications having an international filing date on or after April 1 2007.

Extension of convention deadline

It is possible to extend the convention deadline up to two months from the original 12 month deadline (new Section 17(2A) to 17(2D) and new Rule (9)). To seek an extension of the convention deadline, the applicant must file the following within 14 months from the declared priority date:

- a request to the Registrar in a prescribed form, and
- a prescribed fee.

The applicant must indicate in the request whether failure to file the application within 12 months occurred in spite of due care required by the circumstances having been taken or was unintentional.

In order to make the above request, the applicant should not have requested for early publication of the application or the applicant has withdrawn such a request.

The above extension is, however, at the discretion of the Registrar and it is up to the applicant to convince the Registrar before getting an allowance.

The amendments have made it possible to file a convention application within 14 months from the earliest priority date.

Also, it is possible to add or correct a priority claim of an application filed in Singapore to an earlier application within 14 months from the Singapore filing date, provided that a request to add or correct the priority claim is made within 16 months from the earliest priority date.

Rectification of missing part of a specification

As of April 1 2007, any missing part of a specification can be rectified by submitting the relevant missing part of the specification (new Act S26(8)&(9) and new Rule 26(A)) after filing but before payment of grant fee.

Typically, the date of filing the application shall be the actual date on which the missing part of the specification is filed with the Registry. However, under the new law, it is possible to bring back the date of filing the missing part to the earlier filing date of the application if the applicant had declared a priority date on the date of filing, and within three months of filing the application in Singapore, the applicant files:

- a request to the Registrar in a prescribed form indicating that the missing part is incorporated in the application by reference to, and is completely contained in, the earlier application as filed (new Act S26(9) (a)-(b); new Rule 26A(1)(a)),
- prescribed information, and
- prescribed documents.

The "prescribed information" indicated above shall be:

- the date of filing the earlier application;
- the application or file number of the earlier application; and

- the country of filing the earlier application.

The "prescribed documents" indicated above include:

- a certified copy of the earlier application or a copy of the earlier application otherwise acceptable by the Registrar, and
- an English translation of the priority document, where applicable.

As a result of the above changes to the Acts and Rules, as of April 1 2007, it is possible to overcome problems caused by errors ending up in a missed convention deadline or a missing part of a specification.

The above changes benefit not only foreign clients filing a PCT national phase application through the corresponding changes to the PCT regime, but also benefits local clients in alleviating problems associated with filing a PCT international application or a convention application in Singapore claiming priority from an earlier Singapore application.



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