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Patents (Amendment) Bill

Bill No. 6/2017.

Read the first time on 6 February 2017.

A BILL

intituled

An Act to amend the Patents Act (Chapter 221 of the 2005 Revised Edition).

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 Patents (Amendment) Act 2017 and comes into operation on a date that the Minister appoints by notification in the *Gazette*.

5 Amendment of section 14

2. Section 14 of the Patents Act is amended —

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

10 “(c) the disclosure was due to, or made in consequence of, the inventor displaying the invention at an international exhibition;”;

15 (b) by deleting the full-stop at the end of paragraph (d) of subsection (4) and substituting the word “; or”, and by inserting immediately thereafter the following paragraph:

20 “(e) subject to subsections (5A) and (5B), the disclosure was made to the public by the inventor, or by a person who obtained the matter directly or indirectly from the inventor, in any circumstances not described in paragraphs (a) to (d).”;

(c) by inserting, immediately after subsection (5), the following subsections:

25 “(5A) Subsection (4)(e) applies to the disclosure of matter constituting an invention due to, or in consequence of, the publication by an intellectual property administrator (being a person who obtained the matter directly or indirectly from the inventor) of an application for an intellectual property right (being an application containing the matter, but not being the application for a patent mentioned in subsection (4)), or a registration of an intellectual property right pursuant to such an application, only if —

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- (a) the application was filed, without the consent of the inventor, by a person who obtained the matter directly or indirectly from the inventor; or
- (b) the publication was erroneous by reason that — 5
 - (i) the application had been withdrawn, refused or abandoned before the date of the publication; and
 - (ii) consequently, the publication was not required under the law (whether of Singapore or elsewhere) or treaty governing the application. 10

(5B) For the purposes of subsection (4)(e), where —

- (a) the disclosure of matter constituting an invention is due to, or in consequence of, the publication by an intellectual property administrator (being a person who obtained the matter directly or indirectly from the inventor) of an application for an intellectual property right (being an application containing the matter, but not being the application for a patent mentioned in subsection (4)), or a registration of an intellectual property right pursuant to such an application; and 15 20 25
- (b) the publication was erroneous by reason that the publication occurred earlier than provided under the law (whether of Singapore or elsewhere) or treaty governing the application, 30

the matter is to be treated as disclosed to the public on the date when the publication should have occurred under that law or treaty.”;

(d) by inserting, immediately before subsection (6), the following subsection:

“(5C) If the applicant relies on any circumstances described in any paragraph of subsection (4) when —

5 (a) complying with section 29(1)(b) or (c), (3) or (9); or

10 (b) making a request under section 29B(1) for a review of an examination report issued under section 29(4) or a search and examination report issued under section 29(5),

the applicant must file written evidence complying with the prescribed requirements in support of the applicant’s reliance on those circumstances.”; and

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

“(8) In this section —

“foreign intellectual property office” means —

20 (a) any national or regional office outside Singapore that performs functions similar to those that are performed by —

(i) the Registry;

25 (ii) the Registry of Plant Varieties established under section 7 of the Plant Varieties Protection Act (Cap. 232A);

30 (iii) the Registry of Designs established under section 51 of the Registered Designs Act (Cap. 266); or

(iv) the Registry of Trade Marks established under section 64 of the Trade Marks Act (Cap. 332);

(b) the International Bureau; or 5

(c) the International Bureau as defined in section 2(1) of the Registered Designs Act or section 2(1) of the Trade Marks Act;

“intellectual property administrator” means — 10

(a) the Registrar;

(b) the Registrar of Designs;

(c) the Registrar of Plant Varieties;

(d) the Registrar of Trade Marks; or

(e) a foreign intellectual property office; 15

“Registrar of Designs” means the Registrar of Designs appointed under section 49 of the Registered Designs Act, and includes a Deputy Registrar of Designs and an Assistant Registrar of Designs appointed under that section; 20

“Registrar of Plant Varieties” means the Registrar of Plant Varieties appointed under section 5 of the Plant Varieties Protection Act, and includes a Deputy Registrar of Plant Varieties and an Assistant Registrar of Plant Varieties appointed under that section; 25

“Registrar of Trade Marks” means the Registrar of Trade Marks appointed under section 62 of the Trade Marks Act, and includes a Deputy Registrar of Trade Marks and an Assistant Registrar of Trade Marks appointed under that section.”. 30

Amendment of section 29

3. Section 29 of the Patents Act is amended —

(a) by inserting, immediately before the word “file” in subsection (1)(d), the words “subject to subsection (11A),”;

(b) by deleting the word “The” in subsection (9) and substituting the words “Unless the request under subsection (1)(b), (c) or (d) or (3) for the examination report, search and examination report or supplementary examination report is withdrawn under subsection (10) or (11), the”;

(c) by deleting subsections (10) and (11) and substituting the following subsections:

“(10) Despite subsection (1), where an applicant has filed a request for an examination report under subsection (1)(c) or (3), or a request for a search and examination report under subsection (1)(b), the applicant may —

(a) withdraw that request —

(i) in any case where an Examiner has given a written opinion under subsection (7), and the applicant has not responded to the written opinion — at any time before the expiry of the prescribed period mentioned in subsection (9)(a); or

(ii) in any other case — at any time before the examination report or search and examination report is issued under subsection (4) or (5); and

(b) subject to subsection (11A), file a request for a supplementary examination report under subsection (1)(d) within the prescribed period for that request.

(11) Despite subsection (1), where an applicant has filed a request for a supplementary examination report under subsection (1)(*d*), the applicant may —

(*a*) withdraw that request —

(i) in any case where an Examiner has given a written opinion under subsection (8), and the applicant has not responded to the written opinion — at any time before the expiry of the prescribed period mentioned in subsection (9)(*a*); or

(ii) in any other case — at any time before the supplementary examination report is issued under subsection (6); and

(*b*) file a request for a search and examination report under subsection (1)(*b*) or a request for an examination report under subsection (1)(*c*) or (3) within the prescribed period for that request.

(11A) Subsections (1)(*d*) and (10)(*b*) do not apply unless —

(*a*) in any case where the application in suit is a new application mentioned in section 20(3), 26(11) or 47(4) — the actual date of filing of the application in suit is before the prescribed date; or

(*b*) in any other case — the date of filing of the application in suit is before the prescribed date.”;

(*d*) by deleting paragraph (*a*) of subsection (12) and substituting the following paragraph:

“(a) subject to subsection (13), if the applicant fails to do one of the following:

(i) comply with paragraph (b), (c) or (d) of subsection (1) within the period prescribed under that subsection for that paragraph;

5 (ii) where subsection (3) applies, comply with that subsection;”;

(e) by inserting, immediately after the words “subsection (1)(c)” in subsection (12)(c), the words “or (3)”; and

10 (f) by inserting, immediately after subsection (12), the following subsections:

“(13) Where —

15 (a) after receiving the search report under subsection (2)(b) from the Registrar, the applicant does not file a request for an examination report under subsection (3) within the prescribed period mentioned in that subsection; and

20 (b) the time prescribed for filing a request for an extension of the prescribed period mentioned in subsection (3) expires before, or within 3 months after, the date of commencement of section 3(f) of the Patents (Amendment) Act 2017,

25 the application is treated as abandoned if the applicant fails to file the request for an examination report under subsection (3) within 6 months after that date.

30 (14) In this section, “actual date of filing”, in relation to an application in suit that is a new application mentioned in section 20(3), 26(11) or 47(4), means the actual date of filing of the new application, and not the date of filing of the earlier application mentioned in section 20(3) or 26(11) or of the application for the patent to which the reference

relates mentioned in section 47(4), as the case may be.”.

Saving and transitional provisions

4.—(1) Despite section 2(*a*), section 14(4)(*c*) of the Patents Act as in force immediately before the date of commencement of section 2(*a*) continues to apply to or in relation to any application for a patent the date of filing of which is before that date. 5

(2) Section 2(*b*), (*c*) and (*e*) does not apply to any disclosure of matter constituting an invention, made to the public before the date of commencement of section 2(*b*), (*c*) and (*e*). 10

(3) Section 2(*d*) does not apply to or in relation to any application for a patent the date of filing of which is before the date of commencement of section 2(*d*).

EXPLANATORY STATEMENT

This Bill seeks to amend the Patents Act (Cap. 221) for the following main purposes:

- (*a*) to extend the circumstances in which disclosures made prior to the filing of a patent application are to be disregarded during the determination of the state of the art, when assessing the novelty and inventive step of an invention which is the subject of a patent or patent application;
- (*b*) to restrict the option of filing a request for a supplementary examination report to an applicant whose patent application is filed before a prescribed date;
- (*c*) to make the following changes to the search and examination procedure in the patent application process:
 - (i) to provide an applicant with greater flexibility to withdraw a request for an examination report, a search and examination report, or a supplementary examination report;
 - (ii) to treat a patent application as abandoned unless the applicant complies with one of the requirements in section 29(1)(*b*), (*c*) or (*d*) or (3) to request for an examination report, a search and

examination report or a supplementary examination report within the applicable prescribed period.

Clause 1 relates to the short title and commencement.

Clause 2(a) replaces section 14(4)(c) to remove the requirements imposed on the applicant, where the disclosure of matter constituting an invention was due to the inventor displaying the invention at an international exhibition —

- (a) to state, on filing the patent application, that the invention has been so displayed; and
- (b) to file supporting written evidence within the prescribed period.

Clause 2(b) inserts a new section 14(4)(e) to provide that a disclosure of matter constituting an invention to the public by the inventor, or by a person who obtained the matter directly or indirectly from the inventor, if made within 12 months before the date of filing of a patent application, is to be disregarded during the determination of the state of the art, when assessing the novelty and inventive step of the invention which is the subject of the patent application or patent. The new section 14(4)(e) is subject to the new section 14(5A) and (5B).

Clause 2(c) inserts new section 14(5A) and (5B) which qualify the new section 14(4)(e) in certain circumstances.

The new section 14(5A) deals with the scenario where the disclosure of matter constituting an invention is due to the publication by an intellectual property administrator of an application for an intellectual property right (being an application containing the matter), or a registration of an intellectual property right pursuant to such an application. In this scenario, the new section 14(4)(e) applies only if —

- (a) the application was filed, without the consent of the inventor, by a person who obtained the matter directly or indirectly from the inventor; or
- (b) the publication was erroneous by reason that —
 - (i) the application had been withdrawn, refused or abandoned before the date of the publication; and
 - (ii) consequently, the publication was not required under the law or treaty governing the application.

The new section 14(5B) specifies, for the purposes of the new section 14(4)(e), the date when matter constituting an invention is to be treated as disclosed to the public, in the scenario where —

- (a) the disclosure is due to the publication by an intellectual property administrator of an application for an intellectual property right (being

an application containing the matter), or a registration of an intellectual property right pursuant to such an application; and

- (b) the publication was erroneous by reason that the publication occurred earlier than provided under the law or treaty governing the application.

In this scenario, the matter is to be treated as disclosed to the public on the date when the publication should have occurred under that law or treaty.

Clause 2(d) inserts a new section 14(5C) to require an applicant to file supporting written evidence complying with prescribed requirements if the applicant relies on any circumstances described in any paragraph of section 14(4) when filing a request for an examination report or a search and examination report, submitting a response to a written opinion, or making a request for a review of an examination report or a search and examination report.

Clause 2(e) inserts a new section 14(8) to introduce new definitions for the terms “foreign intellectual property office”, “intellectual property administrator”, “Registrar of Designs”, “Registrar of Plant Varieties” and “Registrar of Trade Marks” used in the amended section 14.

Clause 3(a) amends section 29(1)(d), and clause 3(c) replaces section 29(10) and inserts new section 29(11A), to restrict the option of filing a request for a supplementary examination report to cases where the date of filing of the application in suit is before the prescribed date or, if the application in suit is a new application mentioned in section 20(3), 26(11) or 47(4), the actual date of filing of the new application is before the prescribed date.

Clause 3(b) and (c) also amends section 29(9) and replaces section 29(10) and (11) to provide an applicant who has filed a request for an examination report, a search and examination report or a supplementary examination report with greater flexibility to withdraw that request. Where the applicant has responded to the Examiner’s written opinion, the applicant may withdraw the request at any time before the examination report, search and examination report or supplementary examination report (as the case may be) is issued.

Clause 3(d) replaces section 29(12)(a) to treat a patent application as abandoned unless the applicant complies with one of the requirements in section 29(1)(b), (c) or (d) or (3) to request for an examination report, a search and examination report or a supplementary examination report within the applicable prescribed period. The amended section 29(12)(a) is subject to the new section 29(13) (inserted by clause 3(f)).

Clause 3(e) amends section 29(12)(c) so that a patent application is not treated as abandoned, where section 29(11) applies, if the applicant files a request for an examination report under section 29(3) within the prescribed period mentioned in section 29(11)(b). This option of filing a request for an examination report under

section 29(3) is only available if the applicant had complied with section 29(1)(a) earlier.

Clause 3(f) inserts a new section 29(13) to provide an exception to the new section 29(12)(a) (inserted by clause 3(d)) in a case where an applicant does not file a request for an examination report under section 29(3) within the prescribed period, and the time prescribed for filing a request for an extension of that prescribed period expires before, or within 3 months after, the date of commencement of clause 3(f). In such a case, the applicant's patent application is treated as abandoned only if the applicant fails to file a request for an examination report under section 29(3) within 6 months after that date.

Clause 3(f) also inserts a new section 29(14) to introduce a new definition for the term "actual date of filing" used in new section 29(11A).

Clause 4 contains saving and transitional provisions.

EXPENDITURE OF PUBLIC MONEY

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