

Intellectual Property Office of Singapore  
Registry of Trade Marks

Circular No. 5/2021: Introduction of Amendments to Subsidiary Legislation and Electronic Filing and Service of Documents

## **Introduction of Amendments to the Trade Marks Subsidiary Legislation and Electronic Filing and Service of Documents**

(Circular No. 5/2021, dated 10 September 2021)

### **Amendments to the Trade Marks Subsidiary Legislation**

1. Amendments will be made to the Trade Marks Rules (“TM Rules”) and Trade Marks (International Registration) Rules (“TM(IR) Rules”) to:
  - (a) Enhance dispute resolution processes, and
  - (b) Streamline trade marks operational processes.
2. These amendments will take effect on 1 October 2021. A summary of the key amendments is provided below.

### **Enhancements to Dispute Resolution Processes**

#### **(a) Registrar May Shorten Evidential Deadlines**

3. Currently, the Registrar specifies the periods within which parties’ evidence may be filed. A new Rule 31(1A) will be introduced in the TM Rules to empower the Registrar to shorten these evidential deadlines after giving parties an opportunity to be heard. This power will typically be applied when parties who were previously exploring settlement are no longer doing so, and should therefore be able to file evidence within a shorter time.

#### **(b) Registrar May Consolidate Proceedings on Own Accord**

4. A new Rule 81C will be introduced in the TM Rules to empower the Registrar to consolidate proceedings on her own accord after giving parties an opportunity to be heard. This is intended to facilitate the expeditious and economical disposal of proceedings.

#### **(c) Removal of Form and Fee for Registrar’s Certificate of Taxation**

5. Rule 76 of the TM Rules is amended to allow the Registrar to issue a Certificate of Taxation when a bill of costs has been taxed, without the need for the party, to whom costs are awarded, to file Form HC2 and the relevant fee. This streamlines the process and reduces taxation-related costs for the party.

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## Streamlined Operational Processes

### (a) Clarification on Fees for Form TM4

6. Items 1 and 1A of the First Schedule of the TM Rules are amended to clarify that the fees for Form TM4 (“Application to register a trade mark, collective mark or certification mark”) remains the same regardless of the filing mode (e.g., via IP<sup>2</sup>SG,<sup>1</sup> or FormSG during IP<sup>2</sup>SG unavailability).

### (b) Removal of Mandatory Provision of Translation and/or Transliteration

7. Rule 20 of the TM Rules is amended to remove the mandatory requirement to provide a translation and/or transliteration for foreign characters in a trade mark. However, the Registrar may still require a translation and/or transliteration to be provided, such as in cases where the foreign characters cannot be identified. This amendment follows from the Registry’s easing of translation and/or transliteration requirements, which was highlighted in [Trade Marks Circular No. 04 of 2019](#).

### (c) Clarification of Period that a Holder of an International Registration Designating Singapore is Not Entitled to Damages, Account of Profits or Statutory Damages

8. Rule 8(5) of the TM(IR) Rules is amended to clarify the period where a person is not entitled to damages, an account of profits or statutory damages in respect of any infringement of the International Registration designating Singapore (IR) when a person becomes the holder of an IR (or protected IR) by virtue of a notifiable transaction made under that Rule.
9. This amendment serves to align Rule 8(5) of the TM(IR) Rules with section 39(4) of the Trade Marks Act.
10. The full list of amendments made to the TM Rules and TM(IR) Rules can be accessed [here](#).

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<sup>1</sup> IP<sup>2</sup>SG is IPOS’s one-stop e-filing portal for businesses to transact and communicate with IPOS. IP<sup>2</sup>SG also allows businesses to manage their filings and registrations in one convenient location. Customers with a valid Singpass ID and an authorised Singapore mailing address can easily create an IP<sup>2</sup>SG account to begin transacting on IP<sup>2</sup>SG. Foreign-based corporate entities who wish to create a Corppass account may refer to the Corppass website ([www.corppass.gov.sg](http://www.corppass.gov.sg)) for more details.

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## Electronic Filing and Service of Documents

11. The COVID-19 pandemic has accelerated the digitalisation of operations for businesses and IP Offices worldwide. In tandem with the legislative amendments to the TM Rules and TM(IR) Rules, IPOS will shift towards greater digitalisation of our filing and communications procedures to provide better convenience to our customers.
12. The default mode of filing and/or service of documents on the Registrar for transactions relating to Patents, Trade Marks, and Registered Designs is through our electronic online system, IP<sup>2</sup>SG. Timing with the implementation of the above new changes, IPOS will no longer accept the filing and/or service of documents via alternative filing modes such as FormSG if these actions can be done via IP<sup>2</sup>SG. However, forms or requests which are unavailable on IP<sup>2</sup>SG may still be submitted via FormSG.
13. To update on this new practice, two new Practice Directions, [IP<sup>2</sup>SG Practice Direction \(No. 1 of 2021\)](#) and [Registries Practice Direction \(No. 1 of 2021\)](#) have been published and will take effect on 1 October 2021.
14. If you have any enquiries on this Circular, please email us at [ipos\\_enquiry@ipos.gov.sg](mailto:ipos_enquiry@ipos.gov.sg).

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