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12 August 2021

Intellectual Property Office of Singapore
1 Paya Lebar Link, #11-03
PLQ 1, Paya Lebar Quarter
Singapore 408533

BY EMAIL
IPOS_Consultation@ipos.gov.sg

Dear Sirs,

Public Consultation on the Changes to Simplify Intellectual Property Processes and Improve User Experience with Digital Initiatives

1. We refer to the Intellectual Property Office of Singapore's public consultation on the Intellectual Property (Amendment) Bill 2021 ("the Consultation").
2. The Law Society of Singapore's Intellectual Property Practice Committee 2021 has considered the Consultation paper and prepared the enclosed submission in response. The submission is supported by the Council of the Law Society of Singapore.
3. If you have any questions or require further assistance on the matter, please contact the Representation Department by email at represent@lawsoc.org.sg.
4. Thank you.

Yours sincerely,

Jonathan Foong
Chairperson, Intellectual Property Practice Committee

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The Law Society of Singapore’s Intellectual Property Practice Committee’s response to the Intellectual Property Office of Singapore’s public consultation on Intellectual Property (Amendment) Bill 2021 (“Consultation Paper”)

Preamble

The Law Society of Singapore’s Intellectual Property Practice Committee supports the Intellectual Property Office of Singapore’s (“IPOS”) approach to introduce legislative changes to simplify and streamline intellectual property (“IP”) processes and improve user experience with digital initiatives. This is in line with IPOS’ continuous effort to design and administer a top-class IP regime in Singapore.

We have limited our comments (set out below) to specific areas or details of the Consultation Paper.

We have adopted the numbering set out in the Consultation Paper. The first column is the serial number while the second column sets out the questions posed. Our comments and feedback to the relevant questions are set out in column 3. Where the questions or issues posed in the Consultation Paper are not found in the table below, we are either in accord with IPOS or do not have any comments to these questions.

Please do not hesitate to contact us if you require any further information or clarification on our feedback.

S/N	Consultation Paper ¹ (Questions)	Comments
<u>SECTION 1: PATENTS</u>		
A: Introducing express provisions in respect of submission of sequence listing		
1.	<p><u>A.1</u></p> <p>The proposed amendments will specify that when a patent specification discloses a sequence listing, the furnishing of a sequence listing shall be mandatory. The format of the sequence listing shall be specified in the Practice Directions.</p>	<p>The concern here is that the language used in the draft rules is broad enough to encompass a reference to a sequence listing in the background of the application or even a passing reference to a sequence listing even if the claimed subject matter does not include a sequence listing.</p>

¹ “Public Consultation on Intellectual Property (Amendment) Bill 2021, dated 15 July 2021, accessible at [https://www.ipos.gov.sg/docs/default-source/default-document-library/public-consultation-ip-\(amendment\)-bill.pdf](https://www.ipos.gov.sg/docs/default-source/default-document-library/public-consultation-ip-(amendment)-bill.pdf)

		<p>The risk of such overly broad language is that it may become unnecessarily burdensome to provide a sequence listing just because it is referred to in a specification.</p> <p>In addition, we note that proposed rule 19A(5) seeks to clarify that proposed rule 19A(4) does not prevent an amendment under sections 31 or 38. However, the application of the new proposed rules is unclear in view of sections 84(2) and 84(3)(a), which prohibit amendments from introducing additional matter extending beyond what was disclosed as filed. We are of the view that the amendment of the patent specification in the manner contemplated under proposed rule 19A will effectively amount in substance to an amendment of the specification.</p> <p>This could potentially prove prejudicial to applicants who follow the rules only to be later caught by the overriding statutory restrictions pertaining to amendments.</p>
<p>2.</p>	<p><u>A.2</u></p> <p>If the sequence listing is not provided or not provided in the format as indicated in the Practice Directions issued by the Registrar, the Registrar may invite the applicant to furnish the sequence listing presented in a manner that complies with the Practice Directions for the purposes of search but the sequence listing does not form part of the application. However, this does not prevent the applicant from amending the description of an application for a patent in relation to a sequence listing.</p>	<p>Potential issues as described above.</p>
<p>3.</p>	<p><u>A.3</u></p>	

	<p>To give effect to the above, the following amendments are proposed:</p> <p>(a) Amendment of s25 of the Patents Act;</p> <p>(b) Amendment of r2 of the Patents Rules to introduce the definition of “sequence” and sequence listing”; and</p> <p>(c) Introduction of new r19A to the Patents Rules.</p>	<p>The proposed amendment to section 25(1) seeks to make reference to the rules as well as the practice directions. Reference to the rules promulgated under section 115 is sufficient. The rules should be enacted to be sufficiently clear to provide the proper legal basis for the intention of rule 19A (provided it is not contradicted or rendered inoperable by any other provisions).</p>
<p>D: Inviting amendment to an application in lieu of a written opinion</p>		
<p>4.</p>	<p><u>D.2</u></p> <p>The response to the notice must be made within the prescribed period of two months (an extension of which, under r108 of the Patents Rules, will not be allowed) and in the prescribed manner. The Examiner may issue a written opinion or a further written opinion but only after the prescribed period of two months has expired or after the applicant responds to the notice, whichever is earlier.</p>	<p>It is noted that the issuance of a notice inviting the applicant to amend the application does not preclude the Examiner from issuing a further written opinion. However, where the Examiner has opted to issue a notice to amend, and the applicant does not respond within the 2-month prescribed period, it should be mandatory for the Examiner to then issue a further written opinion in respect of any unresolved objections that remain. Otherwise, where an applicant would ordinarily have 5 months to respond, they would now potentially only have 2 months.</p>
<p>5.</p>	<p><u>D.3</u></p> <p>To give effect to the above (i.e. D.1 and D.2), the following amendments are proposed:</p> <p>(a) Amendment of s29 of the Patents Act;</p>	<p>Agreed, save where further amendments to include the above proposal (in response to D.2) are required.</p>

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	<p>(b) Amendment of r51A and r108 of the Patents Rules; and</p> <p>(c) Introduction of r46AA to the Patents Rules.</p>	
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