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April / May 2017

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Amendments to the Registered Designs Act

As Singapore's design industry continues to develop, trends in technology and design have prompted the Ministry of Law to announce pertinent changes to the Registered Design Act ("**RDA**").

The Registered Designs (Amendment) Bill was read on 3 April 2017 and key changes include:

- (1) a widened scope of registrable designs;
- (2) shifting ownership from the commissioning party to the designer; and
- (3) simplifying the procedural scheme for filing registered designs.

Widened scope of registrable designs

Designers will be enabled to register colours as a design feature, thereby allowing colours to be protected as design features in their products.

Also, the scope of registrable designs have been broadened to include virtual designs of non-physical products that can be projected onto a surface and have useful functions, including items such as a virtual keyboard.

Shifting the ownership of rights

The current default position is that the commissioning party is deemed to be the owner of rights, and not the creator or designer. The proposed change is that ownership will vest in the commissioning party, subject to any agreement to the contrary between the parties concerned.

This change marks an important shift in the design industry landscape and is intended to minimise instances of designers and creators inadvertently ceding their registered design rights.

Simplifying the procedural scheme for filing registered designs

Currently, a designer cannot publicly disclose his / her design before filing for protection. If the design is disclosed, the designer must then file for protection of the design within 6 months of the disclosure. Further, the application will be accepted only under limited circumstances, such as where the disclosure was by a third party in breach of good faith.

Now, the window for registration upon disclosure of the design is doubled to 12 months, and includes all situations where disclosure was by the designer.

Further, the new scheme allows registration of multiple designs under the same broad category and through a single application.





Stylisation may not confer distinctiveness - *Marvelous AQL Inc.* [2017] SGIPOS 3

Facts

Marvelous AQL Inc. (the “**Applicant**”) applied to register (the “**Mark**”) in Classes 9, 16, 28 and 41 for a variety of goods and services.

The Registrar objected on grounds of Section 7(1)(b) and 7(1)(c) of the Trade Marks Act, i.e. that the Mark was descriptive, and non-distinctive.

The Applicant accepted that the word had a laudatory descriptive meaning, but argued that the registration ought to be accepted for the following reasons:

- having a laudatory element in the Mark would not render it descriptive if the Mark does not serve to “directly and specifically designate or describe the goods and services”;
- there was sufficient stylisation in the Mark such that it was not devoid of any distinctive character; and
- the Registrar had, in the past, allowed registration of marks which the Applicant considered to be descriptive.

Decision

The Registrar rejected the arguments against descriptiveness, since the EU cases that the Applicant relied on were dated, and the EU developments clarified that:

- a sign must be refused registration under the provision if at least one of its possible meanings designates a characteristic of the goods or services concerned; and
- it is unnecessary that the signs and indications composing the mark actually be in use at the time of the application for registration in a way that is descriptive of the goods or services. Rather, it is sufficient that the mark could be used for such purposes.

On the facts, the laudatory term “MARVELOUS!” would indicate to consumers the kind or quality (i.e. superb, excellent, great) or intended purpose (i.e. to cause one to marvel in wonder, admiration or surprise). Further, the Registry held that the Mark, used normally, would indicate the type or quality or intended purpose of the goods or services to consumer, and that it was therefore descriptive.

The Registrar also found the stylisation of the Mark to be minor and insufficient to provide the Mark any distinctive character.

Finally, the Registrar held that a mark’s registrability had to be considered on the facts of each case and considered the past registrations as being of no assistance.



Comments

Trade mark applicants should consider not just stylisation, but the necessary degree of stylisation required to imbue the mark with distinctiveness. These considerations are all the more necessary where the applicant mark is a descriptive word.



Post-sale support may amount to evidence of use in Singapore - *Bigfoot Internet Ventures Pte Ltd v Apple Inc.* [2017] SGIPOS 4

Facts

Bigfoot Internet Ventures Pte Ltd ("**Bigfoot**") filed an action to revoke, on the basis of non-use, the registered trade mark "SHERLOCK" covering computer software in Class 9 in the name of Apple Inc. ("**Apple**").

Apple's "SHERLOCK" software was a search application integrated into version 8.5 of its Macintosh computer operating system. The "SHERLOCK" search tool was progressively updated along with newer versions of the Macintosh operating system through software updates.

Decision

The Registrar referred to Apple's submissions highlighting the position the European Court of Justice had taken in *Ansul BV V Ajas Brandbeveiliging BV* [2003] IP & T 970 acknowledging that use of a mark in connection with goods that were no longer newly traded could nonetheless constitute genuine use provided that the proprietor makes actual use of the same mark for component parts that are integral to the make-up or structure of such goods, or for goods or services directly connected with the goods previously sold and intended to meet the needs of customers for those goods.

On the present facts, the Registrar was satisfied that the "SHERLOCK" software application was further supported through progressive upgrades. She took the view that these progressive updates sufficed as component parts which were directly connected with the Macintosh operating system and intended to meet the needs of customers for these software goods.

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Comments

This case confirms the position that online, post-sale support in the form of upgrades and updates, specifically for software goods, could potentially amount to evidence of use in Singapore. This position provides proprietors with an alternative to maintain continuous use of a mark without actually manufacturing the actual goods. As long as there is use of a mark in relation to component parts integral to the make-up of the actual goods, this may constitute use sufficient to defend against a non-use revocation action.

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