
THE INTELLECTUAL PROPERTY REVIEW

THIRD EDITION

EDITOR
ROBERT L BAECHTOLD

LAW BUSINESS RESEARCH

THE INTELLECTUAL PROPERTY REVIEW

The Intellectual Property Review

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THE
INTELLECTUAL
PROPERTY
REVIEW

Third Edition

Editor
ROBERT L BAECHTOLD

LAW BUSINESS RESEARCH LTD

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CONTENTS

Editor's Prefacevii
	<i>Robert L Baechtold</i>
Chapter 1	BRAZIL.....1
	<i>Gabriel Di Blasi and Paulo Parente Marques Mendes</i>
Chapter 2	BULGARIA.....16
	<i>Kostadin Manev and Alexandra Semerdjieva</i>
Chapter 3	CANADA.....27
	<i>Jason Markwell and Adam Haller</i>
Chapter 4	CHINA.....40
	<i>Jay Sha</i>
Chapter 5	CYPRUS.....53
	<i>Ourania Vronidou</i>
Chapter 6	DENMARK.....61
	<i>Sture Rygaard, Michael Hopp and Mikkel Vittrup</i>
Chapter 7	FINLAND.....69
	<i>Inari Kinnunen, Gabrielle Hjelt and Henrik af Ursin</i>
Chapter 8	FRANCE.....81
	<i>Stanislas Roux-Vaillard</i>
Chapter 9	GERMANY.....95
	<i>Felix T Rödiger</i>
Chapter 10	INDIA.....106
	<i>Pravin Anand and T Saukshmya</i>

Chapter 11	ITALY.....	127
	<i>Tommaso Faelli and Francesco Banterle</i>	
Chapter 12	JAPAN.....	140
	<i>Yasufumi Shiroyama</i>	
Chapter 13	KOREA.....	151
	<i>Jung-Ae Suh and Cy Kim</i>	
Chapter 14	LUXEMBOURG	162
	<i>Claire Léonelli</i>	
Chapter 15	MALAYSIA	176
	<i>Lee Tatt Boon and Joshua Teoh Beni Chris</i>	
Chapter 16	NETHERLANDS.....	189
	<i>Michiel Rijdsdijk and Marlies Wiegerinck</i>	
Chapter 17	NIGERIA.....	202
	<i>Ladi Taiwo and Bunmi Binitie</i>	
Chapter 18	NORWAY	210
	<i>Are Stenvik</i>	
Chapter 19	PHILIPPINES.....	221
	<i>Editha R Hechanova</i>	
Chapter 20	POLAND.....	241
	<i>Michał Siciarek and Jakub Mrozowski</i>	
Chapter 21	PORTUGAL.....	255
	<i>António Andrade</i>	
Chapter 22	PUERTO RICO.....	264
	<i>Eugenio J Torres-Oyola, Maristella Collazo-Soto and Rafael Rodríguez-Muriel</i>	

Chapter 23	ROMANIA	277
	<i>Paul George Buta</i>	
Chapter 24	RUSSIA.....	290
	<i>Valentina Orlova and Yuri Yakhin</i>	
Chapter 25	SINGAPORE.....	303
	<i>Farah Namazie and Glendoris R Ocampo</i>	
Chapter 26	SPAIN	319
	<i>Montserrat López-Bellosta</i>	
Chapter 27	SWITZERLAND.....	337
	<i>Michael Isler</i>	
Chapter 28	TAIWAN.....	349
	<i>Tony Tung-Yang Chang</i>	
Chapter 29	THAILAND	362
	<i>Chavalit Uttasart</i>	
Chapter 30	UNITED KINGDOM	373
	<i>Penny Gilbert, Alex May and Alexandra West</i>	
Chapter 31	UNITED STATES.....	389
	<i>Robert L Baechtold, Brian V Slater and Jason A Leonard</i>	
Chapter 32	VIETNAM.....	402
	<i>Thang Duc Nguyen, Loc Xuan Le and Linh Duy Mai</i>	
Appendix 1	ABOUT THE AUTHORS	415
Appendix 2	CONTRIBUTING LAW FIRMS' CONTACT DETAILS.....	435

EDITOR'S PREFACE

It is not an overstatement to say that essentially all business is global, and the protection of intellectual property is the lifeblood of all business. The scope and implementation of that protection, however, varies from country to country.

It would be ideal if there were one universal set of laws, rules and procedures. But, while the efforts of many dedicated individuals have accomplished much in harmonising intellectual property protection, we remain defined as much by our differences as by what we have in common. It therefore is incumbent on all of us, as advisers to our clients, to be conversant with the individual practices in each of the economically significant countries.

The goal of this review is to provide that guidance. We have assembled a body of leading practitioners to explain the opportunities for intellectual property protection in their respective jurisdictions, together with the most significant recent developments and any aspects that are unique to their country. While we have striven to make the book both accurate and comprehensive, we must note that it is necessarily a summary and overview, and we strongly recommend that the reader seek the advice of experienced advisers for application of the principles contained in this review to any specific matter.

Reflecting on the past two editions of this review, we have seen the radical reshaping of US patent law under the America Invents Act, steady progress towards harmonisation of patent rights in Europe with a Unified Patent Court, and continued development and enforcement of patent rights in China. The authors of each chapter will highlight these and other notable developments in their respective countries. This third edition demonstrates the need for annual reviews of intellectual property on a global scale to remain current for our clients.

It is our hope that the reader will find this a useful compilation and often-consulted guide.

Robert L Baechtold
Fitzpatrick, Cella, Harper & Scinto
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May 2014

Chapter 25

SINGAPORE

*Farah Namazie and Glendoris R Ocampo*¹

I FORMS OF INTELLECTUAL PROPERTY

Intellectual property in Singapore includes the full range of intellectual property rights, both registrable and unregistrable, 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 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

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

70 years, while the duration of protection for entrepreneurial works depends on the nature of the work:

- 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 programs 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. 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

i Trademark cases

We report below three important cases heard in the past year, two of which were decisions of The Court of Appeal.

The Singapore Professional Golfers' Association v. Chen Eng Waye and others (2013)

The appellant, the Singapore Professional Golfers' Association, used the abbreviated name SPGA, or Singapore PGA. SPGA is a non-profit golfing organisation, registered under the Societies Act. The respondents were a limited liability partnership that used the name Singapore Senior PGA LLP. They used the initials SSPGA.

SPGA initiated a passing-off action against SSPGA. Both parties were involved in the organisation of golf events.

In the High Court, SPGA did not succeed against SSPGA in their case of passing-off. Although SPGA did have a measure of goodwill, their claim failed because of the following factors:

- a* their name consisted of ordinary words, descriptive in nature;
- b* their name had not acquired secondary meaning;
- c* there were differences between the names SPGA and SSPGA;
- d* the relevant sector of the market were discerning individuals who were unlikely to be confused, and no actual confusion was adduced; and
- e* their allegation of bad faith failed.

However, in the Court of Appeal, SPGA succeeded in its claim of passing-off by SSPGA. The Court of Appeal overturned the High Court's decision, which had earlier decided that there was no case of passing off. The Court of Appeal held that that SPGA (the appellants in the Court of Appeal) did have a measure of goodwill in professional golfing activities, so as to maintain their action of passing-off against SSPGA (the respondents in the Court of Appeal). The Court of Appeal felt that since the parties both operated in the same field of business, and shared the same initials, there was a likelihood of confusion. It was likely that the SSPGA would be associated with the SPGA. A factor of significance in the case against the respondents, SSPGA, was that they used the letter 'A' as part of their initials, even though they were a limited liability partnership, and not an association. This resulted in an adverse inference being drawn against the respondents, which the Court held to be in bad faith, and constituted an actionable misrepresentation.

Staywell Hospitality Group Pty Ltd v. Starwood Hotels & Resorts Worldwide, Inc (2013) Staywell Hospitality Group Pty Ltd (Staywell), the appellant, applied to register the mark 'Park Regis' in Classes 35 & 43 on 3 March 2008. The application was opposed by Sheraton and Starwood (the opponents) relying on their Singapore trademark registration for the trademark 'St Regis' in various classes.

At the hearing in the Intellectual Property Office of Singapore, the Principal Assistant Registrar of Trade Marks (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.

On appeal, the High Court upheld the PAR's decision that the marks were on the whole similar. However, although the marks were considered as similar, and there was a similarity of services (since both marks cater for the same nature of services, namely, 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.

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. '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 St Regis Singapore's services. Hence, goodwill was not established and the opponents' cross-appeal failed.

The opponents appealed against the High Court's decision and the case proceeded to the Court of Appeal in 2013, where the opponents appeal succeeded in part. There were several key points to the Court of Appeal's judgment:

- a* In assessing the respective marks in opposition proceedings, the court was entitled to have special regard to the distinctive or dominant components of a mark, even while assessing the similarity of the two marks each as composite wholes.
- b* In both opposition and infringement proceedings, there should be a step-by-step approach to the analysis.
- c* On the whole, the marks St Regis and Park Regis were similar.
- d* Where a good or service in relation to which the registration is sought falls within the ambit of a specification in which the incumbent mark has been registered, the goods or services in question are to be regarded *prima facie* as identical.
- e* The concept of 'initial interest confusion' is not, and ought not to be, part of Singapore law. Confusion that arose in the initial stages of the purchasing process but that was dispelled by the time of the purchase did not constitute confusion for the purpose of Section 8(2) of the Trade Marks Act. Policy reasons may be attributed for the limitation of the concept of initial interest confusion in Singapore, as by extending the concept, particularly in the context of internet activity, may result in undue restrictions on advertisements and be seen as anti-

competitive. Under Singapore law, the basis for infringement is more related to whether there is origin-based confusion, not dilution or misappropriation of goodwill, although these concepts would still be applicable in the case of well-known marks.

- f Pre-trading activity can generate goodwill. Pre-trading activity need not generate revenue as long as it is directed at generating demand for the plaintiff's business, and the trader shows a unequivocal intention to enter the market.

Motherhood Pte Ltd v. Lau Elaine and others (2013)

This case concerns the application of the law of passing-off. The plaintiffs were the owners of *Motherhood Magazine*. The monthly publication had been published in Singapore since 1983 and covered issues relating to pregnancy, motherhood and parenting. The plaintiffs also had other publications under the 'Motherhood' titles, and had held promotional events in which the trademark 'Motherhood' was used and promoted.

The defendants published an online publication under the title *Today's Motherhood*, and owned a website at www.todaysmotherhood.com. The plaintiffs claimed that the defendants' online publication and website was an act of passing-off, and claimed injunctive relief and damages and an account of profits made by the defendants.

The Court revisited the elements of a claim in passing-off, and examined whether there was goodwill in the plaintiffs' trademark, a misrepresentation by the defendants, causing a likelihood of confusion which caused damage to the plaintiffs' business. On the facts, the Court held that although the plaintiffs did have goodwill in the 'Motherhood' marks, the fact that the mark was a descriptive term worked against the plaintiffs' case, as no one trader ought to have a monopoly over the use of ordinary descriptive words. If another trader takes sufficient steps to distinguish its mark and business from that of the plaintiff, then no misrepresentation could be found. The plaintiffs were not able to establish either misrepresentation leading to a likelihood of confusion, nor was the element of damages established. The plaintiffs' claim of passing-off therefore failed.

ii Copyright cases

Alterm Consortech v. Public Prosecutor (2013)

This case concerns the criminal provisions of the Copyright Act. The appellant (Alterm) was charged with offences under Sections 136(3), 136(2) and 136(3A) of the Copyright Act, which relate to infringement of works. Alterm was in the pest control business and submitted plans for a project relating to the installation of a termite prevention system. A competitor company claimed that Alterm's plans contained similarities with the plans which they had submitted. They instituted a private prosecution of Alterm, who were convicted in the District Court.

Appealing against the conviction, Alterm maintained that they had traced their own specifications over the plans, and that the plans while of commercial value, were not of artistic value, and so were not protected by copyright. Hence, copyright could not subsist in the works provided by Alterm. The Court thus allowed the appeals by Alterm, and dismissed the convictions.

The case and judgment highlights the current distinction between a work of artistic merit, on the one hand, and a work which relates information, on the other.

While the courts are prepared to protect the former sort of work by copyright, they may not be prepared to attribute copyright to works that are purely information or data. There now seems to be a judicial readiness to distinguish between the more traditional 'sweat of the brow' test, which involved an assessment of whether the author exercised skill and labour in the creation of a work, and the more contemporary 'intellectual creation' test. The distinction between a work that has some creative content, as opposed to a work which is merely a compilation of information (for example, databases) is more evident.

iii Patent cases

Novartis AG and another v. Ranbaxy (Malaysia) SDN Bhd (2013)

The plaintiffs, Novartis AG, are the registered proprietor of a patent which relates to certain tablets which the defendant, Ranbaxy (Malaysia), a pharmaceutical company, sought to import into Singapore. The tablets are known as 'Starval' tablets. Ranbaxy required product licences to be granted under the Medicines Act which would effectively alert Novartis that the tablets could potentially infringe their patent. Novartis commenced proceedings seeking declarations that if the licences sought by the defendant to import Starval tablets into Singapore were granted, their patent would be infringed. Ranbaxy, in its defence, alleged that the patent was invalid because the invention had been anticipated by two cases of prior art. In its response, the plaintiff sought to amend their patent claims to 'enhance clarity, to highlight the inventive contributions of the patent and to reduce the number of claims' as well as to further distinguish the claims in the patent from the matter disclosed in the references as cited by the defendant.

The key issue was whether the application for amendment of the patent by the plaintiff would result in the patent disclosing additional matters. Under the Patents Act, Section 83(1), the court has discretion to grant leave to amend the specification of a patent, provided that the amendment complies with the requirements set out in Section 84, namely, that it does not result in the specification disclosing any additional matter or that such amendment will not extend the protection conferred by the patent. The court found that these requirements were all complied with by the plaintiff as the proposed amendments led to the narrowing of the specification.

A second issue was whether there was undue delay by the plaintiff in applying for the specification amendments. The Court found that there was no such delay. It held that the fact that the European Patent Office proceedings raised prior art, which necessitated an application to amend the specifications of the European patent in relation to the same invention did not necessarily mean that the plaintiffs ought to immediately take out an application to amend in Singapore. It was perfectly reasonable for the plaintiffs to endeavour to first prosecute the amendment in Europe, and then take out an application in Singapore after obtaining the ruling upon its amendment application, when the necessity arose.

The decision also emphasises that a patentee must act expeditiously in taking out an application to amend its patent claims upon discovering relevant prior art. Any delay in taking out an application to amend must be capable of explanation, and the patentee cannot persist in refusing to amend its patent specifications despite becoming aware of prior art.

AstraZeneca AB (SE) v. Sanofi-Aventis Singapore Pte Ltd (2012)

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.

iv **Legislative changes**

Moving to a positive grant system

On 14 February 2014, the Singapore patent regime has moved away from a self-assessment system towards a 'positive grant system'. Under the positive grant system, patents will only be granted if it is able to obtain a positive examination result. This change is meant not only to enhance the Singapore's IP infrastructure but also to align Singapore's patent system to those more established foreign patent offices.

Summary of the changes in the prosecution of the application

The dual system of 'fast track' and 'slow track' has been replaced with a 'single prosecution track.'

To coincide with this change, the single system of extensions has been replaced with an extension of time as-of-right and discretionary extension of time. Certain actions can be extended as a matter of right for up to six or 18 months depending on the applicable rules. Discretionary extension of time is only applicable if the applicant has exhausted the as-of-right extension of time and must be filed before the expiry of the maximum period of the as-of-right extension of time.

- a* The new supplementary examination report is mandatory if the applicant wishes to rely on a positive foreign search and examination results;
- b* A Notice of Intention to Refuse will be issued for the patent if an adverse examination report is obtained; and
- c* A new process for review of an adverse examination report is in place to provide the applicant an opportunity to address any outstanding issues raised by the examiner.

If the applicant is able to obtain a positive examination report, a Notice of Eligibility to Proceed to Grant will be issued by the Registrar and the applicant has two months from the date of the said Notice to apply for grant.

Local in-house examiners

Previous search and examination procedures are completely outsourced to patent offices in other countries such as Hungarian, Danish and Austrian Intellectual Property Offices. In order to develop patent experts in Singapore, the Intellectual Property Office of Singapore has been training and establishing local in-house examiners who will conduct a local search and examination to ascertain that the patent application has met the local formal requirements and criteria of patentability.

Foreign patent agents

The patent agent sector has been liberalised to allow a larger talent pool in patent services in Singapore. Foreign-qualified patent agents are now allowed to undertake offshore patent agency work in Singapore.

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. The search and examination options are the following:

All-local approach

An applicant may request to undergo either a search within 13 months from the priority date then examination process by the 36th month from the priority date or a combined search-and-examination process within the 36 months from the priority date of the application.

Combination approach

The applicant may request to undergo examination based on the positive foreign search results within 36 months from the priority date. Alternatively, the applicant may rely on the positive final search and examination results of a corresponding patent or corresponding international application or related national phase application and furnish the Registry with the corresponding international application search and examination result and at the same time file a request for a supplementary examination report at 54 months from priority date of the application.

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. Under the new patent regime, the 30th month time limit may be extendible for up to 18 months, subject to the applicant's filing of a request for an extension and payment of extension fees.

Search and examination and timelines

On or before the 36 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 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 36th month from the date of filing of the application. This is useful if the invention has obtained negative examination results during the international phase.

Combination approach

The applicant may request to undergo examination based on the positive foreign search results within 36 months from the priority date. Alternatively, the applicant may rely and furnish the Registry of Patents with the positive final search and examination results

of a corresponding patent or corresponding international application or related national phase application within 54 months from the filing date. However, applicants who wish to rely on these foreign results are required to file for a request for supplementary examination report by 54 months from the priority date of the application.

Moreover, after completion of the search and examination processes for both domestic and national phase applications, the Singapore Registry will issue either a Notice of Intention to Refuse the patent if the examination result is adverse or a Notice of Eligibility to Proceed to Grant if the examination result is positive. In the event of an adverse examination result, the applicant has the option to file for a review of the examination result.

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 an examination of formalities 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 licences 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 a 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 magistrates 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 is 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* the Copyright Act;
- b* the Registered Designs Act;
- c* the Patents Act;
- d* the Trademarks Act;
- e* the Computer Misuse Act;
- f* the Electronic Transactions Act 1998;
- g* the Layout-Designs of Integrated Circuits Act; and
- h* the Plant Varieties Protection Act.

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

Under the current law, a geographical indication is recognised and enjoys basic protection but there is no registration requirement for the same. In order to provide a broader and better protection for traders of goods identified by geographical indications, a Bill seeking to set up a registry for Geographical Indications (the GI Bill) was published in the Singapore parliament on 5 March 2014.

Under the GI Bill, a registration process similar to a trademark registration process will be made available to businesses to register their geographical indications for certain categories such as wines, spirits, beers, cheese, meat and meat products, seafood, edible oils, non-edible oils, fruits, vegetables, spices and condiments, confectionary and baked goods, flowers and parts of flowers and natural gum.

Appendix 1

ABOUT THE AUTHORS

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 master's 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 listed as one of the top-10 Singapore intellectual property law practices for 10 years and continues to provide its international clientele with expert advice.

GLENDORIS R OCAMPO

Namazie & Co

Glendoris R 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.

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