

INTELLECTUAL PROPERTY LAW IN SINGAPORE: A GENERAL OVERVIEW¹

I. INTRODUCTION

In this age of rapid scientific and technological progress, research and development has given rise to new technologies, particularly in the area of information technology, computers and biotechnology. The advent of these new technologies have resulted in increasing growth in the importance of a legal system for the protection of industrial property and intellectual property rights. In recent years, the problems of counterfeiting and piracy of technology, sometimes resulting from the transfer of technology between industrialised and developing countries, have resulted in intellectual property issues being tabled at international trade negotiations.² This article will seek to provide a general overview of the protection of intellectual property rights in Singapore. A short discussion will be made on each of the main branches of intellectual property law, namely, the law of patents, copyright, registered designs, trade marks and trade names, passing-off and breach of confidence. A brief summary on computer software protection laws in Singapore will also be made. In order to gain a clearer perspective of the intellectual property system in Singapore, it may be appropriate to set out a short description of the Singapore legal system.

II. SINGAPORE LEGAL SYSTEM

The Singapore legal system, with its English colonial heritage, finds its foundation firmly planted in the English common law.³ Under the Second Charter of Justice of 1826, the laws of England as it existed on the 27th November 1826 was formally received into Singapore. This general reception was, however, subject to (i) local legislation; (ii) the religions, manners and customs of the inhabitants of Singapore; (iii) the suitability of its application to Singapore. As the Privy Council held in *Yeap Cheah Neo v. Ong Cheong Neo*⁴: “statutes relating to matters and exigencies peculiar

¹ This article is based substantially on a paper delivered at the International Conference on Legal Regulation to Scientific and Technological Progress held in Shanghai, China on October 14–18, 1991.

² See, in particular, the Uruguay Round of negotiations of the General Agreement on Tariffs and Trade (GATT).

³ For a more detailed discussion on the applicability of English law in Singapore and a general discussion on the Singapore legal system and legal history, see H. Chan, *An Introduction to The Singapore Legal System* (1986), especially chapters I and II; W. Woon (Ed.), *The Singapore Legal System* (1989), especially chapters 4 and 5; G.W. Bartholomew, “English Law *In Partibus Orientalium*” and Soon Choo Hock and A. Phang, “Reception of English Commercial Law in Singapore — A Century of Uncertainty”, chapters 1 and 2 respectively in A.J. Harding (Ed.), *The Common Law in Singapore and Malaysia* (1985).

⁴ (1875) L.R. 6 P.C. 381 at p. 394.

to the local condition of England, and which are not adapted to the circumstances of a particular Colony, do not become a part of its law, although the general law of England may be introduced into it.”⁵ It has generally been accepted that under the Second Charter of Justice of 1826, only pre-1826 English law⁶ was received into Singapore. It is, however, interesting to note that post-1826 English case-law continues to be received into Singapore, for example, in the law of passing-off.⁷ Post-1826 English statutes, on the other hand, have been excluded from the general reception provision and would not apply in Singapore unless:

- (a) they were Imperial Acts which had been extended to the colony by the Imperial Parliament at Westminster. One such example would be the Imperial Copyright Act 1911⁸ which came into force in Singapore on the 1st July 1912 and remained the statutory basis for copyright protection in Singapore until its repeal on the 10th April 1987 by the Singapore Copyright Act 1987,⁹ or
- (b) there is a provision in the Singapore statute directing the Singapore courts to apply the English statutory provisions, for example, section 5 of the Civil Law Act¹⁰ or where there are “saving clauses” which allow English law to be received into Singapore in certain circumstances,¹¹ or
- (c) where the Singapore statute imports into Singapore the same rights and privileges conferred by the English statutes, for example, the

⁵ See H. Chan, *supra*, at pp. 7–13.

⁶ That is, the law of England as at the 27th November 1826. Note that this general reception is subject to the qualifications discussed above.

⁷ See, for example, *Haw Par Brothers International Ltd. v. Jack Chiarapurk* [1991] 2 M.L.J. 428 where the decisions on passing-off referred to in the case were post-1826 English cases. See H. Chan, *An Introduction to The Singapore Legal System* (1986), chapters I and II.D., for a discussion of the Singapore legal history and the reasons for the continuing reception of English case-law into Singapore.

⁸ See section 25(1) Copyright Act 1911 which automatically extends the 1911 Act to all of His Majesty’s dominions, except self-governing dominions. Thus, the 1911 Act extended to Singapore since Singapore was a British colony at that time. See also section 37(2)(d) of the 1911 Act.

⁹ The question of whether the Copyright Act 1911 should be repealed or modified in the light of Singapore’s independence was discussed in *Butterworth & Co. (Publishers) Ltd. v. Ng Sui Nam* [1985] 1 M.L.J. 196, [1987] 2 M.L.J. 5 (affirmed on appeal); *Australian Shipbuilding Industries (W.A.) Pty. Ltd. v. Assets Able* [1987] 2 M.L.J. 17.

¹⁰ Cap. 43, 1988 Rev. Ed. Section 5(1) provides that: “Subject to this section, in all questions or issues which arise or which have to be decided in Singapore with respect to the law of partnerships, corporations, banks and banking, principals and agents, carriers by air, land and sea, marine insurance, average, life and fire insurance, and with respect to merchantile law generally, the law with respect to those matters to be administered shall be the same as would be administered in England in the like case, at the corresponding period, if such question or issue had arisen or had to be decided in England, unless in any case other provision is or shall be made by any law having force in Singapore.”

¹¹ See H. Chan, *supra* note 7, at pp. 17–19.

Registration of United Kingdom Patents Act¹² and the United Kingdom Designs (Protection) Act¹³.

Thus, despite Singapore's status as an independent republic since 1965, her laws are to a large extent intimately linked with those of the United Kingdom, particularly in the area of commercial law and the law of intellectual property. It is within this broad framework of the English common law that the Singapore intellectual property system subsists.

III. LAW OF PATENTS

The most important form of protection for scientific and technological inventions would lie in the patent branch of the intellectual property system. This is especially so since patent protection confers on the patentee a full monopoly for the exploitation of his invention. Singapore has no indigenous patent law and, at present, there is no "local route" for the registration of patents in Singapore. The only way to obtain patent protection in Singapore is under the Registration of United Kingdom Patents Act¹⁴ which provides a system for the re-registration of a United Kingdom patent in Singapore. Section 3 of the Registration of United Kingdom Patents Act provides that:

"Any person being a grantee of a patent in the United Kingdom or any person deriving his right from the grantee by assignment, transmission or other operation of law may apply to the Registrar of Patents within 3 years from the date of issue of the patent to have the patent registered in Singapore. Where any partial assignment or transmission has been made, all proper parties shall be joined in the application for registration: Provided that the Registrar of patents may in his discretion accept the application where it is shown to his satisfaction that for any reason the application could not be made within 3 years from the date of issue of the patent in the United Kingdom."

This would, therefore, require an applicant who is seeking patent protection in Singapore to first obtain a United Kingdom patent. There are, at present, basically three main ways of acquiring a United Kingdom patent:

- (a) by direct application to the British Patent Office for a United Kingdom patent under the Patents Act 1977 (U.K.); or

¹² Cap. 271, 1985 Rev. Ed.

¹³ Cap. 339, 1985 Rev. Ed.

¹⁴ Cap. 271, 1985 Rev. Ed.

- (b) by application to the European Patent Office in accordance with the provisions of the European Patent Convention of 1973 (E.P.C.) for a European Patent (U.K.);¹⁵ or
- (c) by application under the Patent Co-operation Treaty of 1970 (P.C.T.) designating the United Kingdom as a country for which patent protection is sought. Under the P.C.T. the applicant may acquire national patents in any of the contracting states by making a single “international” application. However, in order to apply under the P.C.T. the applicant must be either a national or resident of a P.C.T. contracting state.¹⁶

Singapore is not at present a signatory to any Patent Treaty, A controversial problem which may arise is whether or not patents granted in the United Kingdom under the Patents Act 1977 (U.K.) and European patents (U.K.) granted under the European Patent Convention would be recognised by the Singapore registry and Courts. This problem arises due to the wording of section 2 of the Registration of United Kingdom Patents Act which defines “patent” to mean “letters patent for an invention”. Letters patent were granted under the Patents Act 1949 (U.K.). Under the Patents Act 1977 (U.K.), letters patent are no longer issued but instead certificates of registration are issued. The issue revolves around the interpretation of the term “patents” under the Registration of United Kingdom Patents Act. If a strict interpretation is adopted then patents issued under the Patents Act 1977 (U.K.) and the European patent (U.K.) would not be recognised for the purposes of re-registration under the Registration of United Kingdom Patents Act. This interpretation would result in a lacuna in the re-registration system. To avoid this, the Registry and the courts would have to interpret “patents” to include patents issued under the “successor” legislation to the Patents Act 1949 (U.K.). Thus, an applicant, who is not a national or resident of a P.C.T. contracting state, seeking patent protection in Singapore must apply to the Singapore Registry to re-register either a national (United Kingdom) patent or a European patent

¹⁵ The United Kingdom is a member of the European Patent Convention. Section 77(1) Patents Act 1977 (U.K.) provides that: “. . . a European patent (U.K.) shall, as from the publication of the mention of its grant in the European Patent Bulletin, be treated . . . as if it were a patent under this Act granted in pursuance of an application made under this Act. . .” Thus, a European patent (U.K.) will be treated as if it were a United Kingdom patent granted under the Patents Act 1977 (U.K.).

¹⁶ In relation to the status of an applicant under the Patent Co-operation Treaty, Article 9 provides that: “(1) Any resident or national of a Contracting State may file an international application; (2) The Assembly may decide to allow the residents and the nationals of any country party to the Paris Convention for the Protection of Industrial Property which is not party to this Treaty to file international applications.”

(U.K.)¹⁷ in Singapore. This re-registration system in Singapore is basically a formality since the Registry does not conduct an examination into the substantive requirements for patentability, namely, that of novelty, inventive step and whether the invention is capable of industrial application.

Upon re-registration of the patent in Singapore, the patentee would acquire rights and privileges in Singapore similar in all respects to those conferred by the issue of the patent in the United Kingdom. Section 6 of the Registration of United Kingdom Patents Act provides as follows:

“Such certificate of registration shall confer on the applicant privileges and rights, subject to any privileges or rights acquired under any previous Act of Singapore relating to inventions, similar in all respects to those conferred by the issue of the patent in the United Kingdom.”¹⁸

The rights and privileges¹⁹ conferred by the issue of the patent in the United Kingdom are comprised in the Patents Act 1977 (U.K.). The exclusive rights which a patentee acquires in the case of a product patent are the right to make, dispose of, offer to dispose of, use or import the patented product or keep it whether for disposal or otherwise.²⁰ In the case of a process patent, the patentee’s exclusive rights include not merely the right to use or offer for use the patented process in Singapore,²¹ but also

17 It is worth noting that there is no residency or nationality restrictions on the status of an applicant under the E.P.C. unlike the P.C.T. Article 58 of the European Patent Convention provides that: “A European patent application may be filed by any natural or legal person, or any body equivalent to a legal person by virtue of the law governing it.”

18 Section 6 of the Registration of United Kingdom Patents Act (Cap. 271, 1985 Rev. Ed.) does not make the statutory provisions of the Patents Act 1977 (U.K.) a part of the laws of Singapore. The wordings of section 6 would appear merely to import the *effect* of the statutory provisions of the Patents Act 1977 (U.K.) into Singapore since it is necessary to determine the rights and privileges enjoyed by a patentee in the United Kingdom in order to determine the rights and privileges conferred by the certificate of registration in Singapore. See also Pendleton, *The Law of Intellectual and Industrial Property in Hong Kong* (1984) at pp. 236–240 for a discussion of section 6 of the Hong Kong Registration of Patents Ordinance (Cap. 42, LHK 1979 Ed.) which is similar to section 6 of the Singapore Registration of United Kingdom Patents Act.

19 It is unclear as to the precise meaning of the term “privileges and rights”, for example, whether the term encompasses merely the benefits enjoyed by a patentee under the Patents Act 1977 (U.K.) or whether it includes the burdens as well; whether the effects of the provisions, for example, in relation to employees’ inventions are included in the term “privileges and rights”.

20 See section 60(1)(a) Patents Act 1977 (U.K.). See also *Rhone-Poulenc AG Co. v. Dikloride Herbicides Sdn. Bhd.* [1988] 2 M.L.J. 323.

21 See section 60(1)(b) Patents Act 1977 (U.K.). Note, however, that in order to be liable under this sub-section, it is necessary to show that the alleged infringer “knows or it is obvious to a reasonable person in the circumstances, that its use there without the consent of the proprietor would be an infringement of the patent”.

includes the exclusive right to dispose of, offer to dispose of, use or import any product obtained directly by means of the patented process.²²

In this respects it should be noted that under section 9 of the Registration of United Kingdom Patents Act, the High Court of Singapore has power to:

“... declare that the exclusive privileges and rights conferred by [the] certificate of registration have not been acquired on any of the grounds *mutatis mutandis* upon which the United Kingdom patent might be revoked under the law for the time being in force in the United Kingdom.”

Any person who is aggrieved by the issue of a certificate of registration in Singapore can try to attack the acquisition of the “rights and privileges” thereunder by challenging the patentability of the invention upon the grounds set out in the Patents Act 1977 (U.K.).²³

Since Singapore adopts a “piggy back” on the patent system in the United Kingdom, this article will only briefly summarise the substantive criteria on patentability as set out in the Patents Act 1977 (U.K.).²⁴

The essential characteristics of a patent are set out in section 1(1) of the Patents Act 1977 (U.K.) as follows:

“A patent may be granted only for an invention in respect of which the following conditions are satisfied, that is to say —

- (a) the invention is new;
- (b) it involves an inventive step;
- (c) it is capable of industrial application;
- (d) the grant of a patent for it is not excluded by subsections (2) and (3) below ...”

²² See section 60(1)(c) Patents Act 1977 (U.K.). Note also section 60(2) of the Patents Act 1977 (U.K.), dealing with contributory infringement, which provides that: “... a person (other than the proprietor of the patent) also infringes a patent for an invention if, while the patent is in force and without the consent of the proprietor, he supplies or offers to supply in [Singapore] a person other than a licensee . . . with any of the means, relating to an essential element of the invention, for putting the invention into effect when he knows, or it is obvious to a reasonable person in the circumstances, that those means are suitable for putting, and are intended to put, the invention into effect in [Singapore].” Note also the exception to section 60(2), provided in section 60(3) of the Patents Act 1977 (U.K.) which relates to the supply or offer of a staple commercial product.

²³ See section 72 of the Patents Act 1977 (U.K.) which provides that one of the grounds for revocation of a patent is that the invention is not a patentable invention.

²⁴ See generally, Chartered Institute of Patent Agents, *C.I.P.A. Guide to the Patents Acts* (3rd ed., 1990); Aldous, Young, Watson, Thorley, *Terrell on the Law of Patents* (13th ed., 1982); Cornish, *Intellectual Property: Patents, Copyright, Trade Marks and Allied Rights* (2nd ed., 1989); Ricketson, *The Law of Intellectual Property* (1984).

It is worth noting that the requirement of novelty is based on worldwide novelty, that is, the invention must not have been made available to the public whether in the United Kingdom or elsewhere.²⁵ The requirements of patentability are assessed at the priority date which is usually the date of filing of the patent application.²⁶ The United Kingdom, thus, adopts the “first to file” rule in that once the patent application has been filed, the state of the art for the purpose of examining the patentability of the invention would have crystallised at the priority date and the examination would be made in relation to matters which have been made available to the public *before* that priority date.

The Patents Act 1977 (U.K.) also sets out certain bars to patentability which includes the following:

- (1) Section 1(2) precludes the patenting of the following things *as such*: discoveries, scientific theories or mathematical methods; literary, dramatic, musical or artistic works or any other aesthetic creation; schemes, rules or methods for performing a mental act, playing a game or doing business, or a program for a computer; the presentation of information.
- (2) Section 1(3) sets out further matters which are excluded from patentability on the grounds of public policy. These are:
 - (a) “an invention the publication or exploitation of which would be generally expected to encourage offensive, immoral or anti-social behaviour;”
 - (b) “any variety of animal or plant or any essentially biological process for the production of animals or plants, not being a micro-biological process or the product of such a process.”²⁷
- (3) A further bar to patentability is provided in section 4(2) as follows: “An invention of a method of treatment of the human or animal body by surgery or therapy or of diagnosis practised on the human or animal body shall not be taken to be capable of industrial application.” However, a product, consisting of a substance or composition, of such a method of treatment will not be barred from patentability.²⁸

²⁵ See section 2(1) and (2) Patents Act 1977 (U.K.).

²⁶ See section 5 Patents Act 1977 (U.K.).

²⁷ Difficulties have arisen in relation to the interpretation of this sub-section, for example, regarding the definition of what constitutes a plant and animal *variety* and what is an essentially biological process.

²⁸ See section 4(3) Patents Act 1977 (U.K.).

Apart from these substantive requirements for patentability, there are also two main procedural requirements relating to the patent specification and the patent claim which have to be complied with. These are found in:

- (1) Section 14(3) of the Patents Act 1977 (U.K.) which provides that the specification of the patent application “shall disclose the invention in a manner which is clear enough and complete enough for the invention to be performed by a person skilled in the art.”
- (2) Section 14(5) of the Patents Act 1977 (U.K.), on the other hand, provides that the patent claim(s) shall —
 - “(a) define the matter for which the applicant seeks protection;
 - (b) be clear and concise;
 - (c) be supported by the description; and
 - (d) relate to one invention or to a group of inventions which are so linked as to form a single inventive concept.”

The failure to comply with these requirements could be a ground for the revocation of the patent.²⁹

Once the patent has been granted the patentee would acquire a 20 year monopoly in relation to the exploitation of his invention.³⁰ Section 7(1) of the Registration of United Kingdom Patents Act³¹ provides that:

“Privileges and rights so granted shall date from the date of the patent in the United Kingdom and shall continue in force only so long as the patent remains in force in the United Kingdom: Provided that no action for infringement shall be entertained in respect of any manufacture, use or sale of the invention prior to the date of issue of the certificate of registration in Singapore.”

Although the patent protection conferred by the grant of the certificate of registration in Singapore is similar to those in the United Kingdom, there are exceptions particularly in relation to the grant of compulsory licences and use of certain patented products by or on behalf of the Singapore Government. These are contained in the Patents (Compulsory Licensing) Act.³² Section 3 of the Patents (Compulsory Licensing) Act provides rather limited provision for the grant of compulsory licences in respect of

²⁹ See section 72(1) Patents Act 1977 (U.K.).

³⁰ See section 25 Patents Act 1977 (U.K.) for the duration of the patent which runs from the date of filing of the patent application.

³¹ Cap. 271, 1985 Rev. Ed.

³² Cap. 221, 1985 Rev. Ed.

specified classes of patented invention. These are restricted to the four areas of:

- (1) Sheet metal; metal tubes; wire.
- (2) Glass; mineral and slag wool.
- (3) Textiles³³ and paper.³⁴
- (4) Fixed Construction.³⁵

The Registrar also has power to grant compulsory licences for patented inventions in relation to food, medicine, surgical or curative device.³⁶ Special provisions have also been made to allow the Singapore government to make, import or obtain any patented medicine or drug for distribution and use in any dispensary, hospital or other medical institution maintained by or on behalf of the Government.³⁷

Apart from the law of patents, valuable scientific and technological know-how can also be protected by the law of confidence. However, since the law of confidence only protects confidential information it is important that such information must not be disclosed in the patent specification, since publication of the patent specification would constitute disclosure to the world and thus, destroy the necessary quality of confidence in the information.³⁸

Finally, it may be useful to briefly note the various alternatives to the present system. The current system of requiring an applicant seeking patent protection in Singapore to first obtain a United Kingdom patent is both time-consuming and expensive. The following are some of the possible alternatives:

- (1) The provision of a domestic system of patent registration solely in Singapore. This would require patent examiners in Singapore, who are experts in the relevant field of science and technology, to conduct detailed examination into the requirements of patentability.
- (2) Another alternative may be for the Asean countries to form, for example, an Asean Patent Co-operation Convention for the grant of

³³ Natural and artificial threads and fibres; spinning; weaving; braiding; lace-making; machine knitting; trimmings; non-woven fabrics; sewing; embroidery; bleaching; washing; dyeing; finishing and printing of textiles; dyeing and bleaching of leather; bed feathers; wallpaper; floor coverings; ropes; cables (non-electric).

³⁴ Paper making; production of cellulose.

³⁵ Building: Locks; keys; window and door fittings; safes.

³⁶ See section 5(1) Patents (Compulsory Licensing) Act (Cap. 221, 1985 Rev. Ed.).

³⁷ See section 13 Patents (Compulsory Licensing) Act (Cap. 221, 1985 Rev. Ed.).

³⁸ See below under "Law of Confidence."

an Asean Patent instead of a domestic system of registration in each of the Asean countries. There is at present no medium for such collective discussion.

- (3) The provision of utility models. Developing countries may benefit more from the existence of utility models providing a lower requirement of patentability and a shorter period of protection rather than the full patent protection requiring worldwide novelty of the invention.

IV. REGISTERED DESIGNS LAW

The registered designs system provides protection for industrial designs, namely, designs which are to be used as models for the production of articles based on such designs. In Singapore, such protection is provided under the United Kingdom Designs (Protection) Act.³⁹ Section 2 of the Act provides that:

“Subject to the provisions of this Act, the registered proprietor of any design registered in the United Kingdom under the Registered Designs Act 1949 or any Act amending or substituted for that Act, or any person deriving his right from such registered proprietor by assignment, transmission, or other operation of law, shall enjoy in Singapore the like privileges and rights as though the certificate of registration in the United Kingdom had been issued with an extension to Singapore.”

Unlike copyright protection, registered design protection is dependent upon registration. Unlike patent protection, once the design has been registered in the United Kingdom, the design protection in Singapore is automatic and is not dependent upon re-registration in Singapore. There is, however, no system for registering designs in Singapore. In order to obtain protection for registered designs in Singapore, the applicant must first obtain registration of the design in the United Kingdom. Once the design has been so registered, the registered proprietor will enjoy the same privileges and rights in Singapore as if the certificate of registration in the United Kingdom had been issued with an extension to Singapore.⁴⁰ In order for the design to be registrable in the United Kingdom under the Registered Designs Act 1949 (U.K.) as amended by the Copyright, Designs and Patents Act 1988 (U.K.) (hereinafter referred to as the “C.D.P.A. 1988”), the design must satisfy the following requirements.

³⁹ Cap. 339, 1985 Rev. Ed.

⁴⁰ This is similar to section 6 of the Registration of United Kingdom Patents Act, Cap. 271, 1985 Rev. Ed., where the registered proprietor in the United Kingdom would get the same privileges and rights in Singapore as he would in the United Kingdom. The main difference is that patent protection in Singapore is dependent upon re-registration of the United Kingdom patent in Singapore, whereas, in the case of registered design protection, no re-registration is required in Singapore.

First, the design must be new.⁴¹ Second, the design must have eye appeal. This is so because of the definition of “design” in section 1(1) of the Registered Designs Act 1949 (U.K.) as amended by section 265(1) of the Copyright, Designs and Patents Act 1988 (U.K.) which provides that:

“ ‘design’ means features of shape, configuration, pattern or ornament applied to an article by any industrial process, being features which in the finished article appeal to and are judged by the eye. . . ,”⁴²

Third, the design, whose features of shape or configuration of the article, must not be “dictated solely by the function which the article has to perform”.⁴³ Fourth, the design, whose features of shape or configuration of an article, must not be “dependent upon the appearance of another article of which the article is intended by the author of the design to form an integral part.”⁴⁴ Fifth, the appearance of the article based on the design must be material. This is provided by section 1(3) of the Registered Designs Act 1949 (U.K.) (as amended) as follows:

“A design shall not be registered in respect of an article if the appearance of the article is not material, that is, if aesthetic considerations are not normally taken into account to a material extent by persons acquiring or using articles of that description, and would not be so taken into account if the design were to be applied to the article.”

Once the design has been registered, the registered proprietor would have a monopoly over the use of the design for a maximum period of protection of 25 years.⁴⁵ However, the monopoly would only extend to the classes of articles for which the design registration has been secured.⁴⁶ In infringement proceedings⁴⁷ where the registered proprietor is claiming damages, it is worth noting the defence of innocence which is provided in section 3 of the United Kingdom Designs (Protection) Act as follows:

“The registered proprietor of a design shall not be entitled to recover any damages in respect of any infringement of copyright in a design from

⁴¹ See section 1(2) of the Registered Designs Act 1949 (U.K.) as amended by section 265(1) of the Copyright, Designs and Patents Act 1988. See also *Teh Teik Boay v. Chuah Siak Loo* (1962) 28 M.L.J. 80.

⁴² Note also that “a method or principle of construction” does not fall within the definition of a registrable design. See section 1(1)(a) of the Registered Designs Act 1949 (U.K.) as amended by section 265(1) of the Copyright, Designs and Patents Act 1988 (U.K.).

⁴³ See section 1(1)(b)(i) of the Registered Designs Act 1949 (U.K.) as amended by section 265(1) of the Copyright, Designs and Patents Act 1988 (U.K.).

⁴⁴ See section 1(1)(b)(ii) of the Registered Designs Act 1949 (U.K.) as amended by section 265(1) of the Copyright, Designs and Patents Act 1988 (U.K.).

⁴⁵ See section 8 of the Registered Designs Act 1949 (U.K.) as amended.

⁴⁶ See section 7 of the Registered Designs Act 1949 (U.K.) as amended.

⁴⁷ For infringement of registered designs, see *Redland Tiles Ltd. v. Kua Hong Brick Tile Works* [1966] 2 M.L.J. 62.

any defendant who proves that at the date of the infringement he was not aware nor had any reasonable means of making himself aware of the existence of the registration of the design: Provided that nothing in this section shall affect any proceedings for an injunction.”

Section 4 of the United Kingdom Designs (Protection) Act⁴⁸ also grants to the High Court of Singapore the power to declare that the “exclusive privileges and rights in a design have not been acquired in Singapore under [section 2 of this Act] upon any of the grounds upon which the United Kingdom registration might be cancelled under the law for the time being in force in the United Kingdom.” Thus, the High Court has the power to declare that the registered proprietor of the design has not acquired the “exclusive privileges and rights” in the design in Singapore if the requirements for registrability discussed above are not satisfied.

Under the Registered Designs Act 1949 (U.K.) (as amended) a “functional” design would not be registrable due to its functionality, the lack of eye appeal and the fact that aesthetic considerations are not normally taken into account to a material extent by the user or purchaser of the article. Although these “functional” designs cannot be subject to registered design protection, the possibility remains open that copyright can be used as the vehicle for protection. This is so as copyright can be asserted in a design drawing, as an original artistic work,⁴⁹ to prevent reproduction of the design drawing in two dimensional form and also to prevent the copying of the two dimensional drawing into reproductions of three dimensional articles.⁵⁰ This would, therefore, create an anomaly since copyright protection which is normally for a period of the life of the author plus fifty years thereafter⁵¹ would be given to purely “functional” designs, whereas, aesthetic designs which satisfy the requirements for registration under the amended Registered Designs Act 1949 (U.K.) would receive a shorter period of protection of 25 years. In Singapore, this anomaly is cured, to a certain extent, by section 70 of the Copyright Act 1987 which limits the period of copyright protection to 15 years in the case of an artistic work of a “useful article” which has been industrially applied. Section 70 provides that:

“... the making of any useful article in three dimensions (including a reproduction in two dimensions reasonably required for the making of the article) does not infringe the copyright in an artistic work if, when the useful article or reproduction is made, the artistic work has been

48 Cap. 339, 1985 Rev. Ed.

49 See, for example, *Lau Foo Sun v. Govt. of Malaysia* [1974] 1 M.L.J. 28.

50 See section 15(3) of the Copyright Act 1987, Cap. 63, 1988 Rev. Ed.

51 See section 28(2) of the Copyright Act 1987, Cap. 63, 1988 Rev. Ed.

industrially applied in Singapore or in any other country more than 15 years before the useful article or reproduction is made.”

“Useful article” is defined as “an article having an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information”⁵² and also includes “an article that is normally part of a useful article.”⁵³

Another problem which has arisen is in relation to the overlap between registered design protection and the protection afforded by copyright to the design drawing in relation to designs which are registrable under the Registered Designs Act 1949 (U.K.) (as amended). Such designs would, *prima facie*, attract dual protection, namely, registered designs protection (if registered) and copyright protection. To avoid this overlap, the Copyright Act 1987 has complex and special provisions dealing with protection of industrial designs. Broadly speaking, the effect of these provisions is to compel the owner of the design to register the design under the Registered Designs Act 1949 (U.K.) (as amended) if the design is so registrable.⁵⁴ Section 74(1) of the Copyright Act 1987 deals with designs which have been registered under the Registered Designs Act 1949 (U.K.) or its amending Act⁵⁵. The broad effect of section 74(1) is that in respect of articles for which the design has been registered under the Registered Designs Act 1949 (U.K.) or its amending Act, it will not be copyright infringement to do anything during the subsistence of the registered design (that is, during the first 25 years from the date of registration of the design) which is within the scope of the registered designs protection⁵⁶. After the first 25 years, the bar to copyright protection extends to include all associated designs and articles⁵⁷ for which the design could have been registered.

⁵² See section 70(4) of the Copyright Act 1987, Cap. 63, 1988 Rev. Ed.

⁵³ See section 70(5) of the Copyright Act 1987, Cap. 63, 1988 Rev. Ed.

⁵⁴ See section 74 of the Copyright Act 1987 (Cap. 63, 1988 Rev. Ed.) for the provisions dealing with industrial design.

⁵⁵ Namely, the Copyright, Designs and Patents Act 1988 (U.K.).

⁵⁶ For example, the making of three dimensional articles from the design drawings. See section 73(2) of the Copyright Act 1987 which defines “scope of the copyright in a registered design” as meaning “the aggregate of the things, which, by virtue . . . of the United Kingdom Designs (Protection) Act, the registered proprietor of the design has the exclusive right to do. . . .”

⁵⁷ See section 73(2) of the Copyright Act 1987 which defines “all associated designs and articles” as meaning “the aggregate of the things which, by virtue of that written law, the registered proprietor would have had the exclusive right to do if — (a) when that design was registered, there had at the same time been registered every possible design consisting of that design with modifications or variations not sufficient to alter the character or substantially to affect the identity thereof, and the said proprietor had been registered as the proprietor of every such design; and (b) the design in question, and every other design such as is mentioned in paragraph (a), had been registered in respect of all the articles to which it was capable of being applied.”

Section 74(2) to (6) of the Copyright Act 1987 deals with designs which are registrable under the Registered Designs Act 1949 (U.K.) but which have not been so registered. If these designs have been industrially applied and articles to which the design has been so applied are commercially exploited (that is, in relation to the “relevant articles”), then for the first 15 years from the date of first commercial exploitation of such articles, there will be no copyright protection in respect of the design drawings for these relevant articles. After the expiry of the 15 year period, the loss of copyright protection again extends to include all associated designs and articles.⁵⁸

Thus, in relation to aesthetic designs which are registrable under the Registered Designs Act 1949 (U.K.) it would be advisable for the owner of such designs to apply for registration under the Registered Designs Act 1949 (U.K.), since copyright protection may be excluded in relation to the drawings of such designs.

V. LAW OF COPYRIGHT

A. *Types of Materials Protected by Copyright*

The law of copyright in Singapore is governed by the Copyright Act 1987 (hereinafter referred to as “the Act”) which came into force on the 10th April 1987.⁵⁹ This Act is based on the Australian Copyright Act 1968. The basic principles of copyright law in Singapore is similar to those in the United Kingdom and Australia. The Act provides protection for the following subject matter:

- (1) original literary work;
- (2) original dramatic work;
- (3) original musical work;
- (4) original artistic work;
- (5) sound recordings;
- (6) cinematograph films;
- (7) television broadcasts and sound broadcasts;
- (8) cable programmes;
- (9) published editions of works.

⁵⁸ See section 73(2) of the Copyright Act 1987, *ibid.*, for a definition of associated designs and articles.

⁵⁹ The position of copyright matters made before the 10th April 1987 are governed by the Imperial Copyright Act 1911 and the transitional provisions set out in Part XI of the Act. This article will focus its discussion on new works and new copyright subject-matter which were made after the Copyright Act 1987 (Cap. 63, 1988 Rev. Ed.) came into force.

Copyright, thus, protects both “authors’ work” (a term commonly used to refer to categories (1) to (4) above) and “entrepreneurial copyright” or “neighbouring rights” (a term use to refer collectively to the subject-matters referred to in categories (5) to (9) above). There is no formal registration requirement or any requirement for the work to be marked with a copyright claim in order to secure copyright protection in Singapore. Copyright exists automatically once the relevant connecting factors are satisfied, that is, if there is a sufficient connection between Singapore and the subject-matter claiming copyright in Singapore, in order to justify the grant of copyright protection in Singapore. It is worth noting, however, that copyright only protects the form of expression as oppose to the idea.⁶⁰ Thus, in order for copyright to subsist in a particular work or subject-matter, it must first be reduced into writing or some other material form.⁶¹

B. *The Connecting Factors*

In relation to unpublished “authors’ works”, the relevant connecting factors are set out in section 27(1) of the Act, namely, that the author of the work must be a qualified person at the time when the work was made. “Qualified person” is defined in section 27(4) as “a citizen of Singapore or a person resident in Singapore.” In the case of a published “authors’ work”, there are three alternative connecting factors which are set out in section 27(2) of the Copyright Act 1987:

- (a) if the first publication⁶² of the work took place in Singapore; or
- (b) if the author of the work was a qualified person at the time when the work was first published; or
- (c) if the author died before first publication, if the author was a qualified person immediately before his death.

⁶⁰ Compare this with the law of confidence which protects confidential ideas.

⁶¹ See section 16 of the Act.

⁶² Note that publication is defined in section 24 of the Copyright Act 1987. Section 24(5) also provides for simultaneous first publication, that is, a publication in Singapore will not be treated as being other than first publication by reason only of an earlier publication elsewhere, provided the two publications took place within a period of not more than 30 days of each other. See also *Television Broadcast Ltd. v. Mandarin Video Holdings Sdn. Bhd.* [1983] 2 M.L.J. 346.

The Act also sets out the connecting factors in relation to “entrepreneurial copyrights” as follows:

- (1) In the case of sound recordings there are three connecting factors set out in section 87 of the Act:
 - (a) if the maker of the sound recording was a qualified person⁶³ at the time when the recording was made;⁶⁴ or
 - (b) if the sound recording was made in Singapore;⁶⁵ or
 - (c) if the sound recording was first published in Singapore.⁶⁶
- (2) In relation to cinematograph films, section 88 sets out the connecting factors as follows:
 - (a) if the maker was a qualified person for the whole or a substantial part of the period during which the film was made; or
 - (b) if the film was made in Singapore; or
 - (c) if the first publication of the film took place in Singapore.⁶⁷
- (3) Television and sound broadcasts would have copyright in Singapore if it is made from a place in Singapore by the Singapore Broadcasting Corporation or the holder of a licence for a television station.⁶⁸
- (4) Copyright would subsist in a cable programme which is included in a cable programme service provided by a qualified person in Singapore.⁶⁹
- (5) In respect of published editions of the works, the connecting factors are set out in section 91(1) as follows:

“. . . copyright shall subsist in a published edition of a literary, dramatic, musical or artistic work, or of two or more literary, dramatic, musical or artistic works, where —

 - (a) the first publication of the edition took place in Singapore; or
 - (b) the publisher of the edition was a qualified person at the date of the first publication of the edition.”

⁶³ “Qualified person” is defined in section 81 of the Act as “(a) a citizen of Singapore, or an individual resident in Singapore; or (b) a body corporate incorporated under any written law in Singapore.”

⁶⁴ See section 87(1) of the Copyright Act 1987.

⁶⁵ See section 87(2) of the Act.

⁶⁶ See section 87(3) of the Act. Section 24(1)(c) defines publication of a sound recording as the supply (whether by sale or otherwise) to the public of “records embodying the recording or a part of the recording.”

⁶⁷ Section 24(1)(b) provides that: “a cinematograph film shall be deemed to have been published if, but only if, copies of the film have been sold, let on hire, or offered or exposed for sale or hire, to the public.”

⁶⁸ See section 89 of the Act.

⁶⁹ See section 90(1) of the Act.

Singapore is not at present a member of any of the Copyright Conventions. She has, however, recently acceded to the Convention Establishing the World Intellectual Property Organisation (“WIPO”) which came into force with respect to Singapore on the 10th December 1990.⁷⁰ This could be an indication that Singapore may join the Berne Convention. Singapore has, however, already made arrangements to extend copyright protection to several countries. Under sections 184 and 202 of the Copyright Act 1987, the Minister has powers to issue regulations extending the copyright protection provided under the Copyright Act 1987 to cover works and other subject-matters which emanate from foreign countries. The countries to which the Copyright Act 1987 has been applied are listed in the Schedule to the Copyright (International Protection) Regulations 1987. The countries listed so far are the United States of America,⁷¹ the United Kingdom of Great Britain and Northern Ireland⁷² and Australia.⁷³

Regulation 3(1) of the Copyright (International Protection) Regulations 1987 basically extends the copyright protection provided under the Copyright Act 1987 to literary, dramatic, musical, artistic works and editions of the works, sound recordings and cinematograph films which were first published (and in the case of sound recordings and cinematograph films if it is also made) in a country specified in the Schedule “in like manner as those provisions shall apply in relation to literary, dramatic, musical and artistic works and editions first published, and sound recordings and cinematograph films made or first published, in Singapore.”

Regulation 3 (3) provides that: “. . . the provisions of the Act relating to works and other subject matter shall apply in relation to persons who, at a material time, are citizens or nationals of a country specified in the Schedule in like manner as those provisions shall apply in relation to persons who, at a material time, are citizens of Singapore.”⁷⁴

⁷⁰ See WIPO Notification No. 149, of September 14, 1990.

⁷¹ See the Copyright (International Protection) Regulation 1987 which applied the Copyright Act 1987 to works and other subject-matter emanating from the United States.

⁷² See the Copyright (International Protection) (Amendment) Regulations 1987 and the Copyright (International Protection) (Amendment No. 2) Regulation 1987 which applied the Copyright Act 1987 to works and other subject-matter emanating from the United Kingdom.

⁷³ See the Copyright (International Protection) (Amendment) Regulation 1990 which applied the Copyright Act 1987 to Australian works and other subject-matter.

⁷⁴ See also regulation 3(4) which is a similar provision extending the Act in relation to works and other subject-matter to persons who, at a material time, are resident in a country specified in the Schedule. “At a material time” is defined in regulation 2(1) to mean: “(a) in relation to . . . a work or other subject-matter that is unpublished — (i) at the time when the work or other subject-matter was made; or (ii) if the making of the work or other subject-matter extended over a period — over a substantial part of that period; and (b) in relation to . . . a work or other subject-matter that has been published — at the time when the work or other subject-matter was first published.”

Copyright in the works and other subject-matter can, thus, be secured in Singapore where there is a sufficient domestic “Singapore” connection as discussed above; or where the works or other subject-matter were first published in the United States of America, the United Kingdom or Australia; or where the works or other subject-matter were made by persons who, at a material time, were citizens or nationals or residents of the United States of America, the United Kingdom or Australia. Regulation 6 of the Copyright (International Protection) Regulations 1987 (as amended) also accords retrospective protection to works first published in (i) the United States of America before the commencement of the Copyright Act 1987 (that is, before the 10th April 1987) and (ii) Australia on or after 1st May 1969 but before 10th April 1987.⁷⁵ No such provision exists in the case of United Kingdom works.⁷⁶

C. *Ownership of Copyright in Works and Other Subject-matter*

1. *Author’s Works*

As a general rule the ownership of the copyright in an “author’s work” will belong to the author of the work, that is, the person who gave the work its form of expression.⁷⁷ There are, however, exceptions where the copyright in the work does not vest in the author. These are as follows:

- (a) in relation to works made by journalist employees, section 30(4) provides that the copyright in the literary, dramatic or artistic work is split between the employer newspaper and the journalist employee, where the work is made for the purpose of publication in a newspaper, magazine or similar periodical by a journalist employee in pursuance of the terms of his employment. The employer newspaper would acquire the newspaper publication rights, that is, the right to publish the work in a newspaper, magazine or similar periodical and the right to reproduce the work for the purpose of such publication. All other rights would belong to the journalist employee.

⁷⁵ See Regulation 6 of the Copyright (International Protection) Regulations 1987 as amended and substituted by Regulation 2 of the Copyright (International Protection) (Amendment) Regulations 1990 as follows: “Regulation 6 of the Copyright (International Protection) Regulations 1987 ... is deleted and the following regulation substituted therefor: 6. Where a work was first published — (a) in the United States of America before 10th April 1987; or (b) in Australia (including its external Territories) on or after 1st May 1969 but before 10th April 1987, section 210 of the Act shall apply to the work as if, for the purpose of determining, for the purpose of that section, whether copyright subsisted in a work under the Copyright Act 1911 immediately before 10th April 1987, the work was first published in Singapore.” Difficulties have arisen regarding the interpretation of regulation 6 of the Copyright (International Protection) Regulations 1987. See Wei, *The Law of Copyright in Singapore* (1989) at pp. 77–79.

⁷⁶ For a discussion on copyright protection of old U.K. works, see Wei, *supra*, at pp. 79–94.

⁷⁷ See section 30(2) of the Act.

- (b) in the case of certain limited categories of commissioned artistic works, namely, a photograph, the painting or drawing of a portrait or the making of an engraving, section 30(5) provides that the copyright belongs to the commissioner (that is, the person who commissioned the taking of the photograph etc.) and not the author (that is, the person commissioned to do the work). However, section 30(5) also provides that “if the work is required for any particular purpose, that purpose shall be communicated to [the person commissioned to do the work] and that [person] shall be entitled to restrain the doing, otherwise than for that particular purpose, of any act comprised in the copyright in the work.” Section 30(5) thus, requires the particular purpose (if any) for which the work is required to be disclosed to the author and the author would then acquire a “right of veto” to restrain the doing of any act for non-commissioned purposes. The author of the work would not, however, acquire the copyright in the work but would acquire this limited “right of veto” in relation to non-commissioned purposes.⁷⁸
- (c) in relation to works made by employees these are dealt with in section 30(6) which provides that where a literary, dramatic, musical or artistic work is made by an employee in pursuance of the terms of his employment the copyright would vest in the employer.

2. *Entrepreneurial Copyrights*

The copyright in the “entrepreneurial copyrights” would usually vest in the entrepreneur. In the case of:

- (a) sound recording and cinematograph film, the copyright would vest in the maker of the sound recording⁷⁹ and cinematograph film⁸⁰ respectively.
- (b) television and sound broadcast, the copyright would belong to the Singapore Broadcasting Corporation for broadcasts made by it; in the case of broadcasts made by a licensed broadcasting station, the

⁷⁸ However, it is unclear as to the precise effect of the failure to inform the person commissioned of the particular purpose the work is required for. Such a failure to inform may amount to a breach of statutory duty or it may preclude the commissioner from relying on the section 30(5) exception and the copyright in the work may then vest in the author in accordance with the general rule.

⁷⁹ See section 97(2) of the Act. Section 16(3)(b) read together with section 16(3)(a) would define the “maker of the sound recording” as the person who owned the first record embodying the recording. This would normally be the recording company. Note section 97(3) in relation to commissioned sound recording, where the copyright belongs to the commissioner. There is no “right of veto” unlike section 30(5) discussed above.

⁸⁰ See section 98(2) of the Act. Section 98(3) contains provisions dealing with commissioned cinematograph film where the copyright in the commissioned cinematograph film is vested in the commissioner. Note also that there is no “right of veto” given to the person commissioned to make the film.

copyright subsisting in such broadcasts would belong to the relevant holder of the licence.⁸¹

- (c) cable programme, the copyright would belong to the person providing the cable programme service.⁸²
- (d) published editions of works, the copyright would belong to the publisher of the edition of the works.⁸³

D. *Duration of Copyright*

1. *Author's Works*

The copyright in a literary, dramatic, musical or an artistic work (other than a photograph) would continue to subsist for a period of the life of the author plus 50 years after the expiration of the calendar year in which the author died.⁸⁴ However, section 28(3) provides that if before the death of the author of a literary, dramatic or musical work:

- (a) the work had not been published;
- (b) the work had not been performed in public;
- (c) the work had not been broadcast;
- (d) the work had not been included in a cable programme; and
- (e) records of the work had not been offered or exposed for sale to the public;

then the copyright in the work would continue to subsist until the expiration of 50 years after the end of the calendar year in which any one of the stated events in (a)–(e), first occurred.⁸⁵

In the case of an engraving which has not been published before the death of the author, the copyright would continue to subsist until the expiration of 50 years from the end of the calendar year of its first publication.⁸⁶

In the case of a photograph, the copyright would continue to subsist until the expiration of 50 years from the end of the calendar year of its first publication.⁸⁷

⁸¹ See section 99 of the Act.

⁸² See section 100 of the Act.

⁸³ See section 101 of the Act.

⁸⁴ See section 28(2) of the Act.

⁸⁵ Thus, it would appear that if none of the stated events in (a)–(e) ever occurs then the copyright could be perpetual.

⁸⁶ See section 28(5) of the Act. Thus, if the unpublished engraving is never published, then the copyright may be perpetual.

⁸⁷ See section 28(6) of the Act. The effect of this sub-section would appear to be that if the photograph is never published, then the copyright subsisting in it may be perpetual.

2. *Entrepreneurial Copyrights*

The copyright in a sound recording would continue to subsist until the expiration of 50 years from the end of the calendar year in which the recording was first published.⁸⁸

In the case of a cinematograph film:

- (a) if the film acquired copyright in Singapore either by virtue of the fact that the maker of the film was a qualified person at the time when the film was made or if the film was made in Singapore, then copyright would continue to subsist in the film until the expiration of 50 years from the end of the calendar year of its first publication;⁸⁹
- (b) if the film acquired copyright in Singapore by virtue of the fact that its first publication took place in Singapore, then the copyright would continue to subsist until the expiration of 50 years from the end of the calendar year of its first publication.⁹⁰

In relation to television or sound broadcast, the copyright would continue to subsist until the expiration of 50 years from the end of the calendar year in which the broadcast was made.⁹¹

In the case of a cable programme, copyright would continue to subsist until the expiration of 50 years from the end of the calendar year in which the cable programme was first included in the cable programme service.⁹²

The copyright in a published edition of a work would continue to subsist until the expiration of 25 years from the end of the calendar year in which the edition was first published.⁹³

⁸⁸ See section 92 of the Act. It would also appear that copyright would be perpetual if the sound recording is never published.

⁸⁹ See section 93(1) of the Act. Again, the copyright would appear to be perpetual if the film is never published.

⁹⁰ See section 93(2) of the Act.

⁹¹ See section 94(1) of the Act. In relation to a repetition or re-broadcast of a previous television or sound broadcast, section 94(2)(a) provides that if the repetition was made before the expiration of the copyright in the original broadcast, then the copyright in the re-broadcast would continue to subsist for as long as the copyright subsists in the original broadcast. Section 94(2)(b) further provides that if the repetition was made after the expiration of the copyright in the original broadcast, then, there will be no copyright in the re-broadcast.

⁹² See section 95 of the Act.

⁹³ See section 96 of the Act.

E. *Copyright Infringement*⁹⁴

Once copyright is found to subsist in a work or other subject-matter, the Copyright Act 1987 gives the copyright owner certain exclusive rights. In relation to literary, dramatic or musical works, these exclusive rights are set out in section 26 (a) of the Copyright Act 1987 as follows:

- (1) to reproduce the work in a material form;
- (2) to publish an unpublished work in Singapore or any country to which the Act applies;
- (3) to perform the work in public;
- (4) to broadcast the work;
- (5) to include the work in a cable programme;
- (6) to make an adaptation of the work;
- (7) to do any of the acts stated in (1)–(6) above in relation to an adaptation of the work.⁹⁵

The exclusive rights given to “entrepreneurial copyrights” are as follows:

- (a) in relation to sound recording, the copyright owner gets the exclusive right to make a copy of the sound recording;⁹⁶
- (b) in relation to films, the copyright owner acquires the exclusive right to: (i) make a copy of the film; (ii) cause the film to be seen in public; (iii) broadcast the film; and (iv) include the film in a cable programme.⁹⁷
- (c) in relation to television and sound broadcast, the copyright owner has the exclusive right to: (i) make a cinematograph film of the broadcast, or a copy of such a film, in the case of a television broadcast insofar as it consists of visual images; (ii) make a sound

⁹⁴ Note the limitation period in respect of actions for copyright infringement provided in section 141 of the Act as follows: “An action shall not be brought for an infringement of copyright, after the expiration of 6 years from the time when the infringement took place.”

⁹⁵ The exclusive acts in relation to an artistic work are set out in section 26 (b) of the Act as follows: (i) to reproduce the work in material form; (ii) to publish an unpublished artistic work in Singapore or any country to which the Act applies; (iii) to include the work in a television broadcast; (iv) to include the work in a cable programme.

⁹⁶ See section 82 of the Act. Note, however, that although a sound recording has its own separate copyright, the music in the sound recording may also attract copyright as a musical work and the lyrics may also acquire copyright as literary work.

⁹⁷ See section 83 of the Act.

recording of the broadcast, or a copy of such a sound recording, in the case of a sound broadcast, or a television broadcast insofar as it consists of sounds; (iii) in the case of a television broadcast — to cause it insofar as it consists of visual images, to be seen in public, or, insofar as it consists of sounds, to be heard in public, by a paying audience; and (iv) in the case of a television or a sound broadcast — to re-broadcast it or to include it in a cable programme;⁹⁸

- (d) in relation to cable programmes these are analogous to those for television and sound broadcasts and are set out in section 85;
- (e) in relation to the published edition of a literary, dramatic, musical or artistic work, the copyright owner has the exclusive right “to make, by a means that includes a photographic process, a reproduction of the edition.”⁹⁹

Sections 31 and 103 provide that any person who does or authorises the doing of any of the exclusive rights stated above in relation to copyrighted works and other copyrighted subject-matters, respectively, without the consent of the copyright owner will be liable for copyright infringement. Thus, the copyright owner has the exclusive right not merely to do any of the acts comprised in the copyright but also to authorise the doing in Singapore of any of the acts comprised in the copyright. However, since copyright provides merely a partial monopoly, in that, it protects the copyrighted materials from copying; copyright infringement is, thus, dependent on the copyright owner establishing a causal connection between his copyrighted material and those of the alleged infringer. Coincidental similarity in the forms of expression *per se* is not copyright infringement.

Sections 32 and 33¹⁰⁰ of the Act contain provisions dealing with the importation of articles carried out for commercial purposes and commercial exploitation of ‘pirated’ copies of the articles, respectively. Section 32 of the Act seeks to control the unauthorised importation into Singapore of “pirated” articles of works, that is, articles which were made without the

⁹⁸ See section 84 of the Act.

⁹⁹ See section 86 of the Act. Note that the copyright in the published editions of Works are intended to protect the typographical format and layout of the works. Thus, merely writing out the novel will not infringe the publisher’s copyright in the published edition of the work, although it may infringe the author’s copyright in the novel as an original literary work.

¹⁰⁰ See also sections 104 and 105 of the Act for analogous provisions which apply to the other subject-matter of copyright.

consent of the copyright owner, carried out for commercial purposes.¹⁰¹ Section 33, on the other hand, seeks to control the commercial exploitation of “pirated” articles of works where the defendant knows or ought reasonably to know, that the making of the article constituted an infringement.

F. Defences

A brief discussion will be made on some of the defences available to copyright infringement.

1. The fair dealing defence provided in the Act. In order to raise this defence it must be shown that the dealing is fair and that it is done for the purpose of: (a) research or private study;¹⁰² or (b) criticism or review;¹⁰³ or (c) reporting of current events.¹⁰⁴
2. Sections 38 and 106 of the Act provides that the copyright in the “author’s works” or “entrepreneurial copyrights” respectively, are not infringed by anything done for:
 - (a) the purpose of a judicial proceeding or of a report of a judicial proceeding;

¹⁰¹ Section 32 of the Act provides that: “The copyright in a literary, dramatic, musical or artistic work is infringed by a person who, without the licence of the owner of the copyright, imports an article into Singapore for the purpose of— (a) selling, letting for hire, or by way of trade offering or exposing for sale or hire, the article; (b) distributing the article — (i) for the purpose of trade; or (ii) for any other purpose to an extent that will affect prejudicially the owner of the copyright; or (iii) by way of trade exhibiting the article in public, where he knows or ought reasonably to know, that the making of the article was carried out without the consent of the owner of the copyright.” Note that the section provides that “the making of the article was carried out without the consent of the owner of the copyright.” This term is ambiguous and creates uncertainty as to which “copyright owner” the section is referring to. Is it the copyright owner in the country of actual making of the articles or is it the copyright owner in Singapore? For a discussion on this point see Wei, “Parallel imports and intellectual property rights in Singapore,” (1990) 2 S.Ac.L.J. 286 at pp. 300–308. See also *Television Broadcasts Ltd. v. Golden Line Video & Marketing Pte. Ltd.* [1989] 1 M.L.J. 201.

¹⁰² See section 35 of the Act. This section also sets out the factors the courts take into consideration to determine when a dealing is fair. Section 109 also extends this defence to cover “audio-visual” items. “Audio-visual” items are defined in section 102 as “a sound recording, a cinematograph film, a sound broadcast, a television broadcast or a cable programme.” Section 116 of the Act extends the defence to cover published editions of works.

¹⁰³ See section 36 of the Act. Note that a sufficient acknowledgement of the work must be made. This is defined in section 7(1) in relation to works but there is no definition in relation to “audio-visual” items. Section 110 extends the defence to cover “audio-visual” items. “Audio-visual” items are defined in section 102, *ibid.* Section 116 also extends the defence to cover published editions of works.

¹⁰⁴ See section 37 of the Act. Note that a sufficient acknowledgement must be made if it is in relation to reporting of current events in a newspaper, magazine or similar periodical. Section 111 extends the defence to cover “audio-visual” items which is defined in section 102, *supra* note 102. Section 116 also extends the defence to cover published editions of works.

- (b) the purpose of seeking professional advice from an advocate and solicitor; or
 - (c) the purpose of, or in the course of, the giving of professional advice by an advocate and solicitor.
3. Section 69 of the Act sets out the “non-expert” defence in relation to artistic works. It provides that the making of an object of any kind in three dimensional form does not infringe the copyright in an artistic work that is in two dimensions, and the vice versa, if the object would not appear to persons who are not experts in relation to objects of that kind to be a reproduction of the artistic work.
4. Section 70 of the Act limits the period of copyright protection of an artistic work of a useful article to 15 years from when the artistic work was first industrially applied.¹⁰⁵
5. Section 39 provides a defence for the making of a back-up copy of a “genuine”¹⁰⁶ computer program if:
- (a) the back-up is made by or on behalf of, the owner of the “original copy” from which the back-up is made; and
 - (b) the back-up is made for the purpose only of being used, by or on behalf of the owner of the original copy, *in lieu* of the original copy in the event that the original copy is lost, destroyed or rendered unusable.

Section 39(3) further provides that “it is not an infringement for the owner of a copy of a computer program to make or authorise the making of another copy or adaptation of that computer program provided that such a new copy or adaptation is created as an essential step in the utilisation of the computer program in conjunction with a machine and that it is used in no other manner.”¹⁰⁷

6. Sections 44–50 of the Act contain provisions which deal with reproduction by libraries.

¹⁰⁵ See a more detailed discussion of this under the section entitled “Registered Designs Law”.

¹⁰⁶ That is, a computer program which is not an infringing copy.

¹⁰⁷ Section 17 of the Act provides that the storage of a work or an adaptation of the work in a computer will constitute reproduction of that work or of an adaptation of that work in material form. Unauthorised use would therefore, amount to copyright infringement under section 31 of the Act. Section 39(3) provides a defence to the above where the storage of the work in the computer is essential to the use of the program in the computer.

7. Special provisions are found in sections 51–53 of the Act which deal with educational institutions. Section 51 deals with multiple copying of insubstantial portions of works. Section 52 provides a complex statutory licence scheme which covers multiple copying of substantial portions of works by educational institutions.
8. Section 114 of the Act provides a private user defence in relation to the making of a cinematograph film or a sound recording of the broadcast or the cable programme for the private and domestic use of the person by whom the cinematograph film or sound recording is made.

Apart from the main statutory defences discussed above, there are also two main common law defences which may apply to copyright infringement. These are:

- (a) the spare parts defence of non-derogation from grant set out in *British Leyland v. Armstrong*.¹⁰⁸ It is doubtful whether such a defence would apply in Singapore in the light of section 70 of the Act.¹⁰⁹
- (b) the public interest defence which covers disclosures which have been made in the public interest.¹¹⁰

G. Remedies

These are provided in section 119 of the Act. The main remedies are injunction, damages or account of profits. The court also has power to award additional damages under section 119(4) of the Act and “just and equitable” damages under section 120 (b) of the Act. An order for delivery up of infringing copies of the copyrighted materials may also be made under section 120 (a). However, section 119(3) of the Act provides the defendant with a defence of innocence where he can establish that he was not aware, and had no reasonable grounds for suspecting that the act would constitute copyright infringement. This defence is not a defence to liability but a “defence to remedies” in that it will deprive the plaintiff of any damages for infringement but without prejudice to his right to sue for an account of profits or any other relief.

H. Criminal Offences

Apart from the civil liability for copyright infringement discussed above, the Act also provides that certain types of copyright infringement may also

¹⁰⁸ [1986] R.P.C. 279; [1986] 2 W.L.R. 400.

¹⁰⁹ See *Mono Pumps (N.Z.) Ltd. v. Karinya Industrial Ltd.* (1986) 7 I.P.R. 25 where the New Zealand court refused to follow the *British Leyland* case.

¹¹⁰ See, for example, *Lion Laboratories Ltd. v. Evans* [1984] 2 All E.R. 418; *A-G v. Guardian Newspapers Ltd. (No. 2)* [1988] 3 All E.R. 545.

amount to criminal offences.¹¹¹ These relate mainly to copyright infringement done for commercial purposes.

1. Section 136(1) of the Act provides that the manufacture for sale or hire; the sale or hire; the exhibition in public by way of trade; the importation into Singapore (otherwise than for private and domestic use) of any article which a person knows or ought reasonably to know to be an infringing copy of the work will amount to a criminal offence which is punishable on conviction by a fine not exceeding \$10,000 for the article or for each article in respect of which the offence was committed or \$100,000, whichever is lower, or to imprisonment for a term not exceeding 5 years or to both.
2. Section 136(2) makes it a criminal offence for a person to have in his possession for commercial purposes¹¹² any article which he knows or ought reasonably to know to be an infringing copy of the work. Such an offence is punishable on conviction to a fine not exceeding \$10,000 for the article or for each offending article or \$100,000, whichever is the lower, or to imprisonment for a term not exceeding 5 years or to both.
3. Section 136(3) makes it a criminal offence to distribute for trade purposes or for purposes which affect prejudicially the owner of the copyright, articles which a person knows or ought reasonably to know, to be infringing articles. This offence is punishable on conviction to a fine not exceeding \$50,000 or to imprisonment for a term not exceeding 3 years or to both.
4. Section 136(4) extends the criminal liability to cover the manufacture or possession of a plate or similar contrivance for the purpose of making infringing sound recordings or audio-visual productions where a person has actual or constructive knowledge that such a plate etc. is to be used for making infringing copies of the work. This offence is punishable on conviction to a fine not exceeding \$20,000 for each plate or contrivance or to imprisonment for a term not exceeding 2 years or to both.
5. Section 136(5) extends the penal provisions in subsections (1) to (4) to cover entrepreneurial copyrights.
6. Section 136(6) contains criminal provision dealing with the performance in public of a literary, dramatic or musical work, or the causing of a

¹¹¹ See Goh Phai Cheng, "Effective Enforcement of Copyright," (1990) 2 S.Ac.L.J. 91.

¹¹² That is, for the purpose of "(a) selling, letting for hire, or by way of trade offering or exposing for sale or hire, the article; (b) distributing the article for the purpose of trade, or for any other purpose to an extent that will affect prejudicially the owner of the copyright in the work; or (c) by way of trade exhibiting the article in public," see section 136(2) of the Act. See also section 136(7) of the Act which provides that ". . . any person who has in his possession 5 or more infringing copies of any work or other subject-matter shall . . . be presumed — (a) to be in possession of such copies otherwise than for private and domestic use; or (b) to be in possession of such copies for the purpose of sale."

cinematograph film to be seen and/or heard in public other than by the reception of a television broadcast or cable programme. Such acts if carried out for the private profits of the alleged infringer in circumstances where he knows or ought reasonably to know that copyright subsists in the work or cinematograph film and that the performance constitutes an infringement of the copyright would amount to an offence which is liable on conviction to a fine not exceeding \$20,000 or imprisonment for a term not exceeding 2 years or to both.¹¹³

7. Section 139(1) further extends the criminal liability to cover the advertisement for the supply of infringing copies of computer programs.¹¹⁴ This is subject to the proviso that there will be no liability if the alleged offender can prove that he acted in good faith and had no reasonable grounds for supposing that copyright infringement would take place. This offence is punishable on conviction to a fine not exceeding \$20,000 or to imprisonment for a term not exceeding 2 years or to both.

The criminal provisions are, thus, very wide and covers most types of commercial exploitation of infringing copies of works and other subject-matter of copyright protection.

VI. LAW OF REGISTERED TRADE MARKS

Trade marks can be protected in Singapore in two main ways, namely, under the common law tort of passing-off and under the registration system provided by the Trade Marks Act.¹¹⁵ In this section a discussion will be made on the protection given to trade marks which have been registered under the statutory system.¹¹⁶ The law of registered trade marks in Singapore is governed by the Trade Marks Act¹¹⁷ which was recently amended by the Trade Marks (Amendment) Act 1991¹¹⁸ which came into force on the 1st March 1991.¹¹⁹ The Trade Marks Act is based broadly on the Trade Marks Act 1938 (U.K.). Section 2 of the Trade Marks Act as

¹¹³ In relation to a person charged with any offence under section 136, it is worth noting that section 136(8) grants to the court power to order the delivery-up or destruction of any article which appears to the court to be an infringing copy and any plate or contrivance used or intended to be used for making infringing copies.

¹¹⁴ See also section 139(2) of the Act.

¹¹⁵ Note that section 53 of the Trade Marks Act, as amended, provides that: "Nothing in this Act shall be deemed to affect rights of action against any person for passing-off or the remedies in respect thereof."

¹¹⁶ The protection accorded to trade marks under the common law tort of passing-off will be discussed in the next section.

¹¹⁷ Cap. 332, 1985 Rev. Ed.

¹¹⁸ (No. 7 of 1991).

¹¹⁹ See the Trade Marks (Amendment) Act (Commencement) Notification 1991.

amended by section 2 (e) of the Trade Marks (Amendment) Act 1991 defines a “trade mark” as “. . . a mark used or proposed to be used in relation to goods or services for the purpose of indicating or so as to indicate, a connection in the course of trade between the goods or services and a person who has the right, either as proprietor or as registered user, to use the mark, whether with or without an indication of the identity of that person”.¹²⁰ As a result of the recent amendment to the Trade Marks Act, registration of a trade mark in Singapore is no longer confined to product marks but has also been extended to registration of service marks which *hitherto* were not registrable under the Trade Marks Act.¹²¹

A. Requirements for Registration of a Trade Mark

An application for the registration of a trade mark in Singapore, in Part A or Part B of the trade marks register, may be made by any person claiming to be the proprietor of a trade mark used or proposed to be used by him in Singapore.¹²² The applicant would have to prove, at the date of application for registration, that there has either been actual use or a *bona fide* intention to use the trade mark in Singapore in relation to the goods or services.¹²³ It is also necessary to specify the particular goods or services for which registration is sought,¹²⁴ since the statutory protection granted by the Act to registered trade marks only extends to such goods or services for which registration has validly been granted.¹²⁵

Sections 10 and 11 of the Trade Marks Act (as amended) set out certain conditions for the registration of trade marks in Part A and Part B of the Register in Singapore, respectively.

¹²⁰ Section 2(e) of the Trade Marks (Amendment) Act is based on the Trade Marks Act 1955 (Cth.) (Australia). There is, at present, uncertainty as to whether “retail services” would be registrable as “service marks” under the Act. In the United Kingdom, marks used in relation to “retail services” *per se* have been held not to be registrable as “service marks”. See *Dee Corporation plc. Applications* [1989] 1 F.S.R. 266. In Australia, however, it would appear that retail services may be registrable as service marks.

¹²¹ See the unamended definition of a “trade mark” under section 2 of the Trade Marks Act which confines the meaning of “trade mark” to “a mark used or proposed to be used in relation to goods”. See also *Aristoc v. Rysta* [1945] A.C. 68.

¹²² See section 12(1) of the Trade Marks Act (Cap. 332, 1985 Rev. Ed.), as amended by section 9 of the Trade Marks (Amendment) Act 1991 (No. 7 of 1991). See, for example, *Veb Filmfabrik Agfa Wolfen v. Agfa Aktiengesellschaft Fur Photofabrikation* (1958) 24 M.L.J. 207. Note also section 12(8)(b) (as amended) in relation to an application for the registration of a trade mark which is accompanied by an application for the registration of a person as a registered user of a trade mark. See below under “Registered Users.”

¹²³ See *Imperial Group v. Phillip Morris* [1982] F.S.R. 72. See also section 40 of the Trade Marks Act as amended by section 24 of the Trade Marks (Amendment) Act 1991, which contains provisions dealing with the non-use of a trade mark. See *Re: Arnold Palmer* [1987] 2 M.L.J. 681; *Macy’s Trade Mark* [1989] R.P.C. 546.

¹²⁴ See section 9 of the Trade Marks Act, as amended by section 6 of the Trade Marks (Amendment) Act 1991.

¹²⁵ See section 49 of the Trade Marks Act.

1. Part A: Trade Marks

The requirements for registration of a trade mark in Part A of the Trade Marks Register is provided in section 10(1) of the Trade Marks Act, as amended, as follows:

“A trade mark (other than a certification trade mark) registrable in Part A of the register shall contain or consist of at least one of the following essential particulars:

- (a) the name of a company, individual or firm represented in a special or particular manner;
- (b) the signature of the applicant for the registration or some predecessor in his business;
- (c) an invented word or invented words;
- (d) a word or words having no direct reference to the character or quality of the goods or services,¹²⁶ and not being according to its ordinary signification a geographical name or surname;
- (e) any other distinctive mark; provided that a name, signature, or word or words, other than such as fall within the descriptions in paragraph (a), (b), (c) and (d), shall not be registrable under this paragraph except upon evidence of its distinctiveness.”

“Distinctiveness” for the purposes of registration of a trade mark in Part A of the register has been defined in section 10(2) as amended,¹²⁷ to mean “if it is adapted to distinguish goods or services with which that person is or may be connected in the course of trade from goods or services in respect of which no such connection subsists. . .” In determining whether the trade mark is “adapted to distinguish” the Registrar or the court may have regard to both the inherent distinctiveness and factual distinctiveness of the trade mark.¹²⁸

It is worth noting that the proviso to section 10(3) of the Trade Marks Act which deems a trade mark registered in Part A of the United Kingdom register as distinctive for the purposes of the Singapore Trade Marks Act, has been deleted. This would thus, reflect Singapore’s status as an independent nation.

2. Part B: Trade Marks

The requirement for registration of a trade mark in Part B of the register is

¹²⁶ See section 41 (a) of the Trade Marks (Amendment) Act 1991 (No. 7 of 1991). See *Tobacco Importers v. Registrar of Trade Marks* [1976] 1 M.L.J. 250.

¹²⁷ See section 7 of the Trade Marks (Amendment) Act 1991.

¹²⁸ See section 10(3) of the Trade Marks Act, Cap. 332, 1985, Rev. Ed.

now contained in section 11(1) of the Trade Marks Act as amended by section 8 of the Trade Marks (Amendment) Act 1991 which provides that:

“A trade mark is registrable in Part B of the register if it is capable, in relation to the goods or services in respect of which it is registered or sought to be registered, of distinguishing goods or services with which the proprietor of the trade mark is or may be connected in the course of trade from goods or services in respect of which no such connection subsists either generally or, where the trade mark is sought to be registered or is registered subject to conditions or limitations, in relation to use subject to those conditions or limitations.”

Under the recent amendments, the criterion of requiring a minimum period of two years *bona fide* use of the mark in Singapore before the date of application for registration has been repealed. Further, it is no longer possible for the applicant to register the trade mark in Part B of the register in Singapore by relying solely on a registration of the trade mark in Part B of the United Kingdom register. In determining whether a trade mark is “capable of distinguishing” as aforesaid, the Registrar or the court may have regard to its inherent capability of distinguishing and its factual capability of distinguishing.¹²⁹

Although “distinctiveness” is a requirement for both Part A and Part B registration, it is generally accepted that “capable of distinguishing” which is the requirement for Part B registration requires a lower level of “distinctiveness” and would, thus, be more easily satisfied, than “adapted to distinguish” which is the higher “distinctiveness” requirement for Part A marks.

3. *Registered Users*

Apart from registration of a trade mark by the proprietor of the trade mark. The Trade Marks Act also contains provision dealing with the registration of licensees of the registered proprietor as “registered users”. These are found in section 30 of the Trade Marks Act (as amended). Section 30(1) provides, *inter alia*, that a person other than the proprietor of a trade mark *may* be registered as a registered user in respect of goods or services. The section does not make it mandatory to register a licensee as a registered user. However, one of the benefits of such a registration would be that the use of a trade mark by a registered user within the permitted

¹²⁹ See section 11(2) of the Trade Marks Act, as amended by section 8 of the Trade Marks (Amendment) Act 1991.

use would be deemed to be use by the registered proprietor.¹³⁰ Section 30(7) of the Trade Marks Act, as amended, however, provides that the Registrar may refuse registration under section 30 where the grant thereof would tend to facilitate trafficking in a trade mark.¹³¹ Further, section 30(8) requires the proprietor of the trade mark to maintain control over the use of the trade mark and the quality of the goods or services provided by the registered user. The particulars to be furnished to the Registrar for such registration are set out in section 30(5) (as amended).

B. Obstacles To Registration

The Trade Marks Act also contains certain provisions dealing with obstacles to registration.

1. Section 15 of the Trade Marks Act prevents the registration as a trade mark of “any matter the use of which would, by reason of its being likely to deceive or cause confusion or otherwise, be disentitled to protection in a court of justice, or would be contrary to law or morality, or any scandalous design.”¹³²
2. Section 23 of the Trade Marks Act (as amended), on the other hand, prevents the registration of a trade mark in respect of any (or any description of) goods or services which is identical with or nearly resembles¹³³ a trade mark belonging to a different proprietor which has *already been registered* in the trade marks register in respect of:
 - (i) (in the case of goods)—(a) the same goods; (b) the same description of goods; or (c) services or a description of services which are associated with those goods or goods of that description;¹³⁴
 - (ii) (in the case of services)—(a) the same services; (b) the same description of services; or (c) goods or a description of goods which are associated with those services or services of that description.¹³⁵

This is, however, subject to section 25 of the Trade Marks Act (as amended) which provides, *inter alia*, that in the case of an honest

¹³⁰ See section 30(2) and (3) of the Trade Marks Act as amended by section 18 of the Trade Marks (Amendment) Act 1991. This is useful particularly in relation to section 40 of the Trade Marks Act which deals with non-use and also in relation to section 15. See *Bostitch T.M.* [1963] R.P.C. 183; *Bowden Wire v. Bowden Brake* (1914) 31 R.P.C. 385.

¹³¹ See *American Greetings Card Case* [1984] 1 All E.R. 426. See also *Re: Arnold Palmer* [1987] 2 M.L.J. 681.

¹³² See *Ronuk Ltd. v. Sin Thye Hin & Co.* (1962) 28 M.L.J. 383.

¹³³ See section 2(4) of the amended Trade Marks Act which provides, *inter alia*, that references to a near resemblance of marks are references to a resemblance so near as to be likely to deceive or cause confusion.

¹³⁴ See section 23(1) of the Trade Marks Act (as amended).

¹³⁵ See section 23(2) of the Trade Marks Act (as amended).

concurrent use or other special circumstances, the Registrar or the court may permit the registration by more than one proprietor of trade marks which are identical or nearly resemble each other in respect of the same (or same description of) goods or services; or goods and services or descriptions of goods and services which are associated with each other.

3. Section 16(5) of the Trade Marks Act (as amended) prohibits the registration of a word which is the commonly used and accepted name of any single chemical element or compound as a trade mark in respect of a chemical substance or preparation.

It is worth noting, however, that the Registrar of Trade Marks has a discretion with respect to matters pertaining to the registration of a trade mark. Section 12(2) (as amended) provides that:

“Subject to the provisions of this Act, the Registrar may refuse the application or may accept it absolutely or subject to such conditions, amendments, modifications or limitations, as he may think right to impose.”

C. Trade Mark Infringement

1. Part A

The valid registration¹³⁶ of a trade mark in Part A of the register would give to the registered proprietor the exclusive right to the use of the trade mark in relation to the goods or services in respect of which the trade mark is registered. Section 45(1) as amended, provides that the registered proprietor can sue for trade mark infringement where there has been a use in the course of trade of a mark identical with or nearly resembling the registered trade mark in relation to any goods or services in respect of which registration has been obtained and such use is likely to be taken either:

- (a) as being use *as a trade mark* in relation to the goods or services in respect of which the trade mark is registered;¹³⁷ or
- (b) where the use is use upon the goods or in physical relation thereto or is use at or near the place where the services are available for

¹³⁶ Note that section 48(1) of the Trade Marks Act (as amended) provides that the registration of a trade mark in Part A of the register shall be taken to be conclusive after 7 years unless the original registration was obtained by fraud or unless the trade mark offends against section 15. This provision does not apply to a trade mark registered in Part B of the register. See section 48(3) of the Trade Marks Act, as amended by section 28 of the Trade Marks (Amendment) Act 1991.

¹³⁷ See section 45(1)(a) of the Trade Marks Act, as amended by section 26 of the Trade Marks (Amendment) Act 1991. See *British-American Tobacco Co. Ltd. v. Tobacco Importers & Manufacturers Ltd.* (1963) 29 M.L.J. 196; *Fraser & Neave Ltd. v. Yeo Hiap Seng Ltd.* [1982] 1 M.L.J. 122.

acceptance, or in an advertising circular or other advertisement issued to the public, *as importing a reference* to some person having the right either as proprietor or as registered user to use the trade mark or to goods or services with which such a person as aforesaid is connected in the course of trade.¹³⁸

2. Part B

The exclusive rights conferred on a registered proprietor of a Part B registered trade mark are similar to those of a Part A mark except that in relation to a Part B mark, section 46(2) of the Trade Marks Act provides that:

“no injunction or other relief shall be granted to the plaintiff if the defendant establishes to the satisfaction of the court that the use of which the plaintiff complains is not likely to deceive or cause confusion or to be taken as indicating a connection in the course of trade between the goods or services and some person having the right either as proprietor or as registered user to use the trade mark.”¹³⁹

D. Defences and Exceptions to Infringement¹⁴⁰

1. Limitations on the Register

The exclusive rights granted to a registered proprietor of a registered trade mark are subject to the conditions and limitations (if any) which have been entered on the trade mark register.¹⁴¹

2. Exhaustion of Rights

Section 45(3) of the Trade Marks Act (as amended) provides, *inter alia*, that the exclusive rights in a registered trade mark shall not be deemed to be infringed where:

- (a) in relation to goods connected in the course of trade with the proprietor or registered user, the registered proprietor or the

¹³⁸ See section 45(1)(b) of the Trade Marks Act, as amended by section 26 of the Trade Marks (Amendment) Act. In relation to trade mark infringement by importation of a reference, the use of a trade mark must be use in a “trade mark” sense. See *Bismag v. Amblins* [1940] 2 All E.R. 608.

¹³⁹ It would, thus, appear that the exclusive rights conferred on the registered proprietor of a Part B mark is less than that of a Part A mark. This is not surprising since it is easier to register a trade mark in Part B due to its lower requirement of distinctiveness than in Part A, thus, the extent of protection granted to a Part B mark would in turn be less.

¹⁴⁰ A brief discussion will be made on some of the main defences and exceptions to trade mark infringement.

¹⁴¹ See section 45(2) of the Trade Marks Act as amended by section 26 of the Trade Marks (Amendment) Act 1991.

registered user conforming to the permitted use has applied the trade mark and has not subsequently removed or obliterated it or has at any time, expressly or impliedly, consented to the use of the trade mark;

- (b) in relation to services to which the registered proprietor or registered user conforming to the permitted use has applied the trade mark, where the purpose and effect of the use of the trade mark is to indicate that those services have been performed by the registered proprietor or registered user or where the registered proprietor or registered user has at any time, expressly or impliedly, consented to the use of the trade mark.

Thus, the two main defences, based on the doctrine of exhaustion of rights, which can be raised in relation to trade mark infringement would be the “application defence” and the “defence of consent”.¹⁴²

3. *Component Parts*

Section 45(3)(c) of the Trade Marks Act (as amended) provides that the use of a trade mark in relation to goods or services adapted to form part of, or to be accessory to, other goods or services in relation to which the trade mark has been used without infringement, will not infringe the exclusive rights of the registered proprietor of the trade mark, if the use of the mark was reasonably necessary in order to indicate that the goods or services are so adapted, and neither the purpose nor the effect of the use of the mark is to indicate a connection in the course of trade between any person and the goods or services.

4. *Honest Use of One’s Own Name*

Section 52 (a) of the Trade Marks Act provides that:

“No registration of a trade mark shall interfere with — any bona fide use by a person of his own name or of the name of his place of business, or of the name or of the name of the place of business, of any of his predecessors in business”.

¹⁴² Difficulties have arisen, for example, in relation to the identity of the registered proprietor and also as to the identity of the trade mark which has been applied or whose use has been consented to. See *Revlon v. Cripps* [1980] F.S.R. 85; *Winthrop Products v. Sun Ocean* [1988] 2 M.L.J. 317; *Colgate-Palmolive Ltd. v. Markwell Finance Ltd.* [1988] R.P.C. 283; *Castrol v. Automatic Oil* [1983] R.P.C. 315. See also Wei, “Parallel Imports and Intellectual Property Rights in Singapore,” (1990) 2 S.Ac.L.J. 286 at pp. 314–322.

5. *Honest Use as a Description of Character or Quality of Goods or Services*

This is provided in section 52 (b) of the Trade Marks Act, (as amended) as follows:

“No registration of a trade mark shall interfere with — the use by any person of any bona fide description of the character or quality of his goods or services, not being a description that would be likely to be taken as importing any such reference as is mentioned in section 45(1)(b) or 68(2)(b).”

6. *Prior Use of the Trade Mark*

See the proviso to section 48(1) of the Trade Marks Act, as amended.

7. *Honest Concurrent User*

Section 45(4) of the Trade Marks Act (as amended) basically provides that the use of a trade mark registered under section 25 as honest concurrent use will not constitute an infringement of the right given to any other registered proprietor in respect of those trade marks.

E. *Duration*

Sections 32 and 34 of the Trade Marks Act (as amended) provide that the registration of a trade mark shall be for an initial period of 10 years which may be renewed for a period of 10 years from the expiration of the last registration of the trade mark.¹⁴³

F. *Criminal Offences*¹⁴⁴

1. Section 69(1) of the Trade Marks Act (as amended) provides that:

“If any person makes or causes to be made a false entry in the register, or a writing falsely purporting to be a copy of an entry in the register, or produces or tenders or causes to be produced or tendered in evidence any such writing, knowing the entry or writing to be false, he shall be guilty of an offence and shall be liable on conviction to a fine not exceeding \$50,000 or to imprisonment for a term not exceeding 5 years or to both.”

¹⁴³ It would thus, appear that the trade mark protection may be perpetual if the trade mark was renewed within the prescribed period upon expiry. This is, however, subject to the other provisions in the Act, for example, section 40 which relates to the non-use of a trade mark.

¹⁴⁴ The Trade Marks (Amendment) Act 1991 has recently increased the penalties for the criminal offences.

2. Section 69(2) of the Trade Marks Act (as amended) makes it an offence to falsely represent a trade mark as registered. This offence carries a penalty of a fine not exceeding \$10,000.
3. The counterfeiting of any trade mark used by any other person amounts to a criminal offence which is punishable on conviction to a fine not exceeding \$100,000 or to imprisonment for a term not exceeding 5 years or to both.¹⁴⁵
4. Section 72 of the Trade Marks Act (as amended) makes it a criminal offence for any person to make or have in his possession any instrument for the purpose of counterfeiting a trade mark, or have in his possession a trade mark for the purpose of denoting that any goods are the manufacture or merchandise of a person whose manufacture or merchandise they are not, or that they belong to a person to whom they do not belong. This offence is punishable by a fine not exceeding \$100,000 or to imprisonment for a term not exceeding 5 years or to both.
5. Section 73 of the Trade Marks Act (as amended) provides that the importation or sale etc. of any goods or thing which are marked with a counterfeit¹⁴⁶ trade mark or with a falsely applied registered trade mark will amount to a criminal offence unless the alleged offender can prove that:
 - (a) he had taken all reasonable precautions against committing such an offence and that at the time of the commission of the alleged offence he had no reason to suspect the genuineness of the mark and that he had, on demand by the prosecution, given all the information in his power with respect to the persons from whom he obtained the goods or thing; or
 - (b) he had acted innocently.

This criminal offence carries a penalty on conviction of a fine not exceeding \$10,000 for each goods or thing marked with the counterfeit trade mark or to which a registered trade mark has been falsely applied (but not to exceed in the aggregate \$100,000) or to imprisonment for a term not exceeding 5 years or to both.

6. The new section 73A of the Trade Marks Act (as amended) makes it a criminal offence to falsely apply¹⁴⁷ a registered trade mark to services

¹⁴⁵ See section 70 of the Trade Marks Act, as amended. "Counterfeiting of trade marks" is defined in section 71 of the Trade Marks Act.

¹⁴⁶ Section 71 of the Trade Marks Act defines what constitutes counterfeiting a trade mark.

¹⁴⁷ See also section 73B of the Trade Marks Act (as amended) which defines when a trade mark is deemed to be applied.

unless the alleged offender can prove that he had acted innocently. This criminal offence is punishable by a fine not exceeding \$100,000 or to imprisonment for a term not exceeding 5 years or to both.

7. The representation on a trade mark of the Arms or the Flag of Singapore or of any arms or devices so nearly resembling them as to be likely to deceive will amount to an offence under section 74(1) of the Trade Marks Act, unless such trade mark is authorised to be used by order of the President. Section 74(2) of the Act also extends the criminal liability to the importation, sale etc. of any goods or things to which a trade mark bearing any of the representation prohibited by subsection (1) is applied. Both these offences are punishable by a fine not exceeding \$50,000 or to imprisonment for a term not exceeding 5 years or to both and by the forfeiture of any goods to which the trade mark bearing the prohibited representation is applied.

It is interesting to note that the new section 73C of the Trade Marks Act (as amended) further provides for the forfeiture to the Government of all “offending”¹⁴⁸ articles or goods, upon conviction of an offence under any provision of the Trade Marks Act. This penalty is in addition to the punishment provided under the respective provisions of the Act.¹⁴⁹

VII. LAW OF PASSING-OFF

The law of passing-off in Singapore is based mainly on the English common law of passing-off. The basic principle of this tort is that “no man may pass off his goods as those of another”.¹⁵⁰ Passing-off is, however, no longer confined to deception as to the origin of goods. The tort of passing-off can basically take three different forms: (i) passing-off as to the origin of the goods or services;¹⁵¹ (ii) passing-off involving deception as to the quality of the plaintiffs own product¹⁵² and (iii) passing-off in cases of shared goodwill involving deception in relation to a class of goods produced by a group of manufacturers.¹⁵³ In the leading case of *Warnink v. Townend &*

¹⁴⁸ That is, “all articles or goods by means of which, or in relation to which, the offence was committed.”

¹⁴⁹ See also the new section 73D of the Trade Marks Act (as amended) on the jurisdiction of the courts to determine offences under the Act.

¹⁵⁰ *Per* Lord Oliver in *Reckitt & Colman Products Ltd. v. Borden Inc.* [1990] 1 All E.R. 873 at p. 880.

¹⁵¹ See, for example, *Reckitt & Colman Products Ltd. v. Borden Inc.* [1990] 1 All E.R. 873; *White Hudson v. Asian Organisation* (1965) 31 M.L.J. 186; *Malaysian Dairies v. Yakult* [1980] 1 M.L.J. 202.

¹⁵² See, for example, *Spalding v. Gamage* (1915) 32 R.P.C. 273.

¹⁵³ See, for example, *Warnink v. Townend* [1979] A.C. 731. It is worth noting that the Court of Appeal in *Bristol Conservatories Ltd. v. Conservatories Custom Built Ltd.* [1989] R.P.C. 455 (a case on “reverse passing-off”) appears to have accepted that passing-off could exist in formats other than the three main types stated above.

Sons (Hull) Ltd. (also commonly referred to as the *Advocaat* case) Lord Diplock formulated the five essential elements of the tort of passing-off as follows:

“My Lords, *A.G. Spalding & Bros. v. A.W. Gamage Ltd.* . . . and the later cases make it possible to identify five characteristics which must be present in order to create a valid cause of action for passing-off: (1) a misrepresentation (2) made by a trader in the course of trade, (3) to prospective customers of his or ultimate consumers of goods or services supplied by him, (4) which is calculated to injure the business or goodwill of another trader (in the sense that it is a reasonably foreseeable consequence) and (5) which causes actual damage to a business or goodwill of a trader by whom the action is brought or (in a *quia timet* action) will probably do so.”¹⁵⁴

The tort of passing-off can, thus, be said to consist basically of three essential elements:

- (1) the requirement of goodwill;
- (2) misrepresentation; and
- (3) the need to show damage or likelihood of damage.

A. *Goodwill*

The whole basis of the protection afforded by the law of passing-off is the protection of the goodwill in a trader's product or service. In order to succeed in an action for passing-off, the plaintiff must establish that he has goodwill in the relevant indicia of origin of the product or service and the goodwill must exist within the jurisdiction.¹⁵⁵ Goodwill has been defined as “the attractive force which brings in custom”¹⁵⁶ and has been said to have “no independent existence apart from the business to which it is attached.”¹⁵⁷ It can be found to subsist in the name, mark, label, logo or in the get-up of the product or service. However, it is well established that the law of passing-off does not protect the name, mark or get-up of a product or service *per se* but rather it protects the goodwill that subsists in these indicia of origin. These indicia of origin would, therefore, form the “badge

¹⁵⁴ [1979] A.C. 731 at p. 742. See *Haw Par Brothers International Ltd. v. Jack Chiarapurk* [1991] 2 M.L.J. 428, where these elements were cited by Chao Hick Tin J. These requirements have recently been restated by Lord Oliver in *Reckitt & Colman Products v. Borden Inc.* [1990] 1 All E.R. 873 at p. 880.

¹⁵⁵ See *Jordache v. Millennium* [1985] 1 M.L.J. 281.

¹⁵⁶ See *I.R.C. v. Muller & Co.'s Margarine Ltd.* [1901] A.C. 217 at p. 223.

¹⁵⁷ See *Star Industrial Co. Ltd. v. Yap Kwee Kor* [1976] F.S.R. 256 at p. 269. This passage was quoted by Thean J. in *Tan Gek Neo, Jessie v. Minister for Finance and Another* [1991] 2 M.L.J. 301.

of origin” by which the public associates the plaintiff’s product or service. One of the difficulties which has arisen in this area is in relation to the problem of the foreign trader and the requirement of goodwill within the jurisdiction. Will the tort of passing-off grant protection to the goodwill of a foreign plaintiff, which is attached to a business situated outside the jurisdiction of the courts? This question has given rise to two opposing lines of cases which have adopted two different schools of thought. The “hard line” school of thought which maintains that in order for the plaintiff to establish goodwill within the jurisdiction, it is essential for the plaintiff to have carried on business within the jurisdiction.¹⁵⁸ The “soft line” school, on the other hand, suggests that “something less than that will do.” It is unclear as to whether the judges in Singapore will subscribe to the “hard line” or “soft line” school of thought. There appears not to have been any case directly on point. The *dicta* from the recent cases appear to have gone both ways.¹⁵⁹

B. *Misrepresentation and Damage*

The law of passing-off protects the goodwill of a trader’s product or service only in so far as there is a misrepresentation which causes or is likely to cause damage to the trader’s goodwill. Thus, “A can compete with B by copying his goods provided that he does not do so in such a way as to suggest that his goods are those of B. Lawful competition will not be restricted by the common law.”¹⁶⁰ Thus, the plaintiff in a passing-off action would also have to show that the defendant has made a misrepresentation “to the public (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by him are the goods or services of the plaintiff”.¹⁶¹ Such a misrepresentation could, for example, be in respect of the origin of the goods or services, or a misrepresentation

¹⁵⁸ Difficulties have also arisen regarding the meaning of the term “business” within the jurisdiction.

¹⁵⁹ See *Tan Gek Neo, Jessie v. Minister for Finance and Another* [1991] 2 M.L.J. 301 where Thean J. appears to support the “hard line” school; *R.H. Macy & Co. Inc. v. Trade Accents* (1991) (Unreported), Originating Motion No. 2 of 1991 (Singapore), where Rubin J.C. approved of the decision of Leonard J. of the Hong Kong Supreme Court in *J. C. Penney Co. Inc. v. Punjabi Nick (otherwise Punjabi Narain)* [1979] F.S.R. 26, which was a case which appeared to support the “soft” line school of thought; *Haw Par Brothers International Ltd. and Another v. Jack Chiarapurk and Others* [1991] 2 M.L.J. 428 where Chao Hick Tin J. in his judgment referred to both *Star Industrial Co. Ltd. v. Yap Kwee Kor* [1976] F.S.R. 256 and *Metric Resources Corp. v. Leasematrix Ltd.* [1979] F.S.R. 571, which are cases generally referred to in support of the “hard” and “soft” line schools of thought, respectively. Note, however, that in the *Tan Gek Neo* and the *Macy*’s case, the court was not dealing with the law of passing-off. See Ng Siew Kuan, “Foreign Traders and the Law of Passing-off: The Requirement of Goodwill within the Jurisdiction,” [1991] S.J.L.S. 372.

¹⁶⁰ [1990] 1 All E.R. 873 at p. 890.

¹⁶¹ See *Reckitt & Colman Products Ltd. v. Borden Inc.* [1990] 1 All E.R. 873 at p. 880.

regarding the quality of the plaintiff's goods¹⁶² or a misrepresentation of a trade connection between the plaintiff and the defendant.¹⁶³ The test for determining the likelihood of deception is whether a reasonable member of the public would be so confused. It was not open to the defendant to argue that the members of the purchasing public would not have been so deceived had they been "more careful, more literate or more perspicacious."¹⁶⁴ "Customers have to be taken as they are found."¹⁶⁵ On the other hand, the fact that a "moron shopping in a hurry"¹⁶⁶ would be so deceived will not be sufficient. Each case would, therefore, have to be considered against "the background of the type of market in which the goods are sold, the manner in which they are sold, and the habits and characteristics of purchasers in that market."¹⁶⁷

A problem which has arisen in this area is in relation to whether or not a common field of activity is an essential pre-requisite to establishing the tort of passing-off. The current position appears to be that it is not an essential pre-requisite to establishing the tort of passing-off. However, it is very persuasive evidence in establishing the likelihood of deception or confusion as a result of the misrepresentation.¹⁶⁸

Finally, the plaintiff would also have to establish damage to his goodwill or in a *quia timet* action, that he is likely to suffer damage "by reason of the erroneous belief engendered by the defendant's misrepresentation that the source of the defendant's goods or services is the same as the source of those offered by the plaintiff."¹⁶⁹

VIII. LAW OF CONFIDENCE

The law of confidence protects a wide range of confidential information ranging from commercial and technical/industrial secrets to personal and governmental secrets. The law of confidence can thus, be used to protect

¹⁶² See *Spalding v. Gamage* (1915) 32 R.P.C. 273.

¹⁶³ See, for example, *McDonald v. Burger King* [1986] F.S.R. 45.

¹⁶⁴ See *Reckitt & Colman Products Ltd. v. Borden Inc.* [1990] 1 All E.R. 873 at p. 888.

¹⁶⁵ *Ibid.*

¹⁶⁶ See *per* Foster J. in *Morning Star Co-Operative Society Ltd. v. Express Newspapers Ltd.* [1979] F.S.R. 113.

¹⁶⁷ See *Reckitt & Colman Products Ltd. v. Borden Inc.* [1990] 1 All E.R. 873 at p. 888. See also *M.I. & M. Corp. v. Mohamed Ibrahim* (1964) 30 M.L.J. 392.

¹⁶⁸ Note, however, that where the name, mark etc. of the plaintiff's is so well-known, the courts may be prepared, even in the absence of the common field of activity, to extend the protection granted to the goodwill outside of the plaintiff's goods or services. See, for example, *Lego v. Lemelstrich* [1982] F.S.R. 155. See generally *Heublein v. Paterson* [1985] 1 M.L.J. 177.

¹⁶⁹ See *Reckitt & Colman Products Ltd. v. Borden Inc.* [1990] 1 All E.R. 873 at p. 880.

technological advances and valuable scientific and technological know-how.¹⁷⁰

The law of confidence in Singapore is not codified but is based to a large extent on the English common law. The English cases would be of great persuasive authority in Singapore given the general reception of English common law and rules of equity into Singapore as discussed above. There are no local decisions discussing the nature of the cause of action in breach of confidence. However, it is submitted that there are unlikely to be great divergences in the law in this area, barring one exception which relates to the court's jurisdiction to grant damages in actions for breach of confidence. The exception arises from the issue of whether the Singapore courts have jurisdiction to grant equitable damages in the absence of a Singapore equivalent to the English Lord Cairn's Act 1858, which gave the English courts the jurisdiction to grant damages *in lieu* of or in addition to an injunction.¹⁷¹ This problem will occur if the jurisdictional basis of the cause of action for breach of confidence is based on equity. It poses less of a problem if the jurisdictional basis of the law of confidence is contract or tort, since the Singapore courts have jurisdiction to grant damages at law for tort or breach of contract.

The elements for an action for breach of confidence were set out in the leading case of *Coco v. Clark* by Megarry J. as follows:

"In my judgment three elements are normally required if, apart from contract a case of breach of confidence is to succeed. First, the information itself . . . must 'have the necessary quality of confidence about it.' Secondly, that information must have been imparted in

¹⁷⁰ See generally, Gurry, *Breach of Confidence* (Oxford, 1984); Cornish, *Intellectual Property: Patents, Copyright, Trade Marks and Allied Rights* (2nd ed., 1989) chapter 8; Ricketson, *The Law of Intellectual Property* (1984), chapters 42–45; Ng Siew Kuan, "The *Spycatcher* Saga: Its Implications and Effect on the Law of Confidence," (1990) 32 Mal. L.R. 1.

¹⁷¹ See *Shiffon Creations (S'pore) Pte. Ltd. v. Tong Lee Co. Pte. Ltd.* [1988] 1 M.L.J. 363 where Thean J. held that the Singapore courts did not have the equitable jurisdiction conferred by Lord Cairns' Act to award damages in lieu of specific performance. See also Soh Kee Bun, "Jurisdiction to Award Equitable Damages in Singapore," (1988) 30 Mal. L.R. 79. Query whether the Court has inherent jurisdiction or jurisdiction independent of Lord Cairns' Act to award damages or equitable compensation. In *Shiffon Creations (S) Pte. Ltd. v. Tong Lee Co. Pte. Ltd.* [1991] 1 M.L.J. 65, the Court of Appeal was not inclined to express any firm view on this issue in the absence of fuller arguments. See, however, *Day v. Mead* [1987] 2 N.Z.L.R. 443 at p. 450, where Cooke P. in the New Zealand Court of Appeal was of the view that: "In this court it has been accepted that, independently of Lord Cairns' Act, damages or equitable compensation can be awarded for past breaches of a duty deriving historically from equity. . ." See also *Aquaculture Corp. v. New Zealand Green Mussel Co. Ltd.* (1990) 19 I.P.R. 527.

circumstances importing an obligation of confidence. Thirdly, there must be an unauthorised use of that information to the detriment of the party communicating it.”¹⁷²

A. *Quality of Confidence*

The law of confidence protects confidential information. In order for the information to be protected, it must “have the necessary quality of confidence about it, namely, it must not be something which is public property and public knowledge.”¹⁷³ It must also not be common knowledge, namely, the information must not be in the public domain. Once the information enters the public domain it will lose its confidentiality and will no longer be protected by the law of confidence. In *Mustad v. Allcock & Dosen* the House of Lords refused the plaintiff protection on the ground that the plaintiff’s confidential information had been completely disclosed to the world by virtue of the publication of its patent specification. As Lord Buckmaster stated: “The secret, as a secret, had ceased to exist.”¹⁷⁴ Thus, where the confidential information was put into the public domain by the owner of the confidential information himself or with his consent, the confidant is no longer bound by any duty of confidence. Information can be protected even if it is simple in nature. However, Megarry J. in *Coco v. Clark* expressed reservations against protecting “trivial tittle-tattle.”¹⁷⁵

B. *Relationship of Confidence*

The plaintiff in an action for breach of confidence must show that the confidential information was imparted in circumstances importing an obligation of confidence between the confider and the confidant. This is to be tested objectively from the perspective of the reasonable man. As Megarry J. in *Coco v. Clark* puts it:

“It seems to me that if the circumstances are such that any reasonable man standing in the shoes of the recipient of the information would have realised that upon reasonable grounds the information was being given to him in confidence, then this should suffice to impose upon him the equitable obligation of confidence.”¹⁷⁶

¹⁷² [1969] R.P.C. 41 at p. 47. It is worth noting that Megarry J. doubted whether there was a need to establish detriment in all cases in order for a plaintiff to succeed in an action for breach of confidence. The learned judge left this question open.

¹⁷³ See *Saltman Engineering Co. Ltd. v. Campbell Engineering Co. Ltd.* (1948) 65 R.P.C. 203 at p. 215.

¹⁷⁴ [1963] R.P.C. 41 at p. 43.

¹⁷⁵ See [1969] R.P.C. 41 at p. 48. The learned judge did not define the meaning of the term “trivial tittle-tattle”. Its exact meaning thus, remains uncertain.

¹⁷⁶ See [1969] R.P.C. 41 at p. 48.

Thus, the obligation of confidence is not dependent upon the existence of any contractual relationship or contractual terms. The prevalent view is that such an obligation of confidence can arise out of equity.¹⁷⁷

C. *Unauthorised Use and Detriment*

The plaintiff in an action for breach of confidence must also establish that the defendant had made unauthorised use of the plaintiff's confidential information, in that the information used must come from the plaintiff and is not from some independent source or by reverse engineering. Unauthorised use may consist "in any disclosure or use which contravenes the limited purpose for which the information was revealed"¹⁷⁸ or use of the plaintiff's confidential information without the plaintiff's express or implied consent.

It is unclear whether detriment is an essential pre-requisite which must be established in every action for breach of confidence. Megarry J. in *Coco v. Clark* left this issue open.¹⁷⁹

D. *Public Interest Defence*

Even if the plaintiff can establish all the elements of the action for breach of confidence, the court may still refuse the plaintiff relief if the defendant can show that the disclosure or publication of the plaintiff's confidential information was in the public interest. This defence of public interest can exist at different levels. Not every case of disclosure in the public interest will justify disclosure to the press. Thus, the defendant would have to establish not merely that the matter disclosed was a matter of public interest but also that the public interest justifies the extent and degree of disclosure which has taken place.¹⁸⁰

In summary, the plaintiff would succeed in an action for breach of confidence if the elements laid down in *Coco v. Clark* are satisfied provided:

- (a) the information is not in the public domain;

¹⁷⁷ See *A-G v. Guardian Newspapers (No. 2)* [1988] 3 All E.R. 545.

¹⁷⁸ See Cornish, *Intellectual Property: Patents, Copyright, Trade Marks and Allied Rights* (2nd ed., 1989) at p. 234.

¹⁷⁹ See [1969] R.P.C. 41 at p. 48. Note, however, that a distinction must be made between an action between private litigants in a private action for breach of confidence and a governmental action for breach of confidence. See *A-G v. Guardian Newspapers (No. 2)* (the *Spycatcher* case) [1988] 3 All E.R. 545.

¹⁸⁰ See *Francome v. Mirror Group Newspapers Ltd.* [1984] 1 W.L.R. 892; *A-G v. Guardian Newspapers Ltd.* [1988] 3 All E.R. 545. See also *Lion Laboratories Ltd. v. Evans* [1985] 1 Q.B. 526 where the Court of Appeal laid down guidelines on the application of the public interest defence.

- (b) the information is not mere “trivial tittle-tattle”;
- (c) the disclosure must not be justified in the public interest.

Although the law of confidence has been in existence for a long time, there are still many grey areas left. It is not possible in an article of this nature to provide a discussion on these grey areas.¹⁸¹ However, a brief mention will be made on the problem of indirect recipients of the confidential information, *bona fide* purchase of confidential information and the level of knowledge required for third party liability.

E. *Problems of Indirect Recipients*

The most common scenario is where A (the confider) discloses the confidential information to B (the confidant) and where B then in breach of confidence discloses the confidential information to C (the indirect recipient). The action by A against B for the breach of confidence has already been discussed above. The problem which has arisen is regarding the action by A against C, if any. The obligation of confidence, if any, owed by C to A would on principles of “good faith”¹⁸² depend on when C gained the necessary knowledge that the confidential information was disclosed to him in breach of confidence. Three main scenarios will be considered in this context.

- (a) *The position where C received the confidential information with knowledge that the confidential information was disclosed to him in breach of confidence.*

In this scenario where C, at the time of the receipt of the confidential information, had actual knowledge that the information was revealed to him in breach of confidence would be under an obligation of confidence to A. This obligation of confidence is imposed based on the bad faith of C at the time of receipt of the confidential information.

¹⁸¹ See generally, Ng Siew Kuan, “The *Spycatcher* Saga: Its Implications and Effect on the Law of Confidence,” (1990) 32 Mal. L.R. 1.

¹⁸² Although the jurisdictional basis of the law of confidence still remains an uncertain and controversial area in the law of confidence, there are five possible jurisdictional basis for an action for breach of confidence, namely, the contractual basis, tort/property approach, equitable principle of good faith, equitable property and *sui generis* approach. From the cases the courts appear to have borrowed from equity, contract, tort and property. The weight of current authorities would appear to support liability based on broad equitable principle of good faith. See Gurry, *Breach of Confidence* (Oxford, 1984); Ricketson, *The Law of Intellectual Property* (1984); Ng Siew Kuan, “The *Spycatcher* Saga: Its Implications and Effect on the Law of Confidence,” (1990) 32 Mal. L.R. 1 at pp. 33–40.

- (b) *The position where C received confidential information in the circumstances in which he ought to have known that the confidential information was disclosed to him in breach of confidence.*

In this situation where C received the confidential information in circumstances where he ought to have known that the confidential information was disclosed to him in breach of confidence, he will also be bound by an obligation of confidence to A. This obligation of confidence is imposed on C based on the “constructive bad faith” which he acquired at the time of receipt of the confidential information.

- (c) *The position where C who at the time of receipt of the confidential information received it innocently and without notice that the information was disclosed to him in breach of confidence.*

In this scenario, the principle generally is that C would be under an obligation of confidence to A from the moment C gains the necessary knowledge that the confidential information was disclosed to him in breach of confidence. This is so even though C was completely innocent at the time of receipt of the confidential information. The obligation of confidence owed by C to A would, therefore, crystallise at the moment C acquires the necessary knowledge of the breach of confidence.¹⁸³ In *Talbot v. General Television Corporation Pty. Ltd.*,¹⁸⁴ Harris J. expressed the view that the latest point in time in which C ought to have known that the information had been imparted to him in breach of confidence was at the time when the writ was issued.

F. *Bona Fide Purchaser for Value Without Notice Defence?*

There is, however, some uncertainty as to whether *bonafide* purchaser for value without notice is a defence to an action for breach of confidence.¹⁸⁵ If the basis of liability for imposing an obligation of confidence on the third

¹⁸³ See *Talbot v. General Television Corporation Pty. Ltd.* [1981] R.P.C. 1; see also *Wheatley v. Bell* [1984] F.S.R. 16 where the same principle was adopted in relation to a *bona fide* purchaser for value without notice. In *A-G v. Guardian Newspapers Ltd. (No. 2)* [1988] 3 All E.R. 545, the Court of Appeal and the House of Lords accepted this principle that the third party would be bound by an obligation of confidence to the “owner” of the confidential information from the moment the third party acquires the necessary knowledge that the information was disclosed to him in breach of confidence.

¹⁸⁴ [1981] R.P.C. 1. As to the degree of knowledge required, see below.

¹⁸⁵ In *A-G v. Guardian Newspapers Ltd. (No. 2)* [1988] 3 All E.R. 545, Sir John Donaldson M.R., *ibid.*, at p. 596, intimated that it might be a defence for an action for breach of confidence. However, no reasons were given in support of this view. See *Morison v. Moat* (1851) 9 Hare 241, for *dicta* on this defence. See also Jones, “Restitution of Benefits Obtained in Breach of Another’s Confidence,” (1970) 86 L.Q.R. 463; Law Commission (U.K.) (Law Com. No. 110), *Breach of Confidence*, Cmnd.8388, H.M.S.O., London (1981), paras. 6.53–6.54.

party is based on equitable principles of good faith, then the mere fact of *bona fide* purchase will not necessarily prevent the third party from acquiring the necessary knowledge of the breach of confidence at a later stage such as to taint his conscience in equity. However, this should not prevent the courts from taking “*bona fide* purchase” into account in deciding whether or not to grant injunctive relief. Detrimental change of position on the part of the defendant in the context of a reliance on a representation from the plaintiff, might generate a defence based on estoppel principles. In the absence of estoppel, it is unclear whether detrimental change of position coupled with a *bona fide* purchase is sufficient to operate as a defence to liability.

G. *Level of Knowledge Required by the Third Party*

Finally, a brief mention will be made on the level of knowledge required by a third party before an obligation of confidence will be imposed on him in categories (b) and (c) discussed above. In *Lipkin Gorman v. Karpnale Ltd.*,¹⁸⁶ Allott J. adopted the “*Baden* categorisation”¹⁸⁷ and set out the five categories of knowledge as follows:

“(i) actual knowledge; (ii) wilfully shutting one’s eyes to the obvious; (iii) wilfully and recklessly failing to make such inquiries as an honest and reasonable man would make; (iv) knowledge of circumstances which would indicate the facts to an honest and reasonable man; (v) knowledge of circumstances which would put an honest and reasonable man on inquiry.”¹⁸⁸

The question of the degree of knowledge required by a third party recipient of confidential information before an obligation of confidence will be imposed on him is a difficult one. Different views have been adopted in the different cases by different judges and writers on this area. The answer, at the end of the day, would appear to depend on the degree of notice or the level of knowledge required, such that it would be unconscionable for the third party recipient of the confidential information to make use of it. It is submitted that actual or constructive knowledge on the part of the third party recipient of confidential information that such information was imparted to him in breach of confidence may be sufficient. Thus, constructive notice of the facts [that is, level (iv) knowledge] may suffice to justify the intervention of equity.¹⁸⁹

¹⁸⁶ [1986] F.L.R. 271.

¹⁸⁷ See Peter Gibson J. in *Baden v. Societe Gen. du Commerce S.A.* [1983] B.C.L.C. 325 at p. 407.

¹⁸⁸ *Ibid.* at p. 283. This was also cited by May L.J. in the Court of Appeal in the *Lipkin Gorman* case [1989] F.L.R. 137 at p. 145.

¹⁸⁹ See Ng Siew Kuan, “The *Spycatcher* Saga: Its Implications and Effect on the Law of Confidence,” (1990) 32 Mal. L.R. 1 at pp. 72–76.

IX. PROTECTION OF COMPUTER PROGRAMS

A brief summary will be provided on the protection of computer software in Singapore. This discussion will focus on the law of patents and copyright.

A. Patent Protection of Computer Programs

An inventor seeking to patent a computer program would be faced with the hurdle posed by the bars to patentability set out in section 1(2) of the Patents Act 1977 (U.K.)¹⁹⁰ which specifically excludes a program for a computer “*as such*” from patentability. The issue which has arisen is as to the meaning and the width of the “*as such*” exclusion. If the claim for the patent is not for a computer program *per se* but for the technical effect which the computer program has on the hardware of the computer, then such a patent claim would probably not be caught by the exclusion to patentability and would slip through the “*as such*” gate since the patent would not be for a computer program *as such*. In *Burroughs’ (Perkins) Application*¹⁹¹ a patent claim which was directed towards a method of operating the computer in a new way was allowed by the Patent Appeal Tribunal. This was a decision under the Patents Act 1949. The position under the Patents Act 1977 is probably the same. The provisions of the Patents Act 1977 are drawn from the European Patent Convention 1973. The European Patent Convention equivalent to section 1(2) of the Patents Act 1977 is set out in Article 52. The European Patent Office in 1985 issued revised guidelines on, *inter alia*, the operation of Article 52. Under these guidelines it is clear that the bars set out in Article 52 [section 1(2) of the Patents Act 1977] only prevents the patenting of the excluded subject-matter *as such* and that if a computer program in combination with a computer causes the computer to operate in a different way from a technical point of view, that such a combination might be patentable.¹⁹² The emphasis on patentability would, thus, appear to be on the technical effect of the claimed invention, that is, whether the computer program has a new technical effect on the operation of the computer. If the claim includes a new ‘technical means’ or a new ‘technical result’ or some ‘technical contribution’ or ‘technical effect’, then it would not be caught by the section 1(2) exclusion since it would not be a claim for a computer program *as such*.¹⁹³ However, the Court of Appeal in *Merrill Lynch’s Application*¹⁹⁴ held that even if the claim had a new technical effect, it will

¹⁹⁰ See above under the section entitled “Law of Patents”.

¹⁹¹ [1974] R.P.C. 147.

¹⁹² See *Vicom Application* [1987] E.P.O.R. 66.

¹⁹³ See Chartered Institute of Patent Agents, *C.I.P.A. Guide to the Patents Act* (3rd ed., 1990) at pp. 5–9.

¹⁹⁴ [1989] R.P.C. 561.

still not be patentable if the end effect itself is an unpatentable subject-matter because it falls within the excluded subject-matter set out in section 1(2) of the Patents Act 1977 (U.K.). In the *Merrill Lynch* case itself, the Court of Appeal held that the claim was not a patentable invention since the new end effect of the claim was merely a ‘method of doing business’, which is itself an excluded subject-matter within section 1(2) of the Patents Act 1977 (U.K.).¹⁹⁵

Even if this hurdle is surmounted by the patentee a further difficulty which has arisen is whether or not the claim would be rejected if the requirement of patentability, namely, novelty and inventive step, resided solely in the excluded subject-matter, namely, the computer program *per se*. In the *Merrill Lynch’s* case,¹⁹⁶ Falconer J. held that it was necessary to show that the novelty and inventive step of the invention resided outside the excluded matter, that is, outside the computer program *per se*. Thus, the patentee of a computer program would have to show that the novelty and inventive step of the invention resided in the “non-excluded” part of the claim, that is, the part of the claim which took the computer program out of the “as such” exclusion, namely, the new technical effect of the claim. This reasoning of Falconer J. has been criticised by the Court of Appeal in *Genentech Inc.’s Patent*¹⁹⁷ and was also disapproved by the Court of Appeal in the *Merrill Lynch* case where the court held that in considering whether the invention was novel and inventive, the invention must be viewed “as a whole”. It is, therefore, immaterial whether the novelty and inventive step resided in the excluded matter or outside the excluded matter, so long as the invention as a whole was novel and inventive.

In summary, a computer program would not be caught by the “as such” exclusion under section 1(2) of the Patents Act 1977 (U.K.) if the claim is not for a computer program *per se*, that is, if it includes some new technical result or new technical means or effect. As long as this new technical result etc. itself is not an excluded subject-matter then the invention may be patentable provided the invention viewed as “a whole” satisfies the requirements of patentability set out in section 1(1) of the Patents Act 1977 (U.K.).

Apart from these theoretical problems in patenting a computer program, it

¹⁹⁵ It has been argued that the fact that the claim “involves a method of doing business” should no more create an automatic exclusion from patentability than should the fact that a computer program is involved. A business scheme, taking into account the technical process, when looked at as a whole could be a patentable subject-matter. It is not a method of doing business as such.” See Dworkin, “The Patentability of Computer Software,” in Reed (Ed.), *Computer Law* (1990) at p. 122.

¹⁹⁶ [1988] R.P.C. 1.

¹⁹⁷ [1989] R.P.C. 147.

is also worth noting that there would be practical difficulties in proving that computer programs are novel and inventive. Furthermore, patent law may not be the proper forum for protecting computer programs due to the cost and the length of time required in obtaining patent protection. This problem is particularly acute in relation to computer software where the technology changes so rapidly that it requires a faster method of protection. Therein lies the copyright alternative.

B. *Copyright Protection of Computer Programs*

Under the Copyright Act 1987 (hereinafter referred to as “the Act”), a literary work is defined to include “a computer program or compilation of computer programs.”¹⁹⁸ Thus, a computer program has specifically been provided protection as a form of literary work under the Act. A computer program is defined in section 7 (1) of the Act as meaning:

“an expression, in any language, code or notation, of a set of instructions (whether with or without related information) intended, either directly or after either or both of the following:

(a) conversion to another language, code or notation;

(b) reproduction in a different material form,

to cause a device having information processing capabilities to perform a particular function.”

In discussing copyright protection for computer programs, various matters need to be considered. First, source documents; these are preliminary materials which a computer programmer prepares to assist him in creating the computer program, for example, written instructions, flow charts and algorithms. Source documents would probably be protected as original literary or artistic works under the normal copyright principles and would not fall under the definition of a computer program literary work.

Second, source code program; this is a program written in human-readable high level computer language. Source code would probably be protected as a computer program literary work within the definition set out in section 7(1) of the Act.

Third, object or machine code program; this is the translation of the source code into a machine readable form, that is, a language which the computer is able to “understand” and execute. It is written in binary form. In *Computer Edge Pty. Ltd. v. Apple Computer Inc.*¹⁹⁹ the High Court of

¹⁹⁸ See section 7(1) of the Copyright Act 1987 (Cap. 63, 1988 Rev. Ed.).

¹⁹⁹ [1986] F.S.R. 537.

Australia by a majority held that object code programs embedded in the R.O.M. chips were not protected as original literary works since they were merely a series of electrical impulses which could not be perceived by human senses. However, in Singapore, object code programs may be encompassed within the definition of computer program stated above.²⁰⁰

Even if object code programs are protectable as computer program literary work under the Act, a problem likely to arise is in relation to the requirement of originality. This is so because the translation of source code into object code is done by another program known as the compiler. It appears that very little effort is required to convert the source code into the object code program. Would there be sufficient skill and effort to constitute originality?²⁰¹

Fourth, the “look and feel” of a computer program, namely, the appearance of the computer program on the visual display unit like the menu and user friendly icons. These may be protected as original literary or artistic work.²⁰²

Once the copyright is found to subsist in the computer program, the owner of the copyright in the computer program would acquire the exclusive rights as set out in section 26(a) of the Act.²⁰³ However, since copyright protects form of expression and not ideas, copyright infringement would occur only if the defendant has copied the plaintiff’s form of expression. This principle has caused some difficulties in relation to copyright infringement of computer program literary works. A distinction has to be made between idea and form of expression. In the United States decision of *Whelan Inc. v. Jaslow Dental Laboratories*²⁰⁴ the Court held that copyright infringement could occur even though there has been no literal copying of the program. The court was also of the view that the function or the purpose of a computer program was the idea and that all other matters which were not essential to the function would be the form of expression.²⁰⁵ In deciding whether the structure of a computer program would be

200 See also the wide definition of “computer program” in the Australian case of *Autodesk v. Dyason* (1990) 18 I.P.R. 109; *Star Micronics Pty. Ltd. v. Five Star Computers Pty. Ltd.* (Unreported, No. VG 174/89, October 9, 1990) cited in Ch’ang, “Autodesk Revisited: Copyright Protection for Computer Programs in Australia,” [1990] I.P. Asia 2 at p. 6 note 8, where the author stated that Davies J. confirmed that object code in a R.O.M. chip was a computer program within the definition of the Australian Copyright Act 1968.

201 See Wei, “Software protection laws in Singapore”, [1990] Computer Law & Practice 59.

202 However, it would have to satisfy the requirements of originality and “material form” as set out in section 16 of the Act.

203 See above at note 95.

204 [1987] F.S.R. 1.

205 See Rang, “Singapore: Copyright Protection Against ‘Look-and-Feel-Alike’ Programs,” [1990] I.P. Asia 10.

protected as part of the form of expression, the court put forward the “functionality test”, namely, that the structure of the program would be protected as part of the form of expression if it is not essential to the function. Thus, if there are several ways of achieving the same function or purpose, then the means (that is, structure) chosen for achieving that function or purpose would not be essential to the function of the program and would therefore, be protected as the form of expression and not the idea of the work. The court, therefore, held that the structure was not essential to the function of the program, which was to assist in the efficient management of the dental business, since there were various program structures which could have performed the same function.²⁰⁶ If Singapore follows the reasoning in the *Whelan* case, then computer program structure may be protectable as part of the form of expression of the program. The function of the program would be unprotected as belonging to the realm of idea.

A different approach on computer program function was taken in the Australian case of *Autodesk v. Dyason*. At first instance, Northrop J.²⁰⁷ held that in deciding whether there was objective similarity between the two programs for the purpose of determining copyright infringement, the similarity in the function or purpose of the program could be taken into account. Thus, Northrop J. appeared to be of the view that the copying of the function of a program would constitute copyright infringement. The learned judge, thus, appeared to have blurred the distinction between idea and form of expression, since if the function of a program relates to the idea, then the reproduction of the function of a program would merely amount to a reproduction of the idea and not the form of expression. The Federal Court of Australia²⁰⁸ has overturned the decision of Northrop J. and held that similarity in the function of a program was immaterial to the issue of copyright infringement. Copyright protects form of expression and not idea, thus, mere similarity in the function (that is, idea) of a computer program would not be sufficient to constitute copyright infringement. The court concluded that there was no copyright infringement since there was no objective similarity in the form between the Auto-Key device (the alleged infringing device) and the AutoCAD (Widget C/Hardware) lock and that mere similarity in the function alone was insufficient.²⁰⁹

Apart from the “usual” exclusive rights given to a copyright owner in

²⁰⁶ The difficulty in adopting this test is in the definition of the term “function of a program.”

²⁰⁷ (1989) 15 I.P.R. 1.

²⁰⁸ (1990) 18 I.P.R. 109. See Ch’ang, “Autodesk Revisited: Copyright Protection for Computer Programs in Australia,” [1990] I.P. Asia 2.

²⁰⁹ Note, however, that an appeal has been made to the High Court of Australia.

relation to literary works, in the case of a computer program literary work, the Act also provides that the storage of the work or adaptation²¹⁰ in a computer will also constitute copyright infringement.²¹¹ However, section 39(3) of the Act provides a defence where the storage of the work or adaptation in a computer is created as an essential step in the utilisation of the computer program in conjunction with a machine.²¹²

Finally, it is worth noting that Singapore is looking into legislation to protect semiconductor chips, namely, design of electronic circuitry. At present, the drawings of the circuit design may be protected as original artistic works. However, particular attention should be paid to the non-expert defence provided in section 69 of the Act.²¹³

X. CONCLUSION

The intellectual property system is not really a system in the sense that its various branches have been properly thought out in advance and inter-linked with one another. The various intellectual property rights were evolved at different times in response to differing needs. Underlying the various rights are many broad public policy considerations including: privacy, the need to protect economic interests, the desire to promote fair competition, the need to encourage innovation and the societal interest against abuse of dominant positions. Not surprisingly, the various branches of intellectual property law do not always fit neatly with each other. For example, in the field of copyright and registered designs protection overlaps can occur. Although the various branches of intellectual property law subsist independent of one another, it should be noted that multiple rights can, of course, be asserted in any given subject-matter. Thus, for example, copyright and the law of confidence can both be asserted in a particular confidential work; patents and the law of confidence may also be asserted in a new and confidential invention. However, in the latter example, difficulties may occur since once the invention has been patented, the information in the patent specification and the patent claim would no longer be confidential since it would already be information which is in the public domain. However, the know-how which has not been disclosed in the patent documents and which cannot be discovered by

²¹⁰ Note also that the "adaptation" right in relation to a computer program is provided in section 7(1) of the Copyright Act 1987 as meaning "a version of the work (whether or not in the language, code or notation in which the work was originally expressed) not being a reproduction of the work."

²¹¹ See sections 17, 26 and 31 of the Copyright Act 1987; see also note 107 above.

²¹² See note 107 above. Note also the statutory back-up right given to purchasers of a genuine copy of a computer program in section 39(1) of the Copyright Act 1987.

²¹³ See the section on defences under "Law of Copyright" discussed above.

reverse engineering may still have the necessary quality of confidence and thus, be protected by the law of confidence.²¹⁴

Difficult issues have also arisen in relation to the protection of new technologies, for example, in relation to computers and semiconductor chips. Another area of concern is innovation in the field of bio-technology. Thus far, the approach of the law has been to fit these technological developments within the existing intellectual property framework. The effectiveness of this approach is debatable. For example, problems arise in fitting computer programs into patent and copyright law. Patent protection would appear to be inadequate as it is too costly and takes too long a time for a patent to be granted. In any event only computer programs which have a definite technical effect on the hardware are patentable. The protection of computer programs as original literary work under copyright law has also given rise to difficult issues which have been discussed above. It is uncertain whether the protection of computer programs under the umbrella of copyright law is indeed the best method of protection or whether computer programs should be afforded its own regime of protection. In the case of semiconductor chips, artistic copyright protection may be asserted in the circuit design drawing and thus, afford protection under copyright law. However, this form of protection is unsatisfactory, for example, because of the existence of the “non-expert” defence which may defeat a copyright claim in relation to artistic work. It appears that Singapore may be introducing legislation to provide new intellectual property rights for the protection of semiconductor chips.

However, these problems are, of course, not unique to Singapore since the protection of intellectual property rights in Singapore is based to a large extent on the English and the Australian intellectual property system. In the light of the rapid advance in technological and scientific development, new challenges are constantly posed in the field of intellectual property law. It is therefore, ultimately for the courts and Parliament to respond to these new changes in this evolving field of law.

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²¹⁴ Even if the “know-how” can be reverse engineered, spring board principles can still be used to protect the “know-how” against defendants who seek to by-pass reverse engineering.

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