



17 December 2015

Dear Daren,

Re: Public Consultation on Proposed Changes to Singapore's Registered Designs Regime

We write in response to the public consultation on proposed changes to the registered designs regime in Singapore.

This submission is made by the Association of Singapore Patent Attorneys (ASPA) on behalf of its members.

The Association of Singapore Patent Attorneys is the only professional organisation dedicated solely to the representation of the patent profession in Singapore. ASPA members are engaged in patent work in Singapore and are either registered with IPOS as patent attorneys or are currently undergoing training to qualify as patent attorneys.

In relation to designs, a large number of our members are engaged in filing, prosecuting and enforcing design rights, including registered designs, in Singapore and around the world. Our members represent applicants from Singapore and as well as foreign applicants from the major industrialised countries.

Furthermore, as patent practitioners, even those of our members who may not be actively engaged in designs work are expected to be aware of the provisions governing design protection in Singapore and elsewhere. We may be asked to advise on possible overlap between design rights and patent protection, for example. Because of this, the examinations for qualification as a patent attorney in Singapore, in common with many other jurisdictions, require a working knowledge of design law and its interaction with the other intellectual property rights.

ASPA is therefore keen to ensure that the registered design regime in this country is robust, able to keep up with technological developments and most importantly adequately protects the rights of innovators as well as providing certainty for third parties.

We therefore believe that a review of the registered designs regime in Singapore is timely and welcome the fact that the proposed changes are generally progressive in nature. We provide our detailed comments in relation to the specific proposals below.

Proposal 1 seeks to (a) remove the requirement for the design to be “applied by an industrial process”; (b) replace the word “article” with “product”; and (c) remove the requirement that it be “of manufacture”.

With regard to Proposal 1(a), we do not think that it is necessary or beneficial to remove the language of “applied by any industrial process” from the statute.

Registered designs are a form of industrial property and should be distinguished from purely artistic or aesthetic designs. The removal is also in contradiction to Proposal 9(b), which seeks to keep the 50-article threshold for a design to be considered industrially applied and thereby losing copyright protection. We believe that these two issues should be considered together.

Proposal 2 seeks to not broaden the scope of design protection to cover “experiential” designs.

We believe that the issue with protection of such designs is the difficulty in determining the scope of protection afforded by the registration. This uncertainty causes difficulty both for the rights holder, as well as third parties who wish to work in the field. We therefore agree that the scope of design protection should not extend to “experiential” designs.

Proposal 3 seeks to not broaden the scope of design protection to cover “dynamic” designs.

We generally agree with this proposal. If Parliament were on the other hand minded to introduce legislation to cover “dynamic” designs, then such designs should only be eligible for design protection if the changes in such designs are repeatable or

reproducible in nature. In other words, such dynamic designs should only be protected if they have an element of predictability.

We also consider that dynamic designs should not be limited to those that are applied to dynamic or fluid media. It is entirely possible to have “transformer”-type products that have changing shapes and/or configurations. Finally, we note that design protection is currently available for dynamic graphical user interfaces (GUIs).

Proposal 4 seeks to extend the definition of “design” to cover “virtual” or “projected” designs.

While we agree that virtual and projected designs are more likely to be able to be represented during application without subjectivity than dynamic designs, we are concerned about the possible overlap with other intellectual property rights, such as copyright and patents. The example provided of the virtual keyboard exposes a possible overlap with both of these rights.

The functional aspects of the real-life version of a virtual keyboard are protectable by patent and not registered design right. It is therefore difficult to see how it would be unfair to deny protection for virtual designs if the virtual design (or product) performed the exact same functions as a physical/tangible product.

In Proposal 5, no change is proposed to specifically address the issue of three dimensional (3D) printing.

ASPA considers that the current legislation adequately deals with any issues that may arise from 3D printing. We therefore agree that to the cautious approach outlined in Proposal 5.

Proposal 6 asks for views on partial design protection and proposes to remove the requirement of “made and sold separately” in the Act.

In relation to Proposal 6, the current language of “made and sold separately” is incompatible with the concept of partial designs. We believe that this should be removed if partial designs are allowed. Doing so may result in overlapping designs rights for a single object, which is a situation that currently exists in relation to patent rights.

We do not have any specific comments on Proposal 7 (colour in designs).

In relation to Proposal 8 (unregistered design right), we do not believe that there are good reasons to introduce a regime to protect unregistered design rights in Singapore.

With regard to Proposal 9 (interface with copyright), in addition to the comments made above in relation to Proposal 1(a), we note that there the overlap between designs and copyright is complex and can be very confusing. While seasoned practitioners are aware of the relationships between these two rights, we are concerned that non-practitioners and the public at large may find the interface between copyright and design rights confusing. We believe that it would be beneficial for some effort to be made to simplify the relevant provisions in the statute.

We believe that the current exclusions for shape marks set out in the Trade Marks Act should be maintained (Proposal 10).

In relation to Proposal 11(b), we support the proposal to introduce a post-registration design opinion service. However, it is unclear from the consultation document whether it is intended for only the proprietor to be able to submit prior art for consideration, or if this is available to third parties (i.e., whether the use of the word “applicant” includes any person or just the proprietor). We believe that it should be open to any third parties to submit art for consideration, but in any case believe it is crucial for the statute to clearly set this out.

We believe that it is important for the Registrar to have the ability to revoke a registered design *ex-officio*, if there is no substantive examination of registered design applications. The Registrar should be required to give the proprietor notice of his intention to revoke the registration with a detailed statement of reasons, and the proprietor should have an opportunity to respond to the notice and be provided with an opportunity to be heard. Any decision of the Registrar can then be appealed to court as is presently provided for.

With regard to Proposal 15, we suggest a simplification of the filing procedure in order to make the filing of multiple-design applications more practical. For example, we feel that the onerous requirement for separate views to be filed in specified formats in the case of multiple designs should be removed, or at least simplified.

Furthermore, we suggest increasing the number of drawing views allowed per application from the current limit of 10 views. This will allow for more clarity in the scope of protection sought by the applicant.

We support the conclusion in Proposal 18 that a utility model regime may not be beneficial. We feel that a more effective way to support SMEs would be for the official fees charged for patent applications to be reviewed and reduced.

A good example is the large fee for requesting substantive examination on a patent application, which is very high at the moment. A further change that might be considered might be to have a tiered fee structure for both patents and registered designs, to reduce the cost burdens on SMEs.

We are happy to elaborate on any of the points if needed. If you have any questions or queries in relation to this submission, please do not hesitate to contact us.

Yours faithfully,



Desmond Tan

Secretary

Association of Singapore Patent Attorneys (ASPA)