

# **Final Report**

## **Review of Singapore’s Registered Designs Regime**

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## EXECUTIVE SUMMARY

1. Singapore will be updating its registered designs regime to support Singapore's plans for designs to feature even more strongly in our future economy. Changes will be made to our Registered Designs Act ("RDA"), which was enacted in 2000. The changes will provide a conducive legal and policy framework for the Design 2025 Masterplan, which recommended that businesses capitalise on intellectual property ("IP") to create value through the use of design in service and product innovation. This will in turn support economic growth and job creation in Singapore.
2. This review was conducted jointly by the Ministry of Law and the Intellectual Property Office of Singapore. The objectives of this review were:
  - (a) to support modern business practices while continuing to balance the interests of design creators/owners and users;
  - (b) to provide business certainty; and
  - (c) to ensure that our design protection regime is cost-effective.
3. As part of the review process, the review team looked at the entire life cycle of a registered design, i.e. creation, protection, and use. The conclusions from the review are arranged into three broad categories, which broadly correspond to the various stages of the life cycle of a registered design.

### **Stage 1 (Creation) : Scope of Registered Design Protection**

4. Technological advances, particularly in manufacturing and connectivity, have changed business models. Recognising these changes, the scope of registered design protection will be expanded to ensure our RDA stays relevant. For example, designs of articles made by advanced manufacturing techniques, e.g. 3D printing, and designs of handmade or artisanal articles, will now be protectable. In expanding the scope of registered design protection, care will be taken to maintain the current position of minimal overlap between design protection and other IP rights.
5. New design trends were identified and studied in this review. They are experiential designs, virtual or projected designs, dynamic designs, and 3D printing. Our conclusions address each of these trends. In addition, recognising the value of colours in designs, we will include colours as a registrable design feature, although colours *per se* will continue to fall outside the scope of design protection.

6. The possibility of introducing unregistered design protection in Singapore was also studied in this review. We concluded that the disadvantages of increased uncertainties in the scope of existing IP rights in the market, and resulting costs to businesses, are likely to outweigh the possible advantages of introducing this new IP right. As such, we will not be introducing this new IP right in Singapore at this point in time.

### **Stage 2 (Protection) : Registration and Protection of Designs**

7. The design registration processes were reviewed with a view to streamlining and enhancing them to improve the cost-effectiveness of obtaining registered design protection. On top of this, ensuring that our registration processes are consistent with those of major jurisdictions will facilitate the process for local companies to secure concurrent design protection across multiple jurisdictions.
8. The key advantages of registered designs are the speed and low cost of registration. To safeguard these advantages, substantive examination will not be introduced. We will also amend our provisions on grace period to lengthen and broaden its scope. This will allow designers to test their designs in the market before deciding whether to register them. In addition, to enhance the cost-effectiveness of registration, we will expand the scope of allowing multiple designs in the same application. Further, in recognition of the value of design creation and the creative effort of the designer, we will shift the position on design ownership such that the designer will be the owner of a commissioned design by default.

### **Stage 3 (Use) : Use of Registered Designs**

9. We looked at the present term of registered design protection and block renewal structure, and concluded that the present practice in these areas continues to be aligned to the needs of our creators. We acknowledge the concerns on the lack of clarity on scope of design rights and enforcement options, and will partner industry associations to conduct more outreach and information sessions, to aid designers in protecting, exploiting and enforcing their design rights.

### **Utility Model Protection**

10. Utility model protection was also considered in this review. We concluded that there is insufficient evidence, at least at present, that the introduction of utility model protection would spur innovation and economic growth. Instead, there were concerns that introducing this new IP right could increase business costs, and

weigh against the interests of users. Hence, we will not introduce utility model protection in Singapore at this point in time.

### Enhanced Registered Designs Regime

11. This review does not recommend a significant overhaul of our registered designs regime. Rather, the review conclusions are aimed at enhancing the existing registered designs regime to better support Singapore’s economic and design initiatives. The review conclusions have taken into account the different interests of all stakeholders, as well as international best practices.

### Summary of Conclusions

	Conclusion	Page
	<b>Scope of Registered Design Protection (Creation)</b>	
1	Amend the definition of “design” and in the RDA to provide for a broader scope of design protection.	11
2	Reaffirm the policy position to maintain the current minimal overlap between design protection and copyright protection. The designs of useful articles/products, i.e. articles/products having an intrinsic utilitarian function other than to carry the design, are more appropriately protected under the registered designs regime. However, protection should be via copyright where the article or product has <u>no</u> intrinsic utilitarian function other than to carry the design.	13
3	Maintain current provisions in section 7(3) of the Trade Marks Act in relation to exclusions for shape.	16
4	Do not broaden the scope of design protection to cover experiential designs.	19
5	Amend the definition of “design” to provide protection for virtual or projected designs. To qualify for design protection, virtual or projected designs must: <ul style="list-style-type: none"> <li>(a) be capable of being represented clearly and without subjectivity; and</li> <li>(b) retain the same (or substantially similar) design features irrespective of the surface or medium they are projected on.</li> </ul>	20
6	Reaffirm that dynamic designs can be registered if they are: <ul style="list-style-type: none"> <li>(a) capable of being represented clearly and without subjectivity on a static medium; and</li> <li>(b) capable of being represented through a series of freeze-frames of the dynamic design.</li> </ul>	21
7	There is no necessity to amend the RDA specifically to address 3D printing at this point in time. However, developments in this sector will be monitored, with a view to intervene in a timely manner if required.	22

8	Affirm current position to allow protection for partial designs.	24
9	Amend the RDA to specific colour as one design feature. The scope of design protection will not extend to colours <i>per se</i> .	27
10	Do not introduce a new unregistered design right in Singapore.	29
	<b>Registration and Protection of Designs (Protection)</b>	
11	Do not introduce substantive examination for design applications prior to registration.	32
12	Do not introduce <i>ex officio</i> powers for the Registrar to revoke a registered design. Instead current revocation proceedings at IPOS and at the Courts will be reviewed.	33
13	Amend the RDA to: (a) increase the length of the grace period to 12 months; and (b) remove the requirement that disclosures can only be made at select international exhibitions.	34
14	Retain the request-based 18-month deferment period for design publication.	35
15	Amend the RDA to allow multiple designs in the same Locarno classification to be filed in one application.	37
16	Amend the RDA to remove the provision that automatically treats the person commissioning the design as the owner of the design.	38
	<b>Use of Registered Designs (Use)</b>	
17	Maintain the current 15-year term of protection for registered designs.	39
18	Maintain the initial 5-year term of protection and the 5-year renewal block structure.	40
19	Conduct more outreach and information sessions, in partnership with industry associations. Provide guidance notes on specific areas relating to the registered designs regime, especially in the area of infringement, to increase public awareness of acts that would constitute design infringement and to help increase certainty in this area.	40
	<b>Utility Model Protection</b>	
20	Do not introduce utility model protection at present.	43

# SECTION 1

## INTRODUCTION

### 1.1. DESIGN IN SINGAPORE'S FUTURE ECONOMY

- 1.1.1. Singapore is moving towards being an innovation-driven economy. Design will be a key pillar in this future economy.
- 1.1.2. Good design can enhance the value of a product or service. Businesses use design to differentiate their products or services from their competitors' in an often crowded marketplace. This helps drive their sustainability and growth. User-centric design improves the user experience and the daily lives of people. In addition, design has deep cultural and social significance, as it can be a form of self- or group- expression.
- 1.1.3. The Design 2025 Masterplan, released by the DesignSingapore Council in March 2016, identifies design as a powerful catalyst for innovation and a key driver of value creation. The Masterplan sets out the aim of accelerating the use of design in service and product innovation. To achieve this, an important element identified in the Masterplan is the ability of businesses to capitalise on intellectual property ("IP").
- 1.1.4. This report looks at how our registered designs regime can be enhanced to better support the broader national economic and design goals.

### 1.2. SINGAPORE'S REGISTERED DESIGNS REGIME

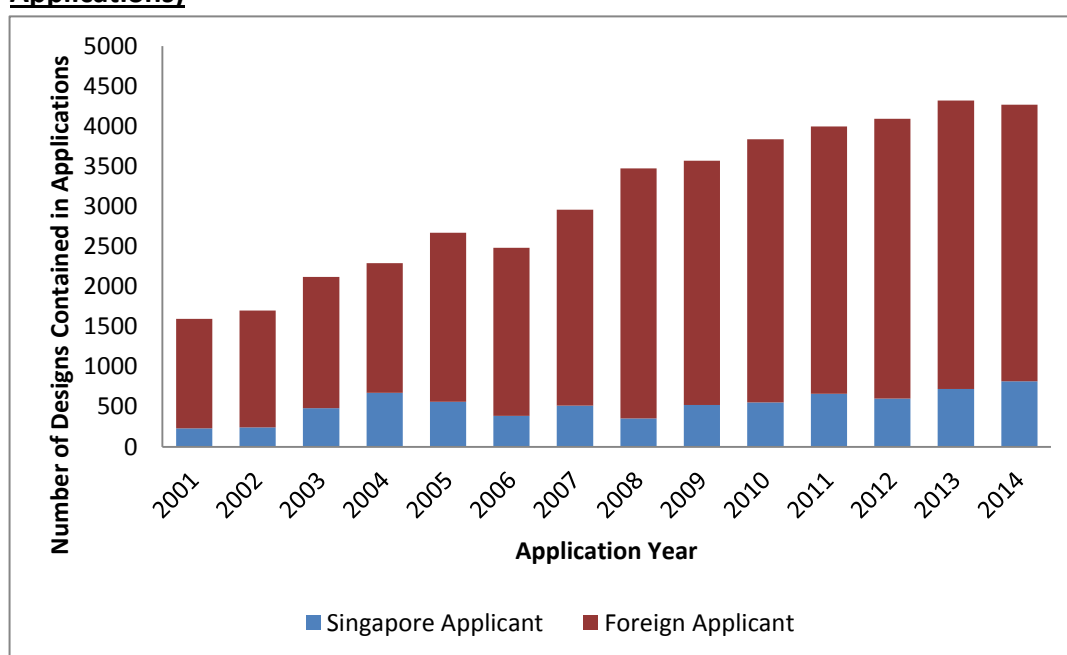
- 1.2.1. Singapore provides for registered design protection under our Registered Designs Act ("RDA"), which was enacted in 2000. Our IP regime, including our registered designs regime, is in line with major international IP agreements, including the TRIPS (or Trade Related Aspects of Intellectual Property Rights) Agreement, the

Berne Convention, the Paris Convention, and the Hague Agreement.<sup>1</sup> In addition, our IP regime is highly regarded internationally.<sup>2</sup>

### *Usage of Designs*

- 1.2.2. Designs filed at the Intellectual Property Office of Singapore (“IPOS”) have increased over the years, from a total<sup>3</sup> of 2670 designs in 2005 to a total of 4268 designs in 2014 (see **Table A** below).

**Table A: Time Series of Designs Lodged in Singapore (National and Hague Applications)**



- 1.2.3. The most popular class of registered designs in Singapore is jewellery (or “articles of adornment”), and these are mostly from our local applicants. This is followed by designs for communication devices, e.g. mobile phones; and thereafter by designs

<sup>1</sup> The TRIPS Agreement introduced a set of IP rules for all members of the World Trade Organization. The Berne Convention for the Protection of Literary and Artistic Works governs aspects of copyright, including the concept that copyright exists the moment a work is “fixed” (and registration is not necessary), and enforces a requirement that signatory countries recognise the copyrights of citizens of all signatory countries. The Paris Convention for the Protection of Industrial Property established a Union for the protection of IP. The Hague Agreement is administered by the World Intellectual Property Organization, and provides a mechanism for registering an industrial design in several countries by means of a single application, filed in one language and with one set of fees.

<sup>2</sup> For instance, Singapore is ranked 4<sup>th</sup> in the world, and top in Asia, for IP protection in the World Economic Forum Global Competitiveness Report 2015/2016. Singapore is also ranked 6<sup>th</sup> globally, and top in Asia, for our IP environment by the US Global Intellectual Property Center’s International IP Index 2016.

<sup>3</sup> This includes design applications filed directly at IPOS and design applications filed via the Hague system and designating Singapore.

for packaging and containers. These two classes see more foreign applicants. The design filing figures may be reflective of the various stages of development or IP awareness of the different industry sectors in Singapore.

- 1.2.4. In relation to designs filed by Singapore-based or local applicants, this increased by 46% from 561 in 2005 to 818 in 2014. This could indicate an increase in IP awareness and recognition of the importance of design protection by Singapore-based companies.
- 1.2.5. However, while there is an increase in the total number of designs filed in Singapore, and also the number of designs filed by Singapore-based companies, we believe that there is still much room for growth based on our engagements with local industry. This potential for growth is further enhanced in light of the larger national goal to accelerate the use of design in service and product innovation.

### 1.3. REVIEW OF SINGAPORE'S REGISTERED DESIGNS REGIME

#### *Objectives of the Review*

- 1.3.1. A comprehensive review of our registered designs regime has not been undertaken since the enactment of our RDA in 2000. This review is timely. The Ministry of Law ("MinLaw") and IPOS embarked on this review with these objectives:
  - (a) Support modern business practices while continuing to balance the interests of design creators/owners and users.
  - (b) Provide business certainty.
  - (c) Ensure that our design protection regime is cost-effective.

#### *Underlying Considerations for the Review*

- 1.3.2. We have identified several considerations which underpin this review:
- 1.3.3. Technological advances and evolving business practices. Technological advances, including advanced manufacturing and new distribution models, have changed the way designs are created and applied onto objects or articles, as well as how goods and services are supplied to customers. In addition, both technology and business thinking have brought about a greater understanding of customer behaviour, needs and wants. This has changed the way businesses are utilising designs. For instance, we have observed the evolution of design from conventional static designs applied onto objects to user-centric, interactive and experiential design concepts. Our current legal framework, which is based on the more traditional and static concepts



of design, may need to be updated in order to better serve current and future designers.

- 1.3.4. RDA based on old UK Registered Designs Act 1949. Many aspects of our current registered design legislation are based on the old UK Registered Designs Act. However, the UK registered designs regime has evolved significantly over the years, particularly with the introduction of the EU community designs regime which is administered by the Office for Harmonisation in the Internal Market<sup>4</sup> (Trade Marks and Designs). More recently, the UK's Intellectual Property Act 2014 introduced further changes to the UK's registered designs law.<sup>5</sup>
- 1.3.5. Low level of awareness of, appreciation for, and knowledge of registered design protection. Feedback from industry in Singapore during the review revealed a generally low level of awareness of, appreciation for, and knowledge of registered design protection, and how it can be used as a strategic business tool. In addition, there appears to be some uncertainty relating to the scope of registered design protection. This in turn creates confusion over whether a registered design right has been infringed, as well as the possible avenues for enforcement. We recognise that when IP owners and businesses are unable to (or perceive themselves to be unable to) effectively enforce their IP rights, the value proposition for IP creation and protection is negatively affected.
- 1.3.6. In contrast, in our engagements with some global MNCs, we observed their understanding of the value of design, accompanied by a sophisticated integration of design into their business, and a well-thought out protection and enforcement strategy. It is important for our local businesses to build up such capabilities as Singapore looks to grow its creative industries, and develop into an innovation-driven economy.
- 1.3.7. International interoperability. It is important to continually study, and be familiar with, the practices of other leading IP jurisdictions and major markets, e.g. US, EU, Australia, China, Japan, and South Korea. Firstly, we want to ensure that the design registration process at IPOS remains in line with international best practices. This will enable companies to register and protect their designs in Singapore simply and cost-effectively.

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<sup>4</sup> Soon to be renamed the European Union Intellectual Property Office (EUIPO).

<sup>5</sup> [https://www.gov.uk/government/uploads/system/uploads/attachment\\_data/file/323145/changes-to-designs-law.pdf](https://www.gov.uk/government/uploads/system/uploads/attachment_data/file/323145/changes-to-designs-law.pdf)

1.3.8. In addition, the small size of Singapore’s domestic market means that our local companies often need to enter foreign markets to grow and expand their businesses. In this regard, greater alignment between our registered designs regime and that of other major markets can help local companies seek overseas registered design protection more efficiently.

#### ***Review Inquiry Process***

1.3.9. The designs review commenced in 2014 and included two rounds of public consultation. An early round of public consultation was held from May to June 2014. The later round of public consultation, which set out specific proposals, was held from October to December 2015.

1.3.10. In addition, numerous focus group discussions and one-to-one consultations, including with industry and design associations, businesses, IP practitioners, and academics, were also held in 2014 and 2015.

1.3.11. Recognising the importance to take reference from major jurisdictions, two study trips covering Germany, Denmark, UK, Japan and US were undertaken in 2015. On these study trips, representatives from design-rich companies, design associations, IP practitioners, and the intellectual property offices were consulted.

## SECTION 2

### SCOPE OF REGISTERED DESIGN PROTECTION

#### 2.1. SCOPE OF REGISTERED DESIGN PROTECTION AND ITS INTERFACE WITH OTHER IP RIGHTS

2.1.1. One objective of providing design rights is to incentivise design creativity and innovation. However, as with other forms of IP, the design rights provided to the creator or owner must be carefully balanced with the interests of users and the public, and with the need to ensure that progressive design innovation is not unduly hampered.

2.1.2. The concept of “design” has been defined in many ways. The DesignSingapore Council adopts a broad view of designs, and has stated that “design is about the things we make, the places we shape, the illustrations we compose, the human interfaces we configure, and the processes and events we organise”.<sup>6</sup> A 2015 OECD publication<sup>7</sup> notes that design can be recognised as the intersection between technology and the user, and is valuable as an intangible factor that contributes in most cases to the value-add and success of companies.

2.1.3. The scope of design protection under our current RDA does not cover the entire range of activities falling within the broad understanding of design stated above.<sup>8</sup> Specifically, “design” under the RDA refers to:

*“features of shape, configuration, pattern or ornament applied to an article by any industrial process”<sup>9</sup>*

*“article” is further defined as “any article of manufacture and includes (a) any part of an article if that part is made and sold separately, and (b) any set of articles”<sup>10</sup>*

2.1.4. In addition, the RDA specifies that design features that are dictated solely by function are excluded from design protection.<sup>11</sup> Design protection is also specifically excluded for:

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<sup>6</sup> [http://www.designsingapore.org/Files/Dsg\\_II\\_Strategic\\_Blueprint.pdf](http://www.designsingapore.org/Files/Dsg_II_Strategic_Blueprint.pdf)

<sup>7</sup> “Enquiries Into Intellectual Property’s Economic Impact”, OECD 2015

<sup>8</sup> That said, some types of design activity that do not fall within the Registered Designs Act may be protected by or addressed under other areas of IP, such as copyrights, trade marks and trade secrets.

<sup>9</sup> Section 2(1) RDA

<sup>10</sup> Section 2(1) RDA

<sup>11</sup> Section 2(1) RDA

- (a) design features that must match the appearance of another integral part or article (i.e. “must match” exclusion);<sup>12</sup> and
  - (b) design features that are dictated by the need to connect to another article (i.e. “must fit” exclusion).<sup>13</sup>
- 2.1.5. The policy reason for these exclusions is to require that functional design features should not be monopolised by any one party.
- 2.1.6. In our public consultation paper, we had proposed to broaden the definition of “design” in our RDA. Specifically, we had proposed to:
- (a) remove the requirement for the design to be “applied by an industrial process”; and
  - (b) remove the words “of manufacture” in the phrase “article of manufacture”.
- 2.1.7. The key rationale for our proposal is to allow our RDA to stay relevant in light of technological advances, which may have rendered the requirement for a design to be applied by way of an industrial process unnecessarily limiting. For instance, 3D printing, which is increasingly commonplace, has enabled designs to be applied to articles outside of an “industrial” context. In addition, the Internet has facilitated new distribution platforms and models which allow small businesses to reach customers in new and direct ways. This has led to a growth in artisanal businesses that produce handmade and uniquely designed products. We believe it is important to provide these businesses with an avenue to protect their designs.
- 2.1.8. We note that our current legislative position is narrower than in a number of major jurisdictions, including UK, EU, and Australia. These jurisdictions presently define “design” more broadly – i.e. as simply the “*appearance of... a product*”, and do not require that the design must be applied to the product by an industrial process. In addition, the definition of “product” is also wider in each of these jurisdictions to include more than just industrial items.<sup>14</sup>

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<sup>12</sup> The “must match” exclusion is part of the definition of “design” in the RDA, where features of shape or configuration of an article that are dependent upon the appearance of another article of which the article is intended by the designer to form an integral part are excluded from design protection. Section 2(1) RDA

<sup>13</sup> The “must fit” exclusion is part of the definition of “design” in the RDA, where features of shape or configuration of an article that enable the article to be connected to, or placed in, around or against, another article so that either article may perform its function are excluded from design protection. Section 2(1) RDA

<sup>14</sup> Under the UK Registered Designs Act 1949 (2001), “product” means “*any industrial or handicraft item other than a computer program; and in particular, includes packaging, get-up, graphic symbols, typographic typefaces and parts intended to be assembled into a complex product*”.

Under the EU Council Regulation EC No. 6/2002 on Community Designs, “product” means “*any industrial or handicraft item, including inter alia parts intended to be assembled into a complex product, packaging, get-up, graphic symbols, typographic typefaces, but excluding computer programs*”.

Under the Australia Designs Act 2003, “product” is a “*thing that is manufactured or handmade*”.

- 2.1.9. We should update our definition of “design” to stay relevant to technological advances and changing business models. The current definition of “design” was relevant when manufacturing required large machinery for mass production. However, such a restricted definition can limit the use of our registered designs regime in encouraging design creativity and the growth of the design industry, particularly in areas where small volume production is feasible.
- 2.1.10. The majority of submissions supported the proposal to broaden the current definition of “design”, and to take reference from UK, EU, and Australian definitions of “design”. That said, we acknowledge that several submissions had also raised concerns that an expansion of the scope of design protection can result in an increase in the overlap between design protection and copyright protection. We think that this is a valid concern, and will address this concern in the following paragraphs.

**Conclusion 1:** Amend the definition of “design” in the RDA to provide for a broader scope of design protection. In amending the definition, reference will be taken from UK, EU and Australian definitions.

### **Interface with Copyright Protection**

- 2.1.11. Section 27 of the Copyright Act provides protection for original artistic works. An “artistic work” is defined as a painting, sculpture, drawing, engraving or photograph, building or model of a building, and work of artistic craftsmanship,<sup>15</sup> and generally can be protected irrespective of its artistic quality.
- 2.1.12. The registered designs regime interfaces with the copyright regime insofar as they both provide for the protection of aesthetic appearances. However, a key difference is that the designs regime is intended to protect the design features of commercial products or articles with an “intrinsic utilitarian function” (otherwise known as “useful products” or “useful articles”).<sup>16</sup> On the other hand, the copyright regime protects specific artistic ideas reduced to a particular medium (e.g. paper, canvas, film). The medium serves only to allow the idea to be represented in a physical form; it has no other use or function.
- 2.1.13. In legislation, this interface is addressed in sections 70, 73 and 74 of the Copyright Act (non-exhaustive). Broadly speaking, the intention of these sections is to

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<sup>15</sup> Section 7(1) of the Copyright Act (Cap 63, 2006 Rev Ed.)

<sup>16</sup> The term “useful article” is introduced in Section 70(4) Copyright Act (Cap 63, 2006 Rev Ed.).

minimise the overlap between design protection and copyright protection given the different purposes for the two types of protection.

- 2.1.14. For instance, section 74 acts to prevent concurrent, or double, protection under the RDA and Copyright Act. Under section 74(1), copyright protection in an artistic work is barred once the corresponding design has been registered under the RDA. Even if that design has not been registered under the RDA, copyright protection is still barred under section 74(2)/(3) of the Copyright Act, as long as the designer has industrially applied his design. A design is deemed to be industrially applied if it has been applied to more than 50 articles.<sup>17</sup> This reflects the national policy to exclude copyright protection in artistic works which (i) have already enjoyed registered design protection or (ii) should have been registered under the RDA.
- 2.1.15. In addition, section 70 of the Copyright Act introduces the concept of a “useful article”, which is defined as an article having an “intrinsic utilitarian function” that is not merely to portray the appearance of the article or to convey information. Section 70 also provides that the production of “useful articles” does not infringe copyright protection in an artistic work, if that artistic work has previously been industrially applied, i.e. applied to more than 50 articles.
- 2.1.16. In the public consultation paper, we had proposed to:
- (a) maintain the current minimal overlap approach between design rights and copyright;
  - (b) keep the “50-articles” threshold, beyond which a design is deemed to be industrially applied (and hence lose copyright protection); and
  - (c) provide further clarity to the design/copyright interface, including a possible redrafting of the relevant legislative provisions.
- 2.1.17. The submissions we received expressed broad support for the proposal to maintain the current approach of minimal overlap between design rights and copyright. Several submissions observed that the current legislative provisions on the interface between design protection and copyright protection are complex and can be very confusing, particularly for non-practitioners, designers, and the public-at-large. As such, there was strong support for the proposed redrafting of the relevant legislative provisions, both for clarity as well as for consistency across the RDA and the Copyright Act.

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<sup>17</sup> Regulation 12 of the Copyright Regulations

- 2.1.18. Having considered the submissions, we reaffirm our policy position to maintain the approach of minimal overlap between design protection and copyright protection in Singapore.
- 2.1.19. This is because of the differing purposes of design protection and copyright protection. Copyright protects artistic works in a material form (such as a sculpture or statue) – the medium serves only to carry the expression of the artistic work. On the other hand, useful articles or products have an intrinsic use or function (such as a vase, cup, or pen), and do not simply serve to carry the design. Designs for such useful articles or products, which are intended for sale, are more appropriately protected under the registered designs regime.
- 2.1.20. In addition, requiring that designs of useful articles be protected under the registered designs regime ensures that such designs are released into the public domain after 15 years (maximum length of design protection), as compared to the much longer term of protection for copyright, i.e. life of author plus 70 years.
- 2.1.21. We will also review the relevant provisions in the RDA and the Copyright Act to ensure that the interface between design protection and copyright protection is clear. Further, IPOS and MinLaw will look to partner industry and design associations to educate the design community about the legislative regime governing the interface between copyright and design protection. In particular, designers can be better-informed about the appropriate type of IP protection for their creations, as well as the instances where copyright protection is lost.

#### ***“50-articles” threshold***

- 2.1.22. In relation to the proposal to retain the “50-article” threshold, some submissions questioned whether the “50-article” threshold remains an appropriate indicator of industrial application, and thus a meaningful “line in the sand” between the registered designs regime and the copyright regime, in light of the newer forms of designs (e.g. graphic user interfaces) and technological advances (e.g. the advent of new technology such as 3D printing).
- 2.1.23. One submission suggested that the current quantitative “50-article” threshold be replaced by a qualitative test, which could include the following factors, i.e.
- (a) intention of the maker of the article/product; and
  - (b) how the article/product is sold in the particular market or industry.
- 2.1.24. We acknowledge that the “50-article” threshold is an arbitrary figure. However, having a quantitative test can help provide certainty in determining the crossover

between copyright protection and registered design protection. We note that the “50-article” threshold is also used in Australia. While we have considered the suggestion to use a qualitative test, we are concerned that a qualitative test can introduce uncertainty, particularly if there is no/little jurisprudence. Hence, we are in favour of retaining a quantitative threshold. This means that where the volume of an article or product is 50 or less, its design can be protected under copyright law or as a registered design. However, once its volume exceeds 50, the design of that article or product can only be protected as a registered design. This clarity is beneficial for business certainty.

- 2.1.25. To raise awareness of this quantitative threshold between copyright protection and design protection, IPOS and MinLaw will partner industry and design associations to conduct educational and outreach events.

**Conclusion 2:** Reaffirm the policy position to maintain the current minimal overlap between design protection and copyright protection. The designs of useful articles/products, i.e. articles/products having an intrinsic utilitarian function other than to carry the design, are more appropriately protected under the registered designs regime. However, protection should be via copyright where the article or product has no intrinsic utilitarian function other than to carry the design.

Retain the “50-article” quantitative threshold, beyond which copyright protection will cross over to registered design protection.

Legislative provisions relating to the overlap between design protection and copyright protection will be amended for clarity, as well as for consistency between the RDA and the Copyright Act. Activities, in partnership with industry and design associations, will be undertaken to educate the design community about the legislative regime governing the interface between copyright protection and design protection.

### **Interface with Trade Mark Protection**

- 2.1.26. The purpose of trade mark protection is different from that of registered design protection. Specifically, trade marks are used to distinguish the trade origin of a particular trader’s goods or services vis-à-vis those offered by other traders. That said, registered design protection overlaps with trade mark protection when a registrable design is further capable of distinguishing the trade origin of a trader’s goods or services. In this scenario, it is possible that the registrable design can also be registrable as a trade mark.



- 2.1.27. Unlike registered design rights which have a maximum term of 15 years, registered trade marks can exist in perpetuity, subject to being renewed every 10 years. Hence, to the IP owner, trade mark protection is generally more attractive than registered design protection. However, from the users' or public's point of view, the perpetual term of trade mark protection may not always be advantageous.
- 2.1.28. To maintain the balance of interests between IP owners and users, there are exclusions in the Trade Marks Act to limit protection for certain three-dimensional signs (or designs).<sup>18</sup> Specifically, section 7(3) of the Trade Marks Act excludes trade mark protection for signs that consist exclusively of:
- (a) the shape that results from the nature of the goods themselves;<sup>19</sup>
  - (b) the shape of goods which is necessary to obtain a technical result;<sup>20</sup> or
  - (c) the shape which gives substantial value to the goods.<sup>21</sup>
- 2.1.29. However, where the shape sought to be registered as a trade mark does not consist exclusively of what has been stated under section 7(3)(a), (b), or (c) of the Trade Marks Act, then that shape might be registrable.
- 2.1.30. In addition, signs must meet the requirement of "distinctiveness" to be registered as trade marks.<sup>22</sup> It is generally more difficult to prove distinctiveness for trade

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<sup>18</sup> The equivalent of Section 7(3) Trade Marks Act can also be seen in UK and EU legislation. The rationale (as explained by the Court of Justice of the EU in *Philips v Remington*, [2006] EWCA Civ 16, in relation to Art 3(1)(e) of the EC Directive which is in substance similar to Section 7(3)) is "to prevent trade mark protection from granting its proprietor a monopoly over technical solutions or functional characteristics of a product which a user is likely to seek in the products of competitors. Article 3(1)(e) is thus intended to prevent the protection conferred by the trade mark right from being extended, beyond signs which serve to distinguish a product or service from those offered by competitors, so as to form an obstacle preventing competitors from freely offering for sale products incorporating such technical solutions or functional characteristics in competition with the proprietor of the trade mark."

<sup>19</sup> For instance, a mark in the shape of an apple for apples will be excluded.

<sup>20</sup> For instance, the shape of the well-known Lego brick was held by the Court of Justice of the EU in *Lego Juris v OHMI*, T-270/06, to be necessary to perform the technical result of connecting it to another brick, and was therefore excluded from trade mark protection. As explained by the Court of Justice of the EU in *Philips v Remington*, [2006] EWCA Civ 16, this provision is intended "to preclude the registration of shapes whose essential characteristics perform a technical function, with the result that the exclusivity inherent in the trade mark right would limit the possibility of competitors supplying a product incorporating such a function or at least limit their freedom of choice in regard to the technical solution they wish to adopt in order to incorporate such a function in their product". The shape of the Philips three-headed shaver was refused trade mark protection in the EU under this ground because the essential features of the shape are attributable to the technical result. The fact that there are other shapes which also allow the same technical result to be obtained is no defence.

<sup>21</sup> For instance, the slender shape of Bang and Olufsen's loudspeaker was found by the General Court of the EU, Case T-508/08, 6 October 2011, to be an essential element of Bang and Olufsen's branding and giving the loudspeaker substantial added value, and was therefore excluded from trade mark protection.

<sup>22</sup> The distinctiveness requirement is manifest in three of the absolute grounds of refusal in the Trade Marks Act, found in Sections 7(1)(b), 7(1)(c), and 7(1)(d). These are – "trade marks which are devoid of any distinctive character" (Section 7(1)(b)), "trade marks which consist exclusively of signs or indications which may serve, in

mark purposes in relation to a three-dimensional shape as consumers are generally not in the habit of making inferences to the trade origin of a good from just the shape of the good.<sup>23</sup>

- 2.1.31. The above exclusions from trade mark protection for shape are intended to prevent an unfair perpetual monopoly over a particular product via particular design features, more specifically the shape, of the product. The Court of Justice of EU (CJEU) in *Bang & Olufsen A/S v OHIM*<sup>24</sup> accepted that one of the purposes of the exclusions from trade mark protection for shapes of a certain nature was to safeguard the limited terms of protection available under other rights, e.g. design rights.
- 2.1.32. In our public consultation document, we had proposed to maintain the current provisions in the Trade Marks Act in relation to the exclusions for shape. This proposal was broadly supported.
- 2.1.33. MinLaw and IPOS will maintain the current provisions in the Trade Marks Act in relation to the exclusions for shape. We note that there was a suggestion to further clarify aspects of the exclusions for shape in section 7 of the Trade Marks Act. In this regard, we will step up our education and outreach efforts, and also explore the use of guidance notes, to increase awareness and clearer understanding of the interface between registered design protection and trade mark protection.

**Conclusion 3:** Maintain the current provisions in section 7(3) of the Trade Marks Act in relation to exclusions for shape.

Step up education and outreach efforts, and also explore the use of guidance notes, to increase awareness and clearer understanding of the interface between registered design protection and trade mark protection.

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trade, to designate 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” (Section 7(1)(c)), and “trade marks which consist exclusively of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade” (Section 7(1)(d)). As an example, the objection of being devoid of distinctive character was raised in relation to a 2001 Singapore trade mark application for the shape of the Nespresso coffee capsule. This is because the target sector of the public would see the mark as signifying certain functionalities, e.g. as a container for holding the coffee mixture, and not as an indication of trade origin, and as the public is likely to recognise the applicant’s house mark, rather than the container, as the trade mark.

<sup>23</sup> Note that it is possible to fulfil the distinctiveness requirement by showing acquired distinctiveness (e.g. through advertising and marketing efforts undertaken prior to the trade mark filing, and consumer survey results).

<sup>24</sup> Case T-508/08, 6 October 2011

## 2.2. EMERGING DESIGN TRENDS

- 2.2.1. MinLaw and IPOS were cognisant of the importance of being sufficiently forward-looking and anticipating future design trends in our review. This is to ensure that the legislative provisions in the RDA not only stay up-to-date, but will also continue to stay relevant with rapid technology advances and the evolving use of design.
- 2.2.2. Subsection 2.2 presents our recommendations in relation to four design trends that were identified, namely:
- (a) experiential designs;
  - (b) virtual or projected designs;
  - (c) dynamic designs; and
  - (d) 3D printing.

### **(A) Experiential Designs**

- 2.2.3. Experiential designs can be broadly defined as designs that focus on the overall user experience and the various sensorial touch points between the company and its customers. Experiential designs can also be intangible by nature, e.g. centring on a method of customer interaction. Specific examples of “experiential” designs include the “look and feel” of a Starbucks store and the general atmosphere of Disneyland.
- 2.2.4. At present, experiential designs do not fall within the scope of design protection under our RDA. Singapore’s position is similar to most other jurisdictions’. A key challenge with protecting experiential designs is their intangibility. It can be difficult, if not impossible, to identify a specific “article” or “product” that the design is tied to. In addition, it would be difficult, if not impossible, to clearly and objectively represent an experiential design for application/registration. This could introduce uncertainty in determining what exactly is protected by the registered design, and hence lead to problems in determining whether or not there is infringement later.
- 2.2.5. In the public consultation paper, we had proposed not to broaden the scope of design protection to cover “experiential” designs. We note that specific elements of an experiential design are already covered (and more appropriately so) by other types of intellectual property rights, such as passing off and trade marks.
- 2.2.6. There was broad support for this proposal. Specifically, one submission highlighted the difficulty in determining the scope of protection afforded by the registration of

experiential designs would cause uncertainties for both the rights holder and third parties who wish to work in the field. These uncertainties can lead to increased business costs.

**Conclusion 4:** Do not broaden the scope of design protection to cover experiential designs.

#### **(B) Virtual or Projected Designs**

- 2.2.7. For the purposes of this review, virtual or projected designs were defined as designs that can be projected onto various surfaces (or even into space). Virtual or projected designs need not be applied onto specific tangible articles, though they would need to be recognisable as analogous to a physical article, but can be projected onto a wide variety of different surfaces or mediums while still retaining the same design features. An example of a virtual design is using light to project the image of a keyboard onto a surface (or into space), with the virtual keyboard being able to perform the same functions as a physical keyboard.
- 2.2.8. There is an increasing trend in the use of virtual designs. However, such designs are not included under the existing scope of design protection under our RDA. In contrast, we note that virtual designs may be protected in some major jurisdictions, notably UK and EU, due to the flexibility provided through the broader definition of “design” in these jurisdictions. For example, in the UK, we understand that the virtual keyboard itself may be regarded as the “product”, and hence the design or appearance of the virtual keyboard may be registrable.
- 2.2.9. In the public consultation document, MinLaw and IPOS had proposed to amend the definition of “design” in our RDA to allow for protection of virtual designs. However, virtual designs will only be eligible for design protection if they:
- (a) are capable of being represented clearly and without subjectivity on application for design registration; and
  - (b) retain the same (or substantially similar) design features irrespective of the surface or medium they are projected on.
- 2.2.10. These conditions are to ensure that the scope of design protection accorded to a virtual design is clearly defined, and hence minimise subjectivity in determining infringement.
- 2.2.11. Submissions received generally supported this proposal.

**Conclusion 5:** Amend the definition of “design” to provide protection for virtual or projected designs. To qualify for design protection, virtual or projected designs must: (a) be capable of being represented clearly and without subjectivity; and (b) retain the same (or substantially similar) design features irrespective of the surface or medium they are projected on.

### **(C) Dynamic Designs**

- 2.2.12. For the purposes of this review, we had defined a dynamic design to be a design that is applied onto dynamic or fluid medium (e.g. water), and as such take on the dynamic or fluid nature of the medium onto which it is applied. An example of a dynamic design is the spray pattern of a water fountain.
- 2.2.13. Dynamic designs do not fall within the scope of protection under our current RDA as the dynamic or fluid medium would not be taken to be an article. In our view, there are good reasons to exclude protection for such situations. There is a lack of consistency in the reproduction of the design, as well as a high level of subjectivity when representing a dynamic design for application. This can result in a lack of clarity in determining the scope of protection, and hence infringement, of dynamic designs. Furthermore, based on our consultations, there appears to be little demand for the availability of design protection for dynamic designs as an incentive for their creation.
- 2.2.14. In the public consultation paper, we had proposed not to broaden the scope of design protection to cover “dynamic” designs. Submissions received expressed broad support for this proposal.

### ***Graphical User Interfaces (GUIs)***

- 2.2.15. However, we note that some submissions had considered animated Graphical User Interfaces (GUIs) to be a subclass of dynamic designs. While GUIs did not fit our original definition of “dynamic” design for the purposes of this review, we will use this opportunity to clarify the registrability of GUIs in general.
- 2.2.16. A GUI generally refers to the visual elements of the display of a computer system that allows a user to interact with the computer. Examples are icons and screen layout. They can be static or animated. GUIs can be seen as the visual cues that we use to control the various electronic devices that are now an integral part of our lives. The design of GUIs is commercially valuable for companies, as such designs can enhance the user appeal and thus value of the electronic devices.

- 2.2.17. The designs of GUIs are registrable under our existing RDA. To meet the definition of “design” in section 2(1) of the RDA, such designs have to be applied to an article, e.g. a mobile telephone, by an industrial process. Where the design is animated, applicants must file it as a series of static representations of the design.<sup>25</sup> Our position to allow registration of designs of GUIs, both static and animated, is similar to that of many other major jurisdictions.
- 2.2.18. We reaffirm our stance to allow the registration of designs of GUIs. However, this is subject to the conditions that such designs:
- (a) be capable of being represented clearly and without subjectivity on a static medium; and
  - (b) where the design is dynamic, be capable of being represented through a series of freeze-frames of the dynamic design.
- 2.2.19. Moving beyond GUIs, we acknowledge that there could likewise be other subclasses of dynamic designs that may be registrable if they also meet the conditions listed above.

**Conclusion 6:** Reaffirm that dynamic designs can be registered if they are:

- (a) capable of being represented clearly and without subjectivity on a static medium; and
- (b) capable of being represented through a series of freeze-frames of the dynamic design.

For clarification:

- (i) Designs on a fluid medium are not registrable (e.g. the spray pattern of a water fountain).
- (ii) Static GUIs are registrable.
- (iii) Dynamic GUIs that satisfy the above conditions are registrable.

#### **(D) 3D Printing**

- 2.2.20. This review studied 3D printing, or additive manufacturing,<sup>26</sup> and whether amendments to the RDA are required in the face of this trend.
- 2.2.21. At present, 3D printing is more commonly used for prototyping and customised, low volume, production. However, the 3D printing industry is expected to grow significantly, and change the nature of commerce as well as the way we live. In particular, as the prices of 3D printers and required materials fall, it is expected that end users may be able to manufacture products at home via 3D printing rather

<sup>25</sup> See IPOS Practice Direction Number 4 of 2014.

<sup>26</sup> Additive manufacturing is a process of making 3D solid objects from a digital file. In an additive process, an object is created by laying down successive layers of material until the whole item is made.

than purchasing products from retailers. As such, concerns have surfaced in relation to whether 3D printing would facilitate the copying and infringement of registered designs.

- 2.2.22. In our public consultation document, we had proposed not to intervene legislatively in this area without evidence of possible gaps in design protection or enforcement. The concern is that any premature action may inadvertently stymie developments in this nascent field.
- 2.2.23. We had also opined that our current IP laws are sufficiently technology neutral to address the concerns regarding 3D printing. For instance, original blueprints are protected by copyright. Third parties who create digital blueprints of registered designs and distribute them may also be liable for enabling infringement under section 30(2)(b) of the RDA. The unauthorised sale, or making for sale, of objects carrying registered designs are also regarded as infringing acts under the RDA.
- 2.2.24. We note that other jurisdictions, for example Australia, have also arrived at the assessment that there is no present need for reform to their design legislation to address 3D printing.<sup>27</sup>
- 2.2.25. Many submissions agreed with the proposal to not intervene legislatively at this point in time to specifically address 3D printing.
- 2.2.26. However, a concern was raised as to whether Section 30(2)(b) is satisfactory in addressing the situation whereby an infringer creates blueprints of the registered designs and distributes them for sale. Specifically, it was submitted that the breadth and vagueness of Section 30(2)(b) leaves doubts as to which party is responsible for the infringement of a design reproduced by 3D printing.
- 2.2.27. It was also raised that, currently, the RDA provides that infringement only occurs where the registered design is made or imported “for sale or hire” or “for use for the purpose of trade or business”.<sup>28</sup> The doing of any act for a private, non-

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<sup>27</sup> See recommendation 21 of the Australian Advisory Council on IP Designs Final Report: [http://www.acip.gov.au/pdfs/ACIP\\_Designs\\_Final\\_Report.pdf](http://www.acip.gov.au/pdfs/ACIP_Designs_Final_Report.pdf)

<sup>28</sup> Section 30(1) The registration of a design under this Act gives to the registered owner the exclusive right:

(a) to make in Singapore or import into Singapore —

(i) for sale or hire; or

(ii) for use for the purpose of trade or business; or

(b) to sell, hire, or offer or expose for sale or hire, in Singapore, any article in respect of which the design is registered and to which that design or a design not substantially different from it has been applied.

(2) For the purposes of this Act, the right in a registered design is infringed by any person who, without the consent of the registered owner and while the registration is in force:

commercial purpose and for the purpose of evaluation, analysis, research or teaching is excluded from the scope of infringement.<sup>29</sup> It was suggested that there may be a need to consider, in light of the inevitable introduction of 3D printing in homes, whether the current exclusions under Section 30(5) of the RDA should be re-worded to exclude instances where the infringement is wilful and significant.

2.2.28. We have studied the concerns raised in the public consultation. However, we note that there has been no concrete evidence submitted that these are, or are likely to develop into, problems. Many stakeholders have instead opined that intervening legislatively at this point in time would be premature. Our conclusion is to not amend our RDA specifically to address 3D printing at this point in time. However, we will continue to carefully monitor developments in this sector with a view to intervene in a timely manner if required.

**Conclusion 7:** There is no necessity to amend the RDA specifically to address 3D printing at this point in time. However, developments in this sector will be monitored, with a view to intervene in a timely manner if required.

### 2.3. PARTIAL DESIGNS

2.3.1. Singapore allows for the protection of partial designs. IPOS' Practice Direction<sup>30</sup> on design representations (i.e. the images of the design submitted with the design application form) clarifies how a partial design may be claimed and protected. The Practice Direction indicates:

*“To protect a design which only applies to a part or parts of an article, clearly identify the part or parts of the article in solid lines. The parts for which protection is not claimed may be indicated by means of broken or stippled lines, or shaded portions. Broken or stippled lines and/or shaded portions are for illustrative purposes only.”*

2.3.2. Our position, as implemented and clarified in the Practice Direction, is to allow protection of designs that are applied to one part or portion of an article. The other parts of the article for which design protection is not claimed should be

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(a) does anything which by virtue of subsection (1) is the exclusive right of the registered owner [...]

<sup>29</sup> Section 30(5) For the purposes of this Act, the right in a registered design is not infringed by —

(a) the doing of any act for a private non-commercial purpose; or

(b) the doing of any act for the purpose of evaluation, analysis, research or teaching.

<sup>30</sup> Special IP2SG Practice Direction No. 2 of 2014

[http://www.ipos.gov.sg/Portals/0/FAQ/IP2SG/Special%20IP2SG%20PD%20No.%202%20of%202014%20\(EOS\).pdf](http://www.ipos.gov.sg/Portals/0/FAQ/IP2SG/Special%20IP2SG%20PD%20No.%202%20of%202014%20(EOS).pdf) (Page 11, no. 16)



clearly indicated in the application. Examples of partial designs include the shape of the handle of a cup, the shape of the base of a kettle, or the pattern applied onto one portion of a bag.

- 2.3.3. Singapore’s stance to allow for the protection of partial design is in line with most major jurisdictions, including EU, UK, US, Japan, and South Korea. In these jurisdictions, the intention to seek protection for a design applied to only one portion of an article or product is often indicated through the use of solid lines with dotted or dashed lines representing the portions for which protection is not claimed. In contrast, the protection of partial designs is not allowed in Australia and China, although it appears that Australia may be open to re-examining its position.<sup>31</sup> This divergence reflects the view of some jurisdictions that protection for partial designs may lead to over-protection in certain instances.
- 2.3.4. Based on our consultations, it appears that partial designs are relevant and important to businesses, as they are increasingly using the design on specific parts of a product, product line, or even across different product lines to differentiate their products from that of competitors. As such, the ability to protect such “partial designs” was argued to be important to support current and future business trends and needs.
- 2.3.5. Most companies consulted did not consider the possibility of overprotection (with the protection of partial designs) to be a problem. Instead, they highlighted that other designers have more than sufficient room or freedom to create original or different designs without infringing a registered partial design. This view on having sufficient “freedom to innovate” was also shared by the designers whom we spoke to. We share this view as the parts of the product or article for which design protection is not claimed provides other designers with the freedom to design those parts without fear of infringement.
- 2.3.6. Hence, our proposal as set out in the public consultation document was to affirm the current position in the RDA for allowing partial design protection.
- 2.3.7. Submissions received were broadly supportive of this proposal.

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<sup>31</sup> In the Designs Review Final Report by Australia’s Advisory Council on Intellectual Property (“ACIP”) released in 2015, it was recommended that “IP Australia continues to investigate whether allowing partial product registrations would enhance the harmonisation of application requirements in a way that would substantially advantage Australian applicants”.

### “Made and sold separately”

- 2.3.8. Under Section 2 of the RDA, a design must be applied onto an article or a part of an article if that part is made and sold separately. In our public consultation document, we sought views as to whether the expression “if that part can be made and sold separately” should be retained, or be removed to add further clarity to the position that partial design protection is available.
- 2.3.9. Most of the submissions appeared in favour of retaining the expression “if that part can be made and sold separately”. One concern raised in removing the “made and sold separately” requirement is that this removes one layer of safeguard in preventing spare parts from being protected via registered designs.
- 2.3.10. On the other hand, we also acknowledge that one submission had suggested that the expression “made and sold separately” may be incompatible with the concept of partial designs. However, in our view, a partial design satisfies the definition in section 2 of the RDA of a design being “features of shape, configuration, pattern or ornament applied to an article”. There is no requirement that the design must be of the article in its entirety. Further, because an article includes any part of an article if that part is made and sold separately, a partial design can be registered for an entire article or for part of an article if that part is made and sold separately, so long as the item specified as the “article” in the design application falls within one of the sub-classes in the Third Schedule of the Registered Designs Rules.<sup>32</sup> Therefore, the phrase “made and sold separately” can co-exist with the concept of partial design protection.
- 2.3.11. As an example, consider a design which is applied to the handle of a cup. If the applicant only wishes to protect the design of the handle, he should clearly identify the handle in solid lines, and disclaim the other parts of the cup by way of broken lines (or other means as stipulated in the Practice Direction). The article would be identified as a “cup”.
- 2.3.12. As another example, a novel design applied to the handlebars of a motorcycle, where the handlebars can be made and sold separately from the motorcycle, is also registrable. It is not necessary to identify the motorcycle in the application. Instead, it is possible to identify the article as the handlebars, and the

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<sup>32</sup> The classification system found in the Third Schedule to the Registered Designs Rules is based on the 8<sup>th</sup> Edition of the Locarno Classification, which is an international classification used for the purposes of the registration of industrial designs established under the Locarno Agreement Establishing an International Classification for Industrial Designs. This Locarno Agreement is administered by the World Intellectual Property Organization.

representation in the application is just the design of the handlebars. To further elaborate, if the design is only applied to one part, portion, or area of the handlebars, it is still possible to register that partial design – i.e. by identifying the article or product as “handlebars”, and indicating the parts of the handlebars that are disclaimed by way of broken lines (or other means as stipulated in the Practice Direction).

#### “Must fit” and “Must match” exclusions

- 2.3.13. Under our RDA, design features which enable an article to be connected to another article in order to perform a function are excluded from design registration under the “must fit” exclusion. In addition, design features which are dependent upon the appearance of another article (where the designer intends for both articles to form one integral part) are also excluded from design registration under the “must match” exclusions. The “must match” exclusion is intended to limit protection for spare parts, and hence facilitate spare parts manufacturing and sale. The exclusion serves a useful function in the balancing of rights. The “must fit” exception can be seen as a specific situation under the general scope of registered design protection which excludes solely functional design features.
- 2.3.14. There was little feedback from the public consultation relating to the “must fit” or “must match” exclusions, save that it would be useful for IPOS to issue Practice Directions to provide guidance as to the practical effects of these exclusions.

**Conclusion 8:** Affirm the current position to allow for protection of partial designs. The expression “made and sold separately” in the RDA is not inconsistent with the position to allow protection for partial designs, and hence can be retained.

## 2.4. PROTECTION OF COLOURS

- 2.4.1. Under our RDA, “design” means features of shape, configuration, pattern or ornament. Colour is not presently listed as a registrable design feature. Accordingly, in general, a registered design right would cover the features identified in the design application/registration certificate, regardless of colour.
- 2.4.2. However, it should be noted that the interplay of colours may be protected as a “pattern”. In such cases, protection is accorded to the pattern created by the interplay of the colours. Protection is not accorded to the colours *per se*.
- 2.4.3. In comparison, many jurisdictions, including UK, EU, Australia, Japan, and South Korea, expressly state that colour is a protectable design feature, either through

legislation or practice guidelines. It may be worthwhile to note that these jurisdictions set a higher bar for protection, such as the requirement for “individual character” in UK and EU, and the requirement for “creative difficulty” in Japan. Based on our discussions with the IP offices of major jurisdictions, in practice, the design is considered in its entirety when assessing registrability; and the feature of colour on its own is generally not sufficient to confer novelty and/or distinctiveness.

- 2.4.4. At present, design protection is accorded to the features identified in the registration certificate, regardless of colour. This could be seen as offering a broader scope of design protection, as the inclusion or specification of one or more colours in the design application may actually narrow the scope of design protection.
- 2.4.5. Based on feedback from consultations, it appears that companies do regard colour as a useful design feature used in combination with other design features. For some companies, the colour of a design (or part thereof) can be a distinctive characteristic of the companies’ brand or a specific product range. Hence, companies generally welcome the option of protecting specific colours in combination with other design features.
- 2.4.6. However, it is also noted that care needs to be taken not to overly broaden the scope of design protection to the extent that it impinges on the reasonable or legitimate use of colours by others. Specifically, design protection for colours *per se* should not be allowed. One reason cited was the limited pool of available colours. The grant of monopoly design rights on a colour (on its own) was said to be unwarranted, unmeritorious, and even unfair; and may stifle design innovation. It was also highlighted that providing registered design rights is not required to incentivise the creation of new colours.
- 2.4.7. The public consultation document set out the proposal to expressly allow colour to be specified in the application for a design as *one* feature of a novel design, but not to extend the scope of design protection to colours *per se*.
- 2.4.8. Submissions received supported this proposal. It was noted that the use of colours (and their interplay or combination thereof) can create a unique or distinctive visual effect that stands out as a significant design feature of a surface pattern/ornamentation, and should warrant design protection. We agree with this position.

**Conclusion 9:** Amend the RDA to specify colour as one design feature. However, the scope of design protection will not extend to colours *per se*.

## 2.5. UNREGISTERED DESIGN RIGHTS

- 2.5.1. Singapore practises a first-to-file system and does not provide for unregistered design rights. This is a position common across most other countries, except for UK and EU.
- 2.5.2. Under the UK unregistered design right regime, design registration is not necessary for design owners to take action against infringers for a period of up to 15 years (or 10 years from first marketing). Under the EU unregistered community design right regime, design registration is not necessary for design owners to take action against infringers for a period of 3 years.
- 2.5.3. The key advantages of unregistered design rights are that they are obtained automatically and at no cost (as no registration is required). Also, there is an ability to retrospectively determine the scope of right. During consultations with some foreign companies, it was noted that unregistered design rights provide an optional fall-back position where the company has failed, or chosen not, to secure registered design rights.
- 2.5.4. However, the disadvantages of unregistered design rights include:
- (i) shorter length of protection as compared to a registered design right;<sup>33</sup>
  - (ii) increased difficulty in enforcement, due to a higher evidentiary burden;<sup>34</sup>
  - (iii) more limited grounds of infringement, i.e. intentional copying needs to be established; and
  - (iv) increased business uncertainty and costs<sup>35</sup> for users and businesses.
- 2.5.5. Unregistered design rights are generally intended to provide some protection for industries where (a) designs have a short commercial life; and (b) many designs are produced but only a small percentage have any longevity, making it cost-inefficient

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<sup>33</sup> The UK unregistered design right provides for a 15-year term of protection, or 10 years from when the product is first put on sale – whichever is shortest – as compared to a 25-year term of protection accorded to UK registered design rights. The community unregistered design right lasts for three years from the design being made available to the public.

<sup>34</sup> The right owner will need to provide evidence of design creation, ownership, date of first marketing/public disclosure, as well as proof of infringement.

<sup>35</sup> For instance, costs associated with doing an additional freedom-to-operate search and analysis on designs which are not registered, i.e. in a national register. Such a search is likely to be more complex and difficult, hence costing companies more. In addition, there could be additional costs of defending themselves against enforcement actions based upon unregistered design rights.

to file for multiple design applications. For instance, the fashion industry is one that has benefited from the availability of unregistered design rights in UK and EU.

- 2.5.6. In our public consultation document, we had proposed not to introduce a new unregistered design right in Singapore. There was mixed feedback to this proposal.
- 2.5.7. A submission noted that the creation of an unregistered design right would be welcomed by companies in industries with fast moving product cycles and large varieties of designs, such as the fashion industry, where it may not be practicable to seek registration over every design that is produced, especially in cases where the usable lifespan of the product is short. It was also submitted that unregistered design rights could benefit SMEs and individual designers who might have disclosed their designs before applying for registration due to the lack of awareness.
- 2.5.8. In relation to the possible drawbacks of increased uncertainties and costs in conducting freedom-to-operate searches, it was pointed out that such issues were also present with other unregistered IP rights, such as copyright and the tort of passing off. It was further submitted that the uncertainty arising from unregistered design rights is mitigated by the short term of protection, as well as the more limited scope of protection, i.e. unregistered design rights only allow the owner to prevent intentional copying.
- 2.5.9. On the other hand, there were several submissions supporting the proposal not to introduce a new unregistered design right in Singapore. In addition, our earlier consultations with industry suggest that there may be little demand for unregistered design rights apart from the fashion industry. In fact, several companies had highlighted that the disadvantages of increased uncertainty in terms of the scope of existing design rights were likely to outweigh any advantages.
- 2.5.10. MinLaw and IPOS have carefully considered all the feedback received. It is our position that the disadvantages of introducing this new IP right, and in particular, the increased uncertainties in determining the existence of design rights in the market and associated business costs, will likely outweigh the possible advantages.
- 2.5.11. It is also our view that the needs of industries with fast moving product cycles can be adequately met with the currently available forms of IP protection. Using the fashion industry as an example, a designer would be able to rely on copyright protection over his design sketches and the prototype of the outfit, until the point where more than 50 copies of the outfit are produced. In this time, he would be able to pursue legal action against infringers who copy the design of the outfit, for instance after it has been disclosed in a fashion show. When the designer has

decided that more than 50 copies of the outfit will be produced (e.g. after fashion retailers express strong demand), the designer can then seek registered design protection, which can be obtained relatively quickly. The proposed amendment of our grace period provisions will enable designers to seek registered design protection even after the design has been voluntarily disclosed. As such, we will not be introducing a new unregistered design right in Singapore.

**Conclusion 10:** Do not introduce a new unregistered design right in Singapore.

To address the valid needs and concerns of (a) industries with fast moving product lines and/or large varieties of designs as well as (b) SMEs and individual designers who might have disclosed their designs before applying for registration due to the lack of awareness, the provision on grace period for registration of designs will be broadened. (Please refer to section 3.2)

## SECTION 3

### REGISTRATION AND PROTECTION OF DESIGNS

#### 3.1. SUBSTANTIVE EXAMINATION

3.1.1. Substantive examination, which involves an examiner searching databases of published designs and making an evaluation on the novelty and registrability of a design filed, is not required in Singapore. There is no common position internationally. While Japan and US undertake substantive examination for design applications; the EU (and its member states), Australia and China do not.

3.1.2. The key advantages of not conducting substantive examination for design applications are:

- (i) quick registration; and
- (ii) a significantly lower cost for registration.

It was noted that most companies viewed registered designs as a cheap and quick tool to secure some protection for their products, and as complementary to patent protection, which is costlier and takes longer to obtain. The speed and low cost of design registration are particularly useful for companies in the Fast Moving Consumer Goods industry.

3.1.3. However, the advantages of conducting substantive examination for design applications include:

- (i) greater certainty over validity of registered designs; and
- (ii) prevention of the registration of designs that are not new.

Without substantive examination, there could be a higher burden on companies to defend against infringement actions based on invalid registered designs, and to revoke invalid registered designs.

3.1.4. However, there are doubts over the ability of substantive examination to keep designs that are not new off the register, given that the comprehensiveness of design databases and quality of prior art searches are far less developed in the area of designs than, say, in patents. It was also noted that the incidence of disputes involving registered designs was low regardless of whether a jurisdiction conducted substantive examination for design applications.

3.1.5. In our public consultation document, we had proposed not to introduce substantive examination for designs applications in Singapore. The majority of the feedback received agreed with the proposal.



- 3.1.6. It was pointed out that the disadvantages of substantive examination might outweigh its benefits, in view that most registered designs have a relatively short lifespan. The introduction of substantive examination would also impose a greater burden on SMEs and independent designers due to the increased costs and time to registration. As with earlier consultations, the low incidence of disputes involving registered designs was also highlighted.
- 3.1.7. The only feedback supporting the introduction of substantive examination noted the greater certainty over the validity of registered designs that substantive examination would bring. Another feedback also noted that it might be useful to examine design applications to ensure that they are properly classified.<sup>36</sup>
- 3.1.8. MinLaw and IPOS believe that currently, the disadvantages of introducing substantive examination for design applications continue to outweigh its benefits. The introduction of substantive examination may also adversely impact Singapore's young design industry.

**Conclusion 11:** Do not introduce substantive examination for design applications prior to registration.

- 3.1.9. In our public consultation document, we had proposed introducing a post-registration opinion service on validity and infringement. Modelled after the opinion service provided by the UK IP office, the service would, based on prior art submitted by the applicant, provide a non-binding opinion on the validity of a registered design, and/or an opinion on whether a submitted design infringes the registered design. The proposed service was intended to provide some guidance to businesses at a lower cost (as compared to filing a Court action), in the absence of substantive examination.
- 3.1.10. The majority of the feedback received pointed out that a non-binding opinion issued by the Registrar may instead lead to greater uncertainty until a decision has been rendered by the Courts. There were also questions about the fairness of issuing an opinion based on the submission of "evidence" by only one party. In addition, we also noted the low usage of a somewhat similar service in the patents regime – the post-grant substantive examination service for patents that was in place under the patent self-assessment system.

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<sup>36</sup> In practice, the Registrar already seeks clarification from an applicant when, *prima facie*, the classification of a design application appears incorrect.

- 3.1.11. The public consultation document also sought feedback on whether *ex officio* powers to revoke design registrations should be introduced as an easier way to revoke invalid designs on the register. Such powers would allow the Registrar to revoke generic designs without imposing the burden on a third party to undertake revocation proceedings.
- 3.1.12. The majority of the feedback received was of the view that *ex officio* powers for the Registrar to revoke registered designs should not be introduced. It was pointed out that the provisions for revocation proceedings under the RDA were sufficient. All received feedback agreed that both the owner and the “applicant” must have a right to be heard before a design is revoked.

**Conclusion 12:** Do not introduce *ex officio* powers for the Registrar to revoke a registered design.

However, there is still a need to have a quick and cost-effective process of revoking designs to serve as a balance for not conducting substantive examination. The current revocation proceedings at IPOS and at the Courts will be reviewed with a view to simplify proceedings while retaining the right for both parties to be heard.

## 3.2. GRACE PERIOD

- 3.2.1. One of the criteria for the registrability of a design is its newness. In other words, a registered design must be new compared to designs that were published earlier. Hence, a design owner can invalidate his own design by disclosing his design to the public before making an application to register the same design.
- 3.2.2. A grace period allows a designer to disclose his design within a limited period before making a design application without destroying the novelty of his design application. This allows designers to test their design in the market before deciding whether to register their design. It also prevents designers from unintentionally losing the right to acquire design protection. One such scenario occurs when a designer originally relying on copyright protection loses copyright protection upon producing more than 50 copies of the design – and also loses the ability to register the design because novelty has been destroyed.
- 3.2.3. We note that as the provisions for grace period are not aligned internationally, the design owner who relies on the grace period in one jurisdiction may not qualify for design protection in other jurisdictions which do not provide for grace periods. Companies consulted earlier also highlighted that the provision of a grace period may limit the rights of another designer who created the same design within the

same period. This, however, is mitigated by provisions allowing the second designer the right to continue use of the design.<sup>37</sup>

- 3.2.4. In Singapore, the applicant has a grace period of six months after the first disclosure to file a design application, only when the first disclosure occurs at a select list of international exhibitions.<sup>38</sup> Internationally, most major jurisdictions provide for grace periods, although of different lengths. The EU and US provide for a 12-month grace period, while Japan and South Korea provide for a 6-month grace period. Furthermore, the availability of a grace period is not limited to disclosure at a closed list of events/circumstances.
- 3.2.5. In our public consultation document, we had proposed lengthening the grace period from six months to 12 months, and removing the restriction that disclosures can only be made at select international exhibitions. This would allow designers to avoid losing their right to acquire design protection because of unintentional prior disclosure, and greater time flexibility to test their design in the market prior to registration.
- 3.2.6. The feedback received was supportive of the proposal and agreed that the introduction of a 12-month grace period would be useful for businesses to test their products in the market before deciding whether to acquire design protection.

**Conclusion 13:** Amend the RDA to:

- (i) increase the length of the grace period to 12 months; and
- (ii) remove the requirement that disclosures can only be made at select international exhibitions.

### 3.3. DEFERRED PUBLICATION

- 3.3.1. In Singapore, a design application is published after its registration, unless deferment of publication is requested. Publication can be deferred for up to 18

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<sup>37</sup> Section 31(1) and Section 20 of the RDA provides a third party the right to continue using a design if, before the filing date of the registered design, the third party had in good faith carried out an act that would have constituted design infringement if the registration had been in force at the time the act is done, or made effective and serious preparations to do such an act.

<sup>38</sup> The grace period is provided under Section 8(2) of the RDA. The list of official international exhibitions comprises any official, or officially recognised, international exhibition falling within the terms of the Convention on International Exhibitions signed at Paris on 22nd November 1928, and any protocols to the Convention, as revised or amended from time to time, as provided under Section 8(3) of the Registered Designs Act.

months from the filing date of the application.<sup>39</sup> This deferment period is aligned with the 18-month deferred publication period for patent applications. The deferment period allows design owners to preserve the confidentiality of their design (such as until the launch of a corresponding product), and helps prevent a design application from destroying the novelty of an associated patent application.<sup>40</sup>

- 3.3.2. On the other hand, allowing the deferment of publication creates uncertainty as to the scope of design rights already existing in the market. It also affects a second designer who starts using a similar design during the term of deferment. This risk is mitigated by section 39 of the RDA, which provides that damages (for infringement) should not be awarded against a defendant who had no reasonable grounds to believe that a design was registered.
- 3.3.3. There is no uniform term for deferment of publication internationally. The Hague Agreement, which governs the international registration of designs, allows for but does not require a deferment period. Australia and US do not provide for the deferment of publication, while EU and Japan provide for 30 and 36 months of deferment respectively.
- 3.3.4. In the public consultation document, we proposed to retain the request-based 18-month deferment period for design publication. Similar to feedback provided from earlier industry consultations, the feedback received from the public consultation agreed with retaining this 18-month deferment period.
- 3.3.5. In addition, there were also calls to allow applicants to flexibly determine the term of deferment. Under current practice, there is already some flexibility to do so. While deferment requests are approved in an 18-month block, design owners can subsequently request for the design to be published before the full term of deferment.

<p><b>Conclusion 14:</b> Retain the request-based 18-month deferment period for design publication.</p>
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<sup>39</sup> Section 18A of the RDA provides that an applicant may, when filing his application for registration of a design, request that any publication under section 18 of the design be deferred for the prescribed period after the date of filing of that application.

<sup>40</sup> Depending on the priority date of the design and patent application, the publication of a design (especially in jurisdictions where they are considered a design patent) can be novelty destroying for an associated patent application.

### 3.4. FILING OF MULTIPLE DESIGNS IN ONE APPLICATION

- 3.4.1. To reduce the administrative burden for applicants filing for protection for more than one design, Singapore allows the filing of multiple designs in the same application if the designs are within the same sub-classification of the Locarno Classification.<sup>41</sup> In practice, each design would then be accorded separate application numbers and treated as individual applications to facilitate subsequent activities such as publication, renewals and licensing. Registration and renewal fees are payable on a per design basis, with no reduced fees for each additional design filed in the single initial application.
- 3.4.2. In comparison, EU, UK and WIPO (international applications under the Hague Agreement), which do not conduct substantive examination for design applications, provide a broader scope for multiple designs in one application. In these jurisdictions, multiple designs within the same Locarno classification can be filed in a single application. In contrast, Japan and US, which conduct substantive examination for design applications, do not provide for multiple designs in one application.
- 3.4.3. In the public consultation document, we had proposed to allow multiple designs of the same Locarno classification to be filed in one application, as compared to the current position that only allows designs of the same Locarno sub-classification to be filed in one application. The proposed change may reduce the administrative burden of the Registrar, and the resulting cost savings might be passed on to applicants in the form of reduced fees for subsequent designs.
- 3.4.4. The feedback received agreed with the proposal, and noted that reduced fees for subsequent designs filed in the same application would be attractive for applicants. The relaxation of the requirements for multiple designs filed in one application would also reduce the administrative burden for applicants.

**Conclusion 15:** Amend the RDA to allow multiple designs in the same Locarno classification to be filed in one application.

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<sup>41</sup> Rule 22 of the Registered Designs Rules provides that two or more designs may be the subject of the same application for registration if the designs relate to the same class and subclass of articles as classified in accordance with the Third Schedule. The Third Schedule is based on the 8<sup>th</sup> Edition of the Locarno Classification, which is an international classification used for the purposes of the registration of industrial designs established under the Locarno Agreement administered by the World Intellectual Property Organisation.

### 3.5. OWNERSHIP OF RIGHTS

3.5.1. The rights of a design are usually owned by the creator of the design. However, the RDA provides two scenarios where the rights of a design are automatically owned by another party instead:

- (i) When a design is commissioned, the person commissioning the design is treated as the owner of the design.<sup>42</sup>
- (ii) When a design is created by an employee in his course of employment, the employer is treated as the owner of the design.<sup>43</sup>

The two scenarios above are subject to any agreement between the parties concerned.

3.5.2. We received feedback that automatically treating the commissioner as the owner of design has disadvantaged SMEs and independent designers who were unaware of this provision. Singapore's current position is also different from the position in most major jurisdictions, such as Australia, EU, Japan, and US, where the creator, instead of the commissioner, owns the design by default.

3.5.3. To encourage the growth of our local design industry, we believe that it would be beneficial to amend the RDA to provide that the rights of a design vest automatically in the creator unless assigned to the commissioner by written agreement. This will prevent designers unfamiliar with the RDA from unintentionally losing the rights to their designs. In addition, Singapore will be aligning itself to international practice with this amendment.

**Conclusion 16:** Amend the RDA to remove the provision (specifically, Section 4(2)) that automatically treats the person commissioning the design as the owner of the design.

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<sup>42</sup> Section 4(2) of the RDA provides that where a design is created in pursuance of a commission for money or money's worth, the person commissioning the design shall be treated as the owner of the design.

<sup>43</sup> Section 4(3) of the RDA provides that for a design created by an employee in the course of his employment, his employer shall be treated as the owner of the design.

## SECTION 4

### USE OF REGISTERED DESIGNS

#### 4.1. TERM OF REGISTERED DESIGN PROTECTION

- 4.1.1. In Singapore, a registered design is accorded a term of protection of up to 15 years from its date of filing. In other words, a registered design will be released into the public domain, and hence be freely available for public use, within a maximum of 15 years after its filing.
- 4.1.2. Determination of the term of protection of a registered design (and other IPs) is a delicate balance between the rights of the design owner and the benefit to the public. Monopoly rights are accorded to design owners to encourage greater creativity and innovation from designers. The subsequent release of registered designs for public use allows designers greater freedom to innovate. It also allows businesses greater freedom to operate. This can translate into lower costs for consumers.
- 4.1.3. Renewal statistics (renewals are made in 5-year blocks, starting from the 6<sup>th</sup> year) suggest that a 15-year term of protection is sufficient in Singapore. About 51% of the designs on our register were renewed for the first extension, i.e. for years 6 to 10. Subsequently, only about 26% of the remaining pool of registered designs were renewed for the second (and last) extension, i.e. for years 11 to 15. In other words, 87% of registered designs were released for public use by the end of the 10<sup>th</sup> year.
- 4.1.4. There is no international consensus on the maximum term of protection for registered designs. Singapore's position is aligned with South Korea and US. In comparison, Australia provides a shorter 10-year term of protection, while Japan and EU provide a longer 20-year and 25-year term of protection respectively.
- 4.1.5. In the public consultation document, we had proposed to maintain the maximum 15-year term of protection. The feedback received agreed with the proposal. Earlier consultations with companies also indicated little demand for a longer term of protection. Most products had a commercial lifespan of 15 years, although it was noted that some furniture products could enjoy a longer lifespan. There were also strong views from across the design community that a longer term of protection will slow the release of designs into the public domain, to the detriment of the wider public, other designers, and consumers.

**Conclusion 17:** Maintain the current 15-year term of protection for registered designs.

## 4.2. RENEWALS OF REGISTERED DESIGNS

- 4.2.1. A design application in Singapore is automatically granted a 5-year term of protection from its filing date upon registration. The term of protection of the registered design can be extended to 15 years by making subsequent renewal requests, which are granted in 5-year blocks. This is aligned with most jurisdictions, such as EU and Australia. In comparison, a US design registration is automatically given a 15-year term of protection.
- 4.2.2. Cognisant of products with shorter commercial lifespans, we considered whether it would be beneficial to design owners to lower renewals fees by reducing the term of each renewal, such as to an annual renewal structure. Another consideration was the quicker release of registered designs for public use to allow greater freedom to operate.
- 4.2.3. In the public consultation document, we had proposed to maintain the initial 5-year term of protection and the 5-year renewal block structure. The proposal was based on feedback from earlier company consultations. Companies noted that while an annual renewal structure could lower renewal fees, it would impose a greater administrative burden and cost to monitor and renew their registered designs. Companies also noted that a 5-year renewal structure was aligned with the lifecycle of their products.
- 4.2.4. The feedback received from the public consultation was in agreement with the feedback from the earlier company consultations. It was pointed out that application fees and renewal fees were already low, and the reduction of fees may not incentivise filing or renewals.

<p><b>Conclusion 18:</b> Maintain the initial 5-year term of protection and the 5-year renewal block structure.</p>
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## 4.3. INFRINGEMENT AND ENFORCEMENT OF REGISTERED DESIGNS

- 4.3.1. Design protection, like other forms of IP rights, aims to encourage innovation and investment by granting designers a time-limited monopoly over the use of their designs in return for upfront public disclosure, and release into the public domain after a given period. For an IP right to be useful, it is important for rights owners to be able to effectively exploit their rights, including enforcing them against infringers when the need arises.



- 4.3.2. At present, the level of awareness on the use and enforcement of design rights in Singapore appears low. In general, a product or a design may be deemed infringing if it is not “substantially different” from a design that has been registered. However, there is a lack of clear guidelines and jurisprudence as to what constitutes infringement. In addition, there is a general perception that the scope of design protection is narrow, and only covers “almost identical” copies.
- 4.3.3. Businesses are further deterred by the high cost of undertaking enforcement actions. In Singapore, infringement proceedings under the RDA have to be initiated at the High Court. They cannot be initiated at the State Courts. Alternatively, parties can choose to engage alternative dispute resolution services, such as mediation, arbitration and expert determination services. However, to engage alternative resolution services, consent of both parties (the design owner and the alleged infringer) are required to enter into proceedings. These options can be costly, especially for SMEs and individual designers, and may not be commercially viable given Singapore’s small market. Companies generally prefer to focus limited resources on developing new designs to stay ahead of the competition.
- 4.3.4. We acknowledge the concerns on the accessibility of IP dispute resolution system in Singapore, especially with regard to its cost. We note the suggestions to have a “small claims tribunal” for disputes relating to registered designs, and to further promote the use of alternate dispute resolution services. The accessibility of our IP dispute resolution system, especially for SMEs and individuals, is the subject of a broader review of the IP dispute resolution system in Singapore. Once that review is completed, we will share the findings and seek comments from relevant stakeholders and the public.
- 4.3.5. We also acknowledge the concerns on the lack of clarity on the scope of rights and enforcement options. Hence, in the public consultation document, we had proposed for IPOS to partner industry associations, such as the Design Business Chamber Singapore and DesignSingapore Council, to conduct more outreach and information sessions. In addition to awareness building, we also proposed providing guidance notes on specific areas relating to the registered designs regime, especially in the area of infringement, to increase public awareness of acts that would constitute design infringement and to help increase certainty in this area.
- 4.3.6. The feedback received from the public consultation supported this proposal, and highlighted that education and outreach would be important to help designers protect, exploit and enforce their design rights more effectively. In particular, designers need to be persuaded of the commercial value of securing design

protection. The feedback received was also supportive of efforts to provide guidance notes on Singapore's registered designs regime, particularly in the area of infringement.

**Conclusion 19:** Conduct more outreach and information sessions, in partnership with industry associations.

Provide guidance notes on specific areas relating to the registered designs regime, especially in the area of infringement, to increase public awareness of acts that would constitute design infringement and to help increase certainty in this area.

## SECTION 5

### UTILITY MODEL PROTECTION

#### 5. UTILITY MODEL PROTECTION

- 5.1. At present, Singapore does not provide for utility model protection. MinLaw and IPOS had considered the introduction of utility model protection as part of this review as utility model protection is sometimes seen as filling the gap between patent and registered design protection. Utility model protection is generally considered to be a way to provide some form of protection for “sub-patentable” inventions, or minor or incremental inventions, which do not possess the level of inventiveness that is required for patent protection. The functional aspects of these inventions may also not qualify for design protection.
- 5.2. Utility model protection is available in some countries including Australia, Germany, Japan, South Korea, and China.<sup>44</sup> The registration of utility models is typically less stringent as it only requires novelty and/or there is no substantive examination undertaken before registration. As a result, the application process for utility models is usually simpler and less costly compared to a patent application. However, the length of protection is typically shorter.<sup>45</sup>
- 5.3. The purported economic reasons for providing utility model protection include:
- (a) to fill the “gap” in IP protection as described above;
  - (b) to help SMEs, which are said to have (i) more “incremental” or “minor” inventions, and (ii) shallower pockets, and hence not be able to afford the cost of full patent protection; and
  - (c) to provide another IP protection option for companies, particularly SMEs, when devising their business and IP strategy.
- 5.4. On the macro-level, the economic rationale for providing utility model protection is to spur R&D in such minor inventions, and in turn encourage the growth of associated companies and industries.
- 5.5. However, most economic analyses seem to suggest that there is no conclusive economic benefit to introducing or providing utility model protection. For example, the Gowers Review (2006, UK) concluded that there was no correlation

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<sup>44</sup> The list of countries providing for such protection can be found on the World Intellectual Property Organization’s (WIPO’s) website: [http://www.wipo.int/sme/en/ip\\_business/utility\\_models/where.htm](http://www.wipo.int/sme/en/ip_business/utility_models/where.htm)

<sup>45</sup> The length of utility model protection in Australia is 8 years. The length of utility model protection in Germany, Japan, and South Korea is 10 years.

between the existence of utility model protection and high levels of innovation. In addition, the review highlighted the possibility that utility model protection could stunt future innovation and increase costs for some parties/users. The review ultimately recommended against the introduction of utility model protection.

- 5.6. “The Economic Impact of Innovation Patents” report commissioned by IP Australia (2015)<sup>46</sup> did not find any correlation or association between innovation patents (i.e. Australia’s version of utility model protection) and economic variables such as firms’ sales growth or market entry rates. According to the report, there was no evidence to suggest that there was a significant increase in R&D expenditure across Australia (or in certain industry sectors) due to the introduction of utility model protection. Also, the evidence suggested that the great majority of Australian SMEs and individual inventors do not benefit from having utility model protection. Instead, the study found that the system imposed a significant regulatory burden, and was a net cost to most SMEs using it.
- 5.7. Closer to home, some of the key findings from “Protection of Sub-Patentable Inventions in Singapore”, which was commissioned by IP Academy<sup>47</sup>, include:
- (a) Singapore companies very seldom file for utility models in foreign jurisdictions, suggesting that utility model protection is not considered useful in foreign markets.
  - (b) There was relatively weak interest in the possible introduction of this new right.
  - (c) As a measure to help innovative SMEs, introducing utility model protection will not be well-targeted at the SMEs – in fact, data suggested that about half of the beneficiaries would not be individuals or SMEs.
- 5.8. The IP Academy study concluded that the benefits of introducing a new IP right for minor inventions are not compelling relative to the costs. It also recommended that the government of Singapore continues with the status quo, and not introduce a new IP right (i.e. utility model protection) for minor inventions.
- 5.9. We also note that any benefits of introducing utility model protection must be balanced with the possible negative effects on other innovators and companies, e.g. the uncertainties caused by the existence of unexamined rights in the system. As utility models are often not subject to substantive examination, the only way to challenge their validity is either via the courts or through a formal invalidation

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<sup>46</sup> Report can be found at: [http://www.ipaustralia.gov.au/uploaded-files/reports/Economic\\_impact\\_of\\_innovation\\_patents\\_-\\_Report.pdf](http://www.ipaustralia.gov.au/uploaded-files/reports/Economic_impact_of_innovation_patents_-_Report.pdf) (accessed: 10 June 2015)

<sup>47</sup> <https://www.ipacademy.com.sg/research/completed-research/2013-current>

process – both of which can be costly and time-consuming. The benefits of introducing utility model protection should also be weighed against the deprivation to the rest of society/public of being able to utilise (as well as build upon) such incremental or minor innovations.

- 5.10. In our public consultation document, we had proposed not to introduce utility model protection for sub-patentable inventions, at least until there is stronger economic evidence in support of its introduction.
- 5.11. Most feedback received supported the proposal not to introduce utility model protection. It was noted that the administrative, operational, and regulatory resources required to provide a new IP protection could be significant.
- 5.12. In relation to helping SMEs enter and benefit from the IP system, it was felt that this could be better achieved through financial subsidies for patent filings by SMEs. Specific suggestions include a reduction in official fees for patent applications and an introduction of a tiered fee structure for both patents and registered designs depending on the size of the company. In addition, there were suggestions to re-introduce the Patent Application Fund<sup>48</sup>, which ended in 2008.
- 5.13. We however note that there was some support for the introduction of utility model protection. A submission highlighted the provision of utility model protection in many ASEAN and Asian countries; and suggested that by also having utility model protection in Singapore, Singapore could better serve as a gateway into, or hub within, this region. Some of the other economic reasons for introducing utility model protection (as cited in paragraph 5.3) were also cited in the feedback on the proposal not to introduce utility model protection.
- 5.14. MinLaw and IPOS recognise that the cost of patent filing can hinder some SMEs and individuals from seeking patent protection. However, we believe this is better addressed head on by alleviating the cost, or at least part of the cost, of patent filing for SMEs, and will study this in greater detail separate from this designs review.
- 5.15. Feedback from the public consultation did not provide strong evidence of the economic benefit to introducing or providing utility model protection. Hence, it

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<sup>48</sup> The Patent Application Fund (PAF) provided financial assistance for covering part of the costs of patent applications, including drafting, legal and filing costs. The PAF was established in 1992 by the Singapore National Science and Technology Board (NSTB) and supported 50% of the legal, official and other related fees incurred in the process of applying for a patent, up to a maximum of S\$30,000 for each invention. One prerequisite of the PAF was that the research work leading to the invention must be conducted in Singapore.

remains our view that there would be little, if any, positive impact on innovation and overall economic growth by introducing utility model protection in Singapore.

**Conclusion 20:** Do not introduce utility model protection at present. This position can be reconsidered when there is stronger evidence to support the economic value of introducing this new IP right.

## SECTION 6 CONCLUSION

- 6.1. This review of the registered designs regime is timely against the key national economic and design goals. The recommendations and conclusions of this review have been carefully formulated to achieve the three objectives identified at the start of the review, which are:
- (a) to support modern business practices while continuing to balance the interests of design creators/owners and users;
  - (b) to provide business certainty; and
  - (c) to ensure that our design protection regime is cost-effective.
- 6.2. The review reached 20 conclusions, which we hope will enhance the existing registered designs regime to allow it to remain relevant in the face of technological advances, changing distribution models, and the evolving use of designs by businesses. The conclusions have also taken into account the best practices of other major jurisdictions. The 20 conclusions are summarised and matched to the objectives of the review in the table below:

	Conclusion	Support modern business practices	Provide business certainty	Be cost-effective
	<b>Scope of Registered Design (Creation)</b>			
1	Amend the definition of “design” in the RDA to provide for a broader scope of design protection.	✓	✓	
2	Reaffirm the policy position to maintain the current minimal overlap between design protection and copyright protection. The designs of useful articles/products, i.e. articles/products having an intrinsic utilitarian function other than to carry the design, are more appropriately protected under the registered designs regime. However, protection should be via copyright where the article or product has <u>no</u> intrinsic utilitarian function other than to carry the design.		✓	
3	Maintain current provisions in section 7(3) of the Trade Marks Act in relation to exclusions for shape.		✓	
4	Do not broaden the scope of design protection to cover experiential designs.		✓	
5	Amend the definition of “design” to provide protection for virtual or projected designs. To qualify for design protection, virtual or projected	✓	✓	

	<p>designs must:</p> <p>(a) be capable of being represented clearly and without subjectivity; and</p> <p>(b) retain the same (or substantially similar) design features irrespective of the surface or medium they are projected on.</p>			
6	<p>Reaffirm that dynamic designs can be registered if they are:</p> <p>(a) capable of being represented clearly and without subjectivity on a static medium; and</p> <p>(b) capable of being represented through a series of freeze-frames of the dynamic design.</p>	✓	✓	
7	<p>There is no necessity to amend the RDA specifically to address 3D printing at this point in time. However, developments in this sector will be monitored, with a view to intervene in a timely manner if required.</p>	✓	✓	
8	<p>Affirm current position to allow protection for partial designs.</p>	✓	✓	
9	<p>Amend the RDA to specific colour as one design feature. The scope of design protection will not extend to colours <i>per se</i>.</p>	✓	✓	
10	<p>Do not introduce a new unregistered design right in Singapore.</p>		✓	✓
	<b>Conclusion</b>	<b>Support modern business practices</b>	<b>Provide business certainty</b>	<b>Be cost-effective</b>
	<b>Registration and Protection of Designs</b>			
11	<p>Do not introduce substantive examination for design applications prior to registration.</p>			✓
12	<p>Do not introduce <i>ex officio</i> powers for the Registrar to revoke a registered design. Instead current revocation proceedings at IPOS and at the Courts will be reviewed.</p>		✓	✓
13	<p>Amend the RDA to:</p> <p>(a) increase the length of the grace period to 12 months; and</p> <p>(b) remove the requirement that disclosures can only be made at select international exhibitions.</p>	✓		
14	<p>Retain the request-based 18-month deferment period for design publication.</p>	✓		
15	<p>Amend the RDA to allow multiple designs in the same Locarno classification to be filed in one application.</p>			✓



16	Amend the RDA to remove the provision that automatically treats the person commissioning the design as the owner of the design.		✓	
	<b>Conclusion</b>	<b>Support modern business practices</b>	<b>Provide business certainty</b>	<b>Be cost-effective</b>
	<b>Use of Registered Designs</b>			
17	Maintain the current 15-year term of protection for registered designs.	✓		✓
18	Maintain the initial 5-year term of protection and the 5-year renewal block structure.	✓		✓
19	Conduct more outreach and information sessions, in partnership with industry associations. Provide guidance notes on specific areas relating to the registered designs regime, especially in the area of infringement, to increase public awareness of acts that would constitute design infringement and to help increase certainty in this area.		✓	
	<b>Conclusion</b>	<b>Support modern business practices</b>	<b>Provide business certainty</b>	<b>Be cost-effective</b>
	<b>Utility Model Protection</b>			
20	Do not introduce utility model protection at present.		✓	✓

- 6.3. Moving forward, legislative amendments to the RDA will be made, together with changes to IPOS' systems and practices, to implement the review conclusions. While this design review process has been concluded, MinLaw and IPOS will continue to maintain a watching brief of new developments, especially with regard to new technological advances and business practices, emerging design trends, and international best practices. We will also continue to make incremental enhancements to our registered designs regime where appropriate. In this regard, we will appreciate continual feedback.
- 6.4. In conclusion, we will like to acknowledge and thank all the businesses, designers, IP practitioners, academics, and the public, who have provided us with valuable insight on the needs of design creators, businesses, and users, as well as suggestions and feedback on how the registered designs regime can be enhanced to meet these needs.