

Registered Designs (Amendment) Bill

Bill No. 23/2017.

Read the first time on 3 April 2017.

A BILL

intituled

An Act to amend the Registered Designs Act (Chapter 266 of the 2005 Revised Edition) and to make related amendments to the Copyright Act (Chapter 63 of the 2006 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 is the Registered Designs (Amendment) Act 2017 and comes into operation on a date that the Minister appoints by notification in the *Gazette*.

5 Amendment of section 2

2. Section 2 of the Registered Designs Act (called in this Act the principal Act) is amended —

(a) by deleting the definition of “article” in subsection (1) and substituting the following definition:

10 “ “article” means any thing that is manufactured (whether by an industrial process, by hand or otherwise), and includes —

(a) any part of an article, if that part is made and sold separately; and

15 (b) any set of articles;”;

(b) by inserting, immediately after the words “an article” in the definition of “corresponding design” in subsection (1), the words “or a non-physical product”;

20 (c) by deleting the definition of “design” in subsection (1) and substituting the following definition:

25 “ “design” means features of shape, configuration, colours, pattern or ornament applied to any article or non-physical product that give that article or non-physical product its appearance, but does not include —

(a) a method or principle of construction;

(b) features of shape, configuration or colours of an article or a non-physical product that —

30 (i) are dictated solely by the function that the article or

non-physical product has to perform;

(ii) are dependent upon the appearance of another article or non-physical product of which the article or non-physical product is intended by the designer to form an integral part; or

(iii) enable the article or non-physical product to be connected to, or placed in, around or against, another article or non-physical product, so that either article or non-physical product may perform its function; or

(c) features consisting only of one or more colours that —

(i) are not used with any feature of shape or configuration; and

(ii) do not give rise to any feature of pattern or ornament;”;

(d) by inserting, immediately after the definition of “exclusive licence” in subsection (1), the following definition:

“ “formal requirements” means —

(a) the requirements of section 11(2)(c) and (4)(a); and

(b) any other requirements of section 11, or of rules made for the purposes of that section, that are prescribed as formal requirements;”;

(e) by inserting, immediately after the definition of “International Bureau” in subsection (1), the following definition:

“ “non-physical product” —

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(a) means any thing that —

- (i) does not have a physical form;
- (ii) is produced by the projection of a design on a surface or into a medium (including air); and
- (iii) has an intrinsic utilitarian function that is not merely to portray the appearance of the thing or to convey information; and

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(b) includes any set of non-physical products;”;

(f) by deleting the full-stop at the end of the definition of “set of articles” in subsection (1) and substituting a semi-colon, and by inserting immediately thereafter the following definitions:

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“ “set of articles and non-physical products” means one or more articles and one or more non-physical products —

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(a) all of which are of the same general character and are ordinarily on sale together or intended to be used together; and

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(b) to each of which the same design, or the same design with modifications or variations not sufficient to alter the character or substantially to affect the identity of the design, is applied;

“set of non-physical products” means 2 or more non-physical products of the same general character that are ordinarily on sale together or intended to be used together, and to each of which the same design, or the same design with modifications or variations not sufficient to alter the character or substantially to affect the identity of the design, is applied.”; 5

(g) by deleting paragraph (b) of subsection (2) and substituting the following paragraphs: 10

“(b) any reference in this Act to an article in respect of which a design is registered is, in the case of a design registered in respect of a set of articles or a set of articles and non-physical products, a reference to any article of that set; 15

(ba) any reference in this Act to a non-physical product in respect of which a design is registered is, in the case of a design registered in respect of a set of non-physical products or a set of articles and non-physical products, a reference to any non-physical product of that set; and”;
and 20

(h) by inserting, immediately after subsection (2), the following subsection: 25

“(3) In this Act, unless the context otherwise requires, a device for projecting a non-physical product —

(a) is any device that when activated projects the non-physical product on a surface or into a medium (including air); and 30

(b) includes any product or component that is used in or with a device mentioned in paragraph (a) to project the non-physical 35

product on a surface or into a medium (including air).”.

Amendment of section 4

3. Section 4 of the principal Act is amended —

- 5 (a) by deleting subsection (2);
- (b) by deleting the words “, in a case not falling within subsection (2),” in subsection (3);
- (c) by deleting the words “Subsections (2) and (3) are” in subsection (4) and substituting the words “Subsection (3) is”; and
- 10 (d) by inserting, immediately after the word “article” wherever it appears in subsection (5), the words “or non-physical product”.

Amendment of section 5

15 4. Section 5 of the principal Act is amended —

- (a) by inserting, immediately after the words “an article” in subsection (1), the words “, a non-physical product, or a set of articles and non-physical products,”; and
- 20 (b) by inserting, immediately after the word “article” in subsection (2)(a) and (b), the words “, non-physical product or set of articles and non-physical products”.

Amendment of section 7

5. Section 7(3) of the principal Act is amended by inserting, immediately after the word “articles” in paragraph (a), the words “and non-physical products”.

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Amendment of section 8

6. Section 8 of the principal Act is amended —

- (a) by deleting the word “An” in subsections (1) and (2) and substituting in each case the words “Subject to subsection (2A), an”;
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(b) by inserting, immediately after subsection (2), the following subsection:

“(2A) This section only applies to —

(a) a disclosure mentioned in subsection (1)(a) or (b);

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(b) an acceptance mentioned in subsection (1)(c);

(c) a communication mentioned in subsection (1)(d), or anything done in consequence of such a communication;

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(d) a display mentioned in subsection (2)(a) or (b); or

(e) a publication mentioned in subsection (2)(c),

that occurs before the date of commencement of section 6 of the Registered Designs (Amendment) Act 2017.”; and

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(c) by deleting the section heading and substituting the following section heading:

“**Disclosure, etc., of design before certain date**”.

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New sections 8A and 8B

7. The principal Act is amended by inserting, immediately after section 8, the following sections:

“Disclosure of design on or after certain date

8A.—(1) An application for registration of a design must not be refused, and the registration of a design must not be revoked, by reason only of any of the following:

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(a) a disclosure of the design made to a person other than the designer, or any successor in title of the designer, under conditions of confidentiality (whether express or implied);

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(b) a disclosure of the design made by the designer, or any successor in title of the designer, during the period of 12 months immediately before the date of filing of the application for registration of the design;

5 (c) a disclosure of the design made by a person other than the designer, or any successor in title of the designer, during the period of 12 months immediately before the date of filing of the application for registration of the design, in consequence of information provided, or
10 any other action taken, by the designer or any successor in title of the designer;

(d) a disclosure of the design made during the period of 12 months immediately before the date of filing of the application for registration of the design, as a
15 consequence of an abuse in relation to the designer or any successor in title of the designer.

(2) This section only applies to a disclosure mentioned in subsection (1)(a), (b), (c) or (d) that is made on or after the date of commencement of section 7 of the Registered Designs
20 (Amendment) Act 2017.

Disclosure of design to be registered in respect of non-physical product

25 **8B.** An application for registration of a design in respect of a non-physical product must not be refused, and the registration pursuant to that application of the design in respect of the non-physical product must not be revoked, by reason only of a disclosure of the design made before the date of filing of that application, if that application is filed during the period of
30 12 months immediately after the date of commencement of section 7 of the Registered Designs (Amendment) Act 2017.”.

Amendment of section 9

8. Section 9 of the principal Act is amended —

(a) by deleting subsection (2) and substituting the following subsection:

“(2) Subsection (1) does not apply if —

(a) the previous use consisted of or included the sale, letting for hire, or offer or exposure for sale or hire, of —

(i) articles or non-physical products to which had been applied — 5

(A) the design in question; or

(B) a design differing from the design in question only in immaterial details or in features that are variants commonly used in the trade (called in this subsection an immaterial variant); or 10

(ii) devices for projecting any non-physical products mentioned in sub-paragraph (i); 15

(b) the design in question or an immaterial variant had been applied industrially in relation to those articles, non-physical products or devices; and 20

(c) the previous use was made by or with the consent of the copyright owner.”; and

(b) by deleting the words “to articles or any description of articles” in subsection (3) and substituting the words “, in relation to articles, non-physical products or devices for projecting non-physical products,”. 25

Amendment of section 10

9. Section 10 of the principal Act is amended —

(a) by inserting, immediately after the words “an article” in subsections (1) and (3), the words “or a non-physical product”; 30

(b) by inserting, immediately after the word “articles” in subsection (1)(a) and (b) and in the section heading, the words “or non-physical products”; and

5 (c) by inserting, immediately after the words “other article” in subsection (3)(a) and (b), the words “or non-physical product”.

Amendment of section 11

10. Section 11 of the principal Act is amended —

10 (a) by deleting the word “The” in subsection (3) and substituting the words “Except as otherwise provided in section 16A, the”; and

(b) by inserting, immediately after subsection (3), the following subsections:

15 “(4) An application may be filed under subsection (1) for the registration of 2 or more designs, if —

20 (a) the articles, non-physical products, or sets of articles and non-physical products, to which any of those designs is intended to be applied, as specified in the application, fall within the same class, or (if they fall within more than one class) all of the same classes, under the classification mentioned in section 75(1)(c), as the articles, non-physical products, or sets of articles and non-physical products, to which each of the other designs is intended to be applied, as specified in the application; and

30 (b) the application complies with such other requirements as may be prescribed.

(5) Every application filed under subsection (1) for the registration of 2 or more designs is to be treated as if a separate application had been filed under that

subsection for the registration of each of those designs.”.

Amendment of section 12

11. Section 12(1) of the principal Act is amended by inserting, immediately after the word “articles” wherever it appears, the words “or non-physical products”.

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Amendment of section 13

12. Section 13(1) of the principal Act is amended by inserting, immediately after the word “articles”, the words “or non-physical products”.

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Amendment of section 15

13. Section 15 of the principal Act is amended by inserting, immediately after subsection (2), the following subsection:

“(2A) The class or classes (under the classification mentioned in section 75(1)(c)) of articles, non-physical products, or sets of articles and non-physical products, to which a design is intended to be applied, as specified in an application for registration of the design, must not be amended if —

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(a) the application is derived under section 11(5) from an application filed under section 11(1) for the registration of 2 or more designs; and

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(b) the amendment would result in the articles, non-physical products, or sets of articles and non-physical products, to which any of those designs is intended to be applied, and the articles, non-physical products, or sets of articles and non-physical products, to which another of those designs is intended to be applied, falling within different classes.”.

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Amendment of section 16

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14. Section 16 of the principal Act is amended by deleting subsection (5).

New section 16A

15. The principal Act is amended by inserting, immediately after section 16, the following section:

5 **“New application treated as filed on date of filing of earlier application**

10 **16A.**—(1) Where, on examining an application for registration of a design (called in this section the earlier application) under section 16(1), the Registrar determines that the earlier application fails to comply with either or both of the formal requirements of section 11(2)(c) and (4)(a) (where applicable), the Registrar may, when notifying the applicant of the non-compliance under section 16(2), invite the applicant to correct the non-compliance by filing one or more new applications under section 11.

15 (2) A new application must not be filed under subsection (1) if —

 (a) a notice of withdrawal has been filed under section 14 in relation to the earlier application;

 (b) the earlier application has been treated as withdrawn under section 16(3);

20 (c) the earlier application has been refused under section 17; or

 (d) the earlier application has been registered under section 18.

25 (3) The Registrar must refuse any new application filed in contravention of subsection (2).

 (4) Each new application filed under subsection (1) is to be treated as filed on the date of filing of the earlier application, if all of the following requirements are satisfied:

30 (a) the new application complies with the requirements of section 11;

 (b) the new application is made by the applicant, or the successor in title of the applicant, for the earlier application;

- (c) the new application does not include any matter that was not in substance disclosed in the earlier application.”.

Amendment of section 26

16. Section 26(1) of the principal Act is amended by inserting, immediately after the word “articles”, the words “or non-physical products”.

Amendment of section 30

17. Section 30 of the principal Act is amended —

- (a) by deleting subsection (1) and substituting the following subsection:

“(1) The registration of a design under this Act gives to the registered owner the following exclusive rights:

- (a) to make in Singapore, or import into Singapore, for sale or hire, or for use for the purpose of trade or business —

- (i) any article in respect of which the design is registered and to which that design, or a design not substantially different from that design, has been applied; or

- (ii) any device for projecting a non-physical product (being a non-physical product in respect of which the design is registered and to which that design, or a design not substantially different from that design, has been applied);

- (b) to sell, hire, or offer or expose for sale or hire, in Singapore —

- (i) any article or non-physical product in respect of which the design is registered and to which that design,

or a design not substantially different from that design, has been applied; or

- (ii) any device for projecting a non-physical product mentioned in sub-paragraph (i).”;

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(b) by inserting, immediately after the words “paragraph (b)” in subsection (6), the words “or (c)”; and

(c) by deleting subsection (7) and substituting the following subsection:

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“(7) The right in a registered design is not infringed by —

(a) the import, sale, hire, or offer or exposure for sale or hire of —

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(i) any article to which the design has been applied, if the article has been placed on the market, whether in Singapore or elsewhere, by or with the consent (conditional or otherwise) of the registered owner; or

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(ii) any device for projecting a non-physical product (being a non-physical product to which the design has been applied), if the device has been placed on the market, whether in Singapore or elsewhere, by or with the consent (conditional or otherwise) of the registered owner; or

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(b) the sale, hire, or offer or exposure for sale or hire of any non-physical product to which the design has been applied, if the non-physical product has been placed on the market, whether in Singapore or elsewhere, by or with the consent (conditional or otherwise) of the registered owner.”.

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Amendment of section 31

18. Section 31 of the principal Act is amended by deleting subsection (4) and substituting the following subsection:

“(4) Where an article, a non-physical product, or a device for projecting a non-physical product, is disposed of to another person in exercise of a right conferred by subsection (1), that other person, and any person claiming through that other person, may deal with the article, non-physical product or device in the same way as if the article, non-physical product or device had been disposed of by the owner of the design concerned.”.

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Amendment of section 39

19. Section 39(2) of the principal Act is amended by inserting, immediately after the words “an article,” wherever they appear, the words “a non-physical product, or a device for projecting a non-physical product,”.

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Amendment of section 40

20. Section 40 of the principal Act is amended —

- (a) by deleting the word “or” at the end of subsection (1)(a);
- (b) by deleting the comma at the end of paragraph (b) of subsection (1) and substituting the word “; or”, and by inserting immediately thereafter the following paragraph:
 - “(c) any infringing device in relation to that design,”;
- (c) by deleting the words “article or thing” in subsections (1) and (3) and substituting in each case the words “article, thing or infringing device”; and
- (d) by inserting, immediately after subsection (4), the following subsection:

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“(5) In this section and section 41, an infringing device in relation to a registered design is a device for projecting a non-physical product where —

(a) the design, or a design not substantially different from that design, has been applied to the non-physical product; and

(b) either or both of the following apply:

(i) the device is made in Singapore or imported into Singapore in such a way as to infringe the design;

(ii) the device is sold, let for hire, or offered or exposed for sale or hire in Singapore in such a way as to infringe the design.”.

Amendment of section 41

21. Section 41 of the principal Act is amended —

(a) by inserting, immediately after the words “any infringing article or thing” in subsection (1), the words “, or any infringing device,”;

(b) by inserting, immediately after the words “no infringing article or thing” in subsection (2)(b), the words “, and no infringing device,”;

(c) by deleting the words “the article or thing” in subsections (3), (4) and (7) and substituting in each case the words “the article, thing or infringing device”; and

(d) by deleting subsection (6) and substituting the following subsection:

“(6) Where there is more than one person interested in the article, thing or infringing device, the Court may —

(a) direct that the article, thing or infringing device be sold, or otherwise dealt with, and the proceeds divided; and

(b) make any other order as the Court thinks just.”.

Amendment of section 45

22. Section 45 of the principal Act is amended —

- (a) by inserting, immediately after the word “articles” wherever it appears in subsections (3)(a), (b) and (A) and (5), the words “, non-physical products, or devices for projecting non-physical products,”; 5
- (b) by deleting the words “made in the exercise of the powers conferred by this section” in subsection (3)(B) and substituting the words “, non-physical products, or devices for projecting non-physical products, originally intended for the services of the Government”; and 10
- (c) by deleting the words “to make an article, or any use of an article,” in subsection (4).

Amendment of section 58

23. Section 58 of the principal Act is amended by deleting the words “or articles” in paragraph (c) and substituting the words “, articles or devices for projecting non-physical products”. 15

Amendment of section 59

24. Section 59 of the principal Act is amended by deleting subsection (2) and substituting the following subsection: 20

“(2) A person who has been required by the Registrar to produce a document, an article or a device for projecting a non-physical product must not, without lawful excuse, fail to produce the document, article or device.”.

Amendment of section 60

25. Section 60(1) of the principal Act is amended by deleting the words “or articles” and substituting the words “, articles or devices for projecting non-physical products”. 25

Amendment of section 66

26. Section 66 of the principal Act is amended —

(a) by inserting, immediately after the word “article” wherever it appears in subsection (1), the words “or non-physical product”; and

(b) by deleting subsections (2) and (3) and substituting the following subsections:

“(2) For the purposes of subsection (1) —

(a) a person is deemed to represent that a design applied to any article is registered in respect of that article, if there is stamped, engraved or impressed on or otherwise applied to the article anything expressing or implying that the design applied to the article has been registered in respect of that article; and

(b) a person is deemed to represent that a design applied to any non-physical product is registered in respect of that non-physical product, if —

(i) there is applied to the non-physical product anything expressing or implying that the design applied to the non-physical product has been registered in respect of that non-physical product; or

(ii) there is stamped, engraved or impressed on or otherwise applied to a device for projecting the non-physical product anything expressing or implying that the design applied to the non-physical product has been registered in respect of that non-physical product.

(3) A person shall be guilty of an offence and shall be liable on conviction to a fine not exceeding \$10,000 or to imprisonment for a term not exceeding 12 months or to both, if the person, after the right in a registered design has expired —

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(a) marks any article to which the design has been applied with anything implying that there is a subsisting right in the design under this Act, or causes any such article to be so marked;

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(b) applies, or causes to be applied, to a non-physical product to which the design has been applied, anything implying that there is a subsisting right in the design under this Act; or

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(c) marks any device for projecting a non-physical product (being a non-physical product to which the design has been applied) with anything implying that there is a subsisting right in the design under this Act, or causes any such device to be so marked.”.

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Amendment of section 75

27. Section 75(1) of the principal Act is amended by deleting paragraphs (c) and (d) and substituting the following paragraphs:

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“(c) the classification of the articles, non-physical products, or sets of articles and non-physical products, to which the design is intended to be applied; and

(d) if the design reproduced in the representation is to be applied to an article, a sample of the article.”.

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Related amendments to Copyright Act

28.—(1) Section 7(1) of the Copyright Act (Cap. 63) is amended by inserting, immediately after the definition of “minimum royalty”, the following definition:

5 ““non-physical product” has the same meaning as in section 2(1) of the Registered Designs Act (Cap. 266);”.

(2) Section 70 of the Copyright Act is amended by deleting subsection (1) and substituting the following subsection:

10 “(1) Despite section 69, the making of any useful article in 3 dimensions (including a reproduction in 2 dimensions reasonably required for the making of the article), or of any non-physical product, does not infringe the copyright in an artistic work if, when the useful article, reproduction or non-physical product is made, the artistic work has been
15 applied industrially in Singapore or in any other country at any time before the useful article, reproduction or non-physical product is made.”.

(3) Section 73 of the Copyright Act is amended —

20 (a) by inserting, immediately after the words “an article” in subsection (1), the words “or a non-physical product”;

(b) by deleting the words “and articles” in subsection (2)(b) and substituting the words “, articles and non-physical products”;

25 (c) by inserting, immediately after the words “all the articles” in subsection (2)(b)(ii), the words “and non-physical products”; and

(d) by inserting, immediately after subsection (2), the following subsection:

30 “(3) In this Division, unless the context otherwise requires, a device for projecting a non-physical product —

(a) is any device that when activated projects the non-physical product on a surface or into a medium (including air); and

(b) includes any product or component that is used in or with a device mentioned in paragraph (a) to project the non-physical product on a surface or into a medium (including air).”

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(4) Section 74 of the Copyright Act is amended —

(a) by inserting, immediately after the words “Registered Designs Act” in subsection (1), the words “(Cap. 266)”;

(b) by deleting the words “and articles” in subsection (1)(b) and substituting the words “, articles and non-physical products”;

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

“(2) Subsections (3), (4), (5) and (6) apply where —

(a) copyright subsists in an artistic work;

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(b) a corresponding design is applied industrially, whether in Singapore or elsewhere, by or with the licence of the owner of the copyright in the work;

(c) articles or non-physical products to which the corresponding design has been so applied, or devices for projecting those non-physical products, are sold, let for hire, or offered or exposed for sale or hire, whether in Singapore or elsewhere; and

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(d) at the time when those articles, non-physical products or devices are sold, let for hire, or offered or exposed for sale or hire, those articles or non-physical products are not articles or non-physical products in respect of which the corresponding design has been registered, or is deemed to be registered, under the Registered Designs Act.”;

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- (d) by inserting, immediately after the words “all relevant articles” in subsection (3)(a), the words “and non-physical products”;
- 5 (e) by deleting the words “and articles” in subsection (3)(b) and substituting the words “, articles and non-physical products”;
- (f) by deleting the words “articles, such as are mentioned in subsection (2)(b),” in subsection (4) and substituting the words “articles, non-physical products or devices for projecting those non-physical products, such as are mentioned in subsection (2)(c),”;
- 10 (g) by inserting, immediately after the words “any articles” in subsection (5), the words “, non-physical products or devices for projecting those non-physical products,”;
- 15 (h) by inserting, immediately after the words “designs for articles” in subsection (5), the words “or non-physical products”; and
- (i) by inserting, immediately after the word “articles” in subsection (6)(a)(i), the words “or non-physical products”.

20 **Saving and transitional provisions**

25 **29.**—(1) Despite section 2(b), (c) and (g), the definitions of “corresponding design” and “design” in section 2(1), and section 2(2)(b), of the principal Act as in force immediately before the date of commencement of section 2(b), (c) and (g) continue to apply to or in relation to —

- (a) an application for registration of a design that is made before that date;
- (b) a design that is registered pursuant to such an application; and
- 30 (c) a right in such a registered design.

(2) Despite section 3(a), (b) and (c), section 4(2), (3) and (4) of the principal Act as in force immediately before the date of commencement of section 3(a), (b) and (c) continues to apply to a

design that is created in pursuance of a commission for money or money's worth, and in relation to which either of the following applies:

(a) the design was created before that date;

(b) before that date, the designer of the design and the person commissioning the design entered into a contract relating to that commission. 5

(3) Despite section 3(d), section 4(5) of the principal Act as in force immediately before the date of commencement of section 3(d) continues to apply to or in relation to — 10

(a) an application for registration of a design that is made before that date;

(b) a design that is registered pursuant to such an application; and

(c) a right in such a registered design. 15

(4) Despite sections 4, 8(a), 9, 10(a), 11, 12 and 14, sections 5(1) and (2), 9(2), 10(1) and (3), 11(3), 12(1), 13(1) and 16(5) of the principal Act as in force immediately before the date of commencement of sections 4, 8(a), 9, 10(a), 11, 12 and 14, respectively, continue to apply to or in relation to an application for registration of a design that is made before that date. 20

(5) Sections 10(b), 13 and 15 do not apply to an application for registration of a design that is made before the date of commencement of sections 10(b), 13 and 15, respectively.

(6) Despite sections 16 and 19, sections 26(1) and 39(2) of the principal Act as in force immediately before the date of commencement of sections 16 and 19, respectively, continue to apply to or in relation to a design that is registered pursuant to an application for registration of a design that is made before that date. 25

(7) Despite sections 17 and 18, sections 30(1), (6) and (7) and 31(4) of the principal Act as in force immediately before the date of commencement of sections 17 and 18, respectively, continue to apply to or in relation to — 30

(a) a design that is registered pursuant to an application for registration of a design that is made before that date; and

(b) a right in such a registered design.

5 (8) Despite section 28(2), section 70(1) of the Copyright Act (Cap. 63) as in force immediately before the date of commencement of section 28(2) continues to apply to or in relation to an artistic work, if the artistic work has been applied industrially before that date in accordance with section 70(2) and (3) of the Copyright Act.

10 (9) Despite section 28(3)(a), (b) and (c) and (4)(c) to (i), sections 73(1) and (2)(b) and 74(2), (3)(a) and (b), (4), (5) and (6)(a)(i) of the Copyright Act as in force immediately before the date of commencement of section 28(3)(a), (b) and (c) and (4)(c) to (i)
15 work has been applied industrially before that date in accordance with the regulations mentioned in section 74(7) of the Copyright Act.

(10) Despite section 28(3)(a), (b) and (c) and (4)(b), sections 73(1) and (2)(b) and 74(1)(b) of the Copyright Act as in force immediately before the date of commencement of section 28(3)(a), (b) and (c) and
20 (4)(b) continue to apply to or in relation to —

(a) a design that is registered, or deemed to be registered, under the principal Act pursuant to an application for registration of a design that is made before that date; and

(b) a right in such a registered design.

25 (11) For a period of 2 years after the date of commencement of any provision of this Act, the Minister may, by rules, prescribe such additional provisions of a saving or transitional nature consequent on the enactment of that provision as the Minister may consider necessary or expedient.

EXPLANATORY STATEMENT

This Bill seeks to amend the Registered Designs Act (Cap. 266) for the following main purposes:

- (a) to broaden the scope of protection under the Act by amending the definition of “design”, and by allowing a design to be registered in respect of a non-physical product, and to clarify the scope of protection under the Act by amending the definition of “article”;
- (b) to change the default position on the ownership of a commissioned design, so that the designer of the design (and not the person commissioning the design) will be the owner of the design;
- (c) to restate the circumstances in which the prior disclosure of a design does not affect the registrability of the design, and specify 12 months as the period after certain disclosures of a design during which the design remains registrable;
- (d) to allow an applicant to apply for the registration of 2 or more designs in one application, if certain requirements are satisfied;
- (e) to allow an applicant whose earlier application for registration of a design fails to comply with certain formal requirements to correct the non-compliance by filing one or more new applications, each of which will be treated as filed on the date of filing of the earlier application if certain requirements are satisfied.

The Bill also makes amendments to sections 7(1), 70(1), 73 and 74 of the Copyright Act (Cap. 63) that are related to the policy of allowing a design to be registered in respect of a non-physical product.

Clause 1 relates to the short title and commencement.

Clause 2 amends section 2 by extending certain definitions, and introducing several new definitions, to support certain amendments in the Bill.

First, the definition of “article” (which determines what a design may be registered in respect of) is amended to clarify that an article is any thing that is manufactured (whether by an industrial process, by hand or otherwise).

Second, the definition of “design” (which determines what may be registered) is amended —

- (a) to cover features of colours, except features consisting only of one or more colours that are not used with any feature of shape or configuration, and do not give rise to any feature of pattern or ornament;
- (b) to cover features applied to non-physical products;

- (c) to clarify that the features constituting a design must give the article or non-physical product to which those features are applied its appearance; and
- (d) to remove the requirement for the features constituting a design to be applied by an industrial process.

Third, a new definition of “non-physical product” is introduced to support the amendments in clauses 2(b), (c), (f), (g) and (h), 3(d), 4, 5, 7, 8, 9 to 13 and 16 to 27, which relate to the policy of allowing a design to be registered in respect of a non-physical product.

A “non-physical product” is any thing that does not have a physical form, is produced by the projection of a design on a surface or into a medium (including air), and has an intrinsic utilitarian function (other than merely to portray the appearance of the thing or to convey information). A reference to a non-physical product may also include a reference to a set of non-physical products. A virtual keyboard that can be used to type characters, in the same manner as a physical computer keyboard, is an example of a non-physical product.

Fourth, a new definition for a device for projecting a non-physical product is introduced to support the amendments in clauses 8(a) and 17 to 26.

A device for projecting a non-physical product is any device that when activated projects the non-physical product on a surface or into a medium (including air), and includes any product or component that is used in or with any such device. An example of such a product or component is the software required to enable the device to project a non-physical product.

Fifth, a new definition for “set of articles and non-physical products” is introduced to support the amendments in clauses 2(g) and 4, and a new definition for “set of non-physical products” is introduced to support the amendments in clause 2(e) and (g).

A “set of articles and non-physical products” consists of one or more articles and one or more non-physical products —

- (a) all of which are of the same general character and are ordinarily on sale together or intended to be used together; and
- (b) to each of which the same design, or the same design with modifications or variations not sufficient to alter the character or substantially to affect the identity of the design, is applied.

A “set of non-physical products” consists of 2 or more non-physical products of the same general character that are ordinarily on sale together or intended to be used together, and to each of which the same design, or the same design with modifications or variations not sufficient to alter the character or substantially to affect the identity of the design, is applied.

Sixth, the definition of “corresponding design” is extended to cover a design applied to a non-physical product that results in a reproduction of an artistic work.

Seventh, a new definition for “formal requirements” is introduced to support the amendment in clause 15, and to replace the existing definition of “formal requirements” in section 16(5). The new definition identifies certain requirements of section 11 as formal requirements, in addition to allowing other requirements of that section, or of rules made for the purposes of that section, to be prescribed as formal requirements. Consequently, clause 14 deletes section 16(5).

Clause 2 also replaces section 2(2)(b), and inserts a new section 2(2)(ba), to provide for —

- (a) how a reference in the Act to an article in respect of which a design is registered is to be construed, in the case of a design registered in respect of a set of articles or a set of articles and non-physical products; and
- (b) how a reference in the Act to a non-physical product in respect of which a design is registered is to be construed, in the case of a design registered in respect of a set of non-physical products or a set of articles and non-physical products.

Clause 3(a), (b) and (c) deletes section 4(2), and makes consequential amendments to section 4(3) and (4), to change the default position on the ownership of a commissioned design, so that the designer of the design (and not the person commissioning the design) will be the owner of the design.

At present, section 4(2) and (4) provides that where a design is created in pursuance of a commission for money or money’s worth, the person commissioning the design is to be treated as the owner of the design, unless there is an agreement to the contrary between the designer of the design and that person.

Upon the deletion of section 4(2) and consequential amendment of section 4(4) by clause 3(a) and (c), respectively, section 4(1) determines the ownership of a commissioned design, and requires the designer of the design to be treated as the owner of the design. However, if the designer assigns the design to the person commissioning the design, section 4(5) requires that person to be treated as the owner of the design.

Clause 3(d) amends section 4(5) so that it determines the ownership of a design where the right to apply the design to any non-physical product becomes vested in a person other than the owner, in addition to where the design, or the right to apply the design to any article, becomes vested in a person other than the owner.

Clause 4(a) amends section 5(1) to enable a new design to be registered in respect of a non-physical product, or a set of articles and non-physical products, in addition to being registered in respect of an article or a set of articles.

Clause 4(b) amends section 5(2) to prevent a design for which an application for registration is made from being regarded as new if it is the same as, or differs only in immaterial details, or in features that are variants commonly used in the trade, from, a design —

- (a) registered in respect of the same or any other article, non-physical product, or set of articles and non-physical products; or
- (b) published (in Singapore or elsewhere) in respect of the same or any other article, non-physical product, or set of articles and non-physical products, before the date of the application.

Clause 5 amends section 7(3)(a) to enable the Minister to make rules to exclude from registration designs for such non-physical products of a primarily literary or artistic character as the Minister considers appropriate.

Clause 6 amends section 8 so that the section applies to any disclosure or other thing mentioned in that section only if that disclosure or thing occurs before the date of commencement of that clause.

Clause 7 inserts a new section 8A —

- (a) to restate the circumstances in which the prior disclosure of a design does not affect the registrability of the design; and
- (b) to specify 12 months as the period after certain disclosures of a design during which the design remains registrable.

Under the new section 8A(1), an application for registration of a design must not be refused, and the registration of a design must not be revoked, by reason only of any of the following disclosures of the design:

- (a) a disclosure made to a person (other than the designer or the designer's successor in title) under conditions of confidentiality (whether express or implied);
- (b) a disclosure made by the designer, or the designer's successor in title, during the period of 12 months immediately before the date of filing of the application for registration of the design;
- (c) a disclosure made by a person (other than the designer or the designer's successor in title) during the period of 12 months immediately before the date of filing of the application for registration of the design, as a consequence of information provided, or any other action taken, by the designer or the designer's successor in title;
- (d) a disclosure made, during the period of 12 months immediately before the date of filing of the application for registration of the design, as a consequence of an abuse, in relation to the designer or the designer's successor in title.

The reference in new section 8A(1)(d) to an abuse, in relation to the designer or the designer's successor in title, mirrors the terminology used in section 1B(6)(e) of the Registered Designs Act 1949 of the United Kingdom, and is intended to cover matters such as a theft of the design from the designer or the designer's successor in title, or the making of an illegitimate copy of the design.

The new section 8A applies to a disclosure only if the disclosure is made on or after the date of commencement of clause 7.

Clause 7 also inserts a new section 8B to provide that the prior disclosure of a design does not affect the registrability of the design in respect of a non-physical product, if the application for registration of the design in respect of the non-physical product is filed during the period of 12 months immediately after the date of commencement of that clause.

Clause 8 replaces section 9(2) and amends section 9(3) —

- (a) to provide that the novelty of a design that corresponds to an artistic work is destroyed by a previous use of the artistic work, if —
 - (i) the previous use consisted of or included the sale, letting for hire, or offer or exposure for sale or hire, of articles, non-physical products or devices for projecting non-physical products in relation to which the design in question, or a design differing from it only in immaterial details or in features that are variants commonly used in the trade, had been applied industrially; and
 - (ii) the previous use was made by or with the consent of the copyright owner; and
- (b) to enable the Minister to make rules providing for the circumstances in which a design is to be regarded as having been applied industrially in relation to non-physical products or devices for projecting non-physical products, in addition to rules providing for the circumstances in which a design is to be regarded as having been applied industrially to articles.

Clause 9 amends section 10 so that an application for registration of a design is not to be refused, and the registration made on the application is not to be revoked, by reason only of the prior registration of the same design or a closely similar design in respect of an article or a non-physical product, if either of the following applies:

- (a) the application is filed by the registered owner in respect of any other article or non-physical product;
- (b) the applicant becomes the owner of the prior registration.

Clause 10 amends section 11 —

- (a) to enable the new section 16A (to be inserted by clause 15) to specify a different date of filing of an application for registration of a design from the date specified in section 11(3);
- (b) to enable a single application to be filed for the registration of 2 or more designs, if the application complies with certain requirements; and
- (c) to provide for a single application filed for the registration of 2 or more designs to be treated, after the filing of that application, as if a separate application had been filed for the registration of each of those designs, so that there are separate proceedings for the registration of each of those designs.

Clause 11 amends section 12(1) so that a person who has filed an application for the registration of a design, in a country that is a party to the Paris Convention or a member of the World Trade Organisation, in respect of certain articles or non-physical products, or that person's successor in title, may claim priority, when filing an application under the Act for the registration of that design in respect of all or any of those articles or non-physical products.

Clause 12 amends section 13(1) so that the Minister may by order confer, on a person who has filed an application for registration of a design in a country or territory with which Singapore has an arrangement for the reciprocal protection of designs, priority for registering the same design under the Act in respect of some or all of the same articles or non-physical products.

Clause 13 inserts a new section 15(2A) to prevent the amendment of the class or classes of articles, non-physical products, or sets of articles and non-physical products, to which a design is intended to be applied, as specified in an application for registration of the design, if —

- (a) the application is one of 2 or more separate applications derived from a single application filed for the registration of 2 or more designs; and
- (b) the amendment would result in the articles, non-physical products, or sets of articles and non-physical products, to which any of those designs is intended to be applied, and the articles, non-physical products, or sets of articles and non-physical products, to which another of those designs is intended to be applied, falling within different classes.

Clause 15 inserts a new section 16A to provide for a new application for registration of a design to be treated as filed on the date of filing of an earlier application for registration of a design, if —

- (a) the new application is filed pursuant to an invitation by the Registrar of Designs (the Registrar) to correct a failure in the earlier application to

comply with either or both of the formal requirements of section 11(2)(c) and (4)(a); and

(b) certain requirements are satisfied.

Clause 16 amends section 26(1) to enable the registration of a design to be surrendered in respect of all or any of the non-physical products for which the design is registered.

Clause 17(a) replaces section 30(1) to restate the exclusive rights that the registration of a design gives to the registered owner, given that a design can now be registered in respect of a non-physical product. The exclusive rights are as follows:

(a) to make in Singapore, or import into Singapore, for sale or hire, or for use for the purpose of trade or business —

(i) any article in respect of which the design is registered, and to which that design or a design not substantially different from that design has been applied; or

(ii) any device for projecting a non-physical product (being a non-physical product in respect of which the design is registered, and to which that design or a design not substantially different from that design has been applied);

(b) to sell, hire, or offer or expose for sale or hire, in Singapore —

(i) any article or non-physical product in respect of which the design is registered, and to which the design or a design not substantially different from that design has been applied; or

(ii) any device for projecting such a non-physical product.

Clause 17(b) makes an amendment to section 30(6) that is consequential to the replacement of the definition of “design” by clause 2(c).

Clause 17(c) replaces section 30(7) to state when the right in a registered design is not infringed by the doing of an act within the exclusive rights of the registered owner under the new section 30(1). The right is not infringed by the sale, hire, or offer or exposure for sale or hire of any article or non-physical product to which the design has been applied, or of any device for projecting such a non-physical product, or by the import of any such article or device, if the article, non-physical product or device (as the case may be) was placed on the market, whether in Singapore or elsewhere, by or with the consent of the registered owner.

Clause 18 replaces section 31(4) to extend its application to a non-physical product or a device for projecting a non-physical product, in addition to an article. Under the new section 31(4), where an article, a non-physical product, or a device for projecting a non-physical product, is disposed of to a person in exercise of a

right conferred by section 31(1), that person (or any person claiming through that person), may deal with that article, non-physical product or device as if it had been disposed of by the owner of the design.

Clause 19 amends section 39(2) so that a person is not to be taken to have been aware, or to have reasonable grounds for believing, that a design was registered by reason only of the application of the word “registered”, or any word or words or abbreviation expressing or implying that the design has been registered, to an article, a non-physical product or a device for projecting a non-physical product, unless the registration number of the design accompanied the word, words or abbreviation.

Clause 20 amends section 40(1) and (3) and inserts a new section 40(5) —

- (a) to enable the Court, in proceedings for infringement of a registered design, to order the delivery to the plaintiff of an infringing device, in relation to that design, that is in the possession of the defendant; and
- (b) to define what constitutes an “infringing device” for the purposes of sections 40 and 41.

A device for projecting a non-physical product is an “infringing device” in relation to a registered design if —

- (a) the design, or a design not substantially different from that design, has been applied to the non-physical product; and
- (b) either or both of the following apply:
 - (i) the device is made in Singapore or imported into Singapore in such a way as to infringe the design;
 - (ii) the device is sold, let for hire, or offered or exposed for sale or hire in Singapore in such a way as to infringe the design.

Clause 21 amends section 41 to enable the court to make an order for the disposal of an infringing device that is delivered up pursuant to an order under section 40, and to provide for matters related to the making of the disposal order.

Clause 22 amends section 45(3), (4) and (5) —

- (a) to treat certain uses of a design involving non-physical products, or devices for projecting non-physical products, as uses for the services of the Government; and
- (b) to enable the purchaser of any non-physical products, or devices for projecting non-physical products, sold in the exercise of powers conferred by section 45(1), or any person claiming through the purchaser, to deal with those products or devices.

Clause 23 amends section 58(c) to empower the Registrar to require the production of devices for projecting non-physical products, in addition to the production of documents or articles, for the purposes of the Act.

Clause 24 replaces section 59(2) to make changes that are consequential to the amendment of section 58(c) by clause 23. Under the new section 59(2), a person who has been required by the Registrar to produce a document, an article or a device for projecting a non-physical product must not, without lawful excuse, fail to produce the document, article or device. Section 59(3) makes a contravention of section 59(2) an offence.

Clause 25 amends section 60(1) to make changes that are consequential to the amendment of section 58(c) by clause 23. Under the amended section 60(1), among other things, a person who appears before the Registrar must not, without lawful excuse, refuse to produce documents, articles or devices for projecting non-physical products which the person is required by the Registrar to produce. Section 60(2) makes a contravention of section 60(1) an offence.

Clause 26 amends section 66(1), and replaces section 66(2) and (3) —

- (a) to make it an offence for a person to falsely represent that a design applied to a non-physical product disposed of by the person for value is registered in respect of that non-physical product;
- (b) to specify when a person is deemed to represent that a design applied to a non-physical product is registered in respect of that non-physical product;
- (c) to make it an offence for a person, after a right in a registered design has expired —
 - (i) to apply, or cause to be applied, to a non-physical product to which the design has been applied, anything implying that there is a subsisting right in the design; or
 - (ii) to mark any device for projecting a non-physical product (being a non-physical product to which the design has been applied) with anything implying that there is a subsisting right in the design, or cause any such device to be so marked;
- (d) to prevent the mere stamping, engraving, impressing or application of the word “registered” to an article from being treated as a representation that a design applied to the article is registered in respect of the article, if it is unclear from the circumstances whether the stamping, engraving, impressing or application of the word “registered” to the article expresses or implies that the design is registered in respect of the article; and

- (e) to prevent the mere marking of an article to which a design has been applied with the word “registered”, after the right in the design has expired, from becoming an offence, if it is unclear from the circumstances whether such marking implies that there is a subsisting right in the design.

Clause 27 replaces section 75(1)(c) and (d) to enable the Minister to make, for the purposes of section 11, rules that require, or permit, an application for registration of a design —

- (a) to contain the classification of the articles, non-physical products, or sets of articles and non-physical products, to which the design is intended to be applied; and
- (b) to contain a sample of an article only if the design is to be applied to an article.

Clause 28 makes amendments to sections 7(1), 70(1), 73 and 74 of the Copyright Act that are related to the policy of allowing a design to be registered in respect of a non-physical product.

Clause 28(1) inserts a definition for “non-physical product” in section 7(1) of the Copyright Act. The term “non-physical product” has the same meaning as in section 2(1) of the Registered Designs Act.

Clause 28(2) replaces section 70(1) of the Copyright Act so that the making of a non-physical product does not infringe the copyright in an artistic work if, when the product is made, the artistic work has been industrially applied in Singapore or in any other country at any time before the product is made. The new section 70(1) also retains the existing position under that provision, which is that the making of any useful article in 3 dimensions (including a reproduction in 2 dimensions reasonably required for the making of the article), does not infringe the copyright in an artistic work if, when the article or reproduction is made, the artistic work has been industrially applied in Singapore or in any other country at any time before the article or reproduction is made.

Clause 28(3) amends section 73 of the Copyright Act —

- (a) to extend, for the purposes of Division 10 of Part III of that Act, the definition of “corresponding design”, in relation to an artistic work, to cover a design which, when applied to a non-physical product, results in a reproduction of the work;
- (b) to provide for the interpretation, in Division 10 of Part III of that Act, of references to the scope of the copyright in a registered design as extended to associated non-physical products; and
- (c) to define, for the purposes of Division 10 of Part III of that Act, what constitutes a device for projecting a non-physical product.

Clause 28(4) amends section 74 of the Copyright Act to extend its application beyond articles to non-physical products and devices for projecting non-physical products.

Clause 28(4)(a) makes an editorial change to section 74(1) of the Copyright Act.

Clause 28(4)(b) amends section 74(1)(b) of the Copyright Act to provide that it will not be an infringement of an artistic work, a corresponding design of which is registered or deemed registered under the Registered Designs Act, to do anything, after the copyright in the registered design has ended, which would have been within the scope of that copyright as extended to all associated non-physical products.

Clause 28(4)(c) replaces section 74(2) of the Copyright Act to provide for the application of section 74(3), (4), (5) and (6) of that Act where —

- (a) copyright subsists in an artistic work;
- (b) a corresponding design is applied industrially, whether in Singapore or elsewhere, by or with the licence of the copyright owner;
- (c) articles or non-physical products to which the corresponding design has been so applied, or devices for projecting those non-physical products, are sold, let for hire, or offered or exposed for sale or hire, whether in Singapore or elsewhere; and
- (d) at the time of the sale, hire, or offer or exposure for sale or hire, those articles or non-physical products are not articles or non-physical products in respect of which the corresponding design has been, or is deemed to be, registered under the Registered Designs Act.

Clause 28(4)(d) and (e) amends section 74(3) of the Copyright Act so that it is not an infringement of the copyright in the work —

- (a) during the relevant period of 15 years, to do anything that, when done, would have been within the scope of the copyright in the design if the design had been registered in respect of all relevant non-physical products; and
- (b) after the relevant period of 15 years, to do anything that, when done, would have been within the scope of the copyright in the design as extended to all associated non-physical products.

Clause 28(4)(f), (g), (h) and (i) makes amendments to section 74(4), (5) and (6)(a)(i) of the Copyright Act that are consequential to the amendments made to section 74(2) and (3) of that Act by clause 28(4)(c), (d) and (e). Section 74(4) of the Copyright Act defines “the relevant period of 15 years” in section 74(3) of that Act. Section 74(5) and (6) of the Copyright Act provides for certain things of which no account is to be taken for the purposes of section 74(2) and (3) of that Act.

Clause 29 contains saving and transitional provisions.

EXPENDITURE OF PUBLIC MONEY

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