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2016 – Study Question (Designs)

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Requirements for protection of designs

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I. Current law and practice

- 1) Does your Group's current law provide for an intellectual property right (registered or patented) that specifically protects the outward appearance or ornamentation of an object or article of manufacture?

As set out in the Study Guidelines, copyrights and trademarks are not such rights in the context of this Study Question.

yes

Please explain:

Such protection can be found in the Registered Designs Act (Cap 266, 2005 Rev Ed). ("RDA"). Nevertheless, it is important to note that there is no substantive examination for Registered Designs in Singapore.

- 2) If yes, what is this right called? (e.g. registered design, design patent, industrial design, industrial design patent)

References to design below are to be read as references to this right, irrespective of what it is called in your jurisdiction.

Right to a Registered Design.

- 3) What are the statutory requirements for such right? Please tick any relevant boxes and explain the basis and application of these requirements.

a) novelty

New Design may be registered

Section 5 of the RDA

(1) Subject to the provisions of this Part, a design which is new may, upon application by the person claiming to be the owner, be registered in respect of an article specified in the application.

(2) A design for which an application for registration is made shall not be regarded as new if it is the same as a design —

(a) registered in respect of the same or any other article in pursuance of a prior application; or

(b) published in Singapore or elsewhere in respect of the same or any other article before the date of the first-mentioned application, or if it differs from such a design only in immaterial details or in features which are variants commonly used in the trade.

b) non-obviousness

c) inventive step

d) individual character

e) originality

f) aesthetic

Refer to explanation under "ornamental" requirement.

g) ornamental

Section 2 of RDA

“design” means features of shape, configuration, pattern or ornament applied to an article by any industrial process, but does not include —

(a) a method or principle of construction; or

(b) features of shape or configuration of an article which —

(i) are dictated solely by the function which the article has to perform;

(ii) are dependent upon the appearance of another article of which the article is intended by the designer to form an integral part; or

(iii) enable the article to be connected to, or placed in, around or against, another article so that either article may perform its function;

Features of shape, configuration, pattern or ornament

To qualify for protection under the RDA, the design applied to the article must comprise of “features of shape, configuration, pattern or ornament”. The RDA links design to the visual appearance of the product. This includes both three and two-dimensional designs, with “shape” and “configuration” referring to three-dimensional designs, while “patterns” and “ornaments” refer to two-dimensional designs.

h) other, namely ...

Industrial Applicability

Rule 12 of the Registered Design Rules, the registered design has to be applied to an article by an industrial process with more than 50 copies of the article have been or are intended to be produced for sale or hire.

4) Does your Group's current law deny design protection to a design with an appearance that is dictated solely by its function?

yes

Please explain:

This can be seen from such an express exclusion in s 2(1)(b)(i) of the RDA, which states that a design does not include “features of shape or configuration of an article which are dictated solely by the function which the article has to perform”.

It is necessary that all of the features/configurations of the design should be dictated solely by its technical function in order for it to fall under the exclusion of s 2(1)(b)(i) of the RDA.

It is important to note that exclusion only applies to three-dimensional designs, since the exclusion does not refer to “patterns” or “ornaments”. This has yet to be clarified by the Singapore Courts and may lead to uncertain situations when the design feature is both a pattern as well as a configuration/shape (*George S S Shun, Industrial Design Law in Singapore (Academy Publishing, 2012) at para 2.51*).

5) If yes, what are the relevant factors to determine whether or not a design is deemed unprotectable as being functional? Please tick any relevant boxes and explain as applicable:

a) whether the overall appearance is dictated solely by its technical function

s 2(1)(b) of the RDA further states that a design will not be registrable if there are features of shape or configuration of an article which are dictated solely by the function which the article has to perform;

b) whether each portion of the overall appearance is dictated solely by its technical function

c) the availability of alternative appearances that can obtain the same functional result

d) the need to achieve the product's technical function was the only relevant factor when the design in question was selected

As stated in the case of *Hunter Manufacturing Pte Ltd and another v Soundtex Switchgear &*

Engineering Pte Ltd and another appeal [1999] SGCA 88 at [37].

e) other, namely ...

6) Does your Group's current law deny design protection to any portions (e.g. a "feature", "element") of the overall design that are deemed functional?

no

Please explain:

Protection is only denied if all the features/configurations of the design are dictated solely by function. See Section 2(1)(b)(ii) of the RDA states that a design does not include "features of shape or configuration of an article which are dictated solely by the function which the article has to perform"

7) If yes, what are the relevant factors to determine whether or not a portion is deemed functional? Please tick any relevant boxes and explain as applicable:

a) whether the overall appearance is dictated solely by its technical function

b) the availability of alternative appearances for the portion to obtain the same functional result

c) the need to achieve the product's technical function was the only relevant factor when the portion in question was selected

d) other, namely ...

8) What is the effect on the scope of protection of a design with one or more functional portions? Please tick any relevant boxes and explain as applicable:

a) any portions deemed functional will not be taken into account when assessing infringement

The case of *Hunter Manufacturing v Soundtex Switchgear* provides that any portions deemed functional will not be taken into account when assessing infringement. It was stated in this case that when comparing the registered article with the infringing one, the features of shape or configuration which are dictated solely by function and methods or principles of construction are excluded.

b) any portions deemed functional will not be taken into account when assessing validity

c) any portions deemed functional will not be taken into account separately when assessing infringement, but can play a role in the overall comparison

d) any portions deemed functional will not be taken into account separately when assessing validity, but may play a role in the overall comparison

It is submitted that this should be the approach, since by statute a design will only not be registered when the overall appearance is dictated solely by its function. There has thus far been no Singapore case law on how functional features should be dealt with when assessing validity of registration.

Additionally, as Singapore does not have substantive examination procedure and there has been no case law on scope of protection of a design with one or more functional portions, we may only rely on statutory provisions.

e) no effect (e.g. so long as the overall appearance is not dictated solely by its technical function, all portions of the design are included in the scope of protection, irrespective as to whether any portions may be functional)

f) the Group's current law is unsettled

There is insufficient case law to interpret the relevant statutory provisions.

g) other, namely ...

II. Policy considerations and possible improvements to your current law

9) How can the following aspects of your Group's current law be improved, if at all?

a) the definition or meaning of a "design"

The current definition of "design" in Singapore has the requirement for the design to be "applied by an industrial process" and the design item must be an "article of manufacture". A review is currently underway to consider broadening the definition of design to exclude the abovementioned requirements. The proposal is to take reference from the UK, EU and Australian definition to provide greater flexibility in constructing the scope of design protection. This proposed broadening of the definition of "design" will take into account technological advances and design related developments.

b) the requirements for protection of a design

Absence of the requirement of eye-appeal

The lack of a statutory requirement for eye-appeal in Singapore has allowed for the registration of designs that may be hidden and internal, which can never be seen by the relevant customer in ordinary use. This has arguably changed the original intent of industrial design protection, which was to "give to the owner of the design the commercial value resulting in customers preferring the appearance of articles which have the design, to those which do not have it" (George S S Shun, *Industrial Design Law in Singapore* (Academy Publishing, 2012) at para 2.36) and thus warrant some discussion.

However, we shall go no further than to state the issue, since the question of whether the design is "visible or invisible during the life of a product embodying such a design" is outside the scope of the Study Guideline. (Point 14 under the "Scope of the Question" of the Study Guidelines)

Whether a strict or balanced approach should be adopted for infringement

In the case of *Hunter Manufacturing v Soundtex Switchgear*, the court held that there was infringement of the registered design since the infringing article had the essential feature of the registered design (its modular design).

It is however, uncertain if the case was for a proposition that:

- a. All essential features had to be incorporated in order to find infringement; or
- b. Whether infringement will be found upon determining the overall impact made by all the features as a whole.

As such, in light of such confusion, clarification by the courts or legislation is necessary. It is submitted that the latter test is more flexible one, preventing a person from escaping infringement by dropping one essential feature from his infringing design.

- c) the treatment of functionality in the sense described in paragraph 14) of the Study Guidelines or aspects of such functionality

Clarifications on the law is required with regard to “Features/configurations that have part functional and aesthetic purposes”

There is uncertainty with regard to registrability, protection and validity of a design with a functional element but still serving an aesthetic purpose as a whole due to the lack of case law.

- 10) Are there any other policy considerations and/or proposals for improvement to your current law falling within the scope of this Study Question?

yes

Please explain:

There are policy considerations for the removal of the requirement for the design to be applied by an industrial process. The Singapore Government is aware that with technological advances such as 3d printing and the growth of artisanal businesses that produce handmade products sold through new distribution platforms via the Internet. The Government is looking into expanding the definition of Design to cover this expanded scope.

III. Proposals for harmonisation

- 11) Does your Group consider that harmonisation in the three areas in question 9) above is desirable?

If yes to some but not all of those three areas, please state in relation to which of the areas your Group considers harmonisation is desirable.

If yes in relation to any of those areas, please respond to the following questions without regard to your Group's current law.

Even if no in relation to any of those areas, please address the following questions to the extent your Group considers your Group's current law could be improved.

yes

Please explain:

It is submitted that harmonization would be desirable for:

- a. **The treatment of functionality.**

The rationale for the protection of industrial design is different from that of patents, and this would thus warrant a clear separation between the two regime; a principle that is applicable even in the international context (World Intellectual Property Organization, *Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications* (Ninth Session, 11 – 15 November 2002) at p 14.). The exclusion of technical function from the ambit is the mechanism by which protection is separated between, industrial design and patents as well as aesthetic and technical function.

As such, it is submitted that there should be harmonization of the treatment of functionality, so as to ensure legal certainty vis-à-vis industrial designs, as well as to further entrench the distinction between protection for aesthetic designs and functional ideas.

a. The definition/meaning of “design”

It is submitted that harmonizing the definition/meaning of a design would be able to resolve confusion as to what would fall within the ambit of “design” protection. This would also reduce transactional costs for registering designs in other jurisdiction.

However, harmonization would not be desirable for:

a. The requirements for protection of the design;

There are numerous models being employed to protect industrial designs, with examples being the:

1. Cumulative protection approach (protected by both copyright laws and *sui generis* industrial design regime) adopted by countries such as France;
2. Separate protection approach (only protected by a *sui generis* industrial design regime) utilized by the USA; and
3. Partial overlap approach (copyright law only comes into play if industrial design is considered a work of art) employed by Nordic countries such as Denmark.

With this backdrop in mind, it is thus submitted that harmonization would not be suitable since the different approaches cater to countries with differing industrial needs.

For example, a jurisdiction adopting the cumulative protection approach would have the lower-threshold requirement of originality (as opposed to novelty). This would be conducive to industries dependent on incremental improvements as opposed to the revolutionary innovations, or short-live industries which require immediate and automatic protection. On the other hand, the low threshold of protection would lead to a narrow and ineffective scope of protection, and would not be conducive to industries such as pharmaceuticals, which require a stronger scope of protection.

In light of the:

- Advantages and disadvantages of different approaches; and
- Differing industry needs and state of development of the jurisdiction.

It is submitted that harmonization should not be carried out vis-à-vis the requirements for protection of the design, since there seems to be:

- No impetus to harmonize; and
- It is difficult to determine the direction in which harmonization should move towards.

Refer to answer in Q9(b) as to how our Group’s current law can be improved with respect to requirements for protection of the design.

12) Should there be harmonisation of the definition of an intellectual property right that specifically protects the outward appearance or ornamentation of an object or article of manufacture?

yes

Please explain:

Such harmonisation will be beneficial.

13) If so, what should that right be called?

Design Rights

14) What should the requirements for such right be? Please tick any relevant boxes and explain the basis and application of these requirements:

a) novelty

Yes. Refer to Q3.

b) non-obviousness

c) inventive step

d) individual character

e) originality

f) aesthetic

Yes. Refer to Q3.

g) ornamental

Yes. Refer to Q3.

h) other, namely ...

15) Should design protection be denied to a design with an appearance that is dictated solely by its function?

yes

Please explain:

16) If yes, what should the relevant factors be to determine whether or not a design is deemed unprotectable as being functional? Please tick any relevant boxes and explain as applicable:

a) whether the overall appearance is dictated solely by its technical function

Yes.

b) whether each portion of the overall appearance is dictated solely by its technical function

c) the availability of alternative appearances that can obtain the same functional result

d) the need to achieve the product's technical function was the only relevant factor when the design in question was selected

Yes.

e) other, namely ...

17) Should design protection be denied to any portions (e.g. a "feature", "element") of the overall design that are deemed functional?

no

Please explain:

No. Design protection should be assessed as a whole. All the features/configurations would have to be for functional purposes in order for the design to not be protected.

18) If yes, what should the relevant factors be to determine whether a portion of a design is functional? Please tick any relevant boxes and explain as applicable:

a) whether the overall appearance is dictated solely by its technical function

b) the availability of alternative appearances for the portion to obtain the same functional result

c) the need to achieve the product's technical function was the only relevant factor when the portion in question was selected

d) other, namely ...

19) What should the effect be on the scope of protection of a design with one or more functional portions? Please tick any relevant boxes and explain as applicable:

a) any portions deemed functional will not be taken into account when assessing infringement

b) any portions deemed functional will not be taken into account when assessing validity

c) any portions deemed functional will not be taken into account separately when assessing infringement, but can play a role in the overall comparison

Yes.

d) any portions deemed functional will not be taken into account separately when assessing validity, but may play a role in the overall comparison

Yes.

- e) no effect (e.g. so long as the overall appearance is not dictated solely by its technical function, all portions of the design are included in the scope of protection, irrespective as to whether any portions may be functional)

Yes.

- f) the Group's current law is unsettled

- g) other, namely ...

- 20) If your answer to question 11) is no, is it your Group's view that a (registered or patented) intellectual property right that specifically protects the outward appearance or ornamentation of an object or article of manufacture should not be available at all?

no

- 21) If yes, why?

Refer to answers in Q11(a) and Q11(b).

- 22) If your answer to question 11) is no in relation to some but not all of the three areas set out in question 9) above, please state why your Group does not consider that harmonisation in that area(s) is desirable.

Refer to answers in Q11(c).

- 23) Please comment on any additional issues concerning any aspect of the definition and requirements for protection of designs, or the role of functionality, you consider relevant to this Study Question.

In addition to harmonization referred to in the above questions, it would be useful to harmonize what cannot be registered as a design right.

Separately, provisions for unregistered design rights will provide protection for industries where

(a) designs have a short commercial life;

(b) designs are revised or varied within a short period of time; and

(c) many designs are produced but only a small percentage have any longevity.

Please indicate which industry sector views are included in part “**III. Proposals for harmonization**” of this form:

Across Industries.

Summary

Law of Registered Designs in Singapore

The law of registered designs in Singapore has been set down by statute, *viz*, the Registered Designs Act (“the Act”). Encompassing both 3 and 2-dimensional designs, the primary element for the design to be registrable is novelty, in which prior art and prior publications will be considered to determine whether the element has been satisfied. The Act also explicitly denies entire designs dictated solely by function, in which the courts has adopted the test of whether functionality was the only relevant factor when the design or portion of the design was selected. However, the Singapore court has thus far been able to adjudicate on only a few design cases and still requires some clarification on certain aspects of its law.

Harmonization

With regard to harmonization, we submit that the law on functionality should be harmonized so as to ensure a clear separation between the law on patents and the law on Registered Designs. Harmonization of the definition of “design” would also be desirable so as to standardize the framework for the law on registered designs to operate as well as to reduce transactional costs for registering designs. However, we submit that the requirements for the protection of registered designs should not be standardized, since different requirements would be deemed necessary to serve the differing industrial needs of various countries.