

Intellectual Property Law Update

Proposed Amendments under the Intellectual Property (Amendment) Bill 2021

Overview

The Intellectual Property Office of Singapore (“**IPOS**”) has published a draft overarching Intellectual Property (Amendment) Bill 2021 (“**the Bill**”) that seeks to amend the various intellectual property (“**IP**”) laws in Singapore. The following is a summary of the key amendments proposed under the Bill, which seeks to streamline IP processes and reduce the administrative burden of those seeking IP protection in Singapore. These amendments are in line with the government’s plans to enhance Singapore’s value proposition as a major global IP hub.

Patents

If passed, there will no longer be a requirement for applicants to provide a copy of an earlier application when making a request to:-

- (a) incorporate the description in a patent application by reference,
- (b) file missing portions, or
- (c) support the declaration of a claim of right of priority,

provided that the application was previously filed at the Registry.

When making a request for an examination report, applicants will also not need to provide a copy of the final result of a search, or the final result of an international search report, if the Registrar had earlier provided a copy of the search result in English.

Further, applicants will no longer have to file a form and pay a fee for the publication of an English translation of a non-English international patent that had entered national phase in Singapore. The Registrar will publish the English translation automatically if it had been filed at the Registry.

In a request for a search and examination report, or a request for an examination report, the Examiner will have a discretion to issue a notice in lieu of a written opinion. Applicants must then respond to the notice within two months, and no extension of time in this regard will be allowed.

Trade Marks

In this respect, it is being proposed that a trade mark that is eligible to be renewed and/or restored will now be regarded as an “earlier trade mark”. If the time period to renew or restore the registration has been extended, the trade mark will continue to be regarded as an earlier trade mark. This will have a bearing on how marks are examined, and also impact upon opposition and other related proceedings before the Registrar.

It is also being proposed that a “partial refusal” mechanism will apply to national trade mark applications. Under this mechanism, the Registrar may then allow a partially refused national trade mark application to proceed to publication even if the applicant does not respond within the prescribed period. Goods or services which do not meet the requirements for registration will be regarded as withdrawn, and the remaining goods or services can then proceed to publication.

Some of the amendments to the Trade Marks Rules that are being proposed are simply intended to reflect IPOS' existing practices. For example, the Rules will now formally state that a trade mark application will be treated as withdrawn if applicants fail to respond to the Registrar's written notice before a deadline. The application will continue to be processed only if applicants file a request for reinstatement within two months from the date when the application is treated as withdrawn. This two-month period cannot be extended. Currently, reinstatement can still be requested, within six months.

Registered Designs

Currently, applicants or proprietors may voluntarily provide a disclaimer to restrict the rights conferred to a registered design. In order to eliminate any ambiguity as to the legal implications of such a disclaimer, it is being proposed that the Registrar may issue Practice Directions to specify the requirements as to how such a disclaimer should be presented. Such disclaimers shall be entered in the Register.

Plant Varieties Protection

In this area, it is being proposed that the Registrar or Examiner may now extend the period for an applicant to provide requested information or documents for the purpose of examination.

To maintain the term of grant of protection, proprietors will now be able to make late payment of annual fees within six months from the anniversary of the date of grant of protection. This is in contrast to the current position, where proprietors could request for an extension of up to four months only to make payment of the annual fees. However, extensions of time will no longer be allowed, and thus late fees will instead apply.

In the examination process of plant varieties, breeders will now have an option of conducting a Distinct, Uniform, Stable test, and can then submit the results to the Registrar or Examiner for verification. The Registrar or Examiner will then conduct an independent examination of the test results to ensure that the plant varieties do satisfy the requirements for grant of protection.

"Cross-IP" Amendments

Further amendments have been proposed that will apply across the various IP regimes. For example and in the context of oppositions, the Registrar will now have a discretion to publish a proposed correction to the particulars of an applicant or owner of IP, or any information relating to a priority application, before the Registrar decides on the proposed correction. After the proposed correction is published, third parties can file a notice of opposition against the proposed corrections if they take objection to the same. This proposed amendment will apply across the different recognised IP regimes in Singapore, including patents, trade marks, registered designs, geographical indications and plant varieties protection.

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This article is intended to discuss the proposed amendments under the Intellectual Property (Amendment) Bill 2021, and it is not intended to be comprehensive nor should it be construed as legal advice. This article is updated as of 25 August 2021.

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