

THE STATUTES OF THE REPUBLIC OF SINGAPORE

TRADE MARKS ACT
(CHAPTER 332)

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Trade Marks Act

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An Act for the registration of trade marks.

[1st February 1939]

PART I

PRELIMINARY

- 1. This Act may be cited as the Trade Marks Act. Short title.
- 2. In this Act, unless the context otherwise requires — Inter-pretation.
 - “assignment” means assignment by act of the parties concerned;
 - “court” means the High Court;
 - “limitations” means any limitations of the exclusive right to the use of a trade mark given by a person

as proprietor thereof, including limitations of that right as to mode of use, as to use in relation to goods to be sold, or otherwise traded in, in any place within Singapore, or as to use in relation to goods to be exported to any market outside Singapore;

“mark” includes a device, brand, heading, label, ticket, name, signature, word, letter, numeral or any combination thereof;

“prescribed” means, in relation to proceedings before the court or preliminary thereto or connected therewith, prescribed by Rules of Court made under the Supreme Court of Judicature Act and in other cases, prescribed by this Act or in any rules made thereunder;

Cap. 322.

“registrable trade mark” means a trade mark which is capable of registration under the provisions of this Act;

“register” means the register of trade marks kept under the provisions of this Act;

“registered trade mark” means a trade mark which is actually upon the register;

“registered user” means a person who is for the time being registered as such under section 30;

“Registrar” means the Registrar of Trade Marks appointed under section 3;

“trade mark” means, except in relation to a certification trade mark, a mark used or proposed to be used in relation to goods for the purpose of indicating or so as to indicate a connection in the course of trade between the goods and some person having the right either as proprietor or as registered user to use the mark, whether with or without any indication of the identity of that person, and means, in relation to a certification trade mark, a mark registered or deemed to have been registered under section 68;

“transmission” means transmission by operation of law, devolution on the personal representatives of a deceased person, and any other mode of transfer not being an assignment.

3.—(1) The President may appoint a fit and proper person to be the Registrar of Trade Marks for the purposes of this Act. Appointment of Registrar. 2/86.

(2) The Registrar shall have a seal of such device as may be approved by the Minister.

(3) Impressions of such seal shall be judicially noticed and admitted in evidence.

(4) Any act or thing directed to be done by or to the Registrar may be done by or to any officer authorised by the President.

Register of trade marks

4. The Registrar shall for the purposes of this Act keep a record called the “register of trade marks” wherein shall be entered all registered trade marks, with the names, addresses and descriptions of their proprietors, notifications of assignments and transmissions, the names, addresses and descriptions of all registered users, disclaimers, conditions, limitations, and such other matters relating to such trade marks as may from time to time be prescribed. Register of trade marks.

5. The register shall be divided into two parts to be called respectively Part A and Part B. Division of register.

6. There shall not be entered in the register any notice of any trust expressed, implied or constructive, nor shall any such notice be receivable by the Registrar. Trust not to be entered in register.

7. The register shall at all convenient times be open to the inspection of the public, subject to such rules as may be prescribed, and certified copies sealed with the seal of the Registrar of any entry in the register shall be given to any person requiring them on payment of the prescribed fee. Inspection of and extract from register.

PART II

REGISTRATION OF TRADE MARKS

8. All trade marks entered in the register under the provisions of Part II of the Trade Marks Ordinance 1938 shall be deemed, for all purposes, to be trade marks registered under this Part. Registered United Kingdom trade marks. 38/38.

Particular
goods.

9.—(1) A trade mark may only be registered in respect of particular goods or classes of goods.

(2) Any question arising as to the class within which any goods fall shall be determined by the Registrar, whose decision shall be final.

Trade
marks
registrable
in Part A.

10.—(1) 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, 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 paragraphs (a), (b), (c) and (d), shall not be registrable under this paragraph except upon evidence of its distinctiveness.

(2) For the purposes of this section, “distinctive” means adapted, in relation to the goods in respect of which a trade mark is registered or proposed to be registered, to distinguish goods with which the proprietor of the trade mark is or may be connected in the course of trade from goods in the case of which no such connection subsists, either generally or, where the trade mark is registered or proposed to be registered subject to limitations, in relation to use within the extent of the registration.

(3) In determining whether a trade mark is adapted to distinguish as aforesaid the Registrar or the court may have regard to the extent to which —

- (a) the trade mark is inherently adapted to distinguish as aforesaid; and
- (b) by reason of the use of the trade mark or of any other circumstances, the trade mark is in fact adapted to distinguish as aforesaid:

Provided that any mark which has been registered as a distinctive mark in Part A of the register kept in the United Kingdom under the Trade Marks Act 1938 shall be deemed to be a distinctive mark for the purpose of this Act.

U.K. 1938
c. 22.

11.—(1) Any person claiming to be the proprietor of a trade mark used or proposed to be used by him who is desirous of registering it in Part A shall apply in writing to the Registrar in the prescribed manner.

Application
for
registration.

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

(3) In the case of a refusal or conditional acceptance, the Registrar shall, if required by the applicant, state in writing the grounds of his decision and the material used by him in arriving at it, and the decision shall be subject to appeal to the court.

(4) An appeal under this section shall be made in the prescribed manner, and on the appeal the court shall, if required, hear the applicant and the Registrar, and shall make an order determining whether, and subject to what conditions, amendments or modifications, if any, or to what limitations, if any, the application is to be accepted.

(5) Appeals under this section shall be heard on the materials so stated by the Registrar to have been used by him in arriving at his decision, and no further grounds of objection to the acceptance of the application shall be allowed to be taken by the Registrar, other than those stated by him, except by leave of the court. Where any further grounds of objection are taken the applicant shall be entitled to withdraw his application without payment of costs on giving notice in the prescribed manner.

(6) The Registrar or the court, as the case may be, may at any time, whether before or after acceptance, correct any error in or in connection with the application, or may permit the applicant to amend his application upon such terms as the Registrar or the court may think fit.

(7) An application for the registration of a trade mark in respect of any goods shall not be refused, nor shall permission for such registration be withheld, on the ground only

that it appears that the applicant does not use or propose to use the trade mark —

- (a) if the Registrar is satisfied that a body corporate is about to be constituted and that the applicant intends to assign the trade mark to the corporation with a view to the use thereof in relation to those goods by the corporation; or
- (b) if the application is accompanied by an application for the registration of a person as a registered user of the trade mark, and the Registrar is satisfied that the proprietor intends it to be used by that person in relation to those goods and the Registrar is also satisfied that that person will be registered as a registered user thereof immediately after registration of the trade mark.

(8) The Registrar may, as a condition of the exercise of the power conferred by subsection (7) in favour of the applicant who relies on intention to assign to a corporation as aforesaid, require him to give security for the costs of any proceedings before him relative to any opposition, and in default of such security being duly given may treat the application as abandoned.

(9) Where a trade mark is registered in respect of any goods under the power conferred by subsection (7) in the name of an applicant who relies on intention to assign to a corporation as aforesaid, then, unless within a period of 6 months the corporation has been registered as the proprietor of the trade mark in respect of those goods, the registration shall cease to have effect in respect thereof at the expiration of that period, and the Registrar shall amend the register accordingly.

Registration
of trade
marks in
Part B.

U.K. 1938
c. 22

12.—(1) Where any mark has for not less than two years been bona fide used in Singapore upon or in connection with any goods (whether for sale in Singapore or exportation abroad), for the purpose of indicating that they are goods of the proprietor of the mark by virtue of manufacture, selection, certification, dealing with or offering for sale, or where any mark has been registered in Part B of the register kept in the United Kingdom under the Trade Marks Act 1938 the person claiming to be the proprietor of the mark may apply in writing to the Registrar in the prescribed

manner to have the mark entered as his registered trade mark in Part B of the register in respect of such goods.

(2) The Registrar shall consider every such application for registration of a trade mark in Part B of the register, and if it appears to him, after such search, if any, as he may consider necessary, that the application is inconsistent with section 15 or 23, or if he is not satisfied that the mark has been so used as aforesaid, or that it is capable of distinguishing the goods of the applicant, he may refuse the application, or may accept it subject to conditions, amendments or modifications as to the goods or classes of goods in respect of which the mark is to be registered, or to such limitations, if any, as to mode or place of user or otherwise as he may think right to impose, and in any other case he shall accept the application.

(3) Every such application shall be accompanied by a statutory declaration verifying the user, including the date of first user, and such date shall be entered on the register:

Provided that where the date of first user is not known with certainty it shall be sufficient to state the earliest date on which the mark was known to have been used and such date shall be entered in the register as the date of first user.

(4) Any such refusal or conditional acceptance shall be subject to appeal in the prescribed manner to the court, and, if the ground for refusal is insufficiency of evidence as to user the refusal shall be without prejudice to any application for registration of the trade mark in Part A of the register.

(5) A mark may be registered in Part B notwithstanding any registration in Part A by the same proprietor of the same mark or any part or parts thereof.

(6) Section 68 does not apply in respect of trade marks to which this section applies.

13. If any person applies for the registration of a trade mark in Part A of the register, the Registrar may, if the applicant is willing, instead of refusing the application, treat it as an application for registration in Part B of the register and deal with the application accordingly.

Power to treat application for registration in Part A as application for registration in Part B.

Coloured
trade
marks.

14. A trade mark may be limited in whole or in part to one or more specified colours, and in such a case the fact that it is so limited shall be taken into consideration by any court having to decide on the distinctive character of the trade mark.

If and so far as a trade mark is registered without limitation of colour it shall be deemed to be registered for all colours.

Restriction
on
registration.

15.—(1) It shall not be lawful to register as a trade mark or part of a trade mark 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.

(2) No trade mark shall be registered in respect of particular goods or classes of goods set forth in the Schedule unless the trade mark has been and is registered in the United Kingdom in respect of such goods or classes of goods and unless the application for registration is made by the registered proprietor in the United Kingdom or any person deriving his right from the registered proprietor by assignment, transmission or other operation of law.

Words
used as
name or
description
of an
article or
substance.

16.—(1) The registration of a trade mark shall not be deemed to have become invalid by reason only of any use after the date of the registration of a word or words which the trade mark contains, or of which it consists, as the name or description of an article or substance:

Provided that, if it is proved either —

- (a) that there is a well-known and established use of the word or words as the name or description of the article or substance by a person or persons carrying on a trade therein, not being use in relation to goods connected in the course of trade with the proprietor or a registered user of the trade mark or (in the case of a certification trade mark) goods certified by the proprietor; or
- (b) that the article or substance was formerly manufactured under a patent, that a period of two years or more after the cesser of the patent has elapsed, and that the word or words is or are the

only practicable name or description of the article or substance,
subsection (2) shall have effect.

(2) Where the facts mentioned in subsection (1) (a) or (b) are proved with respect to any word or words, then —

(a) if the trade mark consists solely of that word or those words, the registration of the trade mark, so far as regards registration in respect of the article or substance in question or of any goods of the same description, shall be deemed for the purposes of section 39 to be an entry wrongly remaining on the register;

(b) if the trade mark contains that word or those words and other matter, the court or the Registrar, in deciding whether the trade mark shall remain on the register, so far as regards registration in respect of the article or substance in question and of any goods of the same description, may, in case of a decision in favour of its remaining on the register, require as a condition thereof that the proprietor shall disclaim any right to the exclusive use in relation to that article or substance and any goods of the same description of that word or those words, so however, that no disclaimer upon the register shall affect any rights of the proprietor of a trade mark except such as arise out of the registration of the trade mark in respect of which the disclaimer is made; and

(c) for the purposes of any other legal proceedings relating to the trade mark —

(i) if the trade mark consists solely of that word or those words, all rights of the proprietor to the exclusive use of the trade mark; or

(ii) if the trade mark contains that word or those words and other matter, all rights of the proprietor to the exclusive use of that word or those words,

in relation to the article or substance in question or to any goods of the same description, whether under the common law or by registration, shall

be deemed to have ceased on the date at which the use mentioned in subsection (1) (a) first became well-known and established, or at the expiration of the period of two years mentioned in subsection (1) (b).

(3) No word which is the commonly used and accepted name of any single chemical element or single chemical compound, as distinguished from a mixture, shall be registered as a trade mark in respect of a chemical substance or preparation.

(4) Subsection (3) shall not have effect in relation to a word which is used to denote only a brand or make of the element or compound as made by the proprietor or a registered user of the trade mark, as distinguished from the element or compound as made by others, and in association with a suitable name or description open to the public use.

Address
for service.

17. When an applicant for the registration of a trade mark or an agent does not reside or carry on business in Singapore he shall give the Registrar an address for service in Singapore, and if he fails to do so the Registrar may refuse to proceed with the application until such address has been given.

Advertis-
ment of
application.

18. When an application for registration of a trade mark has been accepted, whether absolutely or subject to conditions or limitations, the Registrar shall as soon as possible after its acceptance cause the application as accepted to be advertised in the prescribed manner. The advertisement shall set forth all conditions and limitations subject to which the application has been accepted:

Provided that the Registrar may cause an application for registration of a trade mark to be advertised before acceptance if it is made under section 10 (1) (e) or in any other case where it appears to him that it is expedient by reason of any exceptional circumstances to do so, and where an application has been so advertised the Registrar may, if he thinks fit, advertise it again when it has been accepted but shall not be bound to do so.

Opposition to
registration.

19.—(1) Any person may, within the prescribed time from the date of the advertisement of an application for the registration of a trade mark, give notice to the Registrar of opposition to the registration.

(2) The notice shall be given in writing in the prescribed manner, and shall include a statement of the grounds of opposition.

(3) The Registrar shall send a copy of the notice to the applicant, and within the prescribed time after receipt of the notice the applicant shall send to the Registrar in the prescribed manner a counter-statement of the grounds on which he relies for his application, and if he does not do so, he shall be deemed to have abandoned his application.

(4) If the applicant sends such a counter-statement the Registrar shall furnish a copy thereof to the persons giving notice of opposition, and shall after hearing the parties, if so required, and considering the evidence, decide whether, and subject to what conditions, or what limitations, registration is to be permitted.

(5) The decision of the Registrar shall be subject to appeal to the court.

(6) An appeal under this section shall be made in the prescribed manner, and on the appeal the court shall, if required, hear the parties and the Registrar, and shall make an order determining whether, and subject to what conditions, if any, or what limitations, if any, registration is to be permitted.

(7) On the hearing of any such appeal any party may either in the manner prescribed or by special leave of the court bring forward further material for the consideration of the court.

(8) On an appeal under this section no further grounds of objection to the registration of a trade mark shall be allowed to be taken by the opponent or the Registrar other than those stated by the opponent as hereinbefore provided, except by leave of the court. Where any further grounds of objection are taken the applicant shall be entitled to withdraw his application without payment of the costs of the opponent on giving notice as prescribed.

(9) In any appeal under this section, the court may, after hearing the Registrar, permit the trade mark proposed to be registered to be modified in any manner not substantially affecting the identity of the trade mark, but in such a case the trade mark as so modified shall be advertised in the prescribed manner before being registered.

(10) If a person giving notice of opposition or an applicant sending a counter-statement after receipt of a copy of such a notice, or an appellant, neither resides nor carries on business in Singapore, the court may require him to give security for costs of the proceedings before it relative to the opposition or to the appeal, as the case may be, and in default of such security being duly given may treat the opposition or application, or the appeal, as the case may be, as abandoned.

(11) An appeal shall lie from a decision of the court to the Court of Appeal.

Disclaimers.

20. If a trade mark contains parts not separately registered by the proprietor as trade marks, or if it contains matter common to the trade, or otherwise of a non-distinctive character, the Registrar or the court, in deciding whether the trade mark shall be entered or shall remain upon the register, may require as a condition of its being upon the register that the proprietor shall disclaim any right to the exclusive use of any part or parts of the trade mark, or of all or any portion of such matter, to the exclusive use of which the Registrar or the court holds him not to be entitled, or that he shall make such other disclaimer as the Registrar or the court may consider needful for the purpose of defining his rights under such registration:

Provided that no disclaimer on the register shall affect any rights of the proprietor of a trade mark except such as arise out of the registration of the trade mark in respect of which the disclaimer is made.

Date of registration.

21. When an application for registration of a trade mark in Part A or in Part B of the register has been accepted and has not been opposed, and the time for opposition has expired, or having been opposed the opposition has been decided in favour of the applicant, the Registrar shall, unless the application has been accepted in error, register the trade mark in Part A or Part B, as the case may be, and the trade mark when registered shall be registered as of the date of the application for registration, and that date shall be deemed for the purposes of this Act to be the date of registration.

Non-completion of registration.

22. Where the registration of a trade mark is not completed within 12 months from the date of the application by reason of default on the part of the applicant, the Registrar

may, after giving notice in writing of the non-completion to the applicant in the prescribed manner, treat the application as abandoned unless it is completed within the time specified in that behalf in the notice.

Identical trade marks

23. Except as provided by section 25, no trade mark shall be registered in respect of any goods or description of goods that is identical with one belonging to a different proprietor and already on the register in respect of the same goods or description of goods or so nearly resembling such a trade mark as to be likely to deceive or cause confusion.

Identical
trade
marks.

24. Where separate applications are made by different persons to be registered as proprietors respectively of trade marks which are identical or nearly resemble each other, in respect of the same goods or description of goods, the Registrar may refuse to register any of them until their rights have been determined by the court, or have been settled by agreement in a manner approved by him or by the court.

Rival
claims to
identical
trade
marks.

25. In case of honest concurrent user or of other special circumstances, which in the opinion of the court or of the Registrar make it proper to do so, the court or the Registrar may permit the registration of trade marks which are identical or nearly resemble each other for the same goods or description of goods, by more than one proprietor subject to such conditions and limitations, if any, as the court or the Registrar, as the case may be, may think it right to impose.

Concurrent
user.

26.—(1) Where a trade mark which is registered, or is the subject of an application for registration, in respect of any goods is identical with another trade mark which is registered, or is the subject of an application for registration, in the name of the same proprietor in respect of the same goods or description of goods, or so nearly resembles it as to be likely to deceive or cause confusion if used by a person other than the proprietor, the Registrar may at any time require that the trade marks shall be entered on the register as associated trade marks.

Association
of trade
marks.

(2) On application made in the prescribed manner by the registered proprietor of two or more associated trade

marks, the Registrar may dissolve the association as respects any of them if he is satisfied that there would be no likelihood of deception or confusion being caused if that trade mark were used by another person in relation to any of the goods in respect of which it is registered, and may amend the register accordingly.

(3) Any decision of the Registrar under this section shall be subject to appeal to the court.

Combined
trade
marks.

27. If the proprietor of a trade mark claims to be entitled to the exclusive use of any portion of the trade mark separately, he may apply to register the same as separate trade marks. Each such separate trade mark shall satisfy all the conditions and shall have all the incidents of an independent trade mark, except that when registered it and the trade mark of which it forms a part shall be deemed to be associated trade marks, and shall be entered on the register as such, but the user of the whole trade mark shall for the purposes of this Act be deemed to be also a user of such registered trade marks belonging to the same proprietor as it contains.

Series of
trade
marks.

28. When a person claiming to be the proprietor of several trade marks for the same goods or description of goods which, while resembling each other in the material particulars thereof, yet differ in respect of —

- (a) statements of the goods for which they are respectively used or proposed to be used;
- (b) statements of number, price, quality or names of places;
- (c) other matter of a non-distinctive character which does not substantially affect the identity of the trade mark; or
- (d) colour,

seeks to register those trade marks, they may be registered as a series in one registration. All trade marks so registered shall be deemed to be and shall be registered as associated trade marks.

Assignment
and user of
associated
trade
marks.

29. Associated trade marks shall be assignable or transmissible only as a whole and not separately, but they shall for all other purposes be deemed to have been registered as separate trade marks:

Provided that —

- (a) where under the provisions of this Act user of a registered trade mark is required to be proved for any purpose, the court or the Registrar may, if and so far as it or he thinks right, accept user of an associated registered trade mark, or of the trade mark with additions and alterations not substantially affecting its identity, as an equivalent for such user; and
- (b) the foregoing provisions apply in relation to proof of use of any registered trade mark and not in relation only to proof of use of a trade mark which is one of two or more associated trade marks.

30.—(1) Subject to this section, a person other than the proprietor of a trade mark may be registered as a registered user thereof in respect of all or any of the goods in respect of which it is registered (otherwise than as a defensive trade mark) and either with or without conditions or restrictions. Registered users.

The use of a trade mark by a registered user thereof in relation to goods with which he is connected in the course of trade and in respect of which for the time being the trade mark remains registered and he is registered as a registered user, being use such as to comply with any conditions or restrictions to which his registration is subject, is referred to in this Act as the “permitted use” thereof.

(2) The permitted use of a trade mark shall be deemed to be use by the proprietor thereof, and shall be deemed not to be use by a person other than the proprietor, for the purposes of section 40 and for any other purpose for which such use is material under this Act or at common law.

(3) Subject to any agreement subsisting between the parties, a registered user of a trade mark shall be entitled to call upon the proprietor thereof to take proceedings to prevent infringement thereof, and, if the proprietor refuses or neglects to do so within two months after being so called upon, the registered user may institute proceedings for infringement in his own name as if he were the proprietor, making the proprietor a defendant. A proprietor so added as defendant shall not be liable for any costs unless he enters an appearance and takes part in the proceedings.

(4) Where it is proposed that a person should be registered as a registered user of a trade mark, the proprietor and the proposed registered user shall apply in writing to the Registrar in the prescribed manner and shall furnish him with a statutory declaration made by the proprietor, or by some person authorised to act on his behalf and approved by the Registrar —

- (a) giving particulars of the relationship, existing or proposed, between the proprietor and the proposed registered user, including particulars showing the degree of control by the proprietor over the permitted use which their relationship will confer and whether it is a term of their relationship that the proposed registered user shall be the sole registered user or that there shall be any other restriction as to persons for whose registration as registered users application may be made;
- (b) stating the goods in respect of which registration is proposed;
- (c) stating any conditions or restrictions proposed with respect to the characteristics of the goods, to the mode or place of permitted use, or to any other matter; and
- (d) stating whether the permitted use is to be for a period or without limit of period, and, if for a period, the duration thereof,

and with such further documents, information or evidence as may be required under the rules made under this Act or by the Registrar.

(5) When the requirements of subsection (4) have been complied with, if the Registrar, after considering the information furnished to him under that subsection, is satisfied that in all the circumstances the use of the trade mark in relation to the proposed goods or any of them by the proposed registered user, subject to any conditions or restrictions which the Registrar thinks proper, would not be contrary to the public interest, the Registrar may register the proposed registered user as a registered user in respect of the goods as to which he is so satisfied subject as aforesaid.

(6) The Registrar shall refuse an application under this section if it appears to him that the grant thereof would tend to facilitate trafficking in a trade mark.

(7) The Registrar shall, if so required by an applicant, take steps for ensuring that information furnished for the purposes of an application under this section (other than matter entered in the register) is not disclosed to rivals in trade.

(8) Without prejudice to section 39, the registration of a person as a registered user —

(a) may be varied by the Registrar as regards the goods in respect of which, or any conditions or restrictions subject to which, it has effect, on the application in writing in the prescribed manner of the registered proprietor of the trade mark to which the registration relates;

(b) may be cancelled by the Registrar on the application in writing in the prescribed manner of the registered proprietor or of the registered user or of any other registered user of the trade mark;
or

(c) may be cancelled by the Registrar on the application in writing in the prescribed manner of any person on any of the following grounds:

(i) that the registered user has used the trade mark otherwise than by way of the permitted use, or in such a way as to cause, or to be likely to cause, deception or confusion;

(ii) that the proprietor or the registered user misrepresented, or failed to disclose, some fact material to the application for the registration, or that the circumstances have materially changed since the date of the registration;

(iii) that the registration ought not to have been effected having regard to rights vested in the applicant by virtue of a contract in the performance of which he is interested.

(9) Provision shall be made by rules made under this Act for the notification of the registration of a person as a

registered user to any other registered user of the trade mark, and for the notification of any application under subsection (8) to the registered proprietor and each registered user (not being the applicant) of the trade mark, and for giving to the applicant on such an application and to all persons to whom such application is notified and who intervene in the proceedings in accordance with those rules an opportunity of being heard.

(10) The Registrar may at any time cancel the registration of a person as a registered user of a trade mark in respect of any goods in respect of which the trade mark is no longer registered.

(11) Any decision of the Registrar under this section shall be subject to appeal to the court.

(12) Where a person is registered as a registered user of a trade mark on an application made within 6 months from the commencement of this Part, subsection (2) shall have effect in relation to any previous use (whether before or after the commencement of this Act) of the trade mark by that person, being use in relation to the goods in respect of which he is registered and, where he is registered subject to conditions or restrictions, being use such as to comply substantially therewith, as if such previous use had been permitted use.

(13) Nothing in this section shall confer on a registered user of a trade mark any assignable or transmissible right to the use thereof.

PART III

ISSUE OF CERTIFICATE

31. On the registration of a trade mark the Registrar shall issue to the applicant a certificate in the prescribed form of the registration of such trade mark under the seal of the Registrar.

Renewal of registration

32. The registration of a trade mark shall be for a period of 7 years but may be renewed from time to time in accordance with the provisions of this Act.

33. Without prejudice to the operation of section 32, relating to the duration of registration and renewal thereof, in any case where under the provisions of this Act any

Certificate of registration.

Duration of registration.

Exclusion of enemy occupation period.

period of time is stated for the doing or refraining from doing any act then in computing any such period of time the period between 15th February 1942 and 1st October 1947 shall be excluded.

34. The Registrar shall, on application made by the registered proprietor of a trade mark in the prescribed manner and within the prescribed period, renew the registration of the trade mark for a period of 14 years from the expiration of the original registration or of the last renewal of registration, as the case may be, which date is herein termed “the expiration of the last registration”.

Renewal of registration.

35. At the prescribed time before the expiration of the last registration of a trade mark, the Registrar shall send notice in the prescribed manner to the registered proprietor of the date at which the existing registration will expire and the conditions as to payment of fee and otherwise upon which a renewal of registration may be obtained, and if at the expiration of the time prescribed in that behalf those conditions have not been duly complied with, the Registrar may remove the trade mark from the register, subject to such conditions, if any, as to its restoration as may be prescribed.

Procedure on expiry of period of registration.

36.—(1) Where a trade mark has been removed from the register for non-payment of the fee for renewal, the trade mark shall nevertheless, for the purpose of an application for registration during one year next after the date of the removal, be deemed to be a trade mark which is already registered.

Status of unrenewed trade marks.

(2) Subsection (1) shall not have effect when the Registrar is satisfied either —

- (a) that there has been no bona fide trade use of the trade mark which has been removed during the two years immediately preceding its removal; or
- (b) that no deception or confusion would be likely to arise from the use of the trade mark which is the subject of the application for registration by reason of any previous use of the trade mark which has been removed.

*Correction and rectification of register*Correction
of register.

37.—(1) The Registrar may, on request made in the prescribed manner by the registered proprietor —

- (a) correct any error in the name, address or description of the person who is registered as proprietor of a trade mark;
- (b) enter any change in the name or address of the person who is registered as proprietor of a trade mark;
- (c) cancel the entry of a trade mark on the register;
- (d) strike out any goods or classes of goods from those for which a trade mark is registered; or
- (e) enter a disclaimer or memorandum relating to a trade mark which does not in any way extend the rights given by the existing registration of the trade mark.

(2) The Registrar may, on request made in the prescribed manner by a registered user of a trade mark, correct any error, or enter any change, in the name, address or description of the registered user.

(3) Any decision of the Registrar under this section shall be subject to appeal to the court.

Alteration of
registered
trade
mark.

38.—(1) The registered proprietor of any trade mark may apply in the prescribed manner to the Registrar for leave to add to or alter the trade mark in any manner not substantially affecting the identity thereof, and the Registrar may refuse leave or may grant it on such terms and subject to such limitations as he may think fit.

(2) The Registrar may cause an application under this section to be advertised in the prescribed manner in any case where it appears to him that it is expedient to do so and, where he does so, if within the prescribed time from the date of the advertisement any person gives notice to the Registrar in the prescribed manner of opposition to the application, the Registrar shall, after hearing the parties if so required, decide the matter.

(3) Any decision of the Registrar under this section shall be subject to appeal to the court.

(4) Where leave as aforesaid is granted, the trade mark as altered shall be advertised in the prescribed manner,

unless it has already been advertised, in the form to which it has been altered, in an advertisement under subsection (2).

39.—(1) Subject to the provisions of this Act —

Rectification
of register.

- (a) the court may on the application in the prescribed manner of any person aggrieved by the non-insertion in or omission from the register of any entry, or by any entry made in the register without sufficient cause, or by any entry wrongfully remaining on the register, or by any error or defect in any entry in the register, make such order for making, expunging or varying the entry as it thinks fit;
- (b) the court may in any proceeding under this section decide any question that it may be necessary or expedient to decide in connection with the rectification of the register;
- (c) in case of fraud in the registration, assignment or transmission of a registered trade mark the Registrar may himself apply to the court under this section;
- (d) any order of the court rectifying the register shall direct that notice of the rectification be served on the Registrar in the prescribed manner, and the Registrar shall, upon receipt of the notice, rectify the register accordingly.

(2) The power to rectify the register conferred by this section includes power to remove a registration in Part A of the register to Part B of the register.

40.—(1) Subject to section 41, a registered trade mark may be taken off the register in respect of any of the goods in respect of which it is registered on application by any person aggrieved to the court, on the ground either —

Provisions as
to non-use
of trade
mark.

- (a) that the trade mark was registered without any bona fide intention on the part of the applicant for registration that it should be used in relation to those goods by him or, if it was registered under section 11 (7) by the corporation or registered user concerned, and that there has in fact been no bona fide use of the trade mark in relation to those goods by any proprietor

thereof for the time being up to the date one month before the date of the application; or

- (b) that up to the date one month before the date of the application a continuous period of 5 years or longer had elapsed during which the trade mark was a registered trade mark and during which there was no bona fide use thereof in relation to those goods by any proprietor thereof for the time being:

Provided that (except where the applicant has been permitted under section 25 to register an identical or nearly resembling trade mark in respect of the goods in question or where the court is of opinion that he might properly be permitted so to register such a trade mark) the court may refuse an application made under paragraph (a) or (b) in relation to any goods, if it is shown that there has been, before the relevant date or during the relevant period, as the case may be, bona fide use of the trade mark by any proprietor thereof for the time being in relation to goods of the same description, being goods in respect of which the trade mark is registered.

(2) Where in relation to any goods in respect of which a trade mark is registered —

- (a) the matters referred to in subsection (1) (b) are shown so far as regards non-use of the trade mark in relation to goods to be sold, or otherwise traded in, in Singapore (otherwise than for export from Singapore), or in relation to goods to be exported to a particular market outside Singapore; and

- (b) a person has been permitted under section 25 to register an identical or nearly resembling trade mark in respect of those goods under a registration extending to use in relation to goods to be sold, or otherwise traded in, in Singapore (otherwise than for export from Singapore), or in relation to goods to be exported to that market, or the court is of opinion that he might properly be permitted so to register such a trade mark,

on application by that person to the court, the court may impose on the registration of the first-mentioned trade mark

such limitations as it thinks proper for securing that that registration shall cease to extend to such use as last aforesaid.

(3) An applicant shall not be entitled to rely for the purposes of subsection (1) (b), or for the purposes of subsection (2), on any non-use of a trade mark which is shown to have been due to special circumstances in the trade and not to any intention not to use or to abandon the trade mark in relation to the goods to which the application relates.

41.—(1) Where a trade mark consisting of an invented word or invented words has become so well known as respects any goods in respect of which it is registered and in relation to which it has been used that the use thereof in relation to other goods would be likely to be taken as indicating a connection in the course of trade between those goods and a person entitled to use the trade mark in relation to the first-mentioned goods, then, notwithstanding that the proprietor registered in respect of the first-mentioned goods does not use or propose to use the trade mark in relation to those other goods and notwithstanding anything in the last foregoing section, the trade mark may, on the application in the prescribed manner of the proprietor registered in respect of the first-mentioned goods, be registered in his name in respect of those other goods as a defensive trade mark and, while so registered, shall not be liable to be taken off the register in respect of those goods under section 40.

Defensive
trade
marks.

(2) The registered proprietor of a trade mark may apply for the registration thereof in respect of any goods as a defensive trade mark notwithstanding that it is already registered in his name in respect of those goods otherwise than as a defensive trade mark, or may apply for the registration thereof in respect of any goods otherwise than as a defensive trade mark notwithstanding that it is already registered in his name in respect of those goods as a defensive trade mark, in lieu in each case of the existing registration.

(3) A trade mark registered as a defensive trade mark and that trade mark as otherwise registered in the name of the same proprietor shall, notwithstanding that the respective registrations are in respect of different goods, be

deemed to be, and shall be registered as, associated trade marks.

(4) On application by any person aggrieved to the court, the registration of a trade mark as a defensive trade mark may be cancelled on the ground that the requirements of subsection (1) are no longer satisfied in respect of any goods in respect of which the trade mark is registered in the name of the same proprietor otherwise than as a defensive trade mark, or may be cancelled as respects any goods in respect of which it is registered as a defensive trade mark on the ground that there is no longer any likelihood that the use of the trade mark in relation to those goods would be taken as giving the indication mentioned in subsection (1).

(5) The Registrar may at any time cancel the registration as a defensive trade mark of a trade mark of which there is no longer any registration in the name of the same proprietor otherwise than as a defensive trade mark.

(6) Except as otherwise expressly provided in this section, the provisions of this Act apply in respect of the registration of trade marks as defensive trade marks and of trade marks so registered as they apply in other cases.

Assignment
and
transmission
of trade
marks.

42.—(1) Notwithstanding any rule of law or equity to the contrary, a registered trade mark shall be, and shall be deemed always to have been, assignable and transmissible either in connection with the goodwill of a business or not.

(2) A registered trade mark shall be, and shall be deemed always to have been, assignable and transmissible in respect either of all the goods in respect of which it is registered, or was registered, as the case may be, or of some (but not all) of those goods.

(3) Subsections (1) and (2) shall have effect in the case of an unregistered trade mark used in relation to any goods as they have effect in the case of a registered trade mark registered in respect of any goods, if at the time of the assignment or transmission of the unregistered trade mark it is or was used in the same business as a registered trade mark, and if it is or was assigned or transmitted at the same time and to the same person as that registered trade mark and in respect of goods all of which are goods in relation to which the unregistered trade mark is or was used in that

business and in respect of which that registered trade mark is or was assigned or transmitted.

(4) Notwithstanding anything in subsections (1) to (3), a trade mark shall not be, or be deemed to have been, assignable or transmissible in a case in which, as a result of an assignment or transmission, there would in the circumstances subsist, or have subsisted, whether under the common law or by registration, exclusive rights in more than one of the persons concerned to the use, in relation to the same goods or description of goods, of trade marks nearly resembling each other or of identical trade marks, if, having regard to the similarity of the goods and of the trade marks, the use of the trade marks in exercise of those rights would be or have been likely to deceive or cause confusion:

Provided that, where a trade mark is or has been assigned or transmitted in such a case as aforesaid, the assignment or transmission shall not be deemed to be or to have been invalid under this subsection if the exclusive rights subsisting as a result thereof in the persons concerned respectively are or were, having regard to limitations imposed thereon, such as not to be exercisable by two or more of those persons in relation to goods to be sold or otherwise traded in within Singapore (otherwise than for export therefrom), or in relation to goods to be exported to the same market outside Singapore.

(5) The proprietor of a registered trade mark who proposes to assign it in respect of any goods in respect of which it is registered may submit to the Registrar in the prescribed manner a statement of case setting out the circumstances, and the Registrar may issue to him a certificate stating whether, having regard to the similarity of the goods and of the trade marks referred to in the case, the proposed assignment of the first-mentioned trade mark would or would not be invalid under subsection (4), and a certificate so issued shall, subject to this section as to appeal and unless it is shown that the certificate was obtained by fraud or misrepresentation, be conclusive as to the validity or invalidity under subsection (4) of the assignment in so far as such validity or invalidity depends upon the facts set out in the case, but, as regards a certificate in favour of validity, only if application for the registration under section 43 of the title of the person becoming entitled is made within 6 months from the date on which the certificate is issued.

(6) In a case in which as a result of an assignment or transmission of a trade mark there would in the circumstances subsist, or have subsisted, whether under the common law or by registration, an exclusive right in one of the persons concerned to the use of the trade mark limited to use in relation to goods to be sold or otherwise traded in, in a place or places in Singapore, and an exclusive right in another of those persons to the use of a trade mark nearly resembling the first-mentioned trade mark or of an identical trade mark in relation to the same goods or description of goods limited to use in relation to goods to be sold or otherwise traded in, in another place or other places in Singapore, the following provisions shall have effect:

- (a) notwithstanding anything in subsections (1) to (3), a trade mark shall not, after the commencement of this Act, be assignable or transmissible in any such case:

Provided that, on application in the prescribed manner by the proprietor of a trade mark who proposes to assign it, or of a person who claims that a trade mark has been transmitted to him or to a predecessor in title of his since the commencement of this Act, in any such case, the Registrar, if he is satisfied that in all the circumstances the use of the trade mark in exercise of those rights would not be contrary to the public interest, may approve the assignment or transmission, and an assignment or transmission so approved shall not be deemed to be or to have been invalid under this paragraph or under subsection (4), so, however, that in the case of a registered trade mark this provision shall not have effect unless application for the registration under section 43 of the title of the person becoming entitled is made within 6 months from the date on which the approval is given or, in the case of a transmission, was made before that date;

- (b) the validity of an assignment or transmission effected or claimed to have been effected before the commencement of this Act in any such case shall be determined as if this section had not been enacted:

Provided that on application made in the prescribed manner within two years from the commencement of this Act by a person who claims that an assignment or transmission of a registered trade mark to him or to a predecessor in title of his has been so effected, the Registrar shall have the like jurisdiction as under the proviso to paragraph (a), and an assignment or transmission approved by him shall not be deemed to have been invalid on the ground of the subsistence of such rights as aforesaid, or on the ground that the assignment or transmission was effected otherwise than in connection with the goodwill of a business or was effected in respect of some (but not all) of the goods in respect of which the trade mark was registered, if application for registration of the title is made within 6 months from the date on which the approval is given or was made before that date.

(7) Where an assignment, in respect of any goods of a trade mark that is at the time of the assignment used in a business in those goods, is made after the commencement of this Act otherwise than in connection with the goodwill of that business, the assignment shall not take effect until the following requirements have been satisfied, that is to say, the assignee shall, not later than the expiration of 6 months from the date on which the assignment is made or within such extended period, if any, as the Registrar may allow, apply to him for directions with respect to the advertisement of the assignment, and shall advertise it in such form and manner and within such period as the Registrar may direct.

(8) Any decision of the Registrar under this section shall be subject to appeal to the court.

43.—(1) Where a person becomes entitled by assignment or transmission to a registered trade mark, he shall make application to the Registrar to register his title, and the Registrar shall, on receipt of the application and on proof of title to his satisfaction, register him as the proprietor of the trade mark in respect of the goods in respect of which the assignment or transmission has effect, and shall cause particulars of the assignment or transmission to be entered on the register. Any decision of the Registrar under this section shall be subject to appeal to the court.

Registration
of
assignments.

(2) Except in cases of appeals under this section and applications made under section 39, a document or instrument in respect of which no entry has been made in the register in accordance with subsection (1) shall not be admitted in evidence in any court in proof of the title to a trade mark unless the court otherwise directs.

PART IV

EFFECT OF REGISTRATION

Powers of registered proprietor.

44. Subject to the provisions of this Act —

- (a) the person for the time being entered in the register as proprietor of a trade mark shall, subject to any rights appearing from the register to be vested in any other person, have power to assign the trade mark and give effectual receipts for any consideration for such an assignment;
- (b) any equities in respect of a trade mark may be enforced in like manner as in respect of any other personal property.

Effect of registration in Part A of register.

45.—(1) Subject to this section, and sections 48 and 52, the registration of a person in Part A of the register as proprietor of a trade mark (other than a certification trade mark) in respect of any goods shall, if valid, give or be deemed to have given to that person the exclusive right to the use of the trade mark in relation to those goods and, without prejudice to the generality of the foregoing words, that right shall be deemed to be infringed by any person who, not being the proprietor of the trade mark or a registered user thereof using by way of the permitted use, uses a mark identical with it or so nearly resembling it as to be likely to deceive or cause confusion in the course of trade, in relation to any goods in respect of which it is registered, and in such manner as to render the use of the mark likely to be taken either —

- (a) as being use as a trade mark; or
- (b) in a case in which the use is use upon the goods or in physical relation thereto 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 with which such a person as aforesaid is connected in the course of trade.

(2) The right to the use of a trade mark given by registration as aforesaid shall be subject to any conditions or limitations entered on the register, and shall not be deemed to be infringed by the use of any such mark as aforesaid in any mode, in relation to goods to be sold or otherwise traded in, in any place, in relation to goods to be exported to any market, or in any other circumstances, to which, having regard to any such limitations, the registration does not extend.

(3) The right to the use of a trade mark given by registration as aforesaid shall not be deemed to be infringed by the use of any such mark as aforesaid by any person —

(a) in relation to goods connected in the course of trade with the proprietor or a registered user of the trade mark if, as to those goods or a bulk of which they form part, the proprietor or the 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; or

(b) in relation to goods adapted to form part of, or to be accessory to, other goods in relation to which the trade mark has been used without infringement of the right given as aforesaid or might for the time being be so used, if the use of the mark is reasonably necessary in order to indicate that the goods are so adapted and neither the purpose nor the effect of the use of the mark is to indicate otherwise than in accordance with the facts a connection in the course of trade between any person and the goods.

(4) The use of a registered trade mark, being one of two or more registered trade marks which are identical or nearly resemble each other, in exercise of the right to the use of that trade mark given by registration as aforesaid, shall not be deemed to be an infringement of the right so given to the use of any other of those trade marks.

Effect of registration in Part B of register.

46.—(1) Except as provided by subsection (2) and by section 12 (2), the registration of a person in Part B of the register as proprietor of a trade mark in respect of any goods shall, if valid, give or be deemed to have given to that person the like right in relation to those goods as if the registration had been in Part A of the register, and section 45 shall have effect in like manner in relation to a trade mark registered in Part B of the register as it has effect in relation to a trade mark registered in Part A of the register.

(2) In any action for infringement of the right to the use of a trade mark given by registration as aforesaid in Part B of the register, 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 and some person having the right either as proprietor or as registered user to use the trade mark.

Registration prima facie evidence of validity.

47. In all legal proceedings relating to a trade mark registered under this Act (including applications under section 39) the fact that a person is registered as proprietor of the trade mark shall be prima facie evidence of the validity of the original registration of the trade mark and of all subsequent assignments and transmissions thereof.

Registration conclusive after 7 years.

48. In all legal proceedings relating to a trade mark registered under this Act in Part A of the register (including applications under section 39) the original registration in Part A of the register of the trade mark shall after the expiration of 7 years from the date of the original registration be taken to be valid in all respects unless the original registration was obtained by fraud or unless the trade mark offends against section 15:

Provided that nothing in this Act shall entitle the proprietor or a registered user of a registered trade mark to interfere with or restrain the use by any person of a trade mark identical with or nearly resembling it in relation to goods in relation to which that person or a predecessor in title of his has continuously used that trade mark from a date anterior —

(a) to the use of the first-mentioned trade mark in relation to those goods by the proprietor or a predecessor in title of his; or

(b) to the registration of the first-mentioned trade mark in respect of those goods in the name of the proprietor or a predecessor in title of his, whichever is the earlier, or to object (on such use being proved) to that person being put on the register for that identical or nearly resembling trade mark in respect of those goods under section 25.

49. No person shall be entitled to institute any proceeding to prevent or to recover damages for the infringement of an unregistered trade mark. Unregistered trade mark.

50. In any action or proceeding relating to a trade mark or trade name the tribunal shall admit evidence of the usages of the trade concerned and of any relevant trade mark or trade name or get-up legitimately used by other persons. Infringe-ment.

51.—(1) Where, by a contract in writing made with the proprietor or a registered user of a registered trade mark, a purchaser or owner of goods enters into an obligation to the effect that he will not do, in relation to the goods, an act to which this section applies, any person who, being the owner for the time being of the goods and having notice of the obligation, does that act, or authorises it to be done, in relation to the goods in the course of trade or with a view to any dealing therewith in the course of trade, shall be deemed thereby to infringe the right to the use of the trade mark given by the registration thereof, unless that person became the owner of the goods by purchase for money or money's worth in good faith before receiving notice of the obligation or by virtue of a title derived through another who so became the owner thereof. Infringement of trade mark by breach of certain restrictions.

(2) The acts to which this section applies are —

- (a) the application of the trade mark upon the goods after they have suffered alteration in any manner specified in the contract as respects their state or condition, get-up or packing;
- (b) in a case in which the trade mark is upon the goods, the alteration, partial removal or partial obliteration thereof;
- (c) in a case in which the trade mark is upon the goods, and there is also thereon other matter, being

matter indicating a connection in the course of trade between the proprietor or registered user and the goods, the removal or obliteration, whether wholly or partially, of the trade mark unless that other matter is wholly removed or obliterated;

- (d) in a case in which the trade mark is upon the goods, the application of any other trade mark to the goods; and
- (e) in a case in which the trade mark is upon the goods, the addition to the goods of any other matter in writing that is likely to injure the reputation of the trade mark.

(3) Section 46 (2) does not apply to an act that is deemed by virtue of this section to be an infringement of a trade mark registered in Part B of the register.

(4) In this section references in relation to any goods to the proprietor, to a registered user, and to the registration, of a trade mark shall be construed, respectively, as references to the proprietor in whose name the trade mark is registered, to a registered user who is registered, and to the registration of the trade mark, in respect of those goods, and the expression “upon” includes in relation to any goods a reference to physical relation thereto.

User of name, address or description of goods.

52. No registration of a trade mark shall interfere with —

- (a) 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; or
- (b) the use by any person of any bona fide description of the character or quality of his goods, 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).

“Passing off” action.

53. Nothing in this Act shall be deemed to affect rights of action against any person for passing off goods as those of another person or the remedies in respect thereof.

PART V

LEGAL PROCEEDINGS

54. In any legal proceeding in which the validity of a registered trade mark comes into question and is decided in favour of the proprietor of the trade mark, the court may certify the same, and if it so certifies then in any subsequent legal proceeding in which such validity comes into question the proprietor of the trade mark on obtaining a final order or judgment in his favour shall have his full costs, charges and expenses as between solicitor and client, unless in the subsequent proceeding the court certifies that he ought not to have them.

Certificate of validity in legal proceedings.

55. In any legal proceeding in which the relief sought includes alteration or rectification of the register, the Registrar shall have the right to appear and be heard, and shall appear if so directed by the court. Unless otherwise directed by the court, the Registrar in lieu of appearing and being heard may submit to the court a statement in writing signed by him, giving particulars of the proceedings before him in relation to the matter in issue or of the grounds of any decision given by him affecting it or of the practice of the office in like cases, or of such other matters relevant to the issues, and within his knowledge as Registrar, as he thinks fit, and the statement shall be deemed to form part of the evidence in the proceeding.

Registrar to have notice of proceeding for rectification.

Costs

56.—(1) In all proceedings before the court under this Act, the court may award to any party such costs as it may consider reasonable and the costs of the Registrar shall be in the discretion of the court, but the Registrar shall not be ordered to pay the costs of any other of the parties.

Costs of proceedings before court.

(2) In all proceedings before the Registrar, the Registrar shall have power to award to any party such costs as he may consider reasonable, and to direct how and by what parties they are to be paid, and any such order may, by leave of the court or a judge thereof, be enforced in the same manner as a judgment or order of the court to the same effect.

Evidence

57. In any proceeding under this Act before the Registrar, the evidence shall be given by statutory declaration in the absence of directions to the contrary, but, in any

Mode of giving evidence.

case in which he thinks it right to do so, the Registrar may take evidence *viva voce* in lieu of or in addition to evidence by declaration. Any such statutory declaration may in the case of appeal be used before the court in lieu of evidence by affidavit, but if so used shall have all the incidents and consequences of evidence by affidavit.

In case any part of the evidence is taken *viva voce* the Registrar shall in respect of requiring the attendance of witnesses and taking evidence on oath be in the same position in all respects as a referee appointed by the court under section 21 of the Arbitration Act.

Cap. 10.

Scaled
copies to
be evidence.
U.K. 1938
c. 22.

58. Printed or written copies or extracts of or from the register, or of or from the register kept in the United Kingdom under the Trade Marks Act 1938 purporting to be certified by the Registrar and sealed with his seal, or purporting to be certified by the Comptroller-General of Patents Designs and Trade Marks and sealed with the seal of the Patent Office, shall be admitted in evidence in all courts and in all proceedings, without further proof or production of the originals.

Certificate
of Registrar
to be
evidence.

59. A certificate purporting to be under the hand of the Registrar, or of the Comptroller-General of Patents Designs and Trade Marks as to any entry, matter or thing which he is authorised to make or do, shall be *prima facie* evidence of the entry having been made, and of the contents thereof, and of the matter or thing having been done or not done.

Discretionary
powers.

60. In any appeal from the decision of the Registrar to the court under this Act, the court shall have and exercise the same discretionary powers as under this Act are conferred upon the Registrar.

Rectification
of register.

61.—(1) Any application for the rectification of the register which, under section 16, 39 or 40, is to be made to the court may, at the option of the applicant, be made in the first instance to the Registrar:

Provided that no such application shall be made otherwise than to the court where an action concerning the trade mark in question is pending.

(2) The Registrar may, at any stage of the proceedings, refer any such application to the court or he may, after hearing the parties, determine the question between them, subject to appeal to the court.

Registrar may refer application to court or determine question.

(3) In any proceedings for rectification of the register under this Act, the court or the Registrar shall, in addition to the other powers conferred by this Act, have power to direct a trade mark entered in Part A of the register to be removed to Part B of the register.

Removal of trade marks from Part A to Part B.

PART VI

GENERAL

62. Where any discretionary or other power is given to the Registrar by this Act or by any rules made thereunder he shall not exercise that power adversely to the applicant for registration or the registered proprietor of the trade mark in question without (if duly required to do so within the prescribed time) giving to the applicant or registered proprietor an opportunity of being heard.

Exercise of discretionary power of Registrar.

63. Except where expressly provided by this Act or any rules made thereunder, there shall be no appeal from a decision of the Registrar, but the court, in dealing with any question of the rectification of the register (including all applications under section 39), shall have power to review any decision of the Registrar relating to the entry in question or the correction sought to be made.

Appeal from Registrar.

64. Where by this Act any act has to be done by or to any person in connection with a trade mark or proposed trade mark or any proceeding relating thereto, the act may under and in accordance with any rules made under this Act or in particular cases by special leave of the Registrar be done by or to an agent of that person duly authorised in the prescribed manner.

Recognition of agents.

65.—(1) The power to give to a person who proposes to apply for the registration of a trade mark in Part A or Part B of the register advice as to whether the trade mark appears to the Registrar *prima facie* to be inherently adapted to distinguish, or capable of distinguishing, as the case may be, shall be a function of the Registrar under this Act.

Preliminary advice by Registrar as to distinctiveness.

(2) Any such person who is desirous of obtaining such advice shall make application to the Registrar therefor in the prescribed manner.

(3) If on an application for the registration of a trade mark as to which the Registrar has given advice as aforesaid in the affirmative, made within 3 months after the advice is given, the Registrar, after further investigation or consideration, gives notice to the applicant of objection on the ground that the trade mark is not adapted to distinguish, or capable of distinguishing, as the case may be, the applicant shall be entitled, on giving notice of withdrawal of the application within the prescribed period, to have repaid to him any fee paid on the filing of the application.

Power to
make rules.

66.—(1) Subject to the provisions of this Act, the Minister may make such rules, prescribe such forms, and generally do such things as he may consider expedient —

- (a) for regulating the practice (other than that relating to proceedings before the court or connected therewith) under this Act including the service of documents;
- (b) for classifying goods for the purposes of registration of trade marks;
- (c) for making or requiring duplicates of trade marks and other documents;
- (d) for securing and regulating the publishing and selling or distributing in such manner as the Minister may think fit, of copies of trade marks and other documents;
- (e) generally, for regulating the business of the office in relation to trade marks and all things by this Act placed under the direction or control of the Registrar;
- (f) generally, for adjusting any matter or practice which may be prescribed or governed by rules made under this section so that the period between 15th February 1942 and 1st October 1947 may be excluded or equitably accounted for, and any such adjustments may be made with retrospective effect.

(2) All rules made under this section shall be published in the *Gazette* and shall be presented to Parliament as soon as

possible after publication and if a resolution is passed pursuant to a motion notice whereof has been given for a sitting day not later than the first available sitting day of Parliament next after the expiry of 3 months from the date when the rules are so presented annulling the rules or any part thereof as from a specified date, the rules or such part thereof, as the case may be, shall thereupon become void as from that date but without prejudice to the validity of anything previously done thereunder or to the making of new rules.

(3) Subject to the provisions of this Act, the Rules Committee constituted under section 80 of the Supreme Court of Judicature Act may make Rules of Court regulating the practice and procedure in relation to proceedings before the court or connected therewith, and the costs of such proceedings. Cap. 322.

67. There shall be paid in respect of applications and registration and other matters under this Act, such fees as the Minister may from time to time prescribe. Fees.

68.—(1) A mark adapted in relation to any goods to distinguish in the course of trade goods certified by any person in respect of origin, material, mode of manufacture, quality, accuracy or other characteristic, from goods not so certified shall be registrable as a certification trade mark in Part A of the register in respect of those goods in the name, as proprietor thereof, of that person. Certification trade marks.

Provided that a mark shall not be so registrable in the name of a person who carries on a trade in goods of the kind certified.

In determining whether a mark is adapted to distinguish as aforesaid, the Registrar may have regard to the extent to which —

- (a) the mark is inherently adapted to distinguish as aforesaid in relation to the goods in question; and
- (b) by reason of the use of the mark or of any other circumstances, the mark is in fact adapted to distinguish as aforesaid in relation to the goods in question.

(2) Subject to subsections (3) to (5), and sections 48 and 52, the registration of a person as proprietor of a

certification trade mark in respect of any goods shall, if valid, give to that person the exclusive right to the use of the trade mark in relation to those goods, and, without prejudice to the generality of the foregoing words, that right shall be deemed to be infringed by any person who, not being the proprietor of the trade mark or a person authorised by him under the regulations in that behalf using it in accordance therewith, uses a mark identical with it or so nearly resembling it as to be likely to deceive or cause confusion in the course of trade, in relation to any goods in respect of which it is registered, and in such manner as to render the use of the mark likely to be taken either —

(a) as being use as a trade mark; or

(b) in a case in which the use is use upon the goods or in physical relation thereto 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 by his authorisation under the relevant regulations to use the trade mark or to goods certified by the proprietor.

(3) The right to the use of a certification trade mark given by registration as aforesaid shall be subject to any conditions or limitations entered on the register, and shall not be deemed to be infringed by the use of any such mark as aforesaid in any mode, in relation to goods to be sold or otherwise traded in, in any place, in relation to goods to be exported to any market, or in any other circumstances to which, having regard to any such limitations, the registration does not extend.

(4) The right to the use of a certification trade mark given by registration as aforesaid shall not be deemed to be infringed by the use of any such mark as aforesaid by any person —

(a) in relation to goods certified by the proprietor of the trade mark if, as to those goods or a bulk of which they form part, the proprietor or another in accordance with his authorisation under the relevant regulations has applied the trade mark and has not subsequently removed or obliterated it, or the proprietor has at any time expressly or impliedly consented to the use of the trade mark; or

- (b) in relation to goods adapted to form part of, or to be accessory to, other goods in relation to which the trade mark has been used without infringement of the right given as aforesaid or might for the time being be so used, if the use of the mark is reasonably necessary in order to indicate that the goods are so adapted and neither the purpose nor the effect of the use of the mark is to indicate otherwise than in accordance with the fact that the goods are certified by the proprietor:

Provided that paragraph (a) shall not have effect in the case of use consisting of the application of any such mark as aforesaid to any goods, notwithstanding that they are such goods as are mentioned in that paragraph, if the application is contrary to the relevant regulations.

(5) Where a certification trade mark is one of two or more registered trade marks which are identical or nearly resemble each other, the use of any of those trade marks in exercise of the right to the use of that trade mark given by registration shall not be deemed to be an infringement of the right so given to the use of any other of those trade marks.

(6) An application for the registration of a mark under this section shall be made to the Registrar in writing in the prescribed manner by the person proposed to be registered as the proprietor thereof.

(7) Section 11 (2) to (6) shall have effect in relation to an application under this section as it has effect in relation to an application under section 11 (1).

(8) In dealing under section 11 (2) to (6) with an application under this section the Registrar shall have regard to the like considerations, so far as relevant, as if the application were an application under section 11 and to any other considerations relevant to applications under this section, including the desirability of securing that a certification trade mark shall comprise some indication that it is such a trade mark.

(9) An applicant for the registration of a mark under this section shall transmit to the Registrar draft regulations for governing the use thereof, which shall include provisions as

to the cases in which the proprietor is to certify goods and to authorise the use of the trade mark, and may contain any other provisions that the Registrar may require or permit to be inserted therein (including provisions conferring a right of appeal to the Registrar against any refusal of the proprietor to certify goods or to authorise the use of the trade mark in accordance with the regulations). Such regulations, if approved, shall be deposited with the Registrar and shall be open to inspection in like manner as the register.

(10) The Registrar shall consider the application with regard to the following matters:

- (a) whether the applicant is competent to certify the goods in respect of which the mark is to be registered;
- (b) whether the draft regulations are satisfactory; and
- (c) whether in all the circumstances the registration applied for would be to the public advantage;

and may either —

- (i) refuse to accept the application; or
- (ii) accept the application and approve the regulations, either without modification and unconditionally or subject to any conditions or limitations, or to any amendments or modifications of the application or of the regulations, which he may think requisite having regard to any of the matters aforesaid,

but, except in the case of acceptance and approval without modification and unconditionally, the Registrar shall not decide the matter without giving to the applicant an opportunity of being heard:

Provided that the Registrar may, at the request of the applicant, consider the application with regard to any of the matters aforesaid, except that the Registrar shall be at liberty to reconsider any matter on which he has given a decision under this proviso if any amendment or modification is thereafter made in the application or in the draft regulations.

(11) When an application has been accepted, the Registrar shall, as soon as possible after such acceptance, cause the application as accepted to be advertised in the prescribed manner, and section 19 shall have effect in

relation to the registration of the mark as if the application had been an application under section 11:

Provided that, in deciding under those provisions, the Registrar shall have regard only to the considerations referred to in subsection (8), and a decision under those provisions in favour of the applicant shall be conditional on the determination in his favour by the Registrar under subsection (12) of any opposition relating to any of the matters referred to in subsection (10).

(12) When notice of opposition is given relating to any of the matters referred to in subsection (10), the Registrar shall, after hearing the parties, if so required, and considering any evidence, decide whether, and subject to what conditions or limitations, or amendments or modifications of the application or of the regulations, if any, registration is, having regard to those matters, to be permitted.

(13) (a) The regulations deposited in respect of a certification trade mark may, on the application of the registered proprietor, be altered by the Registrar.

(b) The Registrar may cause an application for his consent to be advertised in any case where it appears to him that it is expedient to do so, and, where the Registrar causes an application to be advertised, if within the prescribed time from the date of the advertisement any person gives notice to the Registrar of opposition to the application, the Registrar shall not decide the matter without giving the parties an opportunity of being heard.

(14) (a) The court may, on the application in the prescribed manner of any person aggrieved, or on the application of the Registrar, make such order as it thinks fit for expunging or varying any entry in the register relating to a certification trade mark, or for varying the deposited regulations, on the ground —

- (i) that the proprietor is no longer competent, in the case of any of the goods in respect of which the trade mark is registered, to certify those goods;
- (ii) that the proprietor has failed to observe a provision of the deposited regulations to be observed on his part;
- (iii) that it is no longer to the public advantage that the trade mark should be registered; or

- (iv) that it is requisite for the public advantage that if the trade mark remains registered, the regulations should be varied,

and the court shall not have any jurisdiction to make an order under section 39 on any of those grounds.

(b) The Registrar shall rectify the register and the deposited regulations in such manner as may be requisite for giving effect to an order made under paragraph (a).

(15) Notwithstanding anything in section 56 (2), the Registrar shall not have any jurisdiction to award costs to or against any party on an appeal to him against a refusal of the proprietor of a certification trade mark to certify goods or to authorise the use of the trade mark.

(16) The following provisions of this Act do not have effect in relation to a certification trade mark:

- (a) sections 10, 11, 18 and 19 (except as expressly applied by this section), 30, 40, 41, 42 (4) to (8), 45, 51 and 72 (2); and
- (b) any provisions the operation of which is limited by the terms thereof to registration in Part B of the register.

Offences.

69.—(1) 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 imprisonment for a term not exceeding 5 years.

Penalty
for falsely
representing
a trade
mark as
registered.

- (2) Any person who makes a representation —
- (a) with respect to a mark not being a registered trade mark, to the effect that it is a registered trade mark;
- (b) with respect to a part of a registered trade mark not being a part separately registered as a trade mark, to the effect that it is so registered;
- (c) to the effect that a registered trade mark is registered in respect of any goods in respect of which it is not registered; or
- (d) to the effect that the registration of a trade mark gives an exclusive right to the use thereof in any circumstances in which, having regard to

limitations entered on the register, the registration does not give that right, shall be guilty of an offence and shall be liable on conviction to a fine not exceeding \$200.

(3) For the purposes of this section, the use in Singapore in relation to a trade mark of the word “registered”, or of any other word referring whether expressly or impliedly to registration, shall be deemed to import a reference to registration in the register, except —

- (a) where that word is used in physical association with other words delineated in characters at least as large as those in which that word is delineated and indicating that the reference is to registration as a trade mark under the law of a country outside Singapore, being a country under the law of which the registration referred to is in fact in force;
- (b) where that word (being a word other than the word “registered”) is of itself such as to indicate that the reference is to such registration as last aforesaid; or
- (c) where that word is used in relation to a mark registered as a trade mark under the law of a country outside the United Kingdom and in relation to goods to be exported to that country.

70. Any person who counterfeits any trade mark used by any other person shall be guilty of an offence and shall be liable on conviction to a fine not exceeding \$5,000 or to imprisonment for a term not exceeding 2 years or to both.

Counterfeiting a trade mark used by another. 18/75.

[69A

71.—(1) A person shall be deemed to counterfeit a trade mark who either —

- (a) without the consent of the proprietor of the trade mark makes that trade mark or a mark so nearly resembling that trade mark as to be calculated to deceive; or
- (b) falsifies any genuine trade mark whether by alteration, addition, effacement or otherwise.

What constitutes counterfeiting a trade mark. 18/75.

(2) In any prosecution for counterfeiting a trade mark the burden of proving the consent of the proprietor shall lie on the defendant.

[69B

Making or possession of any instrument for counterfeiting a trade mark. 18/75.

72. Any person who makes or has in his possession any die, plate or other instrument for the purpose of counterfeiting a trade mark, or has 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, shall be guilty of an offence and shall be liable on conviction to a fine not exceeding \$5,000 or to imprisonment for a term not exceeding 3 years or to both. [69c

Importing or selling, etc., goods marked with a counterfeit trade mark. 18/75.

73. Any person who imports, sells or exposes or has in his possession for sale or any purpose of trade or manufacture any goods or things with a counterfeit trade mark affixed to or impressed upon the goods or things or to or upon any case, package or other receptacle in which such goods or things are contained, shall, unless he proves that —

(a) having taken all reasonable precautions against committing an offence under this section, he had, at the time of the commission of the alleged offence, no reason to suspect the genuineness of the mark and on demand made by or on behalf of the prosecution, he gave all the information in his power with respect to the persons from whom he obtained the goods or things; or

(b) otherwise he had acted innocently,

be guilty of an offence and shall be liable on conviction to a fine not exceeding \$2,000 or to imprisonment for a term not exceeding one year or to both. [69D

Representation on trade marks of Arms or Flag prohibited, etc. 18/75.

74.—(1) Any person who causes or permits to appear on a trade mark used by him for the purposes of his trade or business any representation of the Arms or the Flag of Singapore, or of any arms or devices so nearly resembling them as to be likely to deceive, shall, unless such trade mark is authorised to be used by order of the President, be guilty of an offence.

(2) Any person who imports, sells or exposes or has in his possession for sale or any purpose of trade or manufacture any goods or things to which a trade mark bearing any representation prohibited by subsection (1) is applied, shall be guilty of an offence.

(3) Any person guilty of an offence under subsection (1) or (2) shall be liable on conviction to a fine not exceeding \$5,000 or to imprisonment for a term not exceeding 2 years or to both and shall forfeit any goods to which the trade mark bearing the prohibited representation is applied.

[70]

75.—(1) Where any person has registered or has applied for protection for any trade mark in the United Kingdom or in any foreign state to which this section applies, that person or his legal representative or assignee shall be entitled to registration of his trade mark in priority to other applicants; and the registration shall have the same date as the date of application for protection in the United Kingdom or the foreign state, as the case may be:

International
arrange-
ments.

Provided that —

- (a) the application for registration is made within 6 months from the date of commencement of Part II or of the application for protection in the United Kingdom or the foreign state; and
- (b) nothing in this section shall entitle the proprietor of a trade mark to recover damages or infringements happening prior to the actual date on which his trade mark is registered in Singapore.

(2) The registration of a trade mark shall not be invalidated by reason only of the use of the trade mark by some other person in Singapore during the aforesaid period of 6 months.

(3) The application for the registration of a trade mark under this section shall be made in the same manner as an ordinary application under Part II.

(4) This section shall apply only in the case of the United Kingdom and of those foreign states with respect to which the President may by notification to be published in the *Gazette** declare this section to be applicable and so long only in the case of each of such foreign states as the notification continues in force with respect to that state.

(5) Where it is made to appear to the President that in any part of the Commonwealth outside the United Kingdom, satisfactory provision has been made for the

*See G.N. No. S (N.S.) 226/59.

protection of trade marks registered in Singapore it shall be lawful for the President by notification in the *Gazette** to apply this section to that part of the Commonwealth with such variations or additions, if any, as may be stated in the notification.

(6) For the purposes of this section, “foreign state” shall be deemed to include any colony, protectorate, territory subject to the authority or under the suzerainty of a foreign state and any territory administered by a foreign state in accordance with a mandate from the League of Nations or under the trusteeship system of the United Nations. [71

Use of trade mark for export trade, and use where form of trade connection changes.

76.—(1) The application in Singapore of a trade mark to goods to be exported from Singapore and any other act done in Singapore in relation to goods to be so exported which, if done in relation to goods to be sold or otherwise traded in within Singapore, would constitute use of a trade mark therein, shall be deemed to constitute use of the trade mark in relation to those goods for any purpose for which such use is material under this Act or at common law.

(2) The use of a registered trade mark in relation to goods between which and the person using it any form of connection in the course of trade subsists shall not be deemed to be likely to cause deception or confusion on the ground only that the trade mark has been, or is, used in relation to goods between which and that person or a predecessor in title of his a different form of connection in the course of trade subsisted or subsists. [72

Section 15 (2).

THE SCHEDULE

RESTRICTED GOODS

Textile piece goods, yarns and threads

For the purpose of this Schedule, “textile piece goods, yarns and threads” means all goods which are comprised in any of such classes of textile piece goods, yarns and threads as may be prescribed as being classes which refer predominantly to textile piece goods, yarns and threads, other than goods of a kind as to which it may be provided by the rules made under this Act that this Schedule is not to apply.

*See G.N. No. S (N.S.) 225/59.