

RUSSELL-CLARKE AND HOWE ON INDUSTRIAL DESIGNS

TENTH EDITION

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6. NEW ZEALAND

In New Zealand, registered designs are protected under the Designs Act 1953. The provisions of this Act are closely modelled on those of the UK legislation then in force, namely the RDA 1949 (UK) and the New Zealand Act does not reflect the substantial amendments which were made to the RDA 1949 by the Copyright Designs and Patents Act 1988 (UK).¹⁰² Minor amendments (principally to provide for restoration of lapsed designs and to permit electronic filing of applications) were made by the Designs Amendment Act 2010. **11-040**

Thus, the definition of “design” in s.2(1) of the Designs Act 1953 (NZ) is the same as that in s.1(3) of RDA 1949 (UK) before its amendment by the 1988 Act.¹⁰³ Designs are registrable under s.5(2) of the Designs Act 1953 (NZ) if they are “new or original”, the same test as that under s.1(2) of the RDA 1949 (UK).¹⁰⁴ The right conferred by registration is called (rather misleadingly¹⁰⁵) the “copyright in the design” and is infringed by the application to any article in respect of which the design is registered of the same design or a “design not substantially different from” the registered design.¹⁰⁶ **11-041**

Like under the pre-1988 Act UK law,¹⁰⁷ the maximum term of a registered design in New Zealand is 15 years from the date of application.¹⁰⁸ In New Zealand, registered design applications are subjected to substantive examination for validity,¹⁰⁹ a practice which has now been abandoned in respect of UK national registered design applications to conform with the practice of the EU designs registry at the EUIPO.¹¹⁰ **11-042**

7. SINGAPORE

History

In Singapore, registered designs are protected under the Registered Designs Act (Ch.266) (the “Act”). That Act was originally passed in 2000,¹¹¹ and its main provisions are closely modelled on those of the RDA(A) UK then in force (i.e. the pre-Euro-harmonised version of the Registered Designs Act 1949). **11-043**

Definition of “Design”

The definition of “design” in s.2(1) of the Act closely follows the wording of s.1(1) of RDA(A) UK save for three significant differences. First, it omits the words **11-044**

¹⁰² The changes to the RDA 1949 which were made by the CDPA 1988 are set out in App.A5.

¹⁰³ App.A5.

¹⁰⁴ App.A5.

¹⁰⁵ The use of the word “copyright” is misleading because copying is not a necessary ingredient of infringement: see para.3-165.

¹⁰⁶ The Designs Act 1953 s.11(1); same as RDA 1949 (UK) s.7(1). The “not substantially different” test did not change under the law of the UK between the pre-1988 Act and post-1988 Act law, and is explained at para.3-185, et seq. A significant difference in the scope of infringing acts was the introduction via the 1988 Act of infringement by providing a kit of parts; this is not in the Designs Act 1953 (NZ) and in this respect it follows pre-1988 Act UK law: see para.3-174.

¹⁰⁷ See para.3-216.

¹⁰⁸ The Designs Act 1953 (NZ) s.12.

¹⁰⁹ The Designs Act 1953 (NZ) s.7(2).

¹¹⁰ See para.2-235.

¹¹¹ As Act 25 of 2000.

“being features which in the finished article appeal to and are judged by the eye” which were in the UK Act. This appears to have been a deliberate change to widen protection to designs which do not have eye appeal, although the practical extent of this widening may be limited by the continued exclusion of features which are dictated solely by function.¹¹²

11-045 The second difference is the inclusion of an additional subs.(b)(iii) which excludes interconnection features from design protection. This is modelled on the “must fit” exception to UK unregistered design rights in Copyright, Designs, and Patents Act 1988 s.213(3)(b)(i) (UK). Presumably, this feature of UK law was included in the Singapore Act because of the risk that the omission of the requirement of “eye appeal” might otherwise result in such features being monopolised by registered designs.

11-046 The third difference is that the definition of “design” expressly includes designs that are applied to “non-physical products”. The introduction of this new facet in the definition of “design” was a move in recognition of and preparation for the rising importance of products that do not take a physical form.¹¹³

Registrability

11-047 A design is registrable under the Act if it is “new” (s.5(1)). This is defined by s.5(2) using largely the same language as s.1(4) of the RDA(A). Like the RDA(A), the Act does not specify when a design would be considered “new”. Instead, the Act states that a design is not “new” if it is the same as a design in a prior application (whether for the same or a different article) or the same as a prior published design, or if it differs from such a design “only in immaterial details” or in features which are “variants commonly used in the trade”. However, whilst under the old UK law under the UK RDA(A) the available prior art was limited to that published in the UK, the Singapore Act in s.5(2)(b) widened the ambit of available prior art to worldwide publication through the inclusion of the words “in Singapore or elsewhere” as a deliberate policy choice. This choice appears to have been stimulated at least in part by an absurdity which arose under the previous system where UK registered designs were extended to Singapore, where it appeared at first that a UK registered design extending to Singapore could not be invalidated by virtue of prior art published in Singapore because the UK Act (which governed its validity) excluded such prior art from consideration.¹¹⁴

11-048 Although the Act includes designs applied to non-physical products, computer programs are excluded from the Act as they are within the ambit of copyright law

¹¹² See *Nagasima Electronic Engineering Pte Ltd v APH Trading Pte Ltd* [2005] 2 S.L.R. 641; [2005] S.G.H.C. 59, where Lai Kew Chai J held that the design of two electrical signal connectors hidden behind a face plate was dictated by function, since they were in large part dictated by relevant international standards, and further that the approach of the House of Lords in *Amp v Utilux* [1971] F.S.R. 572 (see para.3-056) should be followed in interpreting this provision of the Singapore Act.

¹¹³ Singapore Parliamentary Debates, Official Report 8 May 2017, Second Reading of Registered Designs (Amendment) Bill, Vol 94, Senior Minister of State for Law, Ms Indraneel Rajah. The Minister named a “virtual keyboard”, which is projected by light onto a surface and used to type characters in the same manner as a physical computer keyboard, as an example of a non-physical product. The term “non-physical product” is defined in s.2 of the Act.

¹¹⁴ *Solite Impex Pte Ltd v Ang Lay See* [1997] SGHC 135, where the High Court found itself constrained by the wording of s.1(4) of the RDA(A) and accepted the argument reluctantly at [18]. However, the Court of Appeal in *Ang Lay See v Solite Impex Pte Ltd* [1998] 1 SLR(R) 421 reversed the decision since the consequences of upholding the validity of the design in respect of Singapore in such circumstances were so absurd.

in Singapore.¹¹⁵ Designs applied to sculptures, wall plaques, medals and medallions, or printed matter primarily of a literary or artistic character are also excluded from registration.¹¹⁶

Notably, the Intellectual Property Office of Singapore (“IPOS”) has clarified that a Graphical User Interface (“GUI”) is registrable as long as it meets the definition of “design” in s.2(1) of the Act. In 2018, IPOS published a Practice Direction¹¹⁷ explicitly acknowledging that GUIs can be registered as designs applied to physical products, non-physical products, or both. The Practice Direction also accommodates the registration of dynamic or animated GUIs, setting out helpful instructions on how would-be proprietors should register them using static images.

Third party consent is required for the registration of designs of certain natures. These include the representation of the name, initials or armorial bearings of entities such as a state, society, government body or institution, among others,¹¹⁸ or if the name or representation of any living or recently dead person appears on the design.¹¹⁹

Infringement

The test for infringement under s.30(1) is the “not substantially different” test drawn from RDA(A) s.7(1). The infringing acts (including making moulds, etc. or kits) are also closely modelled on those in RDA(A) s.7.

The Singapore Court applies a two-step test to determine whether a design is “substantially different” from another. First, the court will assess and identify the essential or significant features of the registered design having regard to the statement of novelty, relevant prior art and functional exclusions. Focus is placed on features that have “eye appeal”. Secondly, the court will compare the registered design with the alleged infringement to assess whether visually the latter has incorporated all the design features which, as a result of the first step, are considered to be essential parts of the registration.¹²⁰

In applying this test, the court will have regard to the registered design as a whole, considering *all* of its features in its analysis¹²¹:

“A registered design includes all its features, those which are novel and those which are not, and must be looked at as a whole, and the comparison exercise conducted must have regard to the design as a whole. There will be no infringement, if the alleged infringement is substantially different from the registered design looked at as a whole.”

The Singapore courts may also account for the imperfect recollection from the

¹¹⁵ Registered Designs Act (Cap 226, Rev Ed 2005) s.7(1).

¹¹⁶ Registered Designs Rules (Rev Ed 2002) r.9.

¹¹⁷ Intellectual Property Office of Singapore, Practice Direction No. 4 of 2018, dated 20 June 2018.

¹¹⁸ Registered Designs Act (Cap 226, Rev Ed 2005) s.10.

¹¹⁹ Registered Designs Act (Cap 226, Rev Ed 2005) s.11.

¹²⁰ *Hunter Manufacturing Pte Ltd v Soundtex Switchget & Engineering Pte Ltd* [1999] 3 SLR(R) 1108 at [69]–[72]. Though the Court of Appeal applied this test within the context of the old regime of the RDA(A) that was applied by virtue of the United Kingdom Designs (Protection) Act in Singapore, the High Court in *Nagasima Electronic Engineering Pte Ltd v APH Trading Pte Ltd* [2005] 2 S.L.R. 641 noted at [18] that the provisions of the Act are “almost identical” to those of the RDA(A), and referred at [22] to the test of infringement as expressed in *Hunter Manufacturing*.

¹²¹ *Hunter Manufacturing Pte Ltd v Soundtex Switchget & Engineering Pte Ltd* [1999] 3 SLR(R) 1108 at [70]. For the features the Court of Appeal identified in respect of an electrical meter box, see [73].

perspective of a customer¹²²:

“I think it is right that in considering whether there is or is not a substantial difference I should bear in mind the concept of what is commonly and quite appropriately called imperfect recollection. At the same time I should also bear in mind that a customer’s recollection may be related to or influenced by functional features which are excluded in design copyright”

11-055 The remedies for infringement of a registered design include the order for an injunction restraining further use of the infringing design, delivery up of the infringing articles and any items predominantly used in making the articles,¹²³ the disposal of the infringing articles,¹²⁴ the recovery of damages, or an order for an account of profits. However, damages and an account of profits may not be awarded if the infringing party proves that at the date of the infringement, he was not aware, and had no reasonable grounds for believing, that the design in question was registered.¹²⁵

11-056 Parties that face groundless threats of infringement can seek relief in the forms of an injunction against further threats, a declaration of non-infringement, and damages in respect of losses that were sustained by the threats.¹²⁶ The Singapore Court of Appeal has, in considering similar groundless threats provisions from other Singapore statutes protecting intellectual property rights, recognised that this relief is intended to prevent the use of unjustified threats to unfairly injure competitors. It therefore rejected the argument that private letters of demand can never amount to a groundless threat.¹²⁷ These remedies would not automatically be granted when a claim for infringement fails as they are of a discretionary nature.¹²⁸

11-057 The Act also exempts specific acts as non-infringing acts, including acts for a private non-commercial purpose, or acts for the purposes of evaluation, analysis, research or teaching. Unlike the current RDA(E) in force in the UK, however, no exception is carved out for use of registered designs in relation to ships or aircraft registered in another country but temporarily in Singapore.¹²⁹

Other Features

11-058 The maximum term of a registered design in Singapore is 15 years (under s.21(1) and (2), which provide for an initial term of five years and two successive five-year renewals on payment of an extension fee).

11-059 The Designs Registry of IPOS examines design registration applications for formalities only and does not carry out a substantive examination.

11-060 It is a criminal offence to make false representations that a design applied to an

¹²² *Sebel Furniture Ltd v Tiong Hin Engineering Pte Ltd* [1998] 3 SLR(R) 690 at [25].

¹²³ Registered Designs Act (Cap 226, Rev Ed 2005) s.40.

¹²⁴ Registered Designs Act (Cap 226, Rev Ed 2005) s.41.

¹²⁵ Registered Designs Act (Cap 226, Rev Ed 2005) s.39(1).

¹²⁶ Registered Designs Act (Cap 226, Rev Ed 2005) s.30(5).

¹²⁷ *Singsung Pte Ltd v LG 26 Electronics Pte Ltd (trading as L S Electrical Trading)* [2016] 4 SLR 86 at [122]–[148].

¹²⁸ *Singsung Pte Ltd v LG 26 Electronics Pte Ltd (trading as L S Electrical Trading)* [2016] 4 SLR 86 at [148].

¹²⁹ Registered Designs Act (Cap 226, Rev Ed 2005) s.30(5), cf. Registered Designs Act 1949 s.7A(2)(d)–(f). And see para.2-153.

article or non-physical product disposed of by the representor is registered.¹³⁰ It is also an offence to make or cause a false entry to be made in the Register, or to make or cause to be made anything that falsely purports to be a copy of an entry in the Register.¹³¹

¹³⁰ Registered Designs Act (Cap 226, Rev Ed 2005) s.66.

¹³¹ Registered Designs Act (Cap 226, Rev Ed 2005) s.65.