

REGISTERED DESIGNS ACT

(CHAPTER 266)

REGISTERED DESIGNS (INTERNATIONAL REGISTRATION) RULES 2005

In exercise of the powers conferred by sections 64A and 74 of the Registered Designs Act, the Minister for Law, after consulting with the Intellectual Property Office of Singapore, hereby makes the following Rules:

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PART I

PRELIMINARY

Citation and commencement

1.—These Rules may be cited as the Registered Designs (International Registration) Rules 2005 and shall come into operation on 17th April 2005.

Definitions

2.—In these Rules, unless the context otherwise requires —

"Common Regulations" means the Common Regulations under the 1999 Act, the 1960 Act and the 1934 Act of the Hague Agreement, adopted by the Assembly of the Hague Union with effect from 1st April 2004, as replaced, revised or amended from time to time;

"Designs Journal" means the journal by that name published under rule 67A of the Registered Designs Rules (R 1);

"Geneva Act of the Hague Agreement" means the Act, signed at Geneva on 2nd July 1999, of the Hague Agreement Concerning the International Registration of Industrial Designs;

"international application" means an application to the International Bureau for international registration;

"International Bureau" means the International Bureau of the World Intellectual Property Organization;

"International Register" means the official collection of data concerning international registrations maintained by the International Bureau for the purposes of the Geneva Act of the Hague Agreement;

"international registration" means the international registration of a design effected according to the Geneva Act of the Hague Agreement;

"international registration designating Singapore" means an international registration in respect of which a request has been made (whether in the relevant international application or subsequently) for extension of protection to Singapore under the Geneva Act of the Hague Agreement;

“protected international design (Singapore)” has the meaning given by rule 11, and references to “protected” and “protection” shall be construed accordingly.

Forms

3.—(1) Any reference in these Rules to a numbered form shall be construed as a reference to the current version of the form bearing the corresponding number which is —

- (a) described in the Second Schedule to the Registered Designs Rules (R 1); and
- (b) published in the Designs Journal.

(2) Any form may be modified on the direction of the Registrar for use in a case other than the case for which it is intended.

PART II

INTERNATIONAL REGISTRATION DESIGNATING SINGAPORE

Entitlement to protection

4.—(1) Subject to rule 9, an international registration designating Singapore shall be entitled to become protected in Singapore if, had the particulars of the international registration been comprised in an application for registration of a design under the Act, that application would have satisfied the requirements for registration of a design under the Act and the Registered Designs Rules (R 1).

(2) For the purpose of paragraph (1), section 11 of the Act and rules 7, 13 to 21 and 23 to 28 of the Registered Designs Rules shall be disregarded.

Effects of protected international design (Singapore)

5.—(1) Subject to the provisions of these Rules, the holder of the international registration relating to a protected international design (Singapore) shall have the same rights and remedies as the registered owner of a registered design under sections 30, 31 and 36 to 41 of the Act.

(2) Paragraph (1) shall apply subject to section 30 (5), (6) and (7) of the Act relating to acts not amounting to infringement of a registered design.

(3) For the purposes of the application of section 30 (1) of the Act, the rights of the holder shall have effect from the date on which the protected international design (Singapore) is to be treated as registered under rule 11.

(4) The remedy for groundless threats of infringement proceedings under section 44 of the Act applies to a protected international design (Singapore) as it applies in relation to a registered design.

(5) For the purposes of paragraph (4) —

- (a) the reference in section 44 (1) of the Act to an application for registration of a design shall be treated as a reference to an international application relating to a protected international design (Singapore);
- (b) the reference in section 44 (2) of the Act to the registration of the design shall be treated as a reference to the protection of the protected international design (Singapore); and
- (c) the reference in section 44 (4) of the Act to a notification that a design is registered shall be treated as a reference to a notification that a design is a protected international design (Singapore).

Protected international design (Singapore) as object of property

6.—Sections 32 and 33 of the Act shall apply, with the necessary modifications, in relation to a protected international design (Singapore) as they apply in relation to a registered design.

Notification of transactions

7.—(1) The following are notifiable transactions for the purpose of this rule:

- (a) the grant of a licence or sub-licence for the use of a protected international design (Singapore);
- (b) the grant of any security interest (whether fixed or floating) over a protected international design (Singapore) or any right in it.

(2) On application being made to the Registrar by —

- (a) a person claiming to be entitled to an interest in or under a protected international design (Singapore) by virtue of a notifiable transaction; or
- (b) any other person claiming to be affected by such a transaction,

the relevant particulars of the transaction shall be entered in the Register.

(3) An application for registration of the relevant particulars of a notifiable transaction shall —

- (a) be made in Form D9;
- (b) where the transaction is the grant of a licence or sub-licence for the use of a protected international design (Singapore) —
 - (i) be signed by the grantor of the licence or sub-licence, as the case may be; or
 - (ii) be accompanied by such evidence as the Registrar considers to be sufficient proof of the transaction;
- (c) where the transaction is the grant of any security interest (whether fixed or floating) over a protected international design (Singapore) or any right in it —
 - (i) be signed by the mortgagor of the security interest; or
 - (ii) be accompanied by such evidence as the Registrar considers to be sufficient proof of the transaction; and
- (d) be accompanied by the fee for the filing of Form D9 in the First Schedule to the Registered Designs Rules (R 1).

(4) The following are relevant transactions for the purpose of this rule:

- (a) an assignment of a protected international design (Singapore) or any right in it;
- (b) the making by personal representatives of an assent in relation to a protected international design (Singapore) or any right in it;
- (c) an order of the Court or other competent authority transferring a protected international design (Singapore) or any right in it.

(5) Until —

(a) in the case of any notifiable transaction referred to in paragraph (1), an application has been made for registration of the relevant particulars of the transaction; or

(b) in the case of any relevant transaction, the transaction has been recorded in the International Register,

the transaction is ineffective as against a person acquiring an interest in the protected international design (Singapore) in ignorance of it.

(6) A person claiming to be entitled to an interest in or under a protected international design (Singapore) by virtue of a notifiable transaction referred to in paragraph (1) is not entitled to —

(a) damages or an account of profits in respect of any infringement of the protected international design (Singapore) occurring after the date of the transaction and before the date of the application for registration of the relevant particulars of the transaction; and

(b) compensation under section 46 of the Act in respect of the use of the design for the services of the Government occurring after the date of the transaction and before the date of the application for registration of the relevant particulars of the transaction.

(7) A person who becomes the holder of the international registration relating to a protected international design (Singapore) by virtue of any relevant transaction is not entitled to —

(a) damages or an account of profits in respect of any infringement of the protected international design (Singapore) occurring after the date of the transaction and before the transaction is recorded in the International Register; and

(b) compensation under section 46 of the Act in respect of the use of the design for the services of the Government occurring after the date of the transaction and before the transaction is recorded in the International Register.

(8) In this rule, “relevant particulars” means —

(a) in the case of the grant of a licence for the use of a protected international design (Singapore) —

(i) the name and address of the licensee;

(ii) where the licence is an exclusive licence, that fact;

(iii) where the licence is limited, a description of the limitation; and

(iv) the duration of the licence if the same is, or is ascertainable as, a definite period;

(b) in the case of the grant of a sub-licence for the use of a protected international design (Singapore) —

(i) the name and address of the grantor of the sub-licence and of each person from whom he derived his ability to grant the sub-licence;

(ii) the name and address of the sub-licensee;

(iii) where the sub-licence is an exclusive sub-licence, that fact;

- (iv) where the sub-licence is limited, a description of the limitation; and
 - (v) the duration of the sub-licence if the same is, or is ascertainable as, a definite period; and
- (c) in the case of the grant of any security interest over a protected international design (Singapore) or any right in it —
- (i) the name and address of the grantee;
 - (ii) the nature of the interest (whether fixed or floating); and
 - (iii) the extent of the security or right in the protected international design (Singapore) secured.

Priority

8.—(1) Subject to paragraph (2), section 12 of the Act shall apply so as to confer a right of priority in relation to the protection of an international registration designating Singapore, as it applies in relation to the registration of a design under the Act.

(2) The manner of claiming priority shall be determined in accordance with the Geneva Act of the Hague Agreement and the Common Regulations.

Examination

9.—(1) Upon receiving a notification of an international registration designating Singapore from the International Bureau, the Registrar shall examine whether the international registration satisfies the requirements for protection in Singapore set out in rule 4.

(2) If it appears to the Registrar that the requirements for protection in Singapore set out in rule 4 are not met, he shall give notification of refusal of protection to the International Bureau.

(3) The notification of refusal shall specify the period within which the holder of the international registration may make representations against the refusal.

(4) If the holder requires an extension of time to make representations, he shall file with the Registrar his request for an extension of time on Form D16 before the expiry of —

(a) the period specified in the notification of refusal; or

(b) any extended period previously granted by the Registrar.

(5) A holder of an international registration making representations shall file with the Registrar an address for service in Singapore in Form D1.

Notification of refusal

10.—(1) A notification of refusal under rule 9 (3) shall not be given after the expiry of 6 months from the date of the publication of the international registration in accordance with Rule 26 (3) of the Common Regulations.

(2) A notification of refusal under rule 9 (3) shall set out the matters required under Article 12 of the Geneva Act of the Hague Agreement and Rule 18 of the Common Regulations.

(3) Where, after a notification of refusal has been given under rule 9 (2), the holder makes representations within the period specified in rule 9 (3) or any extended period granted by the Registrar, the Registrar shall, upon a final decision being made in relation to the refusal, notify the International Bureau of that decision.

(4) For the purposes of paragraph (3), a final decision shall be regarded as being made where —

(a) the Registrar or the Court on appeal from the Registrar decides whether the refusal shall be upheld or withdrawn, and any right of appeal against that decision expires or is exhausted; or

(b) the proceedings relating to the refusal are discontinued or abandoned.

Protection

11.—(1) A design which is the subject of an international registration designating Singapore shall be protected as a protected international design (Singapore) —

(a) in a case where no notification of refusal has been given to the International Bureau within the period of 6 months referred to in rule 10 (1), upon the expiry of that period; or

(b) in any other case, upon the Registrar notifying the International Bureau under rule 10 (3) that a final decision has been made to withdraw the refusal of protection.

(2) For the purposes of the application by these Rules of the provisions of the Act, a design which is the subject of an international registration designating Singapore shall be treated as if it was registered under the Act, and shall be protected as a protected international design (Singapore), from the filing date of the corresponding international application.

Revocation

12.—(1) The protection conferred under rule 11 on a protected international design (Singapore) may be revoked on the application of an interested person.

(2) Subject to paragraphs (3), (4) and (5), section 27 of the Act shall apply, with the necessary modifications, in relation to the revocation of the protection conferred on a protected international design (Singapore) as it applies in relation to the revocation of the registration of a registered design.

(3) For the purposes of applying section 27 of the Act —

(a) the references in section 27 (1) and (2) of the Act to the time after a design has been registered shall be treated as references to the time after a design has become protected as a protected international design (Singapore);

(b) the references in section 27 (1), (2), (3), (4) and (5) of the Act to the revocation of the registration of a design shall be treated as references to the revocation of the protection conferred on a protected international design (Singapore);

(c) the references in section 27 (1) and (6) (a) of the Act to the date of registration of a design shall be treated as references to the date a design became protected as a protected international design (Singapore);

(d) the reference in section 27 (2) (a) of the Act to the time a design was registered shall be treated as a reference to the time a design became protected as a protected international design (Singapore); and

(e) the references in section 27 (2) (b) and (6) (b) of the Act to the right in a registered design having expired in accordance with section 22 (1) of the Act shall be treated as a reference to the protection conferred on a protected international design (Singapore) having expired by reason that the copyright in the artistic work referred to in section 27 (2) (a) of the Act has expired.

(4) Part VI of the Registered Design Rules (R 1) shall apply, with the necessary modifications, to an application for revocation of the protection conferred on a protected international design (Singapore) as it applies in relation to the revocation of a registered design.

(5) Where the protection conferred on a protected international design (Singapore) is revoked to any extent —

(a) the Registrar shall notify the International Bureau; and

(b) the rights of the holder of the international registration relating to the protected international design (Singapore) shall be deemed to have ceased to exist as from —

(i) the date of the application for revocation; or

(ii) if the Registrar or the Court is satisfied that the grounds for revocation existed at an earlier date, that date.

False representation that design is protected

13.—(1) Section 66 of the Act shall apply, with the necessary modifications, in relation to a protected international design (Singapore) as it applies in relation to a registered design.

(2) For the purposes of applying section 66 of the Act —

(a) the references in section 66 (1) and (2) of the Act to a person representing that a design applied to any article is registered in respect of that article shall be treated as references to a person representing that a design applied to any article is protected as a protected international design (Singapore); and

(b) the references in section 66 (3) of the Act to a right in a registered design shall be treated as references to protection conferred on a protected international design (Singapore).

Government use

14.—Part IV of the Act shall apply, with the necessary modifications, in relation to a protected international design (Singapore) as it applies in relation to a registered design.

PART III

DIVISION OF INTERNATIONAL REGISTRATION

Division of international registration

15.—(1) Where 2 or more designs are the subject of an international registration designating Singapore and, after examining the international registration, the Registrar is of the view that protection should be refused in respect of any of those designs on the ground that the corresponding international application does not comply with rule 22 of the Registered Designs Rules (R 1), the Registrar shall give notification of refusal of protection to the International Bureau.

(2) The holder of the international registration designating Singapore may apply to the Registrar for a division of the international registration in order to overcome the grounds of refusal stated in the notification.

(3) Where an international registration designating Singapore has been divided by the Registrar, the holder of the international registration may apply under section 11 of the Act for the registration of any design which has been the subject of the division.

- (4) An application under paragraph (3) shall be —
- (a) made within 3 months from the date of the notification of refusal;
 - (b) made in Form D3; and
 - (c) accompanied by the fee for the filing of Form D3 in the First Schedule to the Registered Designs Rules.
- (5) Where any design is registered in Singapore pursuant to an application under paragraph (3) —
- (a) section 20 of the Act shall not apply to that design or registration; and
 - (b) the filing date of the corresponding international application shall be treated, for the purposes of the Act, as the date of registration of that design.
- (6) Rule 57 of the Registered Designs Rules shall not apply to the doing of any act referred to in paragraph (4).

PART IV

INTERNATIONAL APPLICATION THROUGH REGISTRY

International application

16.—(1) Subject to the provisions of these Rules, an international application may be made through the Registry.

- (2) The international application may be made only by any of the following persons:
- (a) a person who is a national of a State that is a Contracting Party;
 - (b) a person who is a national of a State member of an inter-governmental organisation that is a Contracting Party;
 - (c) a person who is domiciled in or has a habitual residence in the territory of a Contracting Party; or
 - (d) a person who has a real and effective industrial or commercial establishment in the territory of a Contracting Party.
- (3) The Registrar shall not be required to transmit the international application to the International Bureau unless the international application is —
- (a) made in such form as may be required under the Common Regulations;
 - (b) accompanied by payment of such fee as may be required under the Common Regulations for the filing of the international application; and
 - (c) accompanied by payment to the Office of a transmittal fee of \$150.
- (4) The payment referred to in paragraph (3) (b) shall comply with —
- (a) such general requirements as may be specified in the practice directions issued by the Registrar; and

(b) such other requirements as the Registrar may, in any particular case, specify in a written notice to the applicant.

(5) In this rule —

"Contracting Party" means any State or inter-governmental organisation which is a party to the Geneva Act of the Hague Agreement;

"territory of a Contracting Party" means —

(a) where the Contracting Party is a State, the territory of that State; or

(b) where the Contracting Party is an inter-governmental organisation, the territory in which the constituent treaty of that inter-governmental organisation applies.

PART V

MISCELLANEOUS PROVISIONS

Evidence of certain matters relating to international registration

17.—(1) In all legal proceedings relating to a protected international design (Singapore), the registration of a person as the holder of the international registration relating to a protected international design (Singapore) shall be prima facie evidence of the validity of that international registration and of any subsequent assignment or other transmission of it.

(2) Judicial notice shall be taken of —

(a) the Geneva Act of the Hague Agreement and the Common Regulations;

(b) a copy of an entry in the International Register issued by the International Bureau; and

(c) a copy of the Bulletin published by the International Bureau.

(3) Any document referred to in paragraph (2) (b) or (c) shall be admissible as evidence of any instrument or act of the International Bureau referred to in the document.

(4) Evidence of any document issued by the International Bureau, or of any entry in or extract from such a document, may be given in any legal proceedings by the production of a copy thereof, and such a copy shall be received in evidence.

(5) In this rule, "legal proceedings" include proceedings before the Registrar.

Agents

18.—Any act required or authorised under these Rules to be done by or to a person in connection with —

(a) a request for protection of a design as a protected international design (Singapore); or

(b) any procedure relating to a protected international design (Singapore),

may be done by or to an agent authorised by that person orally or in writing.

Burden of proving use of protected international design (Singapore)

19.—If in any civil proceedings relating to a protected international design (Singapore), a question arises as to the use to which the design has been put, the holder of the international registration relating to the design shall bear the burden of showing what use has been made of it.

Communication of information to International Bureau

20.—Notwithstanding any written law or rule of law, the Registrar may communicate to the International Bureau any information which Singapore is required to communicate under these Rules, the Geneva Act of the Hague Agreement or the Common Regulations.

Application of Registered Designs Rules

21.—(1) Except as otherwise provided in these Rules, the Registered Designs Rules (R 1) shall apply, with the necessary modifications, in relation to an international registration designating Singapore and to a protected international design (Singapore) as they apply in relation to an application for registration of a design and to a registered design.

(2) The provisions of the Act and the Registered Designs Rules relating to costs and security for costs and to evidence before the Registrar shall apply in relation to proceedings under these Rules in the same manner as they apply in relation to proceedings relating to a registered design or an application for registration of a design.

(3) For the avoidance of doubt, rules 7, 13 to 21, 23 to 29, 31 to 39, 67 and 68 of the Registered Designs Rules do not apply to an international registration designating Singapore or a protected international design (Singapore).

Made this 30th day of March 2005.

LIEW HENG SAN
*Permanent Secretary,
Ministry of Law,
Singapore.*

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