

Changes to Singapore Intellectual Property Law, 1st July 2004

Patents

The 2004 amendments to the Singapore Patents Act implement certain obligations undertaken by Singapore under the United States-Singapore Free Trade Agreement (USSFTA) concluded in 2003, and to modify certain administrative procedures such as the examination system.

The amendments will enter into force on 1 July 2004 and notable changes are highlighted below which include a new examination system, stricter grant requirements, possibility of patent term extensions and post-grant search and examination, inter alia. Changes that affect only patent applications/patents with a filing date on or after the commencement date are indicated with an asterisk (*), whereas changes that affect existing patent applications/patents are indicated with a double asterisks (**). Please note that for PCT applications entering the national phase here, the filing date is that of the PCT application.

1. EXAMINATION SYSTEM*

A new “two-track” examination system for Singapore patent applications is introduced. By default, a patent application proceeds via the “fast track” in which a patent could be granted within 42 months from the relevant date¹. Alternatively, an applicant can elect to prosecute the application via the “slow-track” by paying a block extension fee by 39 months from the relevant date, which defers the deadline for meeting grant requirements until 60 months.

Overviews of the two track examination system and prosecution options are illustrated in Annex A for a non-PCT application, and Annex B for a Singapore national phase application from a PCT application.

Notable changes to the examination system include changes to the timelines for requesting search and examination, recognition of IPRP (Chapter I) as meeting local examination requirements, option of ignoring the IPER (i.e. IPRP Chapter II) and requesting local search and examination, or relying on final prosecution results or grant of a corresponding application accepted by a prescribed patent office. Further, prescribed information relating to only the patent application upon which reliance is placed to meet local examination requirements is to be furnished and this now need only be provided at the time the grant fees are paid.

Which option is taken will depend in each case on the existence of corresponding foreign applications and the speed with which the applicants wish to prosecute their application. There are costs involved in each different route, some greater than others and we will be able to advise you on a case by case basis which option will be preferable. For PCT cases, since International Preliminary Examination takes the place of local examination, we do advise that

¹ relevant date is the earliest declared priority date or, in the absence of a priority date, the application filing date.

where possible attempts be made to overcome as many objections as possible in the International Phase since this will save costs in the national phase where now it will be required that all claims are searched and examined at some point before grant.

2. GRANT CONDITIONS*

The grant requirements are now stricter and important changes include, at time of requesting grant that there must be no unresolved unity of invention objection that each claim must be identical or within the scope of an examined claim that the invention must not be against public policy, and that there must be no double patenting.

3. PATENT TERM EXTENSION*

With the recent changes, a proprietor of a patent may now apply to the Registrar for an extension of the term of a patent on any of the following grounds:

- i) that there has been an unreasonable delay by the Registrar in granting the patent;
- ii) where the Singapore patent was granted on the basis of the grant of a corresponding application, that there was an unreasonable delay in the issue of the corresponding patent, and the patent office that granted the corresponding patent has extended the term of the corresponding patent on the basis of such a delay; or
- iii) where the subject of the patent includes any substance which is an active ingredient of any pharmaceutical product, that there was an unreasonable curtailment of the opportunity to exploit the patent caused by the process of obtaining marketing approval for a pharmaceutical product, being the first pharmaceutical product to obtain marketing approval which uses the substance as an active ingredient, provided the term of the patent has not been previously extended on this ground.

4. Post-Grant Search and Examination**

A post-grant examination system has been introduced by which any person may request a search and examination report in respect of any claim or claims in the specification of a patent if the person believes (1) that at least one claim in the specification of the patent was not identical to or not within the scope of an examined claim or (2) all the relevant prior art was not considered. Unlike the existing revocation procedure, the re-examination procedure is only advisory in nature and if the claims are found unpatentable, this will not result in revocation of the patent, although the conclusion of the examiner will be placed on the public file.

Apart from the use by third parties to have, on the official file, a prima facie indication of non-patentability in respect of claims of a patent in view of prior art of which the third party is aware, the procedure may also be used by the proprietor to allow such an indication in view of newly found prior art. Proposed amendments are allowed to be presented to overcome prior art submitted. If a patent proceeds to grant without all the claims being searched and examined it will also be possible to use this procedure to ensure that this occurs, to avoid a potential restriction on relief for infringement noted in paragraph 10 below.

5. Rights of Exclusive Licensees to Commence Proceedings for Infringement**

With the amendments, it is possible for an exclusive licensee of a patent to commence proceedings for infringement on his own i.e. the proprietor need not be made a party to the infringement proceedings.

6. Compulsory Licence**

The right to a compulsory licence has been restricted. Any interested person can now only apply for a compulsory licence on the ground that the grant of the licence is necessary to remedy an anti-competitive practice. An example of an anti-competitive practice would be where there is a market for the patented invention in Singapore, but the proprietor of the patented invention fails to supply the market or fails to do so on reasonable terms, and there is no valid reason for not doing so.

7. Definition of Pharmaceutical Products**

A definition for “pharmaceutical product”, for the purpose of patent term extension (3, above) and parallel importation (9, below), is introduced which is defined as a medicinal product which is a substance used wholly or mainly by being administered to a human being for the purpose of treating or preventing disease, but excludes any substance used solely for diagnosis or testing, or as a device or mechanism, or an instrument, apparatus or appliance.

Further, a Schedule is added to the Patents Act to identify the substances that do not fall within the definition of “pharmaceutical product”.

8. New Infringement Exceptions*

Two new infringement exceptions relating to pharmaceutical products have been introduced:

- i) An act would not constitute an infringing act if it is done to support any application for marketing approval for a pharmaceutical product, provided that any thing produced to support the application is not made, used or sold in Singapore, or exported outside Singapore, other than for purposes of obtaining the marketing approval (Bolar provision); and
- ii) The act of importing, disposing or offering for disposal of a patented pharmaceutical product for use by or on a specific patient in Singapore, or the use of that product by or on that patient would not constitute an infringing act, if
 - a) that product is required for use by or on that patient,
 - b) the relevant authority has granted approval specifically for the import and export of that product for use by or on that patient, and
 - c) that product was produced by or with the consent (conditional or otherwise) of the proprietor of the patent or a licensee.

9. Restriction on Scope of Parallel Import of Pharmaceutical Products**

The scope of parallel importation has now been cut back for pharmaceutical products. A parallel importer is not allowed to import a patented pharmaceutical if the proprietor or its licensee has not previously been sold or distributed in Singapore, the import of the product would result in the product being distributed in breach of a contract between the proprietor

and its licensee who is licensed to distribute the product outside Singapore; and the importer has actual or constructive knowledge of the breach of contract.

10. RESTRICTION ON RELIEF FOR INFRINGEMENT**

In line with the amendments providing stricter criteria for grant, the court or the Registrar may refuse to grant any relief in an infringement action (damages, an account of profits, injunction or other relief) where any claim alleged to have been infringed is not identical to or within the scope of another claim which has been examined for novelty, inventive step and industrial applicability.

If a patent application proceeds to grant with claims which fall foul of this exclusion, it is possible to request re-examination under the post-grant search and examination procedure noted above to rectify the problem.

Although these restrictions apply only to applications filed on or after 1 July 2004, it has always been our view that there is a doubt as to the enforceability of claims of existing patents and applications where these have been not examined and/or do not fall within the scope of corresponding patent on which reliance was placed in lieu of examination. Where possible these claims should be examined and we would recommend use of the post-grant search and examination procedure to ensure examination in such circumstances even for existing patents.

11. GROUNDS FOR REVOCATION**

The grounds for revocation has been amended such that a patent can be revoked if the patent was obtained fraudulently, on any misrepresentation, or on any non-disclosure or inaccurate disclosure of any prescribed material information, whether or not the person furnishing the information knew or ought reasonably to have known of such information or the inaccuracy. For this latter ground, the prescribed information is defined in the rules and is currently limited to incorrect identification of a corresponding application, acceptance of which is used to meet examination requirements. Further, double patenting is now a ground for revocation and also, if a patent contains a correction which should not have been allowed.

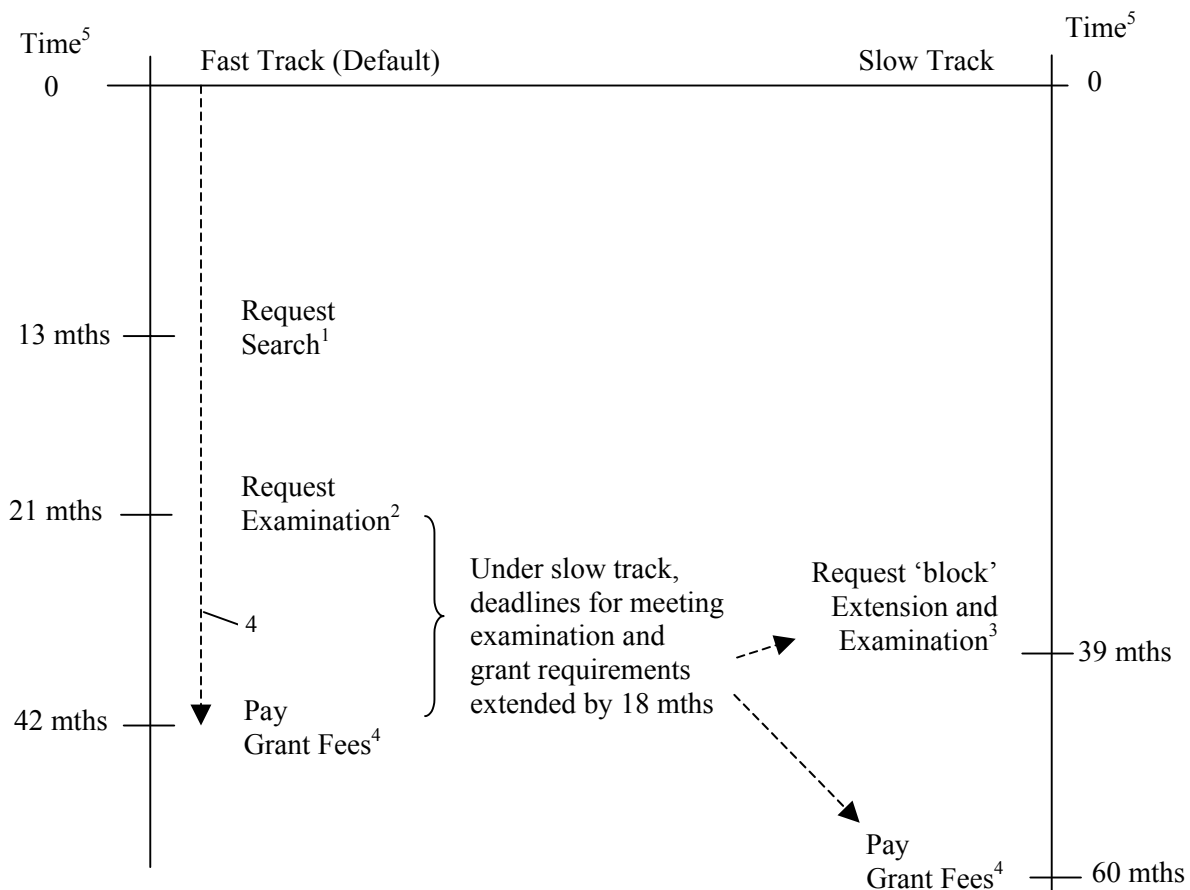
12. Other Changes**

Certified priority documents are no longer necessary, unless specifically requested by the Registrar. This applies not only to applications filed on or after 1st July 2004 but to existing applications. Also, a divisional application forming the subject matter of claims deleted to meet non-unity objections can now be filed at any time before grant fees for the parent is paid.

Come 1 July 2004, the Singapore Patents Registry will also adjust and introduce certain official fees. Official fees relating to Search and/or Examination, and grant will increase. Additionally, for applications filed on or after the commencement date, claim fees at time of requesting grant are payable for each claim in excess of 25.

Newly introduced official fees include fees for requesting a block extension by 39 months to convert from the “fast-track” to “slow-track”, renewal fees for annuities after 20 years (in view of the possibility of patent term extensions), and also fees for requesting search and examination after grant, inter alia.

**PICTORIAL REPRESENTATION OF THE TWO TRACK SYSTEM
(NON-PCT PATENT APPLICATIONS)**

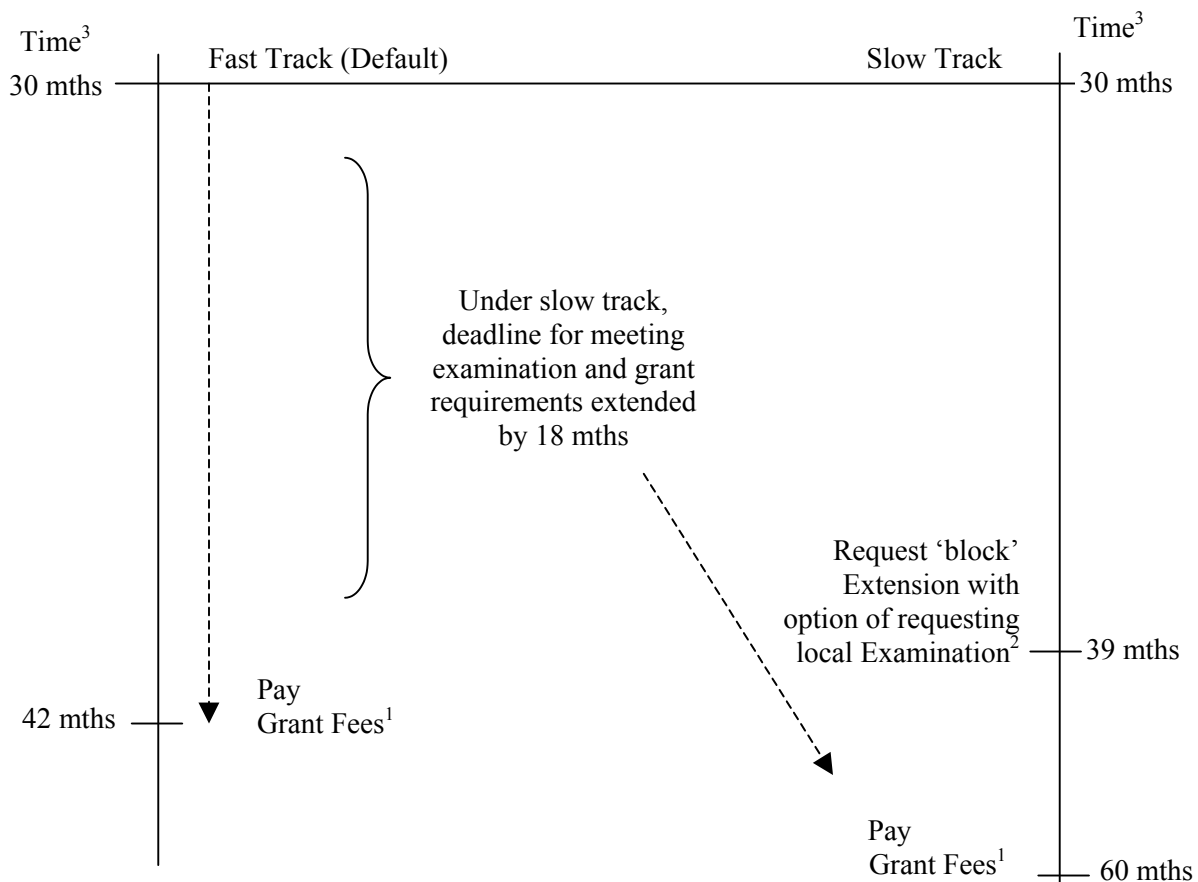


Notes:

1. Search can be deferred until deadline for requesting examination.
2. To meet examination requirements under the fast-track, the applicant has a few options. If local search is requested by 13 months, examination based on the local search report must be requested by 21 months. However, if local search is not requested, combined search and examination must be requested by 21 months. Alternatively, the applicant may file foreign search results from a corresponding application (or corresponding international application) from a prescribed foreign patent office and request examination based on the foreign search result to meet examination requirements. In a further alternative, instead of requesting local examination, the applicant has an option of furnishing prescribed information showing final results or grant of foreign application from a prescribed patent office in place of requesting local examination (see point 4 below).
3. If the applicant wants to opt for slow track, there is no need to request search/examination by 21 months. Instead, the applicant files a 'block' extension of time request retrospectively by 39 months, and either requests combined search and examination, or requests examination based on a foreign search result, at time of requesting the block extension.
4. As an alternative to (2) and (3) above, the applicant also has an option of furnishing prescribed information showing final results or grant of foreign application at time of paying grant fees to meet local examination requirements. Under the slow track, this deadline is extended from 42 months to 60 months.
5. Timelines are calculated from the earliest declared priority date or, in the absence of a priority date, the filing date.

Disclaimer: The above illustration is intended to provide general guidelines only and not advice with regard to specific cases. You should contact us for advice specific to your own situation.

**PICTORIAL REPRESENTATION OF THE TWO TRACK SYSTEM
(PCT NATIONAL PHASE PATENT APPLICATIONS)**



1. File notification to rely on IPRP I or IPRP II to meet local examination requirements and pay grant fees. Alternatively, instead of relying on the IPRP, the applicant can furnish prescribed information showing final results or grant of foreign application from a prescribed patent office to meet local grant requirements. If the applicant opts for the slow track by filing a block extension of time by 39 months, the deadline for filing the notification or prescribed information will be extended until 60 months. (See also point 2 below)
2. Under the slow track, the applicant can file a block extension of time by 39 months to defer the deadline for meeting grant requirements until 60 months. Also, under the slow track, the applicant may choose not to file the notification and request local examination based on the International Search Report or a foreign search report, or request combined search and examination at time of requesting the block extension, similar to the slow track option of a non-PCT application.
3. Timelines are calculated from the earliest declared priority date or, in the absence of a priority date, the filing date of the PCT application. If early entry of national phase is elected, the applicant may also opt for the fast track system similar to the non-PCT applications, but does not have the option of requesting local search and examination separately.

Disclaimer: The above illustration is intended to provide general guidelines only and not advice with regard to specific cases. You should contact us for advice specific to your own situation.

Registered Designs

1. Rights of Exclusive Licensees to Commence Legal Action (applicable to all applications from 1 July 2004 onwards)

An exclusive licensee will now be able to commence legal action on his own i.e. the proprietor need not be made a party to the legal action.