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The Registrar of Trademarks and Patents
Registry of Trade Marks & Patents
51 Bras Basah Road
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Singapore 189554

For the attention of: Ms Isabel Chng

Our Ref: SJ312-99/KC

Your Ref:

BY EMAIL

7 August 2006

Dear Isabel

Re: Proposed 2007 Amendments of the Patents Act

I refer to the discussions held recently and firstly wish to congratulate IPOS on having the material to us so far before the proposed date of implementation.

I also wish to congratulate IPOS on extending the registration of priority right beyond that required by PCT and to accord more to the Patent Law Treaty. This deadline is one of the absolute deadlines we face. It is therefore pleasing to note that the extension will be applied "across the board".

Both of these changes are very good for applicants in that two areas that, in the past, had resulted in loss of rights can now be corrected.

During the discussion, consideration was given to the restoration of priority right and whether it should be on the basis of "in spite of due care" or that it was "unintentional". I strongly submit that it should be on both grounds.

In many instances when the priority deadline is missed we do not know the exact circumstances that lead to the deadline being missed. Even if it is within our office, we will be aware of some of the circumstances but may not be aware of all of the detail. As we both know, quite often the "devil is in the detail". We may not be certain of the more correct ground to use at the time of filing the application and the petition to restore priority right. As such, we will nominate both to preserve the applicant's rights. It will be only after a careful investigation that we will be able to determine what happened, and why, and therefore which is the correct ground, or if both were applicable. I therefore strongly suggest that both grounds be available (and not be separated) at the time of petition for the restoration of

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priority right. In this way the ground for the petition need not be stated at the time of filing the petition.

The petition for restoration of priority right must be made within the time specified. However, normally it takes some time to gather the evidence, to prepare the appropriate affidavit, and to have it sworn. For example, if the mistake was within a client's office, the relevant people may be absent (e.g. overseas). Therefore, there should be a time available for supplying the evidence after filing the application and the petition. It should be by the evidence that the applicant makes the commitment as to whether it was an unintentional error, or in spite of due care.

From my experience in dealing with extensions of time under Section 223 of the Australian Patents Act, Section 224 of the Australian Trademarks Act and the earlier Section 160 of the Australian Patents Act, the time taken to obtain the necessary supporting affidavit from clients (when the error is within the client) can be of some duration. If any person within a corporate patent department has made an error that is related to the missing of the priority claim, in swearing the appropriate affidavit they may be placing themselves in the position when their employment is terminated. So the time taken to obtain the necessary information may be considerable, and obtaining that information may be quite difficult. So please allow a reasonable time for the evidence.

An important factor in the restoration of priority right is that it may be applied for at the very end of the term available, and at the same time as filing the application. Therefore, it is essential that the relevant form be integrated in the PF1(2004), and be available online. The last thing we need when dealing with very strict time limit is to have to file the application without the petition for restoration of priority right, wait on the number being allotted on the application, and only then being able to submit the petition for the restoration of priority right. If there is any delay in issuing the application number, the applicant may miss out due to circumstances beyond its control. If the forms cannot be integrated by 1 April 2007, applicants will be considerably disadvantaged. The problem with separate forms is the requirement for the application number. If this was not a compulsory field in the new form, the problem may be avoided.

In relation to missing parts, my reason for commenting that "incorporation by reference" was an inappropriate term in that it is not used in the changes to the Act and is used not in the changes to the Rules. WIPO have used that expression to describe the changes to PCT but, again, has done so most inappropriately. As advised, this is a term that has been used by patent attorneys for many, many years (at least 35 years in my experience) and we use it in a different way. The confusion is not in the amendments but in the explanation given. Why use an expression in the explanation that has no basis in the amendments? The expression is being used by you in a narrow context rather than the broad context to which it normally applies. I therefore suggest that if there are further presentations to be made, that the expression be not used so as to avoid further confusion.

In relation to Rule 9B(2), the one query I have is the two month limit. In some instances it can take an external office more than two months to provide the certified copy. Where there is a delay that can clearly be evidenced as being beyond the control of the applicant (i.e. as in the international office) should it not be possible to obtain an extension?

For Rule 9C and the translation required, for exceedingly long specifications would the entire specification require translation? This can be important in technologies where long specifications are normal. For example, an application for software may include examples of the source code as an annexure to the specification. Would this require translation even if not relevant to the issue at hand? Perhaps some discretion could be given to the Registrar to request translation of all or part of the document concerned. As proposed, there is no discretion if a translation is called for and the entire document must be translated.

However, in general, I believe the two months time limits provided are reasonable. This allows for receipt of the notification from IPOS, the ability to communicate with our clients overseas by email or by facsimile, a response to be received, and the response filed. Even allowing for holiday periods such as those in Europe and North America, holidays of that duration are quite rare.

With kind regards.

Yours sincerely

A handwritten signature in black ink, appearing to read 'K. Callinan', with a long horizontal flourish extending to the right.

Keith Callinan
Lloyd Wise, Singapore