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Dear Ms Liew

**COMMENTS ON PATENTS (AMENDMENT) BILL 2004 AND TRADE MARKS (AMENDMENT) BILL 2004**

We enclose herewith our firm's comments on the Patents (Amendment) Bill 2004 and Trade Marks (Amendment) Bill 2004, in response to the public consultation exercise.

Should you have any further questions or queries, please feel free to contact us.

Yours sincerely



**Sheena Jacob**  
Partner

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## **COMMENTS ON PATENTS (AMENDMENTS) BILL 2004(THE “BILL”)**

### **Clause 3 – Date of filing applications**

We submit that the amendment to section 26(6) creates uncertainty as to when a divisional can no longer be filed, or if it has been correctly filed. With this amendment, the cut-off point is not when a document is filed, but when the Patent Office determines that that the document filed is satisfactory.

An applicant would not know if he can still file a divisional. It may lead to a less efficient situation for the Patent office as it will have to document the date of satisfaction vigilantly, and applicants will be more inclined to withhold a document that is required, pay the grant fee and await notification under section 30 so that there is certainty as to when the last day of filing a divisional is, thereby creating more work for the Patent Office.

### **Clause 4 – Unity of invention**

We understand that the Patent Office will be relying on the Examination Report, IPER, IPROP etc. to determine if there are any unresolved issues of lack of unity of invention. However, the standard of “unity of invention” varies considerably around the world.

By taking into account these reports from various jurisdictions with different standards, the integrity of Singapore’s patent law may be compromised as a situation where an unresolved objection on the ground of lack of unity of invention exists even though there is unity of invention under Singapore law may well arise.

The fact that there is no indication as to how or who in the Patent Office would determine if there is unity of invention, and the effect of section 37, i.e. no judicial interpretation on the issue, exacerbates the problem.

Therefore, the Patent Office will need to provide guidelines on who is in the position to make a determination of whether there is unity under Singapore law, and the standard to be applied under Singapore law.

### **Clause 8 – Extensions of patent term for unreasonable delays**

The onus of proof on the applicant in proving unreasonable delay is unduly heavy, and it may result in a situation where unreasonable delay can only be established in the most extreme situations. We would recommend a more generous approach to defining unreasonable delays.

### **Clause 9 – Search and examination after grant**

The new section 38A does not cover the situation where some or all of the claims were not searched and/or examined due to a perceived lack of unity problem at the ISA (but not the IPEA), or if an Article 17 declaration is issued, thus creating a lacuna in the law.

### **Clause 20 – Restrictions on recovery of damages for infringement**

The amended section 69(3)(b) restricts its application to only 2 instances. It does not include situations where the claims have not been searched. This may be unfair for defendants as there is no requirement that patentees can only issue proceedings for infringement until all relevant claims have been searched and examined. Thought patentees can be “punished” by the judge’s exercise of discretion on damages, the defendant still has to go through the expense of defeating unsearched and unexamined claims which may be hopelessly invalid.

**Clause 23 – Revocation**

The ground of non-compliance with section 25(5) does not appear in the amended section 80. Article 16.7(4) of the United States-Singapore Free Trade Agreement (the “FTA”) provides that “... a patent may only be revoked on grounds that would have justified a refusal to grant the patent ...”.

We therefore submit that the amended section 80 should refer to the grounds of refusal under sections 29 and 30, and the grounds for abandonment under section 30(7)(d) to fully comply with the terms of the FTA.

## **COMMENTS ON THE TRADE MARKS (AMENDMENT) BILL 2004 (THE "BILL")**

### **Clause 2 – Marks that are not visually perceptible**

The amendment to the definition of a trade mark in section 2(1) makes marks that are not visually perceptible registrable. However, the requirement that a mark has to be represented graphically remains.

Other jurisdictions requiring non visually perceptible marks to be represented graphically have experienced great difficulty in the registration of non visually perceptible marks, and there appears to be no solution to the problem provided by European cases. It is hoped that the Patent Office can clarify the methods in which a non visually perceptible is deemed to be sufficiently represented graphically so as to make non visually perceptible marks registrable in fact, rather than merely in theory. In particular, we anticipate difficulty in the representation of marks containing holograms and moving images.

### **Clauses 5 and 11 – Additional protection of well-known marks**

The amendments to sections 8 and 27 to give greater protection to well-known marks appears to be inadequate to fully implement Article 4 of the Joint Recommendation Concerning Provisions on the Protection of Well-Known Marks ("Article 4").

Article 4 states that use that would amount to a free ride on the goodwill of a well-known mark would entitle a well-known trade mark proprietor to block registration of conflicting marks and use of such marks in the course of trade in respect of unrelated goods or services. However, the Bill additionally requires the value of the well-known mark to be diminished as a result of such use in order to give rise to a claim under this provision.

We recommend that Article 4 be implemented without this additional request as it may be too onerous for the well-known trade mark proprietor to prove that the value of the well-known trade mark has been diminished.

### **Clause 23 – Police powers**

The new section 53A in the Bill provides that police can exercise its powers of search, seizure and detention of counterfeit goods and evidence of trade mark offences without a search warrant issued under section 62 of the Criminal Procedure Code (Cap. 68) (the "CPC"). However, this power is limited as it can only be exercised against "any conveyance".

It seems an anomaly that while under the CPC, the police have wide powers of search, seizure and detention against any premises, its powers under the Bill should be limited to conveyances. This would create an undesirable situation where the powers the police has is determined by the statute they choose to exercise their powers under.