

## **SINGAPORE IP LEGISLATION UPDATE**



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# SINGAPORE PATENTS, REGISTERED DESIGNS AND COPYRIGHT LEGISLATION UPDATE

Recently, there have been amendments to the Singapore Patents Act and Rules, Registered Designs Act and Rules, and the Copyright Regulations. These came into effect on 30 October 2017.

In this note, we highlight the significant amendments.

## **THE PATENTS ACT AND PATENTS RULES**

The significant amendments to our patents law are:

1. restricting the foreign route option for search and examination to patent applications filed before a prescribed date;
2. broader exceptions in relation to public disclosure of the invention prior to a patent application; and
3. procedural amendments to improve the application process.

### **Restricting the foreign route for search and examination to patent applications filed before a prescribed date**

Prior to the amendments, applicants may proceed to grant by using the local, foreign or mixed search and examination routes. With the amendments, the option of proceeding through the foreign route, *i.e.* supplementary examination based on a search and examination report issued by a foreign patent office, will be restricted to an applicant whose application is filed before a prescribed date. This effectively removes the option of reliance on the foreign route for applications filed after the prescribed date.

Essentially, there will now be only 3 routes to grant for applications filed after the prescribed date:

- (a) file a Request for Search by 13 months, followed by filing a Request for Examination by 36 months;
- (b) file a Request for Search and Examination by 36 months; or
- (c) file a Request for Examination by 36 months, by relying on the search report of a corresponding application, corresponding international application, related national phase application or the parent PCT application.

These routes ensure that all granted patents satisfy the patentability criteria under Singapore patents law. This is unlike the foreign route which places reliance on the search and examination report issued by a foreign patent office and may apply different patentability criteria.

The prescribed date is 1 January 2020.

### **Broader exceptions in relation to public disclosure of the invention**

An invention which has been disclosed to the public before a patent application will be considered as part of the “state of the art” (i.e. not novel), unless any of the exceptions under the Patents Act applies.

Previously, the exceptions allow the disclosure of an invention due to:

- (a) the matter therein being obtained unlawfully, or in breach of confidence;
- (b) the inventor displaying the invention at an international exhibition; or
- (c) the reading or publishing of the invention in a paper with his consent before any learned society,

within 12 months of the filing date. Now, any public disclosure made by the inventor or by a person who obtained the matter directly or indirectly from the inventor within 12 months from the filing date is also allowed. This exception however does not apply to the disclosure of an invention due to the publication of a patent application, unless

- (a) the application was filed without the consent of the inventor by the person who obtained the matter directly or indirectly from the inventor;
- (b) the application was published in error by reason of the application having been withdrawn, refused or abandoned before the publication date; or
- (c) the application was published prematurely under the law of the country governing the application.

Where the publication is premature, the invention shall be treated as disclosed to the public on the date when the publication should have occurred under the law of the country governing the application.

Despite the broader exceptions, applicants are advised to avoid disclosing their inventions before the filing date as the laws and practices on disclosure are different in other countries.

### **Procedural amendments targeted to improve the application process**

These amendments enable:

- (a) greater flexibility for applicants to switch between a substantive examination route or a supplementary examination route at any time provided that:
  - (i) the earlier request for substantive or supplementary examination is withdrawn; or
  - (ii) the examination report or supplementary examination report is not yet issued; and
- (b) the treatment of an application as abandoned unless the relevant examination report, search and examination report or supplementary examination report has been requested within the applicable prescribed period.

## **THE REGISTERED DESIGNS ACT AND REGISTERED DESIGNS RULES**

The significant amendments to our registered designs law are:

1. broader scope of protection for designs;
2. default ownership of designs by the designer rather than the commissioning party;
3. extended grace period for public disclosure of designs; and
4. procedural amendments to improve the application process.

### **Broader scope of protection for designs**

Prior to the amendments, it is not clear if designs of handcrafted items, including handmade jewellery, are registrable. This has been clarified, as the definition of “article” has been amended to include “any thing that is manufactured (whether by an industrial process, by hand or otherwise)”.

The amendments to the definition of “design” also provide a broader scope of protection. Colours can now be considered to be a design feature and the design features can be applied not only to an article but also to a “non-physical product”. An example of a non-physical product is a light-projected keyboard which works like a physical keyboard.

### **Default ownership of designs by the designer rather than the commissioning party**

In the context of a commissioned design, the previous position was that the ownership of the design vests in the party who commissioned the designer to create it. This position has now been changed so that the default owner of a commissioned design is the designer, subject to any agreement in writing to the contrary.

### **Extended grace period for public disclosure of designs**

Previously, the exceptions provided in the Act were narrow, being limited to, for instance, public disclosure within 6 months of the filing date.

With the amendments, the grace period is extended to 12 months.

However, applicants are advised to be aware that this extended grace period may not be applicable in other countries.

### **Procedural amendments to improve the application process**

The amendments enable:

- (a) the application for the registration of 2 or more designs in one application; and
- (b) the correction of non-compliance with certain formal requirements of an earlier application for registration by filing one or more new applications, which will be treated as filed on the date of filing of the earlier application.

## **THE COPYRIGHT REGULATIONS**

The significant amendments to the regulations relate to the definitions of “articles” and “design”, as well as the introduction of “non-physical product” in the Registered Designs Act. Also, the regulations were amended to deal with circumstances in which a design is “deemed to be applied industrially”. This is to avoid the overlap between the registered designs and copyright protection.

### **Further Information**

If you have any query, please do not hesitate to contact the Intellectual Property Department, Lee & Lee. The contact persons are Mr Tan Tee Jim, S.C. at DID: +65 65574615 / email: [tanteejim@leenlee.com.sg](mailto:tanteejim@leenlee.com.sg); and Ms Boo Yee Swan at DID: +65 65574869 / email: [booyeeswan@leenlee.com.sg](mailto:booyeeswan@leenlee.com.sg). You can also reach us by fax at 65 63241638.

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