

IP GUIDE – SINGAPORE

1. Introduction about the Globalaw firm

With more than 20 years in the legal industry and a firm-wide combined legal expertise of more than 200 years, Goodwins Law Corporation is regarded as a well-established and respected firm amongst its peers, both locally and internationally. As a commercially-minded firm, we understand and appreciate the realities in the commercial world as well as focus on the things that matter to our clients, which is clearly reflected in our firm's culture of Client Care and Quality Control.

Apart from intellectual property, other niche areas of the law which we support include: -

- FinTech, IoT and Artificial Intelligence
- Blockchain and Cryptocurrency
- eCommerce Law and ICT
- Insurance and Financial Services
- Capital Markets
- Estate, Trusts and Family Offices
- Incorporation of Entities and Corporate Secretarial Support
- Corporate and Commercial Work
- Litigation; and
- Real Estate.

2. Rights conferred by trademark registration and effect of non-registration

In principle, a trademark registration will confer an exclusive right to the use of the registered trademark. This means that the owners of a registered trademark may license or sell it to third parties and raise equity for business undertakings.

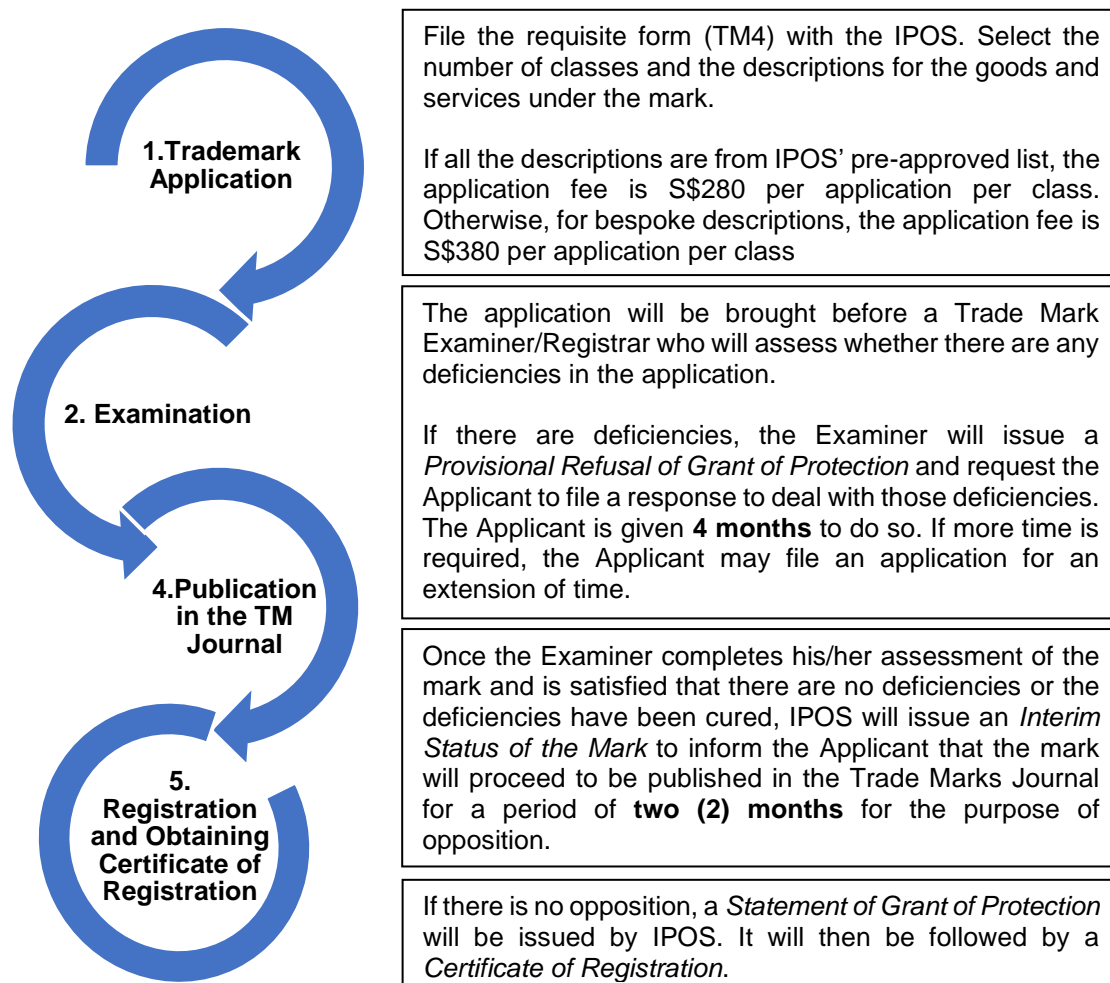
Further, registration also provides a signal to other proprietors through the use of the ® that the mark is protected under the Trade Marks Act (1998) providing legal certainty to the owner of the mark.

3. Pre-filing clearance searches

The Intellectual Property Office of Singapore (“**IPOS**”) registers and is responsible for the administration of IP rights in Singapore.

An Applicant may use IPOS' Digital Hub's search engine to conduct pre-filing clearance searches.

4. Registration procedure and timelines



Note: If the application does not contain any deficiencies or face objections/opposition, it may take about **12 months** for a trademark to be registered.

(For opposition proceedings see Paragraph 13 below)

5. Validity of trademark under any international treaty(ies)

The Trademark Law Treaty (1994) standardises the duration of protection after registration and duration of each renewal to 10 years each. Singapore is not a contracting party to the Treaty but under Singapore's Trade Marks Act 1998 a registered trade mark is protected for a period of 10 years from the date of filing.

Example

Filing date: 12th November 2022

Certificate of Registration issue date: 8th September 2023

Renewal Date: 12th November 2032

6. System of classification

As Singapore is a contracting party to the Nice Agreement, which established the Nice Classification of good and services for the purposes of registering trademarks, there are in total 45 classes, with classes 1-34 for goods and classes 35 to 45 for services.

7. Information and documents required for trademark registration

Generally, the only document required if an Applicant desires to trade mark a composite mark is an image of the mark in jpg, jpeg, png, gif, tif, tiff or bmp format. The image should not exceed 2 MB.

Below is some common information required as part of the registration: -

- a) applicant's particulars (if the applicant is a company, the particulars of the company e.g., address and registration number);
- b) whether there is a colour claim;
- c) the number of marks if the applicant decides to file a series application;
- d) the number classes under the Nice Classification; and
- e) description of the goods and services under those classes.

8. Examination of trademark application

We briefly outline the main factors Trade Mark Examiners consider when assessing the registrability of a mark.

Pursuant to Section 2(1) of the Trade Marks Act (1998), a "trade mark" means: any sign capable of being represented graphically and which is capable of distinguishing goods or services dealt with or provided in the course of trade by a person from those provided by another person.

There are 3 elements constituting a trade mark:-

- a) Sign
Pursuant to Section 2(1) of the Act, a "sign" means "any letter, word, name, signature, numeral, device, brand, heading label, ticket, shape, colour, aspect of packaging or any combination thereof.
- b) Capable of being represented graphically
For a sign to be capable of being represented graphically, seven requirements under the *Sieckmann* Criteria must be satisfied; it must be "clear, precise, self-contained, easily accessible, intelligent, durable and objective".
- c) Capable of distinguishing goods and services
"...If the mark is so descriptive of almost every characteristic of the good so as to be synonymous with the particular good itself, it will have no capacity to distinguish in all respects..." (*Love & Co Pte Ltd v The Carat Club Pte Ltd* [2009] 1 SLR(R) 561 at [39])

A mark that is descriptive will be barred from registration. A closely related concept is whether the mark is distinctive. Generally, the more descriptive the mark, the less distinctive it will be.

There are two kinds of distinctiveness – inherent and *de facto*.

The determination of whether a mark is inherently distinctive will depend on whether the mark possesses distinctive features or characteristics that are adequately unique.

Some marks, though not distinctive, may be registrable if they can be shown that they had acquired *de facto* distinctiveness before the date of the application for registration.

The inquiry for acquired distinctiveness is a question of fact. An inexhaustive list of factors include: - market share held by the mark, nature of the use of the mark, amount invested in promoting the mark, the proportion of the relevant class of persons who identified goods or services sold under the mark as emanating from a particular source seen through market surveys etc.

In addition to the above, the mark to be registered must not conflict with an earlier trade mark. Conflict will generally arise when the two marks are identical or similar, causing confusion to the public.

The likelihood of confusion will be presumed if the marks are identical and the goods/services in question are also identical.

9. Publication of trademark

IPOS frequently publishes the Journals on a weekly basis. If the Examiner is satisfied with the application or the response to the *Provisional Refusal of Protection*, the mark will then be published in the Singapore's Trade Marks Journal for opposition purposes.

10. Issuance of registration certificate

IPOS does not issue a hardcopy of the Certificate. A softcopy will be sent to the Applicant or his appointed agent.

If required, a certified copy of the Certificate may be requested for in writing with the payment of S\$12.

11. Advantages of obtaining trademark registration

See discussion in Paragraph 2 above.

12. Term of trademark registration

See discussion in Paragraph 5 above.

13. Opposition proceedings

Though the Examiner may regard the Applicant's mark as being dissimilar to a registered mark, the registered proprietor may still take a different view and oppose the registration once the mark is published.

A registered trade mark proprietor may oppose the registration by raising either of the following grounds:-

- a) the proposed mark is identical with an earlier trade mark and is to be registered for goods and services similar to those for which the earlier trade mark is protected; or
- b) the proposed mark is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected.

Within two (2) months of the filing of a Notice of Opposition (TM11) by the registered proprietor, a counter-statement (HC3) must be filed. Thereafter, the court will arrange for parties to attend case management conferences in order to give directions and timelines in relation to filing of statutory declarations and evidence.

In addition, at the case conference, the court will request parties to consider mediation at WIPO Arbitration and Mediation Center, Singapore Mediation Centre or Singapore International Mediation Centre.

14. Requirement of use subsequent to grant of trademark registration

Though there is no legal requirement to file a declaration showing use subsequent to the grant, a trade mark proprietor should begin using the mark and keeping records of such use as other trade mark applicants may bring proceedings to revoke the registration on the ground of non-use within 5 years from the date of completion of the registration process.

(For more on Revocation refer to Paragraph 15 below.)

15. Grounds for cancellation of registered trademark

Should a mark no longer be in used or the proprietor no longer offers that good or service in connection with the mark, he may make an application to completely cancel the mark or partially cancel the mark by removing the relevant description of goods or services.

In Singapore, a mark may also be vulnerable to being revoked or expunged from the Register.

Revocation – The initial registration may be valid, but the mark should no longer remain on the register because of the following reasons: -

- a) non-use within 5 years from the date of completion of the registration process
- b) non-use for an uninterrupted period of 5 years
- c) the registered trade mark has become a generic name; and
- d) the registered trade mark has become liable to mislead the public.

Expungement or Invalidation – Expungement involves applying for a declaration that the initial registration was invalid on the grounds that there was a breach of registration criteria, fraud or misrepresentation.

16. Grounds for initiating a legal action for infringement of trademark

Apart from initiating a legal action for infringement on the basis of the Applicant's mark being identical/similar with a registered mark resulting in the likelihood of confusion to relevant sector of the public, a registered trade mark proprietor may institute proceedings on the ground of passing off or parallel imports. (See paragraphs 17 and 19 for more information.)

It should be noted, however, that the registered proprietor must ensure that they have strong grounds to threaten another with proceedings, if not the opposing party may commence proceedings on the basis of groundless threats.

In the case of groundless threats, the Singapore courts have the power to provide any of the following relief: -

- a) a declaration that the threats are unjustifiable;
- b) an injunction against the continuance of the threats;
- c) damages in respect of any loss he has sustained by the threats

17. Passing off or equivalent remedy for unregistered trademarks

At common law, it is an actionable wrong for a defendant to represent or "pass off", for trading purposes, that his goods are those of another, or his business is that of another.

It is important to bear in mind that the tort of passing off runs parallel with protection afforded under the TMA. This means that a registered trade mark proprietor may bring a claim under passing off and TMA. However, if the mark is unregistered, generally, the proprietor can only bring a claim under passing off unless he can show that it is a well-known trade mark.

In an action for passing off, the trader must prove that: - a) there is goodwill attached to his business b) there was misrepresentation as to origin of goods or services leading to confusion amongst the public and c) there was damage to the goodwill of the business as a result of the passing off.

The range of remedies available to a successful plaintiff in an action for passing off includes an injunction, damages or account of profits.

18. Available remedies in a trademark enforcement proceeding

In civil proceedings relating to an infringement of a registered trade mark, the court has powers to order an injunction, either damages or an account of profits, an order for delivery up and /or disposal of infringing articles.

Concerning damages or an account of profits, the court will require evidence of losses. In this regard, it is expected that a forensic accountant be engaged to prepare a statement of accounts to show the losses suffered by the infringement.

Further, the court can make orders to disclose information and documents relating to the infringing conduct. Based on the court's findings of infringement, the registered owner can also ask e-commerce sites to take down a parallel importer's product listings

Where the infringement involves the use of a counterfeit trade mark, the court may even award statutory damages of up to S\$1 million without proof of actual loss.

19. Right to domain names and remedy for unauthorized registrations

As trademarks are commonly translated into domain names, there is a risk that a third-party with no legitimate rights or interests may abuse the domain names. An example of this is cybersquatting.

In order to win back “stolen” domains, the complainant may bring an administrative action

All registrants in the .aero, .biz, .com, .coop, .info, .museum, .name, .net, and .org top-level domains adhere to the Uniform Domain-Name Dispute-Resolution Policy (“UDRP”).

For .sg domains, registrants adhere to the Singapore Domain Name Dispute Resolution Policy (SDRP), which is modelled after the UDRP. Such administrative action must be initiated with the Singapore Mediation Centre.

In order to succeed in the action, the complainant must establish the following: -

- a) the domain name is identical or confusingly similar to a trade mark or service mark in which the complainant has rights;
- b) the respondent does not have any rights or legitimate interests in the domain name; and
- c) the domain name was registered and is being used in bad faith.

20. Rights conferred by usage of trade names

There are no rights conferred by using trade names in Singapore.

Unless the trade name is well-known to the extent that it can be regarded as an unregistered well-known mark under the Trade Marks Act, there are no other special rights or protection conferred by the Act.

21. Law on parallel imports

The issue concerning parallel imports permeates the entire field of intellectual property law. In the context of trade marks, there is no specific law regulating parallel imports in Singapore. However, should a third party be sued for the unauthorised use of an identical or similar sign, name or logo on a product, a defence known as exhaustion of rights conferred by a registered trade mark can be invoked by the parallel importer to show that the goods put on the market were with the proprietor’s express or implied consent.

It should be noted, however, that this defence only applies if the goods are genuine.

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