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Our Ref: LS/RLR/Committees/IPPC/2020/IPOS/TL/jc/lf

14 September 2020

Intellectual Property Office of Singapore
1 Paya Lebar Link, #11-03
PLQ 1, Paya Lebar Quarter
Singapore 408533

BY EMAIL
IPOS_Consultation@ipos.gov.sg

Dear Sirs,

Public Consultation on the Changes to Simplify Intellectual Property Processes and Improve User Experience with Digital Initiatives

1. We refer to the Intellectual Property Office of Singapore's public consultation on the Changes to Simplify Intellectual Property Processes and Improve User Experience with Digital Initiatives ("the Consultation").
2. The Law Society of Singapore's Intellectual Property Practice Committee 2020 has considered the Consultation paper and prepared the enclosed submission in response. The submission is supported by the Council of the Law Society of Singapore.
3. If you have any questions or require further assistance on the matter, please contact Ms Ting Lim, Manager of the Representation and Law Reform Department by email at huiting@lawsoc.org.sg.
4. Thank you.

Yours sincerely,

Jonathan Foong
Chairperson, Intellectual Property Practice Committee

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The Law Society of Singapore’s Intellectual Property Practice Committee’s response to the Intellectual Property Office of Singapore’s public consultation on Changes to Simplify Intellectual Property Processes and Improve User Experience with Digital Initiatives (“Consultation Paper”)

Preamble

The Law Society of Singapore’s Intellectual Property Practice Committee supports the Intellectual Property Office of Singapore’s (“IPOS”) approach to simplify and streamline intellectual property processes and improve user experience with digital initiatives. This is in line with IPOS’ continuous effort to design and administer a top-class IP regime in Singapore.

We have limited our comments (set out below) to specific areas or details of the Consultation Paper.

We have adopted the numbering set out in the Consultation Paper. The first column is the serial number while the second column sets out the questions posed. Our comments and feedback to the relevant questions are set out in column 3. Where the questions or issues posed in the Consultation Paper are not found in the table below, we are either in accord with IPOS or do not have any comments to these questions.

Please do not hesitate to contact us if you require any further information or clarification on our feedback.

S/N	Consultation Paper ¹ (Questions)	Comments
A: SIMPLIFYING AND STREAMLINING PATENTS PROCESSES		
1.	<p><u>Question A1</u></p> <p>a) Are you supportive of this proposed process? Please elaborate with reason(s).</p>	<p>Patents</p> <p>We are supportive of this additional process of an invitation to submit response/amendments to be issued by the Examiner, resulting from informal communications. This is however assuming that:</p> <ol style="list-style-type: none"> 1. The objective and scope of such response/amendments are only for clarification purposes and for minor amendments to be made. It should not be for the purposes of overcoming substantive objections such as novelty,

¹ “Public Consultation on Changes to Simplify Intellectual Property Processes and Improve User Experience with Digital Initiatives, dated 17 August 2020, Accessible at <https://www.ipos.gov.sg/docs/default-source/resources-library/ipos-public-consultation-august-2020.pdf>

	<p>b) If supportive, is 2 months a reasonable period for an applicant to submit the response following an examiner-initiated informal communication? If no, please provide a period and provide us with the rationale.</p>	<p>inventive step etc., which would require more time.</p> <ol style="list-style-type: none"> 2. Since the issues to be resolved are merely minor and non-substantive, after the response/amendments are filed and such issues are resolved, the next action should be the issuance of a positive Examination Report. 3. If the issues are still not resolved after filing of such response/amendments, the Examiner should then issue a Written Opinion. <p>Assuming our above understanding is correct, we believe 2 months would be a reasonable period for applicants to file their response/amendments.</p> <p>We would however raise the following question: What is the effect if the applicant does not file the response/amendments within the 2-month non-extendable period? Our view is that in such an event, the Examiner should still issue a Written Opinion.</p> <p>Whilst we are supportive of the proposed invitation to submit the response/amendments, we do not support reducing the response time for Written Opinions from 5 months. We are of the view that applicants should still be given 5 months to respond to Written Opinions.</p>
<p>2.</p>	<p><u>Question A2</u></p> <p>a) Are you supportive of this proposed change? Please elaborate with reason(s).</p>	<p>Patents</p> <p>We are not supportive of this proposed change.</p> <p>Even when an applicant files amendments with the examination review request, we believe the Examiner should make reference</p>

	<p>b) What are your considerations when deciding if you wish to submit amendments and written submissions or only written submissions during the examination review stage?</p> <p>c) Based on the current examination review process, where an applicant files written submissions and amendments during the request for an examination review, it is apparent that the applicant intends to amend the application to overcome the objections in the earlier examination report. While the examiner has to provide an opinion on whether he agrees/disagrees with the earlier examination report during the examination review,</p>	<p>to the earlier examination report, since such amendments may be made in response to the previous Examiner's objections raised in the earlier examination report. The Examiner reviewing the request should have a holistic assessment of the invention/application having regard to the objections/issues raised by the previous Examiner in the earlier examination report. The official fees payable in requesting for an examination review are high. Hence, the application should be subject to a full review by the Examiner.</p> <p>The applicant's considerations in deciding whether to file amendments and written submissions or only written submissions would include whether the amendments will result in overcoming the objections raised, and whether such amendments are absolutely necessary in light of the Examiner's objections in the earlier examination report (if the applicant is of the view that the previous Examiner may not have interpreted/understood the invention correctly).</p> <p>Given that the current examination review process is a final opportunity for the applicant to convince the Examiner that the invention is patentable, the applicant is likely to file amendments since there would be no further opportunity to do so if the Examiner does not accept the further arguments filed. This is because it is highly likely that, in response to the objections raised in the earlier examination report, the applicant would have had submitted arguments but such arguments did not overcome the objections raised. For the review request, the applicant would thus file amendments together with arguments, even though it may not necessarily be the applicant's intention to amend the application</p>
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	<p>what are the applicant's reason(s) for seeking this opinion?</p>	<p>(which may narrow the scope of protection or change it altogether).</p> <p>The applicant's reason for seeking the Examiner's opinion on whether he agrees/disagrees with the earlier examination report during the examination review, is also to provide/allow for some introspection on the part of the Examiner, and for him to review if the previous Examiner's objections raised in the earlier examination report or the maintenance of such objections were well-grounded.</p>
<p>3.</p>	<p><u>Question A3</u></p> <p>a) Are you supportive of this proposed change? Please elaborate with reason(s).</p> <p>b) If supportive, how do you think the process can be further simplified?</p>	<p>Patents</p> <p>Whilst we agree that integrating PF37 and PF38 would simplify processes, we believe applicants should be given the option to elect publication in the form, especially if there is a difference in the official fees payable.</p> <p>Some applicants may prefer not to have the English translation published at the earliest opportunity, perhaps for commercial or strategic reasons, and for such applicants, they should still have the option to file PF38 at a later stage.</p> <p>We thus propose that, in the event PF37 is to be amended to include the request for publication of English translation, such publication request should be an option for the applicant to elect and it should not be an automatic request for publication. PF38 should still be retained, for applicants who choose to publish their English translation later.</p>
<p>B: SIMPLIFYING AND STREAMLINING TRADE MARKS PROCESSES</p>		
<p>4.</p>	<p><u>Question B1</u></p>	<p>Trade Marks</p>

	<p>a) Do you agree with the adoption of the “partial refusal” mechanism for the national Trade Mark regime? Please elaborate with reason(s).</p> <p>b) What is/are the key priority you consider in the course of Trade Mark registration? (e.g., speed, cost, specificity in relation to objectionable goods and/or services, clarity in examination decisions)</p>	<p>We agree with the adoption of the “partial refusal” mechanism for the national Trade Mark regime. This allows the applicant the option to take no further action and yet maintain the trade mark application which is important to them. It also provides a cost-efficient method for applicants to address objections raised by IPOS. This is especially so when the objections are fairly minor (e.g. IPOS objects to a single specification). In such cases, applicants often complain that they have to incur fees in responding to these objections.</p> <p>Another situation is where the applicant files several trade mark applications with the same set of specifications, and the same minor objection is raised by IPOS in respect of all the applications. In such cases, responding to each of the objections can increase the overall cost of trade mark registration significantly.</p> <p>Furthermore, this mechanism also keeps the examination of national applications consistent with the current practice for international registrations designating Singapore, where the applicants do not stand to lose their application just because they did not address certain minor specification objections. The description in objection is simply removed from the specification and the rest of the application proceeds to the next stage.</p> <p>We prioritise cost, clarity in examination decisions and speed in the course of Trade Mark registration. It is also important for the applicant to overcome the objections and proceed to the acceptance/advertisement stages.</p>
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	<p>c) If you have a partially refused application, will you be more inclined to (i) proceed with an amendment as proposed by the Registrar; (ii) initiate an amendment form (and relevant fee) to remove the objectionable goods and/or services; or (iii) wait for the stipulated deadline to lapse and automatically proceed to the next stage? Please provide reason(s) for your option.</p> <p>d) If objectionable goods and/or services are stated upfront in the examination report in a partially refused application, will you be more inclined to divide out the objectionable portion(s) of the application? Please provide reason(s) for doing/not doing so.</p>	<p>It depends on the objections raised by IPOS and the specific circumstances of the trade mark applicant.</p> <p>Most applicants may prefer to wait for the stipulated deadlines to lapse as this is the most cost-efficient option provided that the following factors apply:</p> <p>(i) the objections are fairly minor;</p> <p>(ii) the specifications objected to are not particularly important to the applicant (e.g. the specifications objected to can be deleted, as there are other specifications which overlap with these specifications);</p> <p>(iii) the client does not have a substantial budget for the trade mark application; and</p> <p>(iv) there is no particular urgency for their trade mark to be registered.</p> <p>Alternatively, if the objection is directed to a fairly unimportant part of the specification, applicants may choose to agree to the amendment suggested by the examiner and pay the amendment fee.</p> <p>If the above factors are present, most applicants may prefer to wait for the stipulated deadlines to lapse rather than dividing out the objectionable portion(s) of the application as the latter would incur additional costs and fees for the applicants.</p>
<p>5.</p>	<p><u>Question B2</u></p> <p>a) Do you generally vary the use of your Trade Marks (such as</p>	<p>Trade Marks</p> <p>Many applicants do vary the use of their trade marks in terms of colour, capitalisation or</p>

	<p>differences in colour, capitalisation, or positioning of elements) in the course of trade? If so, how?</p> <p>b) Are you supportive of the proposals to limit the maximum number and/or type of marks that can be filed in a single application? Please elaborate with reason(s).</p>	<p>positioning of elements in their trade marks when submitting a series mark application. From experience, this is especially so in industries which are perceived to be more creative (e.g. visual arts, advertising, design and online games). There are many applicants who have also hired professional designers to design their logo, and these designers will often create multiple variations of the logo to be used in different settings (e.g. print, website, dark background, light background, black and white version, greyscale).</p> <p>As long as there are no major variations or substantial differences in the material elements of the marks, such trade marks should form a series mark application. We are in favour of series marks applications (provided the marks meet the required criteria) as this is a great way to protect the applicant's rights in differing formats of essentially the same trade mark.</p> <p>We are not supportive of this proposal. While admittedly rare, there are instances where applicants file more than 4 marks in a series of marks. Limiting the number of marks in a series to 4 would prevent these applicants from taking full advantage of the series marks regime. For example, there are several colour combinations an applicant could claim for the same mark. It seems overly harsh to limit the applicant to only 4 specific chosen ones when they have the right to claim all colour combinations.</p> <p>For foreign applicants from jurisdictions that do not recognise the concept of a series of marks, being able to file for a series of marks is often an incentive to seek trade mark protection in Singapore as well, and limiting the series</p>
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	<p>c) Which part of the Trade Marks Registry’s Work Manual Chapter on “Series of Marks” do you find most useful and relevant for reference? Which part(s) do you find the most complex? Do you have any suggestion(s) on how the Chapter can be improved to better the understanding of the requirements for series marks?</p>	<p>marks regime would discourage some of these foreign applicants from filing in Singapore.</p> <p>To address IPOS’ concern that there are applicants who attempt to file marks that do not constitute a series of marks, IPOS might consider prompting applicants who file series marks to read the Trade Marks Registry’s Work Manual Chapter on “Series of Marks”. This could be done in the form of a pop-up or alert that triggers when an applicant clicks the series mark option on Form TM4. Another pop-up or alert could also trigger if the applicant attempts to file more than 4 marks in a series of marks.</p> <p>Paragraph 4, which contains a list of examples of marks which will be accepted/will not be accepted as a series of marks. The illustrations of what trade mark combination qualifies as a proper series is helpful and we often refer clients to this resource just to enhance their understanding. In general, some of our members would not file an application for a series of marks unless it falls under one of the acceptable categories listed in this paragraph.</p> <p>We recommend giving even more examples on the acceptable and unacceptable categories listed in Paragraph 4 as most applicants may not pay much attention to the rest of the Chapter.</p> <p>Moreover, the Chapter could contain references to more complex cases which IPOS has encountered i.e. borderline cases where the marks may be perceived as a proper series but it was decided that the marks</p>
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		<p>did not meet the criteria for a proper series. This would be helpful in creating better understanding. Furthermore, case references where the applicant argued successfully to demonstrate how their trade marks formed a proper series would be useful. This helps in the education of the public in the long run.</p>
<p>C: SIMPLIFYING AND STREAMLINING COMMON PROCESSES</p>		
<p>6.</p>	<p><u>Question C1</u></p> <p>a) Are you supportive of the proposed changes? Please elaborate with reason(s).</p>	<p>Trade Marks</p> <p>We are not supportive of the proposed changes as they would complicate procedures greatly.</p> <p>For one thing, IPOS should assess the % of “treated as withdrawn” applications which are then reinstated. The proportion of “treated as withdrawn” applications which remain withdrawn to those reinstated must be reviewed, especially in the context of citations under Section 8 of the Trade Marks Act.</p> <p>If only a small % is reinstated, bringing in the “continued processing” measure would result in more uncertainty to the new applicant whose trade mark faces a citation of mark which is technically treated as withdrawn. The current regime is fair to the new applicant. Under the “continued processing” measure, there is less certainty and if the cited mark owner is allowed to continue applying for extensions via Form CM13 for further processing of his/her application, this can also be used as a measure to frustrate the new applicant.</p> <p>Registered Designs</p> <p>We are supportive of the proposed changes. The current period of 6 months to reinstate, via</p>

	<p>b) Would you have any refinements to the proposed changes? If yes, please elaborate.</p>	<p>Form CM13, an application for the registration of design that is treated as withdrawn is unnecessarily long. However, we do not consider the risk of registering two identical designs to be lessened with the shorter period for reinstatement. This is because the examination of designs for registration is one of formalities only.</p> <p>Trade Marks/Registered Designs</p> <p>We do not have any refinements to the proposed changes.</p>
<p>7.</p>	<p><u>Question C2</u></p> <p>a) Do you agree that the proposed corrections relating to priority details and name of applicant which result in a change in IP ownership should be advertised? Please elaborate with reason(s).</p> <p>b) Are there any other proposed corrections that you think should be advertised? Please elaborate with reason(s).</p> <p>c) Is 2 months a reasonable period for advertisement? If no, please propose a period and provide us with a rationale.</p>	<p>Registered Designs</p> <p>Given that there are currently no provisions for the Registrar to advertise an application for opposition, the advertisement of such corrections serves no purpose. Therefore, we do not think that there is a necessity for doing so.</p> <p>Moreover, we opine that the publication of corrections may not be appropriate. The current law allows for deferred publication of a registration for 18 months. There is the added danger that IPOS may inadvertently publish a correction and affect the novelty of the design in applications in other parts of the world.</p> <p>As mentioned above, we do not think that the proposed corrections should be advertised.</p> <p>N.A.</p>

<p>8.</p>	<p><u>Question C3</u></p> <p>a) Are you supportive of the proposal to streamline the definition of “relevant parties” across the Trade Marks, Registered Designs and Patents legislation? Please elaborate with reason(s).</p> <p>b) Do you have any refinement(s) to the proposed changes? If yes, please elaborate.</p>	<p>Trade Marks</p> <p>We are supportive of this proposal. This seems like a positive step and reduces delay in the recordal process.</p> <p>Registered Designs</p> <p>We do not agree with the proposed change to the definition of “relevant parties” if it will affect the ability of the transferee of ownership, grantees of a security, licensees or beneficiaries of any transfer of title from registering the transfer. This is because they are the parties whose interests will be affected if the transfers are not registered or improperly registered. Very often in such transactions, the assignees, chargees, licensees and other beneficiaries of transfer will take over the duty to register to ensure that their interests are protected.</p> <p>Registered Designs</p> <p>The retention of submission of documentary evidence is preferred. If an application is to be made based solely on declaration, an advisory against mala fide or unverified application should be present on the form to prevent abuse.</p>
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D: IMPROVING USER EXPERIENCE AND SERVICE WITH DIGITAL INITIATIVES

<p>9.</p>	<p><u>Question D1</u></p> <p>a) Are the safeguard measures described in each example above sufficient? If not, what are your concerns, and what other operational and/or legislative safeguard measures would you deem necessary in</p>	<p>Trade Marks</p> <p>The proposed safeguard measures raise a few concerns. We are uncertain whether the proposed AI examination scheme has been tested out and the specific mechanics of the scheme has not been fleshed out. The Public Consultation paper has offered no illustration on the type of trade mark applications which</p>
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	<p>the adoption of decision making by AI?</p> <p>b) While IPOS will carry out due diligence and conduct rigorous testing before rolling out AI solutions, are there other specific areas you think that should be paid attention to? If so, please elaborate on the reasons and also possible measures.</p>	<p>could be examined and accepted or rejected by AI technology. We would be interested to find out more on the method in which the AI arrives at such a decision (e.g. through keyword search equated with goods/services applied to a search engine).</p> <p>We are of the view that AI can never replace human thought process and ability to analyse. Although the examination report may be checked a second time by a human examiner, we opine that the public would be better served by two humans rather than one robot and one human.</p> <p>We are particularly concerned with paragraph 1.10 of the Consultation paper, in which the AI technology used for examination will send a deficiency letter for marks which are not acceptable to the applicant without human review. In such an instance, the applicant would have no choice but to file submissions just to have a human examiner review his/her arguments and consider the same. This would be costly and would delay the examination process significantly.</p> <p>We are of the view that AI cannot cope with the examination of smart or clever marks i.e. trade marks with some clever allusion to the goods/services and yet have that extra distinctiveness to capture the imagination and function as a badge of origin.</p> <p>Human examiners need convincing to look beyond the standard examination criteria. We have doubts and concerns that AI can look at trade marks objectively with care and attention to current trends, lingo, styles and word speak. Moreover, as legal practitioners advocating for our client's trade mark rights, we are concerned with how AI would treat our</p>
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