
THE INTELLECTUAL PROPERTY REVIEW

FOURTH EDITION

EDITOR
ROBERT L BAECHTOLD

LAW BUSINESS RESEARCH

THE INTELLECTUAL PROPERTY REVIEW

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THE
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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 is therefore 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.

Now in its fourth edition, this review is a testament to the flux of intellectual property law worldwide. From implementation of the American Invents Act in the United States, to further progress on a Unified Patent Court in Europe, and the frequent new controlling court decisions, the need for annual reviews of intellectual property on a global scale is essential for our clients to remain current. The authors of each chapter will provide an overview of the intellectual property rights available and highlight the notable developments in their respective countries. 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 2015

Chapter 27

SINGAPORE

Glendoris R Ocampo and Katherine Kan¹

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 Glendoris R Ocampo is a patents executive and Katherine Kan is a legal associate 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

Staywell Hospitality Group Pty Ltd v. Starwood Hotels & Resorts Worldwide, Inc [2014] 1 SLR 911 (Staywell)

The Court of Appeal's decision in the case of *Staywell* is the leading authority in relation to trademark similarity disputes in Singapore. A summary of both the High Court judgment, as well as the Court of Appeal judgment had been provided in the earlier editions. In brief, the *Staywell* test assists in the determination of whether marks are similar.

The two-stage Staywell test

The first stage is the marks similarity stage to determine:

- a* whether the marks are *prima facie* similar, without any consideration of extraneous factors. The test is whether the marks give a general impression of being similar when considered as a whole, taking into account of the visual, aural and conceptual similarities between the marks; and
- b* whether the goods and services are similar, without any consideration of extraneous factors. A registration in the same specification within the same class establishes *prima facie* case for identicalness.

The second is the confusion inquiry stage to determine whether there will be a 'likelihood of confusion' between the marks. The effect of the objective similarity between the marks (assessed in the marks similarity stage above) on the perception of consumers is assessed at this stage. Extraneous factors will be considered to determine whether there exists a likelihood of confusion between the marks.

It considers factors that are:

- a* intrinsic to the very nature of the goods; or
- b* that affect the impact that the similarity of the marks and goods has on the consumers.

Purchasing practices and degree of care of consumers when purchasing the goods are also permissible factors. Usually, the greater the degree of similarity between the marks, the greater the likelihood of confusion. Non-permissible extraneous factors are those factors which are susceptible to change. For example, steps taken by the trader to differentiate its products from the other traders'.

The Court of Appeal also made a distinction between the 'likelihood of confusion' test for opposition cases and infringement proceedings. In opposition cases, the Court

should consider the full range of actual and notional uses of the competing marks.² In infringement proceedings, the Court would compare the full range of notional fair uses of the registered mark owner against the actual use to which the allegedly infringing mark had been put.³

The *Staywell* test has been applied to some of the recent cases reported below.

Société Des Produits Nestlé SA v. Liwayway Marketing Corporation [2014] SGIPOS 5

The case involved, *inter alia*, an opposition for the application mark ‘Marty’s’ (stylised) in Classes 29 and 30. The opponents argued that the application mark is similar to their ‘Smarties’ marks, registered in Classes 5, 29, 30 and 32 in Singapore. The examining officer applied the step-by-step approach articulated by the Court of Appeal in *Staywell* (as summarised above) to evaluate whether the marks are similar.

It was held that the marks were not visually or conceptually similar. To decide on visual similarity, the factors considered were the length of the words, the number of letters that are identical, and the visually striking components of the mark. It was concluded that although there are more letters in common than not, the visually dominant parts of the application mark contributed to a distinguishable visual impact as compared with the opponent’s marks.⁴ The examiner also concluded that there was no conceptual similarity between the marks, as the application mark appears to represent a person’s name (i.e., Marty) while the opponent’s mark means ‘smart aleck’.⁵ Although the marks may be aurally similar by virtue of the number of syllables and the distinctive sounding part of the marks, in general, it was held that the marks are more dissimilar than similar.⁶

The identity or similarity of goods provided under the marks was also considered. Following the principle articulated in *Staywell*, it was held that the goods are *prima facie* identical, as the goods under the application mark fall within the ambit of the specification in which the opponent’s mark is registered.⁷

In considering the likelihood of confusion between the marks, the actual and notional fair use of each mark was compared and analysed. The reputation of the opponent’s ‘Smarties’ mark lowered the likelihood of confusion between the marks.⁸ Consistent with *Staywell*, the doctrine of initial interest was also considered not to be part of Singapore law as it is inconsistent with Section 8(2) of the Trade Marks Act.⁹ Moreover, by considering consumer perception on the goods and purchasing practices, a consumer is likely to take the goods off the shelves without the need to analyse the

2 *Staywell Hospitality Group Pty Ltd v. Starwood hotels & Resorts Worldwide, Inc* [2014] 1 SLR 911 at [60].

3 *Staywell Hospitality Group Pty Ltd v. Starwood hotels & Resorts Worldwide, Inc* [2014] 1 SLR 911 at [61].

4 *Société Des Produits Nestlé S.A. v. Liwayway Marketing Corporation* [2014] SGIPOS 5 at [35].

5 *Société Des Produits Nestlé S.A. v. Liwayway Marketing Corporation* [2014] SGIPOS 5 at [42].

6 *Société Des Produits Nestlé S.A. v. Liwayway Marketing Corporation* [2014] SGIPOS 5 at [48].

7 *Société Des Produits Nestlé S.A. v. Liwayway Marketing Corporation* [2014] SGIPOS 5 at [55].

8 *Société Des Produits Nestlé S.A. v. Liwayway Marketing Corporation* [2014] SGIPOS 5 at [67].

9 *Société Des Produits Nestlé S.A. v. Liwayway Marketing Corporation* [2014] SGIPOS 5 at [68].

marks carefully. Thus, the visual and conceptual dissimilarities carried more weight than the aural similarity in this case.¹⁰ Hence, no reasonable likelihood of confusion between the marks was found.

The claim for passing off also did not succeed as there was no misrepresentation (since there was no reasonable likelihood of confusion between the marks), and consequently no damage to the opponent's mark.

In short, the opponents did not manage to succeed in the opposition and passing off claims, and the application mark was allowed to proceed to registration.

Jamal Adbunasser Mahmoud Al Mahamid v. Global Tobacco [2015] SGHC 42

This case concerned, *inter alia*, an invalidation claim. The plaintiff owns a device mark that contains the word 'Manchester', used on tobacco packaging. The defendant owns a device mark that also contains the word 'Manchester' and is also used on tobacco packaging. Two years after the defendant's mark was registered, the plaintiff commenced proceedings to invalidate the defendant's mark.

The issues before the court were whether the marks were similar and whether there was a likelihood of confusion between the marks. At the marks similarity stage, the court considered the dominant components of the composite marks, namely, the word 'Manchester', and found that when comparing the marks as a whole there were no other elements present to distinguish from the words 'Manchester'.¹¹ As such, the court held that the marks appear similar visually, aurally and conceptually. There was also no dispute that the goods were identical.¹²

At the confusion inquiry stage, the court applied the test in *Hai Tong* and *Staywell* that the higher the degree of similarity between the marks and goods, the more likely that an average consumer will be confused, bearing in mind of the principle of imperfect recollection.¹³ In deciding the relevant average consumer in this case, the court held that, in the absence of evidence, the court must proceed on the basis that such a consumer would share the characteristics of a general consumer.¹⁴ The court, applying the principle of *Staywell*, further commented that since this was a case where both marks were registered and infringement is not an issue, confusion should be measured against notional fair uses of the marks, instead of actual uses of the marks.¹⁵ On that basis, as both marks were to be used in respect of identical goods, and notionally, such cigarettes could be available to all consumers in Singapore, a high degree of likelihood of confusion between the marks was found to exist.¹⁶ Hence, a basis for invalidation was successfully made out.

10 *Societe Des Products Nestle S.A. v. Liwayway Marketing Corporation* [2014] SGIPOS 5 at [73].

11 *Jamal Adbunasser Mahmoud Al Mahamid v. Global Tobacco* [2015] SGHC 42 at [39] & [40].

12 *Jamal Adbunasser Mahmoud Al Mahamid v. Global Tobacco* [2015] SGHC 42 at [41].

13 *Jamal Adbunasser Mahmoud Al Mahamid v. Global Tobacco* [2015] SGHC 42 at [52].

14 *Jamal Adbunasser Mahmoud Al Mahamid v. Global Tobacco* [2015] SGHC 42 at [54].

15 *Jamal Adbunasser Mahmoud Al Mahamid v. Global Tobacco* [2015] SGHC 42 at [59].

16 *Jamal Adbunasser Mahmoud Al Mahamid v. Global Tobacco* [2015] SGHC 42 at [59].

ii Patent case

Application for correction of a patent by Genpharm International Inc and objection thereto by Lonza Biologics Tuas Pte Ltd [IPOS HMG – 31 July 2014]

The present case deals with the determination on whether a post-grant amendment is allowable.

An application for a correction of a patent specification was filed by Genpharm International Inc, the proprietor of granted patent No. 51905 on the basis that at various places in the specification the terms ‘affinity’ or ‘affinity constant’ are incorrectly used, when in fact what is intended, and what should appear, are the terms ‘avidity’ or ‘avidity constant’.

Section 107 of the Singapore Patents Act as well as Rule 91 of the Singapore Patents Rules were taken into consideration when the Registrar decided on whether to allow the corrections sought for by Genpharm.

According to Section 107, the registrar may, subject to any provision of the rules, correct any error of translation, transcription, clerical error or mistake in any specification of a patent or application for a patent or any other document filed in connection with a patent or such application.

Rule 91 provides for further consideration to be made when considering corrections, including where such a request relates to a specification, no correction shall be made therein unless the correction is obvious in the sense that it is immediately evident that nothing else would have been intended than what is offered as the correction.

The Registrar discussed the difference between a correction and an amendment. In particular, Section 84 of the Patents Act explicitly indicates that an amendment cannot add subject matter or in the case of a patent, extend the protection conferred by a granted patent. In contrast, Section 107 has no restrictions as to correction, such that a correction made can potentially result in the specification disclosing new matter or extending the scope of protection of a patent.

To arrive at a decision, the Registrar revisited the UK practice’s two-step test for determining correction (i.e., if it is clear that there is an error (balance of probabilities) – such that it is apparent on the face of the document that there is an error and such consideration shall be made by a skilled person and, if so, it is clear what is now offered is what was originally intended – such that rectification must be immediately evident.

The Registrar determined that in this case, there were certain errors that were obvious and thus were allowed to be corrected, while, other corrections were not allowable.

iii Legislative changes

Copyright

The Singapore parliament passed a bill to amend the Copyright Act on 8 July 2014. The amendments are mainly focused on: (1) providing persons with reading disabilities

with better access to copyrighted materials, and (2) fighting online piracy by targeting websites/online locations that flagrantly infringe copyrighted works.¹⁷

Increased access for persons with reading disabilities

These amendments are made to implement the provisions of the Marrakesh Treaty, of which Singapore is a signatory to. The amendments to the Copyright Act provide a wider range of 'accessible formats' for the reading disabled, which allows copyrighted materials to be converted into sound recordings, Braille, the DAISY format, etc. Institutions that provide assistance to reading disabled persons are granted a statutory licence under Section 54 of the Copyright Act to convert the copyrighted works into 'accessible formats'. Such institutions can also make copies of the 'accessible formats' or distribute, import and make for export such 'accessible format copies' on a non-profit basis.¹⁸

Targeting flagrantly infringing online locations

These amendments came into operation on 10 December 2014. The amendments allow copyright owners to apply to Court for an order to require a network service provider to disable access to flagrantly infringing online locations. The factors that determine whether an online location (i.e., a website) has been used to flagrantly to commit or facilitate infringement of copyrighted materials are:

- a* whether the primary purpose of the website is to commit or facilitate copyright infringement;
- b* whether the website contains directories, indexes or categories of the means to commit or facilitate copyright infringement;
- c* whether the owner or operator demonstrates a disregard for copyright general;
- d* whether access to the website has been disabled by orders from any court of another country or territory on the ground of or related to copyright infringement;
- e* whether the website contains guides or instructions to circumvent measures or any order of any court that disables access to the online location on the ground of or related to copyright infringement; and
- f* the volume of traffic or frequency of access to the website.¹⁹

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

17 Ministry of Law website, <Amendments to the Copyright Act> www.mlaw.gov.sg/content/minlaw/en/news/press-releases/amendments-to-the-copyright-act-2014.html, accessed on 26 February 2015.

18 Section 54 of the Copyright Act.

19 Section 193DDA(2)(a) to (f) of the Copyright Act.

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 the 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 to 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 following are the criteria in order for the Singapore court to have jurisdiction over a defendant:

- a* the defendant is serviced with originating process when he is present in Singapore;

- b* the defendant agreed to submit to the jurisdiction of Singapore in an agreement with the plaintiff; or
- c* the defendant has agreed to a means of service within Singapore and the same is effected.

In cross-border disputes, the Singapore courts will only have jurisdiction if and when there is a legal connection between the case or the defendant and Singapore; or, given the degree of connection of the case with Singapore and with other countries, the Singapore court is satisfied that it is the most appropriate forum for the dispute.

Venue: the Supreme Court

The Supreme Court comprises the Court of Appeal and the High Court, and hears both civil and criminal matters. Specialised courts like the Intellectual Property court, Admiralty court, and the Arbitration court have also been set up in the Supreme Court to address the increasing complexity of commercial issues reaching the judiciary.

The Court of Appeal hears appeals against High Court decisions in both civil and criminal matters. The High Court hears both criminal and civil cases as a court of first instance. It also hears appeals from the decisions of state courts in civil and criminal cases, and decides points of law reserved in special cases submitted by the state courts.

Venue: the State Courts

The state courts (previously known as the subordinate courts) comprise the district courts, the magistrate courts and specialised courts such as the Family Court, Juvenile Court, Coroner's court, the small claims tribunal and the court mediation centre. The state courts hear both civil and criminal matters. Private prosecutions for trademark and copyright matters are initiated by the IP rights owners in the state 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 (fourth edition) or UNCITRAL Arbitration Rules (as revised in 2010) for the conduct of arbitration at the 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 the SIAC.

V TRENDS AND OUTLOOK

In its efforts to develop into an IP Hub of Asia, Singapore has made several legislative and regulatory changes to its IP infrastructure, including the following:

- a* launch of an IP financing scheme;
- b* launch of an IP advisory service for business owners;
- c* extension of Singapore's patent prosecution highway network. Singapore is now part of the Global Patent Prosecution Highway network;
- d* strengthening of the country's patent search and examination capabilities;
- e* establishment of a panel of top international IP arbitrators in the country;
- f* adoption of the IP competency framework by professional industry bodies;
- g* offering of a new expert determination option for patent disputes; and
- h* strengthening of the IP Academy to deliver IP education and training.²⁰

Moreover, an IP ValueLab will be set up to promote and develop IP management, commercialisation, monetisation and valuation in Singapore.

It is hoped that with these improvements, Singapore's IP infrastructure will be developed to world-class standards and provide rights owners with better protection and opportunities to monetise and commercialise their IP rights in Singapore.

20 IPOS, 'Singapore Continues Stride Towards Becoming an Intellectual Property Hub of Asia, Launches First-Ever IP Management and Value Lab' www.ipos.gov.sg/MediaEvents/Readnews/tabid/873/articleid/284/category/Press%20Releases/parentId/80/year/2014/Default.aspx, accessed on 12 March 2015.

Appendix 1

ABOUT THE AUTHORS

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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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Katherine Kan is a legal associate at Namazie & Co. She graduated from the University of Warwick, UK in 2013 with a LLB (Hons) degree. During her time at Namazie & Co, Katherine has worked on a number of trademark cases, including the registration, protection and enforcement of trademarks. Katherine's practice also involves patent protection, as well as commercial transactions involving intellectual property rights.

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