

Intellectual Property (Miscellaneous Amendments) Bill

Bill No. /2012.

Read the first time on .

A BILL

i n t i t u l e d

An Act to amend the Plant Varieties Protection Act (Chapter 232A of the 2006 Revised Edition), the Registered Designs Act (Chapter 266 of the 2005 Revised Edition) and the Trade Marks Act (Chapter 332 of the 2005 Revised Edition) mainly to streamline certain registry procedures and processes under those Acts.

Be it enacted by the President with the advice and consent of the Parliament of Singapore, as follows:

Short title and commencement

1. This Act may be cited as the Intellectual Property (Miscellaneous Amendments) Act 2012 and shall come into operation on such date as the Minister may, by notification in the *Gazette*, appoint.

5 Amendment of Plant Varieties Protection Act

2. The Plant Varieties Protection Act (Cap. 232A) is amended —

(a) by inserting, immediately after the word “an Assistant Registrar of Plant Varieties” in section 6(1), the words “or any public officer”;

10 (b) by deleting subsection (4) of section 40;

(c) by deleting the words “or (4)” in section 40(5);

(d) by deleting the words “and sealed with the seal of the Registrar” in section 40(6);

15 (e) by inserting, immediately after section 49, the following section:

“Amendment of documents

20 **49A.** The Registrar may, at the written request of a person who has made any application under this Act (including an application for a grant of protection for a plant variety), or filed a notice or other document for the purposes of this Act, or at the written request of the person’s agent, amend the application, notice or document —

(a) to correct a clerical error or an obvious mistake; or

25 (b) if the Registrar is of the opinion that it is fair and reasonable in all the circumstances of the case to do so.”;

(f) by inserting, immediately after the word “applications” in section 50(1), the words “, grants, registrations”;

30 (g) by deleting the words “before the Registrar” in section 50(1); and

- (h) by deleting the word “Registry” in section 50(3) and substituting the word “Office”.

Amendment of Registered Designs Act

3. The Registered Designs Act (Cap. 266) is amended —

- (a) by inserting, immediately after the definition of “exclusive licence” in section 2(1), the following definition: 5

“ “International Bureau” means the International Bureau of the World Intellectual Property Organisation;”;

- (b) by renumbering section 11 as subsection (1) of that section, and by inserting immediately thereafter the following subsection: 10

“(2) The application shall —

- (a) contain a request for the registration of a design;
(b) state the name and address of the applicant; and
(c) contain a clear representation of the design. 15

(3) The date on which the application is filed shall be the earliest date on which —

- (a) the fee payable under subsection (1) has been paid or is treated by the Registrar as paid; and
(b) all the requirements under subsection (2) have been satisfied.”; 20

- (c) by deleting the words “section 17” in section 18 and substituting the words “sections 17 and 18A(3)”;

- (d) by inserting, immediately after section 18, the following section: 25

“Deferment of publication

18A.—(1) An applicant may, when filing his application for registration of a design, request that any publication under section 18 of the design be deferred for the prescribed period after the date of filing of that application. 30

(2) A request under subsection (1) shall be made in the prescribed manner and accompanied by the prescribed fee.

(3) Notwithstanding section 18, the Registrar shall defer the publication under that section of a design which is the subject of a request under subsection (1) for the prescribed period referred to in that subsection.

(4) The Minister may make rules to provide for the deferment of the publication under section 18 of a registered design and for matters relating thereto.”;

(e) by inserting, immediately after subsection (5) of section 21, the following subsection:

“(6) The Minister may make rules to provide for the restoration of the registration of a design which has been removed from the Register, subject to such conditions as may be prescribed.”;

(f) by inserting, immediately after subsection (8) of section 32, the following subsection:

“(8A) A registered design or any right in it may be the subject of a charge in the same way as other personal or movable property.”;

(g) by deleting subsection (3) of section 33 and substituting the following subsection:

“(3) Subject to any agreement to the contrary, where there is more than one registered owner of a registered design, no registered owner shall, without the consent of each of the others —

(a) grant a licence for the use of the design;

(b) assign any interest in the design; or

(c) charge his share in the rights in the design.”;

(h) by inserting, immediately after subsection (4) of section 34, the following subsection:

“(5) Provision may be made by rules as to the amendment, alteration or removal from the Register of

any particulars in the Register relating to any registrable transaction.”;

- (i) by deleting the words “upon payment of the prescribed fee” in section 55(1);
- (j) by deleting the words “and sealed with the seal of the Registry” in section 55(5);
- (k) by deleting the definition of “International Bureau” in section 64A(4);
- (l) by inserting, immediately after section 72, the following section:

“Amendment of documents other than application for registration

72A. The Registrar may, at the written request of a person who has made an application (other than an application for registration of a design), or filed a notice or other document for the purposes of this Act, or at the written request of the person’s agent, amend the application, notice or document —

- (a) to correct a clerical error or an obvious mistake; or
 - (b) if the Registrar is of the opinion that it is fair and reasonable in all the circumstances of the case to do so.”;
- (m) by repealing section 73 and substituting the following section:

“Fees

73.—(1) There shall be paid in respect of applications, registrations and other matters under this Act such fees as may be prescribed.

(2) All fees collected shall be paid into the funds of the Office.

(3) Subsection (2) shall not apply to fees prescribed in rules made under section 64A(2)(e) which are to be forwarded to the International Bureau.”;

(*n*) by inserting, immediately after paragraph (*a*) of section 74(2), the following paragraph:

“(aa) as to the practice and procedure of any proceedings or other matter before the Registrar;”;

5 (*o*) by deleting the word “and” at the end of section 74(2)(*m*); and

(*p*) by deleting the full-stop at the end of paragraph (*n*) of section 74(2) and substituting the word “; and”, and by inserting immediately thereafter the following paragraph:

10 “(*o*) for the reinstatement, and the conditions for the reinstatement, of —

(i) any application which is treated as withdrawn; or

15 (ii) any right which has been abrogated, or thing which has ceased to be in force or to exist, by reason of a failure to comply with any time limit which has been prescribed or which the Registrar has specified.”.

Amendment of Trade Marks Act

4. The Trade Marks Act (Cap. 332) is amended —

20 (*a*) by deleting the definition of “international trade mark (Singapore)” in section 2(1) and substituting the following definitions:

““International Bureau” has the meaning given by Article 2(1) of the Madrid Protocol;

25 “international trade mark (Singapore)” means a trade mark which is entitled to protection in Singapore under the Madrid Protocol, or a trade mark prescribed by the Minister (by rules made under section 54) as an international trade mark (Singapore);

30 “Madrid Protocol” means the Protocol relating to the Madrid Agreement concerning the International Registration of Marks, adopted at Madrid on

27th June 1989, as revised or amended from time to time;”;

(b) by deleting subsection (4) of section 54;

(c) by deleting the words “; and any person who applies for an uncertified copy or extract shall be entitled to such a copy or extract on payment of the prescribed fee” in section 68(3); and

(d) by deleting the words “and sealed with the seal of the Registrar” in section 68(5).

Savings and transitional provisions

5.—(1) Section 3(b) shall not apply to any application for registration of a design that is filed before the date of commencement of section 3(b), and section 11 of the Registered Designs Act in force immediately before that date shall continue to apply to every such application for registration of a design as if section 3(b) had not been enacted.

(2) For a period of 2 years after the commencement of this subsection, the Minister may, by order published in the *Gazette*, prescribe such other provisions of a savings or transitional nature consequent on the enactment of this Act as he may consider necessary or expedient.

EXPLANATORY STATEMENT

This Bill seeks to amend the Plant Varieties Protection Act (Cap. 232A), the Registered Designs Act (Cap. 266) and the Trade Marks Act (Cap. 332) mainly to streamline certain registry procedures and processes under those Acts.

The Bill also makes certain miscellaneous housekeeping amendments to the Registered Designs Act and the Trade Marks Act.

Clause 1 relates to the short title and commencement.

Clause 2 contains the amendments to the Plant Varieties Protection Act.

Clause 2(a) amends section 6(1) of the Plant Varieties Protection Act to empower the Registrar of Plant Varieties to delegate all or any of his powers and functions under that Act (except the power of delegation) to any public officer. Today, the

Registrar of Plant Varieties can only delegate to an Assistant Registrar of Plant Varieties appointed by the Minister.

Clause 2(*b*) deletes section 40(4) of the Plant Varieties Protection Act, and clause 2(*c*) amends section 40(5) of that Act, to abolish the right to apply for or obtain an uncertified copy of an entry in the register of plant varieties or an uncertified extract from that register.

Clause 2(*d*) amends section 40(6) of the Plant Varieties Protection Act, as the Registry of Plant Varieties will no longer seal any certified copy of an entry in the register of plant varieties or any certified extract from that register.

Clause 2(*e*) inserts a new section 49A into the Plant Varieties Protection Act to enable the Registrar of Plant Varieties, at the written request of a person (or his agent) who has made an application under that Act, or filed a notice or other document for the purposes of that Act, to amend the application, notice or document in certain circumstances.

Clause 2(*f*) and (*g*) amends section 50(1) of the Plant Varieties Protection Act to expressly provide for the payment of fees for grants, registrations and other matters (whether or not before the Registrar of Plant Varieties) under that Act.

Clause 2(*h*) amends section 50(3) of the Plant Varieties Protection Act to provide for all fees collected under that Act to be paid into the funds of the Intellectual Property Office of Singapore, of which the Registry of Plant Varieties is a part, instead of the funds of that Registry.

Clause 3 contains the amendments to the Registered Designs Act.

Clause 3(*a*) and (*k*) transfers the definition of “International Bureau” from section 64A(4) of the Registered Designs Act to section 2(1) of that Act, as the term “International Bureau” will be used not only in section 64A of that Act but also in the new section 73 of that Act (to be inserted by clause 3(*m*)).

Clause 3(*b*) amends section 11 of the Registered Designs Act to provide for the minimum requirements that must be satisfied before an application for registration of a design is regarded as filed.

Clause 3(*c*) and (*d*) amends section 18 of the Registered Designs Act and inserts a new section 18A into that Act, respectively, to provide for the deferment of the publication under section 18 of that Act of a registered design.

Clause 3(*e*) inserts a new subsection (5) into section 21 of the Registered Designs Act to expressly empower the Minister to make rules to provide for the restoration of the registration of a design which has been removed from the Register of Designs.

Clause 3(*f*) inserts a new subsection (8A) into section 32 of the Registered Designs Act to clarify that a registered design or any right in it may be the subject of a charge.

Clause 3(*g*) deletes and substitutes section 33(3) of the Registered Designs Act to provide that where there is more than one registered owner of a registered design, none of the registered owners shall, without the consent of each of the others, in addition to granting a licence for the use of the design or assigning any interest in the design (as provided under the present law), charge his share in the rights in the design. The registered owners may contract amongst themselves to displace this statutory restriction.

Clause 3(*h*) inserts a new subsection (5) into section 34 of the Registered Designs Act to expressly empower the making of rules to provide for the amendment, alteration or removal from the Register of Designs of any particulars in that Register relating to any registrable transaction referred to in section 34(2) of that Act. Examples of such registrable transactions include an assignment of a registered design or any right in it, the grant of a licence or sub-licence for the use of a registered design, and the grant of any security interest (whether fixed or floating) over a registered design or any right in it.

Clause 3(*i*) amends section 55(1) of the Registered Designs Act as the Intellectual Property Office of Singapore, of which the Registry of Designs is a part, has ceased to charge a fee for the inspection of the Register of Designs.

Clause 3(*j*) amends section 55(5) of the Registered Designs Act as the Registry of Designs will no longer seal any certified copy of an entry in the Register of Designs or any certified extract from that Register.

Clause 3(*l*) inserts a new section 72A into the Registered Designs Act to enable the Registrar of Designs, at the written request of a person (or his agent) who has made an application (other than an application for registration of a design), or filed a notice or other document for the purposes of that Act, to amend the application, notice or document in certain circumstances.

Clause 3(*m*) repeals and re-enacts section 73 of the Registered Designs Act to align that section with section 77(1), (3) and (4) of the Trade Marks Act.

Clause 3(*n*) inserts a new paragraph (*aa*) into section 74(2) of the Registered Designs Act to expressly provide for the making of rules as to the practice and procedure of any proceedings or other matter before the Registrar of Designs.

Clause 3(*o*) and (*p*) amends section 74(2) of the Registered Designs Act —

- (*a*) by inserting a new paragraph (*o*) to expressly provide for the making of rules for the reinstatement, and the conditions for the reinstatement, of any application under that Act which is treated as withdrawn, or of any right under that Act which has been abrogated, or thing under that Act which has ceased to be in force or to exist, by reason of a failure to comply with any time limit which has been prescribed under that Act or which the Registrar of Designs has specified; and

- (b) to make consequential amendments of a technical nature to section 74(2)(m) and (n).

Clause 4 contains the amendments to the Trade Marks Act.

Clause 4(a) and (b) deletes the existing definition of “international trade mark (Singapore)” in section 2(1) of the Trade Marks Act, transfers the definitions of “International Bureau”, “international trade mark (Singapore)” and “Madrid Protocol” in section 54(4) of that Act to section 2(1) of that Act, and deletes section 54(4) of that Act, as —

- (a) the term “International Bureau” is used not only in section 54 of that Act but also in section 77(4) of that Act;
- (b) the term “international trade mark (Singapore)” is used not only in section 54 of that Act but also in the definition of “earlier trade mark” in section 2(1) of that Act;
- (c) the term “Madrid Protocol” will be used not only in section 54 of that Act but also in the new definitions of “International Bureau” and “international trade mark (Singapore)” to be inserted (by clause 4(a)) into section 2(1) of that Act; and
- (d) upon the transfer of the definitions in section 54(4) of that Act to section 2(1) of that Act, section 54(4) of that Act will be redundant.

Clause 4(c) amends section 68(3) of the Trade Marks Act to abolish the right to apply for or obtain an uncertified copy of an entry in the register of trade marks or an uncertified extract from that register.

Clause 4(d) amends section 68(5) of the Trade Marks Act, as the Registrar of Trade Marks will no longer seal any certified copy of an entry in the register of trade marks or any certified extract from that register.

Clause 5 contains savings and transitional provisions.

EXPENDITURE OF PUBLIC MONEY

This Bill will involve the Government in extra financial expenditure, the exact amount of which cannot at present be ascertained.