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Intellectual Property (Amendment) Bill

Bill No. 39/2021.

Read the first time on 1 November 2021.

A BILL

i n t i t u l e d

An Act to amend the Geographical Indications Act 2014, the Patents Act, the Plant Varieties Protection Act, the Registered Designs Act and the Trade Marks Act to facilitate certain changes to the processes for registration of intellectual property rights, standardise certain provisions across these Acts and make certain other amendments to these Acts, as well as to amend the Intellectual Property Office of Singapore Act for fines and composition sums to be paid into the Consolidated Fund.

Be it enacted by the President with the advice and consent of the Parliament of Singapore, as follows:

Short title and commencement

1. This Act is the Intellectual Property (Amendment) Act 2022 and comes into operation on a date that the Minister appoints by notification in the *Gazette*.

PART 1

AMENDMENT OF GEOGRAPHICAL INDICATIONS ACT 2014

Amendment of section 22

2. Section 22 of the Geographical Indications Act 2014 is amended —

(a) by inserting, immediately after subsection (3), the following subsection:

“(3A) An application to the Registrar for rectification is subject to the rules mentioned in section 84(2)(ea).”; and

(b) by deleting the words “or correction” in the section heading.

Amendment of section 47

3. Section 47 of the Geographical Indications Act 2014 is amended —

(a) by deleting the word “correcting” in subsection (2) and substituting the word “amending”;

(b) by deleting the word “address” in subsection (2)(a) and substituting the words “other particular”;

(c) by deleting the word “correction” in subsection (2) and substituting the word “amendment”; and

(d) by deleting subsection (3) and substituting the following subsection:

“(3) Subsection (2) is subject to the rules mentioned in section 84(2)(ea).”.

Amendment of section 51

4. Section 51 of the Geographical Indications Act 2014 is amended —

(a) by deleting the words “not later than 6 months after the date of expiry of the registration” in subsection (3) and substituting the words “not earlier than the prescribed period before the date of expiry of the registration and not later than another prescribed period after that date”; and

(b) by inserting, immediately after subsection (3), the following subsection:

“(3A) Where the application for renewal is made within the second-mentioned prescribed period in subsection (3) after the date of expiry of the registration, the fees payable are the prescribed renewal fee and the prescribed post-expiration renewal fee.”.

Amendment of section 54

5. The Geographical Indications Act 2014 is amended by renumbering section 54 as subsection (1) of that section, and by inserting immediately thereafter the following subsection:

“(2) Subsection (1) is subject to the rules mentioned in section 84(2)(ea).”.

Amendment of section 84

6. Section 84(2) of the Geographical Indications Act 2014 is amended by inserting, immediately after paragraph (e), the following paragraph:

“(ea) to enable the Registrar to publish —

(i) an application to rectify an error or omission in the register; and

(ii) a request to amend an application, a notice or other document,

and to provide for the making of objections to the rectification or amendment by a person claiming to be affected by it;”.

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PART 2

AMENDMENT OF PATENTS ACT

Amendment of section 25

7. Section 25(1) of the Patents Act is amended by deleting the words “prescribed manner” in paragraph (a) and substituting the words “manner prescribed in the rules made under section 115 and specified in the practice directions issued by the Registrar”.

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Amendment of section 26

8. Section 26 of the Patents Act is amended —

(a) by inserting, immediately after subsection (7), the following subsection:

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“(7A) Subsection (7)(c) does not apply in prescribed circumstances.”; and

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(b) by inserting, immediately before the words “files such other documents” in subsection (9)(b)(iv), the words “except in prescribed circumstances,”.

Amendment of section 28

9. Section 28 of the Patents Act is amended —

(a) by inserting, immediately after the words “section 26(7)(a), (b) and (c)” in subsection (1)(e), the words “(where applicable)”;

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(b) by inserting, immediately before the words “files such other documents” in subsection (9)(b)(iv), the words “except in prescribed circumstances,”.

Amendment of section 29

10. Section 29 of the Patents Act is amended —

(a) by inserting, immediately before the word “file” in subsection (1)(a), the words “except in prescribed circumstances,”;

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(b) by deleting the words “file the prescribed documents and a request in the prescribed form for an examination report,” in subsection (1)(c) and substituting the words “file a request in the prescribed form for an examination report and (except in prescribed circumstances) the prescribed documents,”;

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(c) by inserting, immediately after subsection (7), the following subsections:

“(7A) The Examiner in subsection (7) may, instead of giving the applicant a written opinion concerning a matter mentioned in that subsection, ask the Registrar to give a notice to the applicant inviting the applicant to amend the application (called in this section an invitation to amend), if the Examiner is of the opinion that the matter can be resolved by this means and without a written opinion and a formal response to it.

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(7B) The Examiner may also ask the Registrar to give to the applicant an invitation to amend after reviewing a response by the applicant under subsection (9)(a) or an amendment by the applicant under subsection (9)(b) to the application.

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(7C) An applicant may, within the prescribed period, respond to an invitation to amend by —

(a) amending, in the prescribed manner (but subject to section 84), the specification of the application in accordance with the prescribed conditions; or

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(b) rejecting the invitation to amend (with or without an explanation) in the prescribed manner.

(7D) The applicant need not respond to the invitation to amend if the applicant withdraws under subsection (10) the request under subsection (1)(c) or (3) for the examination report or the request under subsection (1)(b) for the search and examination report, and may not so respond after the examination report or search and examination report is issued under subsection (4) or (5).

(7E) The giving of an invitation to amend to the applicant does not affect the power of the Examiner under subsection (7) to give to the applicant a written opinion, or another written opinion, but the Examiner may not do so until after the applicant responds to the invitation to amend in accordance with subsection (7C) or after the expiry of the prescribed period mentioned in subsection (7C), whichever is earlier.”;

(d) by inserting, immediately before the words “before the examination report” in subsection (9), the words “after receipt of a copy of a written opinion and”; and

(e) by deleting the word “or” at the end of sub-paragraph (i) of subsection (10)(a), and by inserting immediately thereafter the following sub-paragraph:

“(ia) in any case where the Registrar has given an invitation to amend under subsection (7A) or (7B), and the applicant has not responded to the invitation to amend — at any time before the expiry of the prescribed period mentioned in subsection (7C); or”.

Amendment of section 29B

11. Section 29B of the Patents Act is amended —

- (a) by deleting the word “The” in subsection (4) and substituting the words “Subject to subsection (4A), the”; and
- (b) by inserting, immediately after subsection (4), the following subsection:

“(4A) The examination review report need not specify whether the Examiner agrees or disagrees with the examination report, search and examination report or supplementary examination report (as the case may be) if the applicant had amended the specification of the application for the purpose of overcoming all unresolved objections in the report.”.

Amendment of section 36

12. Section 36 of the Patents Act is amended —

- (a) by deleting the words “during the period of 6 months immediately following the end of the prescribed period” in subsection (3) and substituting the words “, during the prescribed period immediately after the end of the period prescribed for the payment of any renewal fee under subsection (2),”; and
- (b) by inserting, immediately after the words “the prescribed period” in subsection (4), the words “for the payment of any renewal fee under subsection (2)”.

Amendment of section 39

13. Section 39(5) of the Patents Act is amended by deleting the words “the prescribed period, or to pay that fee and any prescribed additional fee within the 6 months immediately following the end of that period,” and substituting the words “the period prescribed under section 36(2), or to pay that fee and any prescribed additional fee within the period prescribed under section 36(3),”.

Amendment of section 69

14. Section 69(3) of the Patents Act is amended by deleting the words “any further period specified” and substituting the words “the period prescribed”.

Amendment of section 86

15. Section 86(7) (or section 86(6) as renumbered in the 2020 Revised Edition) of the Patents Act is amended by deleting the words “on payment of the prescribed fee”.

Amendment of section 102

16. Section 102 of the Patents Act is amended by deleting the word “corporations” in the section heading and substituting the words “bodies corporate”.

Amendment of section 108

17. Section 108 of the Patents Act is amended by inserting, immediately after subsection (1), the following subsection:

“(1A) Without affecting subsection (1), the Registrar may, on his or her own initiative, publish or communicate any information or documents relating to an application for a patent published in accordance with section 27 or relating to any patent granted pursuant to such application, subject to any prescribed restriction.”.

Saving and transitional provisions

18.—(1) Despite section 7, section 25(1) of the Patents Act as in force immediately before the date of commencement of section 7, continues to apply to an application for a patent which has a date of filing (as defined in section 2(1) of the Patents Act) before the date of commencement of section 7.

(2) Section 26 of the Patents Act as amended by section 8(a), also applies to an application for a patent in relation to which the prescribed period mentioned in section 26(7) of the Patents Act has not expired as of the date of commencement of section 8(a), if the

documents mentioned in section 26(7)(c) of the Patents Act have yet to be filed by that date.

(3) Section 26 of the Patents Act as amended by section 8(b), also applies to an application for a patent in relation to which the prescribed period mentioned in section 26(9)(b) of the Patents Act has not expired as of the date of commencement of section 8(b), if the documents mentioned in section 26(9)(b)(iv) of the Patents Act have yet to be filed by that date.

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(4) Section 28(9) of the Patents Act as amended by section 9 also applies to an application for a patent in relation to which the prescribed period mentioned in section 28(9)(b) of the Patents Act has not expired as of the date of commencement of section 9, if the documents mentioned in section 28(9)(b)(iv) of the Patents Act have yet to be filed by that date.

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(5) Despite section 10(b), section 29(1)(c) of the Patents Act as in force immediately before the date of commencement of section 10(b), continues to apply to an application for a patent for which a request for an examination report is filed before that date.

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(6) Despite section 11, section 29B of the Patents Act as in force immediately before the date of commencement of section 11, continues to apply to a request for a review of an examination report issued under section 29(4) of the Patents Act, a search and examination report issued under section 29(5) of the Patents Act, or a supplementary examination report issued under section 29(6) of the Patents Act, that is filed before that date.

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(7) Despite section 15, section 86(7) (or section 86(6) as renumbered in the 2020 Revised Edition) of the Patents Act as in force immediately before the date of commencement of section 15, continues to apply to an application for a patent that is an international application for a patent (Singapore), that has entered the national phase in Singapore before that date under section 86(3) of the Patents Act.

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PART 3
AMENDMENT OF PLANT
VARIETIES PROTECTION ACT

Amendment of section 2

- 5 **19.** Section 2 of the Plant Varieties Protection Act is amended by deleting the definition of “Examiner” and substituting the following definition:

10 ““Examiner” means any person, organisation or entity (including an international plant variety office or organisation, or a plant variety office or an organisation of a country or territory other than Singapore) appointed by the Registrar for the purpose of referring any question or matter relating to the examination of a plant variety for a grant of protection;”.

15 **Amendment of section 14**

- 20.** Section 14(2) of the Plant Varieties Protection Act is amended by deleting the words “3 months of” and substituting the words “the prescribed period after”.

Repeal and re-enactment of section 15

- 20 **21.** Section 15 of the Plant Varieties Protection Act is repealed and the following section substituted therefor:

“Publication

25 **15.** The Registrar must publish applications for grant of protection, and information on other prescribed matters, in the prescribed manner at the time and frequency determined by the Registrar.”.

Amendment of section 17

- 22.** Section 17 of the Plant Varieties Protection Act is amended —
30 (a) by inserting, immediately after the words “candidate variety” in subsection (1)(b), the words “, but only if the Registrar or the Examiner requests for it”;

- (b) by inserting, immediately after subsection (2), the following subsection:

“(2A) The Registrar or the Examiner may consider the information and materials lodged under section 18A by the applicant for the purpose of the examination.”; and

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- (c) by inserting, immediately after subsection (4), the following subsection:

“(5) The Registrar or the Examiner (as the case may be) may extend the period in subsection (4) in a particular case.”.

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New section 18A

23. The Plant Varieties Protection Act is amended by inserting, immediately after section 18, the following section:

“Breeder’s test

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18A.—(1) The applicant may, for the purpose of an examination under section 17(2) of the plant variety that is the subject of the application, lodge with the Registrar, in the manner required by the Registrar and within the prescribed period, prescribed information and prescribed materials relating to any test on the plant variety —

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- (a) that was conducted by the breeder or another person, organisation or entity acceptable to the Registrar or the Examiner; and

- (b) that satisfies the prescribed requirements.

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(2) The applicant must, on the request of the Registrar or the Examiner, make arrangements for the Registrar or the Examiner to carry out a site inspection of the test mentioned in subsection (1), for the purpose of enabling the Registrar or the Examiner to determine the veracity or adequacy of the information and materials mentioned in that subsection.”.

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Amendment of section 24

24. Section 24 of the Plant Varieties Protection Act is amended by inserting, immediately after subsection (3), the following subsection:

“(4) A late fee of a prescribed amount may be imposed by rules made under this Act for the payment of the annual fee within the prescribed period but after the anniversary of the date of grant of protection where the anniversary is the first day of the one year period for which the annual fee is payable, in prescribed circumstances.”.

Amendment of section 26

25. Section 26(2) of the Plant Varieties Protection Act is amended by inserting, immediately after the words “to be paid,” in paragraph (b), the words “or the late fee required under section 24(4) to be paid,”.

Amendment of section 41

26. Section 41 of the Plant Varieties Protection Act is amended by inserting, immediately after subsection (1), the following subsection:

“(1A) An application for rectification is subject to the rules mentioned in section 54(2)(ea).”.

Amendment of section 49A

27. Section 49A of the Plant Varieties Protection Act is amended by deleting the word “The” and substituting the words “Subject to the rules mentioned in section 54(2)(ea), the”.

Amendment of section 54

28. Section 54(2) of the Plant Varieties Protection Act is amended by inserting, immediately after paragraph (e), the following paragraph:

“(ea) to enable the Registrar to publish —

- (i) an application to rectify an error or omission in the register; and

- (ii) a request to amend an application (including one for a grant of protection for a plant variety), a notice or other document filed for the purpose of this Act,

and to provide for the making of objections to the rectification or amendment by a person claiming to be affected by it;”.

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Saving and transitional provision

29. Despite section 22(a), section 17(1) of the Plant Varieties Protection Act as in force immediately before the commencement of section 22(a) continues to apply to an application for a grant of protection in respect of a plant variety made before that date.

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PART 4

AMENDMENT OF REGISTERED DESIGNS ACT

Amendment of section 12

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30. Section 12(1) of the Registered Designs Act is amended —

- (a) by deleting the word “and” at the end of paragraph (b); and
- (b) by deleting the comma at the end of paragraph (c) and substituting the word “; and”, and by inserting immediately thereafter the following paragraph:

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“(d) that person or that person’s successor in title provides to the Registrar, upon request by the Registrar —

- (i) any prescribed information; and
- (ii) any supporting document,

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in the manner and within the time specified by the Registrar.”.

Amendment of section 15

31. Section 15(1) of the Registered Designs Act is amended by deleting the word “The” and substituting the words “Subject to subsection (4) and the rules mentioned in section 74(2A), the”.

Amendment of section 21

32. Section 21 of the Registered Designs Act is amended —

(a) by deleting the words “before the expiry of the current period of registration” in subsection (2) and substituting the words “not earlier than the prescribed period before the date of expiry of the current period of registration, and not later than the date of expiry of the current period of registration”; and

(b) by deleting the words “period of 6 months immediately following the” in subsection (5) and substituting the words “prescribed period after the date of”.

New section 30A

33. The Registered Designs Act is amended by inserting, immediately after section 30, the following section:

“Registration subject to disclaimer

30A.—(1) An applicant for registration of a design, or the registered owner of a registered design, may disclaim any right in relation to a specified feature of the design.

(2) Where the registration of a design is subject to a disclaimer, the rights given by section 30 are restricted accordingly.

(3) The Minister may make rules under section 75 as to the publication and entry in the register of a disclaimer.”.

Amendment of section 57

34. Section 57(1) of the Registered Designs Act is amended by inserting, immediately after the word “section”, the words “and the rules mentioned in section 74(2A)”.

Amendment of section 66

35. Section 66 of the Registered Designs Act is amended —

- (a) by deleting the words “or non-physical product” wherever they appear in subsection (1) and substituting in each case the words “, non-physical product or set of articles and non-physical products”; 5
- (b) by deleting the word “and” at the end of subsection (2)(a); and
- (c) by deleting the full-stop at the end of paragraph (b) of subsection (2) and substituting the word “; and”, and by inserting immediately thereafter the following paragraph: 10
 - “(c) a person is deemed to represent that a design applied to a set of articles and non-physical products is registered in respect of that set, if there is stamped, engraved or impressed on or otherwise applied to that set or any part of that set (including a device for projecting a non-physical product that is part of that set) anything expressing or implying that the design applied to the set has been registered in respect of that set.”. 15 20

Amendment of section 72A

36. Section 72A of the Registered Designs Act is amended by deleting the word “The” and substituting the words “Subject to the rules mentioned in section 74(2A), the”. 25

Amendment of section 74

37. Section 74 of the Registered Designs Act is amended by inserting, immediately after subsection (2), the following subsection:

“(2A) Without limiting subsection (1), rules made under this section may make provision to enable the Registrar to publish a request — 30

- (a) to correct an error in the Register; and

(b) to amend an application, a notice or other document, and to provide for the making of objections to the correction or amendment by a person claiming to be affected by it.”.

Miscellaneous amendments

5 **38.** The Registered Designs Act is amended by deleting the words “or non-physical products” wherever they appear in the following provisions and substituting in each case the words “, non-physical products, or sets of articles and non-physical products”:

Section 12(1)

10 Section 13(1)

Section 26(1).

Saving and transitional provision

15 **39.** Despite section 30, section 12 of the Registered Designs Act continues to apply to an application for the registration of a design filed before the date of commencement of section 30 as if it had not been amended by section 30.

PART 5

AMENDMENT OF TRADE MARKS ACT

Amendment of section 2

20 **40.** Section 2(9) of the Trade Marks Act is amended by deleting the word “companies” in paragraph (c) and substituting the words “bodies corporate”.

Amendment of section 8

25 **41.** Section 8 of the Trade Marks Act is amended by deleting subsection (11) and substituting the following subsections:

“(11) An earlier trade mark that is a registered trade mark whose registration has expired must continue to be taken into account in determining the registrability of the trade mark in question until the date mentioned in subsection (12), unless the

Registrar is satisfied that there was no bona fide use of the firstmentioned trade mark during the 2 years immediately preceding that date.

(12) The date mentioned in subsection (11) is the last date specified in this Act or rules made under this Act on which the registration of the earlier trade mark may be restored or renewed.

(13) An earlier trade mark that is an international trade mark (Singapore), whose registration in the register of trade marks maintained by the International Bureau for the purposes of the Madrid Protocol is not renewed, must continue to be taken into account in determining the registrability of the trade mark in question until the date mentioned in subsection (14), unless the Registrar is satisfied that there was no bona fide use of the firstmentioned trade mark during the 2 years immediately preceding that date.

(14) The date mentioned in subsection (13) is the date the Registrar receives the prescribed notice of non-renewal from the International Bureau.”.

Amendment of section 10

42. Section 10(1) of the Trade Marks Act is amended —

- (a) by deleting the word “and” at the end of paragraph (b); and
- (b) by deleting the comma at the end of paragraph (c) and substituting the word “; and”, and by inserting immediately thereafter the following paragraph:

“(d) that person or that person’s successor in title provides to the Registrar in the manner specified by the Registrar any prescribed information within a prescribed time, and provides to the Registrar any supporting document requested by the Registrar, within the time specified by the Registrar,”.

Amendment of section 12

43.—(1) Section 12 of the Trade Marks Act is amended —

(a) by deleting subsection (4) and substituting the following subsection:

“(4) If the applicant responds within the period mentioned in this subsection or subsection (3) but fails to satisfy the Registrar that those requirements are met, or to amend the application or provide the additional information or evidence so as to meet them, the Registrar may —

(a) refuse to accept the application;

(b) accept the application but only in relation to the goods or services for which —

(i) registration is sought; and

(ii) the requirements for registration have been met; or

(c) give the applicant another opportunity within a prescribed period to make representations, to amend the application or to provide the additional information or evidence.”;

(b) by deleting subsection (4A) (or subsection (5) as renumbered in the 2020 Revised Edition) and substituting the following subsection:

“(4A) If the applicant fails to respond within the period mentioned in subsection (3) or (4)(c), the application, or the application insofar as it relates to those goods or services for which registration is sought but the requirements for registration have not been met, is treated as withdrawn, but the Registrar must accept the application in relation to those goods and services for which registration is sought and the requirements for registration have been met.”; and

- (c) by inserting, immediately after the word “registration” in subsection (5) (or subsection (6) as renumbered in the 2020 Revised Edition), the words “in relation to all of the goods or services for which registration is sought”.

(2) Section 12 of the Trade Marks Act, as amended by subsection (1)(b), is further amended by renumbering subsection (4A) as subsection (5).

Amendment of section 13

44.—(1) Section 13 of the Trade Marks Act is amended by inserting, immediately after subsection (4), the following subsection:

“(5) In this section and sections 15, 16 and 17, a reference to an application for the registration of a trade mark that has been accepted includes an application that is accepted under section 12(4) or (4A) in relation to only some of the goods or services for which the registration is sought.”.

(2) Section 13(5) of the Trade Marks Act, as inserted by subsection (1), is further amended by deleting “(4A)” and substituting “(5)”.

Amendment of section 14

45. Section 14 of the Trade Marks Act is amended —

- (a) by deleting the word “correcting” in subsection (3) and substituting the word “amending”;
- (b) by deleting the word “address” in subsection (3)(a) and substituting the words “other particular”;
- (c) by deleting the word “correction” in subsection (3) and substituting the word “amendment”; and
- (d) by deleting subsection (4) and substituting the following subsection:

“(4) Subsection (3) is subject to the rules mentioned in section 108(2)(ea).”.

Amendment of section 15

46. Section 15(1) of the Trade Marks Act is amended by inserting, immediately after the words “register the trade mark”, the words “in relation to the goods or services for which the application has
5 been accepted”.

Amendment of section 17

47. Section 17(3) of the Trade Marks Act is amended by deleting the words “application meets all the requirements under this Act” and substituting the words “Registrar is satisfied that the trade marks in
10 question are a series of trade marks and accepts the application,”.

Amendment of section 19

48. Section 19 of the Trade Marks Act is amended —

(a) by deleting the words “not later than 6 months after the date of expiry of the registration” in subsection (3) and substituting the words “not earlier than the prescribed
15 period before the date of expiry of the registration, and not later than another prescribed period after that date”; and

(b) by deleting the words “the period of 6 months” in subsection (5) and substituting the words “the
20 second-mentioned prescribed period in subsection (3)”.

Amendment of section 25

49. The Trade Marks Act is amended by renumbering section 25 as subsection (1) of that section, and by inserting immediately thereafter the following subsection:

25 “(2) Subsection (1) is subject to the rules mentioned in section 108(2)(ea).”.

Amendment of section 67

50. Section 67 of the Trade Marks Act is amended —

(a) by inserting, immediately after subsection (3), the
30 following subsection:

“(3A) An application to the Registrar for rectification is subject to the rules mentioned in section 108(2)(*ea*).”; and

- (*b*) by deleting the words “or correction” in the section heading.

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Amendment of section 108

51. Section 108(2) of the Trade Marks Act is amended —

- (*a*) by inserting, immediately after paragraph (*e*), the following paragraph:

“(*ea*) to enable the Registrar to publish —

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- (i) an application to rectify an error or omission in the register; and

- (ii) a request to amend an application, a notice or other document,

and to provide for the making of objections to the rectification or amendment by a person claiming to be affected by it;”;

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- (*b*) by deleting the word “and” at the end of paragraph (*i*), and by inserting immediately thereafter the following paragraph:

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“(ia) for the continued processing of an application that is treated as withdrawn; and”;

- (*c*) by deleting sub-paragraph (i) of paragraph (*j*).

Amendment of First Schedule

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52.—(1) Paragraph 7 of the First Schedule to the Trade Marks Act is amended by deleting sub-paragraph (4) (or sub-paragraph (5) as renumbered in the 2020 Revised Edition) and substituting the following sub-paragraph:

“(4) If it appears to the Registrar that —

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- (*a*) the requirements mentioned in paragraph 6(1) are met; and

- (b) the other requirements for registration in relation to all or some of the goods or services for which registration is sought are met,

the Registrar must accept the application in relation to the goods or services for which the requirements for registration are met and must proceed in accordance with section 13.”.

(2) Paragraph 7 of the First Schedule to the Trade Marks Act is further amended by renumbering sub-paragraph (4) (as substituted by subsection (1)) as sub-paragraph (5).

Amendment of Second Schedule

53.—(1) Paragraph 8 of the Second Schedule to the Trade Marks Act is amended by deleting sub-paragraph (4) (or sub-paragraph (5) as renumbered in the 2020 Revised Edition) and substituting the following sub-paragraph:

“(4) If it appears to the Registrar that —

- (a) the requirements mentioned in paragraph 7(1) are met; and
- (b) the other requirements for registration in relation to all or some of the goods or services for which registration is sought are met,

the Registrar must accept the application in relation to the goods or services for which the requirements for registration are met and must proceed in accordance with section 13.”.

(2) Paragraph 8 of the Second Schedule to the Trade Marks Act is further amended by renumbering sub-paragraph (4) (as substituted by subsection (1)) as sub-paragraph (5).

Saving and transitional provisions

54.—(1) Despite section 42, section 10 of the Trade Marks Act as in force immediately before the date of commencement of section 42 continues to apply to an application for registration of a trade mark filed before that date.

(2) Despite sections 43, 44, 46, 47, 52 and 53, sections 12, 13, 15 and 17 of, and the First and Second Schedules to, the Trade Marks Act as in force immediately before the date of commencement of sections 43, 44, 46, 47, 52 and 53, continue to apply in respect of an application for registration of a trade mark whose date of application under section 5(4) of that Act is before that date.

PART 6

AMENDMENT OF INTELLECTUAL
PROPERTY OFFICE OF SINGAPORE ACT**Amendment of Intellectual Property Office of Singapore Act**

55. The Intellectual Property Office of Singapore Act is amended — 5

(a) by deleting the words “, fines and composition fines” in section 13(b); and

(b) by inserting, immediately after subsection (2) of section 33, the following subsection: 10

“(3) All sums collected under this section must be paid into the Consolidated Fund.”.

PART 7

MISCELLANEOUS

Other saving and transitional provision 15

56. For a period of 2 years after the date of commencement of any provision of this Act, the Minister may, by regulations, prescribe such additional provisions of a saving or transitional nature consequent on the enactment of that provision as the Minister may consider necessary or expedient. 20

EXPLANATORY STATEMENT

This Bill seeks to amend the Geographical Indications Act 2014, the Patents Act, the Plant Varieties Protection Act, the Registered Designs Act and the Trade Marks Act mainly for the following purposes:

- (a) to facilitate certain changes to processes for the registration of intellectual property rights under these Acts;
- (b) to standardise certain provisions that are common across these Acts.

The Bill also amends the Intellectual Property Office of Singapore Act to require fines and composition sums paid for offences under the various Acts

administered by the Intellectual Property Office of Singapore, to be paid into the Consolidated Fund.

Clause 1 relates to the short title and commencement.

PART 1

AMENDMENT OF GEOGRAPHICAL INDICATIONS ACT 2014

Part 1 (comprising clauses 2 to 6) deals with amendments to the Geographical Indications Act 2014.

Clause 2 amends section 22 (Rectification or correction of register, etc.) to provide that an application for rectification of an error or omission in the register, is subject to rules mentioned in the new paragraph (*ea*) of section 84(2) (inserted by clause 6).

Clause 3 amends section 47 (Withdrawal or amendment of application) —

- (a) to change the references to “correcting” and “correction” to “amending” and “amendment”, respectively, for consistency with equivalent provisions in the other Acts amended by the Bill;
- (b) to enable any particular of an applicant in an application to register a geographical indication to be amended in accordance with that section (and not just the name or address); and
- (c) to provide that a request to amend particulars in an application to register a geographical indication, is subject to rules mentioned in the new paragraph (*ea*) of section 84(2) (inserted by clause 6).

Clause 4 amends section 51 (Renewal of registration) to enable the Minister to prescribe the period for application for renewal of the registration of a geographical indication in the rules made under the Geographical Indications Act 2014, instead of specifying a fixed period in that Act. The clause further provides that an application for renewal must not be filed earlier than a prescribed period before expiry of the registration, or later than a prescribed period after the expiry, and that an additional fee is payable if the application is made after the expiry.

Clause 5 amends section 54 (Amendment of other documents) to clarify that a request to amend an application, a notice or other document under the Geographical Indications Act 2014 is subject to rules mentioned in the new paragraph (*ea*) of section 84(2) (inserted by clause 6).

Clause 6 amends section 84 (General power to make rules) to enable rules to be made for the Registrar of Geographical Indications to publish an application to rectify an error or omission in the register and a request to amend an application, a

notice or other document, and to allow persons affected by the rectification or amendment to object to the rectification or amendment.

PART 2

AMENDMENT OF PATENTS ACT

Part 2 (comprising clauses 7 to 18) deals with amendments to the Patents Act.

Clause 7 amends section 25 (Making of application) to require an application for a patent to be filed in the manner specified in practice directions issued by the Registrar of Patents (in addition to requirements in the rules).

Clauses 8 and 9 amend sections 26 (Date of filing of application) and 28 (Preliminary examination), respectively, to provide that, in prescribed circumstances, there is no need for an applicant for a patent to file certain additional prescribed documents. These additional documents must currently be filed in the following cases:

- (a) where an application for a patent has a date of filing by reason only that documents filed to initiate the application satisfy the conditions in section 26(1)(a), (b) and (c)(ii) (section 26(7));
- (b) in order to fall within the exception to the rule under section 26(8)(b) that, in the event an applicant files any missing part of an application for a patent, the date of filing of the application is the date the missing part of the application is filed (section 26(9));
- (c) in order to fall within the exception to the rule under section 28(8)(b) that, in the event an applicant files a drawing or part of the description of an invention that was missing from an application for a patent, the date of filing of the application is the date the missing drawing or part of the description of the invention is filed (section 28(9)).

Clause 10 amends section 29 (Search and examination) —

- (a) to provide that a request for a search report need not be filed in prescribed circumstances;
- (b) to provide that, for the purposes of a request for an examination report, the prescribed documents need not be filed in prescribed circumstances; and
- (c) to enable the Examiner (in lieu of giving a written opinion) to ask the Registrar of Patents to give an applicant for registration of a patent an invitation to amend the application if the Examiner is of the opinion that the matter can be resolved without a written opinion and a formal response to the written opinion. The applicant may respond to the invitation by amending the application or rejecting the invitation. The

giving of an invitation to amend does not prevent the Examiner from giving a written opinion, but not before the applicant has responded or the prescribed period for responding has expired. The power to give an invitation to amend in lieu of a written opinion is to facilitate the expeditious examination of an application for registration of a patent.

Clause 11 amends section 29B (Review of examination report, etc.) to provide that the examination review report for an application for a patent need not specify whether the Examiner agrees or disagrees with an earlier report, if the applicant for the patent has amended the specification of the application to address all unresolved objections. This is to streamline the current examination review process where the Examiner has to specify whether he or she agrees or disagrees with an earlier report even though the applicant has submitted amendments which resolved the objections raised on the earlier report.

Clause 12 amends section 36 (Term of patent) to enable the Minister to prescribe the period allowed for applying for renewal of a patent after its expiry in the rules made under the Patents Act, instead of specifying a fixed period in that Act.

Clauses 13 and 14 make amendments to sections 39 (Restoration of lapsed patents) and 69 (Restrictions on relief for infringement), respectively, that are consequential on the amendment in clause 12.

Clause 15 amends section 86 (International and national phases of application) to require the Registrar of Patents to publish a translation filed under that section without the need for the applicant to pay a fee.

Clause 16 makes a minor amendment to the section heading of section 102 (Offences by corporations and partnerships) to replace the term “corporations” with “bodies corporate”, which is the term used in the section.

Clause 17 amends section 108 (Information about patent applications and patents, and inspection of documents) to empower the Registrar of Patents to make any information or documents relating to published applications and their corresponding granted patents available to the public without a prior request but subject to prescribed restrictions.

Clause 18 contains saving and transitional provisions relating to amendments made in clauses 7 to 11 and 15.

PART 3

AMENDMENT OF PLANT VARIETIES PROTECTION ACT

Part 3 (comprising clauses 19 to 29) deals with amendments to the Plant Varieties Protection Act.

Clause 19 amends section 2 (Interpretation) to make it clear that the term “Examiner” includes an international plant variety office or organisation, or a plant variety office or an organisation of a foreign country or territory.

Clause 20 amends section 14 (Priority resulting from foreign application) to enable the Minister to prescribe in rules the period for the submission of documents for making a claim of a right of priority in relation to a foreign application, instead of a fixed period in the Plant Varieties Protection Act.

Clause 21 repeals and re-enacts section 15 (Publication) so that any information (other than applications for grant of protection) that must be published by the Registrar of Plant Varieties is to be set out in rules rather than in the Plant Varieties Protection Act.

Clause 22 amends section 17 (Examination of plant variety) —

- (a) to require the applicant for a grant of protection for a plant variety to provide the propagating material of the variety only if the Registrar of Plant Varieties or Examiner requests for it;
- (b) to enable the Registrar of Plant Varieties or Examiner to use a breeder’s (or any other person’s, organisation’s or entity’s) test results under the new section 18A (inserted by clause 23) for an examination; and
- (c) to enable the Registrar of Plant Varieties or Examiner to extend the period for an applicant to submit further information, documents or propagating material in support of an application.

Clause 23 inserts a new section 18A to enable an applicant for a grant of protection of a plant variety to submit, for the purpose of an examination of the variety by the Registrar of Plant Varieties or Examiner, information and materials of a test conducted by the breeder or other person, organisation or entity. This test is not intended to replace the examination in section 17, but is intended to complement the examination. The applicant must, on request, arrange for the Registrar of Plant Varieties or Examiner to carry out a site inspection of the test.

Clause 24 amends section 24 (Term of grant of protection) to allow a late fee to be imposed by rules for the late payment of the annual fee payable during the term of a grant of protection.

Clause 25 amends section 26 (Cancellation of grant of protection) to require the Registrar of Plant Varieties to cancel a grant of protection if the late fee under the amended section 24 is not paid.

Clause 26 amends section 41 (Rectification of register) to provide that an application for rectification of the register is subject to rules mentioned in the new paragraph (*ea*) of section 54(2) (inserted by clause 28).

Clause 27 amends section 49A (Amendment of documents) to provide that a request to amend an application, a notice or other document under that section is

subject to rules mentioned in the new paragraph (*ea*) of section 54(2) (inserted by clause 28).

Clause 28 amends section 54 (Rules) to enable rules to be made for the Registrar of Plant Varieties to publish an application to rectify an error or omission in the register and a request to amend an application, a notice or other document, and to allow persons affected by the rectification or amendment to object to the rectification or amendment.

Clause 29 contains a saving and transitional provision relating to amendments made in clause 22.

PART 4

AMENDMENT OF REGISTERED DESIGNS ACT

Part 4 (comprising clauses 30 to 39) deals with amendments to the Registered Designs Act.

Clause 30 amends section 12 (Claim to priority of Convention application) to provide that a right of priority for the registration of a design arising from an application in a country or territory that is a party to the Paris Convention or a member of the World Trade Organisation, may only be claimed if (among other things) prescribed information and supporting documents are provided in the manner and within the time specified by the Registrar of Designs.

Clause 31 amends section 15 (Amendment of application) to provide that an amendment of an application for the registration of a design is subject to rules mentioned in the new subsection (2A) of section 74 (inserted by clause 37). The clause further clarifies that an amendment of an application for the registration of a design on the initiative of the Registrar of Designs is subject to section 15(4).

Clause 32 amends section 21 (Initial period of registration and extension) to enable the Minister to prescribe the period to apply for extension of the validity of a registration of a design in the rules made under the Registered Designs Act, instead of specifying a fixed period in that Act. The clause further enables the Minister to prescribe the period after the expiry of the current period of registration where an application for extension can be made and (if the extension fee and any prescribed late fee are paid) the registration of the design is treated as if it had never ceased to be in force.

Clause 33 inserts a new section 30A to allow an applicant for the registration of a design or the registered owner of a registered design to disclaim any right in relation to a specified feature of the design.

Clause 34 amends section 57 (Correction of Register) to provide that the power of the Registrar of Designs to correct any clerical error in the Register is subject to rules mentioned in the new subsection (2A) of section 74 (inserted by clause 37).

Clause 35 amends section 66 (False representation that design is registered) to provide that a person who falsely represents that a design applied to any set of articles and non-physical products disposed of by the person for value is registered is guilty of an offence.

Clause 36 amends section 72A (Amendment of documents other than application for registration) to provide that a request to amend an application, a notice or other document under that section is subject to rules mentioned in the new subsection (2A) of section 74 (inserted by clause 37).

Clause 37 amends section 74 (General power to make rules) to enable rules to be made for the Registrar of Designs to publish a request to correct an error in the Register, and to amend an application, a notice or other document, and to allow persons affected by the correction or amendment to object to it.

Clause 38 amends sections 12 (Claim to priority of Convention application), 13 (Claim to priority of other overseas applications) and 26 (Surrender of registration) to extend those provisions to a set of articles and non-physical products.

Clause 39 contains a saving and transitional provision relating to amendments made in clause 30.

PART 5

AMENDMENT OF TRADE MARKS ACT

Part 5 (comprising clauses 40 to 54) deals with amendments to the Trade Marks Act.

Clause 40 amends section 2 (Interpretation) to provide that the term “relevant sector of the public in Singapore” in section 2(7) and (8) includes not just companies, but all bodies corporate in Singapore dealing in the goods or services to which the trade mark concerned is applied.

Clause 41 amends section 8 (Relative grounds for refusal of registration) to clarify that an earlier trade mark whose registration has expired or has not been renewed, must continue to be taken into account in determining the registrability of a trade mark until the following dates:

- (a) in the case of an earlier trade mark that is a registered trade mark — the last date on which the earlier trade mark may be renewed or restored under the Trade Marks Act or rules made under that Act;
- (b) in the case of an earlier trade mark that is an international trade mark (Singapore) — until the Registrar of Trade Marks receives the prescribed notice of non-renewal from the International Bureau.

Clause 42 amends section 10 (Claim to priority of Convention application) to provide that a right of priority for the registration of a trade mark arising from an application in a country or territory that is a party to the Paris Convention or a member of the World Trade Organisation, may only be claimed if (among other things) prescribed information and supporting documents are provided in the manner and within the time specified by the Registrar of Trade Marks.

Clause 43 amends section 12 (Examination of application) —

- (a) to clarify that if the applicant for registration of a trade mark fails to provide a satisfactory response to an invitation by the Registrar of Trade Marks to make representations, amend the application or provide further information or evidence, the Registrar of Trade Marks may give another invitation to the applicant to do the same; and
- (b) to enable (if the applicant fails to provide a satisfactory response to such invitation) or require (if the applicant fails to respond to such invitation) the Registrar of Trade Marks to accept the application for some of the goods or services for which registration is sought, if the registration requirements are met for those goods or services.

Clause 44 makes an amendment to section 13 (Publication and opposition proceedings) that is consequential on the amendment to section 12 where an application for registration of a trade mark may be accepted for some but not all of the goods or services whose registration is sought. The clause clarifies that a reference in sections 13, 15, 16 and 17 to an application that has been accepted includes an application that is accepted only in relation to some but not all of the goods or services for which registration is sought.

Clause 45 amends section 14 (Withdrawal, restriction or amendment of application) —

- (a) to change the references to “correcting” and “correction” to “amending” and “amendment”, respectively, for consistency with equivalent provisions in the other Acts amended by the Bill;
- (b) to enable any particular of an applicant in an application for registration of a trade mark to be amended in accordance with that section (and not just the name or address); and
- (c) to provide that a request to amend certain particulars in an application for registration of a trade mark, is subject to rules mentioned in the new paragraph (ea) of section 108(2) (inserted by clause 51).

Clause 46 amends section 15 (Registration) to enable the Registrar of Trade Marks to register a trade mark in relation to the goods or services for which the application has been accepted. This amendment is consequential on the amendment to section 12.

Clause 47 amends section 17 (Registration of series of trade marks) to clarify that the Registrar of Trade Marks must first be satisfied that the trade marks in question are a series of trade marks (as defined) and must have accepted the application for registration of the trade marks in question under section 12 (whether for some or all of the goods or services for which registration is sought) before the Registrar of Trade Marks registers them in a single registration.

Clause 48 amends section 19 (Renewal of registration) to enable the Minister to prescribe the period for renewal of registration of a trade mark in the rules made under the Trade Marks Act, instead of specifying a fixed period in that Act. The clause further provides that an application for renewal must not be made earlier than a prescribed period before expiry of the registration, or later than a prescribed period after the expiry.

Clause 49 amends section 25 (Amendment of other documents) to provide that a request to amend an application, a notice or other document under the section is subject to rules mentioned in the new paragraph (*ea*) of section 108(2) (inserted by clause 51).

Clause 50 amends section 67 (Rectification or correction of register) to provide that an application for rectification of an error or omission in the register is subject to the rules mentioned in the new paragraph (*ea*) of section 108(2) (inserted by clause 51).

Clause 51 amends section 108 (Power to make rules) —

- (a) to enable rules to be made for the Registrar of Trade Marks to publish an application to rectify an error or omission in the register and a request to amend an application, a notice or other document, and to allow persons affected by the rectification or amendment to object to the rectification or amendment; and
- (b) to enable rules to be made for the continued processing of applications for registration that are treated as withdrawn. The rules providing for the continued processing of such applications are intended to replace rules providing for the reinstatement of such applications.

Clauses 52 and 53 amend the First and Second Schedules, respectively, to enable the Registrar of Trade Marks to accept applications for registration of a collective mark and a certification mark (respectively) for some of the goods or services for which registration is sought, if the registration requirements are met for those goods or services.

Clause 54 contains saving and transitional provisions for amendments made in clauses 42, 43, 44, 46, 47, 52 and 53.

PART 6

AMENDMENT OF INTELLECTUAL
PROPERTY OFFICE OF SINGAPORE ACT

Part 6 comprises clause 55, which amends sections 13(*b*) and 33 of the Intellectual Property Office of Singapore Act to provide that fines and composition sums must be paid into the Consolidated Fund.

PART 7

MISCELLANEOUS

Part 7 comprises clause 56, which empowers the Minister to make further saving and transitional provisions by regulations.

EXPENDITURE OF PUBLIC MONEY

This Bill will not involve the Government in any extra financial expenditure.
