



The Patents (Amendment) Act 2012 was passed by the legislature on 10 July 2012 and is expected to be in force from 14 February 2014 onwards. The amendment to the Act is effected to place Singapore as an Asian Intellectual Property hub to service the growth in the demand for IP services. Among the key changes to the system are:-

1. The shift from a “self-assessment” patent system to a “positive grant” system
2. Liberalisation of Patent Agent Regime
3. Integrated Registries IT System
4. Single Prosecution Track

1. The shift from a “self-assessment” patent system to a “positive grant” system

The positive grant system will replace the current self-assessment patent system under the amended Act. Under the self-assessment system, an applicant could still file an application and be granted patent in Singapore even if the search and examination report relied on indicates that the invention is not patentable. Under the “positive grant” system, only patents which fully satisfy all three of the patentability criteria will eventually proceed to grant. Comparatively, the “positive grant” system sets a higher threshold for obtaining grant and aims to raise the overall quality of patents granted in Singapore. This change will align Singapore’s patent practices with established patent offices like the European Patent Office, Japan and the UK.

Parallel with the introduction of the positive grant system, IPOS will be establishing patent search and examination capabilities to end the practice of outsourcing the work to patent offices in other countries. At the same time, developing world class search and examination capabilities in specific technology classes in line with Singapore’s main research and development trusts is currently one of IPOS’ focal agenda.

Among the key changes in the shift from a “self-assessment” system to a “positive grant” system are:-

s29A - Eligibility for grant of patent

Once a search and examination, examination or supplementary examination report is issued, the Registry will issue either a “Notice of Eligibility to Proceed to Grant” or where the report contains one or more unresolved objections, a “Notice if Intention to Refuse” will be issued. Where a “Notice if Intention to Refuse” is issued, an applicant may apply for a review of the examination report within the prescribed period.

s29B - Review of examination report

Following a “Notice of Intention to Refuse”, an applicant may apply for a review of the examination report within the prescribed period along with written submissions and/or amendments to overcome the objections raised by the examiner in the examination report.

2. Liberalisation of Patent Agent Regime

The second key changes in the Amended Act see the liberalisation of the patent agent regime. Currently, only

- (i) Singapore-registered patent agents with a patent agent practising certificate issued by IPOS, and
- (ii) advocates and solicitors with a legal practising certificate issued by the Singapore Supreme Court,

are allowed to undertake patent agency work in Singapore (whether for filing in Singapore or other jurisdictions). In addition, a firm is only allowed to carry on a business of and undertake patent agency work, if at least one partner or director of the firm is either (i) or (ii).

Under **s 105A** of the amended Act, foreign-qualified patent agents can now register to undertake **offshore patent agency work** in Singapore without having to qualify as Singapore-registered patent agents or advocates and solicitors with a legal practising certificate issued by the Singapore Supreme Court. These foreign-qualified patent agents, however, are not allowed to undertake local patent agency work such as filing of patents or providing advice on the validity or infringement of patents under Singapore patent law.

This change will enable more international patent experts to set up their practice in Singapore. At the same time, this change provides a platform for Singapore to develop stronger international patent agent capabilities with greater access to wide ranging international patent expertise.

3. Integrated Registries IT System

At present, IPOS operates different Registries for different IPs (Patents; Trade Marks; and Designs). The new amendment will include the streamlining and harmonisation of the IT system and processes of the different Registries into an integrated Registries IT system. It is anticipated that this amendment will provide greater consistencies and efficiencies between different Registries and convenience for customers to transact and access information related to the different types of IP via a single IPOS IP portal.

4. Single Prosecution Track

The dual track system which is currently in place will also be abolished with the coming into effect of the amended Act. In its place, a single prosecution track is introduced. Under the dual track system, an applicant has the option of prosecuting the patent application on the default “fast track” or to convert the prosecution process to a “slow track” by filing a block extension by the 39th month from the filing date or priority date (as the case may be), extending the deadline from 42 months to 60 months. Under the new single prosecution track, examination report should be issued approximately 54 months from the filing date or priority date (as the case may be).

With the new system, patents owners in Singapore can be assured of the recognition on their patents in other parts of the world. At the same time, those who are concerned about patents infringement in Singapore can rely on the new system as the regime will ensure that fewer invalid patents are granted.

This article is intended to highlight the changes in the Singapore Patents Act passed recently in Singapore, and is not intended to be comprehensive nor should it be construed as legal advice.

Please note that should you need to discuss how the PDPA will affect your patent application, our following Directors at Gateway Law Corporation would be glad to assist you.

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