



## Upcoming Reform: Registered Designs Regime in Singapore

### A. Introduction

In light of the recent technological advances and evolving business practices in the designs industry, the Ministry of Law (the “**MinLaw**”) and the Intellectual Property Office of Singapore (the “**IPOS**”) commenced their review of the registered designs regime in Singapore in 2014, conducting 2 rounds of public consultations, and numerous focus group talks and one-to-one consultations with design associations, business, IP practitioners and academics. They have completed their joint review and released a “Final Report on the Review of Singapore’s Registered Designs Regime”, which sets out their recommendations to amend the Registered Designs Act (the “**RDA**”) to keep abreast of the changes in the industry.

### B. Aims

The proposed reform is to complement the “Design 2025 Masterplan” released by DesignSingapore Council in March 2016, which sets out the government initiatives and policy framework to develop Singapore into a creativity- and innovation-driven economy and ecosystem by supporting capitalisation of the intellectual property in Singapore. Design is identified as one of the key pillars and catalysts to propel such a paradigm shift.

In the meantime, it seeks to protect interests of the users and the public, support business certainty and remain in line with international best practices, especially with other major markets. The MinLaw and IPOS have therefore taken into account different interests of all stakeholders and decided to implement some changes to the current designs regime to provide for sustainability and growth of the designs industry in Singapore.

### C. Upcoming Amendments/Changes to the RDA

The impending amendments/changes to the RDA do not involve a large-scale revamping of the regime but attempt to make it easier for designers to protect their creative works by enhancing the existing regime. Some of the salient amendments/changes to be made to the RDA are as follows:-

- (i) Expansion of the Scope of Registrable Designs

To give effect to the underlying objective of granting design rights, which is to incentivise creativity and innovation, the MinLaw and IPOS recognise the need to update the definition of “design” to keep Singapore’s designs regime relevant to the technological advances and evolving business models. References were made to the regimes in other major jurisdictions such as the UK, EU and Australia.

The following changes will therefore be made to the RDA so as to provide for a broader scope of registrable designs:-

- **Protection extended to virtual or projected designs:** As with the UK and EU, designs that can be projected onto a surface (even into space) will also be protected under the registered designs regime *post* amendments to the RDA. Such designs must (a) be capable of being represented clearly and without subjectivity; and (b) retain the same (or substantially similar) design features irrespective of the surface or medium they are projected on.
- **Protection extended to designs of artisanal or handcrafted items:** The evolution of relevant technologies (e.g. 3D printing) and business models (e.g. sales *via* internet) have resulted in growth of artisanal businesses. Cognisant of such changes, Singapore feels the need to provide an avenue to protect such designs and has therefore decided to extend its registered designs protection to artisanal or handcrafted items by removing the requirement for the design to be “applied by an industrial process” in the RDA.
- **Colours recognised as one design feature:** Noting the importance of colour components in designs, the amended RDA will also recognise colour as a design feature. However, the scope of protection will not extend to colour *per se* as colour on its own is not sufficient to satisfy novelty and there are only limited pool of available colours monopolising of which may result in stifling design innovation.
  - (ii) Ownership of the Design lies with the Designers/Creators by Default (Commissioned Work)

According to the RDA as it stands today, the ownership of a design usually falls on the creator by default. However, this is subject to two exceptions, namely (a) commissioned works, and (b) works created in the course of employment, unless otherwise agreed by the parties.

With reference to commissioned works where the commissioner becomes the owner of the design by default, it was recognised that the current regime is disadvantageous to SMEs and independent designers who may not be aware of such legal provisions. This is also not in line with other major jurisdictions such as EU, US and Japan.

The RDA will therefore be amended to make the designers/creators the owner of their own work by default by removing the existing provision that automatically treats the commissioner as the owner.

However, parties will continue to be at liberty to contract out of such default ownership.

(iii) Extension and Broadening of Grace Period for Registration

In Singapore, designers cannot disclose their designs before filing if they wish to seek protection under the current registered designs regime. However, if a disclosure was made at select international exhibitions, they are allowed a grace period to 6 months from the first disclosure to file their applications for registration.

In an effort to provide more opportunity for designers to seek protection under the regime, the RDA will be amended to (a) increase the length of the grace period to 12 months; and (b) remove the requirement that disclosures can only be made at select international exhibitions.

With the upcoming changes in the RDA, designers will be given opportunities to test the market response to their designs before proceeding to register it and have better protection against losing their rights unintentionally.

(iv) Allow Multiple Designs within the Same Locarno Classification to be Filed in One Application

According to the current designs regime in Singapore, designers are allowed to file one application for designs within the same Locarno sub-classification. Each design however, is accorded separate application numbers and treated as individual applications and require separate fees for registration and renewal at no reduced fees.

In the course of review, references were made to designs regimes in EU, UK and WIPO, which are regimes that do not conduct substantive examination for design applications as with Singapore. In an effort to further reduce administrative burden on the part of Registra and reduce costs on the part of the applicant, a proposal was made to broaden the sub-classification condition to classification, which in turn may reduce the costs involved with subsequent designs within the same application. This proposal was met with positive feedback on consultations.

The RDA will therefore be amended to allow multiple designs in the same Locarno classification to be filed in one application.

D. Other Topics Discussed in the Review

A number of other suggestions were considered and discussed during the review, but were ultimately decided not to be included in this round of revision. Some of the salient points discussed are set out below:-

- (i) **Utility models:** Designs protection would not be extended to include utility models in light of counterweighing interest of users/public and insufficient evidence to support that its introduction would spur innovation and economic growth.
- (ii) **Maintain minimal overlap with copyright protection:** Reaffirmed the policy position that designs of useful articles/products should seek protection under the designs regime while those with no intrinsic utilitarian function other than to carry the design should seek protection under the copyright regime.
- (iii) **Maintain minimal overlap with trade marks protection:** The current provisions in s7(3) of the Trade Marks Act shall be maintained and shapes therefore will continue to be excluded from the protection provided under the trade marks regime.
- (iv) **“Dynamic designs”:** Affirmed not to broaden the scope of design protection to cover designs that are applied onto dynamic or fluid medium (e.g. water) due to lack of consistency in the reproduction of design and high level of subjectivity involved in application for registration. Meanwhile, the registrability of designs such as graphic user interfaces shall be maintained, as is currently provided in the RDA.
- (v) **3D designs:** No amendment shall be made to specifically address 3D design as legislative intervention did not appear necessary at this stage. However, they will continue to monitor its progress and will intervene in a timely manner, if so required.
- (vi) **Unregistered design rights:** No introduction of a new unregistered design rights in Singapore. It was opined that the disadvantages of introducing unregistered designs protection (e.g. difficulty in enforcement; business uncertainty) would outweigh the advantages (e.g. fall-back option).
- (vii) **Partial designs:** Affirmed current position to allow protection for partial designs as it was viewed that they are relevant and important to support current and future business trends and needs.
- (viii) **Substantive examination:** No introduction for design applications as it was viewed that its disadvantages would outweigh advantages.

E. Moving Forward

The review shows Singapore's continued commitment to keep its intellectual property regimes up to date with current design trends and business practices. This is especially so in light of the fact that the current RDA is based on the old UK RDA, which has already undergone significant evolution over the years following the introduction of the EU community designs regime in 2002 and UK Intellectual Property Act 2014.

In addition to the amendments to the RDA, guidance notes on specific areas relating to the registered designs regime shall be provided to the public so as to raise public awareness and attain increased certainty in implementation of the Act, particularly in the area of infringement.

With the upcoming reform of designs regime in Singapore, designers, practitioners and entrepreneurs are encouraged to make use of the enhanced regime and capitalise designs, which in turn will contribute to creating creative industries spurring economic growth and job creation. In furtherance of the same, Singapore will continue to conduct outreach and information sessions in partnership with the industry to review its intellectual property regimes regularly and strive to raise public awareness.



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*This article is intended to highlight the salient issues relating to the upcoming reform to the Registered Designs Regime in Singapore, and it is not intended to be comprehensive nor should it be construed as legal advice. This article is updated as at 5 October 2016.*