

## Newsletter

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## General Developments

### Singapore Furthers IP Cooperation with the Lao People's Democratic Republic (Laos)

On 27 November 2019, a Memorandum of Cooperation ("**MOC**") to bridge the innovation ecosystems of Laos and Singapore was signed by Dr Khanlasy Keobounphanh, Director General of the Department of IP ("**DIP**"), Ministry of Science and Technology of Laos, and Mr Daren Tang, Chief Executive of the Intellectual Property Office of Singapore ("**IPOS**").

This cooperation will see IPOS sharing its deep technical IP knowledge and services to support Laos in building its innovation ecosystem and contributing to economic integration in ASEAN through IP and intangible assets. Under the MOC, the DIP will tap on IPOS' patent search and examination expertise and services to grant quality patents in Laos, and will allow Singapore granted patents to be re-registered in Laos, accelerating enterprise access into both markets.

#### Comments

With IP being a key enabler in transforming ASEAN into a highly innovative and economically competitive region, owners of granted Singapore patents looking to pursue patent protection in Laos will soon be able to register their patents with the DIP.

### Supplementary Examination Route Closed from 1 January 2020

From 1 January 2020, the supplementary examination route – that allows applicants to obtain a patent expeditiously by relying on positive substantive examination results of an international application or a corresponding allowed/granted foreign patent application - will no longer be available to the following patent applications:

- (a) Singapore applications with a filing date on or after 1 January 2020;
- (b) International applications entering national phase in Singapore with a filing date on or after 1 January 2020; and
- (c) Divisional applications lodged in Singapore with an actual filing date on or after 1 January 2020

This means that patent applications (a) to (c) with a filing date on or after 1 January 2020 must undergo local substantive examination either where the Intellectual Property Office of Singapore performs search and substantive examination or



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performs substantive examination based on the search results of an international application or corresponding foreign patent application.

Patent applications filed before 1 January 2020 will continue to be eligible for the supplementary examination route.

Further details on the closure of the supplementary examination route can be found on IPOS Circular Nos. [5/2016](#) and [7/2017](#), and our Client Alert (see [here](#)).

## Comments

The closure of the supplementary examination route is in line with IPOS' plan to improve the quality of Singapore granted patents and to instill greater confidence in Singapore's patents system. Although the supplementary examination route is no longer available after 1 January 2020, applicants may still rely on the positive examination results of their applications from certain foreign patent offices to expedite the local examination of their Singapore patent application through programmes such as the Global Patent Prosecution Highway ("**GPPH**") or the ASEAN Patent Examination Cooperation Programme ("**ASPEC**").

## Malaysia's Accession to the Madrid Protocol - 27 December 2019

On 27 September 2019, the Government of Malaysia deposited its instrument of accession to the Madrid Protocol with the World Intellectual Property Organization ("**WIPO**")'s Director General, making Malaysia the 106th member of the Madrid System, which now covers 122 countries. The Protocol had entered into force for Malaysia on 27 December 2019.

The accession will change the previous single class filing system to the multi-class system, allowing trade mark proprietors to file for registration of their trade marks in multiple classes of goods and services in a single application.

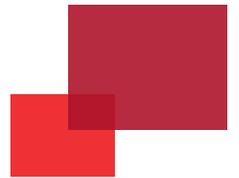
### What Is the Madrid Protocol?

The Madrid Protocol refers to the Protocol in relation to the Madrid Agreement concerning the International Registration of Marks as administered by WIPO.

The Madrid System allows brand owners to apply for trade mark protection in up to 122 territories by filing a single international application with the national or regional IP office of a Madrid System member.

With the Madrid System, the process of multinational trade mark registration is streamlined through a single application and management process.

The Madrid Protocol therefore offers an alternative to filing separate applications directly with individual countries where trade mark owners intend to seek registration.



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Prior to 27 December 2019, trade mark owners in Singapore who want to protect their trade marks in Malaysia would have to do so by filing national applications for their trade marks with the Malaysia Intellectual Property Office ("**MyIPO**").

With Malaysia's accession, eligible applicants will be able to designate Malaysia as one of the designated countries in the international application. The Madrid Union currently has 106 members, covering 122 countries.

## Comments

The Madrid Protocol offers a convenient and cost-effective solution for trade mark owners to expand brand protection into new markets. Trade marks can be registered and managed locally for the protection in multiple territories under the Madrid System. This will likely save time and cost of the trade mark owners in managing their global portfolio.

Furthermore, there is a definite examination period of either 12 or 18 months for IP offices to raise an objection to the trade mark application. In the absence of any such objection, the application will gain automatic protection.

However, the Madrid Protocol is not without its shortfalls. One disadvantage is the "central attack" where the rejection of a trade mark application in the home country within 5 years of the application date will result in the rejection of all applications in other territories that are based on that application.

Another limitation of the Madrid Protocol is the inability to transfer trade mark ownership to an owner who is not a resident in a member country without first withdrawing the trade marks from the Madrid System.

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