

## **PRIORITY CLAIMS**

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## PRIORITY CLAIMS

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## **1. INTRODUCTION**

This chapter is concerned with the claim of priority in trade mark applications.

## **2. RELEVANT LEGISLATION**

### **Trade Marks Act [Cap. 332, 2005 Rev. Ed.]**

#### **Interpretation**

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

“Convention country” means —

(a) in section 10 and paragraph 13 of the Third Schedule, a country or territory, other than Singapore, which is —

(i) a party to the Paris Convention; or

(ii) a member of the World Trade Organisation; and

(b) in any other provision of this Act, a country or territory which is —

(i) a party to the Paris Convention; or

(ii) a member of the World Trade Organisation;

“earlier trade mark” means —

(a) a registered trade mark or an international trade mark (Singapore), the application for registration of which was made earlier than the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks; or

(b) a trade mark which, at the date of application for registration of the trade mark in question or (where appropriate) of the priority claimed in respect of the application, was a well known trade mark,

and includes a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of paragraph (a) subject to its being so registered;

“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;

“WTO Agreement” means the World Trade Organisation Agreement signed in Marrakesh in 1994 as revised or amended from time to time.

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

**10.** — (1) Subject to subsection (6), where —

(a) a person has filed an application for the registration of a trade mark in a Convention country in respect of certain goods or services;

(b) that application is the first application for the registration of the trade mark to be filed in any Convention country in respect of those goods or services (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 trade mark in respect of all or any of those goods or services,

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 trade mark in respect of all or any of the goods or services for which registration was sought in the first Convention application.

(2) Where any person claims the right of priority referred to in subsection (1), the person shall have priority from (and including) the date on which the first Convention application was filed.

(3) Where the right of priority referred to in subsection (1) is claimed in respect of a trade mark, the registrability of the trade mark shall not be affected by any use of the trade mark in Singapore in the period between —

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

(4) Any filing 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.

(5) For the purposes of subsection (4), “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 subsequent fate of the application.

(6) Where a subsequent application 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.

(7) For the avoidance of doubt, where subsection (6) 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.

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

(9) A right of 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.

### **Claim to priority from other relevant overseas application**

**11.** — (1) The Minister may, by order, confer on a person who has filed an application for the registration of a trade mark in a country or territory to which the Government has entered into a treaty, convention, arrangement or engagement for the reciprocal protection of trade marks, a right to priority, for the purpose of registering the same trade mark under this Act for some or all of the same goods or services, 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 10 or such other provision as appears to the Minister to be appropriate.

### **Revocation of acceptance**

**16.**—(1) Notwithstanding section 15(1), if, before a trade mark is registered, the Registrar is satisfied —

- (a) that the application for registration of the trade mark was accepted because of an error or omission in the course of the examination; or
- (b) that, in the special circumstances of the case, the trade mark should not be registered, the Registrar may revoke the acceptance of the application.

(2) If the Registrar revokes the acceptance —

- (a) the application is taken to have never been accepted; and
- (b) section 12 again applies in relation to the application.

### **Trade Marks Rules**

#### **Claim to priority**

**18.** — (1) Where a right of priority is claimed by reason of an application for the registration of a trade mark filed in a Convention country under section 10 of the Act or in another country or territory in respect of which provision corresponding to that set out in section 10 of the Act is made under section 11 of the Act (referred to in this rule as the priority application), particulars of that claim shall be included in the application form at the time of filing the application form.

(2) The particulars referred to in paragraph (1) are —

(a) the country or territory in which —

- (i) the priority application; or
- (ii) where there is more than one priority application, each priority application, was filed;

(b) the date on which —

- (i) the priority application; or
- (ii) where there is more than one priority application, each priority application, was filed;

(c) where the right of priority is claimed in respect of one or more, but not all, of the goods or services for which registration was sought in the priority application, the goods or services in respect of which the right of priority is claimed; and

(d) where the right of priority is claimed through more than one priority application, the goods or services in respect of which the right of priority is claimed through each priority application.

(3) The Registrar may at any time require the applicant to file a certificate by the registering or other competent authority of the country or territory concerned certifying or verifying to the satisfaction of the Registrar —

- (a) the date of filing of the priority application;
- (b) the country or territory, or the registering or competent authority;
- (c) the representation of the mark; and
- (d) the goods and services covered by the priority application.

(4) Where the certificate referred to in paragraph (3) is not in the English language, there shall be annexed to the certificate a translation in English of the contents of the certificate, certified or verified to the satisfaction of the Registrar.

## **Trade Marks (International Registration) Rules**

### **Priority**

**10.** — (1) Subject to paragraph (2), the provisions of section 10 of the Act shall apply so as to confer a right of priority in relation to protection of an international registration designating Singapore, as they apply in relation to registering a trade mark under the Act.

(2) The manner of claiming priority shall be determined in accordance with the Madrid Protocol and the Common Regulations.

### 3. CLAIM OF PRIORITY

#### 3.1 Convention countries

A Convention country is a foreign country or region of a kind prescribed under Section 2 of the Trade Marks Act (the “**Act**”). A Convention country is defined as:

- a. A party to the Paris Convention; or
- b. A member of the World Trade Organisation (WTO).

A list of the contracting parties to the Paris Convention and members of the WTO may be viewed at the websites of the World Intellectual Property Office (WIPO) and the WTO respectively.

#### 3.2 Eligibility & Effect

An earlier application made in a Convention country (also known as a “**priority application**”) may be eligible for a claim of priority in a Singapore trade mark application. This Singapore trade mark application, in the context of claiming priority, is referred to in this document as a “**Singapore application**”. For a claim for priority in a Singapore application to succeed, the following factors must be satisfied –

- (a) The Singapore application must be made by the applicant of the priority application or its successor in title;
- (b) The Singapore application must be for the same trade mark as that of the priority application;
- (c) The Singapore application must have at least one corresponding good or service covered by the priority application; and
- (d) The Singapore application must be filed within six months after the day on which the priority application was first made in the Convention country.

An elaboration of each of the factors is set out further below. Singapore applications which are successful in claiming priority will have their rights dated back to the filing date of the priority application (“**priority date**”).

For the purposes of renewal, the registration will expire 10 years from the date of application in Singapore instead of from the priority date.

##### 3.2.1 Applicant

Priority can be claimed only by the applicant of the priority application or its successor in title. In the latter case, a transfer must have taken place prior to the filing date of the Singapore application.

Subsidiary or associated companies of the applicant are not considered to be the same entity as the applicant and are not eligible to file for a priority claim in their own names.

A change of the applicant's name between the filing of the priority application and the filing of the Singapore application does not impact on the eligibility of the applicant to file for the Singapore application.

### 3.2.2 Representation of the mark

The Singapore application must be for the same trade mark as that of the priority application.

#### Example 1: Priority claim with respect to representation of mark

	Priority Application	Singapore Application
Mark	 (Application for a series of two marks)	

Elaboration of Example 1: The priority claim is acceptable as the mark applied for in the Singapore application is one of the marks in the series represented in the priority application.

### 3.2.3 Specification of goods and/or services

There must be at least one corresponding good or service covered by both the priority application and the Singapore application. The priority claim will only apply to goods and/or services contained in the Singapore application which are common to both the priority application and the Singapore application.

#### Example 2: Priority claim with respect to all the goods and/or services

	Priority Application	Singapore Application
Goods and/or services	Coffee, tea, cocoa and artificial coffee; bread, pastry and confectionery; edible ices; sugar, honey, treacle.	Coffee, tea, cocoa and artificial coffee.

Elaboration of Example 2: The priority claim is acceptable as the specification of goods in the Singapore application is wholly within the scope of the specification applied for in the priority application.

**Example 3: Priority claim with respect to some of the goods and/or services**

	Priority Application	Singapore Application
Goods and/or services	T-shirt and shorts.	T-shirt, shorts and shoes.

Elaboration of Example 3: The priority claim for the Singapore application applies only to “T-shirt and shorts” and does not include the item "shoes" as it is not within the scope of the specification applied for in the priority application.

*Priority claim of goods and/or services in different classes*

Priority claim for goods and/or services that have been classified in different classes in the priority application and the Singapore application is acceptable as long as the goods and/or services claimed in the Singapore application are also claimed in the priority application. The goods and/or services of the priority application may fall in a different class number from the Singapore application due to the change in edition and/or version of the Nice Classification or the difference in classification practices among the intellectual property offices worldwide.

**Example 4: Priority claim with respect to the same goods and/or services in different classes**

	Priority Application	Singapore Application
Filing Date	15 December 2011	9 February 2012
Class Number	9	7
Goods and/or services	Vending machines.	Vending machines.

Elaboration of Example 4: The priority claim is acceptable even though the class number is different as the specification of goods in the Singapore application is also claimed in the specification applied for in the priority application.

**3.2.4 Timing of the Singapore application**

A Singapore application should be filed within six months after the day on which the priority application was made in the Convention country.

When calculating the six-month period, the day on which the priority application was made in the Convention country is not included in the calculation. For example, if the priority application was filed in a Convention country on 1 January 2015, the Singapore application must be filed by 1 July 2015. If the last day for claiming priority falls on an official holiday, or an “excluded day” declared by the Registrar, the deadline is extended until the next working day.

**Example 5: Calculation of the six-month period for priority claim**

	Priority Application	Singapore Application
Filing Date	14 January 2015	≤ 14 July 2015
Goods and/or Services	Clothing; headgear; footwear.	Clothing; headgear; footwear.

Elaboration of Example 5: The priority application was made on 14 January 2015. Therefore, the Singapore Application must be filed on or before 14 July 2015 for it to be able to claim priority for the goods “Clothing; headgear; footwear”.

**3.3 Partial priority claim**

Partial priority claim refers to the claim of priority made in respect of only part of the Singapore application.

**Example 6: Partial priority claim with respect to representation of marks**

	Priority Application	Singapore Application
Mark		  (Application for a series of two marks)

Elaboration of Example 6: The priority claim for the first (top) mark in the series of the Singapore application is acceptable.

**Example 7: Partial priority claim with respect to goods and/or services**

	Priority Application	Singapore Application
Goods and/or services	Computer hardware; computer software.	Computers; computer hardware; computer peripheral devices; computer software; magnetic data carriers.

Elaboration of Example 7: The priority claim for “computer hardware and computer software” of the Singapore application is acceptable.

### **3.4 Multiple priority claims**

A situation of multiple priority claims refers to more than one priority claim made with respect to the Singapore application.

#### *Principle of first filing*

In making multiple priority claims, it should be noted that the priority applications must follow the principle of first filing. If more than one priority application for the trade mark has been filed in respect of particular goods and/or services in the various Convention countries, the Singapore application must be filed within six months after the day on which the earliest of the priority applications was made. This is to prevent the cascading of priority rights, and is known as the principle of first filing.

#### **Example 8: Principle of first filing in multiple priority claims**

	Priority Application 1	Priority Application 2	Singapore Application
Filing Date	31 January 2013	1 July 2014	22 August 2014
Goods and/or services	Toys.	Toys.	Toys.
Convention Country	Thailand	Malaysia	(not applicable)

Elaboration of Example 8: The Singapore application cannot make a claim for priority. This is because the first filing made in a Convention country was Priority Application 1 in Thailand on 31 January 2013, and the Singapore application was filed more than 6 months from the date of Priority Application 1. The Singapore application cannot claim priority from Priority Application 2 filed in Malaysia even though the Singapore application was made within 6 months from Priority Application 2, as Priority Application 2 is not the first priority application made in a Convention country.

The examples below are illustrative of multiple priority claims:

**Example 9: Multiple priority claims with respect to representation of mark**

	Priority Application 1	Priority Application 2	Singapore Application
Mark	<b>ABC</b>	<b>ABC</b>	<b>ABC</b>  <b>ABC</b>  (Application for a series of two marks)
Filing date	2 January 2015	2 March 2015	1 April 2015

Elaboration of Example 9: The marks in Priority Application 1 and 2 form the series of two marks applied for in the Singapore application. The priority claims for the priority applications are acceptable, with the priority date of 2 January 2015 for the first (top) mark in the series and 2 March 2015 for the second (bottom) mark in the series of the Singapore application.

**Example 10: Multiple priority claims with respect to goods and/or services**

	Priority Application 1	Priority Application 2	Singapore Application
Goods and/or services	Services for providing food and drink.	Temporary accommodation.	Services for providing food and drink; temporary accommodation.
Filing date	2 January 2015	2 March 2015	1 April 2015

Elaboration of Example 10: The priority claims for the Singapore application based on Priority Application 1 and Priority Application 2 are acceptable, with the priority dates of 2 January 2015 for "services for providing food and drink" and 2 March 2015 for "temporary accommodation".

#### **4. MAKING A CLAIM FOR PRIORITY**

To claim a right of priority, an applicant must file notice of the priority claim on Form TM4 at **the point of application**. Under Rule 18 of the Trade Mark Rules (the “**Rules**”), the notice must include the following details:

- a. the Convention country in which the earlier application was filed;
- b. the date on which the earlier application was filed, and
- c. the goods and/or services in respect of which the right of priority is claimed.

If priority is claimed on the basis of more than one earlier application, the notice of the claim for priority must contain the above details for each of the earlier applications.

## 5. EXAMINING PRIORITY CLAIM

### 5.1 Documentation

Documentation regarding the priority application claimed is generally **not** required. However, under Rule 18(3) of the Rules, the Registrar may request for documentation certifying the validity of the priority claim during the examination of the application.

### 5.2 Conflicting marks

When conducting a similar mark search for the current Singapore application during the examination stage, a later filed application with a priority date which is earlier than the filing date of the current application being examined, and which is considered to be identical or confusingly similar to the current application, will be cited against the current application by virtue of the definition of “earlier trade mark” under Section 2 of the Act. Please refer to the Trade Marks Work Manual’s section on Relative Grounds for Refusal of Registration for more information.

#### **Example 11: Citation concerning conflicting mark with priority claim**

	Singapore Application 1	Singapore Application 2
Mark	<b>ABC</b>	<b>ABC</b>
Filing date	2 January 2015	26 February 2015
Priority date	(no priority claim)	1 December 2014

Elaboration of Example 11: Although Singapore Application 2 has a later filing date of 26 February 2015 as compared to the filing date of 2 January 2015 of Singapore Application 1, Singapore Application 1 will not be cited against Singapore Application 2. This is because the priority date of 1 December 2014 in Singapore Application 2 is earlier than the filing date of 2 January 2015 in Singapore Application 1. Hence Singapore Application 2 is an earlier trade mark and will be cited against Singapore Application 1.

In the event that the mark to be cited has already been published but has not proceeded to registration, the Registrar will revoke the acceptance of the mark under Section 16 of the Act.

#### *Marks with the same priority/filing date*

When there are two identical or confusingly similar marks with the same filing or priority date, the Registrar will not raise relative grounds objection by citing the other application. The Registrar will separately inform both parties of the existence of the other mark and it will

be up to the two parties to decide if they wish to carry out opposition proceedings against each other.

### **5.3 Priority claim in more than one countries with the same date and scope**

When priority is claimed in two or more countries with the same priority date and scope, the Registrar will allow such claims and not request for the deletion of any priority claim country.

#### **Example 12: Multiple priority claims with the same priority date and scope**

	Priority Application 1	Priority Application 2	Singapore Application
Filing date	2 January 2015	2 January 2015	1 April 2015
Goods and/or services	Printed matter.	Printed matter.	Printed matter.
Convention country	Malaysia	Thailand	(not applicable)

Elaboration of Example 12: The Singapore application is filed within six months of the same priority date of 2 January 2015 for both Priority Application 1 and 2. Hence both priority claims will be endorsed in the Singapore application.

### **5.4 Priority claim date is the same date as filing date**

When the priority date claimed is the same as the filing date of the Singapore application, the Registrar will allow such claim(s) in the application. However, the rights conferred to the Singapore application is not affected by the priority claim since the priority date is the same as the filing date.