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- (b) the date of application for the registration of the geographical indication;
  - (c) details of any matter from which it may be inferred that the trade mark is well known; and
  - (d) details of how the application of section 4 to the use of the trade mark is liable to mislead consumers as to the true identity of the goods identified by the geographical indication.

### **Counterclaim where geographical indication is registered**

**16.** If the geographical indication in an action under section 4 is a registered geographical indication, the defendant may make a counterclaim for one or both of the following:

- (a) the cancellation of the registration of the geographical indication;
- (b) the rectification of an error or omission in the register affecting the registration of the geographical indication.

*Division 4 applications for declarations relating to homogeneous geographical indications (section 10(2))*

### **Mode of commencement**

**17.** An application under section 10(2) must be commenced by originating application.

### **Consultation on possibility of agreement**

**18.—(1)** Where an application is made under section 10(2) —

- (a) the applicant must consult with each defendant on the possibility of agreement to the practical conditions to be declared under section 10(2);
- (b) if the parties reach an agreement, the applicant must file in Court a copy of their agreement, including the details of the agreed practical conditions; and
- (c) if the parties fail to reach an agreement, each party must file with the Court a submission —

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- (i) containing the party's proposal for the practical conditions to be declared; and
  - (ii) identifying the areas for which an agreement could not be reached.
- (2) For the purposes of paragraph (1), the Court must send a written notice to all the parties to the proceedings and the notice must —
- (a) direct the applicant to consult with each defendant as required by paragraph (1)(a); and
  - (b) specify —
    - (i) the period for consultation under paragraph (1)(a);
    - (ii) the period within which the applicant must take the step in paragraph (1)(b) (if applicable); and
    - (iii) the period within which each party must take the step in paragraph (1)(c) (if applicable).
- (3) An application under section 10(2) is deemed to have been discontinued if —
- (a) where paragraph (1)(b) applies — the applicant did not carry out the step in paragraph (1)(b) at the end of the period specified in paragraph (2)(b)(ii); or
  - (b) where paragraph (1)(c) applies — the applicant did not carry out the step in paragraph (1)(c) as it applies to the applicant at the end of the period specified in paragraph (2)(b)(iii).

### **Court may declare practical conditions regardless of agreement**

**19.** After hearing an application under section 10(2), the Court may declare the practical conditions on which the relevant homonymous geographical indications are to be differentiated from one another, whether or not the practical conditions are those in respect of which an agreement between the parties was filed under rule 18.

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*Division 4 — Applications for limitation of scope to be entered in register (section 48A)*

**Mode of commencement, etc.**

**20.**—(1) An application under section 48A(1) must be commenced by originating application.

(2) If the applicant is not the registrant of the relevant registered geographical indication, the registrant must be named as a defendant.

**Particulars to be included in application**

**21.** An application under section 48A(1) must include the following particulars:

- (a) a statement setting out the proposed limitation of the scope of the rights conferred under the Act in respect of a registered geographical indication that is to be entered in the register —
  - (i) in relation to any name contained in the registered geographical indication that is the subject of the application; or
  - (ii) in relation to any term which may be a possible translation of the registered geographical indication that is the subject of the application;
- (b) where the application is made on the ground that an exception under section 11(b) applies to that name or term — the date of the cessation (if applicable) of the protection of the registered geographical indication in its country or territory of origin;
- (c) where the application is made on the ground that an exception under section 12(1) applies to that name or term —
  - (i) the goods or services or related goods or services in relation to which the registered geographical indication (being a geographical indication identifying a wine or a spirit) was continuously used in Singapore by the applicant or by the applicant and the applicant's predecessor in title (as the case may be) and details of such use;

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- (ii) the name of every such predecessor in title (if any) that has continuously used in Singapore the registered geographical indication; and
  - (iii) the date on which the registered geographical indication was first used in Singapore in relation to the goods or services or related goods or services;
- (d) where the application is made on the ground that an exception under section 12(2)(a) applies to that name or term —
- (i) the name of the proprietor of the trade mark;
  - (ii) the date on which the trade mark was first used by the applicant;
  - (iii) the details of the registration of the trade mark or the application for the registration of the trade mark, as the case may be;
  - (iv) a representation of the trade mark; and
  - (v) the date on which the registered geographical indication was first protected in its country or territory of origin;
- (e) where the application is made on the ground that an exception under section 12(2)(b) applies to that name or term —
- (i) the name of the proprietor of the trade mark;
  - (ii) the date on which the trade mark was first used in Singapore in the manner mentioned in that provision by the applicant or by the applicant and the applicant's predecessor in title, as the case may be;
  - (iii) the name of every predecessor in title (if any) of the applicant who has used the trade mark in Singapore in the manner mentioned in that provision;
  - (iv) a representation of the trade mark, and details of its use in Singapore in the manner mentioned in that provision by the applicant or by the applicant and every such predecessor in title, as the case may be; and

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- (v) the date on which the registered geographical indication was first protected in its country or territory of origin;
  - (f) where the application is made on the ground that an exception under section 16(1) applies to that name or term —
    - (i) the goods or services or related goods or services in relation to which the registered geographical indication (being a geographical indication identifying any goods other than a wine or a spirit) was continuously used in Singapore by the applicant or the applicant and the applicant's predecessor in title (as the case may be) and details of such use;
    - (ii) the name of every such predecessor in title (if any) that has continuously used in Singapore the goods or services or related goods or services; and
    - (iii) the date on which the registered geographical indication was first used in Singapore in relation to the goods or services or related goods or services;
  - (g) where the application is made on the ground that an exception under section 16(2)(a) applies to that name or term —
    - (i) whether the trade mark is a registered trade mark or an international trade mark (Singapore);
    - (ii) the name of the proprietor of the trade mark;
    - (iii) the date on which the trade mark was first used by the applicant;
    - (iv) the details of the registration of the trade mark or the application for the registration of the trade mark (as the case may be) and the priority date, if any;
    - (v) a representation of the trade mark; and
    - (vi) the date of application for the registration of the registered geographical indication;
  - (h) where the application is made on the ground that an exception under section 16(2)(b) applies to that name or term —

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- (i) the name of the proprietor of the trade mark;
  - (ii) the date on which the trade mark was first used in Singapore in the manner mentioned in that provision by the applicant or by the applicant and the applicant's predecessor in title, as the case may be;
  - (iii) the name of every predecessor in title (if any) that has used in Singapore the trade mark in the manner mentioned in that provision;
  - (iv) a representation of the trade mark, and details of its use in Singapore in the manner mentioned in that provision by the applicant or by the applicant and every such predecessor in title, as the case may be; and
  - (v) the date of application for the registration of the registered geographical indication;
- (i) where the application is made on the ground that an exception under section 16(3) applies to that name or term —
- (i) the name of the proprietor of the well known trade mark;
  - (ii) the date of application for the registration of the registered geographical indication;
  - (iii) details of any matter from which it may be inferred that the trade mark is well known; and
  - (iv) details of how the application of section 4 to the use of the trade mark is liable to mislead consumers as to the true identity of the goods identified by the registered geographical indication.

#### **Publication of particulars in journal**

**22.—(1)** The Registrar must publish the following particulars of an application under section 48A(1) in the Geographical Indications Journal published under rule 96 of the GI Rules:

- (a) the registered geographical indication concerned, and the registration number of that registered geographical indication;

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- (b) the date on which the application was made;
  - (c) the statement setting out the proposed limitation of the scope of the rights conferred under the Act in respect of the registered geographical indication concerned that is to be entered in the register;
  - (d) the name of the applicant;
  - (e) the address of the applicant for the purpose of service of any document under these Rules.

(2) The particulars must be published within 7 days after the service of the originating application on the Registrar.

#### **Joinder of affected parties**

**23.**—(1) A person who claims that the person's interests will be affected by an order sought in an application under section 48A(1) may apply to the Court to be joined as a party to the application.

(2) An application under paragraph (1) must be made within 2 months after the date on which the particulars of the application are published under rule 22.

#### *Division 5 — References by Registrar to Court*

#### **Application to be made after reference**

**24.**—(1) Where the Registrar refers to the Court an application made to the Registrar under the Act —

- (a) the applicant must make the same application to the Court within the period mentioned in paragraph (2); and
- (b) if the applicant fails to do so, the applicant is treated as having abandoned the application.

(2) For the purposes of paragraph (1) —

- (a) the period is one month after the application is notified of the Registrar's decision to refer; but
- (b) the period may be extended by the Registrar on the application of any interested party (which application may be made before or after the expiration of that month).

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(3) Paragraph (2) does not affect the power of the Court to extend time under Order 3, Rule 4 of the Rules of Court.

*Division 6 — Appeals from Registrar to Court*

**Application of this Division**

**25.** This Division applies for the purposes of an appeal to the Court from a decision of the Registrar in any case in which the Act gives a right of appeal.

**Provisions relating to appellant**

**26.—**(1) An appeal must be brought by originating application (called in this Division a notice of appeal).

(2) A notice of appeal —

- (a) must be filed with the Court within 28 days after the decision of the Registrar;
- (b) may be given in respect of the whole or any specific part of the decision of the Registrar; and
- (c) must specify the grounds of the appeal and the relief which the appellant seeks.

(3) An appellant must, within 7 days after filing the notice of appeal, serve a copy of the notice of appeal on —

- (a) the Registrar; and
- (b) every other party to the proceedings before the Registrar.

(4) An appellant must, within 14 days after filing the notice of appeal, file a bundle consisting of a copy each of the following documents (as applicable):

- (a) a representation of the relevant geographical indication;
- (b) the details of the registration of that geographical indication or the application for the registration of that geographical indication, as the case may be;
- (c) the application to the Registrar that is the subject of the decision of the Registrar being appealed against;

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- (d) the agreement or each submission on the practical conditions to be imposed;
  - (e) the request for qualification of rights;
  - (f) the notice of opposition;
  - (g) the notice of objection;
  - (h) the counter-statement;
  - (i) every statutory declaration (including its exhibits) filed with the Registrar;
  - (j) the written submissions;
  - (k) the grounds of decision of the Registrar.

(5) Except with the permission of the Court, the appellant is not entitled on the hearing of the appeal to rely on any ground of appeal or to apply for any relief not specified in the notice of appeal.

(6) Except with the permission of the Court, no appeal may be entertained unless the notice of appeal is filed within the period specified in paragraph (2)(a).

### **Provisions relating to respondent**

**27.—**(1) The respondent must give notice if the respondent intends to contend on the appeal that the Registrar's decision should be —

- (a) varied (whether in any event or in the event of the appeal being allowed in whole or in part); or
- (b) affirmed on grounds other than those set out in the grounds of decision.

(2) The respondent's notice must specify —

- (a) the grounds of the contention; and
- (b) in the case of paragraph (1)(b), the relief that the respondent seeks from the Court.

(3) The respondent's notice must be filed and served on the following persons within 14 days after the respondent receives the notice of appeal or any further time as the Court may direct:

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- (a) the Registrar;
  - (b) the appellant;
  - (c) every other party to the proceedings before the Registrar.

### **Other provisions**

**28.**—(1) The Registrar must transmit to the Court any document requested by the Court relating to the matter that is the subject of the appeal.

(2) The Court must give notice of the date appointed for the hearing of the appeal to —

- (a) the Registrar;
- (b) the appellant; and
- (c) every other party to the proceedings before the Registrar.

(3) At least 7 days' notice must be given under paragraph (2), but the Court may direct that a shorter period of notice be given.

(4) An appeal is to be by way of rehearing.

(5) The evidence used on appeal must be the same as that used before the Registrar and, except with the permission of the Court, no further evidence may be given.

### *Division 7 — Miscellaneous*

### **Registrant may be served at address in register**

**29.**—(1) Subject to this rule, for the purposes of any proceedings under the Act —

- (a) a document (including an originating process) may be served on the registrant of a geographical indication by serving the document in the manner prescribed by Order 7 of the Rules of Court at the address for service given in the register; but
- (b) if any provision of the Rules of Court requires a response to a document served under sub-paragraph (a) within a specified time limit (whether by filing and serving a notice

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of intention to contest or not contest or otherwise), that time limit is extended by 7 days.

(2) Paragraph (1)(a) ceases to apply when the registrant has provided an address for service within the meaning of Order 4, Rule 8 of the Rules of Court.

(3) This rule does not prevent the registrant from being served in accordance with the Rules of Court.

**Registrar to be notified of proceedings, etc., and may take part**

**30.—**(1) In any proceedings under the Act —

- (a) the party that commenced the proceedings must —
  - (i) serve the originating process on the Registrar within 7 days after the originating process is issued;
  - (ii) if the proceedings are entirely discontinued or withdrawn, notify the Registrar within 7 days after the discontinuance takes effect; and
  - (iii) notify the Registrar of the judgment of the Court within 7 days after the judgment is given;
- (b) a defendant that entirely discontinues or withdraws its defence or counterclaim must notify the Registrar within 7 days after the discontinuance or withdrawal takes effect; and
- (c) a party that files a notice of appeal against the judgment of the Court must —
  - (i) notify the Registrar within 7 days after the notice of appeal is filed;
  - (ii) if the appeal is withdrawn, notify the Registrar within 7 days after the withdrawal takes effect; and
  - (iii) notify the Registrar of the judgment of the appellate court within 7 days after the judgment is given.

(2) Notice under paragraph (1) must be given in writing.

(3) The Registrar —

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- (a) may take part in any proceedings under the Act to the extent permitted by the Court; but
  - (b) need not serve a defence or other pleading unless ordered to do so by the Court.

## PART 4

### PATENTS ACT 1994

#### *Division 1 — Preliminary*

#### **Definitions of this Part**

**31.**—(1) In this Part, “Act” means the Patents Act 1994, and a reference to a section is a reference to a section of the Act.

(2) In this Part, the following words have the meanings given by section 2(1):

- (a) “journal”;
- (b) “patent”;
- (c) “register”;
- (d) “Registrar”;
- (e) “Registry”.

#### **Application of Rules of Court**

**32.** Subject to these Rules, the Rules of Court apply to any proceedings under the Act.

*Division 2 — Actions for infringement (section 67) or  
declaration of non-infringement of patent (section 78)*

#### **Action for infringement**

**33.**—(1) An action for an infringement of a patent must be commenced by originating claim.

(2) The claimant must serve, with the claimant’s statement of claim, particulars of the infringement relied on, and those particulars must —

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- (a) show which of the claims in the specification of the patent are alleged to be infringed; and
  - (b) give at least one instance of each type of infringement alleged.

(3) Except with the permission of the Court, no evidence may be given of any alleged infringement of a patent if the infringement was not raised in the particulars of infringement.

(4) If the defendant alleges, as a defence to the action, that at the time of the infringement there was in force a contract or licence relating to the patent —

- (a) made by or with the consent of the claimant; and
- (b) containing a condition or term void by virtue of section 51,

the defendant must serve on the claimant —

- (c) particulars of the date of, and parties to, the contract or licence; and
- (d) particulars of the condition or term.

### **Production of documents**

**34.—**(1) The application of Order 11 of the Rules of Court to an action for an infringement of a patent, or for a declaration of non-infringement of a patent, is subject to the modifications in this rule.

(2) A document relating to the infringement of a patent by a product or process (called in this rule an exempt document) must not be listed if, before serving a list of documents, the party against whom the allegation of infringement is made has served on the other parties full particulars of the allegedly infringing product or process, including if necessary drawings or other illustrations.

(3) Despite paragraph (2), any party may apply under Order 11 of the Rules of Court for further and better production or specific production of any exempt document.

(4) If, despite paragraphs (1) and (2), a party (X) produces an exempt document for inspection —

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- (a) any other party (*Y*) may request *X* in writing to provide a supplementary list of all other exempt documents; and
  - (b) unless the Court orders otherwise, *X* must serve the supplementary list on *Y* within 14 days after the request.
- (5) This rule does not affect the Court's power to limit production on any other ground.
- (6) To avoid doubt, if the validity of a patent is put in issue in an action for an infringement of a patent, or for a declaration of non-infringement of a patent, rule 37 applies in addition to this rule.

*Division 3 — Proceedings where validity of patent put in issue*  
(section 82)

**Particulars of objections to validity of patent in originating claim**

**35.**—(1) If the claimant in an originating claim intends to put in issue the validity of a patent, the claimant must serve with its statement of claim the particulars of its objections to the validity of the patent.

(2) If the defendant in an originating claim intends to put in issue the validity of a patent by way of defence or counterclaim, the defendant must —

- (a) within 14 days after being served the statement of claim, give prior notice of that intention; and
- (b) within 42 days after being served the statement of claim, serve —
  - (i) the defence or counterclaim, as the case may be; and
  - (ii) particulars of its objections to the validity of the patent.

(3) The particulars of objections must —

- (a) state every ground on which the validity of the patent is put in issue; and

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- (b) include particulars that clearly define every issue that is intended to be raised.
- (4) If the grounds stated in the particulars of objections include want of novelty or want of any inventive step, the particulars must —
- (a) state the manner, time and place of every prior publication or user relied upon; and
- (b) if prior user is alleged —
- (i) specify the name of every person alleged to be a prior user;
- (ii) state whether the prior use is alleged to have continued until the priority date of the claim in question or of the invention, as may be appropriate, and, if not, the earliest and latest date on which the prior use is alleged to have taken place;
- (iii) contain a description accompanied by drawings, if necessary, sufficient to identify the prior use; and
- (iv) if the prior use relates to machinery or apparatus, state whether the machinery or apparatus is in existence and where it can be inspected.
- (5) If in the case of an existing patent —
- (a) one of the grounds stated in the particulars of objections is that the invention, so far as claimed in any claim of the complete specification, is not useful; and
- (b) it is intended, in connection with that ground, to rely on the fact that an example of the invention that is the subject of any such claim cannot be made to work, either at all or as described in the specification,
- the particulars must —
- (c) state that fact and identify each such claim; and
- (d) include particulars of each such example, specifying the respects in which it is alleged that it does not work or does not work as described.

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(6) If the validity of a patent is put in issue on the ground of obviousness, a party that wishes to rely on the commercial success of the patent must state in that party's pleadings the grounds upon which that party so relies.

(7) Except with the permission of the Court, no evidence may be given of any objection to the validity of a patent raised in an originating claim, if —

- (a) the objection was not raised in the particulars of objections; or
- (b) the evidence is not in accordance with a statement in the particulars of objections.

(8) If any machinery or apparatus alleged to have been used before the priority date mentioned in paragraph (4)(b)(ii) exists at the date of service of the particulars of objections, no evidence of its user before that date may be given.

(9) Paragraph (8) does not apply if it is proved that the party relying on the user —

- (a) being in possession of the machinery or apparatus, offered inspection of the machinery or apparatus to the other parties to the proceedings; or
- (b) not being in possession of the machinery or apparatus, used all reasonable endeavours to obtain inspection of the machinery or apparatus for those parties.

### **Particulars of objections to validity of patent in originating application**

**36.—**(1) On the hearing of an originating application in which there are or may be objections to the validity of a patent, the Court must give directions relating to —

- (a) the service of the relevant particulars of any objections to the validity of the patent; and
- (b) the manner in which the evidence must be given.

(2) In paragraph (1), “relevant particulars” —

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- (a) means the particulars mentioned in rule 35(3), (4) and (5) (as applicable); and
  - (b) includes, where the validity of a patent is put in issue on the ground of obviousness and a party wishes to rely on the commercial success of the patent, the grounds upon which that party so relies.

### **Production of documents**

**37.—**(1) In any proceedings where the validity of a patent is put in issue, the application of Order 11 of the Rules of Court is subject to the modifications in this rule.

(2) A document falling within any of the following classes (called in this rule exempt documents) must not be listed:

- (a) a document relating to any ground on which the validity of a patent is put in issue, but not a document that came into existence within the period beginning 2 years before the earliest claimed priority date and ending 2 years after that date;
- (b) a document relating to the issue of commercial success.

(3) If the issue of commercial success arises, the proprietor of the patent must serve a schedule containing the following details:

- (a) where the commercial success relates to an article or product —
  - (i) an identification of the article or product (for example by product code number) that the proprietor asserts has been made in accordance with the claims of the patent;
  - (ii) a summary by convenient periods of sales of any such article or product;
  - (iii) a summary for the equivalent periods of sales (if any) of any equivalent prior article or product marketed before the article or product mentioned in subparagraph (i); and

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- (iv) a summary by convenient periods of any expenditure on advertising and promotion which supported the marketing of the articles or products mentioned in sub-paragraphs (i) and (iii);
- (b) where the commercial success relates to the use of a process —
- (i) an identification of the process which the proprietor asserts has been used in accordance with the claims of the patent;
  - (ii) a summary by convenient periods of the revenues received from the use of such process;
  - (iii) a summary for the equivalent periods of the revenues (if any) received from the use of any equivalent prior art process; and
  - (iv) a summary by convenient periods of any expenditure which supported the use of the process mentioned in sub-paragraphs (i) and (iii).
- (4) Despite paragraph (2), any party may apply under Order 11 of the Rules of Court for further and better production or specific production of any exempt document.
- (5) To avoid doubt, paragraph (2) does not create any privilege in an exempt document.
- (6) If, despite paragraphs (1) and (2), a party (*X*) produces an exempt document for inspection —
- (a) any other party (*Y*) may request *X* in writing to provide a supplementary list of all other documents within the same class as the exempt document; and
  - (b) unless the Court orders otherwise, *X* must serve the supplementary list on *Y* within 14 days after the request.
- (7) This rule does not affect the Court's power to limit production on any other ground.

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**Registrar to be notified**

**38.** If a party to any proceedings under the Act puts in issue the validity of a patent, the party must notify the Registrar within 7 days after filing the pleadings or the affidavit that put the validity of the patent in issue.

*Division 4 — Appeals from Registrar to Court***Application**

**39.** This Division applies for the purposes of an appeal to the Court from a decision of the Registrar in any case in which the Act gives a right of appeal.

**Provisions relating to appellant**

**40.—(1)** An appeal must be brought by originating application (called in this Part a notice of appeal).

(2) A notice of appeal —

(a) must be filed with the Court —

(i) if the Registrar's decision is on a matter of procedure, within 28 days after the Registrar's decision; and

(ii) in any other case, within 6 weeks after the Registrar's decision;

(b) may be given in respect of the whole or any specific part of the decision of the Registrar; and

(c) must specify the grounds of the appeal and the relief which the appellant seeks.

(3) For the purposes of paragraph (2)(a) —

(a) the Registrar may decide whether a decision is on a matter of procedure; and

(b) a decision under sub-paragraph (a) is a decision on a matter of procedure.

(4) An appellant must, within 7 days after filing the notice of appeal, serve a copy of the notice of appeal on —

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- (a) the Registrar; and
  - (b) every other party to the proceedings before the Registrar.

(5) An appellant must, within 14 days after filing the notice of appeal, file a bundle consisting of a copy each of the following documents (as applicable):

- (a) the particulars of the patent that is the subject of the appeal;
- (b) the application or reference to the Registrar that is the subject of the decision of the Registrar being appealed against, and the statement of grounds accompanying the application or reference;
- (c) the notice of opposition;
- (d) the counter-statement;
- (e) every statutory declaration (including any exhibits) filed with the Registrar;
- (f) the written submissions;
- (g) the grounds of decision of the Registrar.

(6) Except with the permission of the Court, the appellant is not entitled on the hearing of the appeal to rely on any ground of appeal or to apply for any relief not specified in the notice of appeal.

(7) Except with the permission of the Court, no appeal may be entertained unless the notice of appeal is given within the period specified in paragraph (2)(a).

#### **Provisions relating to respondent**

**41.—**(1) The respondent must give notice if the respondent intends to contend on the appeal that the Registrar's decision should be —

- (a) varied (whether in any event or in the event of the appeal being allowed in whole or in part); or
- (b) affirmed on grounds other than those set out in the grounds of decision.

(2) The respondent's notice must specify —

- (a) the grounds of the contention; and

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(b) in the case of paragraph (1)(b), the relief that the respondent seeks from the Court.

(3) The respondent's notice must be filed and served on the following persons within 14 days after the respondent receives the notice of appeal or any further time as the Court may direct:

- (a) the Registrar;
- (b) the appellant;
- (c) every other party to the proceedings before the Registrar.

### **Other provisions**

**42.—**(1) The Registrar must transmit to the Court any document requested by the Court relating to the matter that is the subject of the appeal.

(2) The Court must give notice of the date appointed for the hearing of the appeal to —

- (a) the Registrar;
- (b) the appellant; and
- (c) every other party to the proceedings before the Registrar.

(3) At least 7 days' notice must be given under paragraph (2), but the Court may direct that a shorter period of notice be given.

(4) An appeal is to be by way of rehearing.

(5) The evidence used on appeal must be the same as that used before the Registrar and, except with the permission of the Court, no further evidence may be given.

### *Division 5 — Other proceedings under Act*

#### **Determination of questions about entitlement to patents, etc., before grant (section 20(7)) or right to patents after grant (section 47(8))**

**43.—**(1) This rule applies where the Registrar declines to deal with a question under section 20(7) or 47(8).

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(2) A person entitled to do so may apply to the Court to determine the question.

(3) An application under paragraph (2) must be made —

- (a) within one month after the Registrar's decision; and
- (b) by original application.

**Applications for rectification of register (section 44(1))**

44. An application to the Court under section 44(1) for an order that the register be rectified must be commenced by originating application, except where it is made by way of counterclaim in proceedings for infringement.

**Applications relating to certain contracts (section 52(3));  
references of disputes as to Government use (section 58)**

45.—(1) The following proceedings must be commenced by originating application:

- (a) an application under section 52(3);
- (b) proceedings for the determination of a dispute referred to the Court under section 58.

(2) There must be at least 14 days between the service of an originating application under this rule and the hearing date.

(3) On the hearing of an originating application under this rule, the Court must give directions for the further conduct of the proceedings as the Court thinks necessary or expedient, including directions relating to —

- (a) the service of particulars;
- (b) the manner in which the evidence must be given; and
- (c) the hearing date.

**Application for permission to amend specification (section 83)**

46.—(1) Where the proprietor of a patent intends to apply under section 83 for permission to amend the proprietor's specification —

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- (a) the proprietor must give notice of the proprietor's intention to the Registrar, together with a copy of an advertisement —
- (i) identifying the proceedings pending before the Court in which it is intended to apply for such permission;
  - (ii) giving particulars of the amendment sought;
  - (iii) stating the applicant's address for service within Singapore;
  - (iv) stating that a Statement of Reasons is available from that address; and
  - (v) stating that any person intending to oppose the amendment must, within 28 days after the advertisement appears in the journal, give to the applicant —
    - (A) written notice of that person's intention; and
    - (B) a Statement of Opposition; and
- (b) the Registrar must insert the advertisement once in the journal.
- (2) A person who gives notice in accordance with the advertisement is entitled to be heard on the application subject to any direction of the Court as to costs.
- (3) The proprietor must, at the same time as giving notice to the Registrar, serve on all parties to the proceedings —
- (a) a copy of the Statement of Reasons; and
  - (b) a copy of the patent as proposed to be amended.
- (4) The Statement of Reasons must contain —
- (a) full particulars of the amendment sought;
  - (b) the reasons for the amendment;
  - (c) the reasons why the applicant contends that in the exercise of the discretion the amendment should be allowed; and
  - (d) in particular —

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- (i) a statement whether the amendment is by way of deletion of claims or re-writing of claims;
  - (ii) insofar as it involves re-writing claims, details as to why the proposed amendment is in accordance with the statutory requirements of an amendment; and
  - (iii) insofar as the amendment is sought to distinguish over prior art, an indication of the prior art.
- (5) The Statement of Opposition must contain full particulars of all grounds of opposition to the application to amend.
- (6) The proprietor must —
- (a) after the advertisement has appeared in the journal for 42 days, make the application under section 83 —
    - (i) as soon as may be; and
    - (ii) by summons in the proceedings; and
  - (b) serve the summons, together with a copy of the specification certified by the Registrar and showing in coloured ink the amendment sought, on —
    - (i) the Registrar;
    - (ii) the parties to the proceedings; and
    - (iii) any person who has given notice of that person's intention to oppose the amendment.
- (7) On the hearing of the summons, the Court must give directions for the further conduct of the summons as the Court thinks necessary or expedient, including directions relating to —
- (a) whether the summons is to be heard with the other proceedings relating to the patent in question or separately and, if separately, fixing the date of hearing thereof;
  - (b) the manner in which the evidence is to be given;
  - (c) if the evidence is to be given by affidavit, the times within which the affidavits must be filed; and

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- (d) whether any production is necessary and, if so, the extent of production and the manner and time within which production is to be given.
- (8) Where the Court allows a specification to be amended —
- (a) the applicant must —
- (i) forthwith file a copy of the Court's order with the Registrar; and
- (ii) if required by the Court or the Registrar, leave at the Registry a new specification and drawings as amended, prepared in compliance with the Act; and
- (b) the Registrar must cause a copy of the Court's order to be inserted at least once in the journal.

*Division 6 — Miscellaneous*

**Proprietor may be served at address in register**

**47.—**(1) Subject to this rule, for the purposes of any proceedings under the Act —

- (a) a document (including an originating process) may be served on the proprietor of a patent by serving the document in the manner prescribed by Order 7 of the Rules of Court at the address for service given in the register; but
- (b) if any provision of the Rules of Court requires a response to a document served under sub-paragraph (a) within a specified time limit (whether by filing and serving a notice of intention to contest or not contest or otherwise), that time limit is extended by 7 days.
- (2) Paragraph (1)(a) ceases to apply when the proprietor has provided an address for service within the meaning of Order 4, Rule 8 of the Rules of Court.
- (3) This rule does not prevent the proprietor from being served in accordance with the Rules of Court.

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**Registrar to be notified of proceedings, etc., and may take part**

**48.—**(1) In any proceedings under the Act —

- (a) the party that commenced the proceedings must —
  - (i) serve the originating process on the Registrar within 7 days after the originating process is issued;
  - (ii) if the proceedings are entirely discontinued or withdrawn, notify the Registrar within 7 days after the discontinuance takes effect; and
  - (iii) notify the Registrar of the judgment of the Court within 7 days after the judgment is given;
- (b) a defendant that entirely discontinues or withdraws its defence or counterclaim must notify the Registrar within 7 days after the discontinuance or withdrawal takes effect; and
- (c) a party that files a notice of appeal against the judgment of the Court must —
  - (i) notify the Registrar within 7 days after the notice of appeal is filed;
  - (ii) if the appeal is withdrawn, notify the Registrar within 7 days after the withdrawal takes effect; and
  - (iii) notify the Registrar of the judgment of the appellate court within 7 days after the judgment is given.

(2) Notice under paragraph (1) must be given in writing.

(3) The Registrar —

- (a) may take part in any proceedings under the Act to the extent permitted by the Court; but
- (b) need not serve a defence or other pleading unless ordered to do so by the Court.

**Admissions of fact**

**49.—**(1) Where a party (*X*) desires another party (*Y*) to admit any facts for the purposes of a proceeding under the Act, *X* must —

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- (a) serve on *Y* a notice specifying those facts and requiring *Y* to admit them; and
  - (b) do so within 21 days after —
    - (i) the service of a defence or a reply; or
    - (ii) the expiration of the period fixed for serving a defence or reply.
- (2) Within 21 days after being served the notice in paragraph (1), *Y* must serve on *X* a notice stating in respect of each fact specified in the notice whether or not *Y* admits it.

### **Establishing facts by experiments**

- 50.**—(1) This rule applies where a party (*X*) desires to establish any fact by experimental proof.
- (2) *X* must, within 21 days after service of the list of documents under Order 11, Rule 2 of the Rules of Court, serve on every other party a notice —
- (a) stating the facts that *X* desires to establish by experimental proof; and
  - (b) giving full particulars of the experiments proposed to establish those facts.
- (3) A party (*Y*) upon whom a notice under paragraph (2) is served must, within 21 days after service of the notice, serve upon *X* a notice stating in respect of each fact whether or not *Y* admits it.
- (4) Where any fact that *X* desires to establish by experimental proof is not admitted, *X* may seek directions at a case conference about the experiments.

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**PART 5****REGISTERED DESIGNS ACT 2000***Division 1 — Preliminary***Definitions of this Part**

**51.**—(1) In this Part, “Act” means the Registered Designs Act 2000, and a reference to a section is a reference to a section of the Act.

(2) In this Part, the following words and expressions have the meanings given by section 2(1):

- (a) “design”;
- (b) “Register”;
- (c) “registered design”;
- (d) “registered owner”;
- (e) “Registrar”.

**Application of Rules of Court**

**52.** Subject to these Rules, the Rules of Court apply to any proceedings under the Act.

*Division 2 — Action for infringement of registered design (sections 36, 37 and 38)***Mode of commencement**

**53.** An action for an infringement of a registered design must be commenced by originating claim.

**Defendant may dispute validity of registration, etc.**

**54.**—(1) The defendant in an action for an infringement of a registered design may do all or any of the following in its pleadings:

- (a) dispute the validity of the registration of the design;
- (b) counterclaim for the registration of the design to be revoked;

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(c) counterclaim for the register to be rectified.

(2) If defendant does anything mentioned in paragraph (1), the defendant must —

- (a) serve, with the defendant's pleadings, particulars of the defendant's objections to the validity of the registration; and
- (b) serve the pleadings and particulars on the Registrar within 7 days after filing them.

*Division 3 — Applications and references under Act*

**Mode of commencement**

**55.** The following proceedings must be commenced by originating application:

- (a) an application to the Court under the Act;
- (b) a reference to the Court under the Act.

**References by Registrar to Court — application to be made after reference**

**56.—**(1) Where the Registrar refers to the Court an application made to the Registrar under the Act —

- (a) the applicant must make the same application to the Court within the period mentioned in paragraph (2); and
- (b) if the applicant fails to do so, the applicant is treated as having abandoned the application.

(2) For the purposes of paragraph (1) —

- (a) the period is one month after the applicant is notified of the Registrar's decision to refer; but
- (b) the period may be extended by the Registrar on the application of any interested party (which application may be made before or after the expiration of that month).

(3) Paragraph (2) does not affect the power of the Court to extend time under Order 3, Rule 4 of the Rules of Court.

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*Division 4 — Appeals from Registrar to Court*

**Application**

**57.** This Division applies for the purposes of an appeal to the Court from a decision of the Registrar in any case where the Act gives a right of appeal.

**Provisions relating to appellant**

**58.—(1)** An appeal must be brought by originating application (called in this Part a notice of appeal).

(2) A notice of appeal —

- (a) must be filed with the Court within 28 days after the decision of the Registrar;
- (b) may be given in respect of the whole or any specific part of the decision of the Registrar; and
- (c) must specify the grounds of the appeal and the relief which the appellant seeks.

(3) An appellant must, within 7 days after filing the notice of appeal, serve a copy of the notice of appeal on —

- (a) the Registrar; and
- (b) every other party to the proceedings before the Registrar.

(4) An appellant must, within 14 days after filing the notice of appeal, file a bundle consisting of a copy each of the following documents (as applicable):

- (a) a representation of the registered design in issue;
- (b) the details of the registration of that design;
- (c) the application for the revocation of the registration of that design and the statement of grounds accompanying the application;
- (d) the counter-statement;
- (e) every statutory declaration (including any exhibits) filed with the Registrar;

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- (f) the written submissions;
  - (g) the grounds of decision of the Registrar.

(5) Except with the permission of the Court, the appellant is not entitled on the hearing of the appeal to rely on any ground of appeal or to apply for any relief not specified in the notice of appeal.

(6) Except with the permission of the Court, no appeal may be entertained unless the notice of appeal is given within the period specified in paragraph (2)(a).

### **Provisions relating to respondent**

**59.**—(1) The respondent must give notice if the respondent intends to contend on the appeal that the Registrar’s decision should be —

- (a) varied (whether in any event or in the event of the appeal being allowed in whole or in part); or
- (b) affirmed on grounds other than those set out in the grounds of decision.

(2) The respondent’s notice must specify —

- (a) the grounds of the contention; and
- (b) in the case of paragraph (1)(b), the relief that the respondent seeks from the Court.

(3) The respondent’s notice must be filed and served on the following persons within 14 days after the respondent receives the notice of appeal or any further time as the Court may direct:

- (a) the Registrar;
- (b) the appellant;
- (c) every other party to the proceedings before the Registrar.

### **Other provisions**

**60.**—(1) The Registrar must transmit to the Court any document requested by the Court relating to the matter that is the subject of the appeal.

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(2) The Court must give notice of the date appointed for the hearing of the appeal to —

- (a) the Registrar;
- (b) the appellant; and
- (c) every other party to the proceedings before the Registrar.

(3) At least 7 days' notice must be given under paragraph (2), but the Court may direct that a shorter period of notice be given.

(4) An appeal is to be by way of rehearing.

(5) The evidence used on appeal must be the same as that used before the Registrar and, except with the permission of the Court, no further evidence may be given.

*Division 5 — Miscellaneous*

**Registered owner may be served at address in register**

**61.**—(1) Subject to this rule, for the purposes of any proceedings under the Act —

- (a) a document (including an originating process) may be served on the registered owner of a registered design by serving the document in the manner prescribed by Order 7 of the Rules of Court at the address for service given in the Register; but
- (b) if any provision of the Rules of Court requires a response to a document served under sub-paragraph (a) within a specified time limit (whether by filing and serving a notice of intention to contest or not contest or otherwise), that time limit is extended by 7 days.

(2) Paragraph (1)(a) ceases to apply when the registered owner has provided an address for service within the meaning of Order 4, Rule 8 of the Rules of Court.

(3) This rule does not prevent the registered owner from being served in accordance with the Rules of Court.

**Registrar to be notified of proceedings, etc., and may take part**

**62.**—(1) In any proceedings under the Act —

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- (a) the party that commenced the proceedings must —
- (i) serve the originating process on the Registrar within 7 days after the originating process is issued;
  - (ii) if the proceedings are entirely discontinued or withdrawn, notify the Registrar within 7 days after the discontinuance takes effect; and
  - (iii) notify the Registrar of the judgment of the Court within 7 days after the judgment is given;
- (b) a defendant that entirely discontinues or withdraws its defence or counterclaim must notify the Registrar within 7 days after the discontinuance or withdrawal takes effect; and
- (c) a party that files a notice of appeal against the judgment of the Court must —
- (i) notify the Registrar within 7 days after the notice of appeal is filed;
  - (ii) if the appeal is withdrawn, notify the Registrar within 7 days after the withdrawal takes effect; and
  - (iii) notify the Registrar of the judgment of the appellate court within 7 days after the judgment is given.
- (2) Notice under paragraph (1) must be given in writing.
- (3) The Registrar —
- (a) may take part in any proceedings under the Act to the extent permitted by the Court; but
  - (b) need not serve a defence or other pleading unless ordered to do so by the Court.

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**PART 6****TRADE MARKS ACT 1998***Division 1 — Preliminary***Definitions of this Part**

**63.**—(1) In this Part —

“Act” means the Trade Marks Act 1998, and a reference to a section is a reference to a section of the Act;

“registered trade mark” means a trade mark registered under the Act, and includes a trade mark that the Act provides is a registered trade mark for the purposes of the Act.

(2) In this Part, the following words have the meaning given by section 2(1):

- (a) “proprietor”;
- (b) “register”;
- (c) “Registrar”.

**Application of Rules of Court**

**64.** Subject to these Rules, the Rules of Court apply to any proceedings under the Act.

*Division 2 — Action for infringement of trade mark (section 31)***Mode of commencement**

**65.** An action for an infringement of a registered trade mark must be commenced by originating claim.

**Provisions relating to defendant**

**66.**—(1) The defendant in an action for an infringement of a registered trade mark may do all or any of the following:

- (a) dispute the validity of the registration of the trade mark;
- (b) counterclaim for the revocation of the registration;

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- 
- (c) counterclaim for a declaration that the registration was invalid;
  - (d) counterclaim for the rectification of the register.
- (2) If the defendant does anything mentioned in paragraph (1), the defendant must —
- (a) serve, with the pleading, particulars of the objection to the validity of the registration on which the party relies; and
  - (b) serve the pleadings and the particulars mentioned in sub-paragraph (a) on the Registrar within 7 days after filing those pleadings and particulars.

*Division 3 — Applications and references under Act*

**Applications to Court**

**67.** Subject to rule 66(1), every application to the Court under the Act must be commenced by originating application.

**References by Registrar to Court — application to be made after reference**

**68.—**(1) Where the Registrar refers to the Court an application made to the Registrar under the Act —

- (a) the applicant must make the same application to the Court within the period mentioned in paragraph (2); and
  - (b) if the applicant fails to do so, the applicant is treated as having abandoned the application.
- (2) For the purposes of paragraph (1) —
- (a) the period is one month after the applicant is notified of the Registrar's decision to refer; but
  - (b) the period may be extended by the Registrar on the application of any interested party (which application may be made before or after the expiration of that month).
- (3) Paragraph (2) does not affect the power of the Court to extend time under Order 3, Rule 4 of the Rules of Court.

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*Division 4 — Appeals from Registrar to Court*

**Application of this Division**

**69.** This Division applies for the purposes of an appeal to the Court from a decision of the Registrar in any case in which the Act gives a right of appeal.

**Provisions relating to appellant**

**70.—(1)** An appeal must be brought by originating application (called in this Part a notice of appeal).

(2) A notice of appeal —

- (a) must be filed with the Court within 28 days after the decision of the Registrar;
- (b) may be given in respect of the whole or any specific part of the decision of the Registrar; and
- (c) must specify the grounds of the appeal and the relief which the appellant seeks.

(3) An appellant must, within 7 days after filing the notice of appeal, serve a copy of the notice of appeal on —

- (a) the Registrar; and
- (b) every other party to the proceedings before the Registrar.

(4) An appellant must, within 14 days after filing the notice of appeal, file a bundle consisting of a copy each of the following documents (as applicable):

- (a) a representation of the trade mark that is the subject of the appeal;
- (b) the notice of opposition;
- (c) the application for alteration, revocation or rectification of the trade mark or for a declaration that the trade mark is invalid;
- (d) the counter-statement;

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- (e) every statutory declaration (including any exhibits) filed with the Registrar;
  - (f) the written submissions;
  - (g) the grounds of decision of the Registrar.

(5) Except with the permission of the Court, the appellant is not entitled on the hearing of the appeal to rely on any ground of appeal or to apply for any relief not specified in the notice of appeal.

(6) Except with the permission of the Court, no appeal may be entertained unless the notice of appeal is given within the period specified in paragraph (2)(a).

#### **Provisions relating to respondent**

**71.—**(1) The respondent must give notice if the respondent intends to contend on the appeal that the Registrar's decision should be —

- (a) varied (whether in any event or in the event of the appeal being allowed in whole or in part); or
- (b) affirmed on grounds other than those set out in the grounds of decision.

(2) The respondent's notice must specify —

- (a) the grounds of the contention; and
- (b) in the case of paragraph (1)(b), the relief that the respondent seeks from the Court.

(3) The respondent's notice must be filed and served on the following persons within 14 days after the respondent receives the notice of appeal or any further time as the Court may direct:

- (a) the Registrar;
- (b) the appellant;
- (c) every other party to the proceedings before the Registrar.

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**Other provisions**

**72.**—(1) The Registrar must transmit to the Court any document requested by the Court relating to the matter that is the subject of the appeal.

(2) The Court must give notice of the date appointed for the hearing of the appeal to —

- (a) the Registrar;
- (b) the appellant; and
- (c) every other party to the proceedings before the Registrar.

(3) At least 7 days' notice must be given under paragraph (2), but the Court may direct that a shorter period of notice be given.

(4) An appeal is to be by way of rehearing.

(5) The evidence used on appeal must be the same as that used before the Registrar and, except with the permission of the Court, no further evidence may be given.

*Division 5 — Miscellaneous*

**Proprietor may be served at address in register**

**73.**—(1) Subject to this rule, for the purposes of any proceedings under the Act —

- (a) a document (including an originating process) may be served on the proprietor of a registered trade mark by serving the document in the manner prescribed by Order 7 of the Rules of Court at the address for service given in the register; but
- (b) if any provision of the Rules of Court requires a response to a document served under sub-paragraph (a) within a specified time limit (whether by filing and serving a notice of intention to contest or not contest or otherwise), that time limit is extended by 7 days.

(2) Paragraph (1)(a) ceases to apply when the proprietor has provided an address for service within the meaning of Order 4, Rule 8 of the Rules of Court.

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(3) This rule does not prevent the proprietor from being served in accordance with the Rules of Court.

**Registrar to be notified of proceedings, etc., and may take part**

**74.—(1)** In any proceedings under the Act —

- (a) the party that commenced the proceedings must —
  - (i) serve the originating process on the Registrar within 7 days after the originating process is issued;
  - (ii) if the proceedings are entirely discontinued or withdrawn, notify the Registrar within 7 days after the discontinuance takes effect; and
  - (iii) notify the Registrar of the judgment of the Court within 7 days after the judgment is given;
- (b) a defendant that entirely discontinues or withdraws its defence or counterclaim must notify the Registrar within 7 days after the discontinuance or withdrawal takes effect; and
- (c) a party that files a notice of appeal against the judgment of the Court must —
  - (i) notify the Registrar within 7 days after the notice of appeal is filed;
  - (ii) if the appeal is withdrawn, notify the Registrar within 7 days after the withdrawal takes effect; and
  - (iii) notify the Registrar of the judgment of the appellate court within 7 days after the judgment is given.

(2) Notice under paragraph (1) must be given in writing.

(3) The Registrar —

- (a) may take part in any proceedings under the Act to the extent permitted by the Court; but
- (b) need not serve a defence or other pleading unless ordered to do so by the Court.

**Consequential amendments**

75.—(1) Orders 69 and 70 of the Rules of Court are deleted.

(2) The Supreme Court of Judicature (Geographical Indications) Rules 2019 (G.N. No. S 706/2019) are revoked.

Made on 2022.

SUNDARESH MENON  
*Chief Justice,  
Singapore.*

LUCIEN WONG  
*Attorney-General.*

TAY YONG KWANG  
*Justice of the Court of Appeal.*

STEVEN CHONG  
*Justice of the Court of Appeal.*

BELINDA ANG SAW EAN  
*Judge of the Appellate Division.*

QUENTIN LOH  
*Judge of the Appellate Division.*

VINODH COOMARASWAMY  
*Judge.*

VINCENT HOONG SENG LEI  
*Presiding Judge of the State Courts.*

CHRISTOPHER TAN PHENG WEE  
*District Judge and  
Registrar of the State Courts.*

SIRAJ OMAR, SC  
*Advocate and Solicitor.*

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*Advocate and Solicitor.*

[Agency FRN; AG/LEGIS/SL/322/2020/3]

(To be presented to Parliament under section 80(6) of the  
Supreme Court of Judicature Act 1969).

DRAFT