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No. S 739

PATENTS ACT
(CHAPTER 221)

PATENTS
(AMENDMENT NO. 3) RULES 2014

In exercise of the powers conferred by sections 42, 110 and 115 of the Patents Act, the Minister for Law, after consulting with the Intellectual Property Office of Singapore, hereby makes the following Rules:

Citation and commencement

1. These Rules may be cited as the Patents (Amendment No. 3) Rules 2014 and shall come into operation on 13 November 2014.

Amendment of rule 3

2. Rule 3(3) of the Patents Rules (R 1) is amended by inserting, immediately after the words “shall be made using”, the words “any mode of payment designated by”.

Amendment of rule 4

3. Rule 4 of the Patents Rules is amended —

- (a) by deleting the words “in the journal” in paragraph (1) and substituting the words “at the Office’s Internet website at <http://www.ipos.gov.sg>”;
- (b) by deleting the words “in the journal” in paragraph (3)(b) and substituting the words “at the Internet website referred to in paragraph (1)”;
- (c) by inserting, immediately after paragraph (3), the following paragraph:

“(4) The matters referred to in the Act, including sections 17(2D), 25(1) and (9), 26(8), 27(1), 28(4) and (8), 29(9), 29B(2), 31(1), 36A(10), 42(8), 80(9) and 108(1), of the Act, shall be filed with, made to or given to, the Registrar, or done in an effective and efficient manner by means which may be specified by the Registrar by the issuance of practice directions.”.

Amendment of rule 14

4. Rule 14(1) of the Patents Rules is amended by deleting the words “on Patents Form 4” and substituting the words “in writing”.

Amendment of rule 15

5. Rule 15(1) of the Patents Rules is amended by deleting the words “on Patents Form 5” and substituting the words “in writing”.

Amendment of rule 16

6. Rule 16(1) of the Patents Rules is amended by deleting the words “on Patents Form 6” and substituting the words “in writing”.

Amendment of rule 31

7. Rule 31 of the Patents Rules is amended —

(a) by deleting paragraph (2) and substituting the following paragraph:

“(2) Where any form, or any application, request, reference or notice, referred to in paragraph (3) is required to be filed in relation to the proceedings, the address for service shall be furnished on that form, application, request, reference or notice, as the case may be.”;

(b) by deleting the words “on a form” in paragraph (3);

(c) by deleting sub-paragraphs (a) and (b) of paragraph (3) and substituting the following sub-paragraphs:

“(a) where the address for service is furnished on —

(i) Patents Form 1 or 37; or

(ii) any application made under rule 86(9) or (13), the address for service shall be effective for the purposes of all proceedings in respect of the patent, or the application for a patent, in relation to which that form is filed or the application is made, as the case may be;

(b) where the address for service is furnished on —

(i) Patents Form 2, 7, 35 or 58;

(ii) Form HC4 or HC6;

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- (iii) Patents Form 28 (in so far as the form relates to an application referred to in rule 73(1));
 - (iv) an application referred to in rule 14(1), 71(1) or 78(1);
 - (v) a request referred to in rule 15(1) or made under paragraph 3(4) of the Fourth Schedule;
 - (vi) a reference referred to in rule 16(1) or 76(1); or
 - (vii) a notice filed under paragraph 3(6) of the Fourth Schedule,

the address for service shall be effective for the purposes of the proceedings in relation to which that form or notice is filed, or that application, request or reference is made, as the case may be;”;

- (d) by deleting sub-paragraph (d) of paragraph (3) and substituting the following sub-paragraph:

“(d) where the address for service is furnished on —

- (i) Patents Form 34 or 44;
- (ii) Form CM1, CM2, CM10 or CM12;
- (iii) an application made under rule 64(1); or
- (iv) a request made under paragraph 2(1) of the Fourth Schedule,

the address for service shall be effective only for the matter for which that form is filed or that application or request is made, as the case may be;”;

- (e) by deleting sub-paragraph (B) of paragraph (3)(g)(i) and substituting the following sub-paragraph:

“(B) the other address for service shall be effective for the purposes of all other proceedings in respect of that patent or application; or”;

- (f) by deleting the words “, other than renewal applications or proceedings in respect of that patent” in paragraph (3)(g)(ii).

Amendment of rule 56

8. Rule 56 of the Patents Rules is amended by deleting paragraph (2).

Amendment of rule 64

9. Rule 64(1) of the Patents Rules is amended by deleting sub-paragraph (a) and substituting the following sub-paragraph:

“(a) shall file an application to record the order or direction, accompanied by a copy of the order or direction; and”.

Amendment of rule 71

10. Rule 71 of the Patents Rules is amended —

- (a) by deleting the words “on Patents Form 29” in paragraph (1) and substituting the words “in writing”; and
- (b) by deleting the words “Patents Form 29” in paragraph (2)(a) and (b) and substituting in each case the words “the application”.

Amendment of rule 76

11. Rule 76(1) of the Patents Rules is amended by deleting the words “on Patents Form 32” and substituting the words “in writing”.

Amendment of rule 78

12. Rule 78(1) of the Patents Rules is amended by deleting the words “on Patents Form 33” and substituting the words “in writing”.

Amendment of rule 86

13. Rule 86 of the Patents Rules is amended —

- (a) by deleting the words “on Patents Form 39” in paragraph (9) and substituting the words “in writing”; and
- (b) by deleting the words “for it to be treated as an application under the Act by filing Patents Form 39” in paragraph (13) and substituting the words “in writing for it to be treated as an application under the Act”.

Amendment of rule 90**14.** Rule 90 of the Patents Rules is amended —

(a) by deleting paragraph (3) and substituting the following paragraph:

“(3) Notwithstanding paragraph (2), where these Rules require any form, or any application, request, reference or notice, referred to in paragraph (4) to be filed, the advocate and solicitor or person referred to in paragraph (2) may file the declaration of authorisation, and furnish the address for service, on that form, application, request, reference or notice, as the case may be.”;

(b) by deleting the words “on a form” in paragraph (4);

(c) by deleting sub-paragraphs (a) and (b) of paragraph (4) and substituting the following sub-paragraphs:

“(a) where the declaration of authorisation is filed, and the address for service is furnished, on —

(i) Patents Form 1 or 37; or

(ii) any application made under rule 86(9) or (13), the declaration of authorisation and address for service shall be effective for the purposes of all proceedings in respect of the patent, or the application for a patent, in relation to which that form is filed or the application is made, as the case may be;

(b) where the declaration of authorisation is filed, and the address for service is furnished, on —

(i) Patents Form 2, 7, 35 or 58;

(ii) Form HC4 or HC6;

(iii) Patents Form 28 (in so far as the form relates to an application referred to in rule 73(1));

(iv) an application referred to in rule 14(1), 71(1) or 78(1);

(v) a request referred to in rule 15(1) or made under paragraph 3(4) of the Fourth Schedule;

(vi) a reference referred to in rule 16(1) or 76(1); or

(vii) a notice filed under paragraph 3(6) of the Fourth Schedule,

the declaration of authorisation and address for service shall be effective for the purposes of the proceedings in relation to which that form or notice is filed, or that application, request or reference is made, as the case may be;”;

(d) by deleting sub-paragraph (d) of paragraph (4) and substituting the following sub-paragraph:

“(d) where the declaration of authorisation is filed, and the address for service is furnished, on —

- (i) Patents Form 34 or 44;
- (ii) Form CM2, CM10 or CM12;
- (iii) an application made under rule 64(1); or
- (iv) a request made under paragraph 2(1) of the Fourth Schedule,

the declaration of authorisation and address for service shall be effective only for the matter for which that form is filed or that application or request is made, as the case may be;”;

(e) by deleting sub-paragraph (B) of paragraph (4)(g)(i) and substituting the following sub-paragraph:

“(B) the other declaration of authorisation, and the other address for service, shall be effective for the purposes of all other proceedings in respect of that patent or application; or”; and

(f) by deleting the words “, other than renewal applications or proceedings in respect of that patent” in paragraph (4)(g)(ii).

Amendment of rule 91

15. Rule 91 of the Patents Rules is amended by deleting paragraphs (3) and (4) and substituting the following paragraph:

“(3) The Registrar may advertise the proposed correction by publishing the request and the nature of the proposed correction in the journal and in such other manner, if any, as the Registrar may determine.”.

Amendment of rule 97

16. Rule 97(1) of the Patents Rules is amended —

- (a) by deleting the word “or” at the end of sub-paragraph (b); and
- (b) by deleting the full-stop at the end of sub-paragraph (c) and substituting the word “; or”, and by inserting immediately thereafter the following sub-paragraph:
“(d) by hand.”.

Amendment of rule 108A

17. Rule 108A(1) of the Patents Rules is amended by inserting, immediately after “81,” in sub-paragraph (b), “88B,”.

Deletion and substitution of rule 116

18. Rule 116 of the Patents Rules is deleted and the following rule substituted therefor:

“Filing of international applications

116. Where the Registry is the competent receiving Office under the Patent Co-operation Treaty, an international application for a patent shall be filed at the Registry in English.”.

Amendment of rule 117

19. Rule 117(1) of the Patents Rules is amended by deleting the words “, accompanied by Patents Form 48,”.

Amendment of First Schedule

20. The First Schedule to the Patents Rules is amended —

- (a) by deleting the words “Patents Form 4” in item 3 under the heading “*Corresponding Form*” and substituting “—”;
- (b) by deleting the words “Patents Form 5” in item 4 under the heading “*Corresponding Form*” and substituting “—”;
- (c) by deleting the words “Patents Form 6” in item 5 under the heading “*Corresponding Form*” and substituting “—”;
- (d) by deleting the words “Filing a request for an Examiner’s review report” in item 16 under the heading “*Matter*” and substituting the words “Request for an examination review report”;

- (e) by deleting the words “Patents Form 29” in item 28 under the heading “*Corresponding Form*” and substituting “—”;
- (f) by deleting the words “Patents Form 32” in item 29 under the heading “*Corresponding Form*” and substituting “—”;
- (g) by deleting the words “Patents Form 33” in item 30 under the heading “*Corresponding Form*” and substituting “—”;
- (h) by deleting the words “Patents Form 39” in item 36 under the heading “*Corresponding Form*” and substituting “—”;
- (i) by deleting items 37, 47, 48 and 68;
- (j) by deleting the words “Patents Form 48” in item 45 under the heading “*Corresponding Form*” and substituting “—”;
- (k) by deleting the words “Patents Form 52” in item 49 under the heading “*Corresponding Form*” and substituting “—”;
- (l) by deleting item 57 and substituting the following item:

| <i>Matter</i> | <i>Amount</i> \$ | <i>Corresponding</i> <i>Form</i> |
|---|---|-------------------------------------|
| “57. Using the services of a service bureau referred to in rule 96K to file any of the following by means of the electronic online system: | | |
| (a) Patents Form 10, 11, 12, 12B or 45A and any document accompanying that form | 120 plus 0.50 for each page of document | |
| (b) any other form and any document accompanying that form | 40 plus 0.50 for each page of document | |
| (c) any statutory declaration or affidavit filed as evidence in inter partes proceedings or any written submission or bundle of authorities, not accompanying any form when filed | 0.50 for each page of document | |

”; and

(m) by deleting item 72 and substituting the following item:

| <i>Matter</i> | <i>Amount</i> \$ | <i>Corresponding</i> <i>Form</i> |
|---|---------------------|-------------------------------------|
| “72. Request for extension of time under rule 108A — | | Form HC3 |
| (a) for first extension of that period | — | |
| (b) for second or subsequent extension of that period | 100 | |

”.

Amendment of Second Schedule

21. The Second Schedule to the Patents Rules is amended —

- (a) by deleting the items relating to Patents Forms 4, 5, 6, 29, 32, 33, 39, 42, 48, 49, 50 and 52 and Form CM11; and
- (b) by deleting the words “report of Examiner’s review” under the heading “*Description of Form*” in the item relating to Patents Form 12B and substituting the words “examination review report”.

Amendment of Fourth Schedule

22. The Fourth Schedule to the Patents Rules is amended —

- (a) by deleting the words “Patents Form 49 together with” in paragraph 2(1);
- (b) by deleting the words “to the Registrar on Patents Form 50” in paragraph 3(1) and substituting the words “in writing to the Registrar”;
- (c) by deleting the words “apply to the Registrar on Patents Form 49 together with” in paragraph 3(4)(a) and substituting the words “make a request to the Registrar on”;
- (d) by deleting the words “Patents Form 49” in paragraph 3(5) and substituting the words “the form”; and
- (e) by deleting the words “on Patents Form 52” in paragraph 3(6) and substituting the words “in writing”.

Savings and transitional provisions

23.—(1) Rule 7(e) and (f) shall not apply to any address for service furnished on Form CM8 before 13 November 2014, and rule 31(3)(g) of the Patents Rules in force immediately before that date shall continue to apply to every such address for service as if rule 7(e) and (f) had not been enacted.

(2) Rule 14(e) and (f) shall not apply to any declaration of authorisation filed, and any address for service furnished, on Form CM8 before 13 November 2014, and rule 90(4)(g) of the Patents Rules in force immediately before that date shall continue to apply to every such declaration of authorisation and address for service as if rule 14(e) and (f) had not been enacted.

(3) Rule 17 shall not apply to any time or period specified, before 13 November 2014, by the Registrar at a case management conference under rule 88B, and rules 108 and 108A of the Patents Rules in force immediately before that date shall continue to apply to every such time or period specified by the Registrar as if rule 17 had not been enacted.

(4) Rule 19 shall apply to every payment of the transmittal fee relating to an international application for a patent filed at the Registry, regardless of whether the application was filed before, on or after 13 November 2014.

(5) Rule 22(a) shall not apply to any request made, before 13 November 2014, under paragraph 2(1) of the Fourth Schedule to the Patents Rules, and paragraph 2(1) of the Fourth Schedule to the Patents Rules in force immediately before that date shall continue to apply to every such request as if rule 22(a) had not been enacted.

(6) Rule 22(c) and (d) shall not apply to any request made, before 13 November 2014, under paragraph 3(4)(a) of the Fourth Schedule to the Patents Rules, and paragraph 3(4) and (5) of the Fourth Schedule to the Patents Rules in force immediately before that date shall continue to apply to every such request as if rule 22(c) and (d) had not been enacted.

Made on 10 November 2014.

BEH SWAN GIN
Permanent Secretary,
Ministry of Law,
Singapore.

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