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TRADE MARKS ACT (CHAPTER 332)

TRADE MARKS (AMENDMENT) RULES 2021

In exercise of the powers conferred by section 108 of the Trade Marks Act, the Minister for Law makes the following Rules:

Citation and commencement

1. These Rules are the Trade Marks (Amendment) Rules 2021 and come into operation on 1 October 2021.

Amendment of rule 8

2. Rule 8(1) of the Trade Marks Rules (R 1) (called in these Rules the principal Rules) is amended by deleting the words “of business of the person whose address is given” and substituting the words “indicated by the address”.

Deletion and substitution of rule 15

3. Rule 15 of the principal Rules is deleted and the following rule substituted therefor:

“Application for registration

15.—(1) An application for the registration of a trade mark must be made in Form TM 4 (called in this Part the application form).

(2) The application must contain a clear indication of the nature of the mark.”.

Amendment of rule 16

4. Rule 16 of the principal Rules is amended by deleting paragraph (2).

Deletion and substitution of rule 20

5. Rule 20 of the principal Rules is deleted and the following rule substituted therefor:

“Translation and transliteration

20. Where a trade mark contains or consists of a word or words in characters other than Roman or in a language other than English, the Registrar may at any time require any of the following documents to be filed with the Registry:

- (a) a copy of the translation in English and, if the case requires, transliteration in English, of the word or words;
- (b) any supporting document certifying or verifying, to the satisfaction of the Registrar, the accuracy of the translation and transliteration (if any) in English of the word or words.”.

Amendment of rule 24

6. Rule 24 of the principal Rules is amended —

- (a) by inserting, immediately after paragraph (5), the following paragraph:

“(5A) For the purpose of paragraph (5), the Registrar may, on the Registrar’s own accord, send to the applicant the Registrar’s grounds of decision for the decision in respect of the representations of the applicant.”;

- (b) by inserting, immediately after the word “Where” in paragraph (6), the words “the Registrar’s grounds of decision are not sent to the applicant under paragraph (5A), and”; and

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- (c) by inserting, immediately after the words “are sent to the applicant” in paragraph (8), the words “under paragraph (5A) or (6)(b)”.

Amendment of rule 31A

7. Rule 31A of the principal Rules is amended —

- (a) by inserting, immediately after paragraph (1), the following paragraphs:

“(1A) Subject to paragraphs (1B) and (2), the Registrar may, in any case after specifying the periods within which the evidence mentioned in paragraph (1) may be filed by the parties, shorten any of those periods.

(1B) The Registrar may only exercise the Registrar’s power under paragraph (1A) after giving the parties an opportunity to be heard.”; and

- (b) by inserting, immediately after the words “paragraph (1)” in paragraphs (2), (3)(a), (4)(a) and (5)(a), the words “, or as shortened by the Registrar under paragraph (1A) (if applicable),”.

Amendment of rule 32

8. Rule 32(1) of the principal Rules is amended —

- (a) by deleting the words “before the expiry of the later of the following periods:” and substituting the word “within —”;
- (b) by inserting, immediately after the words “rule 31A(1)” in sub-paragraph (a), the words “, or as shortened by the Registrar under rule 31A(1A) (if applicable),”; and
- (c) by inserting the word “or” at the end of sub-paragraph (a).

Amendment of rule 33

9. Rule 33(1) of the principal Rules is amended by inserting, immediately after the words “rule 31A(1)” in sub-paragraph (a), the words “, or as shortened by the Registrar under rule 31A(1A) (if applicable),”.

Amendment of rule 34

10. Rule 34(1) of the principal Rules is amended by inserting, immediately after the words “rule 31A(1)” in sub-paragraph (a), the words “, or as shortened by the Registrar under rule 31A(1A) (if applicable),”.

Amendment of rule 36A

11. Rule 36A of the principal Rules is amended —

- (a) by deleting the words “appear at” in paragraph (6) and substituting the word “attend”; and
- (b) by inserting, immediately after paragraph (7), the following paragraphs:

“(8) Despite paragraphs (1) and (2) but subject to paragraphs (9), (10) and (11), the Registrar may direct that a pre-hearing review be held in an asynchronous manner by exchange of written correspondence with the parties, and the Registrar may exercise any power conferred on the Registrar under this rule for the purpose of securing the just, expeditious and economical disposal of the proceedings.

(9) Where a pre-hearing review is held under paragraph (8), the Registrar must —

- (a) before giving any direction or imposing any requirement on the parties on any matter, give each party an opportunity to address the Registrar on the intended direction or requirement; and
- (b) before giving any direction or imposing any requirement on a party that affects a party’s rights or interests, give that party an opportunity to address the Registrar and respond to any submission made by the other party on the intended direction or requirement.

(10) For the purpose of exercising the Registrar’s powers under paragraph (6) or (7) in a pre-hearing review held under paragraph (8), the references to the non-attendance of a party in paragraph (6) and the absence of a party in paragraph (7) are each to be read as a reference to the failure of a party to respond to the Registrar’s written correspondence relating to the pre-hearing review within the time specified in the written correspondence.

(11) The Registrar must not hold a pre-hearing review in an asynchronous manner under paragraph (8) if any party requests that the pre-hearing review be held in accordance with paragraph (1) instead.”.

Deletion and substitution of rule 47

12. Rule 47 of the principal Rules is deleted and the following rule substituted therefor:

“Certificate of contested validity of trade mark

47.—(1) This rule applies where the Registrar or the Court has certified under section 102(1) of the Act that the registration of a trade mark is found to be wholly or partially valid in any proceedings before the Registrar or the Court (as the case may be), and the fact that the validity of the registration was contested in the proceedings.

(2) If the certificate is given by the Court, the proprietor of the registered trade mark may file a written request with the Registrar to add to the entry of the trade mark in the register a note that the certificate has been given in the course of the proceedings, and a copy of the certificate must be filed together with the written request.

(3) The Registrar must, on receipt of the request mentioned in paragraph (2) and the copy of the certificate, add the note to the entry of the trade mark in the register.

(4) If the certificate is given by the Registrar, the Registrar must add to the entry of the trade mark in the register a note that such certificate has been given in the course of the proceedings.”.

Amendment of rule 59

13. Rule 59(1A) of the principal Rules is amended —

(a) by inserting, immediately after sub-paragraph (a), the following sub-paragraphs:

“(aa) subject to sub-paragraphs (b) and (c), the Registrar may, in any case after specifying the periods within which the evidence mentioned in sub-paragraph (a) may be filed by the parties, shorten any of those periods;

(ab) the Registrar may only exercise the Registrar’s power under sub-paragraph (aa) after giving the parties an opportunity to be heard;”;

(b) by inserting, immediately after the words “under sub-paragraph (a)” in sub-paragraphs (b), (c), (f) and (g)(ii), the words “, or as shortened by the Registrar under sub-paragraph (aa) (if applicable),”.

Amendment of rule 67A

14. Rule 67A of the principal Rules is amended —

(a) by inserting, immediately after paragraph (7), the following paragraph:

“(7A) For the purpose of paragraph (7), the Registrar may, on the Registrar’s own accord, send to every party the Registrar’s grounds of decision for the decision in respect of any request under this rule.”;

(b) by deleting paragraph (8) and substituting the following paragraph:

“(8) Where the Registrar’s grounds of decision are not sent to every party under paragraph (7), and any party wishes to have the Registrar’s grounds of decision in respect of a request under this rule —

(a) the party must, within one month after the date of the Registrar’s decision, request the Registrar in the following manner to state the Registrar’s grounds of decision:

(i) in the case of grounds of decision in respect of a request under paragraph (1) — by filing Form HC5 with the Registrar;

(ii) in the case of grounds of decision in respect of a request under paragraph (3) — by sending a written request to the Registrar; and

(b) the Registrar must, within 2 months after the date of the request, send the grounds of decision to the party.”; and

(c) by inserting, immediately after the words “are sent” in paragraph (9), the words “to every party under paragraph (7A) or”.

Deletion and substitution of rule 68

15. Rule 68 of the principal Rules is deleted and the following rule substituted therefor:

“Hearing before Registrar to be public

68.—(1) The hearing before the Registrar of any proceedings relating to any matter under the Act or these Rules must be in public unless the Registrar, after consultation with the party or parties, otherwise directs.

(2) Paragraph (1) does not apply to —

(a) any pre-hearing review under rule 36A;

(b) any taxation proceedings under rule 74; or

(c) any case management conference under rule 81A.”.

Amendment of rule 73

16. Rule 73(1) of the principal Rules is amended by deleting the words “within one month” and substituting the words “within 6 weeks”.

Amendment of rule 75

17. Rule 75 of the principal Rules is amended by inserting, immediately after paragraph (2), the following paragraphs:

“(3) In applying the provisions in the Fourth Schedule, the Registrar may take into account any direction given by the Registrar under rule 81C in relation to the conduct of 2 or more matters or proceedings.

(4) Paragraphs (1) and (2) do not apply to any taxation of costs of a proprietor of a registered trade mark who is entitled under section 102(2) of the Act to the proprietor’s costs as between solicitor and client.”.

Deletion and substitution of rule 76

18. Rule 76 of the principal Rules is deleted and the following rule substituted therefor:

“Certificate of taxation

76. Where a bill of costs has been taxed, the Registrar must make the Registrar’s certificate for the amount of the taxed costs.”.

Amendment of rule 78A

19. Rule 78A of the principal Rules is amended by deleting the word “malfunction” in paragraphs (3)(d) and (4)(a) and substituting in each case the words “interruption in the operation”.

Deletion of rule 78I

20. Rule 78I of the principal Rules is deleted.

Amendment of rule 81A

21. Rule 81A of the principal Rules is amended —

- (a) by deleting the words “appear at” in paragraph (6) and substituting the word “attend”; and
- (b) by inserting, immediately after paragraph (8), the following paragraphs:

“(9) Despite paragraphs (1) and (2) but subject to paragraphs (10), (11) and (12), the Registrar may direct that a case management conference be held in an asynchronous manner by exchange of written correspondence with the parties, and the Registrar may exercise any power conferred on the Registrar under this rule for the purpose of securing the just, expeditious and economical disposal of the matter.

(10) Where a case management conference is held under paragraph (9), the Registrar must —

- (a) before giving any direction or making any order on any matter, give each party an opportunity to address the Registrar on the intended direction or order; and
- (b) before giving any direction or making any order that affects a party’s rights or interests, give that party an opportunity to address the Registrar and respond to any submission made by the other party on the intended direction or order.

(11) For the purpose of exercising the Registrar’s powers under paragraph (6) or (7) in a case management conference held under paragraph (9), the references to the non-attendance of a party in paragraph (6) and the absence of a party in paragraph (7) are each to be read as a reference to the failure of a party to respond to the Registrar’s written correspondence relating to the case

management conference within the time specified in the written correspondence.

(12) The Registrar must not hold a case management conference in an asynchronous manner under paragraph (9) if any party requests that the case management conference be held in accordance with paragraph (1) instead.”.

Amendment of rule 81B

22. The principal Rules are amended by renumbering rule 81B as paragraph (1) of that rule, and by inserting immediately thereafter the following paragraph:

“(2) Without limiting paragraph (1), the Registrar may control the evidence by giving directions as to —

- (a) the issues on which any evidence is required; and
- (b) the way in which the evidence is to be adduced.”.

New rule 81C

23. The principal Rules are amended by inserting, immediately after rule 81B, the following rule:

“Consolidation of matters or proceedings

81C.—(1) The Registrar may order 2 or more matters or proceedings to be consolidated on terms that the Registrar thinks just, or order them to be heard at the same time, or one immediately after another, or order any of them to be stayed until after the determination of any other of them, if the Registrar is of the opinion that —

- (a) there is some common question of law or fact in the matters or proceedings;
- (b) the rights to relief claimed in the matters or proceedings are in respect of or arise out of the same factual situation; or
- (c) for any other reason it is desirable to make an order under this rule.

(2) The Registrar may only exercise the Registrar’s power under paragraph (1) after giving the parties an opportunity to be heard.”.

Amendment of First Schedule

24. The First Schedule to the principal Rules is amended —

(a) by deleting the Schedule reference and substituting the following Schedule reference:

“Rule 3”;

(b) by deleting the words “filed by means of the electronic online system” in items 1 and 1A; and

(c) by deleting items 2, 9, 22, 23, 28, 30, 35 and 36.

Amendment of Second Schedule

25. Items 7 and 23 of the Second Schedule to the principal Rules are deleted.

Amendment of Fourth Schedule

26. Item 11 of the Fourth Schedule to the principal Rules is amended by deleting the words “and obtaining the Registrar’s certificate or order”.

Saving and transitional provisions

27.—(1) Despite rule 4, rule 16(2) of the principal Rules as in force immediately before 1 October 2021 continues to apply to or in relation to any application for the registration of a trade mark made before that date.

(2) Despite rule 5, rule 20 of the principal Rules as in force immediately before 1 October 2021 continues to apply to or in relation to any application for the registration of a trade mark made before that date.

(3) Despite rule 16, rule 73(1) of the principal Rules as in force immediately before 1 October 2021 continues to apply to or in relation to any award of costs made before that date by the Registrar.

*[G.N. Nos. S 598/2008; S 588/2011; S 761/2013;
S 743/2014; S 739/2015; S 22/2017; S 149/2017;
S 433/2020]*

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