

New Legislation on Court Procedures for Intellectual Property Disputes

Background

To achieve Singapore's vision of becoming a global IP Hub in Asia, the Government believed it was important to improve access to the IP dispute resolution system so as to position Singapore as a choice venue for resolving disputes.

With this objective in mind, the Ministry of Law had appointed a committee in 2015 to perform a review of Singapore's IP Dispute Resolution Framework and conducted a public consultation exercise in 2018 to discuss proposed reforms aimed at enhancing access to our courts for IP disputes.

Following this, the new Supreme Court of Judicature (Intellectual Property) Rules 2022 ("**new Rules**") is expected to come into force on 1 April 2022. A draft of the new Rules is accessible here.

We now summarise and discuss some of the key features of the new legislation below.

Key features

One of the recommendations in the review was to set up a "fast track" system for parties to resolve disputes in an expeditious and more cost-effective manner, especially for individuals and SMEs. The optional "fast track" for IP litigation will be implemented once the new Rules come into force, under "Simplified Process for Certain Intellectual Property Claims". Some notable features include cap on costs, cap on recoverable damages, early active case management, cap on length of trial. These features cater to lower value disputes and/or when parties prefer their case to be resolved expeditiously.

Cap on value of claim

As stipulated in Section 4 of the draft new Rules, claims are suitable for the fast track when the monetary relief does not or is not likely to exceed \$500,000 or all parties agree to go through the fast track. Alternatively, the claimant may also elect to go under the fast track under Section 5. To determine if the case is suitable for the fast track, the court will have regard to the following matters in Section 4(c): whether a party can only afford to bring or defend a claim under the fast track, the complexity of the issues, whether the estimated length of trial is likely to exceed two days.

Stage costs

The fast track also includes stage costs in Section 9 of the new Rules, where the maximum amount of party-and-party costs and disbursements recoverable will be fixed and capped for each stage of the proceeding. This is subject to an overall cap of \$50,000. To encourage early settlement of disputes, the stage costs are front-loaded such that the proportion of costs recoverable at each stage decreases as the matter progresses. A schedule of the stage costs is provided in Section 9(9) of the new Rules.

Cap on length of trial

The fast-track option imposes a limit of 2 hearing days for the trial. As provided in Section 8(6), the court may make an order for the case to be removed from the fast track if it considers that it is not possible or practicable for the trial to be completed within 2 days.

Active management at case conference

Section 8 of the new Rules grants the court a discretion on key matters to ensure that the case can proceed expeditiously. The court will give directions at a single case conference on various matters, such as identifying and narrowing the main factual and legal issues in dispute, identifying the most similar prior art for patent disputes, evidence that may be given, number of affidavits and witnesses, timelines, date and duration of hearing, time for examination of each witness.

Streamlined procedural rules

The new rules consolidate the Rules of Court relating to IP rights into a single piece of legislation. Parts 3 to 6 of the new Rules cover the procedural rules under the different legislation, namely, Geographical Indications Act, Patents Act, Registered Designs Act and Trade Marks Act. The application of the Rules of Court is subject to the provisions in the new Rules, including the mode of commencement of an action and appeal process.

Further, the new rules harmonises related provisions across the different IP rights. An example is the obligation to notify the Registrar of the Intellectual Property Office of Singapore of certain IP proceedings in the Supreme Court. Sections 30, 48, 62, 74 of the new Rules impose notification obligations on the party commencing proceedings, defendant that withdraws its defence or counterclaim, and party that files a notice of appeal.

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This article is intended to provide general information only and should not be relied upon as an exhaustive or comprehensive statement of law. Should you have any specific questions, please speak with one of our above contacts, or your usual contact at Amica Law LLC.

We wish to express our thanks to Clara Nah, our practice trainee, for her contributions to this article.