

Changes to Singapore's Intellectual Property Laws, 1st July 2004

Trade Marks

Substantial amendments to the Singapore Trade Marks Act (the "Amendment") will come into force on 1 July 2004. They are largely aimed at fulfilling Singapore's obligations under the United States-Singapore Free Trade Agreement and giving effect to WIPO's Joint Recommendations Concerning the Protection of Well-Known Marks. Important amendments include the following:

1. Definition of "Trade Mark"

By removing the requirement that a mark has to be "visually perceptible", it will be possible to register non-conventional marks like sound marks. However, the requirement that the mark must be "represented graphically" remains and this may pose some practical challenges to trade mark applicants.

2. Priority Claims

Priority may be claimed from an earlier Convention application provided it is the first application in any Convention country for the mark in respect of the goods/services, i.e. no "cascading" of priorities. On the other hand, it will be possible to claim priority from more than one Convention application filed within the preceding 6 months, i.e. "multiple priorities" will be allowed.

3. Date of Registration

The date of a trademark registration will be the date of filing of the application for registration even if there were priority date claims.

4. Late Renewal and Restoration of Registrations

It will be possible to effect renewal of an expired trade mark registration within 6 months of the expiry date. The fee payable for a late application for renewal will be S\$370. If this initial 6-month grace period is missed, a restoration application may be made within the following 6 months.

5. "Well Known" Marks

The Amendment introduced qualifying criteria similar to WIPO's Joint Recommendations for determining if a mark is to be considered a "well known" mark in Singapore. The mark need only be shown to be well known to a "relevant sector of the public". For an action by the owner of a well-known mark, the requirement to show likelihood of confusion on the part of

the public has been removed. A trade mark owner will need to show that use by the third party of an identical or similar mark would indicate a connection between the third party's goods/services and the owner of the well known mark, and such use is likely to damage the interests of the owner.

Further, apart from the ability to restrain use/registration of an identical or similar mark in relation to goods/services, the Amendment allows the owner of a well known mark to restrain a third party's use of a "business identifier", being defined as "any sign capable of being represented graphically which is used to identify any business".

6. "Dilution"

If a mark is well known to the public at large (as opposed to being well known only to a relevant sector of the public), even greater protection will be enjoyed by the owner. The owner of such a mark would be able to restrain a third party's use which would "cause dilution in an unfair manner" or "take unfair advantage" of the distinctive character of the trade mark.

7. "Counterfeit Goods", "Statutory Damages" and Enforcement Measures

The new category of "counterfeit goods" is introduced by the Amendment for which the trade mark owner may elect to be awarded "statutory damages" (maximum limits prescribed) rather than to furnish the Court with details and evidence for assessment of actual damages and/or accounts of profits.

Furthermore, the Amendment empowers any police officer to arrest without warrant any person in a public place who sells or offers or exposes for sale counterfeit goods or is in possession of such goods for trade or manufacture. An authorized officer may without warrant stop and search any conveyance which he reasonably suspects to contain counterfeit goods and seize such goods and/or relevant evidence. An Order of Court for Search and Seizure may be obtained even before instituting proceedings and the items to be seized may be identified only in general categories rather than individually.

8. Enhanced Border Measures

As for border enforcement measures, an owner/licensee of a registered trade mark need only provide "sufficient information" to Customs (e.g. an estimated time of arrival at an expected location as opposed to a specific time and place). The Amendment confers new powers on an authorized officer to examine goods in transit which he reasonably suspects are counterfeit goods.