

Changes to Patent Law in Singapore

A. Overview

The new patent law has now taken effect. Patent applications (including national phase entry applications and divisional applications) which are filed in Singapore on or after 14 February 2014 will be subject to the new patent law.

This article highlights the key features of the new patent law.

B. A “Positive Grant System”

A major change featuring the new patent law is the transformation into a **“positive grant system”** from the former “self-assessment system”.

Under the old patent law, an application for a patent may proceed to grant regardless of whether the invention fulfils the patentability requirements as to novelty, inventive step and industrial applicability i.e. the “self-assessment system”.

With an aim to establish a more robust patent regime in line with established patent regimes of other jurisdictions (such as USA, Europe, UK, etc), and to enhance the quality of patents granted in Singapore, the new patent law has moved away from the “self-assessment system” towards a **“positive grant system”**. Under the new “positive grant system”, a patent application can only proceed to grant provided that it fulfils all patentability requirements as to novelty, inventive step and industrial applicability.

C. Relying on Related National Phase Applications

Under the old patent law, applicants are only allowed to rely on the search and/or examination results of corresponding patent applications / corresponding PCT applications which are linked by a common priority claim with the Singapore applications.

Under the new patent law, applicants can also rely on the search and/or examination results of **“related national phase applications”** derived from the same PCT applications but do not have any common priority claim as the Singapore applications.

D. Single Prosecution Track and Routes to Grant

The dual-track system under the old patent law i.e. the default “fast-track system” and the optional “slow-track system” has been abolished. Hence, the prosecution timelines under the new patent law have been simplified with only one set of timelines for each route to grant.

Similar to the old patent system, the new patent system allows applicants the choice of the following routes to obtain grant of their patents in Singapore:

(i) Routes to Grant

Route	Type	Timeline (from filing date or earliest priority date, where applicable)
A	<ul style="list-style-type: none"> Filing a Request for a Search Report; <p><i>followed by</i></p> <ul style="list-style-type: none"> Filing a Request for an Examination Report. 	<p>Within 13 months</p> <p>Within 36 months</p>
B	Filing a Combined Request for Search and Examination Report.	Within 36 months
C	Relying on the Search Report of a Corresponding Application / Corresponding PCT Application / Related National Phase Application and Filing a Request for Examination.	Within 36 months
D	Relying on the Final Search and Examination Results of a Corresponding Application / Corresponding PCT Application / Related National Phase Application and Filing a Request for Supplementary Examination	Within 54 months

Extensions of time under the new patent law for certain prosecution timelines are allowed “as of right” up to a period of 6 or 18 months, subject to payment of official fees for each month of extension.

(ii) Introduction of the Supplementary Examination System

Under the new patent law, applicants who wish rely on the foreign examination results from approved jurisdictions of their corresponding foreign applications / corresponding PCT applications / related national phase applications are required to file a separate Request for Supplementary Examination within the 54-month timeline i.e. **Route D** above.

The Supplementary Examination route allows the local Examiners to review the foreign examination reports and decide whether the inventions applied for fulfil the patentability criteria under the Singapore law.

Submission of Claims Correspondence Table

In addition, when filing a Request for Supplementary Examination, the Applicant is required to submit a separate table setting out how each claim in the Singapore application is related to at least one claim in the relevant corresponding application / corresponding PCT application / related national phase application for which the examination results are relied upon.

E. The Examination Process

(i) Written Opinion

During the examination process, if the Examiner has objections to raise, a Written Opinion will be issued and the Applicant will be given the opportunity to respond to the Written Opinion by filing written submissions and/or amendments to the application.

The timeline for responding to a Written Opinion depends on the route to grant chosen by the Applicant:

- (a) *For a Written Opinion issued in respect of a Request for **Local Examination / Local Search & Examination Report**: **within 5 months** from the date of issuance of the Written Opinion.

**Under this route, after the first round of response to a Written Opinion is filed by the Applicant, the Examiner may either issue a further Written Opinion (if there are further objections to raise) or a final Examination Report.*

- (b) **For a Written Opinion Issued in respect of a **Supplementary Examination Report**: **within 3 months** from the date of issuance of the Written Opinion.

***Under this route, the Examiner will only issue 1 Written Opinion.*

Overall, the examination report must be established within 18 months from the date of invitation to respond to the first Written Opinion in the case of a Request for **Local Examination / Local Search & Examination Report**. In the case of a **Request for Supplementary Examination Report**, the examination report must be established within 6 months from the date of invitation to respond to the Written Opinion.

If no response is filed to a Written Opinion, the Written Opinion will be treated as the Local Examination Report / Local Search & Examination Report / Supplementary Examination Report upon expiry of the deadline to respond to the Written Opinion.

(ii) Notice of Eligibility to Proceed to Grant & Payment of Grant Fee

If a positive examination report is established, the Examiner will issue a **Notice of Eligibility** to proceed with the Grant of the Patent. Applicants will then be given 2 months from the date of issuance of the Notice of Eligibility to attend to payment of the grant fee and obtain the grant certificate.

(iii) Notice of Intention to Refuse and Request for Review of Examination Report

However, if a negative examination report is established (e.g. where the Examiner is of the view that the invention for which grant is applied for does not fulfil the patentability requirements or where there are unresolved objections), a “**Notice of Intention to Refuse**”, notifying the Applicant of the Examiner’s intention to refuse the application will be issued.

The Applicant would then have the opportunity to file an appeal against the “**Notice of Intention to Refuse**” by filing a **Request for Review of an Examination Report** (along with written arguments and/or

amendments) within 2 months from the date of the “Notice of Intention to Refuse”. The official fee for filing a Request for Review of an Examination Report is SGD 1,350.

No Written Opinion will be issued by the Examiner. In response to the Request for Review of an Examination Report, the Examiner will issue either a Notice of Eligibility to proceed to grant or a Notice of Refusal.

However, if no Request for Review of an Examination Report is filed within the prescribed period i.e. 2 months from the date of the “Notice of Intention to Refuse”, the refusal of the application will become final.

F. Post Grant Search and Examination

The provisions relating to search and examination after the grant of patents have been abolished under the new patent law. This means that for patent applications filed on or after 14 February 2014, requests for search and examination after these applications have obtained grant are no longer possible.

However, requests for post-grant search and examination in respect of patent applications filed prior to 14 February 2014 are still allowed.

G. Surrender of Patents

The new patent law no longer requires that the surrender of patents be advertised and as a result, the opposition procedure has also been abolished under the new patent law.

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The article contains general information and should not be relied upon as legal advice. If specific legal advice is required, please feel free to contact us.

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