

Image courtesy of Shutterstock.

“If at first the idea is not absurd, then there is no hope for it.”

Albert Einstein



DRIVING THE FUTURE ECONOMY WITH INNOVATION AND IP

PATENTS (AMENDMENT) BILL 2017

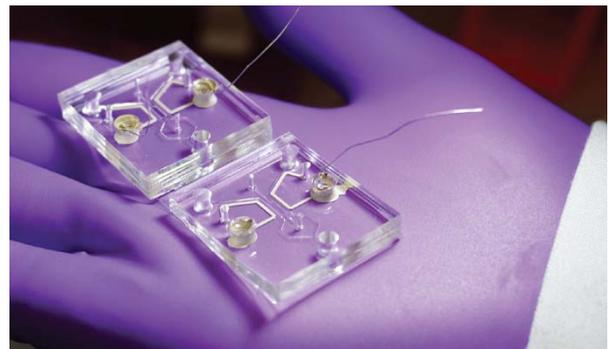
A note from Indranee Rajah S.C., Senior Minister of State for Law

Okay, so maybe Einstein was being a bit extreme. But that’s the essence of innovation. The ultimate innovation is the sort which is so new, so out there, that the very idea of it seems absurd. Until someone makes it a reality.

Innovation is about creating the new. It’s also about finding new ways to do the old. Or making breakthroughs which completely sweep away the old.

Innovation drives economic activity and growth. It generates new products and services. Innovative businesses have a competitive edge. They stay ahead of their rivals. That’s why enabling innovation is one of the 7 strategies identified by the Committee for the Future Economy. Read about the 7 Strategies at www.gov.sg/microsites/future-economy.

Innovation is one thing. But protecting one’s innovation and monetising it is quite another. Here’s where IP comes in. Hitherto, IP has played more of a supporting role. But in an innovation-driven economy, IP really comes into its own.



Singapore-MIT Alliance for Research and Technology (SMART)’s unique microfluidic device enables the application of Tumour Treating Fields (i.e. alternating electric fields) on cancer cells in a 3D environment. This holds promise for the specific treatment of a patient’s cancer cell, making customised treatment possible. Image courtesy of SMART.

As such, we have enhanced our patent system to better support innovation. The Patents (Amendment) Bill (“the Bill”) was passed in Parliament on 28 February 2017. The Bill can be found at statutes.agc.gov.sg. The full text of my Second Reading speech in Parliament can be found at www.mlaw.gov.sg.

GRACE PERIOD WILL APPLY TO ALL INVENTORS' PUBLIC DISCLOSURES

In order to be granted patent protection, an invention must be “new” and “inventive”. Whether it is “new” and “inventive” is measured against the existing “state of the art”. Public disclosure of an invention before a patent application is filed could result in it becoming part of the existing state of the art, and hence being rendered not “new” and “inventive” when a patent application is subsequently filed and examined.

However, in commercialising their inventions, inventors do sometimes need to disclose their inventions, e.g. to potential investors or customers, or to a wider community of experts, prior to a patent application.

The Patents Act currently provides a 12-month grace period within which inventors can still file a patent application and obtain patent protection after certain limited public disclosure situations (e.g. exhibitions and learned society publications)

The amendments expand the situations covered by the grace period. Now any public disclosure by the inventor within the 12-month period will be covered, not just disclosures at exhibitions or learned society publications.

This brings us in line with the US, Australia, Japan and Korea.

However, as not all jurisdictions have a similarly broad grace period, inventors still need to be careful and consider whether disclosure prior to a patent application could result in loss of protection in jurisdictions with shorter grace periods or without a grace period.

CLOSURE OF FOREIGN ROUTE

Currently, patent applications filed in Singapore can rely on search and examination reports by foreign patent offices.

Come January 2020, this “foreign route” will be closed. When this change comes into effect, applications will only be able to go through either:



Razer’s Project Valerie, the world’s first triple display laptop, on display at CES 2017. Image courtesy of Razer.



An IPOS-issued patent certificate. Image courtesy of IPOS.

- (a) the “local route” where both the search and examination are done by IPOS; or
- (b) the “mixed route”, where the search is done by a foreign office but the examination is done by IPOS.

We decided to close the “foreign route” as different patent offices can have different standards of patentability. This can lead to patent grants even when Singapore’s patentability standards are not fully met. This amendment will ensure greater consistency of quality, and increase the level of confidence in our patent system.



NSP Tech’s SAFETiCET promises a safe and painless blood testing experience and has been awarded several IP awards internationally and locally, including the WIPO-IPOS 2016 award for technology patent. Image courtesy of NSP Tech.

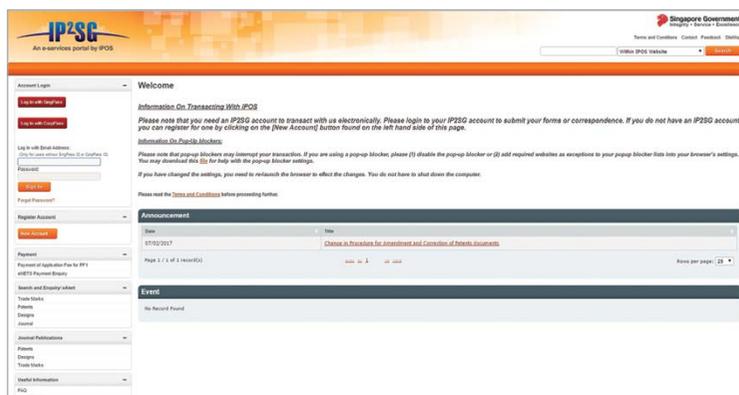
PROCEDURAL CHANGES FOR FLEXIBILITY AND EFFICIENCY

We will enhance the patent application process to give applicants greater flexibility in switching between search and examination routes.

Currently, applicants can only request to switch route in the limited period between receiving a written opinion and responding to it.

With the amendments, a request to switch route can now be made at any time before the Examination Report, Search and Examination Report, or Supplementary Examination Report is issued.

A further amendment, for operational efficiency, allows IPOS to treat an application as abandoned if, after receiving a Search Report, the applicant does not request an Examination Report within the stated deadline.



IPOS’ integrated electronic platform, IP2SG, allows users to search and apply for IP rights in one location. Image courtesy of IPOS.

WHAT THE AMENDMENTS MEAN IN PRACTICAL TERMS

In light of these amendments, IP practitioners may wish to assist their clients to manage their inventions and guide their patenting strategies. In particular:

- (a) Practitioners should remind their clients that while the 12-month grace period in Singapore now covers all public disclosures, such public disclosure could still jeopardise their

applications in other jurisdictions with shorter grace periods or without a grace period. Practitioners may wish to assist their clients to obtain advice on jurisdictions of interest (e.g. key markets and manufacturing sites), and help clients adjust their patenting strategies accordingly.

- (b) Practitioners should advise patent applicants of the situations in which they can take advantage of the additional flexibility in switching between search and examination routes.
- (c) Patent applicants need to be mindful of the deadline to request an Examination Report, or risk the application being treated as abandoned.

After the “foreign route” is closed in January 2020, all Singapore patent applications must undergo substantive examination at IPOS. Local search and examination related work will consequently increase. IP practitioners should consider beforehand whether your firms have sufficient capacity and people to meet the anticipated increase in workload, and deepen your patent expertise ahead of time in readiness to handle such work.

*– Indranee Rajah S.C., Senior Minister of State for Law
28 March 2017*