
First published in the *Government Gazette*, Electronic Edition, on 25 October 2019 at 5 pm.

No. S 706

SUPREME COURT OF JUDICATURE ACT (CHAPTER 322)

SUPREME COURT OF JUDICATURE (GEOGRAPHICAL INDICATIONS) RULES 2019

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In exercise of the powers conferred by section 80 of the Supreme Court of Judicature Act and all other powers enabling us under any written law, we, the Rules Committee, make the following Rules:

PART 1
PRELIMINARY

Citation and commencement

1. These Rules are the Supreme Court of Judicature (Geographical Indications) Rules 2019 and come into operation on 1 November 2019.

Definitions

2. In these Rules —

“Act” means the Geographical Indications Act 2014 (Act 19 of 2014);

“geographical indication”, “homonymous geographical indication”, “international trade mark (Singapore)”, “proprietor” in relation to a trade mark, “register”, “registered geographical indication”, “registered trade mark”, “Registrar” and “well known trade mark” have the respective meanings given by section 2 of the Act;

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“GI Rules” means the Geographical Indications Rules 2019 (G.N. No. S 125/2019).

Application of Rules of Court

3. Subject to the provisions of these Rules, the Rules of Court (R 5) apply to any proceedings before the Court under the Act.

Proceedings under Act

4.—(1) Subject to rules 7 and 10, proceedings before the Court under the Act may be begun by writ or originating summons as the applicant considers appropriate.

(2) The writ or originating summons must be served on the parties and the Registrar.

(3) Where the Registrar refers to the Court an application made to the Registrar under the Act, then, unless the applicant makes the same application to the Court within one month after receiving notification of the Registrar's decision to refer, the applicant is treated to have abandoned the application.

(4) The period mentioned in paragraph (3) may be extended by the Registrar on the application of any party interested, and may be so extended although the application is not made until after the expiration of that period.

(5) Paragraph (4) does not affect the power of the Court under Order 3, Rule 4 of the Rules of Court to extend that period.

PART 2**ACTIONS UNDER SECTION 4 OF ACT****Action brought by interested party for certain uses of geographical indication**

5.—(1) This Part applies where an action is brought by an interested party of goods identified by a geographical indication against a person (called in this Part the defendant) for carrying on an act to which section 4 of the Act applies in relation to that geographical indication.

(2) If the geographical indication that is the subject of an action mentioned in paragraph (1) is a registered geographical indication, the defendant may make a counterclaim for one or both of the following:

- (a) the cancellation of the registration of the registered geographical indication;

(b) the rectification of an error or omission in the register affecting the registration of the registered geographical indication.

(3) A defendant in an action mentioned in paragraph (1) must serve on the Registrar a copy of the defendant's pleading that is filed in Court within 7 days after the filing of the pleading.

(4) The Registrar is entitled to take part in the proceedings in an action mentioned in paragraph (1) to the extent permitted by the Court, but need not serve a defence or other pleading unless ordered to do so by the Court.

Particulars, etc., to be included in pleading

6.—(1) A defendant who by way of defence disputes that a geographical indication falls within the meaning of “geographical indication” as defined in section 2 of the Act must include in the defendant's pleading particulars of the dispute.

(1A) A defendant who by way of defence disputes the validity of the registration of a registered geographical indication must include in the defendant's pleading particulars of the objection to the validity of the registration on which the defendant relies.

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(2) A defendant who by way of defence pleads any exception under Part III of the Act must include in the defendant's pleading particulars of the exception and the relevant particulars set out in paragraph (3), (4), (5), (6), (6A), (6B), (6C) or (6D) (whichever is applicable) in relation to the exception.

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(3) The relevant particular in relation to an exception under section 11(b) of the Act for the use of a geographical indication that has ceased to be protected in its country or territory of origin is the date of such cessation.

(4) The relevant particulars in relation to an exception under section 12(1) of the Act are —

(a) the goods or services or related goods or services in relation to which the geographical indication (being a geographical indication identifying a wine or a spirit) was

continuously used by the defendant or by the defendant and the defendant's predecessor in title (as the case may be) and details of such use;

- (b) the name of every such predecessor in title that has continuously used the geographical indication; and
- (c) the date on which the geographical indication was first used in relation to the goods or services or related goods or services.

(5) The relevant particulars in relation to an exception under section 12(2)(a) of the Act are —

- (a) the name of the proprietor of the trade mark;
- (b) the date on which the trade mark was first used by the defendant;
- (c) the details of the registration of the trade mark or the application for the registration of the trade mark, as the case may be;
- (d) a representation of the trade mark; and
- (e) the date on which the geographical indication was first protected in its country or territory of origin.

(6) The relevant particulars in relation to an exception under section 12(2)(b) of the Act are —

- (a) the name of the proprietor (if any) of the trade mark;
- (b) the date on which the trade mark was first used in the manner mentioned in that provision by the defendant or by the defendant and the defendant's predecessor in title, as the case may be;

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- (c) the name of every predecessor in title (if any) of the defendant who has used the trade mark in the manner mentioned in that provision;

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- (d) a representation of the trade mark, and details of its use in the manner mentioned in that provision by the defendant or

by the defendant and every such predecessor in title, as the case may be; and

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(e) the date on which the geographical indication was first protected in its country or territory of origin.

(6A) The relevant particulars in relation to an exception under section 16(1) of the Act are —

- (a) the goods or services or related goods or services in relation to which the registered geographical indication (being a geographical indication identifying any goods other than a wine or a spirit) was continuously used by the defendant or the defendant and the defendant's predecessor in title (as the case may be) and details of such use;
- (b) the name of every such predecessor in title that has continuously used the goods or services or related goods or services; and
- (c) the date on which the registered geographical indication was first used in relation to the goods or services or related goods or services.

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(6B) The relevant particulars in relation to an exception under section 16(2)(a) of the Act are —

- (a) whether the trade mark is a registered trade mark or an international trade mark (Singapore);
- (b) the name of the proprietor of the trade mark;
- (c) the date on which the trade mark was first used by the defendant;
- (d) the details of the registration of the trade mark or the application for the registration of the trade mark, as the case may be;
- (e) a representation of the trade mark; and

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- (f) the date of application for the registration of the geographical indication.

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(6C) The relevant particulars in relation to an exception under section 16(2)(b) of the Act are —

- (a) the name of the proprietor (if any) of the trade mark;
- (b) the date on which the trade mark was first used in the manner mentioned in that provision by the defendant or by the defendant and the defendant's predecessor in title, as the case may be;
- (c) the name of every predecessor in title (if any) that has used the trade mark in the manner mentioned in that provision;
- (d) a representation of the trade mark, and details of its use in the manner mentioned in that provision by the defendant or by the defendant and every such predecessor in title, as the case may be; and
- (e) the date of application for the registration of the geographical indication.

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(6D) The relevant particulars in relation to an exception under section 16(3) of the Act are —

- (a) the name of the proprietor of the well known trade mark;
- (b) the date of application for the registration of the geographical indication;
- (c) details of any matter from which it may be inferred that the trade mark is well known; and
- (d) details of how the application of section 4 of the Act to the use of the trade mark is liable to mislead consumers as to the true identity of the goods identified by the geographical indication.

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(7) A defendant who makes any counterclaim must include in the defendant's pleading particulars of the counterclaim.

PART 3
APPEALS

Appeal from Registrar's decision

7.—(1) An appeal to the Court from a decision of the Registrar in any case in which a right of appeal is given by the Act must be brought by originating summons (called in this Part the notice of appeal).

(2) An appeal to the Court from a decision of the Registrar is by way of rehearing and —

- (a) the evidence used on appeal must be the same as that used before the Registrar; and
- (b) no further evidence may be given on appeal except with the leave of the Court.

(3) Every notice of appeal from a decision of the Registrar must be filed with the Court within 28 days after the decision.

(4) A notice of appeal may be given in respect of the whole or any specific part of the decision of the Registrar, and must specify the grounds of the appeal and the relief that the appellant seeks.

(5) An appellant must, within 7 days after filing a notice of appeal, serve a copy of the notice of appeal on the Registrar and every other party in the proceedings before the Registrar.

(6) An appellant must, within 14 days after filing a notice of appeal, file a bundle of documents consisting of a copy of each of the following as may be applicable to the appeal:

- (a) a representation of the geographical indication that is the subject of the appeal, and details of the registration of the geographical indication or the application for the registration of the geographical indication, as the case may be;
- (b) the application to the Registrar that is the subject of the decision of the Registrar being appealed against;
- (c) the agreement or each submission filed with the Registrar under rule 26(3) or (4) of the GI Rules;

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- (d) the request for qualification of rights made to the Registrar under rule 40 of the GI Rules;
 - (e) the notice of opposition filed with the Registrar under rule 27(1), 41(1), 50(1) or 66(1) of the GI Rules;
 - (f) the notice of objection filed with the Registrar under rule 20(1) of the GI Rules;
 - (g) the counter-statement filed with the Registrar under rule 21(1), 29(1), 42(1), 51(1) or 67(1) of the GI Rules;
 - (h) every statutory declaration (including its exhibits) filed in the proceedings in question before the Registrar;
 - (i) the written submissions of all parties in the proceedings in question before the Registrar;
 - (j) the grounds of the decision of the Registrar being appealed against.

(7) The Registrar must transmit to the Court any document requested by the Court relating to the matter that is the subject of the appeal.

(8) Except with the leave of the Court, the appellant is not entitled on the hearing of the appeal to rely on any ground of appeal or to seek any relief not specified in the notice of appeal.

(9) Except with the leave of the Court, no appeal is to be entertained unless the notice of appeal is filed within the period specified in paragraph (3).

Respondent's notice

8.—(1) A respondent who, not having appealed from the decision of the Registrar, desires to contend on the appeal that the decision should be varied, either in any event or in the event of the appeal being allowed in whole or in part, must give notice to that effect, specifying the grounds of that contention and the relief which the respondent seeks from the Court.

(2) A respondent who desires to contend on the appeal that the decision of the Registrar should be affirmed on grounds other than

those set out in the grounds of decision must give notice to that effect, specifying the grounds of that contention.

(3) A respondent's notice must be filed and served on the Registrar, the appellant and every other party to the proceedings before the Registrar, within 14 days after the receipt of the notice of appeal by the respondent, or within such further time as the Court may direct.

Notice of hearing of appeal

9. The Court is to give not less than 7 days' notice of the date of the hearing of an appeal from a decision of the Registrar to the Registrar, the appellant and every other party to the proceedings before the Registrar, unless the Court directs that a shorter period of notice be given.

PART 4

DECLARATIONS UNDER SECTION 10(2) OF ACT

Application for declaration under section 10(2) of Act

10.—(1) An application to the Court under section 10(2) of the Act for a declaration of the practical conditions under which homonymous geographical indications are to be differentiated from one another must be made by originating summons.

(2) Where an application mentioned in paragraph (1) is made, the Court is to direct by written notice the applicant to consult with each defendant on the possibility of agreement to the practical conditions to be declared under section 10(2) of the Act.

(3) The notice mentioned in paragraph (2) is to be sent to all the parties to the proceedings, and is to specify —

- (a) the period within which the parties are to consult with each other;
- (b) the period within which the applicant is to carry out the step mentioned in paragraph (4); and
- (c) the period within which the parties are to carry out the steps mentioned in paragraph (5).

(4) If the parties reach an agreement on the practical conditions to be declared within the period specified under paragraph (3)(a), the applicant must, within the period specified under paragraph (3)(b), file in Court a copy of the agreement, including the details of the practical conditions agreed by the parties.

(5) If no agreement is reached between the parties on the practical conditions to be declared within the period specified under paragraph (3)(a), each party must, within the period specified in paragraph (3)(c), file with the Court a submission —

- (a) containing the party's proposal for the practical conditions to be declared; and
- (b) identifying the areas for which an agreement could not be reached.

(6) Upon the hearing of the application mentioned in paragraph (1), the Court may declare the practical conditions on which the homonymous geographical indications (which are the subject of the application) are to be differentiated from one another, whether or not the practical conditions are those in respect of which an agreement between the parties was filed under paragraph (4).

(7) The application mentioned in paragraph (1) is deemed to have been discontinued if the applicant has not carried out the step applicable to the applicant —

- (a) at the expiry of the period specified under paragraph (3)(b) for the carrying out of the step in paragraph (4); or
- (b) at the expiry of the period specified under paragraph (3)(c) for the carrying out of the step in paragraph (5).

PART 5

MISCELLANEOUS

Service of documents

11.—(1) This rule applies to the service of any document (including an originating process) on a party to any proceedings before the Court under the Act until such time as that party has provided an address for

service within the meaning of Order 6, Rule 2(2) or Order 12, Rule 2(3) of the Rules of Court.

(2) Subject to paragraph (3), for the purposes of any proceedings before the Court under the Act, where any document is served in the manner prescribed by Order 10 or 62 of the Rules of Court at an address for service given in the register —

- (a) service is deemed to have been effected on the registrant of the geographical indication on the date on which the document was served at the said address; and
- (b) the party on whom service is deemed to have been effected under sub-paragraph (a) is treated, for the purposes of any provision of these Rules or the Rules of Court which specifies a time-limit for responding to the document so served (whether by entering an appearance or otherwise), as having been served on the 7th day after the date on which the document was served at the said address.

(3) Nothing in paragraph (2) prevents service from being effected on the registrant of a geographical indication in accordance with the provisions of the Rules of Court.

Made on 22 October 2019.

SUNDARESH MENON
Chief Justice.

LUCIEN WONG
Attorney-General.

TAY YONG KWANG
Judge of Appeal.

STEVEN CHONG
Judge of Appeal.

BELINDA ANG SAW EAN
Judge.

QUENTIN LOH
Judge.

VINODH COOMARASWAMY
Judge.

SEE KEE OON
Presiding Judge of the State Courts.

JAMES LEONG
District Judge.

FRANCIS XAVIER, SC
Advocate and Solicitor.

KUAH BOON THENG, SC
Advocate and Solicitor.

[SUPCT.RNJ.009.0203; AG/LEGIS/SL/322/2015/9 Vol. 2]

(To be presented to Parliament under section 80(6) of the Supreme Court of Judicature Act).