

**Draft Intellectual Property (Dispute
Resolution) Bill**

2019

An Act to amend the Arbitration Act (Chapter 10 of the 2002 Revised Edition) and International Arbitration Act (Chapter 143A of the 2002 Revised Edition) to clarify that intellectual property disputes may be arbitrated, and to amend the Copyright Act (Chapter 63 of the 2006 Revised Edition), Geographical Indications Act 2014 (Act 19 of 2014), Patents Act (Chapter 221 of the 2005 Revised Edition), Plant Varieties Protection Act (Chapter 232A of the 2006 Revised Edition), Registered Designs Act (Chapter 266 of the 2005 Revised Edition), State Courts Act (Chapter 321 of the 2007 Revised Edition) and Trade Marks Act (Chapter 332 of the 2005 Revised Edition), to make amendments relating to intellectual property dispute resolution and certain other related amendments.

Please note that the proposed amendments in this draft are still undergoing the legislative drafting and vetting process, and are thus not finalised and subject to change.

PART 1

AMENDMENTS TO ARBITRATION ACT

New Part IXA

1. The Arbitration Act (Cap. 10) is amended by inserting, immediately after section 52, the following Part:

“PART IXA

ARBITRATIONS RELATING TO INTELLECTUAL PROPERTY RIGHTS

Interpretation of Part IXA

52A.—(1) In this Part, unless the context otherwise requires, “intellectual property right” or “IPR” means —

- (a) a patent;
- (b) a trade mark;
- (c) a geographical indication;
- (d) a registered design;
- (e) a copyright;
- (f) a right in a protected layout-design of an integrated circuit;
- (g) a plant variety right;
- (h) a right in confidential information, trade secret or know-how;
- (i) a right to protect goodwill by way of passing off or similar action against unfair competition; or
- (j) any other intellectual property right of whatever nature.

(2) In this Part, a reference to an IPR is a reference to such an IPR whether or not the IPR is protectable by registration.

(3) In this Part, a reference to an IPR includes an application for the registration of an IPR if the IPR is protectable by registration.

(4) In this Part, “IPR dispute” includes —

- (a) a dispute over the enforceability, infringement, subsistence, validity, ownership, scope, duration or any other aspect of an IPR;
- (b) a dispute over a transaction in respect of an IPR; and
- (c) a dispute over any compensation payable for an IPR.

(5) In this section, “registration”, in relation to an IPR, includes the grant of the IPR.

IPR disputes may be arbitrated

52B.—(1) An IPR dispute is capable of settlement by arbitration as between the parties to the IPR dispute.

(2) Subsection (1) applies whether the IPR dispute is the main issue or an incidental issue in the arbitration.

(3) For the purposes of subsection (1), an IPR dispute is not incapable of settlement by arbitration only because a law of Singapore or elsewhere —

- (a) gives jurisdiction to decide the IPR dispute to a specified entity; and
- (b) does not mention possible settlement of the IPR dispute by arbitration.

(4) In subsection (3), “specified entity” means any of the following entities under the law of Singapore or elsewhere:

- (a) a court;
- (b) a tribunal;
- (c) a person holding an administrative or executive office;
- (d) any other entity.

Effect of award involving IPR

52C.—(1) This section applies if an award deciding an IPR dispute is made in arbitral proceedings.

(2) The fact that an entity is a third party licensee in respect of the IPR does not of itself make the entity a person claiming through or under a party to the arbitral proceedings for the purposes of section 44(1).

(3) However, subsection (2) does not affect any right or liability between a third party licensee and a party to the arbitral proceedings whether —

- (a) arising in contract; or
- (b) arising by operation of law.

(4) In this section, “third party licensee”, in relation to an IPR in dispute in arbitral proceedings, means an entity that —

- (a) is a licensee (whether or not an exclusive licensee) of the IPR under a licence granted by a party to the arbitral proceedings; but
- (b) is not a party to the arbitral proceedings.

Recourse against award involving IPR

52D.—(1) For the purposes of section 48(1)(b)(i), the subject-matter of a dispute is not incapable of settlement by arbitration under this Act only because the subject-matter relates to an IPR dispute.

(2) For the purposes of section 48(1)(b)(ii), an award is not contrary to public policy only because the subject-matter in respect of which the award is made relates to an IPR dispute.

Judgments entered in terms of award involving IPR

52E.—(1) This section applies if —

- (a) an award deciding an IPR dispute is made in arbitral proceedings; and

(b) a judgment in terms of the award is entered under section 46.

(2) Section 44(1) applies in relation to the judgment as if the reference in that section to an award made by an arbitral tribunal pursuant to an arbitration agreement were a reference to the judgment.

(3) In this section, “award” includes a declaratory award.

Validity of patent may be put in issue in arbitral proceedings

52F. Section 82(2) of the Patents Act (Cap. 221) does not prevent a party from putting the validity of a patent in issue in arbitral proceedings.”.

PART 2

AMENDMENTS TO COPYRIGHT ACT

Amendment of section 7

2. Section 7(1) of the Copyright Act (Cap. 63) is amended by inserting, immediately after the definition of “Copyright Tribunal”, the following definition:

“ “Court” means the High Court;”.

Miscellaneous amendments

3. The Copyright Act is amended —

(a) by inserting, immediately after the word “action” in section 119(1), the words “in the Court”;

(b) by deleting the word “court” wherever it appears in the following provisions and substituting in each case the word “Court”:

Sections 119(2), (2A), (4) and (5), 120(1) and (2), 120A(1), (2), (3), (6) and (7), 124, 126, 127 and 130(1A), (1B) and (2);

(c) by deleting the word “court” wherever it appears in the following provisions and substituting in each case the word “Court”:

Sections 140C(a), 140H(3)(b), 140I(2), (4) and (7), 140IA(1) and (2), 140K(1), 140L(1) and 140LA(3)(b)(ii) and (iii), (4) and (5);

(d) by deleting the words “A court” in section 140I(5) and substituting the words “The Court”;

(e) by deleting the word “High” wherever it appears in sections 169(1), (2), (3), (4), (5) and (6) and 175(2)(b) and (c);

(f) by deleting the word “High” in the section heading of section 169;

(g) by inserting, immediately after the word “action” in section 192(1), the words “in the Court”;

(h) by deleting the words “a court” in section 192(2) and substituting the words “the Court”;

(i) by deleting the words “the court” in section 192(2) and substituting the words “the Court”;

(j) by deleting the word “High” in the definition of “flagrantly infringing online location” in section 193A(1);

(k) by deleting the word “court” wherever it appears in the following provisions and substituting in each case the word “Court”:

Sections 193B(1), 193C(1), 193D(1) and (6), 193DB(1), (2) and (3) and 193DC;

(l) by deleting the word “court” in the section heading of section 193DB and substituting the word “Court”;

(m) by deleting the word “High” wherever it appears in sections 193DDA(1), (2) and (3), 193DDB(3) and 193DDC(1) and (2);

(n) by inserting, immediately after the words “bring an action” in section 200(1), the words “in the Court”;

- (o) by deleting the word “court” in section 200(1) and substituting the word “Court”;
- (p) by deleting the word “High” in the definition of “flagrantly infringing online location” in section 246(1);
- (q) by deleting the word “court” wherever it appears in the following provisions and by substituting in each case the word “Court”:
 - Sections 252A(1), 252B(1), 252C(1) and (6), 252CB(1), (2) and (3) and 252CC;
- (r) by deleting the word “court” in the section heading of section 252CB and substituting the word “Court”;
- (s) by deleting the word “High” wherever it appears in sections 252CDA(1), (2) and (3), 252CDB(3) and 252CDC(1) and (2);
- (t) by inserting, immediately after the word “action” in section 253(1), the words “in the Court”;
- (u) by deleting the word “court” wherever it appears in sections 253(2), (2A), (3), (3A), (4) and (5) and 254(1), (2), (3), (6) and (7) and substituting in each case the word “Court”;
- (v) by inserting, immediately after the word “brought” in section 260(2), (3) and (4), the words “in the Court” in each case;
- (w) by deleting the word “court” wherever it appears in section 261(1), (2), (4) and (5) and substituting in each case the word “Court”;
- (x) by deleting the word “court” in the section heading of section 261 and substituting the word “Court”;
- (y) by inserting, immediately after the word “brought” in section 261C(2), the words “in the Court”;
- (z) by deleting the word “court” wherever it appears in section 261F(1), (2) and (4) and by substituting in each case the word “Court”; and

(za) by deleting the word “court” in the section heading of section 261F and substituting the word “Court”.

PART 3

AMENDMENTS TO GEOGRAPHICAL INDICATIONS ACT 2014

Amendment of section 32

4. Section 32 of the Geographical Indications Act 2014 (Act 19 of 2014) is amended by inserting, immediately after subsection (2), the following subsection:

“(3) An appeal does not lie to the Court of Appeal from a decision of the Court on appeal from a decision of the Registrar for any matter under this Act or the rules made thereunder unless leave to appeal is given by the Court or the Court of Appeal.”.

Amendment of section 76

5. Section 76 of the Geographical Indications Act 2014 is amended —

- (a) by inserting, immediately before the words “the Court” wherever they appear in subsection (1), the words “the Registrar or”; and
- (b) by deleting subsection (2) and substituting the following subsection:

“(2) If the Registrar or the Court gives such a certificate and in subsequent proceedings before the Registrar or the Court —

- (a) the validity of the registration is again questioned; and
- (b) the registrant obtains a final order or judgment in the registrant’s favour relying on the validity of the registration as found in the earlier proceedings,

the registrant is entitled to be indemnified as to the registrant's costs as between solicitor and client in the subsequent proceedings unless the Registrar or the Court directs otherwise.”.

PART 4

AMENDMENTS TO INTERNATIONAL ARBITRATION ACT

New Part IIA

6. The International Arbitration Act (Cap. 143A) is amended by inserting, immediately after section 26, the following Part:

“PART IIA

ARBITRATIONS RELATING TO INTELLECTUAL PROPERTY RIGHTS

Interpretation of Part IIA

26A.—(1) In this Part, unless the context otherwise requires, “intellectual property right” or “IPR” means —

- (a) a patent;
- (b) a trade mark;
- (c) a geographical indication;
- (d) a registered design;
- (e) a copyright;
- (f) a right in a protected layout-design of an integrated circuit;
- (g) a plant variety right;
- (h) a right in confidential information, trade secret or know-how;
- (i) a right to protect goodwill by way of passing off or similar action against unfair competition; or
- (j) any other intellectual property right of whatever nature.

(2) In this Part, a reference to an IPR is a reference to such an IPR —

- (a) whether or not the IPR is protectable by registration; and
- (b) whether or not the IPR is registered, or subsists, in Singapore.

(3) In this Part, a reference to an IPR includes an application for the registration of an IPR if the IPR is protectable by registration.

(4) In this Part, “IPR dispute” includes —

- (a) a dispute over the enforceability, infringement, subsistence, validity, ownership, scope, duration or any other aspect of an IPR;
- (b) a dispute over a transaction in respect of an IPR; and
- (c) a dispute over any compensation payable for an IPR.

(5) In this section, “registration”, in relation to an IPR, includes the grant of the IPR.

IPR disputes may be arbitrated

26B.—(1) An IPR dispute is capable of settlement by arbitration as between the parties to the IPR dispute.

(2) Subsection (1) applies whether the IPR dispute is the main issue or an incidental issue in the arbitration.

(3) For the purposes of subsection (1), an IPR dispute is not incapable of settlement by arbitration only because a law of Singapore or elsewhere —

- (a) gives jurisdiction to decide the IPR dispute to a specified entity; and
- (b) does not mention possible settlement of the IPR dispute by arbitration.

(4) In subsection (3), “specified entity” means any of the following entities under the law of Singapore or elsewhere:

- (a) a court;
- (b) a tribunal;
- (c) a person holding an administrative or executive office;
- (d) any other entity.

[Alternative 1

(5) The power given to an arbitral tribunal under —

- (a) section 12 or any other provision of the Act; or
- (b) the Model Law,

to award any remedy or relief in deciding an IPR dispute is subject to any agreement (whether in the arbitration agreement or in any other document in writing) between the parties to the IPR dispute.]

[Alternative 2

(5) The parties to the IPR dispute may agree (whether in the arbitration agreement or in any other document in writing) on the powers exercisable by the arbitral tribunal as regards remedies or relief.]

Effect of award involving IPR

26C.—(1) This section applies if an award deciding an IPR dispute is made in arbitral proceedings.

(2) The fact that an entity is a third party licensee in respect of the IPR does not of itself make the entity a person claiming through or under a party to the arbitral proceedings for the purposes of section 19B(1).

(3) However, subsection (2) does not affect any right or liability between a third party licensee and a party to the arbitral proceedings whether —

- (a) arising in contract; or
- (b) arising by operation of law.

(4) In this section, “third party licensee”, in relation to an IPR in dispute in arbitral proceedings, means an entity that —

- (a) is a licensee (whether or not an exclusive licensee) of the IPR under a licence granted by a party to the arbitral proceedings; but
- (b) is not a party to the arbitral proceedings.

Recourse against award involving IPR

26D.—(1) For the purposes of Article 34(2)(b)(i) of the Model Law, the subject-matter of a dispute is not incapable of settlement by arbitration under the law of Singapore only because the subject-matter relates to an IPR dispute.

(2) For the purposes of Article 34(2)(b)(ii) of the Model Law, an award is not in conflict with the public policy of Singapore only because the subject-matter in respect of which the award is made relates to an IPR dispute.

Recognition and enforcement of award involving IPR

26E.—(1) For the purposes of section 31(4)(a), a subject-matter of the difference between the parties to a foreign award is not incapable of settlement by arbitration under the law of Singapore only because the matter relates to an IPR dispute.

(2) For the purposes of section 31(4)(b), it is not contrary to public policy of Singapore to enforce an award only because the award is in respect of a matter that relates to an IPR dispute.

Judgments entered in terms of award involving IPR

26F.—(1) This section applies if —

- (a) an award (whether made in or outside Singapore) deciding an IPR dispute is made in arbitral proceedings; and
- (b) a judgment in terms of the award is entered under section 19 or 29.

(2) Sections 19B(1) and 29(2) apply in relation to the judgment as if —

- (a) a reference in section 19B(1) to an award made by an arbitral tribunal pursuant to an arbitration agreement were a reference to the judgment; and
 - (b) a reference in section 29(2) to a foreign award were a reference to the judgment.
- (3) In this section, “award” includes a declaratory award.

Validity of patent may be put in issue in arbitral proceedings

26G. Section 82(2) of the Patents Act (Cap. 221) does not prevent a party from putting the validity of a patent in issue in arbitral proceedings.”.

PART 5

AMENDMENTS TO PATENTS ACT

Amendment of section 20

7. Section 20(7) of the Patents Act (Cap. 221) is amended by deleting the words “involves matters which would more properly be determined” and substituting the words “involves a matter which would be more conveniently dealt with”.

New section 32

8. The Patents Act is amended by inserting, immediately after section 31, the following section:

“Observations by third party on patentability

32.—(1) Where an application for a patent has been published but a patent has not been granted to the applicant, any other person may make observations in writing to the Registrar on the question whether the invention is a patentable invention, stating reasons for the observations, and the Registrar must, subject to subsection (2), consider the observations in accordance with the rules.

(2) Where at the time the observations are received by the Registrar, the Registrar had sent a copy of an examination report under section 29(4), a search and examination report under section 29(5) or a supplementary examination report under section 29(6), the Registrar will not consider the observations.

(3) A person does not become a party to any proceedings under this Act before the Registrar by reason only that the person makes observations under this section.”.

New section 38A

9. The Patents Act is amended by inserting, immediately after section 38, the following section:

“Re-examination after grant

38A.—(1) Any person may file a request for the Registrar to conduct a re-examination of the specification of a patent for an invention on any of the following grounds:

- (a) the invention is not a patentable invention;
[c.f. s 80(1)(a) Patents Act]
- (b) the specification does not disclose the invention clearly and completely for it to be performed by a person skilled in the art;
[c.f. s 80(1)(c) Patents Act]
- (c) the claim or claims contained in the specification are —
 - (i) not clear or concise; or
 - (ii) not supported by the description of the invention contained in the specification;
[c.f. s 25(5)(b) & (c) Patents Act]
- (d) the matter disclosed in the specification extends beyond that disclosed —
 - (i) in the application for the patent, as filed; or
 - (ii) where the patent was granted on a new application filed under section 20(3) or 47(4) or section 116(6) of the Patents Act (Cap. 221, 1995 Ed.), or in accordance with section 26(11), in —

- (A) the earlier application made under this Act;
- (B) the application made under the United Kingdom Patents Act 1977; or
- (C) the application under the European Patent Convention designating the United Kingdom filed at the European Patent Office,

as the case may be, from which the filing date and the right of priority has been derived, as filed;

[c.f. s 80(1)(d) Patents Act]

- (e) an amendment has been made to the specification of the patent under section 38(1), 81 or 83 which —

- (i) results in the specification disclosing any additional matter; or

- (ii) extends the protection conferred by the patent;

[c.f. s 80(1)(e) & 84(3) Patents Act]

- (f) an amendment has been made to the specification of the application for the patent under section 31 which results in the specification disclosing any additional matter;

[c.f. s 80(1)(e) & 84(2) Patents Act]

- (g) a correction has been made to the specification of the patent or of the application for the patent under section 107 which should not have been allowed;

[c.f. s 80(1)(e) Patents Act]

- (h) the patent is one of 2 or more patents for the same invention having the same priority date and filed by the same party or the party's successor in title.

[c.f. s 80(1)(g) Patents Act]

- (2) Every request under subsection (1) must be —

- (a) filed in the prescribed manner;
- (b) accompanied by the prescribed fee; and
- (c) accompanied, at the time the request is filed, by —

- (i) reasons to substantiate the ground specified in the request; and
- (ii) any document that the person considers to be relevant for the purposes of the re-examination.

[c.f. s 36A(10) Patents Act]

(3) Where any document mentioned in subsection (2)(c)(ii) is not in English, an English translation of the document must be filed at the same time.

(4) The Registrar may reject any request that fails to comply with any requirement in subsection (2).

(5) The Registrar must not grant a request under subsection (1) if the Registrar is of the view that the request is frivolous, vexatious or an abuse of the process.

(6) No request under subsection (1) may be filed where there are pending before the court or the Registrar any proceedings in which the validity of the patent may be put in issue.

[c.f. s 38(2) Patents Act]

(7) Where proceedings before the court or the Registrar, in which the validity of the patent may be put in issue, are filed after a request under subsection (1) is made, the Registrar may make such order or give such direction as the Registrar thinks fit concerning the request.

(8) Where the Registrar grants a request under subsection (1), the Registrar must cause the specification of the patent to be re-examined by an Examiner so as to determine whether the ground specified in the request is made out.

[c.f. s 80(2) Patents Act]

(9) If it appears to the Examiner during the re-examination of the specification of the patent that the ground specified in the request is made out, the Examiner must give the proprietor of the patent a written opinion to that effect, and the Registrar must, upon receiving the written opinion, send the proprietor a copy of the written opinion.

[c.f. s 29(7) Patents Act]

(10) The proprietor of the patent must, before the re-examination report is issued, respond to the written opinion in the prescribed manner and within the prescribed period.

[c.f. s 29(9) Patents Act]

(11) Upon receiving the re-examination report prepared by the Examiner, the Registrar must send a copy of the report to the proprietor of the patent.

[c.f. s 29(4) Patents Act]

(12) Where the re-examination report issued under this section contains one or more unresolved objections, the Registrar must make an order revoking the patent.

[c.f. ss 29A(3) and 80(1) Patents Act]

(13) An order under subsection (12) may be —

(a) an order for the unconditional revocation of the patent;
or

(b) where one of the grounds mentioned in subsection (1) has been established, but only so as to invalidate the patent to a limited extent, an order that the patent should be revoked unless within a specified time the specification is amended under section 83 to the satisfaction of the Registrar.

[adapted from s 80(5) Patents Act]

(14) The Registrar must not revoke a patent under this section while there are proceedings pending before the court or the Registrar in which the validity of the patent may be put in issue.

(15) A decision of the Registrar or on appeal from the Registrar does not estop any party to any civil proceedings in which infringement of a patent is in issue from alleging invalidity of the patent on any of the grounds mentioned in subsection (1)(a), (b) and (d) to (h), whether or not any of the issues involved were decided in the decision of the Registrar.

[c.f. s 80(6) Patents Act]

(16) A decision of the Registrar to revoke a patent under this section has effect from the date of grant of the patent.”

[c.f. s 80(7) Patents Act]

Amendment of section 47

10. Section 47 of the Patents Act is amended —

- (a) by inserting, immediately after the word “entitled” in subsection (5)(b), the words “(whether alone or with other persons)”;
- (b) by deleting the words “more properly be determined” in subsection (8) and substituting the words “be more conveniently dealt with”; and
- (c) by deleting subsection (9) and substituting the following subsection:

“(9) The court must not determine a question whether a patent was granted to a person not entitled to be granted the patent —

- (a) in the exercise of any such declaratory jurisdiction in an action for a declaration, if the action in which the jurisdiction is invoked was commenced after the end of the period of 2 years beginning with the date of the grant of the patent; or
- (b) in the exercise of jurisdiction pursuant to a reference under this section, if that reference was made after the end of the period of 2 years beginning with the date of the grant of the patent,

unless it is shown that any person registered as a proprietor of the patent knew at the time of the grant or, as the case may be, of the transfer of the patent to the person that the person was not entitled (whether alone or with other persons) to the patent.”.

Amendment of section 67

11. Section 67 of the Patents Act is amended —

- (a) by repealing subsections (3), (4) and (5) and substituting the following subsection:

“(4) In this Act, unless the context otherwise requires, any reference to a plaintiff includes a reference to the proprietor of the patent.”; and

(b) by deleting the words “or the Registrar” in subsection (6).

Amendment of section 69

12. Section 69 of the Patents Act is amended —

(a) by deleting the words “or the Registrar may, if it or he” in subsection (3) and substituting the words “may, if the court”;

(b) by deleting the words “, in proceedings before the court,” in subsections (3) and (4); and

(c) by deleting the words “or the Registrar” wherever they appear in subsection (4).

Amendment of section 70

13. Section 70 of the Patents Act is amended —

(a) by deleting the words “or the Registrar” wherever they appear in subsections (1), (2) and (3); and

(b) by deleting the words “its or his” in subsection (3) and substituting the words “the court’s”.

Amendment of section 72

14. Section 72(2) of the Patents Act is amended by deleting the words “or the Registrar for infringement of the patent or” and substituting the words “for infringement of the patent or before the court or the Registrar”.

Amendment of section 75

15. Section 75 of the Patents Act is amended by deleting the words “or the Registrar” wherever they appear in that section.

Amendment of section 76

16. Section 76 of the Patents Act is amended —

- (a) by deleting the words “or before the Registrar” in subsection (1);
- (b) by deleting the words “or the Registrar” wherever they appear in subsection (4); and
- (c) by deleting the words “it or he” wherever they appear in subsection (4) and substituting in each case the words “the court”.

Amendment of section 78

17. Section 78 of the Patents Act is amended —

- (a) by deleting the words “or the Registrar” in subsection (1);
- (b) by deleting subsection (2); and
- (c) by renumbering subsection (1) of that section as that section.

Amendment of section 80

18. Section 80 of the Patents Act is amended —

- (a) by inserting, immediately before the words “the Registrar” in subsection (1), the words “the court or”;
- (b) by inserting, immediately after the word “entitled” in subsection (1)(b), the words “(whether alone or with other persons)”;
- (c) by inserting, immediately before the words “the Registrar” in subsection (2), the words “the court or”;
- (d) by inserting, immediately before the word “Registrar” wherever it appears in subsection (3), the words “court or the”;
- (e) by inserting, immediately after the word “entitled” in subsection (4)(b), the words “(whether alone or with other persons)”;
- (f) by deleting the word “Registrar” in subsection (5)(b) and substituting the words “court or the Registrar, as the case may be”;

- (g) by inserting, immediately before the words “the Registrar” in subsection (8), the words “the court or”;
- (h) by inserting, immediately after the word “application” in subsection (9), the words “to the Registrar”; and
- (i) by inserting, immediately after subsection (10), the following subsection:

“(11) Where an application is made to the Registrar under this section, the Registrar may at any stage of the proceedings refer the application to the court.”.

Amendment of section 81

19. Section 81 of the Patents Act is amended by inserting, at the end of the section heading, the words “on the Registrar’s initiative”.

Amendment of section 82

20. Section 82 of the Patents Act is amended —

- (a) by inserting, immediately before paragraph (a) of subsection (1), the following paragraph:

“(aa) in a request for re-examination of the specification of a patent under section 38A;”;
- (b) by inserting, immediately after the word “before” in subsection (1)(d), the words “the court or”;
- (c) by inserting, immediately after the word “entitled” in subsection (4)(b), the words “(whether alone or with other persons)”;
- (d) by inserting, immediately after the word “entitled” in subsection (6), the words “(whether alone or with other persons)”;
- (e) by deleting the words “67(3), 76, 78 or” in section 82(7).

Amendment of section 83

21. Section 83 of the Patents Act is amended by inserting, immediately after the word “proceedings” in the section heading, the word “, etc.”.

Amendment of section 90

22. Section 90 of the Patents Act is amended —

(a) by inserting immediately after paragraph (c) of subsection (1), the following paragraphs:

“(ca) a decision under section 38A(5) not to grant a request for re-examination;

(cb) a decision under section 38A not to revoke a patent;” and

(b) by inserting, immediately after “83” in subsection (3)(a), the words “, or was a decision to revoke a patent given under section 38A”.

PART 6

AMENDMENTS TO PLANT VARIETIES PROTECTION ACT

Amendment of section 48

23. Section 48 of the Plant Varieties Protection Act (Cap. 232A) is amended by inserting, immediately after subsection (2), the following subsection:

“(3) An appeal does not lie to the Court of Appeal from a decision of the Court on appeal from a decision of the Registrar for any matter under this Act unless leave to appeal is given by the Court or the Court of Appeal.”.

PART 7

AMENDMENTS TO REGISTERED DESIGNS ACT

Amendment of section 43

24. Section 43 of the Registered Designs Act (Cap. 266) is amended by deleting subsections (1) and (2) and substituting the following subsections:

“**43.**—(1) If in any proceedings before the Registrar or the Court the validity of the registration of a design is contested, and

the Registrar or the Court finds that the registration of the design is valid, the Registrar or the Court may certify the finding and the fact that the validity of the registration was so contested.

(2) If the Registrar or the Court gives such a certificate and in subsequent proceedings for infringement of the design or for revocation of the registration of the design before the Registrar or the Court —

- (a) the validity of the registration is again questioned; and
- (b) the registered owner obtains a final order or judgment in the registered owner’s favour relying on the validity of the registration as found in the earlier proceedings,

the registered owner is entitled to the registered owner’s costs as between solicitor and client unless the Registrar or the Court directs otherwise.”.

Amendment of section 62

25. Section 62 of the Registered Designs Act is amended by inserting, immediately after subsection (2), the following subsection:

“(2A) An appeal does not lie to the Court of Appeal from a decision of the Court on appeal from a decision or order of the Registrar under this Act unless leave to appeal is given by the Court or the Court of Appeal.”.

PART 8

AMENDMENTS TO STATE COURTS ACT

Amendment of section 19

26. Section 19(3) of the State Courts Act (Cap. 321) is amended by deleting the word “and” at the end of paragraph (c) and by inserting immediately thereafter the following paragraph:

- “(ca) any jurisdiction to hear and try an action in passing off; and”.

Amendment of section 52

27. Section 52(1A) of the State Courts Act is amended by inserting, immediately after paragraph (a), the following paragraph:

“(aa) the action relates to passing off;”.

PART 9

AMENDMENTS TO TRADE MARKS ACT

Amendment of section 75

28. Section 75 of the Trade Marks Act (Cap. 332) is amended by inserting, immediately after subsection (3), the following subsection:

“(4) An appeal does not lie to the Court of Appeal from a decision of the Court on appeal from a decision of the Registrar for any matter under this Act or the rules made thereunder unless leave to appeal is given by the Court or the Court of Appeal.”.

Amendment of section 102

29. Section 102 of the Trade Marks Act is amended by deleting subsections (1) and (2) and substituting the following subsections:

“102.—(1) If in any proceedings before the Registrar or the Court the validity of the registration of a trade mark to any extent is contested and it is found by the Registrar or the Court that the registration of the trade mark is wholly or partially valid, the Registrar or the Court may give a certificate to that effect and the fact that the validity of the registration was so contested.

(2) If the Registrar or the Court gives such a certificate and in subsequent proceedings before the Registrar or the Court —

- (a) the validity of the registration is again questioned; and
- (b) the proprietor obtains a final order or judgment in the proprietor’s favour relying on the validity of the registration as found in the earlier proceedings,

the proprietor is entitled to the proprietor’s costs as between solicitor and client unless the Registrar or the Court directs otherwise”.