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IP Enforcement Manual - Singapore

The Manual is commissioned by the United Kingdom Intellectual Property Office and drafted by Rouse &Co International in cooperation with Amical Law LLC, Singapore. This manual seeks to provide all IP owners or other interested parties with a clear explanation of the IP enforcement procedures in Singapore. Set out in this Manual are the trademark and copyright enforcement procedures for Singapore. These IP enforcement procedures are up to date as of March 1, 2021. Users of this Manual should take local legal advice to ensure accuracy.

EXECUTIVE SUMMARY

Singapore has a strong legal transparent system with robust remedies for Intellectual Property (IP) infringement. Singapore seeks to have one of the strongest domestic IP regimes in South East Asia. Its IP laws and enforcement are comparable to the UK for example and comply with international treaties like the WTO's IP rules.

Criminal solutions for trademark counterfeiting and copyright piracy are found through the police and criminal court system. Private investigators and IP law firms assist IP owners with criminal cases. Civil court proceedings whilst expensive are also effective at solving complex IP cases. Legal costs are often recoverable along with damages. The court system and subsequent enforcement procedure in Singapore is fairly swift and efficient. This is evident from the statistics on raids and total value of seizure available at IPOS Website.

There are also mediation systems available for IP cases in the courts. Online IP protection is relatively strong too. IP owners can issue notices and have infringing content removed from ecommerce platforms and internet service providers swiftly and efficiently. The biggest IP enforcement challenge tends to be with Customs IP enforcement. Customs can prevent some counterfeit and pirated goods entering Singapore; however, this is not straightforward. More importantly Singapore is a huge transshipment port, and counterfeit goods passing through Singapore's port infrastructure on their way to other countries cannot generally be stopped.

HOW TO USE THIS MANUAL

This Manual covers three main areas of IP enforcement as they apply to counterfeit (trademark infringing) and pirated (copyright infringing) goods. The first area is criminal actions, which usually means conducting raids to seize suspected counterfeit and pirated goods, followed by criminal prosecutions through the criminal courts. The second is court actions brought in the civil courts against IP infringers. In the case of counterfeit and pirated goods this usually means bringing a court case against a counterfeiter for an order to stop infringing as well as claiming damages. Because preparing a lawsuit is expensive and time consuming, civil cases are used carefully, usually only where a target has resources to pay damages. Lastly, there are in some countries, administrative options for IP infringement (including using customs to intercept IP infringing goods at borders). There are no administrative actions available in Singapore.

Outside the legal system there is a fourth avenue, for dealing with online IP enforcement. This typically means how to remove pirated content and counterfeit goods from ecommerce platforms, or internet service providers. This is typically done with notices under the ecommerce platforms', or internet service providers' contractual terms of service. In some countries, laws also back this up.

There are many other areas of IP enforcement outside the areas above, from patent to designs to trade secrets which are beyond the scope of this Manual. IP protection is a complex area of law and practice. There are many technical terms and special procedures which often differ from other areas of law. This manual uses those terms where necessary but also provide definitions.

The aim of this Manual is to provide a summary of the rules and their practical application. This is done by explaining the legal provisions themselves and how they work in practice. In addition, a practical commentary is included setting out details of how the rules work, including examples.

IP owners and those seeking to bring cases must always seek local legal advice. IP lawyers and brand protection professionals are employed in each country to advise on and assist in IP enforcement. Such professionals can be found by searching for Intellectual Property in directories like the Legal 500 (<https://www.legal500.com/>) or Chambers ([chambers.com](https://www.chambers.com/)), or through IP industry organisations like INTA ([inta.org](https://www.inta.org/)) and the UK's Anti-Counterfeiting Group (<https://www.a-cg.org/>). Many countries also have a local IP association which can provide lists of IP lawyers.

IP professionals (for example in other countries) may use this Manual to learn how IP laws and practice operates in the country. Businessmen and women may use this to learn some of the basics and educate themselves on how IP enforcement works. The Manual highlights relevant IP Sections/Regulations/Acts so that IP owners and businesses have a basic understanding of the IP offences committed, possible defences and how the law considers the two types of infringement namely trademark counterfeiting and copyright piracy. This way, businesses can better prepare their enforcement strategy and approaches. This manual can also assist when engaging an IP law firm or IP investigator in a case.

OVERVIEW OF SINGAPORE'S LEGAL AND IP SYSTEM

Legal system

Singapore has a common law legal system which has its roots in English common law tradition. This common law system is characterized by the doctrine of judicial precedent, where the decisions of superior courts are generally binding on lower courts.

The Singapore judiciary is made up of the Supreme Court, the State Courts, and the Family Justice Courts. The Supreme Court comprises the Court of Appeal and the High Court, with the Court of Appeal being the highest court in the land. The Court of Appeal comprises the Chief Justice and two Judges of Appeal. The Chief Justice and the other Judges of the Supreme Court are appointed by the President, acting on the advice of the Prime Minister. The Court of Appeal is the final appellate court of Singapore with jurisdiction over any judgment or order of the High Court in any civil matter whether made in the exercise of its original or appellate jurisdiction. It hears appeals from decisions of the High Court in the exercise of its original criminal jurisdiction and determines questions of law reserved for its decision by the High Court.¹

With effect from 2 January 2021, the High Court has been restructured into two divisions, namely the General Division of the High Court ("**General Division**") and the new Appellate Division of the High Court ("**Appellate Division**"). The General Division hears cases as a court of first instance as well as appeal from decisions in lower courts. The High Court has unlimited original jurisdiction in civil and criminal cases and try all criminal cases involving capital punishment. A decision of the General Division may either be appealed to the Appellate Division or to the Court of Appeal, depending on the nature of the matter. The decision of the Appellate Division can be further appealed to the Court of Appeal in certain circumstances.

IP system

The Intellectual Property Office of Singapore ("**IPOS**") is Singapore's national intellectual property registry and regulator for patents, trademarks and registered designs. It also plays an integral role in the Singapore Government's 10-year master plan to transform the country into a global hub in Asia for IP-related transactions and management, filings, and dispute resolution. Its subsidiary, IPOS International, also assists public and private enterprises across the world with using IP and intangible assets for business growth.

To facilitate the development of its IP landscape, Singapore is also a signatory of several international IP conventions, including but not limited to the following:

- Paris Convention for the Protection of Industrial Property
- Berne Convention for the Protection of Literary and Artistic Works
- Madrid Protocol
- WIPO Copyright Treaty

Singapore has one of the most robust legal systems for the protection of intellectual property rights. In 2019, the World Economic Forum's Global Competitiveness Report ranked Singapore first in Asia and second in the world for its IP protection regime.

The legal profession in Singapore is a fused one so that each lawyer who is called to the Bar bears the title 'Advocate and Solicitor'. A legal practitioner in Singapore must hold a practicing certificate to practice law.

¹ <https://core.ac.uk/download/pdf/216728373.pdf>

1. THE IP ENFORCEMENT SYSTEM UNDER TRIPS²

As a member of the World Trade Organization's TRIPS Agreement, Singapore adopts stringent enforcement measures to protect Intellectual Property Rights, including:

- Civil actions with possible remedies such as injunctions³ to stop further infringing activity, awarding damages⁴ as compensation and orders for the removal of infringing goods such as destruction;
- Criminal actions for wilful trademark and copyright infringement; and
- Border enforcement provisions provide measures for the detection and enforcement of goods infringing copyright and trademarks that are being imported into and exported out of Singapore. Singapore does not provide border enforcement for goods in transit⁵ as of right. Customs authorities have ex-officio (because of one's office or position) powers i.e., the Customs authorities, on their own can stop infringing goods in transit. While it is possible for trademark and copyright owners to request for the seizure of infringing goods being imported and exported out of Singapore, they cannot do so for infringing goods in transit.

2. TRADEMARKS AND COPYRIGHT

Singapore has a dual system of protection for trademarks, provided by the Trade Marks Act (Chapter 332) ("TMA") and the common law of passing off. These two systems are independent of each other.

Legal protection and the provisions for enforcement of trademark rights in Singapore are conditional upon the registration of the trademark with IPOS. There are two exceptions: (i) special protection is granted under the TMA to 'well-known' trademarks, regardless of whether they are registered and (ii) the common law of passing off.

Trademarks may be registered either through a domestic application with IPOS or an international application filed under the Madrid Protocol⁶, designating Singapore as a country where protection is sought.

Commentary: *This dual system of protection means that registered and unregistered trademarks (whether well-known or otherwise) are protectable in Singapore. Registered and well-known unregistered marks are protected under the TMA, while all forms of unregistered marks may be enforced under the law of passing-off.*

In common law countries like Singapore, passing off is a common law tort which can be used to enforce unregistered trade mark rights. The tort of passing off protects the goodwill of a trader from misrepresentation. It prevents a party from representing its goods or services as those of another. The required elements for to establish passing off against another party are:

- *The presence of goodwill*
- *Misrepresentation*
- *Damage*

Trademark owners are however advised to register their marks, since registration confers a number of benefits. For example, registration of a trademark is evidence of validity and ownership of the registration, and the burden is on the defendant or the person accused of infringement to disprove this. In contrast, a passing-off action requires the mark owner to provide goodwill and distinctiveness of its trademark.

In Singapore, the Copyright Act (Chapter 63) ("CA") provides legal protection, in the form of a bundle of exclusive rights, to the owner of original works for limited periods of time and subject to certain permitted exceptions. It is not possible to register a copyright in Singapore, as there is no Registry of

² The WTO Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS) is the most a multilateral agreement on intellectual property (IP).

³a judicial order that restrains a person from beginning or continuing an action threatening or invading the legal right of another person, or that compels a person to carry out a certain act. (Oxford Languages dictionary)

⁴ **damages** [plural] an amount of money that a court decides should be paid to someone by the person, company, etc., that has caused them harm or injury.

⁵ **goods in transit** means goods imported, whether or not landed or transhipped within Singapore, which are to be carried to another country either by the same or another conveyance.

⁶ The Madrid System for the International Registration of Marks is governed by the Madrid Agreement and the [Madrid Protocol](#) relating to that Agreement. The system makes it possible to protect a mark in a large number of countries by obtaining an international registration that has effect in each of the designated Contracting Parties.

Copyright. A copyright exists at the point of creation. Singapore is also a party to the Berne Convention⁷ and thus copyrighted works in any of the 177 countries are similarly protected in Singapore.

Commentary: *Since registration is not required as proof of copyright ownership and subsistence, this means that in legal proceedings, right-holders will need to have to present evidence of copyright subsistence and ownership.*

Right-holders may therefore wish to consider registering their copyright in jurisdictions which permit copyright registration, to facilitate the proving of the 'date of first creation' and ownership rights. Right-holders should also take care to retain initial drafts and related correspondence related to the creation of their works.

For the purposes of this Manual, we will focus on the enforcement provisions of the TMA and CA. Unlike some of the other ASEAN countries, there are no specific e-commerce or administrative enforcement provisions under the TMA and CA.

3. CRIMINAL IP ENFORCEMENT

3.1.1. Criminal offences under TMA

The TMA provides several trademark related offences, allowing the registered proprietor or owner of trademark to enforce his trademark rights in criminal proceedings. Any person shall be guilty of a criminal offence in Singapore if he or she commits any of the following:

3.1.1.1. Counterfeiting a trademark

Section 46 of the TMA provides that any person is deemed to counterfeit a registered trademark if he or she:

- Makes a sign that is identical or is nearly resembling a registered trademark with an intention to deceive; or
- Falsifies a genuine registered trademark, whether by alteration, addition, effacement, partial removal or otherwise without the consent of the registered proprietor.

3.1.1.2. Falsely applying a registered trademark to goods or services

Section 47 of the TMA provides that any person who falsely applies a registered trademark to goods or services, shall be guilty of an offence of falsely applying a registered trademark, unless that person proves that he or she acted innocently.

Falsely applying a registered trademark includes the following acts:

- The person applies the trademark/sign that is likely to be mistaken for the proprietor's registered trademark to goods and services without the proprietor's consent; and
- If the mark or sign is applied to goods, that are not genuine goods of the proprietor or licensee of the registered trademark.

A trademark is applied to goods or services if it is used:

- On any sign or advertisement; or
- On any invoice, wine list, catalogue, business letter, business paper, price list or other commercial document, including any such document in any medium

and the goods are delivered, or services provided pursuant to a request or order, made by reference to the trademark so used.

⁷ The [Berne Convention](#), adopted in 1886, deals with the protection of works and the rights of their authors. It provides creators such as authors, musicians, poets, painters etc. with the means to control how their works are used, by whom, and on what terms. It is based on three basic principles and contains a series of provisions determining the minimum protection to be granted, as well as special provisions available to developing countries that want to make use of them.

3.1.1.3. Making or possessing of article for committing offence

Section 48 of the TMA provides that any person who:

- makes an article specifically designed or adapted for making copies of a registered trademark or a sign likely to be mistaken for that trademark; or
- has such an article in his possession, custody, or control, knowing or having reason to believe that it has been or is to be used for- committing an offence against sections 46 or 47, shall be guilty of an offence for making or being in possession of such article.

3.1.1.4. Importing or selling, etc., goods with falsely applied trademark

Section 49 of the TMA provides that any person who:

- imports into Singapore for the purpose of trade or manufacture;
- sells or offers or exposes for sale; or
- has in his possession for the purpose of trade or manufacture,

any goods to which a registered trademark is falsely applied, will be guilty of an offence under this section, unless:

- he has taken all reasonable precautions against committing an offence;
- had no reason to suspect the genuineness of the mark;
- gave all information in his power with respect to the persons from whom he obtained the goods to the prosecution; or
- acted innocently.

3.1.1.5. Falsification of Register

Section 50 of the TMA provides that any person who:

- makes, or causes to be made, a false entry in the register;
- makes, or causes to be made, anything false aiming to be an entry in the register; or
- produces or presents in evidence anything referred to above
- knowing or having reason to believe that the entry or thing, is false, and shall be guilty of an offence under this section.

3.1.1.6. Falsely representing trademark as registered

Section 51 of the TMA provides that any person who knowingly makes a false representation that a trademark is registered or falsely represents goods or services for which a trademark is registered, shall be guilty of an offence under this section.

3.1.1.7. Representation on trademarks of Arms or Flags prohibited, etc.

Section 52 of the TMA prohibits the unauthorized use or representation of the Arms or the Flag of Singapore, or of any arms or devices likely to be mistaken for them, for the purpose of trade, unless such trademark is authorized to be used by order of the President.

3.1.1.8. Forfeiture and destruction of goods, etc., on conviction

Section 53 of the TMA empowers the court to order any person who has been convicted of an offence relating to a registered trademark to forfeit/surrender to the Government all goods or articles in relation the offence.

Where any person has been convicted of falsely applying a registered trademark to goods or services (section 47 of the TMA) or importing or selling goods with falsely applied trademark (section 49 of the TMA), the court shall order the person to forfeit/surrender goods to the Government in relation to which

the offence was committed for destruction. This includes goods on which the trademark has been falsely applied, and goods or their packaging which bear the trademark or sign that have been falsely applied, unless there are exceptional circumstances for deciding otherwise.

The forfeiture or forfeiture and destruction of goods is in addition to any penalty or punishment that the court may impose for the offence committed.

3.1.2. Criminal procedure for trademark infringement

In Singapore's context, criminal actions for trademark infringement could be commenced either by the right holders or the Police. Singapore adopts a 2-pronged approach for enforcing IP rights, namely:

- (a) a police-led approach and
- (b) a collaborative approach where the police work hand-in-hand with right holders.

In the police-led approach, on receipt of information relating to infringement activities, the police will make an assessment before the commencement of raids and investigations against the perpetrators. At the end of the investigations, the police will review the facts and evidence gathered before initiating criminal proceedings against perpetrators.

As for the collaborative approach, the right holder(s) will gather necessary intelligence of the perpetrators before initiating raids with the full assurance of police's assistance and support. The right holders retain the control of the case and decide whether they should proceed to commence criminal proceedings against the perpetrators after obtaining authorization (also known as fiat) from Attorney-General's Chambers (AGC).

Commentary: *The criminal enforcement process generally begins with field investigations or market surveys to identify sources of supply of counterfeit goods and to ascertain the extent of the availability of the counterfeits. Trap purchases are then made to gather evidence to produce before the court to support an application for a search warrant. It is important to devote sufficient time and resources in ensuring good quality investigations.*

After the right holder is convinced that the trap purchases are indeed counterfeits, a complaint can be lodged with the court for the issuance of a search warrant authorizing the police to raid the premises or conveyance and seize any infringing goods. Once the seizure is done, the infringer may contact the right holder to settle the matter. If the right holder agrees, the matter is resolved, and the seized goods destroyed. If not, the appropriate court action will be instituted.

3.1.2.1 Powers of entry, search, and seizure

Search & Seizure under a Search Warrant

Pursuant to section 53A(3) of the TMA, the court may issue a warrant authorizing a police officer to enter and search premises for articles and documents specified in the warrant, and to seize any of such articles and documents if the police officer reasonably suspects that the article or document is evidence that an offence has been committed.

3.1.2.2 In the event where prosecution is not initiated within time limit

For seizure of any goods, material, article or document, which are made under 53A(3) of the TMA, Section 53A(4)(b) states that where no prosecution⁸ or criminal action is initiated within six months of the seizure, the articles or documents seized shall be returned to the person in whose possession they were when they were seized or, be disposed of in accordance with the law if it is not reasonably practicable to return them to that person.

⁸ [Prosecution](#) is the act of carrying on a legal action against a person accused of a crime in court

3.1.2.3 Police's power and powers of other officers

Search & Seizure without a Search Warrant

On the other hand, under Section 53A (2) TMA, any “**authorised officer**”, without a warrant issued under section 53A (3) TMA, may:

- stop, search and board, whether forcibly or otherwise, any conveyance in which he reasonably suspects there are goods to which a registered trademark has been falsely applied; and
- seize, remove, or detain any such goods and anything which contains evidence of any offence under section 46, 47, 48, 49 or 52 noted above.

“**Authorised Officer**” as defined in Section 53A (6) TMA consists of:

- a police officer;
- an officer of customs as defined in the Customs Act (Cap. 70);
- an immigration officer as defined in the Immigration Act (Cap. 133); or
- any officer(s) appointed by the Minister by notification in the Gazette to exercise the powers and perform the duties conferred and imposed on an authorised officer by this section.

Arrest and Investigation

In addition, Section 53A of the TMA empowers any police officer to arrest without warrant any person who does the following acts:

- sells or offers or exposes for sale; or
- has, or is reasonably suspected of having, in his possession for the purpose of trade or manufacture, any goods to which a registered trademark is falsely applied.

Under the Criminal Procedure Code (Chapter 68) (“CPC”), police officers may exercise any of the special powers of investigation when investigating an arrestable case, including the power to require the attendance of witnesses, examine witnesses, to search, without a warrant, for any document or thing in any place; to access computers and for search and inspection; and to require any complainant or witness to execute a bond to testify in court.

3.1.3 Criminal Prosecution of Trademark Infringement

Under Section 106 of TMA, a District Court or a Magistrate's Court have the jurisdiction to hear and determine all offences under TMA.

3.1.4 Criminal penalties for trademark infringement

3.1.4.1 Penalty for counterfeiting a registered trademark

On conviction⁹ under section 46 of the TMA, that person shall have to pay a fine not exceeding SGD100,000 or to imprisonment for a term not exceeding 5 years or to both.

3.1.4.2 Penalty for falsely applying a registered trademark

On a conviction under section 47 of the TMA, that person shall have to pay a fine not exceeding SGD100,000 or to imprisonment for a term not exceeding 5 years or to both.

3.1.4.3 Penalty for making or possessing an article for committing offence

On a conviction under section 48 of the TMA, that person shall have to pay a fine not exceeding SGD100,000 or to imprisonment for a term not exceeding 5 years or to both.

⁹ Conviction means the act or process of finding a person guilty of a crime especially in a court of law

3.1.4.4 Penalty for importing or selling goods with falsely applied trademark

On a conviction under section 49 of the TMA, that person shall have to pay a fine not exceeding SGD10,000 for each goods or thing to which the trademark is falsely applied (but not exceeding in the aggregate SGD100,000), or to imprisonment for a term not exceeding 5 years or to both.

3.1.4.5 Penalty for falsification of register

On being convicted under section 50 of the TMA, that person shall have to pay a fine not exceeding SGD50,000 or to imprisonment for a term not exceeding 5 years or to both.

3.1.4.6 Penalty for falsely representing trademark as registered

On a conviction under section 51 of the TMA, that person shall have to pay a fine not exceeding SGD10,000.

3.1.4.7 Penalty for representation of trademark of arms or flags

On conviction under section 52 of the TMA, that person shall have to pay a fine not exceeding SGD50,000 or to imprisonment for a term not exceeding 5 years or to both and shall forfeit/surrender to the Government any goods or things to which the trademark bearing the prohibited representation is applied.

Commentary: *In line with the recommendations under the TRIPS Agreement, Singapore has enacted strict laws to deal with the issue of counterfeit and pirated products, which impose onerous criminal penalties on the infringers. These laws (in particular, section 49 of the TMA) also compel persons who deal with goods (i.e., end sellers) to take appropriate measures to avoid dealing in counterfeit products.*

Local enforcement agencies, such as the Intellectual Property Rights Branch (“IPRB”) of the Singapore Police Force, actively enforce these laws. Between 2009 and 2019, the IPRB conducted more than 1,700 trademark-related raids in Singapore. The total value of products seized in these raids (including copyright raids) is approximately SGD 52.5 million.¹⁰

Criminal prosecution of trademark infringement is generally restricted to egregious cases where the public interest justifies the imposition of criminal sanctions.

3.2.1 Criminal offences under the CA

- Under section 136(1), a person shall be guilty of an offence of the CA if he or she:
 - makes for sale or hire;
 - sells or lets for hire, or by way of trade, offers or exposes for sale or hire; or
 - by way of trade exhibits in public

any article which he or she knows or ought to reasonably know, to be an infringing copy of the work at a time when copyright subsists in the work. This encompasses the act of selling, regardless of whether there is a resulting transaction.

- A person shall be guilty of an offence under section 136(2) of the CA if that person has in his/her possession or imports into Singapore any article which he or she knows, or ought to reasonably know to be an infringing copy of the work for the purpose of:
 - selling, letting for hire, or by way of trade offering or exposing for sale or hire, the article;
 - distributing the article for the purpose of trade, or for any other purpose to an extent that will prejudicially affect the owner of the copyright in the work; or
 - by way of trade exhibiting the article in public.

¹⁰ <https://www.ipos.gov.sg/media-resources/statistics>

- A person shall be guilty of an offence under section 136(3) of the CA if that person distributes articles which he or she knows, or ought to reasonably know, to be infringing copies of the work either:
 - for purposes of trade; or
 - for other purposes, but to such an extent as to affect prejudicially the owner of the copyright at a time when copyright subsists in the work.
- A person shall be guilty of an offence under section 136(3A) of the CA if:
 - that person does an act that constitutes wilful infringement of the copyright in the work; and
 - either the extent of the infringement is significant, or infringement is done to obtain a commercial advantage, or both.
- A person shall be guilty of an offence under section 136(4) of the CA if, that person makes or has in his or her possession an article specifically designed or adapted for making copies of the work in which copyright subsists, and that the person knows, or ought reasonably to know, that the article is to be used for making infringing copies of the work or subject-matter.
- A person shall be guilty of an offence under section 136(6) of the CA if that person, for his or her private profit causes a literary, dramatic, or musical work to be performed in public, or causes a cinematograph film to be seen or heard publicly or otherwise, other than programme, where he/she knows, or ought to reasonably know that copyright subsists and that such performance consists an infringement of the copyright.
- A person shall be guilty of an offence under section 139 of the CA if he or she publishes, or causes to be published in Singapore, an advertisement for supply in Singapore (whether from within or outside Singapore) of a copy of a computer program which is an infringing copy, Unless, that person proves that he or she acted in good faith and had no reasonable grounds for supposing that copyright maybe be infringed.

3.2.2 Criminal procedure for copyright infringement

Similar to trademark infringement, criminal actions for copyright infringement could be commenced either by the right holders or the Police. Please refer to para. [3.1.2] for the details.

3.2.2.1 Powers of entry, search, and seizure

Search & Seizure under a Search Warrant

Pursuant to section 136(9) of the CA, the court may issue, a warrant authorizing a police officer to enter and search premises for articles and documents specified in the warrant, and to seize any of such articles and documents if the police officer reasonably suspects that the article or document is evidence that an offence has been committed.

3.2.2.2 In the event where prosecution is not initiated within time limit

Section 136(10) of the CA states that where no prosecution is initiated within six months of the seizure, articles or documents seized shall be returned to the person in whose possession they were when they were seized or, be disposed of in accordance with the law if it is not reasonably practicable to return them to that person.

3.2.2.3 Police's power and powers of other officers

Search & Seizure without a Search Warrant

Section 138(1) of the CA permits a police officer to arrest any person in any street or public place without a warrant if he or she

(1) sells or exposes or offers for sale; or

(2) has, or is reasonably suspected of having, in his or her possession for the purpose of selling or letting for hire, any infringing copy of any work or other subject-matter.

Any authorized officer is also permitted, pursuant to section 138(2) of the CA, to stop, search and board any conveyance which he or she reasonably suspects has an infringing copy of any work or other subject-matter; and may seize, remove, or detain any infringing copy and anything which appears to be or contains evidence of an offence under the CA.

The definition of “*Authorised Officer*” under CA is defined in Section 136(3) and comprises the same group of officers as mentioned in para. [3.1.2.3].

The arrest and investigative powers granted to the Police for copyright infringement are similar to those mentioned in para. [3.1.2.3].

3.2.3 Criminal Prosecution of copyright crimes

Under section 140 of the CA, the District Court or Magistrate’s Court shall have jurisdiction to try any offence under the CA and award the full punishment for such offence.

3.2.4 Criminal Penalties for copyright infringement

- A fine of not more than SGD10,000 for each infringing copy up to a maximum fine of SGD100,000, or imprisonment for a term not exceeding five years or both for offences set out in (1) and (2) of 3.2.1 above. In practice, custodial sentences are the norm unless the quantity of infringing article is small.
- A fine of not more than SGD50,000 or imprisonment for a term not exceeding three years or both for offence set out in (3) of 3.2.1 above.
- A fine of not more than SGD20,000 or imprisonment for a term not exceeding six months or both. For any subsequent offence, the penalty is a fine not exceeding SGD50,000 or imprisonment for a term not exceeding three years or both. This penalty is in relation to the offence set out in (4) of 3.2.1 above.
- A fine of not more than SGD20,000 for each article in respect of which the offence is committed or imprisonment for a term not exceeding two years or both for the offence set out in (5) of 3.2.1 above.
- A fine of not more than SGD20,000 or imprisonment for a term not exceeding two years or both for the offences set out in (6) and (7) of 3.2.1 above.

The overall sentence imposed on an accused depends on the number of articles involved.

*The criminal procedure for trademark and copyright infringement is shown by way of a flowchart in Annex 1 of this Chapter.

Commentary: *Criminal remedies are typically in the form of fines, imprisonment, orders for forfeiture and destruction of goods or articles. Strict laws have also been enacted against copyright infringement in line with the recommendations under the TRIPS Agreement. Local enforcement agencies are equally active in the enforcement of these laws. Between 2009 and 2019, the IPRB conducted more than 200 copyright-related raids in Singapore. The total value of products seized in these raids (including trademark raids) is approximately SGD 52.5 million.¹¹*

Criminal prosecution of copyright infringement is also restricted to glaring cases where the public interest justifies the imposition of criminal sanctions.

Commentary:

¹¹ <https://www.ipos.gov.sg/media-resources/statistics>

Pros of criminal enforcement

- *Its less time consuming, a relatively cheaper option than a civil suit in most cases.*

4 CIVIL IP ENFORCEMENT

4.1 Trademark infringement

4.1.1 Under section 27(1) of the TMA a person infringes a registered trademark if he/she uses, during trade, a sign identical to the trademark in relation to the goods or services which are identical with those for which it is registered, without the consent of the proprietor of the trademark.

4.1.2 Under section 27(2) of the TMA, a person infringes a registered trademark where he /she uses a sign that is identical with / similar to which the trademark is registered, and can cause confusion to the public. Similarity however between the marks and the goods does not automatically mean that there is a likelihood of confusion.

4.1.3 Well known trademark infringement

A person infringes a well-known trademark under section 27(3) of the TMA if:

- without the consent of the proprietor of the trademark, he or she uses in the course of trade a sign which is identical with or similar to the trademark in relation to goods or services which are not similar to those for which the trademark is registered;
- the use of the trademark in relation to those goods or services would indicate a connection between those goods or services and the proprietor.
- there exists a likelihood of confusion on the part of the public because of such use; and
- the interests of the proprietor are likely to be damaged by such use.

4.1.4 Defences to trademark infringement or acts not amounting to infringement

4.1.4.1 Acts not amounting to infringement

Section 28 of the TMA sets out circumstances where a person does not infringe a registered trademark. These include:

- using his or her name or the name of his or her place of business; or the name of his or her predecessor in business or the name of his predecessor's place of business.
- using a sign to indicate the kind, quality, quantity, intended purpose, value, geographical origin or other characteristics of the goods or services; or the time of production of goods or of rendering of services; or
- using the trademark to indicate the intended purpose of the goods (as accessories or spare parts) or services, and such use is in accordance with honest practices in industrial or commercial matters.

Section 28 of the TMA also states that a person does not infringe a registered trademark if he or she, and his or her predecessor in title, have continuously used in the course of trade the unregistered trademark in relation to those goods and services from a time before the date of registration of the registered trademark; or the date the proprietor of the registered trademark/predecessor in title/person who was a registered user of the trademark under TMA first used the trademark, whichever is the earlier.

4.1.4.2 Exhaustion of rights

Section 29(1) of the TMA provides that a registered trademark is not infringed by the use of that trademark in relation to goods which have been put on the market, (in Singapore or outside), under that trademark by the proprietor of the registered trademark or with his express or implied consent (conditional or otherwise).

4.1.4.3 Acquiescence

Section 24(1) of the TMA provides that if the proprietor of an earlier trademark or other earlier right has acquiesced or consented (for a continuous period of five years) the usage of a later registered trademark (in Singapore) in the course of trade, he will, if he was aware of such use, lose his entitlement:

- To apply for a declaration that the registration of the later trademark is invalid; or
- To oppose the use of the later trademark in relation to the goods or services in relation to which it has been so used unless the registration of the later trademark was applied for in bad faith.

Commentary: *Civil trademark infringement proceedings are heard by the General Division of the High Court at first instance. A decision from the General Division can be appealed to the Appellate Division of the High Court, and to the Court of Appeal in limited circumstances.*

The Singapore Government has plans to introduce a specialized litigation track for IP disputes at the High Court, featuring simplified processes and cost-saving features, which will allow right-holders and litigants to resolve their disputes in a less-costly manner.

IP cases in the High Court are typically heard by a specialist IP judges who has the requisite experience and expertise in IP matters. The parties may also appoint their own expert witnesses. The Court also typically appoints its own independent technical expert to assist the Court in its determination.

The Singapore legal system also provides for the process of discovery, whereby parties are obligated to disclose documents which are relevant to the issues and which are in their possession, custody, or power. Where documents provided are confidential, the parties may agree upon the provision of confidentiality undertakings prior to disclosure.¹² In Singapore, the claimant in civil cases generally has the legal burden of proving its case and the relevant standard is on 'the balance of probabilities'.

4.2 Copyright infringement

4.2.1 Infringement by doing acts comprised in copyright

Section 31(1) of the CA provides that copyright in a literary, dramatic, musical, or artistic work is infringed by a person who, is not the owner of the copyright, and without the license of the owner of the copyright, does in Singapore, or authorizes the doing in Singapore of, any act comprised in the copyright.

Without the license of the owner of the copyright, the doing in Singapore of any exclusive rights under Section 26 of the CA will, subject to available defense, result in infringement.

These exclusive rights are as follows:

- To do all or any of the following acts in the case of a literary, dramatic, or musical work:
 - To reproduce¹³ the work in a material form; (i)
 - To publish the work if the work is unpublished; (ii)
 - To perform the work in public; (iii)
 - To communicate the work to the public; (iv)
 - To make an adaptation¹⁴ of the work; (v)

¹² <https://www.legal500.com/guides/chapter/singapore-intellectual-property/>

¹³ the right to control the act of reproduction – be it the reproduction of books by a publisher or the manufacture by a record producer of compact discs containing recorded performances of musical works – is the legal basis for many forms of exploitation of protected works.

¹⁴ Adaptation is generally understood as the modification of a work to create another work, for example adapting a novel to make a film, or the modification of a work for different conditions of exploitation, e.g., by adapting a textbook originally written for university students to make it suitable for a lower level.

- To do, in relation to a work that is an adaptation of the first-mentioned work, any of the acts specified above.
- To do all or any of the following acts in the case of an artistic work:
 - To reproduce the work in a material form;
 - To publish the work in Singapore or any country, if the work is unpublished;
 - To communicate the work to the public; and
- To enter into a commercial rental agreement in respect of the program unless the program is not the essential object of the rental in the case of a computer program.

4.2.2 Infringement of copyright by reproduction

Pursuant to section 26(1) of the CA, the reproduction of a work in a material form is one of the exclusive rights conferred by copyright in relation to a work. Whether a work has been reproduced in a material form varies depending on the type of work in which copyright subsists.

- For literary, dramatic, or musical work, reproduction includes reproduction in the form of a sound recording or cinematograph film of the work. It is reproduced if it is converted into or from a digital or other electronic machine-readable form, and any article embodying the work or reproduction of the work in such a form - section 15(1B) of CA.
- For artistic work, reproduction includes making a version or copy in three dimensions of a two-dimensional work and the making of a version or copy in two dimensions of a three-dimensional work - section 15(3) of the CA.
- Any other work: reproduction includes the making of a copy which is transient or is incidental to some other use of the work - Section 15(1A) of the CA.

Section 17 of the CA states that the reduction or adaptation of a work to a material form, includes storing that work or adaptation in a computer, on any electronic medium; or on any other medium from which the work or adaptation, or a substantial part of the work, can be directly reproduced. There must be sufficient objective similarity between the two works and a causal connection between them before a work can constitute a 'reproduction'.

4.2.3 Infringement by importing infringing copies

Under section 32 of the CA, any person infringes the copyright in a work if he or she, without the license of the owner of the copyright, imports an article into Singapore for the purpose of:

- Selling, letting for hire, or by way of trade offering or exposing for sale or hire, that article;
- Distributing the article for the purpose of trade or for any other purpose that prejudicially affects the owner of the copyright; or
- By way of trade exhibiting the article in public, where he or she knows, or ought to reasonably know, that the making of the article was carried out without the consent of the owner of the copyright.

Commentary - An exclusive license may provide that the licensee shall have the same rights and remedies as if the licence had been an assignment. In such a case, the exclusive licensee may bring infringement proceedings in its own name against any person other than the proprietor. Otherwise, licensees (exclusive or not) do not have rights to bring proceedings for infringement in their own name unless they have first called upon the proprietor to do so and the proprietor refuses to, or fails to do so within 2 months after being called upon. Exclusive licensees for copyrights have the same rights of action and are entitled to the same remedies as the owner of the copyright,

*except against the owner of the copyright.*¹⁵

4.2.4 Defences/ exceptions: acts not considered as copyright infringement

4.2.4.1 The defence of fair dealing generally

Under section 35(1) of the CA, fair dealing with a literary, dramatic, musical, or artistic work (or with an adaptation of a literary, dramatic, or musical work) does not infringe the copyright in the work.

Section 35(2) of the CA sets out several matters that shall be given regard in determining whether a dealing with a literary, dramatic, musical, or artistic work or any adaptation of such work, by way of copying the whole or part of the work or adaptation, constitutes fair dealing for the work or adaptation:

- the purpose and character of the dealing, including whether such dealing is of a commercial nature or is for non-profit educational purposes;
- the nature of the work or adaptation;
- the amount and substantiality of the part copied taken in relation to the whole work or adaptation;
- the effect of the dealing upon the potential market for, or value of, the work or adaptation; and
- the possibility of obtaining the work within a reasonable time at an ordinary commercial price.

4.2.4.2 Fair dealing in relation to research or study

Pursuant to section 35(3) of the CA, dealings with a literary, dramatic, or musical work, or with an adaptation of such a work are deemed to be fair dealings for the purposes of research or study if:

- the work or adaptation comprises an article in a periodical publication, copying the whole or a part of that work;
- in all other cases, copying not more than a reasonable portion of the work or adaptation.

4.2.4.3 Fair dealing for purposes of criticism or review

Pursuant to section 36 of the CA, fair dealing with a work (or with an adaptation of a work) for the purpose of criticism or review does not infringe the copyright in the work, provided that a sufficient acknowledgement of the work is made.

4.2.4.4 Fair dealing for purposes of reporting current events

Pursuant to section 37 of the CA, fair dealing for the purpose of reporting current events in a newspaper, magazine or similar periodical does not infringe the copyright in the work, provided that a sufficient acknowledgement of the work is made.

No acknowledgment is required in connection with the reporting of current events by means of broadcasting or a cable program service or in a cinematograph film.

4.2.4.5 Acts done for purposes of judicial proceedings or professional advice

Section 38 of the CA states that any copyright in a literary, dramatic, musical, or artistic work is not infringed by another, if the doing is for the purpose of a judicial proceeding or for a report of a judicial proceeding; for seeking professional advice from an advocate and solicitor; or even giving of professional advice by an advocate and solicitor.

¹⁵ <https://www.legal500.com/guides/chapter/singapore-intellectual-property/>

Commentary: Currently, civil copyright infringement proceedings can be commenced in the High Court or the State Courts, depending on the value of the claim. However, once the amendments to the CA come into force pursuant to the Intellectual Property (Dispute Resolution) Act 2019, the High Court will have exclusive jurisdiction to hear copyright infringement proceedings.

4.3 Civil IP remedies in trademark and copyright cases

4.3.1 Damages

The Court may grant damages to the proprietor of the registered trademark in an action for an infringement pursuant to section 31(2)(b) of the TMA. Damages is also one of the remedies a Court can grant under section 119(2)(b) of the CA.

4.3.2 Account of profits

Section 31(2)(c) of the TMA and section 119(2)(c) of the CA provides that the court can grant the remedy of an account of profits (a remedy which aims to cut the profits made by the defendant by committing a wrongful act under law) in an action for trademark infringement and copyright infringement, respectively. Similar to the injunctions, account of profits is a discretionary remedy.

Commentary: Remedies are the measures of relief that the Court can grant to a person whose rights are infringed. In civil lawsuits, remedies for trademark and copyright owners include injunctions (to stop someone from doing something), damages (whether actual damages, as proved, or statutory damages), account of profits, an order for erasure of the offending sign, and an order for delivery up and disposal of the infringing goods.

Where it is proper to do so, considering the extent of the infringement, the Court may also order additional damages to be paid by the infringing party to the right owner.¹⁶ In practice, IP infringement proceedings are often bifurcated into two tranches – proceedings for liability, and if liability is established, proceedings for assessment of damages / account of profits. This saves time and costs for all parties: if liability is not established, parties need not adduce evidence or make submissions on the quantum of damages / profits to be paid.

As the remedy of damages and account of profits are alternative remedies, right holder must elect to claim either of them. The court will typically order pre-action discovery at the start of the assessment of damages / account of profits proceedings. It enables the rights-holder to make an informed decision on which remedy to claim.

Pre-action discovery may be applied for where one party (the applicant) requires documents or information from another party in order to:

- decide whether the applicant has a cause of action;
- identify a wrong-doer; or
- obtain necessary information and documents to properly frame or quantify a claim

4.3.3 Injunction

Section 31(2)(a) of the TMA provides that the court may grant an injunction subject to such terms, as it thinks fit. Similarly, section 119(2)(a) of the CA lists injunction as a remedy by the court for an infringement of copyright. Injunctions are discretionary remedies and are broken down to interlocutory and final injunctions.

¹⁶ https://www.ipos.gov.sg/docs/default-source/resources-library/copyright/copyright-infopack_updated-oct-12.pdf

Commentary: Both interlocutory and final injunctions may be available as remedies. Interlocutory or interim injunctions are generally granted in the interim until further order of the Court or the conclusion of a trial. An interim injunction can be mandatory (requiring a person or entity to do something) or prohibitory (requiring a person or entity not to do something). The purpose of an interim injunction is to preserve the position of a party claiming to have suffered damage by an incorrect or unlawful action, until that party's challenge to the action can be fully heard and determined by the Court finally. A final injunction is granted after a trial is concluded, on the merits¹⁷ of the case.

4.3.4 Statutory damages

Section 31(2)(d) of the TMA states that the court may grant the statutory damages provided in section 31(5)(c) where the infringement involves the use of a "counterfeit trademark". The objective of statutory damages is to compensate the trademark proprietor for losses suffered, particularly in cases where losses are hard to prove. Statutory damages are quantified not to exceed SGD100,000 for each type of goods or service in relation to which the counterfeit trademark has been used, and not to exceed SGD1 million in aggregate, unless the aggrieved party proves that his actual loss from the infringement exceeds SGD1 million.

Section 119(2)(d) of the CA states that the court may grant, where the plaintiff/claimant has elected for an award of statutory damages instead of damages or an account of profit. Statutory damages are quantified not to exceed SGD10,000 for each work or subject-matter in respect of which the copyright has been infringed; but not more than SGD200,000 in the aggregate, unless the plaintiff proves that his actual loss from such infringement exceeds SGD200,000.

Commentary: Statutory damages can be awarded in situations where the right-holder has suffered damage as a result of the infringement, but has evidential difficulties proving the amount of damages suffered or likely suffered or proving the infringer's profits. However, the type of relief is not intended to allow recovery damages where no loss is suffered; therefore, it remains incumbent on the rights-holder to show that it has suffered or is likely to suffer loss.

As the plaintiff/complainant will not receive any compensation from the infringer through the criminal process, they may simultaneously commence civil litigation proceedings to claim for monetary compensation from the infringer.

In determining the amount of statutory damages, the Court is to consider these factors:

- *Nature and purpose of the infringing act, including whether the infringing act was of a commercial nature or otherwise;*
- *Flagrancy of infringement;*
- *If the act was done in bad faith;*
- *Any loss suffered or likely to be suffered by the copyright owner;*
- *Any benefit shown to have accrued to the defendant;*
- *conduct of both parties before and during proceedings;*
- *The need to deter similar instances of infringement; and*
- *All other relevant matters.*

4.3.5 To erase, remove obliterate offending sign and counterfeit goods

Under section 32(1)(a) of the TMA, the court may order a person who is found to have infringed a registered trademark to erase, remove or obliterate the offending sign from any infringing goods, material or articles in his possession, custody, or control.

4.3.6 Delivery up/Destruction/Disposal of infringing goods, material, or articles

Pursuant to section 32(1)(b) of the TMA, the court may order the infringing goods, material, or articles, to be destroyed if it is not reasonably practicable for the offending sign to be erased, removed, or obliterated. Section 33 of the TMA states that the court may order any infringing goods, material, or articles in the possession of the defendant (alleged offender) or before the court to be delivered to the

¹⁷ referring to a judgment, decision or ruling of a court based upon the facts presented in evidence and the law applied to that evidence.

plaintiff/claimant. An application can then be made to the court for an order to destroy or forfeit the infringing goods as stated in section 34(1) of the TMA.

Pursuant to section 136(8) of the CA, regardless of whether a person is convicted of an offence under section 136 of the CA in relation to copyright infringement or not, the court may order any articles that appears to be an infringing copy or any article which has been used for making infringing copies in the possession of the alleged offender or before the court to be destroyed, delivered up to the owner of the copyright concerned or otherwise deal with in such a manner as the court thinks fit.

Commentary: Usually High Court infringement proceeding may take around two years to conclude. Costs depend on complexity and generally range from SGD 150,000 to SGD 500,000 (usually for complex patent cases).

Commentary:

Pros of Civil Enforcement:

- permanent injunction can be obtained.
- preliminary injunction can be requested.
- monetary compensation can be awarded for damages caused by the infringement.
-

Cons of Civil Enforcement

- Procedure is usually more time consuming and costly than criminal enforcement.
- Strong evidence of infringement and commercial prejudice needed (higher burden of proof of infringement)
- May be difficult to enforce the Court's decision in case the defendant does not have assets or declares its bankruptcy.

4. DIGITAL IP ENFORCEMENT IN SINGAPORE

4.1.1. Online trade mark infringement in Singapore

As there are no provisions specific to digital trade mark enforcement in Singapore, the same principles under the TMA applies to online trade mark infringement. To date, there are no reported decisions on trade mark infringement cases against internet service providers or online marketplaces. This is possibility due to the usual notification and takedown mechanisms that brand owners can avail themselves to.

4.1.2. Online copyright infringement in Singapore

Generally, the same principles under the CA apply to online copyright infringement. The Singapore government has also enacted specific legislation to more effectively deal with the proliferation of copyright infringement committed over the Internet.

In particular, sections 193DDA to 193DDE CA were introduced in 2014 to require network service providers upon an application by rights-holders to block access to a “*flagrantly infringing online location*”, such as illegal movies and sports streaming websites. The courts have also ruled that courts have the power to issue a “dynamic” injunction pursuant to section 193DDA CA, to require network service providers to disable new means of accessing those infringing websites, for example, by a new domain name, web address or IP address upon a subsequent request by the rights-holders without the need

for a new application to court¹⁸. This provides rights-holders with the means to deal more effectively with circumventive measures taken by these online infringers.

The CA also contains safe harbor provisions (see sections 193B to 193D CA) which exempt a “network service provider” from copyright infringement in relation to the following activities, subject to their fulfilment of the prescribed conditions:

1. transmission, routing and provision of connections for an electronic copy of the copyrighted work, and transient copy of the work made in the process (section 193B CA);
2. system caching (section 193C CA); and
3. storage and information location of an electronic copy of the copyrighted work (section 193D CA).

As the phrase “network service provider” has not been defined in the CA or by the courts, it is an open question whether e-commerce platforms fall within this definition in order to qualify for protection under these safe harbour provisions. However, given the breadth of this definition, it is arguable that they do.¹⁹

Commentary: *In practice, major online marketplaces operating in Singapore (like Shopee and Lazada) have in place measures against IP infringement committed on their platforms. To that end, they provide right-holders with proper channels to issue take-down requests against infringing proprietors, and these requests are typically processed and acted upon swiftly. There are case laws that validate that online platforms can no longer refute liability merely because they do not physically manufacture or stock the products and Courts will investigate an ISPs purported business model to determine their **secondary liability**, if need be.²⁰*

*Similarly, as regards site-blocking applications brought by right-holders against infringing streaming websites under Part IXA of the CA, Singapore network service providers generally will not object to such applications unless they are without merit or improperly commenced. An example of a meritless case is PCCW Media Ltd v M1 Ltd and others [2018] 5 SLR 375, where the network service providers successfully opposed the application brought by the plaintiff/complainant on the basis that it had no **locus standi** to make the application since it was a mere licensee of Korean dramas.*

5 CUSTOMS IP BORDER ENFORCEMENT

5.1 Trademark

Seizure of goods on request (Lodgement of Notice)

5.1.1 Restriction of importation or exportation of infringing goods

Under section 82 of the TMA, a person who is the proprietor or a licensee of a registered trademark may give the Director-General a written notice stating that he is the proprietor or a licensee of the registered trademark of goods that are expected to be imported or exported and are infringing goods, thereby requesting the Director to seize those goods.

5.1.2 Seizure and inspection of counterfeit goods (transshipment)

¹⁸ *Disney Enterprises, Inc and others v M1 Ltd and others* [2018] 5 SLR 1318 at [37]-[50]

¹⁹ *RecordTV Pte Ltd v MediaCorp TV Singapore Pte Ltd and others* [2010] 2 SLR 152 at [89].

²⁰ *Calvin Klein, Inc and another v HS International and others* [2016] SGHC 214

Under section 93A of the TMA, an authorized officer may examine any goods, including goods in transit²¹, or seize any goods that are imported into, or exported from Singapore; and that are not goods in transit and consigned to a local person with a commercial or physical presence in Singapore.

As soon as practicable after the goods are seized, the Director-General must give a written notice (personally, by post or (with the prior consent of the addressee) by email) to the importer, exporter or consignee of the seized goods, and the proprietor of the registered trademark of such seizure.

The Director-General can continue to detain the seized goods if the registered proprietor wishes to continue the detention to institute an infringement action. The Director-General can only do so if the proprietor:

- gives a written notice supported by such documents and information as the Director-General may require, accompanied by requisite fee; and,
- either deposits a sum of money with the Director-General that is sufficient in the Director-General's opinion; or give security to the Director-General's satisfaction for such purpose, unless the owner had earlier given such deposit or security it had not been forfeited or returned or the security is still effective.

5.1.3 Powers of search in relation to vessels, aircraft, and vehicles

Pursuant to section 94 of the TMA, an authorized officer may board any conveyance in Singapore and may search all parts of the conveyance for goods liable to be seized.

Such powers include, amongst others:

- requiring the master of any vessel in Singapore to heave to;
- require the vessel or aircraft, as the case may be, not to proceed until so authorized; and
- break open and forcibly enter any the conveyance to which he cannot otherwise reasonably obtain access.

An authorised officer may exercise the powers conferred by this section in respect of a vessel under way if he reasonably suspects that it is not in transit through Singapore.

5.1.4 Examination of packages, etc

Under section 95 of the TMA, any goods, package, box, chest or other article which has been recently imported or exported and is reasonably suspected to contain goods liable to be seized under Section 82 or 93A of the TMA may be examined and searched by an authorized officer, or detained until any person in charge has opened it for examination and search. It can also be forcibly opened for infringement verification or tests or analysis as the authorized officer thinks fit.

5.2 Copyright

5.2.1 Restriction of importation or exportation of copyrighted works

Similar to counterfeit goods for trademark infringement, Singapore adopts a notification procedure to allow copyright owners or licensee to request the Director-General of Customs to seize specific infringing copies of copyright material to be imported or exported, without the consent of the copyright owner or licensee. The notice must be accompanied by the fee prescribed under section 140AB and the copyright owner must also furnish a security deposit to the Director-General as part of the notification procedure.

As soon as practicable after copies are seized, the Director-General will issue a written notice to both the importer and the owner or licensee. Pursuant to section 140E(1) of the CA, seized copies will be released to the importer unless:

²¹ "Goods in transit" is defined as "goods imported, whether or not landed or transhipped within Singapore, which are to be carried to another country either by the same or another conveyance".

- an action for infringement of copyright in respect of the copies is instituted by the owner or licensee within a specified period; and

the owner or licensee gives written notice to the Director-General within that period stating that the action for infringement of copyright has been instituted.

If the owner or licensee fails to commence infringement action in respect of the seized copies within the retention period, a person aggrieved by such seizure may apply to the court for an order of compensation against the requestor under section 140IA (1) of the CA.

5.2.2 Seizure and inspection of copyrighted works (transshipment)

In addition, customs officers may also exercise *ex officio* powers to seize copyright items. Pursuant to section 140LA(1) of the CA, an authorized officer may examine any copies of copyright material (including goods in transit), or detain any copies of copyright material that are imported into, or exported from, Singapore; and that are not goods in transit, unless they are consigned to a person with a commercial or physical presence in Singapore.

Section 140LA(3) states that as soon as practicable after the copies of the copyright material are detained, the Director-General must give a written notice (given personally, by post or with the prior consent of the addressee by email) to the importer, exporter or consignee of the seized copies, and the owner of the copyright in the copyright material.

Pursuant to section 140LB(1) of the CA, the Director-General can continue to detain the seized copies of the copyright material so that the owner of the copyright may institute an action for infringement of copyright in relation to them. The Director-General can only do so if the owner:

- gives the Director-General a written notice supported by such documents and information as the Director-General may require, and accompanied requisite fee and;
- either deposits a sum of money with the Director-General that is sufficient in the Director-General's opinion; or give security to the Director-General, unless the owner had earlier given such deposit or security and the deposit had not been forfeited or returned or the security is still effective.

*The Seizure process for trademarks and/or copyright is shown in Annex 2 of this Chapter.

Commentary: *Singapore Customs is a governmental agency run by the Ministry of Finance. Their objective is the implementation of customs and trade enforcement measures, including the checking and detainment of suspected infringing goods crossing the border. Singapore's port is a major transit point for imports and exports travelling between Europe and East Asia.*

There is no official IP recordal system in Singapore via which right holders can request that customs monitor suspected infringing goods being imported into Singapore and notify interested parties. However, border enforcement can be activated by giving written notice to customs about the suspected importation of IP infringing goods. This protection can only be activated for registered trademarks and copyrighted materials. Occasionally customs may also act ex officio and detain goods imported into or exported from Singapore, and goods which are in transit in Singapore and consigned to a local person. The IP owner must file a written notice to customs to inform them of each suspected shipment.

Notice given to the Director General is valid for 60 days. Within this period, Singapore Customs will seize the infringing copies or goods if they are being imported into Singapore. The objector and the importer or consignee will be informed of the seizure. The objector has to institute an action for copyright or trademark infringement and notify the Director General accordingly within 10 working days of the issue of the notice of seizure by the Director General. The time limit for initiating infringement action may be extended by a further 10 working days at the request of the objector.²²

²² https://www.southeastasia-iprhelpdesk.eu/sites/default/files/bean_files/singapore_factsheet.pdf

Singapore's intellectual property border enforcement procedures have been enhanced significantly by the Intellectual Property (Border Enforcement) Act 2018, which gives the local custom enforcement agencies wider powers relating to seizure and the obtaining of information.

The main IP owner complaint is that a large volume of transshipped products flow unchecked through Singapore's port, sometimes in conjunction with the nearby Indonesia port of Batam. An example of such a case is Burberry Ltd v Megastar Shipping Pte Ltd and another appeal [2019] SGCA 1. IP owners have only one remedy to sue the shipping companies, but they will not be liable as mere shippers without knowledge.

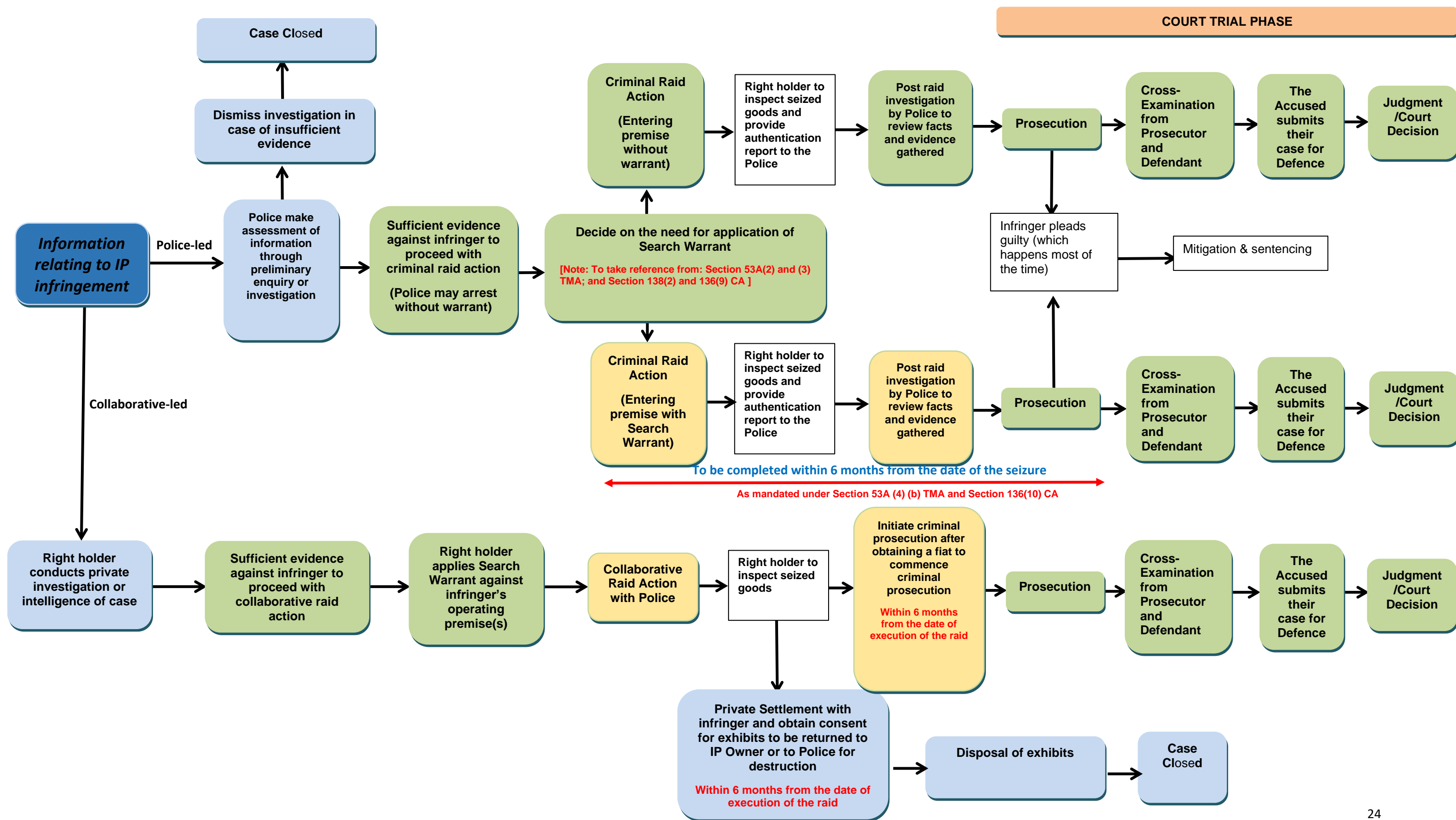
6 ALTERNATIVE DISPUTE RESOLUTION

Mediation and arbitration are common methods of alternative dispute resolution. WIPO has established an Arbitration and Mediation Centre (AMC) in Singapore, that provides alternative dispute resolution options to enable private parties to settle their domestic or cross-border IP disputes. The Singapore International Arbitration Centre (SIAC) also provides facilities for arbitration and has a specialised IP Panel of arbitrators to hear IP disputes.

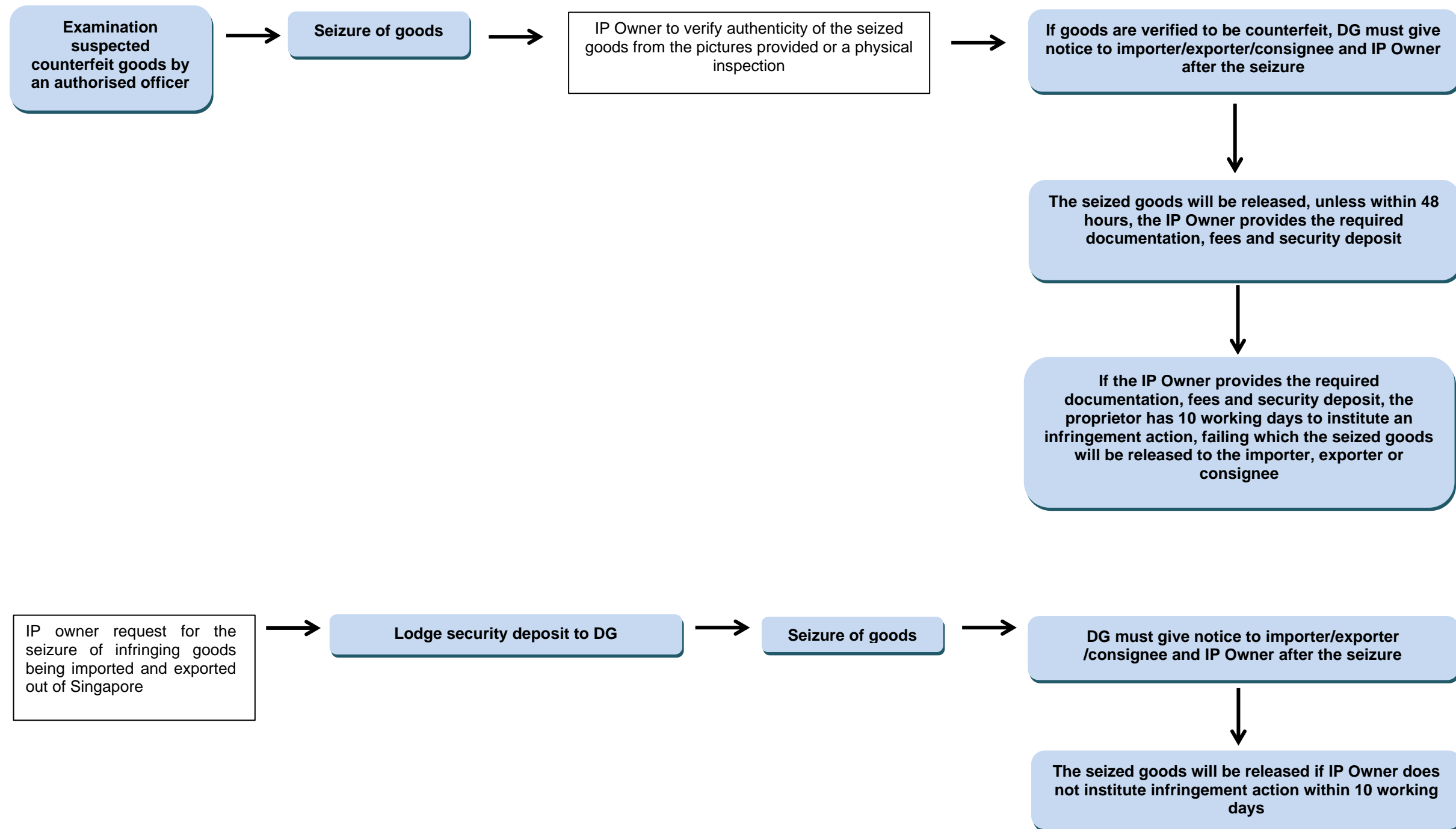
7 CEASE & DESIST LETTERS AND SETTLEMENTS

Most IP disputes in Singapore can be resolved by issuing a Cease & Desist letter and negotiating a settlement due to the strict enforcement of laws. Settlement agreements, including undertakings and statutory declarations, destruction of the infringing goods and compensation are commonly demanded and obtained in most out-of-court resolutions.

ANNEX 1: FLOWCHART FOR CRIMINAL PROCEDURE FOR TRADEMARK AND COPYRIGHTS



ANNEX 2: FLOWCHART ON CUSTOMS SEIZURE PROCESS FOR TRADEMARKS AND/OR COPYRIGHT



ANNEX 1: CONTACT DETAILS OF INTELLECTUAL PROPERTY OFFICES - SINGAPORE

Contact details of IP Offices	Website
Intellectual Property Office of Singapore (IPOS) Address: 1 Paya Lebar Link #11-03 PLQ 1, Paya Lebar Quarter, 408533 Tel: 6339 8616	https://www.ipos.gov.sg/

ANNEX 2: REFERENCES TO COPYRIGHT AND TRADEMARK LAWS - SINGAPORE

Relevant links from WIPO Lex
Trademark Law: https://wipolex.wipo.int/en/legislation/details/18797 Copyright Law: https://wipolex.wipo.int/en/legislation/details/18348