

**Intellectual Property Office of Singapore**  
**Public Consultation on Proposed Designs-Related Legislative Amendments**

**11 November 2016**

**1. Introduction**

1.1 The Intellectual Property Office of Singapore (“IPOS”) is seeking feedback from members of the public on proposed designs-related legislative amendments. The amendments seek to implement proposals from the review of the registered designs regime (“the Designs Review 2016”). The period of public consultation is from **11 November 2016 to 11 December 2016**.

**2. Background**

2.1 On 16 March 2016, the Ministry of Law and IPOS completed the review of Singapore’s registered designs regime. The objectives of the review were:

- (a) to support modern business practices while continuing to balance the interests of design creators/owners and users;
- (b) to provide business certainty; and
- (c) to ensure that our design protection regime is cost-effective.

2.2 The “*Final Report - Review of the Registered Designs Regime*”<sup>1</sup> (“the Designs Review 2016 Report”) contained a list of 20 conclusions. We have considered whether the following conclusions of these 20 require legislative changes to implement:

**Conclusion 1**

Amend the definition of “design” in the Registered Designs Act (Cap. 266) (“RDA”) to provide for a broader scope of design protection. In amending the definition, reference will be taken from the United Kingdom (“UK”), European Union (“EU”) and Australian definitions.

**Conclusion 2**

Reaffirm the policy position to maintain the current minimal overlap between design protection and copyright protection. The designs of useful articles/products, i.e. articles/products having an intrinsic utilitarian function other than to carry the design, are more appropriately protected under the registered designs regime. However, protection should be via copyright where the article or product has no intrinsic utilitarian function other than to carry the design.

Retain the “50-article” quantitative threshold, beyond which copyright protection will cross over to registered design protection.

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<sup>1</sup> The report is available on the Ministry of Law’s website at <https://www.mlaw.gov.sg/content/dam/minlaw/corp/News/Annex%20A%20-%20Final%20Report%20for%20Designs%20Review.pdf>

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Legislative provisions relating to the overlap between design protection and copyright protection will be amended for clarity, as well as for consistency between the RDA and the Copyright Act. Activities, in partnership with industry and design associations, will be undertaken to educate the design community about the legislative regime governing the interface between copyright protection and design protection.

**Conclusion 5**

Amend the definition of “design” to provide protection for virtual or projected designs. To qualify for design protection, virtual or projected designs must:

- (a) be capable of being represented clearly and without subjectivity; and
- (b) retain the same (or substantially similar) design features irrespective of the surface or medium they are projected on.

**Conclusion 6**

Reaffirm that dynamic designs can be registered if they are:

- (a) capable of being represented clearly and without subjectivity on a static medium; and
- (b) capable of being represented through a series of freeze-frames of the dynamic design.

For clarification:

- (i) Designs on a fluid medium are not registrable (e.g. the spray pattern of a water fountain).
- (ii) Static GUIs are registrable.
- (iii) Dynamic GUIs that satisfy the above conditions are registrable.

**Conclusion 9**

Amend the RDA to specify colour as one design feature. However, the scope of design protection will not extend to colours *per se*.

**Conclusion 13**

Amend the RDA to:

- (i) increase the length of the grace period to 12 months; and
- (ii) remove the requirement that disclosures can only be made at select international exhibitions.

**Conclusion 15**

Amend the RDA to allow multiple designs in the same Locarno classification to be filed in one application.

**Conclusion 16**

Amend the RDA to remove the provision (specifically, Section 4(2)) that automatically treats the person commissioning the design as the owner of the design.

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- 2.3 The proposed legislative amendments described in the Annexes to this public consultation document relate to the above conclusions from the Designs Review 2016 Report.
- 2.4 The changes are intended to provide a conducive legal and policy framework to support the growth of local design industry. They also support the objectives of the Design 2025 Masterplan, which recommended that businesses capitalise on intellectual property to create value through the use of design in service and product innovation, which will in turn support economic growth and job creation in Singapore.
- 2.5 A brief outline of the proposed changes can be found in **Annex A**.
- 2.6 A draft of the proposed legislative amendments can be found in the following annexes:
- (a) **Annex B** – Proposed Amendments to Registered Designs Act (Cap. 266)
  - (b) **Annex C** – Proposed Amendments to Registered Designs Rules
  - (c) **Annex D** – Proposed Amendments to Registered Designs (International Registration) Rules
  - (d) **Annex E** – Proposed Amendments to Copyright and Registered Designs Legislation on the Interface Between Copyright and Registered Designs

**3. Public consultation period and feedback**

- 3.1 IPOS welcomes your feedback on the proposed legislative changes. Please note that the proposed amendments in **Annexes B to E** have not undergone the legislative drafting and vetting process **and hence are not finalised**.
- 3.2 Your views are important and will help us in improving the registered designs regime in Singapore. The feedback should be submitted in electronic or hardcopy form with the subject **“Public Consultation on Proposed Designs-Related Legislative Amendments”** to:

Intellectual Property Office of Singapore (IPOS)  
51 Bras Basah Road #01-01, Manulife Centre  
Singapore 189554  
Email: ipos\_consultation@ipos.gov.sg

- 3.3 IPOS reserves the right to disclose feedback or suggestions and make them available to the general public, in whole or in part, through its website or other means. However, the identity of the respondents will not be disclosed, if so requested.
- 3.4 Please submit your feedback by **11 December 2016**.

Thank you.

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**ANNEX A**  
**Proposed changes to the Designs Regime 2016**

This **Annex A** provides a brief summary of the proposed legislative changes.

For the wording of the proposed legislation amendments, please refer to **Annexes B to E**.

For the full text of the current intellectual property legislation, please refer to the IPOS legislation webpage at <https://www.ipos.gov.sg/AboutIP/IPLegislation.aspx>.

**Proposal 1: Broadening the scope of design protection via amendments to the definition of “design” and the definition of “article” and the inclusion of a new category of “non-physical products” into the Registered Designs Act, and amendments to the exclusions to the definition of “design”**

1.1 **Proposed amendments to the definition of “design” in Section 2(1) of the Registered Designs Act (“RDA”)**

1.1.1 We propose to amend the definition of “design” as shown in **Annex B**.

1.1.2 The new definition of “design” will relate to things which are “articles” as well as things which are “non-physical products”. As discussed at paragraph 1.3 below, “non-physical products” is a new category which we propose to insert into the RDA so as to accord design protection to virtual or projected designs.

1.1.3 We propose to remove the existing reference to “applied to an article by any industrial process”. This is because of the inclusion of handmade items in the proposed amended definition of “article” (see paragraph 1.2 below). Instead, we are proposing the new reference “applied to any article or non-physical product that give that article or non-physical product its appearance”.

1.1.4 We propose to amend the definition of “design” in the RDA so as to specify “colours” as one of the “features” of a “design”. The language of the proposed amendments is intended to permit a “design” to be comprised of one colour feature plus at least one non-colour feature, and in the case where the “features” of a “design” consists of only colours, they would be eligible for protection where they give rise to a “pattern” or “ornament”. As seen from limbs (c) and (d) of the definition of “design”, the situation where the “features” of a “design” consist of only one colour, and the situation where the “features” of a “design” consist only of colours which do not give rise to a “pattern” or “ornament”, will be excluded from the RDA definition of “design”, so that the scope of design protection does not impinge on the reasonable or legitimate use of colours by others. We have provided the examples below to illustrate our proposal. Note that a “design” is protected under Section 5 of the RDA only where it is novel.

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- (a) As a first example, a “design” can consist of a ribbing structure that is found on the surface of a vacuum cleaner together with the colour purple on the ribs (i.e. the colour feature of purple on the ribs, plus another non-colour feature of the ribbing structure found on the surface of the vacuum cleaner), and such a “design” as applied onto a vacuum cleaner would be protected under the RDA if it is novel.
- (b) As a second example, a “design” can consist of circles of varying sizes of the colours red, green, purple and blue applied onto a T-shirt in a random and haphazard manner. Such a “design” would give rise to “ornament” on the T-shirt, and would be protected under the RDA if it is novel.
- (c) As a third example, a “design” can consist of squares of a particular size of the colours red, green, purple and blue applied onto a T-shirt in a repeated manner. In this situation where the features consist of only colours but there is a “pattern” (because of the repeated manner of the squares of colour), the RDA definition of “design” is met.
- (d) As a fourth example, we have the colour yellow applied onto an entire plain T-shirt which is not of any novel shape. Such a situation is excluded from the RDA definition of “design”, so that the scope of design protection does not impinge on the reasonable or legitimate use of colours by others.

1.1.5 The new definition of design (as shown in **Annex B**) is flexible enough to permit dynamic designs to be registered. Please refer to Proposal 6 below for a more detailed discussion on this issue.

1.1.6 We propose to amend limb (b) of the definition of “design” (which excludes certain kinds of features from consideration as part of the definition of “design”) as shown in **Annex B**, so that limb (b) applies to both articles and non-physical products, and is not limited just to “features of shape and configuration”. We propose for limb (b) to exclude features which:

- (a) are dictated solely by the function which the article or non-physical product has to perform (for ease of reference we will refer to this as the ‘functional exclusion’);
- (b) 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 (for ease of reference we will refer to this as the ‘must match exclusion’); or
- (c) 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 (for ease of reference, we will refer to this as the ‘must fit exclusion’).

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- 1.1.7 There are strong policy reasons why the functional, must match and must fit exclusions exist in the RDA. These exclusions currently apply to articles only. As explained in the Designs Review 2016 Report,<sup>2</sup> these exclusions prevent functional design features from being monopolised by any one party and limit protection for spare parts, hence facilitating spare parts manufacturing and sale. These exclusions serve a useful purpose in the balancing of rights.
- 1.1.8 Thinking ahead of the future, we are of the view that the policy reasons for these three exclusions that already apply to articles, may similarly apply to non-physical products as well, since many non-physical products may be analogous to physical products (e.g. a virtual keyboard). We would like to invite views on whether (and if so how) the legislation should be “future-proofed” to take into account future forms of non-physical products. If you have any views, please provide an explanation/rationale for your view.
- 1.1.9 We also propose that that limb (b) should not be limited just to “features of shape and configuration”. In this regard, we note that in the UK and in the EU legislation,<sup>3</sup> the functional and the must fit exclusions apply to all “features of appearance” that are within their respective definition of “design”.<sup>4</sup> Also, we are of the view there are situations where colours could be dictated solely by the function which the article or non-physical product has to perform (for example, the colours, red, amber or yellow, and green for a traffic light). We are also of the view that in practice, it is not likely that the functional, must match and must fit exclusions would apply to features of “pattern” and “ornament” (this is because of the inherent nature of features of “pattern” and “ornament”, and because of the nature of the functional, must match and must fit exclusions). If you have any views, please provide an explanation/rationale for your view.
- 1.1.10 We welcome any other views as well concerning the proposed amendments to the definition of “design” as shown in **Annex B**. Please provide an explanation/rationale for your views if any.
- 1.2 Proposed amendments to the definition of “article” in Section 2(1) of the RDA
- 1.2.1 We propose to amend the definition of “article” as shown in **Annex B**.
- 1.2.2 The proposed amendments to the definition of “article” are comparable to corresponding definitions in UK, Canada and Australia. Section 1(3) of the UK Registered Designs Act 1949 defines a “product” as “any industrial or handicraft item other than a computer program”. Section 2 of Canada’s Industrial Design Act defines “article” as “any thing that is made by hand, tool or machine”. Section 6 of

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<sup>2</sup> Paragraphs 2.1.5 and 2.3.13 of the Designs Review 2016 Report.

<sup>3</sup> Section 1C of the UK Registered Designs Act and Article 8 of the Community Designs Regulation (6/2002).

<sup>4</sup> Section 1(2) of the UK Registered Designs Act and Article 3(a) of the Community Designs Regulation (6/2002).

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Australia's Designs Act 2003 defines a "product" as "a thing that is manufactured or hand made".

- 1.2.3 We propose to amend the definition of "article" by replacing the words "article of manufacture" with the words "thing that is manufactured or handmade (regardless whether the thing is unique or made or produced on any scale)." The wording in brackets clarifies that the volume of production does not determine whether an item is an "article".
- 1.2.4 Items that are wholly not man made will be excluded from the definition of "article" (examples of such items would be a seashell collected from a seashore, and raw natural rock crystal formations plucked from a cave).
- 1.2.5 We welcome views concerning the proposed amendments to the definition of "article" as shown in **Annex B**. Please provide an explanation/rationale for your view.

1.3 Proposed new category of "non-physical product" in the RDA

1.3.1 In Conclusion 5 of the Designs Review Report 2016, it was decided to provide design protection for virtual or projected designs. We therefore propose to amend the definition of "design" (as discussed at paragraph 1.1.2 above), as well as insert a new category of "non-physical products" into the RDA, so as to accord design protection to virtual or projected designs.

1.3.2 Along this vein, we propose to insert a new definition of "non-physical product" into Section 2(1) of the RDA, as shown in **Annex B**.

1.3.2.1 The new definition of "non-physical product" will cover things which satisfy the following criteria: (a) they do not have a physical form, (b) they are produced by the projection of a design onto a surface or into a medium, including air; and (c) they perform any utilitarian function. In contrast, "article" in Section 2(1) of the RDA is meant to cover things which have a physical form. The proposed definition of "non-physical product" will also include any set of non-physical products.

1.3.2.2 Our intention behind the phrase "utilitarian function" is 'a function other than merely serving as a substrate or carrier for artistic or literary matter', similar to Section 2 of Canada's Industrial Design Act.

1.3.2.3 The IPOS Designs Registry intends to amend its practice direction which presently permits applicants to claim and protect partial designs in relation to articles, to also cover non-physical products as well.<sup>5</sup> We would also like to seek views on the applicability of limb (a) of the definition of "article" in

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<sup>5</sup> Special IP2SG Practice Direction No. 2 of 2014, [https://www.ipos.gov.sg/Portals/0/FAQ/IP2SG/Special%20IP2SG%20PD%20No.%202%20of%202014%20\(EOS\).pdf](https://www.ipos.gov.sg/Portals/0/FAQ/IP2SG/Special%20IP2SG%20PD%20No.%202%20of%202014%20(EOS).pdf) (Page 11, no. 16).

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relation to non-physical products. Limb (a) of the definition of “article” states that article includes “any part of an article, if that part is made and sold separately”.

- 1.3.3 We propose not to have requirements for the obtaining of design protection in relation to non-physical products that are different from the requirements for the obtaining of design protection in relation to articles.
- 1.3.4 Therefore, the existing Section 11(2) RDA, which requires all design applications to contain a clear representation of the design, will also apply to applications for the designs of non-physical products.
- 1.3.5 To enforce design protection against allegedly infringing non-physical products under Section 30(1) RDA, similar to existing design protection against allegedly infringing articles, the allegedly infringing non-physical product must bear a design that is exactly the same, or not substantially different, to the design which has been registered.<sup>6</sup> Therefore, the representation of the design under the design registration is very important, as it will be taken into consideration by the Court when determining the issue of infringement.
- 1.3.6 We have also proposed amendments to other provisions in the RDA, to the Registered Designs Rules, to the Registered Designs (International Registration) Rules, to the Copyright Act as well as to the Copyright Regulations, to take into account the new category of non-physical products. The proposed amendments can be found in **Annexes B, C, D and E**. These include:
- 1.3.6.1 Subsequent registration of a design in respect of other articles or non-physical products (see the proposed amendments to Section 10 RDA in **Annex B**);
  - 1.3.6.2 Claim to priority (see the proposed amendments to Sections 12 and 13 RDA in **Annex B** and to Rule 19 of the Registered Designs Rules in **Annex C**);
  - 1.3.6.3 Surrender of registration (see the proposed amendments to Section 26 RDA in **Annex B**, and the proposed amendments to Rule 39 of the Registered Designs Rules in **Annex C**);
  - 1.3.6.4 Exclusive rights that registration confers in relation to a non-physical product (see the proposed amendments to Section 30 RDA in **Annex B**). We would like to request for views on the exclusive rights that registration confers in relation to a non-physical product. Please provide an explanation/rationale for your views if any;
  - 1.3.6.5 Rights of third parties to continue use of registered designs (see the proposed amendments to Section 31 RDA in **Annex B**);
  - 1.3.6.6 General restriction on recovery of damages or profits (see the proposed amendments to Section 39 RDA in **Annex B**);

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<sup>6</sup> Please see **Annex B** for the proposed amendments to Section 30(1) of the RDA (to include a reference to non-physical products).



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- 1.3.6.7 Order for delivery up and order for disposal (see the proposed amendments to Section 40 and 41 RDA in **Annex B**);
  - 1.3.6.8 Government use of registered designs (see the proposed amendments to Section 45 RDA in **Annex B**);
  - 1.3.6.9 Powers of the Registrar (see the proposed amendments to Section 58 RDA in **Annex B**);
  - 1.3.6.10 Disobedience to summons an offence (see the proposed amendments to Section 59 RDA in **Annex B**);
  - 1.3.6.11 Refusal to give evidence an offence (see the proposed amendments to Section 60 RDA in **Annex B**); and
  - 1.3.6.12 False registration that a design is registered (see the proposed amendments to Section 66 RDA in **Annex B** and to Rule 13 of the Registered Designs (International Registration) Rules in **Annex D**).
  - 1.3.6.13 Copyright and registered designs legislation on the interface between copyright and registered designs (see the proposed amendments to Sections 7 and 9 RDA, Rules 9 and 12 of the Registered Designs Rules, Sections 7(1), 70, 73, 74 Copyright Act and Regulation 12 of the Copyright Regulations in **Annex E**.)
- 1.3.7 We welcome views concerning the amendments described in **Annexes B, C, D and E**, relating to the category of non-physical products. Please provide an explanation/rationale for your views.
- 1.4 **Proposed new definitions of “set of non-physical products” and “set of articles and non-physical products” in Section 2(1) of the RDA**
- 1.4.1 We propose to insert these new definitions into Section 2(1) of the RDA as shown in **Annex B** so as to accommodate new kinds of sets that would arise with the new category of non-physical products. These new terms will be modelled after the existing definition of “set of articles” in Section 2(1) of the RDA. We have also proposed corresponding amendments to Rule 14(4) and 14(5) of the Registered Designs Rules as shown in **Annex C**.
  - 1.4.2 An example of a “set of non-physical products” is a set that comprises a virtual keyboard and a virtual pointer/mouse.
  - 1.4.3 An example of a “set of articles and non-physical products” is a set that comprises a headset and handheld implements (both of which have a physical form) as well as a virtual keyboard and virtual pointer/mouse (these two do not have a physical form).
  - 1.4.4 We welcome views concerning the proposed amendments as shown in **Annex B** and **Annex C**. Please provide an explanation/rationale for your views.

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Impact of proposed changes

- 1.4.5 The intention behind the proposed amendments is to implement Conclusions 1, 5 and 9 from the Designs Review 2016 Report.
- 1.4.6 Today, designs are applied onto things that have a physical form as well as things that do not have a physical form. Technological advances and evolving business practices have changed the way designs are created, as well as how goods and services are supplied to and used by customers. The proposed changes not only allow our RDA to stay relevant, they are also aimed at better serving current and future designers.

**Proposal 2: Treating the designer as owner of a design created under commission**

- 2.1 Proposed amendments to the ownership of a commissioned design in Section 4 of the RDA
- 2.1.1 Under the existing Section 4 of the RDA, where a design is created under a commission, the person commissioning the design is automatically treated as the owner of the design, unless there is an agreement to the contrary between the parties concerned.
- 2.1.2 We propose to amend Section 4 of the RDA as shown in **Annex B**, so that in the situation where a design is created under a commission, the designer is treated as the owner of the design by default. Such rights can still be assigned to the commissioner by written agreement. This is intended to give effect to Conclusion 16 of the Designs Review 2016 Report.
- 2.1.3 For the proposed amendments relating to Sections 4(1), 4(2) and 4(3) RDA, on the issue of savings and transitional provisions, we are proposing the approach as described in the box in **Annex B** under Section 4 RDA. This proposed approach is similar to the savings and transitional provisions that were made by the UK in relation to similar legislative amendments.<sup>7</sup>
- 2.1.4 We welcome views concerning the proposed amendments as shown in **Annex B**.
- 2.2 Impact of the proposed changes
- 2.2.1 The changes will encourage the growth of our local design industry (by encouraging designers to build their design portfolios), and prevent designers unfamiliar with the existing Section 4 of the RDA from unintentionally losing rights to their designs.

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<sup>7</sup> The amendments to Section 2 of the UK Registered Designs Act 1949 took place under Section 6 of the UK Intellectual Property Act 2014. On 1 Oct 2014, Section 6 of the UK Intellectual Property Act 2014 was brought into force via the Intellectual Property Act 2014 (Commencement No. 3 and Transitional Provisions) Order 2014.

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- 2.2.2 Singapore will also be aligning itself with the practice of other major jurisdictions, such as Australia, the EU, Japan and the United States of America, where the creator, instead of the commissioner, owns the design by default.

**Proposal 3: Broadening the grace period for disclosures of the design that have been made prior to filing of the design application**

3.1 Proposed amendments to Section 8 of the RDA to broaden the grace period for pre-filing disclosures

3.1.1 The existing Section 8 RDA provides for particular situations where, even though the design has been disclosed prior to the filing of the design application, the application is not to be refused, and the registration of the design is not to be revoked, on the ground of lack of novelty. In essence, under such situations, the application for registration is accorded 'grace' (i.e. excused) in relation to the requirement that the design be "new" under Section 5 of the RDA. In particular, Section 8(2) RDA deals with the situation of first disclosure of the design at a select list of international exhibitions,<sup>8</sup> and for such situation, the applicant must file his design application within 6 months of the disclosure in order to qualify for 'grace'.

3.1.2 In Conclusion 13 of the Designs Review 2016 Report, it was decided to amend the RDA to increase the length of the grace period to 12 months, and to remove the requirement that disclosures can only be made at select international exhibitions.

3.1.3 We propose to replace the existing Section 8 RDA with a new provision as shown in **Annex B**, which is largely modelled after Section 1B(6)(b) to Section 1B(6)(e) of the UK Registered Designs Act. The amendments would result in Singapore having a broadened 12 month grace period with approximately the same scope of non-novelty destroying disclosures as the UK and the EU, with the exception that there would not be an equivalent of Section 1B(6)(a) of the UK Registered Designs Act, because that provision is concerned with the European Economic Area and so is not relevant for the Singapore context. We also propose to amend Rule 17 of the Registered Designs Rules as shown in **Annex C**.

3.1.3.1 Limbs (a), (b), (c) and (d) of the new provision combined, cover a wide scope of scenarios of disclosure of the design by the designer or by a successor in title to the designer, and the scenario where the designer or successor in title to the designer exhibits the design at an official international exhibition would generally be covered within these limbs.

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<sup>8</sup> The list of official international exhibitions comprises any official, or officially recognized, international exhibition falling within the terms of the Convention on International Exhibitions signed at Paris on 22<sup>nd</sup> November 1928, and any protocols to the Convention, as revised or amended from time to time, as provided under the current Section 8(3) of the RDA.

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- 3.1.4 In limb (d), the wording “as a consequence of bad faith” has been chosen as:
- (a) this wording provides more clarity than the wording “as a consequence of an abuse” (which is seen in Section 1B(6)(e) of the UK Registered Designs Act), and also covers a thieving situation (where the thief breaks into the designer’s office and steals the designer’s design and subsequently uses or publishes the design); and
  - (b) the concept of “bad faith” is also not unfamiliar to intellectual property law, as what amounts to “bad faith” (in the context of making of making a trade marks application) has been the subject of many trademarks cases in both Singapore<sup>9</sup> and the UK.
- 3.1.5 Third parties would still be able to claim prior user rights.<sup>10</sup> Therefore, the proposed amendments provide a limited safety net for registered design applicants.
- 3.1.6 We also propose that the amended Section 8 RDA would apply where the disclosure has been made on or after the commencement date of the new designs legislation. The existing Section 8 RDA will still continue to apply where the disclosure was made before the commencement date of the new designs legislation.
- 3.1.7 We welcome views concerning the proposed amendments as shown in **Annex B** and **Annex C**.

3.2 Impact of proposed changes

- 3.2.1 The effect of a broadened grace period provision is that designers who have publicly disclosed their designs during the 12 month grace period (e.g. to market-test their products) would be able to obtain design protection in Singapore. Designers would also be able to obtain design protection overseas only in countries which have a broad grace period (it should be noted that the length of the designs grace period differs in those overseas jurisdictions that provide a broad grace period).<sup>11</sup> For countries whose design regimes do not provide for broad grace periods, the earlier disclosure would mean that the design would no longer be novel and can no longer qualify for design protection in those countries. Therefore, all individuals and businesses are ***strongly encouraged*** to keep their designs a secret until a first application for a design has been filed, and to enter into confidentiality agreements if there is a need to tell others about the design.

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<sup>9</sup> Section 7(6) of the Trade Marks Act states “A trade mark shall not be registered if or to the extent that the application is made in bad faith”.

<sup>10</sup> Under Section 31(1) and Section 20 of the RDA, a third party has the right to continue using the design in Singapore if, before the filing date of the registered design, the third party had in good faith carried out an act that would have constituted design infringement if the registration had been in force at the time the act is done, or made effective and serious preparations to do such an act in Singapore.

<sup>11</sup> The EU and the US provide for a 12 month grace period whereas Japan and South Korea provide for a 6 month grace period.

**Proposal 4: Simplification of the “applied industrially” interface between copyright and registered designs, and clarifying the interface between copyright and registered designs given the new category of non-physical products**

4.1 Proposed amendments to selected provisions which relate to the interface between copyright and registered designs: Section 7(3) and 9 of the RDA, Rule 9 and 12 of the Registered Designs Rules, Sections 70, 73 and 74 of the Copyright Act and Regulation 12 of the Copyright Regulations

4.1.1 Existing legislation that relates to the interface between designs and copyright can be found in the following:

- (a) Section 7(1) and 7(3) RDA and Rule 9 of the Registered Designs Rules;
- (b) Section 9 RDA and Rule 12 Registered Designs Rules;
- (c) Copyright Act Sections 73 and 74 and the Schedule to the Copyright Act, and Regulation 12 of the Copyright Regulations;
- (d) Copyright Act Section 70; and
- (e) Copyright Act Section 69.

For the full text of the above legislation, please refer to the IPOS legislation webpage at <https://www.ipos.gov.sg/AboutIP/IPLegislation.aspx>.

4.1.2 We propose to amend Section 7(3) of the RDA as well as Rule 9 of the Registered Designs Rules as shown in **Annex E**, so as to exclude from registration non-physical products of a primarily literary or artistic character. For such items, protection should be sought under copyright as a literary or artistic work.

4.1.2.1 We would like to ask for feedback and examples of non-physical products of a primarily literary or artistic character that should be excluded from registration under the RDA.

4.1.2.2 Rule 9(c) of the Registered Designs Rules currently excludes from designs registration a list of items that are primarily of a literary or artistic character, and our preliminary view is that where the item takes the form of a non-physical product, protection should be sought under copyright as a literary work or as an artistic work. We welcome any feedback on this preliminary view. Please provide an explanation/rationale for your views if any.

4.1.2.3 We welcome views concerning the proposed amendments to Section 7(3) of the RDA as well as Rule 9 of the Registered Designs Rules as shown in **Annex E**.

4.1.3 We will retain the “50” quantitative threshold, beyond which copyright protection will cross over to registered design protection. However, we propose to amend the current “50 article” quantitative threshold<sup>12</sup> to a “50 item” quantitative threshold

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<sup>12</sup> Found in Rule 12(1)(a) of the Registered Designs Rules and Regulation 12(1)(a) of the Copyright Regulations.

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instead (as seen in the proposed amendments to Section 9 RDA, Rule 12 of the Registered Designs Rules, Section 74(2) and 74(2A) of the Copyright Act and Regulation 12 of the Copyright Regulations in **Annex E**), under which each “item” is an article or a non-physical product. In this approach, the number of instances of application of the design, whether on articles or on non-physical products or on both kinds of things, determines whether the quantitative threshold has been exceeded. So for example, if a design has been applied to an article 40 times and onto a non-physical product 11 times (so a total of 51 times), the quantitative threshold would be exceeded.

- 4.1.4 We propose to amend Rule 12(1) of the Registered Designs Rules and Regulation 12(1) of the Copyright Regulations in such a way so as to have parallel provisions that would simplify the “applied industrially” interface between copyright and registered designs. For these provisions, we propose to have two limbs as shown in **Annex E**. These two limbs have been modelled after UK designs legislation that is the equivalent of Rule 12 of the Registered Designs Rules and Regulation 12 of the Copyright Regulations<sup>13</sup> but with modifications to take non-physical products into account. Limb (a) will contain the “50 item” quantitative threshold (which has been explained in the previous paragraph above), whereas limb (b) will deal with the issue of articles manufactured in lengths or pieces which are not handmade articles.<sup>14</sup>
- 4.1.5 We propose to amend Section 70 and 73 and 74 of the Copyright Act as shown in **Annex E**, to take into account non-physical products.
- 4.1.6 The scope of non-infringement of copyright in the following provisions will be retained:
- (a) In Section 74(1) Copyright Act read with Section 73 Copyright Act (these provisions relate to non-infringement of artistic work copyright in relation to corresponding designs that have been registered under the RDA);
  - (b) In Section 74(2) read with Section 74(3) and Section 73 of the Copyright Act (these provisions relate to non-infringement of artistic work copyright in relation to corresponding designs that were registrable under the RDA but which have not been so registered).
- 4.1.7 We would like to for views on whether the existing term “applied industrially” seen in Section 9 RDA, Rule 12 of the Registered Designs Rules, Section 74(2) of the Copyright Act, Regulation 12 of the Copyright Regulations and Section 70(2) of the Copyright Act should be replaced with another phrase (e.g. “applied on scale”). One reason is because the essence underlying the concept of “applied industrially” is the concept of application on a large scale. A second reason is because with the proposed

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<sup>13</sup> Schedule 2, Paragraph 12 of the UK Registered Designs Rules 2006, and Article 2 of the UK The Copyright (Industrial Process and Excluded Articles) (No. 2) Order 1989.

<sup>14</sup> An example of an article that is manufactured in lengths would be wallpaper, whereas an example of an article that is manufactured in pieces would be floor tiles.

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amendments to the definition of “design” (as seen in **Annex B**), the application of the features of appearance do not necessarily take place via an industrial process. However, we note that Australia has retained the concept of “applied industrially” in Section 77 of the Australian Copyright Act notwithstanding the definition of “design” and the definition of “product” in the Australian Designs Act, and we note that similar to Singapore, Australia takes the approach of separation between designs and copyright protection. If you have a view on this matter, please provide an explanation/rationale.

4.1.8 We welcome views on the proposed amendments to selected provisions concerning the interface between copyright and registered designs as shown in **Annex E**.

#### 4.1.9 Impact of proposed changes

4.1.9.1 The proposed changes clarify the interface between copyright and registered designs given the new category of non-physical products, and the proposed parallel provisions between Rule 12(1) of the Registered Designs Rules and Regulation 12(1) of the Copyright Regulations help to simplify the “applied industrially” interface between copyright and registered designs.

4.1.9.2 To ease confusion and lack of awareness about the legislative regime governing the interface between copyright protection and design protection, IPOS and/or its training arm IP Academy will organise awareness events in partnership with industry and design associations to educate the design community.

### **Proposal 5: Allow filing of multiple designs within a single application and division of design applications**

#### 5.1 Proposed legislation changes to allow multiple designs in the same Locarno classification to be filed in one application.

5.1.1 Currently, under Rule 22(a) of the Registered Designs Rules, two or more designs may be the subject of the same application for registration if the designs relate to the same class and sub class of articles as classified in accordance with the Third Schedule<sup>15</sup> of the Registered Designs Rules. For designs which relate to articles falling within different classes, or within different sub-classes of the same class, they have to be filed under separate applications.

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<sup>15</sup> The current Third Schedule of the Registered Designs Rules is based on the 8<sup>th</sup> edition of the Locarno Classification, which is an international classification used for the purposes of registration of industrial designs established under the Locarno Agreement administered by the World Intellectual Property Organization.

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- 5.1.2 In Conclusion 15 of the Designs Review Report 2016, it was decided to amend the RDA to allow multiple designs in the same Locarno classification, to be filed in one application.
- 5.1.3 In this regard, we propose to amend Section 11 of the RDA as shown in **Annex B**, and Rule 22 of the Registered Designs Rules as shown in **Annex C**, so as to permit multiple designs to be filed in the same design application, subject to the following:
- (a) The applicant can elect to file multiple designs in the same application only at the point of filing Form D3 (i.e. at the point in time when the applicant first lodges the design application).
    - (i) Applicants would not be permitted to include more designs into the application after Form D3 has been filed, as this would pose problems for the accordance of the filing date, as well as for the calculation of filing fees.
    - (ii) Any attempt to use Section 15 RDA (which permits amendment of application) to include more designs into the application after Form D3 has been filed will be rejected under Section 15(2) RDA. Under Section 15(2) RDA, it is not possible to amend an application if the scope of the application would be increased by the inclusion of matter that was not in substance disclosed in the application as filed.
  - (b) The articles or non-physical products to which the multiple designs relate to, must all relate to the same class, or alternatively, must all relate to the same classes.
    - (i) This is in line with international norms concerning designs registration,<sup>16</sup> and facilitates ease of formalities examination for an application containing multiple designs.
    - (ii) The current requirement that the article to which the multiple designs relate to must fall within the same sub-class will be removed.
  - (c) The maximum number of designs that may be filed in one application shall not exceed the number as specified in practice directions issued by the Registrar.
- 5.1.4 An applicant that adheres to the 3 requirements described at paragraph 5.1.3(a), (b) and (c) above, when filing applications containing 2 or more designs in the same Locarno class, may possibly be able to enjoy some cost savings as compared to filing separate individual applications for each design.

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<sup>16</sup> Rule 7(7) of the Hague Agreement Common Regulations states that all products which constitute the industrial designs to which an international application relates, or in relation to which the industrial designs are to be used, shall belong to the same class of the International Classification.



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- 5.1.5 In relation to sub-paragraph (b) of paragraph 5.1.3, the Designs Registry at IPOS will indicate in a practice direction as well as in Form D3 that the class/classes indicated for the first design will determine the class/classes that apply for all of the subsequent designs. So for example, if the applicant files in total 3 designs in one application, and the classes (of articles or non-physical products) indicated for the 1<sup>st</sup> design are classes 9, 10 and 11, the classes (of articles or non-physical products) for the 2<sup>nd</sup> and 3<sup>rd</sup> design shall be regarded as classes 9, 10 and 11 as well.
- 5.1.6 Where an application is filed containing 2 or more designs, the Registrar will treat each design in the application as if a separate application is being made under the RDA (see the proposed Section 11(5) RDA in **Annex B**). This is to facilitate ease of downstream activities pertaining to each individual design (for example, publication of the design under Section 18 and 18A RDA, extension of the period of registration of the design for the 2<sup>nd</sup> and 3<sup>rd</sup> block of 5 years each under Section 21(2) RDA, and the registrations of transactions affecting a registered design such as assignments and licenses, under Section 34 RDA). The Designs Registry at IPOS will allocate separate application numbers to each design, where an application is filed containing 2 or more designs.
- 5.1.7 We propose that the 3 requirements described at paragraph 5.1.3(a), (b) and (c) above, will become part of the formal requirements<sup>17</sup> under which the IPOS Designs Registry examines<sup>18</sup> designs applications with (see the proposed Section 11(4) RDA in **Annex B** and the reference to Section 11 in Section 16(5) RDA in **Annex B**, as well as the amendments to Rule 22 of the Registered Designs Rules in **Annex C**).
- 5.1.8 If the Registrar determines that an application fails to comply with the formal requirements,<sup>19</sup> the Registrar shall notify the applicant and give him an opportunity to correct the non-compliance (see Section 16(2) RDA in **Annex B** and Rule 27(2) of the Registered Designs Rules in **Annex C**).
- 5.1.9 We propose that where the non-compliance relates to the requirement<sup>20</sup> in the proposed section 11(4) RDA (where the application was derived from an application containing 2 or more designs), or where the non-compliance relates to the requirement that the application contain a clear representation of the design in Section 11(2)(c) RDA, the Registrar may, when he issues the written notice to the applicant concerning the non-compliance under Section 16(2) RDA, invite the

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<sup>17</sup> The legal provisions which make up the formal requirements can be found in Section 16(5) RDA and Rule 27(1) of the Registered Designs Rules. These provisions are: Section 11 RDA, and Rules 10, 11, 13, 14, 15, 17, 18 and 19 of the Registered Designs Rules.

<sup>18</sup> Under Section 16(1) RDA, the Registrar will carry out an examination to determine whether the formal requirements are satisfied.

<sup>19</sup> As discussed at paragraph 5.1.7 above, the 3 requirements described at paragraph 5.1.3(a), (b) and (c) above will become part of the formal requirements under which the IPOS Designs Registry examines designs applications with.

<sup>20</sup> 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) RDA.

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applicant to file one or more new applications (see the proposed new Section 16A(1) RDA in **Annex B**, and the amendments to Rule 27(2) of the Registered Designs Rules in **Annex C**).

- (a) Such new applications must not be filed where a notice of withdrawal has been filed, or the application has been treated as withdrawn, or where the application has been refused (see the proposed Section 16A(2) RDA in **Annex B**).
- (b) If the new application meets the requirements of Section 11, the applicant of the new application is the same as the applicant or successor in title of the earlier application, and the new application does not include matter that was not in substance disclosed in the earlier application, the new application will be treated as having the same filing date of the earlier application (the application to which the written notice pertains to). (See the proposed Section 16A(3) and 16A(4) RDA in **Annex B**).
- (c) The new proposed Section 16A RDA is intended to allow new applications to be filed in certain limited circumstances, and for such new applications to retain the same filing date of the earlier application, provided the requirements described in the previous sub-paragraph are met. Applicants of such new applications will have to pay filing fees in relation to such new applications, and may not stand to benefit from the possible cost savings described at paragraph 5.1.4 as a result. As such, applicants (and those representing them) are ***strongly encouraged***, right from the outset, to carefully check their applications prior to submission, to ensure that:
  - (i) every article or non-physical product to which each of those designs in the application is to be applied, falls within the same class, or alternatively, all the same classes, under the classification mentioned in Section 75(1)(c); and
  - (ii) all the images of the design submitted by the applicant under Section 11(2)(c) RDA as the representation of the design relate to one design.

5.1.10 We are also proposing to amend Section 15 RDA (to insert a new proposed section 15(2A) as shown in **Annex B**), so that the class or classes in an application<sup>21</sup> derived from an application containing 2 or more designs shall not be amended if, as a result of the amendment, the requirement mentioned in section 11(4) RDA 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.

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<sup>21</sup> As discussed at paragraph 5.1.6 above, where an application is filed containing 2 or more designs, the Registrar will treat each design in the application as if a separate application is being made under the RDA, and separate application numbers will be allocated to each design.

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- 5.1.10.1 The reason for this amendment is because applicants are permitted to file multiple designs in the same application, and to enjoy the possible cost savings discussed at paragraph 5.1.4, only where the requirement of same class or classes is met.
- 5.1.10.2 Along this vein, the new proposed Section 15(2A) RDA would not inhibit amendment of the class or classes of an application that is derived from an application filed under section 11(1) containing 2 or more designs (referred to as the earlier application), if all the applications that are derived from the earlier application are also amended to the same class or classes.
- 5.1.10.3 The new proposed Section 15(2A) RDA is limited just to the situation where the filing was made via an application containing 2 or more designs, and so in the situation where the filing was made via an application containing only 1 design, and where the applicant seeks to amend the class or classes of such an application, it would be possible to do so under Section 15 RDA (i.e. the proposed Section 15(2A) does not apply to restrict this).
- 5.1.11 We do not propose to amend the provisions relating to withdrawal of application (in Section 14 RDA<sup>22</sup> and Rule 23 of the Registered Designs Rules). Where the filing was made under an application containing 2 or more designs, it would be possible to withdraw all the designs, or any particular design, using Form CM9.
- 5.1.12 We do not propose to amend the provisions relating to publication of the representation of the design (in Section 18 and 18A RDA). At the time of filing an application pertaining to 2 or more designs, an applicant will be able to request for a deferment of publication under Section 18 RDA of particular designs or of all designs in that application, in Form D3.
- 5.1.13 We are also proposing for the prescribed requirements under Section 11(4) RDA read with the new proposed Rule 22 of the Registered Designs Rules, to not apply to international registrations made under the Hague Agreement<sup>23</sup> designating Singapore. (See the reference to Section 11 RDA in Rule 4(2) of the Registered Designs (International Registration) Rules, and the inclusion of Rule 22 of the Registered Designs Rules within the amendments to Rule 4(2) of the Registered Designs (International Registration) Rules and also within the amendments to Rule 21(3) of the Registered Designs (International Registration) Rules, all shown in **Annex D.**)

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<sup>22</sup> Under Section 14 RDA, an applicant may initiate withdrawal of an application for registration by filing a notice of withdrawal before the date on which preparations for publication under section 18 RDA have been completed.

<sup>23</sup> Singapore is party to the Hague Agreement Concerning the International Registration of Industrial Designs (the Act signed at Geneva on 2<sup>nd</sup> July 1999). This Agreement permits international applications to be made to obtain protection in countries that are party to the Agreement.

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5.1.13.1 This is because there is already an existing requirement for international applications that all products which constitute the industrial designs to which an international application relates, shall belong in the same class of the Locarno Classification.<sup>24</sup> Also, the maximum number of designs that can be filed in each international application is prescribed in the Hague Agreement Common Regulations.<sup>25</sup>

5.1.14 On a related note:

(a) we are proposing to remove Rule 15 of the Registered Designs (International Registration) Rules (as shown in **Annex D**), and to make a consequential amendment to Rule 25 of the Registered Designs Rules (as shown in **Annex C**).

(i) This is because the new proposed Rule 22 of the Registered Designs Rules will not apply to international registrations made under the Hague Agreement (see discussion under paragraph 5.1.13 above), and so in future, the Registrar will not raise notifications of refusal of protection to the International Bureau under Rule 15 of the Registered Designs (International Registration) Rules, and so applications for division of the international registration in order to overcome the grounds of refusal stated in the notification are no longer needed.

(b) we are also proposing to remove the classification of designs from the Third Schedule of the Registered Designs Rules, and to put the classification into a practice direction to be issued by the Registrar. This is intended to facilitate greater ease of future updates to the classification system. (See the proposed amendments to Rule 26, 28(d), 31(d) and to the Third Schedule of the Registered Designs Rules in **Annex C**.)

5.1.15 We welcome views on the proposed amendments as shown in **Annexes B, C and D**.

## 5.2 **Impact of proposed changes**

5.2.1 For design applicants who have a large number of designs that they wish to seek protection for (e.g. design applicants in the jewellery, furniture, fashion and clothing industries), there will be time and possible cost savings and increased efficiency when filing multiple designs in a single application.

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<sup>24</sup> Rule 7(7) of the Hague Agreement Common Regulations states that all products which constitute the industrial designs to which an international application relates, or in relation to which the industrial designs are to be used, shall belong to the same class of the International Classification (the International Classification refers to the Locarno Classification).

<sup>25</sup> Rule 7(3)(v) of the Hague Agreement Common Regulations states that the number of industrial designs included in the international application may not exceed 100.

**Proposal 6: Reaffirm that dynamic designs can be registered**

6.1 Reaffirming that dynamic designs can be registered through flexibility in the definition of “design”, and by requiring such designs to be represented through a series of freeze-frames

6.1.1 The new definition of “design” (as proposed in **Annex B**) is flexible as it does not restrict the features of shape, configuration, colours, pattern or ornament that are applied, to only static features. It is therefore possible for such features to be dynamic in nature. Nor does the definition of “design” specify how these features are to be applied to an article or to a non-physical product.

6.1.2 In the existing Section 11(2) of the RDA, there is a requirement that a design application contain a clear representation of the “design”.

6.1.2.1 Going forward, we propose to have a practice direction that applies to all design applications where the features of appearance of the design are dynamic in nature, and for such designs, we will require applicants to file the “design” through a series of static representations. Presently, this requirement for applicants to file the “design” through a series of static representations applies to animated Graphical User Interfaces (GUIs) that are claimed as designs in relation to mobile devices such as mobile telephones.<sup>26</sup>

6.1.2.2 To enforce design protection against an allegedly infringing article or non-physical product under Section 30(1) RDA, the allegedly infringing article or non-physical product must bear a design that is exactly the same, or not substantially different, to the design which has been registered. Therefore, the static representations that are filed are very important, as they will be taken into consideration by the Court when determining the issue of infringement.

6.1.3 We therefore propose to deal with Conclusion 6 of the Designs Review 2016 report in the manner discussed above. The intention is to permit the registration of different kinds of designs where the features of appearance of the design are dynamic in nature.

6.2 Impact of proposed changes

6.2.1 The proposed changes permit the registration of different kinds of dynamic designs.

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<sup>26</sup> See IPOS Practice Direction Number 4 of 2014, available online at <https://www.ipos.gov.sg/Portals/0/Practice%20Direction%20No%20%204%20of%202014%20-%20GUIs.pdf>