

A&G ASIA



KEY CONSIDERATIONS FOR ENTERPRISES IN PROTECTION STRATEGY IN SINGAPORE AND ASEAN

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A&G OVERVIEW

A LEADING SOUTH-EAST ASIAN LAW FIRM

- ✓ Established in 1902
- ✓ Presence in Singapore, Myanmar, Vietnam, Malaysia, Indonesia and China
- ✓ Over 650 lawyers across the region, making us one of the largest law firms in South-east Asia
- ✓ Consistently ranked as a top-tier firm across majority of our practice areas

ASSOCIATION OF SINGAPORE PATENT ATTORNEYS

- <https://www.aspa.org.sg/>
- Representation of Singapore patent profession
- Approximately 120 members
- Registered patent attorneys, patent trainees
- Members from law firms, patent boutique firms, and corporates
- Works closely with Intellectual Property Office of Singapore (“**IPOS**”)
- Furthering members’ interests
 - (training, networking, career development)
- Engages regularly with other organisations in IP field

ADVANTAGES OF SINGAPORE IP SYSTEM

SINGAPORE IP STRATEGY 2030



Source: ipos.gov.sg

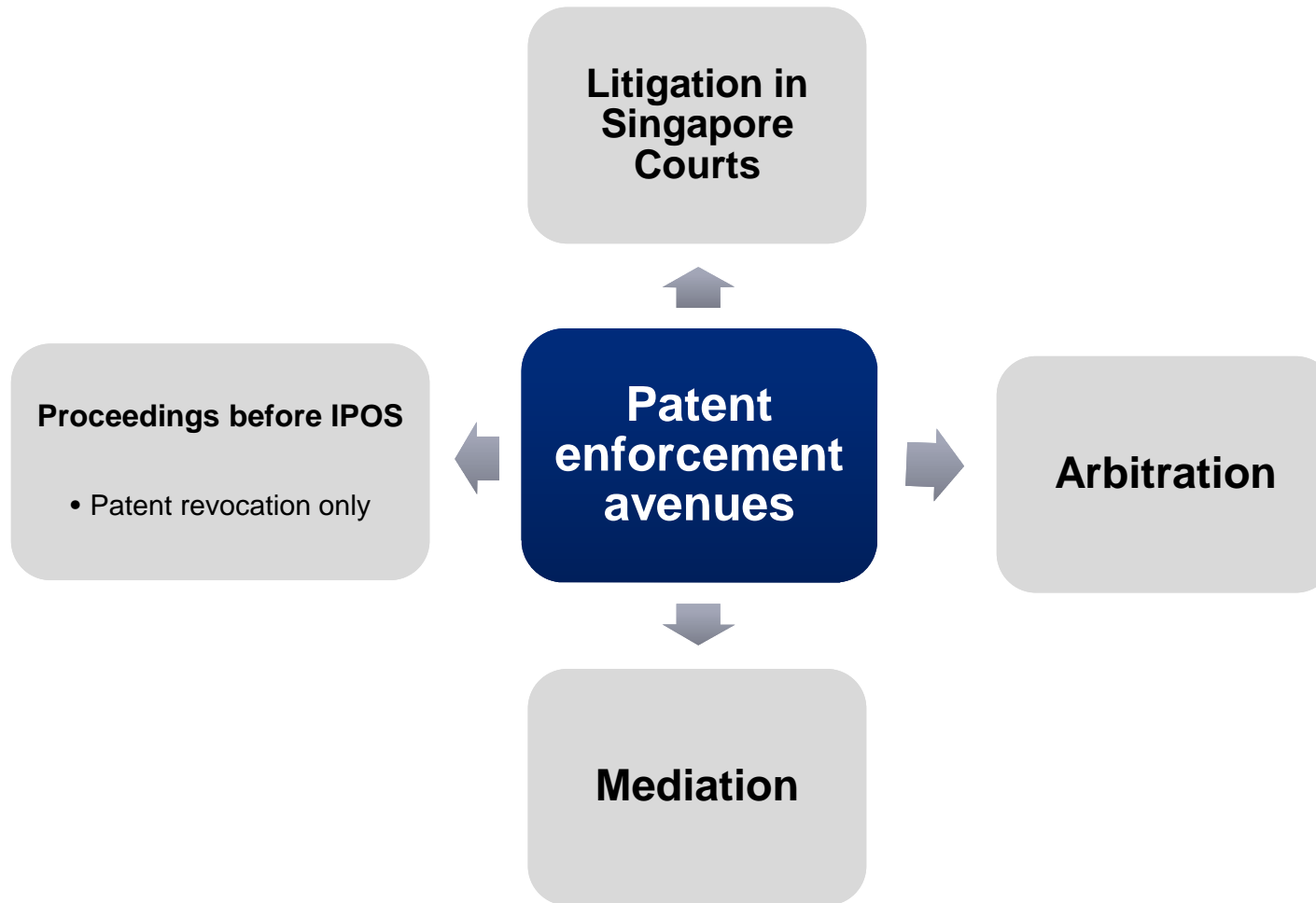
- The Singapore IP Strategy (SIPS) 2030 is a national strategy that supports enterprises and the wider innovation community
- **The objectives of SIPS 2030 are:**
 - growing Singapore as a global hub for IA/IP activities and transactions
 - maintaining Singapore’s top ranked IA/IP regime to instil confidence in investors and innovators
- **SIPS 2030 consists of three main focus areas:**
 - supporting international activities
 - growing local enterprises
 - building a high-calibre workforce

WHY CHOOSE SINGAPORE AS A PATENT FILING DESTINATION

- **PCT Filing in Chinese at IPOS**
- **Comprehensive Search & Examination**
 - IPOS boasts a team of over 100 multi-lingual patent examiners, 90% of whom hold Ph.D. degrees in specialised fields
- **Robust IP Ecosystem and Conducive Business Environment**
 - Singapore's IP regime is consistently ranked among the best in the world
 - Singapore continues to refine its measures for IP enforcement and avenues for IP dispute resolution
 - Singapore's business-friendly environment further contributes to its allure, and is well positioned as an optimal gateway to ASEAN for global expansion
- **Domestic and Regional / International Acceleration**
 - Domestic acceleration through IP Fast Track
 - ASEAN acceleration programs
 - Patent Prosecution Highway

SINGAPORE IP DISPUTE SYSTEM

PATENT ENFORCEMENT AVENUES IN SINGAPORE



LITIGATING PATENT DISPUTES IN SINGAPORE

- Patent disputes are primarily heard in the High Court of Singapore (General Division) at first instance
- Singapore High Court hears all manner of patent disputes, including infringement, validity and licence agreement disputes
- Singapore High Court litigation is efficient, with even complex patent lawsuits taking at most 1.5 - 2 years to reach trial
- Singapore High Court has specialised Intellectual Property / Information Technology List with **specialist IP Judges**. IP Court Guide sets out special case management procedures for IP cases
- Optional avenues :
 - Litigants can potentially opt for patent disputes to be heard on the **Simplified Process for Certain IP Claims**, an optional “fast track” for IP disputes
 - IP disputes of an international and commercial nature can be transferred to the Singapore International Commercial Court (specialist IP/IT International Judges)

IP ARBITRATION IN SINGAPORE

- Home to top international arbitration institutions such as the Singapore International Arbitration Centre (specialist panel of IP arbitrators), WIPO Arbitration and Mediation Center (only one outside WIPO HQ in Geneva), International Chamber of Commerce (ICC), American Arbitration Association - International Centre for Dispute Resolution (AAA-ICDR) and Permanent Court of Arbitration (PCA)
- **Maxwell Chambers** - launched in 2010, world's first integrated dispute resolution complex with state-of-the-art hearing facilities
- Legislative amendments in 2019 to Arbitration Act 2001 and International Arbitration Act 1994 made clear that *IP (including patents) disputes are arbitrable in Singapore*
- Arbitral awards are enforceable across multiple jurisdictions in over 160 countries pursuant to the New York Convention

IP MEDIATION IN SINGAPORE

- Mediation can be conducted under the auspices of **Singapore Mediation Centre (“SMC”)** or **Singapore International Mediation Centre (“SIMC”)**
 - SIMC has a large panel of international and specialist mediators, including mediators with particular experience in IP disputes
SIMC
- **Singapore Convention on Mediation Act 2020** promotes cross-border enforcement of international commercial settlement agreements resulting from mediation among signatories
- SIAC offers the **SIAC-SIMC Arb-Med-Arb Protocol** as an option to arbitrating parties SIAC
 - The parties’ mediated settlement agreement may be converted into a consent arbitral award that is enforceable worldwide under the New York Convention
- Mediation promotion schemes :
 - *WIPO-Singapore ASEAN Mediation Programme (AMP)*
Disputing parties in ASEAN can resolve their IP or technology disputes through WIPO with funding. Up to S\$8,000
 - *The Revised Enhanced Mediation Promotion Scheme (REMPS)*
REMPS is a funding scheme by IPOS to encourages parties in IPOS proceedings to choose mediation by funding the process

SINGAPORE PATENT PROSECUTION PROCESS

OVERVIEW OF REGISTERING A PATENT IN SINGAPORE

A Quick Overview

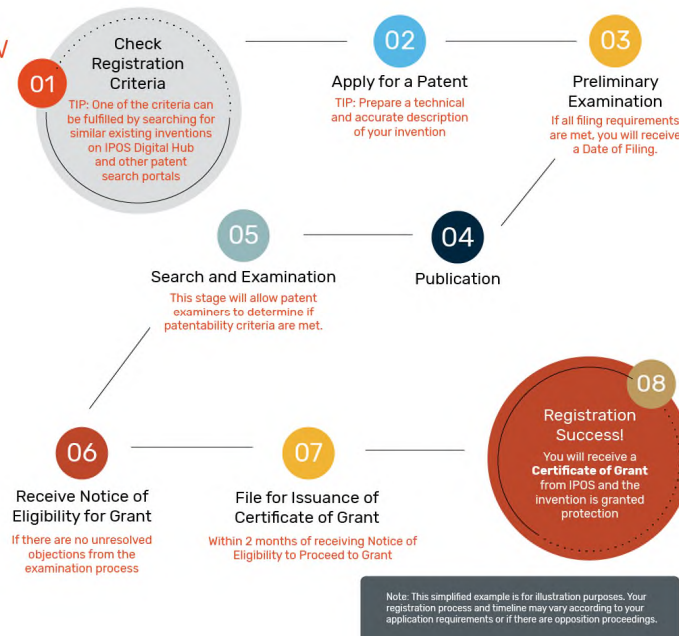
of Registering a Patent
in Singapore (Domestic Route)

Term of Protection
20 YEARS
from date of filing

Estimated Cost
FROM \$2,470

Estimated Time Required
FROM 24 MONTHS
(depending on complexity of invention)

Did You Know?
If you plan to bring your patent overseas, you will also need to file for National Security Clearance.

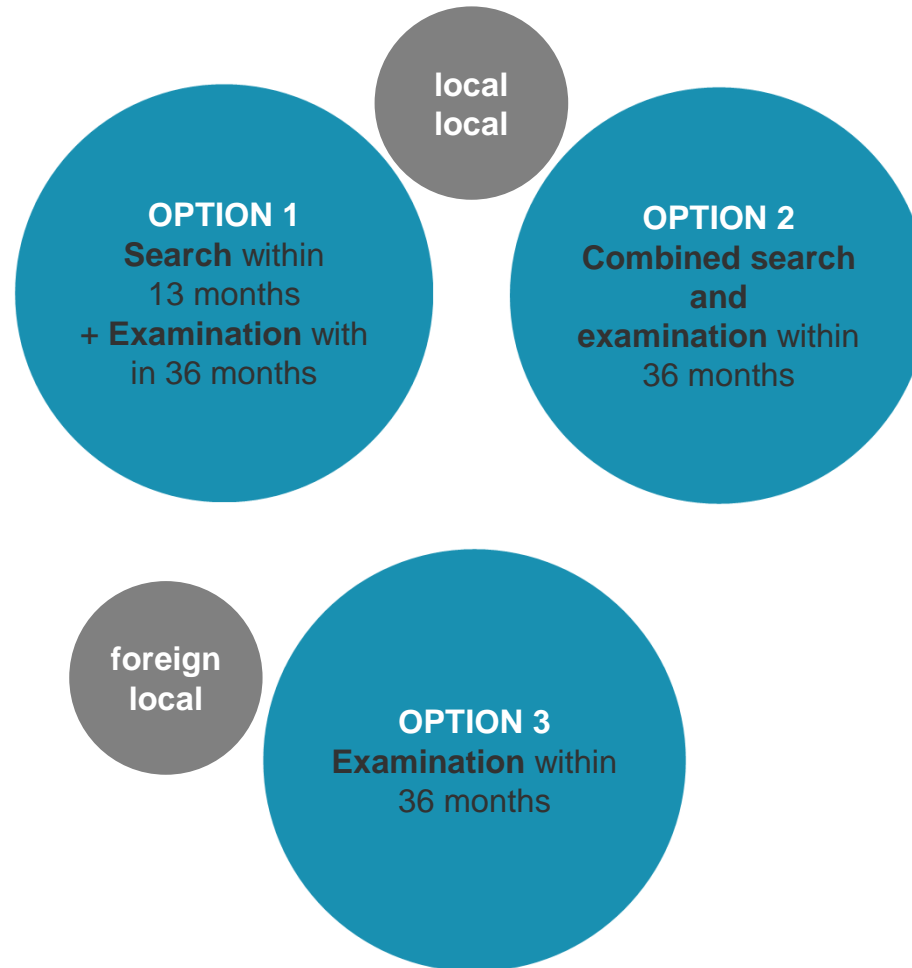


Source: <https://www.ipos.gov.sg>

Steps for obtaining grant in Singapore

1. Check Registration Criteria
2. Apply for a Patent
3. Preliminary Examination
4. Publication
5. Search and Examination
6. Receive Notice of Eligibility for Grant
7. File for issuance of Certificate of Grant
8. Registration Success

SINGAPORE SEARCH & EXAMINATION OPTIONS



SINGAPORE SEARCH & EXAMINATION OPTIONS

	Option 1 Local Search + Examination	Option 2 Combined Search and Examination	Option 3 Examination based on Foreign Search
Advantages	Independent search by Singapore Examiner		
	Claims are examined in accordance with local practice		
		Time and cost savings over Option 1	Less expensive if a foreign search result is available
Disadvantages	More expensive than Option 2 if proceeding with examination		Claims comprising unsearched subject matter may not be examined
			There may be other prior art not uncovered in earlier search

SINGAPORE PATENT ACCELERATION PROGRAMMES

DOMESTIC ACCELERATION PROGRAMME

SG IP FAST

- Allow concurrent request for the acceleration of related trademark and registered design
- Straightforward patent applications can be registered in as fast as 6 months
- Available to patent applications filed for all inventions across all technological sectors

Requirements :

- Cap of 10 patent applications per month, with a further cap of 2 patent applications per entity
- Patent application must be first filed in Singapore, i.e. no priority claim
- Patent application must contain 20 or fewer claims
- A request for search and examination report must be submitted at the time of filing the patent application
- Applicant must respond within 2 weeks from receipt of a formalities examination adverse report
- Applicant must respond within 2 months from receipt of a written opinion

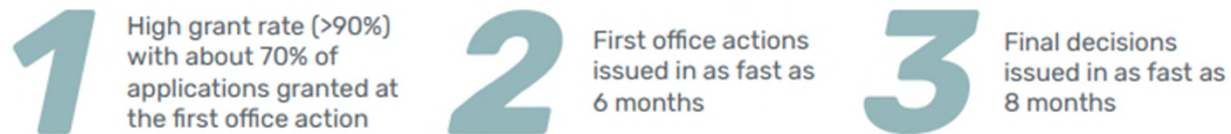
INTERNATIONAL / REGIONAL ACCELERATION PROGRAMS

- (1) PPH
- (2) Global PPH
- (3) ASPEC
- (4) Cambodia / Laos
- (5) CS&E Programme with Vietnam

(1) PATENT PROSECUTION HIGHWAY

- The Patent Prosecution Highway (“PPH”) is a programme between IP Offices where the examination process of a patent application in one IP Office can be accelerated by referencing the examination results from another IP Office
- IPOS has PPH pilot programs with EPO (Europe), (CNIPA) (China), (IMPI) (Mexico), (SAIP) (Saudi), (INPI) (France)

In 2022, PPH applications continue to see:



Source: SG IP Filing Insights 2022

(2) GLOBAL PATENT PROSECUTION HIGHWAY

- The GPPH network has over 28 participating offices
- Accelerated processing at any participating office based on work product from any one of the other participating office or international search and/or examination results under the PCT established by any one of the other participating office




















(3) ASEAN PATENT EXAMINATION CO-OPERATION

- Regional patent work-sharing programme among 9 participating ASEAN Member States IP Offices of Brunei Darussalam, Cambodia, Indonesia, Lao PDR, Malaysia, the Philippines, Singapore, Thailand, and Viet Nam

(3) ASEAN PATENT EXAMINATION CO-OPERATION

Total no. of ASPEC requests submitted: 1436 (as of July 2023)

			2nd AMS							
										
1st AMS		BN								
		KH								
		ID				11	2		16	12
		LA								
		MY			8		2		37	14
		PH			4	8			17	9
		SG	1		84	450	168		243	319
		TH				1				
		VN							7	

Source: [aseanip.org/statistics/asean-patent-examination-cooperation-\(aspec\)-statistics](https://aseanip.org/statistics/asean-patent-examination-cooperation-(aspec)-statistics)

- Average pendency rate to 1st office action as ASPEC request: 9.31 months
- Number of ASPEC requests with first or final office action: 1132 requests
- Allowance rate at final decision: 98.32%

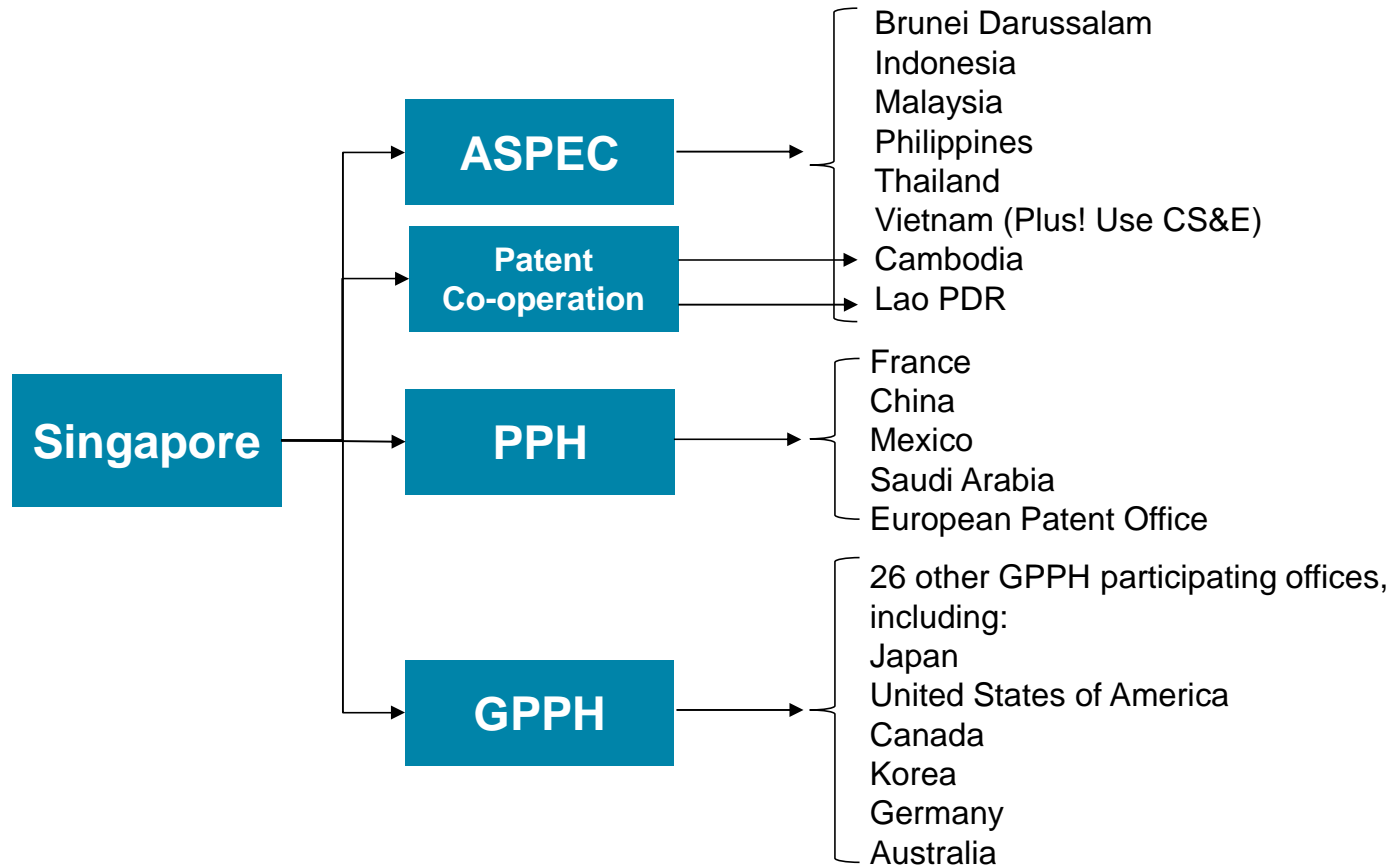
(4) PATENT COOPERATION WITH CAMBODIA AND LAO

- Singapore patents can be re-registered in Cambodia and Lao PDR
- No deadline to re-register

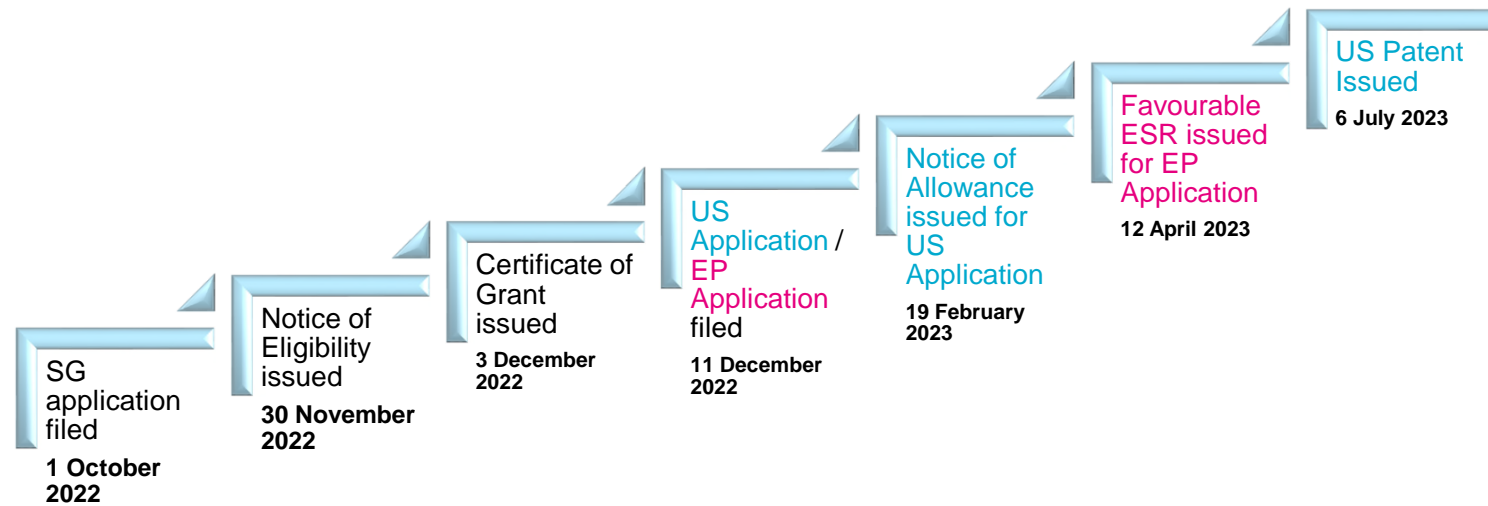
(5) CS&E PROGRAMME WITH VIET NAM

- Collaborative Search and Examination (CS&E Programme)
- First in ASEAN programme between Singapore and Viet Nam offices to speed up patent search and examination process for innovators filing in both countries
- Pilot from 1 March 2023 to 28 February 2027
- Enhanced Prior Art Search and Examination Results through collaboration
- Choose to file in Singapore or Viet Nam first
- Joint first OA received within 10 months of request to support decision to file patent application in the second office of filing

SINGAPORE AS IP HUB TO ACCELERATE PATENT WORLDWIDE



SAMPLE CASE STUDY



- Singapore patent granted within 2 months from filing
- US corresponding patent issued within 7 months from US filing date
- Favourable Examination Search Report was issued for the corresponding EP application within 4 months from the EP filing

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Notes

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