



**ASIAN PATENT ATTORNEYS ASSOCIATION
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27, April 2006

MS ISABEL CHNG
DIRECTOR, REGISTRY OF PATENTS
INTELLECTUAL PROPERTY OFFICE OF SINGAPORE
51 Bras Basah Road #04-01
Plaza By The Park
Singapore 189554

Dear Madam,

**“PS REVIEW 2006: PROPOSAL TO REVISE THE TIMELINES OF
CERTAIN PROCESSES OF PCT (SINGAPORE) NATIONAL PHASE
ENTRY APPLICATIONS” - INVITATION FOR COMMENTS**

We refer to your letter dated 07 April 2006 and thank you for the opportunity to offer our observations on the proposed amendments to the Patents Rules by the extended dateline of 30 April 2006.

As a general comment, the proposed changes are commendable and will no doubt be welcomed by PCT users, in particular by MNCs who've had to review their overseas filing strategy in light of the unavoidable and onerous block extension fees under the current regime.

That said, we offer the following observations for your consideration:

It appears from the transitional provisions that the proposed changes will only benefit national phase entries for which the respective datelines to file a request for search and examination report /examination report, the filing of prescribed information relating to a corresponding application and the filing of prescribed documents for the grant of the patent have not expired as of 1 Oct 2006. It is not clear to us why applications with datelines properly extended beyond the 1st Oct 2006 dateline should be excluded from the effect of the new Rules.

The proposed changes do not address the situation where an examination report has still not been issued by WIPO by the grant date. In such a situation, the applicant is unable to request for grant due to circumstances beyond his control yet is required to pay extension fees in order to preserve his option to request for grant. This, in our view is inequitable to the applicant. In contrast, an applicant in a direct national filing is not faced with this anomaly because the grant date is not due so long as the examination report is not issued.

We note that the two-track system continues to apply to direct national filings. The two-track system works well if all stakeholders are able to perform their part in the system according to schedule. Our members have encountered occasions where search reports are not issued by the 21 month and their clients are forced to request for examination without the benefit of the search report. Alternatively, they have to incur higher cost and request a combined search & examination at the outset. If there persist in waiting for the search report they have to bear block extension fees if the 39th month deadline is reached. Clearly these are not satisfactory options for local inventors and companies who are highly cost-sensitive. Although the concept of the two-track system is a good one, we are of the view that the interests of patent applicants are better served if the distinction is abolished. The applicant should not be made to bear extension fees for failing to observe deadlines arising from the Patent Office's inability to issue search or examination reports in good time.

We request that the new Patents Rules retain the numbering in the existing Patents Rules to facilitate cross-referencing. If this is not administratively expedient, it would help considerable if the changes in numbering are highlighted.

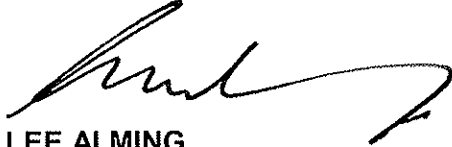
On a separate note, we request your consideration of the requirement for unity of invention as a precondition to grant. Effective from 1 July 2004, the Registry now views unity of invention as a precondition for grant. This may potentially lead to considerable uncertainty as various jurisdictions (particularly the countries whose applications qualify as corresponding applications in Singapore) have varying standards for unity, which will have an impact on Singapore applications relying on the substantive results from a corresponding application to satisfy the search and examination requirements in Singapore.

It is not clear how the Registry views the issue of restriction requirements in the U.S and the requirement for unity of invention in Singapore. Commonly, divisional applications are filed in response to a lack of unity of invention objection. However, US applications subject to a restriction requirement are also required to file a divisional application. US applications subject to restriction requirements may or may not be so restricted due to what we (as in the local patent law context) would define as a lack of unity of invention issue. Therefore, divisional applications arising from a US application may not be due to a lack of unity of invention objection. In the case where it is not, then when these divisional applications are combined in Singapore, they will still meet the precondition for grant. It is not clear how the Registry will view these type of applications. Will the Registry review the combined claims in the Singapore application to establish that the precondition is met, or will they review the substantive reasons for the restriction requirement in the US, or will the Registry just view combined divisional applications as not meeting the precondition for grant on the basis of lack of unity of invention without any substantive review? It would appear, that as these applications would typically not request for a local substantive examination and instead use the substantive results from the Notice of Allowance (in the US) or the granted patent, these applications will not be substantively examined on this basis.

If there cannot be any outstanding issues of unity before grant, then the officers establishing whether the conditions for grant has been met must be able to establish substantively whether there is unity of invention. Rather than put undue burden on the Registry, they may consider removing this requirement.

We thank you in anticipation of your consideration of these observations.

Yours faithfully

A handwritten signature in black ink, appearing to read 'Lee Ai Ming', with a long, sweeping horizontal stroke extending to the right.

LEE AI MING
PRESIDENT