

## OCTOBER 2007 Loss of time extensions as of right

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Under the interpretation of the rules put forth by the Intellectual Property Office of Singapore (IPOS), the extensions of time as of right under Rule 108(3) are not available under the slow track option.

Singapore has a fast and slow track patent application system for applications with a filing date on or after July 1 2004. Each track has its own set of prescribed periods for the purpose of complying with the search and examination requirements, and the payment of the fee for grant.

For convention, non-convention and national phase applications under the Patent Cooperation Treaty (PCT), the non-extendable deadline for invoking the slow track is 39 months from the declared priority date. Upon invoking the slow track, the prescribed periods available under the slow track system are extended by 18 months from the prescribed periods under the fast track.

The acts and their respective time extensions under the slow track are summarized as follow:

- request for search and examination report, being extended from 21 to 39 months from the declared priority date;
- file a search report and request for an examination report based on the search report, being extended from 21 to 39 months from the declared priority date;
- file prescribed information, for example, final examination results or certified patent document, relating to a corresponding foreign application in selected jurisdictions or international patent application to be relied on for grant, being extended from 42 to 60 months from the declared priority date; and
- payment of the fee for the grant of the Singapore patent application, extended from 42 to 60 months from the declared priority date.

The position being taken by IPOS is that the election of the slow track route is an "extension of time". Rule 108(3) stipulates that extensions of time under this provision are only allowed if "not previously extended". Therefore IPOS will not allow an extension of time as of right under the slow track because it regards the deadlines as having already been extended.

While it could be argued that IPOS is technically correct in its application of Rule 108(3) due to its present wording, this does not appear to be the intention of the Rules. This is because the Rules define prescribed deadlines under each of the respective slow and fast tracks. Furthermore, Singapore patent applicants should not be in danger of loosing their patent rights due to what is effectively a formality action.

Under the rules as interpreted by IPOS, any request for an extension of time under the slow track would be subject to the Registrar's approval and require the submission of a statutory declaration or affidavit stating the grounds for the request.

The position advanced by IPOS creates some issues, particularly as it relates to PCT applications that enter the national phase in Singapore at the 30 month deadline. The request for search and examination must be filed concurrently with the request to invoke the slow track option. If instructions are provided last minute (for example, a foreign firm in the US provides instructions to invoke the slow track and request local examination on the 39 month due date) these instructions would not reach the Singapore patent agent until the following day. Under the interpretation of the rules propagated by IPOS, this one day delay necessitates the filing of a statutory declaration and a request for an extension of time under Rule 108(4).

The costs involved in making this late request for local search and exam then become comparable to the costs for filing a divisional application. However, filing the divisional application further extends the deadlines for requesting local search and exam, or for relying on corresponding information from foreign patents. If an applicant is still awaiting results from corresponding applications, it becomes more cost effective to file a divisional application, rather than request local search and exam with an extension of time under Rule 108(4).



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