

**CHECKLIST OF ISSUES ON ENFORCEMENT<sup>1</sup>**

Responses from Singapore

**Civil and Administrative Procedures and Remedies**

(a) *Civil judicial procedures and remedies*

**1. Specify the courts which have jurisdiction over IPR infringement cases.**

Under the Patents Act (Cap. 221) and Trade Marks Act 1998 (N° 46 of 1998), Geographical Indications Act 1998 (N° 44 of 1998), Layout-Designs of Integrated Circuits Act (N° 3 of 1998), Copyright Act 1987 (Cap. 63) and the United Kingdom Design (Protection) Act (Cap. 339), the High Court has jurisdiction over matters arising under these Acts.

Appeals from the High Court are to the Court of Appeal.

**2. Which persons have standing to assert IPRs? How may they be represented? Are there requirements for mandatory personal appearances before the court by the right holder?**

Infringement actions may be instituted:

- by a copyright owner, exclusive licensee or performer under the Copyright Act;
- by the patent owner or exclusive licensee under the Patents Act;
- by the trademark owner or registered licensee under the Trade Marks Act;
- by the registered proprietor of any design registered under the United Kingdom Designs (Protection) Act;
- by an interested party of goods identified by a geographical indication under the Geographical Indications Act. An interested party is defined under the Act to mean a producer of the goods identified by a geographical indication, a trader of the goods, or an association of such producers or traders; and
- by an owner of a layout-design or exclusive licensee under the Layout-Designs of Integrated Circuits Act.

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<sup>1</sup> Document IP/C/5.

Individuals may either represent themselves or be represented by a lawyer. However, a body corporate may not begin or carry on any proceedings in Court otherwise than by a lawyer.

There are no requirements for mandatory personal appearances before the Court by the right holder.

**3. What authority do the judicial authorities have to order, at the request of an opposing party, a party to a proceeding to produce evidence which lies within its control?**

The Court may order any party to a cause or matter to make and serve on any other party a list of the documents which are or have been in his possession, custody or power relating to any matter in question in the cause or matter, and may at the same time or subsequently also order him to make and file an affidavit verifying such a list and to serve a copy thereof on the other party.

A discovery order may be limited to such document or classes of document only or to such only of the matters in question in the cause or matter, as may be specified in the order.

**4. What means exist to identify and protect confidential information brought forward as evidence?**

A Court can impose confidentiality orders in respect to information, for example, prohibiting the reporting of the contents of a document or only permitting certain persons of the other party to the proceedings to inspect the documents, for example, the legal advisors or technical experts.

A Court can also order any proceeding to be held in camera if it is satisfied that it is expedient in the interests of justice, public safety, public security or propriety, or for some other sufficient reason to do so. (s8 SCJA)

**5. Describe the remedies that may be ordered by the judicial authorities and criteria, legislative or jurisprudentially, for their use:**

- **injunctions;**
- **damages, including recovery of profits, and expenses, including attorney's fees;**
- **destruction or other disposal of infringing goods and materials/implements for their production;**
- **any other remedies.**

Under the provisions of the Copyright Act, Patents Act, the Trade Marks Act, Geographical Indications Act, and Layout-Designs of Integrated Circuits Act, the Courts may grant the following remedies:

- interlocutory or permanent injunctions; and
- damages; or account of profits.

Under their general jurisdiction, the Courts have the powers to order a party to pay the legal costs of another party.

Whether or not an interlocutory injunction will be granted will depend on the following factors:

- whether there is a serious issue to be tried;
- if there is a serious issue, whether damages will compensate the plaintiff in the absence of an interlocutory injunction;
- if an injunction should be granted, whether the plaintiff can provide an undertaking to pay damages to the defendant should the plaintiff's case not succeed; and
- where the case is evenly weighted, the balance of convenience in granting the interlocutory injunction.

A permanent injunction may be granted where the plaintiff establishes infringement.

Under the Copyright Act and the Layout-Designs of Integrated Circuits Act, the Court, if satisfied that it is proper to do so, having regard to:

- the flagrancy of the infringement;
- any benefit shown to have accrued to the defendant by reason of the infringement; and
- all other relevant matters

may in assessing damages for the infringement, award such additional damages as it considers appropriate in the circumstances.

Under the Copyright Act, Patents Act, Trade Marks Act and the Layout-Designs of Integrated Circuits Act, the Court may order the delivery up and/or destruction or other disposal of infringing goods and materials and implements for their production in appropriate situations.

**6. In what circumstances, if any, do judicial authorities have the authority to order the infringer to inform the right holder of the identity of third persons involved in the production and distribution of the goods or services found to be infringing and of their channels of distribution?**

The Courts have inherent and statutory authority to make an order requiring the infringer to inform the right holder of the identity of third persons involved in the production and distribution of the goods or services found to be infringing.

The Anton Piller order may be coupled with an order for the discovery of the names of suppliers.

**7. Describe provisions relating to the indemnification of defendants wrongfully enjoined. To what extent are public authorities and/or officials liable in such a situation and what "remedial measures" are applicable to them?**

Damages and injunction may be sought for groundless threats of legal proceedings under the Copyright Act, Patents Act, Trade Marks Act and Layout-Designs of Integrated Circuits Act.

An interlocutory injunction is normally granted only if the plaintiff gives an undertaking as to damages. If it is decided at trial that the injunction has been wrongly ordered, the Court may order the unsuccessful plaintiff to pay damages to the defendant.

The Copyright Act and the Trade Marks Act further provide that, in a case arising from a border seizure if a Court decides that there was no infringement or the objector to the importer fails to commence infringement proceedings, the Court may order the objector to the importation (the plaintiff in the action), to pay compensation in such amount as the Court thinks fit to the defendant upon being satisfied that the defendant has suffered damage as a result of the seizure.

Public authorities and officials cannot be held personally liable in situations in which their actions were within the scope of their duties and responsibilities and in which they were acting in good faith.

**8. Describe provisions governing the length and cost of proceedings. Provide any available data on the actual duration of proceedings and their cost.**

The length and cost of proceedings will vary with each case. Factors which can influence length and cost are the number of parties involved, the complexity of the proceedings and availability of witness. No specific data is available on actual duration of proceedings and costs.

(b) *Administrative procedures and remedies*

**9. Reply to the above questions in relation to any administrative procedures on the merits and remedies that may result from these procedures.**

The power which the Registrar has relating to enforcement in patent infringement cases is a very limited one. The Registrar can only hear patent infringement cases if all parties to the proceedings consent to the trial by the Registrar. Even then, the Registrar has no power to award an injunction or an account of profits, and can only order the payment of damages and make a declaration that the patent is valid and has been infringed by the defendant.

Nevertheless, the Registrar does have the authority to adjudicate upon an application for a declaration of non-infringement of a patent. This is a concurrent jurisdiction with that of the Courts entitled to hear patent infringement proceedings and an application for revocation of the patent. In such proceedings for a declaration of non-infringement (whether brought before the Registrar or a Court), the applicant has the onus of proving that his article/process does not infringe a valid claim of the patent, whereas in infringement proceedings as such, it is the patentee which has the onus of proof that the defendant has carried out an act of patent infringement.

**Provisional Measures**

(a) *Judicial measures*

**10. Describe the types of provisional measures that judicial authorities may order, and the legal basis for such authority.**

Pre-trial injunctions or orders that may be granted by the Courts include interlocutory injunctions, Anton Piller orders and Mareva injunctions. Interlocutory injunctions were discussed in the answer to question 5.

The Anton Piller order and the Mareva injunction were established through precedent in English case law and have been adopted by the Courts in Singapore. Anton Piller orders which are

granted *ex parte* allow the plaintiff to search the defendant's premises for documents or evidence which would demonstrate the infringement in order to preserve these against destruction or loss. Such an order would be granted if there is a strong *prima facie* case, the potential damage to the plaintiff is serious, and if there is a real possibility that the goods or documents would otherwise be destroyed by the defendant. A range of conditions on the execution of the order and subsequent dealings with material seized are used to prevent possible injustice to the potential defendant. The Mareva injunction is intended to prevent any movement of the defendant's assets before the Court's decision which would circumvent the Court awarding damages. Mareva injunctions may be granted by the Court if the plaintiff's case would otherwise be prejudiced and if it is just and convenient to do so, considering the interests of both the plaintiff and the defendant.

**11. In what circumstances may such measures be ordered *inaudita altera parte*?**

By its nature the Anton Piller order and a Mareva injunction may be granted *ex parte*. In cases of urgency, an injunction may be granted *ex parte*.

**12. Describe the main procedures for the initiation, ordering and maintenance in force of provisional measures, in particular relevant time-limits and safeguards to protect the legitimate interests of the defendant.**

The circumstances in which such measures may be ordered *inaudita altera parte* (*ex parte*) are discussed above in the comments relating to questions 5 and 10.

**13. Describe provisions governing the length and cost of proceedings. Provide any available data on the actual duration of proceedings and their cost.**

Under the laws of Singapore there are no provisions which govern the length of the proceedings for provisional measures. Provided that a request for provisional measures is made promptly, the Court will then stipulate a timetable for further procedure and a hearing date will be appointed.

As for the costs, please see the answer to question 8.

(b) *Administrative measures*

**14. Reply to the above questions in relation to any administrative provisional measures.**

There are no provisions in the laws of Singapore whereby provisional relief can be given by an administrative body, save as regards "Border Measures" discussed in answers 15 to 19 below.

Additional Information: Other legislation or actions available for enforcement of IPR rights

Unregistered trademarks are enforced under the Common Law action of "passing off". In such proceedings the plaintiff must show that the defendant has misappropriated some part of the plaintiff's "goodwill", that is that, as a result of a reputation gained from past activities, members of the public are likely to be misled by the acts of the defendant as to the origin of goods or services for which the public has an expectation that such are associated with the plaintiff.

An action for the protection of trade secrets may be initiated by any person claiming to be the owner of such secret under the Common Law action of breach of confidence and to have suffered damage by an unauthorized disclosure of the same.

Confidential data/test data are protected under the Medicines Act/Control of Plants Act for a period of 5 years.

**Special Requirements Related to Border Measures.**

- 15. Indicate for which goods it is possible to apply for the suspension by the customs authorities of the release into free circulation, in particular whether these procedures are available also in respect of goods which involve infringements of intellectual property rights other than counterfeit trademark or pirated copyright goods as defined in the TRIPS Agreement (footnote to Article 51). Specify, together with relevant criteria, any imports excluded from the application of such procedures (such as goods from another member of a customs union, goods in transit or *de minimis* imports). Do the procedures apply to imports of goods put on the market in another country by or with the consent of the right holder and to goods destined for exportation?**

Section 82 (1) of the Trade Marks Act allows Customs to seize trademark infringing goods which are imported for the purpose of trade, if a notice of objection to importation of the goods has been given to Customs by the proprietor of the registered trade mark (or a licensee).

Under Section 140B of the Copyright Act, Customs may also seize copies of copyright materials that had been made wholly or partly outside of Singapore without the copyright owner's consent and imported for trade purposes or distribution, if the owner of the copyright has given a notice of objection to Customs. The copyright materials cover works, sound recordings, cinematograph films, published editions of a work, and television or sound broadcasts recorded in a cinematograph film or a sound recording.

In line with the TRIPS Agreement, goods and copyright materials imported for personal use only and goods in transit are not covered under the provisions for seizures.

There is no interdiction for importation of goods that have been put on the market in another country by or with the consent of the right holder in that country (i.e. parallel imports).

Border procedures are not available in respect of exports.

- 16. Provide a description of the main elements of the procedures relating to the suspension of the release of goods by customs authorities, in particular the competent authorities (Article 51), the requirements for an application (Article 52) and various requirements related to the duration of suspension (Article 55). How have Articles 53 (security or equivalent assurance), 56 (indemnification of the importer and of the owner of the goods) and 57 (right of inspection and information) been implemented?**

The main elements of the procedures relating to the suspension of release of goods are as follows:

**Article 51 – Suspension of Release by Customs Authorities**

Under the Trade Marks Act and Copyright Act, a rights holder who has valid grounds for suspecting that the importation of a counterfeit trademark or pirated copyright goods may take place, can make an application (via a notice of objection) to Customs to seize the goods.

### Article 52 – Application

Regulations made under the Trade Marks and Copyright Acts require that notices lodged should be sufficiently supported by documents and evidence that the objector is the owner of the copyright or the proprietor/licensee of a registered trade mark.

The objector must also provide information and evidence in support of the claim that the goods to be seized infringe the trade mark or the copyright. Customs may also require the person serving the notice to provide such information and evidence that is reasonably required for the identification of the infringing materials.

A notice lodged will be valid till the end of 60 days commencing on the day the notice was given. A fresh application can be made to Customs after the expiry of the notice if the objector wishes to maintain an objection.

### Article 53 – Security or Equivalent Assurance

Section 83 of the Trade Marks Act and Section 140C of the Copyright Act specify that the person giving a notice under the Trade Marks Act and the Copyright Act may be required to provide a security to indemnify:

- the Government for any liability and expenses which it may incur as a result of seizing the goods, and
- a person suffering damage as a result of the seizure.

The security may be in the form of a deposit of money or an instrument of guarantee.

### Article 55 – Duration of Suspension

After the goods have been seized, Customs would give to the importer and the objector via either in person, or post a written notice identifying the goods and stating that they have been seized.

The notice will state that the seized goods shall be returned to the importer of the goods unless an action for infringement of the copyright or trade mark involved is instituted within 10 working days from the date that the notice is served (retention period). Before the expiry of the retention period, the objector can make a written request to Customs for the extension of the retention period. Customs may grant an extension of up to 10 working days.

If there is no order from the Court to prevent the release of the seized goods after three weeks from the day the infringement action was instituted in relation to the seized goods, Customs will release the goods to the importer.

### Article 56 - Indemnification of the Importer and the Owner of the Goods

Under Section 90(6) of the Trade Marks Act and Section 140(I)(7) of the Copyright Act, if:

- the actions are dismissed or discontinued, or if the Court decides that the relevant registered trade mark or copyright was not infringed by the importation of the seized goods, and

- the importer or owner of the goods has suffered loss or damage as a result of the seizure,

the Court may order the objector to pay compensation in such amount as the Court thinks fit. The Court may also order compensation for a failure to take any action.

#### Article 57 - Right of Inspection and Information

Upon application to Customs, the objector or the importer may be allowed to remove a sample of the seized goods for inspection.

- 17. Describe provisions governing the length and cost of proceedings. Provide any available data on the actual duration of proceedings and their cost. How long is the validity of decisions by the competent authorities for the suspension of the release of goods into free circulation?**

The requirements for the retention of goods seized under the Trade Marks Act and the Copyright Act are described in the answer to question 16 above. The rights holder or the appointed agent must institute an action for infringement of the copyright or trade mark involved within 10 working days from the date that the notice is served to inform him about the seizure of the goods. The ten working days can be extended to a further 10 working days upon application to Customs.

If three weeks after the action had been brought, there is no order of the Court to prevent the release of the seized goods, Customs would release the goods to the importer. Customs would also release the goods if the Court orders the release of the seized goods at any time after the infringement action has been commenced. There are no available data on the actual duration or cost of proceedings at the moment.

- 18. Are competent authorities required to act upon their own initiative and, if so, in what circumstances? Are there any special provisions applicable to *ex officio* action?**

There is no provision for *ex officio* action as this is not a TRIPS requirement.

- 19. Describe the remedies that the competent authorities have the authority to order and any criteria regulating their use.**

The competent authorities do not have any power to order any remedies. Only the Courts have the power to order remedies.

#### Criminal Procedures

- 20. Specify the courts which have jurisdiction over criminal acts of infringement of IPRs.**

In Singapore, the infringement of intellectual property rights is governed by the Copyright Act (Cap. 63) and the Trade Marks Act (Cap. 332). The Courts which have jurisdiction would be the Magistrate Court, the District Court, the High Court and the Court of Appeal.



**21. In respect of which infringements of which intellectual property rights are criminal procedures and penalties available?**

Under the Copyright Act:

A person who at a time when copyright subsists in a work

- makes for sale or hire;
- sells or lets for hire, or by way of trade offers or exposes for sale or hire; or
- by way of trade exhibits in public,

any article which he knows, or ought reasonably to know, to be an infringing copy of the work shall be guilty of an offence and shall be liable on conviction to a fine not exceeding S\$10,000 for the article or for each article in respect of which the offence was committed or S\$100,000, whichever is the lower, or to imprisonment for a term not exceeding 5 years, or to both.

A person who at a time when copyright subsists in a work has in his possession or imports into Singapore any article which he knows, or ought reasonably to know, to be an infringing copy of the work for the purpose of:

- selling, letting for hire, or by way of trade offering or exposing for sale or hire, the article;
- distributing the article for the purpose of trade, or for any other purpose to an extent that will affect prejudicially the owner of the copyright in the work; or
- by way of trade exhibiting the article in public,

shall be guilty of an offence and shall be liable on conviction to a fine not exceeding S\$10,000 for the article or for each article in respect of which the offence was committed or S\$100,000, whichever is the lower, or to imprisonment for a term not exceeding 5 years, or to both.

Any person who, at a time when copyright subsists in a work, distributes, either:

- for purposes of trade; or
- for other purposes, but to such an extent as to affect prejudicially the owner of the copyright,

articles which he knows, or ought reasonably to know, to be infringing copies of the work, shall be guilty of an offence and shall be liable on conviction to a fine not exceeding S\$50,000 or to imprisonment for a term not exceeding 3 years, or to both.

A person who, at a time when copyright subsists in a work, makes or has in his possession an article specifically designed or adapted for making copies of the work that the person knows, or ought reasonably to know, is to be used for making infringing copies of the work, shall be guilty of an offence and shall be liable on conviction to a fine not exceeding S\$20,000 for each such article in respect of which the offence is committed or to imprisonment for a term not exceeding 2 years, or to both.

Any person who for his private profit causes a literary, dramatic or musical work to be performed in public, or causes a cinematograph film to be seen or heard or seen and heard in public, other than by the reception of a television broadcast or cable programme, where he knows, or ought reasonably to know, that copyright subsists in the work or cinematograph film and that the performance constitutes an infringement of the copyright, shall be guilty of an offence and shall be liable on conviction to a fine not exceeding S\$20,000 or to imprisonment for a term not exceeding 2 years, or to both.

Any person who, by any means, publishes, or causes to be published, in Singapore an advertisement for the supply in Singapore (whether from within or outside Singapore) of a copy of a computer program which is an infringing copy shall, unless he proves that he acted in good faith and had no reasonable grounds for supposing that copyright would or might thereby be infringed, be guilty of an offence and shall be liable on conviction to a fine not exceeding S\$20,000, or to imprisonment for a term not exceeding 2 years, or to both.

Under the Trade Marks Act:

Any person who counterfeits a registered trade mark shall be guilty of an offence and shall be liable on conviction to a fine not exceeding S\$100,000 or to imprisonment for a term not exceeding 5 years, or to both.

A person who

- makes a sign identical to or so nearly resembling a registered trade mark as to be calculated to deceive; or
- falsifies a genuine registered trade mark, whether by alteration, addition, effacement, partial removal or otherwise,

without the consent of the proprietor of the registered trade mark shall be deemed to counterfeit a registered trade mark.

In a prosecution under this section, the burden of proving the consent of the proprietor lies on the accused.

Any person who falsely applies a registered trade mark to goods or services shall, unless he proves that he acted innocently, be guilty of an offence and shall be liable on conviction to a fine not exceeding S\$100,000 or to imprisonment for a term not exceeding 5 years or to both.

Any person who

- makes an article specifically designed or adapted for making copies of a registered trade mark or a sign likely to be mistaken for that trade mark; or
- has such an article in his possession, custody or control,

knowing or having reason to believe that it has been, or is to be, used for, or in the course of, committing an offence against section 46 or 47, shall be guilty of an offence and shall be liable on conviction to a fine not exceeding S\$100,000 or to imprisonment for a term not exceeding 5 years, or to both.

Any person who

- imports into Singapore for the purpose of trade or manufacture;
- sells or exposes for sale; or
- has in his possession for the purpose of trade or manufacture,

any goods to which a registered trade mark is falsely applied shall, unless he proves that

- having taken all reasonable precautions against committing an offence under this section, he had, at the time of the commission of the alleged offence, no reason to suspect the genuineness of the mark and on demand made by or on behalf of the prosecution, he gave all the information in his power with respect to the persons from whom he obtained the goods; or
- he had acted innocently,

be guilty of an offence and shall be liable on conviction to a fine not exceeding S\$10,000 for each goods or thing to which the trade mark is falsely applied (but not exceeding in the aggregate S\$100,000) or to imprisonment for a term not exceeding 5 years, or to both.

Any person who

- makes, or causes to be made, a false entry in the register;
- makes, or causes to be made, any thing false purporting to be a copy of an entry in the register; or
- produces or tenders or causes to be produced or tendered in evidence any thing referred to in the above paragraph,

knowing or having reason to believe that the entry or thing, as the case may be, is false shall be guilty of an offence and shall be liable on conviction to a fine not exceeding S\$50,000 or to imprisonment for a term not exceeding 5 years, or to both.

Any person who

- falsely represents that a mark is a registered trade mark; or
- makes a false representation as to the goods or services for which a trade mark is registered,

knowing or having reason to believe that the representation is false shall be guilty of an offence and shall be liable on conviction to a fine not exceeding S\$10,000.

**22. Which public authorities are responsible for initiating criminal proceedings? Are they required to do this on their own initiative and/or in response to complaints?**

In criminal prosecution, the Police are responsible for investigating suspected offences under the Copyright Act and the Trade Marks Act. They may do so on their own initiative or in response to complaints. In addition, intellectual property right owners can also initiate criminal proceedings by way of *fiats* issued by the Attorney-General's Chambers. Prosecution on behalf of the State is by the Attorney-General's Chambers.

**23. Do private persons have standing to initiate criminal proceedings and, if so, who?**

Please refer to question 22.

**24. Specify, by category of IPR and type of infringement where necessary, the penalties and other remedies that may be imposed:**

- **imprisonment**
- **monetary fines**
- **seizure, forfeiture and destruction of infringing goods and materials and implements for their production**
- **other**

The remedies of imprisonment, monetary fines, seizure, forfeiture and destruction of infringing goods and materials and implements for their production are available under both the Copyright Act and the Trade Mark Act. On the question of penalties and fines, please see answer to question 21.

**25. Describe provisions governing the length and any cost of proceedings. Provide any available data on the actual duration of proceedings and their cost, if any.**

Please refer to question 8. This is in accordance with criminal procedure.

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