

International Registrations Designating Singapore Procedure for Trade Mark Prosecution

Procedure
<p>Step 1:</p> <ul style="list-style-type: none">• Receiving objection• Taking over representation• Monitoring deadline• Advising on objection with risk evaluation, cost estimates on options available, and our recommended approach (with providing fallback positions for each step of the proceedings)
<p>Step 2:</p> <ul style="list-style-type: none">• Drafting & filing Request for Review, with written arguments, and case authorities (for citation and distinctiveness objections only)• Limit specifications (if decided to do so)
<p>Step 2A (only applicable if objection maintained after Step 2):</p> <ul style="list-style-type: none">• Reporting and advising on 2nd Examination Report• Drafting and filing 2nd Written Response, undertaking level 1 fallback position, i.e. next best alternative option
<p>Step 2B (only applicable if objection maintained after Step 2A):</p> <ul style="list-style-type: none">• Reporting and advising on 3rd Examination Report• Drafting and filing 3rd Written Response, undertaking level 2 fallback position, i.e. next best alternative option
<p>Step 2C (only applicable if objection maintained after Step 2B):</p> <ul style="list-style-type: none">• Depends on the case, whether we have additional fallback positions
<p>Step 2D (only applicable if objection maintained after Step 2C):</p> <ul style="list-style-type: none">• Appeal to High Court (<i>never happens – only for contentious cases where priority of trade mark filing is important</i>)
<p>Step 3:</p> <ul style="list-style-type: none">• Trademark accepted and published for opposition (<i>Sometimes opposition filed by 3rd party - opposition information sheet available upon request</i>)• Reporting on acceptance, checking and reporting publication and registration (Optional service)

***For detailed quotes, please e-mail us at: office@trademarks-patents.sg**

Frequently Asked Questions (FAQ)

1. Why does the Intellectual Property Office of Singapore (IPOS) cite earlier trademarks against my own trademark application in Singapore.

Different from many jurisdictions in the world, IPOS tries to keep the trademark register clean, by comparing new trademark applications against existing registered trademarks, and tries to anticipate conflicts between potentially confusing trademarks. This can be a disadvantage because this can be costly. On the other hand, having a registered trade mark in Singapore comes with some sort of freedom-to-operate: a registered trademark is not infringed by the use of another registered trade mark in relation to goods or services for which the latter is registered.

2. How do I get a better estimate of the fees applicable to me?

Please e-mail us at office@trademarks-patents.sg for a detailed quote for step 1 above, based on your specific case.

3. Are you able to advise on the chances of success for overcoming objection(s)?

Yes. Our advisory fees cover the following scope of work:

- (a) Identification of all options available for your case;
- (b) Provide risk evaluation of each option;
- (c) Provide cost estimates for each option;
- (d) Provide our recommendation on best option to pursue, with fallback positions; and
- (e) Provide chances of success in percentage terms for proceeding based on our recommended option.

With our comprehensive advisory report, you will be able to make an informed decision on the options to pursue for further proceedings.

4. What is the likelihood of successfully overcoming an objection with just one round of written submissions? Does it also depend on the type of objection?

For straightforward matters such as simple specification objections, translation objections, series objections, it is likely that one round of written submissions would suffice.

For complex matters such as difficult similar mark objections and distinctiveness objections, we may need more than one round of submissions and further fallback positions.

Regardless of complexity of objection, we will always put forth the best written arguments supported by case law (where appropriate) in our attempt to overcome the objection in an expeditious and cost-effective manner.

5. Can I file an appeal against the Examiner's decision if I do not agree with the findings of the Examiner in charge of my file? Is this a realistic option?

It is possible to lodge an appeal with the High Court, to contest the decision of the Examiner as to the registrability of a trade mark. However, this is not a realistic option unless you have deeper pockets. Appeals to the High Court against IPOS decisions in ex-parte trademark application registration matters are so far unheard of in Singapore.