

**IPOS' RESPONSE 15 Mar 2007
TO FEEDBACK ON IPOS' CONSULTATION 11 Jul to 7 Aug 06 (on the Patents Act & Rules)**

Background

1. Public consultation on the proposed amendments to the Singapore Patents Act & Rules was held from 11 July 2006 to 7 August 2006.
2. IPOS sent out notifications to its patent users, inviting them to give their comments on the proposed changes.

Responses Received

3. In general, IPOS received positive feedback in relation to the proposed amendments. Suggestions and comments from the users as to how the proposed amendments could be further improved are summarized in the table (next page) enclosed. IPOS' corresponding comments to them can also be found in the table.
4. IPOS had taken in several suggestions and comments from the users and this is reflected in the amendments to the Patents Act and its subsidiary legislation.

IPOS
15 Mar 07

IPOS' Consultation on the proposed amendments to the Patents Laws in SG	Users' Response to IPOS Invites	IPOS' response
<p>A. Priority Claim</p> <p>IPOS sought the views of the patent users on the following:</p> <ol style="list-style-type: none"> 1. As to the proposed amendments to the section 17; 2. As to which of the criteria* would be best for Singapore (both as a PCT receiving Office and Designated Office) to adopt. See PCT rule 26bis.3(i), 49ter.2(g) & 49ter.2(h) which will come into force on 1 Apr 07 <p>* (failure occurred) in spite of due care or that (failure) was unintentional</p>		
Section 17(2C)(a)	There was a suggestion to follow the same words as UK's provision. This gives IPOS flexibility as amendment in the patents act would not be required in the event if IPOS decides later not to charge a fee. It was also indicated that 'prescribed period' and other variants of 'prescribed' are already used in many other places of the Act and avoiding such duplication of terms where unnecessary would be preferred.	IPOS had taken the suggestions on drafting style of the provisions into consideration wherever possible.
Section 17(2C)(b)	One suggestion made was for IPOS to standardize the	IPOS had taken the suggestion and had aligned

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	language used for section 17(2C)(b) with PCT rule 26bis.3(a)(i).	the text with the PCT provisions.
Unintentional or in spite due care	<p>a. Suggestion to make both criteria available was offered.</p> <p>b. A question was raised as to how the words 'due care' and '(un)intentional' will be interpreted.</p>	<p>a. The suggestion of providing both grounds for the applicants to choose from has been taken.</p> <p>b. On the interpretation of words "due care" and "intentional", these words are extracted from the PCT amendments which will come into force on 1 Apr 07.</p> <p>c. The new PCT rule 26.3bis will apply to receiving Offices (includes IPOS) and IPOS (as receiving Office) will be guided by the receiving Office guidelines from the PCT.</p> <p>d. As a national office, IPOS will refer to the PCT guidelines as well when deciding whether the requirements of "due care" or "unintentional" are met.</p> <p>e. If one were to apply the ordinary meaning on "unintentional", it would suggest the establishment of an intention to file the application in suit <u>within</u> the 12 month period mentioned in section 17(2A)(a) and that failure to do so was unintentional.</p> <p>f. As for the requirement of "... due care...", if one applies the ordinary meaning, this suggests</p>

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		failure occurring despite having exercised diligence (e.g. having a tracking and alert system in place) – that is to say, diligence expected of applicants to ensure filing the application in suit within the 12 month period mentioned in section 17(2A)(a).
Prescribed period for filing request to restore right of priority – rules 9A(1); 9A(2)	<p>a. It was suggested to provide more time (extend to 4 month) for supplying evidence after filing the application and patents form. It was explained that there may not be sufficient for overseas applicant to gather supporting evidence and statutory declaration.</p> <p>b. Another suggestion called for the integration of the patents form for restoration of priority claim with PF1(2004) online. If it cannot be done by 1 April 2007, the application number field on request for restoration of priority claim should not be made mandatory.</p>	<p>a. IPOS had taken note of the concern for more time to meet either of the 2 grounds. Hence, if the Registrar is not satisfied that the failure to file under either of the 2 grounds, she will inform the applicant that she intends to refuse the restoration request and the applicant is given 2 months from her notification to reply. Further, the period in rule 9A(5) is extendible under rule 108(3).</p> <p>b. On ePatents, IPOS had packaged the new form with PF1 (2004) for the convenience of the patent users.</p>
Prescribed fee for request to restore right of priority – rule 9A(2)	There was a suggestion that in the event that IPOS imposes a significant fee for restoration of right of priority, a 2-step approach could be adopted where the payment of any significant fee is required only upon the acceptance by IPOS of the restoration.	IPOS had considered the suggestion but did not adopt the proposed 2-step fee requirement as this will create more administrative steps for both applicants and IPOS.

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Correction/ Addition of priority claim – rules 9(2), (3)	The current practice of PF23 to correct a priority claim was satisfactory and it was felt that the new procedure relating to correction/ addition of priority claim did not appear to be of any benefit to applicants.	<p>a. IPOS had aligned the correction/addition provision with that of PCT rule 26bis.1 & PCT rule 91.1(g)(iv)¹.</p> <p>b. Note that the new rules 9(2) and 9(3) provisions are limited to specific scenarios which involves a change to the declared priority date.</p>
Certified copy of priority document when required by the Registrar – rule 9B(2)	It was asked whether an extension of time is available when there is a delay in getting the certified copy.	Yes. IPOS had taken note of this concern that more time may be required. Rule 9B(4) is extendible under rule 108(3).
Translation of priority document when required by the Registrar – rule 9C	It was suggested to allow discretion to Registrar to request translation of all or part of the document concerned.	<p>a. IPOS had taken note of this suggestion. However, as the requirement for translation of the non English priority document is already limited to a situation where the validity of the claim to priority is relevant in determining whether the invention concerned is patentable, this provision is unlikely to be activated frequently.</p> <p>b. Further, when it is activated and a translation is sought, it will be for a substantive consideration on patentability which probably will require one to consider the whole document as opposed</p>

¹ PCT rule 91.1 (g) states "A mistake shall not be rectifiable under this Rule if: (iv) the mistake is in a priority claim or in a notice correcting or adding a priority claim under Rule 26bis.1(a), where the rectification of the mistake would cause a change in the priority date; ...provided that this paragraph shall not affect the operation of Rules 20.4, 20.5, 26bis and 38.3."

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		to part thereof.
<ul style="list-style-type: none"> • Transitional/ Implementation date 	It was asked whether it would be possible to apply the provisions for restoration of right of priority to an application filed at IPOS on 1 Apr 07 with a priority 1 Mar 06?	The transitional provision can be found in section 6(3) of the Statutes (Miscellaneous Amendment) Act 2007. In brief, the changes will apply to patent applications that qualify for a date of filing on or after the date of commencement (1 st Apr 2007) of the amendments.
<p>B. Date of Filing</p> <p>IPOS invited views from the patent users as to the proposed amendments to section 26 and its corresponding proposed amendments to section 28, 36A, 80 & 84.</p>		
<p>Identification of applicant – section 26(1)</p> <p>Draft section 26(1)(b) read: "the documents identify the person applying for a patent or contain information sufficient to enable that person to be contacted by the Registry"</p>	The proposed amendment to section 26(1)(b) is ambiguous.	IPOS had considered the comments and to avoid creating uncertainty, IPOS retained substantially, the provision in the section 26(1)(b) instead which reads: "the documents identify the applicant for the patent"
<p>Missing elements, parts – sections 26 and 27</p>	<p>a. It was suggested that IPOS not use the term 'incorporation by reference' as patent agents use the term differently. This will also avoid confusion.</p> <p>b. One user group found these provisions acceptable as long as the missing matter sought to be introduced is supported and identical to that in the priority application.</p>	<p>a. "Incorporation by reference" is a term found in the amending PCT rules e.g. see new rule 4.18. The amendments in SG are aligned accordingly.</p> <p>b. The provisions on missing matter (i.e. missing specification or missing parts) are aligned with the new PCT rules 4.18 and 20.6 where they have to be completely contained in the earlier application to which priority has been claimed. Further, as the applicant is relying on what was furnished in the</p>

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	<p>c. It was suggested that terms like 'something', 'appears to be', and 'thing' in Section 26 be avoided as they appear quite uncertain.</p>	<p>earlier priority application in lieu of furnishing the description or part thereof, "completely contained" can be seen as "identical".</p> <p>c. As to the comment on the word "something" in section 26 appearing "uncertain", IPOS would explain that this word is appropriate for the provision in section 26 and note that this word is also found in section 15(1)(c)(i) of the UK Patents Act.</p>
<p>Application for grant of a patent - Rule 19</p> <p>Draft rule 19 contained provisions where the documents filed at the Registry to initiate an application for a patent included something which is or appears to be a description of the invention in a language other than English.</p>	<p>a. This proposal was found to be acceptable by one user group.</p> <p>b. One suggested clarifications to the amendment as was proposed then.</p> <p>c. One raised a concern over the provision where the English translation may be filed after 2 months from filing date and this could have an impact on clearance of security under section 34. Further, clarification on section 34(1) was sought on whether 2 months under section 34(1)(a) runs from the filing date established under section 26(1) or the 'initiation date'.</p>	<p>a. IPOS had taken into consideration the comments made on the draft rule 19(10).</p> <p>b. On the timelines, IPOS will monitor the situation and assess the impact of rule 19 on section 34, if any.</p> <p>c. On section 34(1)(a), it states "an application for a patent for the same invention has been filed in the Registry not less than 2 months before the application outside Singapore". No mention of filing date is found.</p>
<p>Reference under section 26(1)(c)(ii) - Rule 26</p>	<p>a. One submission received was that it not clear whether the whole document, which is not in English, ought to be translated or only the missing portion needs to be translated. The former would be costly.</p>	<p>a. IPOS had taken into consideration the translation costs concerns on missing parts under rule 26(7)(b).</p>

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	<p>b. The rule 26(1) proposed in 2006 required a reference to include the application number at filing date but in a declaration of priority under rule 9, it allowed the application number to be given on a later date. Clarification was thus sought.</p>	<p>b. IPOS had also taken into consideration the comments made on the draft. Rule 26(1) no longer requires such a reference.</p>
<p>C. Preliminary examination</p> <p>The amendments proposed for consultation were mainly consequential to the section 26 amendments. IPOS thus invited views on the proposed amendments.</p>		
	<p>Clarity was sought as to how the preliminary examination will interact with the mechanism of section 26(10) proposed in 2006.</p>	<p>The comments on the need to provide clarity in the provisions have been taken in when amending the Act and Rules.</p> <p>The amended section 28 on preliminary examination deals with the examination as to:</p> <ul style="list-style-type: none"> a) whether the formal requirements are met, and b) whether there are missing parts to the application <p>Time periods are reflected in the Rules.</p>
<p>D1. Others – Proposed amendments to Act – Section 2</p> <p>In the amendment to section 2 as was proposed in 2006, the following phrase was added to the definition of “designate” to include a reference to a country being treated as designated in pursuance of the convention or treaty.</p>		
<p>Interpretation - Section 2(1)</p>	<p>It was pointed out that amending section 2 would mean that IPRP of all international applications can no longer be relied upon.</p>	<p>IPOS had considered the comment made but did not see how the amendment to the definition of “designate” in section 2 would lead to the result that was mentioned.</p> <p>In any event, IPOS decided to remain status quo and not</p>

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		amend the definition of "designate".
D2. Others – Proposed amendments to Act – Sections 51 & 52		
IPOS invited views from the patent users as to the proposed repeal to sections 51 & 52.		
Avoidance of certain restrictive conditions - Section 51 <ul style="list-style-type: none"> • Determination of parts of certain contracts – Section 52 	These 2 provisions are more straightforward to apply than the elaborate provisions of the Competition Act and certainty may be lost in the effort in repealing these provisions. If there is a need to repeal, there should be no need for transitional provisions to create 2 sets of overlapping standards governing agreements pre-1 Aug 07.	The proposed repeal of Sections 51 and 52 is still under consideration.
D3. Others – Proposed amendments to Act – Section 87		
On section 87, it was proposed to make clear that the application is treated as published under section 27 when it is published under the PCT even if the publication occurred after the application has entered national phase.		
Adaptation of provisions in relation to international applications - Section 87	This proposal was found to be acceptable.	-