

INTRODUCTION TO INTELLECTUAL PROPERTY IN SINGAPORE

TRADE MARKS

Introduction

Trade mark registration in Singapore is governed by the Trade Marks Act and the Trade Marks Rules. Registration of a trade mark under the Trade Marks Act gives the proprietor the exclusive right to use (and to authorise others to use) the mark in relation to the goods or services in respect of which the mark is registered.

Registration of a trade mark is not a prerequisite to its protection as the common law concept of "passing off" is recognised in Singapore. However, there are advantages in registering trade marks. One advantage is the ease of enforcement of the rights relating to trade marks, as a registered proprietor need not adduce evidence of use and reputation in Singapore. A mark may be registered in Singapore on the basis of an intention to use.

Criminal penalties are also imposed under the Trade Marks Act for importing or selling goods to which a counterfeit trade mark is applied, or possession of instruments for counterfeiting purposes.

Marks that are registrable

Under the Trade Marks Act, a trade mark is generally registrable if it fulfils the following conditions:

- it is a visually perceptible sign;
- it is capable of distinguishing the goods or services of its proprietor from those of another;
- it is not devoid of distinctive character;
- it does not consist exclusively of references to the characteristics of the goods or services in point; and
- it does not consist exclusively of references which have become customary in the current language or in the bona fide and established practices of the trade.

A trade mark which does not satisfy the last three conditions may yet be registrable if it has acquired a distinctive character through use. On the other hand, notwithstanding that a trade mark satisfies all the above conditions or has acquired distinctiveness through use, the Registrar will not permit its registration in certain circumstances, including the following:

- the mark is identical with or confusingly similar to an already registered trade mark, and registration is sought in respect of goods or services identical with or similar to those specified for the registered mark; or

the mark is identical with or with confusingly similar to an well-known and registered trade mark.

Class of goods and services

Singapore is a party to the Nice Agreement. Accordingly, goods and services are divided into 45 different classes in accordance with the 8th edition of the International Classification of Goods and Services (Nice Classification) published by the World Intellectual Property Office (WIPO). Where a mark is sought to be registered in multiple classes, a separate application is required for each class. The Registry of Trade Marks is generally rather strict in requiring that the description of goods or services in the trade mark application conforms with the International Classification of Goods and Services. In this regard, English, Australian and Hong Kong precedents in respect of the classification and description of goods or services are generally persuasive.

It is important that the applicant carefully considers and identifies the goods or services which require protection and ascertain their appropriate class(es) as rights against infringement under the Trade Marks Act extend only to the particular goods or services covered in the specification. Although an application with a specification covering all or a wide variety of goods or services may be made, the Registry usually will not allow it to proceed unless the applicant can justify the width of such specification by showing use of the mark on all such goods or services or by a statutory declaration of intention to use the mark on all such goods or services.

International Trade Marks

As Singapore is a signatory to the Madrid Protocol, an applicant for international registration of his trade mark may designate Singapore as one of the countries in which protection is sought. The Registry of Trade Marks will assess whether protection should be granted in respect of an international trade mark the same manner as it would a domestic application to register the mark. If an international trade mark is granted protection by the Registry of Trade Marks, its proprietor will enjoy the same rights and remedies as he would, had he registered the mark in Singapore.

The Registry also functions as an office of origin for applications for international registrations filed by Singapore citizens, persons domiciled in Singapore, entities constituted in Singapore and persons with commercial presence in Singapore.

PATENTS

Introduction

Previously, patent protection in Singapore was secured by re-registering a United Kingdom patent or European patent designating the United Kingdom under the Registration of United Kingdom Patents Act.

The application for re-registration in Singapore had to be filed within three years from the date of grant of the UK/EP(UK) patent. The patent registration secured in Singapore under this previous system of re-registration was effective so long as the patent remained in force in the United Kingdom. No renewal fees were required to be paid.

On 23 February 1995, the Registration of United Kingdom Patents Act was repealed and the Patents Act came into effect. Under the Patents Act, an application may be made to the Registry of Patents for the grant of a patent.

Singapore has acceded to the Patent Co-operation Treaty ("PCT") as well as the Budapest Treaty.

Requirements for patentability

Under the Patents Act, a patentable invention is one that satisfies the following conditions:

- the invention is new (worldwide novelty);
- it involves an inventive step;
- it is capable of industrial application; and
- the publication or exploitation of the invention would not generally be expected to encourage offensive, immoral or anti-social behaviour.

Restrictions on applications abroad by Singapore residents

A person residing in Singapore is not permitted to file or "cause to be filed" an application for a patent outside Singapore unless he has obtained the written authority of the Registrar, or the overseas patent application is made no less than two months after the filing of an application for the same invention in Singapore. Any Singapore resident who contravenes this provision of the Patents Act would be guilty of an offence and liable to a fine not exceeding S\$5,000 and/or imprisonment for a term not exceeding two years.

A person resident in Singapore is defined in the Act as "[including] a person who, at the material time, is residing in Singapore by virtue of a valid pass lawfully issued to him under the Immigration Act to enter and remain in Singapore for any purpose".

PCT Applications

As Singapore has acceded to the Patent Co-operation Treaty (PCT), Singapore may be designated in an international application as one of the countries for national phase entry. The deadline for entering the national phase in Singapore is either 20 months or 30 months from the filing date of the international application or the declared priority date of the same (if claimed), depending on whether or not Singapore was designated for the purposes of International Preliminary Examination under Chapter II of the PCT at the appropriate time.

The minimum documentation required for entry into national phase, whether at 20 or 30 months, is an English translation of the international application (description, claims, any text matter of drawings, abstract) where it was not filed in English, as well as the lodgement of the relevant official fee and forms. If the PCT application (non-English) has been amended, the English translation of the amendment(s) should also be filed. The English translations of the international application as originally filed, and of its amendment(s) should preferably be verified by their respective translators. Otherwise, a verified version would have to be lodged within two months from the due date for national phase entry.

Additionally, the following information must be provided at the time of national phase entry:

- international filing date;
- earliest priority date; and
- international publication number (if known).

If the international application claims priority from an application which was not filed in the English language, a copy of the priority application, duly certified by the authority with which it was filed or otherwise verified to the satisfaction of the Registrar, is required to be filed within 8 months of the due date for national phase entry.

In the case of an application for national phase entry under Chapter I of the PCT, the search and examination requirements may be fulfilled either by:

- filing a request for examination with a copy of the International Search Report and full copies of all citations and a patent family list for all citations that are not in English; or
- filing a combined request for search and examination.

Either step must be taken within 8 months of the due date for national phase entry. Once the search and/or examination report is established, the applicant may request for grant of the patent by paying the grant fee.

In the case of applications for national phase entry under Chapter II of the PCT, obtaining grant of the patent is simpler as there is no need to file a request for search and/or examination. Provided that the other requirements set out above have been observed, the applicant may request for grant of the patent once the Registry of Patents receives the International Preliminary Examination Report.

Introduction

Copyright law in Singapore is governed by the Copyright Act. The Act protects copyright in original literary, dramatic, musical and artistic works, as well as original sound recordings, cinematograph films, broadcasts, cable programmes and published editions of works.

Singapore has no copyright registration or deposit system. Copyright subsists automatically once the original work is created or published, and certain criteria are met. Where the work is unpublished, the author of the work must be a "qualified person", which term is defined in the Copyright Act as a citizen of Singapore or a person resident in Singapore.

In the case of a published work, the work must have been first published in Singapore or the author must have been a qualified person. If the first publication took place elsewhere, the re-publication in Singapore must have taken place in Singapore within 30 days of its first publication.

Singapore is not a member of any international copyright conventions. However, the Copyright (International Protection) Regulations, which subsists under the Copyright Act, provides that works which were first published in the following states will be deemed to have been first published in Singapore:

Duration

Literary, dramatic, musical and artistic works

For published literary, dramatic, musical and artistic works (other than photographs), copyright subsists until the expiration of 50 years after the expiration of the calendar year in which the author of the work died.

If, before the death of the author of a literary, dramatic or musical work:

- the work had not been published;
- the work had not been performed in public;
- the work had not been broadcast;
- the work had not been included in a cable programme; and
- records of the work had not been offered or exposed for sale to the public,

then copyright will continue to subsist until the end of 50 years after the expiration of the calendar year in which the work is subsequently first published, performed in public, broadcast, or included in a cable programme, or records of the work are first offered or exposed for sale to the public, whichever is the earliest of those events to have occurred.

Sound recordings, cinematograph films, broadcasts and cable programmes

The term of copyright in sound recordings, cinematograph films, broadcasts and cable programmes is 50 years from the end of the calendar year of the first publication (or first broadcast in the case of

broadcasts).

Infringement

In general terms, copyright is infringed if a person, who not being the owner of the copyright, and without the licence of the owner of the copyright, does in Singapore, or authorises the doing in Singapore of any of the acts listed above as the owner's exclusive rights. The plaintiff has the burden of proving that there was copying of the plaintiff's work.

Copyright is also infringed by a person who, in Singapore, and without the licence of the copyright owner -

- sells, lets for hire, or by way of trade offers or exposes for sale or hire, an article; or
- by way of trade exhibits an article in public,

where he knows, or ought reasonably to know, that the making of the article constituted an infringement of the copyright or, in the case of an imported article, the making of the article was carried out without the consent of the copyright owner.

Criminal sanctions

The Copyright Act also makes it an offence, punishable with a fine not exceeding S\$10,000 and/or imprisonment for a term not exceeding five years, for a person to -

- make for sale or hire;
- sell or let for hire or by way of trade offer or expose for sale or hire;
- by way of trade exhibit in public; or
- import into Singapore (otherwise than for private and domestic use)

any articles which he knows or ought reasonably to know to be an infringing copy of the work. It is also an offence for a person to have in his possession any article which he knows or ought reasonably to know to be an infringing copy of the work for the purpose of, inter alia, selling, letting for hire or exposing for sale or hire, the article.

REGISTERED DESIGNS

Introduction

Until recently, there was no facility for design registration in Singapore. Singapore relied on the United Kingdom system of design registration as the basis for protection. To obtain protection for a design in Singapore, the United Kingdom Designs (Protection) Act required the design to be registered in the United Kingdom under the UK Registered Designs Act of 1949. The registered

proprietor of the design would thereby automatically enjoy like privileges and rights in Singapore, as if the Certificate of Registration in the United Kingdom had been issued with an extension to Singapore.

This changed with the repeal of United Kingdom Designs (Protection) Act and the introduction of Registered Designs Act 2000 ("the new Act") which came into force on 13 November 2000. By the new Act, a Registry of Designs was established to receive and examine design registration applications, and to confer registration of designs.

Registrable designs

For the purposes of the new Act, the term "design" refers to any "feature of shape, configuration, pattern or ornament applied to any article by industrial process". Expressly excluded from the scope of the term are:

- methods and principles of constructions;
- features which are dictated solely by the function which the article has to perform;
- features which are dependent on the appearance of another article; and
- features which allow the article in point to connect to another article.

For a design to be registrable, it must be novel in that it must not be identical or substantially similar to another design which has been published in Singapore or beyond. Certain designs are not registrable, even if they are novel, including computer programs, layout-designs of integrated circuits (protected under the Layout-Designs of Integrated Circuits Acts), designs which publication or use may compromise morality or public order, and designs for medals, sculptures, book jackets, postcards, stamps, maps and other articles of a primarily literary or artistic character.

Copyright and registered design rights

A design may comprise or contain an artistic work. The Copyright Act specifically provides that if the design has been industrially applied and commercially exploited, it will not be protected by copyright against unauthorised three-dimensional reproduction of the same during the 15-year period in which the design ought to have been registered, whether or not the design has in fact been registered. After the 15-year period, the owner cannot rely on copyright protection for associated designs and articles as well. However, the copyright does protect against the two-dimensional reproduction of the design as an artistic work. Accordingly, if the owner of an artistic work wishes to have the exclusive right to industrially apply a design to make an article, it is imperative that he seeks to register the design.

LAYOUT-DESIGNS OF INTEGRATED CIRCUITS

Introduction

Introduced on 15 February 1999, the Layout-Designs of Integrated Circuits Act 1999 ("the Act") protects certain layout-designs of integrated circuits. In connection with the advent of the Act, copyright laws in Singapore were amended so that such layout-designs are excluded copyright protection.

The Act confers automatic protection to "qualified owners" of all independently created layout-designs created on or after the commencement of the Act. However, it does not apply in relation to any idea, procedure, process, system, method of operation, concept, principle or discovery.

A layout-design is deemed as "created" once it has been recorded in documentary form or incorporated into an integrated circuit. Meanwhile, the Act describes "qualified owners" as owners of layout-designs:

- who are nationals of, domiciled or ordinarily resident in Singapore or in a member country of the World Trade Organisation (WTO);
- whose place of incorporation or formation is in Singapore or a WTO member country;
- who have a real and effective industrial or commercial establishment for the creation of layout-designs or for the production of integrated circuits in Singapore or in a WTO member country; or
- whose layout-design was first commercially exploited in Singapore or in a WTO member country.

Subject to any agreement to the contrary, the owner of the layout-design created in the course of employment or in pursuance of a commission would belong to the employer or the person who commissioned the layout-design, as the case may be.

Protection will be granted even if such layout-designs are identical. A criterion for protection is that the layout-design has to be original, which term is elaborated on in the Act to mean "the result of its creator's own intellectual effort and is not commonplace among creators of layout-designs and manufacturers of integrated circuits at the time of its creation".

The term of protection expires either:

- at the end of the tenth calendar year after the calendar year in which it was first commercially exploited, if it was first commercially exploited within five years after the calendar year in which it was created; or
- in any other case, at the end of fifteen calendar years after the year in which it was created.

Infringement

The Act provides that a qualified owner has the following rights:

to copy, and to authorise the copying of, all or part of the protected layout-design, whether by incorporation into an integrated circuit or otherwise;
to commercially exploit, and to authorise the commercial exploitation of, the protected layout-design.

These rights of the qualified owner would be infringed by any person who does any such acts without his consent.

However, the Act makes an exception for the copying of a protected layout-design for the sole purpose of evaluation, analysis, research or teaching. It would also not constitute infringement for a person to create a different layout-design derived from a protected layout-design, provided that his creation is original within the definition of the Act.

Other "non-infringing acts" include the following:

Copying done for private purpose and not for the purpose of commercial exploitation.

Copying of any part of a protected layout-design that is not original.

For a qualified owner of another protected layout-design that is identical and independently created, to do any of the acts referred to in Section 8 of the Act in respect of that other layout-design.

Act done by the Government or person authorised by the Government in relation to a protected layout-design if the act is done for a public non-commercial purpose.

Remedies

A qualified owner whose rights have been infringed can take whatever proceedings and seek whatever remedy as are available with respect to any other property rights. The usual remedies of damages, injunctions and accounts of profits may be claimed. In addition, the Act provides that the court may award additional damages, depending on the circumstances of the case including the flagrancy of the infringement and any benefit accruing to the defendant by reason of the infringement.

The court is also empowered to make an order for delivery up to the qualified owner or other person specified by the court of any infringing integrated circuit or any article used to make integrated circuits in which a protected layout-design is incorporated. An order for the disposal or destruction of the infringing articles delivered up may also be sought.

There are also remedies for groundless threats of infringement proceedings. An aggrieved person may apply to the court for a declaration that the threat is unjustified, and seek an injunction against the continuance of the threat as well as compensation for damage sustained.

Kelvin Chia Partnership
April 2003

Contact details:

CHEAH Swee Gim

Email: cheah.sweegim@kcpartnership.com

DID: (65) 6332 9349

Margaret LAW

Email: margaret.law@kcpartnership.com

DID: (65) 6332 9346