

Bird & Bird ATMD

Making Singapore Patents More Robust



July 2019

The Intellectual Property (Dispute Resolution) Bill was tabled in Parliament this week. The Bill seeks to make extensive changes to how intellectual property ("IP") rights may be enforced in Singapore including, most notably, providing for the consolidation of civil IP proceedings in the High Court (Read more [here](#)). Additionally, the Bill introduces two new procedures aimed at reducing the risk of undeserving patents being granted and at allowing any such granted patents to be revoked in a cost-effective manner. It also seeks to amend the time bars to patent entitlement proceedings.

New procedure for submission of third party observations

A new procedure for third parties to submit to IPOS observations on the patentability of an invention in a patent application will be introduced. The Bill provides that:

- TPOs may be filed at any time after publication of the application up to before the examination report, search and examination report or supplementary examination report for the application is sent to the patent applicant.
- Submission of TPOs does not make the third party a party to proceedings before IPOS (which means that a third party cannot become susceptible to an adverse cost order simply because he filed TPOs).

At present, there is nothing to prevent the submission of such third party observations ("TPOs") and, provided that the submission is timely, IPOS will typically forward any TPOs received to the examiner. The amendments thus largely only formalises this practice and clarifies its parameters.

New procedure for making of request for post-grant re-examination of patents

Another new procedure introduced by the Bill is that of re-examination after patent grant. The key features are:

- Any person can make the request, which can be on any of the grounds for patent revocation.
- A request may be filed at any time after patent grant, except when there are pending proceedings before the High Court or IPOS where the validity of the patent is in issue. On the other hand, if proceedings are filed after the request is made, IPOS has the discretion to refer the request to the High Court.
- Similar to the submission of TPOs, the making of a request does not make the requestor a party to proceedings before IPOS.
- If the request is granted, it will be forwarded to a patent examiner who will conduct the re-examination and issue a written opinion. The patentee will be given an opportunity to respond to the written opinion, following which a re-examination report will be established. If the re-examination report contains unresolved

objections, the patent will be revoked, although the patentee may also be given an opportunity to amend the patent. IPOS's decision not to grant a request for re-examination or not to revoke a patent pursuant to re-examination cannot be appealed against.

- Finally, the issuance of a re-examination report does not prevent any person from challenging the patent on the same grounds in subsequent proceedings before IPOS or the Court.

At present, the only avenue available to a third party who wishes to challenge a granted patent is to file an application for revocation, which can lead to protracted and costly proceedings. This new procedure will provide a welcome alternative to third parties who have reasons for believing that a patent is invalid but may not have the resources to commence or maintain revocation proceedings. Additionally, the request will not make the applicant a party to proceedings. So, unlike in a revocation application, the requestor will not be subject to an adverse cost order even if the patent is ultimately not revoked. The trade-off is that the requestor will have no opportunity to participate in the re-examination process (e.g., to rebut the patentee's responses to the written opinion).

Changes to time bars to patent entitlement proceedings

Currently, IPOS and the High Court have concurrent jurisdiction over patent entitlement proceedings (i.e., as to which party is the true proprietor of a patent). A reference of a question as to entitlement (to IPOS) or an action for a declaration as to entitlement (brought in the High Court) must be made or commenced within 2 years from patent grant unless it is shown that the registered proprietor knew at the time of grant or transfer of the patent that he was not entitled to it.

This provision came to the fore in *Cicada Cube Pte Ltd v National University Hospital (Singapore) Pte Ltd* and another appeal [2018] SGCA 52. NUH filed a reference to IPOS in respect of Cicada's patent 3 days before the expiry of the 2 year period. IPOS only responded 2½ years later, declining to determine the reference. NUH commenced an action in the High Court for a declaration. The High Court's decision that the relevant date to consider was that of NUS's reference to IPOS, but the Court of Appeal disagreed. Based on s 47(9) of the Patents Act, the Court of Appeal held that there was a requirement to show Cicada's knowledge because the court action was only commenced after the 2 year period.

Whilst NUH could have been more diligent (e.g., by monitoring the timelines and ensuring that it commenced an action in the High Court if it did not hear from IPOS before the deadline), the outcome was still seen as unsatisfactory. Under the amendment, if the matter came before the High Court pursuant to a reference made to IPOS, the relevant date for calculating the 2 year period would be when the reference to IPOS was made, instead of when the court proceedings were commenced.

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