

PUBLIC CONSULTATION
AMENDMENTS TO THE PATENTS ACT

1. The Patents Act provides the legislative basis for Singapore's patent and patent agent regulatory regime. The Ministry of Law (MinLaw) is considering amendments to the Patents Act to liberalise the patent agent sector. The proposed draft legislative amendments to the Patents Act can be found in **Annex B**.

2. The proposed draft legislative amendments seek to introduce these changes:

(a) Enable foreign-registered patent agents to undertake offshore patent agency work in Singapore; and

(b) Provide formal recognition of the title of "patent attorney".

(A) Enable foreign-registered patent agents to undertake offshore patent agency work in Singapore

3. Under the current Patents Act, patent agency work can be broadly defined as (i) applying for or obtaining patents in Singapore or another country, (ii) the preparation of specifications for the purposes of the Singapore Patents Act or the patent law of another country; and (iii) the provision of advice on the validity and infringement of patents.

4. Only (i) Singapore-registered patent agents with a patent agent practising certificate issued by the Intellectual Property Office of Singapore (IPOS); and (ii) advocates and solicitors with a legal practising certificate issued by the Singapore Supreme Court; are allowed to undertake patent agency work in Singapore. In addition, a firm is allowed to carry on a business of and undertake patent agency work only if at least one partner or director is either (i) or (ii). There are only about 100 Singapore-registered patent agents in practice today.

5. MinLaw and IPOS are proposing to amend the Patents Act to allow foreign-registered patent agents to undertake offshore patent agency work, without having to meet the local registration requirements (which include the completion of the Graduate Certificate in Intellectual Property Law, passing of four patent agent qualifying examination papers, as well as the completion of an internship in patent agency work). Offshore patent agency work includes:

a) Applying for or obtaining patents outside Singapore;

b) Drafting of patent specifications for the purposes of the patent law of another country, and

c) Provision of advice about the validity and infringement of patents under the patent law of another country.

6. Foreign-registered patent agents who wish to practise offshore patent agency work in Singapore will be required to register with IPOS. MinLaw and IPOS are currently reviewing the specific registration requirements, such as proof of foreign

patent agent qualifications, professional insurance, and being subject to a Code of Conduct.

7. Under the proposed amendments, a firm will also be allowed to carry on a business of and undertake offshore patent agency work as long as the firm has at least one partner or director who is a foreign-registered patent agent registered with IPOS as per paragraph 6 above.

8. Local patent agency work (that is, the drafting and filing of patents for Singapore, and providing advice on infringement relating to Singapore patent law) will continue to, and can only, be undertaken by Singapore-registered patent agents with a patent agent practising certificate issued by IPOS; and advocates and solicitors with a legal practising certificate issued by the Singapore Supreme Court. In addition, the filing of Patent Cooperation Treaty applications with IPOS as the receiving office can be performed only by Singapore-registered patent agents with a practising certificate. Foreign patent agents will be able to do so via the International Bureau of the World Intellectual Property Organization, among other channels.

9. The proposed legislative amendments to allow foreign-registered patent agents and firms to undertake offshore patent agency work are set out in section 105 and the new section 105(A) of the draft revised Patents Act.

(B) Provide formal recognition of the title of “patent attorney”

10. Patent professionals are accorded different titles in different countries. The title “patent attorney” is widely used analogously to “patent agents” in several established jurisdictions like Australia and Europe.

11. In response to feedback given by the local patent agent profession, MinLaw and IPOS are considering amending legislation to make it clearer that individuals who meet the local registration requirements, or the proposed foreign registration requirements, can use the title of “patent attorney”, in addition to the title of “patent agent”.

12. The recognition of the title “patent attorney” does not alter the scope of patent agency work that a patent agent is able to undertake. Like today, patent agents/attorneys will be required to ensure that they do not misrepresent themselves in their conduct of business.

13. The related legislative amendments are found in sections 105(5), (6), (7) and (9) and 105A(6) to (9) and (11) of the draft revised Patents Act.

Conclusion

14. MinLaw invites interested parties to provide your views and feedback on proposed areas of legislative amendments to the Patents Act. The consultation period is from **16 March 2012 to 12 April 2012**.

15. The feedback may be sent in electronic or hard copy form to:

Intellectual Property Policy Division
Ministry of Law
100 High Street
#08-02, The Treasury
Singapore 179434
Fax: 6332 8842
E-mail: MLAW_Consultation@mlaw.gov.sg
