

## **Annex B - Proposed amendments to the Registered Designs Act (Cap 266)**

Note:

- (i) This annex does not contain all the provisions of the Registered Designs Act. For the full text of the existing Registered Designs Act, please refer to the IPOS legislation webpage at <https://www.ipos.gov.sg/AboutIP/IPLegislation.aspx>.
- (ii) The tracked changes indicate the proposed changes to be made to existing legislation. Please note that the wording of the proposed amendments is subject to change after legislation drafting by the Attorney General's Chambers.
- (iii) The proposed amendments are intended to come into operation on such date as the Minister may, by notification in the Gazette, appoint.

### **Section 2 of the Registered Designs Act**

#### **Interpretation**

2.—(1) In this Act, unless the context otherwise requires —

“application for registration”, in relation to a design, means an application under section 11 for the registration of the design;

~~“article” means 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;~~

“article” means any thing that is manufactured or handmade (regardless whether the thing is unique or made or produced on any scale), and includes –

(a) any part of an article, if that part is made and sold separately; and

(b) any set of articles;

“artistic work” has the meaning assigned to it in section 7(1) of the Copyright Act (Cap. 63);

“Convention country” means a country or territory, other than Singapore, which is a party to the Paris Convention or a member of the World Trade Organisation;

“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;

“Court” means the High Court;

~~“design” means features of shape, configuration, pattern or ornament applied to an article by any industrial process, but does not include—~~

~~(a) a method or principle of construction; or~~

~~(b) features of shape or configuration of an article which—~~

~~(i) are dictated solely by the function which the article has to perform;~~

~~(ii) are dependent upon the appearance of another article of which the article is intended by the designer to form an integral part; or~~

~~(iii) enable the article to be connected to, or placed in, around or against, another article so that either article may perform its function;~~

“design” means features of shape, configuration, colours, pattern or ornament applied to any article or non-physical product that give that article or non-physical product its appearance, but does not include –

(a) a method or principle of construction;

(b) features which –

(i) are dictated solely by the function which the article or non-physical product has to perform;

(ii) are dependent upon the appearance of another article or non-physical product of which the article or non-physical product is intended by the designer to form an integral part; 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;

(c) features which consist only of one colour; or

(d) features which consist only of colours, except where they give rise to a pattern or ornament;

“designer”, in relation to a design, means the person who creates it or, if there are 2 or more such persons, each of those persons;

“exclusive licence” means a licence from the registered owner of a registered design authorising the licensee, or the licensee and persons authorised by him, to the exclusion of all other persons (including the registered owner), to use the design in the manner authorised by the licence and “exclusive licensee” shall be construed accordingly;

“International Bureau” means the International Bureau of the World Intellectual Property Organisation;

“non-physical product” means any thing that –

(a) does not have a physical form;

(b) is produced by the projection of a design on a surface or into a medium, including air; and

(c) performs any utilitarian function

and includes any set of non-physical products;

“Office” means the Intellectual Property Office of Singapore incorporated under the Intellectual Property Office of Singapore Act (Cap. 140);

“owner” has the meaning assigned to it in section 4;

“Paris Convention” means the Convention for the Protection of Industrial Property signed at Paris on 20th March 1883, as revised or amended from time to time;

“Register” means the Register of Designs maintained under section 53;

“registered design” means a design registered under this Act;

“registered owner”, in relation to a registered design, means the person whose name is for the time being entered in the Register as the owner of the design or, if there are 2 or more such persons, each of those persons;

“Registrar” means the Registrar of Designs referred to in section 49 and includes any Deputy Registrar of Designs referred to in that section;

“Registry” means the Registry of Designs established under section 51;

“set of articles” means 2 or more articles of the same general character that are ordinarily on sale together or intended to be used together, and to each of which the same design, or the same design with modifications or variations not sufficient to alter the character or substantially to affect the identity of the design, is applied.

“set of non-physical products” means 2 or more non-physical products of the same general character that are ordinarily on sale together or intended to be used together, and to each of which the same design, or the same design with modifications or variations not sufficient to alter the character or substantially to affect the identity of the design, is applied.

“set of articles and non-physical products” means 2 or more articles and non-physical products of the same general character that are ordinarily on sale together or intended to be used together, and to each of which the same design, or the same design with modifications or

variations not sufficient to alter the character or substantially to affect the identity of the design, is applied.

(2) Unless the context otherwise requires —

(a) any reference in this Act to the filing of a document shall be construed as a reference to the filing of the document with the Registrar;

(b) any reference in this Act to an article in respect of which a design is registered shall, in the case of a design registered in respect of a set of articles or a set of articles and non-physical products, be construed as a reference to any article of that set; ~~and~~

(ba) any reference in this Act to a non-physical product in respect of which a design is registered shall, in the case of a design registered in respect of a set of non-physical products or a set of articles and non-physical products, be construed as a reference to any non-physical products of that set; and

(c) any reference to the infringement of a registered design shall be construed as a reference to the infringement of any right in the design conferred by this Act.

#### **Section 4 of the Registered Designs Act**

##### **Owner of design**

4.—(1) Subject to this section, the designer of a design shall be treated for the purposes of this Act as the owner of the design.

(2) ~~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.~~

(3) ~~Where, in a case not falling within subsection (2),~~ a design is created by an employee in the course of his employment, his employer shall be treated as the owner of the design.

(4) ~~Subsections (2) and (3) are~~ Subsection (3) is subject to any agreement to the contrary between the parties concerned.

(5) Where a design, or the right to apply a design to any article or non-physical product, becomes vested, whether by assignment, transmission or operation of law, in any person other than the owner, either alone or jointly with the owner, that other person or, as the case may be, the owner and that other person, shall be treated for the purposes of this Act as the owner of the design or as the owner of the design in relation to that article or non-physical product.

(6) In the case of a design generated by computer in circumstances such that there is no human designer, the person by whom the arrangements necessary for the creation of the design are made shall be deemed to be the designer.

**Note:**

The proposed approach on the issue of savings and transitional provisions for the proposed amendments relating to Section 4(1), 4(2) and 4(3) RDA is as follows (the intention is for the text in square brackets below to be replaced with a reference to the corresponding amendment provision in the Bill).

X. — (\*) [The amendments to Section 4(2) RDA], [the amendments to Section 4(3) RDA] and [the amendments to Section 4(4) RDA] does not apply to a design which is created in pursuance of a commission for money or money's worth, and in relation to which either of the following applies:

- (a) the design was created before the date of commencement of [the amendments to Section 4(2) RDA], [the amendments to Section 4(3) RDA] and [the amendments to Section 4(4) RDA];
- (b) before the date of commencement of [the amendments to Section 4(2) RDA], [the amendments to Section 4(3) RDA] and [the amendments to Section 4(4) RDA], the designer of the design and the person commissioning the design entered into a contract relating to that commission.

(\*\*) Instead, the provisions of the principal Act as in force immediately before the date of commencement of [the amendments to Section 4(2) RDA], [the amendments to Section 4(3) RDA] and [the amendments to Section 4(4) RDA] continue to apply to every design mentioned in subsection (3) as if [the amendments to Section 4(2) RDA], [the amendments to Section 4(3) RDA] and [the amendments to Section 4(4) RDA] had not been enacted.

As for the proposed amendments to Section 4(5) RDA, the proposed approach on the issue of savings and transitional provisions is described at the end of this **Annex B**.

**Section 5 of the Registered Designs Act**

**New design may be registered**

5.—(1) Subject to the provisions of this Part, a design which is new may, upon application by the person claiming to be the owner, be registered in respect of an article, or a non-physical product, specified in the application.

(2) A design for which an application for registration is made shall not be regarded as new if it is the same as a design —

- (a) registered in respect of the same or any other article or non-physical product in pursuance of a prior application; or
- (b) published in Singapore or elsewhere in respect of the same or any other article or non-physical product before the date of the first-mentioned application,

or if it differs from such a design only in immaterial details or in features which are variants commonly used in the trade.

(3) The Registrar may, in such cases as may be prescribed, direct that, for the purpose of deciding whether a design is new, an application for registration of the design shall be treated as filed on a date earlier or later than that on which it was in fact filed.

**Please refer to Annex E for proposed amendments to Section 7 of the RDA.**

### **Section 8 of the Registered Designs Act**

#### **Provisions as to confidential disclosure, etc.**

~~8.—(1) An application for registration of a design shall not be refused, and the registration of a design shall not be revoked, by reason only of—~~

- ~~(a) the disclosure of the design by the owner to any other person in such circumstances as would make it contrary to good faith for that other person to use or publish the design;~~
- ~~(b) the disclosure of the design in breach of good faith by any person other than the owner of the design;~~
- ~~(c) in the case of a new or original textile design intended for registration, the acceptance of a first and confidential order for goods bearing the design; or~~
- ~~(d) the communication of the design by the owner to a Government department or the Office or to any person authorised by a Government department or the Office to consider the merits of the design, or of anything done in consequence of such a communication.~~

~~(2)—An application for registration of a design shall not be refused, and the registration of a design shall not be revoked, by reason only—~~

- ~~(a) that a representation of the design, or any article to which the design has been applied, has been displayed, with the consent of the owner of the design, at an official international exhibition;~~
- ~~(b) that after any such display as is mentioned in paragraph (a), and during the period of the exhibition, a representation of the design, or any article to which the design has been applied, has been displayed by any person without the consent of the owner; or~~
- ~~(c) that a representation of the design has been published in consequence of any such display as is mentioned in paragraph (a);~~

if the application for registration of the design is made no later than 6 months after the opening of the exhibition.

~~(3) In this section, “official international exhibition” means an 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 that Convention, as revised or amended from time to time.~~

### **Disclosure of design**

**8.** An application for registration of a design is not to be refused, and the registration of a design is not to be revoked, by reason only of any of the following:

- (a) a disclosure of the design made to a person other than the designer, or any successor in title of the designer, under conditions of confidentiality (whether express or implied);
- (b) a disclosure of the design made by the designer, or any successor in title of the designer, during the period of 12 months immediately before the date of filing of the application for registration of the design;
- (c) a disclosure made by a person other than the designer, or any successor in title of the designer, during the period of 12 months immediately before the date of filing of the application for registration of the design, in consequence of information provided, or any other action taken, by the designer or any successor in title of the designer;
- (d) a disclosure made during the period of 12 months immediately before the date of filing of the application for registration of the design, as a consequence of bad faith in relation to the designer or any successor in title of the designer.

**Please refer to Annex E for the proposed amendments to Section 9 of the RDA**

### **Section 10 of the Registered Designs Act**

**Subsequent registration of design in respect of other articles or non-physical products, etc.**

**10.—(1)** Where the registered owner of a design registered in respect of an article or a non-physical product files —

- (a) an application for registration of the registered design in respect of one or more other articles or non-physical products; or

- (b) an application for registration of a design consisting of the registered design with modifications or variations not sufficient to alter the character or substantially to affect the identity of the registered design, in respect of the same or one or more other articles or non-physical products,

the application shall not be refused, and the registration made on the application shall not be revoked, by reason only of the previous registration or publication of the registered design.

(2) The right in a design registered by virtue of subsection (1) shall not extend beyond the end of the period, and any extended period, for which the right subsists in the original design.

(3) Where a person files an application for registration of a design in respect of an article or a non-physical product and either —

- (a) the design has been previously registered by another person in respect of some other article or non-physical product; or
- (b) the design to which the application relates is a design previously registered by another person in respect of the same or some other article or non-physical product with modifications or variations not sufficient to alter the character or substantially to affect the identity of the registered design,

then, if at any time while the application is pending, the applicant becomes the registered owner of the design previously registered, subsection (1) shall apply as if, at the time of filing the application, the applicant had been the registered owner of that design.

## **Section 11 of the Registered Designs Act**

### **Application for registration**

**11.**—(1) An application for registration of a design shall be filed in the prescribed manner with the Registrar, and is subject to the payment of the prescribed application fee.

(2) The application shall —

- (a) contain a request for the registration of a design;
- (b) state the name and address of the applicant; and
- (c) contain a clear representation of the design.

(3) Except where section 16A(3) applies, the date on which the application is filed shall be the earliest date on which —

- (a) the fee payable under subsection (1) has been paid or is treated by the Registrar as paid; and
- (b) all the requirements under subsection (2) have been satisfied

(4) Nothing in this Act prevents an applicant from applying for the registration of 2 or more designs in one application in accordance with prescribed requirements, including the requirement that every article or non-physical product to which each of those designs is to be applied falls within the same class, or alternatively, falls within all of the same classes, under the classification mentioned in section 75(1)(c).

(5) Where an application filed under subsection (1) contains 2 or more designs, the Registrar shall treat each design in the application as if a separate application is being made under this Act.

## **Section 12 of the Registered Designs Act**

### **Claim to priority of Convention application**

**12.—**(1) Subject to subsection (7), where —

- (a) a person has filed an application for the registration of a design in a Convention country in respect of certain articles or non-physical products;
- (b) that application is the first application for the registration of the design to be filed in any Convention country in respect of those articles or non-physical products (referred to in this section as the first Convention application); and
- (c) within 6 months after the date on which the first Convention application is filed, that person or his successor in title applies under this Act for the registration of the design in respect of all or any of those articles or non-physical products,

that person or his successor in title may, when filing the application under this Act, claim a right of priority for the registration of the design in respect of all or any of the articles or non-physical products for which registration was sought in the first Convention application.

(2) Where any person claims a right of priority in accordance with subsection (1) in respect of an application for the registration of a design —

- (a) the person shall have priority from (and including) the date on which the first Convention application was filed; and
- (b) the application shall be treated, for the purposes of determining whether that or any other design is new, as filed on the date on which the first Convention application was filed.

(3) Subsection (2) shall not be construed as excluding the power to give directions under section 5(3) in relation to the application for the registration of a design.

(4) Notwithstanding any of the provisions of this Act, where a right of priority is claimed in respect of an application for the registration of a design, the application shall not be refused,

and the registration of the design under this Act shall not be revoked, by reason only of the fact that the first Convention application has been published during the period between —

- (c) the date the first Convention application was filed; and
- (d) the date the application under this Act was filed.

(5) Any filing of an application for the registration of a design which in a Convention country is equivalent to a regular national filing, under its domestic legislation or an international agreement, shall be treated as giving rise to the right of priority.

(6) In subsection (5), “regular national filing” means a filing which is adequate to establish the date on which the application was filed in the Convention country, whatever may be the outcome of the application.

(7) Where a subsequent application for registration of a design concerning the same subject as an earlier application is filed, whether in the same or a different Convention country, and these are the first 2 applications concerning that subject to be filed in any Convention country, the subsequent application shall be considered the first Convention application if, at the date the subsequent application is filed —

- (a) the earlier application has been withdrawn, abandoned or refused, without having been laid open to public inspection and without leaving any rights outstanding; and
- (b) the earlier application has not yet served as a basis for claiming a right of priority.

(8) For the avoidance of doubt, where subsection (7) applies —

- (a) the date on which the subsequent application was filed, rather than that of the earlier application, shall be considered the starting date of the period of priority under subsection (2); and
- (b) the earlier application may not thereafter serve as a basis for claiming a right of priority.

(9) The Minister may make rules as to the manner of claiming priority under this section.

(10) A right to priority arising under this section may be assigned or otherwise transmitted, either with the application or independently, and the reference in subsection (1) to the applicant’s “successor in title” shall be construed accordingly.

### **Section 13 of the Registered Designs Act**

#### **Claim to priority of other overseas applications**

**13.—**(1) The Minister may by order confer on a person who has filed an application for registration of a design in a country or territory to which the Government has entered into a

treaty, convention, arrangement or engagement for the reciprocal protection of registered designs, a right to priority, for the purpose of registering the same design under this Act for some or all of the same articles or non-physical products, for a specified period from the date of filing of that application.

(2) An order under this section may make provision corresponding to that set out in section 12 or such other provision as appears to the Minister to be appropriate.

### **Section 15 of the Registered Designs Act**

Amendment of application

15.—(1) The Registrar may, on his own initiative or upon request made to him in the prescribed manner by the applicant and payment of the prescribed fee, amend an application for registration of a design.

(2) An application for registration of a design shall not be amended if, as a result of the amendment, the scope of the application would be increased by the inclusion of matter that was not in substance disclosed in the application as filed.

(2A) The class or classes of articles or non-physical products in an application for registration of a design shall not be amended —

(a) if the application was derived from an application filed under section 11(1) containing 2 or more designs (referred to in this subsection as the earlier application), and

(b) if, as a result of the amendment, the requirement mentioned in section 11(4) would not be complied with, namely, that every article or non-physical product to which each of those designs in the earlier application is to be applied, falls within the same class, or alternatively, falls within all of the same classes, under the classification mentioned in section 75(1)(c).

(3) The Registrar shall not be obliged to correct on his own initiative any error not due to the default of the Registrar.

(4) Where the Registrar proposes to make any amendment on his own initiative, he shall give notice of the proposal to every person who appears to him to be likely to be affected by the amendment, and shall give the person an opportunity to be heard before making the amendment.

### **Section 16 of the Registered Designs Act**

Examination of application

16.—(1) The Registrar shall examine an application for registration of a design, being an application which has not been withdrawn, to determine whether it satisfies the formal requirements.

(2) If the Registrar determines that an application fails to comply with the formal requirements, he shall notify the applicant and give him an opportunity to correct the non-compliance within such period as the Registrar determines.

(3) If the non-compliance is not corrected within the period referred to in subsection (2), the application shall be treated as withdrawn, but the Registrar may, upon —

- (a) the filing by the applicant of a notice in the prescribed form requesting reinstatement of the application;
- (b) the payment of the prescribed fee; and
- (c) the compliance by the applicant with such conditions as the Registrar may impose,

reinstate the application.

(4) Upon reinstatement of an application, any right or means of redress lost by the applicant as a result of the withdrawal shall be restored to him.

(5) In this section and sections 17 and 18, "formal requirements" means those requirements of section 11, and of rules made for the purposes of that section, that are prescribed as formal requirements.

Note:

The existing Section 16 RDA has been included within this Annex B for ease of reference only. No amendments are proposed to Section 16 RDA in this public consultation document.

Note that under Section 16(1) RDA, the Registrar will examine an application for a design, to determine whether it satisfies the formal requirements. The legal provisions that comprise the formal requirements can be found in Section 16(5) RDA and Rule 27(1) of the Registered Designs Rules. These legal provisions are the following: Section 11 RDA, and Rules 10, 11, 13, 14, 15, 17, 18 and 19 of the Registered Designs Rules.

Under Section 16(2) RDA, if the Registrar determines that an application fails to comply with the formal requirements, the Registrar shall notify the applicant and give the applicant an opportunity to correct the non-compliance. Thereafter, Rule 27 of the Registered Designs Rules applies.

Please refer to **Annex C** for the proposed amendments to Rule 27 of the Registered Designs Rules.

## **New proposed Section 16A of the Registered Designs Act**

### **New application with date of filing of earlier application**

16A.—(1) Where non-compliance with the formal requirements relates to either or both of the following, the Registrar may, when he issues a written notice under section 16(2), invite the applicant to file one or more new applications under section 11 —

(a) non-compliance with the requirement mentioned in section 11(4), where the application was derived from an application filed under section 11(1) containing 2 or more designs;

(b) non-compliance with the requirement that the application contain a clear representation of the design in section 11(2)(c).

(2) New applications shall not be filed pursuant to subsection (1) where —

(a) a notice of withdrawal has been filed under section 14;

(b) the application has been treated as withdrawn under section 16(3); or

(c) the application has been refused under section 17.

(3) Each new application filed pursuant to subsection (1) shall be treated as having, as its date of filing, the date of filing of the earlier application, if the following are satisfied —

(a) the new application complies with the requirements of section 11;

(b) the applicant of the new application is the same as the applicant or successor in title of the earlier application; and

(c) the new application does not include matter that was not in substance disclosed in the earlier application.

(4) In subsection (3), “earlier application” means the application to which the written notice under section 16(2) pertains to.

Note:

The proposed Section 16A RDA should be read together with Section 16 RDA.

## **Section 26 of the Registered Designs Act**

### **Surrender of registration**

**26.—(1)** The registration of a design may be surrendered by the registered owner in respect of all or any of the articles or non-physical products for which the design is registered.

- (2) The Minister may make rules —
- (a) as to the manner and effect of a surrender; and
  - (b) for protecting the interest of other persons having a right in the design.

### **Section 30 of the Registered Designs Act**

#### **Rights conferred by registration**

**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 or non-physical product 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 —

- (a) does anything which by virtue of subsection (1) is the exclusive right of the registered owner;
- (b) makes anything for enabling any article referred to in subsection (1) to be made in Singapore or elsewhere;
- (c) does anything in relation to a kit that would constitute an infringement of the design if it had been done in relation to the assembled article; or
- (d) makes anything for enabling a kit to be made or assembled, in Singapore or elsewhere, if the assembled article would be an article referred to in subsection (1).

(2A) For the purposes of subsection (1) and subsection (2)(a):

- (a) the making in Singapore or importation into Singapore, for sale or hire or for use for the purpose of trade or business, of equipment for projecting a non-physical product, shall be deemed the making in Singapore or importation into Singapore, for sale or hire or for use for the purpose of trade or business, of the non-physical product.
- (b) the sale, hire, or offer or exposure for sale or hire in Singapore, of equipment for projecting a non-physical product, shall be deemed the sale, hire, or offer or exposure for sale or hire in Singapore, of the non-physical product.

(3) In subsection (2), “kit” means a complete or substantially complete set of components intended to be assembled into an article.

(4) In the application of subsection (2) to a registered design of which there is more than one registered owner, the reference to the registered owner shall be construed —

- (a) in relation to any act, as a reference to the registered owner or those registered owners who is or are entitled to do that act by virtue of section 33 or any agreement; and
- (b) in relation to any consent, as a reference to the registered owner or those registered owners who is or are the proper person or persons to give the consent by virtue of section 33 or any agreement.

(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.

(6) The right in a registered design is not infringed by the reproduction of a feature of the design which, by virtue of paragraph (b) of the definition of “design” in section 2(1), is left out of account in determining whether the design is registrable.

(7) The right in a registered design is not infringed by the import, sale, hire, or offer or exposure for sale or hire of any article or non-physical product to which the design has been applied, and which has been placed on the market, whether in Singapore or elsewhere, by or with the consent (conditional or otherwise) of the registered owner.

### **Section 31 of the Registered Designs Act**

#### **Rights of third parties to continue use of registered designs**

**31.**—(1) A person who, before the date of registration of a design —

- (a) does in good faith in Singapore an act which would have constituted an infringement of the design if the registration had been in force at the time the act is done; or
- (b) makes in good faith effective and serious preparations to do such an act in Singapore,

has the right to continue to do the act or, as the case may be, to do the act.

(2) If the act was done, or the preparations were made, in the course of a business, the person entitled to the right conferred by subsection (1) may —

- (a) authorise the doing of that act by any of his partners for the time being in that business; and
- (b) assign that right, or transmit it on death (or in the case of a body corporate on its dissolution), to any person who acquires that part of the business in the course of which the act was done or the preparations were made.

(3) The right conferred by subsection (2) shall not include a right to grant a licence to any person to do an act referred to in subsection (1).

~~(4) — Where an article is disposed of to another person in exercise of a right conferred by subsection (1), that other person and any person claiming through him may deal with the article in the same way as if it had been disposed of by the owner of the design concerned.~~

(4) Where an article, or any equipment for projecting a non-physical product, is disposed of to another person in exercise of a right conferred by subsection (1), that other person, and any person claiming through that other person, may deal with the article or use the equipment to make the non-physical product in the same way as if it had been disposed of by the owner of the design concerned.

### **Section 39 of the Registered Designs Act**

#### **General restriction on recovery of damages or profits**

39.—(1) In infringement proceedings, the Court shall not award damages, nor make an order for an account of profits, against a defendant who proves that at the date of the infringement he was not aware, and had no reasonable grounds for believing, that the design in question was registered.

(2) For the purposes of subsection (1), a person shall not be taken to have been aware, or to have had reasonable grounds for believing, that the design was registered by reason only of the application to an article or a non-physical product, or to any printed matter accompanying an article or a non-physical product, of the word “registered”, or any word or words or abbreviation expressing or implying that the design has been registered, unless the registration number of the design accompanied the word or words or abbreviation.

### **Section 40 of the Registered Designs Act**

#### Order for delivery up

40.—(1) Where the defendant to proceedings for infringement of a registered design has in his possession —

- (a) any infringing article in relation to that design; or
- (aa) equipment for projecting any infringing non-physical product in relation to that design;
- (b) anything predominantly used for the making of infringing articles, which the defendant knows or has reason to believe has been or is to be used to make infringing articles; or

(bb) anything predominantly used for the making of equipment for projecting infringing non-physical products, which the defendant knows or has reason to believe has been or is used to project infringing non-physical products;

the Court may, in addition to any relief granted under section 36, order the article, equipment or thing to be delivered to the plaintiff.

(2) No order shall be made under this section unless the Court also makes, or it appears to the Court that there are grounds for making, an order under section 41.

(3) A person to whom any article, equipment or thing is delivered up in pursuance of an order made under this section shall, if an order under section 41 is not made, retain them pending the making of an order, or the decision not to make an order, under that section.

(4) In this section and section 41, an article is an “infringing article” in relation to a registered design if the design or a design not substantially different from it has been applied to the article and —

- (a) the application of the design to the article was an infringement of the design;
- (b) the article is imported into Singapore in such a way as to infringe the design; or
- (c) the article is sold, let for hire, or offered or exposed for sale or hire in Singapore in such a way as to infringe the design.

(5) In this section and section 41, a non-physical product is an “infringing non-physical product” in relation to a registered design if the design or a design not substantially different from it has been applied to the non-physical product and —

- (a) the application of the design to the non-physical product was an infringement of the design;
- (b) equipment for projecting the non-physical product is imported into Singapore in such a way as to infringe the design; or
- (c) equipment for projecting the non-physical product is sold, let for hire, or offered or exposed for sale or hire in Singapore in such a way as to infringe the design.

## **Section 41 of the Registered Designs Act**

Order for disposal

41.—(1) Where any infringing article, equipment or thing has been delivered up in pursuance of an order made under section 40, an application may be made to the Court —

- (a) for an order that it be destroyed or forfeited to such person as the Court thinks fit; or
- (b) for a decision that no such order should be made.

(2) In deciding what order, if any, should be made, the Court shall have regard to —

- (a) whether other remedies available in proceedings for infringement would be adequate to compensate the plaintiff and protect his interest; and
- (b) the need to ensure that no infringing article, equipment or thing is disposed of in a manner that would adversely affect the plaintiff.

(3) The Court shall issue directions as to service of notice on persons having an interest in the article, equipment or thing.

(4) Any person having an interest in the article, equipment or thing is entitled—  
(a) to appear in proceedings for an order under this section, whether or not that person is served with notice; and  
(b) to appeal against any order made, whether or not that person appears in the proceedings.

(5) An order made under this section shall not take effect until the end of the period within which notice of an appeal may be given or, if before the end of that period notice of appeal is duly given, until the final determination or abandonment of the proceedings on appeal.

(6) Where there is more than one person interested in the article, equipment or thing, the Court may direct that the article, equipment or thing be sold, or otherwise dealt with, and the proceeds divided, and shall make any other order as the Court thinks just.

(7) If the Court decides that no order should be made under this section, the person in whose possession the article, equipment or thing was before being delivered up is entitled to its return.

#### **Section 45 of the Registered Designs Act**

Government use of registered designs

45.—(1) Notwithstanding any of the provisions of this Act, the Government and any person authorised in writing by the Government may use any registered design for the services of the Government in accordance with section 46.

(2) The authority of the Government under subsection (1) may be—  
(a) given either before or after the registration of the design;  
(b) given either before or after the acts in respect of which the authority is given are done; and  
(c) given to any person whether or not he is authorised, directly or indirectly, by the registered owner to use the design.

(3) Without prejudice to the generality of subsection (1), any use of the design for —

(a) the supply to the government of any country or territory outside Singapore, in pursuance of any agreement or arrangement between the Government and the government of that country, of articles or non-physical products required —

(i) for the defence of that country; or

(ii) for the defence of any other country whose government is party to any agreement or arrangement with the Government in respect of defence matters; or

(b) the supply to the United Nations, or to the government of any country belonging to that organisation, of articles or non-physical products required for

any armed forces operating in pursuance of a resolution of that organisation or any organ of that organisation,

shall be deemed to be a use of the design for the services of the Government; and the power of the Government or a person authorised by the Government to use the design shall include power —

(A) to sell the articles or non-physical products to the government or to that organisation in pursuance of the agreement or arrangement; and

(B) to sell to any person any articles or non-physical products made in the exercise of the powers conferred by this section which are no longer required for the purpose for which they were made.

(3A) For the avoidance of doubt, the power to sell non-physical products in subsection (3)(A) and (3)(B) includes a power to sell equipment for projecting the non-physical products.

(4) Without prejudice to the generality of subsection (1), any use of a design to make an article or non-physical product, or any use of an article or non-physical product, for any purpose which appears to the Government necessary or expedient —

(a) to avoid prejudice to the security or defence of Singapore;

(b) to assist in the exercise of powers and the implementation of civil defence measures during a state of emergency or state of civil defence emergency under the Civil Defence Act (Cap. 42); or

(c) for public non-commercial use,

shall be deemed to be a use of the design for the services of the Government.

(5) The purchaser of any articles or equipment for projecting non-physical products sold in the exercise of powers conferred by subsection (1), and any person claiming through him, shall have the power to deal with the articles or equipment for projecting the non-physical products as if the rights in the registered design were held on behalf of the Government.

(6) Notwithstanding any provision in any other written law, the reproduction or publication of any model or document in connection with any use of a design made by virtue of subsection (1) shall be deemed not to constitute an infringement of any copyright subsisting in the document by virtue of the Copyright Act (Cap. 63) or any right subsisting in a layout-design by virtue of the Layout-Designs of Integrated Circuits Act (Cap. 159A).

## **Section 58 of the Registered Designs Act**

### **Powers of Registrar**

**58.** The Registrar may, for the purposes of this Act —

(a) summon witnesses;

(b) receive evidence on oath, whether orally or otherwise; and

(c) require the production of documents ~~or articles~~, articles or equipment for projecting non-physical products.

### **Section 59 of the Registered Designs Act**

#### **Disobedience to summons an offence**

**59.**—(1) A person who has been summoned to appear as a witness before the Registrar shall not, without lawful excuse, fail to appear in obedience to the summons.

~~(2) A person who has been required by the Registrar to produce a document or an article shall not, without lawful excuse, fail to produce the document or article.~~

(2) A person who has been required by the Registrar to produce a document, an article or any equipment for projecting a non-physical product must not, without lawful excuse, fail to produce the document, article or equipment.

(3) Any person who contravenes subsection (1) or (2) shall be guilty of an offence and shall be liable on conviction to a fine not exceeding \$2,000 or to imprisonment for a term not exceeding 3 months or to both.

### **Section 60 of the Registered Designs Act**

#### **Refusal to give evidence an offence**

**60.**—(1) A person who appears before the Registrar shall not, without lawful excuse, refuse to be sworn or to make an affirmation, or to produce documents ~~or articles~~, articles or equipment for projecting non-physical products, or to answer questions, which he is required by the Registrar to produce or answer.

(2) Any person who contravenes subsection (1) shall be guilty of an offence and shall be liable on conviction to a fine not exceeding \$2,000 or to imprisonment for a term not exceeding 3 months or to both.

### **Section 66 of the Registered Designs Act**

#### **False representation that design is registered**

**66.**—(1) Any person who falsely represents that a design applied to any article or non-physical product disposed of by him for value is registered in respect of that article or non-physical product shall be guilty of an offence and shall be liable on conviction to a fine not exceeding \$10,000 or to imprisonment for a term not exceeding 12 months or to both.

~~(2) For the purposes of subsection (1), a person shall be deemed to represent that a design applied to any article is registered in respect of that article, if there is stamped, engraved, or~~

~~impressed on or otherwise applied to the article the word “registered” or anything expressing or implying that the design applied to the article has been registered in respect of that article.~~

~~(3) — Any person who, after the right in a registered design has expired, marks any article to which the design has been applied with the word “registered”, or anything implying that there is a subsisting right in the design under this Act, or causes any such article to be so marked, shall be guilty of an offence and shall be liable on conviction to a fine not exceeding \$10,000 or to imprisonment for a term not exceeding 12 months or to both.~~

(2) For the purposes of subsection (1), a person is deemed to represent that a design applied to any article or non-physical product is registered in respect of that article or non-physical product, if —

(a) there is stamped, engraved or impressed on or otherwise applied to the article the word “registered” or anything expressing or implying that the design applied to the article has been registered in respect of that article; or

(b) there is applied to the non-physical product the word “registered” or anything expressing or implying that the design applied to the non-physical product has been registered in respect of that non-physical product.

(3) A person shall be guilty of an offence and shall be liable on conviction to a fine not exceeding \$10,000 or to imprisonment for a term not exceeding 12 months or to both, if the person, after the right in a registered design has expired —

(a) marks any article to which the design has been applied with the word “registered”, or anything implying that there is a subsisting right in the design under this Act, or causes any such article to be so marked; or

(b) applies, or causes to be applied, to a non-physical product to which the design has been applied the word “registered”, or anything implying that there is a subsisting right in the design under this Act.

## **Section 75 of the Registered Designs Act**

### **Rules relating to application for registration**

**75.**—(1) Without prejudice to the generality of section 74, the Minister may, for the purposes of section 11, make rules providing that an application for registration of a design shall or may contain —

(a) a statement describing the representation of the design;

(b) a statement describing the features of the design which the applicant considers to be new;

(c) the classification of the articles or non-physical products to which the design is intended to be applied, according to any ~~class or sub-class specified by the rules practice directions issued by the Registrar~~; and

~~(d) a sample of the article to which the design reproduced in the representation is to be applied.~~

(d) if the design reproduced in the representation is to be applied to an article, a sample of the article.

(2) Rules made under this section may provide for the manner in which the following are to be claimed in connection with an application for registration:

- (a) any claim that section 8, 9 or 10 applies in relation to the application;
- (b) any claim to a right of priority under section 12 or 13.

### **Savings and transitional provisions**

**Note:**

In general, except where otherwise stated in this public consultation document, the proposed amendments to the RDA described in this **Annex B** will not apply to any application for registration of a design that is filed before the date of commencement of the relevant provisions, or to any design registered as a result of any such application.

Instead, the provisions of the RDA as in force immediately before the date of commencement of the relevant provisions continue to apply to every application for registration of a design that is filed before that date, and to every design registered as a result of any such application, as if the relevant provisions had not been enacted.

However, for the savings and transitional provisions for the proposed amendments relating to Section 4(1), 4(2) and 4(3) RDA, please refer to the box in this **Annex B** underneath the proposed amendments relating to Section 4(1), 4(2) and 4(3) RDA.