

Mr. Simon Seow
Director, IP Policy Division
Ministry of Law
100 High Street, #08-02, The Treasury
Singapore 179434

via email: Simon_Seow@mlaw.gov.sg

Re: Comments on *Public Consultation on Proposed Changes to Singapore's Registered Designs Regime*

Dear Mr. Seow:

The American Intellectual Property Law Association ("AIPLA") welcomes the opportunity to submit comments in response to the Public Consultation on Proposed Changes to Singapore's Registered Designs Regime ("Public Consultation").

AIPLA is a national bar association of approximately 14,000 members who are primarily lawyers engaged in private or corporate practice, in government service, and in the academic community. AIPLA members represent a wide and diverse spectrum of individuals, companies, and institutions involved directly or indirectly in the practice of patent, trademark, copyright, trade secret, and unfair competition law, as well as other fields of law affecting intellectual property. Our mission includes helping establish and maintain fair and effective global laws and policies that stimulate and reward invention while balancing the public's interest in healthy competition, reasonable costs, and basic fairness. Our members represent both owners and users of intellectual property, across the world, including in Singapore.

AIPLA applauds the Ministry of Law ("MinLaw") and the Intellectual Property Office of Singapore ("IPOS") on their efforts to amend and improve the existing Registered Designs Regime of Singapore. On May 13, 2015, AIPLA submitted responsive comments to the survey of IPOS regarding industrial design protection in the United States. In reviewing the Public Consultation, AIPLA appreciates that IPOS has taken into consideration our responsive comments to the survey in preparing the proposed changes.

AIPLA has not commented on every question covered by the Public Consultation. However, our decision not to do so for any a particular question or proposal should not be interpreted as agreement or acquiescence to the proposed change. Below, please find AIPLA's comments on the proposals and specific questions raised in the Public Consultation.

Proposal (1):

We propose to broaden the definition of “design” in our Registered Designs Act to take into account technological advances and design-related developments, in line with current practices from other developed countries, and to support our ambition of becoming a design hub.

Specifically we propose to:

- (a) Remove the requirement for the design to be “applied by an industrial process”;
- (b) Replace the word “article” with “product”; and
- (c) Remove the requirement that it be “of manufacture”.

In this regard, we can take reference from the UK, EU, and Australian definition of “design” to provide for greater flexibility in constructing the scope of design protection.

Questions:

What are your views on proposal (1)?

AIPLA Proposal (1) comments:

AIPLA agrees with Proposals 1(a), 1(b), and 1(c).

Proposal (2):

We propose not to broaden the scope of design protection to cover “experiential” designs.

Question:

What are your views on proposal (2)?

AIPLA Proposal (2) comments:

AIPLA agrees that design protection should not be broadened to cover “experiential” designs for the reasons stated by stakeholders in the Public Consultation.

Proposal (3):

We propose not to broaden the scope of design protection to cover “dynamic” designs.

Question:

What are your views on proposal (3)?

AIPLA Proposal (3) comments:

AIPLA agrees that design protection should not be broadened to cover “dynamic” designs for the reasons stated by stakeholders in the Public Consultation.

Proposal (4):

We propose to amend the definition of “design” in our RDA to provide for greater flexibility in constructing the scope of design protection. “Virtual” or “projected” designs that remain constant, and can be represented during application without subjectivity, may be protected, in line with the UK and EU position on “virtual” designs. This could be achieved by the proposed amendments set out in proposal (1).

Question:

What are your reviews on proposal (4)?

AIPLA Proposal (4) comments:

AIPLA agrees that “virtual” or “projected” designs that remain constant should be protected.

Proposal (5):

We propose no change to our registered designs regime at this time that specifically addresses 3D printing, but will continue monitoring developments closely.

Question:

What are your views on proposal (5)? With the emergence of 3D printing, do you anticipate issues or challenges that the current registered designs regime cannot handle?

AIPLA Proposal (5) comments:

AIPLA agrees that, at present, no change should be undertaken with respect to 3D printing.

Proposal (6):

We propose to affirm the current position in the RDA for allowing partial design protection. We also seek further views on whether the requirement that a design must be applied to an article or a part of an article if “that part can be made and sold separately” should be retained.

Questions:

What are your views on partial design protection?

What possible positive or negative impact could there be in removing the requirement of “made and sold separately”? If there are possible negative consequences, how may these be mitigated?

AIPLA Proposal (6) comments:

AIPLA agrees that partial design protection should be allowed.

Removing the “made and sold separately” requirement makes practical sense given the capabilities of today’s manufacturing processes.

Proposal (7):

We propose to expressly allow colour to be specified in the application for a design as one feature of a novel design. However, the scope of design protection will not be extended to colour per se.

Question:

What are your reviews on proposal (7)?

AIPLA Proposal (7) comments:

AIPLA agrees that expressly allowing color to be specified in the application for a design is desirable, and that color per se should not be included in the scope of protection.

Proposal 8:

We propose not to introduce unregistered design rights in Singapore.

Question:

What are your views on proposal (8)?

AIPLA Proposal (8) comments:

AIPLA supports the protection of unregistered nonfunctional distinctive designs as currently recognized by U.S. law.

Proposal (11):

(a) We propose not to introduce substantive examination of Registered Design applications.

(b) We propose instead to introduce a post-registration design opinion service. This service could include one or both of:

(i) An opinion on the validity of a registered design. (The Registrar will provide an opinion based on prior art submitted by the application.)

(ii) An opinion on whether a submitted design infringes the registered design.

Questions:

(i) What are your views on proposal 11(a)?

(ii) What are your views on the proposal in 11(b)? In particular, should the post-registration design opinion service include both (b)(i) and (b)(ii)?

(ii) Should the Registrar be granted ex-officio powers to revoke a registered design? If so, under what circumstances should the Registrar be able to exercise his ex-officio powers to revoke a registered design?

AIPLA Proposal (11) comments:

11(i). Substantive examination would provide more certainty to design owners and the public at large regarding novelty and validity of the design protection.

11(ii). AIPLA does not support such an opinion service. A post-registration design opinion service is non-binding and creates uncertainty until a decision is rendered. Because of the uncertainty created, such an opinion would likely become *de facto* mandatory for applicants.

With respect to 11(b)(ii), AIPLA does not support putting an infringement question to an examiner without the ability to brief the issues involved.

Rather than a post-registration design opinion service, AIPLA supports substantive examination. A substantive examination is of high value to users, and the speed and cost can be controlled in a manner that is favorable to applicants.

Many civil law countries like Germany, Japan and Korea have *inter partes* proceedings within their respective patent offices to consider the validity of certain IPR known as nullity or invalidity actions. In these proceedings, both parties have an opportunity to submit evidence, prior art and briefs in support of their positions, and the patent office (administrative tribunal) will conduct hearings then render a binding decision on validity. Any decision by the patent office (after appeal) is a final ruling that is binding on a Singaporean infringement court (Civil Courts). Therefore, rather than an opinion service, IPOS should consider implementing a formal administrative process to handle questions of validity.

Also, since there is no substantive examination of designs in Singapore, then a first step when a party challenges the validity of a design would be to send the case back to IPOS for substantive examination.

With respect to 11(b)(ii), countries like the United States and South Korea have Declaratory Judgement and Confirmation of Scope actions, respectively, which are *inter partes* proceeding where an accused infringer can ask for a judgement on whether a product or process infringes an asserted/issued patent. If IPOS implements any type of service to opine on the infringement of a design, then they should consider first subjecting the design right to substantive examination, then implementing a formal administrative process to handle questions of infringement that would be binding on Singaporean Courts.

Proposal 12:

We propose to maintain the current 15-year term of protection.

Question:

What are your views on proposal (12)?

AIPLA Proposal (12) comments:

AIPLA agrees that the current 15 year term of protection should be maintained.

Proposal (13):

(a) We propose to increase the grace period in Singapore to 12 months.

(b) We also propose to remove the requirement that disclosures can only be made at select international exhibitions.

Question:

What are your views on 13(a) and (b)?

AIPLA Proposal (13) comments:

13(a). AIPLA agrees that the grace period should be increased to 12 months.

13(b). AIPLA agrees that the requirement that disclosures can only be made at select international exhibitions should be removed.

Proposal (14):

We propose to maintain the current allowable term of deferred publication at 18-months from the filing date of the application.

Questions:

(i) What are your views on proposal (14)?

(ii) Are there other ways to mitigate the effects of deferred publication on third parties/market, and encourage early publication?

AIPLA Proposal (14) comments:

14(i). AIPLA agrees that maintaining the current 18 month deferred publication is advisable given user feedback.

14(ii). Reducing the pendency of design applications would make it more important to have them published earlier. [Is there a pendency for designs if there is no substantive examination?]

Proposal (15):

(a) We propose to maintain the current position of accepting multiple designs from the same Locarno Classification in a single application.

(b) We also propose to consider lowering the application fee for subsequent designs filed in a single application, and review the renewal fee structure.

Questions:

What are your views on proposal 15(a) and (b)?

AIPLA Proposal (15) comments:

15(a). AIPLA agrees with maintaining the current practice of accepting multiple designs from the same Locarno class in a single application since user feedback supports this.

15(b) AIPLA agrees with lowering application fees for subsequent designs filed in a single application. Reviewing fee structures on a regular basis is prudent. Moreover, any changes should be based on an accurate model of the financial impact of the changes.

Proposal (16):

We propose to maintain the current automatic 5-year term of protection and 5-year block renewal structure.

Questions:

(i) What are your views on proposal (16)?

(ii) Would a shorter term of initial protection (with reduced application cost) be beneficial to companies and encourage more design registration?

AIPLA Proposal (16) comments:

16(i). AIPLA agrees that the 5 year term and 5 year block renewal should be maintained since the input received from users clearly supports no change.

16(ii). There is no evidence to suggest that a shorter term of initial protection would benefit companies or encourage more design registrations.

Proposal (17):

(a) We propose for IPOS to partner industry associations, such as the Design Business Chamber Singapore and DesignSingapore Council, to conduct more outreach and information sessions.

(b) We also propose providing guidance notes on specific areas relating to the Registered Designs regime, especially in the area of infringement, on IPOS' website, to increase public awareness of acts that would constitute design infringement and to help increase certainty in this area.

(Note: Proposal (11) for IPOS to offer a post-grant opinion (non-binding) service on design infringement also seeks to provide a lower-cost avenue for parties to seek clarity on possible design infringement.)

Question:

Do you have any views or suggestions on how to raise the level of awareness for design protection and/or providing for greater certainty for creators and users?

AIPLA Proposal (17) comments:

17(a) AIPLA agrees and supports IPOS's effort to partner with various stakeholders to conduct outreach. Outreach and education are critically important to raise the level of awareness and understanding regarding design protection and enforcement.

17(b) AIPLA agrees and supports IPOS's efforts to provide clear guidance on its website, and in particular guidance regarding infringement. Such guidance will help raise awareness and increase certainty about what constitutes infringement. [Please refer to the comments above on the post grant opinion service on validity and infringement.]

Proposal (18):

We propose that Singapore not introduce utility model protection for sub-patentable inventions, at least until there is stronger economic evidence in support of its introduction.

Questions:

What are your views on proposal (18)?

AIPLA Proposal (18) comments:

AIPLA agrees that utility model protection should not be introduced at this time given the lack of clear evidence to suggest there would be concrete benefits. The administrative/operational burden would be significant.

Again, AIPLA appreciates the opportunity to provide these comments on the Public Consultation. Please contact us if you would like us to provide additional information on any issues discussed above.

Sincerely,



Denise W. DeFranco
President
American Intellectual Property Law Association