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Intellectual Property Office of Singapore
51 Bras Basah Road
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Singapore 189554

BY EMAIL
Daren TANG@ipos.gov.sg
& POST

Attention: Mr Daren Tang

Dear Sirs

PUBLIC CONSULTATION ON PROPOSED CHANGES TO SINGAPORE'S REGISTERED DESIGNS REGIME

We refer to your email of 13 October 2015 inviting feedback from the Law Society in relation to the review of the registered designs regime and the preliminary proposals by IPOS in its consultation paper titled "Public Consultation on Proposed Changes to Singapore's Registered Designs Regime".

2 The consultation paper was referred to the Intellectual Property Practice Committee ("the Committee") for feedback. The views of the Committee are set out in Annex A for your consideration.

3 The Council of the Law Society has considered the feedback provided and shares the views of the Committee.

4 We thank you for inviting the Law Society to participate in this consultation and look forward to an update in due course.

Yours faithfully

Delphine Loo Tan
Director (HOD), Representation and Law Reform Department

Encl.

CC: (1) Council 2015
(2) Intellectual Property Practice Committee 2015

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ANNEX A

VIEWS OF THE INTELLECTUAL PROPERTY PRACTICE COMMITTEE

Proposal No.	Issues Raised for Public Consultation	Feedback
1	Definition of "Design" and "Article"	<p>The Committee is agreeable to the removal of the requirement for the design to be "applied by an industrial process", the replacement of the word "article" with "product", and to remove the requirement that it be "of manufacture".</p> <p>The Committee is of the view that the definition of "design" should be similar to the definition in the UK or the EU, namely, "the appearance of the whole or a part of a product resulting from the features of, in particular, the lines, contours, colours, shape, texture and/or materials of the product and/or its ornamentation".</p> <p>The Committee is of the view that the definition of "product" should be similar to the definition in the UK or the EU, namely, "any industrial or handicraft item other than a computer program; and, in particular, includes packaging, get-up, graphic symbols, typographic type-faces and parts intended to be assembled into a complex product".</p>
2	"Experimental" designs	Agree.
3	"Dynamic" designs	Agree. However, the Committee of the view that graphic user interfaces (GUIs) which are also dynamic in nature should continue to be protected under the RDA. We note that the IPOS has in Practice Direction No. 4 of 2014 recognised and acknowledged that GUIs may be protected under the Registered Designs Act ("RDA").
4	"Virtual"/"Protected" designs	The Committee agrees in principle to the proposed amendment, as long as the "virtual" designs to be protected retain the same (or substantially similar) design features irrespective of the medium they are projected on.
5	3D Printing	Agree.
6	Partial Designs	<p>Partial designs should become registrable for the following reasons:</p> <ul style="list-style-type: none"> • As modular and interchangeable goods are becoming more common, registration of partial designs would be useful for designers of such goods; • Partial designs are already being registered in a way, the parts to be protected being denoted by solid lines, and the other parts not being protected by dotted lines <p>The benefits from protecting partial designs are likely to exceed the detriment. As designing a part of a product can involve significant amount of effort, protection should be given if such parts are sufficiently distinctive and novel.</p>
7	Protection of Colours	The Committee agrees in principle to expressly allow colour to be specified in the application for a design as one feature of a novel design, but design protection should not be extended to colour <i>per se</i> .
8	Unregistered design rights	The Committee is of the view that the creation of an unregistered design right would be welcome by companies in industries with

		<p>fast moving product cycles and large variety of designs (such as the fashion industry), where it may not be practicable to seek registration over every design that is produced, especially in cases where the usable lifespan of the product is short. Nevertheless, such designs are still valuable intellectual property and deserve protection from copycats. The onus of having to prove copying is no more onerous than in the case of having to establish copyright protection.</p> <p>There is a need to plug the gap caused by Section 74 of the Copyright Act, where unregistered designs that have been industrially applied are not protected by both the copyright and registered designs regime. However, if dual protection under the registered design regime and copyright regime is being considered, there may be an opportunity to include unregistered designs as part of that dual regime instead of introducing it as a new and separate right.</p>
9	Interface with Copyright	<p>9(i) The interplay between design and copyright protection affects many clients as not many designers in Singapore register their designs. Under the current regime, their designs will not be protected if they do not do so.</p> <p>The provisions relating to the interface between design and copyright protection was initially intended to prevent rights owners from circumventing the need to register a design by solely relying on copyright protection. However, this has caused significant problems to copyright owners whose works are increasingly being licensed for application to a wide a variety of products. As such, the provisions to the overlap should be carefully examined.</p> <p>9(ii) The Committee is of the view that the “50-articles/products” threshold should be removed. It no longer seems meaningful to peg “industrial application” to an arbitrary number. In particular, if the categories of designs are expanded, it may not be feasible for this requirement to apply to all categories (e.g. computer icons, computer game screenshots). Consideration should be given to fostering the creative economy, and not to exclude categories of products that would otherwise not receive protection in the absence of an unregistered design right, e.g. the fashion, cottage and handicraft industries.</p> <p>In place of a test based on a fixed number (a quantitative test), the Committee suggests that a qualitative test as to whether an article is industrially applied be implemented. The qualitative test may include the following factors:</p> <ul style="list-style-type: none"> • Intention of the maker of the article/product; • How the article/product is sold in the particular market or industry
10	Interface with Trade Marks	Agree.
11	Substantive	11(i) Agree.

	Examination	<p>11(ii) The Committee does not see the need or value in having the IPOS provide non-binding opinions on whether a registered design is being infringed and/or on the validity of a registered design, based on documents or “evidence” submitted by a user of such service. The “evidence” presented to the IPOS may be self-serving and the IPOS might render an opinion based on a one-sided, biased account without considering the views or evidence that may be furnished by the other party.</p> <p>Such opinion would also be superfluous given that the Court or the hearing officer of the IPOS in an infringement or revocation hearing would not be bound by it. The Court or hearing officer would have the benefit of considering the arguments, evidence and submissions tendered by both parties, and make a decision based on the totality of the evidence presented at the hearing.</p> <p>11(iii) The Committee does not agree that the Registrar should be granted ex-officio powers to revoke a registered design. Such powers would go against the principles of natural justice and create uncertainty in the validity of a registered design right. Any interested party who wishes to challenge the validity of a registered design may apply for its revocation under Section 27 of the Registered Designs Act. We are strongly of the view that a registered design should only be revoked after both the applicant and registered proprietor have been given an opportunity to be heard.</p>
12	Term of Design Protection	Agree.
13	Grace Period	Agree.
14	Deferred Publication	Agree.
15	Filing of Multiple Designs in One Application	<p>The Committee is of the view that the filing of multiple designs within a single design application will make design filings administratively easier for design owners. The option would be of greater attractiveness if the filing of multi-design applications can be made at a reduced fee, as compared to the filing of separate applications for each of the individual designs.</p> <p>Similarly, the option for divisional applications and permitting designs not encountering objections to proceed with the application process will expedite the application process and likewise render the design registration regime more attractive to business owners, especially small and medium-sized businesses.</p>
16	Renewal	Agree.
17	Infringement and Enforcement	No comments.
18	Utility Model Protection	The Committee agrees given the constraints of our local context (i.e. due to our small size and the lack of a large manufacturing base). However, from an economic policy perspective and as Singapore continues to aspire to be the ASEAN/Asian Regional IP Hub, the IPOS may want to consider implementing utility model protection, given that many of our ASEAN/Asian neighbours such

		as Malaysia, Thailand and Indonesia, etc, have provisions for the protection of Utility Models, and it is possible that they may want to seek and obtain similar protection in the other countries of the ASEAN/Asian region.
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