



**DREW & NAPIER**

# Changes in Singapore Patents System

**29 September 2021**

# LEGAL UPDATE

# In this Update

Subsequent to the Intellectual Property (Dispute Resolution) Act 2019, some changes have been made to the patent legislation in Singapore and these will be in force on **1 October 2021**.

This article discusses some of the legislative changes.

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## INTRODUCTION

### KEYPOINT

*There will be significant changes to the Patents System that will come into force on 1 October 2021.*

The new rules will include pre-grant observations on the patentability of an invention by third parties (“**Third Party Observation**”) and post-grant requests by third parties to re-examine the specification of patent of an invention (“**Re-Examination**”).

The new rules will also cover the effect of counter-statements in revocation proceedings and provide for a note to be added to the Patents Register on the validity of a patent.

## THIRD PARTY OBSERVATIONS

The Third Party Observation can be filed before the examination report is issued by the Examiner<sup>1</sup>.

When a Third Party Observation is filed, the Registrar will give written notice of the filing to the patent applicant and send a copy of the observation to an Examiner who must take the observation into consideration.

A Third Party Observation that is considered in examination will be published on the Patents Open Dossier. If the third party wishes to keep their identity confidential, a Third Party Observation may be submitted by a Registered Patent Agent.

Previously, the only possible route to contest a patent or a patent application was to apply to have the patent (once granted) revoked, and this remains available as a formal option requiring an application to the Registrar and grounds for revocation to be made out.

## RE-EXAMINATION<sup>2</sup>

For granted patents, third parties are allowed to file a request to the Registrar to conduct a re-examination of the specification of a patent for an invention based on grounds for revocation such as:

- (a) the invention not being a patentable invention;
- (b) the specification not disclosing the invention clearly and completely for it to be performed;

- (c) the matter disclosed extending beyond that disclosed as filed;
- (d) amendments resulting in additional matter or extending the protection conferred;
- (e) corrections that should not have been allowed;
- (f) the patent being one of two or more patents for the same invention having the same priority date and filed by the same party.

The Re-Examination request may only be filed if there are no other proceedings in which the validity of the patent may be put in issue whether in Court or before the Registrar. The Registrar may also reject any request that fails to comply with the requirements or if the Registrar is of the view that the request is frivolous, vexatious, or an abuse of the process.

The request for Re-Examination, Written Opinion and Examination Report in relation to the re-examination process will be published on the Patents Open Dossier. Again, to maintain confidentiality of the third party requesting for the re-examination, the request for re-examination may be filed by a Registered Patent Agent.

## **FILING OF COUNTER-STATEMENT IN REVOCATION**

Patent proprietors should take note that under the new rules, when an application to revoke a patent has been filed, the Registrar must grant the application for revocation if no counter-statement is filed within the time period of 3 months<sup>3</sup>. Previously, the application for revocation would be considered as if each fact set out in the statement was conceded except where contradicted by other document(s) in possession of the Registrar.

## **PATENT REGISTER NOTE**

Another change is that the proprietor of the patent may request for a note to be added to the Register of a patent to record that the patent was found to be valid in proceedings before the Court or the Registrar and, if applicable, that a certificate of contested validity has been given by the Court<sup>4</sup>. This would provide an indication to everyone that the patent has been tested in litigation proceedings, which typically is an ultimate test of validity of a patent.

## COMMENTS

These changes would improve the quality of the patents being granted and strengthen the patent regime, although it would also seem that more onus is being placed on patent proprietors to defend their patent and to ensure their application for an invention is robust.

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Sections and Rules are with reference to the latest versions of the Singapore Patents Act and Patents Rules coming into force 1 October 2021

1. New Section 32 and new Rule 45A
2. New Section 38A and new Rule 42A
3. Amended Rule 80
4. New Rule 62A

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