

Information Note on the interface between registered designs and copyright

(Updated as of 6 October 2017)

Introduction

1. This Information Note provides general information on the interface between the registered designs regime and the copyright regime. The Copyright and Registered Designs law of Singapore in force as on 30 October 2017 has been used to prepare this Information Note. The information contained in this Information Note has been simplified for ease of reading, and is not intended to be comprehensive on the entire interface between registered designs and copyright. Should you require the full details, we suggest that you refer to the actual legal provisions themselves (a list of the relevant legal provisions has been placed at the **Annex** at the end of this Information Note).
2. This Information Note does not constitute, and should not be relied upon, as legal advice. For advice that is tailored to your specific factual circumstances, we highly recommend that you approach a Singapore law firm.

How the visual expression of a designer's design may be protected under copyright

3. The visual expression of a designer's design may be protected as an artistic work under copyright law.
 - (a) The design drawing of the design, and the article itself, may each be artistic works protected by copyright. For an artistic work to be protected by copyright, the item that is the artistic work must have originated from its creator,¹ and must not have been copied from elsewhere.
 - (b) No registration is required to obtain copyright protection.
4. The copyright owner of an artistic work has the following exclusive rights: (a) to control the reproduction of the work in a material form; (b) to publish the work in Singapore or any country in relation to which the Copyright Act applies, if the work is unpublished; and (c) to communicate the work to the public. For (a), protection is against the whole or a substantial portion of the work being copied without permission by third parties. Even if only a portion is copied, copyright infringement may still be found by a Court, for example, if significant visual elements are copied.
5. Infringement of artistic work copyright occurs when a third party, without permission, does in Singapore or authorises the doing in Singapore of, any act that is within the copyright owner's exclusive rights (described in paragraph 4 above). In addition, infringement of artistic work copyright can also occur by

¹ It should be noted that the creator of an artistic work is referred to as the "author" in the Copyright Act.

importation for sale for hire, or by sale or other dealings, with articles that were made without the consent of the copyright owner.²

Copyright exceptions to the protection of designs

6. In the interface between registered designs and copyright, **there are three key exceptions to copyright protection.**
7. Under **Exception 1** and **Exception 2** below, there is no copyright protection for mass produced products. For these exceptions, **“more than 50”** is the threshold for when a product is mass produced, except for articles manufactured in lengths or in pieces that are not handmade (such as non-handmade wallpaper and floor tiles), where the production of one such article is sufficient. When this benchmark is reached, copyright protection is lost. Therefore, if intellectual property protection for the appearance of such mass produced products is desired, it should be sought under the Registered Designs Act. As for **Exception 3** below, copyright protection is not available to designs that have been registered under the Registered Designs Act, since protection is already available under that Act to registered designs.

(a) Exception 1 - The copyright exception for the making of useful articles and non-physical products

There is an exception to copyright infringement that applies to the making of “useful articles” and the making of “non-physical products”.

The making of any useful article in 3 dimensions (including a reproduction in 2 dimensions reasonably required for the making of the useful article), or of any non-physical product, does not infringe the copyright in an artistic work, if, when the useful article, reproduction or non-physical product is made, the artistic work has been “applied industrially” in Singapore or in any other country at any time before the useful article, reproduction or non-physical product is made.

As background:

- A “useful article” is any article having an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information. In addition, an article that is normally part of a useful article is considered a useful article.
 - So for example, consumer products such as cars, boats, washing machines, printers and so on, and the spare part components of such consumer products, would be considered to be useful articles.

² The provisions relating to infringement of artistic work copyright can be found at Sections 31 to 33 of the Copyright Act, which is available on Singapore Statutes Online at www.statutes.agc.gov.sg.

- A “non-physical product” is any thing that (i) does not have a physical form; (ii) is produced by the projection of a design on a surface or into a medium (including air); and (iii) has an intrinsic utilitarian function that is not merely to portray the appearance of the thing or to convey information.
 - So for example, a virtual keyboard that does not have a physical form and which is projected by light onto a surface or into the air, and which can be used to type characters in the same manner as a computer keyboard that is a physical object (and so has an intrinsic utilitarian function), is a non-physical product.

For this Exception 1, the artistic work is considered to be “applied industrially” (i.e. mass produced) if any of the following apply:

- (i) more than 50 reproductions in 3 dimensions are made of it, for the purposes of sale or hire;
- (ii) it is reproduced in 3 dimensions in one or more articles manufactured in lengths (such as wallpaper), for the purposes of sale or hire; *or*
- (iii) it is reproduced as a plate which has been used to produce:
 - (1) more than 50 reproductions of an object in 3 dimensions for the purposes of sale or hire; *or*
 - (2) one or more articles in 3 dimensions manufactured in lengths (such as wallpaper), for the purposes of sale or hire.

Example in relation to Exception 1

John draws a novel design for a computer keyboard on a piece of paper.

The design drawing of the computer keyboard is an “artistic work” for copyright purposes.

If John carries out either of the following, the design drawing of the computer keyboard is considered to be “applied industrially” (i.e. mass produced), and there is no copyright protection.

- (a) John makes more than 50 computer keyboards (that are physical objects i.e. articles) with the design for the purposes of sale or hire whether in Singapore or in any other country; *or*
- (b) John develops more than 50 virtual keyboards (that are non-physical products) with the design for the purposes of sale or hire whether in Singapore or in any other country;

Where “applied industrially” has occurred, if third parties make computer keyboards that are physical objects or virtual computer keyboards to the

design without permission, such acts by third parties do not infringe the copyright in John's design drawing of the computer keyboard.

(b) Exception 2 - The copyright exception for where the design has been applied industrially but the design has not been registered under the Registered Designs Act

There is an exception to copyright infringement where the corresponding design to an artistic work has been "applied industrially" (i.e. mass produced) by or with the license of the copyright owner, but the design has not been registered under the Registered Designs Act.

- A design is a corresponding design in relation to an artistic work if, when applied to an article or non-physical product, it results in a reproduction of the artistic work.

This exception operates where (a) to (d) below all apply:

- (a) copyright subsists in an artistic work;
- (b) a corresponding design is applied industrially, whether in Singapore or elsewhere, by or with the licence of the copyright owner in the work;
- (c) articles or non-physical products to which the corresponding design has been so applied, or devices³ for projecting these non-physical products, are sold, let for hire, or offered or exposed for sale or hire, whether in Singapore or elsewhere; *and*
- (d) at the time when those articles, non-physical products or devices are sold, let for hire, or offered or exposed for sale or hire, those articles or non-physical products are not articles or non-physical products in respect of which the corresponding design has been registered under the Registered Designs Act.

For this Exception 2, a design is deemed to be applied industrially to articles if:

- (a) the design is applied to one or more articles that are manufactured in lengths or in pieces which are not handmade articles (such as non-handmade wallpaper and floor tiles);
- (b) the design is applied to more than 50 articles; *or*
- (c) the design is applied to both articles and non-physical products (totalling more than 50).

For this Exception 2, a design is deemed to be applied industrially to non-physical products if:

³ A device for projecting a non-physical product (a) is any device that when activated projects the non-physical product on a surface or into a medium (including air); and (b) includes any product or component that is used in or with a device mentioned in (a) to project the non-physical product into a surface or into a medium (including air).

- (a) the design is applied to more than 50 non-physical products; *or*
- (b) the design is applied to both articles and non-physical products (totalling more than 50).

The date on which the design is applied to the article or non-physical product is irrelevant.

The effect of this copyright exception is as follows:

- (a) there is no copyright infringement for 15 years in respect of all relevant articles and non-physical products, beginning from the date on which articles, non-physical products or devices for projecting those non-physical products, were first sold, let for hire, or offered for sale or hire, whether in Singapore or elsewhere; and
- (b) after the end of the 15 years, the scope of the copyright exception expands from the scope in (a) to also cover all associated designs, articles and non-physical products. To elaborate, this means that there is no copyright protection against all associated designs (i.e. every possible design consisting of that design but with modifications or variations not sufficient to alter the character or substantially to affect the identity thereof), and the copyright exception covers all the articles and non-physical products to which the design and every associated design was capable of being applied.

Therefore, it is highly recommended to apply for registration under the Registered Designs Act if you envisage that your design is going to be applied industrially (i.e. mass produced), so as to obtain intellectual property rights protection under the registered designs regime.

Example in relation to Exception 2

Mary draws a novel design for a computer keyboard on a piece of paper.

The design drawing of the computer keyboard is an “artistic work” for copyright purposes.

If the computer keyboard design, when applied to a physical object (an article) or when applied to an intangible virtual keyboard that is projected onto a surface (which is a non-physical product), results in a reproduction of the artistic work, the design is a “corresponding design” to the artistic work.

For the situations discussed below in this Example, we will assume that Mary is the copyright owner of this “artistic work”.

Situation 1 – More than 50 articles

Mary makes 51 computer keyboards (that are physical objects i.e. articles) with the design, and offered or exposed for sale these computer keyboards. At the time when these computer keyboards were offered or exposed for sale, the

corresponding design of the computer keyboard had not been registered for articles under the Registered Designs Act.

Situation 2 – More than 50 non-physical products

Mary developed 51 virtual keyboards (which are non-physical products) with the design. These 51 virtual keyboards are projected from 51 devices (each device, when activated, can project 1 virtual keyboard onto a surface). Mary offered or exposed for sale the devices for projecting these virtual keyboards. At the time when these devices were offered or exposed for sale, the corresponding design of the computer keyboard had not been registered for non-physical products under the Registered Designs Act.

Situation 3 – Both articles and non-physical products totalling more than 50

Mary developed 40 computer keyboards (that are physical objects i.e. articles) as well as developed 11 virtual keyboards (which are non-physical products) with the design. The 11 virtual keyboards are projected from 11 devices (each device, when activated, projects 1 virtual keyboard onto a surface). In this situation, the total number of articles and non-physical products is 51 (i.e. the total number exceeds 50). Mary offered or exposed for sale the computer keyboards (that are physical objects) as well as the devices for projecting the 11 virtual keyboards. At the time when the computer keyboards (that are physical objects) as well as the devices for projecting the virtual keyboards were offered or exposed for sale, the corresponding design of the computer keyboard had not been registered for articles and for non-physical products under the Registered Designs Act.

Under all 3 situations above, the design of the computer keyboard is deemed to be applied industrially (i.e. mass produced), and there is no copyright protection.

Therefore, Mary should have applied for registration under the Registered Designs Act when she envisaged that the novel design of her computer keyboard was going to be applied industrially (i.e. mass produced), so that she could obtain intellectual property rights protection under the registered designs regime.

(c) Exception 3 - The copyright exception for where the design is registered under the Registered Designs Act

There is an exception to copyright infringement where the corresponding design to an artistic work is registered under the Registered Designs Act. In such situation, protection of the design is from the design rights under the Registered Designs Act.

- A design is a corresponding design to an artistic work if, when applied to an article or non-physical product, it results in a reproduction of the artistic work.

The effect of this copyright exception is as follows:

- (a) there is no copyright protection for the aggregate of the things that fall within the exclusive rights of a registered designs owner under the Registered Designs Act.⁴ This applies during the subsistence⁵ of the copyright in the registered design; and
- (b) after the subsistence of the copyright has come to an end, the scope of the copyright exception expands from the scope in (a) to also cover all associated designs, articles and non-physical products. To elaborate, this means that there is no copyright protection against all associated designs (i.e. every possible design consisting of that design but with modifications or variations not sufficient to alter the character or substantially to affect the identity thereof), and the copyright exception covers all the articles and non-physical products to which the design and every associated design was capable of being applied.

Example in relation to Exception 3

Peter draws the design for a necklace on a piece of paper.

The design drawing of the necklace is an “artistic work” for copyright purposes.

If the necklace design when applied to an article results in a reproduction of the artistic work, the design is a “corresponding design” to the artistic work.

Peter applies for the registration of the necklace design for articles under the Registered Designs Act.

⁴ With effect from 30 October 2017, the exclusive rights of a registered design owner are the ability to prevent third parties from carrying out the following acts without permission:

- (a) to make in Singapore, or import into Singapore, for sale or hire, or for use for the purpose of trade or business – (i) any article in respect of which the design is registered and to which that design, or a design not substantially different from that design, has been applied; or (ii) any device for projecting a non-physical product (being a non-physical product in respect of which the design is registered and to which that design, or a design not substantially different from that design, has been applied);
- (b) to sell, hire or expose for sale or hire, in Singapore – (i) any article or non-physical product in respect of which the design is registered and to which that design, or a design not substantially different from that design, has been applied; or (ii) any device for projecting a non-physical product mentioned in (i).

The exclusive rights of a registered design owner are subject to the exceptions in Sections 30 and 31 of the Registered Designs Act.

⁵ For artistic works other than photographs, copyright subsists until the expiration of 70 years after the expiration of the calendar year in which the creator of the work died. In the case of engravings that were not published before the death of the author of the engraving, copyright in the engraving continues to subsist until the expiration of 70 years after the expiration of the calendar year in which the engraving is first published. In the case of photographs, the copyright subsisting in a photograph shall continue to subsist until the expiration of 70 years after the expiration of the calendar year in which the photograph is first published. Please note that the creator of an artistic work is referred to as the “author” in the Copyright Act.

Upon registration under the Registered Designs Act:

- (a) there is no copyright protection for the design of the necklace; and
- (b) protection of the design of the necklace is from the rights under the Registered Designs Act.

How protection may be obtained under the Registered Designs Act for designs

8. The features of shape, configuration, colours, pattern or ornament that are applied to any article⁶ or non-physical product⁷ that give that article or non-physical product its appearance, may be protected as a “design” under the Registered Designs Act, subject to a few statutory exclusions.⁸
9. Design protection is only available under the Registered Designs Act where the design sought to be registered is **new**. This means that the design must not have been:
 - (a) registered in respect of the same or any other article, non-physical product or set of articles and non-physical products in pursuance of a prior application; or
 - (b) published in Singapore or elsewhere in respect of the same or any other article, non-physical product or set of articles and non-physical products before the date the design application was made.

⁶ “article” means any thing that is manufactured (whether by an industrial process, by hand or otherwise), and includes – (a) any part of an article, if that part is made and sold separately; and (b) any set of articles.

⁷ “non-physical product” (a) means any thing that – (i) does not have a physical form; (ii) is produced by the projection of a design on a surface or into a medium (including air); and (iii) has an intrinsic utilitarian function that is not merely to portray the appearance of the thing or to convey information; *and* (b) includes any set of non-physical products.

⁸ These statutory exclusions are:

- (a) a method or principle of construction;
- (b) features of shape, configuration or colours of an article or non-physical product that –
 - (i) are dictated solely by the function that the article or non-physical product has to perform (this is known as the functional exclusion);
 - (ii) are dependent upon the appearance of another article or non-physical product or which the article or non-physical product is intended by the designer to form an integral part (this is known as the “must-match” exclusion); or
 - (iii) enable the article or non-physical product to be connected to, or placed in, around or against, another article or non-physical product, so that either article or non-physical product may perform its function (this is known as the “must fit” exclusion); or
- (c) features consisting only of one or more colours that – (i) are not used with any feature of shape of configuration; and (ii) do not give rise to any feature of pattern or ornament.

Registration of corresponding designs of artistic works under the Registered Designs Act

10. Where a design application is filed by, or with the consent of the copyright owner of the artistic work for the registration of a corresponding design,⁹ any use previously made of the artistic work (the “previous use”) does not cause the design to be treated as being other than new.
11. However, paragraph 10 does not apply if (a), (b) and (c) below all apply:
- (a) the previous use consisted of or included the sale, letting for hire, or offer or exposure for sale or hire, of:
 - (i) articles or non-physical products to which had been applied the design in question or an immaterial variant¹⁰; or
 - (ii) devices for projecting any non-physical products mentioned in (i);
 - (b) the design in question or an immaterial variant had been applied industrially in relation to those articles, non-physical products, or devices; *and*
 - (c) the previous use was made by or with the consent of the copyright owner.
12. A design is regarded as having been applied industrially as described below:

<p>On or after 30 October 2017 but before 30 October 2018</p> <p>(the 12 month phase in period)</p>	<p>A design is regarded as applied industrially in relation to <u>articles</u> if the design is applied –</p> <ul style="list-style-type: none"> (a) to one or more articles that are manufactured in lengths which are not handmade articles (such as non-handmade wallpaper); <i>or</i> (b) to more than 50 articles. <p>Note: For this timeframe, there is no rule on applied industrially in relation to <u>non-physical products or devices for projecting non-physical products</u>, or in relation to <u>articles that are manufactured in pieces (that are not handmade articles)</u>, so as to provide for a <u>12 month phase in period</u>.</p>
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⁹ A “corresponding design”, in relation to an artistic work, means a design which, when applied to an article or a non-physical product, results in a reproduction of that work.

¹⁰ An immaterial variant differs from the design in question only in immaterial details or in features that are variants commonly used in the trade.

<p>On or after 30 October 2018</p>	<p>A design is regarded as having been applied industrially in relation to <u>articles</u> if the design is applied –</p> <ul style="list-style-type: none"> (a) to one or more articles that are manufactured in lengths or in pieces which are not handmade articles (such as non-handmade wallpaper, non-handmade wall tiles); (b) to more than 50 articles; <i>or</i> (c) to both articles and non-physical products (totalling more than 50). <p>A design is regarded as having been applied industrially in relation to <u>non-physical products or devices for projecting non-physical products</u> if the design is applied -</p> <ul style="list-style-type: none"> (a) to more than 50 non-physical products; <i>or</i> (b) to both articles and non-physical products (totalling more than 50).
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During the 12 month phase in period, as well as on or after 30 October 2018, the date on which the design is applied to an article or non-physical product is irrelevant.

13. As seen from the table at paragraph 12, there is a 12 month phase in period. This is primarily intended to facilitate applications for design registration to be made in respect of non-physical products as well as articles, where the design has been applied (a) to only non-physical products, or (b) to both articles as well as non-physical products (but where the number of articles is less than 50 articles).

Example concerning the registration of corresponding designs of artistic works under the Registered Designs Act

John draws a novel design for a computer keyboard on a piece of paper.

The design drawing of the computer keyboard is an “artistic work” for copyright purposes.

For the situations discussed below in this Example, we will assume that John is the copyright owner of this “artistic work”.

Situation 1 – More than 50 articles

John made 51 computer keyboards (that are physical objects i.e. articles) with the design, and offers or exposes for sale these computer keyboards, before

submitting his design application under the Registered Designs Act (“RDA”) in relation to articles.

- In this situation, the design of the computer keyboard would no longer be regarded as new under the RDA (because the design is regarded as applied industrially), and so John would not be able to obtain valid design rights under the RDA.

Situation 2 – More than 50 non-physical products

John developed 51 virtual keyboards (which are non-physical products) with the design. These 51 virtual keyboards are projected from 51 devices (each device, when activated, can project 1 virtual keyboard onto a surface). John offers or exposes for sale the devices for projecting these virtual keyboards, before applying for design registration under the RDA in relation to non-physical products.

- In this Situation 2, **so long as the design application is filed on or after 30 October 2017 and before 30 October 2018**, the design will be regarded as new, and John can obtain valid design rights under the RDA.
- In this Situation 2, **if the design application is filed on or after 30 October 2018**, the design will not be regarded as new (because the design is regarded as applied industrially), and so John would not be able to obtain valid design rights under the RDA.

Situation 3 – Both articles and non-physical products totalling more than 50

John made 40 computer keyboards (that are physical objects i.e. articles) as well as developed 11 virtual keyboards (which are non-physical products) with the design. In this situation, the total number of articles and non-physical products is 51 (i.e. the total number exceeds 50). The 11 virtual keyboards are projected from 11 devices (each device, when activated, projects 1 virtual keyboard onto a surface). John offers or exposes for sale the computer keyboards (that are articles) as well as the devices for projecting the 11 virtual keyboards, before applying for design registration under the RDA in relation to articles and non-physical products.

- In this Situation 3, **so long as the design application is filed on or after 30 October 2017 and before 30 October 2018**, the design will be regarded as new, and John can obtain valid design rights under the RDA.
- In this Situation 3, if the design application is filed **on or after 30 October 2018**, the design will not be regarded as new (because the design is regarded as applied industrially), and so John would not be able to obtain valid design rights under the RDA.

Special provision for the registration of non-physical products under the Registered Designs Act notwithstanding disclosure of the design prior to the date of the filing the design application.

14. In addition to providing for a 12 month phase in period as described at paragraphs 12 and 13 above, to assist in the registration of non-physical products under the Registered Designs Act, a special provision has also been provided in the new Section 8B of the Registered Designs Act. So long as the application for the registration of the design of the non-physical product is filed during the period of 12 months immediately after 30 October 2017, disclosure of the design before the date of filing of the application shall not cause the design application to be refused, or the registration pursuant to the application to be revoked. For information on how to apply for the registration of the design of a non-physical product, please refer to the “Information Note on Virtual Designs and Non-Physical Products” which is available from IPOS.

Conclusion

15. In summary, if intellectual property protection is desired for the appearance of mass produced products, protection should be sought under the Registered Designs Act, and not under copyright. Copyright protection is lost once the product is regarded as having been mass produced.
16. Copyright protection is also not available to designs that have been registered under the Registered Designs Act, since designs protection is already available under that Act to registered designs.
17. It is possible to apply for design registration of the designs of articles and non-physical products under the Registered Designs Act, before the design is regarded as “applied industrially” (i.e. mass produced).
18. A 12 month phase in period has been provided (from 30 October 2017) for when a design is regarded as applied industrially, so as to facilitate applications for design registration to be made in respect of non-physical products as well as articles, where the design has been applied (a) to only non-physical products, or (b) to both articles as well as non-physical products (but where the number of articles is less than 50 articles).
19. In addition, a special provision has been provided in the new Section 8B of the Registered Designs Act to assist in the registration of non-physical products.

Annex

Relevant legal provisions on the interface between copyright and designs

General note

- The legal provisions on the interface between the registered designs regime and the copyright regime can be found in the Registered Designs Act, the Copyright Act, the Registered Designs Rules and the Copyright Regulations. The legislation can be viewed at Singapore Statutes Online at www.statutes.agc.gov.sg.
- The following pieces of legislation, which amend the existing Singapore Copyright and Registered Designs legislation in (a) above, come into operation on 30 October 2017: The Registered Designs (Amendment) Act 2017 (“RDAA 2017”), the Registered Designs (Amendment No. 2) Rules 2017, and the Copyright (Amendment) Regulations 2017.

The copyright exception for the making of useful articles and non-physical products

- Section 70 of the Copyright Act (as amended by Section 28(2) of the RDAA 2017).
- Section 29(8) of the RDAA 2017.

The copyright exception for where the design has been applied industrially but the design has not been registered under the Registered Designs Act

- Section 74(2) to Sections 74(7) Copyright Act (as amended by Section 28(4)(c) to (i) of the RDAA 2017), read with Section 73 of the Copyright Act (as amended by Section 28(3) of the RDAA 2017).
- Section 29(9) of the RDAA 2017.
- Regulation 12 of the Copyright Regulations (as amended by Regulation 2 of the Copyright (Amendment) Regulations 2017).
- Regulation 3 of the Copyright (Amendment) Regulations 2017.

The copyright exception for where the design is registered under the Registered Designs Act

- Section 74(1) Copyright Act (as amended by Sections 28(4)(a) and 28(4)(b) of the RDAA 2017), read with Section 73 Copyright Act (as amended by Section 28(3) of the RDAA 2017).
- Section 29(10) of the RDAA 2017.

Definition of “design” in the Registered Designs Act

- Section 2(1) of the Registered Designs Act (as amended by Section 2(c) of the RDAA 2017).
- Section 29(1) of the RDAA 2017.

New designs may be registered under the Registered Designs Act

- Section 5 of the Registered Designs Act (as amended by Section 4 of the RDAA 2017).
- Section 29(4) of the RDAA 2017.

Registration of corresponding designs of artistic works under the Registered Designs Act

- Section 9(1) of the Registered Designs Act.
- Section 9(2) of the Registered Designs Act (as amended by Section 8 of the RDAA 2017).
- Section 29(4) of the RDAA 2017.
- Rule 12 of the Registered Designs Rules (as amended by Rule 3 of the Registered Designs (Amendment No. 2) Rules 2017).
- Rule 18(2) of the Registered Designs (Amendment No. 2) Rules 2017.

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