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BRIC-a-BRAC February 5, 2014: News Items from BRIC Countries

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1. Reminder: Amendments to Singapore's Patents Act (Patents Act) come into effect on February 14, 2014. The new law applies to domestic applications filed on or after February 14, 2014, including divisional applications as well as Patent Cooperation Treaty (PCT) applications entering the national phase in Singapore on or after February 14, 2014 (Note: The international filing date of a PCT application is not used in determining whether or not an application falls under the new law).

Some key changes to the Patents Act include:

a. Positive grant: Patents will no longer be granted despite the existence of a negative examination report (the "self-assessment" system is abolished). Under the new law, an application must comply with all the substantive patentability requirements before a patent will be granted. In other words, it will no longer be possible to obtain grant if there are unresolved objections (such as, novelty and/or inventive step) relating to patentability.

b. Elimination of the "slow track" for requesting examination and block extensions of time: The new law creates a single track for patent examination and prosecution.

c. Deadline for requesting examination:

i. Local Examination (Options I and II): Must be requested 36 months from the earliest priority date (which is 6 months from the national phase entry deadline off of a PCT application); or

ii. Prescribed or Modified Examination (Options III and IV)): Must be requested 54 months from the earliest priority date.

Other than the change in the time period for requesting examination and the inability to obtain a grant if a negative examination report exists, there are no other substantive changes to the local

examination procedure.

With prescribed or modified examination, an Applicant has 54 months from the earliest priority date to submit prescribed information relating to a corresponding foreign application. The "prescribed information" consists of a certificate of grant and a certified copy of the patent specification, or documents setting out the final results of a search and examination (such as a notice of allowance) and a copy of the allowed claims (together with a verified English translation if needed). In addition, a claim correspondence table must be filed. Specifically, the table must set forth how each claim in the pending Singapore application is related to one or more allowed claims in the corresponding foreign application. The claims in the Singapore application must have the same or narrower scope than the corresponding claims in the foreign application.

d. Supplemental examination will be required if modified examination is chosen: The Intellectual Property Office of Singapore (IPOS) recognizes that in instances where modified examination is chosen that the corresponding foreign application being relied upon for allowance may not fully comply with certain requirements of Singapore's patent law. Supplementary examination allows IPOS to examine the Singapore application for compliance with the law.

In view of these impending changes, Applicants should quickly consider:

a. Reviewing their existing applications in Singapore to determine whether the filing of a divisional application is necessary and if so, filing such a divisional application by February 13, 2014 (to take advantage of the less stringent requirements and cost savings under the existing law); and

b. Entering the national phase in Singapore early (such as by February 13, 2014 to take advantage of the less stringent requirements and cost savings under the existing law).

2. China's Ministry of Public Security (MPS) is reporting the arrest last year of nearly 60,000 people suspected of committing intellectual property (IP) infringement. According to the MPS, there were about 55,000 separate cases of infringement having a combined value of about U.S. $28 billion. Additionally, more than 90 million tons of counterfeit materials were confiscated and more than 1,000 criminal networks uncovered. China continues to work on improving its efforts to clamp down on IP infringement. Such efforts are expected to increase in view of the opening last June of a dedicated office (the Office National Leading Group on the Fight against IPR infringement and Counterfeiting) to combat infringement. To learn more, click here.

3. An interesting article in *Forbes* discusses Actavis' decision to walk away from China's generic drug market which is estimated to reach approximately U.S. $82 billion by 2015. According to Actavis' CEO, Paul Bisaro, "If we're going to allocate capital, we're going to do so where we can get the most amount of return for the least amount of risk. And China is just too risky." The article discusses several rationales for Actavis' decision. These include the recent trend of China becoming less hospitable to foreign companies and the concern of foreign companies of whether they can generate sufficient profit in the Chinese market. Do you agree with Actavis' decision?

4. Indian pharmaceutical companies and intellectual property experts are dismissing a report by the U.S. Chamber of Commerce's Global Intellectual Property Centre (GIPC) that ranked the country last among 25 countries in terms of protecting intellectual property rights. The report ranked the U.S., Great Britain and France as the top upholders of intellectual property rights

with Vietnam, Thailand and India at the bottom. According to Shamnad Basheer of SpicyIP, “Underlying this report is a major paradox that protecting weak patents makes the IP regime a strong one. Countries such as India that have stood up for genuine innovation and refused to protect trivial inventions have been accused of having ‘weak’ IP regimes while it should have been the other way round.” To learn more, click here.

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