

Enforcement of Intellectual Property Rights (IPR) Singapore

1. Introduction to IPR Enforcement in Singapore

Intellectual Property Rights can be enforced by the rights holders themselves via civil actions. In addition, criminal enforcement activities (e.g. raids on software pirates) are carried out regularly by the Intellectual Property Rights Branch of the Criminal Investigations Department of the Singapore Police Force. Border enforcement measures are carried out by Singapore Customs.

2. Civil IPR Enforcement

2.1. Competent Courts

2.1.1. First Instance

Depending on the type of intellectual property right and the monetary damages claimed, civil actions are commenced in the Subordinate Courts or in the High Court.

2.1.2. Appeal

Depending on where the civil action was first commenced, the relevant appeal courts are the High Court and the Court of Appeal.

2.2. Remedies Available (Compensation, Injunctions – Preliminary and Final)

Civil remedies for copyright infringement include an injunction, damages (whether actual damages, as proved, or statutory damages), and an account of profits. Where it is proper to do so, considering the flagrancy of the infringement, any benefit shown to have accrued to the defendant by reason of the infringement; and all other relevant matters, the Court may also order additional damages to be paid by the infringing party to the copyright owner. The court may also make an order for the delivery up and/or disposal of infringing copies.

Civil remedies for the circumvention of a technological measure applied to a copyrighted work or for certain acts relating to rights management information include:

- an injunction;
- either:
 - damages;
 - account of profits; or
 - an award of statutory damages in lieu of damages or account of profits, of not more than S\$20,000; and/or
- delivery up or destruction of the contravening articles.



Civil remedies for patent infringement include an injunction to stop the infringing action, demand for the profits gained by the infringing party at his expense and/or, damages for the loss suffered.

Civil remedies for registered design infringement include an injunction, a demand for the profits gained by the infringing party at his expense and/or damages for the loss suffered.

Civil remedies for trade mark infringement include an injunction and either a demand for the profits gained by the infringing party at his expense or damages for the loss suffered. When awarding damages, the Court may also award an account of profits attributable to the infringement that have not been taken into account in computing the damages. In an infringement action involving the use of a counterfeit trade mark in relation to goods or services, the owner of the registered trade mark has an additional alternative remedy of statutory damages (of up to S\$100,000 for each type of goods or service in relation to which the counterfeit trade mark has been used, and not exceeding in the aggregate S\$1 million, unless the plaintiff proves that his actual loss from such infringement exceeds S\$1 million.) The court may also make an order for the delivery up and destruction/ forfeiture of infringing goods, material or articles

A producer, trader or an association who takes legal action under the Geographical Indications Act for infringing use of the Geographical Indication may seek the following relief - an injunction; an accounting of the profits gained as a result; and/or damages for the loss suffered.

Civil remedies for infringement of a protected plant variety include an injunction to stop the infringing activities, a demand for the profits gained by the infringing party at his expense and/or damages for the loss suffered.

The owner who takes legal action under the Layout-design of Integrated Circuits Act for infringement may seek relief in the form of an injunction or demand an accounting for the profits gained and/or seek damages for the loss suffered from the infringement. The court may also award additional damages, having regard to all of the circumstances of the case including the flagrancy of the infringement and any benefit accruing to the defendant by reason of the infringement.

2.3. Execution of Court Orders

2.3.1. Local Court Orders

Local court orders may be executed in accordance with the Rules of Court.

2.3.2. Overseas Court Orders

An application for the reciprocal enforcement of judgments may be made in accordance with the Reciprocal Enforcement of Commonwealth Judgments Act (Chapter 264) and the Reciprocal Enforcement of Foreign Judgments Act (Chapter 265) and the Rules of Court.

3. Criminal IPR Enforcement

3.1. Police Authorities (Commercial, Market, Economic Police Etc.)

Regular enforcement activities are carried out by the Intellectual Property Rights Branch of the Criminal Investigation Department (CID) of the Singapore Police Force.

3.2. Competent Courts and Jurisdiction (Including Appeal)

Magistrate's Court, District Court, High Court and Court of Appeal

3.3. Penalties

Copyright

In Singapore, copyright criminal offences include the following:

- the making of infringing copies for sale;
- the sale of infringing copies;
- the possession or import of infringing copies for the purposes of sale or of distribution for the purpose of trade;

In any of the instances above, it must be proven that the infringing party knows or ought reasonably to know that the copies were infringing copies at the relevant time.

Singapore law provides that where a person is found to have more than 5 copies of any one work, it is presumed that the infringing copies were not for personal use.

The penalties for the above offences are a fine not exceeding S\$10,000 for the article or for each article in respect of which the offence was committed or S\$100,000, whichever is the lower, or to imprisonment for a term not exceeding 5 years or to both.

It is also a criminal offence to distribute infringing copies for the purposes of trade or for other purposes so as to affect prejudicially the copyright owner. If guilty, the penalties are a fine of up to \$50,000 or to imprisonment for a term not exceeding 3 years or to both.

The making or possession of an article designed for making infringing copies is also an offence attracting the following penalties: a fine not exceeding S\$20,000 for each such article; and/or imprisonment for up to 2 years.

Further, it is also a criminal offence if a person wilfully infringes copyright either to a significant extent or for the purpose of obtaining a commercial advantage. Commercial advantage means any direct advantage, benefit or financial gain for a business or trade. As to whether the infringement is to a significant extent, this is judged based on the volume, value of infringing copies and whether the infringement has a substantial prejudicial impact on the copyright owner and all other relevant matters.

The criminal penalties for such wilful copyright infringement are:

- 1st offence, a fine not exceeding S\$20,000 and/or imprisonment up to 6 months;
- 2nd or subsequent offence, a fine not exceeding S\$50,000 and/or imprisonment up to 3 years.

Under Section 136(6) of the Copyright Act, any person who for private profit causes a literary, dramatic or musical work to be performed in public, or causes a cinematograph film to be seen or heard or seen and heard in public, other than by the reception of a television broadcast or cable programme, where he knows, or ought reasonably to know, that copyright subsists in the work or cinematograph film and that the performance constitutes an infringement of the copyright, shall be guilty of an offence and shall be liable on conviction to a fine not exceeding S\$20,000 or to imprisonment for a term not exceeding 2 years or to both.

Under Section 139 of the Copyright Act, any person who, by any means, publishes, or causes to be published, in Singapore an advertisement for the supply in Singapore (whether from within or outside Singapore) of a copy of a computer program which is an infringing copy shall, unless he proves that he acted in good faith and had no reasonable grounds for supposing that copyright would or might thereby be infringed, be guilty of an offence and shall be liable on conviction to a fine of up to \$20,000 or to imprisonment for a term not exceeding 2 years or to both.

Under Sections 254(A) (5) and 254(A)(6) of the Copyright Act, a person who, at any time during the protection period of a performance, for his private profit and without the authority of the performer:

- (1) causes the performance to be seen or heard, or seen and heard, live in public; or
- (2) causes a recording of the performance, being a recording which he knows or ought reasonably to know is an unauthorised recording, to be heard in public

shall be guilty of an offence and shall be liable on conviction to a fine not exceeding \$20,000 or to imprisonment for a term not exceeding 2 years or to both.

Where technological measures are applied to copyrighted works and a person performs any of the acts below willfully and for the purpose of obtaining any commercial advantage, if convicted, he may be liable to

- a fine not exceeding S\$20,000 for (a); or
- a fine not exceeding S\$20,000 or imprisonment for a term not exceeding 2 years or both for (b) or (c).

- (a) knowingly circumvents a technological measure that effectively controls access to a work;
- (b) manufactures, imports, distributes, offers to the public, provides or otherwise traffics in any device, product or component which serves to circumvent a technological measure ("circumventing device") which
 - (i) is promoted as to circumvent the technological measure,



- (ii) has limited commercial significance other than to circumvent the technological measure, or
 - (iii) is designed or made primarily for the purpose of circumventing the technological measure;
- (c) offers to the public or provide any service which relates to circumventing a technological measure (that either effectively restricts access or that effectively limits or prevents any unauthorised/infringing act) (“circumventing service”) which
- (i) is promoted, advertised or marketed for the purpose of circumventing the technological measure,
 - (ii) has limited commercial significance other than to circumvent the technological measure, or
 - (iii) is performed primarily for the purpose of circumventing the technological measure.

Where a person performs any of the acts below relating to rights management information willfully and for the purpose of obtaining any commercial advantage, if convicted, he may be liable to:

- a fine not exceeding S\$20,000 for (a); or
 - a fine not exceeding S\$20,000 or imprisonment for a term not exceeding 2 years or both for (b) or (c).
- (a) knowingly removes or alters the rights management information relating to any work;
 - (b) distributes or imports for distribution the rights management information relating to any work being rights management information which has been altered; or
 - (c) distributes, imports for distribution, communicates or makes available to the public copies of a work in which the rights management information has been removed or altered.

Plant Varieties

Under Section 46 of the Plant Varieties Protection Act, a person who willfully or negligently misuses the registered denomination shall be guilty of an offence and shall be liable on conviction to a fine of up to S\$10,000.

Trade Marks

Under Section 46(1) of the Trade Marks Act, any person who counterfeits a registered trade mark shall be guilty of an offence and shall be liable on conviction to a fine not exceeding S\$100,000 or to imprisonment for a term not exceeding 5 years or to both.

Under Section 47(1) of the Trade Marks Act, any person who falsely applies a registered trade mark to goods or services shall, unless he proves that he acted



innocently, be guilty of an offence and shall be liable on conviction to a fine not exceeding S\$100,000 or to imprisonment for a term not exceeding 5 years or to both.

Under Section 48 of the Trade Marks Act, any person who —

(a) makes an article specifically designed or adapted for making copies of a registered trade mark or a sign likely to be mistaken for that trade mark; or
(b) 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, or in the course of, committing an offence against section 46 or 47, shall be guilty of an offence and shall be liable on conviction to a fine not exceeding S\$100,000 or to imprisonment for a term not exceeding 5 years or to both.

Under Section 49 of the Trade Marks Act, any person who —

(a) imports into Singapore for the purpose of trade or manufacture;
(b) sells or offers or exposes for sale; or
(c) has in his possession for the purpose of trade or manufacture, any goods to which a registered trade mark is falsely applied shall, unless he proves that:

(i) 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
(ii) he had acted innocently,

be guilty of an offence and shall be liable on conviction to a fine not exceeding S\$10,000 for each goods or thing to which the trade mark is falsely applied (but not exceeding in the aggregate S\$100,000) or to imprisonment for a term not exceeding 5 years or to both.

4. Border Control

4.1. Registration Procedure

Copyright

Restriction on the Importation of Infringing Copies

A copyright owner or licensee may serve on the Director-General of Customs a written notice stating that he objects to the impending importation of infringing copies of his works. The person would have to provide sufficient information to enable the Director-General of Customs to identify the alleged infringing copies and to ascertain the time and place where the copies are expected to be imported. The person would also have to satisfy the Director-General of Customs that the copies are infringing copies. Copies of the relevant notice can be found on IPOS website www.ipos.gov.sg (Forms Download > Copyright Forms > Border Enforcement Notices). The notice is to be accompanied by a statutory declaration that the particulars in the notice are correct; and the fee of S\$200 as specified in the Copyright (Border Enforcement Measures) Regulations.

The notice is to be served during the business hours of the office of the Singapore Customs and at such time as is reasonably possible for an authorized officer to take any action under the Copyright Act in relation to the notice. The notice shall remain in force for 60 days commencing on the day on which the notice was given, or the end of the period for which the copyright in the copyright material to which the notice relates is to subsist, whichever is earlier.

If the notice has been given, it has not lapsed or been revoked, and a person imports copies of the copyright material for any one of the purposes in Section 140B(7) Copyright Act (listed below), an authorized officer may seize the copies.

- selling, letting for hire, or by way of trade offering or exposing for sale or hire, the copies;
- distributing the copies for the purpose of trade;
- distributing the copies for any other purpose to an extent that will affect prejudicially the owner of the copyright in the copyright material; or
- by way of trade exhibiting the copies in public.

The Director General of Customs shall inform the objector and importer of the seizure as soon as is practicable by written notice. Unless an infringement action in respect of the copies is instituted within 10 working days from the date specified in the notice, and the objector gives written notice to the Director General stating that the infringement action has been instituted, the goods shall be released to the importer (if there is no written notice from the importer consenting to the seized copies being forfeited to the Government). The objector may request for a further extension of ten working days to institute the infringement action.

If an infringement action has been instituted in relation to the seized copies, but at the end of 3 weeks from the day on which the action was instituted, there is no court order in force preventing the release of the copies, the Director General shall release the goods to the importer

Detention of Infringing Copies

An authorised officer may (a) detain any copies of copyright material (i) that are imported into, or that are to be exported from, Singapore; and (ii) that are not goods in transit, unless the copies are consigned to any person with a commercial or physical presence in Singapore; or (b) examine any copies of copyright material, including goods in transit, which he reasonably suspects are infringing copies of any copyright material.

Upon detention, the Director-General shall give a written notice to the importer, exporter or consignee (as the case may be) of the detained copies and to the copyright owner. The detained copies shall be released to the importer, exporter or consignee, as the case may be, unless, within the prescribed period (see below), the owner of the copyright in the copyright material:

(a) in the case of copies that are imported into Singapore and that are not goods in transit:

- (i) gives the Director-General the written notice referred to in Section 140B (1) of the Copyright Act;
 - (ii) submits to the Director-General the documents and information referred to in Section 140B (2) Copyright Act; and
 - (iii) deposits with the Director-General the sum of money referred to in section 140C (a) or gives the security referred to in section 140C (b) of the Copyright Act;
- or
- (b) in the case of copies that are to be exported from Singapore or copies that are goods in transit and consigned to a person with a commercial or physical presence in Singapore —
 - (i) institutes an action for the infringement of his copyright;
 - (ii) serves on the Director-General an order of the court authorising the further detention of the copies; and
 - (iii) deposits with the Director-General a sum of money that, in the opinion of the Director-General, is sufficient to —
 - (A) reimburse the Government for any liability or expense it has and is likely to further incur as a result of the detention of the copies; and
 - (B) pay such compensation to any person who suffers loss or damage as a result of the detention of the copies as may be ordered by the court, or gives security, to the satisfaction of the Director-General, for the reimbursement of the Government for any such liability or expense and the payment of such compensation.

The prescribed period is:

- (a) 48 hours after the Director General has given the owner of the copyright in the copyright material or the performer of the performance embodied in an unauthorized recording, as the case may be, the written notice; or
- (b) where the detained copies of copyright material or unauthorized recording of a performance, as the case may be, are copies that are to be exported from Singapore or goods in transit that are consigned to a person with a commercial or physical presence in Singapore; and the owner of the copyright or the performer of the performance embodied in the unauthorized recording has deposited with the Director General the sum of money or the security required under Section 140LA (3)(b)(iii) Copyright Act, or section 140LA(3)(b)(iii) read with Section 254B of the Copyright Act within the 48 hour period in paragraph (a), 10 working days after the Director General has given the owner of the copyright in the copyright material or the performer the written notice referred to in Section 140LA(2) of the Act.

Trade Marks

Restriction on the Importation of Infringing Goods

The proprietor of a registered trade mark or his licensee may serve on the Director-General of Customs a written notice stating that he objects to the impending importation of certain goods which infringe the registered trade mark. The person would have to provide sufficient information to enable the Director-General of Customs to identify the alleged infringing goods and to ascertain the time and place where the alleged infringing goods are expected to be imported. The person would also have to satisfy the Director-General of Customs that the goods are infringing

goods. The notice is to be accompanied by a statutory declaration that the particulars in the notice are correct; the fee of S\$200 as specified in the Trade Marks (Border Enforcement Measures) Rules; a copy of the certificate of registration of the mark, and evidence that the registered trade mark was duly renewed at all times (e.g. the certificate of renewal).

The notice is to be served during the business hours of the office of the Customs and Excise Department and at such time as is reasonably possible for an authorized officer to take any action under the Trade Marks Act in relation to the notice. The notice shall remain in force for 60 days commencing on the day on which the notice was given, unless revoked before the end of that period by notice in writing given to the Director General pursuant to Section 82(3) of the Trade Marks Act. If there are any changes to the particulars specified in the notice or affecting the notice, the proprietor or licensee is to notify the Director General of the change in writing.

Upon receipt of such a notice, if the notice has not lapsed or been revoked, and a person imports goods, not being goods in transit, which bear a sign that, or whose packaging bears a sign that, in the opinion of an authorised officer, is identical with or similar to the registered trade mark in question, an authorised officer may seize the goods. An authorised officer may refuse to seize goods unless (a) the objector has deposited with the Director-General a sum of money which (in the opinion of the Director General) is sufficient to (i) reimburse the Government for any liability or expense it is likely to incur as a result of the seizure of the goods; and (ii) pay such compensation as may be ordered by the Court if the objector fails to institute an infringement action or if the infringement action fails or is discontinued or dismissed; or (b) the objector has given security for the reimbursement of the Government for any such liability or expense and the payment of such compensation.

The Director General shall inform the objector and the importer of the seizure as soon as is practicable by written notice. Unless an infringement action in respect of the goods is instituted within 10 working days from the date specified in the notice, and the objector gives written notice to the Director General stating that the infringement action has been instituted, the goods shall be released to the importer. The objector may request for a further extension of ten working days to institute the infringement action.

If an infringement action has been instituted in relation to the seized goods, but at the end of 3 weeks from the day on which the action was instituted, there is no court order in force preventing the release of the goods, the Director General shall release the goods to the importer.

Detention and Examination of Counterfeit Goods

An authorized officer may detain any goods (i) that are imported into, or that are to be exported from, Singapore; and (ii) that are not goods in transit, unless the goods are consigned to any person with a commercial or physical presence in Singapore; or (b) examine any goods, including goods in transit, which he reasonably suspects are counterfeit goods in relation to a registered trade mark.

Upon detention, the Director-General shall give a written notice to the importer, exporter or consignee (as the case may be) of the detained goods and to the proprietor of the registered trade mark. The detained goods shall be released to the importer, exporter or consignee, as the case may be, unless, within the prescribed period (see below), the proprietor of the registered trade mark —

(a) in the case of goods that are imported into Singapore and that are not goods in transit

- (i) gives the Director-General a written notice referred to in section 82 (1) of the Trade Marks Act;
- (ii) submits the documents and information, and pays the fee, referred to in section 82 (2) of the Trade Marks Act to the Director-General; and
- (iii) deposits with the Director-General the sum of money referred to in section 83 (a) or gives the security referred to in section 83 (b) of the Trade Marks Act; or

(b) in the case of goods that are to be exported from Singapore or goods in transit that are consigned to a person with a commercial or physical presence in Singapore —

- (i) institutes an action for the infringement of his trade mark;
- (ii) serves on the Director-General an order of the Court authorising the further detention of the goods; and
- (iii) deposits with the Director-General a sum of money that, in the opinion of the Director-General, is sufficient to —
 - (A) reimburse the Government for any liability or expense it has incurred and is likely to further incur as a result of the detention of the goods; and
 - (B) pay such compensation to any person who suffers loss or damage as a result of the detention of the goods as may be ordered by the Court; or gives security, to the satisfaction of the Director-General, for the reimbursement of the Government for any such liability or expense and the payment of such compensation.

The prescribed period is

- (a) 48 hours after the Director General has given the proprietor of the registered trade mark the written notice; or
- (b) where the detained goods are goods that are to be exported from Singapore or goods in transit that are consigned to a person with a commercial or physical presence in Singapore; and the proprietor of the registered trade mark has deposited with the Director General the sum of money or the security required under Section 93A(3)(b)(iii) within 48 hours, 10 working days after the Director General has given the proprietor of the registered trade mark the written notice.

4.2. Registration Authority

Director-General of Customs, Singapore Customs.

4.3. Relevant Courts

Relevant courts for civil infringement suits relating to border infringement cases are the High Court and the Court of Appeal.

4.4. Remedies

In addition to any civil remedies (see 2.2 above), a court may order goods seized under the Copyright Act and the Trade Marks Act to be forfeited to the Government.

5. Administrative IPR Enforcement

5.1. Role of Patent Office (If any)

The Intellectual Property Office of Singapore (IPOS) is active in policymaking and in the drafting of legislation relating to the enforcement of intellectual property rights.

Enforcement roles are carried out by the Director General of Singapore Customs and by the Intellectual Property Rights Branch of the Criminal Investigation Department of the Singapore Police Force.

5.2. Relevant Courts

There are no administrative courts which carry out enforcement roles.

6. Comments (for instance, are there any changes in IPR enforcement planned for the future, etc.)

In Singapore, other laws not related to copyright operate to deter parties from using equipment for the legitimate manufacture of optical discs for the purposes of piracy.

The manufacture of optical discs, i.e. CDs, VCDs, CD-ROMs, DVD-ROMs, and importation of replication and mastering equipment for optical discs are regulated by the Manufacture of Optical Discs Act and the Regulation of Imports and Exports Act respectively.

Manufacture of Optical Discs Act

Under section 4 of the Manufacture of Optical Discs Act, no party shall engage in the manufacture for sale or other commercial purpose of any CDs, VCDs, CD-ROMs, DVD-ROMs in any place except under the authority, and in accordance with the terms and conditions of a licence.

The manufacture of optical discs without a licence is an offence. Under Section 22 of the Manufacture of Optical Discs Act, upon conviction, the following penalties will apply:

- a body corporate will be liable to pay a fine not exceeding S\$200,000; and, in the case of a second or subsequent offence, to a fine not exceeding S\$400,000; and

- in any other case, a fine not exceeding S\$100,000 or to imprisonment for a term not exceeding 12 months or to both and, in the case of a second or subsequent offence, a fine not exceeding S\$200,000 or to imprisonment for a term not exceeding 2 years or to both.

Any party may apply to the Registrar of Optical Discs to obtain a licence to manufacture optical discs. Under Section 7 of the Manufacture of Optical Discs Act, the Registrar may grant a licence containing such terms and conditions as he thinks fit to the party and assign a manufacturer's code.

Importation of Manufacturing Equipment

In addition, under Regulation 3 of the Regulation of Imports and Exports Regulations, any party who wishes to import replication and mastering equipment for manufacture of optical discs must obtain a permit from the Director-General of Customs to do so. Any party who imports without a permit shall be guilty of an offence.

The penalties for a first conviction are a fine not exceeding S\$100,000 or 3 times the value of the goods in respect of which the offence was committed, whichever is the greater, or to imprisonment for a term not exceeding 2 years or to both.

For a second or subsequent conviction, the penalties are a fine not exceeding S\$200,000 or 4 times the value of the goods in respect of which the offence was committed, whichever is the greater, or to imprisonment for a term not exceeding 3 years or to both.

To deter false declarations of trade descriptions of goods by persons who wish to avoid obtaining a licence to import replication and mastering equipment for optical discs, Section 28A of the Regulation of Imports and Exports Act provides that any person who imports, exports or transships any goods and (a) applies or causes to be applied to such goods an incorrect trade description; or (b) has in his possession for sale or for any purpose of trade any such goods to which an incorrect trade description has been applied, shall be guilty of an offence.

The penalties for a first conviction are a fine not exceeding S\$100,000/- or up to 3 times value of goods, whichever is greater and/or imprisonment for up to 2 years. For a second conviction, the fine payable shall not exceed S\$200,000/- or up to 4 times value of goods, whichever is greater and/or imprisonment for up to 3 years.

