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THE LAW SOCIETY
OF SINGAPORE

21 April 2006

Via Email Only

Ms Isabel Chng
Director (Patents)
Legal Counsel
Intellectual Property Office of Singapore
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Dear Isabel

**"PS REVIEW 2006: PROPOSAL TO REVISE THE TIMELINES OF CERTAIN
PROCESSES OF PCT (SINGAPORE) NATIONAL PHASE ENTRY APPLICATIONS"
INVITATION FOR COMMENTS
CONSULTATION PAPER OF 7 APRIL 2005**

We refer to your email of 10 April 2006 and the Public Consultation Paper of 7 April 2006 relating to the proposed amendments to the Patent Rules.

Considering the far-reaching effect of the amendments, we were concerned by the little time available for public consultation and consideration. Be that as it may, we have reviewed the Paper to the best of our abilities given the limited time and our comments are as follows:

a) We welcome the postponement of the 21 month examination deadline faced by PCT national phases in Singapore to 39 months and the corresponding postponement of the deadline to file prescribed information (or notice to rely on IPRP) to 60 months. This addresses a significant weakness which plaques the current system and we are glad that efforts are being expended to resolve it.

b) It is not clear from the Paper that the amendment will take effect with sufficient lead-time before 1 October 2006. This would mean that applicants will not have the opportunity to react to the same. In particular, we note that if the 39 month had expired on 1 Oct 2006 (or 42 month, as the case may be), extension fees would be payable to enjoy the new Rule 43(1A) (or Rule 43(4A) and Rule 47(1A), as the case may be). Rather than that, we feel that it is more useful if a window period of say 3 to 6 months is provided post 1 Oct 2006 for reliance on the new provisions without penalty of extension fees, even though the current deadlines may have expired on 1 Oct 2006.

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c) We also note that applicants who had relied on the current stricter position (ie, by having filed PF11B, PF11C or PF14, as the case may be) are penalized whether the 39 months had expired by 1 October 2006 (or 42 months as the case may be). PF11B and PF11C situations without any accompanying extensions of time are extremely rare. However, PF14s are a different matter. It is, we submit, fairer that these applicants also be given the opportunity of a more forgiving transitional position (eg, allowing the new deadlines to apply).

d) There is a potential conflict in the new provisions with the old. The new Rule 43(4A) allows an applicant to file a notice to rely on IPRP (under s29(2)(e)(ii)) within 60 months. Presently under Rule 47A(3), the applicant may also do so but needs a block extension request under Rule 43(5) by the 39th month. However, Rule 43(5) appears unchanged by the amendments and potentially conflicts with the new Rule 43(4A) which does not require a block extension.

e) We regret that the amendments do not extend to removal of the dichotomy between fast and slow track national applications. It is our view that the dichotomy is artificial and has the effect of imposing financial sanctions on applicants who may have very legitimate reasons for delaying prosecution in Singapore. The same effect of fast and slow track could have been achieved by removing the block extension process. Even without a so-called "fast-track" option, applicants who wish to move faster could choose to request search/examination earlier in any event.

f) We are hopeful that our representations submitted on 8 March 2006 would already be under consideration although we have not received any response from IPOS to-date. In view of the current proposal to amend the Rules, we urge that our representations be considered so that requisite changes to the Rules can also be addressed at the same time. In that regard, we look forward to discussing the same with IPOS as soon as possible.

We believe the above is helpful. We would be pleased to discuss the above items with IPOS and look forward to receiving your response as soon as possible.

Yours sincerely



Murgiana Haq
Chairperson
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