

Patents (Amendment) Bill

Bill No. 19/2004.

Read the first time on 19th May 2004.

A BILL

i n t i t u l e d

An Act to amend the Patents Act (Chapter 221 of the 2002 Revised Edition).

Be it enacted by the President with the advice and consent of the Parliament of Singapore, as follows:

Short title and commencement

1. This Act may be cited as the Patents (Amendment) Act 2004 and shall come into operation on such date as the Minister may, by notification in the *Gazette*, appoint.

5 Amendment of section 2

2. Section 2 of the Patents Act is amended —

(a) by inserting, immediately after the definition of “Convention on International Exhibitions” in subsection (1), the following definitions:

10 ““corresponding application”, in relation to an application for a patent (referred to in this definition as the application in suit), means an application for protection filed, or treated as filed, with any prescribed patent office that —

15 (a) forms the basis for a priority claim under section 17 in the application in suit; or

(b) is subject to a priority claim based on —

(i) the application in suit; or

20 (ii) an application which is also the basis for a priority claim under section 17 in the application in suit;

25 ““corresponding international application”, in relation to an application for a patent (referred to in this definition as the application in suit), means an application for protection filed under the Patent Co-operation Treaty that —

(a) forms the basis for a priority claim under section 17 in the application in suit; or

(b) is subject to a priority claim based on —

30 (i) the application in suit; or

(ii) an application which is also the basis for a priority claim under section 17 in the application in suit;

“corresponding patent”, in relation to a corresponding application, means a patent granted in respect of the corresponding application by the prescribed patent office in which the corresponding application was filed or treated as filed;”;

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(b) by inserting, immediately after the definition of “international exhibition” in subsection (1), the following definition:

“ “international preliminary report on patentability” means —

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(a) an international preliminary report on patentability (Chapter I of the Patent Co-operation Treaty); or

(b) an international preliminary report on patentability (Chapter II of the Patent Co-operation Treaty),

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referred to in the Regulations under the Patent Co-operation Treaty;”;

(c) by inserting, immediately after the definition of “legal officer” in subsection (1), the following definitions:

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“ “marketing approval”, in relation to a pharmaceutical product, means a product licence under section 5 of the Medicines Act (Cap. 176);

“medicinal product” has the same meaning as in the Medicines Act;”;

(d) by inserting, immediately after the definition of “person” in subsection (1), the following definitions:

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“ “pharmaceutical product” means a medicinal product which is a substance used wholly or mainly by being administered to a human being for the purpose of treating or preventing disease, but does not include —

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(a) any substance which is used solely —

(i) for diagnosis or testing; or

(ii) as a device or mechanism, or an instrument, apparatus or appliance; or

(b) any substance or class of substances specified in paragraph 2 or 3 of the Schedule;

“prescribed form” means a form published by the Registrar under section 115A;”;

5 (e) by inserting, immediately after the definition of “Registry” in subsection (1), the following definition:

““relevant authority”, in relation to a pharmaceutical product, means the Health Sciences Authority established under the Health Sciences Authority Act (Cap. 122C);”;

10 and

(f) by inserting, immediately after subsection (3), the following subsection:

“(3A) For the purposes of this Act —

(a) a claim is related to another claim if —

15 (i) the 2 claims are identical; or

(ii) each limitation in the second claim —

(A) is identical to a limitation in the first claim;
or

20 (B) differs from a limitation in the first claim only in expression but not in content; and

(b) more than one claim may be related to a single claim.”.

Amendment of section 26

25 **3.** Section 26(6) of the Patents Act is amended by deleting the words “the patent is granted” and substituting the words “the conditions in section 30(2) and (3) are satisfied”.

Amendment of section 27

4. Section 27(1) of the Patents Act is amended by inserting, immediately after the word “withdrawn”, the words “in the prescribed manner”.

Repeal and re-enactment of sections 29 and 30

5. Sections 29 and 30 of the Patents Act are repealed and the following sections substituted therefor:

“Search and examination

5 **29.**—(1) Where an application for a patent complies with all the formal requirements referred to in section 28(1), the Registrar shall send a notification to the applicant.

10 (2) Upon receiving the Registrar’s notification under subsection (1), the applicant shall comply with any of the following paragraphs which is applicable within the period prescribed for that paragraph:

15 (a) where the application is not an international application for a patent (Singapore) that has entered the national phase in Singapore under section 86(3), file a request in the prescribed form and pay the prescribed fee for a search report;

 (b) file a request in the prescribed form and pay the prescribed fee for a search and examination report;

 (c) where a corresponding application for a patent has been filed at any prescribed patent office —

20 (i) file —

 (A) a copy of the search report in respect of the corresponding application;

 (B) where the search report is not in English, an English translation of the search report;

25 (C) a copy of each prescribed document and, where required by the rules, an English translation of the document if it is not in English; and

 (D) a request in the prescribed form for an examination report,

30 and pay the prescribed fee for an examination report; or

(ii) file —

(A) in the prescribed form, the prescribed information relating to the corresponding application; and

5 (B) where the prescribed information includes any document that is not in English, an English translation of such document;

(d) where a corresponding international application for a patent has been filed —

10 (i) file —

(A) a copy of the international search report in respect of the corresponding international application;

15 (B) where the international search report is not in English, an English translation of the international search report;

(C) a copy of each prescribed document and, where required by the rules, an English translation of the document if it is not in English; and

20 (D) a request in the prescribed form for an examination report,

and pay the prescribed fee for an examination report; or

(ii) file —

25 (A) in the prescribed form, the prescribed information relating to the corresponding international application; and

(B) where the prescribed information includes any document that is not in English, an English translation of such document;

30 (e) where the application is an international application for a patent (Singapore) that has entered the national phase in Singapore under section 86(3) —

(i) file —

(A) a copy of the international search report issued in respect of the application;

5 (B) where the international search report is not in English, an English translation of the international search report;

(C) a copy of each prescribed document and, where required by the rules, an English translation of the document if it is not in English; and

10 (D) a request in the prescribed form for an examination report,

and pay the prescribed fee for an examination report; or

15 (ii) file a notice in the prescribed form of the applicant's intention to rely on the international preliminary report on patentability in respect of that application.

(3) Where the applicant has filed a request and paid the prescribed fee for a search report under subsection (2)(a), the Registrar shall —

(a) cause the application to be subjected to a search by an Examiner to discover the relevant prior art contained in —

20 (i) such documentation as may be prescribed; and

(ii) any additional documentation that the Examiner is aware of and considers to be relevant; and

25 (b) upon receiving the search report prepared by the Examiner, send the applicant a notification and a copy of the search report.

(4) Upon receiving the search report under subsection (3)(b) from the Registrar, the applicant shall, within the prescribed period, file a request in the prescribed form and pay the prescribed fee for an examination report.

30 (5) Where the applicant has filed a request and paid the fee for an examination report under subsection (2)(c)(i), (d)(i) or (e)(i) or (4), the Registrar shall —

(a) cause the application to be subjected to an examination by an Examiner to determine —

(i) whether the conditions specified in sections 13 and 25(4) and (5) have been complied with;

5 (ii) whether the application discloses any additional matter referred to in section 84(1); and

(iii) whether the application discloses any matter extending beyond that disclosed in the application as filed,

10 taking into consideration all the relevant prior art, if any, that the Examiner is aware of or that has been referred to in the search report or international search report, as the case may be; and

(b) upon receiving the examination report prepared by the Examiner, send the applicant a notification and a copy of the examination report.

15 (6) Where the applicant has filed a request and paid the fee for a search and examination report under subsection (2)(b), the Registrar shall —

(a) cause the application to be subjected to —

20 (i) a search by an Examiner to discover the relevant prior art contained in —

(A) such documentation as may be prescribed; and

(B) any additional documentation that the Examiner is aware of and considers to be relevant; and

25 (ii) an examination by an Examiner to determine —

(A) whether the conditions specified in sections 13 and 25(4) and (5) have been complied with;

(B) whether the application discloses any additional matter referred to in section 84(1); and

30 (C) whether the application discloses any matter extending beyond that disclosed in the application as filed,

taking into consideration all the relevant prior art, if any, that the Examiner is aware of or that has been discovered in the search; and

(b) upon receiving the search and examination report prepared by the Examiner, send the applicant a notification and a copy of the search and examination report.

(7) If, within the prescribed period under —

(a) paragraph (b), (c)(i) or (ii), (d)(i) or (ii) or (e)(i) or (ii) of subsection (2); or

(b) subsection (4),

an applicant files a request in the prescribed form and pays the prescribed fee for that period to be extended, the applicant shall perform the acts set out in that provision within the prescribed extended period for performing those acts.

Grant of patent

30.—(1) Subject to subsection (4), the Registrar shall grant the applicant a patent if —

(a) the conditions in subsection (2) are satisfied before the end of the prescribed period or any extension thereof; and

(b) the conditions in subsection (3) have been satisfied.

(2) The conditions referred to in subsection (1)(a) are —

(a) that all the formal requirements have been complied with;

(b) that the Registrar has received —

(i) the search report referred to in section 29(3) and the examination report referred to in section 29(5);

(ii) the search and examination report referred to in section 29(6);

(iii) the search report referred to in section 29(2)(c)(i), the examination report referred to in section 29(5) and, where the search report is not in English, an English translation of the search report;

- (iv) the prescribed information referred to in section 29(2)(c)(ii) or (d)(ii) and, where the prescribed information includes any document that is not in English, an English translation of such document;
- 5 (v) the international search report referred to in section 29(2)(d)(i) or (e)(i), the examination report referred to in section 29(5) and, where the international search report is not in English, an English translation of the international search report; or
- 10 (vi) in the case of an international application for a patent (Singapore) which has entered the national phase in Singapore under section 86(3), as an alternative to the document or documents referred to in any of sub-paragraphs (ii), (iii), (iv) and (v) —
- 15 (A) the notice referred to in section 29(2)(e)(ii);
- (B) an international search report in respect of that application;
- (C) an international preliminary report on patentability in respect of that application; and
- 20 (D) where any report referred to in sub-paragraph (B) or (C) is not in English, an English translation of that report;
- (c) that the prescribed documents for the grant of the patent have been filed; and
- 25 (d) that the prescribed fee for the grant of the patent has been paid.
- (3) The conditions referred to in subsection (1)(b) are —
- (a) that —
- 30 (i) the document or documents received by the Registrar under subsection (2)(b) do not disclose any unresolved objection on the ground that the claim or claims in the application do not relate to one invention or to a group of inventions which are so linked as to form a single inventive concept; or

- (ii) if any such objection is disclosed, the applicant has satisfied the Registrar that the objection has been resolved;
- (b) where the applicant relies on any examination report referred to in section 29(5), any search and examination report referred to in section 29(6) or any international preliminary report on patentability referred to in subsection (2)(b)(vi), that each claim in the application at the time the prescribed documents for the grant of the patent were filed and the prescribed fee for the grant of the patent was paid is related to at least one claim in the application at the time the report was issued —
 - (i) which has been examined; and
 - (ii) which is referred to in the report;
- (c) where the applicant relies on the prescribed information relating to a corresponding application referred to in section 29(2)(c)(ii) or the prescribed information relating to a corresponding international application referred to in section 29(2)(d)(ii), at the time the prescribed documents for the grant of the patent were filed and the prescribed fee for the grant of the patent was paid, that each claim in the application is related to at least one claim —
 - (i) which is set out in the prescribed information relating to the corresponding application or corresponding international application, as the case may be; and
 - (ii) which has been examined to determine whether the claim appears to satisfy the criteria of novelty, inventive step (or non-obviousness) and industrial applicability (or utility);
- (d) that the invention is not an invention referred to in section 13(2); and
- (e) that there is —
 - (i) no other application for a patent for the same invention having the same priority date filed by the same applicant or his successor in title; and

(ii) no earlier grant of a patent for the same invention having the same priority date to the same applicant or his successor in title.

(4) If, within the prescribed period under subsection (1)(a) —

- 5 (a) an appeal is filed in court in respect of an application; and
 (b) the applicant applies to the court to extend that period while the appeal is pending,

the court may extend that period to such date as the court may determine.

10 (5) Where the conditions in subsection (2) are not satisfied before the end of the prescribed period under subsection (1)(a) or any extension thereof, the applicant shall be deemed to have abandoned his application at the end of that period.

15 (6) If the Registrar is of the opinion that any condition in subsection (3) has not been satisfied —

- (a) the Registrar shall send a notification to the applicant setting out the grounds for the Registrar's objection to granting a patent;
- 20 (b) the applicant shall have the right to respond to the Registrar's objection within a period specified by the Registrar;
- (c) unless the Registrar withdraws his objection, the applicant shall, within a period specified by the Registrar and subject to section 84, amend the specification of his application in accordance with the prescribed conditions, with a view to satisfying the conditions in subsection (3); and
- 25 (d) if any condition in subsection (3) remains unsatisfied at the end of the period referred to in paragraph (c), the applicant shall be deemed to have abandoned his application at the end of that period.”.
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Amendment of section 31

6. Section 31 of the Patents Act is amended —

(a) by deleting subsection (1) and substituting the following subsections:

“(1) If it appears to an Examiner during the examination of an application that —

5 (a) the conditions specified in sections 13 and 25(4) and (5) have not been complied with; or

(b) the application discloses —

(i) any additional matter referred to in section 84(1);
or

10 (ii) any matter extending beyond that disclosed in the application for the patent as filed,

the Examiner shall give the applicant at least one written opinion to that effect, and the Registrar shall, upon receiving the written opinion, send the applicant a notification and a copy of the written opinion.

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(1A) The applicant shall, before the examination report is issued, have the right —

(a) to respond in the prescribed manner to the written opinion within any prescribed period; and

20 (b) subject to section 84, to amend in the prescribed manner the specification of the application in accordance with the prescribed conditions.”; and

(b) by deleting the words “at any time before a patent is granted in pursuance of an application” in subsection (2) and substituting the words “during any period prescribed for the purposes of this subsection”.

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Repeal of section 32

7. Section 32 of the Patents Act is repealed.

Amendment of section 36

30 8. Section 36 of the Patents Act is amended —

(a) by inserting, immediately after the words “and shall take effect” in subsection (1), a comma;

- (b) by inserting, immediately after the words “subject to subsection (2)” in subsection (1), the words “and section 36A”; and
- (c) by deleting the words “for the services of the Government” in subsection (3)(c) and substituting the words “in accordance with section 56”.

New section 36A

9. The Patents Act is amended by inserting, immediately after section 36, the following section:

“Extension of term of patent

36A.—(1) The proprietor of a patent may apply to the Registrar to extend the term of the patent on any of the following grounds:

- (a) that there was an unreasonable delay by the Registrar in granting the patent;
- (b) where the patent was granted on the basis of prescribed information relating to a corresponding application referred to in section 29(2)(c)(ii), that —
- (i) there was an unreasonable delay in the issue of the corresponding patent; and
- (ii) the patent office that granted the corresponding patent has extended the term of the corresponding patent on the basis of such delay;
- (c) where the subject of the patent includes any substance which is an active ingredient of any pharmaceutical product, that —
- (i) there was an unreasonable curtailment of the opportunity to exploit the patent caused by the process of obtaining marketing approval for a pharmaceutical product, being the first pharmaceutical product to obtain marketing approval which uses the substance as an active ingredient; and
- (ii) the term of the patent has not previously been extended on this ground.

(2) A delay by the Registrar in granting a patent shall not be treated as an unreasonable delay under subsection (1)(a) unless —

(a) the interval between the date of filing of the application for the patent and the date of issue of the certificate of grant, excluding any period attributable to an act or omission of the applicant, exceeds 4 years; or

5 (b) the interval between the date on which the applicant —

(i) filed a request for a search and examination report in accordance with section 29(2)(b); or

(ii) filed a request for an examination report in accordance with section 29(2)(c)(i), (d)(i) or (e)(i) or (4),

10 and the date of issue of the certificate of grant, excluding any period attributable to an act or omission of the applicant, exceeds 2 years.

(3) Where the proprietor of a patent has made an application under subsection (1)(a) and has satisfied the Registrar that there was in fact an unreasonable delay under subsection (1)(a), the Registrar shall extend the term of the patent —

(a) in a case to which subsection (2)(a) applies, by the period by which the interval referred to in subsection (2)(a) exceeds 4 years;

20 (b) in a case to which subsection (2)(b) applies, by the period by which the interval referred to in subsection (2)(b) exceeds 2 years; or

(c) in a case to which both paragraphs (a) and (b) of subsection (2) apply, by the period by which —

25 (i) the interval referred to in subsection (2)(a) exceeds 4 years; or

(ii) the interval referred to in subsection (2)(b) exceeds 2 years,

whichever is the longer period.

30 (4) Where the proprietor of a patent has made an application under subsection (1)(b) and has satisfied the Registrar of the matters referred to in sub-paragraphs (i) and (ii) of subsection (1)(b), the Registrar may, if the Registrar thinks fit, extend the term of the patent

by such period, not exceeding 5 years, as the Registrar may determine.

5 (5) A curtailment of the opportunity to exploit a patent, the subject of which includes a substance which is an active ingredient of any pharmaceutical product, caused by the process of obtaining marketing approval for a pharmaceutical product, being the first pharmaceutical product to obtain marketing approval which uses the substance as an active ingredient, shall not be treated as an unreasonable curtailment under subsection (1)(c) unless —

- 10 (a) the marketing approval was obtained after the date of issue of the certificate of grant; and
- (b) the interval between the date the application for marketing approval was filed and the date marketing approval was obtained, excluding any period attributable to an act or omission of the applicant for marketing approval, exceeds 2 years.
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(6) Subject to subsections (7), (8) and (9), where the proprietor of a patent has made an application under subsection (1)(c) and has satisfied the Registrar that there was in fact an unreasonable curtailment of the opportunity to exploit the patent under subsection (1)(c), the Registrar shall extend the term of the patent by —

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- (a) a period equivalent to the interval between the date of issue of the certificate of grant and the date marketing approval was obtained;
- 25 (b) the period by which the interval referred to in subsection (5)(b) exceeds 2 years; or
- (c) a period of 5 years,

whichever is the shortest period.

(7) The Registrar shall not extend the term of the patent under subsection (6) unless the applicant has procured and submitted to the Registrar a certificate from the relevant authority stating —

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- (a) the date the application for marketing approval was filed;
- (b) the date marketing approval was obtained; and

(c) for each period attributable to an act or omission of the applicant for marketing approval, the dates on which the period started and ended.

5 (8) In determining the period by which to extend the term of the patent under subsection (6), the Registrar shall rely on, and shall not be concerned to inquire into the truth of, the statements contained in the certificate from the relevant authority under subsection (7).

10 (9) Where the term of a patent has been extended under subsection (6), the protection conferred by the patent during the term of the extension shall apply only to the substance referred to in subsection (1)(c).

(10) Every application to extend the term of a patent shall be —

(a) made by the proprietor of the patent in the prescribed form within the prescribed period;

15 (b) filed in the prescribed manner; and

(c) accompanied by the prescribed fee and any prescribed documents,

and the Registrar may reject any application that fails to comply with any requirement under this subsection.

20 (11) As soon as practicable after the Registrar has extended the term of a patent, he shall —

(a) send to the proprietor of the patent a certificate of extension of patent term in the prescribed form specifying —

(i) the period of the extension; and

25 (ii) any limitation on the protection conferred by the patent during the term of the extension; and

(b) publish in the journal a notice of the extension.

30 (12) The proprietor of a patent who has made an application under subsection (1) may withdraw the application by informing the Registrar in writing of the withdrawal of the application, and any such withdrawal shall not be revocable.

(13) In subsection (2), “period attributable to an act or omission of the applicant” includes (without prejudice to the generality of the expression) any of the following periods which is applicable:

- 5 (a) the period taken by the applicant to pay the filing fee under section 25(1)(b), calculated from the date of filing of the application for the patent to the date on which the filing fee is paid;
- 10 (b) the period taken by the applicant to correct deficiencies in his application under section 26(3), calculated from the date of the Registrar’s notification to the applicant of the deficiencies to the date on which the applicant corrects the deficiencies;
- 15 (c) the period taken by the applicant to file one or more claims for the purposes of the application under section 26(8), calculated from the date of filing of the application for the patent to the date on which the applicant files the claim or claims;
- 20 (d) the period taken by the applicant to amend his application under section 28(2) to comply with the formal requirements, calculated from the date of the Registrar’s notification to the applicant that not all formal requirements have been complied with to the earliest date on which the application, as amended by the applicant, complies with the formal requirements;
- 25 (e) the period taken by the applicant to —
- (i) file a request and pay the prescribed fee for a search report under section 29(2)(a); or
 - (ii) file a request and pay the prescribed fee for a search and examination report under section 29(2)(b),
- 30 calculated from the date of the Registrar’s notification under section 29(1) to the date on which the applicant files the request and pays the fee;
- 35 (f) the period taken by the applicant to file the documents referred to in section 29(2)(c)(i), (d)(i) or (e)(i) and pay the prescribed fee for an examination report, calculated from the

date of the Registrar's notification under section 29(1) to the date on which the applicant files the documents and pays the fee;

- 5 (g) the period taken by the applicant to file the documents referred to in section 29(2)(c)(ii) or (d)(ii), calculated from the date of the Registrar's notification under section 29(1) to the date on which the applicant files the documents;
- 10 (h) the period taken by the applicant to file a notice under section 29(2)(e)(ii), calculated from the date of the Registrar's notification under section 29(1) to the date on which the applicant files the notice;
- 15 (i) the period taken by the applicant to file a request for an examination report under section 29(4), calculated from the date of the Registrar's notification under section 29(3)(b) to the date on which the applicant files the request;
- (j) the period taken by the applicant to file the prescribed documents under section 30(2)(c) and pay the prescribed fee under section 30(2)(d) for the grant of the patent, calculated from —
- 20 (i) in a case to which section 30(2)(b)(i), (iii) or (v) applies, the date of the Registrar's notification under section 29(5);
- (ii) in a case to which section 30(2)(b)(ii) applies, the date of the Registrar's notification under section 29(6);
- 25 (iii) in a case to which section 30(2)(b)(iv) applies, the date on which the applicant files the documents referred to therein; or
- (iv) in a case to which section 30(2)(b)(vi) applies, the date on which the applicant files the notice under section
- 30 29(2)(e)(ii),
- to the date on which the prescribed documents under section 30(2)(c) are filed and the prescribed fee under section 30(2)(d) is paid;
- 35 (k) the period taken by the applicant to rectify any failure to satisfy any condition under section 30(3), calculated from

the date of the Registrar's notification under section 30(6)(a) to the date on which every condition in section 30(3) is satisfied;

- 5 (l) the period taken by the applicant to respond to a written opinion under section 31(1A)(a), calculated from the date of the Registrar's notification under section 31(1) to the date on which the applicant responds to the written opinion;
- 10 (m) the period taken by the applicant to amend the specification of his application under section 31(1A)(b), calculated from the date of the written opinion given under section 31(1) to the date on which the applicant amends the specification of his application;
- 15 (n) where the application is an international application for a patent (Singapore) that has entered the national phase in Singapore under section 86(3), the period taken by the applicant to cause the application to enter the national phase in Singapore, calculated from the date of the filing of the application in accordance with the Patent Co-operation Treaty to the date on which the national phase of the application begins under section 86(3);
- 20 (o) the period taken by the applicant to rectify any failure to comply with any requirement under this Act or the rules, such period —
- 25 (i) to be calculated from the date by which the applicant is required to comply with the requirement to the date on which the applicant rectifies the failure to comply with the requirement; and
- 30 (ii) to include any period taken by the Registrar or the Registry to detect or to notify the applicant of the applicant's failure to comply with the requirement;
- 35 (p) the period taken by the applicant to respond to any request by the Registrar for any document, information or evidence, calculated from the date of the Registrar's notification to the applicant of the request to the date on which the applicant responds to the request;

(q) any extension or alteration of any period to do any thing that is granted by the Registrar or the court at the request or on the application of the applicant.

(14) In subsections (5) and (7), “period attributable to an act or omission of the applicant for marketing approval” includes (without prejudice to the generality of the expression) —

(a) the period taken by the applicant for marketing approval to correct deficiencies in his application for marketing approval, calculated from the date of the relevant authority’s notification to the applicant for marketing approval of the deficiencies to the date on which the applicant for marketing approval corrects the deficiencies;

(b) the period taken by the applicant for marketing approval to respond to any request by the relevant authority for clarification or information, calculated from the date of the relevant authority’s request to the date on which the relevant authority receives the response of the applicant for marketing approval; and

(c) any extension of any period to do any thing that is granted by the relevant authority at the request or on the application of the applicant for marketing approval.”.

New section 38A

10. The Patents Act is amended by inserting, immediately after section 38, the following section:

“Search and examination after grant

38A.—(1) Subject to subsection (2), any person may request for a search and examination report in respect of any claim or claims in the specification of a patent on any of the following grounds:

(a) where the patent was granted on the basis of any examination report or search and examination report referred to in section 29, any international preliminary report on patentability referred to in section 30(2)(b)(vi) or any international preliminary examination report, that —

- 5 (i) at least one claim in the application for the patent at the time the prescribed documents for the grant of the patent were filed and the prescribed fee for the grant of the patent was paid was not related to any claim in the application at the time the report was issued —
- (A) which has been examined; and
 - (B) which is referred to in the report; or
- (ii) the Examiner of the application did not consider all the relevant prior art before preparing the report;
- 10 (b) where the patent was granted on the basis of any prescribed information relating to a corresponding application or corresponding international application referred to in section 29, that —
- 15 (i) at the time the prescribed documents for the grant of the patent were filed and the prescribed fee for the grant of the patent was paid, at least one claim in the application for the patent did not relate to any claim —
- 20 (A) which is set out in the prescribed information relating to the corresponding application or corresponding international application, as the case may be; and
 - (B) which has been examined to determine whether the claim appears to satisfy the criteria of novelty, inventive step (or non-obviousness) and industrial applicability (or utility); or
- 25 (ii) the Examiner of the corresponding application or corresponding international application, as the case may be, did not consider all the relevant prior art before preparing his report on the examination of the corresponding application or corresponding international application, as the case may be.
- 30 (2) The Registrar shall not grant a request under subsection (1) unless —
- (a) the request is filed in the prescribed manner;

(b) the prescribed fee for the search and examination report has been paid; and

(c) in a case to which subsections (3) and (4) apply, subsection (4) has been complied with.

5 (3) Subject to subsection (4), any person who files a request under subsection (1) may, at the time he files the request, also file —

(a) any observation which he wishes to make in relation to the patent; and

10 (b) any document which he considers to be relevant for the purposes of the examination.

(4) Where any document referred to in subsection (3)(b) is not in English, the person who files the request under subsection (1) shall also file an English translation of the document.

15 (5) The Registrar shall not grant a request under subsection (1) if he is of the view that the request is frivolous, vexatious or an abuse of the process.

(6) No request under subsection (1) shall be filed or granted where there are pending before the court or the Registrar proceedings in which the validity of the patent may be put in issue.

20 (7) Where the Registrar grants a request under subsection (1), the Registrar shall cause the claim or claims to be subjected to —

(a) a search by an Examiner to discover the relevant prior art contained in —

(i) such documentation as may be prescribed; and

25 (ii) any additional documentation that the Examiner is aware of and considers to be relevant; and

(b) an examination by an Examiner to determine —

(i) whether the conditions specified in sections 13 and 25(4) and (5) have been complied with;

30 (ii) whether the specification of the patent discloses any additional matter referred to in section 84(1); and

(iii) whether the specification of the patent discloses any matter extending beyond that disclosed in the application for the patent as filed,

taking into consideration all the relevant prior art, if any, that the Examiner is aware of or that has been discovered in the search.

(8) If it appears to the Examiner during the examination of the specification of the patent that —

(a) the conditions specified in sections 13 and 25(4) and (5) have not been complied with; or

(b) the specification of the patent discloses —

(i) any additional matter referred to in section 84(1); or

(ii) any matter extending beyond that disclosed in the application for the patent as filed,

the Examiner shall give the proprietor of the patent a written opinion to that effect, and the proprietor of the patent shall, before the examination report is issued, have the right to respond in the prescribed manner to the written opinion within the prescribed period.

(9) Upon receiving the search and examination report prepared by the Examiner, the Registrar shall —

(a) send a copy of the report to the proprietor of the patent; and

(b) where the request under subsection (1) is not filed by the proprietor of the patent, send a copy each of —

(i) the report;

(ii) any written opinion given by the Examiner; and

(iii) any response given in the prescribed manner by the proprietor of the patent to any such written opinion,

to the person who filed the request.”.

Amendment of section 39

11. Section 39(14) of the Patents Act is amended by deleting the words “for the services of the Government” and substituting the words “in accordance with section 56”.

Amendment of section 40

12. Section 40(3) of the Patents Act is amended by deleting the words “for the services of the Government” and substituting the words “in accordance with section 56”.

5 **Amendment of section 55**

13. Section 55 of the Patents Act is amended —

(a) by deleting subsections (1) and (2) and substituting the following subsections:

10 “(1) Any interested person may apply to the court for the grant of a licence under a patent on the ground that the grant of the licence is necessary to remedy an anti-competitive practice.

(2) Without prejudice to the generality of subsection (1), the court may determine that the grant of a licence is necessary to remedy an anti-competitive practice if —

15 (a) there is a market for the patented invention in Singapore;

(b) that market —

(i) is not being supplied; or

(ii) is not being supplied on reasonable terms; and

20 (c) the court is of the view that the proprietor of the patent has no valid reason for failing to supply that market with the patented invention, whether directly or through a licensee, on reasonable terms.”;

25 (b) by deleting the words “either of the grounds referred to in subsection (2)” in subsection (3) and substituting the words “the ground referred to in subsection (1)”;

(c) by inserting, at the end of subsection (4)(a), the word “and”;

(d) by deleting the word “; and” at the end of subsection (4)(b) and substituting a full-stop;

30 (e) by deleting paragraph (c) of subsection (4);

(f) by inserting, immediately after the words “ceased to exist” in subsection (5), the words “and is unlikely to recur”; and

(g) by deleting subsections (7), (8), (9) and (12).

Amendment of section 56

14. Section 56 of the Patents Act is amended —

(a) by deleting subsection (1) and substituting the following
5 subsection:

“(1) Subject to sections 60, 61 and 62, but notwithstanding any other provision of this Act, the Government and any party authorised in writing by the Government may do anything in relation to a patented invention —

10 (a) for a public non-commercial purpose; or

(b) for or during a national emergency or other circumstances of extreme urgency,

and anything done by virtue of this section shall not amount to an infringement of the patent.”;

15 (b) by deleting the words “the services of the Government of Singapore;” in subsection (2)(a) and substituting the words “a public non-commercial purpose; and”;

(c) by deleting paragraph (b) of subsection (2);

20 (d) by deleting the words “the power of a Government department or a person authorised by a Government department under this section to vend a patented invention” in subsection (2)(c) and substituting the words “the power of the Government or any party authorised by the Government to do anything in accordance with this section”;

25 (e) by inserting, immediately after subsection (3), the following subsection:

30 “(4) In this section, “integrated circuit” means a product, in its final or an intermediate form, in which the elements, at least one of which is an active element, and some or all of the interconnections are integrally formed in and on, or in or on, a piece of material and which is intended to perform an electronic function.”; and

- (f) by deleting the words “for services of Government” in the section heading and substituting the words “by Government and authorised parties”.

Amendment of section 57

5 **15.** Section 57 of the Patents Act is amended —

- (a) by deleting paragraphs (a) and (b) of subsection (1) and substituting the following paragraphs:

10 “(a) anything done in accordance with section 56 by the Government or any party authorised in writing by the Government; or

(b) anything done to the order of the Government —

(i) for a public non-commercial purpose; or

(ii) for or during a national emergency or other circumstances of extreme urgency,

15 by the proprietor of a patent in respect of the patented invention or by the proprietor of an application for a patent in respect of the invention for which the application has been filed and is still pending.”; and

20 (b) by deleting the words “a Government department” in subsection (3) and substituting the words “the Government”.

Amendment of section 58

16. Section 58 of the Patents Act is amended —

- (a) by deleting subsection (1) and substituting the following subsection:

25 “(1) Any dispute as to the exercise by the Government or a party authorised by the Government of the powers conferred by, or as to the terms for doing anything in accordance with, section 56 may be referred to the court by either party to the dispute after a patent has been granted for the invention.”;

30 (b) by deleting the words “any Government department or any person authorised by a Government department” in subsection

(2)(a) and substituting the words “the Government or any party authorised by the Government”; and

(c) by deleting the words “for the services of the Government” in subsection (3) and substituting “in accordance with section 56”.

5 **Repeal of section 59**

17. Section 59 of the Patents Act is repealed.

Amendment of section 60

18. Section 60 of the Patents Act is amended —

10 (a) by deleting the words “a Government department or a person authorised by a Government department” in subsection (1)(c) and substituting the words “the Government or a party authorised by the Government”; and

(b) by deleting subsection (3).

Repeal and re-enactment of section 61

15 19. Section 61 of the Patents Act is repealed and the following section substituted therefor:

“Duty to inform patentee

20 61.—(1) Where any thing set out in section 66(1) is done in relation to a patented invention by the Government or a party authorised in writing by the Government for a public non-commercial purpose, the Government department that did or authorised the doing of the thing shall inform the patentee promptly of the doing of the thing.

25 (2) Where any thing set out in section 66(1) is done in relation to a patented invention by the Government or a party authorised in writing by the Government for or during a national emergency or other circumstances of extreme urgency, the Government department that did or authorised the doing of the thing shall, as soon as reasonably practicable, inform the patentee of the doing of the thing.”.

Amendment of section 66

30 20. Section 66 of the Patents Act is amended —

- (a) by deleting the words “shall not do so” in subsection (2) and substituting the words “shall not be so”;
- (b) by deleting the word “or” at the end of subsection (2)(f);
- (c) by deleting the words “it consists of the import, use, disposal or offer to dispose of, of any patented product, or of any product” in subsection (2)(g) and substituting the words “subject to subsection (2A), it consists of the import, use or disposal of, or the offer to dispose of, any patented product or any product”;
- (d) by deleting the full-stop at the end of paragraph (g) of subsection (2) and substituting a semi-colon, and by inserting immediately thereafter the following paragraphs:

“(h) it consists of the doing of any thing set out in subsection (1) in relation to the subject-matter of the patent to support any application for marketing approval for a pharmaceutical product, provided that any thing produced to support the application is not —

- (i) made, used or sold in Singapore; or
- (ii) exported outside Singapore,

other than for purposes related to meeting the requirements for marketing approval for that pharmaceutical product; or

- (i) it consists of the import, disposal or offer to dispose of a patented pharmaceutical product for use by or on a specific patient in Singapore, or the use of that product by or on that patient, where —

- (i) that product is required for use by or on that patient;

- (ii) the relevant authority has granted approval specifically for the import of that product for use by or on that patient; and

- (iii) that product was produced by or with the consent (conditional or otherwise) of the proprietor of the patent or any person licensed by him (and for this purpose “patent” includes a patent granted in any

country outside Singapore in respect of the same or substantially the same product and “licensed” shall be construed accordingly.”; and

(e) by inserting, immediately after subsection (2), the following subsections:

“(2A) Subsection (2)(g) shall not apply to the import of any patented pharmaceutical product by any person (referred to in this subsection and subsection (2B) as the importer) if —

(a) the product has not previously been sold or distributed in Singapore by or with the consent (conditional or otherwise) of the proprietor of the patent or any person licensed by the proprietor of the patent to sell or distribute the product in Singapore;

(b) the import of the product by the importer would result in the product being distributed in breach of a contract between —

(i) the proprietor of the patent; and

(ii) any person licensed by the proprietor of the patent to distribute the product outside Singapore; and

(c) the importer has actual or constructive knowledge of the matters referred to in paragraph (b).

(2B) For the purposes of subsection (2A), where the importer has received a written notice containing the prescribed particulars, he shall be deemed to have constructive knowledge of the matters referred to in subsection (2A)(b).

(2C) For the avoidance of doubt, in subsection (2A), “patent” does not include a patent granted in any country outside Singapore in respect of the same or substantially the same product and “licensed” shall be construed accordingly.”.

Amendment of section 69

21. Section 69 of the Patents Act is amended —

(a) by deleting subsection (3) and substituting the following subsection:

“*(3)* In proceedings for infringement of a patent, the court or the Registrar may, if it or he thinks fit, refuse to award any damages, make an order for an account of profits or grant any other relief (including, in proceedings before the court, an injunction) —

5

(a) in respect of an infringement committed during any further period specified under subsection *(3)* of section 36, but before the payment of the renewal fee and any additional fee prescribed for the purposes of that subsection;

10

(b) where the patent was granted on the basis of any examination report referred to in section 29(5), any search and examination report referred to in section 29(6) or any international preliminary report on patentability referred to in section 30(2)(*b*)(vi), in respect of any infringement alleged to have been committed at any time when any claim (in the specification of the patent) that is alleged to have been infringed is not related to any claim in the application for the patent at the time the report was issued —

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(i) which has been examined; and

(ii) which is referred to in the report; or

(c) where the patent was granted on the basis of the prescribed information relating to a corresponding application referred to in section 29(2)(*c*)(ii) or the prescribed information relating to a corresponding international application referred to in section 29(2)(*d*)(ii), in respect of any infringement alleged to have been committed at any time when any claim (in the specification of the patent) that is alleged to have been infringed is not related to any claim —

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(i) which is set out in the prescribed information relating to the corresponding application or corresponding international application, as the case may be; and

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(ii) which has been examined to determine whether the claim appears to satisfy the criteria of novelty, inventive step (or non-obviousness) and industrial applicability (or utility).”;

- 5 (b) by deleting the words “no damages shall be awarded in proceedings for an infringement of the patent committed before the decision to allow the amendment” in subsection (4) and substituting the words “the court or the Registrar shall not, in proceedings for an infringement of the patent committed before
10 the decision to allow the amendment, award any damages, make an order for an account of profits or grant any other relief (including, in proceedings before the court, an injunction)”;
- (c) by deleting the section heading and substituting the following section heading:

15 **“Restrictions on relief for infringement”.**

Amendment of section 74

22. Section 74 of the Patents Act is amended —

- (a) by deleting the words “Subject to this section, the” in subsection (1) and substituting the word “The”; and
- 20 (b) by deleting the words “shall be made a party” in subsection (3) and substituting the words “need not be made a party”.

Repeal of section 79

23. Section 79 of the Patents Act is repealed.

Amendment of section 80

25 **24.** Section 80(1) of the Patents Act is amended by deleting paragraphs (d) to (g) and substituting the following paragraphs:

“(d) the matter disclosed in the specification of the patent extends beyond that disclosed —

- (i) in the application for the patent, as filed; or
- 30 (ii) where the patent was granted on a new application filed under section 20(3) or 47(4) or section 116(6) of the

Patents Act (Cap. 221, 1995 Ed.), or in accordance with section 26(6), in —

- (A) the earlier application made under this Act;
- (B) the application made under the United Kingdom Patents Act 1977; or
- (C) the application under the European Patent Convention designating the United Kingdom filed at the European Patent Office,

as the case may be, from which the filing date and the right of priority has been derived, as filed;

- (e) an amendment or a correction has been made to the specification of —
 - (i) the patent; or
 - (ii) the application for the patent,
 which should not have been allowed;
- (f) the patent was obtained —
 - (i) fraudulently;
 - (ii) on any misrepresentation; or
 - (iii) on any non-disclosure or inaccurate disclosure of any prescribed material information, whether or not the person under a duty to provide the information knew or ought reasonably to have known of such information or the inaccuracy;
- (g) the patent is one of 2 or more patents for the same invention having the same priority date and filed by the same party or his successor in title.”.

Amendment of section 87

25. Section 87(3) of the Patents Act is amended by deleting the words “section 56 (use of invention for service of the Government) and section 76 (infringement of rights conferred by publication)” and substituting the words “sections 56 and 76.”.

Amendment of section 110

26. Section 110 of the Patents Act is amended by deleting subsection (1) and substituting the following subsection:

5 “(1) The Minister may, after consulting with the Office, make rules to provide for the extension of any period of time specified for the doing of any act in relation to —

- (a) any application for or grant of a patent;
- (b) any proceedings before the Registrar under this Act or the rules; or
- 10 (c) any other matter under this Act or the rules.”.

Repeal and re-enactment of section 111

27. Section 111 of the Patents Act is repealed and the following section substituted therefor:

“Hours of business and excluded days

15 **111.**—(1) The Registrar may issue practice directions to specify —

- (a) the hours of business of the Registry; and
- (b) the days which are to be treated as excluded days.

(2) The Minister may prescribe the effect of doing any business under this Act —

- 20 (a) on any day after the hours of business of the Registry; or
- (b) on any day which is an excluded day.

(3) For the purposes of subsections (1) and (2) —

- (a) different hours of business may be specified for different classes of business;
- 25 (b) different excluded days may be specified for different classes of business; and
- (c) different effects of doing business —
 - (i) outside the hours of business of the Registry; or
 - (ii) on an excluded day,
- 30 may be prescribed for different classes of business.”.

Amendment of section 115

28. Section 115(2) of the Patents Act is amended by deleting the words “form and” in paragraph (a).

New section 115A

5 29. The Patents Act is amended by inserting, immediately after section 115, the following section:

“Forms and directions of Registrar

115A. The Minister may make rules for the publication by the Registrar of —

- 10 (a) the forms to be used for any purpose relating to —
- (i) any application for or grant of a patent;
 - (ii) any proceedings before the Registrar under this Act or the rules; or
 - (iii) any other matter under this Act or the rules; and
- 15 (b) the practice directions issued by the Registrar.”.

New Schedule

30. The Patents Act is amended by inserting, immediately after section 117, the following Schedule:

“THE SCHEDULE

20 Section 2(1)

SUBSTANCES WHICH ARE NOT PHARMACEUTICAL PRODUCTS

1. In this Schedule, unless the context otherwise requires —

25 “Chinese proprietary medicine” means any medicinal product in any dosage form used in the system of therapeutics according to the traditional Chinese method, that is to say, any medicinal product —

- (a) which has been manufactured as a finished product;
- (b) which contains one or more active ingredients which are derived wholly from any plant, animal or mineral or a combination of plants, animals or minerals; and

(c) which is, or all of the active ingredients of which are, described in the current edition of “A Dictionary of Chinese Pharmacy” << 中药大辞典 >>, “The Chinese Herbal Medicine Materia Medica” << 本草纲目 >> or such other publication as may be approved by the Minister,

but does not include —

- (i) any medicinal product to be injected into the human body;
- (ii) any item specified in the Poisons List in the Schedule to the Poisons Act (Cap. 234); or
- (iii) any medicinal product which contains as an active ingredient any chemically defined isolated constituent of any plant, animal or mineral or a combination of plants, animals or minerals;

“current edition”, in relation to any publication which describes a Chinese proprietary medicine, means an edition which is current at the time the Chinese proprietary medicine in question is sold or supplied, and includes any amendment, addition or deletion made to that edition of the publication up to that time;

“homoeopathic medicine” means any substance used in the system of therapeutics in which a disease is treated by the use of minute amounts of one or more substances capable of producing in a healthy human being symptoms similar to those of the disease being treated;

“medicated oil or balm” means any external medicated embrocation, medicated cream, ointment or inhalant which is used mainly for soothing purposes and which contains one or more of the following substances as active ingredients:

- (a) any essential oil;
- (b) any fixed oils derived from a plant;
- (c) methyl salicylate;
- (d) menthol;
- (e) camphor;
- (f) peppermint;

“quasi-medicinal product” means —

- (a) any anti-dandruff preparation;
- (b) any type of medicated cosmetics for the treatment of pimples and acne, except any preparation containing tretinoin or 13-cis-retinoic acid;
- (c) any medicated soap;
- (d) any sweet for relieving coughs or throat irritations;
- (e) any medicated plaster;

- (f) any sunscreen or suntan preparation;
- (g) any medicated beverage;
- (h) any vitamin or nutritional preparation from a natural source; or
- (i) any medicated toothpaste;

5 “traditional medicine” means any medicinal product consisting of one or more substances derived from natural sources, that is to say, any plant, animal or mineral or a combination of plants, animals or minerals, but does not include —

- (a) any medicinal product administered by injection into a human body;
- 10 (b) any vaccine used by a human being;
- (c) any product derived from human blood;
- (d) any item specified in the Poisons List in the Schedule to the Poisons Act (Cap. 234); or
- (e) any Chinese proprietary medicine.

15 2. For the purposes of this Act, “pharmaceutical product” does not include —

- (a) any traditional medicine;
- (b) any homeopathic medicine;
- (c) any quasi-medicinal product;
- (d) any raw material which is used as an ingredient in the preparation or
- 20 manufacture of any medicinal product; or
- (e) any medicated oil or balm.

3. For the avoidance of doubt, for the purposes of this Act, “pharmaceutical product” does not include any substance —

- (a) which is a type of food, a food additive or a food supplement; or
- 25 (b) which occurs naturally in any plant, animal or mineral.”.

Savings and transitional provisions

30 **31.**—(1) Sections 2(a), 3, 5, 6 and 7 shall only apply in relation to an application for a patent with a date of filing on or after the date of commencement of this Act, and sections 26(6), 29, 30, 31 and 32 of the Patents Act in force immediately before that date shall continue to apply to an application for a patent with a date of filing before that date.

(2) Section 4 shall not apply in relation to any application for a patent that is withdrawn before the date of commencement of this Act, and

section 27(1) of the Patents Act in force immediately before that date shall continue to apply to such an application.

(3) Sections 8(b) and 9 shall only apply in relation to a patent granted pursuant to an application for a patent with a date of filing on or after the date of commencement of this Act.

(4) Section 21 shall only apply in relation to a patent granted pursuant to an application for a patent with a date of filing on or after the date of commencement of this Act, and section 69 of the Patents Act in force immediately before that date shall continue to apply to a patent granted pursuant to an application for a patent with a date of filing before that date.

(5) Section 23 shall not apply in relation to a patent granted pursuant to an application for a patent with a date of filing before the date of commencement of this Act, and section 79 of the Patents Act in force immediately before that date shall continue to apply to such a patent.

(6) The Minister may, by order published in the *Gazette*, make such further transitional, savings and other consequential provisions as he may consider necessary or expedient.

EXPLANATORY STATEMENT

This Bill seeks to amend the Patents Act (Cap. 221) —

- (a) to implement certain obligations undertaken by Singapore under the United States-Singapore Free Trade Agreement (USSFTA) concluded in 2003; and
- (b) to modify certain administrative procedures.

Clause 1 relates to the short title and commencement.

Clause 2(a) amends section 2(1) by introducing —

- (a) a definition for the term “corresponding application” in the re-enacted sections 29 and 30 (by clause 5), the new section 36A (inserted by clause 9), the new section 38A (inserted by clause 10) and the amended section 69(3) (by clause 21);
- (b) a definition for the term “corresponding international application” in the re-enacted sections 29 and 30 (by clause 5), the new section 38A (inserted by clause 10) and the amended section 69(3) (by clause 21); and

- (c) a definition for the term “corresponding patent” in the new section 36A (inserted by clause 9).

Clause 2(b) amends section 2(1) by introducing a definition for the term “international preliminary report on patentability” in the re-enacted sections 29 and 30 (by clause 5), the new section 38A (inserted by clause 10) and the amended section 69(3) (by clause 21).

Clause 2(c) amends section 2(1) by introducing —

- (a) a definition for the term “marketing approval” in the new section 36A (inserted by clause 9) and the new section 66(2)(h) (inserted by clause 20); and
- (b) a definition for the term “medicinal product” in the definition of “pharmaceutical product” (inserted by clause 2(d)) and in the new Schedule (inserted by clause 30).

Clause 2(d) amends section 2(1) by introducing —

- (a) a definition for the term “pharmaceutical product” in the new section 36A (inserted by clause 9) and the new section 66(2)(h) and (i) and (2A) (inserted by clause 20); and
- (b) a definition for the term “prescribed form” in the re-enacted section 29 (by clause 5) and the new section 36A (inserted by clause 9), and in existing sections 25, 35 and 80.

Clause 2(e) amends section 2(1) by introducing a definition for the term “relevant authority” in the new section 36A (inserted by clause 9) and the new section 66(2)(i) (inserted by clause 20).

Clause 2(f) amends section 2 by introducing a new subsection (3A) to explain when one claim is to be treated as related to another claim.

Clause 3 amends section 26(6) by bringing forward the time for filing a divisional application to before the conditions in section 30(2) and (3) are satisfied.

Clause 4 amends section 27(1) to clarify that where an application for a patent is withdrawn, it must be withdrawn in the prescribed manner.

Clause 5 —

- (a) repeals and re-enacts section 29 to streamline the procedures for search and examination in applications for patents; and
- (b) repeals and re-enacts section 30 —
 - (i) to incorporate amendments consequential to the repeal and re-enactment of section 29;
 - (ii) to recognise international preliminary reports on patentability introduced by amendments to the Regulations under the Patents Co-operation Treaty;

- (iii) to introduce additional conditions for the grant of a patent; and
- (iv) to consolidate all provisions relating to —
 - (A) the grant of a patent; and
 - (B) the time within which an applicant must comply with the conditions for the grant of the patent,
 within a single section.

Clause 6 amends section 31 to —

- (a) delete and substitute subsection (1) with new subsections (1) and (1A) to expand on the matters considered by the Examiner in his written opinion; and
- (b) delete and substitute subsection (2) to restate when an applicant may amend his application for a patent on his own volition.

Clause 7 repeals section 32, the relevant portions of which have been incorporated in the re-enacted section 30 (by clause 5).

Clause 8 —

- (a) amends section 36(1) by making —
 - (i) a technical amendment; and
 - (ii) an amendment that is consequential upon the enactment of the new section 36A (inserted by clause 9); and
- (b) makes an amendment to section 36(3)(c) that is consequential upon the deletion and substitution of section 56(1) (by clause 14(a)).

Clause 9 inserts a new section 36A to provide for the situations where a proprietor of a patent may apply to the Registrar of Patents (the Registrar) to extend the term of the patent, and for the procedures to be followed in such an application.

Section 36A(1)(a), (2), (3) and (13) enable the proprietor to make the application where there was an unreasonable delay by the Registrar in granting the patent, and prescribe how the period of extension is to be determined. These provisions implement the obligation undertaken by Singapore under Article 16.7.7 of the USSFTA.

Section 36A(1)(b) and (4) enable the proprietor to make the application where —

- (a) the patent was granted on the basis of prescribed information relating to a corresponding application;
- (b) there was an unreasonable delay in the issue of the corresponding patent; and
- (c) the patent office that granted the corresponding patent has extended the term of the corresponding patent on the basis of such delay.

These provisions implement the obligation undertaken by Singapore under Article 16.7.8 of the USSFTA.

Section 36A(1)(c), (5), (6), (7), (8), (9) and (14) —

- (a) enable the proprietor to make the application where the subject of the patent includes any substance which is an active ingredient of a pharmaceutical product, and there has been an unreasonable curtailment of the opportunity to exploit the patent caused by the process of obtaining marketing approval for that pharmaceutical product; and
- (b) prescribe how the period of extension is to be determined.

These provisions implement the obligation undertaken by Singapore under Article 16.8.4(a) of the USSFTA.

Section 36A(10), (11) and (12) prescribe the procedure for an application under the section.

Clause 10 inserts a new section 38A to prescribe the procedures for search and examination in respect of any claim or claims in the specification of a patent that has been granted.

Clauses 11 and 12 make amendments to sections 39(14) and 40(3) respectively that are consequential upon the deletion and substitution of section 56(1) by clause 14(a).

Clause 13 amends section 55 to align the provisions relating to compulsory licences with Article 16.7.6(a) of the USSFTA and Article 31(g) and (k) of the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS).

Clause 13(a) deletes and substitutes section 55(1) and (2) to enable the court to grant a compulsory licence to remedy an anti-competitive practice.

Clause 13(b) makes an amendment to section 55(3) that is consequential upon the deletion and substitution of section 55(1) and (2) by sub-clause (a).

Clause 13(c) and (d) makes technical amendments to section 55(4) that are consequential upon the deletion of paragraph (c) of section 55(4) by sub-clause (e).

Clause 13(e) deletes paragraph (c) of section 55(4). The paragraph was inserted to bring section 55 into conformity with Article 31(f) of TRIPS. With the deletion and substitution of section 55(1) and (2) by sub-clause (a), Article 31(k) of TRIPS permits the deletion of this paragraph.

Clause 13(f) amends section 55(5) to adopt the phraseology used in Article 31(g) of TRIPS.

Clause 13(g) repeals section 55(7). Section 55(7) was inserted to bring section 55 into conformity with Article 31(b) of TRIPS. With the deletion and substitution of section 55(1) and (2) by sub-clause (a), Article 31(k) of TRIPS permits the deletion of section 55(7).

Clause 13(g) also repeals section 55(8), (9) and (12). The deletion of section 55(8) and (9) is consequential upon the deletion and substitution of section 55(1) and (2) by sub-clause (a). The deletion of section 55(12) is consequential upon the deletion of section 55(8).

Clause 14 amends section 56 to restate the circumstances in which it would not be an infringement of a patent for the Government, or any party authorised in writing by the Government, to do anything done in relation to the patented invention.

Clause 14(a) deletes and substitutes section 56(1) to implement the obligations undertaken by Singapore under Article 16.7.6(b) of the USSFTA.

Clause 14(b), (c) and (d) makes consequential amendments to section 56(2).

Clause 14(e) provides a definition for the term “integrated circuit” in the amended section 56(2), and is consequential upon the repeal of section 55(12) by clause 13(g).

Clause 15(a) makes an amendment to section 57(1) that is consequential upon the deletion and substitution of section 56(1) by clause 14(a).

Clause 15(b) makes a technical amendment to section 57(3).

Clause 16 makes amendments to section 58 that are consequential upon the deletion and substitution of section 56(1) by clause 14(a).

Clause 17 repeals section 59 as a consequence of the deletion and substitution of section 56(1) by clause 14(a). The portions of section 59 that are consistent with Article 16.7.6(b) of the USSFTA have been incorporated in the re-enacted section 56(1) (by clause 14(a)).

Clause 18(a) makes an amendment to section 60(1)(c) that is consequential upon the deletion and substitution of section 56(1) by clause 14(a).

Clause 18(b) deletes section 60(3). Section 60(3) was inserted to bring section 56 into conformity with Article 31(b) of TRIPS. With the deletion and substitution of section 56(1) by clause 14(a), Article 31(b) of TRIPS permits the deletion of section 60(3).

Clause 19 repeals and re-enacts section 61 to adopt the phraseology used in Article 31(b) of TRIPS.

Clause 20 amends section 66 to implement certain obligations undertaken, and certain concessions obtained, by Singapore under the USSFTA.

Clause 20(a) and (b) makes technical amendments to section 66(2).

Clause 20(c) amends section 66(2)(g) and clause 20(e) inserts new section 66(2A), (2B) and (2C) to give effect to Article 16.7.2 and footnote 16-10 of the USSFTA. Clause 20(c) also makes a technical amendment to section 66(2)(g).

Clause 20(d) inserts new paragraphs (h) and (i) in section 66(2).

New section 66(2)(h), which permits the doing of any thing in section 66(1) to support any application for marketing approval for a pharmaceutical product, has been drafted in a manner which gives effect to the obligations undertaken by Singapore under Article 16.7.5 of the USSFTA.

New section 66(2)(i) allows certain types of dealings in a patented pharmaceutical product if —

- (a) the product is required for the eventual use of any specific patient in Singapore;
- (b) the relevant authority in Singapore has approved of such use; and
- (c) the product was produced by or with the consent of the proprietor of the patent or any person licensed by him.

Clause 21 amends section 69(3) and (4) to allow the court or the Registrar to decline to award damages, make an order for an account of profits or grant any relief (including, in proceedings before the court, an injunction) in certain circumstances.

Clause 22 amends section 74 to implement the obligations undertaken by Singapore under Article 16.9.7 and footnote 16-15 of the USSFTA.

Clause 23 repeals section 79 and is consequential upon the repeal and re-enactment of section 29 (by clause 5).

Clause 24 —

- (a) makes a technical amendment to section 80(1)(d);
- (b) amends section 80(1)(e) to allow the revocation of a patent on the ground that an amendment or correction has been made to the specification of the patent or the application for the patent which should not have been allowed;
- (c) deletes the existing section 80(1)(f) as a consequence of the repeal and re-enactment of section 29 by clause 5, and inserts a new section 80(1)(f) to allow the revocation of a patent that was obtained fraudulently, on any misrepresentation, or on any non-disclosure or inaccurate disclosure of prescribed material information, as allowed under Article 16.7.4 of the USSFTA; and
- (d) deletes the existing section 80(1)(g) as a consequence of the enactment of the new section 80(1)(f), and inserts a new section 80(1)(g) to allow the revocation of a patent where the patent is one of 2 or more patents for the same invention having the same priority date and filed by the same party or his successor in title, so as to be consistent with the re-enacted section 30(3)(e).

Clause 25 makes technical amendments to section 87(3).

Clause 26 amends section 110(1) to restate what the Minister may make rules for the extension of time for.

Clause 27 repeals and re-enacts section 111 —

- (a) to allow the Registrar to issue practice directions to specify the hours of business of the Registry and the days which are to be treated as excluded days; and
- (b) to allow the Minister to prescribe the effect of doing any business under the Act outside the hours of business of the Registry or on an excluded day.

Clause 28 makes an amendment to section 115(2) that is consequential to the enactment of new section 115A (by clause 29).

Clause 29 inserts a new section 115A to allow the Registrar —

- (a) to publish the forms to be used for any purpose relating to any application for or grant of a patent, any proceedings before the Registrar and any other matters under the Act or the rules; and
- (b) to issue practice directions.

Clause 30 inserts a new Schedule to identify the substances and classes of substances that do not fall within the definition of “pharmaceutical product” (inserted in section 2(1) by clause 2(d)).

Clause 31 contains savings and transitional provisions.

EXPENDITURE OF PUBLIC MONEY

This Bill will involve the Government in extra financial expenditure, the exact amount of which cannot at present be ascertained.
