



PATENTS UPDATE - MARCH 2007

Dear Associates, Clients and Friends,

In our Amica News Issue 1 (July-August 2006), we provided a note on what changes to expect in April 2007. Amendments have since been passed to the Patent Act and Rules in Singapore to align with two major changes to the Regulations under the Patent Cooperation Treaty ("PCT"), to which Singapore is a member. These changes will come into force on 1 April 2007, and are summarised in this update.

Priority

An applicant who has filed an application for a patent in one of the members of the Paris Convention or the World Trade Organization can claim this earlier relevant application as priority in his subsequent patent application(s), provided that the subsequent patent application(s) is made within 12 months from the date of filing of the earlier filed patent application. Singapore, like many countries, has absolute novelty requirements for patenting. If an application is filed after the 12 month period, priority cannot be claimed. This in turn may subject a patent application to patentability or invalidity attacks if the invention has been disclosed in the interim. To ameliorate this situation, amendments have been introduced with respect to priority claims.

Correction of the priority date

Where there is an error in the date (and not other details) of the priority application, it is now possible for an applicant to correct the declared priority date, but this must be done within 16 months from the declared priority date. It is important to note that the declared priority date means the date of the earliest of those applications, in cases where there is more than one earlier relevant application.

If the error relates to other aspects of the priority application or is not in respect of the earliest declared priority application, the usual form to correct an error must be used, but in such a case, it must be shown that the error was obvious and therefore, a correction will not be permitted automatically.

Restoration of the right of priority

Apart from errors in the application, the amendments also address the following problems:

- (i) a Singapore patent application filed outside of the 12-month period – possibly because the Singapore patent application was inadvertently filed late;
- (ii) a priority claim which was not declared at the time of filing of the Singapore patent application; or
- (iii) an error made on the priority date which upon correction, would bring forward the 12 month deadline.

In such cases, it may now be possible for applicants to remedy the problem. For applications filed on or after 1 April 2007, the applicant will now have an additional two months (non-extendable) after the 12-month period expires in which to file his Singapore patent application and claim the priority of an earlier relevant application. Please note however, that if there are more than one earlier relevant applications, only the earliest of them may be restored. This is subject to the condition that the applicant must state the reason for the failure to file within the 12-month period – (1) whether the failure occurred in spite of having taken the due care required by the circumstances; or (2) whether the failure occurred unintentionally. The applicant is encouraged to provide evidence to support his request to restore the priority claim. The Registry may refuse the request for restoration if the Registry is not convinced by the reasons provided, but an opportunity to respond will be given.

Other conditions for restoration are as follows:

- (i) The patent application must not have been published, unless it is a PCT national phase application. If the applicant had requested an early publication, the publication should be withdrawn before the applicant files the request to restore the right of priority.
- (ii) For PCT national phase applications, the request for restoration must be filed within one (1) month from the date of national phase entry.
- (iii) For divisional applications, the declaration or request to restore must be filed on the same day as filing the divisional application

Incorporation by reference to an earlier relevant application

Incorporation of Description

Under the current Act, the following considerations must be satisfied before a date of filing can be issued:

- (1) the documents filed at the Registry must contain an indication that a patent is sought in pursuance of the application;
- (2) the documents identify the applicant or applicants for the patent; and
- (3) the documents contain a description.

The change to the patent system allows the applicant to substitute the description in his Singapore patent application, by making reference to an earlier relevant application under which the Singapore patent application claims priority. The documents to be filed should contain the following:

- (a) a reference to that earlier relevant application;
- (b) the date of filing of the earlier relevant application and the country it was filed in; and
- (c) a statement that the description that should be filed in the Singapore patent application is incorporated and entirely contained in the earlier relevant application.

You may note that the incorporation by reference of the description does not include drawings. This means that any drawings that should be included in the Singapore patent application must be filed at the time of filing that application. Any drawings filed later will be treated as missing parts from the application (see below).

The applicant is given three months from the date of filing to furnish the following documents:

- (i) a written notice confirming that the description of the invention for which the patent is sought is incorporated and completed contained in the earlier relevant application;
- (ii) the description of the invention for which the patent is sought;
- (iii) a copy of the earlier relevant application and its verified English translation (if any);

If the documents are not submitted in time, the application will be treated as abandoned.

Incorporation of Missing Parts

The “missing part”, in relation to an application for a patent, refers to

- (1) any drawing; or
- (2) any part of the description of the invention for which the patent is sought, which was missing from the application at the date of filing the Singapore patent application.

For the purpose of this definition, claims are not considered as a part of the patent application.

The amendment provides that the applicant can now file a drawing or part of the description missing from the application, and the applicant can make a specific request for the date of filing not to be changed. Otherwise, if no request is made, the date of filing the application will be changed to the lodgement date of the missing part. The applicant is given two opportunities to file the missing part: by his own volition, or when the Registry determines during the preliminary examination stage that the drawing or part of the description is missing from the application. The request to file a missing part must be made within three months from the date of filing, the initiation date*, the date of Registrar’s notification that a drawing or a part of the description is missing from the application, or any time before the payment of the fee for grant, whichever is the case. Although the prescribed period to file the request is three months from the relevant date, the request must be made at the same time as filing of the missing part. This “same time” requirement is not extendable.

When making the request, the applicant has to:

- (a) confirm that a reference to an earlier relevant application has been declared in the Singapore patent application;
- (b) provide a statement that the missing part is incorporated and completely contained in that earlier relevant application as filed;
- (c) furnish the date of filing of the earlier relevant application, the application number of the earlier relevant application, and the country in or for which the earlier relevant application was made.

Likewise, if the applicant wishes to withdraw a missing part, it must be done by way of written notice to the Registry and only within three months from the date of filing, the initiation date*, the date of Registrar’s notification that a drawing or a part of the description is missing from the application, or any time before the payment of the fee for grant, whichever is the case.

** initiation date refers to the date on which the divisional application is filed*

Corresponding provisions under the PCT Regulations applicable to PCT International applications filed with Singapore as the Receiving Office

For international applications with international filing dates on or after 1 April 2007, the applicant may request the restoration of the right of priority under new Rule 26bis.3 of the PCT Regulations.

The criteria for restoration are the same as those required for a Singapore patent application as discussed above.

Under the changes to the PCT Regulations, the new Rule 4.18 provides that under an international application which claims an earlier application, the applicant can submit a statement to file Missing Element(s) (entire description or entire claim(s)) or Missing Part(s) (part of description, part of claims or part or all of drawings). This is applicable to international applications with international filing dates on or after 1 April 2007, but excludes international applications in respect of which one or more elements referred to Article 11.1(iii) were first received by the Receiving Office before 1 April 2007. The elements referred to in Article 11.1(iii) are: (a) an indication that it is intended as an international application; (b) the designation of at least one Contracting State; (c) the name of the applicant; (d) a part which on the face of it appears to be a description; (e) a part which on the face of it appears to be a claim or claims.

Other Amendments

The Registry has also introduced other changes to streamline certain administrative procedures in the Singapore patent process. For instance, for a PCT national phase application that proceeds under early entry, a copy of the PCT application as filed and its English translation (if the PCT application is not in English) is no longer required unless the PCT application has not been published at the time of the early entry.

Please note that the above is only intended as a summary of the updates in the law. Should you require any advice on how the above changes affect your specific case, please do not hesitate to contact any one of us.

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