

Managing Intellectual Property

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Trade Marks (Amendment) Act 2007

The Trade Marks (Amendment) Act 2007 (TMA) was passed on January 22 2007. The TMA, Trade Marks (Amendment) Rules 2007 (TMR) and Trade Marks (International Registration) (Amendment) Rules 2007 has taken effect on July 2 2007. Highlights of the amendments are summarized below.

Multiple class registration

Most significantly, a trade mark owner may file a single trade mark application for a mark in respect of two or more goods or service classes, with a view to securing a single registration. Consequently, the mark owner need only renew that single registration for the renewal to be effective for all the classes of goods and services registered. These amendments facilitate trade mark administration and management as there will be a consolidated official examination letter (if any) issued, giving one deadline, and only one trade mark number to renew.

The official fees for filing an application remain chargeable on a per class basis. However, ancillary applications such as the updating of address for service, recordal of assignment/merger and recordal of licence are chargeable on a per application/registration basis.

Division of application for registration

This amendment complements the system of multiple class registration, by allowing an application for registration of a mark to be divided (for a fee) into two or more separate applications. The original application need not be a multiple class application before it may be divided. However, an International Registration designating Singapore cannot be divided and only national applications made on or after July 2 2007 may be divided.

A divided application shall have the same filing date as the original application. Any priority that was claimed in the original application will also apply to the divided application claiming the applicable goods/services. A divisional serial number will be assigned to the new additional application.

The division of an application is particularly useful where there are objections raised by an examiner in respect of some classes or where there is an opposition in respect of some classes. By isolating the problematic classes in this manner, the registration of the other classes which are not facing any objections or oppositions will not be held back and may then be able to proceed to registration expeditiously.

Licences relating to pending marks

The amendments also allow for the recordal of licences relating to pending marks. Previously, only licences relating to registered marks can be recorded on the register. A transitional provision in this regard permits the recordal of a licence for pending applications filed before July 2 2007, provided the recordal application is made on or after this date.

Relief for procedural oversight

The TMA further provides for relief measures to alleviate the effects of missed deadlines. These enable an applicant to maintain (for a fee) his rights in an application that has been filed, even when a time limit to act has been overlooked.

An applicant who has missed a time limit for action before the Registry, may (subject to certain exceptions) have his rights reinstated if the following conditions are met:

- the reinstatement application is filed within six months from the date of expiration of the time limit;
- the omitted act is completed together with the application; and
- the failure to comply with the time limit is unintentional.

It should be noted that such reinstatement is only applicable to time limits prescribed/specified by the Registrar on or after July 2 2007. In addition, it does not apply to certain types of deadlines, such as those to claim priority;

those in opposition, revocation or invalidation proceedings; or those to pay renewal fees.

Further, the Registrar may refuse a reinstatement application if there is a good and sufficient reason to do so, such as in the case where an up-to-date search reveals that a conflicting mark had been filed during the period when the mark of the applicant for reinstatement was treated as withdrawn.

Singapore Treaty on the Law of Trademarks

The latest amendments give effect to the Singapore Treaty on the Law of Trademarks, which was adopted by the Diplomatic Conference for the Adoption of a Revised Trademark Law Treaty that took place in Singapore in March 2006. The Singapore Treaty is aimed at creating a dynamic and modernized international framework for the harmonization of administrative trade mark registration procedures. It is not in force yet but will take effect three months after 10 WIPO member states or qualifying intergovernmental organizations having a regional trade marks office have deposited their instruments of ratification or accession.

The Singapore Treaty represents yet another progressive step in the evolution of Singapore's IP regime. Further developments upon its coming into force are awaited (so far, one WIPO member state, Singapore, has ratified it).



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