

Patents (Amendment) Rules 2004

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No. S 366

**PATENTS ACT
(CHAPTER 221)**

PATENTS (AMENDMENT) RULES 2004

In exercise of the powers conferred by sections 42, 110 and 115 of the Patents Act, the Minister for Law, after consulting with the Intellectual Property Office of Singapore, hereby makes the following Rules:

Citation and commencement

1. These Rules may be cited as the Patents (Amendment) Rules 2004 and shall come into operation on 1st July 2004.

Amendment of rule 2

2. Rule 2(1) of the Patents Rules (R 1) is amended —

(a) by deleting the definition of “certificate” and substituting the following definition:

““certificate of grant” means a certificate for the purposes of section 35(1);” and

(b) by deleting the definition of “international preliminary examination report”.

Amendment of rule 3

3. Rule 3 of the Patents Rules is amended by deleting paragraph (2) and substituting the following paragraph:

“(2) Unless —

(a) otherwise provided for in these Rules; or

(b) the Registrar permits or directs otherwise,

where a fee is specified in the First Schedule in respect of any matter, the fee shall be paid at the same time as the filing of the form corresponding to the matter.”.

Amendment of rule 4

4. Rule 4 of the Patents Rules is amended —

(a) by deleting paragraph (1) and substituting the following paragraph:

“(1) The Registrar shall publish in the journal —

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

(i) any application for or grant of a patent;

(ii) any proceedings before the Registrar under the Act or these Rules; or

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

(b) the Registrar’s directions relating to the use of any form; and

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

(b) by inserting, immediately after paragraph (2), the following paragraph:

“(3) Any reference in these Rules to a numbered form shall be construed as a reference to the current version of the form bearing the corresponding number which is —

(a) described in the Second Schedule; and

(b) published in the journal.”.

Amendment of rule 6

5. Rule 6 of the Patents Rules is amended by deleting paragraph (1) and substituting the following paragraph:

“(1) Where the Registrar has made an order for costs in favour of a party to proceedings before the Registrar and the party wishes to have party and party costs taxed by the Registrar, the party shall, within one month from the date of the order for costs —

(a) apply for the costs to be taxed by filing a copy of the bill of costs; and

(b) send at the same time a copy of the bill of costs to every other person entitled to be heard in the taxation proceedings.”.

Amendment of rule 9

6. Rule 9 of the Patents Rules is amended —

(a) by deleting paragraphs (2A) to (5) and substituting the following paragraphs:

“(2A) Where the Registrar, by notice sent to the applicant or proprietor, requires him to furnish to the Registry, in respect of any application specified in the declaration, a copy of that application which is —

(a) duly certified by the authority with which it was filed; or

(b) otherwise acceptable to the Registrar,

the applicant or proprietor, as the case may be, shall comply with the Registrar’s requirement within 2 months from the date of the notice.

(3) Where an application specified in the declaration is an application for a patent under the Act or an international application for

a patent which is filed at the Registry, the applicant or proprietor may file —

- (a) a request that a copy of the application specified in the declaration be prepared for use in the Registry; and
- (b) Patents Form 26 requesting the Registrar to certify the same.

(4) Where the application in suit is an international application for a patent (Singapore) which is to be treated as an application for a patent under the Act, the requirements of paragraphs (1) and (2) shall be treated as having been complied with to the extent that the requirements of rule 4.10 (a) and (b), read subject to rules 26bis.1 and 26bis.2 (b), of the Regulations under the Patent Co-operation Treaty have been fulfilled.

(5) Where —

- (a) a copy of an application is filed under paragraph (2A), (3) or (4);
- (b) that application is in a language other than English;
- (c) the validity of the claim to priority is relevant to determining whether the invention concerned is patentable; and
- (d) the Registrar, by notice sent to the applicant or proprietor, requires him to furnish to the Registry an English translation of that application,

the applicant or proprietor, as the case may be, shall comply with the Registrar's requirement within 2 months from the date of the notice.”; and

(b) by deleting paragraph (7) and substituting the following paragraph:

“(7) If —

- (a) the applicant fails to comply with paragraph (2); or
- (b) the applicant or proprietor fails to comply with any requirement under paragraph (2A) or (5),

within the time specified or as extended under rule 108, the claim to priority shall be deemed to be relinquished.”.

Deletion and substitution of rule 24

7. Rule 24 of the Patents Rules is deleted and the following rule substituted therefor:

“Form of statements, counter-statements and evidence

24. Rule 23(3) to (7) shall apply, with the necessary modifications, to any statement, counter-statement or evidence filed, unless the Registrar directs otherwise.”.

Amendment of rule 27

8. Rule 27 of the Patents Rules is amended by deleting paragraph (1) and substituting the following paragraphs:

“(1) Subject to paragraphs (1A), (2) and (3), a new application for a patent which includes a request that it be treated as having as its date of filing the date of filing of an earlier application may be filed in accordance with section 26(6) —

(a) of the applicant’s own volition; or

(b) to comply with the requirements of section 25(5)(d),

at any time after the filing of the earlier application.

(1A) Such new application shall in any event be made —

(a) before the earlier application has been refused, withdrawn or treated as having been abandoned; and

(b) before all the conditions in section 30(2) and (3) are satisfied.”.

Amendment of rule 28

9. Rule 28 of the Patents Rules is amended by deleting paragraphs (2), (2A) and (3) and substituting the following paragraphs:

“(2) Where a new application is filed under section 20(3), 26 (6) or 47 (4), the requirement of paragraph (2A) or (5) of rule 9, if applicable, shall be met no later than the time prescribed in that paragraph.

(3) Where a new application is filed under section 26(6) after the period prescribed in rule 9 (2) or 18 (1) but within any extension of that period under rule 108 (3) or (4) in respect of the earlier application, the requirements of rule 9 (2) or 18, as the case may be, shall be complied with before the end of the extended period.”.

Amendment of rule 29

10. Rule 29 of the Patents Rules is amended by deleting paragraph (4) and substituting the following paragraph:

“(4) No application for a patent may be published if it is —

- (a) withdrawn by filing Patents Form 9A; or
- (b) treated as having been abandoned or refused,

earlier than one month preceding the expiration of the time period applicable under paragraph (1) or (2).”.

Amendment of rule 36

11. Rule 36 of the Patents Rules is amended by deleting the words “section 29 (1) (a)” and substituting the words “section 29 (2) (a)”.

Amendment of rule 37

12. Rule 37 of the Patents Rules is amended by deleting the words “section 29 (1) (b) or (6) (b)” and substituting the words “section 29 (2) (b)”.

Deletion and substitution of rule 38

13. Rule 38 of the Patents Rules is deleted and the following rule substituted therefor:

“Period for filing request for search report

38.—(1) The period prescribed for the purposes of section 29 (2) (a) shall be —

- (a) if the application contains no declared priority date, 13 months from the date of filing; or
- (b) if the application contains a declared priority date, 13 months from the declared priority date.

(2) Notwithstanding paragraph (1), where a new application is filed under section 20 (3), 26(6) or 47(4), as the case may be, the period prescribed for the purposes of section 29 (2) (a) shall be 13 months from the actual date of filing of the new application.”.

Deletion of rule 39

14. Rule 39 of the Patents Rules is deleted.

Amendment of rule 40

15. Rule 40 of the Patents Rules is amended —

- (a) by deleting the words “section 29” in paragraph (1) and substituting the words “section 29(3) and (6)”;
- (b) by inserting, immediately after paragraph (1), the following paragraph:
 - “(1A) The documentation prescribed for the purposes of section 38A(7) (“minimum documentation”) shall consist of —
 - (a) the patents issued by or registered in Singapore;
 - (b) the patent applications published in Singapore;
 - (c) the “national patent documents” as specified in paragraph (2); and
 - (d) the published international (Patent Co-operation Treaty) applications.”;
- (c) by inserting, immediately after the words “the “minimum documentation”” in paragraph (3), the words “referred to in paragraph (1) or (1A)”;
- (d) by inserting, immediately after the words “the “minimum documentation”” in paragraph (4), the words “referred to in paragraph (1) or (1A)”.

Deletion and substitution of rules 41 and 42

16. Rules 41 and 42 of the Patents Rules are deleted and the following rules substituted therefor:

“Prescribed patent offices

41. The patent offices prescribed for the purposes of the definitions of “corresponding application” and “corresponding patent” in section 2 (1) and of section 29 (2) (c) shall be —

- (a) those of Australia, Canada (in respect of applications for a Canadian patent filed in the English language), Japan, New Zealand, the United Kingdom and the United States of America; and
- (b) the European Patent Office (in respect of applications for a European patent filed in the English language).

Request for examination report

42.—(1) A request for an examination report under section 29 (2) (c) (i), (d) (i) or (e) (i) or (4) shall be made on Patents Form 12.

(2) A request for an examination report under section 29 (2) (c) (i), (d) (i) or (e) (i) shall not be treated as having been made unless the form required under paragraph (1) is accompanied by —

- (a) in the case of a request for an examination report under section 29 (2) (c) (i), a copy of the search report referred to in section 29 (2) (c) (i) together with each of the documents referred to in that search report;
- (b) in the case of a request for an examination report under section 29 (2) (d) (i), a copy of the international search report in respect of the corresponding international application referred to in section 29 (2) (d) (i) together with —
 - (i) the original or a copy of each of the documents referred to in that international search report; and
 - (ii) the original or a copy of the international preliminary report on patentability in respect of that corresponding international application, if available;
- (c) in the case of a request for an examination report under section 29 (2) (e) (i), a copy of the international search report in respect of the application referred to in section 29 (2) (e) (i) together with —
 - (i) the original or a copy of each of the documents referred to in that international search report; and
 - (ii) the original or a copy of the international preliminary report on patentability in respect of that application, if available;
- (d) a list of references to the patent family members as corresponding to each of the non-English documents cited in the search report referred to in section 29 (2) (c) (i) or the international search report referred to in section 29 (2) (d) (i) or (e) (i); and
- (e) where any copy of a search report, international search report, international preliminary report on patentability or list of references to the patent family members referred to in this paragraph, or any part of that copy or list, is in a language other than English —
 - (i) an English translation of that copy, list or part; and
 - (ii) a copy of a verification document —
 - (A) made in accordance with the Registrar's requirements; and

(B) verifying that the translation corresponds to the original text of that copy, list or part.

(3) Where an applicant has filed a request for an examination report under section 29 (2) (c) (i), (d) (i) or (e) (i), the Registrar may require the applicant to furnish, in respect of any document referred to in the search report or international search report, as the case may be, that is in a language other than English —

- (a) an English translation of the whole or any part of that document; and
- (b) a copy of a verification document —
 - (i) made in accordance with the Registrar’s requirements; and
 - (ii) verifying that the translation corresponds to the original text of that document or part thereof.

(4) The Registrar may, by notice sent to the applicant, require him to —

- (a) furnish the copy of the verification document referred to in paragraph (2)(e); or
- (b) furnish the translation and copy of the verification document referred to in paragraph (3),

within such period as may be specified in the notice.

(5) Where an applicant fails to comply with paragraph (3) within the period specified in a notice under paragraph (4)(b), the request for an examination report shall be treated as having been abandoned.”

New rule 42A

17. The Patents Rules are amended by inserting, immediately after rule 42, the following rule:

“Reliance on international preliminary report on patentability

42A. A notice of intention to rely on an international preliminary report on patentability under section 29 (2) (e) (ii) shall be filed using Patents Form 11C.”

Deletion and substitution of rules 43 and 44

18. Rules 43 and 44 of the Patents Rules are deleted and the following rules substituted therefor:

“Period prescribed under section 29 (2) (b) to (e) or (4)

43.—(1) Subject to paragraphs (2) and (3), the period prescribed for filing a request for a search and examination report under section 29 (2) (b) or a request for an examination report under section 29 (2) (c) (i), (d) (i) or (e) (i) or (4) shall be 21 months from —

- (a) the declared priority date; or
- (b) where there is no declared priority date, the date of filing the application.

(2) Subject to paragraph (3), where a new application is filed under section 20 (3), 26(6) or 47(4), as the case may be, the period prescribed for the purposes specified in paragraph (1) shall be 21 months from the actual date of filing of the new application.

(3) Where the Registrar sends the applicant a copy of the search report under section 29 (3) (b) at any time later than one month before the expiry of the period prescribed under paragraph (1) or (2), as the case may be, the period prescribed for filing a request for an examination report under section 29 (4) shall be one month from the date of the Registrar’s notification under section 29 (3) (b).

(4) The period prescribed for filing the prescribed information relating to a corresponding application under section 29 (2) (c) (ii), the prescribed information relating to a corresponding international application under section 29 (2) (d) (ii) or a notice in Patents Form 11C under section 29 (2) (e) (ii) shall be —

- (a) subject to sub-paragraph (b), 42 months from —
 - (i) the declared priority date of the application; or
 - (ii) where there is no declared priority date, the date of filing of the application; or
- (b) where a new application is filed under section 20 (3), 26(6) or 47(4), as the case may be, 42 months from the actual date of filing of the new application,

or the date on which section 30 (2) (c) is complied with and the prescribed fee for the grant of a patent is paid in accordance with rule 47(3), whichever is the earlier.

Information prescribed under section 29 (2) (c) (ii) or (d) (ii)

44.—(1) The information prescribed for the purposes of section 29 (2) (c) (ii) or (d) (ii) shall be —

- (a) that which is sufficient to indicate the result of the corresponding application under section 29 (2) (c) (ii) or corresponding international

application under section 29 (2) (d) (ii), as the case may be, and shall be in the form of —

- (i) a copy of the patent granted by the patent office in question which is —
 - (A) duly certified by that patent office; or
 - (B) otherwise acceptable to the Registrar; or
- (ii) other documents, to the satisfaction of the Registrar, setting out the final results of the search and examination as to substance and a copy of the patent claims referred to in the final results; and

(b) any symbol of the International Patent Classification which has been or which in the opinion of the applicant should be allocated to the application.

(2) The information referred to in paragraph (1) shall be furnished in Patents Form 11B.”.

Amendment of rule 45

19. Rule 45 of the Patents Rules is amended —

- (a) by deleting the words “either paragraph (a) or (b) of section 29(1), or section 29(6)(b)” in paragraph (1) and substituting the words “section 29(2)(a) or (b)”;
- (b) by inserting, immediately after the words “Patents Form 10” in paragraph (2), the word “for”;
- (c) by deleting paragraph (3) and substituting the following paragraphs:

“(3) If a new application for a patent is filed under section 26(6) in respect of any part of the matter contained in an earlier application for a patent, the applicant may, in lieu of complying with section 29(2)(a), notify the Registrar in writing that he intends to rely on —

- (a) any search report or supplementary search report established in the earlier application; or
- (b) where the earlier application is an international application for a patent (Singapore) that has entered the national phase in Singapore under section 86(3), any international search report or international supplementary search report

established during the international phase of the earlier application.

(4) Rule 42(2) to (5) shall apply to any request for an examination report that is filed by an applicant who relies on an international search report or international supplementary search report under paragraph (3).”; and

(d) by deleting the marginal note and inserting the following rule heading:

“Search procedure where 2 or more inventions claimed”.

Amendment of rule 46

20. Rule 46 of the Patents Rules is amended —

(a) by deleting paragraph (1) and substituting the following paragraph:

“(1) If during an examination under section 29(5) or (6), the Examiner is of the opinion that —

(a) the description, claims, or drawings are so unclear, or the claims are so inadequately supported by the description, that no meaningful opinion can be formed on —

(i) the novelty or inventive step of the claimed invention; or

(ii) whether the claimed invention is capable of industrial application;

(b) the invention defined in any claim —

(i) does not appear novel;

(ii) does not appear to involve an inventive step; or

(iii) does not appear to be capable of industrial application;

(c) the conditions specified in sections 13 and 25 (4) and (5) have not been complied with;

(d) the application discloses —

(i) any additional matter referred to in section 84(1); or

(ii) any matter extending beyond that disclosed in the application for the patent as filed; or

(e) a claim relates to an invention in respect of which no search has been completed, and he has decided not to carry out the examination in respect of that claim,

the Examiner shall notify the Registrar in writing of that opinion and shall state fully the reasons for his opinion.”;

(b) by deleting paragraphs (3), (4) and (5) and substituting the following paragraphs:

“(3) The applicant may file a response to the written opinion in Patents Form 13A containing —

(a) written submissions on the Examiner’s opinion; or

(b) an amendment of the specification of the application,

and where the applicant wishes to make written submissions and amend the specification of the application, he shall do both at the same time.

(4) Any response under paragraph (3) to a first written opinion in respect of —

(a) an examination report under section 29(5); or

(b) a search and examination report under section 29(6),

shall be filed within 5 months from the date of the Registrar’s notification enclosing the written opinion.

(5) Where the applicant has filed a response under paragraph (3) —

(a) the Examiner may, in his discretion, issue a further written opinion to the Registrar stating fully the reasons for the opinion;

(b) paragraphs (2) and (3) shall accordingly apply; and

(c) any response under paragraph (3) to the further written opinion shall be filed within 5 months from the date of the Registrar’s notification enclosing the further written opinion.”;

(c) by deleting the words “amendment or argument” in paragraph (7) and substituting the word “response”;

(d) by deleting paragraph (8) and substituting the following paragraph:

“(8) Subject to paragraphs (9) and (10), the Examiner shall send the search and examination report or examination report to the Registrar before the expiry of —

(a) 39 months from —

(i) the declared priority date; or

(ii) where there is no declared priority date, the date of filing the application; or

(b) where a new application is filed under section 20(3), 26 (6) or 47 (4), as the case may be, 39 months from the actual date of filing of the new application.”; and

(e) by deleting paragraph (10) and substituting the following paragraph:

“(10) Where the period for filing a request for a search and examination report under section 29(2)(b) or a request for an examination report under section 29(2)(c) (i), (d)(i) or (e)(i) or (4) has been extended under section 29(7), the Examiner shall send the search and examination report or examination report to the Registrar before the expiry of —

(a) 57 months from —

(i) the declared priority date; or

(ii) where there is no declared priority date, the date of filing the application; or

(b) where a new application is filed under section 20(3), 26 (6) or 47 (4), as the case may be, 57 months from the actual date of filing of the new application.”.

Amendment of rule 47

21. Rule 47 of the Patents Rules is amended —

(a) by deleting the words “section 30(1) shall be 54 months” in paragraph (1) and substituting the words “section 30(1)(a) shall be 42 months”;

(b) by deleting the words “54 months” in paragraph (2) and substituting the words “42 months”;

(c) by deleting paragraph (4) and substituting the following paragraph:

“(4) Where the specification of the application for a patent has been amended or corrected since the filing of the application —

- (a) if any such amendment or correction is made before or at the time of compliance with paragraph (3), the applicant shall file a specification incorporating every such amendment and correction at the time of compliance with paragraph (3); and
- (b) if any such amendment or correction is made after the time of compliance with paragraph (3), the applicant shall file a specification incorporating every such amendment and correction within such period as the Registrar may specify.”; and

(d) by inserting, immediately after paragraph (4), the following paragraph:

“(4A) The documents prescribed for the purposes of section 30(2)(c) shall be —

- (a) the completed Patents Form 14 filed under paragraph (3); and
- (b) every specification required to be filed under paragraph (4).”.

New rule 47A

22. The Patents Rules are amended by inserting, immediately after rule 47, the following rule:

“Extension of prescribed periods under sections 29 (7) and 30 (1) (a)

47A.—(1) A request under sections 29 (7) and 30(1)(a) to extend a prescribed period under section 29 (2) (b), (c) (i) or (ii), (d) (i) or (ii) or (e) (i) or (ii) or (4) and the corresponding prescribed period under section 30 (1) (a) shall be made on Patents Form 45A within —

- (a) subject to sub-paragraph (b), 39 months from —
 - (i) the declared priority date; or
 - (ii) where there is no declared priority date, the date of filing the application; or
- (b) where a new application is filed under section 20 (3), 26(6) or 47(4), as the case may be, 39 months from the actual date of filing of the new application.

(2) The extended period prescribed under section 29 (7) for filing a request for a search and examination report under section 29 (2) (b) or a request for an examination report under section 29 (2) (c) (i), (d) (i) or (e) (i) or (4) shall be —

- (a) subject to sub-paragraph (b), 39 months from —
 - (i) the declared priority date; or
 - (ii) where there is no declared priority date, the date of filing the application; or
- (b) where a new application is filed under section 20 (3), 26(6) or 47(4), as the case may be, 39 months from the actual date of filing of the new application.

(3) The extended period prescribed under section 29 (7) for filing the prescribed information relating to a corresponding application under section 29 (2) (c) (ii), the prescribed information relating to a corresponding international application under section 29 (2) (d) (ii) or a notice in Patents Form 11C under section 29 (2) (e) (ii) shall be —

- (a) subject to sub-paragraph (b), 60 months from —
 - (i) the declared priority date of the application; or
 - (ii) where there is no declared priority date, the date of filing of the application; or
- (b) where a new application is filed under section 20 (3), 26(6) or 47(4), as the case may be, 60 months from the actual date of filing of the new application,

or the date on which section 30 (2) (c) is complied with and the prescribed fee for the grant of a patent is paid in accordance with rule 47(3), whichever is the earlier.

(4) For the purposes of section 30 (1) (a), the extended prescribed period shall be —

- (a) subject to sub-paragraph (b), 60 months from —
 - (i) the declared priority date; or
 - (ii) where there is no declared priority date, the date of filing the application; or
- (b) where a new application is filed under section 20 (3), 26(6) or 47(4), as the case may be, 60 months from the actual date of filing of the new application.”.

Amendment of rule 49

23. Rule 49(2) of the Patents Rules is amended —

- (a) by deleting the words “section 29(1)(a)” in sub-paragraph (a) and substituting the words “section 29(2)(a)”;
- (b) by deleting the words “section 29(1)(b) or (6)(b)” in sub-paragraph (b) and substituting the words “section 29(2)(b)”;
- (c) by deleting the words “section 29(3), (6)(a) or (10)” in sub-paragraph (c) and substituting the words “section 29(2)(c) (i), (d)(i) or (e)(i) or (4)”.

Deletion and substitution of rule 50

24. Rule 50 of the Patents Rules is deleted and the following rule substituted therefor:

“Certificate of grant

50. A certificate of grant under section 35 (1) shall be in Certificate Form 1.”.

Amendment of rule 51

25. Rule 51 of the Patents Rules is amended —

- (a) by inserting, immediately after the words “a further year” in paragraph (1), the words “or part thereof”; and
- (b) by inserting, immediately after paragraph (2), the following paragraph:

“(2A) Where the Registrar has extended the term of a patent under section 36A after the expiry of the period of 20 years referred to in section 36(1), an application for the renewal of the patent may be filed, and any renewal fees which have become due (including any fees due in respect of preceding years) may be paid, within 3 months from the date of the certificate of extension of patent term issued under section 36A(11) in respect of the patent.”.

New rule 51A

26. The Patents Rules are amended by inserting, immediately after rule 51, the following rule:

“Extension of term of patent

51A.—(1) For the purposes of section 36A (10), an application to extend the term of a patent under section 36A (1) (a) or (b) shall be —

- (a) made on Patents Form 54 within 6 months from the date of the grant of the patent; and

(b) accompanied by —

- (i) the prescribed fee; and
- (ii) all documentary evidence which the applicant wishes to rely on to support the application.

(2) For the purposes of section 36A (10), an application to extend the term of a patent under section 36A (1) (c) shall be —

(a) made on Patents Form 54 —

- (i) within 6 months from —
 - (A) the date of the grant of the patent; or
 - (B) the date marketing approval was obtained, whichever is the later;
- (ii) not later than 6 months before the end of the period of 20 years referred to in section 36 (1); and
- (iii) in any case, while the patent is still in force; and

(b) accompanied by —

- (i) the prescribed fee;
- (ii) a certificate under section 36A (7);
- (iii) all other documentary evidence which the applicant wishes to rely on to support the application.

(3) Notwithstanding paragraph (1)(b) or (2)(b), the Registrar may direct an applicant for an extension of the term of a patent to produce, within such period as the Registrar may specify, such additional evidence in support of the application as the Registrar may reasonably require.

(4) A certificate of extension of patent term under section 36A (11) shall be in Certificate Form 2.”.

Amendment of rule 52

27. Rule 52 of the Patents Rules is amended by inserting, immediately after paragraph (9), the following paragraph:

“(10) Where an application to amend is filed using the electronic online system —

- (a) paragraphs (6) and (6A) shall not apply to the application; and
- (b) the application shall instead comply with practice directions issued by the Registrar in place of the requirements under those paragraphs.”.

New rule 52A

28. The Patents Rules are amended by inserting, immediately after rule 52, the following rule:

“Search and examination after grant

52A.—(1) A request for a search and examination report under section 38A(1) shall be made on Patents Form 55 and shall be accompanied by —

- (a) the prescribed fees;
- (b) a statement —
 - (i) identifying each ground under section 38A (1) on which the request has been made; and
 - (ii) explaining how that ground has been satisfied; and
- (c) each observation or document referred to in section 38A (3), if any.

(2) Where the Registrar grants a request under section 38A (1), he shall forward to the Examiner —

- (a) the request;
- (b) the statement referred to in paragraph (1)(b); and
- (c) any observation or document filed under section 38A (3) and paragraph (1).

(3) If during the preparation of a report under section 38A in respect of any claim or claims in the specification of a patent, it appears that the claim or claims relate to 2 or more inventions which are not so linked as to form a single inventive concept —

- (a) the search and examination may be restricted to the first invention specified in the claim or claims; and
- (b) the Registrar shall notify —
 - (i) the proprietor of the patent; and
 - (ii) where the request under section 38A (1) was not filed by the proprietor, the person who filed the request,of that fact.

(4) If —

- (a) the proprietor of the patent; or
- (b) where the request under section 38A (1) was not filed by the proprietor, the person who filed the request,

desires a search and examination to be conducted in relation to a second or subsequent invention specified in the claim or claims, he shall, within 2 months from the date of the Registrar's notification referred to in paragraph (3), request on Patents Form 55 for a supplementary search and examination report and pay the prescribed search and examination fee for each invention in respect of which the search and examination is to be made.

(5) If during an examination under section 38A, the Examiner is of the opinion that —

- (a) the description, claim or claims, or drawings are so unclear, or the claim or claims are so inadequately supported by the description, that no meaningful opinion can be formed on —
 - (i) the novelty or inventive step of the claimed invention; or
 - (ii) whether the claimed invention is capable of industrial application;
- (b) the conditions specified in requirements of sections 13 and 25(4) and (5) have not been complied with; or
- (c) the specification of the patent discloses —
 - (i) any additional matter referred to in section 84 (1); or
 - (ii) any matter extending beyond that disclosed in the application for the patent as filed,

the Examiner shall notify the Registrar in writing of that opinion and shall state fully the reasons for his opinion.

(6) The Registrar shall, on receipt of the written opinion, forward the opinion as soon as possible to the proprietor of the patent, together with an invitation to the proprietor to file a response thereto.

(7) The proprietor of the patent may file a response to the written opinion in Patents Form 13A containing —

- (a) written submissions on the Examiner's opinion; or
- (b) a proposed amendment of the specification of the patent,

and where the proprietor wishes to make written submissions and propose an amendment of the specification of the application, he shall do both at the same time.

(8) Any response under paragraph (7) to a written opinion in respect of a search and examination report under section 38A shall be filed within 3 months from the date of the Registrar's notification enclosing the written opinion.

(9) Where the proprietor of a patent has filed a response under paragraph (7) —

- (a) the Registrar shall forward the response to the Examiner; and
- (b) the Examiner shall consider the response and prepare the search and examination report.

(10) Where the proprietor of a patent does not file a response under paragraph (7) within the period specified in paragraph (8) —

- (a) the Registrar shall notify the Examiner accordingly; and
- (b) the Examiner shall prepare the search and examination report.

(11) The Examiner shall send the search and examination report to the Registrar before the expiry of 10 months from the date the Registrar forwarded the request under section 38A (1) to the Examiner.

(12) Upon receiving the search and examination report, the Registrar shall proceed in accordance with section 38A (9).”.

Amendment of rule 53

29. Rule 53 of the Patents Rules is amended —

- (a) by deleting the words “supported by evidence of the statements made in it” in paragraph (1)(b) and substituting the words “together with a statutory declaration or affidavit setting out the grounds for the application and the evidence in support thereof”; and
- (b) by inserting, immediately after the words “upon consideration of the” in paragraph (2), the words “grounds and”.

Amendment of rule 55

30. Rule 55(3) of the Patents Rules is amended by inserting, immediately after sub-paragraph (g), the following sub-paragraphs:

- “(ga) the date of any application under section 36A to extend the term of the patent;

- (*gb*) the period of the extension of the term of the patent under section 36A, if any;
- (*gc*) the date of any search and examination report issued under section 38A;”.

Deletion and substitution of rule 57

31. Rule 57 of the Patents Rules is deleted and the following rule substituted therefor:

“Application for registration of transaction, etc.

57.—(1) An application to register, or to give notice to the Registrar of, any transaction, instrument or event to which section 43 applies shall be made on Patents Form 24.

(2) Subject to paragraph (3), an application under paragraph (1) in respect of any transaction, instrument or event referred to in section 43 (3) (*a*), (*b*), (*c*) or (*d*) shall, for —

- (*a*) each party to the transaction or instrument; or
- (*b*) each person —
 - (i) giving assent; or
 - (ii) on whom any patent, application for a patent or right is to be vested,

under section 43 (3) (*d*),

be accompanied by a declaration of authorisation in Patents Form 41 in respect of that party or person.

(3) An application under paragraph (1) in respect of any transaction, instrument or event referred to in section 43 (3) (*a*), (*b*), (*c*) or (*d*) need not be accompanied by a declaration of authorisation in Patents Form 41 in respect of a party or person referred to in paragraph (2) if —

- (*a*) a declaration of authorisation in Patents Form 41 which was filed earlier in respect of that party or person is in sufficiently wide terms to cover that transaction, instrument or event;
- (*b*) that party or person is the person making the application; or
- (*c*) the person making the application complies with paragraph (4).

(4) If —

- (*a*) paragraph (2) is not complied and sub-paragraphs (*a*) and (*b*) of paragraph (3) do not apply;

- (b) paragraph (2) does not apply; or
- (c) the Registrar so directs,

the person making an application under paragraph (1) shall lodge with the Registrar, within such period as the Registrar may specify —

- (i) a copy of any document establishing the transaction, instrument or event which is —
 - (A) duly certified; or
 - (B) otherwise acceptable to the Registrar; or
- (ii) a copy each of such extracts from such documents as are sufficient to establish the transaction, instrument or event which is —
 - (A) duly certified; or
 - (B) otherwise acceptable to the Registrar.”.

New heading and new rule 75A

32. The Patents Rules are amended by inserting, immediately after rule 75, the following heading and rule:

INFRINGEMENT OF PATENTS

Particulars prescribed under section 66 (2B)

75A. A written notice to an importer under section 66 (2B) shall contain the following particulars:

- (a) a statement that the notice is issued in accordance with section 66 (2B);
- (b) the patent number (or P-No.) of the patent relied on, as stated in the certificate of grant;
- (c) the date of filing of the application pursuant to which that patent was granted;
- (d) the date on which that patent was granted;
- (e) the name and address of each proprietor of that patent;
- (f) the address for service of the proprietor or proprietors, as the case may be;
- (g) the name and address of the person referred to in section 66 (2A) (b) (ii);
- (h) a detailed statement explaining how the import of the patented product by the importer would result in the product being distributed in breach of the contract referred to in section 66 (2A) (b);

- (i) the text of all clauses in the contract referred to in section 66 (2A) (b) which are relied on or referred to in the statement under paragraph (h).”.

Deletion of rule 79

33. Rule 79 of the Patents Rules is deleted.

New rule 80A

34. The Patents Rules are amended by inserting, immediately after rule 80, the following rule:

“Material information prescribed under section 80 (1) (f) (iii)

80A. The material information for the purposes of section 80 (1) (f) (iii) shall be —

- (a) any prescribed information relating to a corresponding application referred to in —
 - (i) section 29 (2) (c) (ii); or
 - (ii) repealed section 29 (5) in force immediately before 1st July 2004;
- (b) any prescribed information relating to a corresponding international application referred to in —
 - (i) section 29 (2) (d) (ii); or
 - (ii) repealed section 29 (5) in force immediately before 1st July 2004; and
- (c) where the prescribed information referred to in paragraph (a) or (b) includes any document that is not in English, the English translation of such document that was filed.”.

Amendment of rule 86

35. Rule 86(4) of the Patents Rules is amended —

- (a) by deleting sub-paragraph (c); and
- (b) by deleting the words “by rule 112 (1) and (2)” in sub-paragraph (d) and substituting the words “under rule 112”.

Deletion and substitution of rule 90

36. Rule 90 of the Patents Rules is deleted and the following rule substituted therefor:

“Right of audience

90.—(1) Unless the Registrar directs otherwise in any particular case —

(a) all attendances upon the Registrar by a party to any proceedings before the Registrar or any other matter under the Act or these Rules may be made by or through —

(i) an advocate and solicitor; or

(ii) any other person,

appointed by the party to act on his behalf; and

(b) every notice, application or other document filed under the Act by the party may be signed by the advocate and solicitor or person so appointed.

(2) Where any party to any proceedings before the Registrar or any other matter under the Act or these Rules appoints an advocate and solicitor or any other person —

(a) to act on his behalf; or

(b) to act on his behalf in substitution for another,

the advocate and solicitor or person shall file a declaration of authorisation in Patents Form 41 on the first occasion when he acts on behalf of the party.”.

Amendment of rule 96A

37. Rule 96A(2) of the Patents Rules is amended by deleting sub-paragraph (b) and substituting the following sub-paragraph:

“(b) the filing with the Registry of any form referred to in —

(i) rule 9 (3)(b), 18 (1), 29 (3), 36, 37, 42 (1), 42A, 44 (2), 45 (2), 47 (3), 47A (1), 48 (1), 51 (3), (3A) or (7), 52 (1), 52A (7), 53 (1)(b) or (4), 54 (1), 56 (1), (3) or (3A), 57 (1) or (2), 58 (1), 63 (1) or (2), 70 (1), 75 (4), 86 (2) or (7), 88 (1), 90 (2), 91 (1) or (3), 92 (3), 93 (1) or (2) or 108 (3), (3A), (4) or (6); or

- (ii) revoked rule 39 (2) in force immediately before 1st July 2004;”.

Amendment of rule 96C

38. Rule 96C of the Patents Rules is amended by inserting, immediately after paragraph (2), the following paragraph:

“(3) In this rule and rule 96D, “certificate” has the same meaning as in the Electronic Transactions Act (Cap. 88).”.

Amendment of rule 97

39. Rule 97 of the Patents Rules is amended by deleting the marginal note and inserting the following rule heading:

“**Service of documents**”.

Deletion and substitution of rule 98

40. Rule 98 of the Patents Rules is deleted and the following rule substituted therefor:

“Hours of business and excluded days

98.—(1) Subject to paragraphs (4), (7) and (10), any business done under the Act or these Rules —

- (a) on any day after the hours of business of the Registry for that class of business; or
- (b) on any day which is an excluded day for that class of business,

shall be taken to have been done on the next following day which is not an excluded day for that class of business.

(2) Where the time for doing any business under the Act or these Rules expires on an excluded day for the doing of that class of business, that time shall be extended to the next following day which is not an excluded day for the doing of that class of business.

(3) For the avoidance of doubt, where the time for the submission or filing of any document pertaining to an application for a patent by means of the Patents Deposit Box expires on an excluded day for the submission or filing of that document in that manner, that time shall be extended to the next following day which is not an excluded day for the submission or filing of that document in that manner, notwithstanding the availability of the Patents Deposit Box for the submission or filing of that document.

(4) Where a document is submitted or filed by means of the Patents Deposit Box at any time before midnight on any day which is not an excluded day for the business of submitting or filing that document, that document shall be treated as submitted or filed at that time and on that day.

(5) For the purposes of paragraph (4), a document shall be treated as submitted or filed if and only if all sheets comprising the complete document have been deposited in the Patents Deposit Box.

(6) For the avoidance of doubt, where the time for carrying out any transaction referred to in rule 96A(2) expires on an excluded day for the carrying out of that transaction, that time shall be extended to the next following day which is not an excluded day for the carrying out of that transaction, notwithstanding the availability of the electronic online system for the carrying out of that transaction.

(7) Where, in carrying out any transaction referred to in rule 96A(2), a document —

- (a) is transmitted to the Registry by means of the electronic online system; and
- (b) is received, by the server of that system set up to receive such transmissions, at any time before midnight on any day which is not an excluded day for the business of sending to or filing with the Registry that document by means of that system,

that document shall be treated as sent to or filed with, and received by, the Registry at that time and on that day.

(8) For the purposes of paragraph (7), a document shall be treated as sent to or filed with, and received by, the Registry if and only if the last byte of the transmission containing the document is received by the server referred to in that paragraph.

(9) Any person who sends or files a document by means of the electronic online system may produce a record of transmission issued through that system together with a copy of the notification of acceptance of that document by the Registrar as evidence of —

- (a) the sending or filing of that document; and
- (b) the date and time when the sending or filing took place.

(10) Subject to rule 97(2), where a document referred to in rule 97(2) —

- (a) is transmitted to the Registrar or Registry by means of facsimile transmission; and

- (b) is received —
- (i) by any facsimile machine designated by the Registry for the receipt of such transmissions; and
 - (ii) at any time before midnight on any day which is not an excluded day for the business of sending to or filing with the Registry of that document by means of facsimile transmission,

that document shall be treated as sent to or filed with, and received by, the Registry at that time and on that day.

(11) For the purposes of paragraph (10) —

- (a) a document shall be treated as sent to or filed with, and received by, the Registry if and only if all sheets comprising the complete document are received by the facsimile machine referred to in that paragraph; and
- (b) the date and time of receipt of the document, as recorded by the facsimile machine referred to in that paragraph, shall, until the contrary is proved, be treated as the date and time when the document was sent to or filed with, and received by, the Registry.

(12) In the Act and these Rules, “excluded day”, in relation to any specific class of business, means any day on which the Registry shall be taken to be closed for the purposes of the transaction by the public of that class of business.

(13) In this rule, “Patents Deposit Box” means the box with openings for placing documents that is installed at the premises of the Registry and designated as such.”.

Deletion of rule 99

41. Rule 99 of the Patents Rules is deleted.

Amendment of rule 102

42. Rule 102 of the Patents Rules is amended by deleting paragraph (2) and substituting the following paragraphs:

“(2) The original statutory declaration or affidavit shall be filed, unless the Registrar directs in any particular case that a copy thereof may be filed.

(3) Unless the Registrar directs otherwise, he —

- (a) may, if he thinks fit in any particular case, in lieu of or in addition to such evidence —

- (i) take oral evidence; or
 - (ii) accept any written statement or documentary evidence; and
- (b) shall allow any witness to be cross-examined on any evidence given by the witness.”.

Amendment of rule 103

43. Rule 103 of the Patents Rules is amended by deleting the words “filed under the Act or these Rules” and substituting the words “, the original or a copy of which is to be filed under the Act or these Rules,”.

Deletion and substitution of rule 105

44. Rule 105 of the Patents Rules is deleted and the following rule substituted therefor:

“Directions as to furnishing of documents

105. At any stage of —

- (a) any proceedings before the Registrar; or
- (b) any other matter under the Act or these Rules,

the Registrar may direct that such documents, information or evidence as he may require shall be furnished within such period as he may fix.”.

Amendment of rule 108

45. Rule 108 of the Patents Rules is amended —

- (a) by deleting “26 (5), 26 (6)” in paragraph (2) and substituting the words “26 (5) and (6)”;
- (b) by deleting the words “46 (4), (5), (8) and (10)” in paragraph (2) and substituting the words “46 (4) and (5)(c), 47A (1)”;
- (c) by inserting, immediately after “51 (1)” in paragraph (2), the words “and (2A), 51A (1) and (2)”;
- (d) by inserting, immediately after “52 (2),” in paragraph (2), “52A (8),”;
- (e) by deleting “91 (1), 91 (3), 91 (4)” in paragraph (2) and substituting the words “91 (3) and (5)”;
- (f) by deleting paragraph (3) and substituting the following paragraph:

“(3) A time or period prescribed in rules 9 (2), (2A) and (5), 18 (1), 26 (2) and (4), 28 (except so far as it relates to rule 9 (1)), 38 (1), 43, 47 (1) and (2), 53 (4), 86 (1), (6) and (8), 97 (2)(c) and paragraph 1(3) of the Fourth Schedule shall, if not previously extended, be extended for a period not exceeding 3 months upon filing Patents Form 45 before the end of the period for which extension is sought.”; and

(g) by deleting paragraph (4) and substituting the following paragraphs:

“(4) Without prejudice to paragraph (3) but subject to paragraph (4A) —

- (a) a time or period prescribed in the rules referred to in paragraph (3) may, upon request made on Patents Form 46, be extended or further extended if the Registrar thinks fit, whether or not the time or period (including any extension obtained under paragraph (3)) has expired; and
- (b) the Registrar may allow an extension, or further extension, under this paragraph —
 - (i) on such terms as he may direct; and
 - (ii) subject to the furnishing of a statutory declaration or affidavit setting out the grounds for the request.

(4A) Where the period under rule 86 (1) has expired and a request to extend the period is made under paragraph (4) within 42 months from —

- (a) the declared priority date; or
- (b) where there is no declared priority date, the date of filing of the application for a patent,

the Registrar shall allow the extension sought if he is satisfied, after considering the statutory declaration or affidavit setting out the grounds for the request, that the delay giving rise to the request was unintentional.”.

Amendment of rule 112

46. Rule 112 of the Patents Rules is amended —

- (a) by deleting the words “, verified to the satisfaction of the Registrar as corresponding to the original text” in paragraph (1);

- (b) by deleting the words “verified as aforesaid” in paragraph (5); and
- (c) by inserting, immediately after paragraph (5), the following paragraphs:

“(6) A translation referred to in paragraph (1) or (5) of a document shall be accompanied by a copy of a verification document —

- (a) made in accordance with the Registrar’s requirements; and
- (b) verifying that the translation corresponds to the original text of the document.

(7) The Registrar may, by notice, require a person who files a translation referred to in paragraph (1) or (5) to furnish the original of the verification document referred to in paragraph (6) within such period as may be specified in the notice.”.

Amendment of First Schedule

47. The First Schedule to the Patents Rules is amended —

- (a) by inserting, immediately after item 10, the following item:

“

10A.	On filing a notice of withdrawal of an application for a patent under section 27(1)	—	9A
------	---	---	----

”;

- (b) by deleting items 11 and 12 and substituting the following items:

“

11.	On filing a request for a search report or a supplementary search report	1,600	10
12.	On filing a request for a search and	2,300	11

”

examination
report
”;

- (c) by deleting the words “rule 39 (1)” in item 12A and substituting the words “revoked rule 39 (1) in force immediately before 1st July 2004”;
- (d) by inserting, immediately after item 12B, the following item:

“
12C. On — 11C
filing a
notice of
intention to
rely on an
international
preliminary
report on
patentability
”;

- (e) by deleting item 13 and substituting the following item:

“
13. On 1,050 12
filing a
request for
an
examination
report
”;

- (f) by inserting, immediately after item 14, the following item:

“
14A. On — 13A
filing a
response
to a
written
opinion
under
section 31
or 38A

”;

(g) by deleting items 15 and 16A and substituting the following items:

“

15. On request that a certificate of grant be issued — 14

(a) where the application for a patent has a date of filing before 1st July 2004 170

(b) where the application for a patent has — 200

(i) a date of filing on or after 1st July 2004; and

(ii) not more than 25 claims in the patent specification

when rule 47

(3) is complied with

(c) where the application for a patent has — 200 plus 20 for each claim in excess of 25 claims

(i) a date of filing on or after 1st July 2004; and

(ii) more than 25 claims in the patent specification

when rule 47

(3) is complied with

16. On payment of renewal fee (not 15

including payment of back renewal fees pursuant to restoration or cancellation of entry in the register that licences are available as of right) —

(a) for each year in respect of the 5th, 6th or 7th year of the patent 150

(b) for each year in respect of the 8th, 9th or 10th year of the patent 250

(c) for each year in respect of the 11th, 12th or 13th year of the patent 350

(d) for each year in respect of the 14th, 15th or 16th year of the patent 450

(e) for each year in respect of the 17th, 18th or 19th year of the patent 550

(f) for the 20th year of the patent 650

(g) for each year after the 20th year of the patent 950

”;

(h) by deleting the words “section 79(1)” in item 36 and substituting the words “repealed section 79(1) in force immediately before 1st July 2004”;

(i) by inserting, immediately after item 49, the following item:

“

49A.	On	1,800	45A
	request for		
	extension of		
	periods under		

sections 29(7)
and 30 (1) (a)
”;

(j) by deleting item 56 and substituting the following items:

“

56. On payment of renewal fee under section 53 or 54 —	53
(a) for each year in respect of the 5th, 6th or 7th year of the patent	75
(b) for each year in respect of the 8th, 9th or 10th year of the patent	125
(c) for each year in respect of the 11th, 12th or 13th year of the patent	175
(d) for each year in respect of the 14th, 15th or 16th year of the patent	225
(e) for each year in respect of the 17th, 18th or 19th year of the patent	275
(f) for the 20th year of the patent	325

(g) for each year after the 20th year of the patent	475	
56A. On application to extend the term of a patent under section 36A	950	54
56B. On filing a request for a search and examination report after grant under section 38A —		55
(a) where the Examiner is the Australian Patent Office	2,340	
(b) where the Examiner is the Austrian Patent Office	2,060	
(c) where the Examiner is the Danish Patent and Trademark Office	2,515	
”; and		

(k) by deleting item 59 and substituting the following item:

“

59. For using the services of a service bureau referred to in rule 96K to

—

file any
of the
following
by means
of the
electronic
online
system:

(a) any 120 plus 0.50 for each page of form
form or or document
other
document
referred
to in rule
36, 37, 42
(1), 45
(2) or
47A (1)

(b) any 45 plus 0.50 for each page of form or
form or document
other
document
referred
to in rule
9 (3) (b),
19 (1), 29
(3), 47
(3), 51
(3), (3A)
or (7), 52
(1), 53
(1) (b) or
(4), 54
(1), 56
(1), (3) or
(3A), 57
(1) or (2),
58 (1), 63
(1) or (2),
70 (1), 75
(4), 86
(2) or (7),
88 (1), 90
(2), 91
(1) or (3),
92 (3), 93
(1) or (2)
or 108

(3), (3A),
(4) or (6)
”.

Deletion and substitution of Second Schedule

48. The Second Schedule to the Patents Rules is deleted and the following Schedule substituted therefor:

“SECOND SCHEDULE

Rule 4(3)

DESCRIPTIONS OF FORMS

<i>Form</i>	<i>Description of Form</i>
Certificate Form 1	Certificate of Grant
Certificate Form 2	Certificate of Extension of Patent Term
Patents Form 1	Request for the Grant of a Patent under section 25
Patents Form 2	Reference under section 20 (1) or 47(1)
Patents Form 3	Counter-Statement
Patents Form 4	Application under section 20 (5) or 47(3) for Authorisation by the Registrar
Patents Form 5	Request for Directions under section 22
Patents Form 6	Reference under section 23 (5) or 48(5) to Determine the Question of a Licence
Patents Form 7	Application to Registrar under section 24 (1) and/or 24 (3)
Patents Form 8	Statement of Inventorship and of Right to the Grant of a Patent under section 24
Patents Form 9	Request for Early Publication under section 27 (2)
Patents Form 9A	Withdrawal of an Application for a Patent under section 27 (1)
Patents Form 10	Request for a Search Report or Supplementary Search Report
Patents Form 11	Request for a Search and Examination Report

Patents Form 11A	Furnishing of Prescribed Details
Patents Form 11B	Furnishing of Prescribed Information
Patents Form 11C	Notice of Intention to Rely on International Preliminary Report on Patentability under section 29 (2) (e) (ii)
Patents Form 12	Request for an Examination Report
Patents Form 13	Request to Amend Application before Grant under section 31 (2)
Patents Form 13A	Response to Written Opinion under section 31 or 38A
Patents Form 14	Payment of Fee for Grant of a Patent under section 30
Patents Form 15	Payment of Renewal Fee under section 36 (2) or 54(2)
Patents Form 16	Payment of Additional Fee under section 36 (3)
Patents Form 17	Application to Amend Specification after Grant under section 38
Patents Form 18	Notice of Opposition to Amendment of Specification after Grant under section 38 or 83
Patents Form 19	Application for Restoration of a Patent under section 39
Patents Form 20	Additional Fee on the Application for Restoration of a Patent under section 39
Patents Form 21	Offer to Surrender a Patent under section 40 (1)
Patents Form 22	Notice of Opposition to Offer to Surrender a Patent under section 40 (2)
Patents Form 23	Request for Alteration of Name, Address or Address for Service, or Correction of an Error, Clerical Error or Mistake under section 107
Patents Form 24	Application to Register or to Give Notice of a Transaction, Instrument or Event Affecting the Rights in a Patent or an Application for a Patent under section 43
Patents Form 25	Request for Miscellaneous Information under section 42 or 108
Patents Form 26	Request for Certificate of the Registrar under section 45

Patents Form 27	Application for Entry of Order of Court in the Register under section 43
Patents Form 28	Application for Entry to be Made in the Register to the Effect that Licences under the Patent are to be Available as of Right under section 53 (1)
Patents Form 29	Application for Settlement Terms of a Licence of Right under section 53 (3)
Patents Form 30	Application under section 54 (1) or (3) for Cancellation of Entry in the Register
Patents Form 31	Notice of Opposition to an Application under section 54 (1) or (3) for Cancellation of Entry in the Register
Patents Form 32	Reference to the Registrar of a Dispute as to Infringement under section 67 (3)
Patents Form 33	Application for Declaration of Non-Infringement under section 78
Patents Form 34	Application for Information on Corresponding Applications for a Patent
Patents Form 35	Application for Revocation of a Patent under section 80
Patents Form 36	Request for Re-Examination of a Patent in Response to Direction of the Registrar under section 80
Patents Form 37	Payment of Fee for Entry into National Phase under section 86 (3)
Patents Form 38	Payment of Prescribed Fee and Request for Publication of Translation under section 86 (7)
Patents Form 39	Application to the Registrar for an International Application to be Treated as an Application under the Act under section 85
Patents Form 40	Request for the Exercise of the Registrar's Discretionary Powers under section 92
Patents Form 41	Declaration of Authorisation where an Agent is Appointed or where One Agent is Substituted for Another
Patents Form 42	Additional Fee for the Advertisement of Proposed Correction under section 107
Patents Form 43	Notice of Opposition to the Correction of an Error, Clerical Error or Mistake under section 107

Patents Form 44	Request for Information Relating to a Patent or an Application for a Patent under section 108
Patents Form 45	Request for Extension of Time or Period under rule 108(3)
Patents Form 45A	Request for Extension of Periods under sections 29 (7) and 30(1)(a)
Patents Form 46	Request for Extension of Time or Period under rule 108(4)
Patents Form 47	Additional Fee for Extension of Time or Period under rule 108(6)
Patents Form 48	Payment of Transmittal Fee under rule 14 of the Regulations under the Patent Co-Operation Treaty
Patents Form 49	Request for Certificate Authorising Release of Sample of Micro-Organism
Patents Form 50	Notice of Intention to Restrict Availability of Samples of Micro-Organisms to Experts
Patents Form 51	Request for Certificate Authorising Release of Sample of Micro-Organisms to an Expert
Patents Form 53	Payment of Renewal Fee pursuant to section 53 (3) (d)
Patents Form 54	Request for an Extension of the Term of a Patent under section 36A
Patents Form 55	Request for Search and Examination after Grant under section 38A”.

Deletion of Fifth Schedule

49. The Fifth Schedule to the Patents Rules is deleted.

Deletion and substitution of Seventh Schedule

50. The Seventh Schedule to the Patents Rules is deleted and the following Schedule substituted therefor:

“SEVENTH SCHEDULE

Rule 120

MODIFIED APPLICATION OF THE ACT AND RULES TO UNITED KINGDOM AND
EUROPEAN PATENT OFFICE APPLICATIONS

1. In this Schedule, “foreign application” means —

- (a) an application for a patent under the United Kingdom Patents Act 1977; or
- (b) an application designating the United Kingdom filed at the European Patent Office.

2. Where a foreign application is pending on 23rd February 1995, and the applicant makes an application under section 116(6) of the Patents Act (Cap. 221, 1995 Ed.) for the grant of a patent, the provisions of the Act and these Rules shall apply to the foreign application with the following modifications:

- (a) where the application under section 116(6) of the Patents Act (Cap. 221, 1995 Ed.) is filed after the 16-month period prescribed in rule 9(2) or 18(1) —
 - (i) all the requirements of rules 9 and 18, except for the prescribed period of 16 months, shall be complied with within the same day of filing the application; and
 - (ii) the requirements of rule 1(2)(a)(ii) and (3) of the Fourth Schedule, in a case to which they apply, shall be complied with on or before the time ascertained under the said rule 1(3) or the time of filing the application, whichever is the later;
- (b) the application for the patent shall, notwithstanding rule 19, be treated as having been abandoned unless —
 - (i) the description, claims and drawings required to be filed are identical with those as filed with the foreign application;
 - (ii) the application is accompanied by a certified copy of the description, claims and drawings as filed with the foreign application; and
 - (iii) a declaration stating that the foreign application was pending on 23rd February 1995 is made within the same day of filing the application;
- (c) the requirements of section 26 (1) are modified to the extent that the application shall be accorded, under section 116(6) of the Patents Act (Cap. 221, 1995 Ed.), the same date of filing as the date of filing of the foreign application, when the following considerations are satisfied in relation to the application:
 - (i) the considerations of section 26 (1) (a) and (b); and
 - (ii) the documents filed at the Registry contain a description of the invention which is identical with that as filed with the foreign application as of its filing date;
- (d) the period prescribed for the purposes of section 28 (1) shall be the period which expires on the actual date of filing of the application;

- (e) the requirements of rule 29 are modified to the extent that the 18-month period under rule 29(1) or (2) shall commence from the actual date of filing the application;
- (f) the requirements of rule 33(1) are modified to the extent that the requirements of rule 19 as modified by sub-paragraph (b) also apply;
- (g) the requirements of rule 38 in force immediately before 1st July 2004 shall apply and are modified to the extent that the 16-month period commences from the actual date of filing the application;
- (h) the requirements of repealed section 29 (1) (a) in force immediately before 1st July 2004 shall apply and are modified to the extent that instead of filing a request for a search report, the applicant may file a copy of the search report which is issued in respect of the foreign application, provided that the application in Singapore relates to the same or substantially the same invention as the foreign application at the time of search;
- (i) the requirements of repealed section 29 (1) (b) in force immediately before 1st July 2004 shall apply and are modified to the extent that instead of filing a request for a search and examination report, the applicant may file a copy of the search report and the examination report resulting from an examination as to substance which is issued in respect of the foreign application, provided that the application in Singapore relates to the same or substantially the same invention as the foreign application at the time of search and at the time of examination, respectively;
- (j) repealed section 29 (12) in force immediately before 1st July 2004 shall apply and is modified to the extent that “corresponding application” includes the foreign application;
- (k) the conditions of repealed section 30 (2) (c) in force immediately before 1st July 2004 shall apply and are modified to the extent that the search report and the substantive examination report which is issued in respect of the foreign application can be substituted for
 - (i) the search and examination report referred to in repealed section 30 (2) (c) (i) in force immediately before 1st July 2004; or
 - (ii) the search report and the examination report referred to in repealed section 30 (2) (c) (ii) or (iii) in force immediately before 1st July 2004,as the case may be;
- (l) the requirements of rule 43 in force immediately before 1st July 2004 shall apply and are modified to the extent that the period prescribed under paragraph (1) or (2) of that rule shall be 22 months from the actual date of filing the application;
- (m) the requirements of rule 46(8) in force immediately before 1st July 2004 shall apply and are modified to the extent that the period referred to in that provision shall be 39 months from the actual date of filing the application under section 116(6) of the Patents Act (Cap. 221, 1995 Ed.);
- (n) the requirements of rule 47(1) in force immediately before 1st July 2004 are modified to the extent that the period prescribed under that provision shall be 42 months from the actual date of filing the application; and

- (o) the date prescribed for the purposes of section 36 (1) shall be the date of filing of the application accorded under section 116(6) of the Patents Act (Cap. 221, 1995 Ed.).

3. Rule 108(2) and (3) shall, when applied to any foreign application referred to in paragraph 2, be modified to read as follows:

(2) The provisions referred to in paragraph (1) are rules 9(1), 19(2), 26(5) and (6), 28 (so far as it relates to rule 9(1)), 46(4), (5), (8) and (10), 49, 51(1), 52(2), 52A(8), 53(1), 54(2), 73(1), 74(1), 75, 85(1), 91(3) and (5) and rule 4(2) of the Fourth Schedule.

(3) A time or period prescribed in rules 9(2), (2A) and (5) (including the period therein prescribed as substituted by paragraph 2(a) of the Seventh Schedule), 18(1) (including the period therein prescribed as substituted by paragraph 2(a) of the Seventh Schedule), 26(2) and (4), 28 (except so far as it relates to rule 9(1)), 38(1), 43 (including the period therein prescribed as substituted by paragraph 2(l) of the Seventh Schedule), 47(1) and (2), 53(4), 86(1), (6) and (8), 97(2)(c) and rule 1(3) of the Fourth Schedule shall, if not previously extended, be extended for a period not exceeding 3 months upon filing Patents Form 45 before the end of the period for which extension is sought.

4. Sections 26 (6), 27(1), 29, 30, 31, 36(2), 36A and 69 shall not apply to any foreign application referred to in paragraph 2, and instead sections 26 (6), 27(1), 29, 30, 31, 32, 36(2), 69 and 79 in force immediately before 1st July 2004 shall apply to that application with the modifications referred to in paragraph 2.

5. Rules 27(1), 36, 37, 38, 40(1), 41, 42, 42A, 43, 44, 45(1), (3) and (4), 46, 47(1), (2) and (4A), 47A, 49(2), 51(2A) and 51A shall not apply to any foreign application referred to in paragraph 2, and instead —

- (a) rules 27(1), 36, 37, 38, 39, 40(1), 41, 42, 43, 44, 45(1) and (3), 46, 47(1) and (2), 49(2) and 79 in force immediately before 1st July 2004 shall apply to that application with the modifications referred to in paragraph 2; and
- (b) any reference in these Rules to rules 27(1), 36, 37, 38, 40(1), 41, 42, 43, 44, 45(1) and (3), 46, 47(1) and (2) and 49(2) shall be construed in accordance with subparagraph (a).”(2)[nbsp][nbsp]The provisions referred to in paragraph (1) are rules 9 (1), 19 (2), 26 (5) and (6), 28 (so far as it relates to rule 9 (1)), 46 (4), (5), (8) and (10), 49, 51 (1), 52 (2), 52A (8), 53 (1), 54 (2), 73 (1), 74 (1), 75, 85 (1), 91 (3) and (5) and paragraph 4 (2) of the Fourth Schedule.

Transitional and savings provisions

51.—(1) Rules 6 and 9 shall apply to both —

- (a) an application for a patent made on or after 1st July 2004; and
- (b) an application for a patent made before that date, if the compliance date for that application has not expired by that date.

(2) Rules 8, 10, 11, 12, 13, 14, 15 (a), 16, 17, 18, 19 (a) and (c), 20, 21 (a), (b) and (d), 22, 23 and 33 shall only apply in relation to an application for a patent with a date of filing on or after 1st July 2004, and rules 27(1), 29(4), 36, 37, 38, 39, 40(1), 41, 42, 43, 44, 45(1)

and (3), 46, 47(1) and (2), 49(2) and 79 of the Patents Rules in force immediately before that date shall continue to apply to an application for a patent with a date of filing before that date.

(3) Rules 25(b), 26 and 45(c) shall only apply in relation to a patent granted pursuant to an application for a patent with a date of filing on or after 1st July 2004.

(4) Rule 45(b) shall only apply in relation to an application for a patent with a date of filing on or after 1st July 2004, and rule 108(2) of the Patents Rules as amended by rule 45(a), (d) and (e) shall apply to an application for a patent with a date of filing before that date.

(5) In paragraph (1), “compliance date”, in relation to an application for a patent made before 1st July 2004, means the date by which, in respect of every application specified in the declaration referred to in rule 9(2A) of the Patents Rules in force immediately before 1st July 2004, a copy of that application —

- (a) duly certified by the authority with which it was filed; or
- (b) otherwise verified to the satisfaction of the Registrar,

is (but for paragraph (1)) to be furnished to the Registry under that provision, including such date as extended under the provisions of the patents Rules in force immediately before 1st July 2004.

Made this 24th day of June 2004.

YONG YING-I
*Permanent Secretary,
Ministry of Law,
Singapore.*

[TMC 002/87B; AG/LEG/SL/221/2002/1 Vol. 5]