

DIALOGUE SESSION BETWEEN IPOS AND IP COMMITTEE OF LAW SOCIETY AND AIPPI

22nd January 2003

At this dialogue session held at IPOS, several officers from IPOS were present besides representatives from the IP Committee of the Law Society. From AIPPI, the representatives present were Teresa O'Connor, Audrey Yap, Francine Tan, Adrian Ee, Max Ng and Winnie Tham.

IPOS expressed their welcome to all those present and extended apologies to APAA which they had inadvertently left out of the formal invitation. However it was noted that many of those present were also committee members of APAA so the end-result was not disadvantageous. IPOS plans to hold such feedback or dialogue sessions with members of the profession once every 6 months.

1. Amendments to provide for e-filing of Forms TM 27, TM 22

IPOS disclosed that it was making preparations to allow for e-filing of the above forms. With regard to TM 27, the specification would be automatically updated. For situations where submissions are filed together with TM 27, IPOS advised that it would be possible to attach the submissions to the TM 27. There was concern raised as to whether there would be an acknowledgement date for such submissions. It was decided that there would be a date of acknowledgement via the payment receipt. Everyone present welcomed the possibility of e-filing TM 27. As for TM 22, some reservations were expressed where members of the public utilized the e-filing service to carry out a transaction affecting the ownership of a mark and the concern was as to possible abuse. This is because when TM 22 is e-filed, there is no longer any requirement for it to be signed. There were 3 possible safeguards which IPOS will consider. (1) The agent could be required to make a declaration that he is duly authorized by all parties to make the recordation. IPOS will check for this declaration and the CPF PAL pin before GIRO authentication is effected. (2) For lay applicants, there could also be a declaration. (3) It might be necessary to attach a scanned copy of the agreement to the application. On the whole, no member of the profession had any strong objection to an assignment being possible by e-filing TM 22.

2. Proposed Amendments to Fourth Schedule : Scale of Costs

IPOS proposed to make upward revisions to the Scale of Costs seeing that there were no changes even at the time of the last major amendments in 1998. For example, regarding the drafting of the Notice of Opposition, the scale would be raised to range between \$325.00 to \$650.00. These costs should also apply to the drafting of the Counter-Statement. All persons present welcomed these revisions.

The reason given by IPOS for having a range rather than a fixed amount is that some hearings may involve unrepresented members of the public.

It was felt that the scale should reflect a minimum fee that is at least on par with the official filing fee for the form or document concerned.

3. Proposed Amendments to Consent Provisions : rules 29, 31 and 77

The present procedure is unsatisfactory in that the party writing in for the extension cannot be sure that the extension will be granted, even where the other side consents, and IPOS does not reply in good time before the statutory maximum extended date. It is also unsatisfactory as there is no time deadline within which the other side must reply to indicate whether or not it consents. Initially, IPOS proposed to introduce an amendment to the rules such that the Registrar may proceed to grant an extension even if the other

side fails to consent or to reply within 2 weeks of the request. In practice, there is little difficulty as practitioners are aware that IPOS invariably grants the additional 2 months' time extension. However, this problem becomes exacerbated when firms which do not regularly handle trade marks work get involved in oppositions, etc. After much discussion it was felt that one solution of disposing of the issue of time, consent, etc would be to dispense with the necessity of obtaining consent from the other side. The party requesting the extension would simply have to write in to IPOS giving good and sufficient reasons for the request for extension, and notifying the other party of such request having been made. IPOS then has the discretion to grant the extension on its own, without taking into account consent from the other side.

If the rules are amended to provide for the foregoing, the problem currently posed where IPOS does not revert to confirm that the time for filing Notice of Opposition or Counter Statement, as the case may be, is also removed since IPOS will always grant the extension if there are reasons given therefor.

4. Deadline for filing Notice of Opposition

IPOS mooted the idea of extending the time for filing Notice of Opposition to a flat period of 3 months after the date of advertisement instead of the present 2 months. Practitioners present confirmed that the present 2 month period was often a little too short because overseas opponents would not receive copies of the advertisements until the 2 months was almost up. However, taking into account the possibility of extension and the primary interest of applicants in getting their mark registered as quickly as possible, it was felt that no radical changes should be made to the present time-scheme for oppositions i.e. 2 months from the date of gazette and maximum of 2 months extension.

5. Post-Grant Opposition instead of pre-grant opposition

IPOS mooted a radical change, all in the interest of facilitating speedy issue of Certificates of Registration. Instead of the present system where a mark is advertised and third parties are given 2 months in which to oppose, it was proposed that a mark simply proceed to issue of Certificate of Registration, after which the fact of registration be advertised. Third parties may then, if they wish, file a post-grant opposition. Virtually all practitioners present opposed such an arrangement as it was felt that it would render the value of a Singapore Certificate of Registration of a trade mark uncertain in light of possible opposition to be filed. Also, many trade mark owners would wish to immediately take infringement or other enforcement action upon receipt of their Certificates of Registration and this would lead to uncertainty and confusion. Further, IPOS is at present very fast at issuing Certificates of Registration and it was felt that there was no necessity to speed up the process even further by means of such a radical change.

6. Publication of marks within 6 months of application

IPOS has been examining marks on a fast-track, as far as possible. This means that in many cases a mark can clear all examination hurdles before 6 months. In the past, IPOS has been holding back such cases until at least 6 months has passed, before it proceeds to advertise the mark in the Journal. The reason for this is due to the possibility of later-filed applications being lodged, which claim earlier priority filing dates than the subject application. Therefore, in the event that IPOS proceeds to advertise and accept the mark before the 6 months has passed, bearing in the mind the 6 months' priority claim period, the possibility arises that an identical mark is filed by a third party which claims an earlier priority filing date. IPOS maintained that the possibility of this happening is extremely rare, that it sees no compelling reason why applications should be held back from the fast-track due to the remote possibility of a priority application coming in. As such, IPOS

does not propose to hold back examination and advertisement, and disclosed that this was also the practice of the UK Registry.

However, as there may be rare cases where a problem arises, it was discussed whether the best method of dealing with such cases was through the ordinary opposition or rectification channel or through a special observations procedure as was available in the UK Registry. In Singapore, where a mark had simply been advertised but the Certificate of Registration had not been issued yet, any third party may simply write in and the Registrar has the power to revoke an earlier acceptance. This procedure could also work in the case where the Certificate of Registration had already been granted. When queried as to whether this would also be the case for a prior similar mark, it appeared that IPOS may only do so where there is a prior identical trade mark and not where the mark is similar. However, there is no such limitation currently under Section 16 of the Trade Marks Act. IPOS then indicated that they would discuss this internally and take it offline for the time being.

There were no strong objections from those present. As such, it can be expected that the speed of processing and examination of marks can be increased in the near future.

7. Recordal of Licenses to be made voluntary instead of mandatory

IPOS clarified that it was not its stance that the present provisions made recordal of the licence compulsory, as the statutory provisions clearly do not make it mandatory. However, as there were certain adverse consequences should a licensee not arrange for recordal, the recordal may be seen as being virtually compulsory, from that perspective. IPOS proposes to remove all adverse consequences of not having a licence recorded. Some of those present raised the issue that there is merit in having a mandatory recordal of licence since the register serves as a record where members of the public can obtain the relevant information. However there was in general no strong objection. It was revealed by IPOS that these amendments were prompted by certain considerations flowing from Singapore's membership of the Free Trade Agreement.

8. Notification by IPOS of advertisement of application

The point was raised by a practitioner that it would be of assistance if IPOS would notify agents of the acceptance of an application and plans to advertise the same in the Trade Marks Journal, in order to avoid unnecessary reminders or queries to IPOS about the status of an application in progress. There was also feedback to IPOS that it would be helpful if IPOS notified agents of an abandonment of an application for reasons of non-response to an outstanding office action, as there may be cases which escape the diary procedure and such notification would at least provide the agent/applicant with some recourse for restoring the application since involuntary abandonments may come to light before inordinate time passes. After some discussion, IPOS commented that it is their policy to speed up advertisement as far as possible and delays would be minimized. As a trade-off, IPOS commented that they would look into the issue of providing notifications of abandonment which was felt to be more helpful on the whole than providing notifications of acceptance. Practitioners present were generally in agreement with this.

9. Grace Period for Renewals without Statutory Declaration

The Registrar is considering amending the rules to allow for a grace period of 6 to 12 months for late renewal without the need to file any Statutory Declaration giving reasons. Presently, the rules do not allow for late renewal and it is necessary to apply for restoration for all renewals filed late. The members present all welcomed this suggestion.

The dialogue session ended at 1.00 pm with thanks to all those attending.