

## **Comments of the INTA Designs Committee on the Final Report of the Review of Singapore’s Registered Designs Regime December 2016**

The International Trademark Association (INTA) welcomes the opportunity to provide feedback to the Intellectual Property Office of Singapore (IPOS) on the Public Consultation on Proposed Designs-Related Legislative Amendments dated 11 November 2016 (the Consultation Document), following the Final Report of the Review of Singapore’s Registered Designs Regime (the Final Report).

INTA is a global association of trademark owners and professionals dedicated to supporting trademarks and related intellectual property in order to protect consumers and to promote fair and effective commerce. INTA’s members are more than 6,700 organizations from 190 countries, with almost 60 member organizations just in Singapore. See more information about INTA [below](#).

Overall, INTA Designs Committee considers it likely that the proposed amendments will assist in achieving the three stated objectives set out in the Final Report and the Consultation Document:

- (a) to support modern business practices while continuing to balance the interests of design creators/owners and users;
- (b) to provide business certainty; and
- (c) to ensure that Singapore’s design protection regime is cost-effective.

As a preliminary point, we note that some of the proposed amendments to the Registered Designs Act (**RDA**) have not undergone the legislative drafting and vetting process and are not yet finalised. We have therefore made only limited comments on specific drafting issues. We have adopted the numbering used by IPOS in the Consultation Document and would like to propose the following comments:

### **1.1 Proposed amendments to the definition of “design” in Section 2(1) of the RDA**

INTA welcomes the express inclusion of “colours” as one of the protectable “features” of a design. This is in line with global best practice, and something of great interest to designers and users of the system.

We are less certain about the exclusion of protection for “features which consist only of one colour”. INTA agrees that design law is not the mechanism for protecting colours *per se*. We also note the fourth example given on page 5 of the Consultation Document and understand the desire not to provide wide monopolies in the circumstances of a yellow t-shirt. However, in our view, the better approach to this is through validity – a t-shirt which is itself not novel is unlikely to be novel merely because it is yellow, as yellow t-shirts are well known as prior designs. The exclusion, as

drafted, does not appear in EU or US law, for example, and seems not to aid certainty. If the aim is not to protect colours *per se*, then it may be preferable to say so.

IPOS may also wish to consider “texture” as one of the features of a product specifically protected. The texture of, say, brushed steel is clearly an aspect of design, and goes beyond merely the colour of the article.

## **1.2 Proposed amendments to the definition of “article” in Section 2(1) of the RDA**

INTA welcomes the inclusion of hand-made articles within the definition. As the Consultation Document sets out, the aim of the definition is to exclude from protection those things that are naturally occurring, such as plants and animals. Including manufactured and handmade articles is consistent with this purpose.

No amendment is currently proposed to the requirement in the definition of “article” that extends protection to “any part of an article if that part is made and sold separately”. The protection of parts of articles (as opposed to spare parts) is handled differently in different countries, but, as the Final Report notes, the overwhelming global trend is *towards* providing protection for parts of articles (for example, just the back of a chair). A designer may well design an innovative back to a chair, which will never be sold separately, but which has commercial value when sold together with a commonplace seat and legs. If the designer can only seek protection of the whole article, infringement may be avoided by a copyist who copies the innovative back, but combines it with a different banal seat and legs.

Whilst recognising that IPOS in effect already allows the registration of parts of products which are not sold separately through the use of dotted lines and a claim to the whole product, INTA urges IPOS to consider removing the requirement that parts of articles, to be protected, have to be made and sold separately. It does not add certainty and is not in the interest of users. Other countries, like the US and the EU, already allow protection of portions without the requirement that the portion can be made or sold separately and some countries like China have plans to remove the requirement.

## **1.3 Proposed new category of “non-physical product” in the RDA**

INTA welcomes the specific inclusion of “non-physical products” to protect virtual or projected designs. This reflects world-wide filing practice, where GUIs are already one of the fastest growing product designations in design filings.

As a drafting point, it would seem to us possible to include “non-physical products” in the definition of “article”, so that it does not need to be mentioned separately each time. As noted at paragraph 1.3.3 and 1.3.5 of the Consultation Document, the provisions for validity and infringement of designs of non-physical products should be identical to those for physical designs, so it ought not be necessary to repeat “and non-physical products” each time. Rather, the definition of “article” could be broadened to include “non-physical products”. This would also avoid the need for the various consequential amendments proposed in paragraph 1.3.6 of the Consultation Document.

We question the requirement that a non-physical product must perform “any utilitarian function”. This is not a requirement for “articles” protected by design law. There is little apparent risk of a

projected design being a “substrate”. This exclusion is unnecessary, and will likely lead to satellite disputes.

Parts of non-physical products should also be protectable, as noted above, without having to be made and sold separately.

#### **1.4 Proposed new definitions of “set of non-physical products” and “set of articles and non-physical products” in Section 2(1) of the RDA**

Filing sets of products is popular with users of the design registration system, who are likely under the (mistaken) belief that it is a cost-effective way of filing individual registrations for each item in the set. A registration for a set does not protect each item in the set separately – it protects the set. So the scope of protection of a design registration for a set is different than if each of the items in the set had been filed separately. (The proposal to accept multiple filings may lessen the temptation for designers to file for a set).

The EUIPO is considering a convergence project on sets – apparently one of the major issues facing national intellectual property offices across the EU. It remains plausible that the Court of Justice of the European Union will rule that a set is not a “product”, and hence not protectable as such, although the items in the set will remain separately protectable.

If the filing of sets is to continue to be encouraged, greater certainty around what is and what is not a set is required. Further, education efforts should be undertaken to encourage users (especially individual designers and SMEs) to consider whether their protection may be broader if they file individually for the individual items in the set.

INTA has no difficulty with the extension of sets to non-physical products, although we note again that this may be able to be achieved more simply by including non-physical products within the definition of “article”.

We consider it to be an open question whether a virtual keyboard and a virtual mouse could be considered to be the “same design” or “the same design with modifications or variations not sufficient to alter the character or substantially to affect the identity of the design”. The pieces of a holographic chess set may be a better example.

#### **2.1 Proposed amendments to the ownership of a commissioned design in Section 4 of the RDA**

INTA welcomes this proposed change, in line with global movement on this issue.

We would advocate for a budget to be provided for educating stakeholders in relation to this change, and for capacity building among designers who will be asked to transfer their rights in commissioned designs to the commissioner (for example, education about exclusive licences etc).

#### **3.1 Proposed amendments to Section 8 of the RDA to broaden the grace period for pre-filing disclosures**

INTA welcomes the extension of the grace period to 12 months and the removal of the requirement that any pre-filing disclosure be at one of a small number of selected international exhibitions. This reflects global practice of a general move towards a 12-month grace period for any relevant disclosure. The change is particularly important given the importance of the Internet in global commerce.

We make one minor comment in relation to bad faith disclosures. The EU legislation on which the IPOS proposed amendment is based only provides for an abusive disclosure not to be novelty-destroying if made in the 12 months before the design application was filed. This appears to have been done for ease of drafting, rather than with any specific purpose in mind. The danger is that an abusive or bad faith disclosure will often go undetected. The very nature of bad faith is that the bad faith discloser is unlikely to own up to his/her potentially unlawful activity. It may therefore be considered unfair on designers if their rights in a design are lost (and in the case of designs, lost forever) in circumstances where they weren't aware of the bad faith disclosure, and so didn't move to file within the 12-month window the EU legislation provides. INTA would therefore prefer to see no 12-month limit on bad faith disclosures. If a disclosure is in bad faith, it should not be novelty-destroying, in the same way that a confidential disclosure will never be novelty-destroying (but for the bad faith, the design would have remained confidential).

We are conscious that this creates some uncertainty for prior design searching, as a third party is not necessarily going to know whether a disclosed design was disclosed in bad faith or not. But we consider that that uncertainty is preferable to depriving designers of their rights because of the nefarious activity of third parties.

If removing the 12-month bad faith disclosure period remains unpalatable, IPOS may wish to consider providing that a bad faith disclosure will not be novelty destroying if the filing is made within 12 months of when the designer knew (or, potentially, ought to have known) about the bad faith disclosure.

Again, we would advocate setting aside budget to educate stakeholders about the grace period changes, particularly to ensure that it is understood that the broader grace period in Singapore has not (yet) been followed in a number of its trading neighbours, and that testing the market in Singapore may remove (for ever) the ability to file for design protection in a number of key countries.

#### **4.1 Proposed amendments to selected provisions which relate to the interface between copyright and registered designs**

The overlap of copyright and design rights can be confusing. The EU legislation does not attempt to provide a clear legislative division. Instead, it provides that design rights sit alongside other rights, none impacting on the others

IPOS may therefore want to consider not excluding “products primarily of a literary or artistic character”. For example, in the EU, there are good reasons for registering, say, a CD or DVD cover as a design rather than relying on copyright protection – the RCD can be notified to customs to enable officers throughout the EU to seize counterfeit goods as they enter the territory, without reference to the musical work on the CD itself.

Further, as the decision of the Supreme Court of the United Kingdom concerning the Star Wars storm trooper helmet demonstrates, experts can differ on what is or is not a sculpture. A list of current technologies also does not help future-proof the legislation.

The EU system has now coped reasonably well for 15 years without drawing a firm line between copyright and registered designs. IPOS may want to consider a similar approach.

### **5.1 Proposed legislation changes to allow multiple designs in the same Locarno classification to be filed in one application**

INTA supports this proposed change. It is in line with global norms and assists users in keeping costs down.

The EU-wide legislation provides an exception to the same-class requirement – for logos and other ornamentation. These, which now fall in Class 32, can be filed together with designs for goods in any other class. In this way, the logo for the product can be protected in the same filing as the product itself. IPOS may wish to consider allowing this as a cost-effective way to promote creativity and design protection.

INTA urges the Registrar to set a suitably high number for the maximum number of designs to be filed in the one application.

### **6.1 Reaffirming that dynamic designs can be registered through flexibility in the definition of “design”, and by requiring such designs to be represented through a series of freeze-frames**

INTA welcomes the proposed clarity of the extension of design protection in Singapore to dynamic designs, which are increasingly popular with users.

We recommend that the requirement for a series of static representations be included in an instrument that can readily be updated as technologies advance (eg, a practice note rather than the RDA or rules). Short video files can currently capture moving designs, and the EUIPO has moved towards accepting them for trademark applications. It will hopefully not be too long before they can routinely be filed for design applications.

Although it is not specifically mentioned, the amendment to remove Rule 14(1A)(c) is a positive step. With reproductive technology as it is, and the increasing reliance on electronic filing of design applications, it is no longer necessary to submit more than one set of representations of the design with the exception of physical specimens of, say, cloth. IPOS is to be commended for this cost-saving amendment.

### **Other**

The transitional provisions have been clearly and helpfully set out. Given the life of a design registration, it may seem preferable to bring into force all aspects of the new legislation immediately. However, as that potentially invalidates existing designs, INTA agrees with IPOS's approach of bringing the amendments into force only in relation to new design filings. Thus, the old law will continue to apply to “old” designs for up to 15 years (the life of a design registration in Singapore).

In the UK, the new law was brought in immediately in relation to infringement, whilst the old law is still used to assess validity of registered designs filed before commencement of the new act. Whilst concerns were expressed about this creating difficulties, none has arisen in practice and we recommend following that approach.

INTA also welcomes Conclusion 19 of the Final Report, which is to conduct more outreach and information sessions, in partnership with industry associations. Increasing public awareness of the tools available to protect novel designs will assist with the aims of the review.

Should you wish to discuss any of the above, please contact David Stone, Chair of INTA's Designs Committee, at [david.stone@allenoverly.com](mailto:david.stone@allenoverly.com).

### **About INTA**

The International Trademark Association (INTA) is a global association of trademark owners and professionals dedicated to supporting trademarks and related intellectual property in order to protect consumers and to promote fair and effective commerce. INTA's members are more than 6,700 organizations from 190 countries. INTA members collectively contribute almost US \$12 trillion / €8.8 trillion / ¥73 trillion to global GDP annually. For comparison, the 2013 annual GDP of the top three markets was \$9.2 trillion (China), \$17.9 trillion (European Union) and \$16.7 trillion (United States).

The Association's member organizations represent some 30,000 trademark professionals and include brand owners from major corporations as well as small- and medium-sized enterprises, law firms and nonprofits. There are also government agency members as well as individual professor and student members. INTA has almost 60 member organizations in Singapore.

INTA undertakes advocacy work throughout the world to advance trademarks and related rights, and offers educational programs and informational and legal resources of global interest. Headquartered in New York City, INTA also has offices in Brussels, Shanghai and Washington D.C. and representatives in Geneva, New Delhi and Singapore.

Further information about our Association can be found at [www.inta.org](http://www.inta.org).