

PATENTS ACT

(CHAPTER 221)

(Act 21 of 1994)

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An Act to establish a new law of patents, to enable Singapore to give effect to certain international conventions on patents, and for matters connected therewith.

[23rd February 1995]

PART I

PRELIMINARY

Interpretation

2.—(1) In this Act, unless the context otherwise requires —

“Convention on International Exhibitions” means the Convention relating to International Exhibitions signed in Paris on 22nd November 1928, as amended or supplemented by any protocol to that convention which is for the time being in force;

“corresponding application”, in relation to an application for a patent (referred to in this definition as the application in suit), means an application for protection filed, or treated as filed, with any prescribed patent office that —

- (a) forms the basis for a priority claim under section 17 in the application in suit; or
- (b) is subject to a priority claim based on —
 - (i) the application in suit; or

- (ii) an application which is also the basis for a priority claim under section 17 in the application in suit;

“corresponding international application”, in relation to an application for a patent (referred to in this definition as the application in suit), means an application for protection filed under the Patent Co-operation Treaty that —

- (a) forms the basis for a priority claim under section 17 in the application in suit; or
- (b) is subject to a priority claim based on —
 - (i) the application in suit; or
 - (ii) an application which is also the basis for a priority claim under section 17 in the application in suit;

“corresponding patent”, in relation to a corresponding application, means a patent granted in respect of the corresponding application by the prescribed patent office in which the corresponding application was filed or treated as filed;

“Council for TRIPS” means the Council for Trade-Related Aspects of Intellectual Property Rights established under the TRIPS Agreement;

“country” includes —

- (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;

“court” means the High Court;

“date of filing”, in relation to —

- (a) an application for a patent made under this Act, means the date of filing that application by virtue of section 26; and

(b) any other application, means the date which, under the law of the country where the application was made or in accordance with the terms of a treaty or convention to which that country is a party, is to be treated as the date of filing that application in that country or is equivalent to the date of filing an application in that country (whatever the outcome of the application);

“designate”, in relation to an application or a patent, means designate the country or countries (in pursuance of the Patent Co-operation Treaty) in which protection is sought for the invention which is the subject of the application or patent;

“Doha Declaration Implementation Decision” means the Decision adopted by the General Council of the World Trade Organisation on 30th August 2003 on the implementation of paragraph 6 of the Declaration on the TRIPS Agreement and Public Health adopted in Doha on 14th November 2001;

“employee” means a person who works or (where the employment has ceased) worked under a contract of employment or in employment under or for the purposes of a Government department;

“employer”, in relation to an employee, means the person by whom the employee is or was employed;

“European Patent Convention” means the Convention on the Grant of European Patents;

“European Patent Office” means the office of that name established by the European Patent Convention;

“Examiner” means such person, organisation or foreign or international patent office or organisation as may be prescribed to whom the Registrar may refer questions relating to patents, including search and examination of applications for patents;

“exclusive licence” means a licence from the proprietor of or applicant for a patent conferring on the licensee, or on him and persons authorised by him, to the exclusion of all other

persons (including the proprietor or applicant), any right in respect of the invention to which the patent or application relates, and “exclusive licensee” and “non-exclusive licence” shall be construed accordingly;

“filing fee” means the fee prescribed for the purposes of section 25;

“formal requirements” means those requirements of this Act and the rules which are designated by the rules as formal requirements for the purposes of this Act;

“international application for a patent” means an application made under the Patent Co-operation Treaty;

“international application for a patent (Singapore)” means an application of that description which, on its date of filing, designates Singapore;

“International Bureau” means the secretariat of the World Intellectual Property Organisation established by a convention signed at Stockholm on 14th July 1967;

“international exhibition” means an official or officially recognised international exhibition falling within the terms of the Convention on International Exhibitions or falling within the terms of any subsequent treaty or convention replacing that convention;

“international preliminary report on patentability” means —

(a) an international preliminary report on patentability (Chapter I of the Patent Co-operation Treaty); or

(b) an international preliminary report on patentability (Chapter II of the Patent Co-operation Treaty),

referred to in the Regulations under the Patent Co-operation Treaty;

“inventor”, in relation to an invention, means the actual deviser of the invention and “joint inventor” shall be construed accordingly;

“journal” has the same meaning as in section 115(4);

- “Legal Service Officer” means an officer in the Singapore Legal Service;
- “marketing approval”, in relation to a pharmaceutical product, means a product licence under section 5 of the Medicines Act (Cap. 176);
- “medicinal product” has the same meaning as in the Medicines Act (Cap. 176);
- “missing part”, in relation to an application for a patent, means —
- (a) any drawing; or
 - (b) any part of the description of the invention for which the patent is sought,
- which was missing from the application at the date of filing of the application;
- “mortgage”, when used as a noun, includes a charge for securing money or money’s worth and, when used as a verb, shall be construed accordingly;
- “Office” means the Intellectual Property Office of Singapore incorporated under the Intellectual Property Office of Singapore Act (Cap. 140);
- “Paris Convention” means the Convention for the Protection of Industrial Property signed at Paris on 20th March 1883;
- “patent” means a patent under this Act and includes a patent in force by virtue of section 117(3);
- “Patent Co-operation Treaty” means the treaty of that name signed at Washington on 19th June 1970;
- “patented invention” means an invention for which a patent is granted and “patented process” shall be construed accordingly;
- “patented product” means a product which is a patented invention or, in relation to a patented process, a product

obtained directly by means of the process or to which the process has been applied;

“person” includes the Government;

“pharmaceutical product” means a medicinal product which is a substance used wholly or mainly by being administered to a human being for the purpose of treating or preventing disease, but does not include —

(a) any substance which is used solely —

(i) for diagnosis or testing; or

(ii) as a device or mechanism, or an instrument, apparatus or appliance; or

(b) any substance or class of substances specified in paragraph 2 or 3 of the Schedule;

“prescribed form” means a form published by the Registrar under section 115A;

“priority date” means the date determined as such under section 17;

“published” means made available to the public (whether in Singapore or elsewhere) and a document shall be taken to be published under any provision of this Act if it can be inspected as of right at any place in Singapore by members of the public, whether on payment of a fee or not, and “republished” shall be construed accordingly;

“register”, when used as a noun, means the register of patents maintained under section 42 and, when used as a verb, means, in relation to any thing, to register or register particulars, or enter notice, of that thing in the register and, when used in relation to a person, means to enter his name in the register;

“registered foreign patent agent” means a person whose name is entered in the register of foreign patent agents kept in accordance with the rules made under section 104;

“registered patent agent” means a person whose name is entered in the register of patent agents kept in accordance with the rules made under section 104;

“Registrar” means the Registrar of Patents and includes any Deputy Registrar of Patents holding office under this Act;

“Registry” means the Registry of Patents established under this Act;

“relevant authority”, in relation to a pharmaceutical product, means the Health Sciences Authority established under the Health Sciences Authority Act (Cap. 122C);

“relevant health product” means a patented invention which is a product referred to in —

(a) paragraph 1(a) of the Doha Declaration Implementation Decision; or

(b) paragraph 1(a) of the Annex to the TRIPS Agreement;

“right”, in relation to any patent or application, includes an interest in the patent or application and, without prejudice to the foregoing, any reference to a right in a patent includes a reference to a share in the patent;

“scientific adviser” means any person with any scientific qualification, any medical practitioner, engineer, architect, surveyor, accountant, actuary and any other specially skilled person;

“TRIPS Agreement” means the Agreement on Trade-Related Aspects of Intellectual Property Rights, set out in Annex 1C to the WTO Agreement, as revised or amended from time to time;

“WTO Agreement” means the World Trade Organisation Agreement signed in Marrakesh in 1994 as revised or amended from time to time.

(2) Rules may provide for stating in the journal that an exhibition falls within the definition of “international exhibition” in

subsection (1) and any such statement shall be conclusive evidence that the exhibition falls within that definition.

(3) For the purposes of this Act, a matter shall be taken to have been disclosed in any relevant application within the meaning of section 17 or in the specification of a patent if it was either claimed or disclosed (otherwise than by way of disclaimer or acknowledgment of prior art) in that application or specification.

(4) For the purposes of this Act —

(a) a claim is related to another claim if —

(i) the 2 claims are identical; or

(ii) each limitation in the second claim —

(A) is identical to a limitation in the first claim; or

(B) differs from a limitation in the first claim only in expression but not in content; and

(b) more than one claim may be related to a single claim.

(5) References in this Act to an application for a patent, as filed, are references to such an application in the state it was on the date of filing.

(6) References in this Act to an application for a patent being published are references to its being published under section 27.

(7) References in this Act to the Paris Convention or the Patent Co-operation Treaty are references to that Convention or Treaty or any other international convention or agreement replacing it, as amended or supplemented by any convention or international agreement (including in either case any protocol or annex) to which Singapore is a party, or in accordance with the terms of any such convention or agreement and include references to any instrument made under any such convention or agreement.

(8) The Arbitration Act (Cap. 10) shall not apply to any proceedings before the Registrar under this Act.

LEGAL PROCEEDINGS

Privilege for communications with patent agents, etc.

95.—(1) A communication with respect to any matter relating to patents —

~~— (a) between a person and a registered patent agent, a partnership entitled under Part XIX to describe itself as a firm of patent agents or a body corporate entitled under Part XIX to describe itself as a patent agent; or~~

~~(a) between a person and any of the following:~~

~~(i) a registered patent agent or a registered foreign patent agent;~~

~~(ii) a partnership entitled under Part XIX to describe itself as a firm of patent agents or as a firm of foreign patent agents; or~~

~~(iii) a body corporate entitled under Part XIX to describe itself as a patent agent or as a foreign patent agent; or~~

(b) for the purpose of obtaining, or in response to a request for, information which a person is seeking for the purpose of instructing his patent agent or a registered foreign patent agent,

is privileged from disclosure in legal proceedings in Singapore in the same way as a communication between a person and his solicitor or, as the case may be, a communication for the purpose of obtaining, or in response to a request for, information which a person seeks for the purpose of instructing his solicitor.

(2) In this section, “legal proceedings” includes proceedings before the Registrar.

PART XIX

PATENT AGENTS AND FOREIGN PATENT AGENTS**Registration of patent agents and foreign patent agents**

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

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

- (a) for the keeping, by such person as the Minister may determine, of a register of patent agents and a register of foreign patent agents;
- (b) for the form and manner of application for registration as a patent agent or as a foreign 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;
- (d) for the correction of errors and updating of entries in the register of patent agents and the register of foreign patent agents; and
- (e) for transitional matters in relation to the registration of individuals as patent agents or as foreign patent agents, and exclude or vary the operation of this Act in relation to such transitional matters.

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

- (a) making complaints against registered patent agents and registered foreign patent agents and hearing and deciding upon such complaints;

- (b) imposing penalties on registered patent agents and registered foreign patent agents, including issuing a reprimand, and suspending or cancelling registration;
- (c) summoning witnesses;
- (d) receiving evidence from persons on oath or affirmation;
- (e) administering oaths or affirmations to persons giving evidence;
- (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.

Persons entitled to act as patent agents, etc.

105.—(1) ~~A~~Subject to section 105A, 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.

(2) ~~A~~Subject to section 105A, 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.

(3) ~~A~~Subject to section 105A, 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.

(4) For the purposes of this section and section 105A, 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;~~

(a) applying in Singapore or outside Singapore for, or obtaining in Singapore or outside Singapore, patents granted in Singapore or another country;

(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 patents.

(5) ~~A~~ Subject to section 105A, an individual shall not —

(a) carry on a business under any name or other description which contains the words “patent agent” or “patent attorney”; or

(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” or “patent attorney”,

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

(6) ~~A~~ Subject to section 105A, a partnership shall not —

(a) carry on a business under any name or other description which contains the words “patent agent” or “patent attorney”; 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” or “patent attorneys”,

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

(7) ~~A~~ Subject to section 105A, a body corporate shall not —

(a) carry on a business under any name or other description which contains the words “patent agent” or “patent attorney”; 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” or “patent attorney”,

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”.~~

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

(10) Where an individual’s employer does not carry on a business, practise or act as a patent agent or as a foreign patent agent, the individual does not contravene subsection (1) in respect of anything done, or undertaken to be done, by the individual for his employer in his capacity as employee of his employer.

(10A) Where —

- (a) an individual’s employer is a member of a related company group;
- (b) the individual’s employer does not carry on a business, practise or act as a patent agent or as a foreign patent agent; and

- (c) ~~any every~~ other member of the related company group does not carry on a business, practise or act as a patent agent or as a foreign patent agent,

the individual does not contravene subsection (1) in respect of anything done, or undertaken to be done, by the individual for that other member of the related company group in his capacity as employee of his employer.

(11) A Legal Service 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 93 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) In 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 under 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 (Cap. 61); 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.

Foreign patent agents

105A.—(1) An individual may carry on a business, practise or act as a foreign patent agent only if he is a registered foreign patent agent.

(2) A partnership may carry on a business, practise or act as foreign patent agents only if at least one partner is a registered foreign patent agent.

(3) A body corporate may carry on a business, practise or act as a foreign patent agent only if at least one director is a registered foreign patent agent.

(4) For the purposes of section 105 and this section, a person is taken to carry on a business, practise or act as a foreign patent agent if the person does in Singapore or undertakes to do, on behalf of someone else, any of the following in Singapore for gain:

(a) applying outside Singapore for, or obtaining outside Singapore, patents granted in Singapore or another country;

(b) preparing specifications or other documents for the purposes of 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 patents under the patent law of another country.

(5) Except as permitted under subsections (1) to (4), a registered foreign patent agent —

(a) shall not carry on a business, practise or act as a patent agent; and

(b) shall not purport to carry on a business, practise or act as a patent agent.

(6) If an individual is a registered foreign patent agent, he —

- (a) may carry on a business under any name or other description which contains the words “foreign patent agent” or “foreign patent attorney”; and
- (b) may in the course of a business otherwise describe himself, hold himself out or permit himself to be described or held out as a “foreign patent agent” or “foreign patent attorney”.
- (7) If at least one partner of a partnership is a registered foreign patent agent, the partnership —
- (a) may carry on a business under any name or other description which contains the words “foreign patent agent” or “foreign patent attorney”; and
- (b) may 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 “foreign patent agents” or “foreign patent attorneys”.
- (8) If at least one director of a body corporate is a registered foreign patent agent, the body corporate —
- (a) may carry on a business under any name or other description which contains the words “foreign patent agent” or “foreign patent attorney”; and
- (b) may in the course of a business otherwise describe itself, hold itself out or permit itself to be described or held out as a “foreign patent agent” or “foreign patent attorney”.
- (9) No person (other than an individual referred to in subsection (6), a partnership referred to in subsection (7) or a body corporate referred to in subsection (8)) shall —
- (a) carry on a business under any name or other description which contains the words “foreign patent agent” or “foreign patent attorney”; or
- (b) describe himself, hold himself out or permit himself to be described or held out as a “foreign patent agent” or “foreign patent attorney”.

(10) Any person who contravenes subsection (5) or (9) 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.

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

(12) In this section, “director”, in relation to a body corporate whose affairs are managed by its members, means any member of the body corporate.

PART XX

MISCELLANEOUS AND GENERAL

Immunity of Office, its officers and Examiners

106. The Office, any officer of the Registry and any Examiner shall not —

- (a) be taken to warrant the validity of any patent granted under this Act or any treaty to which Singapore is a party;
- (b) incur any liability by reason of or in connection with any examination or investigation required or authorised by this Act or any such treaty or any report or other proceedings consequent on any such examination or investigation; or
- (c) incur any liability by reason of an incorrect entry in the register of patent agents or the register of foreign patent agents maintained under Part XIX.

Rules

115.—(1) The Minister may, after consulting with the Office, make such rules as he thinks expedient for regulating the business of the Registry in relation to patents and applications for patents

(including international applications for patents) and for regulating all matters placed by this Act under the direction or control of the Registrar.

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

- (a) prescribing the contents of applications for patents and other documents which may be filed at the Registry and requiring copies to be furnished of any such documents;
- (b) regulating the procedure to be followed in connection with any proceeding or other matter before the Registrar or the Registry and authorising the rectification of irregularities of the procedure;
- (c) requiring fees to be paid in connection with any such proceeding or matter or in connection with the provision of any service by the Registry and providing for the remission of fees in the prescribed circumstances;
- (d) regulating the mode of giving evidence in any such proceeding and empowering the Registrar to compel the attendance of witnesses and the discovery of and production of documents;
- (e) requiring the Registrar to publish any proposed amendment of patents and any other prescribed matters including any prescribed steps in any such proceeding;
- (f) providing for the appointment of scientific advisers to assist the court and the Registrar in any proceeding before it or him and for the remuneration of such advisers;
- (g) prescribing time limits for doing anything required to be done in connection with any such proceeding by this Act or the rules;
- (h) giving effect to the right of an inventor of an invention to be mentioned in an application for a patent for the invention;
- (i) providing for the publication and sale of documents in the Registry and of information about such documents;

- (j) prescribing, in relation to international applications, matters necessary or convenient to be prescribed for carrying out or giving effect to the Patent Co-operation Treaty;
 - (k) excluding or varying the operation of the provisions of this Act in relation to international applications and applications for patents made under section 117;
 - (l) requiring and regulating the translation of documents in connection with any application for a patent and the filing and authentication of any such translations;
 - (m) prescribing the scale of costs for proceedings before the Registrar; and
 - (n) prescribing anything that is required or permitted to be prescribed under this Act.
- (3) The rules may make different provisions for different cases.
- (4) The rules shall provide for the publication by the Registrar of a journal (referred to in this Act as the journal) containing particulars of applications for and grants of patents, particulars of application for and the registration of patent agents and foreign patent agents, and of other proceedings under this Act.
- (5) The rules may require or authorise the Registrar to make arrangements for the publication of reports of cases relating to patents decided by him or by any court or body whether in Singapore or elsewhere.