

THE CHANGING FACE OF SINGAPORE PATENT LAW

Patent law in Singapore has undergone a dramatic transformation since its foundation as a system of re-registration of UK patents. The first major change occurred when an independent patent regime with its own patent examination system was introduced on 23 February 1995. At the same time, Singapore joined the Patent Co-Operation Treaty. It was a big step forward.

We are now in the next phase of change and Singapore is ready to enter the global arena in its quest to make Singapore an intellectual property hub in Asia – an ambitious goal, but one which Singapore has steadily been gaining ground.

This article summarises the recent changes and new initiatives introduced towards this goal, and hopefully will provide an overview of the changing landscape of patent practice in Singapore.

Changes in prosecution of patents

A robust IP regime in Singapore has been cited by IPOS as being a key factor for global companies such as Procter & Gamble, Mead Johnson and 30 leading biomedical sciences multinational companies to set up their headquarters in Singapore. It is therefore perhaps not surprising that amendments were introduced to Singapore's patent legislation to further strengthen the patents granted through the system.

One of the most significant changes is the shift from a “self-assessment” system to a positive grant system. With this shift, it is now compulsory that all patents meet the patentability criteria of novelty, inventive step and industrial applicability. This was not the case previously under the self-assessment approach.

The second measure is to introduce a Supplementary Examination for applications which rely on a foreign grant or final examination results. Presently, Singapore recognises certain foreign grants or final results of foreign examination from approved corresponding applications¹ (“the Foreign Route”), which Applicants can rely on in order to obtain grant, instead of requesting local search and examination. The introduction of a Supplementary Examination is to ensure that the foreign grant or final results of foreign examination meets Singapore requirements. However, the examination does not consider the substantive issues of novelty and inventive step, and there is no official fee payable at present.

Finally, an Examination Review which functions as a type of appeal procedure has also been introduced in the event that that a negative examination report or

¹ Approved corresponding applications/related national phase applications are Australia, Japan, Canada (in respect of applications filed in English only), New Zealand, United Kingdom, United States of America, European Patent Office (in respect of EPO applications filed in English only), the receiving office of a PCT application, Republic of Korea.

PATENT UPDATES

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supplementary examination report is issued. If the objections cannot be resolved, then a Notice of Refusal will be issued. Otherwise, if all is clear, then the Notice of Eligibility will be issued.

“Closure of foreign route” deferred

After studies conducted and consultations, IPOS has decided that it will be abolishing the Foreign Route. It was announced earlier that this would take place in 2017, but since then, IPOS has decided that this closure will only take place from 1 January 2020. Therefore for now, IPOS will continue to allow patent applications with a date of filing before 1 January 2020 to use the foreign route.

There was also discussion of introducing a fee for supplementary examination requests, but in the interests of a more measured transition, IPOS has decided not to introduce the same for now.

Although the closure of the foreign route has been deferred a few more years, this is a clear signal of the direction of the Singapore patent system toward independent examination.

Formation of local search and examination unit

Central to the objective of being an intellectual property hub in Asia is the formation of our own local search and examination unit in Singapore. IPOS still continues to outsource search and examination to the Danish, Hungarian and Austrian Patent Offices, but with our own local search and examination unit in Singapore, it is anticipated that more work can now be done locally.

Currently, IPOS has approximately 104 examiners, who are highly qualified and have deep technical expertise. The European and Japan Patent Offices have been closely involved in the training of the Singapore examiners. Some interesting facts are as follows:

- around 95% of patent examiners at the Intellectual Property Office of Singapore (IPOS) are PhD holders; and
- approximately 25% have the ability to conduct searches in Chinese due to their language skills and searches in English as well as Chinese. IPOS also offers the Supplementary International Search (SIS) service under the PCT. It is the first SIS Authority to carry out searches in Chinese.

IPOS is targeting a speedy turnaround time of 60 days for the First Office Action to issue for most cases. By any standards, this is quite rapid and will be extremely useful for Applicants who wish to obtain a preliminary assessment of the patentability of their invention.



Competent International Search and Preliminary Examination Authority

With its own search and examination unit, Singapore has managed to join the ranks of a competent International Searching Authority (ISA) and International Preliminary Examining Authority (IPEA).

With effect from 1 September 2015, patent applications entering their respective markets under the Patent Cooperation Treaty (PCT) from United States, Mexico and Vietnam are able to designate Singapore as an ISA and IPEA, with Thailand, Brunei, Japan, Laos and Indonesia to come.

Patent Prosecution Highway (PPH)

In line with other major Patent Offices, Singapore has also PPH arrangements with Global PPH, Europe, China, and Mexico. The Global PPH network has an extensive reach and currently has 20 participating offices including from Australia, United States, Germany, United Kingdom, Korea, Japan.²

This allows search and examination results to be shared between offices, so that patents may be obtained more quickly and efficiently.

ASEAN IP Cooperation

Apart from the PPH arrangements, Singapore being a member of ASEAN, also has a regional patent work-sharing effort through the ASEAN Patent Examination Cooperation (ASPEC). According to IPOS, since its launch in 2012, 80% of applicants who used ASPEC received a first office action within nine months compared to a typical period of two to seven years previously in those countries.

Patent Cooperation with Cambodia

IPOS has also entered into a patent cooperation with the Ministry of Industry & Handicraft (MIH) of Cambodia which allows patent owners in Singapore to re-register their Singapore patents at the MIH, and submit an IPOS issued Search and Examination Report to MIH for the grant of a Cambodia related patent application.

² The participating offices of the Global PPH include IP Australia (IP Australia), Austrian Patent Office (APO), Canadian Intellectual Property Office (CIPO), Danish Patent and Trademark Office (DKPTO), Estonian Patent Office (EPA), Finnish Patent and Registration Office (PRH), German Patent and Trade Mark Office (DPMA), Hungarian Intellectual Property Office (HIPO), Icelandic Patent Office (IPO), Israel Patent Office (ILPO), Japan Patent Office (JPO), Korean Intellectual Property Office (KIPO), Nordic Patent Institute (NPI), Norwegian Industrial Property Office (NIPO), Portuguese Institute of Industrial Property (INPI), Russian Federal Service for Intellectual Property (ROSPATENT), Intellectual Property Office of Singapore (IPOS), Spanish Patent and Trademark Office (SPTO), Swedish Patent and Registration Office (PRV), United Kingdom Intellectual Property Office (UKIPO), and United States Patent and Trademark Office (USPTO).



Re-registration of a Singapore Patent can be effected by submitting a request for re-registration to the MIH.

Patent applicants with pending Cambodia patent applications can also request IPOS to submit a copy of (i) the final Search and Examination Report issued by IPOS and (ii) the final specifications of the Singapore related patent application to MIH for grant of the Cambodia related patent application. The applicant may also request the specifications of the Cambodia related patent application to be amended accordingly to the final specifications of the Singapore related patent application to expedite grant.

Conclusion – what’s in store for the Singapore Patent System

There is no doubt that the patent system in Singapore has transformed over the last twenty years since its own independent patent filing system was introduced. With the perceived rising costs of patenting in Singapore, one issue which arises is whether Singapore will be able to continue to attract applicants to file in Singapore.

Certainly, there are advantages in obtaining a Singapore patent as Singapore has a good record of intellectual property enforcement and protection . However, there are also strategic benefits to filing in Singapore with respect to prosecution in other ASEAN countries.

With Singapore’s bilateral PPH agreements and Global PPH participation, and with the quick pace of examination in Singapore, search and examination reports obtained from IPOS may prove to be helpful and valuable for prosecution in other countries.

With the increase in patent filings in the ASEAN region, obtaining a Singapore examination and grant would also enable applicants to fast track their applications in ASEAN using the ASPEC framework. The Cambodia patent cooperation is a further example of how a Singapore patent or examination results may prove useful. With the continued efforts of IPOS, there may well be other countries in future which would be added to this list.

Whilst Singapore has set itself a challenging objective to become an intellectual property hub in Asia, there is no doubt that it has, over a short period of time, taken great strides forward. It will be interesting to see the Singapore patent landscape in time to come.

