



EU-SG Matchmaking Event: IP tips for the Singapore market

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Speaker's Bio

Name: James Kinnaird
Firm: Marks & Clerk Singapore LLP
Location: Singapore



James Kinnaird (BSc (Hons) Chemistry with Medicinal Chemistry from Glasgow University, PhD from Cambridge University) initially followed the usual path for chemists with his background and spent time in the US doing postdoctoral work at Columbia University and as a medicinal chemist at Pfizer in Sandwich (UK), before switching track to become a patent attorney in 2005. He is now a Registered Singapore Patent attorney (2014), Chartered Patent Attorney (UK, 2009) and he was also a European Patent Attorney (qualified 2009) before his move to Singapore in 2013.

James is now a Partner in the Singapore office of Marks & Clerk and has broad experience in assisting clients protect their ideas over a wide range of technology areas, including the electronic and chemical arts, as well as wearable technology, materials and food. James also has particular expertise in assisting clients understand IP-risks associated with launching their product in a new territory – particularly in ASEAN. James has been actively involved in training the next generation of patent attorneys and he was also a member of two examination committees for the Singapore patent examinations from 2015 to 2018.



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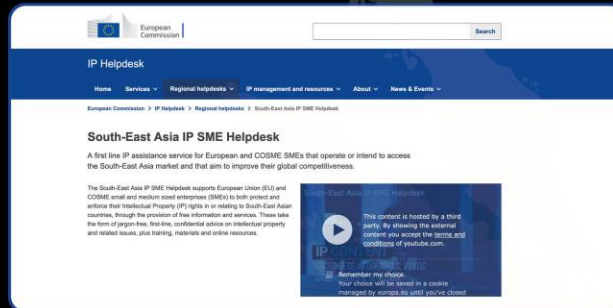
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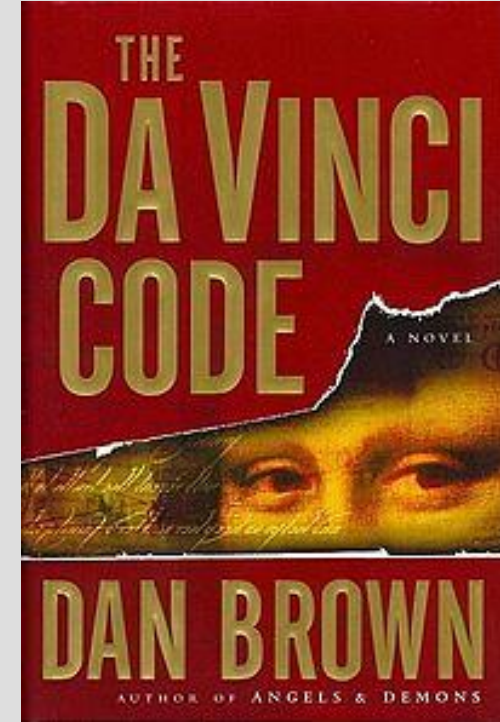
Agenda

- What is IP?
- Singapore, ASEAN and IP
- Case Studies

What is IP?

What is Intellectual Property?

- Protection of Intangible Assets
- Copyright
 - **Written word**
 - **Recorded performances**
 - **Music**
 - **Film**
 - **Software**
 - **Art**
- Set time limit (up to 70 years from death of Artist)



Trade Marks & Designs



Word Mark/
Logos



Colours



Shapes

A ____ a day helps you
rest work and play

Gestures

Jingles

Smells

- **Designs 3D Products defined by:**

- Shape, Contours, Colours
- Lines, Textures, Materials
- Ornamentation



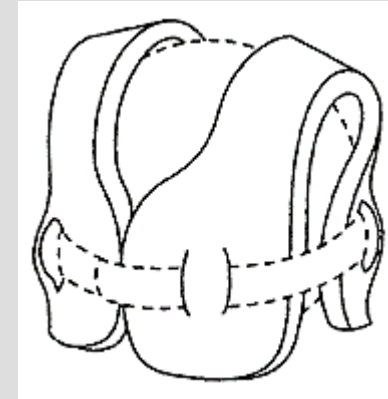
Patents

- *Deal between state and applicant*



Requirements:

- Novel
 - Inventive
 - Capable of Industrial Application
-
- Reverse engineering protection...



US D497966
Golf Ball Flotation
Device

Trade Secrets

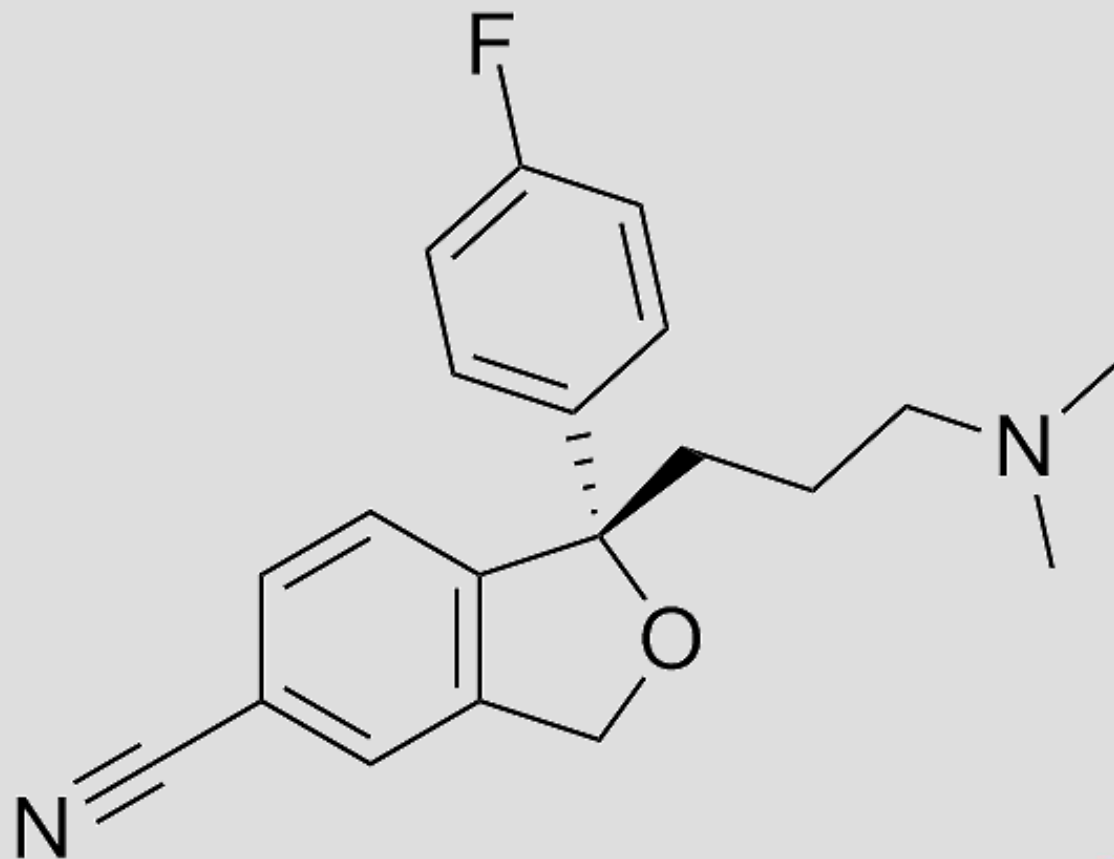
- Cannot register, reverse engineering possible
- Useful for processes, **products difficult to copy**, short shelf-life products
- Vulnerable?



How to Protect?



How to Protect?




Exploiting your IP

Economic Exploitation of IP

- IP gives right to stop others doing something, does not give you a right to do anything.
 - e.g. need regulatory approval before can launch new medicine into market.
- *What is your company's strategy?*
 - Direct use?
 - Indirect use?
 - Defensive?

Economic Exploitation of IP

Direct Use

- Exploit product/service yourself (core business)
 - Prevent others from doing so
- 
- Note, **IP is territorial**. A patent in IT does not provide protection in SG.
 - Key markets for sales
 - Key manufacturing hubs
 - Think long term – patents last 20 years, TMs can last for ever...

Economic Exploitation of IP

Indirect Use

- Sale, license, franchise, merchandise
- Non-core business (unless franchise/licensing model)
- Generate royalties
- Retain some control over product/service



Economic Exploitation of IP

Other Uses of IP

- Defensive patent
 - Not really interested in technology, but want to stop others exploiting it
 - Can publish instead (e.g. journal article)
- Finance
 - IP is an intangible asset
 - Can raise money based on IP portfolio
 - Nortel went bankrupt -----



Nortel patents sold for \$4.5bn

Apple, Microsoft, Sony and RIM part of consortium that bought patent portfolio from bankrupt telecoms company Nortel Networks



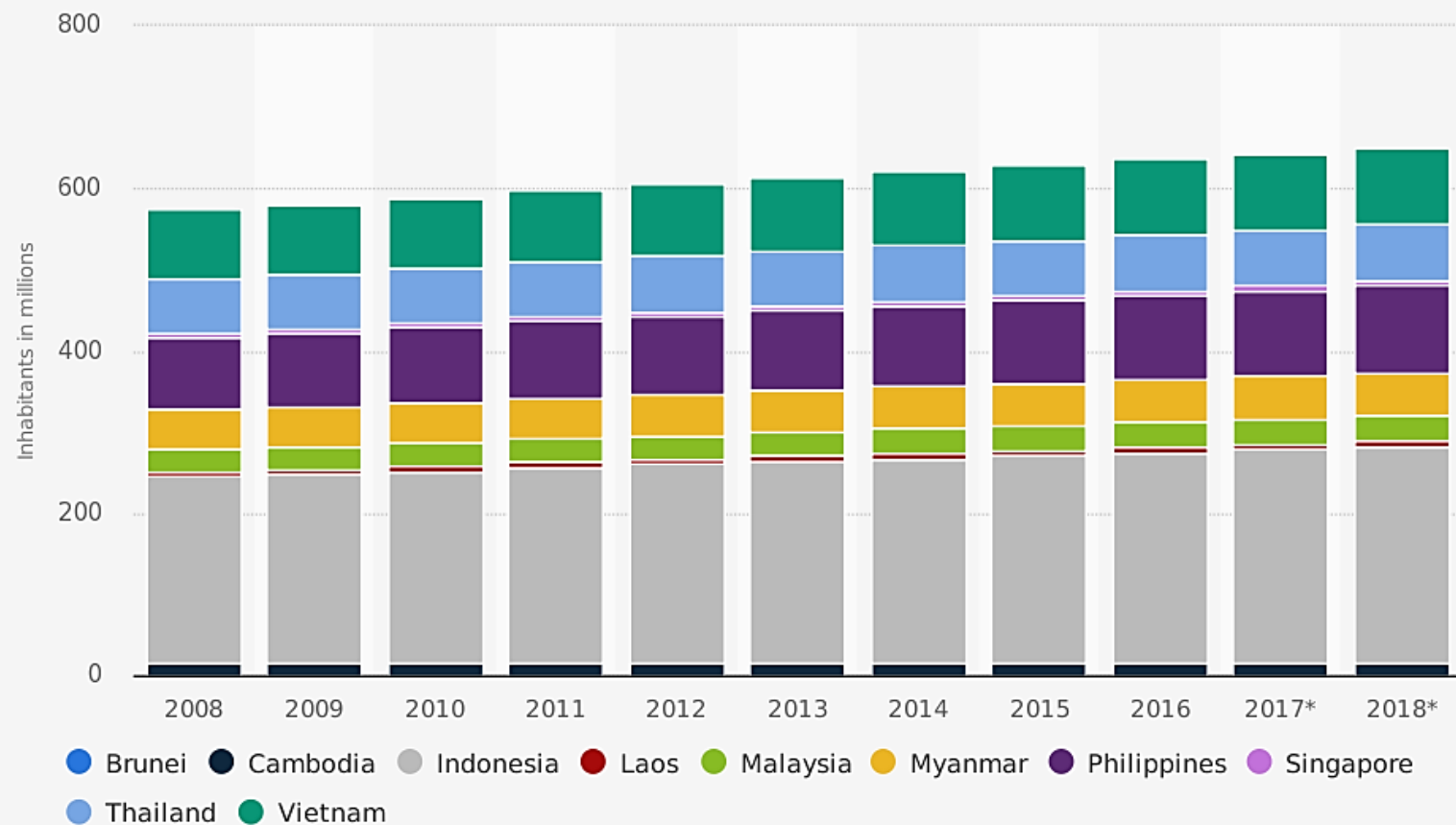
▲ Apple and RIM are part of a consortium that bought a portfolio of communications patents from Nortel Networks. Photograph: Paul Sakuma/AP

Singapore, ASEAN and IP

What is ASEAN?



Total population of the ASEAN countries from 2008 to 2018 (in million inhabitants)

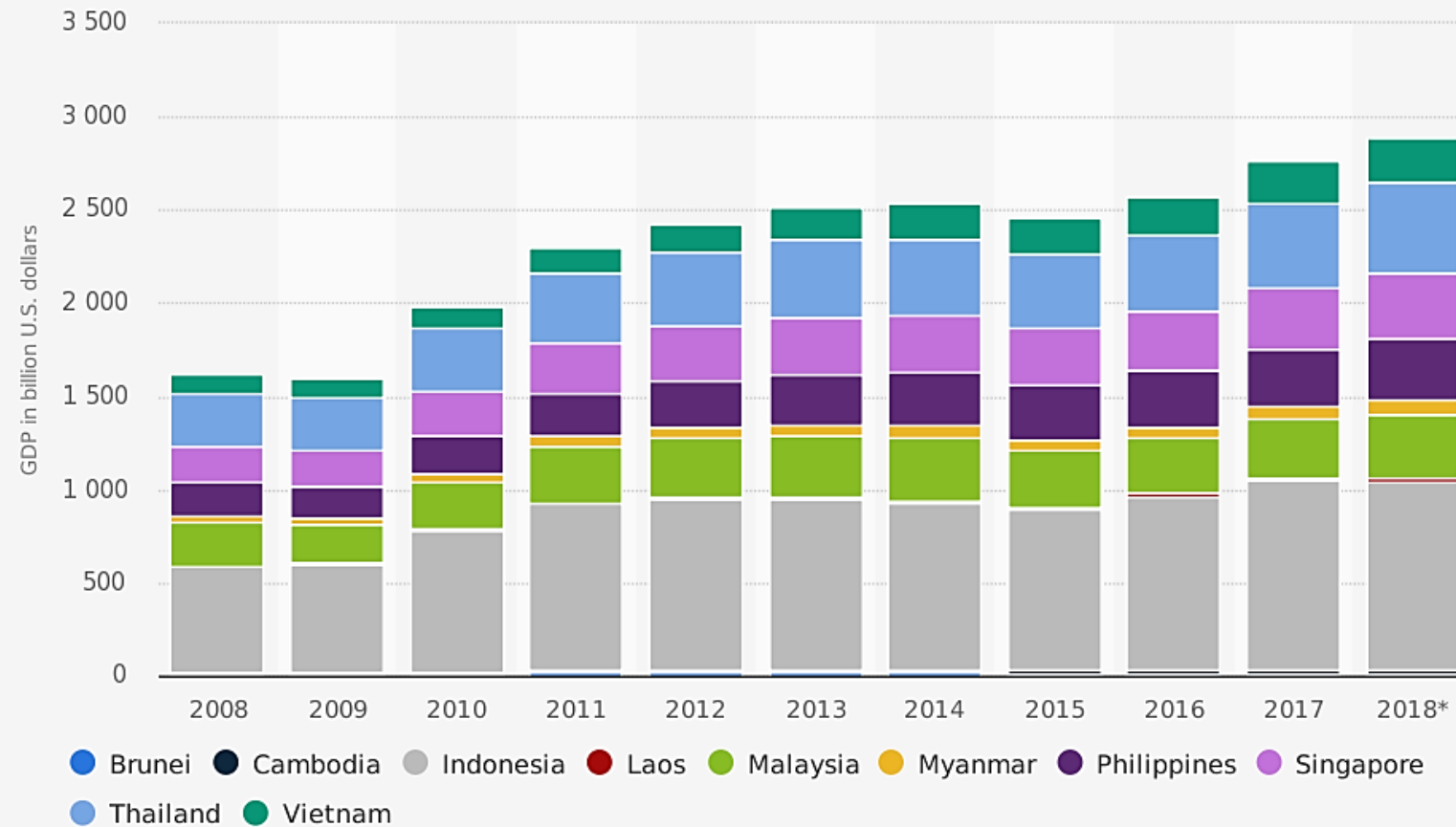


Source
IMF
© Statista 2018

Additional Information:
Worldwide; 2008 to 2011

statista

Gross domestic product (GDP) of the ASEAN countries from 2008 to 2018 (in billion U.S. dollars)



Source
IMF
© Statista 2018

Additional Information:
Worldwide

statista

Why Consider Singapore?

- Small island country with relatively big population (for size)
- Not independent for food or water – plans in place to increase self-sufficiency
- **30 by 30**
 - Needs new technologies to help it achieve this goal
- SG Net 0 by 2050
 - 2030 – 60 MtCO₂e
 - Again, needs to adopt new technologies to get to goal



Locally Active IP Scene in this Area

- Universities (NUS/NTU) – actively license out their technology
- Companies (Keppel)
- Energy-saving technologies (compositions, devices, clothes!)
- Water treatment and conservation
- Smart cities initiative (part of SG's current 5-year plan)

ASEAN Region Patent Filings

Source: WIPO Statistics Database. Last Updated December 2023

Country	2016	2017	2018	2019	2020	2021	2022
Brunei	89	107	121	141	120	139	155
Cambodia	80	55	161	310	248		162
Indonesia	9,639	9,303	9,754	11,481	8,160	8,800	9,967
Malaysia	7,236	7,072	7,295	7,551	6,828	7,534	7,374
Philippines	3,419	3,395	4,300	4,380	3,993	4,393	4,765
Singapore	10,980	10,930	11,845	14,136	13,265	14,590	14,653
Thailand	7,820	7,865	8,149	8,172	7,525	8,242	8,607
Viet Nam	5,228	5,382	6,071	7,520	7,695	8,534	8,707

Time to Grant & Protection

Country	Time to Grant of EP	IP Court System	Prosecution Focus
Singapore	Fast	Specialized	Move to Local Exam
Malaysia	Similar	IP Court	Rely on corresponding case
Thailand	Slow	IP Court	Rely on corresponding case
Brunei	Fast	No	Rely on corresponding case
Philippines	Similar	IP Court	Rely on corresponding case
Indonesia	Slow	Specialized	Rely on corresponding case
Vietnam	Slow	No	Rely on corresponding case
Cambodia	Fast	No	Re-Registration
Laos	?	No	?

Case Studies

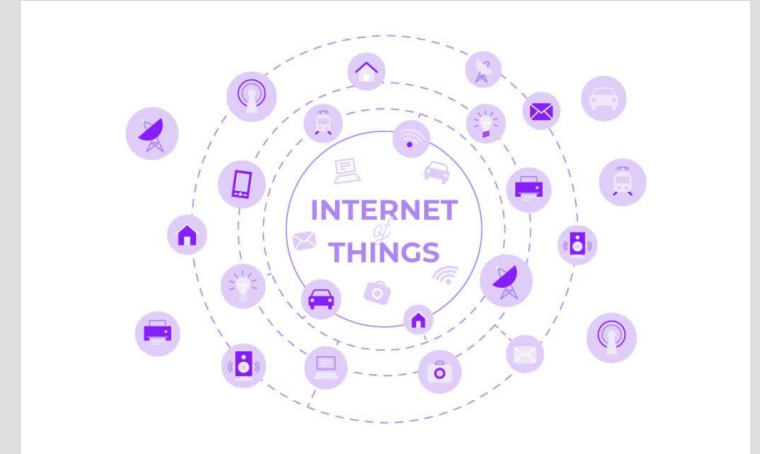
Case Study I

- European consultancy company sets up joint venture with local SG company.
- Branding is heavily based on the EU consultancy's.
- EU company does not register their brand.
- Their partner in the JV does...
- They fall out, EU company wants to continue business in SG alone.
- EU company sued for Trademark infringement by former partner!



Case Study II

- European IoT company had patent application drafted by European attorney, but did not contemplate Singapore when drafting.
- Claims drafted to cover entire process. But process involves server and client relationship. Clients in Singapore, but server located in Europe.
- So entire scope of claims not conducted in Singapore...
- In Europe, no issue, can use contributory infringement to catch this situation, but SG does not have contributory infringement provisions.
- Patent may be worthless in SG because not drafted appropriately!
- Ensure separate claims to server and client as well as overall process...



Key Takeaways

- IP is territorial
- Singapore (and ASEAN) handle infringement differently to Europe; ensure your attorney drafts accordingly!
- Take care of your own Trademarks – otherwise your partners might!

We want your feedback



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