



## PCT National Phase Change from 1<sup>st</sup> August 2006 in Singapore

With effect from 1<sup>st</sup> August 2006, an International (PCT) Patent application entering the national phase in Singapore, which has an international filing date on or after 1<sup>st</sup> July 2004, has the option to switch from the default fast track for search and examination to the slow track **without incurring any official fees from extension of time fees**. Previously, patent applicant's entering the Singapore national phase incurred official fees of S\$1,800 (about US\$1,150) when requesting a block extension to switch from the default fast track to the slow track.

The high official fees for the block extension were a significant hindrance to Singapore patent applicants electing to take advantage of the delayed search and examination options available under the slow track route. Recognising the disadvantage to Singapore patent applicants, the Intellectual Property Office of Singapore (IPOS) elected to dispense with the official fees for the block extension of Singapore national phase PCT applications.

Continue >>

## Malaysia accedes to the PCT

Malaysia became the 131<sup>st</sup> contracting state of the Patent Cooperation Treaty (PCT) when its instrument of accession was deposited at WIPO on 16<sup>th</sup> May 2006.

Malaysia may be designated as a state in any International (PCT) Patent application filed on or after 16<sup>th</sup> August 2006. As such, applicants should keep in mind the option of national phase entry in Malaysia in due course.

Nationals and residents of Malaysia can file International applications with the Intellectual Property Corporation of Malaysia (MyIPO), with delayed payment for a month as the official fees are yet to be published by MyIPO.

Should you wish to know more about how we can assist you with your International applications in Malaysia, please contact us at [malaysia@ecsf-asia.com](mailto:malaysia@ecsf-asia.com)

## contents

PCT National Phase Change from 1st August 2006 in Singapore .....	01
Malaysia accedes to the PCT .....	01
Opposition against "jWEST" by owners of "JEFFERY-WEST" succeeds at first instance ..	03
First sound mark in Singapore .....	04
Events .....	04



## << Continued from PCT National Phase Change from 1<sup>st</sup> August 2006 in Singapore

### Current search and examination procedures

There are two routes of examination, namely the default fast track route and the optional slow track route. The options under the slow track are essentially the same as that under the fast track except that the deadlines are extended by 18 months in the slow track route. Hence, the options and relevant deadlines under the fast track and slow track routes are:

- Option 1: Request local search and examination: 21 months from the priority date under the fast track route or 39 months from the priority date under the slow track route.
- Option 2: Request examination based on either the International Search Report (ISR) or search reports of corresponding applications: 21 months from the priority date under the fast track route or 39 months from the priority date under the slow track route.
- Option 3: Rely on the International Preliminary Report on Patentability (IPRP) (Chapter I/II) or furnish prescribed information relating to corresponding applications: 42 months from the priority date under the fast track route or 60 months from the priority date under the slow track route.

The prescribed information refers to details of the final search and examination results or grant details of a corresponding application. For this purpose, a corresponding application is an international (PCT) application or an application filed in the patent offices of: Australia, Canada (in relation to Canadian applications filed in the English language only), Japan, New Zealand, the United Kingdom, the United States, and the European Patent Office (in relation to European applications filed in the English language only). For national phase entry applications with a priority date on or after 2<sup>nd</sup> June 2006, a corresponding Korean application is also regarded as a corresponding application for the purpose of option 2.

### Requirement for examined claims

For Singapore national phase entry applications with an international filing date on or after 1<sup>st</sup> July 2004, IPOS can refuse grant if any claim to be granted is not related to at least one examined claim in the examination

report issued by IPOS, the IPRP, the final examination report on the corresponding application or the granted patent being relied on to support grant. A claim is considered to be “related” to an examined claim if the two are the same or every limitation in the examined claim is in the claim to be granted.

### Meeting the Requirement for examined claims

With the above in mind, if there are unsearched and/or unexamined claims in the IPRP, the final examination report on the corresponding application or the granted patent being relied on to support grant, Option 3 is not an appropriate choice because the Singapore patent includes unexamined claims. The appropriate choice is to request “local” examination.

As mentioned above, in the default fast track local examination can proceed under Option 1 or 2 by 21 months from the priority date. As most International (PCT) applications enter the national phase just before the 30-month national phase entry deadline from the priority date, most Singapore national phase entry applications would have already missed this 21-month deadline. For such applications, the requirement for examined claims can only be met by invoking the slow track.

The change from 1<sup>st</sup> August 2006, removing the requirement of an official fee of S\$1,800 (about US\$1,150) for switching to the slow track is indeed good news for Singapore national phase patent applicants who wish to elect local examination in Singapore.



	<p>Kristian Robinson krobinson@ecsf-asia.com</p>	
	<p>Phee Lay Kuan lkphee@ecsf-asia.com</p>	



# Opposition against "jWEST" by owners of "JEFFERY-WEST" succeeds at first instance

Mark Richard Jeffery and Guy Anthony (the opponents), owners of the registered mark "JEFFERY-WEST" in Class 25, brought an application against Nautical Concept Pte Ltd (the applicant) who applied to register "jWEST" as a trade mark in Class 25 for similar goods, i.e. shoes/footwear.

The mark "jWEST" was opposed on various grounds. Below is a summary of the successful grounds of opposition, the parties' relevant arguments and evidence submitted as well as the findings of the Principal Assistant Registrar (Registrar).

## Bad faith

One of the main grounds for opposing the mark "jWEST" was bad faith. This stemmed from the fact that the applicant had past dealings with the opponents by virtue of having sold and/or distributed the opponents' shoes in Singapore. The opponents felt that the applicant had "copied the essential or prominent features of their mark". The applicant, on the other hand, argued that the mark "jWEST" was invented on the basis of its purported significance in relation to, among other things, the faith, family, a friend, business aspiration and place of residence of its Managing Director (who had also set up the applicant company).

The applicant further argued that it had applied to register the mark "jWEST" after discovering that the opponents had not filed for the mark "JW" or "JEFFERY-WEST" in Singapore. The applicant claimed that it thought the opponents were no longer in business. This argument was rejected by the Registrar who explained that all the applicant had to do was make a call or send an email to the opponents confirming whether they had indeed gone out of business and to seek their consent to use the mark "jWEST" in Singapore.

In deciding whether there was bad faith, the Registrar applied the test of "the honest reasonable man". She felt that an honest reasonable man would have asked for the opponents' consent to use the mark "jWEST", which would have shown that the applicant acted in good faith. The applicant's argument that the marks are not confusingly similar, and hence there can be no misappropriation of the mark, did not carry much weight with the Registrar having regard to the past dealings between the parties and the applicant's knowledge of the opponents' mark.

The Registrar also rejected the applicant's various explanations on the derivation of the mark "jWEST" and the reasons given for not having applied to register the mark much earlier than the opponents when it could have done so, especially since the mark "jWEST" meant so much to its managing director.

## Confusing similarity of the marks

The opponents argued that the respective marks "JEFFERY-WEST" and "jWEST" (the latter appearing to be an abbreviation of the former) were confusingly similar. Further, the goods claimed in both applications were very similar, namely, shoes/footwear. In its defence, the applicant claimed that as it was selling only women's shoes, unlike the opponents, who were selling only men's shoes (a claim which was denied by the opponents), there was unlikely to be confusion in the marketplace.

Nonetheless, the Registrar's overall assessment was that the marks were visually, phonetically and conceptually more similar than dissimilar and it did not matter that the parties were selling shoes to different markets as both of their applications covered men's and women's footwear. Taking into account the Singaporean customer and the fact that the marks and goods were similar, the Registrar concluded that, if the opposed mark did proceed to registration, the relevant shoe consumers would likely be confused.



## Conclusion

The Registrar decided that there was sufficient evidence to convince her that the applicant's application was made in bad faith. She also decided that the respective marks and goods were of the requisite confusing similarity to be likely to cause confusion on the part of the public if the applicant's mark was allowed to proceed to registration. Consequently, the opponent's opposition succeeded before the Registrar.

Subsequent to these proceedings, the applicant appealed to the High Court against the Registrar's decision. At the time of writing of this article, the appeal hearing had concluded and we await the High Court's decision for an update on this case.

	<p>Kevin Wong kvwong@ecsf-asia.com</p>	
<p>Kiran Dharsan kdharsan@ecsf-asia.com</p>		



events

FRANCHISING & LICENSING ASIA 2006  
31 October - 02 November 2006

Ella Cheong Spruson & Ferguson exhibited again at Franchising & Licensing Asia.



Licensing Conference  
Intellectual Property Protection in South-East Asia  
by Soh Kar Liang

NUS' TECHNOLOGY COMMERCIALISATION FORUM (TCF) 2006

in conjunction with Global Entrepolis 2006  
31 October - 01 November 2006

Ella Cheong Spruson & Ferguson was the only platinum sponsor of NUS' TCF 2006.



Building, Managing And Commercialising Your Strategic Intellectual Property Portfolio  
by Rob McInnes

First sound mark in Singapore

The Intellectual Property Office of Singapore granted its first sound mark registration to the mobile phone giant, Nokia, for its distinctive "Nokia Tune" ring tone.

Singapore's first registered sound mark arose from amendments to the Trade Marks Act that came into force on 1<sup>st</sup> July 2004. The Trade Marks (Amendment) Act 2004 removed the requirement that a trade mark must be visually perceptible to be registrable, thus allowing IP owners to register non-conventional marks that are capable of being represented graphically.

To graphically represent a sound mark, the sound must be depicted by way of musical notation. If required, the Examiner may request for a recording of the sound during the course of examination.



This registration reflects Singapore's proactive approach towards recognition and protection of the non-conventional trade marks of IP owners.



Kevin Wong  
kvwong@ecsf-asia.com



Kiran Dharsan  
kdharsan@ecsf-asia.com

★ ELLA CHEONG SPRUSON & FERGUSON (SINGAPORE)

152 Beach Road #30-00 Gateway East Singapore 189721  
Tel: +65 6333 7200 Fax: +65 6333 7222 Email: mail@ecsf-asia.com Website: www.ecsf-asia.com  
Contact person: Ella Cheong / Soh Kar Liang

★ ELLA CHEONG SPRUSON & FERGUSON (M) SDN BHD

#06-03 Wisma Bandar No. 18 Jalan Tuanku Abdul Rahman 50100 Kuala Lumpur Malaysia  
Tel: +65 6333 7200 Fax: +65 6333 7222 Tel: +60 3 2697 1668 Fax: +60 3 2697 2668  
Email: malaysia@ecsf-asia.com Website: www.ecsf-asia.com  
Contact person: David Griffith / Alex Tan

Associated Offices

◆ ELLA CHEONG (HK) and ELLA CHEONG LAW

3701 Central Plaza 18 Harbour Road Hong Kong/3701A Central Plaza 18 Harbour Road Hong Kong  
Tel: +852 2810 0558 Fax: +852 2810 0933 Email: mail@ellacheong.com Website: www.ellacheong.com  
Tel: +852 2810 7400 Fax: +852 2810 7411 Email: ellacheong@ellacheonglaw.com  
Contact person: Ella Cheong

◆ SPRUSON & FERGUSON

Level 35, St. Martins Tower 31 Market Street Sydney, NSW 2000 Australia  
Tel: +61 2 9393 0100 Fax: +61 2 9261 5486 Email: mail@sprusons.com.au Website: www.sprusons.com.au  
Contact person: David Griffith

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