

LEGAL SYSTEMS IN ASEAN – SINGAPORE
CHAPTER 5 – BUSINESS LAW (PART 4):
THE LAW OF INTELLECTUAL PROPERTY

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TABLE OF CONTENTS

A.	FOUNDATIONS OF THE INTELLECTUAL PROPERTY REGIMES IN SINGAPORE ...	2
	Statutory Basis.....	2
	Governance and Policy.....	2
	Standing to Sue for Infringement.....	2
B.	COPYRIGHT	4
	Scope of Protection.....	4
	Infringement.....	4
	Defences.....	5
	Remedies for Infringement; Enforcement.....	6
C.	PATENTS	6
	Registration and Scope of Protection.....	6
	Infringement.....	7
	Defences.....	7
	Remedies for Infringement; Enforcement.....	8
D.	REGISTERED TRADE MARKS.....	9
	Registration and Scope of Protection.....	9
	Infringement.....	9
	Defences.....	10
	Remedies for Infringement; Enforcement.....	10
E.	WELL-KNOWN TRADE MARKS	12
	Scope of Protection.....	12
	Infringement.....	12
	Defences.....	13
F.	UNREGISTERED AND UNREGISTRABLE TRADE MARKS AND THE TORT OF PASSING OFF	14
	The Legal Test.....	14
	Defence	14
	Remedies.....	15
G.	REGISTERED DESIGNS	15
	Registration and Scope of Protection.....	15

Infringement.....	16
Defences.....	16
Remedies for Infringement; Enforcement.....	18

A. FOUNDATIONS OF THE INTELLECTUAL PROPERTY REGIMES IN SINGAPORE

Statutory Basis

In Singapore, the law of intellectual property is contained in several statutes, including but not limited to the following primary legislation:

- Copyright Act.¹
- Patents Act.²
- Trade Marks Act.³
- Registered Designs Act.⁴
- Plant Varieties Protection Act.⁵
- Geographical Indications Act.⁶
- Layout-Designs of Integrated Circuits Act.⁷

This chapter will describe the copyright, patents, trade marks and registered designs regimes.

Governance and Policy

The Intellectual Property Office of Singapore (hereafter IPOS) is a statutory board established under the Ministry of Law pursuant to the Intellectual Property Office of Singapore Act (hereafter IPOS Act).⁸ It is the agency charged with administering the systems in Singapore for the protection of intellectual property.⁹ It maintains the Registry of Patents, Registry of Trade Marks, and the Registry of Designs.

Standing to Sue for Infringement

The standing to bring infringement proceedings is statutorily conferred. Under the Copyright Act, the owner of a copyright may bring an action for an

¹ Cap 63, 2006 Rev Ed.

² Cap 221, 2005 Rev Ed.

³ Cap 332, 2005 Rev Ed.

⁴ Cap 266, 2005 Rev Ed.

⁵ Cap 232A, 2006 Rev Ed.

⁶ Cap 117B, 1999 Rev Ed.

⁷ Cap 159A, 2000 Rev Ed.

⁸ Cap 140, 2002 Rev Ed.

⁹ *ibid* s 6(1)(a).

infringement of the copyright.¹⁰ An exclusive licensee of a copyright has the same rights of action as the owner except as against the owner.¹¹

Under the Patents Act, the proprietor of a patent may bring civil proceedings in respect of any act alleged to infringe the patent.¹² The exclusive licensee has the same right as the proprietor to bring proceedings for an infringement committed after the date of the licence.¹³

Under the Trade Marks Act, the proprietor of a registered trade mark may bring infringement proceedings.¹⁴ Unless the licence provides otherwise, a licensee may call on the proprietor of the registered trade mark to bring infringement proceedings in respect of any matter which affects his interests. If the proprietor refuses or fails to do so within the prescribed period, the licensee may bring the proceedings in his own name.¹⁵ It is permissible for an exclusive licence to provide that the licensee shall have, to the extent allowed by the licence, the same rights and remedies in respect of matters occurring after the grant of the licence as if the licence had been an assignment. Where such provision is made, the exclusive licensee may bring infringement proceedings in his own name against any person other than the proprietor, subject to the terms of the licence.¹⁶

Under the Registered Designs Act, the registered owner of a registered design may bring infringement proceedings.¹⁷ Where there is more than one registered owner, each registered owner may bring infringement proceedings provided that the other registered owner or owners are made parties to the proceedings.¹⁸ The exclusive licensee of a registered design has the same right as the registered owner to bring proceedings for an infringement committed after the date of the grant of the licence.¹⁹

In *PCCW Media Ltd v M1 Ltd*,²⁰ the High Court held that the assignment of a bare right to sue does not effectively confer standing on the assignee to bring copyright infringement proceedings. While the decision was concerned with the right to obtain relief under section 193DDA of the Copyright Act, it may be of general application to all intellectual property infringement proceedings in Singapore.

¹⁰ Copyright Act (n 1) s 119(1).

¹¹ *ibid* s 123.

¹² Patents Act (n 2) s 67(1).

¹³ *ibid* s 74(1).

¹⁴ Trade Marks Act (n 3) s 31(1).

¹⁵ *ibid* ss 44(3) and (4).

¹⁶ *ibid* ss 45(1) and (2).

¹⁷ Registered Designs Act (n 4) s 36(1).

¹⁸ *ibid* s 37.

¹⁹ *ibid* s 38(1).

²⁰ [2018] SGHC 99, [26] (High Court, Singapore).

B. COPYRIGHT

Scope of Protection

Copyright is a statutory creation. The Copyright Act expressly provides that no copyright shall subsist otherwise than by virtue of the Act.²¹

In Singapore, copyright does not require any formalities to be performed to exist. It arises automatically upon the creation of a work in physical form. The Copyright Act also does not currently provide for a system of registration of first ownership or recording of subsequent dealings in copyrights. This may change. In a 2016 public consultation, the Ministry of Law and the IPOS announced that they were studying the feasibility of setting up a voluntary system of copyright registration and recordation.

The Copyright Act confers copyright protection to a work, or subject-matter other than a work, if the work is original and has been reduced to some material form and there is a connecting factor between the work or its author and Singapore.²² The duration of copyright protection varies across different types of works:

- (a) For a literary, dramatic or musical work, or an artistic work other than a photograph, the period is 70 years after the death of the author.²³
- (b) For a sound recording or a cinematograph film, the period is 70 years after its first publication.²⁴
- (c) For a television broadcast or sound broadcast, the period is 50 years after it was made.²⁵
- (d) For a cable programme, the period is 50 years after it was first included in the cable programme service.²⁶
- (e) For a published edition of a work or works, the period is 25 years after its first publication.²⁷

Infringement

There are two types of copyright infringement under the Copyright Act: direct or primary infringement and indirect or secondary infringement. Primary infringement occurs when a person does or authorises the doing of any of the restricted acts which are within the copyright owner's exclusive rights, such as

²¹ Copyright Act (n 1) s 4.

²² Susanna H S Leong, 'Historical Origins and Current State of Copyright Laws' in *Intellectual Property Law of Singapore* (Academy Publishing 2013) [03.013].

²³ Copyright Act (n 1) s 28(2).

²⁴ *ibid* ss 92 and 93 respectively.

²⁵ *ibid* s 94.

²⁶ *ibid* s 95.

²⁷ *ibid* s 96.

reproducing a work in a material form and publishing an unpublished work.²⁸ Secondary infringement occurs when a person distributes or deals with infringing articles after they have been made.²⁹

Defences

The Copyright Act provides various defences by declaring that certain acts do not constitute infringement.³⁰ The most significant defence is fair dealing with a copyrighted work, where the dealing is for research and study, criticism or review, or the reporting of current events.³¹ Examples of other, more specific, defences include:

- (a) Making a reproduction of a work for purposes of a judicial proceeding, seeking professional advice from a lawyer, or providing professional advice by a lawyer.³²
- (b) Making a temporary or transient reproduction of a work incidentally as part of the technical process of making or receiving a communication.³³
- (c) Reproducing a computer program by or on behalf of the owner of a copy of the program for the sole purpose of using the reproduction as a back-up.³⁴
- (d) Decompiling a computer program expressed in a low-level language where this is necessary to achieve the sole objective of obtaining certain information.³⁵
- (e) Where a lawful user of a computer program observes, studies or tests its functions to determine the ideas and principles underlying any of its elements.³⁶
- (f) Where a lawful user of a computer program copies or adapts it and the copying or adapting is necessary for his lawful use.³⁷
- (g) Including a short extract of a work in a collection for use by educational institutions.³⁸

²⁸ *ibid* ss 26(1)(a)(i) and (ii), which apply to literary, dramatic and musical works. Different exclusive rights apply to other types of works.

²⁹ Leong (n 22) [08.020]–[08.021].

³⁰ Leong, 'Defences to Copyright Infringement' in *Intellectual Property Law of Singapore*, *ibid* 231–260.

³¹ Copyright Act (n 1) ss 35–37 respectively.

³² *ibid* s 38.

³³ *ibid* s 38A.

³⁴ *ibid* s 39.

³⁵ *ibid* s 39A.

³⁶ *ibid* s 39B.

³⁷ *ibid* s 39C.

³⁸ *ibid* s 40.

- (h) Reading or reciting an extract of a work of reasonable length in public, or including it in a communication of a reading or recitation.³⁹
- (i) Performing a work of a religious nature in the course of services at a place of worship or other religious assembly.⁴⁰

Remedies for Infringement; Enforcement

Under the Copyright Act, the court is empowered to grant the following remedies:

- (a) An injunction, damages, an account of profits, or statutory damages in lieu of damages or an account of profits.⁴¹
- (b) An order that any infringing copy, or any article which has been used for making infringing copies, in the defendant's possession or before the court be delivered up to the plaintiff.⁴²
- (c) In addition to an order for delivery up, an order that an infringing copy or other object delivered up be forfeited to the plaintiff, destroyed, or otherwise dealt with as the court thinks fit.⁴³

An act of infringement may also amount to a criminal offence.⁴⁴

C. PATENTS

Registration and Scope of Protection

The Patents Act establishes the Registry of Patents within the IPOS and sets out the process of registration in Singapore. To enjoy protection under the Patents Act, an inventor must apply for a grant of patent for the invention. It is possible to make either a national filing of an application to the IPOS, or an international filing under the Patent Cooperation Treaty⁴⁵ to the World Intellectual Property Organization.

For an invention to be patentable under the Patents Act, it must satisfy the following conditions:

- (a) The invention must be new.⁴⁶
- (b) The invention must involve an inventive step.⁴⁷

³⁹ *ibid* s 41.

⁴⁰ *ibid* s 42.

⁴¹ *ibid* s 119(2).

⁴² *ibid* s 120(1).

⁴³ *ibid* s 120A(1).

⁴⁴ *ibid* s 136.

⁴⁵ 1160 UNTS 231, entered into on 19 June 1970.

⁴⁶ Patents Act (n 2) s 13(1)(a).

⁴⁷ *ibid* s 13(1)(b).

- (c) The invention must be capable of industrial application.⁴⁸
- (d) The publication or exploitation of the invention must not be generally expected to encourage offensive, immoral or anti-social behaviour.⁴⁹

The term of a grant under the Patents Act is 20 years.⁵⁰ The term may be extended on a few limited grounds, such as where there was an unreasonable delay by the Registrar in granting the patent.⁵¹

Infringement

A person infringes a patent for an invention if, but only if, while the patent is in force, and he or she does any of the following acts without the proprietor's consent:

- (a) In relation to a patent for a product, if he or she makes, disposes of, offers to dispose of, uses or imports the product or keeps it whether for disposal or otherwise.⁵²
- (b) In relation to a patent for a process, if he or she uses the process or offers it for use in Singapore when he or she knows, or it is obvious to a reasonable person in the circumstances, that its use without the consent of the proprietor would be an infringement.⁵³
- (c) In relation to a patent for a process, if he or she disposes of, offers to dispose of, uses or imports any product obtained directly by means of that process or keeps any such product whether for disposal or otherwise.⁵⁴

Defences

The Patents Act provides that an act is not an infringement if:⁵⁵

- (a) It is done privately and for non-commercial purposes.
- (b) It is done for experimental purposes relating to the subject-matter of the invention.
- (c) It consists of the extemporaneous preparation of a medicine for an individual in accordance with a prescription given by a registered

⁴⁸ *ibid* s 13(1)(c).

⁴⁹ *ibid* s 13(2).

⁵⁰ *ibid* s 36(1).

⁵¹ *ibid* s 36A.

⁵² *ibid* s 66(1)(a).

⁵³ *ibid* s 66(1)(b).

⁵⁴ *ibid* s 66(1)(c).

⁵⁵ *ibid* s 66(2).

medical or dental practitioner or consists of dealing with a medicine so prepared.

- (d) It consists of the use of a product or process in the body or operation of a relevant aircraft, hovercraft, or vehicle which has temporarily or accidentally entered or is crossing Singapore (including the air space above it and its territorial waters) or the use of accessories for such a relevant aircraft, hovercraft or vehicle.
- (e) It consists of the use, exclusively for the needs of a relevant ship, of a product or process in the body of the ship or in its machinery, tackle, apparatus or other accessories, in a case where the ship has temporarily or accidentally entered the territorial waters of Singapore.
- (f) It consists of the use of an exempted aircraft which has lawfully entered or is lawfully crossing Singapore as mentioned in paragraph (d) or of the importation into Singapore, or the use or storage, of any part or accessory for that aircraft.
- (g) It consists of the import, use, disposal of, or the offer to dispose of any patented product or any product obtained by means of a patented process or to which a patented process has been applied, which is produced by or with the consent (conditional or otherwise) of the proprietor of the patent or any person licensed by him.
- (h) It consists of the doing of anything within the proprietor's exclusive rights in relation to the subject-matter of the patent to support any application for marketing approval for a pharmaceutical product.
- (i) It consists of the import, disposal of, or the offer to dispose of a patented pharmaceutical product for use by or on a specific patient in Singapore, or the use of that product by or on that patient, under specific conditions.

Remedies for Infringement; Enforcement

Under the Patents Act, the court is empowered to grant the following remedies:

- (a) An injunction.⁵⁶
- (b) An order for the defendant to deliver up or destroy any infringing product, article, material, or implement.⁵⁷
- (c) Damages.⁵⁸

⁵⁶ *ibid* s 67(1)(a).

⁵⁷ *ibid* s 67(1)(b).

⁵⁸ *ibid* s 67(1)(c).

- (d) An account of profits.⁵⁹
- (e) A declaration that the patent is valid and has been infringed by the defendant.⁶⁰

A person aggrieved by groundless threats of infringement proceedings may apply for a declaration that the threats are unjustifiable, an injunction, and damages.⁶¹

It is a criminal offence for a person to falsely represent that anything disposed of by him or her for value is a patented product,⁶² or to represent that a patent has been applied for in respect of any article disposed of for value by him or her where no such application has been made or any such application has been refused, withdrawn, or treated as having been abandoned.⁶³

D. REGISTERED TRADE MARKS

Registration and Scope of Protection

The Trade Marks Act establishes the Registry of Trade Marks within the IPOS and sets out the process of registration in Singapore. In addition to the statutory protection conferred under the Trade Marks Act, registered trade marks are also protected under the tort of passing off. This was confirmed by the Court of Appeal in *Future Enterprises Pte Ltd v McDonald's Corp.*⁶⁴ The law on passing off is discussed separately below.

An application for trade mark registration can be refused by the Registrar of Trade Marks on various grounds, such as the lack of any distinctive character, or if the trade mark is contrary to public policy or to morality.⁶⁵

The initial period of registration is ten years and registration may be renewed for further periods of ten years.⁶⁶

Infringement

Section 27 of the Trade Marks Act sets out the acts amounting to an infringement of a registered trade mark. Generally, a person infringes the exclusive rights of a registered trade mark proprietor if he or she uses an identical or confusingly similar trade mark in the course of trade in relation to identical or similar goods or services without the consent of the proprietor or the exclusive licensee as the case may be.

⁵⁹ *ibid* s 67(1)(d).

⁶⁰ *ibid* s 67(1)(e).

⁶¹ *ibid* s 77.

⁶² *ibid* s 99(1).

⁶³ *ibid* s 100(1).

⁶⁴ [2007] 2 SLR(R) 845, [17] (Court of Appeal, Singapore).

⁶⁵ Trade Marks Act (n 3) ss 7(1)(b) and 4(a); see generally ss 7–9 of the Act.

⁶⁶ *ibid* s 18.

Defences

The Trade Marks Act provides that a person does not infringe a registered trade mark in the following situations:

- (a) In accordance with honest practices, he or she uses his or her name, the name of his or her place of business, the name of his or her predecessor in business, or the name of his or her predecessor's place of business.⁶⁷
- (b) In accordance with honest practices, he or she uses a sign to indicate certain characteristics of goods or services.⁶⁸
- (c) In accordance with honest practices, he or she uses the trade mark to indicate the intended purpose of goods or services.⁶⁹
- (d) He or she uses an unregistered trade mark that is identical with or similar to the registered trade mark in relation to goods or services identical with or similar to those for which the trade mark is registered if he or she has continuously used in the course of trade the unregistered trade mark in relation to those goods or services before the date of registration of the registered trade mark or before the proprietor first used the trade mark.⁷⁰
- (e) Another registered trade mark is used in relation to goods or services for which this other trade mark is registered.⁷¹
- (f) His or her use is fair use in comparative commercial advertising or promotion, for a non-commercial purpose, or for the purpose of news reporting or commentary.⁷²
- (g) He or she uses the trade mark in relation to goods which have been put on the market under that trade mark by the proprietor or with his or her consent.⁷³

Remedies for Infringement; Enforcement

Under the Trade Marks Act, the court is empowered to grant the following relief:

- (a) An injunction, damages, an account of profits, and statutory damages.⁷⁴

⁶⁷ *ibid* s 28(1)(a).

⁶⁸ *ibid* s 28(1)(b).

⁶⁹ *ibid* s 28(1)(c).

⁷⁰ *ibid* s 28(2).

⁷¹ *ibid* s 28(3).

⁷² *ibid* s 28(4).

⁷³ *ibid* s 29(1).

⁷⁴ *ibid* s 31.

- (b) An order that the defendant cause the offending sign to be erased, removed, or obliterated from any infringing goods, material, or articles in his or her possession, custody, or control or, where it is not reasonably practicable to do so, destroy those items.⁷⁵
- (c) An order that the defendant deliver up any infringing goods, material, or articles in his or her possession or before the court.⁷⁶
- (d) In addition to an order for delivery up, an order that the defendant destroy or forfeit the infringing goods, material, or articles delivered up as the court thinks fit.⁷⁷

A person aggrieved by groundless threats of infringement proceedings may apply for a declaration that the threats are unjustifiable, and also request an injunction and damages.⁷⁸

It is a criminal offence for a person to do any of the following acts:

- (a) Counterfeit a registered trade mark.⁷⁹
- (b) Falsely apply a registered trade mark to goods or services unless he or she acted innocently.⁸⁰
- (c) Make an article specifically designed or adapted for making copies of a registered trade mark or a sign likely to be mistaken for that trade mark or have such an article in his possession, custody, or control, knowing or having reason to believe that it has been, or is to be, used for, or in the course of, committing an offence against section 46 or 47 of the Trade Marks Act.⁸¹
- (d) Import, sell, or have in his or her possession for the purpose of trade or manufacture any goods to which a registered trade mark is falsely applied unless he or she had no reason to suspect the genuineness of the mark after having taken all reasonable precautions and acting innocently.⁸²
- (e) Knowingly make a false representation that a mark is registered or in relation to the goods or services for which a trade mark is registered.⁸³

⁷⁵ *ibid* s 32(1).

⁷⁶ *ibid* s 33(1).

⁷⁷ *ibid* s 34(1).

⁷⁸ *ibid* s 35.

⁷⁹ *ibid* s 46(1).

⁸⁰ *ibid* s 47(1).

⁸¹ *ibid* s 48.

⁸² *ibid* s 49.

⁸³ *ibid* s 51(1).

E. WELL-KNOWN TRADE MARKS

Scope of Protection

A well-known trade mark is accorded protection under section 55 of the Trade Marks Act, regardless of whether it is registered in Singapore or whether the proprietor carries on business or has any goodwill in Singapore. For instance, when a Singapore property developer named its housing project after the name of a well-known luxury resort in Bali, which was not registered as a trade mark in Singapore, it was made to rename the project as the resort's name was deemed a well-known trade mark in Singapore.⁸⁴

Section 2(7) of the Trade Marks Act provides that in deciding whether a trade mark is well known in Singapore, it is relevant to consider any matter from which it may be inferred that the trade mark is well known, including the following matters:

- (a) The degree to which the trade mark is known to or recognised by any relevant sector of the public in Singapore. A trade mark is deemed to be well known in Singapore if it is well known to any relevant sector of the public in Singapore.⁸⁵
- (b) The duration, extent, and geographical area of any use of the trade mark or any promotion of the trade mark, including any advertising of, any publicity given to, or any presentation at any fair or exhibition of the goods or services to which the trade mark is applied.
- (c) Any registration or application for the registration of the trade mark in any country or territory in which the trade mark is used or recognised, and the duration of such registration or application.
- (d) Any successful enforcement of any right in the trade mark in any country or territory, and the extent to which the trade mark was recognised as well known by the competent authorities of that country or territory.
- (e) Any value associated with the trade mark.

The list is not exhaustive of the matters that may be taken into account.⁸⁶

Infringement

The proprietor of a well-known trade mark is entitled to restrain the following acts by injunction:

⁸⁴ *Novelty Pte Ltd v Amanresorts Ltd* [2009] 3 SLR 216 (Court of Appeal, Singapore).

⁸⁵ *ibid* s 2(8).

⁸⁶ *Novelty Pte Ltd* (n 84) [137]

- (a) The unauthorised use in Singapore of any identical or similar trade mark in relation to identical or similar goods or services where the use is likely to cause confusion.⁸⁷
- (b) The unauthorised use in Singapore of any identical or similar trade mark in relation to any goods or services where the use would indicate a connection between those goods or services and the proprietor and is likely to damage the proprietor's interests, or would unfairly dilute the trade mark's distinctive character or take unfair advantage of its distinctive character if the trade mark is well known to the public at large in Singapore.⁸⁸
- (c) The unauthorised use in Singapore of any business identifier identical or similar to the trade mark where the use would indicate a connection between the business identified and the proprietor and is likely to damage the proprietor's interests, or would unfairly dilute the trade mark's distinctive character or take unfair advantage of its distinctive character if the trade mark is well known to the public at large in Singapore.⁸⁹

Defences

The defendant has a defence if his or her use is permitted under section 55A of the Trade Marks Act. Such uses include:

- (a) The use by a person of his or her own name, the name of his or her place of business, the name of his or her predecessor in business or the name of his or her predecessor's place of business, in accordance with honest practices.⁹⁰
- (b) The use of any sign to indicate certain characteristics of goods or services.⁹¹
- (c) The use of the trade mark to indicate the intended purpose of goods or services.⁹²
- (d) The use in Singapore of any registered trade mark in relation to goods or services for which the registered trade mark is registered.⁹³
- (e) The use of the well-known trade mark if the use is fair use in comparative commercial advertising or promotion, for a non-

⁸⁷ *ibid* s 55(2).

⁸⁸ *ibid* s 55(3).

⁸⁹ *ibid* s 55(4).

⁹⁰ *ibid* s 55A(1)(a).

⁹¹ *ibid* s 55A(1)(b).

⁹² *ibid* s 55A(1)(c).

⁹³ *ibid* s 55A(2).

commercial purpose, or for the purpose of news reporting or commentary.⁹⁴

F. UNREGISTERED AND UNREGISTRABLE TRADE MARKS AND THE TORT OF PASSING OFF

While statutory remedies are provided in various intellectual property statutes, the tort of passing off remains important, in particular by offering protection to unregistered and unregistrable trade marks. This is implicitly acknowledged by the Trade Marks Act which preserves common law rules relating to passing off.⁹⁵

The Legal Test

For a plaintiff to succeed in an action for passing off, three elements must be proved:⁹⁶

- (a) Goodwill in a business.
- (b) Misrepresentation, namely, passing off one's goods or services as the goods or services of another.
- (c) Damage.

Goodwill refers to the benefit and advantage of the good name, reputation, and connection of a business; it is the attractive force which brings in custom.⁹⁷ Goodwill is the bedrock of the tort because the tort protects goodwill and nothing else.⁹⁸

To establish the element of misrepresentation, the plaintiff must show that the defendant has made a misrepresentation to the relevant sector of the public, and such misrepresentation has resulted in or is likely to result in damage to the plaintiff's goodwill.⁹⁹ Proof of actual damage is not always required so long as the plaintiff shows a likelihood of damage.¹⁰⁰

Defence

There is a limited defence where the goodwill in question is shared by the plaintiff and the defendant. In such a case, the plaintiff would not be able to prevent the defendant from using the name or mark associated with that goodwill. However, the mere fact that the defendant is a concurrent user of the name or mark is not sufficient to raise the defence. It has to be shown that the defendant commenced

⁹⁴ *ibid* s 55A(3).

⁹⁵ *ibid* s 4(2).

⁹⁶ *Lifestyle 1.99 Pte Ltd v S\$1.99 Pte Ltd* [2000] 1 SLR(R) 687, [17] (Court of Appeal, Singapore); *Novelty Pte Ltd* (n 84) [37].

⁹⁷ *CDL Hotels International Ltd v Pontiac Marina Pte Ltd* [1998] 1 SLR(R) 975, [44] (Court of Appeal, Singapore); *Novelty Pte Ltd*, *ibid* [39].

⁹⁸ *Novelty Pte Ltd*, *ibid* [38].

⁹⁹ *Novelty Pte Ltd*, *ibid* [69].

¹⁰⁰ *Nation Fittings (M) Sdn Bhd v Oystertec Plc* [2006] 1 SLR(R) 712, [176] (High Court, Singapore).

the use of the trade name either before or shortly after the plaintiff started using the name.¹⁰¹ Additionally, the defendant cannot dishonestly adopt the name, for example, by adopting it despite knowing it will cause confusion to the public.¹⁰²

Remedies

The remedies available to a successful claimant for passing off are an injunction, damages, or an account of profits.

G. REGISTERED DESIGNS

The Registered Designs Act is the main statute governing industrial designs in Singapore. However, there may be concurrent protection of industrial designs under the law of copyright and the law of trade marks.¹⁰³

Registration and Scope of Protection

The Registered Designs Act establishes the Registry of Designs within the IPOS and sets out the process of registration in Singapore. A ‘design’ is defined in the Act as features of shape, configuration, colours, pattern, or ornament applied to any article or non-physical product that give that article or non-physical product its appearance, subject to certain exclusions.¹⁰⁴

New designs may be registered in respect of an article, a non-physical product, or a set of articles and non-physical products.¹⁰⁵ An example of a non-physical product is a virtual keyboard projected on to a surface and which can be used to type characters in the same manner as a physical computer keyboard. The non-physical product has to have a utilitarian function and not just be a projection of a design.¹⁰⁶ A design cannot be registered if publication or use of the design would be contrary to public order or morality or if it is a computer program or layout-design.¹⁰⁷ A registered design is granted to the person who first applies for the design to be registered.¹⁰⁸

Where a person has filed an application for the registration of a design in respect of certain articles or non-physical products in a country which is a party to the Paris Convention for the Protection of Industrial Property¹⁰⁹ or a member of the World Trade Organization and files an application under the Registered Designs Act within six months after the first application for the registration of the design

¹⁰¹ *Mainfreight (S) Pte Ltd v Mainfreight International Logistics Pte Ltd* [2012] 4 SLR 1002, (High Court, Singapore) [81].

¹⁰² *ibid* [75]; see Leong, ‘Passing Off’ in *Intellectual Property Law of Singapore* (n 22) [35.178].

¹⁰³ Leong, ‘Industrial Designs’ in *Intellectual Property Law of Singapore* (n ???) [25.088]–[25.094].

¹⁰⁴ Registered Designs Act (n 4) s 2(1).

¹⁰⁵ *ibid* s 5(1).

¹⁰⁶ Intellectual Property Office of Singapore, *Information Note on Virtual Designs and Non-Physical Products* (6 October 2017).

¹⁰⁷ Registered Designs Act (n 4) ss 6 and 7(1) respectively.

¹⁰⁸ *ibid* s 5(2).

¹⁰⁹ 828 UNTS 305, entered into on 20 March 1883.

in respect of all or any of those articles or non-physical products, he or she may claim a right of priority.¹¹⁰

The design is protected during its period of registration, and the maximum period is 15 years from the date of registration of the design. The initial period is five years and may be extended for a second and third period of five years each.¹¹¹

Infringement

The right in a registered design is infringed by a person who, without the registered owner's consent and while the registration is in force:¹¹²

- (a) does anything that is within the registered owner's exclusive rights under section 30(1) of the Registered Designs Act, including the right to make in Singapore or import into Singapore for sale or hire of any article in respect of which the design is registered, and to sell, hire or offer in Singapore any article or non-physical product in respect of which the design is registered;
- (b) makes anything for enabling any article referred to in section 30(1) to be made in Singapore or elsewhere;
- (c) does anything in relation to a kit – that is, a complete or substantially complete set of components intended to be assembled into an article,¹¹³ – that would constitute an infringement of the design if it had been done in relation to the assembled article; or
- (d) makes anything for enabling a kit to be made or assembled, in Singapore or elsewhere, if the assembled article would be an article referred to in section 30(1).

Defences

The Registered Designs Act provides that the right in a registered design is not infringed by the following:

- (a) The doing of any act for a private non-commercial purpose.¹¹⁴
- (b) The doing of any act for the purpose of evaluation, analysis, research or teaching.¹¹⁵
- (c) The reproduction of a feature of the design which, by virtue of paragraph (b) of the definition of *design* in section 2(1), is left out

¹¹⁰ Registered Designs Act (n 4) s 12.

¹¹¹ *ibid* ss 21(1) and (2).

¹¹² *ibid* s 30(2).

¹¹³ *ibid* s 30(3).

¹¹⁴ *ibid* s 30(5)(a).

¹¹⁵ *ibid* s 30(5)(b).

of account in determining whether the design is registrable.¹¹⁶ This means that purely functional or utilitarian features of a design which are not registrable¹¹⁷ can be reproduced. For instance, in Singapore newly licensed drivers are required by law to display a probation plate on their motor vehicles. The colours of the probation plate can be reproduced without infringing a registered design, because they are attributable only to the function of the probation plate.¹¹⁸

- (d) The import, sale, hire, offer or exposure for sale or hire of any article to which the design has been applied, if the article has been placed on the market, whether in Singapore or elsewhere, by or with the consent (conditional or otherwise) of the registered owner.¹¹⁹
- (e) The import, sale, hire, offer or exposure for sale or hire of any device for projecting a non-physical product (being a non-physical product to which the design has been applied), if the device has been placed on the market, whether in Singapore or elsewhere, by or with the consent (conditional or otherwise) of the registered owner. A device for projecting a non-physical product refers to any device that when activated projects the non-physical product on a surface or into a medium, including air.¹²⁰
- (f) The sale, hire, offer or exposure for sale or hire of any non-physical product to which the design has been applied, if the non-physical product has been placed on the market, whether in Singapore or elsewhere, by or with the consent (conditional or otherwise) of the registered owner.

If, before the date when the design is registered, a person does in good faith in Singapore an act which would have been an infringement if the registration had been in force at the time, or makes in good faith effective and serious preparations to do such an act in Singapore, he has the right to continue to do the act or to do the act.¹²¹

In a civil action, a court will not award damages or an account of profits if the defendant proves that at the date of infringement he or she was not aware, and had no reasonable grounds for believing, that the design in question was registered.¹²²

¹¹⁶ *ibid* s 30(6).

¹¹⁷ Leong, 'Industrial Designs' in *Intellectual Property Law of Singapore* (n 22) [25.039].

¹¹⁸ Intellectual Property Office of Singapore, *Information Note on Colours as a Design Feature* (6 October 2017).

¹¹⁹ Registered Designs Act (n 4) s 30(7)(a)(i).

¹²⁰ *ibid* s 30(7)(a)(ii).

¹²¹ *ibid* s 31.

¹²² *ibid* s 39(1).

Remedies for Infringement; Enforcement

When a plaintiff brings legal proceedings for infringement of a registered design, the court is empowered to grant the following relief:

- (a) An injunction, an award of damages, or an account of the profits earned by the defendant.¹²³
- (b) An order that the defendant deliver up any infringing article, anything predominantly used for the making of infringing articles, or any infringing device in relation to the design to the plaintiff.¹²⁴
- (c) In addition to an order for delivery up, an order that the infringing article or thing or any infringing device delivered up be destroyed or forfeited as the court thinks fit.¹²⁵

A person can apply in writing to the registered owner for a written acknowledgement stating that an act that he or she does, or plans to do, would not constitute an infringement of the owner's design. If the owner then refuses or fails to give such an acknowledgement when it is appropriate to do so, if the owner later brings legal proceedings against the person claiming that the design has been infringed, the court may make a declaration that the person's act is not, or proposed act would not, constitute an infringement.¹²⁶

A person aggrieved by groundless threats of infringement proceedings may apply for a declaration that the threats are unjustifiable, an injunction, and damages.¹²⁷

It is a criminal offence for a person to falsely represent that a design applied to any article or non-physical product disposed of by him or her for value is registered in respect of that article or non-physical product.¹²⁸ Moreover, where the right in a registered design has expired, it is an offence to do any of the following:¹²⁹

- (a) Mark, or cause to be marked, any article to which the design has been applied, with anything implying that the right under the Registered Designs Act is still subsisting.
- (b) Apply, or cause to be applied, to a non-physical product to which the design has been applied, anything to that effect.

¹²³ *ibid* s 36(2).

¹²⁴ *ibid* s 40(1).

¹²⁵ *ibid* s 41(1).

¹²⁶ *ibid* s 42.

¹²⁷ *ibid* s 44.

¹²⁸ *ibid* s 66(1).

¹²⁹ *ibid* s 66(3).

- (c) Mark, or cause to be marked, any device for projecting a non-physical product (being a non-physical product to which the design has been applied), with anything to that effect.

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