

RECENT CHANGES TO IP PROCEDURE

New Supreme Court Practice Directions Relating to Simplified Process for Certain Intellectual Property Claims

The Supreme Court has published Amendment No. 1 of 2022 of the Supreme Court Practice Directions 2021 (the “**Practice Directions**”). These amendments introduce a new Part 23 and Appendix I relating to the new Simplified Process for certain Intellectual Property Claims under Part 2 of the Supreme Court of Judicature (Intellectual Property) Rules 2022 (“**SCJIPR**”) (the “**Simplified Process**”). The new practice directions are accessible [here](#).

Part 23 provides directions on all proceedings under the Simplified Process. Claimants and defendants who wish to bring their action under the Simplified Process may refer to section 170 for specific procedural directions. Additionally, the section provides directions for defendants responding to claimants who elect to go under the Simplified Process.

These amendments took effect on 1 April 2022 and its key features are summarised below.

Election by Claimant to go under the Simplified Process

The Simplified Process caters to lower value disputes and/or when parties prefer their case to be resolved expeditiously. A claimant who wishes to bring an action under the Simplified Process should refer to section 170(1) of the Practice Directions for next steps.

In compliance with rule 5(1) of the SCJIPR, the claimant must file and serve the following: (1) the form to elect for Part 2 of the SCJIPR to apply, and (2) the form to abandon any claim for monetary relief in excess of \$500,000.

This illustrates that cases with a cap on the value of claim are suitable for the Simplified Process.

Directions for defendant making a counterclaim

A defendant making a counterclaim may respond to a claimant who has elected to bring an action under the Simplified Process by following the directions in section 170(2) of the Practice Directions.

If the defendant agrees to proceeding under the Simplified Process, the defendant has two options. Within 2 working days after filing the defence and counterclaim, the defendant may do either of the following:

- File and serve the form to abandon any claim for monetary relief in excess of \$500,000
- Inform the Court by letter that the defendant agrees to the application of this Part without abandoning any claim for monetary relief in excess of \$500,000

Therefore, it is not necessary for the defendant to abandon any claim for monetary relief in excess of \$500,000.

Having regard to the matters in section 4 of the SCJIPR, the Court will then give directions to determine whether the Simplified Process should continue applying to the case. Under section 4, an originating claim is only suitable for the Simplified Process if:

- The dispute involves an intellectual property right
- The monetary relief claimed by each party does not or is not likely to exceed \$500,000 or all parties agree to the application of the Simplified Process
- The case is otherwise suitable for the Simplified Process, having regard to the following factors
 - Whether a party can only afford to bring or defend a claim under the Simplified Process
 - Complexity of the issues
 - Whether the estimated length of trial is likely to exceed 2 days
 - Any other relevant matters

These considerations ought to guide claimants and defendants in determining whether its case is suitable for the Simplified Process.

If the defendant does not wish to proceed under the Simplified Process, section 170(2)(b) provides that the defendant must inform the Court by letter that the defendant does not intend to file the form to abandon any claim for monetary relief in excess of \$500,000 and the defendant does not agree going under the Simplified Process.

Directions for defendant who does not make a counterclaim

If the defendant does not make a counterclaim and does not agree to proceeding under the Simplified Process, section 170(5) is relevant. Within 2 working days after the defence is filed, the defendant must make an application under rule 5(4) of the SCJIPR for the Simplified Process not to apply.

Application by Defendant for order for Simplified Process to apply

Claims are suitable for the Simplified Process when the monetary relief does not or is not likely to exceed \$500,000 or all parties agree to go through the Simplified Process. This is illustrated in section 170(7) of the Practice Directions which gives directions for a defendant who wishes to apply to go under the Simplified Process.

If the defendant is making a counterclaim, the defendant must do either of the following as soon as practicable before making the application:

- Comply with rule 6(3)(a) of the SCJIPR by filing and serving the form to abandon any claim for monetary relief in excess of \$500,000; or
- Inform the Court by letter that rule 6(3)(c) of the SCJIPR applies, in that all parties agree to the application of Part 2 of the SCJIPR.

Amendments to legislation

The remaining amendments to the Copyright Act 2021, Intellectual Property (Dispute Resolution) Act 2019 and Patents (Amendment Rules) 2022 came into effect on 1 April 2022. Of note are the jurisdictional changes to certain intellectual property disputes effected by these amendments. This should provide claimants with a better idea of the appropriate forum for bringing a claim for infringement of intellectual property rights.

The amendments are summarised below.

Copyright Act 2021

Section 501 clarifies the jurisdiction of the Courts with respect to the Copyright Act.

It states that the District Court and Magistrate's Court have jurisdiction to try any offence under the Copyright Act 1987 and 2021 and have the power to impose the full punishment for any offence. However, subject to section 501(1), the General Division of the High Court is the court that has jurisdiction on such matters.

Intellectual Property (Dispute Resolution) Act 2019

Amendments to the Patents Act

The Intellectual Property Dispute Resolution Act 2019 includes several provisions amending the Patents Act. These amendments effectively clarify the jurisdiction of the Registrar and Court when it comes to patent proceedings.

Amendments are made to several provisions of the Patents Act relating to infringement of patents. These amendments reflect that patent are primarily enforced in the Singapore Courts and not the Intellectual Property Office of Singapore. This change is also reflected in the implementing subsidiary legislation, the Patents (Amendment) Rules 2022, which also came into operation on 1 April 2022.

Section 80 of the Patents Act relating to the power to revoke patents has been amended to cloak the Court with jurisdiction to revoke patents.

The amendment to section 82 of the Patents Act clarifies that both the Court and the Registrar have jurisdiction to hear proceedings for the revocation of a patent.

Amendments to the State Courts Act

Section 31 and 32 reflect amendments to the State Courts Act 1970. The amendments make it clear that the District Court and Magistrate's Court do not have the jurisdiction to hear and try an action in passing off.

For queries or more information, please contact:



Jason Chan
Director
Litigation & Enforcement
jason.chan@amicalaw.com
(65) 6303 6215



Melvin Pang
Director
Litigation & Enforcement
melvin.pang@amicalaw.com
(65) 6303 6220

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 case note.