

Our Ref: LS/2006/IPCom – MH/AG

Your Ref:

7 August 2006

Via Email Only

Ms Tan Kar Leng
Assistant Director (Registry of Patents)
Intellectual Property Office of Singapore

Dear Madam

REPRESENTATIONS RELATING TO THE PUBLIC CONSULTATION PAPER ON THE PROPOSED 2007 AMENDMENTS OF THE PATENTS ACT

We refer to your email of 11 July 2006 relating to the Public Consultation Paper on the Proposed 2007 Amendments of the Patents Act.

Proposed section 17(2C)(a)

The proposed amendments to section 17 mirror the section 5(2)(A) of the UK Patents Act 1977. However, proposed section 17(2C)(a) provides that "(a) the request is made within the prescribed period, in the prescribed manner, with the prescribed fee and it shall comply with the prescribed requirements".

We propose adopting the UK provision "(a) the request complies with the relevant requirements of the rules" as this is clearer and easier to understand. The "prescribed period", "prescribed manner" and "prescribed fee" may be provided for in the Rules without specifying them in the Act giving IPOS greater flexibility to make changes subsequently without having to amend the Act. For example, the PCT changes allow the discretion whether or not to charge a fee. It would be better for IPOS to retain flexibility not to charge a fee without any need to amend the Act if they later choose to do so. Furthermore, as "prescribed period" and other variants of "prescribed ..." are already used in many other places of the Act (eg. section 14(4)(c)), and avoiding such duplication of terms where unnecessary would be preferable.

Criterion for restoration of priority

PCT rule 26^{bis}.3(a)(i) provides that the Receiving Office shall restore the right of priority if it finds that the criterion applied by it is satisfied, namely that the failure to file the international application within the priority period: occurred in spite of due care required by the circumstances having been taken; or was unintentional. The PCT provides that each Receiving Office shall apply at least one of those criteria and *may apply both of them*. (emphasis added)

We note that IPOS is seeking views as to the criteria to be adopted. The UK has adopted the criterion of "unintentional" in proposed section 5(2C). This appears to be the lower of the two criteria to satisfy. It is our view that rather than opting for either criterion, IPOS should take advantage of the flexibility allowed by the PCT and provide for both alternative criteria to apply.



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From the standpoint of users and practitioners, the option to select the appropriate criterion that applies and which would be recognised by other designated patent offices where necessary is preferable. For instance, in suitable cases, users may prefer the option of selecting the more onerous "in spite of due care" criterion. Users should also be allowed to rely on both criteria in the declaration in the alternative.

Proposed section 17(2C)(b) adopts the criterion "had arisen in spite of due care" which is not the exact language adopted in PCT rule 26^{bis}.3(a)(i) "occurred in spite of due care required by the circumstances having been taken". Since these words will be of great importance in determining the requisite standard of care, it is best to standardize the language so that users can rely on guidance from the PCT and other countries. If the language is not identical there is a possibility that decisions may deviate from those of other jurisdictions. We propose adopting the same language as the PCT rule 26^{bis}.3(a)(i).

Proposed rule 9A(2) also provides for a fee payable upon making the application for restoration. There is no indication of the amount of this fee. At present the system of extension of time in PF46 and 47 is a 2-step system where the significant fee is paid upon IPOS allowing the extension of time. If IPOS intends to impose a significant fee for the restoration, we request that a similar 2 step approach be adopted and require the payment of any significant fee only upon the acceptance by IPOS of the restoration.

Correction/Addition of Priority

In addition, we note the new procedure for additions and corrections of priority and that for these there is no requirement for affidavit required and the period to act is 16 months. This is intended to replace the current practice of allowing such a correction where it is proved that an error was made by the filing of PF23 (which has no fee) and which can be made at any time. This is to reflect the change in PCT rule 26^{bis}.1. Whilst this follows the UK practice, there does not appear to be any benefit to applicants by the introduction of the new procedure. Instead a fee is payable and there is a time limit for the correction. Applicants would prefer to retain the current system which has greater flexibility.

Establishing a date of filing

We note that proposed section 26(1) is essentially identical to the corresponding UK section 15(1). It appears to make it easier to establish a date of filing compared to the current section 26(1). In particular, it is no longer necessary to identify the applicant as long as sufficient information to contact the applicant is provided. Unfortunately, there is no guidance in the proposed rules as to what would be considered sufficient information. If the identity of such a person is not available, would having his correspondence address be "sufficient"?

A related comment to the applicant's identity arises from proposed rules 19(1A) & (1B) which provide that the lack of the applicant's name and/or address is a deficiency which could be notified to the applicant and rectified. It is not specifically provided whether the effect of rectifying such deficiency would be an establishment of the filing date as of the date of rectification. Proposed section 26(1)(b) appears to assume that it is possible to provide sufficient contact information for the applicant without providing his name and/or address. If so, the filing date could be established prior to the date of rectification. Therefore, it remains crucial how the sufficiency of contact information is to be determined.

We note that the public consultation paper (Annex A) available on IPOS' website explains that the purpose of proposed section 26, including subsection (1), is alignment with proposed PCT changes. Referring to the proposed PCT changes as indicated by Annex A, it appears that the requirements for establishing a date of filing under the proposed PCT changes are stricter. In particular, proposed PCT rule 20.1(b) requires the applicant's identity to be established, not just contactable. Therefore, the proposed section 26(1) has gone beyond the PCT changes. Although this may not be a problem on its own, it is important not to introduce uncertainty and we recommend that better guidance be provided regarding what would be "sufficient" contact information.

Reference to a relevant application

Proposed rule 26(1) requires a reference to include the application number at the filing date. It is noted that a declaration of priority, which also relates to a relevant application, does not need to include the application number at the filing date. A clarification for this distinction would be useful.

Translations

Proposed rule 19(10)(b) provides 2 alternatives for filing a translation of non-English descriptions submitted at the filing date. These are described as "a translation into English of that thing" and an English description "with a declaration that it is a complete and accurate translation into English of that thing". A typical translation would itself be an English description. Therefore, it would seem that the key difference between the 2 alternatives appears to be the superfluous inclusion of a declaration in the latter alternative. This should be contrasted with proposed section 26(10)(b) read with proposed rule 26(2)(b) where both an English translation or a declaration were provided as alternatives. The declaration in that case relates to the case where a patent application is accompanied by an English description.

Proposed rule 19(11) imposes a period of 2 months within which a translation needs to be filed when notified of the same by the Registrar. It is noted that the reckoning of the 2 months starts on the date of notification. It is proposed that the translation be submitted within 2 months from the date of notification which is consistent with the language of the provisions implementing other prescribed periods.

Further, since an English translation may possibly be filed after 2 months from the filing date, a practical concern arises on the Registrar's timely clearance of security under section 34 so that foreign filing may be undertaken by the applicant. In particular, if reliance on proposed section 26(1)(c)(ii) could lead to delayed security clearance and consequent negative directions under section 33, this may reduce its usefulness in practice. Further, section 34(1) does not refer to the filing date but rather to the fact that "an application ... has been filed". This creates a potential uncertainty whether the 2 months under section 34(1)(a) runs from the filing date established under proposed section 26(1) or the "initiation date" as defined under the proposed rules as being the date on which any of the documents in proposed section 26(1) is "filed".

Missing parts

Proposed rule 26A(1) requires the "missing parts" to be filed before the date of the preliminary examination. Unfortunately, the date of preliminary examination is not determinable by the applicant until he is notified pursuant to section 28(3). This leads to a limbo status for missing parts filed after the date of preliminary examination but before the date of notification pursuant to section 28(3). To improve certainty to the applicant, it is proposed that the period for filing missing parts be clearly specified as a certain number of months or as ending at the date of the section 28(3) notification.

Proposed rule 26A(5) appears to be missing a conjunctive, presumably "or", between its 2 limbs.

Proposed rule 26A(5)(b) destroys the effect of a section 26(7)(b) request if the applicant does not furnish certified copies of "all" earlier relevant applications. There appears to be a procedural trap in that not all relevant applications may be the subject of references in the application.

Preliminary examination

As a point of workflow under proposed section 28(9), although it is useful for the Registrar to inform the applicant of non-compliance with proposed section 26(10), it is not clear how it interacts with the mechanism of proposed section 26(10). Proposed rule 27A provides a period of 12 months or 2 months from the filing date to comply with proposed section 26(10) ("the compliance route"). In reporting the Registrar's determination under proposed section 28(3) read with proposed section 28(9), the Registrar may impose a period to respond to the determination under proposed section 28(6) ("the remediation route"). This potentially raises a few practical questions:

1) if the period (or rather, deadline) imposed under the compliance route and the remediation route are different, which takes precedence? The negative consequence of the compliance route is automatic abandonment (proposed section 26(10)), while that of the remediation route is refusal of the application (proposed section 28(7)). They are equally dire.

2) the remediation route provides for amendment of the application subject to section 84 (eg, no added subject matter). The compliance route allows the introduction of missing parts without any apparent limitation (except rule 26A(5)). If a section 28(3) issues, must the applicant planning to submit missing parts under section 26(10) be prevented by section 84?

Transitional provisions

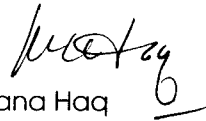
Annex A states that the changes would apply to any SG applications which qualify for a date of filing by complying with the new section 26(1) on or after 1 April 2007. It appears from this that an application may be filed at IPOS on 1 April 2007 allowing for restoration of priority for example from 1 March 2006. Is the intention of the amendment to immediately allow applications for restoration from 1 April 2007? We would appreciate IPOS' confirmation of this.

Repeal of Sections 51 and 52

These provisions are being repealed on the basis that the Competition Act deals with restrictive agreements and practices (in section 34) and the abuse of a dominant position (in section 47). We agree that the competition law is a better means for dealing with these issues and it is reasonable to consider their repeal. Some of our members have commented that sections 51 and 52 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.

We also note that the transitional provisions provide that the sections 51 and 52 will continue to apply to agreements entered into before 1 August 2007. As the competition law is already in force, if it is desirable that sections 51 and 52 to be repealed, there should be no need for transitional provisions to create 2 sets of overlapping standards governing agreements pre-1 August 2007.

Yours faithfully



Murgiana Haq
Chairperson
Intellectual Property Committee
Of The Law Society of Singapore