

PATENTS ACT

(CHAPTER 221)

PATENTS (PATENT AGENTS) RULES 2001

In exercise of the powers conferred by section 104 of the Patents Act, the Minister for Law hereby makes the following Rules:

Arrangement of Provisions

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PART I

PRELIMINARY

Citation and commencement

1.—These Rules may be cited as the Patents (Patent Agents) Rules 2001 and shall come into operation on 2nd January 2002.

Interpretation

2.—(1) In these Rules, unless the context otherwise requires —

"certificate of registration" means a certificate of registration issued under rule 7 (4);

"Court" means the High Court;

"Disciplinary Committee" means the Disciplinary Committee appointed under rule 16;

"patent agency work" means any of the following types of work:

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

"practice year" means the period from 1st April in a calendar year to 31st March in the next calendar year;

"practising certificate" means a practising certificate issued under rule 9;

"register" means the register of patent agents maintained under rule 5.

(2) For the purposes of these Rules, an individual is resident in Singapore if —

- (a) the individual has his place of residence in Singapore;

(b) Singapore is the country of his permanent abode even though he is temporarily absent from Singapore; or

(c) the individual has a valid pass issued to him under the Immigration Act (Cap. 133) to enter and remain in Singapore for any purpose other than a temporary purpose.

Fees

3.—(1) The fees to be paid in respect of matters arising under these Rules shall be those specified in the First Schedule.

(2) A fee specified in the First Schedule shall be paid at the same time as the filing of the matter in question.

(3) For the avoidance of doubt and subject to rule 17 (2) (f) (ii), fees paid under these Rules shall not be refundable.

Forms

4.—(1) The Registrar shall publish in the journal —

(a) the forms to be used for any purpose relating to —

(i) the registration of a patent agent;

(ii) any proceedings under Part XIX of the Act or these Rules; or

(iii) any other matter under Part XIX of the Act or these Rules;

(b) the Registrar's directions relating to the use of any form referred to in sub-paragraph (a); and

(c) any amendment or modification of any such form or direction.

(2) Any form referred to in paragraph (1) (a) may be modified on the direction of the Registrar for use in a case other than the case for which it is intended.

(3) Any reference in these Rules to any form shall be construed as a reference to the current version of that form which is —

(a) described in the Second Schedule; and

(b) published in the journal.

PART II

REGISTRATION OF PATENT AGENTS

Register of patent agents

5.—(1) The Registrar shall keep and maintain a register of patent agents which shall contain —

(a) the names and practice addresses in Singapore of all individuals registered as patent agents under these Rules;

(b) the dates of their registration;

- (c) the terms of practising certificates issued to them (if any); and
 - (d) such of their other particulars as the Registrar may determine.
- (2) The register need not be kept in documentary form.

Entitlement to registration

6.—Subject to rules 7 and 8, an individual is entitled to be registered as a patent agent if he —

- (a) is resident in Singapore;
- (b) holds a university degree or equivalent qualification approved by the Registrar;
- (c) has passed the course specified in Part I of the Third Schedule;
- (d) has passed the examination specified in Part II of the Third Schedule; and
- (e) has completed internship in patent agency work under the supervision of a registered patent agent, or an individual registered as a patent agent or its equivalent in a country or territory, or by a patent office, specified in the Fourth Schedule, for —
 - (i) a continuous period of at least 12 months; or
 - (ii) a total period of at least 12 months within a continuous period of 24 months.

Application for registration

7.—(1) An application for registration shall be made to the Registrar in Form A, and shall be accompanied by —

- (a) the applicable fee in the First Schedule;
 - (b) the necessary documentary proof of the applicant's entitlement to be registered; and
 - (c) 2 certificates of good character of the applicant in Form B by 2 responsible individuals —
 - (i) who are not immediately related to the applicant;
 - (ii) who have known the applicant for at least 12 months and have had opportunities to judge his character; and
 - (iii) one or both of whom is or are resident in Singapore.
- (2) The Registrar may require the applicant to furnish, within a specified period, such further evidence or information as he considers necessary to determine if the applicant is entitled to be registered.
- (3) The Registrar may accept in place of, or require in addition to, either or both of the certificates of good character such other evidence of good character of the applicant as the Registrar considers necessary.
- (4) Subject to rule 8, the Registrar shall, if satisfied that the applicant is entitled to be registered and is of good character, register the applicant as a patent agent by issuing to him a certificate of registration and entering his name and particulars in the register.

(5) The Registrar may, before registering the applicant, require him to satisfy, within a specified period, such conditions as the Registrar considers appropriate.

(6) The Registrar may subject the registration of the applicant to such conditions as the Registrar considers appropriate.

(7) Subject to rule 8, an application shall be refused if it is not made in accordance with this rule.

Exemptions

8.—(1) The Registrar may, upon the written request of an applicant for registration, register the applicant as a patent agent —

(a) notwithstanding rule 6 (c) if he is satisfied that the applicant is sufficiently proficient in the law of intellectual property;

(b) notwithstanding rule 6 (d) if he is satisfied that the applicant is sufficiently proficient in the law of patents and has the necessary knowledge and practical experience to carry out patent agency work; and

(c) notwithstanding rule 6 (e) if he is satisfied that the applicant has the necessary knowledge and practical experience to carry out patent agency work, gained from carrying out such work under the supervision of a registered patent agent, or an individual registered as a patent agent or its equivalent in a country or territory, or by a patent office, specified in the Fourth Schedule.

(2) The Registrar may require the applicant to furnish, within a specified period, such further evidence or information as he considers necessary for the purposes of his determination under paragraph (1).

Application for practising certificate

9.—(1) A registered patent agent who wishes to obtain a practising certificate for any practice year shall, before making an application for the certificate, take out professional indemnity insurance against any liability incurred by him when carrying out patent agency work in that practice year, where the amount of insurance cover is at least \$1 million for each claim.

(2) Paragraph (1) shall not apply to a registered patent agent —

(a) if —

(i) his employer does not carry on a business, practise or act as a patent agent; and

(ii) he intends to carry out patent agency work for his employer, and for no other person, in his capacity as employee of his employer, and in no other capacity, during the practice year; or

(b) if —

(i) his employer is a member of a related company group;

(ii) his employer does not carry on a business, practise or act as a patent agent;

(iii) any other member of the related company group does not carry on a business, practise or act as a patent agent; and

(iv) he intends to carry out patent agency work for his employer or for that other member of the related company group, and for no other person, in his capacity as employee of his employer, and in no other capacity, during the practice year.

(3) An application for a practising certificate shall not be made earlier than 2 months before the commencement of the practice year in question.

(4) The application shall be made to the Registrar in Form C, and shall be accompanied by —

(a) the applicable fee in the First Schedule which shall be the same amount irrespective of the term of the practising certificate;

(b) a declaration in writing stating —

(i) the applicant's name in full;

(ii) the name under which he intends to practise or the name of his employer;

(iii) his practice address in Singapore;

(iv) that he is resident in Singapore;

(v) that he has not been convicted of an offence under the Act and has not been convicted or guilty of any of the matters referred to in rule 17 (1) (a) to (g) for which he has not already been dealt with under Part III;

(vi) that he continues to meet the requirements of these Rules by virtue of which he was registered; and

(vii) in a case where paragraph (1) applies, that he has obtained professional indemnity insurance referred to in that paragraph; and

(c) either of the following:

(i) in a case where paragraph (1) applies, a written undertaking by the applicant that —

(A) he will maintain in force at all times during the practice year in question the professional indemnity insurance that he has taken out; and

(B) where the insurance taken out is due to expire before the end of the practice year, he will renew the insurance before such expiry;

(ii) in a case where paragraph (2) applies, a written undertaking by the applicant that he will, if he is to carry out patent agency work at any time during that practice year other than in his capacity as employee of his employer for —

(A) where paragraph (2) (a) applies, his employer; or

(B) where paragraph (2) (b) applies, his employer or the other member of the related company group referred to in that paragraph,

take out the professional indemnity insurance referred to in paragraph (1) before he does so.

(5) The Registrar may require the registered patent agent to furnish, within a specified period, such other evidence or information as he considers necessary for the purposes of the application.

(6) The Registrar shall, if satisfied that the application is made in accordance with this rule, issue the practising certificate.

(7) The issue of a practising certificate may be subject to such conditions as the Registrar may specify.

(8) In this rule, “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.

Term of practising certificate

10.—(1) A practising certificate issued under rule 9 shall be in force from the date of its issue or, if it is applied for before the beginning of the practice year in question, the first day of the practice year.

(2) Where the registration of a patent agent has been cancelled or suspended under rule 20, any practising certificate issued to him shall be treated as cancelled and he shall immediately surrender the certificate to the Registrar.

(3) Any person who without lawful excuse contravenes paragraph (2) shall be guilty of an offence and shall be liable on conviction to a fine not exceeding \$1,000.

Correction of errors in documents filed

11.—(1) A request to correct a clerical error or mistake in any document filed with the Registrar under these Rules shall be made by filing with him Form D and by paying the applicable fee specified in the First Schedule.

(2) The Registrar may require the person making the request to furnish, within a specified period, such other evidence or information as the Registrar considers necessary to determine if the correction should be made.

Correction of errors in register

12.—The Registrar may, whether or not on his own initiative, if satisfied that any entry in the register has been made in error or that any entry is incorrect, delete or correct the same.

Update of particulars

13.—(1) A registered patent agent shall, within one week of any change in his name or practice address, give notice to the Registrar of the change by filing with the Registrar Form D and paying the fee specified in the First Schedule.

(2) Upon receipt of the matters referred to in paragraph (1), the Registrar shall update the entry in the register accordingly.

Inspection of register

14.—Any person may, subject to such conditions as the Registrar may specify, inspect, search or retrieve information from the register.

Duplicate certificates

15.—(1) If a certificate of registration or practising certificate has been lost, destroyed or defaced or becomes obliterated so that any information on such certificate is illegible, the holder thereof shall immediately notify the Registrar by filing Form E and by paying the applicable fee in the First Schedule.

(2) Subject to paragraphs (3) and (4), the Registrar may issue a duplicate of such certificate to the holder.

(3) In the case of a certificate of registration or practising certificate that has been defaced or become obliterated, no duplicate of such certificate shall be issued unless the original is first returned to the Registrar.

(4) In the case of a certificate of registration or practising certificate that has been lost or destroyed, no duplicate of such certificate shall be issued unless the holder has made a statutory declaration of the loss or destruction and forwarded the statutory declaration to the Registrar.

PART III

DISCIPLINARY PROCEEDINGS

Appointment of Disciplinary Committee

16.—(1) The Minister may in writing appoint a Disciplinary Committee which shall consist of —

- (a) a registered patent agent;
- (b) an advocate and solicitor; and
- (c) a lay person.

(2) The Minister shall appoint one member of the Disciplinary Committee as the president.

(3) The members of the Disciplinary Committee shall hold office for such term as may be determined by the Minister and shall be eligible for reappointment.

(4) Notice of the appointment of the Disciplinary Committee shall be published in the Patents Journal.

(5) Any member of the Disciplinary Committee may resign at any time by giving notice in writing to the Minister.

(6) If any member of the Disciplinary Committee is, by reason of illness, absence or other cause, for the time being unable to perform the duties of his office, the Minister may appoint another person to discharge the duties of that member for such term as the Minister may determine, and a person so appointed shall, during that term, have the same powers and functions as the person in whose place he is appointed.

(7) All members must be present to constitute a quorum for a meeting of the Disciplinary Committee.

(8) Any question arising at a meeting of the Disciplinary Committee shall be determined by a majority of votes.

Complaint against registered patent agent

17.—(1) The Registrar or any person (referred to in this Part as the complainant) may make a complaint or provide information to the Disciplinary Committee that a registered patent agent (referred to in this Part as the affected person)—

- (a) has been convicted of a criminal offence implying a defect of character which makes him unfit for his profession;
- (b) has been guilty of fraudulent or grossly improper conduct in carrying out his professional duties;

(c) has been adjudicated bankrupt and has been guilty of any of the acts mentioned in section 124 (5) (a), (b), (c), (d), (e), (f), (h), (i), (k), (l) or (m) of the Bankruptcy Act (Cap. 20);

(d) has allowed any person who is not a registered patent agent to carry out any patent agency work in his name, where that other person was not under his direct and immediate control and supervision when carrying out the work;

(e) has obtained registration as a patent agent or a practising certificate by fraud or misrepresentation;

(f) has breached any condition to which his registration or the issue of his practising certificate is subject, or has breached any undertaking made to the Registrar; or

(g) has been guilty of conduct unbecoming a member of his profession.

(2) Any complaint or information made or given by any person other than the Registrar shall be forwarded to the Registrar and shall —

(a) be in Form F;

(b) state the name of the affected person and his address, if known;

(c) state the nature of the complaint;

(d) state the name and address of the complainant;

(e) be signed by the complainant; and

(f) be accompanied by —

(i) a statutory declaration verifying the facts on which the complainant relies in support of his complaint or information; and

(ii) the applicable fee in the First Schedule, which is refundable at the end of the inquiry of the Disciplinary Committee unless it otherwise determines under rule 18 (5).

(3) The Registrar shall forward the matters received under paragraph (2) to the Disciplinary Committee.

(4) The Disciplinary Committee may require the complainant to provide such further information or document as it may consider necessary for its inquiry and may, if he fails without lawful excuse to do so, dismiss the complaint or matter.

Inquiry by Disciplinary Committee

18.—(1) If the Disciplinary Committee is of the opinion that the affected person should be called upon to answer any allegation made against him, the Committee shall serve on him —

(a) a copy of the complaint or information and any statutory declaration made in support of it; and

(b) a notice inviting him, within the period specified in the notice (not being less than one month from the date of the notice), to —

(i) submit to the Disciplinary Committee any written representations he may wish to make; and

(ii) advise the Disciplinary Committee if he wishes to make oral representations.

(2) The Disciplinary Committee shall serve on the complainant a copy of the notice referred to in paragraph (1) (b) and a copy of any written representations made by the affected person.

(3) If the affected person has advised the Disciplinary Committee that he wishes to make oral representations, the Committee shall give him not less than one month's notice, or such shorter period as the affected person may request or consent to accept, of the date, time and place at which his representations will be heard.

(4) The Disciplinary Committee shall inform the complainant of the date, time and place appointed for the hearing; and the complainant shall be entitled to appear at the hearing and make submissions touching on the matters in issue.

(5) Where the Disciplinary Committee determines that any complaint made or information given is frivolous or vexatious, the Committee shall dismiss the complaint or matter and any fee paid under rule 17 (2) (f) (ii) shall not be refunded to the complainant.

Hearing of representations

19.—(1) The Disciplinary Committee may determine the procedure to be followed at the hearing and need not apply the rules of evidence.

(2) The Disciplinary Committee may at the hearing take evidence on oath or affirmation; and for that purpose may administer oaths and affirmations.

(3) At the hearing, the affected person and complainant may each appear in person or be represented by an advocate and solicitor who has in force a practising certificate issued under section 25 of the Legal Profession Act (Cap. 161).

(4) The affected person or complainant, or his representative, may request the Disciplinary Committee to summon a witness to give evidence or produce any document or article relating to any matter in issue.

(5) Any person who, without lawful excuse, refuses or fails —

(a) to appear in obedience to the summons; or

(b) to be sworn or to make an affirmation, to give evidence relating to any matter in issue, or to produce any document or article specified in the summons, at the hearing,

shall be guilty of an offence and shall be liable on conviction to a fine not exceeding \$2,000 or to imprisonment for a term not exceeding 3 months or to both.

(6) The hearing may be adjourned at the discretion of the Disciplinary Committee and, if adjourned, it shall give the affected person and complainant reasonable notice of the date, time and place at which the hearing is to be resumed.

Powers of Disciplinary Committee upon inquiry

20.—(1) Where, upon due inquiry into the complaint or matter, the Disciplinary Committee is satisfied that the affected person has been convicted or guilty of any of the matters referred to in rule 17 (1) (a) to (g), it shall —

(a) reprimand the affected person;

- (b) order that his registration as a patent agent be suspended for a period not exceeding 12 months;
- (c) order that his registration as a patent agent be cancelled; or
- (d) make such other order as it considers appropriate.

(2) The Disciplinary Committee may, in addition to the facts of the complaint or matter, take into account any past conduct of the affected person in order to determine what order should be made.

(3) Where, upon due inquiry into the complaint or matter, the Disciplinary Committee is not satisfied that the affected person has been convicted or guilty of any of the matters referred to in rule 17 (1) (a) to (g), it shall dismiss the complaint or matter.

(4) The Disciplinary Committee shall serve notice of its decision on the Registrar, the affected person and the complainant (if he is not the Registrar).

(5) If the Disciplinary Committee orders that the registration of the affected person be suspended, the Registrar shall enter the order and the period of suspension in the register.

(6) If the Disciplinary Committee orders that the registration of the affected person be cancelled, the Registrar shall remove the name and other particulars of the affected person from the register.

Completion of outstanding business

21.—(1) Where the registration of the affected person has been ordered by the Disciplinary Committee to be suspended or cancelled, the Committee may, with the agreement of a registered patent agent, appoint that registered patent agent to carry on the practice of the affected person for such period as the Committee may specify.

(2) The registered patent agent so appointed may give notice to the affected person requiring him to make available to the registered patent agent —

- (a) any information about the practice that the registered patent agent may reasonably require to carry on the practice;

- (b) any books, accounts or other documents concerning the practice that the registered patent agent may reasonably require to carry on the practice;

- (c) any moneys held by the affected person —

- (i) on behalf of a client; or

- (ii) that have been paid by a client in respect of services not yet performed for the client.

(3) Any person given a notice under paragraph (2) who without lawful excuse fails or refuses to comply with a requirement in the notice shall be guilty of an offence and shall be liable on conviction to a fine not exceeding \$5,000.

Restoration of registration

22.—(1) An individual whose registration has been cancelled may make an application to the Disciplinary Committee for his registration to be restored.

(2) The application shall —

- (a) be made in Form G;

- (b) be made through the Registrar; and
 - (c) be accompanied by the applicable fee in the First Schedule.
- (3) The Disciplinary Committee may, after considering all relevant circumstances and upon the furnishing by the applicant of such information or document as it may require within the specified period and compliance by the applicant of all conditions imposed by it, if any, restore his registration.
- (4) The Disciplinary Committee shall inform both the individual and the Registrar of its decision; and the Registrar shall, if the decision is to restore the registration of the individual, re-enter the individual's name and other particulars in the register.
- (5) No application for the restoration of a registration shall be made to the Board before the expiration of 2 years from the date of the cancellation.

PART IV

TRANSITIONAL MATTERS

Transitional provision as to registration of patent agents

23.—(1) Notwithstanding rule 6, an individual is entitled to be registered as a patent agent if —

- (a) he is resident in Singapore;
- (b) immediately before 2nd January 2002, he was either —
 - (i) registered as a patent agent or its equivalent in any country or territory, or by a patent office, specified in the Fourth Schedule;
 - (ii) an advocate and solicitor; or
 - (iii) the holder of a university degree or equivalent qualification that is approved by the Registrar; and
- (c) he had carried out patent agency work, in Singapore —
 - (i) for a continuous period of 12 months immediately before 2nd January 2002;
 - (ii) for a total period of 12 months at any time between 2nd January 2000 and 2nd January 2002; or
 - (iii) for such other period as the Registrar may allow,and had been resident in Singapore during that period.

(2) An application for registration of an individual referred to in paragraph (1) shall be made —

- (a) no later than 9 months from 2nd January 2002; and
- (b) in accordance with rule 7.

(3) The Registrar may require the applicant to provide, within a specified period, such other supporting evidence as the Registrar considers necessary.

(4) If the Registrar is satisfied that the applicant —

(a) is entitled to be registered in accordance with paragraph (1);

(b) is sufficiently proficient in the law of patents and has the necessary knowledge and practical experience to carry out patent agency work; and

(c) is of good character,

he shall register the applicant as a patent agent by issuing to him a certificate of registration and entering his name and other particulars in the register.

(5) The Registrar may, before registering the applicant, require him to satisfy, within a specified period, such conditions as the Registrar considers appropriate.

(6) The Registrar may subject the registration of the applicant to such conditions as the Registrar considers appropriate.

(7) An application that is not made in accordance with this rule shall be refused.

Transitional provision as to practising certificates

24.—(1) Notwithstanding rule 9 (3), an application for a practising certificate for the practice year ending 31st March 2002 may be made at any time before that date.

(2) Notwithstanding rule 10, a practising certificate referred to in paragraph (1) shall be taken to be in force from the date of its issue.

Transitional provision as to practice as patent agent

25.—(1) Any person who, immediately before 2nd January 2002 —

(a) has been carrying on a business, practising or acting as a patent agent within the meaning of section 105 (4) of the Act;

(b) has been carrying on a business under any name or other description which contains the words “patent agent”, “patent attorney” or other like expression; or

(c) in the course of a business, has been describing himself, holding himself out or permitting himself to be described or held out as a patent agent, patent attorney or other like expression,

may continue to do so as if section 105 of the Act had not been enacted for a period of one year from that date.

FIRST SCHEDULE

Rules 3, 7 (1), 9 (4), 11 (1), 13 (1), 15 (1), 17 (2) and 22 (2)

<i>Matter or Proceeding</i>	<i>Form</i>	<i>Amount (\$)</i>
1. Application for registration as a patent agent under rule 7 or 23	A	150
2. Application for practising certificate under rule 9 —	C	
(a) for the practice year ending on 31st March 2002		50 irrespective of term of certificate
(b) for any other practice year		150 irrespective of term of certificate
3. Request to correct an error in a filed document under rule 11 or to update a change in name or practice address under rule 13	D	20
4. Request for a duplicate copy of certificate of registration or practising certificate under rule 15	E	150
5. Making a complaint against a registered patent agent under rule 17	F	500
6. Application for restoration of registration	G	150

SECOND SCHEDULE

Rule 4 (3)

DESCRIPTIONS OF FORMS

<i>Form</i>	<i>Description of Form</i>
A	Application for Registration as a Patent Agent under rule 7 (1)
B	Certificate of Good Character under rule 7 (1) (c)
C	Application for a Practising Certificate under rule 9
D	Request to Correct an Error under rule 11/Notice of Change of Particulars under rule 13
E	Request for a Duplicate Copy of the Certificate of Registration or Practising Certificate under rule 15
F	Complaint against a Registered Patent Agent under rule 17
G	Application for the Registration of Patent Agent to be Restored under rule 22

THIRD SCHEDULE

Rule 6

PART I

APPROVED COURSE

Graduate Certificate in Intellectual Property Law course conducted by the Faculty of Law, National University of Singapore.

PART II

APPROVED EXAMINATION

Patent Agents Qualifying Examinations conducted by the Registrar comprising Papers A to D.

FOURTH SCHEDULE

Rules 6, 8 (1) and 23 (1)

List of countries and territories for the purposes of rules 6 (e), 8 (1) (c) and 23 (1) (b) (i).

Australia

Canada

New Zealand

United Kingdom

United States of America

List of patent offices for the purposes of rules 6 (e), 8 (1) (c) and 23 (1) (b) (i).

European Patent Office

Made this 18th day of December 2001.

LIEW HENG SAN
*Permanent Secretary,
Ministry of Law,
Singapore*

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AG/LEG/SL/221/1997/1 Vol. 2]
