

SEPTEMBER 2007 Time extensions uncertainty over divisional applications

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Under the Singapore Patents Act, a divisional application must be filed before grant conditions are met for the parent application. In any event, the divisional application must be filed before the parent application has been refused, withdrawn or treated as having been abandoned.

The grant conditions mentioned above include formal requirements to be met for the parent application as well as payment of the grant fee for the parent application. The relevant deadline for satisfying the grant conditions is 42 months from the earliest priority date under the default fast track prosecution procedure in Singapore (or 60 months from the earliest priority date under the optional slow track prosecution procedure). If the grant conditions are not satisfied before the relevant deadline or any extension, the parent application is deemed to have been abandoned.

Thus, the deadline for filing the divisional application is linked to prosecution of the parent application. While this is not unusual compared with other jurisdictions, the Singapore system is different in one significant way. For example, in the US, the deadline for filing a divisional application is non-extendable and is triggered by the issuance of the parent patent by the USPTO, which is an action by the Patent Office. In contrast, the deadline for filing the divisional application in Singapore is not dependent on actions of the Patent Office but rather, dependent on the applicant fulfilling the grant conditions for the parent application (that is, not the actually granting by the Singapore Patent Office).

This means that there is effectively no direct prescribed deadline for filing the divisional application. While the prosecution deadline for satisfying the grant conditions for the parent application is extendable as of right, it is not clear whether the "deadline" to file the divisional application can be extended directly as-of-right.

Typically, if the grant fee for the parent application is not paid by the 42-month deadline, the parent application would be deemed abandoned, but that abandonment can be retrospectively resolved. The grant fee deadline may be extended as-of-right for up to three months and the time extension request may be filed before the end of the period for which extension is sought. In practice, therefore, an applicant can allow the grant fee deadline to lapse and later request for the as-of-right time extension at the time of paying the grant fee (that is, after the deadline but before the three months period is over).

Thus, for an applicant who decides to file a divisional application after the grant fee deadline for the parent application has expired but without wanting to pay the grant fee (for example, if a corresponding foreign patent does not issue in time), it is uncertain whether the divisional application can still be validly filed. On the relevant form for requesting the time extension, there is no provision for extending the deadline for filing the divisional application. Thus, it is unclear whether it is legally correct for the applicant to request the time extension indicating explicitly that the time extension is for paying the grant fee but simultaneously filing a divisional application instead of paying the grant fee.

In view of the above, if an applicant is considering delaying paying the grant fee for an application with a view to possibly filing a divisional application later, we would recommend that the applicant requests the as-of-right time extension before the grant fee deadline actually expires. This will clearly avoid the application being deemed as abandoned as long as the requested time extension period has not expired. Therefore, not only is the applicant allowed additional time to consider whether to pay the grant fee and/or file the divisional application, but also, regardless of whether the grant fee is ultimately paid before the requested time extension period expires, the above mentioned uncertainties in relation to filing the divisional application would also be removed or at least significantly reduced.



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