

Intellectual Property

Proposed Changes to Singapore's Registered Designs Regime

Introduction

The Registered Designs (Amendment) Bill ("**Bill**") was read the first time in Parliament on 3 April 2017. The proposed legislative changes will update Singapore's registered designs regime to take into account latest trends in design and technology. This will also support the growth of the design industry in Singapore.

The Bill implements the recommendations from the review of Singapore's registered designs regime conducted by the Ministry of Law ("**MinLaw**") and the Intellectual Property Office of Singapore ("**IPOS**") from May 2014 to December 2016. The review included 3 rounds of public consultation, from May to June 2014, October to December 2015, and November to December 2016 respectively.

This is the first major amendment to the Registered Designs Act ("**RDA**") proposed since the law was enacted in 2000.

Key Features of the Registered Designs (Amendment) Bill

The proposed key changes contained in the Bill are set out below.

Broaden scope of registrable designs

- (i) Colours as a design feature – They refer to colours used in conjunction with the feature of a shape or configuration, and give rise to a feature of a pattern or ornament. For example, not only can a new shape of a vacuum cleaner be registered, the yellow and black striped colours of its body can also be registered.
- (ii) Designs of non-physical products that can be projected onto a surface or any medium (including air) and have intrinsic utilitarian functions. An example of a non-physical product that qualifies under this category is a virtual computer keyboard, which, when projected onto a wall, functions as a real, physical keyboard.

In this regard, the Bill enables a new design to be registered in respect of a non-physical product, or a set of articles and non-physical products, in addition to being registered separately as an article and a physical product, respectively.

- (iii) Designs of artisanal or handcrafted items – They refer to designs of articles that are manufactured by an industrial process, by hand or otherwise. Previously, the design must be "applied by an industrial process" to be registrable. Under the new Bill, this requirement no longer applies. Handcrafted items such as handmade jewelries can be registered for protection.

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Change of default position in relation to ownership of commissioned designs

The Bill seeks to change the default position on the ownership of a commissioned design. Currently, the commissioning party owns the design of a designer who is commissioned to create a design. The Bill will allow the designer of a commissioned design, rather than the commissioning party, to own the design by default.

Despite this change, the Bill also stipulates that both parties are still free to contract otherwise. What this means is that if the designer assigns the design to the commissioning party, then the latter will be treated as the owner of the design.

The shift in the default position on the ownership of a commissioned design is aimed at encouraging creativity and recognizing the valuable contribution of designers.

Timeline for registration application; Broadened circumstances in which prior disclosure of design not a ground for refusal of registration application

Under the current set-up, a design cannot be registered if it has been publicly disclosed before the application date. However, this general rule is subject to a few exceptions (for example, when the disclosure was in breach of confidence, or if the application was made within 6 months of the disclosure).

The Bill proposes to broaden the circumstances in which the prior disclosure of a design does not affect the registrability of a design. It also lengthens the period for the filing of application for registration of a design. Specifically, it specifies 12 months as the period after certain disclosures of a design during which the design remains registrable.

The circumstances under which an application of a design must not be refused by reason solely of prior disclosure are as follows:

- (i) a disclosure made to a person other than the designer under conditions of confidentiality (whether express or implied);
- (ii) a disclosure made by the designer within 12 months immediately before the date of the filing of the registration application;
- (iii) a disclosure made by a person other than the designer during the period of 12 months immediately before the date of the filing of the registration application, as a consequence of the information provided by the designer;
- (iv) a disclosure made during the 12-month period prior to the application of registration, as a consequence of an abuse in relation to the designer. This particular measure is intended to cover matters such as theft of the design from the designer, or the making of an illegitimate copy of the design.

Correction of non-compliance with formal requirements in earlier registration applications

The Bill allows an applicant whose previous application for registration was denied for non-compliance with certain formal requirements, to rectify such non-compliance by filing one or more applications. Such applications will be treated as filed on the date of the filing of the original application, subject to certain conditions.

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Registration of 2 or more designs in one application

Generally, for applicants who wish to file multiple designs, the rule is that each design requires its own separate application. However, to reduce the administrative burden, the RDA presently allows for the filing of multiple designs in the same application if the designs are within the same sub-classification of the Locarno Classification. On the backend, each design would then be accorded separate application numbers and treated as individual applications to facilitate subsequent activities such as publication, renewals and licensing.

The Bill proposes to extend this practice to allow multiple designs with the same Locarno classification to be filed in the same application. This would further streamline the application process, and the resultant cost savings could be used to offset the registration fees for subsequent designs. This also mirrors the procedure used in the EU, the UK and WIPO.

Comments

Many of the amendments in this new Bill are welcomed for reinforcing Singapore's position as a robust IP hub in the region. For example, by extending protection to non-physical products which the UK and the EU has done, the Bill affirms again the readiness of Singapore to keep pace with other jurisdictions as well as with the advent of technology. Overall, the Bill is compatible with the objective of incentivising designers to continue producing creative works using an expanded range of methods and mediums, given that the Bill increases the scope of protection for registered designs, the types of designs that may be protected, as well as the ease with which designs may be registered.

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ASEAN Economic Community Portal

The launch of the ASEAN Economic Community ("AEC") in December 2015, businesses looking to tap the opportunities presented by the integrated markets of the AEC can now get help a click away. Rajah & Tann Asia, United Overseas Bank and RSM Chio Lim Stone Forest, have teamed up to launch "Business in ASEAN", a portal that provides companies with a single platform that helps businesses navigate the complexities of setting up operations in ASEAN.

By tapping into the professional knowledge and resources of the three organisations through this portal, small- and medium-sized enterprises across the 10-member economic grouping can equip themselves with the tools and know-how to navigate ASEAN's business landscape. Of particular interest to businesses is the "Ask a Question" feature of the portal which enables companies to pose questions to the three organisations which have an extensive network in the region. The portal can be accessed at <http://www.businessinasean.com>.

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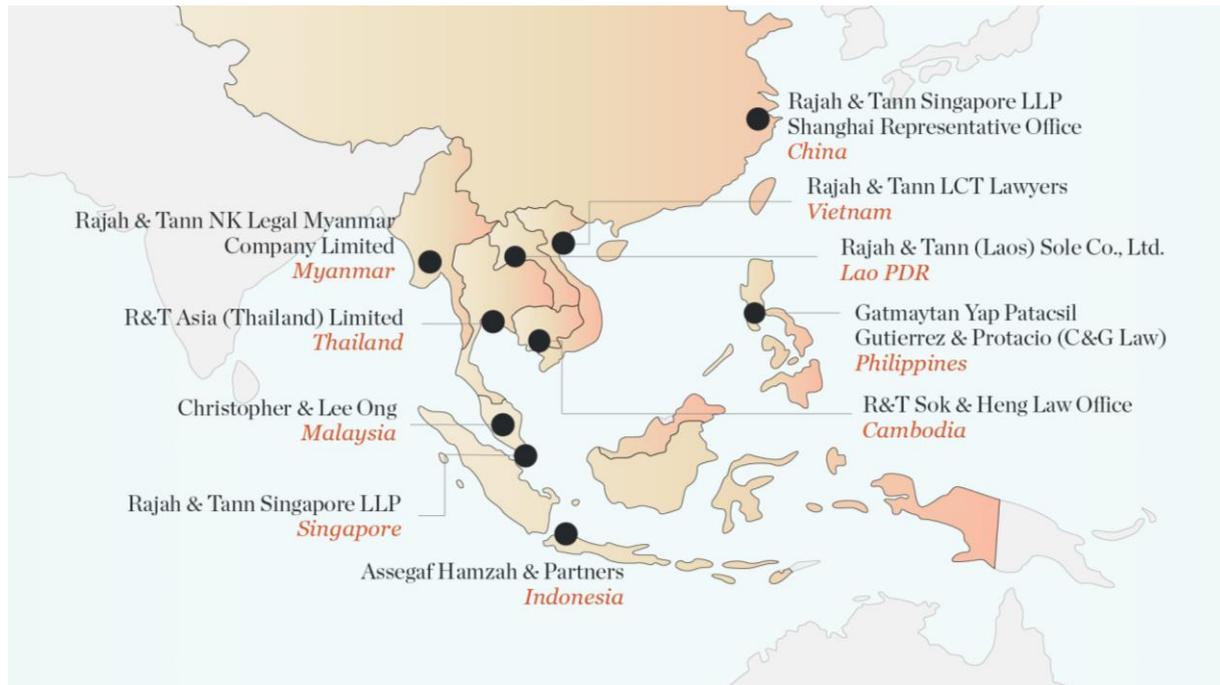
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