



**COUNTRY
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Singapore

INTELLECTUAL PROPERTY

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This country-specific Q&A provides an overview of intellectual property laws and regulations applicable in Singapore.

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SINGAPORE

INTELLECTUAL PROPERTY



1. What different types of intellectual property rights exist to protect: (a) Inventions (e.g. patents, supplementary protection certificates, rights in trade secrets, confidential information and/or know-how); (b) Brands (e.g. trade marks, cause of action in passing off, rights to prevent unfair competition, association marks, certification marks, hallmarks, designations of origin, geographical indications, traditional speciality guarantees); (c) Other creations, technology and proprietary interests (e.g. copyright, design rights, semiconductor topography rights, plant varieties, database rights, rights in trade secrets, confidential information and/or know-how).

The main categories of intellectual property rights in Singapore are:

- Patent rights – to protect inventions that are novel, inventive and industrially applicable;
- Rights in confidential information;
- Industrial design rights – to protect features of shape, configuration, colours, pattern or ornament applied to an article or non-physical product;
- Trade mark rights – to protect indications of trade origin, both registered and unregistered, including collective and certification marks and including through the tort of passing off;
- Rights in geographical indications (“GIs”);
- Copyright – which could subsist in literary, dramatic, musical and artistic works, and ancillary works such as sound recordings, television broadcasts and cinematograph films;
- Rights in layout designs of integrated circuits;
- Plant varieties protection.

2. What is the duration of each of these intellectual property rights? What procedures exist to extend the life of registered rights in appropriate circumstances?

Patents. Up to 20 years from the date of filing, subject to payment of annual renewal fees starting from the end of the fourth year from the date of filing. An application may be made to extend the patent term in exceptional circumstances, for example if there was an unreasonable delay in the grant of the patent, or a delay in the grant of marketing approval for a pharmaceutical product.

Confidential information. Until the information ceases to be confidential.

Industrial designs. Up to 15 years from the date of filing. This is divided into an initial period of 5 years, and two further periods of 5 years each upon application and payment of fees.

Trade marks. Indefinite, subject to payment of renewal fees every 10 years for registered trade marks.

Geographical indications. Indefinite, subject to payment of renewal fees every 10 years for registered GIs.

Copyright. Different durations apply for different types of copyrighted works. Generally for literary, dramatic, musical or artistic works, the life of the author plus 70 years after the end of the calendar year in which the author died.

Layout designs of integrated circuits. 10 years if it is first commercially exploited within 5 years after the calendar year of its creation; otherwise, up to 15 years after the calendar year of its creation.

Plant varieties. Up to 25 years from the date of grant of protection, subject to annual payment of renewal fees.

3. Who is the first owner of each of these intellectual property rights and is this different for rights created in the course of employment or under a commission?

Patents. The inventor, or a person who was entitled to the property in the invention by virtue of any law or an agreement entered into before the invention was made. Inventions created in the course of employment generally belong to the employer, unless otherwise agreed by the parties. There is no special treatment for inventions made under commission.

Confidential information. Generally, the originator of the confidential information.

Industrial designs. The designer. Designs created in the course of employment generally belong to the employer, unless otherwise agreed by the parties. In case of designs generated by computer such that there is no human designer, the person by whom the arrangements necessary for the creation of the design are made is deemed to be the designer.

Trade marks. For registered trade marks, prima facie, the registrant; for unregistered trade marks, the first user in Singapore.

Geographical indications. The entitlement to file for registration of a GI is given to a producer of the relevant goods in the geographical area specified, an association of such producers, or a competent authority having responsibility for the relevant GI.

Copyright. In general, for literary, dramatic, musical and artistic works, the person who created the work (the author) owns the copyright to the work. Content creators are the default copyright owners, including for all types of commissioned content. However, for employee-created content, the employer is the default copyright owner of all types of content created by their employees in the course of their employment.

Layout designs of integrated circuits. The creator of the layout design. Layout designs created in pursuance of a commission are owned by the commissioner, and those created in the course of employment are owned by the employer.

Plant varieties. An application for the grant of protection for a plant variety must be made by the person who bred, or discovered and developed, that variety. Plant varieties bred, or discovered and developed, in the course of employment belong to the employer.

4. Which of the intellectual property rights described above are registered rights?

Rights in patents, industrial designs, trade marks, GIs of certain categories of goods, and plant varieties may be registered.

5. Who can apply for registration of these intellectual property rights and, briefly, what is the procedure for registration?

Generally, the owner of those rights or its successor in title can apply for registration.

Registration procedure for trade marks, GIs and plant varieties follows the basic formula of the filing of an application, the examination of that application by the Registry, and upon acceptance, publication for third parties to raise objections or oppositions. Registration will be granted where no objections or oppositions are sustained.

For patents, applications can be made directly to the Intellectual Property Office of Singapore (IPOS), or through the Patent Cooperation Treaty (PCT) National Phase Entry route.

- In the former, domestic route, an application is filed with IPOS, undergoes a formalities examination before publication, and a substantive examination thereafter.
- In the latter route, a PCT application is filed at the International Bureau of WIPO or IPOS and examined by an International Searching Authority before it is published. The applicant then has to request for entry into National Phase in Singapore, where it will undergo substantive examination.

For both routes, once all issues raised in substantive examination have been resolved, a certificate of grant must be requested to obtain registration.

For industrial design applications, registration is granted after a formalities examination only. Thereafter, the design is published and third parties have the opportunity to contest the registration.

6. How long does the registration procedure usually take?

Patents. At least 12 months, depending on many factors such as the application route selected, type of examination requested and how quickly the applicant files examination requests and responds to patent office

correspondence. The typical time frame is 2 to 4 years. The Intellectual Property Office of Singapore (IPOS) has introduced a pilot programme to accelerate grants of patent applications in all technology fields to just six months, which is touted as the world's fastest application-to-grant process of its kind.

Industrial designs. 4-6 months.

Trade marks. 10-12 months.

Geographical indications. 10-12 months.

Plant varieties. 24-36 months.

7. Do third parties have the right to take part in or comment on the registration process?

Yes, a registration may be disputed, usually through the filing of pre-grant oppositions, post-grant cancellation, invalidation and/or revocation actions. The availability and specific procedures for such actions will depend on the right at issue. Patents and industrial design rights do not allow pre-grant oppositions, but for patents, third parties may submit written observations to the Registrar on the patentability of an invention before the Registrar has issued an examination report in respect of that invention.

8. What (if any) steps can the applicant take if registration is refused?

During the application process, the applicant is given the opportunity to address any grounds for refusal that may be raised by the Registrar. If the Registrar maintains a decision to refuse registration, the applicant can appeal the decision to the High Court.

9. What are the current application and renewal fees for each of these intellectual property rights?

Patents.

- Application fees: S\$170 for a domestic application, \$210 for a national phase application;
- Renewal fees: starts at S\$165 per year for the 5th to 7th years of the patent, and increases every three years up to S\$1,120 for the 20th year of the patent.

Industrial designs.

- Application fees: S\$200 per design;
- Extension fees: S\$220 for the first 5-year period, S\$330 for the second 5-year period.

Trade marks.

- Application fees: S\$380 per class (S\$280 per class if the specifications comply fully with the IPOS list of pre-approved items);
- Renewal fees: S\$440 per class.

Geographical indications.

- Application fees: S\$1,500;
- Renewal fees: S\$940.

Plant varieties.

- Application fees: S\$1,600;
- Annual fees: S\$150.

10. What are the consequences of a failure to pay any renewal fees and what (if any) steps can be taken to remedy a failure to pay renewal fees?

Patents. The patent will cease to have effect. An application to restore the lapsed patent may be made within 6 months with payment of a fee.

Industrial designs. The registration will cease and be removed from the Register. A restoration application may be made within 6 months with payment of a fee.

Trade marks. The registration will be removed from the Register. A restoration application may be made within 6 months with payment of a fee.

Geographical indications. A renewal application may be made up to 6 months after the expiry of the registration with payment of a fee. If this is not done, the GI will be removed from the Register.

Plant varieties. The grant of protection will be cancelled. A request for an extension of time to pay the annual fee must be made before the due date for payment.

11. What are the requirements to assign ownership of each of the intellectual property rights described above?

All registered rights will only be effectively assigned if the assignment is in writing and signed by or on behalf of the assignor. For registered GIs, the assignee must be a person who is also entitled to file for registration of the

GI (see Question 3), and must consent to having the registration transferred to them.

An assignment which is not in writing will constitute an equitable assignment only, until the equitable assignee calls for and obtains a written assignment. An equitable assignee is not entitled to certain rights, for example to bring an action for trade mark or copyright infringement in their own name.

For unregistered rights, there are generally no special requirements except for copyright and layout designs of integrated circuits, for which an assignment must be in writing and signed by or on behalf of the assignor.

12. Is there a requirement to register an assignment of any of these intellectual property rights and, if so, what is the consequence of failing to register?

Recordal of an assignment is not mandatory, but is recommended. For registered rights, until an application is made to record an assignment, it is ineffective against a person acquiring a conflicting interest in that right in ignorance of the transaction. This is not expressly provided for in the legislation for GIs and plant varieties, but will nevertheless still be generally applicable on the basis of equity. For some rights, the assignee will also not be entitled to certain rights or remedies which accrue after the date of the assignment.

13. What are the requirements to licence a third party to use each of the intellectual property rights described above?

A licence of a registered trade mark is not effective unless it is in writing and signed by or on behalf of the licensor. There are no special requirements for the licensing of any of the other intellectual property rights.

14. Is there a requirement to register a licence of any of these intellectual property rights and, if so, what is the consequence of failing to register?

Recordal of a licence is not mandatory, but is recommended. For registered rights, until an application is made to record a licence, it is ineffective against a person acquiring a conflicting interest in that right in ignorance of the licence. For some rights, the licensee will also not be entitled to certain rights or remedies which accrue after the date of the licence.

15. Are exclusive and non-exclusive licensees given different rights in respect of the enforcement of the licensed IP, and if so, how do those rights differ?

Patents. Yes. Exclusive licensees have the same rights as a proprietor to bring proceedings for infringement, while non-exclusive licensees do not.

Confidential information. No.

Industrial designs. Yes. Exclusive licensees have the same rights as a proprietor to bring proceedings for infringement, while non-exclusive licensees do not.

Trade marks. An exclusive licence may provide that the licensee shall have the same rights and remedies as if the licence had been an assignment. In such a case, the exclusive licensee may bring infringement proceedings in its own name against any person other than the proprietor. Otherwise, licensees (exclusive or not) do not have rights to bring proceedings for infringement in their own name unless they have first called upon the proprietor to do so and the proprietor refuses to or fails to do so within 2 months after being called upon.

Geographical indications. No.

Copyright. Yes. Exclusive licensees have the same rights of action and are entitled to the same remedies as the owner of the copyright, except against the owner of the copyright.

Layout designs of integrated circuits. Yes. Exclusive licensees have the same rights against a successor in title to the owner as they have against the licensor. They also have the same rights and remedies as the owner, except against the owner.

Plant varieties. No.

16. Are there criminal sanctions for infringement of any intellectual property rights, and if so, what are they and how are they invoked?

Criminal sanctions are available in respect of the main intellectual property rights. Penalties range from a fine to a term of imprisonment of up to five years, or both.

Notably, intellectual property rights holders may take it upon themselves to prosecute infringers upon the grant of a fiat from the Attorney-General's Chambers. In a private prosecution, any search and seizure will be carried out by the specialist Intellectual Property Rights

Branch of the Singapore Police Force.

Trade marks. Counterfeiting, falsely applying a trade mark to goods, and importing and selling of counterfeits all attract criminal sanctions. The courts are strict about this and the benchmark sentence is typically a term of imprisonment, especially if the counterfeit goods were sold commercially from a permanent establishment.

Copyright. Dealing in a copyright work (including the importation, distribution, or sale) with the knowledge, actual or presumed, that the work is an infringing copy will attract criminal liability.

Patents. Falsely claiming that a product is patented or that it is the subject of a pending patent application is an offence. There are, however, no criminal sanctions for patent infringement.

Industrial designs. It is an offence to claim, falsely, that a design applied to any article is registered. Such a claim may be made expressly or by implication.

17. What other enforcement options are available for each of the intellectual property rights described above? For example, civil court proceedings, intellectual property office proceedings, administrative proceedings, alternative dispute resolution.

Civil court proceedings for infringement are available for all intellectual property rights. All civil intellectual property disputes will be tried in the High Court.

All pre-registration and pre-grant proceedings are heard by IPOS. IPOS may also adjudicate revocation and invalidation disputes for trade marks and patent and design revocation proceedings.

Alternative dispute resolution mechanisms are promoted by both IPOS and the Courts. Legislation explicitly clarifies that intellectual property rights disputes are capable of settlement by arbitration as between the parties to the dispute. WIPO operates its own Arbitration and Mediation Center in Singapore to provide mediation in respect of trade mark, patent, and registered design disputes as well as expert determination for patent proceedings. Such WIPO mediation is actively promoted by IPOS in the course of trade mark dispute proceedings.

18. What is the length and cost of such procedures?

The typical High Court infringement proceeding will take around two years to conclude.

Costs depend on complexity and generally range from SGD 200,000 to SGD 500,000 (usually for more complex patent cases). However, the successful party in litigation is usually able to recover a proportion – typically, 50-60% – of its legal costs from the other party.

Costs for proceedings before IPOS are significantly cheaper. A typical trade mark opposition will cost around SGD 20,000-30,000.

19. Where court action is available, please provide details of which court(s) have jurisdiction, how to start proceedings, the basics of the procedure, the time to trial, the format of the trial, the time to judgment and award of relief and whether any appeal is available.

All civil intellectual property disputes fall within the jurisdiction of the General Division of the High Court.

Proceedings in all courts are commenced by filing an Originating Claim setting out the particulars of the claim. The parties then exchange further pleadings to delimit the issues in dispute.

This is followed by the process of discovery where the parties produce and exchange documents which they may then rely upon as evidence. Interrogatories may also be requested and ordered.

Evidence for the trial is usually provided by way of affidavits of evidence-in-chief before the commencement of trial proper. At the trial, after the parties' opening statements are made, the witnesses, both factual and expert, are subject to cross-examination by opposing counsel. After all evidence has been led, the Court usually requests for written closing submissions be filed.

A party who is not satisfied with the trial court's decision may appeal it to the Appellate Division of the High Court to set aside or vary the decision.

20. What customs procedures are available to stop the import and/or export of infringing goods?

A copyright or registered trade mark holder may notify Singapore Customs that infringing goods are expected to be imported into Singapore. Singapore Customs will then seize the infringing goods upon import. The intellectual

property right holder will then have to institute infringement proceedings within ten working days.

Singapore Customs may also take action on their own accord to detain counterfeit goods.

21. Are any non-court enforcement options or dispute resolution mechanisms mandatory in respect of intellectual property disputes in any circumstances? If so, please provide details.

Nil

22. What options are available to settle intellectual property disputes in your jurisdiction?

A dispute may be settled at any time, even midway through trial. If official proceedings have been commenced, a notice of discontinuance will have to be filed with the court.

Parties may also elect to refer their disputes for mediation or expert determination. However, such alternative dispute resolution mechanisms will require the consent of both parties.

23. What is required to establish infringement of each of the intellectual property rights described above? What evidence is necessary in this context?

The tests for infringement in respect of the main forms of IPRs are provided below. Very often, especially in relation to registered IPRs, a claim for infringement will beget a counterclaim for invalidity or non-use. One therefore has to keep an eye out for potential vulnerabilities before commencing infringement proceedings.

Patents. Proving patent infringement depends on the type of patent in question – different rules apply for product and process patents.

- Where the invention is a product, there will be infringement when the infringer makes, keeps, disposes of, uses, or imports the product.
- Where the invention is a process, there will be infringement when the infringer uses the process or offers it for use in Singapore when he knows, or ought to know, that such use is

unauthorized by the patent holder.

- Where the invention is a process, there will be infringement when the infringer disposes of, keeps, uses, or imports any product obtained directly by means of that process.

Notably, where the invention is a process for obtaining a product, the burden of proof is reversed: if the product is new or likely to have been made by the patented process, the alleged infringer will have to prove his product is not made by the patented process.

A person may also be liable for indirect or secondary patent infringement by inducing or inciting the infringement of the patent.

Trade marks. A person will infringe a registered trade mark if he uses an identical sign on identical goods or services. If the competing marks and/or goods or services are merely similar (and not identical), then a likelihood of confusion must be proven. If the trade mark owner can prove that his trade mark is well known in Singapore, he may also sue for infringement even though his mark is not registered.

Copyright. A person will commit primary copyright infringement when he does any of the acts restricted by the copyright. This includes reproducing the work, communicating the work to the public, adapting the work, and performing the work in public. A person who authorizes another to commit a primary infringement will also be liable for authorizing infringement. Lastly, a person who trades in an article knowing that it is an infringing article will be liable for secondary infringement.

Industrial designs. Industrial design rights will be infringed when a person does anything which falls within the exclusive rights of the design owner. This includes making, selling, or importing for sale any article which is the subject of a registered design. More broadly, there will also be infringement if a person makes anything which enables a protected article or its components to be manufactured in Singapore or elsewhere.

24. How does the court acquire any necessary information (fact or technical) and in what circumstances does it do so? In particular a) Is there a technical judge, a judge with technical experience, a court appointed expert, an expert agreed by the parties, and/or parties' expert witness evidence? b) What mechanisms are

available for compelling the obtaining and protecting of evidence? Is disclosure or discovery available?

IP cases in the High Court are typically heard by specialist IP judges who possess experience and expertise in IP matters.

The parties may also appoint their own expert witnesses. The Court also typically appoints its own independent technical expert to assist the Court in its determination, especially for patent disputes.

The Singapore legal system also provides for the process of discovery whereby parties are obligated to disclose documents which are relevant to the issues and which are in their possession, custody, or power. Notably, this obligation applies even if the documents are damaging to their own case.

Where documents provided are confidential, the parties may agree upon the provision of confidentiality undertakings prior to disclosure.

25. How is information and evidence submitted to the court scrutinised? For example, is cross-examination available and if so, how frequently is it employed in practice?

All witnesses will be subject to cross-examination by the opposing counsel. This includes expert witnesses.

26. What defences to infringement are available?

Generally, the first countermeasure that a defendant will call upon would be to challenge the validity of the intellectual property right in question.

Singapore also has carved out a very expansive parallel importation exception to infringement. Once a genuine product that is the subject of a patent, trade mark, or industrial design has been put on the market by the rights holder anywhere in the world, the rights holder loses his ability to oppose subsequent acts of use or resale in Singapore.

Other notable defences are detailed below.

Patents. Private, non-commercial acts, or acts performed for an experimental purpose will not be considered to be infringement. A defendant may also avail itself of the “Gillette” defence by arguing that its

product or process was already disclosed and part of the prior art. Thus, when the patentee claims that a defendant’s product or process falls within the scope of the patent, the patent will run into issues with validity. On the other hand, if the patent is valid, then the Defendant will not infringe the same. The “Bolar” defence – which permits the clinical testing of generic drugs to be conducted during the term of the patented drug – is also available in Singapore. Further, a patentee’s remedies may be limited in the case of innocent infringement. If the infringer can prove that he was not aware, and had no reasonable grounds for supposing, that the patent existed, the court will not award damages or an account of profits to the patentee.

Trade marks. The use of trade mark in a descriptive manner – for instance, to indicate the kind, quality, or geographical origin of goods – will not be infringement. An example of this is indicating that a toner cartridge is compatible with particular brand of printer. The use of a trade mark in comparative advertising or promotion will also not be infringement if the use is considered to be fair.

Copyright. The foremost defence of fair dealing involves taking into account a host of factors including whether the dealing is non-commercial, how much of the work was copied, and the effect of the dealing on the potential market for the work. The use of a copyrighted work for criticism or review, for reporting current events, or as part of judicial proceedings will not be considered to be infringement.

Industrial designs. The use of a registered design for a private non-commercial purpose will not be infringement. Neither will the use the design for the purpose of analysis, research, or teaching.

Like the case with patents, there is also some leeway given for innocent infringement. Although not a defence, if the infringer can prove that he was not aware, and had no reasonable grounds for supposing, that the design in question was registered, the court will not award damages or an account of profits to the design holder.

27. Who can challenge each of the intellectual property rights described above?

There are no *locus standi* requirements to bring invalidation or revocation proceedings against a patent or trade mark. Any person may institute such proceedings. Revoking a registered design, however, requires a plaintiff to have an interest in the matter.

28. When may a challenge to these intellectual property rights be made (e.g. during any registration process or at any time during the subsistence of the right)?

Trade marks. A trade mark may be challenged via opposition to prevent its registration. Post-registration, it may be challenged by invalidation or non-use revocation proceedings.

Patents. A patent may be challenged pre-grant only as to whether the patentee is entitled to own the patent. There is no opposition available. Post grant, the validity of a patent may be challenged via a patent revocation or by way of a counterclaim in an infringement action.

Industrial designs. A registered design may only be revoked after registration.

29. Briefly, what is the forum and the procedure for challenging each of these intellectual property rights and what are the grounds for a finding of invalidity of each of these intellectual property rights?

Trade marks. A trade mark may be challenged on the same grounds as that in an opposition, which include the following: that the trade mark is non-distinctive, descriptive, liable to mislead the public, that it was registered in bad faith, or that it conflicts with a senior mark. A trade mark may also be revoked if it has not been used in Singapore for five years. Trade mark invalidation or revocation proceedings may be commenced either at the Registry or in the High Court.

Patents. A patent may be challenged on grounds that the patentable invention was not new, that the specification discloses additional matter, that an illegitimate amendment was made to the specification, or that the patent was obtained fraudulently. The validity of a patent may be challenged at the Registry. If challenged in the High Court it must be by way of a counterclaim in an infringement suit.

Industrial designs. A registered design may be challenged on grounds including the following: that the design is not new, that the design is dictated solely by function, or that right holder is not the rightful owner of the design. A registered design may be challenged either at the Registry or in the High Court.

30. Are there any other methods to remove or limit the effect of any of the intellectual

property rights described above, for example, declaratory relief or licences of right?

A third party seeking market entry may apply for a declaration from the Court that its proposed conduct or goods does not infringe a particular patent or registered industrial design.

The Court may also grant a compulsory license to work a patented invention where it is necessary to remedy an anti-competitive practice. For instance, such a compulsory license may be ordered where there is a market for the patented invention in Singapore and the patented proprietor has no valid reason for failing to supply this market on reasonable terms.

31. What remedies (both interim and final) are available for infringement of each of the intellectual property rights described above?

Apart from the usual final injunctions and monetary remedies, an intellectual property rights holder may also seek the following non-exclusive remedies:

- **Statutory damages.** Statutory damages are available in respect of trade mark and copyright infringement. A plaintiff may elect to receive statutory damages in lieu of damages or an account of profits to avoid having to prove actual loss.
- **Order for disposal.** In the case of counterfeit goods, the Court will usually order that they be destroyed following the conclusion of the matter.
- **Search orders.** The grant of a search order will enable a plaintiff's solicitors to enter a defendant's premises to seize infringing goods or incriminating evidence.
- **Interim injunction.** An intellectual property rights holder may seek an interim injunction at time of commencement or partway through proceedings to prevent the alleged infringer from continuing its infringement.

32. What are the costs of enforcement proceedings and is any kind of costs recovery available for successful parties? Is there a procedural mechanism enabling or requiring security for costs?

The rule of thumb in infringement proceedings is that the successful party will usually be able to recover

around 50-60% of its legal costs.

Security for costs is will usually be ordered upon application by the defendant if the plaintiff is resident outside of Singapore.

33. The Unified Patent Court ("UPC") [came into] [will come into] existence in certain European states on 1 June 2023, as did the introduction of European patents with

unitary effect ("unitary patents"). Have industry-specific trends developed in your country in terms of the number of patent applicants seeking unitary patent protection and/or enforcing European patents or unitary patents before the UPC?

Patent owners in our jurisdiction are generally adopting a "wait-and-see" approach before participating more fully in the unitary patent system.

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