



AMICA LAW LLC

Dear Clients, Associates and Friends

## **UPDATE ALERT: NEW PATENT AMENDMENTS COMING INTO EFFECT ON 14 FEBRUARY 2014**

We wish to update you of an important change to our patents system in Singapore which will come into effect on **14 FEBRUARY 2014**. Since the introduction of the new patents law in 2005 in Singapore, these new amendments represent the next significant change, and are aligned with Singapore's goal of becoming an IP Hub in this region.

In our previous alert, we advised that Singapore is set to change from a "self-assessment" patent system to a positive grant system, where a patent must satisfy the requirements of patentability before it can be granted. Further details of the changes are now at hand as the draft Patent Rules have been circulated for our information. The Rules are not finalised and may be subject to further changes.

This update focusses on the changes to patent prosecution procedure, which will apply to patent applications, divisional patent applications and PCT international applications for a patent (Singapore) entering national phase on or after 14 February 2014.

### **Prosecution Options under the New System**

You may already be aware that it is possible to prosecute a Singapore patent application either using local foreign or mixed routes, namely:

- (a) File request for search and/or examination with the Intellectual Property Office of Singapore (IPOS);
- (b) Rely on final search and examination results or grant of corresponding applications, corresponding PCT applications;
- (c) Rely on International Preliminary Report on Patentability (IPRP) (in the case of Singapore national phase applications)
- (d) File search reports from corresponding applications or corresponding PCT application and request local examination.

These routes still remain, but the amendments have introduced some modifications and new features to prosecution, set out below.

### **Positive examination report**

All local, mixed and foreign route prosecution options will require a positive examination report to be issued. If all is clear, then the Registrar will issue a notice of eligibility to proceed with the grant of the patent ("**Grant Notice**"). Applicants will be given 2 months to comply with all formal requirements and file the prescribed documents for grant. At this time, no further amendments will be permitted.

In the event that unresolved objections remain, then the Registrar will issue a Notice of Intention to Refuse to the Applicant. The Applicant may then apply for a review of the examination report within 2 months of the date of the Notice.

If no request for review is filed, then the application for the patent will be refused, and a Notice of Refusal issued ("**Refusal Notice**").

### **The review procedure**

At the review stage, Applicants may file written submissions to overcome the objections and at the same time, amend the specification if they wish. The official fee for the review request is S\$1350. Amendments cannot be filed after a request for review is made, and therefore it is important to fully

consider the case that you wish to put forward when submitting the request for review. It is possible to apply for an extension of time as of right, of up to 6 months to file the request for review.

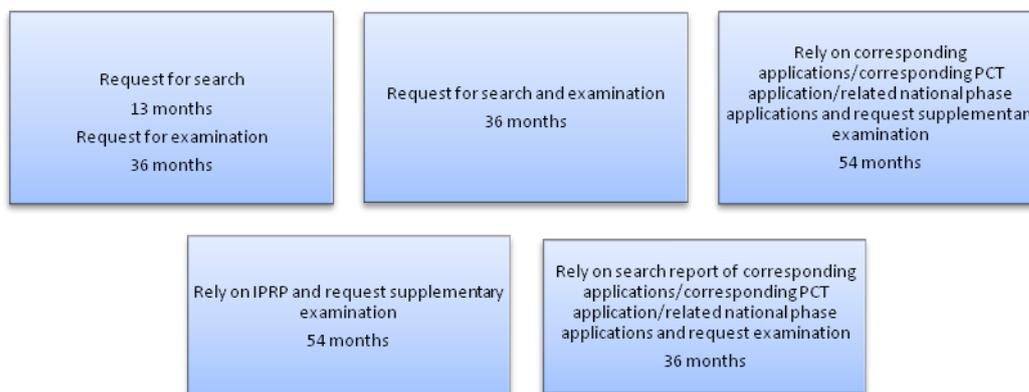
The Examiner will then review the examination report together with the amendments, if any, and then issue an examination review report (“**Review Report**”) setting out the Examiner’s decision and reasons for the same. The Review Report will then be sent to the Applicant, together with either a Grant Notice or a Refusal Notice. In the event of a positive result, the Applicant will have 2 months to comply with the Grant Notice.

### **Foreign Route: Related national phase applications**

One anomaly in our current patent system is though Applicants can rely on final results or grant from approved countries, there must be a priority link with the Singapore application. The amendments now recognise as corresponding applications, “related national phase applications”, which derive from the same PCT application as the Singapore national phase application, but do not have any priority claim. This would seem sensible given that the final results or patent grant are relevant to Singapore prosecution.

### **One Prosecution Track: New Timelines**

With the new amendments, the timelines for prosecution have been simplified. There is only one prosecution track, and no longer a choice of fast track and slow track. The diagram below shows the different routes and deadlines.



### **What if objections are raised in a Written Opinion?**

If objections are raised in a Written Opinion, 5 months will be given to respond to a written opinion issued for a local examination or search and examination report. If the written opinion is issued for a supplementary examination report, then 3 months will be given to respond. If no response is filed, then the written opinion will become the final examination report.

All in all, the examination report must be issued within 18 months from the date of the Registrar’s invitation to file a response to a first written opinion, or a considerably shorter 6 months after the invitation in the case of a supplementary examination report.

### **Request for supplementary examination report**

Currently, there is no examination when Applicants rely on final results of search and/or examination or grant from approved foreign countries. Under the new system, Applicants need to request supplementary examination in addition to submitting the final results or grant as mentioned above. This is to ensure that the invention is patentable under Singapore law. The deadline to file the request is 54 months from the earliest declared priority date or, where there is no priority date, the date of filing the application.

### **Table of related claims**

There is also a new requirement to submit, at the time of requesting supplementary examination, a table setting out how each claim in the application in suit is related to at least one claim in the corresponding application, corresponding international application or related national phase application, or IPRP as the case may be, being a claim which has been examined to determine whether the claim appears to satisfy the criteria of novelty, inventive step (or non-obviousness) and industrial applicability (or utility);

### **Post grant search and examination**

With the introduction of positive grant, the provisions relating to post grant search and examination (similar to “re-examination”) will be removed. This will not affect any requests for post grant search and examination made before 14 February 2014.

### **Surrender of patents**

The amendments no longer require that the surrender of patents be advertised, and consequently the opposition procedure has now been abolished.

### **NEXT STEPS**

We recommend that you give careful consideration to whether you may want to file new patent applications before the changes come into effect. Depending on your case, there may be advantages to file now or to wait until the amendments come into effect. If you require any advice, please do not hesitate to contact us.

We hope that you find this note useful. If you have any queries, please do not hesitate to contact us.

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