

Chapter XX

SINGAPORE

*Farah Namazie and Glendoris Ocampo*¹

I FORMS OF INTELLECTUAL PROPERTY

Intellectual property in Singapore includes the full range of intellectual property rights, both registrable and unregistrable rights, such as: copyright and related rights, registered designs, trademarks, patents, geographical indications, layout-designs of integrated circuits, confidential information, trade secrets and know-how.

With its historical basis in United Kingdom common law principles, Singapore law on intellectual property has evolved to accommodate legal developments shaped by both international intellectual property law and trade treatise, such as the TRIPS agreement, as well as extensive national legislative reforms that together form a comprehensive and contemporary body of intellectual property law.

In this review, we discuss the main features of some key intellectual property rights.

i Copyright and related rights

Copyright is a non-registrable but statutory right governed by the Copyright Act. Any work that is original and that complies with the statutory definition contained in the Copyright Act will enjoy copyright protection under the Copyright Act. The work must be an expression of some form, as copyright does not protect mere ideas. Works that may be protected by copyright include literary, dramatic, musical and artistic works; sound recordings, films and broadcasts; cable programmes; and published editions of works. Such works may be also broadly categorised as authors' works or entrepreneurial works. The duration of copyright protection for authors' work is the lifetime of the author plus 70 years, while the duration of protection for entrepreneurial works depends on the nature of the work:

¹ Farah Namazie is the proprietor and Glendoris Ocampo is patents executive at Namazie & Co..

- a* for sound recordings and films, the copyright duration is 70 years from the first publication of the work;
- b* for broadcasts and cable programmes, the copyright duration is 50 years from the making of the broadcast, or the inclusion of the cable programme; and
- c* for published editions of works, the copyright duration is for 25 years from the first publication of the work.

ii Registered design rights

A registered design is a right conferred by the Registered Designs Act, and which protects features of a shape, configuration, pattern or ornament applied to an article by an industrial process, and which qualify under the statutory definitions of the Registered Designs Act. There are express exclusions as to what does not qualify as a registered design, and these include: methods or principles of construction; features of shape or configuration that are dictated solely by function of the article; features of shape or configuration that are dependent on the appearance of another article of which the article is intended by the designer to form an integral part (for example, spare parts for a car); and features of shape or configuration that enable the article to be connected to, or placed in, around or against, another article so that either article may perform its function (for example, an electric plug). Other express exceptions relate to designs that offend public morality and computer programmes and layout-designs. The maximum period of protection for a registered design is 15 years, and so the initial registration of five years may be renewed only twice before the maximum period of protection expires.

iii Trademarks

A trademark can be registered under the Trademarks Act, or it can exist in common law. The rights conferred under registration and the rights of a trademark under common law are distinct. A registered trademark confers a right in the registered trademark itself, whereas a trademark protected under common law protects the business or goodwill associated with the trademark (and hence presupposes actual use of the mark). For a trademark to be registered and protected under the Trademarks Act it must comply with the statutory definition of a mark. Marks that may be registered include any letter, word, name, numeral, device, brand, heading, slogans, shape, colour, aspect of packaging or any combination of these as long as the mark is capable of distinguishing the goods or the services provided under it from that of another, in the course of trade. An initial trademark registration is for 10 years, and may be renewed for further periods of 10 years upon payment of renewal fees. In effect, therefore, a trademark registration may be maintained in perpetuity, unless it falls vulnerable to cancellation for lack of use.

iv Patents

Patents protect processes and products that are novel, involve an inventive step and are capable of industrial application. Patents, patentability and a patentee's rights are the subject of the Patents Act. Until now, the patent system in Singapore has been one of self-assessment, in the sense that the patent will be granted even if the substantive examination of the patent shows non-patentable matter. This, however, is soon to change (see Section V, *infra*). A patent registration is valid for 20 years, and provides the patentee

with the exclusive ability to manufacture, license or sell the product during that period of monopoly. Patents are considered a valuable intellectual property right and tool for the commercialisation of products and processes. There are various private grants as well as government grants and tax subsidies to encourage the filing of patent applications and to boost research and development in Singapore. Singapore has positioned itself as an 'IP hub' in Asia, and governmental incentives to achieve this goal play a key role in the generation and commercialisation of intellectual property.

II RECENT DEVELOPMENTS

We discuss below case law that illustrates recent developments in the various aspects of intellectual property rights.

i Trademark cases

Sarika Connoisseur Café Pte Ltd v. Ferrero SPA [2013] 1 SLR 531, [2012] SGCA 56

This case involved the trademarks 'Nutello', as used by the appellant (Sarika Connoisseur Café Pte Ltd) in relation to gourmet hot coffee beverages, and the respondent's (Ferrero SPA's) registered trademark 'Nutella' as registered and used in relation to cocoa-based hazelnut spread marketed under that name.

On appeal by the appellant of the lower court's decision, the Appeal Court found that the appellant had infringed the respondent's Nutella mark. The Court of Appeal agreed with the respondent that there was trademark infringement under Section 27(2) (b), as the marks Nutello and Nutella were visually and aurally similar, although not conceptually similar. As an invented word, Nutella possessed a high degree of inherent distinctiveness, and the mere change of the last letter from 'a' to 'o' would not suffice to meet the correspondingly high threshold required to render Nutello dissimilar to Nutella.

Addressing the similarity of the goods, the Court of Appeal stated that the correct comparison to be made was between the alleged infringing goods and the products in respect of which the trademark was registered (as opposed to the products on which the registered trademark was actually used).

The 'likelihood of confusion' element involved was determined by deciding whether a substantial portion of the relevant public would be confused. In the present case, the 'relevant public' would be the general public, as both parties' products were generally available. A substantial relevant sector of the public (30 per cent of the public, according to the survey of both parties) were confused in that they thought that the parties were related or had business links between them. There was therefore an infringement of a well-known trademark, by damaging connection, under Section 55(3).

This case also dealt with the concept of dilution in Section 55(3)(a). The Court of Appeal found there to be dilution by blurring of a well-known mark under Section 55(3)(b)(i), as well as passing off.

The Court established that claims for infringement and dilution are not mutually exclusive, hence an action in dilution can stand even when a finding of a likelihood of confusion is also present.

The respondent succeeded in its claims for Sections 27(2)(b), 55(3)(a) and 55(3)(b)(i) hence, an injunction was granted. However, the Court of Appeal judge declined to order an injunction as there was no practical need since the appellant had ceased using the Nutello sign and selling the Nutello beverage, having revised its menu accordingly so as not to feature Nutello.

Staywell Hospitality Group Pty Ltd v. Starwood Hotels & Resorts Worldwide, Inc and Another [2012] SGHC 204

Staywell Hospitality Group Pty Ltd ('Staywell'), the appellant, applied to register the mark 'Park Regis' in classes 35 and 43 on 3 March 2008. The application was opposed by Sheraton and Starwood ('the opponents') relying in their Singapore trademark registration for the trademark 'St. Regis' in various classes, namely, classes 41, 42, 36 and 37. They claimed that the appellant's application for 'Park Regis' contravened Sections 8(2)(b), 8(4)(a) read with Sections 8(4)(b)(i), 8(4)(b)(ii), 7(4)(b) and 7(6) of the Trademarks Act.

At the hearing in the Intellectual Property Office of Singapore ('IPOS'), the Principal Assistant Registrar of Trademarks ('the PAR') held that the marks were similar and that there was a real likelihood of confusion as potential customers would be misled into thinking that Staywell's services originated from the opponents. However, the PAR found that the opponents failed to discharge the burden of proof that the Singapore public had goodwill attaching to the St. Regis Hotel in Singapore within the meaning of Section 8(7) of the Act. The appellant, Staywell, appealed the PAR's decision on the grounds of opposition under Section 8(2)(b) and Section 8(4) of the Act while the opponents cross-appealed the PAR's decision rejecting the grounds of opposition under Section 8(7).

On appeal to the High Court, the High Court upheld the PAR's decision that the marks were on the whole similar. They were aurally similar as persons enunciating both marks might pay more attention to the second distinctive word in each of the marks rather than to the more common first word. Further, the marks were also conceptually similar as the second distinctive word employed the concept of royalty or aristocracy. Hence, given the distinctiveness of the mark, the aural and conceptual similarities offset the visual dissimilarity. However, although the marks were considered as similar, and there was a similarity of services (i.e., hotels), the High Court found that there was no likelihood of confusion on the basis that the marks could be readily detached from the hotel itself and any confusion could likely be dispelled either at the point of booking or check-in. Hence, the PAR's decision was reversed in respect to Section 8(2)(b) of the Act, which required the element of a likelihood of confusion to be proven.

In the absence of a likelihood of confusion it follows that there was no likelihood of damage to the Opponents' marks.

The Court also upheld the PAR's decision that there was no goodwill attached to the St. Regis brand as at 3 March 2008, namely, the date of registration of the mark for Park Regis. In Lord Macnaghten's often-quoted view 'goodwill is worth nothing unless it has power of attraction sufficient to bring customers home to the source from which it emanates'; in the present case there was no evidence that persons who purchase units in the St. Regis Residences did so because of the merits of the St. Regis Singapore's services. Hence, goodwill was not established and the opponents' cross-appeal failed.

Facebook, Inc v Zheng Zhongxing [2012] SDRP 1

Facebook, Inc is the provider of online social networking services. It operates through its website, www.facebook.com, and owns the trademark 'Facebook' in Singapore and in many other jurisdictions. Facebook, Inc ('the complainant') brought a complaint against the respondent in respect of his domain name, 'facebook.sg'. The basis for the complaint was that the respondent's domain name was identical and confusingly similar to the Facebook trademark, to which the respondent has no rights, and was not authorised to use. The complainant alleged bad faith on the part of the respondent.

No response was filed by the respondent within the time stipulated by the Rules for the Singapore Domain Name Dispute Resolution Policy ('SDRP'). The panel opined that the domain name was identical to the Facebook trademark of the complainant. The panel agreed that the respondent had acted in bad faith. They granted the remedy of a transfer of the domain name to the complainant, as provided for under Paragraph 4(i) of the SDRP.

ii Patent cases

Main-line Corporate Holdings Ltd v. DBS Bank Ltd [2012] SGHC 147

Main-line Corporate Holdings Ltd ('Main-line Corp'), the plaintiff, owned Singapore Patent No. 86037 entitled Dynamic Currency Conversion for Card Payment Systems, which was filed in 1999 and granted on 30 June 2003 ('the patent').

Main-line Corp claimed that the defendant bank, DBS Bank Ltd ('DBS') had infringed its patent, through use of an automatic currency detection service called the 'Monex System', provided by E-Clearing Singapore Pte Ltd ('ECS'), a service provider. Previously and in a separate case, the plaintiff had instituted a suit against another bank, UOB, and First Currency Choice for patent infringement for the same patent allegedly infringed by DBS in the present case. In the UOB case, the Singapore Court of Appeal decided that the plaintiff's patent was valid and both had novelty and involved an inventive step.

DBS's defence was that the patent was invalid and lacked novelty, and the plaintiff had failed to disclose an inventive step. It further relied on the fact that a corresponding European patent had been revoked by the European Patent Office ('EPO'), and so the Singapore patent ought to be invalidated.

The Court held that the fact that the EPO had come to a different conclusion from the Singapore Court of Appeals (in the UOB case), did not mean the Court was mandated to follow the EPO findings; the findings would, at best, serve as persuasive on its decision, but the Singapore court was not bound by them.

To determine whether a particular article or process had infringed a patent, the claims of the patent had to be construed purposively to determine the essential integers of the patent. Taking into consideration that the Monex System performed automatic currency detection and conversion by using the information obtained from swiping the payment card, it was thus evident that the Monex System functioned in a manner equivalent to the essential integers of Main-line Corp patent.

It was also revealed in the course of the trial by the DBS Vice President for the card merchant business that at the material time, DBS was aware of the existence of

the plaintiff's patent. In light of this, the Court was of the view that the defendants' conduct amounted to wilful blindness since they knew of the existence of the plaintiff's patent yet proceeded to adapt the Monex System, the functionality of which was the same. Therefore, the Court maintained that the plaintiff's patent was valid and had been infringed.

The Court of Appeal judge ordered an inquiry by the registrar on damages or account of the profits, pursuant to Section 67(2) of the Patents Act. Since the proprietor could not be awarded both patent damages and account of the profits for the same infringement, the plaintiff had to elect at or before the stage of directions to be given for such an inquiry. The costs of the trial were awarded to the plaintiff, with costs of the inquiry reserved to the registrar conducting the inquiry.

Astrazeneca AB (SE) v. Sanofi-Aventis Singapore Pte Ltd [2012] SGHC 16

The plaintiff, Astrazeneca, owned Singapore patent No. 89993 for 'Pharmaceutical Compositions Comprising a HMG COA Reductase Inhibitor'. The invention was composed of two elements, an active ingredient (Rosuvastatin Calcium) and a stabiliser. Significantly, the stabiliser consisted specifically of 'an inorganic salt in which the cation is multivalent'.

On 1 April 2011, the defendant, Sanofi-Aventis Singapore Pte Ltd, submitted its applications to the Health Sciences Authority ('HSA') for product licences in respect of the Rosucard Film-coated products and openly declared therein that, in fact, a patent was in force in Singapore, of which they were not the proprietor, that no consent was obtained from the proprietor and the existing patent would not be infringed. The HSA subsequently requested the defendant to serve a notice to the plaintiff, informing the plaintiff that applications for product licenses were made to the HSA in respect of the Rosucard Film-coated products (a component of the plaintiff's patent).

On 10 June 2011, the plaintiff filed its original statement of claim and prayed, *inter alia*, for a declaration that the defendant's performance of acts sought in the licence infringed their patent and for an injunction to restrain the defendant whether acting by its directors, officers, employees, servants or agents, or any of them or otherwise howsoever from infringing Singapore patent No. SG 89993. No particulars of infringement were mentioned. The defendant sought to strike out the plaintiff's statement of claim and prayed for the plaintiff's claim in the action to be wholly dismissed.

The Court noted that the plaintiff had not taken out a patent infringement action pursuant to Sections 66 and 67 of the Patents Act, but rather the plaintiff relied upon Section 12A of the Medicines Act for its cause of action. The question before the court was whether Section 12A of the Medicines Act provided for a cause of action separate and independent from a patent infringement action under the Patents Act.

The defendant was of the view that the Medicines Act merely provides for a notification mechanism whereby a patentee would be informed of any application for a product licence that related to its patent, and that any action to be taken out should still be made pursuant to the Patents Act. However, according to the plaintiff, Section 12A of the Medicines Act entitled the plaintiff to test the possibility of future infringement of the patent on the assumption that the defendant would carry out the acts for which the product licences were sought. It was, therefore, pre-emptive in nature.

The Court held that in order for a patentee to succeed in a patent infringement action pursuant to the Patents Act, two essential features must be made out: that the alleged infringing product fell squarely within the claim of the patent; and that the patentee must also prove that the infringer had committed – and not merely will commit – an act of infringement as defined in Section 66 of the Patents Act.

Section 12A of the Medicines Act, read with its accompanying subsidiary legislation, contemplates a cause of action separate and independent from a patent infringement action under the Patents Act. On the basis of the above, the Court indicated that the plaintiff's case was not wholly and clearly unarguable, and hence Sanofi-Aventis's application for striking out Astrazeneca's case was dismissed.

iii Copyright cases (criminal)

Public Prosecutor v Lim Tiong Yee [2012] SGDC 101

The accused was the director of registered company BA Export Pte Ltd, the retail shop of which was raided by the Singapore Police Force Criminal Investigation Department ('CID'). The CID proceeded to place under arrest the accused and his three accomplices. During the operation, an estimated street value of \$3.782 million-worth of goods was seized including 15,018 counterfeit handphones and 15,663 counterfeit handphone accessories. An amount of cash of about \$30,063.10 was also seized.

The accused faced four charges under Section 136(2)(b) of the Copyright Act (Cap. 63) and 26 charges under Section 49(c) of the Trade Marks Act (Cap. 332), namely:

Section 136(2)(b) of the Copyright Act

A person who at the time when copyright subsists in a work has in his possession or imports into Singapore any article that he knows, or ought to reasonably know, to be an infringing copy of the work for the purpose of: distributing the article for the purpose of trade, or for any other purpose to an extent that will affect prejudicially the owner of the copyright in the work.

Section 49(c) of the Trade Marks Act:

Any person who has in his possession for the purpose of trade or manufacture any goods to which a registered trade mark is falsely applied shall – unless he proves that: (1) having taken all reasonable precautions against committing an offence under this Section, he had, at the time of the commission of the alleged offence, no reason to suspect the genuineness of the mark and on demand made by or on behalf of the prosecution, he gave all the information in his power with respect to the persons from whom he obtained the goods; or (2) he had acted innocently – be guilty of an offence and shall be liable on conviction to a fine not exceeding \$10,000 for each of the goods or thing to which the trade mark is falsely applied (but not exceeding in the aggregate \$100,000) or to imprisonment for a term not exceeding five years or both.

Only one charge under the Copyright Act and nine charges under the Trade Marks Act proceeded; consequently, the accused pleaded guilty to these 10 charges.

After deliberation, the court sentenced the accused and his accomplices to a term of 42 months' imprisonment and fine of \$1,000, with, in default of payment, one further week's imprisonment, which the accused appealed.

The Court upheld that taking into consideration Singapore's reputation as a commercial hub, laws on copyright and trademark infringements must be strictly enforced. Therefore, the primary consideration for a court in deciding an appropriate sentence for cases of this nature was that of public interest, as held in *Ong Ah Tiong v. PP*. The mitigating circumstance of being a first offender was offset by the aggravating circumstances, such as the scale of operations, the value of the seized counterfeit goods and the potential profits to be obtained by the accused. Hence, the accused's appeal was dismissed.

Public Prosecutor v. Ch'ng Kean Seng [2012] SGDC 224

The accused, Ch'ng Kean Seng, was convicted of being the mastermind of a syndicate distributing pirated computer programmes and obscene films in a retail shop. He was charged and convicted for the following acts:

- a* carrying on a business of distributing films without a valid licence in contravention of Section 6(1)(a) of the Films Act, Chapter 107 (1985 Rev. Ed.);
- b* attempting to distribute video CDs and films without valid certificates approving the exhibition of the said films;
- c* possessing for the purpose of distributing for the purpose of trade articles embodying copies of computer programs;
- d* abetting by intentionally aiding various people to have in their possession for the purposes of distributing CDs containing films that are obscene; and
- e* possessing video tapes and laser discs containing obscene films.

He appealed the decision of the Court arguing for a total sentence of not more than 24 months' imprisonment. The accused also told the court that he would not be able to pay any fines imposed.

The Court in arriving at its sentence, followed the principle in *PP v. Syamsul Hilal bin Ismail* that where an accused faces multiple charges, the appropriate approach to be adopted by the sentencing court is to determine the individual sentences before deciding on the global sentence.

The prosecution submitted that the maximum custodial sentences were warranted in four of the proceeding charges. Even though the Court was of the view that due consideration ought to be given to the accused's guilty plea, the combined effect of the aggravating factors and the need for a deterrent sentence far outweighed the mitigating value of the plea. It was held that, as in the case of *Amir Hamzah bin Berang Kutu v. PP*, in which the accused was the mastermind, a harsher sentence was appropriate. In this instance, as the accused was the mastermind of the syndicate and had perpetuated the illegal operations, the judge was of the view that the sentence was appropriate and dismissed the appeal.

III OBTAINING PROTECTION

i Patents

There are various routes to obtaining patent protection in Singapore, some of which are discussed below. Typically, a patent will be granted within two to four years from filing in Singapore. However, more complex specifications will undergo a longer examination process. An applicant may select to have a patent protected in Singapore through a domestic filing or through the Patent Cooperation Treaty ('PCT'), to which Singapore is a party. Each of these methods of protection is discussed here.

Domestic applications: initial filing and requirements

An applicant may opt to proceed with a domestic Singapore patent application, and within 12 months from the date of filing the Singapore application, file further applications in other countries of interest, claiming priority over the Singapore application under the Paris Convention.

The Singapore Registry does not require that the patent claims be submitted at the initial application to obtain a date of filing, which is similar to a provisional application. However, as a patent claim is an essential part of the application, the claims must be filed within 12 months from the initial filing date, otherwise, the application will be deemed as withdrawn.

Upon receipt of the filing documents, the IPOS will conduct a preliminary examination of the application to determine compliance with all formalities; should there be any discrepancies in the application, the IPOS will issue a deficiency notice.

The publication ensues on the 18th month from the declared priority date or if there is none, from the date of filing the application. Once the application is published, it will become open for public inspection and the applicant's right over the patent accrues on this date.

Search and examination, and timelines

Once all the formal requirements are met, the applicant may proceed to the search and examination process. There are three approaches to the search and examination process:

All-local approach

An applicant may request to undergo either a search within 13 months from the priority date then examination process by the 21st month from the priority date or a combined search-and-examination process within the 21 months from the priority date.

All-foreign approach

The applicant relies on the final search and examination results of a corresponding patent or corresponding international application and furnishes the Registry with the corresponding international application search and examination result, within 42 months from the priority date. A request for an examination is no longer required if the applicant opts for this approach. The grant fees are also payable at the same time the applicant notifies the Registry of the reliance on the final search and examination results of a corresponding patent.

Combination approach

The applicant files an examination request with the Registry of Patents notifying it of the reliance on the search results of a corresponding patent or corresponding international application, within 21 months from the priority date.

Conversion from default fast track to slow track

Patent applications filed in Singapore on or after 1 July 2004 are automatically placed on a fast track, with a grant deadline of the 42nd month from the priority date. It is, however, possible to delay the prosecution process of the patent application by filing a request to move the application to slow track on or before 39 months from the priority date. By opting to move the application to slow track, the grant deadline is delayed until the 60th month from the priority date.

International (PCT) application and national phase entry

Alternatively, an applicant may opt to file a single international patent application under the PCT with Singapore as a Receiving Office.

It is a requirement that any applicant who is a resident of Singapore must obtain a security clearance under Section 34 of the Patents Act prior to applying for a patent outside Singapore. Failure to do so would render the applicant liable to criminal offence.

There are, broadly speaking, two phases to PCT applications: the international phase and the national phase. An international application will be applicable if you have a large number of targeted markets worldwide. It is important to note that the PCT system facilitates patent applications with PCT contracting states when the application enters national phase. However, a patent will not be granted for a PCT international application: the patent will be granted during the national phase, subject to the patent law of each country (contracting states of the PCT).

Search and examination during the international phase

During the international phase, the invention will be assessed by an examiner, who will issue a written opinion or international search report based on prior art searches conducted by the examiner, examined against the patent specification of the invention. The applicant will be allowed to amend or request for further examination. An International Preliminary Report on Patentability will be issued indicating whether the invention meets the patentability criteria.

National phase and requirements for filing

At the 30th month from the date of filing of the PCT application, the application will enter the national phase. To obtain a date of filing, one must submit all the relevant forms required by the Singapore Registry together with the complete English specification of the application and pay the prescribed fees.

Search and examination, fast track and slow track, and timelines

On or before the 39th month from the priority date, the applicant may proceed to request the search and examination of the application. The Registry of Patents in Singapore offers the following three approaches to the search and examination process:

All-local approach

In the all-local approach, an applicant may request to undergo a combined search and examination process on or before the 39th month from the date of filing. This is useful if the invention has obtained negative examination results during the international phase.

All-foreign approach

Under Singapore's self-assessment patent system, the applicant can rely on their positive International Preliminary Report on Patentability ('IPRP'), Chapter I or Chapter II, within 42 months (if fast track) or at the 60th month if the applicant has opted to move the application to slow track. Alternatively, the applicant may furnish the Registry of Patents with the final search and examination results of a corresponding patent or corresponding international application within 42 months (if fast track) and at the 60th month if the applicant has opted to move the application to slow track. Under this approach, the applicant does not need to file a further search and examination request with the Registry in respect of the same invention.

Combination approach

In the combination approach, the applicant files an examination request with the Registry of Patents relying on the international search report, or the search results of a corresponding patent or corresponding international application on or before the 39th-month deadline.

Ultimately, the application will be prosecuted through the fast-track system unless the applicant requests a block extension of time to move the application to slow track by the 39th month from the date of filing.

It is mandatory to move the application to slow track if the applicant opts to proceed with either a request for a combined search and examination or an examination based on the international search report, to ensure sufficient time for the prosecution of the application. Accordingly, moving the prosecution time and the official deadlines to file a notification of reliance on a corresponding international application or notification of reliance on an IPRP to the 60th month from the date of filing coincides with the payment of grant fees. Moving to slow track allows the application to delay prosecution costs and at the same time provides sufficient time for assessment of the value of the invention for business strategy purposes.

Designs

To obtain protection for a design, it must meet two criteria: it must be new, and it must be industrially applicable onto an article.

An application for registration of a design can be made by filing Form D3 along with the representation of the design (a maximum of 10 representations may be submitted), a statement of novelty describing the features of the design, a disclaimer if required and the relevant Locarno classification.

The Locarno classification is an international classification used for the purposes of the registration of industrial designs with reference to a single classification system.

Pursuant to Section 19 of the Registered Designs Act, only a formalities examination is required to determine whether the application is to be accepted for registration. Hence, if all formalities are met, the application will proceed to registration. Once registered, the full details of the design are made available in the Designs Journal.

As with other intellectual property rights, a design protection is also territorial in nature. Therefore, to obtain protection outside Singapore, one must file for a design application in each of the respective countries of interest.

Alternatively, one can file through the Hague System, whereby the applicant files a single international application with the International Bureau of the World Intellectual Property Office ('WIPO'), in one language, and by paying one set of fees in one currency (Swiss francs).

Trademarks

Trademarks may be protected in Singapore by filing a local application or through an international application under the Madrid Protocol. Singapore is also a party to the Paris Convention and recognises the priority date of applications filed in other Paris Convention countries if the corresponding application is filed here within six months. The IPOS maintains the trademark registry and database. Applications and registrations are classified according to the Nice Classification.

IV ENFORCEMENT OF RIGHTS

i Possible venues for enforcement

The appropriate venue for enforcement proceedings will depend on the particular intellectual property right being enforced, the nature of the offending act and the available forum prescribed by statute. In this section, we discuss some of the more interesting features of enforcement of IP rights in Singapore.

ii Civil and criminal enforcement

Typically, IP rights may be enforced by civil enforcement or criminal enforcement, and in some instances, a combination of both. Civil and criminal actions, and the common law or statutory remedies that may be sought, are initiated through different proceedings. Civil and criminal proceedings may also be commenced concurrently and, depending on the evidence available and various other factors such as the defendant's assets and jurisdiction, and ability to pay eventual costs, one set of proceedings may be pursued and the other set discontinued.

Criminal proceedings may be initiated by private prosecutions in the Subordinate Courts, subject to the property owner obtaining a fiat from the Attorney General's Chambers. Search and seizure warrants may be obtained and would involve the Intellectual Property Rights Branch of the CID or, for matters concerning computer crimes, the CID's Technology Crime Investigation Branch.

Criminal remedies for offences committed under the Copyright Act and Trademarks Act include custodial sentences and monetary fines.

There are no criminal penalties for patent infringement, nor for design rights infringement.

iii Trademark disputes

Since January 2012, a voluntary mediation option has been made available to parties in trademark opposition, invalidation and revocation proceedings before the IPOS. This enables parties to explore mediation and to negotiate a settlement in a structured format, presided and regulated by the IPOS through a series of case management conferences, which stipulate timelines and processes for the parties to follow.

Trademark disputes such as oppositions, cancellation and revocation proceedings may be initiated in the IPOS. The next level of jurisdiction is the High Court, where a judge presides over the matter. Infringement actions may be commenced in the High Court. The highest court of appeal is the Court of Appeal, where both civil and criminal cases are heard by a court of three judges

iv Copyright disputes

Under the Copyright Act, a Copyright Tribunal provides for a forum for resolving disputes between licensors who are in the business of collectively administering copyright licenses for different copyright owners, and users of copyright materials. The Tribunal comprises the president, two deputy presidents and 15 members of a panel. The procedure for applications to be made to a Tribunal is set out in the Copyright Tribunal (Procedure) Regulations 1988. Disputes before the Copyright Tribunal typically relate to the appropriate amount of royalties payable to a copyright owner, the licensing terms between parties and employees' rights to the use of works protected by copyright. The Copyright Tribunal may make orders, including the order of costs between the parties. A Tribunal may refer to the High Court any matter that comes before it for determination on a point of law. The Tribunal may refer the matter to the High Court on its own volition or at the request of any party to the matter.

v Requirements for jurisdiction and venue

Jurisdiction

The general principle is that service of originating process on the defendant is the basis of the jurisdiction of the court. The Singapore court has jurisdiction over a defendant who is served with originating process when the defendant is present in Singapore, or when the defendant has agreed to submit to the jurisdiction of Singapore in an agreement with the plaintiff and has also agreed to a means for service within Singapore and the service is effected.

In cross-border disputes, there must be a legal connection between the case or the defendant and Singapore for jurisdiction to exist; or, given the degree of connection of the case with Singapore and with other countries, the Singapore court may not exercise its jurisdiction unless it is satisfied that it is the most appropriate forum for the dispute.

Venue: the Supreme Court – the Court of Appeal and the High Court

The Supreme Court comprises the Court of Appeal and the High Court, and hears both civil and criminal matters. The Supreme Court Bench consists of the Chief Justice,

the Judges of Appeal, Judges and the Judicial Commissioners of the Supreme Court. The Supreme Court Registry is headed by the Registrar who is assisted by the Deputy Registrar, Senior Assistant Registrars and Assistant Registrars.

The Court of Appeal hears appeals against High Court decisions in both civil and criminal matters. The Court of Appeal usually comprises three judges. However, certain appeals, including those against interlocutory orders, may be heard by only two judges.

The High Court consists of the Chief Justice and the judges of the High Court. An appeal judge may also sit in the High Court. Proceedings in the High Court are usually heard before a single judge. The High Court may also appoint one or more persons with expertise in the subject matter of the proceedings to assist the court. There is a panel of judges familiar with IP law issues.

The High Court hears both criminal and civil cases as a court of first instance. The High Court also hears appeals from the decisions of district courts and magistrate courts in civil and criminal cases, and decides points of law reserved in special cases submitted by a district court or a magistrate court. In addition, the High Court has general supervisory and revisionary jurisdiction over all subordinate courts in any civil or criminal matter.

The High Court has the jurisdiction to hear and try any action in which the defendant is served with a writ or other originating process in Singapore, or outside Singapore in the circumstances prescribed by Rules of Court, or if the defendant submits to the jurisdiction of the High Court.

Venue: the Subordinate Courts

The Subordinate Courts comprise the district and magistrate courts. The Subordinate Courts hear both civil and criminal matters. Private prosecutions for trademark and copyright matters are initiated by the IP rights owners in the Subordinate Courts. The legal cost of such private prosecution is borne by the IP rights owners.

vi Obtaining relevant evidence of infringement and discovery

Evidence to support private prosecutions are often obtained through search and seizure procedures conducted after IP rights owners have applied for, and obtained, search warrants in the Subordinate Courts.

In civil litigation, rules of discovery apply under the Rules of Court, which determine the discovery process between parties prior to trial.

To seek the detention and preservation of evidence that is material to the suit, particularly in IP rights cases, where the destruction of the evidence is likely, a party may apply to court for an *Anton Piller* order. Such an application, typically made *ex parte*, is subject to very high standards and requirements of full and frank disclosure by the applicant.

vii Infringement

Copyright Infringement

Copyright in a work is infringed by the unauthorised use of the copyright in the work. This is considered primary infringement. Unauthorised reproduction of the work in a material form without the consent of the copyright owner would be an infringement,

and is actionable in Singapore if it was done in Singapore. Reproduction occurs when there is sufficient objective similarity between the original work and the alleged copy, and when there is some causal connection between them. Statutory exceptions are provided under the Copyright Act.

Secondary infringement occurs when a person trades in an article knowing that it is an infringing article. Both primary and secondary infringement can give rise to criminal liability.

Trademark Infringement

A trademark is infringed if, without the consent of the proprietor of a registered trademark, the mark is used in the course of trade on goods or services that are identical to those for which it is registered. A trademark is also infringed if, without the consent of the proprietor of a registered trademark, the mark is used in the course of trade in goods or services that are identical or similar to those for which it is registered, and there is likelihood of confusion on the part of the public. The Trademarks Act provides exceptions to infringement. Parallel imports are generally legal in Singapore and may be used as a defence against a charge of trademark infringement.

Patent Infringement

A direct infringement occurs when a person makes, disposes of, offers to dispose of, or uses an invention that is protected by a patent in Singapore, without the consent of the owner of the patent. An indirect infringement occurs when a third party deals with the infringing product or process without the patent owner's consent.

viii Defences

Defences are available under the legislation, which lists the acts that do not amount to an infringement and exceptions to the general provisions on infringement. In the context of copyright, fair dealing defences are available for, *inter alia*, private use of copyright works.

Parallel imports are generally allowed under Singapore law, hence providing an available defence in trademark infringement cases.

A defendant to a patent infringement must show that the patent was invalid or lacked an inventive step. The claims of a patent have to be construed purposively to determine the essential integers of the patent.

ix Remedies

A civil action may be brought privately by the applicant or plaintiff against the opponent or defendant, respectively. A court may order a combination of remedies, such as an injunction, damages, account of profits, delivering up of property, statutory damages or declaration as to a party's rights. Interim remedies may be granted by the courts on interlocutory applications, until final remedies are granted pursuant to a full trial in the matter.

Statutory remedies for infringements, contravention and offences of intellectual property rights disputes are contained in the following legislation:

a Copyright Act (Cap. 63)

- b* Registered Designs Act
- c* Patents Act (Cap. 221)
- d* Trademarks Act (Cap. 332)
- e* Computer Misuse Act
- f* Electronic Transactions Act 1998
- g* Layout-Designs of Integrated Circuits Act (Cap. 159A)
- h* Plant Varieties Protection Act (Cap. 232A)

x Appellate review

The highest court of appeal is the Court of Appeal, where both civil and criminal cases are heard by a court of three judges. However, certain appeals, including those against interlocutory orders, may be heard by only two judges. If necessary, the Court of Appeal may comprise five or any greater uneven number of judges.

xi Alternatives to litigation

Mediation and arbitration are commonly pursued for IP disputes. The Singapore International Arbitration Centre ('SIAC') offers facilities for arbitration and has a panel of international arbitrators. Parties may adopt the 2010 SIAC Rules (4th edition) or UNCITRAL Arbitration Rules (as revised in 2010) for the conduct of arbitration at SIAC. The Rules are essentially designed for the *ad hoc* form of arbitration; parties can, with special provision, enjoy the benefit of institutional administration of the arbitration from SIAC.

V TRENDS AND OUTLOOK

Singapore presently has a self-assessment patent system. This means that a patent will be granted notwithstanding an adverse examination report. However, the present self-assessment system will soon change to a 'positive grant' system with the amendment of the Patent Rules, to take effect in 2013. The implication is that only patent applications with a positive search and examination result can proceed to grant. In line with the change to a 'positive grant' system, the patent process will now include a mandatory supplementary examination process and a review process of examination reports, search and examination reports and supplementary reports to be conducted by the local in-house examiners of the Singapore Registry. New notices (i.e., notice of eligibility and notice of intention to refuse) will be issued by the Registry after the supplementary examination, depending on whether a positive or negative result is obtained during the supplementary exam.

There are also amendments to the Patent Rules relating to the integrated Registries IT system to streamline procedures in certain patent processes, and to the introduction of new common forms to be used across all Registries for clarity; these changes are part of a review of the patent legislation that is being undertaken to help to establish Singapore as an IP hub in Asia.

NAMAZIE & CO

51 Goldhill Plaza
Penthouse 4
#24-06/07
Singapore 308900
Tel: +65 6538 9711
Fax: +65 6538 9722
farahnamazie@namazie-law.com
ocampo@namazie-law.com
www.namazie-law.com

FARAH NAMAZIE

Namazie & Co

Farah Namazie is an intellectual property law practitioner practising in Singapore. Her focus is on intellectual property law protection in the field of brands, trademarks, copyright, designs and patents. She handles commercial transactions involving IP rights. Farah has published widely and lectured internationally on intellectual property law.

She studied law at Lady Margaret Hall, University of Oxford, where she graduated in 1987. She also obtained a Masters degree in corporate and commercial law from King's College London, before being called to the Bar in England and Wales, and is admitted as an advocate and solicitor of the Supreme Court of Singapore.

In addition to being in private practice for 20 years, she worked for several years as in-house counsel for Apple Computer, Inc.

Farah founded Namazie & Co in 2001 as an intellectual property and technology law firm, and, together with highly qualified and experienced intellectual property professionals, leads an experienced team to advise and represent both international and local clients on IP rights legal protection.

Namazie & Co has been consistently listed as one of Singapore's top ten intellectual property law practices since 2003.

GLENDORIS R OCAMPO

Namazie & Co

Glendoris Ocampo manages Namazie & Co's patents and design portfolios. Ms Ocampo's focus is on patent protection and she has comprehensive experience in both domestic and PCT patent applications. She also handles some of the larger trademark portfolios of clients from the entertainment, property and hospitality services. Prior to embarking on a specialised career in intellectual property, she worked as a legal researcher in a full-service law firm in the Philippines, which provided her with a background in other areas of law. She graduated from the University of San Carlos, Cebu, Philippines in 2003 with a Bachelor of Science degree in Management Accounting. She later pursued further studies and graduated from the University of San Jose-Recoletos, Cebu, Philippines in 2008 with a Bachelor of Laws degree.