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Your ref: -  
Our ref: ASPA/KC/kt

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Intellectual Property Office of Singapore  
51 Bras Basah Road #04-01  
Plaza By The Park  
Singapore 189554

Attn: Mr Chig Kam Tack  
Assistant Director

Dear Sirs,

**PUBLIC CONSULTATION 2006: PROPOSED AMENDMENTS TO THE PATENTS RULES**

We refer to your email of 10 April 2006 and first thank you for the opportunity to file submissions.

From my understanding of the information obtained from your web site, the position for direct national filings - those using a PF 1 (2004) - is unchanged. National phase entry applications - those using a PF 37 - no longer require the block extension of rule 47A yet all relevant actions are now due at 39 or 60 months. This will significantly lower the cost for prosecution of national phase entry applications in Singapore, simplify the procedure and thereby make national phase entry more attractive. It also accommodates those cases where the ISR issues quite late. Also, any PCT Article 23 problems are overcome.

The transitional provisions are a cause for concern. The "guillotine" nature of the 1 October 2006 date will not allow applicants time to react unless the amendments come into effect well before that date. Given that advice will be required by many applicants on how the changes will impact on them, and the number of potential cases, some time will be required.

Also, by 1 October 2006 applicants may have filed documents, including a PF45A, even though the due date is after 1 October 2006. Shouldn't there be the possibility of their position being able to be restored? This is particularly so in view of the PCT Article 23 problems.

We note Rule 43(5) appears unchanged. Doesn't that conflict with new Rule 43(4A)?

Regarding those applications filed using a PF1 or PF1 (2004), rather than a fast track/slow track position, why not reverse it and make the slow track the norm, with the ability to speed it up? This is the normal situation in other countries. This could be done by having a petition to make special/expedited examination as used in USA/Australia. In this way those who want to move quickly can request search and examination early and thus save some time. But if they need expedited treatment (as in, there is an infringement) they can seek expedition of the case by filing a form, paying a fee (about S\$300 would be about right), file an affidavit attesting to the facts as to why expedited treatment is required, and the application is very fast tracked – the search and examination report would issue about 1 month later. Plus there should be no delays by IPOS, and grant should be about 1 month after paying the grant fee.

Also, the very high fee payable (S\$1,862.00) caused many problems. Similarly, the search and examination fee payable is S\$2,362.00. The fee payable at the Australian patent office for the search and examination of an Australian patent application is AU\$340.00 – approximately S\$395.00. The fee payable for the search and examination of a PCT application filed in Singapore is S\$1,530.00 if the Australian patent office is indicated, and S\$410.00 if the Austrian patent office is indicated. The PCT search report is accompanied by a written opinion and is the same as the search report and written opinion that issue on a Singapore application in response to a request for search and examination. For Australian applications, there is the right of a response to the examiner's report with no fee being payable for the response, even if amendments are made. Under PCT, the examiner does not have to consider a response unless a Demand is filed.

The search fee for an application filed at the EPO is €1000 and the examination fee is €1,335. These become approximately S\$1,950.00 and S\$2,603.25 respectively, totalling S\$4,553.25. The fees on an application filed at the US patent office (large entity) for search and examination are US\$500 and US\$200 respectively. These become approximately S\$805.00 and S\$322.00 respectively totalling S\$1,127.00.

Why, then, is search and examination in Singapore so expensive when compared to the costs for the same actions at PCT level, and at the national stage in USA and Australia? The European cost is for 25 countries, so the per country cost is quite low.

Why is it that there is a significant difference in cost between the costs of search and examination by the patent offices of Austria and Australia at PCT level, but not at national level?

Why is it that the cost of the search and examination conducted by the Australian patent office is different for a Singapore based PCT application as against a Singapore patent application? Is it to allow for a consideration of responses?

These are questions that are regularly put to our members by Singaporean applicants. We cannot answer them.

In July 2004 it was suggested that the application fee be increased from S\$160.00 to about S\$250.00, and the search and examination fees be reduced. Such cross-subsidies are quite common in patent offices such as, for example, Germany and Australia. Industry representatives at the time both commented that they preferred such an approach as the filing increase is minimal, and the cost of filing in Singapore is quite low.

Also, at present the time for response to a written opinion is five months. Why not move to a more internationally-used system and allow only three months, plus an extra three months at increasing extension of time fees. For example, S\$50.00 for the first month, S\$200.00 for the second month (so two months extension costs S\$250.00) and S\$400.00 for the third month (so three months extension costs S\$650.00). This is similar to the systems used in USA, China, Japan and Korea. It would also encourage more complete, and speedier, responses. The allowance of the extensions of time would be automatic if the form and fee were both correct as is done in USA.

Finally, to contain costs, most patent offices are limiting the right of response. In the Singapore context, the second response would be automatically followed by the examination report, even if not favourable. Submissions and/or amendments in response to a search report but before requesting examination would be considered the first response. This could be done as a practice direction (as should have been the new rule 101 procedures).

In March of this year we made extensive submissions regarding the patent system in Singapore. We trust those items are still under consideration. A copy is attached.

Yours faithfully,

A handwritten signature in black ink, appearing to read 'K. Callinan', written in a cursive style.

Keith Callinan  
Patent Attorney

Enc.