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24 Apr, 2006 03:46 PM

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Kam Tack
CHIG/IPOS/SINGOV@SIN
GOV

Re: Public Consultation
2006: Proposed
amendments to the Patents
Rules

Dear Kam Tack,

I am so sorry that I have missed the 21 April 2006 deadline. I have only managed to study the proposed amendments more closely over the weekend.

Please find below my comments:

1. The proposed amendment to Rule 43(2)

I believe that it is not necessary to include the words "or 1(A)". Rule 43(2) only covers a situation where a Request for Search Report is made under Section 29(2)(a). This excludes PCT national phase cases. Therefore Rule 43(2) should not be affected by the present proposed amendments.

2. The proposed new Rule 43(4A)

42 months is not mentioned in "paragraphs (1)(a) and (b)". It is mentioned in "paragraph (4)".

3. Treatment of Section 29(2)(e) under the proposed new regime

I believe that it is preferable to remove all reference to Section 29(2)(e) from the Rules such as Rules 43(1), 43(3), 43(4), 43(5), 46(10), 47A etc. Under the proposed new regime, unlike the other Section 29 subsections, Section 29(2)(e) will never follow the timelines of

the fast track system as it is only applicable to PCT national phase applications. Allowing these Rules to stand as they are may result in possible conflicts. It would also appear that the block extension under Section 29(7) is still applicable to PCT national phase.

I would suggest drafting new Rules to cover the deadlines of Section 29(2)(e).

4. Transitional provisions

The proposed amendments suggest that if the 39th month has expired as of 1 October 2006 (for PCT national phase applications with filing dates after 1 July 2004), then an applicant will have to apply for extension of time to enjoy the amended Rules.

The Patents Act and Rules as amended on 1 July 2004 apply to PCT applications with an international filing date of 1 July 2004 and after. Therefore the earliest priority date that could be claimed is 1 July 2003.

39 months from 1 July 2003 would be 1 October 2006.

If the amendments come into force on 1 October 2006, then the above mentioned transitional provisions are not necessary and should not be included.

If the amendments come into force after 1 October 2006, then it would not be equitable to expect a small portion of the applicants to pay extra official fees to enjoy the amendment provisions, since the preparations for these amendments have commenced well before 1 October 2006. In such a case, I would suggest making these amendment provisions retrospective with effect from 1 October 2006, or to waive the PF 45 (2004)/PF 46 (2004) fees (perhaps so long as the extension applications are made within a certain period of time).

I hope the above comments are useful. If you need any clarifications, please do let me know.

Kind regards
Lip Khoon