

Re-examination systems

Singapore

On 5 August 2019, the Intellectual Property (Dispute Resolutions) Bill (“Bill”)¹ was passed in Parliament. Among others, the Bill introduces a new, binding re-examination process (ex parte) that is available post-grant.

Amendment 11 of the Bill introduces new section 38A of the Patents Act as follows:

11. The Patents Act is amended by inserting, immediately after section 38, the following section:

“Re-examination after grant

- 38A.—(1) Any person may, at any time after a patent is granted, file a request for the Registrar to conduct a re-examination of the specification of a patent for an invention on any of the following grounds:
- (a) the invention is not a patentable invention;
 - (b) the specification does not disclose the invention clearly and completely for it to be performed by a person skilled in the art;
 - (c) the matter disclosed in the specification extends beyond that disclosed —
 - (i) in the application for the patent, as filed; or
 - (ii) where the patent was granted on a new application filed under section 20(3) or 47(4) or section 116(6) of the Patents Act (Cap. 221, 1995 Ed.), or in accordance with section 26(11), in —
 - (A) the earlier application made under this Act;
 - (B) the application made under the United Kingdom Patents Act 1977; or
 - (C) the application under the European Patent Convention designating the United Kingdom filed at the European Patent Office,as the case may be, from which the filing date and the right of priority has been derived, as filed;
 - (d) an amendment has been made to the specification of the patent under section 38(1), 81 or 83 which —
 - (i) results in the specification disclosing any additional matter; or
 - (ii) extends the protection conferred by the patent;
 - (e) an amendment has been made to the specification of the application for the patent under section 31 which results in the specification disclosing any matter extending beyond that disclosed in the application as filed;
 - (f) a correction has been made to the specification of the patent or of the application for the patent under section 107 which should not have been allowed;
 - (g) the patent is one of 2 or more patents for the same invention having the same priority date and filed by the same party or the party’s successor in title.
- (2) Every request under subsection (1) must be —
- (a) filed in the prescribed manner;
 - (b) accompanied by the prescribed fee; and
 - (c) accompanied, at the time the request is filed, by —
 - (i) reasons to substantiate the ground specified in the request; and
 - (ii) any document that the person considers to be relevant for the purposes of the re-examination.

¹ Intellectual Property (Dispute Resolution) Bill. Bill No: 17/2019.

- (3) The Registrar may reject any request that fails to comply with any requirement in subsection (2).
- (4) The Registrar must not grant a request under subsection (1) if the Registrar is of the view that the request is frivolous, vexatious or an abuse of the process.
- (5) No request under subsection (1) may be filed where there are pending before the court or the Registrar any proceedings in which the validity of the patent may be put in issue.
- (6) Where proceedings before the court or the Registrar, in which the validity of the patent may be put in issue, are filed after a request under subsection (1) is made, the Registrar may make such order or give such direction as the Registrar thinks fit concerning the request.
- (7) Where the Registrar grants a request under subsection (1), the Registrar must cause the specification of the patent to be re-examined by an Examiner so as to determine whether the ground specified in the request is made out.
- (8) If it appears to the Examiner during the re-examination of the specification of the patent that —
- (a) the ground specified in the request; or
 - (b) based on any document submitted under subsection (2)(c)(ii), any other ground mentioned in subsection (1),
- is made out, the Examiner must give the proprietor of the patent a written opinion to that effect, and the Registrar must, upon receiving the written opinion, send the proprietor a copy of the written opinion.
- (9) The proprietor of the patent must respond to the written opinion in the prescribed manner and within the prescribed period.
- (10) Upon receiving the re-examination report prepared by the Examiner, the Registrar must send to the proprietor of the patent a copy of the report.
- (11) Where the re-examination report issued under this section contains one or more unresolved objections (being an objection mentioned in the written opinion), the Registrar must make an order revoking the patent.
- (12) An order under subsection (11) may be —
- (a) an order for the unconditional revocation of the patent; or
 - (b) where one of the grounds mentioned in subsection (1) has been established, but only so as to invalidate the patent to a limited extent, an order that the patent should be revoked unless within a specified time the specification is amended under section 83 to the satisfaction of the Registrar.
- (13) A decision of the Registrar or on appeal from the Registrar does not estop any party to any civil proceedings in which infringement of a patent is in issue from alleging invalidity of the patent on any of the grounds mentioned in subsection (1), whether or not any of the issues involved were decided in the decision.
- (14) A decision of the Registrar to revoke a patent under this section has effect from the date of the grant of the patent.

(15) A person does not become a party to any proceedings under this Act before the Registrar by reason only that the person files a request under subsection (1), unless the person is the proprietor of the patent.”

The above entered into force on 1 October 2021.