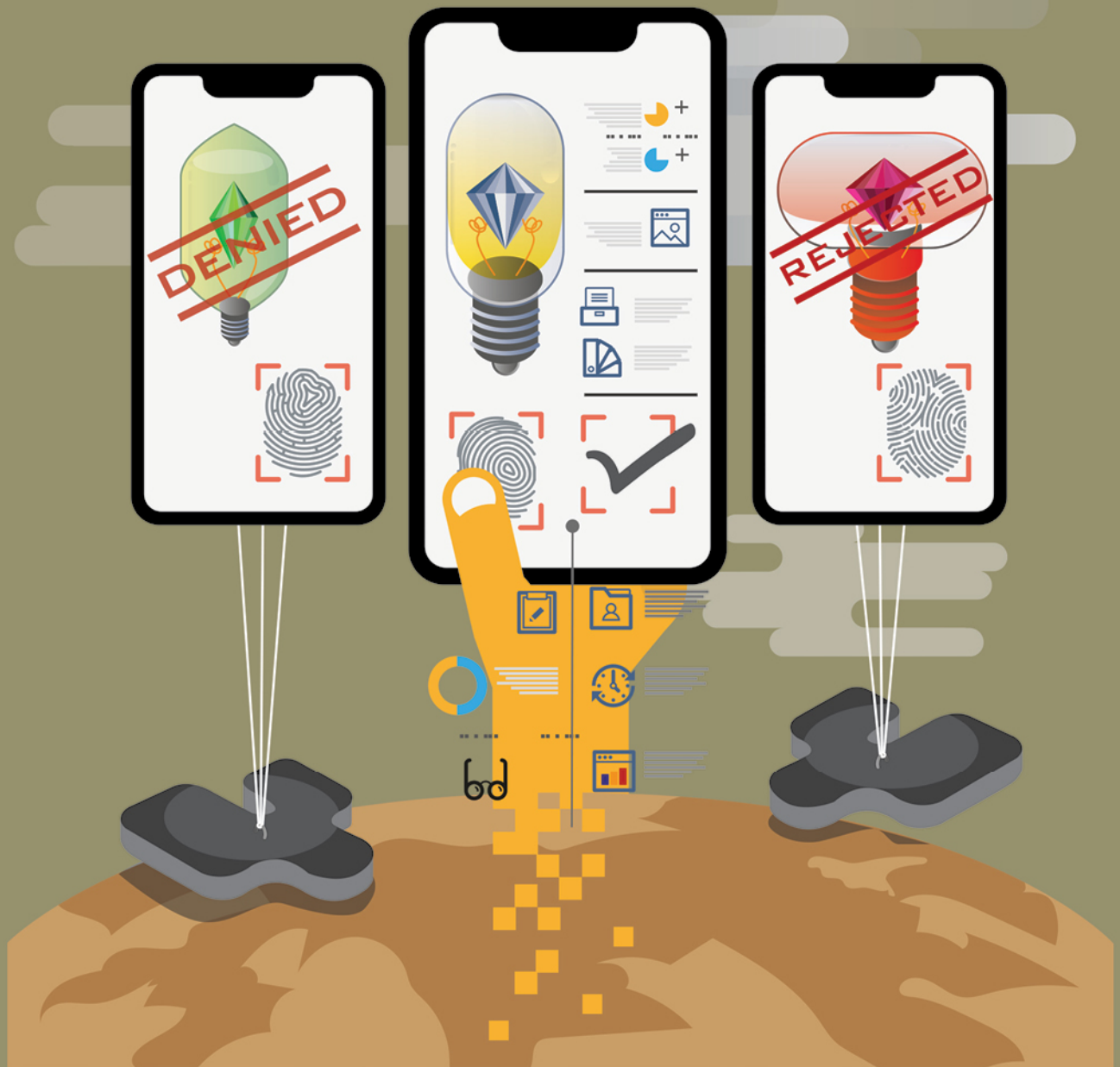


# Upholding Your IP Rights

*How to tackle infringers and defend your IP against attack*





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# Introduction

Intellectual property (IP) is of vital importance because it can provide your business with monopoly rights to your creations or in the case of patents, negative rights to exclude others from doing things with your inventions. These rights have value because they have the backing of the law to enforce them if required.

Marking your goods appropriately can make the public aware that your products are protected by IP and help to deter copying. While most companies do not need to enforce their rights very often, there are times when it becomes necessary to take a stand. This does not mean that you have to end up in the courts, because there are several much less costly options, but it does require you to take action.

This guide outlines the main routes you can use to enforce your IP if you think that someone else is encroaching on your creative or inventive work.

**Chapter 1** sets out the reasons why having the right to enforce your IP is so important. It examines the role of IP in driving business value and the consequences that may follow if you fail to enforce your rights when they are infringed. The chapter includes suggestions on how you can increase the deterrent effect of the IP you own to reduce the chances that proactive enforcement measures will be necessary.

The actions which constitute infringement are examined in **Chapter 2**, broken down by type of IP right. This chapter also discusses which actions are also considered a criminal offence in Singapore.

**Chapter 3** offers practical tips on how you can use your IP to create barriers to entry around the scope of your commercial activity without court action. Examples include how to remain vigilant on new applications being filed by competitors or others for similar or identical trade marks and how these can be opposed during the registration process; how domain name registrations that contain your trade mark can be prevented; and how to submit observations during the patent examination process.

**Chapter 4** sets out the options available if you have to enforce your IP rights. In addition to court action, the chapter discusses mediation and arbitration options. Each type of IP has its own special circumstances and additional enforcement options, which are also examined. Consideration is also given to funding your enforcement actions.





# Why does IP enforcement matter?



01



# 1. Why does IP enforcement matter?

## Why is IP valuable and worth enforcing?

IP underpins the Unique Selling Points (USPs) of a business. It provides a means to prevent others from copying the key features or properties of the products and services that maintain and grow the company's position in the marketplace.

IP is part of your promise to customers. They may come to rely on your product, process, design, brand, code, or publications. In terms of your brand, for example, if someone passes their products or services off as yours, it could lead to loss of income. Furthermore, you may be trading in a sector that relies on regulated and safe products, so any purchase of a low-quality copy by an unsuspecting customer who has been deceived into buying a copycat could harm more than just your reputation.

For a host of commercial reasons, IP and the wider category of intangibles are extremely valuable assets for any company. As World Intellectual Property Organisation (WIPO) research confirms, IP and intangibles are often the most valuable assets companies own. It is therefore vital to protect and look after them.

*Two accompanying guides—**Safeguarding Your Competitive Edge** and **Unlocking Your Hidden Value** set out in more detail what IP and intangible assets are, how IP creates value and how its worth can be estimated and leveraged.*



The value of your IP rights is likely to change over time because it is linked to the way your company uses them and the benefits it derives from them. Of all the external events that might affect your IP value, the strongest influence will be whether your rights would prevail if challenged in a court of law. This is because it is never possible to be 100% certain no-one else can challenge their validity until this assumption is tested. If you can prove your IP is valid and enforceable, you can expect its value to increase substantially.

An IP owner is likely to use the law in two main scenarios. The first is when the rights holder is accused of infringing a third party's IP and defends itself against the allegation (you will hear this referred to as 'defence'). The second scenario is when the rights holder suspects a third party of infringing its rights, and wishes to use the courts to seek redress (this is often called 'pursuit').

Several options are available to enforce these rights, which are explored in more detail in this guide. Whichever route you go down, it is vital to have a strong IP position.

## What role does enforcement play?

IP is backed by powers that allow you to enforce your legal rights in the courts, should you need to do so. Without these rights and legal recourse, there would be nothing to stop a potential infringer from using or copying your IP without permission. Enforcement is, therefore, a vital right given to IP holders.

It should be noted that often companies may only undertake an enforcement action as a 'last resort' when other methods of resolving IP disputes have failed. However, unless you have a credible threat to sue infringers, your ability to reach a mutually acceptable conclusion will be severely compromised. In such a situation, the other party will not be adequately motivated to engage in meaningful discussion, because there will be no 'bite' to match your 'bark'.

Without this credible threat, the benefits that you can obtain from your IP rights ownership will be limited to marketing. You will be able to show that your products or services are innovative; you just will not be able to stop other people benefiting from your hard work. Additionally, the ability for you to demonstrate having an 'innovative' product or service will be eroded over time if there are a lot of copycats flooding the market—what you have can no longer be considered innovative if everyone else can do the same thing.

IP enforcement options should, therefore, be seen as strategic weapons by a business—to be used sparingly, but also to be part of the 'toolkit'. When embarking on the IP journey, and at regular intervals, it is important to think strategically about how you would handle a dispute, what routes you would pursue, how you would fund an action, and how strong your legal position really is. When you know what your enforcement options are and what they entail, you will be better equipped to take a strategic approach to IP and its management, and to make good decisions regarding which rights to obtain.



*Enforcement is part of treating IP as a valuable business asset rather than a purely legal construct. You wouldn't let someone walk off with your stock: so why would you let them walk off with your ideas?*

## Do IP rights act as a deterrent?

**A**rguably, in an ideal world, there would be no need to enforce IP rights because everyone would have the utmost respect for them and would not infringe them. Unfortunately, we do not live an ideal world; the nature of competition, of innovation, and of IP itself means that some level of contention is almost inevitable.

There are some actions that you can take to maximise the deterrent effect of the IP rights that you have. The most important of these is to make sure you put other people on notice of their existence. You may find the checklist at the end of this chapter helpful to confirm that you have done what you can to make your rights obvious and discourage others from infringement.

# 1. Why does IP enforcement matter?



The primary reason infringement exists is because you will very seldom be the only supplier to a given market. Other companies will be working to satisfy customer needs, as you are, and it is not unusual for people skilled and knowledgeable in a particular area to gravitate towards similar solutions. This is just the way companies compete and innovate.

The competitive process of development can often translate into a multitude of IP rights in a single product. However, you may not be able to examine these potential overlaps in detail and understand whether these have implications for your business until patents are filed, brands are launched or product designs appear. This is because it is in all parties' interests to keep their R&D plans secret for as long as possible.

A prime example of overlapping IP can be found in the smartphone sector. It has been estimated that contemporary devices rely on up to 250,000 patents, many of which originate from different manufacturers and suppliers. Industry standards that power other devices may also require the use of many different patents which have to be licensed under FRAND principles. Hopefully, your business will not find itself in such an intense 'thicket' as this.

*Fair, Reasonable And Non-Discriminatory (FRAND) licensing is described in more detail in an accompanying guide in this series—**Unlocking Your Hidden Value** dealing with IP valuation.*



There is a secondary reason infringement exists, which concerns the nature of IP. Subjectivity can never be eliminated in terms of whether rights should be granted or registered if only because the information used to make such decisions is never perfect or complete. This is evident in the examination of patent 'inventive step', and consideration of whether a copyright work is truly original (i.e. does 'substantially similar' copyright work exist?). It is therefore possible for conflicting claims to emerge regarding inventions, designs or original creative works, and it may take a court to sort them out.



## What could happen if I don't enforce my rights?

If your company is falsely accused of infringement and you do not defend it, or if you suspect someone is infringing you and you choose not to act, the consequences can be serious. As well as a loss of opportunity, or risk that competition in your space will intensify, there is the risk that your company will become known for not enforcing its rights. This will remove the deterrent effect your IP has in the marketplace.

Disputes are unpleasant. They are also costly, time-consuming and can be a massive distraction for a business. It is therefore tempting to actively avoid disputes, by ignoring infringement and not defending your company from spurious allegations of infringement brought by third parties. This approach, however, carries many risks.

Once an infringement is detected, if you do not act promptly, you could lose your right to bring an action for the infringement over time. Not acting is considered to be acquiescing to the infringer's activity; it is interpreted as an active decision not to act, and so is akin to giving in without a fight.

One of the equitable principles on which Singapore law is based is that "Equity aids the vigilant not the indolent", or, "Delay defeats equity". If you do not act swiftly, once a wrong-doing has been discovered you may lose the right to equitable relief. Furthermore, many of the IP laws in Singapore have statutory limitations on the time during which an action can be brought for infringement, such as six years from the date on which the cause of action arose for trade marks.

As noted above, one of the main benefits of owning IP is its deterrent effect. You want your competitors to think twice about copying you because they know that you have the option to sue if they do. If you become known in the industry for not robustly defending your IP position, the deterrent effects of your IP will be reduced or eliminated. Others will notice that you are being infringed and that no action is being taken and will also be tempted to take advantage of your creative and inventive work.



*In practice, each case should be treated on its merits. Some disputes may be with very small entities who would not be in a position to pay damages. In other cases, your position may be relatively weak and you may assess that you have little chance of success. In such circumstances, it may be the best strategic decision to not to pursue an alleged infringer or to acquiesce to a request to cease performing a particular action. It is important to pick your battles and disputes and to ensure that you win the most important ones.*





*It is also important not to 'throw your weight around' and make groundless threats. There is a specific defence against groundless threats in Singapore and other countries. This point is explained further in the following chapters, but the golden rule is to make sure you seek proper legal advice.*

# 1. Why does IP enforcement matter?



## CHECKLIST

### Maximising the deterrent effect of IP

IP RIGHT	ACTION	✓
<b>Patents</b> 	Make reference to patents that are granted or pending on your product literature, packaging and website	
	Issue news stories when your patents are granted (it may be advisable not to put competitors on notice earlier than this—in highly contested markets, you may even wish to wait until the formal opposition period has elapsed)	
	Mark your products with patent numbers, if applicable	
<b>Trade Marks</b> 	Use the ® symbol next to your mark in all the territories where it is registered on all goods and services, including product packaging (but remember: using the ® symbol on marks that are NOT registered is an offence, both in Singapore and other markets).	
	Use the 'TM' symbol next to any marks you consider distinctive of your organisation that are not yet registered in the territory in question (but notionally could be)	
	Add a statement to your website and your product or service literature drawing attention to the existence of your registered trade marks	
<b>Designs</b> 	Mark your physical products and labels with your registered design number, and state explicitly that they are registered	
	Make reference to designs that are registered on your product literature and website	
<b>Copyright</b> 	Place a clear statement on your website and on any promotional or product literature stating that these documents are '© [Company name] [year of creation]. All rights reserved'	
	Ensure any creative works that you sell bear a copyright statement	
	If you allow anyone else to use your IP, insist on an attribution—i.e. that your ownership of the material is asserted	
<b>Trade Secrets</b> 	Write 'Private and Confidential' or equivalent on documents which contain anything you consider to be a trade secret	



# What acts are considered infringement or criminal acts?



02

## 2. What acts are considered infringement or criminal acts?

### What does 'IP infringement' actually mean?

As its name suggests, IP is a type of property, which belongs to a specific person or corporate body. As with all property, unlawful use of it by a person or corporation is not permitted, as this runs counter to the law. Being an intangible (non-physical) asset, however, the unlawful uses for IP are different; they are generally summarised under the heading of 'infringement'.

Like all other types of property, IP has an owner who can control when and how it is used. Unauthorised taking of a car is usually considered theft. You are not allowed to steal IP either, but since you are not removing anything physical when you do so (the original asset still exists in the same place or places it was previously), the law has to be applied differently.

The law also has to cater for contention. It is usually reasonably straightforward to determine whether a specific car taken from your possession is the same one that a thief is now driving. However, if someone steals your design, they may use it to create something that is physically new and somewhat different that has never been in your possession.

*IP law also has to accommodate some defined types of IP re-use. If it did not, you would not be able to reference your car's make and model when you sell it or review a book using quotes from it. These are called **exceptions**—occasions when unauthorised acts are permitted by law, under specific circumstances. You can read more about them in our accompanying guide—**Keeping Your IP Out Of Trouble**.*



The acts that constitute IP infringement vary to some extent, depending on the type of right involved. These variations occur by type (whether it is a patent, design, trade mark, copyright or some other form of what would generally be considered intellectual property), and occasionally also by the jurisdiction in which the act occurs—although international treaties such as the Berne Convention and Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS) mean there is a large degree of harmonisation internationally.

As an example of a variation, in some countries, it is permitted for consumers to copy music CDs to produce MP3 files that can be played on their mobile devices, whereas in other countries this is not permitted. The actions which constitute infringement in Singapore are outlined in the following sections below.



The accompanying **Going Global** guide in this series provides some detail on the differences between the laws in Singapore and those of other major markets around the globe. It also provides further information on where you are likely to find it easier or more difficult to enforce your rights.

## Can IP infringements be criminal offences?

**M**ost IP-related illegal acts performed with IP ('infringements') are heard in the civil courts. However, some acts are judged to be of such harm to society that they also constitute criminal offences, and can be tried in the criminal courts.

Singapore, like many jurisdictions, has two parallel court systems. Disputes between two parties can be heard in the civil courts. The two parties put their cases before a judge, and a decision is made as to whether a law has been breached.

When an act is considered to not only harm another party but also the fabric of society, a criminal act or an 'offence' is committed. The sanctions for criminal offences and civil infringement are very different, with the possibility of the courts imposing a prison sentence and/or a fine for criminal offences.

At present, IP disputes are heard in the High Court, State Courts and at the Intellectual Property Office of Singapore. A new bill has been passed in Parliament to consolidate most civil IP proceedings in the High Court. There is also a proposal to introduce a 'Fast Track' procedure to cater for lower value disputes and/or where parties prefer the conduct of their case to be expedited. This may be particularly advantageous for smaller businesses owing to the likely introduction of a cap on hearing durations and claim levels.

## What sort of actions constitute IP infringement?

**I**nfringement takes many forms, from using or making a product to simply holding or storing infringing goods without permission. Infringing acts are usually classified as either primary or secondary infringement, depending on whether you are the party performing the infringing act (primary) or whether your actions assist or encourage the primary infringer (secondary).

The legal protection afforded to intellectual property rights owners is wide-ranging. In general, unless covered by a specific exception, it is not permissible to do anything with a third party's intellectual property without their consent (where provided, this usually involves a licence). Typically, acts that are considered infringing involve copying, making, selling, offering for sale, importing, using and even just possessing the product embodying the IP with the intention to distribute without permission. The panel below provides an overview showing which offences apply to which rights.

## 2. What acts are considered infringement or criminal acts?

With registered rights (patents, trade marks and designs), ignorance is no defence against infringement. However, the extent of your knowledge can affect whether damages are awarded against you, and a lack of knowledge may limit criminal liability in relation to registered rights offences. For unregistered rights like copyright, knowledge of the previous right has to be present for infringement to be proven.

In the following sections, we examine the position for each of the main types of IP right. There are similar provisions for other, less commonly used forms of IP, including plant variety rights and layout designs of integrated circuits.

### Illegal civil actions for the main registrable IP rights

If done without permission of the rights owner, subject to specific exceptions, the following acts constitute an infringement of IP rights. Note that this table does not cover acts which are also criminal, such as counterfeiting, which are discussed at the end of this chapter.

OFFENCE	PATENT	TRADE MARK	DESIGN
Make (manufacture)	Infringement—for a patented product	Infringement—if mark invalidly applied to goods being made	Infringement—for a registered design
Pre-manufactured goods		Infringement—if mark invalidly applied to goods already made	
Dispose of (sell)	Infringement—for a patented product, or a product created by a patented process	Infringement—if identical or similar mark is used in the course of trade in identical or similar goods or services	Infringement—for a registered design

OFFENCE	PATENT	TRADE MARK	DESIGN
Offer to dispose of (offer to sell)	Infringement—for a patented product, or a product created by a patented process	Infringement—if identical or similar mark is used in the course of trade on goods or services, their packaging, their advertising and any related commercial materials (e.g. invoices)	Infringement—for a registered design
Use	Infringement—for a patented product or process, or a product created by a patented process	Infringement—if identical or similar mark is used in the course of trade in identical or similar goods or services  Also infringes with dissimilar goods or services if the mark has a 'reputation'	Infringement—for a registered design
Offer to use	Infringement—for a patented process		
Import	Infringement—for a patented product	Infringement—if identical or similar mark is used in the course of trade in identical or similar goods or services	Infringement—for a registered design. Also applies to export
Keep	Infringes for a patented product, or a product created by a patented process	Infringement—if mark invalidly applied to goods in your possession, in the ordinary course of business	Infringement—for a registered design (stocking the product counts as infringement)
Hire or let out in the course of business		Infringement—if identical or similar mark is used in the course of trade in identical or similar goods or services	
Supplying or offer to supply a means to enable someone to put the IP into effect in an infringing manner	Constitutes secondary infringement for a patented product or process	Constitutes secondary infringement	

## 2. What acts are considered infringement or criminal acts?

### How does copyright infringement differ from other IP-infringing acts?

Copyright is, as the name suggests, the right the owner of the work has to stop you from 'copying' the work. Without prior knowledge of the work, copying is (by definition) not possible, and for this reason, bringing an action under copyright will be easier if it can be proven that the alleged infringer had access to it.

With regards to copyright, unless there is an exception, it is an infringement to do any of the acts listed below, or to authorise someone else to do so. As can be seen, there is a secondary as well as a primary infringement risk.

PRIMARY INFRINGEMENT	SECONDARY INFRINGEMENT
Copy, make or adapt the work	<i>Import infringing copies of a work</i>
Issue copies of the work to the public	<i>Possess, show, exhibit or distribute infringing works in the course of business</i>
Rent or lend the copied work to the public	<i>Provide (by making, selling, importing or possessing) the means for a party to make infringing copies of a work</i>
Perform, show or play the protected work to the public	<i>Permit the use of premises and/or platform for an infringing performance to be shown</i>
Communicate the work to the public (e.g. by putting it on the internet for viewing or download)	

It is important to note that as well as being infringements that can be pursued using civil proceedings, some of these may also be criminal offences, as further explained below.

The accompanying **Keeping Your IP Out Of Trouble** guide lists the statutory exceptions—these are acts that are allowed to be performed with your IP without your permission.





## When does an IP infringement become a criminal offence?

Some acts are not only considered infringement but are also criminal offences. In IP law, these are primarily offences related to copyright and trade marks, as most patent and design-related infringing acts are not criminal.

Most patent-related matters in Singapore are a civil matter and criminal sanctions do not apply in relations to infringement. The exceptions for patent holders to be aware of are that you must not falsely claim that a patent is in force (or applied for) when it is not, or make false declarations to the register. There are also no criminal sanctions associated with unauthorised copying of a registered design in Singapore (though such sanctions do exist in some other countries).

There are, however, criminal offences associated with various unauthorised acts associated with trade marks and copyright. This arises from the fact that infringers are misleading the public about the authenticity of the origin or goods and as pointed out in Chapter 1, the consequences of this can be extremely serious.

## Criminal offences under Singapore IP law

**NOTE:** *all of these assume that the acts in question are being done without the rights owner's consent.*

TRADE MARKS	COPYRIGHT
Counterfeiting a trade mark by using a sign that is the same or similar to a registered mark with the intention to deceive	<i>Manufacturing infringing copies for commercial purposes</i>
Applying a mark to either goods or their packaging that is the same or similar to a registered one on the same or similar goods	<i>Selling infringing copies for commercial purposes</i>
Falsifying a genuine registered mark by alteration, addition, effacement or partial removal	<i>Importing infringing copies for commercial purposes</i>
Making or possessing an article for committing a trade mark offence	<i>Distributing infringing copies for commercial purposes</i>
Importing, selling or offering to sell goods or services carrying a registered trade mark without the mark owner's permission	

## 2. What acts are considered infringement or criminal acts?

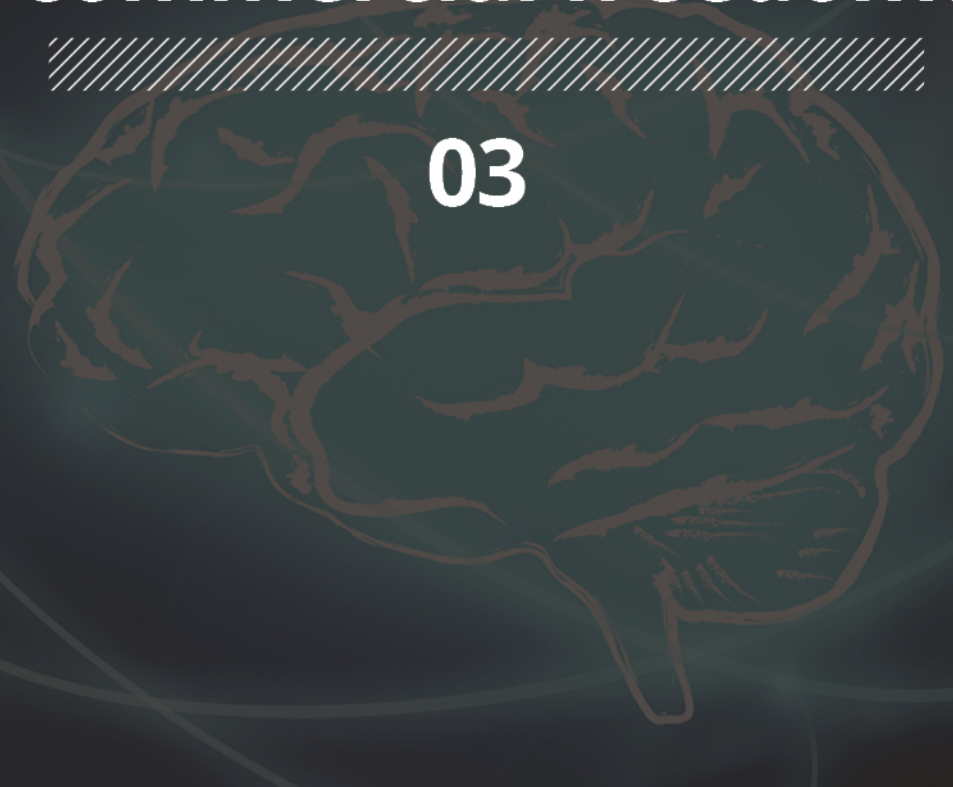
TRADE MARKS	COPYRIGHT
Using the arms or flags of Singapore that have a trade mark without permission from the Singapore authorities	
Falsifying the trade mark register or claiming to have a mark registered when you do not	



# How can I prevent others obtaining rights that could limit my commercial freedom?



03



### 3. How can I prevent others obtaining rights that could limit my commercial freedom?

#### Can I use my existing IP to prevent others obtaining new IP?

It is generally much simpler and less expensive to prevent the registration of someone else's IP before it is accepted than to overturn, strike off, invalidate or revoke the right once it has been approved and has entered the register. This section sets out practical tips on how to prevent registration of

trade marks, patents and domains that could have an adverse impact on your business.

Prevention, in general, is better than cure. If you can stop an IP application from being registered by an opponent using the existing rights you have, you are likely to eliminate the chances of a dispute occurring in the future. Also, if a dispute does occur, you will have a much stronger position legally.

In an ideal world, it is best to strive to secure registered rights before a third party, as Singapore practises a first-to-file system. In other words, the first person to file an application (in respect of trade marks, designs and patents) may gain rights and potentially invalidate any future claim you may have in a patent, design or registered trade mark.

Nevertheless, in Singapore, there are procedures in place to prevent the registration of trade marks, domains and patents, if these registrations are invalid due to the existence of an existing right. Most, but not all, other countries have similar procedures that can be followed, though you may need to hire a legal adviser locally to use them efficiently and successfully.

#### How can I oppose a trade mark registration?

During the trade mark registration procedure, there is an opportunity for existing rights holders to oppose the registration of new marks that may confuse the public about the origin or quality of the goods or services being

offered. If you are using a mark (irrespective of whether or not it is registered), you may be able to stop a new mark that encroaches on your rights from being approved.

Registered trade marks provide the owner with rights to prevent parties from using the same or similar marks for the same or similar goods. If your mark has a reputation (in other words, if it can be shown to be very well known), it may prevent use for any goods or services.

This mechanism exists primarily to protect the public. It is intended to prevent them from being confused by the two marks, and so from buying goods or services from the 'wrong' party.

If a new trade mark application is received that is similar to your registered mark and the application is in the same class as the one you have registered, IPOS will write to you alerting you of the new trade mark application. Before a new trade mark is registered, it is published and anyone with a prior mark (registered or unregistered) which may be affected by this registration has the right to oppose the registration.



*If you wish to be alerted when new marks are applied for that are similar to yours in all classes or if you want to receive alerts and you do not have a registered trade mark yourself, then you will need to sign up to a watch service. The accompanying guide in this series—**Knowing Your Competition** explains how you can set up a watch service to monitor for new trade mark applications.*

## How can I prevent registration of a domain name that contains my trade mark?

Cybersquatting can cause serious problems by diverting traffic away from your legitimate website. In certain circumstances, it is possible to be alerted to and prevent attempts to register domain names that contain your trade mark name. You can use the Trademark Clearing House, or the Singapore Domain Name Dispute Resolution Policy (SDRP).

Domain name registration is a first to file system, so even if you own a prior registered trade mark it is possible that someone may try and secure a domain name containing your registration before you. However, there are ways to keep a watch on this kind of activity.

The domain name provider ICANN, runs a service known as the "Trademark Clearinghouse" (see <http://www.trademark-clearinghouse.com/>). For a fee, registered trade mark owners or their agents can register 'accepted trademarks' with the service, which may include unregistered trade marks, and are then informed whenever ICANN receives a new request to register a domain which includes the string contained in the registered trade mark. If you are using the service and receive such a notification, you then have the option to oppose the registration of the new domain.

'Accepted trademarks' include *marks protected by statute or treaty, or court validated marks* as well as any other marks that constitute IP rights in accordance with the registry's policies and that meet the eligibility requirements of the *Trademark Clearinghouse*.

Once your trade mark has been lodged in the Trademark Clearinghouse database you also have an automatic right to register domains containing

### 3. How can I prevent others obtaining rights that could limit my commercial freedom?

your trade mark when new top level domains (gTLDs) are launched—such as .app or .food). As part of the launch, each new gTLD must allow a ‘sunrise’ period of at least 30 days when registered mark owners can register relevant domains before registration is opened up more widely to the general population. This gives you the chance to obtain new domains containing your trade mark before they go on general release.

*The service described here is only available for domains that are controlled by ICANN (most notably .com, .info and the new gTLD domains). It is not available for .sg domains which are administered by the Singapore Network Information Centre (SGNIC) Pte Ltd.*



*For .sg domains, owners of a domain should consider using the Singapore Domain Name Dispute Resolution Policy (SDRP), which is run by a mediation service, to prevent registration by the other party.*

#### How can I stop someone else from getting a patent similar in scope to my granted patent?

If a competitor submits a patent application and you believe that it should not be granted, you can submit observations which the examiner can take into account during the examination process. This applies both to Singapore and to many other jurisdictions where the application may be pending.

When a patent application is first filed, it remains confidential and unpublished for up to 18 months unless an application is made by the patent assignee for accelerated publication. However, a patent cannot be granted in most countries until it has been published for a minimum of three months.

Once the patent application has published and is in the public domain, but before it is granted, any interested party can submit observations to IPOS or the examining body in question. The examiner then has the discretion to consider these comments, provided that they relate to legal reasons why the patent should not be granted.

## Usual grounds for objecting to a patent application

GROUND FOR OBJECTION	EXPLANATION/EVIDENCE
<b>Lack of novelty</b>	<i>You have evidence that shows that the invention is not new—i.e. that something very similar is already known or has been disclosed to the public before</i>
<b>Lack of inventive step</b>	<i>You can show that, for someone with the relevant technical knowledge, the step that is subject to the patent application could be considered obvious. This might be demonstrated using suitable parallels</i>
<b>Not sufficiently well described</b>	<i>Patents are often intentionally somewhat economical with detail in order to preserve proprietary knowledge within the firm. As a 'person skilled in the art', you may be well placed to provide evidence that the invention is not set out in sufficient detail to enable anyone else to reproduce it.</i>
<b>Does not cover patentable subject matter</b>	<i>Certain types of inventions are inherently not patentable. The rules vary by country. In Singapore, following revised guidelines in 2016, the rules exclude discoveries, scientific theories and mathematical methods, ways of doing business or program for a computer, presentation of information and all kinds of aesthetic creations.</i>

Your competitor may also have filed their patent application in other jurisdictions. Most have similar formal or informal procedures that allow the submission of third-party observations and so you should ensure that your observations are not only submitted in Singapore but also in other territories where the patent is pending.

### How can I stop use or dissemination of my trade secrets and confidential information??

It is often assumed that if secret information is acquired by a third party, it is no longer secret and is outside the company's control. This is not entirely true, as there are steps that can be taken to minimise any damage caused and to seek redress.

For a trade secret to qualify for legal protection, it has to be secret (in the sense that it is not generally known among, or readily accessible to, persons within the circles that normally deal with the kind of information in question); have commercial value because it is secret; and to have been subject to reasonable steps to keep it secret.

In Singapore and internationally, there are laws in place to protect owners of trade secrets from the unauthorised dissemination and use of confidential information. Nevertheless, the value of a trade secret may be lost if it is disclosed, as you cannot turn back the clock and make the information secret again, so it is important to ensure that every effort has been taken to ensure confidentiality is maintained at the outset.

### 3. How can I prevent others obtaining rights that could limit my commercial freedom?

In Singapore, you can bring an action for breach of confidence if you believe that your confidential information has been taken by a party you did not authorise or is being used in a way that you have not permitted. Of course, this only allows you to seek damages—you can't make it secret again. Under breach of confidence, you have to be able to show three things, set out in the following table.

	TEST	EXPLANATION
1	<b>The information has the essence of confidential information about it</b>	To qualify, the information has to be discrete, identifiable pieces of information which are not generally well know in the industry and are treated as secret (i.e. documents will usually have "Private and Confidential" written on them and they will not be readily accessible across the organisation). For example, it may be that the information is kept in encrypted form or locked away in some form. It is important to show that reasonable steps have been taken to treat the information as secret and control access to it
2	<b>The information was obtained either unlawfully or under conditions that imparted an obligation of confidence on the party obtaining the information</b>	<p>There are a several situations where the information could be shared under conditions that impart an obligation of confidentiality on the recipient:</p> <ul style="list-style-type: none"> <li>• On some occasions, the recipient will have signed an NDA and so have a contractual obligation of confidence</li> <li>• Other recipients have an obligation of confidence by virtue of their position (for example your doctor or your solicitor)</li> <li>• At other times, the obligation is more of an implied one, for example when it should be obvious from the context (such as a company sharing CAD drawings with its manufacturer)</li> </ul> <p>By contrast, if the information was disclosed at a social event and not in a business setting, then the recipient is much less likely to be under an obligation of confidence</p>
3	<b>The information has been used for a purpose that is unauthorised</b>	Sometimes, you may wish to tell your secrets to particular parties for specific purposes. The recipient can use the information for the purpose you intended, but not for any other purpose. If the information is used for an unauthorised purpose and the other two conditions are also met, there is a breach of confidence. If this has caused detriment to the owner, legal recourse is possible.



If you can show these things, which will be viewed and assessed in the whole context by the court, an injunction can be obtained which can prevent the party acquiring the information from disseminating it further or using it, even though it is known to them.

You may also be able to rely on Singapore's Computer Misuse Act, which defines it an offence if a person obtains unauthorised access to an employer's computers to retrieve or download information, such as confidential trade secrets stored in electronic form.



*The accompanying guide—**Safeguarding Your Competitive Edge** discusses best practice in managing your trade secrets and how to prevent them from entering the public domain.*

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# What are my main enforcement options?



04

## Who should I talk to first?

**W**hen you discover that someone appears to be infringing your IP, you may find it difficult to know what to do first. As you have to be careful not to prejudice your case, or make accusations of groundless threats that can lead you into dangerous ground, you should avoid approaching the other party directly.

It is important not to accuse another party of infringement unless you are certain of your case (and even then, it is not wise to do so in haste). You should, therefore, be very careful when approaching potential infringers; it is prudent to seek professional advice before any approach is made.

One reason why it is risky to rush in is that it is illegal to make threats that turn out to be groundless. If you do so, the other party can sue you in court and seek an injunction preventing further threats being made, along with a declaration from the court that their activities are not infringing your IP.

To make matters even worse, it is also possible that the other party may be able to claim damages and costs from you equivalent to the loss obtained as a result of the threats that you made. So if you are not careful, you may end up being in a significantly worse position than if you had done nothing at all.

This need for caution must be balanced against the principles set out in Chapter 1 of this guide. Since failure to act promptly can affect your chances of a successful outcome (as well as your sales and potentially your reputation in the meantime), you will not wish to leave it too long before addressing the issue.



*The accompanying guide—**Keeping Your IP Out Of Trouble** considers this situation from the opposite angle—if you are in receipt of approaches that imply you are infringing someone else's IP.*

## If you become aware of infringement, what will your adviser need to know?

	TEST	EXPLANATION
1	Which of your IP rights you think is being infringed	The identifiers of any registered rights and descriptions of copyright works

## 4. What are my main enforcement options?

	TEST	EXPLANATION
2	The identity of the suspected infringer	Whether they are known to you as a competitor or supplier, whether you have had any business dealings with them, and what size of operation you believe they have
3	The act you consider to be infringing	Which aspect appears to have been copied and what the other party has done to copy it
4	Where this act is taking place	The geographic territories you believe are affected (with observations on what protection you have there)
5	When you found out about it, and who told you	Whether this has arisen from a report received from a contact, a 'whistleblower', or your own independent enquiries, and how long you have known about it
6	What the possible impact on your business of this act is	An explanation of how this suspected infringement is already being, or likely to be, detrimental to your business, with some indications of the order of magnitude

### Am I in a position to take effective action?

Your first step when notified of a possible infringement will be to work out what grounds you may have to do anything about it. This will involve careful consideration of the rights you have, where they are applicable, and what stage they have reached.

For obvious reasons, IP rights can only be enforced in territories where they exist. They may have to be registered or granted to be enforceable (required in the case of patents and designs, and greatly preferable with trade marks—but not necessary with copyright in Singapore).

The first difficulty you may have is that your rights may be in progress rather than already registered or granted—particularly in the case of patents—or may not apply to the territory where the infringement is taking place.

If you have a patent that is pending which you think is being infringed, you may be able to accelerate the examination process either in

Singapore or overseas. If you have a patent pending in the territory where the infringement is occurring but have another member of the same patent family granted in another territory, it may be possible to use the Patent Prosecution Highway (PPH) or other, similar mechanisms to 'fast track' your grant in the territory of interest. If this is the case, one of the first people you should speak to will be your patent agents, so that they can advise on your options for accelerating grant.

If your concern relates to brands, you may first need to determine whether the offending party has managed to register a mark in relation to the word or image being used. If they have not, and you can demonstrate the use of the mark over a period of time, you may be able to register it first. If they have succeeded in getting a mark registered already, you are likely to have a difficult job getting this overturned.



*Assuming that you do have a case, it is likely that your legal adviser will start by sending a formal letter to the party concerned, commonly known as a 'cease and desist' letter. This tells the alleged infringer that they have to stop what they are doing and (generally) account to you for what they have already done.*

## How can I avoid court action?

**A** dispute does not always have to lead to court action. If you need to enforce your IP rights but do not want to go to court, Singapore offers several Alternative Dispute Resolution ('ADR') routes, including both mediation and arbitration.

In IP matters, only a small percentage of disputes actually end up in court. The vast majority are resolved before it escalates to this point because the costs involved in both bringing and defending a civil action are substantial for both parties.

This makes going to court a last resort when both parties believe that they have a good prospect of winning. In many cases, one party's legal position is much weaker than the other's and, in these situations, an out-of-court settlement is usually desirable and possible.

Singapore has an internationally recognised IP mediation facility and is a route well worth considering. In Singapore, the courts cannot force the parties to undertake Alternative Dispute Resolution (ADR) procedures, but these are encouraged and promoted, and a refusal to engage can affect the level of compensation awarded.

Of course, a further possible solution may present itself if your complaint concerns a third party that is importing and selling infringing goods into Singapore. You may be in a position to approach them and agree with them to remove the infringing goods, then work with them to only supply genuine products (produced by yourself) to the other party. This solution turns a potential issue into an opportunity: the infringing goods lose a distributor in your home market, and your former adversary now works to sell your goods and services under licence.

## 4. What are my main enforcement options?

The accompanying guide—**Knowing Your Competition** explains how you can keep tabs on competitor activity.



### Recognised Alternative Dispute Resolution (ADR) routes

	ROUTE	EXPLANATION
1	Mediation	This is a successful and well-established option that has been running under WIPO guidelines since 2011. As an incentive to use it, IPOS has recently introduced the Mediation Promotion Scheme, which provides S\$5.5k per case.
2	Arbitration	<p>As an alternative to mediation or court action, disputes can also be settled using arbitration. These proceedings are governed by the Arbitration Act or the International Arbitration Act, depending on whether the dispute is national or international in nature.</p> <p>Arbitration can be 'ad hoc' or administered by the Singapore International Arbitration Centre or WIPO AMC.</p> <p>Arbitration has several possible advantages over court proceedings. It costs less than a full court hearing; the outcome is kept confidential; and the arbitration awards are final, with limited scope for appeal.</p>

### What will happen if I cannot avoid legal action?

If you do have to begin legal proceedings in Singapore, it is important to know the steps involved and what you can expect. The procedures for civil and criminal cases differ somewhat, but both follow an established sequence.

If you are considering legal action, you will almost certainly require legal assistance and your counsel will provide you with more details on the procedures and processes that are involved. The following is a basic overview of what you can expect that may be helpful before you engage professional support.

Civil cases are generally heard in the High Court. A high court action in Singapore is normally initiated by a writ of summons. This is then followed by an often lengthy series of steps that may lead to a trial in open court (except breach of confidence cases) where witnesses from both sides are called and cross-examined. The case is decided by a high court judge.



For criminal matters, enforcement is normally carried out by the Intellectual Property Rights Branch (IPRB) of the Singapore Police Force. The owner of the IP rights normally has to gather some evidence of wrong-doing initially and present this to the IPRB who will then jointly file a complaint with a magistrate of the State Courts of Singapore.

Following this, it is common for a search warrant to be issued and for IPRB officers to search the premises of the alleged offender and to seize any counterfeit or illegal goods found. The rights owner then has a period of six months to bring a criminal case against the other party, which could end up in court or a settlement between the parties.

This summary applies to cases brought in Singapore. If your rights are being infringed overseas, you may need to take legal action in other territories outside of Singapore. Some countries have more robust IP laws and enforcement regimes than others.





*The accompanying—**Going Global** guide explains in more detail how you can enforce your IP overseas and how the laws in other countries vary to those in Singapore.*



## 4. What are my main enforcement options?

### What complications may arise?

The claims and counter-claims that are likely to be made in the course of a trial, or during ADR proceedings, will vary according to the type of rights that are alleged to have been infringed. Here are some indicative arguments that may be used. A checklist is provided for you to mark up any you feel might be relevant.

IP RIGHT	ACTION	EXPLANATION	
<b>Patents</b> 	<b>Invalidity</b>	<p>The defendant may claim the patent they are alleged to infringe is, in fact, invalid and should be removed from the register, based on:</p> <ul style="list-style-type: none"> <li>• Lack of novelty</li> <li>• Lack of inventive step</li> <li>• Not disclosed in sufficient detail</li> <li>• Not patentable subject matter</li> </ul> <p>The Singapore courts in general deal with both infringement and validity together. The validity of patents may be determined by IPOS but if proceedings are pending in the court, no proceedings can be instituted before the Registrar at IPOS without the leave of the court. IPOS has discretion to refer cases to the court if its validity is better dealt with simultaneously.</p>	
	<b>Counter-claim</b>	<p>The defendant may claim that the plaintiff is also infringing their rights. This is not uncommon where the case is brought between direct competitors with strong IP portfolios. This may turn out to be a 'zero-sum game' with proceedings concluding that both are equally infringing, in which case the solution is likely to involve cross-licensing.</p>	
	<b>Declaratory judgment</b>	<p>A declaratory judgement of non-infringement can be issued by either the High Court or IPOS. This is only possible if the alleged infringer has sought written confirmation that they were not infringing prior to the action being brought and the patent owner did not reply.</p>	



IP RIGHT	ACTION	EXPLANATION	✓
<b>Trade Marks</b> 	<b>Revocation through lack of use</b>	<p>A common defence strategy is to argue that the trade mark that is registered should be removed from the register, for example, due to lack of use. If a trade mark has not been used for a particular good or service for a continuous period of 5 years, it can be removed from the register and is then free for all to use.</p>	
	<b>Border enforcement measures</b>	<p>The owner (or licensee) of a trade mark registered in Singapore who expects infringing goods to be imported can give written notice to the Director General indicating when and where the goods will be imported and why they are infringing. This notice is valid for 60 days and will lead to the infringing goods being seized at the port of entry.</p>	
<b>Copyright</b> 	<b>Actual knowledge</b>	<p>A successful prosecution requires the IP owner to show that the infringer has seen and copied or has been instructed in some way that they could only make the work in question (this could be via a design brief, for example). Unlike registered rights, where the burden of proof is on the alleged infringer to show that they are not infringing, copyright law requires the plaintiff to show that copying has occurred, and that copying is of a ‘substantive’ nature and has not, say, only ‘influenced’ or ‘inspired’ another work. Defendants will seek to claim that they had no actual knowledge of the work in question.</p>	
	<b>Injunctive relief</b>	<p>If you suspect that your copyright assets are being flagrantly copied via a third party website, you may use the provisions added to the Copyright Act in 2014 aimed specifically at discouraging online piracy. Companies that host illicit websites, sites that stream pirated content and sites that link to copyright infringing material are subject to expeditious injunctive relief that results in the illicit sites being disabled.</p> <p>If you can show that the purpose of the site is to infringe copyright, it provides circumvention methods to overcome copyright protections and the site operators demonstrates a disregard for copyright laws generally, then you can apply directly to the High Court for an injunction “requiring the network service provider to take reasonable steps to disable access to the flagrantly infringing online location”.</p>	



# Where do I get help?

## 05

### GETTING RIGHTS GRANTED

IPOS : [www.ipos.gov.sg/resources](http://www.ipos.gov.sg/resources)

### GETTING IP ADVISORY

- Intangible asset audit
- Intangible asset strategy and management
- Business and technology intelligence
- Commercial analytics on patents
- Due diligence on intangible assets
- Bespoke advisory services

### GETTING IP TRAINING

- Executive programmes
- Certifications
- Undergraduate and postgraduate courses
- Regional training

### GETTING PATENTS RIGHT

- Patent search and examination (for both national and international PCT applications)
- Patent analytics
- Customised search services

### DEALING WITH DISPUTES

IP Legal Clinic (IPOS) : [www.ipos.gov.sg/e-services](http://www.ipos.gov.sg/e-services)

### FOR INFORMATION AND ENQUIRIES

Website : [www.iposinternational.com](http://www.iposinternational.com)

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