

Amendment to Patents Act and Rules To Enter Into Force On 30 October 2017 (Circular No. 7/2017, dated 6 October 2017)

As part of IPOS' effort to provide a fit-for-purpose legal and policy framework to support innovative individuals and businesses, the Patents (Amendment) Act 2017 and the Patents (Amendment No.2) Rules 2017 will enter into force on 30 October 2017. The revised Examination Guidelines for Patent Applications at IPOS (October 2017 version) ("Guidelines") will also be published on the same day on the IPOS Website.

Key features of the amendments include:

- a. broadening of grace period;
- b. changes to supplementary examination; and
- c. amendments to the Guidelines on isolated products from nature and the assessment of post-grant amendments.

Broadening of Grace Period

The broadened grace period will take effect on 30 October 2017. Under the broadened grace period, applicants have the opportunity to obtain patent protection for their invention notwithstanding that it has been disclosed prior to the filing of the patent application.

The objective of the broadened grace period is to provide a limited safety net for the obtaining of Singapore patent rights for patent applicants in instances where the invention has been publicly disclosed prior to the filing of a patent application. Applicants should note that not all jurisdictions have a similarly broad grace period provision. Therefore, all applicants are strongly encouraged to avoid disclosing their inventions to third parties before applying for a patent.

Applicants who wish for disclosure to be graced may inform the Registrar when making:

- 1) a request for search and examination;
- 2) a request for examination;
- 3) a response to written opinion; and
- 4) a request for a review of an examination report or of a search and examination report.

The request for the disclosure to be graced must be accompanied by written evidence in the form of a statutory declaration or affidavit that complies with the requirements of the new Rule 8 of the Patents Rules.

More information on how patent examiners will examine patent applications when an applicant requests for a disclosure to be graced will be made available in Chapter 3 of the revised Guidelines.

Changes to Supplementary Examination

The supplementary examination route will not be available for patent applications filed on or after 1 January 2020¹. Patent applications filed before 1 January 2020 may continue to use the supplementary examination route.

With the closure of the supplementary examination route, all patent applications filed on or after 1 January 2020 will undergo full examination by our examiners. This will increase the quality of our granted patents and increase stakeholders' confidence in the validity of these patents. It will also align our patent system with that of major jurisdictions, such as those of the US, Japan and Europe, that perform a full examination on the patent applications that they receive. As this is a substantial change in practice, a three-year lead time was given for the community to adjust since the first announcement was made.

In line with our plan to progressively improve the quality of Singapore granted patents, the scope of supplementary examination has been expanded to allow an examiner to raise an objection relating to patentable subject matter. This will ensure consistency in the assessment of patentable subject matter across all the routes of examination. This change will take effect on 30 October 2017.

More information on the new scope of supplementary examination will be made available in Chapter 9 of the revised Guidelines, which incorporated feedback that was provided during the public consult held from 5 July 2017 to 15 August 2017.

Amendments to the Guidelines on Isolated Products from Nature

The Guidelines will be amended to clarify the distinction between inventions and discoveries as applied to the issue of isolated products from nature. To find a material or microorganism that pre-existed in nature would represent a discovery and therefore an isolated or purified material or microorganism from nature is not an invention. However if a new use of the isolated or purified material or microorganism is found, then the new use can be claimed. The revised Guidelines will take effect on 30 October 2017.

The objective of this revision is to facilitate innovation by allowing others to develop applications relating to the discovery, and to incentivise translational research and development.

More information can be found in Chapter 8 of the revised Guidelines, which will be made available on the IPOS website on 30 October 2017.

¹ Patent applications filed on or after 1 Jan 2020 refers to –

- National applications having a date of filing on or after 1 Jan 2020,
- International applications entering national phase having a date of filing on or after 1 Jan 2020, and
- Divisional applications having an initiation date on or after 1 Jan 2020.

Updates to the Guidelines on Assessment of Patent Post-Grant Amendments

In light of the recent Singapore Court of Appeal decision of *Warner-Lambert Company LLC v Novartis (Singapore) Pte Ltd [2017] SGCA 45*, Circular No. 1/2016 and Chapter 7, Section E of the Guidelines will be updated to provide greater clarity on the assessment of post-grant amendments, including the issue of “obviously invalid” claims at paragraphs 61 to 65 of the Court of Appeal decision.

More information can be found in the revised Circular and Chapter 7 of the revised Guidelines, which will be made available on IPOS’ website. The revised Circular and revised Guidelines will take effect on 30 October 2017.

Other Procedural Changes

The new legislation also introduces the following procedural improvements, which take effect on 30 October 2017 –

- a) Applicants can choose to switch examination route at any time before the examination report or supplementary examination report is issued. This is a change from the current requirement to switch examination route before responding to a written opinion. The greater flexibility in switching between search and examination routes will make our patent application process more applicant-friendly.
- b) The Registry can treat an application as abandoned if the applicant does not, after receiving a search report, request for an examination report within the prescribed time frame. This will facilitate the flow of new ideas and technologies if the applicant is no longer interested in obtaining protection. Affected applicants (of those applications where the time prescribed for filing Patents Form 45 to extend the time to request for an examination report expires before, or within 3 months after, 30 October 2017) are given the opportunity till 30 April 2018 to file Patents Form 45.

The updated legislative amendments in relation to the changes above will be made available on the IPOS website (<https://www.ipos.gov.sg/resources/ip-legislation>) after it is published in the Government Gazette.

The revised Examination Guidelines for Patent Applications at IPOS (October 2017 version) (“Guidelines”) will be available on the IPOS website (<https://www.ipos.gov.sg/resources/patent>) on 30 October 2017.

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