

Changes to Singapore Trade Marks and Registered Designs Law

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The legislative amendments to the Trade Marks Rules, Trade Marks (International Registration) Rules, Registered Designs Rules and Registered Designs (International Registration) Rules came into effect on 13 November 2014. A brief summary of the changes are as follows:

TRADE MARK

Counter-statement in invalidation proceedings

Previously there was no detrimental effects to non-filing of counter-statements in invalidation proceedings. The registered proprietor will now be required to file a counter statement (within 2 months and extendible to a maximum of 4 months) as otherwise the application for declaration of invalidity will be granted. This new procedure will ensure that registered proprietors participate in the invalidation proceedings to demonstrate their genuine interest in their trade mark registration.

Revocation due to non-use

In the past, it was mandatory for the applicant for revocation and the registered proprietor to file evidence after close of pleadings in revocation proceedings on grounds of non-use. Now the only compulsory evidence is that filed by the registered proprietor with the counter-statement. It is not mandatory to file evidence in the evidential rounds after the counter-statement is filed as the burden of proof lies on the registered proprietor.

Extensions of time

For non-dispute resolution deadlines, only the first two requests for obtaining an extension of time are free of official fees; the third and subsequent requests will now entail payment of official fees. In the past, there was no requirement for official fees to be paid for obtaining an extension of time for non-dispute resolution related deadlines. The imposition of the official fee will also encourage a more expeditious trade mark prosecution process. Each request for extension will extend the deadline for three (3) months if allowed.

DESIGN

Deferment of publication

Deferment of publication will be provided for design applications in Singapore. The Registered Designs Rules will be amended to enable an applicant to defer the publication of a registered design up to 18 months. The request for deferment will have to be made when applying for the registration of the design and the period of deferment will have to be specified on the application form. A request for deferment of publication after the date of filing the application will not be allowed.

Restoration of registration

Previously, late renewals were allowed to be filed within a six (6) month grace period after the renewal due date. The design lapsed if no renewal was carried out during the grace

period and there was no provision for reinstatement. To provide relief measures to the registered design owner whose registered design has lapsed, the Registered Designs Rules has been amended to provide for restoration of a registered design which has been removed from the Register within six (6) months from the date of the removal of the design from the Register. Thus there is a total of twelve (12) months [grace period of six (6) months plus another restoration period of six (6) months] to renew the design.

IP2SG SYSTEM (PHASE II)

The Intellectual Property Office of Singapore (IPOS) has extended the integrated electronic services portal, IP2SG System (Phase II) to allow for the filing of trade mark and registered design applications on a unified platform together with patent filings. Certain common official forms have been introduced to streamline the filing process across Registries and thereby provide a more consistent user interface. The legislative amendments consolidate and give effect to the necessary procedural changes required to be adopted under the new e-services platform along with changes to some processes, forms and fees.

This is only a brief summary of the legislative changes to the Singapore Trade Marks and Registered Designs law and is not intended to constitute legal advice.