

Japan Patent Office (JPO) Commissioned Survey

**Survey on the Appeal, Opposition, and  
Invalidation Procedures Related to Patents,  
Designs, and Trademarks in Singapore**

March 2020

Japan External Trade Organization (JETRO)  
Singapore Office

## Table of Contents

<b>A. INTRODUCTION</b> .....	<b>2</b>
I. Objective .....	2
II. Scope of Survey .....	2
III. Method of Survey .....	3
IV. Results of Survey .....	3
<b>B. ADJUDICATORY BODIES AND FORUM</b> .....	<b>4</b>
I. Adjudicatory Bodies.....	4
II. Forums .....	5
<b>C. PATENTS</b> .....	<b>7</b>
I. Overview of the Patent Application Process .....	7
II. Processing of a Patent Application .....	8
III. Opposition Proceedings.....	9
IV. Revocation Proceedings.....	9
V. Putting Validity of Patent into Issue .....	14
VI. Other Procedures to Challenge the Patentability of a Patent Application Before and After Grant .....	15
VII. Statistics.....	18
VIII. Case study .....	19
<b>D. REGISTERED DESIGNS</b> .....	<b>21</b>
I. Overview of the Design Application Process.....	21
II. Processing of a Design Registration Application.....	22
III. Opposition Proceedings.....	23
IV. Revocation Proceedings.....	23
V. Invalidation Proceedings.....	26
VI. Statistics.....	26
VII. Case Study.....	27
<b>E. TRADE MARKS</b> .....	<b>28</b>
I. Overview of the Trade Mark Application Process .....	28
II. Processing of a Trade Mark Application .....	29
III. Opposition Proceedings.....	30
IV. Revocation Proceedings.....	36
V. Invalidation Proceedings.....	39
VI. Statistics.....	41
VII. Case Study.....	42
<b>ACKNOWLEDGEMENTS</b> .....	<b>44</b>
<b>ANNEX</b> .....	<b>44</b>

## A. INTRODUCTION

### I. Objective

The Singaporean intellectual property (IP) system offers procedures re-examine the validity of patents, designs, and trademarks, or final refusals in examination. However, users may lack basic knowledge of the legal and cost effectiveness of each scheme, which may lead to sub-optimal rights securement and enforcement.

Thus, this survey aims to clarify the appeal, opposition, revocation, and invalidation procedures related to patents, designs, and trademarks in Singapore order to support IP activity there.

### II. Scope of Survey

2.1. This survey report covers procedures concerning appeal, opposition, revocation and invalidation procedures for patents, registered designs and trade marks (together referred to as, “**IP rights**”) in Singapore, including:

- (a) The main bodies that adjudicate on IP rights and their binding effect *inter se*;
- (b) Requirements to be a judge/examiner, challenges to a judge/examiner, removal of a judge/examiner;
- (c) The applicable actions (i.e., appeal, opposition, revocation or invalidation proceedings) and forum for commencing the actions;
- (d) The requirements for parties;
- (e) Time limits for commencing an action;
- (f) Scope and reasons for commencing an action;
- (g) Possibility of amendments to filings;
- (h) Amendments and corrections to the scope of IP (requirements, time limits, etc.);
- (i) Mode (oral or written) of hearings;
- (j) Average duration from commencement of an action to a decision;
- (k) Details on the contents of non-final and final decisions;
- (l) Effect of decision and when it is finalised;
- (m) Applicable forms and fees;
- (n) Publication of decisions and method of publication;
- (o) Flowchart of procedures;
- (p) Relationship between types of actions (i.e., certain proceedings that can only arise within the context of other proceedings) and the possibility of a two-track dispute;
- (q) Statistics on number of dispute cases for each IP right filed at the IPOS/court, heard by the IPOS/court, the success rate of the cases heard by the IPOS/court, and decisions that were appealed; and
- (r) Representative cases and strategies to utilize the systems.

### III. Method of Survey

3.1. We have prepared this survey report based on (a) a desktop survey of the various IP law and regulations, and circulars and practice directions issued by the Intellectual Property Office of Singapore (“IPOS”); and (b) an in-person interview session conducted with the IPOS.

3.1.1. **Desktop survey on IP laws, regulations and practice directions.** In Singapore, IP rights are governed by the following statutes:

- (a) *Patents Act (Chapter 221)* (“**Patents Act**”) and *Patent Rules (GN No. S 1/1995)* (“**Patent Rules**”);
- (b) *Registered Designs Act (Chapter 266)* (“**Registered Designs Act**”) and *Registered Designs Rules (GN No. S 504/2000)* (“**Registered Designs Rules**”); and
- (c) *Trade Mark Act (Chapter 332)* (“**Trade Marks Act**”) and *Trade Mark Rules (GN No. S 635/1998)* (“**Trade Marks Rules**”).

3.1.2. The IPOS also issues circulars and practice directions on the procedures pertaining to each IP right.

3.1.3. It should also be noted that the *Intellectual Property (Dispute Resolution) Bill*, which was passed in the Singapore Parliament on 5 August 2019, is now partially in force. With effect from 21 November 2019, the *Intellectual Property (Disputes Resolution) Act* (the “**New Act**”) has, amongst others, amended the *Arbitration Act (Chapter 10)* and the *International Arbitration Act (Chapter 143A)* confirming that IP disputes can be arbitrated in Singapore. The New Act will also introduce changes to enhance the IP dispute resolution in Singapore namely, introducing a new framework to consolidate most civil IP disputes to be heard by the High Court at first instance, and formalising procedures that allow third parties to challenge the validity of patents before and after grant. As of the date of this survey report, these proposed changes are not in force yet. However, in anticipation of these incoming proposed changes, we have referenced them in the survey results, where relevant.

3.1.4. **In-person interview session conducted with the IPOS.** An in-person interview session was conducted with IPOS officers on 9 January 2020 (“**The IPOS Interview**”).

### IV. Results of Survey

4.1. The results of the survey are set out in the following chapters of this survey report:

- (a) **Chapter B: Adjudication bodies and Forum.**
- (b) **Chapter C: Patents.**
- (c) **Chapter D: Registered Designs.**
- (d) **Chapter E: Trade Marks.**

## B. ADJUDICATORY BODIES AND FORUM

### I. Adjudicatory Bodies

1.1. The two main bodies that adjudicate on IP rights in Singapore are: (a) the IPOS; and (b) the Singapore courts.

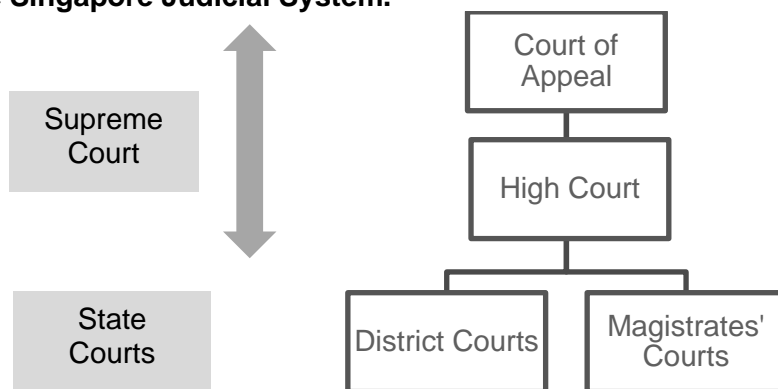
#### 1.2. The IPOS.

1.2.1. The IPOS, a government agency under the Singapore Ministry of Law of the Singapore Government, administers IP laws and hears disputes relating to IP rights.<sup>1</sup>

1.2.2. The Trade Marks, Patents and Designs Registries within the IPOS are responsible for registering IP which qualifies for registration as per provisions of the IP laws, and maintaining the Registers for each IP.<sup>2</sup> Over 90% of the patents examiners hold PhD degrees in various sectors including biotechnology, pharmaceuticals, chemistry, ICT, semiconductors, and engineering. Examiners in the Trade Mark Registry are required to minimally hold a university degree (from any background) and have good academic standing.<sup>3</sup>

1.2.3. IP dispute proceedings are heard by a hearing officer from the Hearing & Mediation Department within IPOS (“HMD”) or by an externally appointed IP Adjudicator. The hearing officer may be a Principal Assistant Registrar or Assistant Registrar employed by the IPOS while IP Adjudicators are externally appointed from academia, the legal commission or private legal practice for a term of 2 years, and are selected on the basis of their expertise and reputation.<sup>4</sup> When assigning cases to be heard, the IPOS follows an internal policy to ensure that there is no conflict of interest.<sup>5</sup> Parties may file a request in writing to the HMD to change the assigned hearing officer or IP Adjudicator, providing reasons for the request.<sup>6</sup> This has not happened before, possibly because the internal process to check against conflict of interest works.

#### 1.3. The Singapore Judicial System.



Flowchart B-1: Structure of the Singapore Courts.

<sup>1</sup> <https://www.ipos.gov.sg/who-we-are>.

<sup>2</sup> <https://www.ipos.gov.sg/who-we-are/organisational-chart>.

<sup>3</sup> The IPOS Interview.

<sup>4</sup> The IPOS Interview.

<sup>5</sup> The IPOS Interview.

<sup>6</sup> The IPOS Interview.

- 1.3.1. The Singapore judicial system is divided into two tiers: the Supreme Court and the State Courts.<sup>7</sup> The Supreme Court consists of the High Court and the Court of Appeal.<sup>8</sup> Within the High Court, an IP Court with specialist judges hears IP disputes.<sup>9</sup> The State Courts comprise of the District Courts and the Magistrates' Courts, as well as the Coroners' Courts, a small civil claims court called the Small Claims Tribunals and the Employment Claims Tribunals.<sup>10</sup>
- 1.3.2. In general, civil cases involving claims not exceeding S\$60,000 are dealt with by the Magistrates' Courts.<sup>11</sup> Claims of more than S\$60,000 but not exceeding S\$250,000 are dealt with by the District Courts.<sup>12</sup> Claims above S\$250,000 are dealt with by the High Court.<sup>13</sup>
- 1.3.3. The Chief Justice, Judges of Appeal and Judges of High Court are appointed by the President (on advice of the Prime Minister).<sup>14</sup> A person must have at least 10 years of legal practice as a qualified lawyer or as a member of the Singapore Legal Service to be qualified to be appointed as a Judge of the Supreme Court.<sup>15</sup> Hearings before the High Court are heard by 1 Judge while appeals before the Court of Appeal are heard by a panel of Judges of Appeal. A Judge of the Supreme Court can only be removed on the grounds of misbehaviour, inability, infirmity of body or mind or other causes to properly discharge the functions of his office.<sup>16</sup> Such a recommendation may only be made by the Prime Minister or the Chief Justice (after consulting the Prime Minister) to the President.<sup>17</sup> Thereafter, the President will appoint a tribunal of at least 5 persons who are/were Judges to investigate further and may, on the recommendation of the tribunal, remove the Judge from office.<sup>18</sup> A party may apply to have a Judge be recused from a hearing for reasons of bias (apparent or actual), prejudgment amounting to apparent bias and excessive judicial interference.<sup>19</sup>
- 1.3.4. The decisions of the High Court and the Court of Appeal bind the IPOS proceedings in Singapore. However, the IPOS is not bound by its previous decisions.

## II. Forums

### 2.1. Litigation.

- 2.1.1. Presently, IP disputes may be heard by the High Court, State Courts, or the IPOS, depending on the nature of the IP right, the type of proceeding or the value of the claim. An overview of the appropriate forum to commence an action for each IP right is set out in the table below.

<sup>7</sup> Section 3, *Supreme Court Judicature Act (Chapter 322)* ("**SCJA**") and Section 3(1), *State Courts Act (Chapter 321)*.

<sup>8</sup> Section 3, *SCJA*.

<sup>9</sup> <https://www.supremecourt.gov.sg/about-us/the-supreme-court/structure-of-the-courts>.

<sup>10</sup> Section 3(1), *State Courts Act (Chapter 321)*.

<sup>11</sup> Section 2, *State Courts Act (Chapter 321)*.

<sup>12</sup> *Ibid* and Section 19, *State Courts Act (Chapter 321)*.

<sup>13</sup> Section 16, *SCJA*.

<sup>14</sup> Article 95(1), *Constitution of the Republic of Singapore*.

<sup>15</sup> Article 96, *Constitution of the Republic of Singapore*.

<sup>16</sup> Article 98(3), *Constitution of the Republic of Singapore*.

<sup>17</sup> *Ibid*.

<sup>18</sup> *Ibid* read with Article 98(4), *Constitution of the Republic of Singapore*.

<sup>19</sup> *BOI v BOJ* [2018] 2 SLR 1156.

<b>IP Right</b>	<b>Opposition</b>	<b>Challenges to validity<sup>20</sup>/Invalidation</b>	<b>Revocation</b>	<b>Infringement</b>
<b>Patents</b>	N/A	IPOS / High Court	IPOS / High Court (in future, under the New Act)	IPOS (some types) / High Court
<b>Designs</b>	N/A	N/A	IPOS / High Court	High Court
<b>Trade Marks</b>	IPOS	IPOS / High Court	IPOS / High Court	High Court
<b>Copyright</b>	N/A	N/A	N/A	State Courts / High Court only (in future, under the New Act)

2.1.2. When in force, the New Act will simplify the process of IP dispute resolution by consolidating most civil IP disputes (including infringement actions, passing off actions and declarations of non-infringement) to be heard by the High Court at first instance. Parties will also be able to proceed under a “specialized track” option for IP litigation, intended for lower value disputes or those where parties wish to expedite the conduct of their case.

## 2.2. Alternative Dispute Resolution.

2.2.1. Beyond litigation, parties can consider alternative dispute resolution to settle their IP disputes, using institutions such as the WIPO Arbitration and Mediation Center (Singapore Office), or the Singapore International Arbitration Center (SIAC). These are alternatives to the adjudication framework described at 1.2 and 1.3.

### 2.2.2. WIPO Arbitration and Mediation Center (Singapore Office)

The WIPO Arbitration and Mediation Center (“WIPO Center”) is based in Geneva at WIPO Headquarters. Its Singapore office was established in May 2010. The WIPO Center, including its Singapore Office, provides a suite of alternative dispute resolution services, which include mediation, arbitration, expedited arbitration and expert determination<sup>21</sup>.

### 2.2.3. Singapore International Arbitration Center (SIAC)

The Singapore International Arbitration Center (SIAC) is a global arbitration center that deals with a broad range of disputes including IP. SIAC has an experienced international panel of over 500 expert arbitrators from over 40 jurisdictions, including a panel of 23 arbitrators for intellectual property disputes<sup>22</sup>.

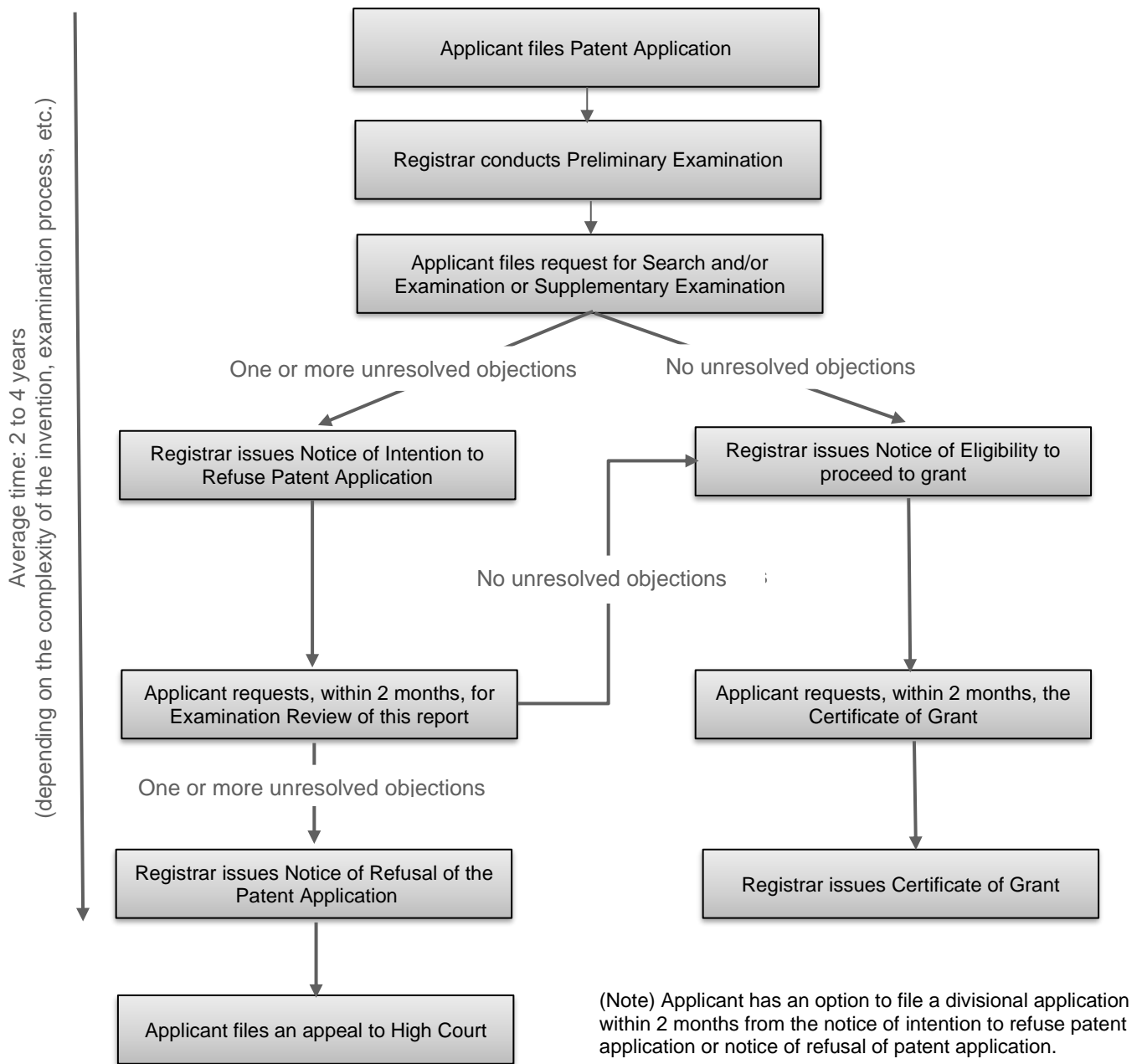
<sup>20</sup> There is no separate class of proceedings called “Invalidation Proceedings” for patents. Instead, as paragraph 5.1 elaborates, the validity of a patent can be challenged in different contexts.

<sup>21</sup> <https://www.wipo.int/amc/en/>

<sup>22</sup> <https://www.siac.org.sg/>

## C. PATENTS

### I. Overview of the Patent Application Process



Flowchart C-1: Overview of the Patent Application Process for applications filed on or after 14 February 2014.



## II. Processing of a Patent Application

- 2.1. **Applicant Files for Request for Search and/or Examination or Supplementary Examination.** During the examination process, the patent examiner may issue one or more written opinion(s) if there are any unresolved objections regarding the patent application.<sup>23</sup> The applicant can respond to the written opinion(s) by filing Patents Form 13A accompanied with written submissions and/or amendments<sup>24</sup> to the patent specification within 3 months or 5 months from the date of the written opinion (depending on the examination route selected).<sup>25</sup>
- 2.2. **Registrar Issues Notice of Intention to Refuse Patent Application.** If the patent examiner's objections cannot be overcome or there is no response from the applicant within this timeline, a Notice of Intention to Refuse will be issued with a negative examination report.<sup>26</sup>
- 2.3. **Applicant Requests within 2 Months for Examination Review of this Report.** The applicant may request a review of the examination report by filing Patents Form 12B/13 (together with payment of S\$1,350) accompanied by written submissions and/or amendments to the specification to overcome the unresolved objections within 2 months from the date of the Notice of Intention to Refuse.<sup>27</sup> The matters relating to the examination report under review is generally performed by a different and more senior patents examiner.<sup>28</sup>
- 2.4. **Registrar Issues Notice of Eligibility to Proceed to Grant or Notice of Refusal of Patent Application.** The examination review process provides an applicant with a *final* opportunity for the applicant to address any unresolved objections to put the patent application in order for grant.<sup>29</sup> The patents examiner issues an examination review report addressing all issues concerning the examination report under review, and providing reasons for the decision in respect to each issue.<sup>30</sup>
- (a) If the patent examiner's objections have been resolved, the Registrar will issue a positive examination review report together with a notice of eligibility to proceed to grant.<sup>31</sup>
  - (b) If the patent examiner's objections remain unresolved, a negative examination review report together with a notice of refusal of the patent application will be issued as the final refusal signifying the end of the prosecution process for the application.<sup>32</sup> If the applicant wishes to continue pursuing an application to grant, the applicant will have to restart the prosecution of the Singapore application by filing a divisional application within two months from the date of the notice of refusal of the patent application.
- 2.5. **Applicant Files an Appeal to High Court.** An applicant can contest a negative examination review report by filing a Notice of Appeal with the High Court within six weeks from the date of the notice of final refusal.<sup>33</sup> The appeal is heard by way of an *ex parte* hearing.

---

<sup>23</sup> Rule 46(1), *Patents Rules*.

<sup>24</sup> Rules 46(3), *Patent Rules*.

<sup>25</sup> Rules 46(4) and 46(4A), *Patents Rules*.

<sup>26</sup> Section 29A(3), *Patents Act*.

<sup>27</sup> Rule 46A of the *Patents Rules* read with Section 29B of the *Patents Act*.

<sup>28</sup> IPOS, 'Examination Guidelines for Patent Applications at IPOS' (IPOS, April 2017) at Paragraphs 10.5 and 10.6 <[https://www.ipos.gov.sg/docs/default-source/resources-library/patents/infopacks/examination-guidelines-for-patent-applications-at-ipos\\_2017-apr.pdf](https://www.ipos.gov.sg/docs/default-source/resources-library/patents/infopacks/examination-guidelines-for-patent-applications-at-ipos_2017-apr.pdf)> (the "**Patents' Examination Guidelines**") (accessed 2 January 2020).

<sup>29</sup> *Ibid.*

<sup>30</sup> Section 29B(4), *Patents Act*; The Patents' Examination Guidelines at paragraph 10.10.

<sup>31</sup> Section 29B(5)(b)(i), *Patents Act*.

<sup>32</sup> Section 29B(5)(b)(ii), *Patents Act*.

<sup>33</sup> Section 29B, *Patents Act* read with the Patents' Examination Guidelines at paragraph 10.5; Section 90(1), *Patents Act*.

- 2.6. **Effect of Decision.** Unless the applicant appeals the Registrar's decision to the High Court, the Registrar's decision will be final.
- 2.7. **Publication of Non-Final and Final Decisions.** All decisions issued by the Registrar and the Singapore courts are issued in the English language. For patent applications filed on or after 14 February 2014, the Registrar's search and/or examination reports, examination review reports, written opinions and decisions will be published on the Patents Open Dossier on the online patents database of the IPOS. Decisions issued by the High Court and Court of Appeal are published in the Singapore Law Reports and Singapore Law Reports (Reissue) (which are the official law reports series of Singapore), in addition to being made available on LawNet Singapore, Singapore's legal online platform for decisions and judgments in Singapore (see: <https://www.lawnet.sg/lawnet/web/lawnet/home>).

### III. Opposition Proceedings

- 3.1. There are no procedures available for pre-grant opposition proceedings for Singapore patent applications. Opposition proceedings only arise within the context of post-grant matters, such as a standalone application to amend the specification, or an application to amend the specification in the context of revocation proceedings. The latter will be discussed in detail in **Section IV: Revocation Proceedings** below.  
(See **Section VI: Other Procedures to Challenge the Patentability of a Patent Application Before and After Grant, paragraph 6.1.1** for discussions on the new pre-grant third party observation procedures (unimplemented). For procedures to challenge the validity of a patent after grant, see **Section IV, Section V: Invalidation Proceedings** and **Section VI, paragraph 6.1.2.**)

### IV. Revocation Proceedings

- 4.1. **Grounds for Revocation.** Section 80(1) of the *Patents Act* sets out the grounds upon which a patent may be revoked:
- (a) The invention is not a patentable invention;
  - (b) The patent was granted to a person who was not entitled to be granted that patent;
  - (c) The patent specification fails to disclose the invention clearly and completely for it to be performed by a person skilled in the art;
  - (d) The matter disclosed in the patent specification extends beyond what has been disclosed in the filed patent application;
  - (e) An amendment or correction has been made to the specification, which should not have been allowed;
  - (f) The patent was obtained fraudulently, on any misrepresentation or on any non-disclosure or inaccuracy in disclosure of any prescribed material information, regardless of whether the person under the duty to provide the information knew or ought to have reasonably known of such information or inaccuracy; and

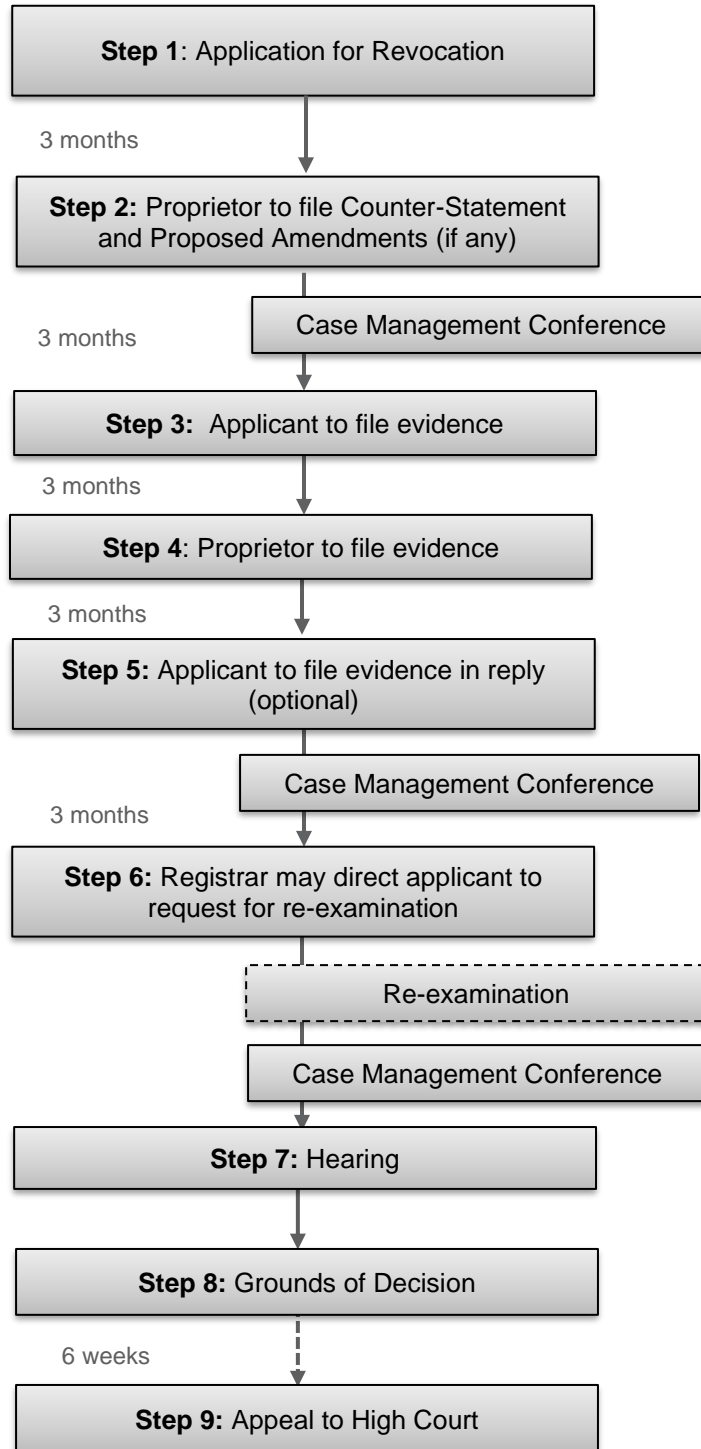
- (g) The patent is one of 2 or more patents for the same invention having the same priority date and filed by the same party or its successor in title.
- 4.2. On an application to revoke a patent on any of the grounds specified in (a), (c), (d) and (e), the Registrar may direct the patent to be re-examined by a patents examiner so as to determine whether the patent should be revoked on any of those grounds.<sup>34</sup> The applicant will be required to file Patents Form 36 and pay the prescribed re-examination official fee of S\$900.<sup>35</sup>
- 4.3. **Eligible Persons.** Any person may apply to revoke a granted patent by filing an application for revocation.<sup>36</sup>
- 4.4. **Procedure for Revoking a Granted Patent.** An overview of the procedural steps and timelines for revoking a granted patent is set out below.

---

<sup>34</sup> Section 80(2), *Patents Act*.

<sup>35</sup> <https://www.ipos.gov.sg/resources/patent>.

<sup>36</sup> Section 80(1), *Patents Act*.



Flowchart C-2: Overview of the procedural steps and timelines for revoking a granted patent.

- 4.4.1. **Step 1: Application for Revocation.** Revocation proceedings are *inter partes* and at present can only be initiated before the Registrar of Patents at the IPOS<sup>37</sup> by filing Patents Form 35 and a Statement of Grounds setting out the facts upon which the revocation action is based on and the relief sought by the applicant (together with payment of S\$500).<sup>38</sup> A copy of the same must be served on the proprietor of the patent at the time of filing the documents.<sup>39</sup>
- 4.4.2. **Step 2: Proprietor to File Counter-Statement and Proposed Amendments (if any).** The proprietor must, within 3 months from the date of receipt of the application for revocation, file a Counter-Statement in Form HC6 with the Registrar to contest the application (together with payment of S\$360).<sup>40</sup> A copy of the same must be served on the applicant at the time of filing the document. All facts raised in the application for revocation will be deemed conceded if no Counter-Statement is filed.<sup>41</sup>
- 4.4.2.1. The proprietor may also at the same time, file proposed amendments to the patent specification with the Counter-Statement in Form HC6, and serve a copy of the same to the applicant at the time of filing.<sup>42</sup> The proposed amendments will be published for opposition in the Patents Journal.<sup>43</sup> Any person may oppose the proposed amendments within 2 months from the date of publication by filing with the Registrar of Patents Form 58 and a Statement of Grounds setting out the facts upon which the opposition action is based on and the relief sought (together with payment of S\$480).<sup>44</sup> A copy of the same must be served on the proprietor of the patent at the time of filing the documents.<sup>45</sup>
- 4.4.2.2. After the Counter-Statement (and proposed amendments to the patent specification) are filed, the Registrar will convene a case management conference to provide parties with the opportunity to consider alternative dispute resolution means such as mediation or expert determination conducted by the WIPO Center.<sup>46</sup> If parties choose for proceedings to resume, the Registrar will discuss deadlines for the filing of evidence.
- 4.4.3. **Step 3: Applicant to File Evidence.** The applicant is required to file evidence in support of its case via a Statutory Declaration within 3 months from the date of receipt of the copy of the amendment (if any) and the Counter-Statement.<sup>47</sup> The application will be deemed abandoned if the applicant fails to do so.<sup>48</sup>

---

<sup>37</sup> Presently, revocation actions commenced as an independent action must be first heard before the Registrar of Patents at IPOS. Under the proposed amendments in the New Act, the High Court and the IPOS will have concurrent jurisdiction over patent revocation.

<sup>38</sup> Rule 80(1), *Patents Rules*.

<sup>39</sup> Rule 80(2), *Patents Rules*.

<sup>40</sup> Rule 80(3), *Patents Rules*.

<sup>41</sup> Rule 80(4), *Patents Rules*.

<sup>42</sup> Rule 80(3), *Patents Rules*.

<sup>43</sup> Rule 80(3), *Patents Rules* read with Section 83(1), *Patents Act*.

<sup>44</sup> Rules 85(1) and 85(2), *Patents Rules*.

<sup>45</sup> Rule 85(3), *Patents Rules*.

<sup>46</sup> <https://www.ipos.gov.sg/protecting-your-ideas/hearings-mediation/patent-revocation/revoking-a-granted-patent>.

<sup>47</sup> Rule 80(5), *Patents Rules*.

<sup>48</sup> Rule 80(6), *Patents Rules*.

- 4.4.4. **Step 4: Proprietor to File Evidence.** The proprietor may file evidence in support of its case via a Statutory Declaration within 3 months from the date of receipt of the applicant's evidence.<sup>49</sup>
- 4.4.5. **Step 5: Applicant to File Evidence in Reply (Optional).** The applicant may file further evidence for the purpose of strictly replying to the proprietor's evidence. This evidence in reply may be made via a Statutory Declaration as well within 3 months from the date of receipt of the proprietor's evidence.<sup>50</sup> After this stage, further evidence can only be filed with leave from the Registrar.<sup>51</sup> The Registrar will direct parties to attend a second case management conference, where matters such as the re-examination of the patent and the proposed amendments to the patent specification (if any) will be considered.
- 4.4.6. **Step 6: Registrar may Direct Applicant to Request for Re-Examination.** If the Registrar directs the applicant for revocation to request for re-examination, the applicant must file Patents Form 36 (together with payment of S\$900) within 2 months from the date of the Registrar's direction.<sup>52</sup> The application will be deemed abandoned if the applicant fails to do so.<sup>53</sup>
- 4.4.6.1. During the re-examination process, the patents examiner will take into account the representation of both parties and the proposed amendments filed (if any), and issue a re-examination report setting out:<sup>54</sup>
- (a) The patent examiner's recommendation (and arguments supporting the recommendation) as to whether the patent should be revoked;
  - (b) If proposed amendments are filed, the patent examiner's opinion as to whether the amendments of the patent specification are permitted, and whether they will successfully overcome the grounds of revocation specified in the revocation application.
- 4.4.6.2. The Registrar will direct parties to attend a third case management conference to discuss the application in light of the re-examination report and permitted amendments to the patent specification (if any). Where amendments to the patent specification have been permitted, the proprietor must file the amended patent specification within 1 month of the Registrar's direction. The Registrar will also discuss matters relating to the hearing, if the parties do not wish to negotiate. Such matters include whether there will be cross-examination; and whether the parties wish to attend an oral hearing or have a determination on the papers.
- 4.4.7. **Step 7: Hearing.** The Registrar will set a date to hear the arguments of the parties. Written submissions and bundles of authorities in the Written Submissions & Bundle of Authorities Form must be filed with the Registrar at least 1 month before the date of hearing and exchanged between the parties<sup>55</sup>. Parties must also file Form HC1

---

<sup>49</sup> Rule 80(7), *Patents Rules*.

<sup>50</sup> Rule 80(8), *Patents Rules*.

<sup>51</sup> Rule 80(9), *Patents Rules*.

<sup>52</sup> Rule 81(1)(a), *Patents Rules*.

<sup>53</sup> *Ibid.*

<sup>54</sup> Rule 81(1)(b), *Patents Rules*.

<sup>55</sup> Rule 88A(3), *Patents Rules*

(together with payment of S\$715) to indicate their intention to attend the oral hearing<sup>56</sup>.

4.4.8. **Step 8: Grounds of Decision.** The Registrar will issue a written decision setting out the grounds for the decision within 6 months from the date of the hearing in straightforward cases.<sup>57</sup> An order for the unconditional revocation of the patent, or where one of the grounds of revocation have been established but only so as to invalidate the patent to a limited extent, an order that the patent should be revoked unless amended within a specified time, may be made.<sup>58</sup> Costs are usually awarded to the winning party.

4.4.9. **Step 9: Appeal to High Court.** A party can contest the Registrar's decision by filing a Notice of Appeal with the High Court within six weeks from the date of the decision.<sup>59</sup> The appeal is heard by way of an *inter partes* hearing.

4.5. **Extensions of Time.** Parties may request for extensions of time at any point during the proceedings. The Registrar will grant such requests if it is satisfied that there is good and sufficient reason for the request.<sup>60</sup>

4.6. **Effect of Decision.** If an order for the revocation of the patent has been issued by the Registrar, the revocation of the patent shall have effect from the date of the grant of the patent.<sup>61</sup> The Registrar's decision will be final, unless parties file an appeal against the Registrar's decision to the High Court (they may file a subsequent appeal against the High Court's decision at the Court of Appeal)<sup>62</sup>.

4.7. **Publication of Decisions.** All decisions issued by the Registrar are available on the IPOS' website whereas decisions of the Singapore courts are published in the official law reports (see **Section II: Processing of a Patent Application, paragraph 2.7**).

## V. Putting Validity of Patent into Issue

5.1. **Putting Validity of Patent into Issue.** The validity of granted patents may only be challenged in limited types of proceedings. Section 82(1) of the *Patents Act* set out the proceedings within which the validity of a patent may be challenged:

- (a) By way of a defense, in proceedings for infringement of a patent or proceedings for infringements of rights conferred by the publication of an application;
- (b) In proceedings claiming relief for groundless threats of infringement proceedings;
- (c) In proceedings claiming relief for a declaration of non-infringement;
- (d) In revocation proceedings before a Registrar; or

---

<sup>56</sup> Rule 88A(4), *Patents Rules*

<sup>57</sup> <https://www.ipos.gov.sg/who-we-are/service-commitment>.

<sup>58</sup> Section 80(5)(a) and (b), *Patents Act*.

<sup>59</sup> Order 87A, rule 14(1)(b), *Rules of Court*.

<sup>60</sup> Rule 108(1), *Patents Rules*.

<sup>61</sup> Section 80(7), *Patents Act*.

<sup>62</sup> Section 90(3), *Patents Act*.

(e) In proceedings relating to the Government's use of a patented invention.

- 5.2. **Grounds for Putting Validity of Patent into Issue.** The grounds upon which a granted patent may be challenged are the same as those for the revocation of a patent (see **Section IV: Revocation Proceedings, paragraph 4.1**).<sup>63</sup>
- 5.3. **Eligible Persons.** Only parties to the relevant proceedings set out in paragraph 5.1 (a) to (e) may apply to invalidate a patent.
- 5.4. **Procedure for Putting the Validity of a Granted Patent into Issue.** Procedures for invalidating a granted patent will be different depending on whether the invalidation action is commenced before the IPOS or High Court (see **Chapter B: Adjudicatory Bodies and Forum, Section II: Forum, paragraph 2.1**). For the purposes of this survey report, we have limited the putting into issue of a patent's validity to be within the context of revocation proceedings. (see **Section IV: Revocation Proceedings, paragraph 4.4**).
- 5.5. **Effect of Decision.** The Registrar's decision will be final, unless parties choose to file an appeal against the Registrar's decision to the High Court (they may file a subsequent appeal against the High Court's decision at the Court of Appeal)<sup>64</sup>.
- 5.6. **Publication of Decisions.** All decisions issued by the Registrar are available on the IPOS' website whereas decisions of the Singapore courts are published in the official law reports (see **Section II: Processing of a Patent Application, paragraph 2.7**).

## VI. Other Procedures to Challenge the Patentability of a Patent Application Before and After Grant

- 6.1. The proposed amendments in the New Act, when in force, will formalize the pre-grant third party observation process for patent applications and introduce new post-grant patent re-examination process.

### 6.1.1. Pre-Grant Third Party Observations.

6.1.1.1. Presently, there are no formal procedures under the *Patents Act* or *Patents Rules* for submitting pre-grant third party observations. Third party observations may be submitted in writing by third parties on the patentability of an invention to the Registrar of Patents at any time before the issuance examination report in order for the Registrar of Patents to consider such observations in the examination report. Such observations are not made available to the public.<sup>65</sup>

6.1.1.2. The New Act seeks to introduce formal procedures for pre-grant third party observations as follows:

6.1.1.2.1. **Eligible Persons.** Any person may make observations in writing to the Registrar of Patents on the question of whether the invention is a patentable invention. A person will not become a party to any

---

<sup>63</sup> Section 82(3) read with Section 80, *Patents Act*.

<sup>64</sup> Section 90(3), *Patents Act*.

<sup>65</sup> The IPOS Interview.



proceedings under the *Patents Act* before the Registrar by reason only that the person has made such observations.

6.1.1.2.2. **Procedure for Submitting Third Party Observations.** New Section 32 of the *Patents Act* (when in force) will require parties to state, in writing to the Registrar of Patents, the observations made on the patentability of the invention and the reasons for the observations made. These observations, if filed within the specified timeframe in Section 32, will be published on the Patents Open Dossier.<sup>66</sup> Further information and guidelines on the procedure will be issued when new Section 32 comes into force.

6.1.1.2.3. **Effect of Submissions.** The observations must be received by the Registrar of Patents after publication and before issuance of the examination report in order for the Registrar of Patents to consider such observations in the examination report.

## 6.1.2. Post-Grant Patent Re-examination.

6.1.2.1. Presently, the only recourse for persons to challenge the patentability of an invention is to commence revocation proceedings (see **Section IV: Revocation Proceedings**). There is no available procedure that allows for a person to request for patent to be re-examined after grant.

6.1.2.2. The New Act seeks to introduce a new post-grant patent re-examination process as follows:

6.1.2.2.1. **Eligible Persons.** Any person may apply for the Registrar of Patents to conduct a re-examination of a patent. The applicant will not become a party to any proceedings under the Patents Act before the Registrar by reason only that the person files a request for re-examination, unless the applicant is the proprietor of the patent.

6.1.2.2.2. **Grounds for Post-Grant Re-Examination.** New Section 38A(1) of the *Patents Act* (when in force) will set out the grounds upon which a patent will be re-examined:

- (a) The invention is not a patentable invention;
- (b) The patent specification fails to disclose the invention clearly and completely for it to be performed by a person skilled in the art;
- (c) The matter disclosed in the patent specification extends beyond what has been disclosed in the filed patent application;
- (d) An amendment has been made to the specification, which results in the specification disclosing any additional matter or extends the protection conferred by the patent;

---

<sup>66</sup> The IPOS Interview.

- (e) A correction has been made to the specification, which should not have been allowed; and
- (f) The patent is one of 2 or more patents for the same invention having the same priority date and filed by the same party or its successor in title.

6.1.2.2.3. **Procedure to Request for Post-Grant Re-Examination.** New Section 38A(2) of the *Patents Act* (when in force) will require parties to file an application setting out the grounds for the requested re-examination, the reasons to substantiate the grounds specified, any document that the applicant considers relevant for the purposes of the re-examination, and pay an official fee.

- (a) **Registrar Grants the Request.** If the Registrar of Patents grants the request, the Registrar will direct the patent to be re-examined by a patent examiner. The patents examiner will issue a written opinion to the proprietor if the patents examiner is of the view that the grounds have been made out. The proprietor has an opportunity to respond to the written opinion in writing before a re-examination report is issued. Where unresolved objections remain, the patents examiner will issue a negative re-examination report and the Registrar of Patents will make an order revoking the patent.
- (b) **Registrar Rejects the Request.** The Registrar of Patents may reject any request that fails to comply with the formalities requirements as set out in new Section 38A(2) or if the Registrar is of the view that the request is frivolous, vexatious, or an abuse of the process.

6.1.2.2.4. Further information and guidelines on the procedure will be issued when new Section 38A comes into force.

6.1.2.3. **Effect of the Decision.** If an order for the revocation of the patent has been issued by the Registrar of Patents, the revocation of the patent shall have effect from the date of the grant of the patent; and could be:

- (a) An order for the unconditional revocation of the patent; or
- (b) Where the grounds have been established but only invalidates the patent to a limited extent, an order that the patent should be revoked unless the patent is amended to the satisfaction of the Registrar of Patents.

6.1.2.3.1. The Registrar of Patents' decision will be final, unless the proprietor chooses to file an appeal against the decision at the High Court. This appeal procedure is similar to the appeal procedure for revocation proceedings (see **Section IV: Revocation Proceedings, paragraph 4.4.9.**)

## VII. Statistics<sup>67</sup>

### 7.1. IPOS Statistics.

7.1.1. **Filings.** Patent dispute cases filed with the IPOS between years 2001 to 2018:

	2001-2010	2011	2012	2013	2014	2015	2016	2017	2018
Revocation Proceedings	20	2	0	0	1	2	0	3	2
Other proceedings <sup>68</sup>	-	-	3	0	0	1	0	0	1

7.1.2. **Hearings.** Patent dispute cases heard by the IPOS between years 2001 to 2018:

Type of hearing / Year	2001–2010	2011	2012	2013	2014	2015	2016	2017	2018
<i>Ex-parte</i> Hearings	9	3	0	0	0	0	1	0	0
<i>Inter-partes</i> Hearings <sup>69</sup>	Oppositions	-	-	-	0	0	0	0	1
	<i>Revocations</i>	2	0	0	0	0	1	1	2

7.1.3. **Hearings Outcomes.** Success rate of patent dispute cases heard by the IPOS between years 2001 to 2018:

Type of hearing / Year	2001 – 2010 <sup>70</sup>	2011	2012	2013	2014	2015	2016	2017	2018
<i>Ex-parte</i> Hearings (successful / unsuccessful)	N/A	2 / 0	0 / 0	0 / 0	0 / 0	0 / 0	0 / 1	0 / 0	0 / 0
<i>Inter-partes</i> Hearings <sup>71</sup>	Oppositions	N/A	-	-	-	0 / 0	0 / 0	0 / 0	0 / 0
	<i>Revocations</i>	N/A	0 / 0	1 / 0	0 / 0	0 / 0	1 / 0	1 / 0	2 / 0

<sup>67</sup> The data is obtained from the IPOS' published statistics set out in the Annex.

<sup>68</sup> "Other proceedings" include cases such as "Patent Entitlement" or "Opposition to Inventorship".

<sup>69</sup> The findings stated are limited to revocation hearings.

<sup>70</sup> The data for 2001 – 2010 is not published.

<sup>71</sup> The findings stated are limited to revocation hearings.

7.2. **Appeal Outcomes.** Patent dispute decisions from the IPOS that were appealed before the High Court and/or Court of Appeal between years 2001 to 2018.

Type of hearing / Year	2001 – 2010	2011	2012	2013	2014	2015	2016	2017	2018
Appeals to High Court / Court of Appeal for patents	2	0	1	0	0	0	0	0	0
IPOS Decision Upheld / Overturned	N/A <sup>72</sup>	0 / 0	0 / 1	0 / 0	0 / 0	0 / 0	0 / 0	0 / 0	0 / 0

7.3. **Court Statistics.** The Singapore courts do not publish official statistics about the hearings before the courts.

## VIII. Case study

8.1. ***Sunseap Group Pte Ltd and 2 Ors v Sun Electric Pte Ltd* [2019] 1 SLR 645<sup>73</sup>**

8.1.1. In a recent decision, ***Sunseap Group Pte Ltd and 2 Ors v Sun Electric Pte Ltd* [2019] 1 SLR 645**, the Court of Appeal considered whether the Singapore High Court would have the jurisdiction to hear patent revocation proceedings at first instance since most patent revocation proceedings are generally heard at first instance at the Registrar level (see **Section IV: Revocation Proceedings**).

8.1.2. **Facts.** The respondent patent proprietor commenced infringement proceedings alleging that the appellants had infringed 8 out of 12 claims in its Singapore patent. The appellants counterclaimed that all the patents' claims were invalid and sought a declaration of invalidity and an order for the patent to be revoked. The High Court Assistant Registrar held, amongst others, that revocation proceedings could be commenced in the High Court by way of counterclaim. The respondent appealed this finding to the High Court, which allowed the respondent's appeal. On appeal to the Court of Appeal, the 5-judge panel reversed the High Court's decisions.

8.1.3. **Finding.** The Court of Appeal clarified that there are two categories of cases where revocation might be at issue.

- (a) In infringement proceedings where revocation proceedings are brought by way of defense and counterclaim, the *Patents Act* confers original jurisdiction on the High Court to determine the validity of the patent. However, since validity can only be in issue by way of defense, such issues of validity are confined to the asserted claims that are put in issue. Furthermore, where all claims or independent claims in the patent are invalid, the High Court could exercise its power to revoke the patent. However, where there are independent claims (and the validity of which has not been disputed), the

<sup>72</sup> The data for 2001 – 2010 is not published.

<sup>73</sup> The full grounds of decisions can be found at: <https://www.supremecourt.gov.sg/docs/default-source/module-document/judgement/ca-ca-190-of-2017-pdf.pdf>

High Court should not revoke the patent but instead may allow the proprietor to amend the specification in a manner and subject to such terms as the court thinks fit.

- (b) In non-infringement proceedings where revocation applications are made, the High Court does not have jurisdiction to determine the validity of the patent and original jurisdictional vests exclusively in the Registrar.

## 8.2. **Element Six Technologies Ltd v Ila Technologies Pte Ltd [2020] SGHC 26**<sup>74</sup>

8.2.1. **Brief Summary.** In relation to the issue of the distinction between dependent and independent claims, this Court of Appeal suggests that *Sunseap* requires qualification: “[i]f the court finds in the defendant’s favour that the independent claims are invalid, it follows that the dependent claims must also fall unless one or more of them can be shown to be independently valid.”

## 8.3. **Singapore Shipping Association and Association of Singapore Marine Industries v Hitachi, Ltd. and Mitsubishi Shipbuilding Co., Ltd. [2019] SGIPOS 5**<sup>75</sup>

8.3.1. **Brief Summary.** The decision related to an opposition that was made to the post-grant amendments. The Registrar rejected the amendments based on the factor (among other reasons) of “unfair advantage” as extended to a scenario of monetisation of patent. This goes beyond the traditional scenario of “unfair advantage” in the context of infringement (alleging infringement based on a patent that the proprietor knows needs amendment).

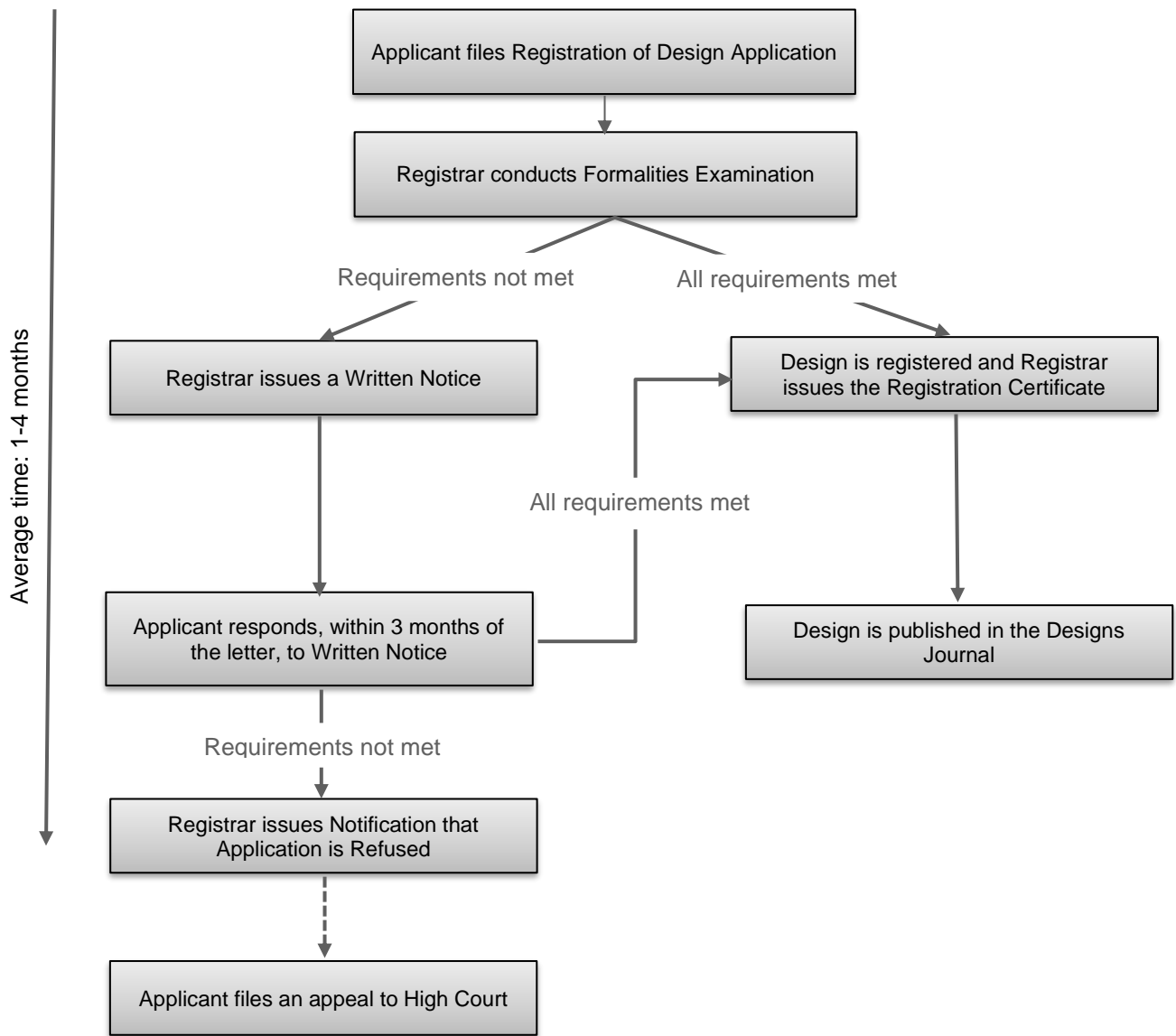
---

<sup>74</sup> The full grounds of decisions can be found at: [https://www.supremecourt.gov.sg/docs/default-source/module-document/judgement/-2020-sghc-26-\(r\)-pdf.pdf](https://www.supremecourt.gov.sg/docs/default-source/module-document/judgement/-2020-sghc-26-(r)-pdf.pdf)

<sup>75</sup> The full grounds of decisions can be found at: <https://www.ipos.gov.sg/docs/default-source/resources-library/hearings-and-mediation/legal-decisions/2019/singapore-shipping-association-and-association-of-singapore-marine-industries-v-hitachi-and-mitsubishi-shipbuilding-2019-sgipos-5.pdf>

**D. REGISTERED DESIGNS**

**I. Overview of the Design Application Process**



*Flowchart D-1: Overview of the Design Application Process.*

## II. Processing of a Design Registration Application

### 2.1. Formalities Examination Process.

2.1.1. **Applicant Responds, within 3 Months, to the Written Notice.** Design applications undergo only formalities examination. During the formalities examination process, the design examiner may issue a written notice if the formalities requirements are not met.<sup>76</sup> The formalities examination includes examining whether a design is, on the face of the application and by way of a visual inspection,<sup>77</sup> not new or not registrable for any reason as determined by the Registrar of Designs.<sup>78</sup> The applicant can respond to the written notice within 3 months from the date of the notice by filing:<sup>79</sup>

- (a) Written representations and/or amendments to the design application; or
- (b) Request to the Registrar of Designs for an *ex parte* hearing by filing Form HC4 (together with payment of S\$100). Written submissions and bundle of authorities must be submitted by the applicant 14 days before the date of hearing.<sup>80</sup>

2.1.2. **Registrar Issues the Registration Certificate or Notification that the Application is Refused.**

- (a) If the formality requirements are met, the Registrar will issue the registration certificate and the design will be published in the Designs Journal.
- (b) If the formality requirements are not met, the Registrar will issue a notification informing the applicant that the designs application has been refused.

2.1.3. **Applicant Files an Appeal to the High Court.** If the applicant wishes to contest the notification of refusal of registration, an appeal may be made to the High Court.<sup>81</sup>

2.2. **Effect of Decision.** Unless the applicant appeals the Registrar's decision to the High Court, the Registrar's decision will be final.<sup>82</sup>

2.3. **Publication of Non-Final and Final Decisions.** All decisions issued by the Registrar and the Singapore courts are issued in the English language. Whilst the Registrar's decisions will be issued to the applicants, they will not be published. Decisions issued by the High Court and Court of Appeal are published in the Singapore Law Reports and Singapore Law Reports (Reissue) (which are the official law reports series of Singapore), in addition to being made available on LawNet Singapore, Singapore's legal online platform for decisions and judgments in Singapore (see: <https://www.lawnet.sg/lawnet/web/lawnet/home>).

---

<sup>76</sup> Rule 27(2), *Registered Designs Rules*.

<sup>77</sup> The IPOS Interview.

<sup>78</sup> Section 17(2), *Registered Designs Act* read with IPOS Circular Nos. 1 and 4 of 2019

<sup>79</sup> Rule 27(3), *Registered Designs Rules*.

<sup>80</sup> Rule 27(6), *Registered Designs Rules*.

<sup>81</sup> Section 62(1), *Registered Designs Act*.

<sup>82</sup> Section 62(2A), *Registered Designs Act*.

### III. Opposition Proceedings

3.1. N/A.

### IV. Revocation Proceedings

4.1. **Grounds for Revocation.** Section 27 of the *Registered Designs Act* sets out the grounds upon which a registered design may be revoked:

- (a) At the date of its registration, the design was not new;<sup>83</sup>
- (b) On any other ground on which the Registrar could have refused to register the design;<sup>84</sup>  
or
- (c) At the time of registration, the design was a corresponding design in relation to an artistic work in which copyright subsisted and the right has expired (ie, the copyright in the work expired).<sup>85</sup>

4.2. **Eligible Persons.** At any time after a design has been registered, any interested person may apply to the Registrar or the Court for the revocation of the registration of the design by filing an application for revocation.<sup>86</sup>

4.3. **Procedure for Revoking a Registered Design.** Procedures for revoking a registered design will be different depending on whether the revocation action is commenced before the IPOS or High Court (see **Chapter B: Adjudicatory Bodies and Forum, Section II: Forum, paragraph 2.1**). If however, there are any proceedings concerning a registered design pending before the High Court, the revocation proceedings for the same registered design must be commenced at the High Court.<sup>87</sup> The Registrar may also at any time refer any revocation proceedings to the High Court.<sup>88</sup> For the purposes of this survey report, an overview of the procedural steps and timelines for revoking a registered design before the IPOS is set out below.

---

<sup>83</sup> Section 27(1), *Registered Designs Act*.

<sup>84</sup> *Ibid.*

<sup>85</sup> Section 27(2), *Registered Designs Act*.

<sup>86</sup> Section 27(1), *Registered Designs Act*.

<sup>87</sup> Section 27(3), *Registered Designs Act*.

<sup>88</sup> Section 27(4), *Registered Designs Act*.





*Flowchart D-2: Overview of the procedural steps and timelines for revoking a registered design.*

- 4.3.1. **Step 1: Application for Revocation.** Revocation proceedings are *inter partes* and can be initiated at IPOS<sup>89</sup> by filing Designs Form 13 and a Statement of Grounds setting out the facts upon which the revocation action is based on<sup>90</sup> and add the relief sought by the application (together with a payment of S\$400 in respect of each design).<sup>91</sup> A copy of the same must be served on the registered owner of the design at the time of filing the documents.
- 4.3.2. **Step 2: Registered Owner to File Counter-Statement.** The registered owner must, within 2 months from the date of receipt of the application for revocation, file a Counter-Statement in Form HC6 (together with a payment of S\$360) with the Registry to contest the application.<sup>92</sup> A copy of the same must be served on the applicant at the time of filing the document.<sup>93</sup> All facts raised in the application for revocation will be deemed conceded and the application for revocation granted if no Counter-Statement is filed.<sup>94</sup>
- 4.3.2.1. The Registrar will convene a case management conference to provide parties with the opportunity to consider alternative dispute resolution means such as mediation which will be conducted by the WIPO Center. If parties choose for proceedings to resume, the Registrar will specify deadlines for the filing of evidence.<sup>95</sup>
- 4.3.3. **Step 3: Applicant to File Evidence.** The applicant is required to file evidence in support of its case via a Statutory Declaration within 3 months from the date of receipt of the Counter-Statement.<sup>96</sup> The application will be deemed withdrawn if the applicant fails to do so.<sup>97</sup>
- 4.3.4. **Step 4: Registered Owner to File Evidence.** The registered owner may file evidence in support of its case via its case via a Statutory Declaration within 3 months from the date of receipt of the applicant's evidence.<sup>98</sup> If no evidence is filed, the registered owner will be deemed to have admitted to the facts alleged by the applicant.<sup>99</sup>
- 4.3.5. **Step 5: Applicant to File Evidence in Reply (Optional).** The applicant may file further evidence for the purpose of strictly replying to the registered owner's evidence.<sup>100</sup> This evidence in reply may be made via a Statutory Declaration as well within 3 months from the date of receipt of the proprietor's evidence.<sup>101</sup> After this stage, further evidence can only be filed with leave from the Registrar.<sup>102</sup>
- 4.3.6. **Step 6: Hearing.** The Registrar will set a date to hear the arguments of the parties. Written submissions and bundles of authorities in the Written Submissions & Bundle of Authorities Form must be filed with the Registry at least 1 month before the date of

---

<sup>89</sup> Section 27(1), *Registered Designs Act*.

<sup>90</sup> Rule 40, *Registered Designs Rules*.

<sup>91</sup> <https://www.ipos.gov.sg/resources/design>.

<sup>92</sup> Rule 41(1), *Registered Designs Rules*.

<sup>93</sup> Rule 41(2), *Registered Designs Rules*.

<sup>94</sup> Rule 41(8A), *Registered Designs Rules*.

<sup>95</sup> The IPOS Interview.

<sup>96</sup> Rule 42(1), *Registered Designs Rules*.

<sup>97</sup> Rule 42(2), *Registered Designs Rules*.

<sup>98</sup> Rule 43(1), *Registered Designs Rules*.

<sup>99</sup> Rule 43(2), *Registered Designs Rules*.

<sup>100</sup> Rule 44(3), *Registered Designs Rules*.

<sup>101</sup> Rule 44(1), *Registered Designs Rules*.

<sup>102</sup> Rule 45, *Registered Designs Rules*.

hearing and exchanged between the parties.<sup>103</sup> Parties must also file Form HC1 (together with payment of S\$715) to indicate their intention to attend the oral hearing.<sup>104</sup> At the pre-hearing review, parties who prefer a written decision without a hearing may inform the Registrar of their preference. However, if one party still wishes to proceed with a hearing, the hearing will take place in person and the other party may choose whether or not to be heard at the hearing.<sup>105</sup>

4.3.7. **Step 7: Grounds of Decision.** The Registrar will issue a written decision setting out the various grounds and arguments for the decision made within 3 months from the date of the hearing.<sup>106</sup> Costs will usually be awarded to the winning party.

4.3.8. **Step 8: Appeals to High Court.** If a party wishes to contest the Registrar's decision, an appeal may be made to the High Court.

4.4. **Extension of Time.** Parties may request for extensions of time at any point during the proceedings. The Registrar will grant such requests if it is satisfied that there is good and sufficient reason for the request.<sup>107</sup>

4.5. **Effect of Decision.** If an order for the revocation of a registered design is granted under paragraphs 4.1(a) or (b) above, the design will be revoked from the date of the registration.<sup>108</sup> If the registered design is revoked under paragraph 4.1(c) above, the revocation takes effect from the date the right in the registered design expired.<sup>109</sup> The Registrar's decision will be final, unless parties choose to file an appeal against the Registrar's decision to the High Court (parties may file a subsequent appeal against the High Court's decision at the Court of Appeal).<sup>110</sup>

4.6. **Publication of Decisions.** All decisions issued by the Registrar are available on the IPOS' website whereas decisions of the Singapore courts are published in the official law reports (see **Section II: Processing of a Design Registration Application, paragraph 2.3**).

## V. Invalidation Proceedings

5.1. N/A.

## VI. Statistics<sup>111</sup>

6.1. **IPOS Statistics.**

---

<sup>103</sup> Rule 48(2), *Registered Designs Rules*

<sup>104</sup> Rule 48(3), *Registered Designs Rules*.

<sup>105</sup> HMG Circular No. 4/2015 dated 30 June 2015, and the IPOS Interview.

<sup>106</sup> <https://www.ipos.gov.sg/who-we-are/service-commitment>.

<sup>107</sup> Rules 57(1) and 57(4), *Registered Designs Rules*.

<sup>108</sup> Section 27(6), *Registered Designs Act*.

<sup>109</sup> Section 27(6), *Registered Designs Act*.

<sup>110</sup> Section 62, *Registered Designs Act*.

<sup>111</sup> The data is obtained from the IPOS' published statistics set out in the Annex.

6.1.1. **Filings.** Design dispute cases filed with the IPOS between years 2001 to 2018:

Type of hearing / Year	2001 – 2010	2011	2012	2013	2014	2015	2016	2017	2018
Revocation	6	1	1	0	0	0	0	0	0

6.1.2. **Hearings.** There were no design dispute cases heard by the IPOS between years 2001 to 2018.

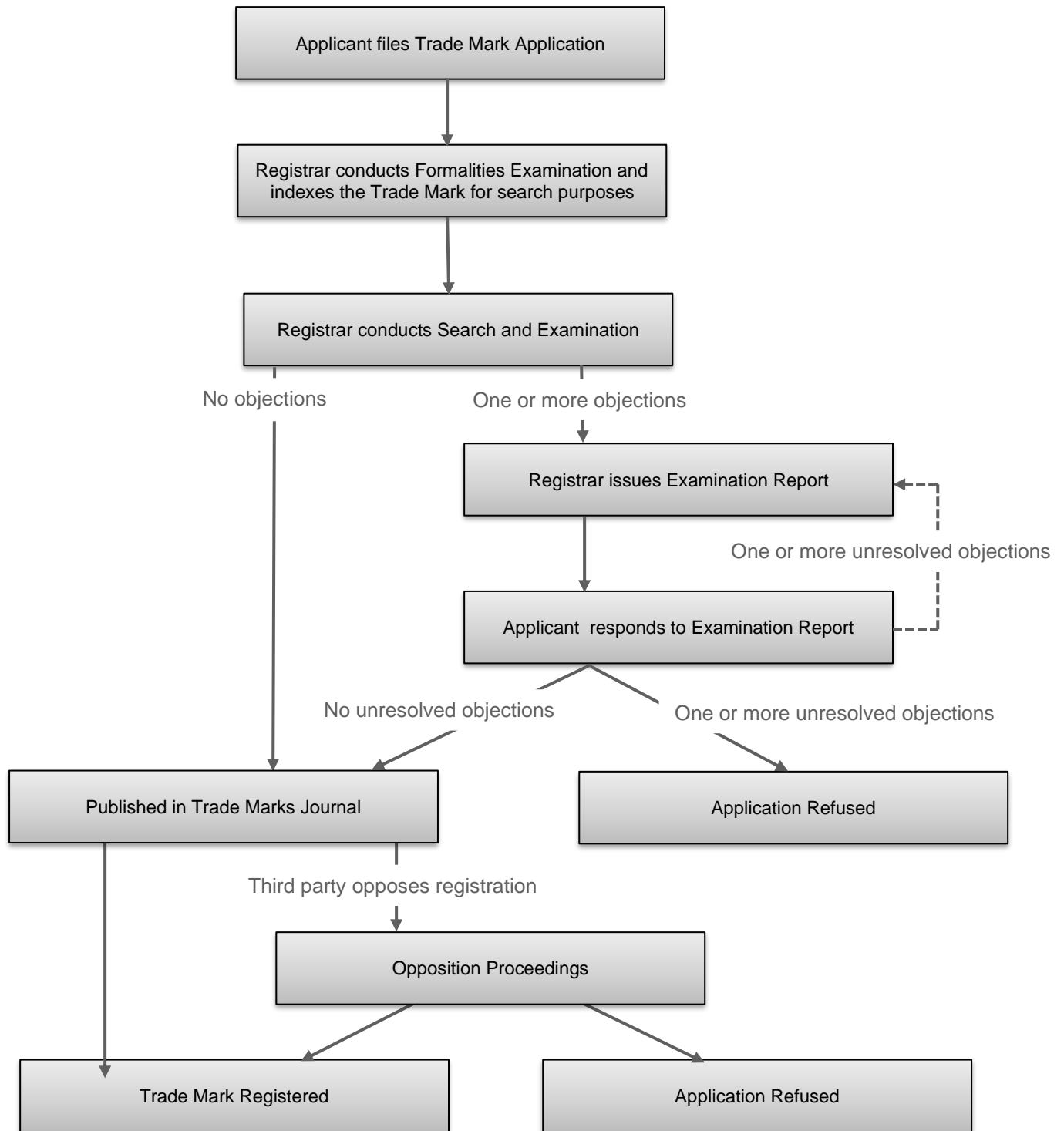
6.2. **Court Statistics.** The Singapore courts do not publish official statistics about the hearings before the courts.

## VII. Case Study

7.1. There have been no recent Singapore cases reported in relation to revocation proceedings brought under the *Registered Designs Act*.

**E. TRADE MARKS**

**I. Overview of the Trade Mark Application Process**



*Flowchart E-1: Overview of the Trade Mark Application Process*

## II. Processing of a Trade Mark Application

### 2.1. Examination Process.

2.1.1. **Applicant Responds, within 4 Months to the Examination Report.** During the search and examination process, the Registrar of Trade Marks may issue one or more examination report(s) stating the grounds of refusal if it appears to the Registrar of Trade Marks that the requirements for registration are not met or that additional information or evidence is required to meet those requirements.<sup>112</sup> The applicant can respond to the examination report(s) within 4 months from the date of the examination report:<sup>113</sup>

- (a) By filing written representations and/or amendments to the goods/services specification to the Registrar of Trade Marks. There is no official form and fee for responding to the examination report by way of written representations. For filing of amendments in respect of national applications, the applicant could do so via the amendment form (Form TM27) and the requisite fee (S\$40 per trade mark, if the request excludes amendments to applicant name/particulars, goods/services and associated priority claim details; S\$40 per class of goods/services, if the request excludes amendments to applicant name/particulars but includes goods/services and associated priority claim details).<sup>114</sup> For filing of amendments for an international registration designating Singapore in respect of goods/services refused by the Registrar, the international registration holder could submit the amendments in writing to IPOS (no fee required);
- (b) For second (or subsequent) examination reports, by writing to the Registrar of Trade Marks to request for re-consideration of the examination report. Upon such request, the Registrar of Trade Marks will appoint a fresh panel of experienced examiners to review the examination decision. Where the panel of examiners maintains the objections raised in the examination report, a final refusal against the application will be issued.<sup>115</sup>

### 2.2. *Ex Parte* Hearing.

2.2.1. Notwithstanding paragraph 2.1.1, an applicant can respond to the examination report(s) by requesting for an *ex parte* hearing by filing Form HC4 (together with payment of S\$100) with the Registrar. Written submissions and bundle of authorities must be submitted by the applicant 14 days before the date of hearing.<sup>116</sup>

2.2.2. The Registrar will issue his decision either during the hearing or in writing.<sup>117</sup> The applicant can request for the written grounds of decision by filing Form HC 5 (together with a payment of S\$700) within 1 month from the date of the Registrar's decision.<sup>118</sup> The Registrar will send its grounds of decision within 2 months from the filing of Form HC 5.<sup>119</sup>

---

<sup>112</sup> Rule 24(1), *Trade Marks Rules*.

<sup>113</sup> Rules 24(2), 24(3) and 24(4), *Trade Marks Rules*.

<sup>114</sup> Rules 16(6), 22(1), item 10 (First Schedule), *Trade Marks Rules*.

<sup>115</sup> IPOS Circular No. 8/2015 (13 October 2015).

<sup>116</sup> Rule 24(4), *Trade Marks Rules*.

<sup>117</sup> Rule 24(5), *Trade Marks Rules*.

<sup>118</sup> Rule 24(6)(a), *Trade Marks Rules*.

<sup>119</sup> Rule 24(6)(b), *Trade Marks Rules*.

2.2.3. **Applicant Files an Appeal to High Court.** An applicant can contest the Registrar's grounds of decision by filing a Notice of Appeal with the High Court within 28 days from the date of the decision.<sup>120</sup> The appeal is heard by way of an *ex parte* hearing.

2.2.4. **Effect of decision.** Unless the applicant appeals the Registrar's decision to the High Court, the Registrar's decision will be final.<sup>121</sup>

### 2.3. Registrar Accepts Application for Publication or Refuses the Application.

(a) If the objections are overcome, the trade mark will be published in the Trade Marks Journal and will be open for opposition proceedings for 2 months.<sup>122</sup>

(b) For trade marks which underwent *ex parte* hearings, if the final hearing outcome is unsuccessful (i.e., no further possible appeals can be filed, and/or any appeal has ended), the trade mark application shall be refused.

2.4. **Publication of Non-Final and Final Decisions.** All decisions issued by the Registrar and the Singapore courts are issued in the English language. Whilst the Registrar's decisions will be made to the applicants in writing, they will not be published to the public. For *ex parte* hearings, the Registrar's grounds of decision will be issued and published on the IPOS website if the applicant has requested for the written grounds of decision.<sup>123</sup> Decisions issued by the High Court and Court of Appeal are published in the Singapore Law Reports and Singapore Law Reports (Reissue) (which are the official law reports series of Singapore), in addition to being made available on LawNet Singapore, Singapore's legal online platform for decisions and judgments in Singapore (see: <https://www.lawnet.sg/lawnet/web/lawnet/home>).

## III. Opposition Proceedings

3.1. **Grounds for Opposition.** Sections 7 and 8 of the *Trade Marks Act* set out the grounds upon which a trade mark application which has been accepted for registration by the Registrar of Trade Marks and published may be opposed.

### 3.1.1. Section 7: Absolute Grounds for Refusal of Registration.

3.1.1.1. Trade marks that fall under one or more of the following circumstances:

- (a) Devoid of distinctive character;
- (b) Descriptive of the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services;
- (c) Generic (common in trade);
- (d) Deceptive;
- (e) Contrary to public policy or morality;
- (f) Use is prohibited in Singapore by law; or
- (g) Applied for in bad faith.

<sup>120</sup> Order 87, rule 4(3), *Rules of Court*.

<sup>121</sup> Section 75(2)(a), *Trade Marks Act*.

<sup>122</sup> Rules 26(1) and 29(1), *Trade Marks Rules*.

<sup>123</sup> Rule 24(6), *Trade Marks Rules*. Note: grounds of decision may be issued even if parties do not request for it, especially if the matter decided has jurisprudential value.

### 3.1.2. Section 8: Relative Grounds for Refusal of Registration.

3.1.2.1. Trade marks that are identical to an earlier mark <sup>124</sup> (with identical goods/services) or likely to cause confusion to the public under the following circumstances:

No.	Application Mark	Goods/Services	Other requirements
(i)	Identical to earlier mark	Goods/Services identical	-
(ii)	Identical to earlier mark	Goods/Services similar	<ul style="list-style-type: none"> <li>There exists a likelihood of confusion on the part of the public.</li> </ul>
(iii)	Similar to earlier mark	Goods/Services identical or similar	
(iv)	Identical or similar to earlier mark	Goods/Services identical, similar or dissimilar	<ul style="list-style-type: none"> <li>The earlier trade mark is well known in Singapore.</li> <li>Use of the application mark would indicate a connection between the applicant's good/services and the owner of the earlier trade mark, and such use is likely to damage the interests of the owner of the earlier trade mark.</li> </ul>
(v)	Identical or similar to earlier mark	Goods/Services identical, similar or dissimilar	<ul style="list-style-type: none"> <li>The earlier trade mark well known to the public at large in Singapore.</li> <li>Use of the application mark would cause dilution in an unfair manner, or take advantage of, the distinctive character of the earlier trade mark.</li> </ul>

<sup>124</sup> The following qualifies as an "earlier mark" under the Trade Marks Act, Section 2: (i) a registered or pending trade mark or an international trade mark (Singapore) whose date for application is earlier than that of an Application Mark (taking into account any priority claims made in respect of the trade marks). This includes pending applications, provided that the trade mark is eventually registered; (ii) a registered trade mark which, at the date the Application Mark was filed (taking into account any priority claims made in respect of the trade marks), is well known in Singapore; or (iii) an unregistered trade mark which, at the date the Application Mark was filed (taking into account any priority claims made in respect of the trade marks), is well known in Singapore and the owner is from a Paris Convention or World Trade Organisation ("WTO") country or is domiciled in and has a real and effective industrial or commercial establishment in a Paris Convention or WTO country. This is regardless of whether the owner of the well known trade mark carries on business, or has any goodwill in Singapore.



3.1.2.2. Trade marks will also not be registered if their use in Singapore is liable to be prevented by virtue of any law that protects unregistered trade marks (such as the law of passing off) or by virtue of an earlier right (such as the copyright or protection of designs rights).<sup>125</sup>

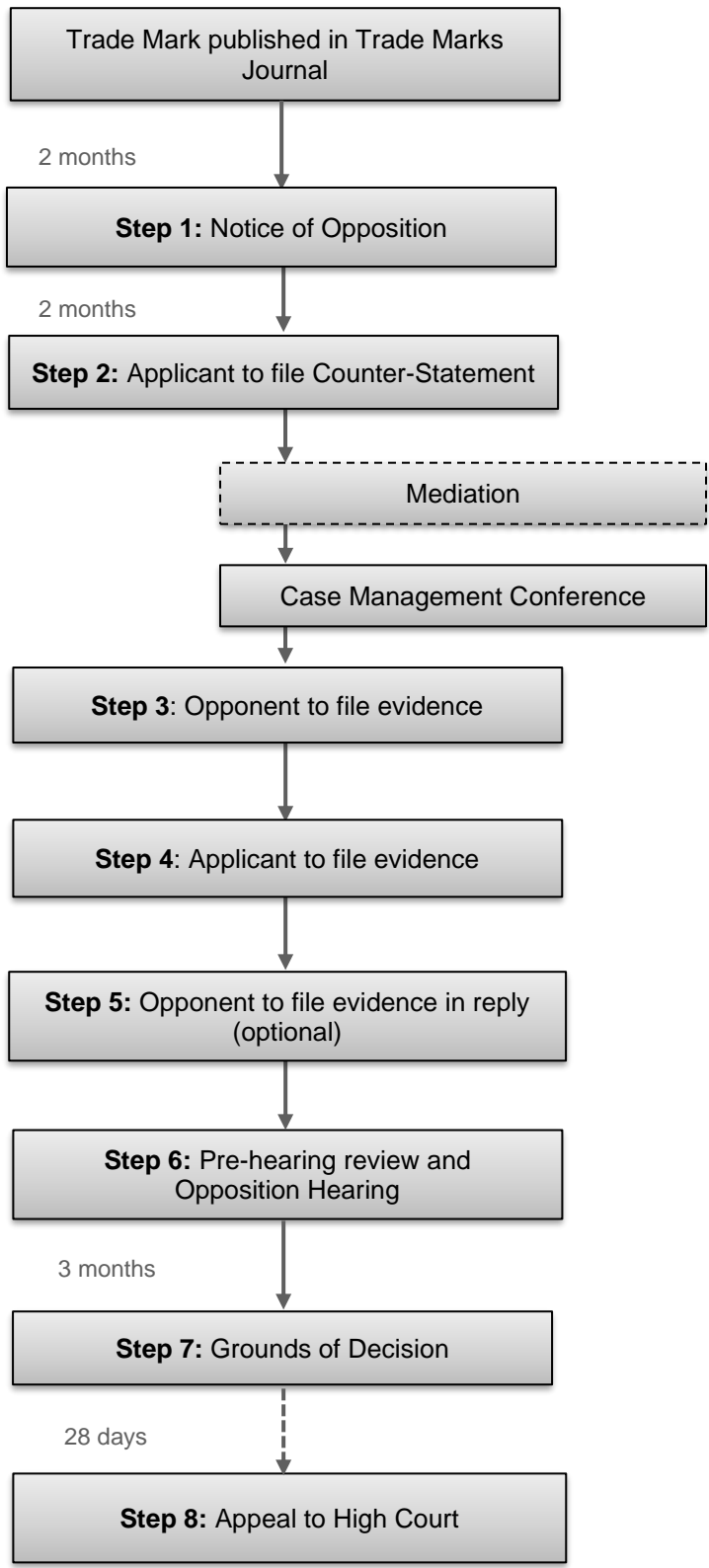
3.2. **Eligible Persons.** Any person may object to a trade mark registration by commencing opposition proceedings.<sup>126</sup>

3.3. **Procedure for Opposition Proceedings.** An overview of the procedural steps and timelines for opposing a trade mark application for registration is set out below.

---

<sup>125</sup> Section 8(7), *Trade Marks Act*.

<sup>126</sup> Section 13(2), *Trade Marks Act*.



*Flowchart E-2: Overview of the procedural steps and timelines for opposing a trade mark application for registration.*

- 3.3.1. **Step 1: Notice of Opposition.** Opposition proceedings are *inter partes* and can be initiated with the Registrar of Trade Marks at the IPOS<sup>127</sup> by filing Trade Marks Form 11 (Notice of Opposition) and a Statement of Grounds setting out the facts upon which the opposition action is based on and the relief sought by the opponent (together with payment of S\$374 in respect of each class).<sup>128</sup> A copy of the same must be served on the trade mark applicant at the time of filing the documents.<sup>129</sup>
- 3.3.1.1. Under Rule 30(2) of the *Trade Marks Rules*, if an application for opposition is made on the basis of an identical or similar earlier trade mark (including when it is well-known in Singapore) (see **Section III: Opposition Proceedings, paragraph 3.1.2.1.**) the statement must include further details for the purpose of determining whether the application mark is identical or similar to an earlier trade mark. For registered earlier trade marks, such particulars include a representation of the earlier trade mark, its registration number, etc. For well-known earlier trade marks, information on the use of the earlier trade mark and information on any promotion undertaken for the earlier trade mark must be included.<sup>130</sup>
- 3.3.2. **Step 2: Applicant to File Counter-Statement.** The applicant must, within 2 months from the date of receipt of the application for opposition, file a Counter-Statement in Form HC6 with the Registrar to contest the application (together with payment of S\$360 in respect of each class).<sup>131</sup> A copy of the same must be served on the opponent at the time of filing the document.<sup>132</sup> The application will be deemed withdrawn if the applicant fails to do so.<sup>133</sup>
- 3.3.2.1. After the Counter-Statement is filed, the Registrar will convene a case management conference to provide parties with the opportunity to consider alternative dispute resolution means such as mediation which will be conducted by the WIPO Center. If parties choose for proceedings to resume, the Registrar will specify deadlines for the filing of evidence.<sup>134</sup>
- 3.3.3. **Step 3: Opponent to File Evidence.** The opponent is required to file evidence in support of its case via a Statutory Declaration within such deadline as specified by the Registrar.<sup>135</sup> The opposition will be deemed withdrawn if the opponent fails to do so.<sup>136</sup>
- 3.3.4. **Step 4: Applicant to File Evidence.** The applicant may file evidence in support of its case via a Statutory Declaration within such deadline as specified by the Registrar.<sup>137</sup> If no evidence is filed, the applicant will be deemed to have withdrawn its application for registration of the trade mark.<sup>138</sup>

---

<sup>127</sup> Section 13(2), *Trade Marks Act*.

<sup>128</sup> Rules 29(1) and 29(3), *Trade Marks Rules*.

<sup>129</sup> Rule 29(2), *Trade Marks Rules*.

<sup>130</sup> Rules 30(2) and 30(3), *Trade Marks Rules*.

<sup>131</sup> Rule 31(1), *Trade Marks Rules*.

<sup>132</sup> Rule 31(2), *Trade Marks Rules*.

<sup>133</sup> Rule 31(3), *Trade Marks Rules*.

<sup>134</sup> The IPOS Interview.

<sup>135</sup> Rules 31A(1)(a) and 31A(2), *Trade Marks Rules*.

<sup>136</sup> Rule 31A(8), *Trade Marks Rules*.

<sup>137</sup> Rules 31A(1)(b) and 31A(4), *Trade Marks Rules*.

<sup>138</sup> Rule 31A(9), *Trade Marks Rules*.

- 3.3.5. **Step 5: Opponent to File Evidence in Reply (Optional).** The opponent may file further evidence for the purpose of strictly replying to the applicant's evidence.<sup>139</sup> This evidence in reply may be made via a Statutory Declaration as well within such deadline as specified by the Registrar.<sup>140</sup> After this stage, further evidence can only be filed with leave from the Registrar.<sup>141</sup>
- 3.3.6. **Step 6: Pre-hearing Review and Opposition Hearing by Registrar.** The Registrar will direct parties to attend a pre-hearing review, where matters such as possible settlement of the dispute will be considered.<sup>142</sup> The Registrar will then set a date to hear the arguments of the parties. Written submissions and bundles of authorities in the Written Submissions & Bundle of Authorities Form must be filed with the Registrar at least 1 month before the date of hearing and exchanged between the parties.<sup>143</sup> Parties must also file Form HC1 (together with payment of S\$715) to indicate their intention to attend the oral hearing.<sup>144</sup> At the pre-hearing review, parties who prefer a written decision without a hearing may inform the Registrar of their preference. However, if one party still wishes to proceed with a hearing, the hearing will take place in person and the other party may choose whether or not to be heard at the hearing.<sup>145</sup>
- 3.3.7. **Step 7: Grounds of Decision.** The Registrar will issue a written decision setting out the various grounds and arguments for the decision made within 3 months from the date of the hearing.<sup>146</sup> Costs will usually be awarded to the winning party.
- 3.3.8. **Step 8: Appeal to High Court.** A party can contest the Registrar's decision by filing a Notice of Appeal with the High Court within 28 days from the date of the decision.<sup>147</sup> The appeal is heard by way of an *inter partes* hearing.
- 3.4. **Extension of Time.** Parties may request for extensions of time at any point during the proceedings. The Registrar will grant such requests if it is satisfied that there is good and sufficient reason for the request.<sup>148</sup>
- 3.5. **Effect of Decision.** The Registrar's decision will be final, unless parties choose to file an appeal against the Registrar's decision to the High Court (parties may file a subsequent appeal against the High Court's decision at the Court of Appeal).<sup>149</sup>
- 3.6. **Publication of Decisions.** All decisions issued by the Registrar are available on the IPOS' website whereas decisions of the Singapore courts are published in the official law reports (see **Section II: Processing of a Trade Mark Application, paragraph 2.3**).

<sup>139</sup> Rules 31A(1)(c), 31A(5) and 31A(10), *Trade Marks Rules*.

<sup>140</sup> *Ibid.*

<sup>141</sup> Rule 35, *Trade Marks Rules*.

<sup>142</sup> Rule 36A(5), *Trade Marks Rules*.

<sup>143</sup> Rule 37(2), *Trade Marks Rules*.

<sup>144</sup> Rule 37(3), *Trade Marks Rules*.

<sup>145</sup> HMG Circular No. 4/2015 dated 30 June 2015, and the IPOS Interview.

<sup>146</sup> <https://www.ipos.gov.sg/who-we-are/service-commitment>.

<sup>147</sup> Order 87, rule 4(3), *Rules of Court*.

<sup>148</sup> Rules 77(1) and 77(2), *Trade Marks Rules*.

<sup>149</sup> Section 75, *Trade Marks Act*.

## IV. Revocation Proceedings

- 4.1. **Grounds for Revocation.** Section 22(1) of the *Trade Marks Act* sets out the grounds upon which a registered trade mark may be revoked:
- (a) There has been no genuine use of the registered mark in relation to the goods or services it is registered for within 5 years from completion of registration (without any proper reason for non-use);
  - (b) The registered mark has not been used for an uninterrupted period of 5 years (without any proper reason for non-use);
  - (c) The registered mark has become a common name in the trade of the product or service that the mark is registered for as a result of the acts or inactivity of the proprietor of the mark; or
  - (d) The registered mark is liable to mislead the public as a result of the use of the mark by the proprietor.
- 4.2. **Eligible Persons.** Any person may apply to revoke a registered trade mark in whole or in part by filing an application for revocation.<sup>150</sup> Once revocation proceedings are commenced, a third party that claims an interest in a registered mark may write to the Registrar requesting for leave to intervene in the proceedings, which the Registrar may allow discretionarily.<sup>151</sup>
- 4.3. **Procedure for Revoking a Registered Trade Mark.** Procedures for revoking a trade mark will be different depending on whether the revocation action is commenced before the Registrar of Trade Marks at IPOS or High Court (see **Chapter B: Adjudicatory Bodies and Forum, Section II: Forum, paragraph 2.1**).<sup>152</sup> If however, there are any proceedings concerning a particular trade mark pending before the High Court, the revocation proceedings for the same trade mark must be commenced at the High Court.<sup>153</sup> The IPOS' Registrar may also at any time refer any revocation proceedings commenced before the Registrar to the High Court.<sup>154</sup> For the purposes of this survey report, an overview of the procedural steps and timelines for revoking a registered trade mark before the Registrar is set out below.

---

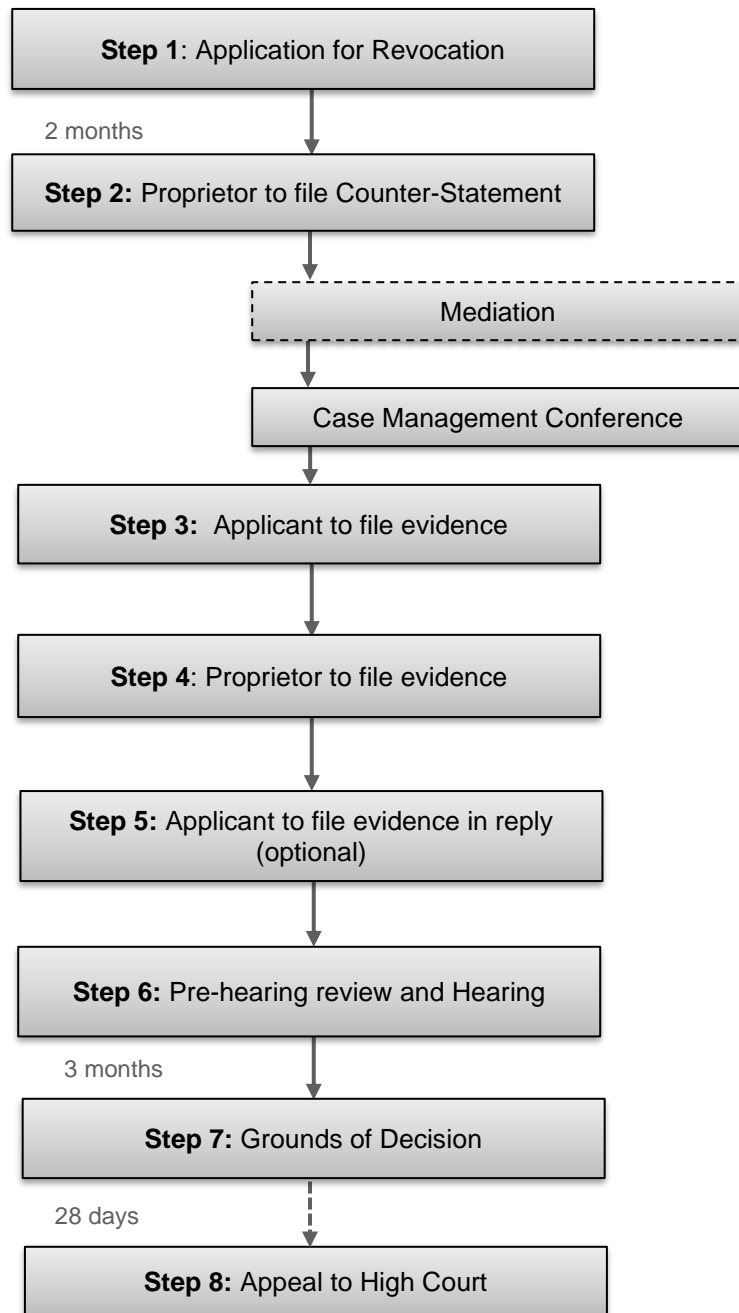
<sup>150</sup> Section 22(5), *Trade Marks Act*.

<sup>151</sup> Rule 60, *Trade Marks Rules*.

<sup>152</sup> Section 22(5), *Trade Marks Act*.

<sup>153</sup> Section 22(5)(a), *Trade Marks Act*.

<sup>154</sup> Section 22(5)(b), *Trade Marks Act*.



- 4.3.1. **Step 1: Application for Revocation.** Revocation proceedings are *inter partes* and can be initiated with the Registrar within IPOS<sup>155</sup> by filing Trade Marks Form 28 and a Statement of Grounds setting out the facts upon which the revocation action is based on (together with a payment of S\$357 in respect of each class).<sup>156</sup> A copy of the same must be served on the proprietor of the registered trade mark at the time of filing the documents.<sup>157</sup>
- 4.3.2. **Step 2: Proprietor to file Counter-Statement.** The proprietor must, within 2 months from the date of receipt of the application for revocation, file a Counter-Statement in Form HC6 with the Registrar to contest the application<sup>158</sup> (together with a payment of S\$360 per class).<sup>159</sup> A copy of the same must be served on the applicant at the time of filing the document.<sup>160</sup> The revocation application will be granted if the proprietor fails to do so.<sup>161</sup>
- 4.3.2.1. If the proprietor is contesting the revocation action on the basis of use of a registered mark (see **Section IV, Revocation Proceedings, paragraphs 4.1.(a) and 4.1.(b)**), then it must also file and serve evidence (by way of statutory declarations) to prove the use of the registered trade mark or the evidence supporting the proper reason for non-use.<sup>162</sup> If no statutory declaration is filed with the Counter-Statement by the proprietor, the application for revocation will be granted.<sup>163</sup>
- 4.3.2.2. After the Counter-Statement is filed, the Registrar will convene a case management conference to provide parties with the opportunity to consider alternative dispute resolution means such as mediation which will be conducted by the WIPO Center. If parties choose for proceedings to resume, the Registrar will specify deadlines for the filing of evidence.
- 4.3.3. **Step 3: Applicant to file evidence (optional).** The applicant may file evidence in support of its case via a Statutory Declaration within such deadline as specified by the Registrar.<sup>164</sup>
- 4.3.4. **Step 4: Proprietor to file evidence (optional).** The proprietor may file evidence in support of its case via a Statutory Declaration within such deadline as specified by the Registrar.<sup>165</sup>
- 4.3.5. **Step 5: Applicant to file evidence in reply (optional).** The applicant may file further evidence for the purpose of strictly replying to the proprietor's evidence. This evidence in reply may be made via a Statutory Declaration within such deadline as specified by the Registrar.<sup>166</sup> After this stage, further evidence can only be filed with leave from the

---

<sup>155</sup> Section 22, *Trade Marks Act*.

<sup>156</sup> Rules 57(1) and 57(2), *Trade Marks Rules*.

<sup>157</sup> Rule 57(3), *Trade Marks Rules*.

<sup>158</sup> Rule 58(1), *Trade Marks Rules*.

<sup>159</sup> <https://www.ipos.gov.sg/resources/trade-mark>

<sup>160</sup> Rule 58(2), *Trade Marks Rules*.

<sup>161</sup> Rules 58(10) and 58(11), *Trade Marks Rules*.

<sup>162</sup> Rule 58(3), *Trade Marks Rules*.

<sup>163</sup> Rule 58(10), *Trade Marks Rules*.

<sup>164</sup> Rule 59(1A), *Trade Marks Rules*.

<sup>165</sup> Rules 59(1A)(a)(ii) and 59(1A)(b), *Trade Marks Rules*.

<sup>166</sup> Rules 59(1A)(a)(iii) and 59(1A)(b), *Trade Marks Rules*.

Registrar.<sup>167</sup> The Registrar will direct parties to attend a pre-hearing review, where matters such as possible settlement of the dispute will be considered.<sup>168</sup>

4.3.6. **Step 6: Pre-Hearing Review and Revocation Hearing by IPOS Registrar.** The Registrar will set a date to hear the arguments of the parties.<sup>169</sup> Written submissions and bundles of authorities in the Written Submissions & Bundle of Authorities Form must be filed with the Registrar at least 1 month before the date of hearing and exchanged between the parties. Parties must also file Form HC1 (together with payment of S\$715) to indicate their intention to attend the oral hearing. At the pre-hearing review, parties who prefer a written decision without a hearing may inform the Registrar of their preference. However, if one party still wishes to proceed with a hearing, the hearing will continue as scheduled and the other party may choose whether or not to be heard at the hearing.<sup>170</sup>

4.3.7. **Step 7: Grounds of Decision.** The Registrar will issue a written decision setting out the various grounds and arguments for the decision made within 3 months from the date of the hearing.<sup>171</sup> Costs will usually be awarded to the winning party.

4.3.8. **Step 8: Appeal to High Court.** A party can contest the Registrar's decision by filing a Notice of Appeal with the High Court within 28 days from the date of the decision.<sup>172</sup> The appeal is heard by way of an *inter partes* hearing.

4.4. **Extensions of time.** Parties may request for extensions of time at any point during the proceedings. The Registrar will grant such requests if it is satisfied that there is good and sufficient reason for the request.<sup>173</sup>

4.5. **Effect of decision.** If an order for the revocation of the registered trade mark has been issued by the Registrar, the revocation of the trade mark shall have effect from the date of the application for revocation (unless the Registrar is satisfied that the grounds of revocation existed at an earlier date).<sup>174</sup> The Registrar's decision will be final, unless parties choose to file an appeal against the Registrar's decision to the High Court (parties may file a subsequent appeal against the High Court's decision at the Court of Appeal).

4.6. **Publication of decisions.** All decisions issued by the Registrar are available on the IPOS' website whereas decisions of the Singapore courts are published in the official law reports (see **Section II: Processing of a Trade Mark Application, paragraph 2.3**).

## V. Invalidation Proceedings

5.1. **Grounds for Invalidation.** Section 23 of the *Trade Marks Act* sets out the grounds upon which a registered trade mark may be invalidated:

---

<sup>167</sup> Rules 59(1A)(i) and 35, *Trade Marks Rules*.

<sup>168</sup> Rules 59(1A)(i) and 36A(5), *Trade Marks Rules*.

<sup>169</sup> Rule 59(1A)(i) and 37(1), *Trade Marks Rules*.

<sup>170</sup> HMG Circular No. 4/2015 dated 30 June 2015, and the IPOS Interview.

<sup>171</sup> <https://www.ipos.gov.sg/who-we-are/service-commitment>.

<sup>172</sup> Order 87, rule 4(3), *Rules of Court*.

<sup>173</sup> Rule 77(2), *Trade Marks Rules*.

<sup>174</sup> Section 22(7), *Trade Marks Act*.



- (a) The trade mark was registered in breach of the absolute or relative grounds of refusals (see **Section III: Opposition Proceedings, paragraphs 3.1.1. and 3.1.2.1.**); or
- (b) There was fraud in the registration or the registration was obtained by misrepresentation.
- 5.2. **Eligible Persons.** Any person may apply to invalidate a registered trade mark in whole or in part by filing an application for invalidation.<sup>175</sup> Once invalidation proceedings are commenced, a third party that claims an interest in a registered mark may write to the Registrar requesting for leave to intervene in the proceedings, which the Registrar may allow discretionarily.<sup>176</sup>
- 5.3. **Procedure for Invalidating a Registered Trade Mark.** Procedures for invalidating a trade mark will be different depending on whether the invalidation action is commenced before the IPOS or High Court (see **Chapter B: Adjudicatory Bodies and Forum, Section II: Forum, paragraph 2.1.**)<sup>177</sup> If however, there are proceedings concerning a particular trade mark pending before the High Court, the invalidation proceedings for the same trade mark must be commenced at the High Court.<sup>178</sup> The IPOS' Registrar may also at any time refer any invalidation proceedings commenced before the IPOS to the High Court.<sup>179</sup> The invalidation proceedings will follow a similar procedure as revocation proceedings, although there are fewer mandatory stages of evidence in revocation proceedings than in invalidation proceedings.
- 5.4. **Effect of decision.** If an order for the invalidity of the registered trade mark has been issued by the Registrar, the registration of the trade mark shall be deemed never to have been made.<sup>180</sup> If the order for invalidity is only for part of the goods and services for which the trade mark is registered for, the invalidation will only be for that limited part.<sup>181</sup> The Registrar's decision will be final, unless parties choose to file an appeal against the Registrar's decision to the High Court (parties may file a subsequent appeal against the High Court's decision at the Court of Appeal).
- 5.5. **Publication of decisions.** All decisions issued by the Registrar are available on the IPOS' website whereas decisions of the Singapore courts are published in the official law reports (see **Section II: Processing of a Trade Mark Application, paragraph 2.3.**).

---

<sup>175</sup> Section 23(5), *Trade Marks Act*.

<sup>176</sup> Rule 60, *Trade Marks Rules*.

<sup>177</sup> Section 23(5), *Trade Marks Act*.

<sup>178</sup> Section 23(5)(a), *Trade Marks Act*.

<sup>179</sup> Section 23(5)(b), *Trade Marks Act*.

<sup>180</sup> Section 23(10), *Trade Marks Act*.

<sup>181</sup> Section 23(9), *Trade Marks Act*.

## VI. Statistics<sup>182</sup>

### 6.1. IPOS Statistics.

6.1.1. **Filings.** Trade mark dispute cases filed with the IPOS between years 2001 to 2018:

	2001-2010	2011	2012	2013	2014	2015	2016	2017	2018
Opposition	2,525	185	222	197	207	319 <sup>183</sup>	337 <sup>184</sup>	199 <sup>185</sup>	310 <sup>186</sup>
Invalidation / Revocations / Rectifications	188 <sup>187</sup>	32	47	46	65	87	61	77	86

6.1.2. **Hearings.** Trade marks dispute cases heard by the IPOS between years 2001 to 2018:

Type of hearing / Year		2001 – 2010	2011	2012	2013	2014	2015	2016	2017	2018
<i>Ex-parte</i> Hearings		7	12	1	3	2	3	5	3	0
<i>Inter-partes</i> Hearings	Oppositions	167	27	9	5	8	13	8	16	21
	Invalidations	5	3	0	1	4	1	4	10	11
	Revocations	1	1	1	0	3	2	3	6	1

6.1.3. **Hearings Outcome.** Success rate of trade mark dispute cases heard by the IPOS between years 2001 to 2018:

Type of hearing / Year		2001 – 2010 <sup>188</sup>	2011	2012	2013	2014	2015	2016	2017	2018
<i>Ex-parte</i> Hearings (successful / unsuccessful)		N/A	7 / 2	0 / 1	2 / 2	0 / 2	1 / 2	0 / 5	0 / 3	0 / 0
<i>Inter-partes</i> Hearings (Successful / Unsuccessful)	Oppositions	N/A	3 / 3	2 / 8	0 / 5	1 / 11	2 / 12	2 / 7	1 / 10	6 / 17
	Invalidations	N/A	3 / 0	0 / 0	0 / 1	1 / 1	4 / 0	1 / 2	1 / 7	10 / 0
	Revocations	N/A	1 / 0	1 / 0	0 / 0	1 / 1	3 / 0	1 / 0	4 / 1	4 / 0

<sup>182</sup> The data is obtained from the IPOS' published statistics set out in the Annex.

<sup>183</sup> There were 414 "intended oppositions" in 2015.

<sup>184</sup> There were 469 "intended oppositions" in 2016.

<sup>185</sup> There were 362 "intended oppositions" in 2017.

<sup>186</sup> There were 407 "intended oppositions" in 2018.

<sup>187</sup> The data for 2001 – 2003 is not available.

<sup>188</sup> The data for 2001 – 2010 is not published.

6.1.4. **Appeal Outcomes.** Trade mark disputes decisions from the IPOS that were appealed before the High Court and/or Court of Appeal between years 2001 to 2018.

Type of hearing / Year	2001 – 2010	2011	2012	2013	2014	2015	2016	2017	2018
Appeals to High Court / Court of Appeal for trade marks	4	0	0	1	0	7	0	8	6
IPOS Decision Upheld / Overturned	N/A <sup>189</sup>	0 / 0	0 / 0	1 / 0	0 / 0	5 / 2	0 / 0	8 / 0	6 / 0

6.2. **Court Statistics.** The Singapore courts do not publish official statistics about the hearings before the courts.

## VII. Case Study

### 7.1. *Guccitech Industries (Private Ltd) v Guccio Gucci SpA [2018] SGIPOS 1*<sup>190</sup>

7.1.1. The decision of *Guccitech Industries (Private Ltd) v Guccio Gucci SpA [2018] SGIPOS 1* stems from an opposition action before the Registrar of Trade Marks at the Intellectual Property Office of Singapore.

7.1.2. **Facts.** The Applicant, Guccitech Industries (Private Ltd), is a Singapore-incorporated company engaged in the business of, among other things, designing and manufacturing household appliances. The Applicant applied to register the trade mark

**GUCCITECH**  
INNOVATION SAVES SPACE

("Applicant's Mark") in Singapore in Class 11, in respect of an extremely detailed list of appliances and other goods used in or as part of the process of cooking or preparing food. The application was accepted and published for opposition. The Opponent, Guccio Gucci SpA, is the owner of the globally-renowned brand GUCCI. While the Opponent is most known for its bags, shoes and clothing, the Opponent claims that the range of products on which the GUCCI trade mark is used today extends to beauty and cosmetic products, lifestyle products, food and beverage services, games products, and products used in the technology area such as mobile phone covers and USB devices. The Opponent filed an opposition to the registration of the Applicant's Mark, on the following grounds:

- (a) **Section 8(2)(b) of the Trade Marks Act** - that the Applicant's 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, and there exists a likelihood of confusion on the part of the public.

<sup>189</sup> The data for 2001 – 2010 is not published.

<sup>190</sup> The full grounds of decision can be found at: <https://www.ipos.gov.sg/docs/default-source/resources-library/hearings-and-mediation/legal-decisions/2018/guccio-gucci-v-guccitech-industries-2018-sgipos-1.pdf>

- (b) **Section 8(4) of the Trade Marks Act** - that the Applicant's Mark is identical with or similar to the Opponent's earlier trade mark which is well known in Singapore; and (i) the use of the Applicant's Mark in relation to the goods for which the Applicant's Mark is sought to be registered would indicate a connection between those goods or services and the Opponent, and is likely to damage the Opponent's interests; or (ii) if the Opponent's trade mark is well known to the public at large in Singapore, the use of the Applicant's Mark would cause dilution in an unfair manner of the distinctive character of the Opponent's mark, or would take unfair advantage of the distinctive character of the Opponent's mark.
- (c) **Section 8(7)(a) of the Trade Marks Act** - that the registration of the Applicant's Mark is liable to be prevented by virtue of the law of passing off.
- (d) **Section 7(6) of the Trade Marks Act** - that the application of the Applicant's Mark is made in bad faith.

7.1.3. **Finding.** On the facts and evidence before it, the Registrar found in the Opponent's favour and allowed the opposition on grounds (a), (b) and (c), but not (d). Notwithstanding that the Registrar found in the Opponent's favour, the Registrar chose to depart from the usual order that costs follow the event, and declined to award costs to the Opponent. The Registrar instead ordered that each party bears its own costs in the proceedings. The Registrar considered that the case was "*albeit perhaps unintentionally, a potentially oppressive use of the opposition procedure*", on account of the voluminous exhibits (comprising 6,852 pages) tendered by the Opponent, a significant part of which the Registrar found was "*has no relevance to these proceedings or is needlessly excessive and duplicative*". The Registrar warned against the "*impulse to bury the tribunal and the opposing party in material that is irrelevant or excessive*".

7.1.4. **Comments.** This case is significant not only in terms of the legal principles that it affirms, but also as a timely reminder to clients and their solicitors not to use a sledgehammer to crack a nut in legal proceedings. Such observations are particularly applicable to actions before the IPOS, which is intended to be a low cost tribunal for the effective resolution of intellectual property disputes. In relation to types of evidence that should be tendered, this decision clarified that survey evidence is not a prerequisite in cases where it is asserted that a particular trade mark is well known or well known to the public at large in Singapore. In fact, the Registrar commended the Opponent's counsel for resisting the temptation to adduce survey evidence. Once there is sufficient relevant evidence before the tribunal on the basis of which it can conclude that a particular trade mark is well-known, it is of no further assistance to adduce yet more.

## **ACKNOWLEDGEMENTS**

We would like to express our sincerest gratitude to our colleagues in the International Engagement Department, the Hearings & Mediation Department, the Registries of Patents, Designs & Plant Varieties, and the Registry of Trade Marks at the Intellectual Property Office of Singapore (IPOS). They have not only supported us through interviews and with valuable information, but also helped us by checking the report in its final stage.

Further information on the Singaporean IP system can be obtained at the IPOS website at: <https://www.ipos.gov.sg/>

## **ANNEX**<sup>191</sup>

<b>No.</b>	<b>Year</b>	<b>Statistics' Source</b>
1.	2001 – 2010	<a href="https://www.ipos.gov.sg/docs/default-source/about-ipos-doc/Statistics/2001---2010.pdf?sfvrsn=c5b27a59_0">https://www.ipos.gov.sg/docs/default-source/about-ipos-doc/Statistics/2001---2010.pdf?sfvrsn=c5b27a59_0</a>
2.	2011	<a href="https://www.ipos.gov.sg/docs/default-source/about-ipos-doc/Statistics/2010---2011.pdf?status=Temp&amp;sfvrsn=0.7894511083565093">https://www.ipos.gov.sg/docs/default-source/about-ipos-doc/Statistics/2010---2011.pdf?status=Temp&amp;sfvrsn=0.7894511083565093</a>
3.	2012	<a href="https://www.ipos.gov.sg/docs/default-source/about-ipos-doc/Statistics/2011---20121c631977c2d0635fa1cdff0000abd271.pdf?sfvrsn=2ab37a59_0">https://www.ipos.gov.sg/docs/default-source/about-ipos-doc/Statistics/2011---20121c631977c2d0635fa1cdff0000abd271.pdf?sfvrsn=2ab37a59_0</a>
4.	2013	<a href="https://www.ipos.gov.sg/docs/default-source/about-ipos-doc/Statistics/2012---2013.pdf?sfvrsn=fdb27a59_0">https://www.ipos.gov.sg/docs/default-source/about-ipos-doc/Statistics/2012---2013.pdf?sfvrsn=fdb27a59_0</a>
5.	2014	<a href="https://www.ipos.gov.sg/docs/default-source/about-ipos-doc/Statistics/2013---2014.pdf?sfvrsn=35b37a59_0">https://www.ipos.gov.sg/docs/default-source/about-ipos-doc/Statistics/2013---2014.pdf?sfvrsn=35b37a59_0</a>
6.	2015	<a href="https://www.ipos.gov.sg/docs/default-source/about-ipos-doc/Statistics/ar-stats-2015-2016.pdf?sfvrsn=4">https://www.ipos.gov.sg/docs/default-source/about-ipos-doc/Statistics/ar-stats-2015-2016.pdf?sfvrsn=4</a>
7.	2016	<a href="https://www.ipos.gov.sg/docs/default-source/about-ipos-doc/Statistics/ar-2016-2017-stats.pdf?sfvrsn=2">https://www.ipos.gov.sg/docs/default-source/about-ipos-doc/Statistics/ar-2016-2017-stats.pdf?sfvrsn=2</a>
8.	2017	<a href="https://www-ipos-gov-sg-admin.cwp.sg/docs/default-source/about-ipos-doc/Statistics/registries-stats-content-for-ar1718_compiled.pdf">https://www-ipos-gov-sg-admin.cwp.sg/docs/default-source/about-ipos-doc/Statistics/registries-stats-content-for-ar1718_compiled.pdf</a>
9.	2018	<a href="https://www.ipos.gov.sg/docs/default-source/about-ipos-doc/annual-reports/ipos-ar-201819-2.pdf">https://www.ipos.gov.sg/docs/default-source/about-ipos-doc/annual-reports/ipos-ar-201819-2.pdf</a>

<sup>191</sup> The statistical data for year 2019 is expected to be published on the IPOS official website in Q4 of this year.

Japan Patent Office (JPO) Commissioned Survey

**Survey on the Appeal, Opposition, and Invalidation  
Procedures Related to Patents, Designs, and Trademarks  
in Singapore**

Published by

**Japan External Trade Organization (JETRO)  
Singapore Office**

In cooperation with

**Baker McKenzie Wong & Leow**

March 2020

This report presents the findings of the survey conducted in 2019 by JETRO Singapore Office in cooperation with Baker McKenzie Wong & Leow. There are possibilities that relevant laws may change, and although the report is intended to be accurate, the publisher does not represent or warrant the truth or accuracy of the information provided herein.

Copyright(C) 2020 JPO/JETRO. All rights reserved