

Dated: 120404

Hi

I took the opportunity to run through the bill very briefly over the weekend.

Basically, I'm happy with most of it apart from some clarifications (which despite being small matters are rather important) and one major point as follows:

1. In section 30(3), I don't think (a) necessarily has the right effect. It seems that the registrar could refuse to grant the patent if there was an unresolved disunity of invention objection even if that was subsequently resolved, as long as the objection was unresolved in the examination report that the registrar received. Although, of course, one would hope that the registrar would take a commonsense approach, this may not stop a third party from subsequently asserting that the registrar did not follow the act and granted the patent in error. In order to clarify this I recommend that "any unresolved objection" be changed to read "any objection, since unresolved,".

2. In section 38(A)(1)(iii), I wonder how well this gels with the requirement for a search (and examination) report. Could the requestor make a general assertion that all prior art had not been considered without citing prior art himself on the basis that the search would uncover relevant art? I don't think this is intended but is there a loophole here?

3. In section 80, the new ground of revocation under (f)(iii) still causes me problems simply because "prescribed" is undefined. Although you have mentioned that this would essentially mean positively prescribed in the rules for the purpose, the fact that it does not state this means that "prescribed" could be argued before a judge as being of much broader scope.

>From example this could arguably mean any requirement of the act or rules as long as it is prescribed in the act or rules for obtaining a patent. It would be impossible to practice with such an interpretation, since any error could lead to revocation. I would very much like to see the phrase changed from "prescribed material information" to "material information prescribed [in the rules] for the purposes of this section", so that this is clear for everybody.

4. The final point concerns the definition of "related claim". As I mentioned earlier, the definition that I gave has not really been adopted in the final proposal. Even reviewing my original definition again I feel this is in anyway lacking. Basically, the purpose of my definition was to ensure that a claim now would only be considered to be related to a claim of the application in the past if it was within the scope of the claim in the past. This means there must be an inequality in the definition of related claim. It must also mean that if one claim is

related to another, the reverse cannot apply unless the claims are essentially the same, otherwise the definition would be meaningless.

In the amended definition of "related claim", I find this very confusing! It is stated that every limitation in the second claim is contained in the first claim, but what the first and second claims are is not directly defined (unlike my original version). The only help one might get is from (b) which states that "related claim" in relation to any claim means another claim to which the first claim is related. This is in the passive voice which "reverses" the meaning and when applied to the phrase "a claim is related to another claim" the "another claim" must be the first claim and applying this to S69(ii), for example, means the definition comes out the wrong way round.

This also does not take into account narrower claims which have some difference in expression (which my definition didn't either).

I suggest the following, based on my original definition:

"3A For the purposes of this Act:

- (a) a second claim is related to a first claim if every limitation of the first claim is contained in the second claim either exactly or differing only in expression and not in content;
- (b) a "related claim" is the first claim of paragraph (a); and
- (c) more than one second claim may be related to a single first claim;

where the terms "first claim" and "second claim" are used only as labels to identify two claims in this definition."

Identical claims are a subset of this definition and thus need not be separately mentioned.

With this definition, I don't think the other definitions mentioned in Sections 30(3)(b)(ii), 38A(1)(a)(ii), 38A(1)(b)(i)(B), 69(3)(b)(ii) and 69(3)(c)(ii) are needed, but I can't see any harm in keeping them...a belt and braces approach might be preferable.

5. I would like us again to look at the transitional provisions to see if we can move this up a bit. I would like, for example, S80 to apply to any revocation action commenced after the appointed day. Can't see a problem with this, if the (f)(iii) definition is resolved.

Regards

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