



## Amendments to the Singapore Patents Act as of 1<sup>st</sup> April 2007

In line with changes made to the Patents Co-operation Treaty (PCT) as of 1<sup>st</sup> April 2007, the Singapore Patents Act and Rules have been amended. The amendments make it possible, for patent applications filed on or after 1<sup>st</sup> April 2007 in Singapore, to extend the convention deadline up to two months and correct a missing part of a patent specification, without losing the priority date, subject to filing relevant documents before specific time period.

The Intellectual Property Office of Singapore has proactively amended the Patents Act and Rules so that they are in concurrence for both local applications filed on or after 1<sup>st</sup> April 2007 and PCT applications having an international filing date on or after 1<sup>st</sup> April 2007.

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**Extension of convention deadline**

It is possible to extend the convention deadline up to two months from the original 12 months deadline [New Section 17(2A) to 17(2D) and New Rule (9)]. To seek an extension of the convention deadline, the applicant must file the following within 14 months from the declared priority date:

- a request to the Registrar in a prescribed form, and
- a prescribed fee.

The applicant must indicate in the request whether failure to file the application within 12 months:

- occurred in spite of due care required by the circumstances having been taken; or
- was unintentional.

In order to make the above request:

- the applicant should not have requested for early publication of the application, or
- the applicant has withdrawn such a request.

The above extension is, however, at the discretion of the Registrar and it is up to the applicant to convince the Registrar before getting an allowance.

The amendments have made it possible to file a convention application within 14 months from the earliest priority date.

Also, it is possible to add or correct a priority claim of an application filed in Singapore to an earlier application within 14 months from the Singapore filing date, provided that a request to add or correct the priority claim is made within 16 months from the earliest priority date.

**Rectification of missing part of a specification**

As of 1<sup>st</sup> April 2007, any missing part of a specification

can be rectified by submitting the relevant missing part of the specification [New Act S26(8)&(9) and New Rule 26(A)] after filing but before payment of grant fee.

Typically, the date of filing the application shall be the actual date on which the missing part of the specification is filed with the Registry. However, under the new law, it is possible to bring back the date of filing the missing part to the earlier filing date of the application if the applicant had declared a priority date on the date of filing, and within 3 months of filing the application in Singapore, the applicant files:

- a request to the Registrar in a prescribed form indicating that the missing part is incorporated in the application by reference to, and is completely contained in, the earlier application as filed [New Act S26(9)(a)–(b); New Rule 26A(1)(a)],
- prescribed information, and
- prescribed documents.

The “prescribed information” indicated above shall be:

- The date of filing the earlier application;
- The application or file number of the earlier application; and
- The country of filing the earlier application.

The “prescribed documents” indicated above include:

- a certified copy of the earlier application or a copy of the earlier application otherwise acceptable by the Registrar, and
- an English translation of the priority document, where applicable.

As a result of the above changes to the Acts and Rules, as of 1<sup>st</sup> April 2007, it is possible to overcome problems caused by errors ending up in a missed convention deadline or a missing part of a specification.

The above changes benefit not only foreign clients filing a PCT national phase application through the corresponding changes of the PCT regime, but also benefits local clients in alleviating problems associated with filing a PCT international application or a convention application in Singapore claiming priority from an earlier Singapore application.



Dr. Michael Koch  
mkoch@ecsf-asia.com



R N Gnanapragasam  
rnsam@ecsf-asia.com



## Singapore Trade Marks (Amendment) Act 2007

The Trade Marks (Amendment) Act 2007 (“TMA”) was passed on 22<sup>nd</sup> January 2007. The TMA, Trade Marks (Amendment) Rules 2007 (“TMR”) and Trade Marks (International Registration) (Amendment) Rules 2007 took effect on 2<sup>nd</sup> July 2007. Highlights of the amendments are summarised below.

### Multiple Class Registration

Most significantly, a trade mark owner may file a single trade mark application for a mark in respect of two or more goods or service classes, with a view to securing a single registration. Consequently, the mark owner need only renew that single registration in order for the renewal to be effective for all the classes of goods and services registered. These amendments facilitate trade mark administration and management as there will be a consolidated official examination letter (if any) issued, giving one deadline, and only one trade mark number to renew.

The official fees for filing an application remain chargeable on a per class basis, as is the current practice. However, ancillary applications such as the updating of address for service, recordal of assignment/merger and recordal of licence are chargeable on a per application/registration basis.

### Division of Application for Registration

This amendment complements the system of multiple class registration, by allowing an application for registration of a mark to be divided (for a fee) into two or more separate applications. The original application need not be a multiple class application before it may be divided. However, an International Registration designating Singapore cannot be divided and only national applications made on or after 2<sup>nd</sup> July 2007 may be divided.

A divided application shall have the same filing date as the original application. Any priority that was claimed in the original application will also apply to

the divided application claiming the applicable goods/services. A divisional serial number will be assigned to the new additional application.

The division of an application is particularly useful where there are objections raised by an examiner in respect of some classes or where there is an opposition in respect of some classes. By isolating the problematic classes in this manner, the registration of the other classes which are not facing any objections or oppositions will not be held back and may then be able to proceed to registration expeditiously.

### Licences related to pending marks

The amendments also allow for the recordal of licences relating to pending marks. Previously, only licences relating to registered marks could be recorded on the register. A transitional provision in this regard permits the recordal of a licence for pending applications filed before 2<sup>nd</sup> July 2007, provided the recordal application is made on or after this date.

### Relief Measures for Procedural Oversight

The TMA further provides for relief measures to alleviate the effects of missed deadlines. The relief measures enable applicants to maintain (for a fee) their rights in applications, even when time limits to act have been overlooked.

Applicants who have missed a time limit for action before the Registry, may (subject to certain exceptions) have their rights reinstated if the following conditions are met:-

- the reinstatement application is filed within 6 months from the date of expiration of the time limit;
- the omitted act is completed together with the application; and
- the failure to comply with the time limit is unintentional.

It should be noted that such reinstatement is only applicable to time limits prescribed/specified by the Registrar on or after 2<sup>nd</sup> July 2007. In addition, it does

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## << Continued from Singapore Trade Marks (Amendment) Act 2007

not apply to certain types of deadlines, such as those:-

- to claim priority
- in opposition revocation or invalidation proceedings
- in rectification proceedings commenced by persons other than the proprietor of the mark
- to pay renewal fees

Further, the Registrar may refuse a reinstatement application if there is a good and sufficient reason to do so, such as in the case where an up-to-date search reveals that a conflicting mark had been filed during the period when the mark of the applicant for reinstatement was treated as withdrawn.

### Singapore Treaty on the Law of Trademarks

The latest amendments as highlighted above give effect to the Singapore Treaty on the Law of Trade marks (“Singapore Treaty”), which was adopted by the Diplomatic Conference for the Adoption of a Revised

Trade mark Law Treaty that took place in Singapore in March 2006. The Singapore Treaty is aimed at creating a dynamic and modernised international framework for the harmonisation of administrative trade mark registration procedures. It is not in force yet but will take effect three months after ten member States of the World Intellectual Property Organisation (WIPO) or qualifying intergovernmental organisations having a regional trade marks office have deposited their instruments of ratification or accession.

The Singapore Treaty represents yet another progressive step in the evolution of Singapore’s IP regime. Further developments upon its coming into force are awaited.



Kevin Wong  
kjwong@ecsf-asia.com



Angeline Raj  
araj@ecsf-asia.com

## Changes to Deferment of Grant in Malaysia

With the accession of Malaysia as a contracting member of the Patent Cooperation Treaty (PCT) on 15<sup>th</sup> May 2006, Regulation 27B of Malaysian Patents Act concerning deferment of a request for Substantive Examination or Modified Examination has been amended.

In particular, an applicant’s option to request for a deferment has been extended to 5 years from the filing date instead of 3 years.

If the applicant is unable to file in a request for a modified substantive examination within this 5 years period, the applicant may file a request for a substantive examination within 3 months from the expiry of the said time period.

These extended periods for deferment of grant applies to all requests filed after 16<sup>th</sup> August 2006.

For more information, please contact us at [malaysia@ecsf-asia.com](mailto:malaysia@ecsf-asia.com)



## High Court agrees that "jWEST" mark applied in bad faith

In our previous issue, it was reported that opposition proceedings had been brought by Mark Richard Jeffery and Guy Anthony (the Opponents), owners of the trade mark "JEFFERY-WEST" mark in Class 25 against Nautical Concept Pte Ltd (the Applicant), who applied to register the mark "jWEST" in Class 25. That article had summarised the decision of the Principal Assistant Registrar (Registrar), who found that the application for "jWEST" was made in bad faith and that "jWEST" was confusingly similar to "JEFFERY-WEST".

The Applicant had subsequently appealed to the High Court against the Registrar's decision and at the time of the article was written, the hearing had concluded but we were waiting for the appeal decision.

This article is an update on developments in this case and in particular summarises the Applicant's subsequent High Court appeal against the Registrar's decision in favour of the Opponents.

At this appeal, the High Court considered two issues:

- Whether the "jWEST" mark was applied for in bad faith (section 7(6)); and
- Whether the marks "JEFFERY-WEST" and "jWEST" are confusingly similar to each other (section 8(2)(b)).

### Bad faith

The Judge referred to section 8(6) of the Trade Marks Act (TMA) to determine whether bad faith had existed in this case. Section 8(6) states that in deciding whether an application was made in bad faith, "it shall be relevant to consider whether the applicant had, at the time the application was made, knowledge of, or reason to know of, the earlier mark". Further, once bad faith is established, the Applicant's mark will not be allowed to proceed further, even if the marks are not confusingly similar.

Upon hearing the arguments and evidence presented, the Judge agreed with the Registrar's observations and her conclusion that the application was made in bad faith, thus upholding the Registrar's ruling that the Opponents succeeded under section 7(6) of the TMA. The Judge was of the view that the Applicant's actions were not of the standards of "acceptable commercial behaviour observed by reasonable and experienced men".

### Confusing similarity of the marks

The Judge agreed with the Registrar that the mark "jWEST" is "visually different" from "JEFFERY-WEST".

However, he disagreed with the Registrar in respect of the aural similarity of the two marks. In this regard, the Judge found that both marks were not confusingly similar to each other and there was no credible evidence to show otherwise.

He went on to add that the average Singaporean was not likely to be confused between the two marks as there were enough differences between "JEFFERY-WEST" and "jWEST", including the price of the respective shoes, which are sold through separate channels.

As such, the Judge overturned the Registrar's finding in ruling that the Opponents failed under section 8(2)(b).

### Conclusion

Taking into account the recent case of Rothmans of Pall Mall Limited v. Maycolson International Ltd (the Rothman's case), once an application is made in bad faith (regardless of whether the respective parties' marks in question are confusingly similar), the application will be refused registration. Similarly, in this latest case the Opponents have succeeded in preventing the Applicant from registering mark "jWEST" in Singapore, on the basis of bad faith.

The consistent judicial sentiments represented by these two cases serve to re-emphasise the point that in order to avoid an application from being refused due to "bad faith", it is important for an Applicant to bear in mind the test laid out in the Rothman's case, i.e. to take positive steps to make further enquiries before registering a mark. These enquiries may include trade mark conflict searches or even general Internet searches. In the same case, the Court had ruled that bad faith is "a distinct and independent argument" from the argument of confusing similarity of marks, which meant that a trade mark application would be refused as long as bad faith is established.



Kevin Wong  
kjwong@ecsf-asia.com



Kiran Dharsan  
kdharsan@ecsf-asia.com



## Malaysia: IP Case

### "TITLEIST" wins counterfeit suit

In a recently reported case, Acushnet Company v. Metro Golf Manufacturing Sdn Bhd [2006] 7 CLJ 557, the Plaintiff was both the common law owner and registered proprietor of the mark "TITLEIST" for golf items in Malaysia.

The Defendant was caught with counterfeit golf items bearing the mark "TITLEIST" and argued that they had obtained the said products from a third party company, the authorised manufacturer of the Plaintiff. This, in fact, was not the case.

Subsequently, the Plaintiff applied for summary judgment against the Defendant on the basis that the Defendant failed to submit evidence to show that the said third party was an authorised contract manufacturer. In any event, the Court held that the contract manufacturer was not entitled to the use of the mark in any manner outside the ambit of the manufacturing license. The third party therefore had no right to sell the products to the Defendant or authorise the Defendant to use the Plaintiff's mark. The Court therefore granted summary judgment in favour of the Plaintiff.

This case is reflective of the Malaysian Court's stand in the enforcement of IP rights in Malaysia. As shown in this case, the Courts will not hesitate to grant summary judgment in favour of IPR owners where it so warrants.



Alex Tan  
atan@ecsf-asia.com

Roy Joseph  
malaysia@ecsf-asia.com

## Welcome Aboard



Joseph Lee Krupa  
Registered Patent Attorney  
(Utah, US)  
Attorney at Law (Utah, US)

Email: jlkrupa@ecsf-asia.com

Joseph is a former Senior Network Systems Engineer. Joseph has been working as a US Patent Attorney for several years. Drawing on his many years experience as a Network Systems Engineer, he specialises in the preparation and prosecution of patents in the fields of computer software and networking technologies. Joseph also has extensive experience in the preparation and prosecution of medical device technology, optics devices and any type of mechanical invention. Joseph has experience in drafting and prosecuting patent applications internationally including in the USA, Europe, Southeast Asia, and many other countries.

Joseph holds a Bachelor of Science Degree in Mechanical Engineering from one of the top undergraduate engineering schools in the US, a Master of Science Degree in Systems Management, and Juris Doctorate (Law) from one of the top ten law schools in the US.

★ ELLA CHEONG SPRUSON & FERGUSON (SINGAPORE) PTE LTD

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.my  
Contact person: David Griffith / Alex Tan

#### Associated Offices

◆ ELLA CHEONG (HK) (Hong Kong and Beijing)

3701 Central Plaza 18 Harbour Road Hong Kong  
Tel: +852 2810 0558 Fax: +852 2810 0933 Email: echk@ellacheong.com Website: www.ellacheong.com  
Contact person: Ella Cheong

◆ SPRUSON & FERGUSON (Australia and New Zealand)

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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