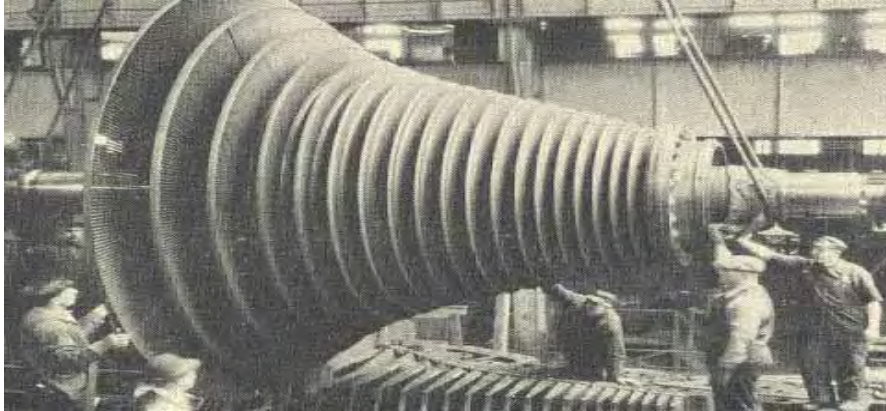


Intellectual Properties: For Div 1



Dr Daniel Theyagu

1

Intellectual Properties: Division One

Intellectual Property rights is not a subject that is easily understood. For many inventors, writers, artists, computer programmers, designers, movie makers and music composers and possibly individuals like you and me, intellectual property rights are a mean of living.

Even if you do not own your own IP, it is necessary for you to understand the merit in which the system is based so that you do not wittingly or unwittingly infringe upon another person's IP. In this intensive two day workshop you will learn the basic principles of patents, trademarks, registered designs and copyright.

Amongst under things you will learn:

- How to go about protecting your rights under the IP law in Singapore and globally
- When you need patents, trade marks or copyright in business
- How to exploit or use your patents, trade marks or copyright to make money in the global marketplace.
- How to go about the procedures involved in protecting and checking the IP status of other products and services
- How to ask for permission to use other people IP.



This workshop is carefully planned for Engineers and people working in the technical line to give them an effective working knowledge of Industrial designs and the copyright that goes with it.

2

Introduction to Intellectual Property Law

Not so long ago, intellectual property was a relatively narrow and unimportant area of law. This is no longer true today. The rise of a technologically advanced and information-driven global economy has created new ways of generating wealth. Much of this new wealth is in the form of intellectual property.

For example, one of the world's largest companies today is Microsoft, which produces computer software. Microsoft's wealth is based primarily on the software it develops. In turn, computer software is in the form of property protected by the intellectual property system. It follows that, in our age of rapid technological progress, an understanding of the legal framework for intellectual property protection is necessary for business professionals.



Some examples...

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What is Intellectual Property?

Intellectual property (IP) is a product of creativity an intellectual effort. Just like physical goods, intellectual property can be protected against theft by other people.

The owner of intellectual property has certain exclusive rights recognized by law for him to control or exploit them through licensing or franchising .

IP rights are intangible rights recognized by law and they are the assets of the company which can be bought, sold or transferred.

They, however need to be protected.

IP rights include patents, trade marks, service marks, registered designs, copyright and confidential information.

Patent protects ideas. The rights of trade marks, service marks protects logos, names and the get-up (the appearance) used for identifying the business products and services, e.g the famous golden arch "M" of McDonald's.

Copyright protects any form of the expression but not the ideas. Design rights are quite similar to copyright. They protect the form and appearance of a design and not its ideas.

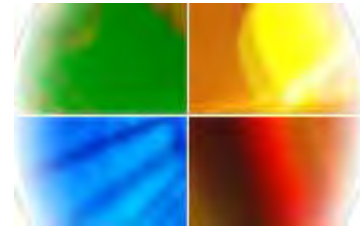
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About WIPO

<http://www.wipo.int/>

The World Intellectual Property Organization (WIPO) is an international organization dedicated to promoting the use and protection of works of the human spirit. These works - intellectual property -- are expanding the bounds of science and technology and enriching the world of the arts. Through its work, WIPO plays an important role in enhancing the quality and enjoyment of life, as well as creating real wealth for nations.

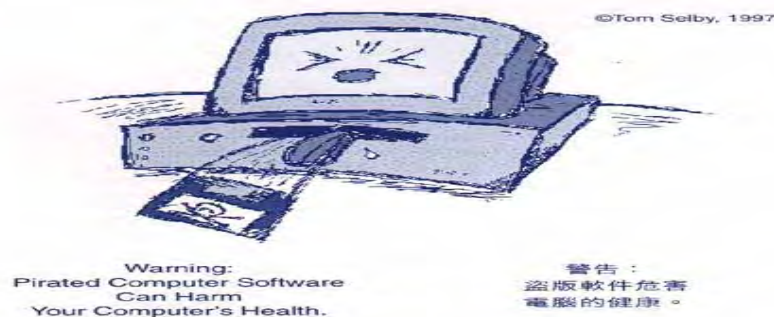
With headquarters in Geneva, Switzerland, WIPO is one of the 16 specialized agencies of the United Nations system of organizations. It administers 23 international treaties dealing with different aspects of intellectual property protection. The Organization counts 182 nations as [member states](#).



5

Intellectual Property Protection

Intellectual Property (IP) laws primarily seek to balance two competing interests. On the one hand, to encourage creativity and technical innovation, entrepreneurs, authors and inventors must be given legal protection over the fruits of their intellectual effort. An engineer who invents a new internal combustion engine should be allowed to obtain a patent which grants him a monopoly on the manufacture and sale of the engine for a specific period. This will enable him to generate sufficient financial returns for his effort.



On the other hand, the protection given must not stifle competition in the economy. Otherwise, the protection given will rise to monopolies. In other words, at some stage other persons must be given the right to use the new technology since this will encourage competition and benefit the community as a whole. This is delicate balancing of competing interests underlies much of the evolution of IP law.

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In recent years, Singapore has bolstered its intellectual property protection system significantly. This is partly due to the recognition that an acceptable intellectual property protection framework is a necessary pre-condition for the nation's push towards innovation, knowledge-based industries and attaining a high level of technological research and development.



For your own notes:

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COPYRIGHT

Copyright protects works like novels, software programs, plays, sheet music and paintings. Generally, the author of a copyright work has the right to reproduce, publish, perform, communicate and adapt his work. These rights enable him to control the commercial exploitation of his work.

Copyright is a form of property. It can be licensed or assigned, either as an individual right (e.g. the right to reproduce) or in a bundle (all the rights an author owns in his work).

For a work to be protected by copyright, it has to be original and fixed, or expressed in a tangible form such as in a recording or in writing. Originality simply means that there is a degree of independent effort in the creation of the work. It is not a question of whether the work has creative value or not.

Note: *Copyright protects the expression of ideas such as in words and illustrations. Ideas alone are not protected.*



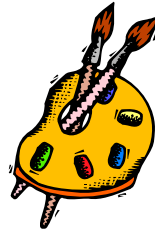
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COPYRIGHT

Works Protected by Copyright

The Law of Copyright protects the following:

1. **Literary works**
2. **Dramatic works**
3. **Musical works**
4. **Artistic works**



Protection also applies to other works like films, sound recordings, broadcasts, cable programmes, performances and published works (often referred as **neighbouring** or **related rights**).



AUTOMATIC PROTECTION

In Singapore, copyright protection is automatically conferred on the author from whom the work originates, as soon as a work is created and fixed in a material or tangible form. Thus, an author of a work does not need to be file for registration to get copyright protection.

As long as the work is independently created, it has copyright protection. However, if two separate works, based on the same idea, are created independently, there would be copyright in each independent work.

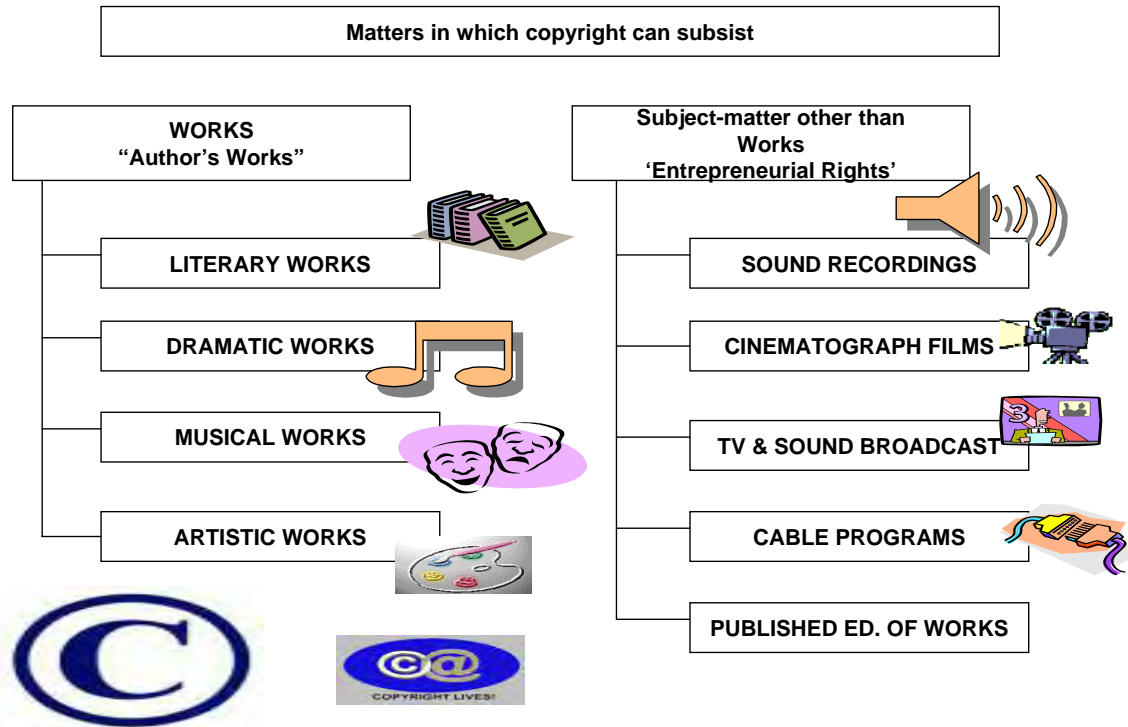
Overseas Protection for Copyright Works Created in Singapore

Generally, a copyright work created by a Singapore citizen or resident is protected overseas by virtue of an international convention (Berne Convention for the Protection of Literary and Artistic Work) and agreement signed by countries (The Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS Agreement) (1994) of the World Trade Organization).

International conventions and agreements obligate the member countries and WTO member countries (including Singapore) to grant uniform protection for copyright works. This means that the protection of a work of a Singapore resident would be protected as though the work was made in those countries. Some countries such as Canada and the US provide for registration to facilitate proof of copyright in infringement proceedings



COPYRIGHT



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How do I get permission to use somebody else's work and other subject matters?

You can contact the right owner. For certain types of works and other subject matter, you can get permission from a collective management organization. Collective management organizations license use of works and other subject matter that are protected by copyright and related rights whenever it is impractical for right owners to act individually. There are several international non-governmental organizations that link together national collective management organizations.

How much of someone else's work can I use without getting permission?

Under most national copyright laws, it is permissible to use limited portions of a work, including quotes, for purposes such as news reporting and private personal use. For further information see the national legislation available in the Collection of Laws for Electronic Access (CLEA).

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Is computer software protected by copyright?

In the 1970s and 1980s, there were extensive discussions on whether the patent system, the copyright system, or a *sui generis* system, should provide protection for computer software. These discussions resulted in the generally accepted principle that computer programs should be protected by copyright, whereas apparatus using computer software or software-related inventions should be protected by patent.

Copyright law and patent law provide different types of protection. Copyright protection extends only to expressions, and not to ideas, procedures, methods of operation or mathematical concepts as such, whereas a patent is an exclusive right granted for an invention, which is a product or a process that provides a new way of doing something, or offers a new technical solution to a problem. Copyright protection is formality-free in countries party to the Berne Convention for the Protection of Literary and Artistic Works (the Berne Convention), which means that protection does not depend on compliance with any formalities such as registration or deposit of copies. A patent is generally granted after completing an examination procedure by a government agency. Copyright protection of computer software is established in most countries and harmonized by international treaties to that effect. The law relating to the patentability of software is still not harmonized internationally, but some countries have embraced the patentability of computer software and others have adopted approaches that recognize inventions assisted by computer software.

In view of the complexity of these matters, it is recommended that you contact a practicing lawyer who is specialized in intellectual property or the intellectual property offices of those countries in which you are interested to get protection. You can find a list of URLs and a directory of national and regional intellectual property offices on our Website.

Is a television format protected by copyright?

Broadcasting organizations are protected as holders of related rights under the International Convention for the Protection of Performers, Producers of Phonograms and Broadcasting Organizations (Rome Convention). Broadcast content as such, as opposed to broadcast signals, can also be protected by copyright and related rights, depending on the national legislation. Television formats, however, have not been discussed at WIPO as subject of a separate international protection.

Is a character protected by copyright?

A character could be protected under copyright if it is an original expression of an author. Merchandising items such as toys, interactive games, books and clothing including characters can also be protected by intellectual property rights in certain circumstances, mainly copyright and trademarks, along with other areas of law.

Is a name, title, slogan or logo protected by copyright?

Copyright may or may not be available for titles, slogans, or logos, depending on whether they contain sufficient authorship. In most circumstances copyright does not protect names.

What is the rule concerning copyright and related rights in my country?

While in some countries treaties are “self-executive”, meaning that the provisions of treaties can be directly applied as law, in general copyright and related rights are provided in national legislation of individual countries. International treaties link various national laws by ensuring that at least a minimum level of rights will be granted to creators under each national law. The treaties do not themselves grant rights, but rather require the countries that join the treaties to grant certain rights specified on a nondiscriminatory basis. Copyright laws of a wide range of countries can be consulted from the Collection of Laws for Electronic Access (CLEA) database of WIPO. For further information, you can also contact national copyright administrations.

I have a problem with my copyright. Can you give me a legal advice?

WIPO is an intergovernmental organization, which administers a number of international treaties in the field of intellectual property, and may, at their request, advise governments. WIPO has, however, no mandate to give legal advice to private persons or non-governmental bodies or entities. For advice concerning specific matters, it is recommend that you consult a practicing lawyer who is specialized in intellectual property.

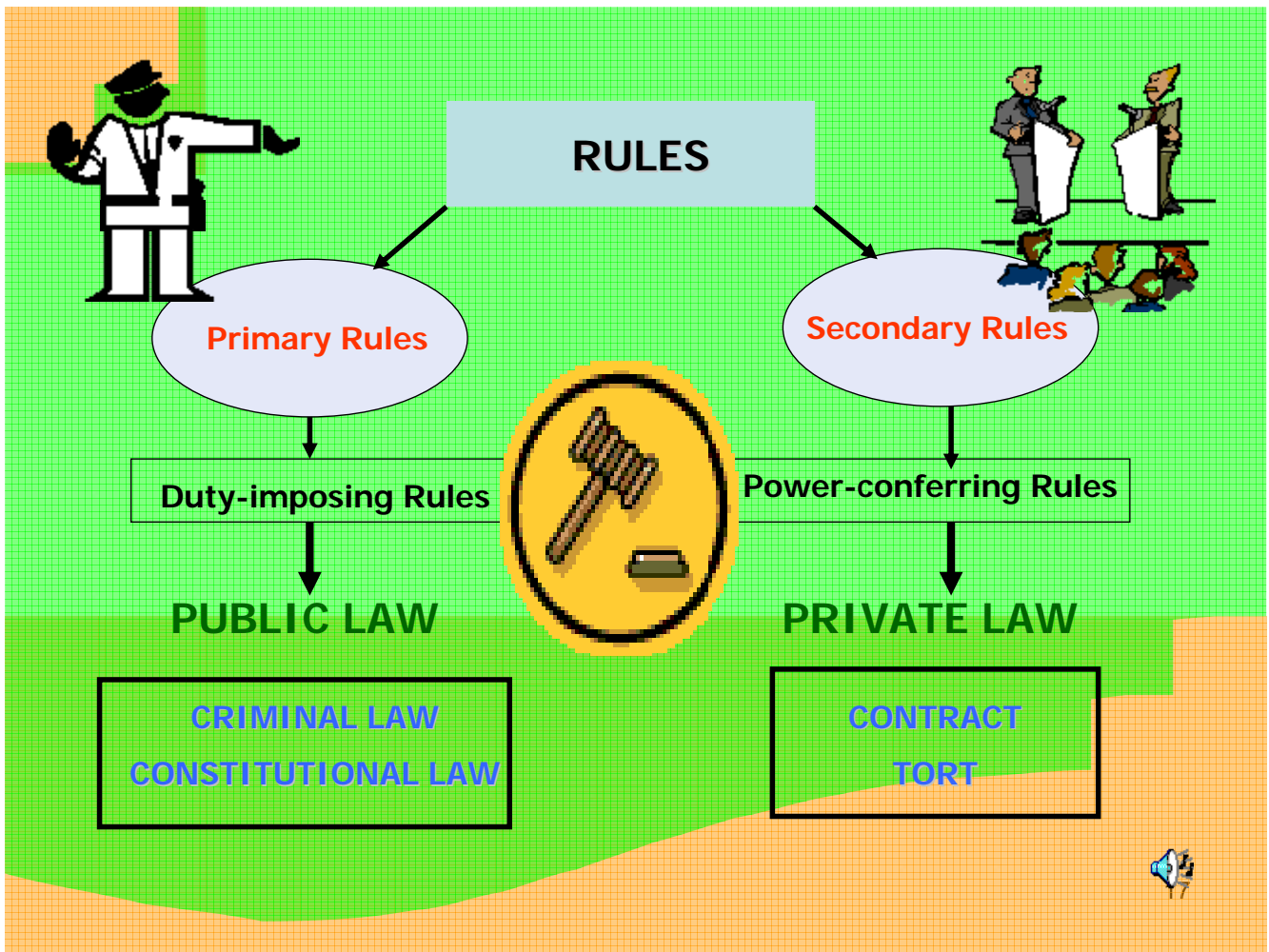
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Terms

The duration varies according to the type of copyright work concerned

Literary, dramatic, musical, artistic works	70 years from the end of the year in which the author died. If the work is published after the death of the author, it lasts for 70 years, from the end of the year in which the work was first published.
Published editions of literary, dramatic, musical or artistic works (layout)	25 years from the end of the year in which the edition was first published
Sound recordings and films	70 years from the end of the year of release of the sound recording or film
Broadcasts and cable programmes	50 years from the end of the year of making the broadcast or cable program
Performances	70 years from the end of the year of the performance.

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Civil Law and Criminal Law



Most business laws are found within civil law. However, it is useful to know a bit of criminal law as some type of unfair or unlawful business conduct are criminal offences. If a person commits any of these unlawful acts, the penalty is a criminal conviction which may include a jail term – a serious thing indeed. In contrast, the liability for breaching civil laws usually involves the payment of financial compensation to the injured party. Thus when a wrong is committed, the criminal law punishes whereas the civil law compensates.

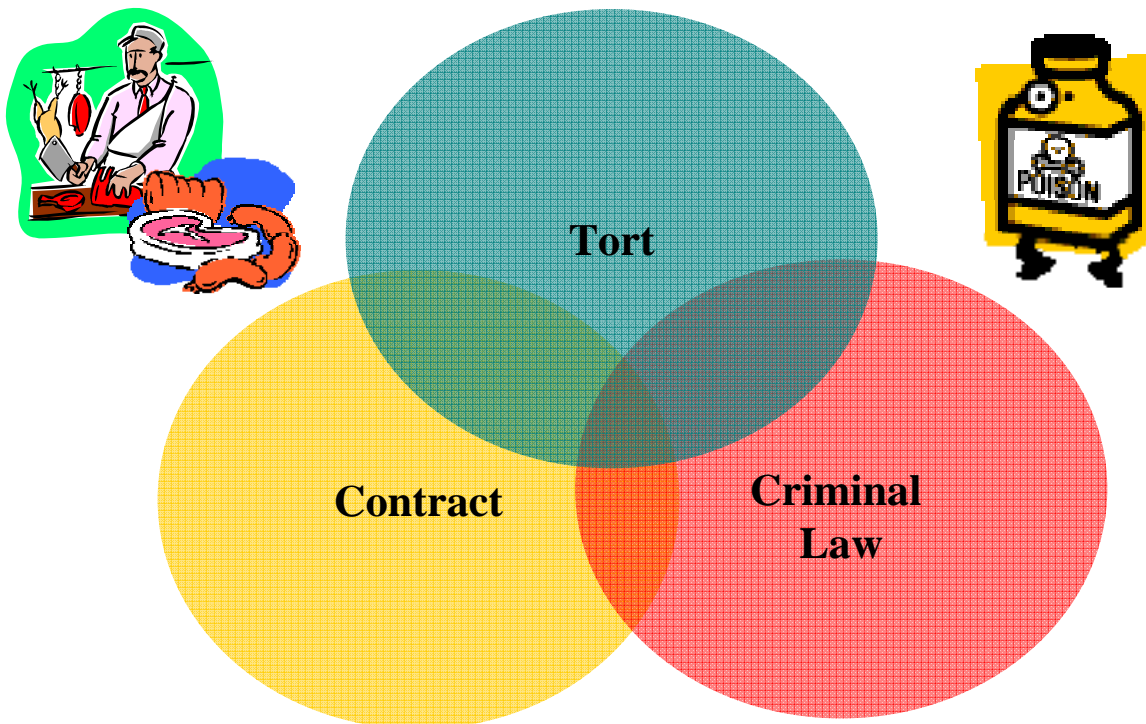
Function of Business Law

Facilitator: business law exists to facilitate the existence of business. For example, contract law provides a framework for business agreements.

Regulator: with the increase in government intervention in business activity, business law acts as a government check on business activities.

Adjudicator: disputes are inevitable and there must be a means to resolve them. Apart from courts there are other ways to resolve dispute such as mediation, arbitration and litigation.

Overlap of Contract, Tort and Criminal Law





Singapore Court Structure

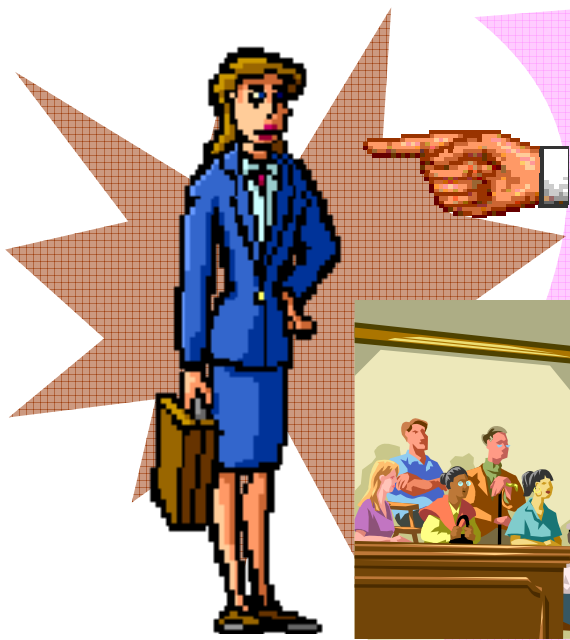


<p>COURT OF APPEAL</p> <p><i>Final court of appeal for all cases in Singapore.</i></p>	<p><i>Not bound by lower court decisions. Not bound by its own previous decision although might follow to maintain uniformity.</i></p>
<p>HIGH COURT</p>	<p><i>Only bound by decisions of Court of Appeal. Not bound by sub-court decisions.</i></p>
<p>SUB-ORDINATE COURT</p>	<p><i>Bound by the decisions of the High Court and the Court of Appeal.</i></p> <p style="text-align: right;">21</p>

<p><u>District Courts</u></p> <p>These courts have power to hear both civil and criminal cases. These courts deal with civil cases involving claims of more than \$60000 but less than \$250000</p>	<p><u>Magistrates' Court</u></p> <p>These courts also have power to hear both civil and criminal cases. These courts deal with civil cases which do not exceed \$60 000.</p>
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The Subordinate Court

<p><u>Family Court</u></p> <p>Hears petition for divorce, custody, adoptions, maintenance, protection order against spousal violence and related matters</p>	<p><u>Juvenile Court</u></p> <p>This court deals with criminal offences committed by person under 16 years of age.</p>
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PERSON SUING IS CALLED:

PLAINTIFF



PERSON BEING SUED IS CALLED:

DEFENDANT



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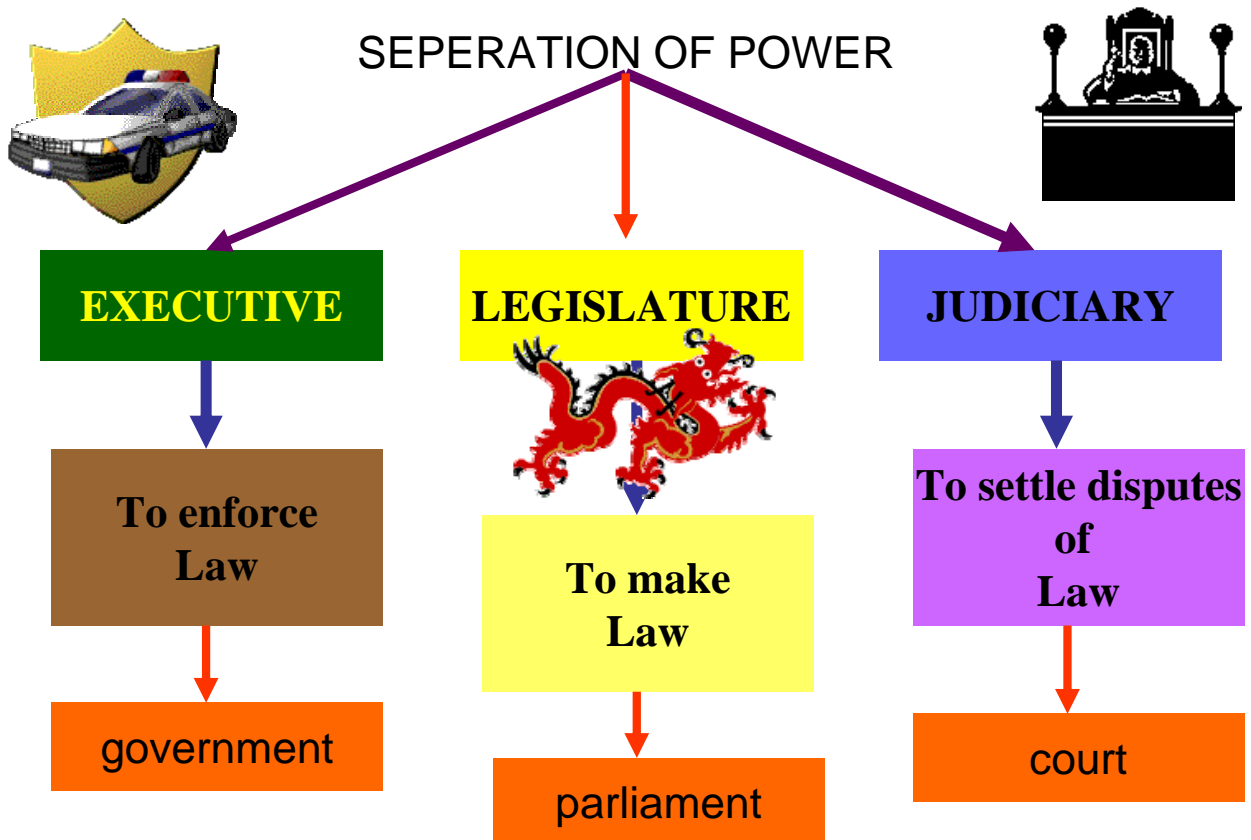
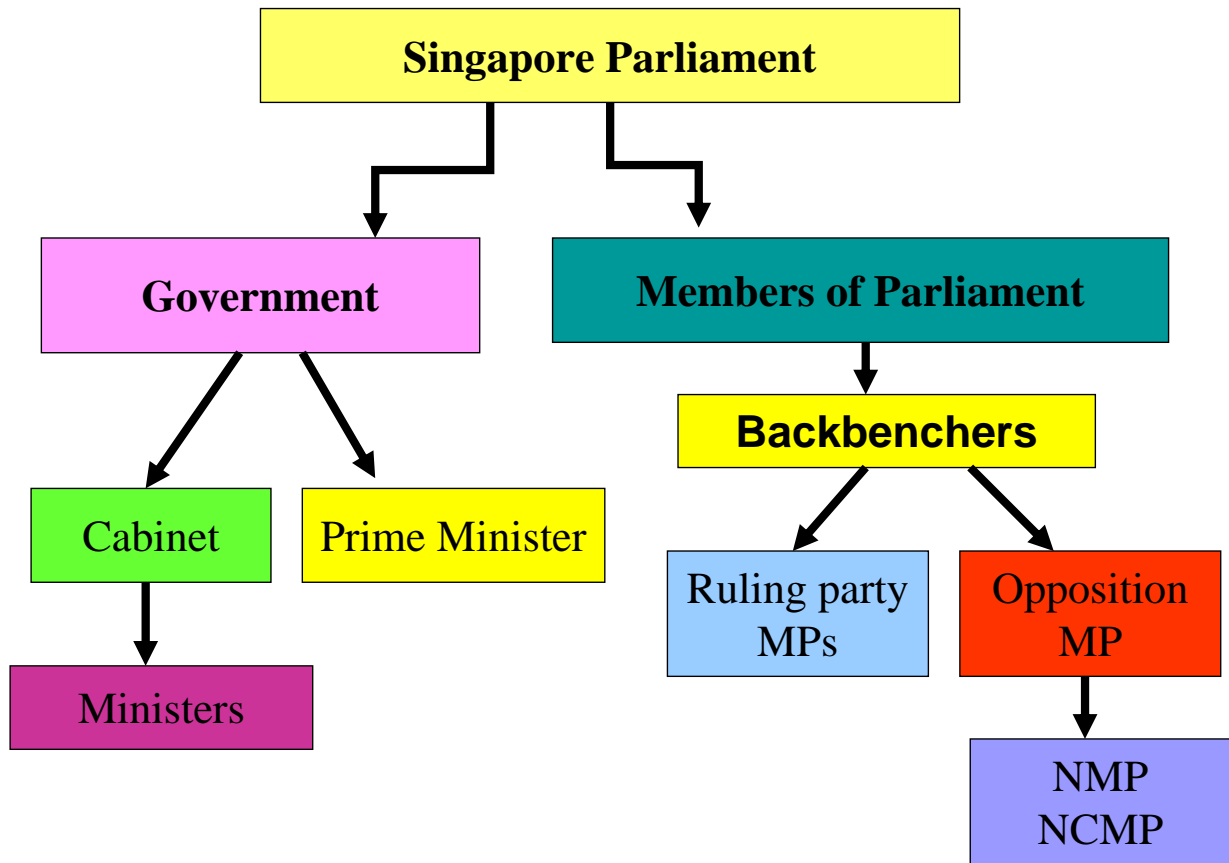
Plaintiff

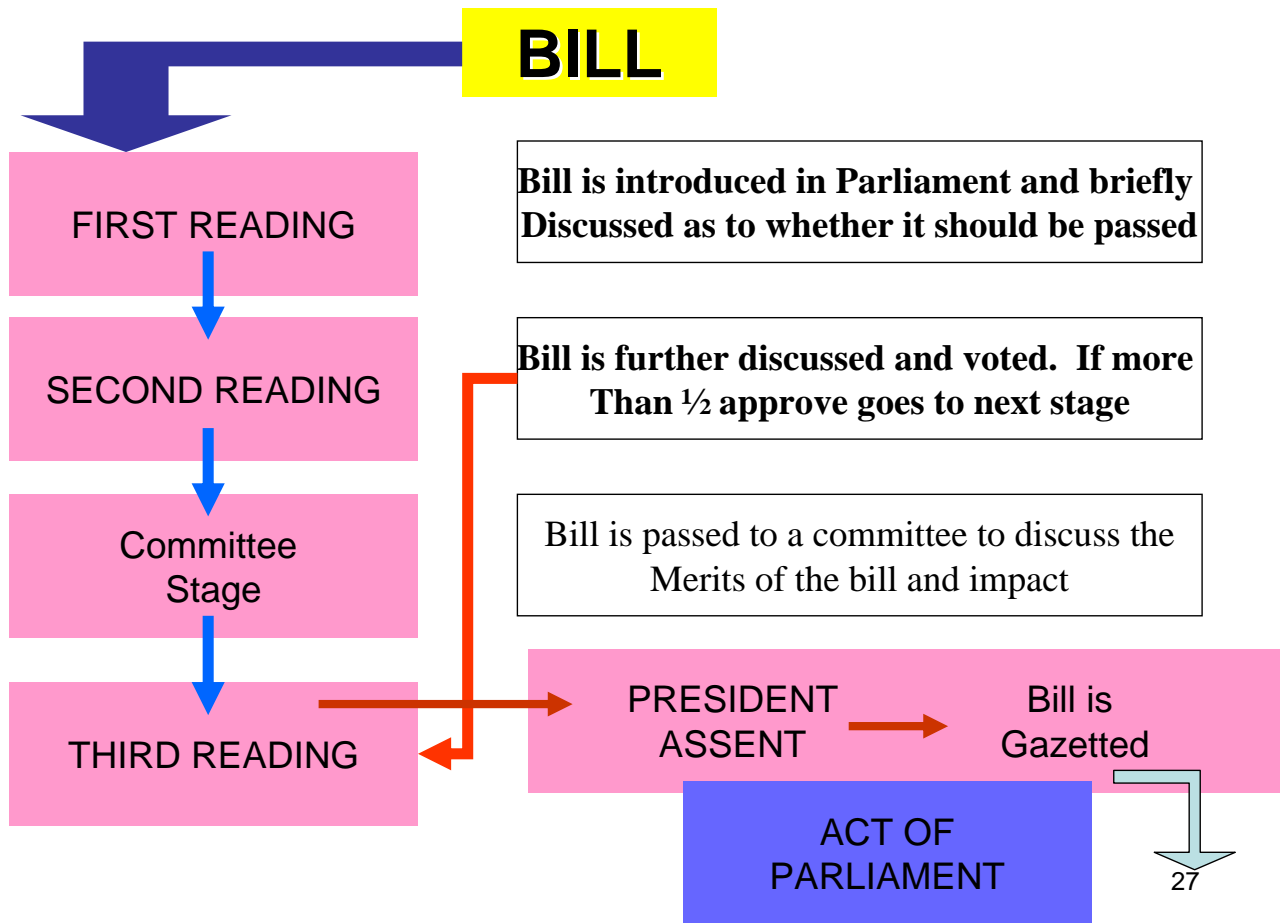
Year case was reported

Defendant

2nd volume of Singapore Law Report



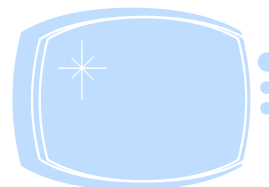




PATENTS

A Patent is a monopoly right given by the Government to the owner of an invention to enable him to prevent others from using, copying or making the invention without his consent in the country in which he has obtained patent protection. A patentable invention can be a product or a process that gives a new technical solution to a problem.

In exchange for full disclosure of the invention, the government will grant the owner of the invention, a monopoly right for 20 years, subject to an annual renewable fee payable from the end of the 4th year from the date of filing.



PATENTABLE INVENTION

For an invention to be patentable, it must satisfy three key criteria.

New The invention should not have been made known to the public in any way, anywhere in the world. Owners of inventions should be careful to keep the invention secret, until a patent application has been successfully made. An invention could be considered as not new if it has already been made available to the public by word of mouth, or it has been commercially exploited, or it has been featured in an article or advertised in the press, or it has been demonstrated. Such disclosure may be novelty destroying and forms one of the grounds for the revocation of a patent.

PATENTABLE INVENTION

Inventive Step The invention must be something that represents an improvement over any existing product or process that is already available. The improvement must be non-obvious to a person who is skilled in the art in that technological field of the invention.

PATENTABLE INVENTION

Industrial Application The invention must be useful and have some form of practical application. It should be capable of being made or used, or achieving a concrete end result in any industry.

In addition, the publication or exploitation of the intention must not encourage offensive, immoral or anti-social behaviour.

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Why are patents necessary?

Patents provide **incentives** to individuals by offering them **recognition** for their **creativity** and **material reward** for their marketable inventions. These incentives encourage **innovation**, which assures that the **quality of human life** is continuously enhanced.



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What role do patents play in everyday life?

Patented inventions have, in fact, **pervaded every aspect of human life**, from electric lighting (patents held by Edison and Swan) and plastic (patents held by Baekeland), to ballpoint pens (patents held by Biro) and microprocessors (patents held by Intel, for example).

All patent owners are obliged, in return for patent protection, to **publicly disclose information** on their invention in order to **enrich the total body of technical knowledge** in the world. Such an ever-increasing body of public knowledge promotes **further creativity and innovation** in others. In this way, patents provide not only protection for the owner but valuable **information** and **inspiration** for **future generations** of researchers and inventors.



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When to File

The application system in Singapore operates on a first-to-file basis. The basis of deciding who was the first-to-file is the date of filing accorded to the application. The Registry allocates a date of filing based on the date it receives a patent request, together with an identification of the applicants and a description of the invention.

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Priority Claim

Singapore, like many countries, allow priority claims to be made in a patent application. If an applicant has an application filed earlier in a Paris Convention or World Trade Organization member country, he may claim this earlier filed application as priority in a subsequent Singapore patent application. This is provided the Singapore application is made within 12 months from the date of filing of the earlier filed application.

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Entitlement to a Patent

The right to the grant of a patent belongs primarily to the inventor or inventors. However, should the invention be developed in the course of work, under Singapore law, the rights to the invention may then vest with the employer. The patent law lays down the circumstances in which inventions by the employee belong to the employer and those in which they remain with the employee.

The owner of the invention may also assign his rights to another person or entity and the right would pass over the assignee.

Any person or corporation claiming to be the owner of an invention can apply for a patent in Singapore. There are no restrictions or discrimination as to nationality or residency. However, an applicant who is not a resident in Singapore must provide the Registry of Patents with an address for service in Singapore to which all correspondences will be sent. If a patent agent is hired to act on the applicant's behalf, this address for service should be the practice address of the patent agent.

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Terms and Renewals

The terms of a patent is 20 years from the date of filing subject to the payment of annual renewal fees. Annual renewal fees are payable starting from the end of 4th year from the date of filing, and for every subsequent year thereafter, until the patent expires.

Infringement

Infringement occurs when an invention of a patented product or process is used without the consent of the patent owner while the patent is in force.

This generally means that there is infringement when a party, without asking for permission from the patent owner, makes, disposes of, offersto dispose of, uses or imports the product or keeps it whether for disposal or otherwise.

This also means that there is infringement when a party uses the process or offers it in Singapore when he knows, or it is obvious to a reasonable person in such circumstances, that the use without consent would be infringement on the right of the patent owner. It is also an infringement when he disposes of, offers to dispose of, uses or imports any product obtained directly by means of the that process or keeps any such product whether for disposal or otherwise.

Enforcement

The patent owner can take civil legal action against infringing party, seeking relief in the form of an injunction to stop the infringing action, demand for the profits gained by the infringing party at his expense and/or, seek damages for the loss suffered.

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Remedies

The remedies for the infringement of a patent are:

- **an injunction to restrain further infringement;**
- **delivery up to infringing items;**
- **destruction of infringing items;**
- **damages; and**
- **account of profits**

No damages or account of profits will be granted by the courts if a defendant can prove that at the time of infringement, he was reasonably unaware of the existence of the patent.

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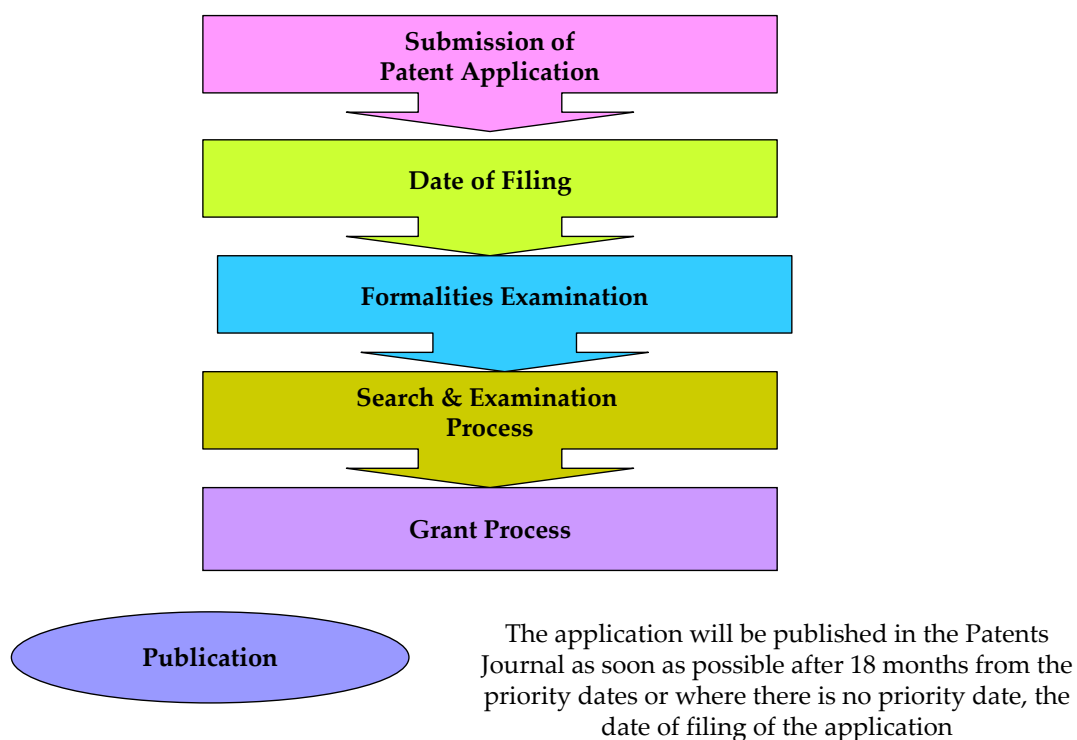
Criminal Offences under the Patents Act

Offences under the Patents Act include the following:

- making or causing a false entry in the register
- falsely representing that anything is patented; and
- falsely representing that a patent has been applied for.

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FLOWCHART OF A PATENT APPLICATION



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Have you disclose your invention or design?

Keeping Things Secret – Novelty

It is a natural impulse to spread the good news when you have developed a great new product – the more publicity the better! It also might appear to make perfect business sense to talk about your great new design or invention in seeking investors. But take caution, such action may cost you your valuable IP.

The invention must be novel in order that it may qualify for a grant of patent. It must therefore be kept a secret until the patent application has been filed. If it has been disclosed anywhere else in the world, it may not be regarded as novel. Although there are certain specific situations where a disclosure may be disregarded (e.g. in breach of confidence, if displayed in specific international exhibitions etc.) in most cases public disclosure is novelty destroying and makes the invention unpatentable. Note though, that different countries have different standards in determining how disclosure would affect the novelty.

Novelty is also a requirement for registered designs. If the designs has been registered, or has been published before the date of application of the design registration anywhere in the world, in respect of the same or any other article, the design is considered to have been disclosed and therefore not new or novel. The design is also not new if it differs only in immaterial details, or features, from other designs that are commonly found in trade.

TRADEMARKS

A Trademark is a sign used by any person in the course of business or trade to distinguish his goods or services from those of other traders.

Registering a trademark gives the owner right to enable him to control the use of the sign. A registered trademark has to be capable of being represented graphically.

The registration of a trademark is valid for 10 years from the date of application. Protection can last indefinitely subject to the payment of renewal fees every 10 years and with proper use of the mark.

Registrable Marks

A trade mark can be letters, words, names, signatures, numerals, devices, brands, labels, tickets, shapes, colours, aspect of packaging or any combination of these. For a trademark to be registered it must be distinctive and capable of distinguishing the goods and/or services of the owner from similar goods and/or services of other traders.

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Unregistrable Marks

In general, marks that are non-distinctive or are descriptive, common to the trade, deceptive, contrary to public policy or morality, or mark that are identical to an earlier mark on identical goods/services, cannot be registered. Also, a mark that is identical to an earlier mark to be used on similar goods/services, or a mark that is similar to an earlier mark to be used on identical/similar goods/services, may not be registered if it could cause confusion with the earlier mark.

Generally, trade marks that do not have a distinctive character cannot be registered. However, there may be exceptions where the company has built up its branding to such an extent that the mark is associated with the company, even though the mark in itself was not distinctive. For such cases, the mark may still be registered on the basis of substantial use resulting in the mark acquiring a distinctive character.

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How to seek Trade Mark Protection?

Protection can be sought by filing for an application to register the mark. The applicant would need to provide a description of the mark, the aspects of protection for the mark and enclose a representation of the mark. The application process usually takes about 4 to 6 months.

Classification of Goods and Services

The scope of a trade mark registration is determined by the goods or services in relation to which the trade mark is registered. Singapore uses the Nice Classification to classify goods and services for which the trade mark will be used. There are a total of 34 classes of goods and 11 classes of services.

For further information you may wish to visit the following website:

<http://www.ipos.gov.sg> (About IP>Trade Marks>Classification of Goods and Services).

Is it Necessary to Register a Trade Mark?

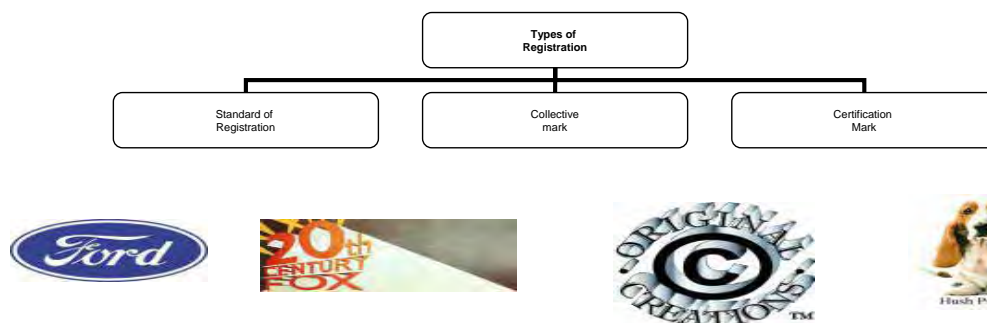
It is not compulsory to register a trade mark in Singapore. For a mark that is not registered, the owner can rely on his rights under common law and protect his mark against imitation. This remedy, however, requires the owner of the mark to prove there is goodwill in his business for the goods/services on which the mark is used. A registered trade mark, on the other hand, grants the owner of the trade mark statutory rights. Hence, in the event of a possible infringement, the registered trade mark owner can rely on his registration as proof of his rights to the mark without need to prove goodwill.

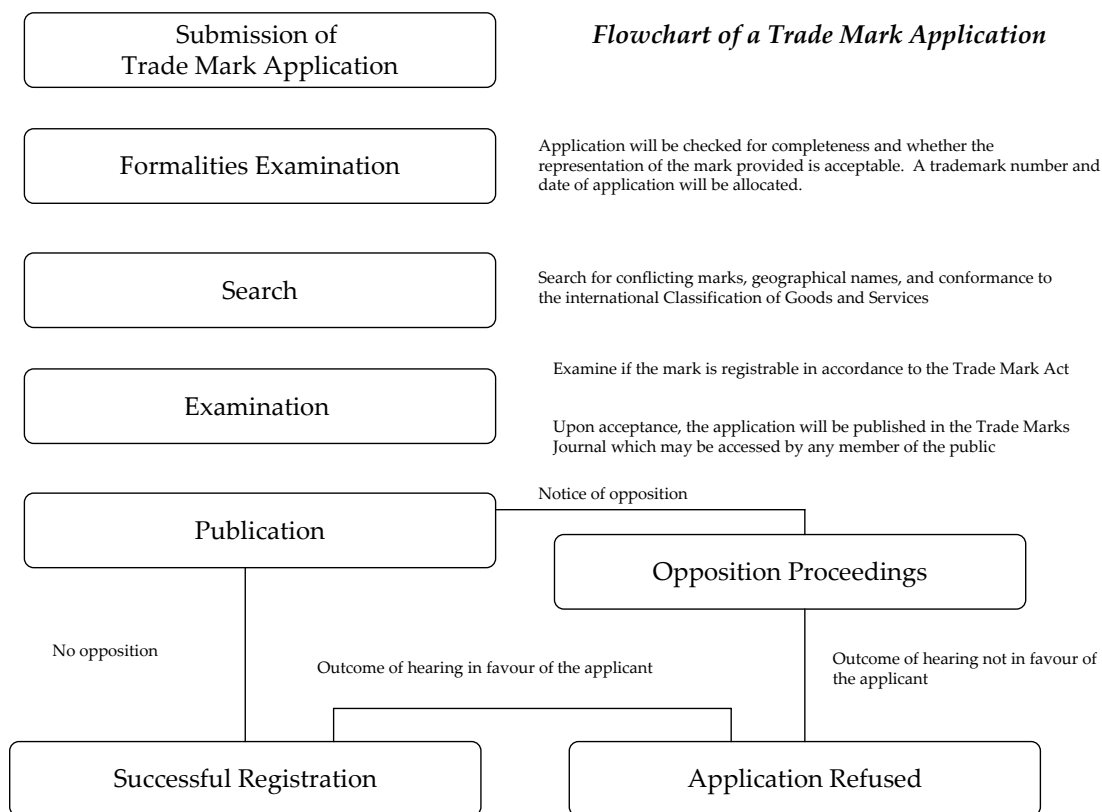
Singapore Stand

In Singapore, the most effective way of protecting trade marks is to register them under the Trade Mark Act (TMA). Alternatively, unregistered trade marks may also be protected by the common law action of passing off.

If the trademark has already been applied for in a country which is a member of the Paris Convention or the World Trade Organization, and a similar application is lodged in Singapore within six months, then the application date is the date when the mark is applied overseas: s10 TMA. Since Singapore acceded to the Madrid Protocol in 2000 the procedure for making international trade mark applications has become even easier. The Madrid Protocol allows one trade mark application to be made in one member country with the effect that similar applications are deemed to be made in all member countries. However, the registration authorities in each country still have the discretion to decide whether to register the trade mark in their respective jurisdiction.

Trade Mark Registration





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DESIGNS

A design refers to the features of shape, configuration, pattern or ornament applied to an article by an industrial process. It is the appearance of articles we see everyday. An article refers to any object to which the design is applied.

Design may be protected through registration. A registered design gives the owner the right to control the use of his design.

Upon registration, a registered design lasts for an initial period of 5 years. Thereafter, the registration may be renewed every 5 years up to a maximum of 15 years, subject to the payment of renewal fees.

Registrable Designs

To qualify for registration, a design must, in general, satisfy two key criteria:

New It has not been registered in Singapore and elsewhere; or published anywhere in the world before the date of application of the first filing. Thus the owner of a design should be careful not to disclose the design to anyone, until a design registration is filed.

If a design is substantially the same as another that is registered in respect of the same or any other article, it is not new.

Generally, a design is not new if it

- has been registered; or
- has been published anywhere in the world, in respect of the same or any other article; or
- differs in immaterial details, or features, from other designs that are commonly found in trade.

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Industrial Process - In general, a registered design is applied onto and article by an industrial process if more than 50 reproductions are made of it for the purposes of sales or hire.

Designs that cannot be Registered

Under the Registered Designs law in Singapore, the following cannot be registered:

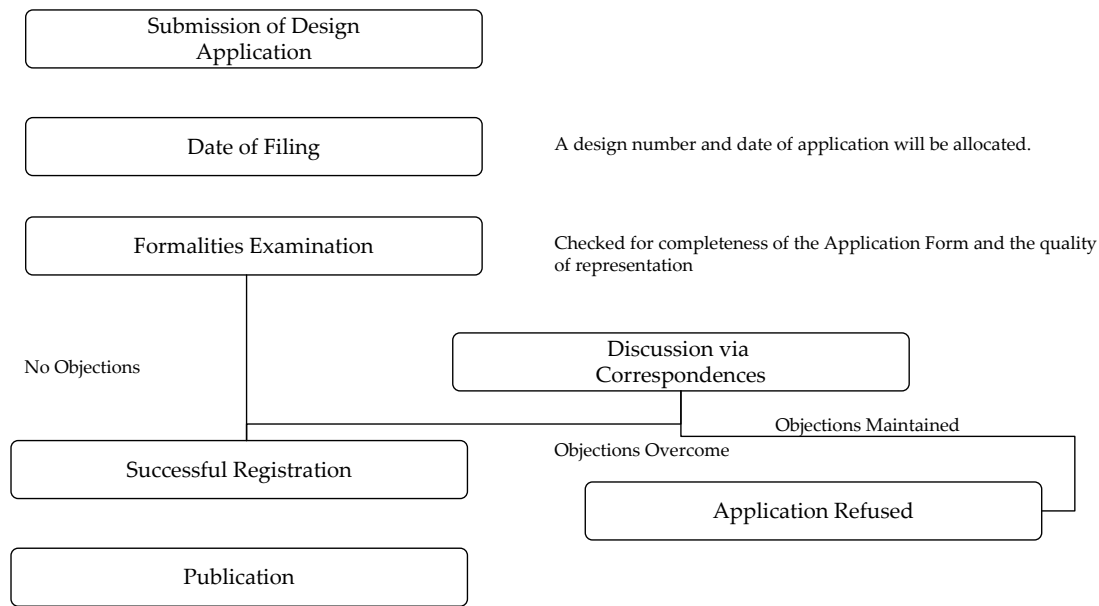
1. Design that are contrary to the public policy or morality
2. Computer programs or layout-designs of integrated circuits.
3. Designs applied to certain articles: Works of sculpture (other than casts used process); wall plaques, medals and medallions; and printed matter primarily of a literary or artistic character (including book jackets, calendars, certificates, playing cards, postcards, stamps, trade advertisements, trade forms and cards, transfers and similar articles).
4. Any method of principle of construction.
5. Designs that are solely functional.
6. Designs that are dependent upon the appearance of another article, of which it is intended by the designer to form an integral part; or enable the article to be connected to, or placed in, around or against, another article so that either article may perform its function.

Priority Claim

Singapore, like many countries, allow priority claims in the application for design registration. If an applicant has a corresponding design application filed earlier in a Paris Convention country or a World Trade Organization member country (other than Singapore), he may claim priority from this first-filed application, provided the Singapore registration is filed within 6 months from the date of the first filing. In such a case, where the application in Singapore is a subsequent application, the Registry of Designs will treat the date of application of the first filing as the date of application in Singapore (known as priority date claim).

Applying for a Design Outside Singapore

Protection for designs is territorial in nature. A separate registration will have to be made in each of the countries where protection is desired. To obtain protection outside Singapore, the applicant needs to file his application directly in the countries concerned either individually or via the Hague System.



Flowchart of Design Application

Geographical Indications

What is a geographical indication?

A geographical indication is a sign used on goods that have a specific geographical origin and possess qualities or a reputation that are due to that place of origin. Most commonly, a geographical indication consists of the name of the place of origin of the goods. Agricultural products typically have qualities that derive from their place of production and are influenced by specific local factors, such as climate and soil. Whether a sign functions as a geographical indication is a matter of national law and consumer perception. Geographical indications may be used for a wide variety of agricultural products, such as, for example, "Tuscany" for olive oil produced in a specific area of Italy (protected, for example, in Italy by Law No. 169 of February 5, 1992), or "Roquefort" for cheese produced in France (protected, for example, in the European Union under Regulation (EC) No. 2081/92 and in the United States under US Certification Registration Mark No. 571.798).

Can geographical indications only be used for agricultural products?

The use of geographical indications is not limited to agricultural products. They may also highlight specific qualities of a product which are due to human factors that can be found in the place of origin of the products, such as specific manufacturing skills and traditions. That place of origin may be a village or town, a region or a country. An example for the latter is "Switzerland" or "Swiss," which is perceived as a geographical indication in many countries for products that are made in Switzerland and, in particular, for watches.

What is an appellation of origin?

An appellation of origin is a special kind of geographical indication, used on products that have a specific quality that is exclusively or essentially due to the *geographical environment* in which the products are produced. The concept of geographical indication encompasses appellations of origin.

What does a geographical indication do?

A geographical indication points to a specific place or region of production that determines the characteristic qualities of the product that originates therein. It is important that the product derives its qualities and reputation from that place. Since those qualities depend on the place of production, a specific "link" exists between the products and their original place of production.

Why do geographical indications need protection?

Geographical indications are understood by consumers to denote the origin and the quality of products. Many of them have acquired valuable reputations which, if not adequately protected, may be misrepresented by dishonest commercial operators. False use of geographical indications by unauthorized parties is detrimental to consumers and legitimate producers. The former are deceived and led into believing to buy a genuine product with specific qualities and characteristics, while they in fact get a worthless imitation. The latter suffer damage because valuable business is taken away from them and the established reputation for their products is damaged.

What is the difference between a geographical indication and a trademark?

A trademark is a sign used by an enterprise to distinguish its goods and services from those of other enterprises. It gives its owner the right to exclude others from using the trademark. A geographical indication tells consumers that a product is produced in a certain place and has certain characteristics that are due to that place of production. It may be used by all producers who make their products in the place designated by a geographical indication and whose products share typical qualities.

How is a geographical indication protected?

Geographical indications are protected in accordance with national laws and under a wide range of concepts, such as laws against unfair competition, consumer protection laws, laws for the protection of certification marks or special laws for the protection of geographical indications or appellations of origin. In essence, unauthorized parties may not use geographical indications if such use is likely to mislead the public as to the true origin of the product. Applicable sanctions range from court injunctions preventing the unauthorized use to the payment of damages and fines or, in serious cases, imprisonment.

How are geographical indications protected on the international level?

A number of treaties administered by the World Intellectual Property Organization (WIPO) provide for the protection of geographical indications, most notably the Paris Convention for the Protection of Industrial Property of 1883, and the Lisbon Agreement for the Protection of Appellations of Origin and Their International Registration. In addition, Articles 22 to 24 of the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS) deal with the international protection of geographical indications within the framework of the World Trade Organization (WTO).

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What is a "generic" geographical indication?

If a geographical term is used as the designation of a kind of product, rather than an indication of the place of origin of that product, this term does no longer function as a geographical indication. Where that has occurred in a certain country over a substantial period of time, that country may recognize that consumers have come to understand a geographical term that once stood for the origin of the product - for example, "Dijon Mustard," a style of mustard originally from the French town of Dijon - to denote now a certain kind of mustard, regardless of its place of production.

What is WIPO's role in protection geographical indications?

WIPO is in charge of the administration of a number of international agreements which deal partly or entirely with the protection of geographical indications (see, in particular, the Paris Convention for the Protection of Industrial Property, and the Lisbon Agreement for the Protection of Appellations of Origin and Their International Registration). Furthermore, through the work of the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications, made up of representatives of member States and interested organizations, WIPO explores new ways of enhancing the international protection of geographical indications.

Singapore Standpoint

Unlike trademarks, geographical indications in Singapore needs not be registered. Among other things, the legislation prohibits the use of misleading geographical indications and allows certain interested parties to obtain a court injunction to restrain such unlawful conduct. The legislation also prohibits the registration of misleading geographical indications as trade marks. However, it is possible that a geographical indication may also fulfill the criteria for trade mark registration. It is possible to also obtain trade mark registration for that geographical indication.



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1. Singapore, 23 April 2005...The HIP (Honour Intellectual Property) Alliance, an initiative championed by the Intellectual Property Office of Singapore (IPOS) unveiled its 2005 campaign at the REAL Hunt, organised in celebration of the World Intellectual Property Day. The HIP campaign is a yearly initiative targeting young Singaporeans, with the aim of raising their awareness that intellectual property is important and adds value to their daily lives.

2. This year, the campaign, featuring young and fresh faces making a stand on protecting creativity and ideas, aims to get the young Singaporeans to understand that every new piece of work or invention that helps to enrich our lives started with someone's idea. By rejecting piracy and supporting creativity, we are rewarding the creator's effort and encouraging him to continue innovating.

3. Speaking at the launch of the REAL Hunt, Assoc Prof Ho Peng Kee, Senior Minister of State, Ministry of Law & Ministry of Home Affairs, said: "All of us need to realise that intellectual property enriches our everyday lives. It sustains the lifestyle we have grown accustomed to. It inspires creativity, promotes diversity, and encourages innovation. It is in all our interest to keep creativity and IP alive whether at work or at play."

4. The campaign targets those in the 14 - 35 age bracket, who grew up with Internet, mobile phones, online games, music and movies. "Not only do we want to educate them about respecting intellectual property available online, this group forms also our future generation of IP creators. It would be a pity if our young talents give up simply because they believe little is being done to reward their creative efforts," said Ms Liew Woon Yin, Director-General of IPOS.

5. The launch of the campaign coincides with the celebration of the World Intellectual Property Day, a global project by the Geneva-based World Intellectual Property Organisation (WIPO). The organisation recently set up a Singapore office to support efforts to promote intellectual property among its Asian member states.

6. Singapore's strong intellectual property infrastructure was recently highlighted as a reason for WIPO's decision to locate in Singapore. Explaining the choice, Ms Rowena Paguio, Head for the WIPO Singapore Office, said:

7. "Singapore's unparalleled commitment in embracing IP protection sets the benchmark for many countries in the Asia-Pacific region. WIPO's regional presence through an office in Singapore, which will be officially inaugurated on 7 June 2005, underscores our commitment to provide more comprehensive support for our member states in the region."

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Infringement

Generally the proprietor of a trademark has the exclusive right to use or authorise other persons to use the trademark: s 26 TMA. The trade mark is infringed if an unauthorised third party uses a sign identical or similar to the trade mark for goods and services identical or similar to which the trade mark is registered and this creates the likelihood of confusion among the public: s 27 TMA. So, when a person affixes the Rolex trade mark on a counterfeit watch, this amounts to a trade mark infringement.

The importation of goods which infringes a registered trademark is subject to severe consequences. The trade mark proprietor can notify the customs authorities objecting to such importation: s82 TMA. The customs authorities are empowered to seize the goods. They also have extensive powers of search allowing them to board and inspect vessels and aircraft as well as examine packages.

However, a third party can use his own name or place of business or his predecessor's name or place of business despite that name being a registered trade mark: s28 TMA. Similarly, if a third party or his predecessor has used the trade mark before it was registered by another person, then the continued use of the trade mark by the third party does not amount to an infringement. In all of these cases – specified under s 28 TMA – there is a general requirement that the use be in accordance with honest practices in industrial or commercial matters.

Typically, the proprietor of a trade mark will initiate proceedings against an infringer. In such proceedings, the court may order the infringer to remove or erase the offending sign; alternatively, the court may order the goods on which the infringing sign is affixed to be destroyed or seized: s32 TMA. On the other hand, an aggrieved person may sue a party if that party makes groundless threats of trade mark infringement and such party can be liable unless he shows that the aggrieved person's use of the trademark is in fact an infringement: s35TMA.

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