

**Baker  
McKenzie  
Wong & Leow.**

## **Judicial Symposium on Intellectual Property 2021**

Andy Leck | Principal | Singapore



# Agenda

- 1 Enforcement Methods against Counterfeit Goods in Singapore
- 2 Criminal Proceedings and remedies
- 3 Civil Proceedings and remedies
- 4 Border Enforcement



**Andy Leck**  
Principal,  
Baker McKenzie Wong & Leow

# **1 Enforcement methods against Counterfeit Goods in Singapore**

# Enforcement methods against Counterfeit Goods in Singapore

## Criminal Proceedings

- Private Criminal proceedings - (“Hybrid”, “self-help” regime – Rights holder can prosecute.)
- Ex-officio criminal proceedings

## Civil proceedings

- Cease and desist letter
- Civil claim, seeking:
  - Interim injunction
  - Final remedies, e.g. final injunction, damages (or an account of profits), and legal costs.

## Border enforcement

- Seizures on request
- Ex-officio seizures



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# Criminal Proceedings and remedies

# Criminal Proceedings, generally

1. Private Criminal Action

2. *Ex Officio* Criminal Action



# Counterfeitting is a criminal offence

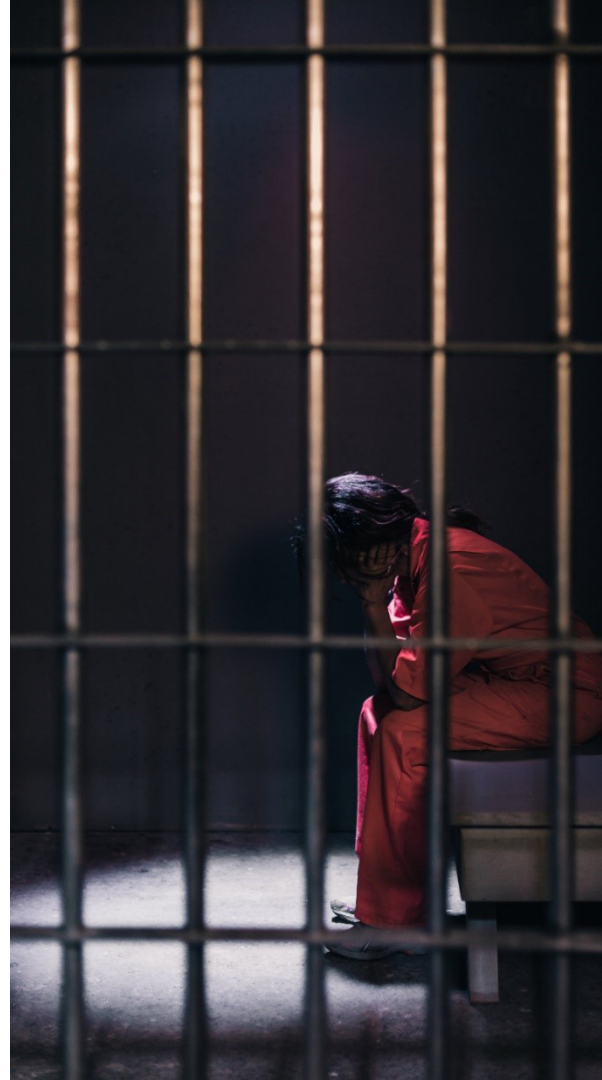
**Import /  
Manufacture /  
Sell (s.49  
Trade Marks  
Act (“TMA”))**

**Counterfeiting  
(s.46 TMA)**

**Falsely  
applying mark  
(s.47 TMA)**

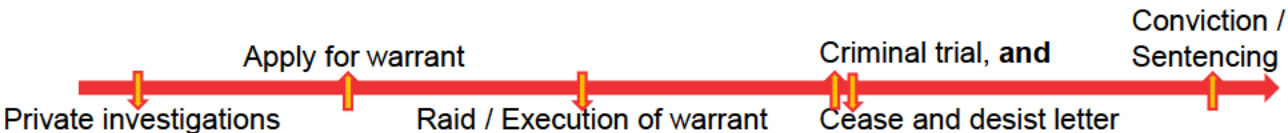
**Penalty:** Fine of  $\leq$  SGD 10,000 (approx. USD 7,300) for each infringing item (maximum aggregate fine of SGD 100,000 (approx. USD 73,000) ) and/or imprisonment of  $\leq$  5 years.

**Directors:** Directors / officers of company may be liable for infringement if offence was committed with their consent or connivance.



# Private Criminal Proceedings

- **Preliminary Steps:**
  - Private investigations to obtain evidence.
  - Apply to Court for Criminal Search and Seizure Warrant.
- **Investigations typically include:**
  - Sample purchases (online or in-person);
  - Background checks;
  - Internet checks; and
  - Surveillance.



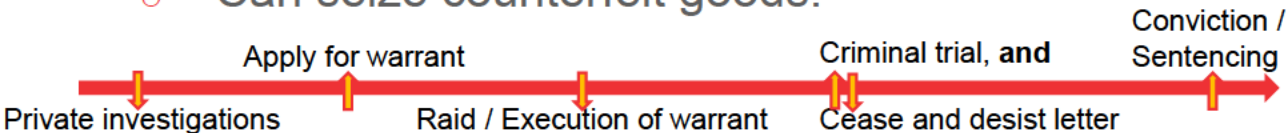
# Private Criminal Proceedings

## ■ Warrant

- Rights holders may apply to the Singapore State Courts for criminal search and seizure warrants.
- Application made with support of statutory declaration by private investigator 1 day before raid.

## ■ Raid / Execution of warrant

- Warrants are executed by the Intellectual Property Rights Branch of the Singapore Police Force (“IPRB”);
- Lawyers and brand representative can attend; and
- Can seize counterfeit goods.

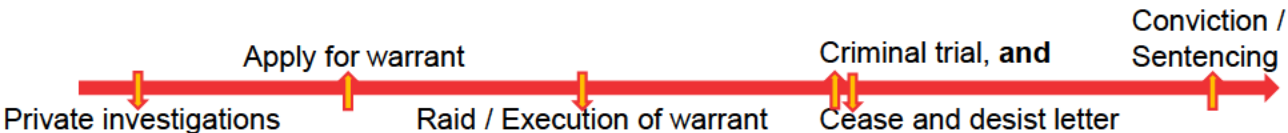




# Private Criminal Proceedings

## Criminal trial

- Rights holder must obtain a fiat from the Attorney-General's Chambers to prosecute.
- Once a fiat is obtained, the rights holder may commence proceedings and prosecute the counterfeiter.



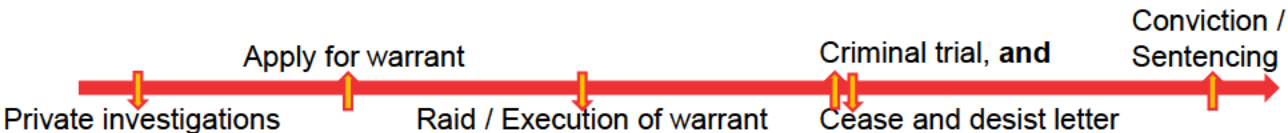
# Private Criminal Proceedings

## Cease and Desist Letter

- Sets out rights holder's claim
- Sets out evidence against counterfeiter
- Demand infringer to sign a Deed of Undertaking in exchange not to pursue further legal action

## Deed of Undertaking

- Refrain from further infringing activities
- Source disclosure
- Compensation / Damages / Costs
- Delivery up
- Public apology



# *Ex Officio* Criminal Action

- IPRB may also undertake *ex officio* investigations, raids and criminal prosecution.
- Such raids are conducted on IPRB's own initiative. IPRB may also act upon complaints from the general public or the IPR owners.





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# **Civil Proceedings and remedies**

# Civil Proceeding - Stages

**Rights holders may sue counterfeiters in a civil claim.**

Typical stages of civil proceedings:

1. Cease and desist letter / Deed of Undertaking;
2. Filing formal legal proceedings (i.e. a civil claim for trade mark infringement in the Singapore High Court) and/or an application for an interim injunction restraining infringement up to trial;
3. Interlocutory proceedings, if any; and
4. Trial

# Civil Proceedings - Timeline

## Timeline

- Can last anywhere from 12 to 24 months
- Faster proceedings possible in:
  - Urgent interim injunction application (a few days)
  - Summary judgment application against a counterfeiter (around 4 months)

# Civil Proceedings – Remedies

**Rights holder may seek various remedies, including:**

- Interim injunction restraining the counterfeiter from further infringing acts until the trial of the matter
- Final injunction
- Damages / account of profits
- Statutory damages
  - Trade Marks Act:  $\leq$  SGD100,000 (approx. USD 73,000) for each type of infringing good and  $\leq$  SGD1,000,000 (approx. USD 730,000) in aggregate)
- Source disclosure
- Delivery up of all remaining stocks of infringing goods
- Costs.



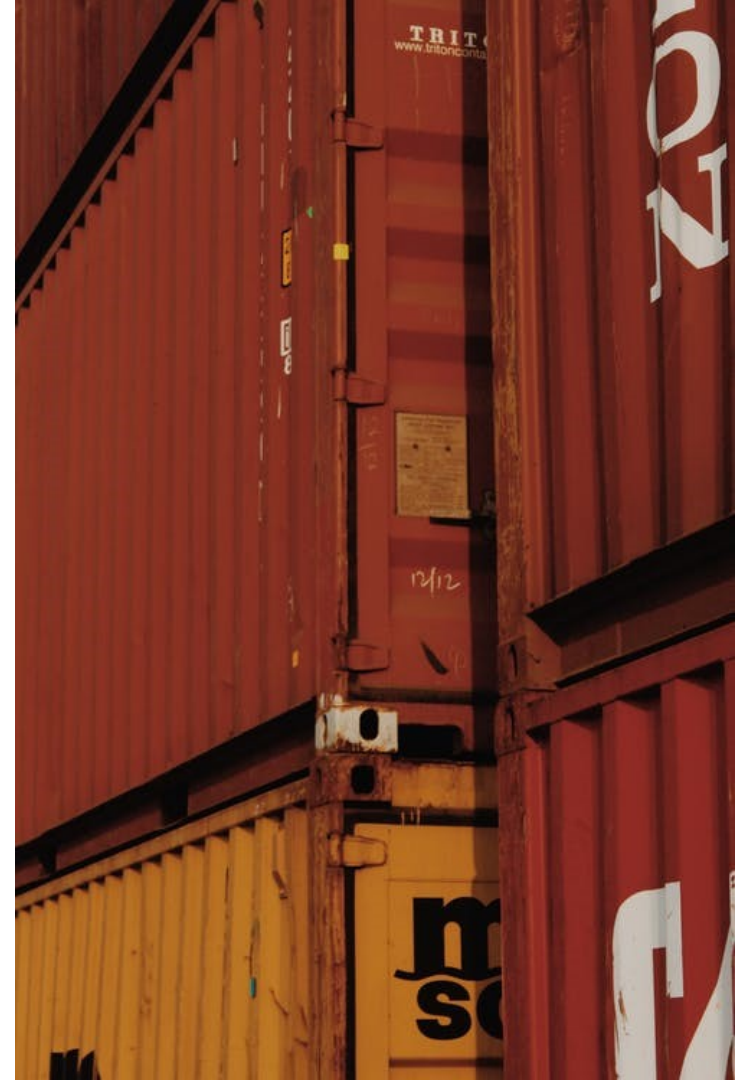
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# **Border Enforcement**

# Border Enforcement

The Singapore Customs has powers to conduct enforcement actions in 2 ways:

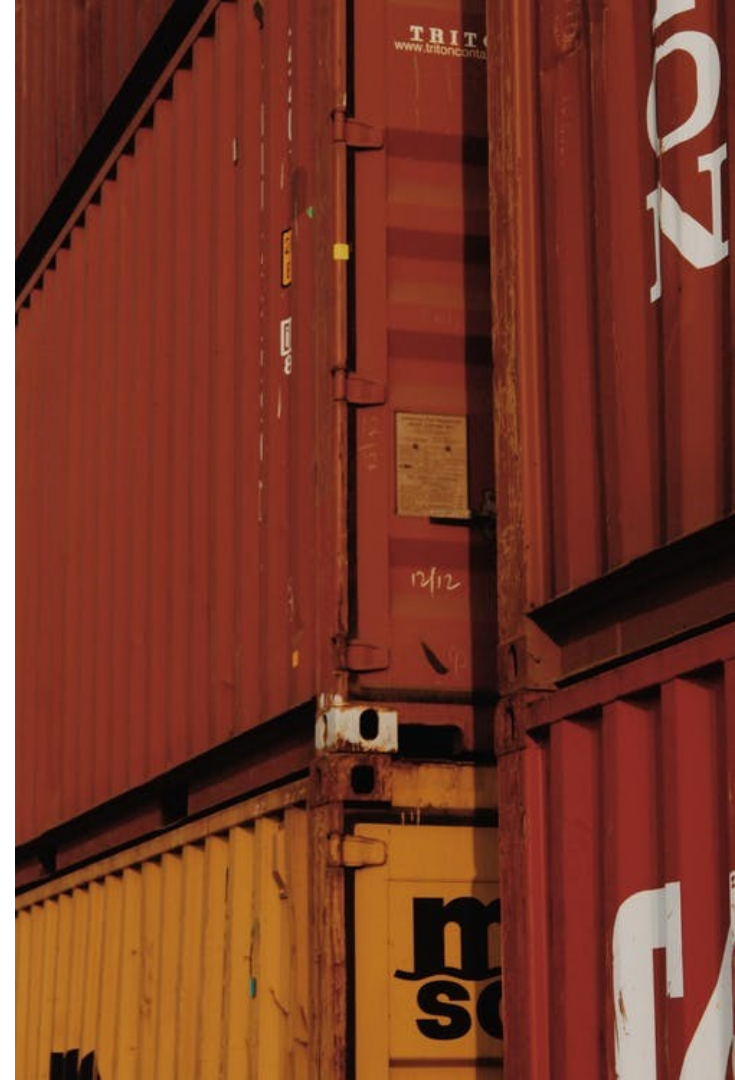
- Seizures on Request
- Ex-officio Seizures





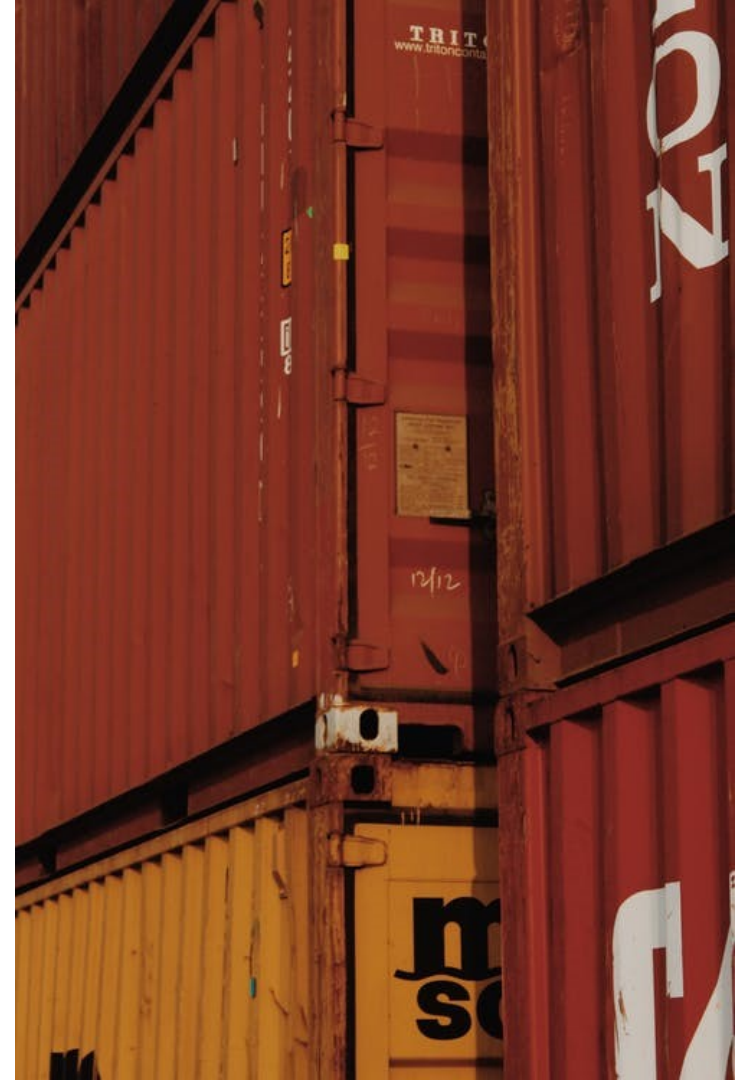
# Border Enforcement: Seizures on request

- Rights holder must request by filing a notice.
- Singapore Customs will seize infringing goods if they are imported into or exported from Singapore.
- Once seized, Singapore Customs will notify rights holder.
- Rights holder must institute action for infringement and seek order of court preventing release of goods.
- If action is not commenced in 10 days, and if an order of court preventing release is not obtained by 22 days after commencing an action, the Singapore Customs will release the goods



# Border Enforcement: Ex-officio seizures

- Singapore Customs may seize goods if suspected to be counterfeit.
- Once seized, Singapore Customs will notify rights holder.
- Rights holder must institute action for infringement and seek order of court preventing release of goods.
- If action is not commenced in 10 days, and if an order of court preventing release is not obtained by 22 days after commencing an action, the Singapore Customs will release the goods





## Contact



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