
Intellectual Property

Enhanced IP Border Enforcement Measures to Come into Effect On 21 November 2022

Introduction

The Ministry of Law has announced that enhanced border enforcement measures relating to certain intellectual property rights will come into force on 21 November 2022. These measures apply to goods that infringe intellectual property rights ("IPR") relating to geographical indications and registered designs, allowing Singapore Customs ("**Customs**") to:

- Upon request by the IPR holder, seize goods suspected of infringing the IPR that are to be imported or exported; and
- Obtain and provide information relating to the seized goods.

The new measures represent the third and final phase of the Intellectual Property (Border Enforcement) Act 2018 ("**IPBE Act**"), which was enacted to implement a phased approach to fulfilling Singapore's border enforcement obligations under the European Union-Singapore Free Trade Agreement ("**EUSFTA**").

This Update provides an overview of the key elements of the border enforcement measures set to take effect.

Phased Implementation of Measures

The IPBE Act sets out various amendments to Singapore's intellectual property regulatory framework to enhance its border enforcement. Enacted in 2018, its implementation has been spread across three phases:

- **Phase 1** – Amendments to the Copyright Act 2021 ("**Copyright Act**") and Trade Marks Act 1998 ("**Trade Marks Act**") came into effect on 10 October 2018, empowering Customs to obtain and provide information relating to seized goods.

Contribution Note: This Client Update was written with contributions from Edina Lim, Associate, and Yong Yi Xiang, Associate, from Intellectual Property, Technology and Gaming.



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- **Phase 2** – Enhanced border enforcement measures relating to the Copyright Act and Trade Marks Act came into operation on 21 November 2019.
- **Phase 3** – Enhanced border enforcement measures relating to the Geographical Indications Act 2014 ("**GIA**") and the Registered Designs Act 2000 ("**RDA**") will come into operation on 21 November 2022.

The enhanced measures under Phase 3 will be given effect through the following legislation and subsidiary legislation:

- **Geographical Indications**
 - Amendments to GIA
 - Enactment of the Geographical Indications (Border Enforcement Measures) Rules 2022
 - Enactment of the Geographical Indications (Border Enforcement Measures Fees) Rules 2022
- **Registered Designs**
 - Amendments to RDA
 - Enactment of the Registered Designs (Border Enforcement Measures) Rules 2022
 - Enactment of the Registered Designs (Border Enforcement Measures Fees) Rules 2022

Phase 3 Measures

Under the Phase 3 Measures, Customs may seize goods suspected of infringing geographical indications or registered design rights upon request from the relevant IPR holder.

The procedure is as follows:

- **Request for seizure** – The IPR holder may give written notice to the Director-General of Customs stating that infringing goods are expected to be imported or exported, and requesting the Director-General to seize the goods. The notice must include the necessary information on the goods, the prescribed supporting documents evidencing the IPR ownership, and the prescribed fee. The requestor may also be required to provide security for such seizure.
- **Seizure of goods** – Upon direction by the Director-General, the goods will be seized and taken to a secure place.

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- **Notice of seizure** – The Director-General will give written notice to the importer/exporter and the requestor that the goods have been seized, and that they will be released to the importer/exporter unless an infringement action is instituted by the requestor within the specified period (10 days after the date specified in the notice). This period may be extended by request if the Director-General is satisfied that such request is reasonable.
- **Obtaining information** – If authorised Customs officers have reasonable cause to believe that a person has any relevant information or document, they may require that person to provide such information or document. Failure to comply is an offence that is punishable by a fine not exceeding S\$6,000 and/or imprisonment not exceeding six months.
- **Providing information** – The Director-General may provide information to the requestor necessary for instituting an infringement action, including the name and contact details of any person connected with the import/export of the seized goods.
- **Inspection of seized goods** – The Director-General may permit the requestor, or the importer/exporter, to inspect the seized goods, and may permit a sample of the seized goods to be removed from its custody for such inspection if the necessary undertakings are given by the importer/exporter or the requestor.
- **Forfeiture of seized goods** – The importer/exporter may consent to the forfeiture of the seized goods to the Government. Notice of such consent must be given before an infringement action is instituted.
- **Release of seized goods** – The seized goods will be released to the importer/exporter if:
 - The requestor has not instituted an infringement action and notified the Director-General within the prescribed period;
 - An infringement action has been instituted, but the Court has not granted an order preventing the release of the goods after 22 days from the date the action was instituted; or
 - The requestor consents to such release.

Concluding Words

The impending enhanced border enforcement measures are set to take effect from 21 November 2022. IPR holders, as well as importers and exporters, should take note of these measures and be aware of the relevant obligations and procedures relating to the seizure of goods suspected of infringing geographical indications and registered design rights.

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The Phase 3 measures highlighted above bring the regime for the seizure of goods in relation to geographical indications and registered designs in line with the equivalent regimes for copyrights and trade marks. These measures serve to create an effective framework for protecting IPR by preventing the import and export of infringing goods and facilitating the instituting of infringement actions. At present, there are no border enforcement measures in place in relation to potential patent-infringing goods. This is likely because the current trade agreements that Singapore is a party to do not require such measures to be implemented. In particular, the EUSFTA only requires Singapore to enhance its border measures in respect of counterfeit trademark goods, pirated copyright goods, counterfeit geographical indication goods and pirated design goods. The Agreement on Trade-Related Aspects of Intellectual Property Rights (more commonly known as the TRIPS Agreement) which applies to all members of the World Trade Organisation also only requires member states to implement border enforcement measures in respect of counterfeit trade mark goods and pirated copyright goods, as opposed to goods which infringe patents. It remains to be seen whether enhanced border enforcement measures in respect of patent-infringing goods will be implemented in the future.

For further queries, please feel free to contact our team below.

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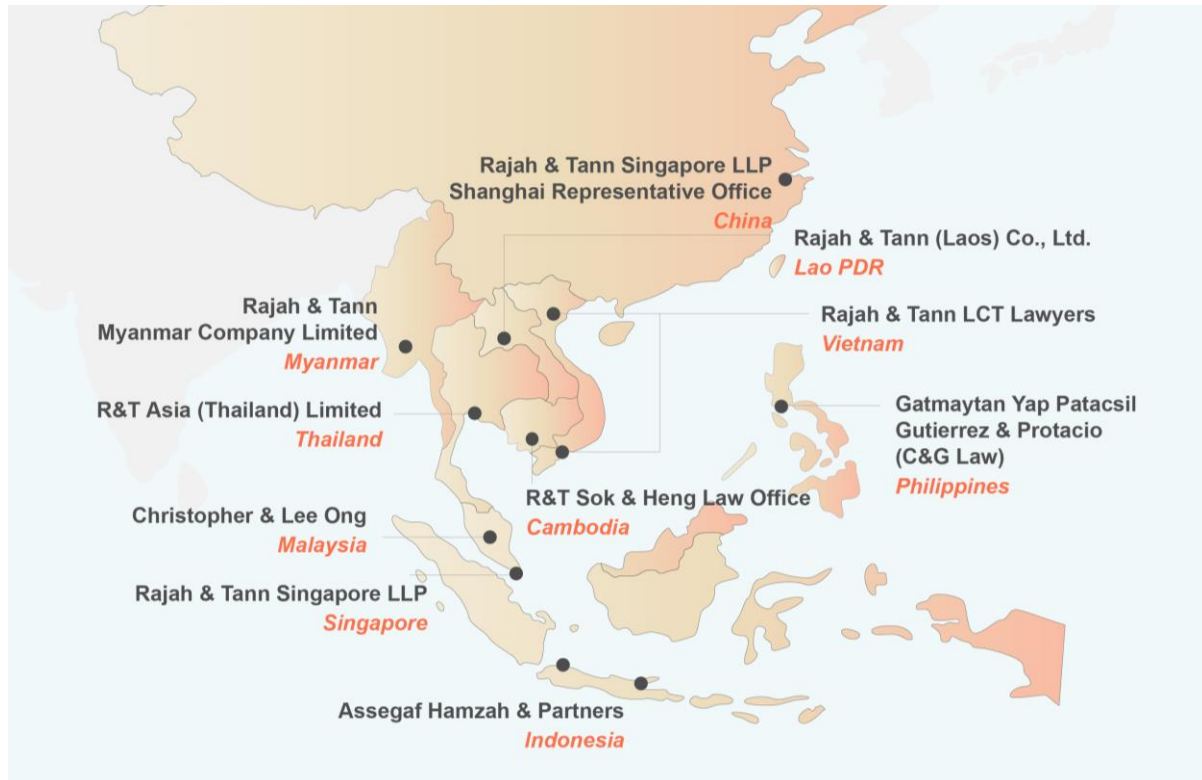
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