

# Patents (Amendment) Rules 2003

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### **THE SCHEDULE Miscellaneous Amendments**

**No. S 324**

PATENTS ACT  
(CHAPTER 221)

PATENTS (AMENDMENT) RULES 2003

In exercise of the powers conferred by section 115 of the Patents Act, the Minister for Law, after consulting with the Intellectual Property Office of Singapore, hereby makes the following Rules:

#### **Citation and commencement**

**1.** These Rules may be cited as the Patents (Amendment) Rules 2003 and shall come into operation on 1st August 2003.

## **Amendment of rule 2**

**2.** Rule 2 of the Patents Rules (R 1) is amended —

(a) by inserting, immediately after the definition of “certification authority” in paragraph (1), the following definition:

““convention country” has the same meaning as in section 17(6);”;

(b) by deleting the words “which is a convention country specified in an order made under section 89” in paragraph (b) of the definition of “declared priority date” in paragraph (1) and substituting the words “which is a convention country”; and

(c) by deleting the words “and the Austrian Patent Office” in paragraph (3) and substituting the words “, the Austrian Patent Office and the Danish Patent and Trademark Office”.

## **Amendment of rule 3**

**3.** Rule 3 of the Patents Rules is amended —

(a) by deleting the words “rules 19 (2) and 117 (1)” in paragraph (2) and substituting the words “rule 117 (1)”;

(b) by deleting the word “matter” in the last line of paragraph (2) and substituting the words “form corresponding to the matter”; and

(c) by inserting, immediately after paragraph (2), the following paragraph:

“(3) Unless the Registrar permits or directs otherwise, payment of a fee in connection with an act referred to in rule 96A (2) shall be made using the electronic online system if the act is carried out using that system.”.

## **Amendment of rule 9**

**4.—(1)** Rule 9 of the Patents Rules is amended by deleting paragraphs (5), (6) and (7) and substituting the following paragraphs:

“(5) Where —

(a) a copy of an application is filed or treated as having been filed under paragraph (2A), (3) or (4); and

(b) that application is in a language other than English,

the Registrar may, where the validity of the claim to priority is relevant to determining whether the invention concerned is patentable, by notice sent to the applicant or proprietor, as the case may be, require him to furnish a translation of the application into English within 2 months from the date of that notice.

(6) The translation referred to in paragraph (5) shall be verified to the satisfaction of the Registrar as corresponding to the original text.

(7) If —

- (a) the applicant fails to comply with paragraph (2) or (2A); or
- (b) the applicant or proprietor fails to comply with a requirement under paragraph (5),

within the time specified or as extended under rule 108, the claim to priority shall be deemed to be relinquished.”.

(2) Paragraph (1) shall apply to —

- (a) an application for a patent made on or after 1st August 2003; and
- (b) an application for a patent made before that date if the compliance date for that application has not expired by that date.

(3) In paragraph (2), “compliance date”, in relation to an application for a patent, means the date by which the translation referred to in rule 9 (5) in force immediately before 1st August 2003 is (but for paragraph (2)) to be lodged with the Registrar under that provision, including such date as extended under the provisions of the Patents Rules in force immediately before 1st August 2003.

### **Amendment of rule 18**

5. Rule 18 of the Patents Rules is amended —

- (a) by deleting the words “made on Patents Form 8” in paragraph (1) and substituting the words “filed with the Registrar on Patents Form 8”;
- (b) by deleting paragraph (2) and substituting the following paragraph:

“(2) Where —

- (a) the applicant is not the sole inventor; or
- (b) the applicants are not the joint inventors of the invention,

and the application does not contain a declared priority date which relates to an earlier relevant application as defined in section 17(5)(b), the Registrar shall send a copy of the Patents Form 8 filed under paragraph (1) to each inventor who is not one of the applicants.”; and

- (c) by deleting the words “paragraphs (1) and (2)” in paragraph (3) and substituting the words “paragraph (1)”.

### **Amendment of rule 19**

6. Rule 19 of the Patents Rules is amended by deleting paragraph (2) and substituting the following paragraph:

“(2) Where a document containing an indication that a patent is sought in pursuance of an application is filed with the Registrar without Patents Form 1 or the filing fee, the Form shall be filed with, and the fee shall be paid to, the Registry within one month from the date of the filing of the document.”.

### **Amendment of rule 21**

7. Rule 21 of the Patents Rules is amended by inserting, immediately after paragraph (6), the following paragraph:

“(7) Paragraphs (1) to (4) and (5)(f), (g) and (j) shall not apply to any drawing to be filed with the Registry using the electronic online system, and that drawing shall instead comply with practice directions issued by the Registrar in place of the requirements of those paragraphs.”.

### **Amendment of rule 23**

8. Rule 23 of the Patents Rules is amended —

(a) by deleting paragraph (1) and substituting the following paragraphs:

“(1) Subject to paragraph (29), this rule shall apply to all documents (including drawings) making up an application for a patent, including any replacement thereof, to be filed with the Registry by any means.

(1A) All documents referred to in paragraph (1) shall be in English.”;

(b) by deleting the words “electrostatic processes” in paragraph (3) and substituting the words “electrostatic or electronic processes, scanning”;

(c) by deleting the words “, except in the case of a request for the grant of a patent” in paragraph (5);

(d) by deleting paragraph (6) and substituting the following paragraph:

“(6) All documents referred to in paragraph (1) shall be in A4 paper size (29.7 cm x 21 cm) and shall be on pliable, strong, white, smooth, matt and durable paper.”;

(e) by deleting the words “Patents Form 1 may be completed in writing, and that” in paragraph (15); and

(f) by inserting, immediately after paragraph (28), the following paragraph:

“(29) Paragraphs (2) and (4) to (15) shall not apply to any document to be filed with the Registry using the electronic online system, and that document shall instead comply with practice directions issued by the Registrar in place of the requirements of those paragraphs.”.

### **Amendment of rule 28**

**9.** Rule 28 of the Patents Rules is amended —

- (a) by deleting the words “or (5)” in paragraph (2);
- (b) by inserting, immediately after paragraph (2), the following paragraph:

“(2A) Where a new application is filed under section 20(3), 26 (6) or 47 (4), the requirement of paragraph (5) of rule 9, if applicable, shall be met no later than the time prescribed in that paragraph.”;
- (c) by deleting the words “and (5)” in paragraph (3)(b) and (c); and
- (d) by deleting the words “the requirements of rule 9 (2), (2A) and (3), and rule 9 (5) or 18, as the case may be,” in paragraph (3) and substituting the words “the requirements of rules 9 (2), (2A) and (3) and 18”.

### **Amendment of rule 33**

**10.** Rule 33(1) of the Patents Rules is amended by deleting the words “and (5) (other than those contained in paragraph (5) (h))” in sub-paragraph (b) and substituting the words “, (5) (other than those contained in paragraph (5) (h)) and (7)”.

### **Amendment of rule 47**

**11.** Rule 47 of the Patents Rules is amended —

- (a) by inserting, immediately after paragraph (5), the following paragraph:

“(5A) Paragraph (5) shall not apply to the copy of the specification if it is to be filed using the electronic online system, and the copy shall instead comply with practice directions issued by the Registrar in place of the requirement in that paragraph.”; and
- (b) by deleting the words “Paragraphs (4), (5) and (6)” in paragraph (7) and substituting the words “Paragraphs (4), (5), (5A) and (6)”.

### **Amendment of rule 48**

**12.** Rule 48 of the Patents Rules is amended —

- (a) by deleting sub-paragraph (a) of paragraph (1) and substituting the following sub-paragraph:

“(a) the request for the grant of a patent on Patents Form 1; or”;  
and

(b) by inserting, immediately after paragraph (3), the following paragraph:

“(4) Paragraphs (2) and (3) shall not apply if the application for amendment is to be filed using the electronic online system; and the application for amendment shall instead comply with practice directions issued by the Registrar in place of the requirements in those paragraphs, including the filing of such other document prepared in such manner as may be specified therein.”.

### **Amendment of rule 51**

**13.** Rule 51 of the Patents Rules is amended —

- (a) by inserting, at the end of paragraph (3)(a), the word “or”;
- (b) by deleting the word “; or” at the end of paragraph (3)(b) and substituting a full-stop;
- (c) by deleting sub-paragraph (c) of paragraph (3); and
- (d) by deleting paragraph (3A) and substituting the following paragraph:

“(3A) Payment of any additional fee for a late application for the renewal of a patent referred to in section 36(3) shall be made to the Registry together with Patents Form 16.”.

### **Amendment of rule 56**

**14.** Rule 56(3) of the Patents Rules is amended by deleting sub-paragraph (b).

### **Amendment of rule 58**

**15.** Rule 58(1) of the Patents Rules is amended by deleting the words “annexed to the form” and substituting the words “filed together with the form”.

### **Amendment of rule 75**

**16.** Rule 75 of the Patents Rules is amended by deleting paragraph (4) and substituting the following paragraph:

“(4) Patents Form 15 shall be filed with the Registry when fees are paid to the Registry under this rule.”.

### **Amendment of rule 86**

**17.** Rule 86 of the Patents Rules is amended —

- (a) by deleting the words “and (5)” in paragraph (4)(c); and
- (b) by deleting the words “one month” in paragraph (6)(a) and substituting the words “2 months”.

### **Amendment of rule 91**

**18.** Rule 91 of the Patents Rules is amended —

- (a) by deleting the following words in paragraph (1):

“and shall be accompanied by a copy of the document with the proposed correction indicated therein in the following manner:

- “(a) by striking through any text, figure or other matter to be replaced or deleted; and
- (b) by underlining any replacement text, figure or other matter”;

- (b) by inserting, immediately after paragraph (1), the following paragraph:

“(1A) The request shall be accompanied by a copy of the document with the proposed correction indicated in the following manner:

- (a) by striking through any text, figure or other matter to be replaced or deleted; and
- (b) by underlining any replacement text, figure or other matter.”;

- (c) by deleting the words “paragraph (1)” in the existing paragraph (1A) and substituting the words “paragraph (1A)”;

- (d) by renumbering the existing paragraph (1A) as paragraph (1B), and by inserting immediately thereafter the following paragraph:

“(1C) Paragraphs (1A) and (1B) shall not apply if the request is to be filed using the electronic online system; and the request shall instead comply with practice directions issued by the Registrar in place of the requirements in those paragraphs, including the filing of such other document prepared in such manner as may be specified therein.”.

### **Amendment of rule 93**

**19.** Rule 93(4) of the Patents Rules is amended by deleting “60 (2),” in sub-paragraph (d).



### **Amendment of rule 96A**

**20.** Rule 96A of the Patents Rules is amended by deleting paragraph (2) and substituting the following paragraph:

“(2) Unless otherwise directed by the Registrar —

- (a) the filing with the Registry of Patents Form 1 or the specification or abstract forming part of an application for a patent;
- (b) the filing with the Registry of any form referred to in rule 9 (3)(a)(ii), 18 (1), 36, 37, 45 (2), 47 (3), 48 (1), 51 (3), (3A) or (7), 54 (1), 56 (1), (3) or (3A), 58 (1), 63 (1) or (2), 75 (4), 86 (7), 90 (2), 91 (1), 92 (3), 93 (1) or (2) or 108 (3), (3A) or (6);
- (c) the filing with the Registry of any document referred to in rule 47 (4), 48 (4), 58 (1) or 91 (1C); or
- (d) the inspection, search or retrieval referred to in rule 59, or the supply of a copy or extract referred to in rule 63 (2),

shall be carried out using the electronic online system either by an account holder or via a service bureau.”.

### **Amendment of rule 96D**

**21.** Rule 96D(3) of the Patents Rules is amended by deleting the words “If the person desires to make use” and substituting the words “Before a person makes use”.

### **Deletion and substitution of rule 96H**

**22.** Rule 96H of the Patents Rules is deleted and the following rule substituted therefor:

**“Use of electronic online system to be in accordance with these Rules, etc.**

**96H.** A person shall comply with these Rules and practice directions issued by the Registrar when using the electronic online system for any purpose under these Rules.”.

### **Amendment of rule 96I**

**23.** Rule 96I of the Patents Rules is amended by deleting the words “rule 96D (5)” and substituting the words “rule 96D (4)”.

### **New rule 96K**

**24.** The Patents Rules are amended by inserting, immediately after rule 96J, the following rule:

**“Service bureau**

**96K.** The Registrar may establish or appoint agents to establish one or more service bureaus to assist in the use of the electronic online system in carrying out any of the transactions referred to in rule 96A(2).”.

### **Amendment of rule 97**

**25.** Rule 97 of the Patents Rules is amended —

- (a) by deleting the word “Any” in paragraphs (1) and (1A) and substituting in each case the words “Subject to rule 96A (2), any”;
- (b) by deleting paragraph (1B); and
- (c) by deleting the words “A document containing a request for the grant of a patent, and any later document” in paragraph (2) and substituting the words “A document containing an indication that a patent is sought in pursuance of an application, and any document”.

### **Amendment of rule 98**

**26.** Rule 98 of the Patents Rules is amended —

- (a) by deleting the words “and the register shall be open to inspection, on payment of the fee specified in the First Schedule” in paragraph (1);
  - (b) by deleting paragraph (2A) and substituting the following paragraph:
    - “(2A) Notwithstanding paragraphs (1) and (2), the Registry shall be taken to be open every day at all hours —
      - (a) for the submission of any document pertaining to an application for a patent by means of the Patents Deposit Box; and
      - (b) for the carrying out of any of the transactions referred to in rule 96A (2) by means of the electronic online system, and the retrieval of published patent specifications by means of that system.”;
- (c) by deleting the words “notwithstanding the availability of the electronic online system” in paragraph (2B) and substituting the words “notwithstanding the availability of the Patents Deposit Box or electronic online system”;
- (d) by deleting “12 a.m.” in paragraphs (3), (4) and (6) and substituting in each case the word “midnight”;
- (e) by inserting, immediately after paragraph (5), the following paragraph:
  - “(5A) Any document filed by means of the Patents Deposit Box containing more than one sheet of information shall be considered as

having been submitted on the day by which all the sheets comprising the complete document have been deposited in the Patents Deposit Box before midnight of that day or, if that day is an excluded day, on the next following day which is not an excluded day.”;

- (f) by deleting the words “Notwithstanding paragraphs (1) and (2), any document” in paragraph (6) and substituting the words “Any document”; and
- (g) by inserting, immediately after paragraph (8), the following paragraph:

“(9) In this rule, “Patents Deposit Box” means the box with openings for placing documents that is installed at the premises of the Registry and designated as such.”.

### **Amendment of First Schedule**

**27.** The First Schedule to the Patents Rules is amended —

- (a) by deleting item 1;
- (b) by deleting the dash in item 2 under the heading “*Amount*” and substituting “160”;
- (c) by inserting, immediately after item 12, the following items:

“

12A.	On furnishing details referred to in rule 39 (1)	—	11A
12B.	On furnishing information referred to in rule 44 (1)	—	11B

”;

- (d) by deleting item 16;
- (e) by deleting the words “by means of the electronic online system” in item 16A under the heading “*Matter or Proceeding*”;
- (f) by inserting, in item 16A under the heading “*Corresponding Form No.*”, “15”;
- (g) by deleting item 17;
- (h) by deleting the words “by means of the electronic online system” in item 17A under the heading “*Matter or Proceeding*”;
- (i) by inserting, in item 17A under the heading “*Corresponding Form No.*”, “16”;

- (j) by deleting the words “and upon request made other than by means of the electronic online system,” in item 26 under the heading “*Matter or Proceeding*”;
- (k) by deleting “25” in item 26 under the heading “*Amount*” and substituting “12”;
- (l) by deleting item 26A;
- (m) by deleting “10” in item 43 under the heading “*Amount*” and substituting the words “10 for each patent or application for patent”;
- (n) by deleting item 55;
- (o) by deleting the words “by means of the electronic online system” in item 56 under the heading “*Matter or Proceeding*”;
- (p) by inserting, in item 56 under the heading “*Corresponding Form No.*”, “53”;
- (q) by deleting item 57 and substituting the following item:

“

57. For using the patent computer facilities in the public search room of the Registry —	—
(a) for every half-hour or part thereof of log on access using the patent search terminal	2
(b) for each sheet of information printed	0.30
(c) for every hour or part thereof of using the secured enclosure with terminal for patent application preparation for the purpose of using the electronic online system	22.50
(d) for purchase of each recordable compact disc	1.60
(e) for each session of use of the certificate belonging to the Registry for use with the electronic online system	5 and

”;

- (r) by inserting, immediately after item 58, the following item:

“

59. For using the services of a service bureau referred to in rule 96K to file the following by means of the electronic online system:

(a) any form or other document referred to in rule 36, 37 or 45 (2) 120 per form and 0.50 for every page of form or document

(b) any form or other document referred to in rule 9 (3) (a) (ii), 19 (1), 47 (3), 51 (3), (3A) or (7), 54 (1), 56 (1), (3) or (3A), 58 (1), 63 (1) or (2), 75 (4), 86 (7), 90 (2), 91 (1), 92 (3), 93 (1) or (2) or 108 (3), (3A) or (6) 45 per form and 0.50 for every page of form or document

”.

## Miscellaneous amendments

**28.** The Patents Forms in the Second Schedule to the Patents Rules that are specified in the first column of the Schedule are amended in the manner specified in the second column thereof.

## THE SCHEDULE

Rule 28

### MISCELLANEOUS AMENDMENTS

#### *First column*

(1) Patents Forms 2, 4, 6, 8, 10, 13, 15, 20, 32 to 35, 40, 44, 48 and 53

#### *Second column*

Delete paragraph 7 under the heading “NOTES” and substitute in each case the following paragraph:

“7. Where an individual is appointed as an agent, the sub-field “Name” under “DETAILS OF AGENT” must be completed by entering the full name of the individual. The sub-field “Firm” must be left blank. Where a partnership/body corporate is appointed as an agent, the sub-field “Firm” under “DETAILS OF AGENT” must be completed by entering the name of the partnership/body corporate. The sub-field “Name” must be left blank. Where both the “Name” and “Firm” have been

entered, the Registry shall treat the details entered in the sub-field “Firm” as the agent detail intended.”.

(2) Patents Forms 3, 7, 16, 17, 25, 26, 39, 45, 46, 47 and 50 Delete paragraph 8 under the heading “NOTES” and substitute in each case the following paragraph:

“8. Where an individual is appointed as an agent, the sub-field “Name” under “DETAILS OF AGENT” must be completed by entering the full name of the individual. The sub-field “Firm” must be left blank. Where a partnership/body corporate is appointed as an agent, the sub-field “Firm” under “DETAILS OF AGENT” must be completed by entering the name of the partnership/body corporate. The sub-field “Name” must be left blank. Where both the “Name” and “Firm” have been entered, the Registry shall treat the details entered in the sub-field “Firm” as the agent detail intended.”.

(3) Patents Forms 5, 11, 11B, 12, 14, 18, 19, 21, 22, 27, 29, 30, 31, 36 and 43 Delete paragraph 6 under the heading “NOTES” and substitute in each case the following paragraph:

“6. Where an individual is appointed as an agent, the sub-field “Name” under “DETAILS OF AGENT” must be completed by entering the full name of the individual. The sub-field “Firm” must be left blank. Where a partnership/body corporate is appointed as an agent, the sub-field “Firm” under “DETAILS OF AGENT” must be completed by entering the name of the partnership/body corporate. The sub-field “Name” must be left blank. Where both the “Name” and “Firm” have been entered, the Registry shall treat the details entered in the sub-field “Firm” as the agent detail intended.”.

(4) Patents Forms 9, 11A, 28 and 38 Delete paragraph 5 under the heading “NOTES” and substitute in each case the following paragraph:

“5. Where an individual is appointed as an agent, the sub-field “Name” under “DETAILS OF AGENT” must be completed by entering the full name of the individual. The sub-field “Firm” must be left blank. Where a partnership/body corporate is appointed as an agent, the sub-field “Firm” under

“DETAILS OF AGENT” must be completed by entering the name of the partnership/body corporate. The sub-field “Name” must be left blank. Where both the “Name” and “Firm” have been entered, the Registry shall treat the details entered in the sub-field “Firm” as the agent detail intended.”.

(5) Patents Form 23

(a) Delete paragraph 1 under the heading “NOTES” and substitute the following paragraph:

“1. \* denotes mandatory fields. However, where an application is made to change the agent’s address under the heading “(B) Change of address of” in paragraph 6, the field for “PATENT APPLICATION NUMBER” in paragraph 2 must be left blank.”.

(b) Delete paragraph 7 under the heading “NOTES” and substitute the following paragraph:

“7. Where an individual is appointed as an agent, the sub-field “Name” under “DETAILS OF AGENT” must be completed by entering the full name of the individual. The sub-field “Firm” must be left blank. Where a partnership/body corporate is appointed as an agent, the sub-field “Firm” under “DETAILS OF AGENT” must be completed by entering the name of the partnership/body corporate. The sub-field “Name” must be left blank. Where both the “Name” and “Firm” have been entered, the Registry shall treat the details entered in the sub-field “Firm” as the agent detail intended.”.

(6) Patents Form 41

Delete paragraph 3 under the heading “NOTES” and substitute the following paragraph:

“3. Where an individual is appointed as an agent, the sub-fields “Name”, “Address” and “Address for service in Singapore” in paragraph 5 must be completed. The sub-field “Firm” must be left blank. Where a partnership/body corporate is appointed as an agent, the sub-fields “Firm”, “Address” and “Address for service in Singapore” in paragraph 5 must be completed. The sub-field “Name” must be left blank. Where both the “Name”

and “Firm” have been entered, the Registry shall treat the details entered in the sub-field “Firm” as the agent detail intended.”.

(7) Patents Form 42

Delete paragraph 4 under the heading “NOTES” and substitute the following paragraph:

“**4.** Where an individual is appointed as an agent, the sub-field “Name” under “DETAILS OF AGENT” must be completed by entering the full name of the individual. The sub-field “Firm” must be left blank. Where a partnership/body corporate is appointed as an agent, the sub-field “Firm” under “DETAILS OF AGENT” must be completed by entering the name of the partnership/body corporate. The sub-field “Name” must be left blank. Where both the “Name” and “Firm” have been entered, the Registry shall treat the details entered in the sub-field “Firm” as the agent detail intended.”.

(8) Patents Form 49

Delete paragraph 11 under the heading “NOTES” and substitute the following paragraph:

“**11.** Where an individual is appointed as an agent, the sub-field “Name” under “DETAILS OF AGENT” must be completed by entering the full name of the individual. The sub-field “Firm” must be left blank. Where a partnership/body corporate is appointed as an agent, the sub-field “Firm” under “DETAILS OF AGENT” must be completed by entering the name of the partnership/body corporate. The sub-field “Name” must be left blank. Where both the “Name” and “Firm” have been entered, the Registry shall treat the details entered in the sub-field “Firm” as the agent detail intended.”.

(9) Patents Form 51

Delete paragraph 12 under the heading “NOTES” and substitute the following paragraph:

“**12.** Where an individual is appointed as an agent, the sub-field “Name” under “DETAILS OF AGENT” must be completed by entering the full name of the individual. The sub-field “Firm” must be left blank. Where a partnership/body corporate is appointed as an agent, the sub-field “Firm” under



“DETAILS OF AGENT” must be completed by entering the name of the partnership/body corporate. The sub-field “Name” must be left blank. Where both the “Name” and “Firm” have been entered, the Registry shall treat the details entered in the sub-field “Firm” as the agent detail intended.”.

*[G.N. Nos. S 224/96; S132/97; S 260/97; S 458/97; S 82/98; S 116/98; S 203/99; S 286/99; S 510/99; S 300/2000; S 60/2001; S 500/2001; S 656/2001; S 75/2002; S 355/2002]*

Made this 30th day of June 2003.

LIEW HENG SAN  
*Permanent Secretary,  
Ministry of Law,  
Singapore.*

[TMC 002/87B (Pat Amend); AG/LEG/SL/221/2002/1 Vol. 3]