

Changes to the ASEAN Patent Examination Co-operation (ASPEC) to Further Expedite Obtaining Patent Rights in South East Asia

The ASEAN Patent Examination Co-operation (ASPEC) has recently been updated for its 12th anniversary to make it easier to obtain patent rights throughout ASEAN.

What is ASEAN?

The Association of Southeast Asian Nations (ASEAN) is a political and economic organisation of ten South East Asian countries as can be seen in Figure 1. Namely, Brunei, Cambodia, Indonesia, Laos, Malaysia, Myanmar, Philippines, Singapore, Thailand and Vietnam. It was formed on 8 August 1967 to accelerate economic growth, social progress among its members, promote protection of regional peace and stability, and opportunities for member countries to resolve differences peacefully. In the last 12 years Intellectual property has been identified as one of the main focus areas of ASEAN to accelerate economic growth. Similar harmonisation measures in regulatory processes is also underway.



Figure 1: Member states of ASEAN

What is ASPEC?

Launched in 2009, the ASPEC is the first regional patent work-sharing programme among 9 participating ASEAN Member States (AMS) IP Offices of Brunei Darussalam, Cambodia, Indonesia, Laos, Malaysia, Philippines, Singapore, Thailand, and Vietnam. Under the ASPEC initiative, patent offices in participating AMS have been able to consider the other search and examination documents from a 'First IP Office' they receive under the programme. The participating AMS IP office where the ASPEC request is filed is called "Second IP Office". The "First IP Office" refers to the IP Office in which its Search and Examination result is relied upon.

However, it is important to note that Second IP Office is not obliged to adopt any of the findings or conclusions reached by the First IP Office. It will each proceed with and conclude its own search and examination work as well as decide on whether to grant the patent in a manner that is consistent with its national laws. ASPEC is essentially sought to accelerate patent application timelines in ASEAN countries by avoiding duplicative search and examination procedures. Further, search and examination work done on a corresponding application via ASPEC serves as a useful reference in producing quality examination reports. Added to this is the advantage that ASPEC does not require any additional official fees at any participating AMS IP office. However, local search and examination fees at each AMS IP office still apply.

Changes

There have been two key changes to ASPEC over its lifetime that have both resulted in more applicants using ASPEC as can be seen in Figure 2. The first was when it was decided that all forms and applications should be filed in English in 2012. The second was when the scope of ASPEC was broadened in 2019 to include Patents Cooperation Treaty ("PCT") reports issued from an ASEAN International Searching Authority (ISA) and International Preliminary Examining Authority (IPEA), which currently includes Intellectual Property Office of Singapore (IPOS) or Intellectual Property Office of the Philippines (IPOPPL). PCT Applicants filing at the following receiving offices are able to select IPOS as the ISA: Brunei Darussalam; Indonesia; Japan; Cambodia; Korea; Mexico; Singapore; Thailand; Uganda; USA and Vietnam. In 2019 the participating offices also agreed to ensure a first report after an ASPEC request is made will be issued in 6 months for applications in the field of industry 4.0 manufacturing.

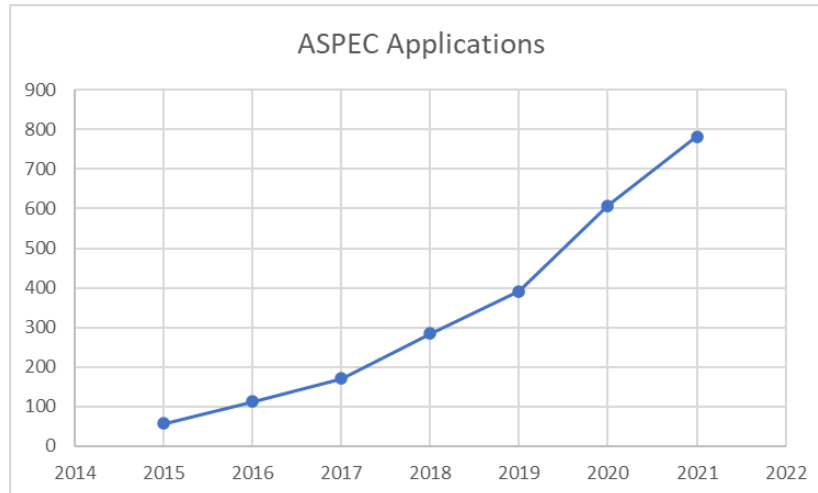


Figure 2: Number of ASPEC requests applied for from 2015 up to June 2021 based on the ASPEC statistics provided by ASEAN each year.

The newest change to ASPEC that is anticipated to again result in more applicants using ASPEC, started on 15 June 2021 and allows applicants to use Written Opinions from the AMS IP office where at least one claim has been allowed to file an ASPEC request. Altogether there have been almost 1000 ASPEC requests filed in the participating countries. More than half of these have been based on Singapore Examination reports. A key drawback of this is that IPOS will only issue an Examination report once the Applicant/s has been given the opportunity to address any objections in a written opinion. Consequently, a Singapore application may have allowed claims, but applicants are forced to wait until the Examination Report issues usually together with a Notice of Eligibility before they are able to file an ASPEC request in a second AMS IP office, often long after the deadline to request examination. While it is still possible to request ASPEC after filing the request for examination this seems to be contrary to the concept of expediting examination. The new change should allow applicants to request ASPEC at the same time as filing the request for examination in the second AMS IP office in most cases.

What does this mean for applicants of Singapore applications?

The changes will further enhance the use of a Singapore patent application within the region. ASPEC requests that rely on an IPRP established by IPOS or a written opinion established for a Singapore application can now both be used as a search and examination result to request expedited examination under the ASPEC program with most ASEAN patent offices'. In addition to being able to file ASPEC requests in most ASEAN patent offices, there are also cooperation agreements in place between IPOS and the Ministry of

Industry & Handicraft (MIH) of Cambodia; and IPOS and Department of Intellectual Property (DIP) of Lao People's Democratic Republic (Laos) to re-register granted Singapore patents in Cambodia and Laos.

ASPEC confers enormous benefit to both IP offices and the applicants as it provides an alternative for patent applicants to enjoy expedited filing in ASEAN and reduces the workload of the regional patent offices. We therefore highly encourage any patent applicant who has a commercial interest in the ASEAN region to consider ASPEC and the other cooperation agreements to leverage on a Singapore patent application/Singapore patent.

If you would like to have further information on this update or discuss the impact of this case on your business, please contact:

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