

CLIENT NOTE



THE INTELLECTUAL PROPERTY (DISPUTE RESOLUTION) ACT 2019 – AMENDMENT TO THE REGISTERED DESIGNS ACT

10 December 2019

Introduction

1. On 5 August 2019, the Intellectual Property (Dispute Resolution) Bill (the “**Bill**”) was passed in Parliament. The Bill was published in the Gazette on 11 September 2019 and is known as the Intellectual Property (Dispute Resolution) Act 2019 (the “**Act**”).
2. In this Client Note, we discuss the amendments made by the Act to the Registered Designs Act (“**RDA**”). The amendments were part of the overall move to ensure consistency across all intellectual property (“**IP**”) rights in Singapore.

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Background

3. In 2015, the Ministry of Law appointed a committee to review the IP dispute resolution framework in Singapore, as a part of the Government’s IP Hub Master Plan. One of the objectives of the review was to position Singapore as a choice venue for IP dispute resolution in Asia.
4. The committee’s finding was that there was a jurisdictional bias in favour of using the High Court for resolving disputes relating to IP rights. As a result, legal costs have been driven up.
5. To lower legal costs, the committee recommended that parties also have the choice to bring their disputes before the Intellectual Property of Singapore (“**IPOS**”), an administrative tribunal with IP expertise. This recommendation was accepted and, accordingly, amendments were made to sections 43, 62 and 68 of the RDA.

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Amendments to Section 43

6. Section 43 stipulates that if the validity of the registration of a design is contested in any proceedings before the High Court, and the Court finds that the design is validly registered, it may certify the finding and the fact that the validity of the registration was so contested.

CLIENT NOTE



7. Section 28 of the Act amends section 43 by stipulating that the validity of the registration of a design can also be contested before IPOS and IPOS can also certify the finding and the fact that the validity of the registration was so contested.
8. If a certificate as to the validity of the registration of a design has already been granted but the validity is again questioned in any subsequent proceedings before the High Court in respect of disputes relating to design infringement or for the revocation of the registration of the design, the High Court can order costs on a solicitor-and-client basis to the registered owner if he successfully relies on the certificate and obtains a final order or judgment in his favour.
9. Section 28 stipulates that IPOS can also order costs on a solicitor-and-client basis.
10. Section 28 has not yet come into force and will come into operation at a date to be fixed by the Minister of Law.

Amendments to Section 62

11. Section 62 currently provides that any decision or order of the Registrar can be appealed to the High Court.
12. Section 29 of the Act amends section 62 by inserting a new section (2A) to make it clear that where the Registrar's decision or order has been appealed to the High Court, no further appeal may be made to the Court of Appeal unless leave has been granted by the High Court or the Court of Appeal.
13. Section 29 came into force on 21 November 2019.

Amendments to Section 68

14. Section 68 presently provides that a sum of S\$2,000 may be collected from any person reasonably suspected of having committed any offence under the RDA which has been prescribed as a compoundable offence.
15. Section 30 of the Act amends section 68 to limit the amount collectable from the offender to a sum not exceeding the lower of the following:
 - (a) one half of the amount of the maximum fine that is prescribed for the offence;
 - (b) S\$5,000.
16. The amendment therefore caps the amount payable by an offender of a compoundable offence under the RDA to a sum of S\$5,000, which is an increase from the present sum of S\$2,000.

CLIENT NOTE



17. Section 30 has yet to come into force and will come into operation at a date to be fixed by the Minister of Law.

Conclusion

18. The amendments to the RDA mean that parties whose proceedings are before the Registrar may enjoy lower legal costs as they now are able to obtain a certificate of contested validity in these proceedings and rely upon this certificate to recover costs on a higher scale in any subsequently proceedings where the validity of the registered design is once again questioned.
19. Please do not hesitate to contact us if you have any queries concerning this Client Note.

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