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**Notification No. B 28** — The Patents (Amendment) Bill is hereby published for general information. It was introduced in Parliament on the 25th day of July 2001.

# Patents (Amendment) Bill

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**Bill No. 28/2001.**

*Read the first time on 25th July 2001.*

A BILL

*intituled*

An Act to amend the Patents Act (Chapter 221 of the 1995 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 2001  
5 and shall come into operation on such date as the Minister may, by notification in the *Gazette*, appoint.

## **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”, the following definition:

“ “country” includes —

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- (a) a colony, protectorate or territory subject to the authority or under the suzerainty of another country; or

- (b) a territory administered by another country under the trusteeship of the United Nations;”;

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- (b) by inserting, immediately after the definition of “journal”, the following definition:

“ “legal officer” means a person appointed as a legal officer in the Singapore Legal Service;”;

- (c) by deleting the word “kept” in the 2nd line of the definition of “register” and substituting the word “maintained”.

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## **Amendment of section 17**

### **3. Section 17 of the Patents Act is amended —**

- (a) by deleting the words “specified under section 89” in the 2nd line of subsection (5) (b); and

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- (b) by inserting, immediately after subsection (5), the following subsection:

“(6) In subsection (5), “convention country” means —

- (a) a country other than Singapore that is a party to the Paris Convention or a member of the World Trade Organisation; or

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- (b) any other country with which Singapore has entered into a treaty, convention, arrangement or engagement and which is declared by the Minister, by order published in the *Gazette*, as a convention country.”.

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## **Amendment of section 26**

### **4. Section 26 of the Patents Act is amended —**

- (a) by deleting the words “and one or more claims whether or not the description or the claim or claims” in the 2nd and

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3rd lines of subsection (1) (c) and substituting the words “whether or not the description”; and

(b) by inserting, immediately after subsection (7), the following subsection:

5           “(8) An application for a patent shall be treated as having been abandoned at the end of the prescribed period unless before that period ends the applicant files one or more claims for the purposes of the application.”.

### **Amendment of section 28**

10   **5.** Section 28 of the Patents Act is amended by deleting subsection (1) and substituting the following subsection:

          “(1) Where —

          (a) an application for a patent has a date of filing;

15           (b) the application is not withdrawn or treated as having been abandoned; and

          (c) one or more claims for the purposes of the application have been filed in accordance with section 26 (8),

20           the Registrar shall, as soon as practicable after the end of the prescribed period, examine the application so as to determine whether the application complies with those requirements of this Act and the rules which are designated by the rules as formal requirements for the purposes of this Act.”.

### **Amendment of section 29**

**6.** Section 29 of the Patents Act is amended —

25           (a) by inserting, immediately after the words “furnish such detail as prescribed” in the 5th and 6th lines of subsection (1) (c), the words “in the prescribed form”; and

          (b) by inserting, immediately after the word “file” in the 3rd line of subsection (4), the words “in the prescribed form,”.

### **Amendment of section 35**

**7.** Section 35 of the Patents Act is amended —

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

35           “(1) As soon as practicable after a patent has been granted under this Act, the Registrar shall —

- (a) send to the proprietor of the patent a certificate in the prescribed form that the patent has been granted to the proprietor; and
- (b) publish in the journal a notice that the patent has been granted.”; and 5
- (b) by deleting the words “subsection (1)” in the 2nd line of subsection (3) and substituting the words “subsection (1) (b)”.

### **Amendment of section 36**

#### **8. Section 36 of the Patents Act is amended —**

- (a) by deleting the words “on which notice of its grant is published in the journal” in the 3rd and 4th lines of subsection (1) and substituting the words “of issue of the certificate of grant”; and 10
- (b) by deleting subsection (4) and substituting the following subsection: 15

“(4) Rules shall include provision requiring the Registrar to notify the registered proprietor of a patent that a renewal fee has not been received from him in the Registry before the end of the prescribed period and before the framing of the notification.”. 20

### **Amendment of section 42**

#### **9. Section 42 of the Patents Act is amended by deleting subsection (1) and substituting the following subsection:**

“(1) The Registrar shall maintain a register of patents in accordance with the rules made by virtue of this section.”. 25

### **Amendment of section 66**

**10.** Section 66 (3) of the Patents Act is amended by deleting the words “other than Singapore which is a party to the Paris Convention” in the 4th and 5th lines and substituting the words “, other than Singapore, which is a party to the Paris Convention or a member of the World Trade Organisation”. 30

### **Amendment of section 79**

**11.** Section 79 (2) of the Patents Act is amended by deleting the words “available at the Registry” in the 3rd line and substituting the words “in the Registrar’s possession or control”.

### **5 Repeal of section 89**

**12.** Section 89 of the Patents Act is repealed.

### **Amendment of section 94**

**13.** Section 94 of the Patents Act is amended —

10 (a) by deleting the words “or, subject to section 105, by any other person whom he desires to represent him” in the penultimate and last lines of subsection (1);

(b) by inserting, immediately after subsection (1), the following subsection:

15 “(1A) The Government may be represented by a legal officer in any proceedings before the Registrar under this Act or any treaty to which Singapore is a party.”; and

(c) by deleting the words “and a registered patent agent shall each” in the 3rd line of subsection (2) and substituting the word “shall”.

### **20 Repeal and re-enactment of Part XIX**

**14.** Part XIX of the Patents Act is repealed and the following Part substituted therefor:

#### **“PART XIX**

#### **PATENT AGENTS**

#### **25 “Registration of patent agents**

**104.—**(1) The Minister may make rules for the registration of individuals as patent agents.

(2) Without prejudice to the generality of subsection (1), the rules may provide —

30 (a) for the keeping, by such person as the Minister may determine, of a register of patent agents;

- (b) for the form and manner of application for registration as a patent agent, the qualifications and other requirements for registration, the fees payable for registration, and the conditions of registration;
- (c) for the issue of practising certificates to registered patent agents; 5
- (d) for the correction of errors and updating of entries in the register of patent agents; and
- (e) for transitional matters in relation to the registration of individuals as patent agents, and exclude or vary the operation of this Act in relation to such transitional matters. 10

(3) The rules may make provision to regulate the professional conduct of registered patent agents and their practice and, for that purpose, may make provision for and in relation to all or any of the following: 15

- (a) making complaints against registered patent agents and hearing and deciding upon such complaints;
- (b) imposing penalties on registered patent agents, including issuing a reprimand, and suspending or cancelling registration; 20
- (c) summoning witnesses;
- (d) receiving evidence from persons on oath or affirmation;
- (e) administering oaths or affirmations to persons giving evidence; 25
- (f) requiring persons to produce documents or articles;
- (g) restoring any registration that has been cancelled and lifting the suspension imposed on any registration.

(4) The rules may provide that a contravention of the rules shall be an offence and may provide penalties not exceeding a fine of \$5,000 or imprisonment for a term not exceeding 12 months or to both. 30

### **Persons entitled to act as patent agents, etc.**

**105.—**(1) An individual shall not carry on a business, practise or act as a patent agent unless he is a registered patent agent, or an advocate and solicitor, who has in force a practising certificate. 35

(2) A partnership shall not carry on a business, practise or act as patent agents unless at least one partner is a registered patent agent, or an advocate and solicitor, who has in force a practising certificate.

5 (3) A body corporate shall not carry on a business, practise or act as a patent agent unless at least one director is a registered patent agent, or an advocate and solicitor, who has in force a practising certificate.

10 (4) For the purposes of this section, a person is taken to carry on a business, practise or act as a patent agent if, and only if, the person does, or undertakes to do, on behalf of someone else, any of the following in Singapore for gain:

- (a) applying for or obtaining patents in Singapore or anywhere else;
- 15 (b) preparing specifications or other documents for the purposes of this Act or the patent law of another country; or
- (c) giving advice (other than advice of a scientific or technical nature) about the validity, or infringement, of
- 20 patents.

(5) An individual shall not —

- (a) carry on a business under any name or other description which contains the words “patent agent”; or
- 25 (b) in the course of a business otherwise describe himself, hold himself out or permit himself to be described or held out as a “patent agent”,

unless he is a registered patent agent who has in force a practising certificate.

(6) A partnership shall not —

- 30 (a) carry on a business under any name or other description which contains the words “patent agent”; or
- (b) in the course of a business otherwise describe itself, hold itself out or permit itself to be described or held out as a firm of “patent agents”,

35 unless at least one partner is a registered patent agent who has in force a practising certificate.



(7) A body corporate shall not —

- (a) carry on a business under any name or other description which contains the words “patent agent”; or
- (b) in the course of a business otherwise describe itself, hold itself out or permit itself to be described or held out as a “patent agent”,

unless at least one director is a registered patent agent who has in force a practising certificate.

(8) Any person who contravenes this section shall be guilty of an offence and shall be liable on conviction to a fine not exceeding \$5,000 or to imprisonment for a term not exceeding 12 months or to both.

(9) Where subsection (5), (6) or (7) would be contravened by the use of the words “patent agent” in reference to an individual, partnership or body corporate, it is equally contravened by the use of the expression “patent attorney” in reference to that person, or his business or place of business, or any other expression in reference thereto which is likely to be understood as indicating that he is entitled to be described as a “patent agent”.

(10) An individual does not contravene subsection (1) in respect of anything done, or undertaken to be done, by that individual in the capacity of employee for —

- (a) in any case, the individual’s employer; or
- (b) if the individual’s employer is a member of a related company group, another member of the group.

(11) A legal officer does not commit an offence against subsection (1) in respect of anything done, or undertaken to be done, by him on behalf of the Government.

(12) A body corporate that is a member of a related company group does not contravene subsection (3) in respect of anything done, or undertaken to be done, by the body corporate for another member of the group.

(13) This section shall not be construed as prohibiting an advocate and solicitor from taking part in proceedings relating to patents and applications for patents and, in particular, shall not derogate from section 94 as it applies to advocates and solicitors.

(14) No offence is committed under section 33 of the Legal Profession Act (Cap. 161) by any person by reason only of the preparation by him of a document (other than a deed) for use in proceedings before the Registrar in relation to any patent or application for a patent.

(15) For the purposes of this section —

“director”, in relation to a body corporate whose affairs are managed by its members, means any member of the body corporate;

“practising certificate” means —

(a) in relation to a registered patent agent, a practising certificate issued to him under rules made pursuant to section 104; or

(b) in relation to an advocate and solicitor, a practising certificate issued to him under section 25 of the Legal Profession Act; and

“related company group” means a group of 2 or more corporations within the meaning of the Companies Act (Cap. 50) which are related to each other in accordance with section 6 of that Act.”.

### **Amendment of section 115**

**15.** Section 115 (2) of the Patents Act is amended —

(a) by deleting the word “and” at the end of paragraph (l);

(b) by deleting the full-stop at the end of paragraph (m) and substituting the word “; and”, and by inserting immediately thereafter, the following paragraph:

“(n) prescribing anything that is required or permitted to be prescribed under this Act.”.

### **Amendment of section 116**

**16.** Section 116 (3) of the Patents Act is amended by inserting, immediately after the words “United Kingdom” in the penultimate and last lines of paragraph (a), the words “before the date of commencement of the Patents (Amendment) Act 2001”.

## **Savings provision**

**17.** Section 4 shall only apply in relation to an application for a patent made on or after the date of commencement of this Act, and section 26 of the Patents Act in force immediately before that date shall continue to apply to an application for a patent made before that date. 5

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## **EXPLANATORY STATEMENT**

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

Clause 1 relates to the short title and commencement.

Clause 2 —

- (a) introduces a definition for the word “country” that is consequential upon the repeal of section 89 by clause 12;
- (b) introduces a definition for the term “legal officer” as used in sections 94 and 105; and
- (c) makes an amendment to the definition of “register” that is consequential upon the amendment made to section 42 by clause 9.

Clause 3 provides a definition for the term “convention country” in section 17.

Clause 4 amends section 26 to enable a filing date to be accorded to an application for a patent even though no claim referred to in section 25 (3) of the Act has been filed at the time of application, and to require a claim to be filed within the prescribed period.

Clause 5 amends section 28 to provide that an application for registration may be examined as to its form only after a claim has been filed in accordance with section 26 (8) (as amended by clause 4).

Clause 6 amends section 29 to provide that the furnishing of both the prescribed details under subsection (1) (c) and the prescribed information under subsection (4) should be done in prescribed forms.

Clause 7 amends section 35 to provide that, as soon as practicable after a patent has been granted under the Act, the Registrar must send to the proprietor of the patent a certificate in the prescribed form that the patent has been granted to him and publish in the journal a notice that the patent has been granted.

Clause 8 amends section 36 —

- (a) to provide that the grant of a patent takes effect on the date of issue of the certificate of grant; and

- (b) to remove, in the case of the renewal of a patent previously registered under the repealed Registration of United Kingdom Patents Act, the requirement for a statutory declaration that the patent remains in force in the UK.

Clause 9 amends section 42 to enable the register of patents to be kept off-site in an electronic form.

Clause 10 extends the definitions of “relevant ship” and “relevant aircraft, hovercraft or vehicle” in section 66 to a ship, aircraft, hovercraft or vehicle registered in, or belonging to, a member country of the World Trade Organisation.

Clause 11 makes an amendment to section 79 that is consequential upon the amendment made to section 42 by clause 9.

Clause 12 repeals section 89, the substance of which is set out in the definition of “country” in section 2 (as amended by clause 2), and in section 17 (as amended by clause 3).

Clause 13 amends section 94 —

- (a) to provide that a person may only be represented by an advocate and solicitor, a registered patent agent or (in the case of the Government) a legal officer of the Singapore Legal Service in proceedings before the Registrar; and
- (b) to remove the right of a registered patent agent to appear and be heard on behalf of any party to an appeal to the High Court from the Registrar.

Clause 14 repeals and re-enacts Part XIX comprising sections 104 and 105. New section 104 enables rules to be made for additional matters in relation to the registration of patent agents. These rules include powers and procedures relating to disciplinary proceedings against registered patent agents.

New section 105 provides, in addition to the existing requirements relating to the use of the terms “patent agent” and “patent attorney”, that —

- (a) only a registered patent agent, or an advocate and solicitor, with a practising certificate may carry on a business, practise or act as a patent agent; and
- (b) a partnership or a body corporate may carry on a business, practise or act as a patent agent only if at least one partner or director, as the case may be, is a registered patent agent, or an advocate and solicitor, with a practising certificate.

Clause 15 amends section 115 to enable rules to be made for anything that is required or permitted to be prescribed under the Act.

Clause 16 amends section 116 so that the validity of a patent that is treated thereunder as a patent granted pursuant to an application made under the Act will not lapse if the patent is revoked in the UK after the date of commencement of the Bill.

Clause 17 is a savings provision in respect of the amendments made to section 26 by clause 4.

#### EXPENDITURE OF PUBLIC MONEY

This Bill will not involve the Government in any extra financial expenditure.

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