

Trade Marks (Amendment) Bill

Bill No. 15/2006.

Read the first time on 8th November 2006.

A BILL

intituled

An Act to amend the Trade Marks Act (Chapter 332 of the 2005 Revised Edition).

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 Trade Marks (Amendment) Act 2006 and shall come into operation on such date as the Minister may, by notification in the *Gazette*, appoint.

5 **New section 5A**

2. The Trade Marks Act (referred to in this Act as the principal Act) is amended by inserting, immediately after section 5, the following section:

“Division of application for registration

10 **5A.**—(1) Subject to this section and any rules made under subsection (3), an application for registration of a trade mark may, at the request of the applicant, be divided into 2 or more separate applications for registration of the trade mark.

(2) A request under subsection (1) —

(a) shall be made to the Registrar —

15 (i) in the prescribed manner; and

(ii) before the trade mark is registered; and

(b) shall be subject to the payment of such fee as may be prescribed.

20 (3) The Minister may make rules for the purposes of this section and may, in those rules, provide for —

(a) the circumstances in which an application for registration of a trade mark may be divided;

(b) the conditions to be satisfied before a request under subsection (1) may be granted by the Registrar; and

25 (c) the effect of dividing an application for registration of a trade mark into 2 or more separate applications for registration of the trade mark.”.

Amendment of section 17

30 **3.** Section 17(1) of the principal Act is amended by deleting the words “in respect of the same goods or services, or of similar goods or services which fall within a single class in accordance with the system of classification referred to in section 6”.

Amendment of section 41

4. Section 41 of the principal Act is amended by deleting subsections (3), (4) and (5) and substituting the following subsections:

“(3) Any person claiming to be —

- 5 (a) entitled to an interest in or under an application for registration of a trade mark by virtue of a registrable transaction; or
- (b) affected by a registrable transaction,

10 may give to the Registrar notice of the prescribed particulars of the transaction.

(4) The following are registrable transactions under subsection (3):

- (a) an assignment of an application for registration of a trade mark or any right in it;
- 15 (b) the grant of a licence under an application for registration of a trade mark;
- (c) the granting of any security interest (whether fixed or floating) over an application for registration of a trade mark or any right in or under it;
- 20 (d) the making by personal representatives of an assent in relation to an application for registration of a trade mark or any right in or under it;
- (e) an order of the Court or other competent authority transferring an application for registration of a trade mark or any right in or under it.

25 (5) The Registrar shall maintain a record of each notice given to him under subsection (3).

 (6) Until the notice referred to in subsection (3) has been given to the Registrar in respect of a transaction referred to in subsection (4)(a), (c), (d) or (e), the transaction is ineffective as against a person

30 acquiring a conflicting interest in or under the application for registration of a trade mark in ignorance of the transaction.

 (7) For the avoidance of doubt, subsection (6) shall not apply to any registrable transaction relating to —

- (a) a licence under an application for registration of a trade mark; or
- (b) any right in or under the licence.

(8) Provision may be made by rules as to —

- 5 (a) the amendment of the record maintained by the Registrar relating to the particulars of a grant of a licence under an application for registration of a trade mark, notice of which has been given to the Registrar under subsection (3), so as to reflect any alteration of the terms of the licence; and
- 10 (b) the removal from the records maintained by the Registrar of the particulars of a grant of a licence under an application for registration of a trade mark, notice of which has been given to the Registrar under subsection (3) —
 - 15 (i) where it appears from the particulars that the licence was granted for a fixed period and that period has expired; or
 - (ii) where no such period is indicated and, after such period as may be prescribed, the Registrar has notified the parties of his intention to remove the particulars from the records.
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(9) Provision may also be made by rules as to the amendment of the record maintained by the Registrar relating to, or the removal from the records maintained by the Registrar of, the particulars of the granting of a security interest over an application for registration of a trade mark on the application of, or with the consent of, the person entitled to the benefit of that interest.”

Amendment of section 108

5. Section 108 of the principal Act is amended —

- 30 (a) by deleting the words “, after consulting with the Office,” in subsection (1);
- (b) by deleting paragraph (h) of subsection (2) and substituting the following paragraph:

“(h) for the extension of any time limit which has been prescribed, or which the Registrar has specified, and which has not expired;” and

(c) by deleting paragraph (j) of subsection (2) and substituting the following paragraph:

“(j) for the reinstatement of —

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

(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,

and the conditions for such reinstatement.”.

Transitional provision

6. Section 2 shall only apply to an application for registration of a trade mark that is made on or after the date of commencement of this Act.

EXPLANATORY STATEMENT

This Bill seeks to amend the Trade Marks Act (Cap. 332) —

- (a) to provide for an application for registration of a trade mark to be divided into 2 or more separate applications for registration of the trade mark, so as to enable Singapore to give effect to Article 7 of the Singapore Treaty on the Law of Trademarks (clause 2);
- (b) to enable a person to make a single application for the registration of a series of trade marks in respect of goods or services belonging to 2 or more different classes (clause 3);
- (c) to provide for the grant of a licence under an application for registration of a trade mark to be a registrable transaction under section 41 (clause 4);
- (d) to provide for the making of certain rules for the purposes of section 41 (clause 4);
- (e) to remove the mandatory requirement for the Minister to consult the Intellectual Property Office of Singapore before he makes any rules under section 108 (clause 5(a)); and

- (f) to enable the Minister to make rules for the extension of any time limit which has not expired (clause 5(b)), and for the reinstatement of certain matters where there has been a failure to comply with a time limit (clause 5(c)), so as to enable Singapore to give effect to Article 14 of the Singapore Treaty on the Law of Trademarks.

EXPENDITURE OF PUBLIC MONEY

This Bill will not involve the Government in any extra financial expenditure.
