

REGULATIONS UNDER THE SINGAPORE TREATY
ON THE LAW OF TRADEMARKS

REGULATIONS UNDER THE SINGAPORE TREATY
ON THE LAW OF TRADEMARKS

List of Rules

- Rule 1: Abbreviated Expressions
Rule 2: Manner of Indicating Names and Addresses
Rule 3: Details Concerning the Application
Rule 4: Details Concerning Representation and Address for Service
Rule 5: Details Concerning the Filing Date
Rule 6: Details Concerning Communications
Rule 7: Manner of Identification of an Application Without Its Application
Number
Rule 8: Details Concerning Duration and Renewal
Rule 9: Relief Measures in Case of Failure to Comply with
Time Limits
Rule 10: Requirements Concerning the Request for Recordal of a License or
for Amendment or Cancellation of the Recordal of a License

Rule 1
Abbreviated Expressions

(1) [*Abbreviated Expressions Defined in the Regulations*] For the purposes of these Regulations, unless expressly stated otherwise:

- (i) “Treaty” means the Singapore Treaty on the Law of Trademarks;
- (ii) “Article” refers to the specified Article of the Treaty;
- (iii) “exclusive license” means a license which is only granted to one licensee and which excludes the holder from using the mark and from granting licenses to any other person;
- (iv) “sole license” means a license which is only granted to one licensee and which excludes the holder from granting licenses to any other person but does not exclude the holder from using the mark;
- (v) “non-exclusive license” means a license which does not exclude the holder from using the mark or from granting licenses to any other person.

(2) [*Abbreviated Expressions Defined in the Treaty*] The abbreviated expressions defined in Article 1 for the purposes of the Treaty shall have the same meaning for the purposes of these Regulations.

Rule 2
Manner of Indicating Names and Addresses

(1) [*Names*]

- (a) Where the name of a person is to be indicated, any Contracting Party may require,
 - (i) where the person is a natural person, that the name to be indicated be the family or principal name and the given or secondary name or names of that person or that the name to be indicated be, at that person’s option, the name or names customarily used by the said person;
 - (ii) where the person is a legal entity, that the name to be indicated be the full official designation of the legal entity.

(b) Where the name of a representative which is a firm or partnership is to be indicated, any Contracting Party shall accept as indication of the name the indication that the firm or partnership customarily uses.

(2) [*Addresses*]

(a) Where the address of a person is to be indicated, any Contracting Party may require that the address be indicated in such a way as to satisfy the customary requirements for prompt postal delivery at the indicated address and, in any case, consist of all the relevant administrative units up to, and including, the house or building number, if any.

(b) Where a communication to the Office of a Contracting Party is in the name of two or more persons with different addresses, that Contracting Party may require that such communication indicate a single address as the address for correspondence.

(c) The indication of an address may contain a telephone number, a telefacsimile number and an e-mail address and, for the purposes of correspondence, an address different from the address indicated under subparagraph (a).

(d) Subparagraphs (a) and (c) shall apply, *mutatis mutandis*, to addresses for service.

(3) [*Other Means of Identification*] Any Contracting Party may require that a communication to the Office indicate the number or other means of identification, if any, with which the applicant, holder, representative or interested person is registered with its Office. No Contracting Party may refuse a communication on grounds of failure to comply with any such requirement, except for applications filed in electronic form.

(4) [*Script to Be Used*] Any Contracting Party may require that any indication referred to in paragraphs (1) to (3) be in the script used by the Office.

Rule 3

Details Concerning the Application

(1) [*Standard Characters*] Where the Office of a Contracting Party uses characters (letters and numbers) that it considers as being standard, and where the application contains a statement to the effect that the applicant wishes that the mark be registered and published in the standard characters used by the Office, the Office shall register and publish that mark in such standard characters.

(2) [*Mark Claiming Color*] Where the application contains a statement to the effect that the applicant wishes to claim color as a distinctive feature of the mark, the Office may require that the application indicate the name or code of the color or colors claimed and an indication, in respect of each color, of the principal parts of the mark which are in that color.

(3) [*Number of Reproductions*]

(a) Where the application does not contain a statement to the effect that the applicant wishes to claim color as a distinctive feature of the mark, a Contracting Party may not require more than

(i) five reproductions of the mark in black and white where the application may not, under the law of that Contracting Party, or does not contain a statement to the effect that the applicant wishes the mark to be registered and published in the standard characters used by the Office of the said Contracting Party;

(ii) one reproduction of the mark in black and white where the application contains a statement to the effect that the applicant wishes the mark to be registered and published in the standard characters used by the Office of that Contracting Party.

(b) Where the application contains a statement to the effect that the applicant wishes to claim color as a distinctive feature of the mark, a Contracting Party may not require more than five reproductions of the mark in black and white and five reproductions of the mark in color.

(4) [*Three-Dimensional Mark*]

(a) Where the application contains a statement to the effect that the mark is a three-dimensional mark, the reproduction of the mark shall consist of a two-dimensional graphic or photographic reproduction.

(b) The reproduction furnished under subparagraph (a) may, at the option of the applicant, consist of one single view of the mark or of several different views of the mark.

(c) Where the Office considers that the reproduction of the mark furnished by the applicant under subparagraph (a) does not sufficiently show the particulars of the three-dimensional mark, it may invite the applicant to furnish, within a reasonable time limit fixed in the invitation, up to six different views of the mark and/or a description by words of that mark.

(d) Where the Office considers that the different views and/or the description of the mark referred to in subparagraph (c) still do not sufficiently show the particulars of the three-dimensional mark, it may invite the applicant to furnish, within a reasonable time limit fixed in the invitation, a specimen of the mark.

(e) Notwithstanding subparagraphs (a) to (d), a sufficiently clear reproduction showing the three-dimensional character of the mark in one view shall be sufficient for the granting of a filing date.

(f) Paragraph (3)(a)(i) and (b) shall apply *mutatis mutandis*.

(5) [*Hologram Mark*] Where the application contains a statement to the effect that the mark is a hologram mark, the representation of the mark shall consist of one or several views of the mark capturing the holographic effect in its entirety. Where the Office considers that the view or views submitted do not capture the holographic effect in its entirety, it may require the furnishing of additional views. The Office may also require the applicant to furnish a description of the hologram mark.

(6) [*Motion Mark*] Where the application contains a statement to the effect that the mark is a motion mark, the representation of the mark shall, at the option of the Office, consist of one image or a series of still or moving images depicting movement. Where the Office considers that the image or images submitted do not depict movement, it may require the furnishing of additional images. The Office may also require that the applicant furnish a description explaining the movement.

(7) [*Color Mark*] Where the application contains a statement to the effect that the mark is a color per se mark or a combination of colors without delineated contours, the reproduction of the mark shall consist of a sample of the color or colors. The Office may require a designation of the color or colors by using their common names. The Office may also require a description on how the color is or the colors are applied to the goods or used in relation to the services. The Office may further require an indication of the color or colors by a recognized color code chosen by the applicant and accepted by the Office.

(8) [*Position Mark*] Where the application contains a statement to the effect that the mark is a position mark, the reproduction of the mark shall consist of a single view of the mark showing its position on the product. The Office may require that matter for which protection is not claimed shall be indicated. The Office may also require a description explaining the position of the mark in relation to the product.

(9) [*Sound Mark*] Where the application contains a statement to the effect that the mark is a sound mark, the representation of the mark shall, at the option of the Office, consist of a musical notation on a staff, or a description of the sound constituting the mark, or an analog or digital recording of that sound, or any combination thereof.

(10) [*Mark Consisting of a Non-Visible Sign Other Than a Sound Mark*] Where the application contains a statement to the effect that the mark consists of a non-visible sign, other than a sound mark, a Contracting Party may require one or more representations of the mark, an indication of the type of mark and details concerning the mark, as prescribed by the law of that Contracting Party.

(11) [*Transliteration of the Mark*] For the purposes of Article 3(1)(a)(xiii), where the mark consists of or contains matter in script other than the script used by the Office or numbers expressed in numerals other than numerals used by the Office, a transliteration of such matter in the script and numerals used by the Office may be required.

(12) [*Translation of the Mark*] For the purposes of Article 3(1)(a)(xiv), where the mark consists of or contains a word or words in a language other than the language, or one of the languages, admitted by the Office, a translation of that word or those words into that language or one of those languages may be required.

(13) [*Time Limit for Furnishing Evidence of Actual Use of the Mark*] The time limit referred to in Article 3(3) shall not be shorter than six months counted from the date of allowance of the application by the Office of the Contracting Party where that application was filed. The applicant or holder shall have the right to an extension of that time limit, subject to the conditions provided for by the law of that Contracting Party, by periods of at least six months each, up to a total extension of at least two years and a half.

Rule 4

Details Concerning Representation and Address for Service

(1) [*Address Where a Representative Is Appointed*] Where a representative is appointed, a Contracting Party shall consider the address of that representative to be the address for service.

(2) [*Address Where No Representative Is Appointed*] Where no representative is appointed and an applicant, holder or other interested person has provided as its address an address on the territory of the Contracting Party, that Contracting Party shall consider that address to be the address for service.

(3) [*Time Limit*] The time limit referred to in Article 4(3)(d) shall be counted from the date of receipt of the communication referred to in that Article by the Office of the Contracting Party concerned and shall not be less than one month where the address of the

person on whose behalf the communication is made is on the territory of that Contracting Party and not less than two months where such an address is outside the territory of that Contracting Party.

Rule 5
Details Concerning the Filing Date

(1) [*Procedure in Case of Non-Compliance with Requirements*] If the application does not, at the time of its receipt by the Office, comply with any of the applicable requirements of Article 5(1)(a) or (2)(a), the Office shall promptly invite the applicant to comply with such requirements within a time limit indicated in the invitation, which time limit shall be at least one month from the date of the invitation where the applicant's address is on the territory of the Contracting Party concerned and at least two months where the applicant's address is outside the territory of the Contracting Party concerned. Compliance with the invitation may be subject to the payment of a special fee. Even if the Office fails to send the said invitation, the said requirements remain unaffected.

(2) [*Filing Date in Case of Correction*] If, within the time limit indicated in the invitation, the applicant complies with the invitation referred to in paragraph (1) and pays any required special fee, the filing date shall be the date on which all the required indications and elements referred to in Article 5(1)(a) have been received by the Office and, where applicable, the required fees referred to in Article 5(2)(a) have been paid to the Office. Otherwise, the application shall be treated as if it had not been filed.

Rule 6
Details Concerning Communications

(1) [*Indications Accompanying Signature of Communications on Paper*] Any Contracting Party may require that the signature of the natural person who signs be accompanied by

(i) an indication in letters of the family or principal name and the given or secondary name or names of that person or, at the option of that person, of the name or names customarily used by the said person;

(ii) an indication of the capacity in which that person signed, where such capacity is not obvious from reading the communication.

(2) [*Date of Signing*] Any Contracting Party may require that a signature be accompanied by an indication of the date on which the signing was effected. Where that indication is required but is not supplied, the date on which the signing is deemed to have been effected shall be the date on which the communication bearing the signature was received by the Office or, if the Contracting Party so allows, a date earlier than the latter date.

(3) [*Signature of Communications on Paper*] Where a communication to the Office of a Contracting Party is on paper and a signature is required, that Contracting Party

(i) shall, subject to item (iii), accept a handwritten signature;

(ii) may permit, instead of a handwritten signature, the use of other forms of signature, such as a printed or stamped signature, or the use of a seal or of a bar-coded label;

(iii) may, where the natural person who signs the communication is a national of the Contracting Party and such person's address is on its territory, or where the legal entity on behalf of which the communication is signed is organized under its law and has either a domicile or a real and effective industrial or commercial establishment on its territory, require that a seal be used instead of a handwritten signature.

(4) [*Signature of Communications on Paper Filed by Electronic Means of Transmittal*] A Contracting Party that provides for communications on paper to be filed by electronic means of transmittal shall consider any such communication signed if a graphic representation of a signature accepted by that Contracting Party under paragraph (3) appears on the communication as received.

(5) [*Original of a Communication on Paper Filed by Electronic Means of Transmittal*] A Contracting Party that provides for communications on paper to be filed by electronic means of transmittal may require that the original of any such communication be filed

(i) with the Office accompanied by a letter identifying that earlier transmission and

(ii) within a time limit which shall be at least one month from the date on which the Office received the communication by electronic means of transmittal.

(6) [*Authentication of Communications in Electronic Form*] A Contracting Party that permits the filing of communications in electronic form may require that any such communication be authenticated through a system of electronic authentication as prescribed by that Contracting Party.

(7) [*Date of Receipt*] Each Contracting Party shall be free to determine the circumstances in which the receipt of a document or the payment of a fee shall be deemed to constitute receipt by or payment to the Office in cases in which the document was actually received by or payment was actually made to

(i) a branch or sub-office of the Office,

(ii) a national Office on behalf of the Office of the Contracting Party, where the Contracting Party is an intergovernmental organization referred to in Article 26(1)(ii),

(iii) an official postal service,

(iv) a delivery service, or an agency, specified by the Contracting Party,

(v) an address other than the nominated addresses of the Office.

(8) [*Electronic Filing*] Subject to paragraph (7), where a Contracting Party provides for the filing of a communication in electronic form or by electronic means of transmittal and the communication is so filed, the date on which the Office of that Contracting Party receives the communication in such form or by such means shall constitute the date of receipt of the communication.

Rule 7

Manner of Identification of an Application Without Its Application Number

(1) [*Manner of Identification*] Where it is required that an application be identified by its application number but where such a number has not yet been issued or is not known to the applicant or its representative, that application shall be considered identified if the following is supplied:

- (i) the provisional application number, if any, given by the Office, or
- (ii) a copy of the application, or
- (iii) a representation of the mark, accompanied by an indication of the date on which, to the best knowledge of the applicant or the representative, the application was received by the Office and an identification number given to the application by the applicant or the representative.

(2) [*Prohibition of Other Requirements*] No Contracting Party may demand that requirements other than those referred to in paragraph (1) be complied with in order for an application to be identified where its application number has not yet been issued or is not known to the applicant or its representative.

Rule 8

Details Concerning Duration and Renewal

For the purposes of Article 13(1)(c), the period during which the request for renewal may be presented and the renewal fee may be paid shall start at least six months before the date on which the renewal is due and shall end at the earliest six months after that date. If the request for renewal is presented and/or the renewal fees are paid after the date on which the renewal is due, any Contracting Party may subject the acceptance of the request for renewal to the payment of a surcharge.

Rule 9

Relief Measures in Case of Failure to Comply with Time Limits

(1) [*Requirements Concerning Extension of Time Limits Under Article 14(2)(i)*] A Contracting Party that provides for the extension of a time limit under Article 14(2)(i) shall extend the time limit for a reasonable period of time from the date of filing the request for extension and may require that the request

(i) contain an identification of the requesting party, the relevant application or registration number and the time limit concerned, and

(ii) be filed within a time limit which shall not be less than two months from the date of expiry of the time limit concerned.

(2) [*Requirements Concerning Continued Processing Under Article 14(2)(ii)*] A Contracting Party may require that the request for continued processing under Article 14(2)(ii)

(i) contain an identification of the requesting party, the relevant application or registration number and the time limit concerned, and

(ii) be filed within a time limit which shall not be less than two months from the date of expiry of the time limit concerned. The omitted act shall be completed within the same period or, where the Contracting Party so provides, together with the request.

(3) [*Requirements Concerning Reinstatement of Rights Under Article 14(2)(iii)*]

(a) A Contracting Party may require that the request for reinstatement of rights under Article 14(2)(iii)

(i) contain an identification of the requesting party, the relevant application or registration number and the time limit concerned, and

(ii) set out the facts and evidence in support of the reasons for the failure to comply with the time limit concerned.

(b) The request for reinstatement of rights shall be filed with the Office within a reasonable time limit, the duration of which shall be determined by the Contracting Party from the date of the removal of the cause of failure to comply with the time limit concerned. The omitted act shall be completed within the same period or, where the Contracting Party so provides, together with the request.

(c) A Contracting Party may provide for a maximum time limit for complying with the requirements under subparagraphs (a) and (b) of not less than six months from the date of expiry of the time limit concerned.

(4) [*Exceptions Under Article 14(3)*] The exceptions referred to in Article 14(3) are the cases of failure to comply with a time limit

(i) for which a relief measure has already been granted under Article 14(2),

(ii) for filing a request for a relief measure under Article 14,

(iii) for payment of a renewal fee,

(iv) for an action before a board of appeal or other review body constituted in the framework of the Office,

(v) for an action in *inter partes* proceedings,

(vi) for filing the declaration referred to in Article 3(1)(a)(vii) or the declaration referred to in Article 3(1)(a)(viii),

(vii) for filing a declaration which, under the law of the Contracting Party, may establish a new filing date for a pending application, and

(viii) for the correction or addition of a priority claim.

Rule 10

*Requirements Concerning the Request for Recordal of a License or for
Amendment or Cancellation of the Recordal of a License*

(1) [*Content of Request*]

(a) A Contracting Party may require that the request for recordal of a license under Article 17(1) contain some or all of the following indications or elements:

(i) the name and address of the holder;

(ii) where the holder has a representative, the name and address of that representative;

(iii) where the holder has an address for service, such address;

(iv) the name and address of the licensee;

(v) where the licensee has a representative, the name and address of that representative;

(vi) where the licensee has an address for service, such address;

(vii) the name of a State of which the licensee is a national if he/she is a national of any State, the name of a State in which the licensee has his/her domicile, if any, and the name of a State in which the licensee has a real and effective industrial or commercial establishment, if any;

(viii) where the holder or the licensee is a legal entity, the legal nature of that legal entity and the State, and, where applicable, the territorial unit within that State, under the law of which the said legal entity has been organized;

(ix) the registration number of the mark which is the subject of the license;

(x) the names of the goods and/or services for which the license is granted, grouped according to the classes of the Nice Classification, each group preceded by the number of the class of that Classification to which that group of goods or services belongs and presented in the order of the classes of the said Classification;

(xi) whether the license is an exclusive license, a non-exclusive license or a sole license;

(xii) where applicable, that the license concerns only a part of the territory covered by the registration, together with an explicit indication of that part of the territory;

(xiii) the duration of the license.

(b) A Contracting Party may require that the request for amendment or cancellation of the recordal of a license under Article 18(1) contain some or all of the following indications or elements:

(i) the indications specified in items (i) to (ix) of subparagraph (a);

(ii) where the amendment or cancellation concerns any of the indications or elements specified under subparagraph (a), the nature and scope of the amendment or cancellation to be recorded.

(2) [*Supporting Documents for Recordal of a License*]

(a) A Contracting Party may require that the request for recordal of a license be accompanied, at the option of the requesting party, by one of the following:

(i) an extract of the license contract indicating the parties and the rights being licensed, certified by a notary public or any other competent public authority as being a true extract of the contract; or

(ii) an uncertified statement of license, the content of which corresponds to the statement of license Form provided for in the Regulations, and signed by both the holder and the licensee.

(b) Any Contracting Party may require that any co-holder who is not a party to the license contract give its express consent to the license in a document signed by it.

(3) [*Supporting Documents for Amendment of Recordal of a License*]

(a) A Contracting Party may require that the request for amendment of the recordal of a license be accompanied, at the option of the requesting party, by one of the following:

(i) documents substantiating the requested amendment of the recordal of the license; or

(ii) an uncertified statement of amendment of license, the content of which corresponds to the statement of amendment of license Form provided for in these Regulations, and signed by both the holder and the licensee.

(b) Any Contracting Party may require that any co-holder who is not a party to the license contract give its express consent to the amendment of the license in a document signed by it.

(4) [*Supporting Documents for Cancellation of Recordal of a License*] A Contracting Party may require that the request for cancellation of the recordal of a license be accompanied, at the option of the requesting party, by one of the following:

(i) documents substantiating the requested cancellation of the recordal of the license; or

(ii) an uncertified statement of cancellation of license, the content of which corresponds to the statement of cancellation of license Form provided for in these Regulations, and signed by both the holder and the licensee.