



2008

INDUSTRIAL DESIGNS – WRITE UP

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ABOUT NANYANG LAW LLC

We are a dynamic, innovative and vibrant boutique Singapore law firm. We are fully committed to providing the highest quality legal services to our clients and ensuring our clients have easy access to our professional staff.

We specialize in a variety of work such as corporate, intellectual property, chancery, litigation and corporate secretarial services.

As a result, our clients range from public listed companies to venture capital firms to individuals with specific needs.

We will be happy to meet you to discuss your needs and see how best your interests can be protected. We take this opportunity to reiterate our vision statement which is to provide quality and timely legal services, which adhere to the highest standards of integrity and excellence, delivered in a professional, responsible and client-oriented manner.

We look forward to being of assistance to you.

FOREWORD

Dear friends, partners and clients,

We might not all be aware that the products we use and enjoy daily also have attached to them certain rights related to their functions and designs. This issue gives a brief introduction into Industrial Designs and their regulation in Singapore.

We hope you enjoy reading this edition and as usual, we will be happy to answer any specific queries you may have.

Happy reading!

Ng Kim Tean
Chairman

1. INDUSTRIAL DESIGNS

Industrial designs essentially protect the design of a product e.g. its shape and configuration. As attractive and clever designs can be big selling points for a product, much attention is paid to product design by manufacturers and companies. Some product designs even achieve the status of works of art. Philippe Starck's creations for example, have earned places in museums (e.g. his *Juicy Salif* citrus fruit squeezer is exhibited in the Museum of Modern Art in New York). Thus, industrial designs of products are demonstrations of intellectual activity both in industry and art.



Juicy Salif

2. STATUTORY PROTECTION OF INDUSTRIAL DESIGNS

As of 13 November 2000 – Singapore Registered Designs Act 2000

As of 13 November 2000, the date on which the Singapore Registered Designs Act 2000 (“**Singapore RDA**”) came into force, the scope of protection for designs in Singapore is circumscribed by the provisions in the Singapore RDA. As its title suggests, registration of the design is necessary. The proprietor of the design registered for a particular product may stop others from, inter alia, making the same type of products bearing the same or substantially the same design. This monopoly is limited to a maximum period of 15 years from the date of registration of the design.¹

Copyright Act

Because industrial designs may also be artistic works, there are some implications for the protection of industrial designs under the Copyright Act.



3. PROTECTION OF REGISTERED DESIGNS UNDER THE SINGAPORE RDA – REQUIREMENTS

3.4.1 “New”

Whether a design is “new” essentially depends on whether it has been made available to the public in Singapore or elsewhere before the application for registration of the design: see s 5(2) of the Singapore RDA.

3.4.2 “Functionality” Exception

A design is excluded by the “functionality” exception if its features are “dictated solely by the function which the article embodying the design has to perform”. The relevant question to ask, when determining whether a design was caught by the “functionality” exception was whether the features in the design were “attributable to or caused by” the function which the article had to perform (Lord Pearson in *Amp Incorporated v. Utilux Proprietary Limited* [1972] RPC 103 at 122).

3.4.3 “Must Fit” Exception

The “must fit” exception is found in the definition of “design” in s 2(1)(b)(iii) of the Singapore RDA. In *Ocular Sciences Ltd v. Aspect Vision Care Ltd* [1997] RPC 289 (“Ocular Sciences”), which involved the design of soft contact lenses, Laddie J (as he then was) said at 424:

“... a feature which meets the interface criteria must be excluded even if it performs some other purpose, for example it is attractive. There is also nothing in the provision which requires the feature to be the only one which would achieve the proper interface. If a number of designs are possible each of which enables the two articles to be fitted together in a way which allowed one or other or both to perform its function, each falls within the statutory exclusion.”

Some examples of design features which have been held to fall within this exception include features of soft contact lenses which allow the lenses to fit in the right location on the front of the eyeball in order to provide a particular correction to the light focusing ability of the eye, e.g. rear radius, diameter of lens (*Ocular Sciences*); aspects of the design of leather cases tailored for specific models of mobile telephones, e.g. hole to permit charger to be connected to the telephone while in the case (*Philip Parker v. Stephen Tidball* [1997] FSR 680).

3.4.4 Requirement of Novelty

In *CKE Marketing Sdn Bhd v. Virtual Century Sdn Bhd & Anor* [2006] 1 MLJ 767, the Court said:

“As regards the requirement of novelty for an industrial design, the English Court of Appeal in the case of *Amp Incorporated v. Utilux Ptv. Limited* 119701 R.P.C. 397 inter alia had this to say:

*“Novelty or originality must be **substantial**, that is, must be present as a matter of substance, having regard to the nature of the article ... There must still be substantial novelty or originality **having regard to the nature of the article** before it is registrable, and differences from the prior art in details which are immaterial is not enough.”*

Based on the above, a relevant consideration would therefore be whether the article is a generic product that is commonly used by members of the public. In such circumstances it is likely that the design features applied to an article are already individually in existence or in use prior to the formation of the said article. The design features must therefore be taken as a whole and the overall appearance of the common article would be a paramount consideration for the Court's determination of novelty.

In relation to generic or common product, the **standard of novelty or originality must be construed in accordance to its circumstances**. In the case of *D Sebel & Co. Ltd, v. National Art Metal Co. Pty. Ltd.* [1965] 10 FLR 224., he court held inter alia at page 227 as follows:

*“It is also true no doubt that a mere conjunction of old features does not necessarily result in a new design. However, it may do so and it seems to me that **when one is dealing with furniture design, with the obvious limitations that exist in the addition of new features, one should not be astute to deny novelty upon the ground that there is not some wholly new feature of design incorporated**. Design in such a field is a subtle thing and, provided it is distinctive to the trained eye, I think that registration should not be denied in view of the element of subtlety which is involved in the combination of old features in a particular way and the manner in which they are combined.”*

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4. PROTECTION UNDER THE COPYRIGHT ACT

4.1 Registration

Protection under the Copyright Act is not dependent on registration. It is not possible to register a copyright in Singapore either as there is no Registry of Copyright in Singapore. Neither is protection under the Copyright Act dependent on compliance with any formality. For example, drawings of a chair design can enjoy copyright protection even if it does not bear the so-called 'copyright notice' (wherein is displayed the copyright symbol '©', the year of first publication of the work and the name of its copyright owner). Copyright protection for this design-drawing arises the moment the copyright work is made, provided that other criteria are satisfied (e.g. the 'originality' requirement for literary, dramatic, musical and artistic works).

4.2 Duration of Copyright Protection

In the case of literary, dramatic, musical and artistic works, the period of protection lasts for 70 years after the death of the work's author. This is often referred to as the 'life + 70 years' formula. The copyright owner is granted a bundle of exclusive rights over the use of the copyright work, including the right to make a copy of the work.

4.3.1 The Copyright Act defines 'artistic work' to mean:

(a) a painting, sculpture, drawing, engraving or photograph, whether the work is of artistic quality or not;

(b) a building or model of a building, whether the building or model is of artistic quality or not; or

(c) a work of artistic craftsmanship to which neither paragraph (a) nor (b) applies,

but does not include a layout-design or an integrated circuit within the meaning of section 2 (1) of the Layout-Designs of Integrated Circuits Act (Cap. 159A);

In determining whether a work falls within paragraphs (a) and (b) of this statutory definition, it has been expressly provided that artistic quality of the work is an irrelevant consideration. A technical piece, such as the artwork design for a fax modem's printed circuit board showing what electrical components were used and how they were connected to one another, would still qualify as an 'artistic work'. Other examples of technical drawings which fall into this category are outline drawings of a car exhaust pipe,¹ specification drawings of ships¹ and a flowchart.¹

4.4 Consequences of Infringement of Copyright

Infringement of copyright may invoke both civil liability and criminal liability. For example, commercial exploitation of infringing articles (e.g. sale of any article with knowledge that it is an infringing copy of the copyright work) constitutes a criminal offence under the Copyright Act. Since 1 January 2005, the list of criminal offences has been expanded to include infringement that is 'wilful' and 'significant', even if such infringement is not for financial gain.

5. INTERNATIONAL REGISTRATION OF INDUSTRIAL DESIGNS¹

If you register your design under the Geneva Act of the Hague Agreement for the International Registration of Industrial Designs, you could secure similar design rights in 48 countries simultaneously.

But there are non-signatories such as the United States, China and Malaysia, which could be very important markets. You would have to file separately in each of these countries.

Nevertheless, thanks to the Agreement on Trade-Related Aspects of Intellectual Property that all World Trade Organisation members must abide by, design rights, however conceived, must be protected for at least 10 years.

Reference:
"Law of Intellectual Property of Singapore" by Ng-Loy Wee Loon, Sweet & Maxwell Asia (2008) 5-8.

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