

# The Intellectual Property Amendment (2021) Bill: Simplifying and Streamlining Intellectual Property Processes

## I. Introduction

1. Further to the public consultation on the proposed changes to the various IP legislation to simplify and streamline IP processes and improve user experience with digital initiatives in August 2020, the Intellectual Property Office of Singapore (the “**IPOS**”) now seeks to implement those legislative changes to give effect to the intended policies.
2. This e-briefing sets out the proposed legislative changes to the patents, trade marks, registered designs and plant varieties protection regimes, as well as the proposed legislative changes that are common across multiple IP regimes. More information on the foregoing can be found at [https://www.ipos.gov.sg/docs/default-source/default-document-library/public-consultation-ip-\(amendment\)-bill.pdf](https://www.ipos.gov.sg/docs/default-source/default-document-library/public-consultation-ip-(amendment)-bill.pdf).

## II. Patents

3. The proposed legislative changes to the patents regime are as follows:-

| S/N | Item  | Summary of Proposed Legislative Changes   |
|-----|---|---|
| 1   | Introducing express provisions in respect of submission of sequence listing   | <ol style="list-style-type: none"> <li>a. To specify that when a patent specification discloses a sequence listing, the furnishing of the sequence listing shall be mandatory. The format of the sequence listing shall be specified in the Practice Directions.</li> <li>b. If the sequence listing is not provided or not provided in the format as indicated in the Practice Directions, the Registrar may invite the applicant to furnish the sequence listing presented in a manner that complies with the Practice Directions for the purposes of search.</li> </ol>  |
| 2   | Removing the obligation to furnish prescribed documents in certain prescribed circumstances during the patent prosecution process | <ol style="list-style-type: none"> <li>a. If the document in respect of the earlier relevant application has been previously filed at the Registry, applicants need not provide a copy of the earlier relevant application or its English translation when making a request to:-               <ol style="list-style-type: none"> <li>i. Incorporate the description in the patent application by reference;</li> <li>ii. File the missing parts; or</li> <li>iii. Support the declaration of a claim of right of priority.</li> </ol> </li> <li>b. If the Registrar had earlier sent a copy of the final result of the search or final result of the international search report in English language to the applicants, applicants need not provide the copy of the search result when making a request for an examination report</li> </ol> |
| 3   | Clarifying existing provisions  | <ol style="list-style-type: none"> <li>a. To clarify the application of section 29(1)(a) of the Patents Act (i.e. request for a search report) in relation to divisional applications.</li> </ol>   |

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| 4 | Inviting amendment to an application in lieu of a written opinion   | <p>a. At any time before the examination process is concluded, if the Examiner is of the opinion that the matter could be resolved by a notice to the applicant inviting amendment to the application without a written opinion, such notice will be issued in lieu of a written opinion.</p> <p>b. The notice is only applicable in relation to a request for a search and examination report and a request for an examination report.</p> <p>c. The response to the notice must be made within the prescribed period of two months (non-extendable) and in the prescribed manner.</p> |
| 5 | Refining the examination review process   | <p>a. During an examination review, if an applicant amends the specification for the purpose of overcoming all unresolved objections in the earlier examination report, the Examiner will not be required to agree or disagree with the objections raised in the earlier examination report.</p> <p>b. The Examiner will only need to assess whether the amendments have overcome the objections in the earlier examination report.</p>   |
| 6 | Removing the form and accompanying fee for publication of international patent application in English             | <p>a. To remove the requirement for applicants to file a form and pay a fee for the publication of the English translation of a non-English international patent application that has entered national phase in Singapore.</p> <p>b. Subject to the 18-month publication period or any request for early publication, the Registrar will publish the English translation automatically if the English translation has been filed at the Registry.</p>   |
| 7 | Providing express power for Registrar to make documents for published patent applications available to the public | <p>a. In 2017, IPOS launched the Patents Open Dossier to provide the public with easier access to certain patent documents.</p> <p>b. To make it clear that IPOS can now make such documents publicly available without any request being made except where certain restrictions apply (e.g. where documents are to be treated as confidential).</p>  |

### III. Trade Marks

4. The proposed legislative changes to the trade marks regime are as follows:-

| S/N | Item  | Summary of Proposed Legislative Changes   |
|-----|---|---|
| 1   | Clarifying the period that an expired mark is regarded as an earlier trade mark | <p>a. To clarify that insofar as a registered trade mark is eligible to be renewed or restored, it would be regarded as an earlier trade mark.</p> <p>b. To clarify that an earlier trade mark that is an international trade mark (Singapore) will continue to be regarded as an earlier trade mark until IPOS receives the notification in case of non-renewal from the International Bureau.</p> |
| 2   | Introducing partial refusal mechanism for national trade mark applications      | <p>a. To introduce the "partial refusal" mechanism to national trade mark applications. Under the "partial refusal" mechanism, the Registrar may allow a partially refused national trade mark application to proceed to publication</p>  |

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|   |   | <p>even if no response is provided by the prescribed period.</p> <p>b. This means that only the goods and/or services that do not meet the requirements for registration will be treated as withdrawn while the remaining goods and/or services can proceed to publication.</p>  |
| 3 | Implementing “continued processing” for trade mark applications that are treated as withdrawn | <p>a. A trade mark application will be treated as withdrawn if the applicant fails to comply with the deadline to respond to the Registrar’s written notice.</p> <p>b. To enable the trade mark applicant to file a request within two months (non-extendable) from the date the application is treated as withdrawn to continue the processing of the application.</p> <p>c. The request must be accompanied by the document or thing, the omission of which, led to the lapsed deadline.</p> |

#### IV. Registered Designs

5. The proposed legislative changes to the registered designs regime are as follows:-

| S/N | Item   | Summary of Proposed Legislative Changes  |
|-----|--|--|
| 1   | Clarifying legislation in respect of set of articles and non-physical products | <p>a. The definition of “article” includes any set of articles while the definition of “non-physical product” includes any set of non-physical products. However, these two definitions do not cover “sets of articles and non-physical products”.</p> <p>b. To cover “sets of articles and non-physical products” for references to “articles and non-physical products”.</p>   |
| 2   | Introducing express legal effect to disclaimer                                 | <p>a. Currently, an applicant or a proprietor may voluntarily indicate a disclaimer to restrict rights conferred to a registered design.</p> <p>b. To remove any ambiguity as to the legal effect of such a disclaimer. The Registrar may issue Practice Directions to specify the requirements in relation to how a disclaimer would be presented. A disclaimer in respect of a registered design shall be entered in the Register.</p> |

#### V. Plant Varieties Protection

6. The proposed legislative changes to the plant varieties protection regime are as follows:-

| S/N | Item   | Summary of Proposed Legislative Changes   |
|-----|--|---|
| 1   | Amending the definition of “Examiner”  | <p>a. To amend the definition of “Examiner” to include person, organisation or entity (including an international plant variety office or organisation, or a plant variety office or an organisation of a country or territory other than Singapore) appointed by the Registrar for the purpose of referring any question or matter relating to the examination of a plant variety for a grant of protection.</p> |
| 2   | Extending of period to furnish information, document or propagating material for examination | <p>a. To enable the Registrar or the Examiner to extend the period for an applicant to furnish requested information, document or propagating material to the Registrar or the Examiner for the purpose of examination.</p>   |

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| 3 | Shifting of technical information from the Act to the Rules in respect to Plant Varieties Protection Journal                                       | <p>a. To enable the Registrar to determine the frequency of journal publication instead of having it set at a regular interval.</p> <p>b. To shift rules relating to information to be published in the journal from the Act to the Rules.</p>   |
| 4 | Maintaining the term of grant of protection via late payment of annual fee and clarifying existing provision in relation to when annual fee is due | <p>a. Currently, to maintain the term of grant of protection, a proprietor may request for extension of time (discretionary) not exceeding four months to make payment for annual fee.</p> <p>b. To enable a proprietor to make late payment of annual fee (as of right) six months (non-extendable) from that anniversary of the date of the grant of protection.</p>   |
| 5 | Providing an option for breeder to conduct a Distinct, Uniform, Stable (the "DUS") test and submit the results                                     | <p>a. "Breeder testing" is one of the cooperation modes endorsed by the International Union for the Protection of New Varieties of Plants. This mode gives an applicant the option to cooperate with the Registrar and the Examiner to support the examination process. The breeders will conduct a Distinct, Uniform, Stable (the "DUS") test and submit the test results to the Registrar or the Examiner for verification.</p> <p>b. The Registrar or the Examiner will then conduct independent examinations based on the DUS test results to ensure that the plant varieties satisfy the requirements for grant.</p> <p>c. For the purpose of examination, propagating materials of the candidate variety need not be given to the Registrar or the Examiner unless upon request. "Breeder testing" will complement the examination process of plant varieties.</p> |

## VI. Cross-IP Amendments

7. The proposed legislative changes that are common across multiple IP regimes are:-

| S/N | Relevant IP  | Item  | Summary of Proposed Legislative Changes  |
|-----|--|---|--|
| 1   | <p>a. Trade Marks</p> <p>b. Registered Designs</p> | Mandating the provision of priority application number for a claim of right of priority | <p>a. To require that the priority application number be provided when an application which has a claim of right of priority is made so as to provide greater certainty to applicants and third parties on the validity of such a claim.</p> <p>b. The priority application number must be furnished within a prescribed or specified period, failing which the claim of right of priority will be disregarded.</p> <p>c. Relief measures in the form of extension of time and reinstatement requests will be available for a claim of a right of priority in the Registered Designs legislation. No relief measure will be provided for a claim to right of</p> |

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|   |   |   | priority in the Trade Marks legislation.   |
| 2 | <ul style="list-style-type: none"> <li>a. Patents</li> <li>b. Trade Marks</li> <li>c. Registered Designs</li> <li>d. Geographical Indications</li> <li>e. Plant Varieties Protection</li> </ul> | Empowering the Registrar to advertise or publish proposed corrections for opposition purposes | <ul style="list-style-type: none"> <li>a. To give the Registrar the discretion to advertise or publish, for opposition purposes, a proposed correction to the name or other particular of an applicant or IP owner or any information pertaining to a priority application under such IP.</li> <li>b. Upon advertisement or publication of the proposed correction, third parties will have the opportunity to file a notice of opposition against the proposed correction within two months.</li> </ul> |
| 3 | <ul style="list-style-type: none"> <li>a. Patents</li> <li>b. Trade Marks</li> <li>c. Registered Designs</li> <li>d. Geographical Indications</li> <li>e. Plant Varieties Protection</li> </ul> | Shifting of provisions stipulating time periods from the Act to the Rules                     | <ul style="list-style-type: none"> <li>a. To shift provisions that stipulate time periods from the Act to the Rules for purpose of enabling IPOS to be more nimble in responding to business trends and needs.</li> </ul>  |
| 4 | <ul style="list-style-type: none"> <li>a. Patents</li> <li>b. Trade Marks</li> </ul>  | Standardising the references of “company” or “corporations”                                   | <ul style="list-style-type: none"> <li>a. To amend references of “company” or “corporation” to the term “body corporate” for the purpose of adopting a consistent reference within the Patents and Trade Marks legislation and with the other IP legislation.</li> </ul>   |

## VII. Conclusion

8. In light of the proposed changes to the various IP legislation, applicants and IP owners can expect shorter IP prosecution timelines and greater costs savings when seeking IP protection moving forward. By simplifying and streamlining IP processes, IPOS’ turnaround time for the examination of IP applications is likely to be even shorter, and applicants and IP owners can obtain IP protection with even less hassle, thereby further strengthening Singapore’s IP regime and position as a global IP hub.
9. Should you require advice on managing your IP portfolios, our IP team at Harry Elias Partnership would be pleased to assist you. Working closely with our network of associate firms, we are also well versed and have a breadth of experience handling IP matters across numerous jurisdictions.

**For further information, contact:**

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