ASIAN PATENT ATTORNEYS ASSOCIATION

Council Meeting 2026, Singapore
Anti-Counterfeiting Committee

SINGAPORE SPECIAL TOPIC REPORT

"Protection of Product Shapes/Configurations"

A. Introduction

1. This report examines the anti-counterfeiting measures available in Singapore when product shapes and configurations fall within what is described as the "protection gap". This gap arises after a product has been commercialised (such that the novelty required for design registration may have been lost) but before sufficient recognition for three-dimensional trade mark registration has been established through use.

B. Protection of product shapes/configurations in Singapore

Copyright

2. The Copyright Act 2021 ("**CA**") governs copyright protection in Singapore. Artistic works, including sculptures, works of artistic craftsmanship, and drawings, are capable of copyright protection. In principle, a three-dimensional product shape may qualify as an original artistic work. However, the industrial application provisions in Part 5 of the CA severely limit the practical utility of copyright for product configurations. This issue is discussed in section C of this Report.

Unfair Competition

3. Unlike some other jurisdictions, Singapore has no general cause of action for unfair competition that allows a rights holder to challenge the copying of a product shape based solely on unfair commercial conduct. The closest equivalent is the common law tort of passing off.

Passing Off

4. The tort of passing off is well established in Singapore under the common law and is the principal means of protecting unregistered product shapes and configurations outside the registered intellectual property regime.

5. The classical formulation from *Reckitt & Colman Products Ltd v Borden Inc* [1990] 1 WLR 491 was endorsed by the Singapore Court of Appeal in *Novelty Pte Ltd v Amanresorts Ltd and Another* [2009] SGCA 13. A claimant must establish three elements:

    a. The claimant must demonstrate that it has accrued goodwill in Singapore in connection with the product shape. The relevant public must recognise the shape as distinctive of the claimant's goods.

    b. The defendant must have made a misrepresentation (whether intentional or otherwise) that has led, or is likely to lead, the public to believe that the defendant's goods are those of the claimant or are connected with or authorised by the claimant.

c. The claimant must show that it has suffered, or is likely to suffer, damage as a result of the misrepresentation.

6. The tort of passing off protects, among other things, a product's "get-up". "Get-up" has been defined as "a capricious addition" to the product or service itself. It includes product shapes and configurations, provided that the shape has acquired distinctiveness and goodwill among the relevant public in Singapore. The claimant must demonstrate that the product shape functions as a badge of origin, that is, that the public associates the shape with the claimant's business, rather than merely with the product type or category.

7. This creates a high evidentiary threshold. The shape must be more than attractive, functional, or descriptive of the product category. It must indicate trade origin. Evidence that may be adduced to establish distinctiveness includes:

    a. Duration and extent of use of the shape in Singapore;
    b. Sales figures and market share;
    c. Advertising and promotional expenditure directed at the shape;
    d. Media coverage and public recognition;
    e. Evidence of actual confusion amongst consumers; and
    f. Consumer survey evidence.

C. Enforceability of product shapes/configurations in Singapore

Copyright Protection

8. As noted above, the industrial application provisions in Part 5 of the CA (the "**Industrial Application Limitations**") severely limit the practical utility of copyright for product shapes and configurations.

9. Sections 270 to 276 of the CA expressly restrict the application of copyright law where an artistic work has a corresponding design, that is, a design[1] that is, has been, or could be applied to articles or products under the Registered Designs Act 2000 ("**RDA**").

10. In particular, section 274 of the CA provides that, where an artistic work has a corresponding design that could have been registered under the RDA but was not, and that design is applied industrially (generally defined as application to 51 or more articles or products,[2] whether in Singapore or elsewhere) with the copyright owner's consent to commercially dealt articles, it becomes a permitted use to do any act that would have fallen within the exclusive rights of the corresponding design had it been registered under the RDA, during the period of 15 years starting from the date of the first commercial dealings in those articles or products.[3]

11. That said, section 274 of the CA is engaged only once the corresponding design has been applied industrially. Until then, the artistic work technically retains full copyright protection. But this protection survives only so long as the design remains unexploited at scale. Once the owner consents to industrial application, section 274 of the CA bars the owner from relying on that copyright to prevent others reproducing the design in articles. Copyright protection is

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[1] A "corresponding design", in relation to an artistic work, refers to a design which, when applied to an article or a non-physical product, results in a reproduction of that work: Section 270 of the CA read with Section 2(1) of the RDA.
2 Regulation 69 of the Copyright Regulations 2021.
[3] Section 274(2)(a) of the CA.

therefore of marginal value for mass-market products, because commercialising them at scale is the very act that ends that protection.

12. The policy is clear: where a work qualifies for protection under both regimes, it should be channelled to the RDA rather than the CA. A significant consequence is that the duration of protection is a maximum of 15 years under the RDA,[4] compared to the life of the author plus 70 years under the CA.[5]

13. The CA provides civil remedies for copyright infringement, including injunctions, damages or an account of profits, delivery up of infringing articles, and statutory damages. Such an action is brought in the General Division of the High Court. The CA also provides for criminal offences relating to certain infringing acts, including making or dealing in infringing copies for commercial purposes, which are punishable by fines, imprisonment or both. In addition, the CA provides that Singapore Customs may seize infringing goods at the border. A copyright owner may apply for border enforcement measures and request that Singapore Customs detain imported goods suspected of infringing copyright.

14. However, as discussed above, the **Industrial Application Limitations** severely restrict enforcement of copyright in product shapes for mass-produced goods. Once the artistic work underlying a product shape has been industrially applied, a claimant will generally be unable to establish copyright infringement based on the manufacture or sale of articles reproducing that shape. In practice, therefore, civil remedies, criminal enforcement and copyright-based border measures are largely unavailable for commercialised product shapes.

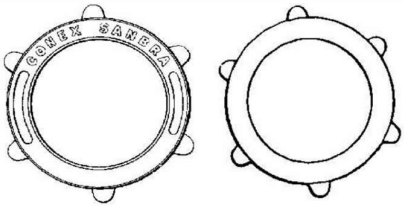
Passing Off

15. Passing off claims based on a product's get-up are generally difficult to establish. A product's get-up is not ordinarily regarded as indicative of trade origin, and the courts exercise considerable caution where it has functional value or comprises the product's shape, colour, or smell.

16. *Nation Fittings (M) Sdn Bhd v Oystertec Plc* [2006] 1 SLR(R) 712 ("***Nation Fittings***") illustrates this difficulty. The claimant sued the defendant for, among other things, passing off, alleging in particular that the defendant had passed off their pipe fittings as the claimant's by adopting the shape of the claimant's own fittings. The claimant failed to establish that the ribbed shape of its pipe fittings was distinctive of its product. The court found that, in the eyes of the relevant public, the shape was functional and did not indicate trade origin. In particular, the court found that: first, average purchasers, plumbers and contractors, would select pipe fittings based on the specifications and attributes required for the job, rather than the product's appearance.[6] Second, the ribbed shape served a significant functional purpose in the trade: the ribs made it easier to tighten the fitting in confined spaces, including where pipes were concealed.[7] Therefore, the court held that the passing off claim failed.

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[4] Section 21(1) of the RDA.
[5] Section 114 of the CA.
[6] *Nation Fittings* at [159].
[7] *Nation Fittings* at [171].

The claimant's registered trade marks	The defendant's pipe fitting
 T81/02113Z ("TM 113") T81/02114H ("TM 114")	

17. Where the product or its packaging bears a trade mark, establishing passing off based on product get-up is even more difficult. Consumers are far more likely to identify and distinguish products by their trade names than by their visual appearance.

18. The decision in *OTO Bodycare Pte Ltd v Hiew Keat Foong* [2005] SGHC 133 ("***OTO Bodycare***") illustrates this point. The claimant's claims included an allegation that the defendant had committed passing off by imitating the design and shape of its machine. In dismissing that claim, the court found that any public confusion about whether the defendant's machine was an OTO product was attributable not to the machine's design and shape, but to the extensive advertising of the OTO name and the defendant's adoption of a mark closely resembling "OTO".[8] The case underscores that, where a well-known trade mark is present, the relevant public is far more likely to associate a product with its name than with its get-up, diminishing any distinctiveness the get-up might otherwise have acquired.

19. Passing off is enforceable through civil proceedings in the Singapore courts, specifically in the General Division of the High Court. Available civil remedies include injunctions restraining the defendant from continuing the passing off, damages, an account of the defendant's profits, delivery up or destruction of infringing goods, and costs.

20. Interim injunctive relief may also be sought on an urgent basis where the claimant can satisfy the requirements of the *American Cyanamid* test.[9]

21. Passing off is the most viable route for civil enforcement of product shape rights during the protection gap, provided that the claimant can establish the requisite goodwill, misrepresentation, and damage.

22. There is no criminal offence of passing off under Singapore law. Passing off is a civil tort only. Accordingly, criminal enforcement is unavailable for passing off, regardless of the scale or deliberateness of the defendant's conduct.

23. Singapore Customs lacks jurisdiction to act on passing off claims. The border enforcement regime under the Trade Marks Act 1998 ("**TMA**") and the CA is tied to registered intellectual property rights rather than common law torts. Accordingly, rights holders relying solely on passing off to protect product shapes cannot use customs border measures to intercept counterfeit goods. This creates a notable enforcement gap before registered rights are secured.

D. Whether and how customs authorities and e-commerce platforms in each jurisdiction can address counterfeiting involving such product shapes/configurations

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[8] *OTO Bodycare* at [87].

[9] The *American Cyanamid* test sets out the threshold for obtaining an interlocutory injunction. The court considers: (1) whether there is a serious question to be tried; (2) whether damages would be an adequate remedy for the applicant; and (3) where the balance of convenience lies between the parties. See *American Cyanamid Co v Ethicon Ltd* [1975] AC 396 (HL).

Customs

24. A registered trade mark owner may file a border enforcement application with Singapore Customs requesting that goods bearing a sign identical with or similar to the registered mark be detained upon importation. This mechanism, however, requires a registered trade mark. If a product shape has not been registered as a three-dimensional trade mark, the rights holder cannot benefit from the regime.

25. This limitation follows from what the term "counterfeit" means under the TMA. A "counterfeit trade mark" is defined by reference to a *registered* trade mark: broadly, a sign identical with a registered mark, or so nearly resembling it as to be calculated to deceive, applied to goods without the proprietor's consent.[10] Goods that copy a product shape not registered as a trade mark therefore cannot be "counterfeit" in this statutory sense.

26. This has a direct effect on the Singapore Customs' powers as Customs lacks jurisdiction to act on passing off claims. The border enforcement regime under the TMA and the CA is tied to registered intellectual property rights (trade marks, copyright, and geographical indications) rather than common law torts.

27. Accordingly, rights holders relying solely on passing off to protect product shapes cannot use customs border measures to intercept goods that incorporate the product shapes.

E-commerce platforms

28. In general, e-commerce platforms do not remove a listing simply based on a complaint founded on passing-off. Where the rights holder has registered the shape or configuration of its product as a trade mark or registered design, it can rely on that registration to submit takedown notices through the platform's intellectual property protection programme. The difficulty arises where there is no such registration. If a third party copies the shape or configuration of a product in respect of which no trade mark or registered design has been obtained, there appears to be no practical way to have the infringing listings taken down through the platform. This is because most platform intellectual property protection programmes in Singapore, such as those run by Shopee and Lazada, require takedown notices to be based on registered rights under their guidelines. Unregistered rights generally fall outside these programmes.

E. What strategic approaches can be taken to protect shapes/configurations once the product has already been commercialised in this manner

Register as a trade mark

29. Under the Trade Marks Act 1998 ("**TMA**"), a three-dimensional shape may be registered as a trade mark if it satisfies the TMA's requirements. A shape that is not inherently distinctive (as is typically the case for product shapes) may nonetheless be registered if it has acquired distinctiveness through use (pursuant to section 7(2) of the TMA).

30. Notably, section 7(3) of the TMA sets out certain absolute grounds for refusal that apply specifically to shape marks:

    a. Shapes which result from the nature of the goods themselves;
    b. Shapes which are necessary to obtain a technical result; and
    c. Shapes which give substantial value to the goods.

31. Registration of a three-dimensional trade mark is a long-term strategy. Rights holders should begin gathering and preserving evidence of acquired distinctiveness from the date of commercialisation, with a view to filing an application once sufficient evidence has accumulated. This may take several years, depending on the nature of the product and the extent of its market presence in Singapore. The evidence of use should also show how the applicant has promoted, referred to or presented the shape, as claimed, to the relevant public in a way that shows it

[10] Section 3(6) of the TMA.

serves as a trade mark, that is, as an indication of trade origin. Further, the mark shown in the evidence of prior use should not depart from the mark as represented in the application. For example, where the shape mark is filed without any accompanying word or figurative elements, but the evidence shows the shape used only together with such elements, the evidence will not establish that the shape itself has acquired distinctiveness.[11]

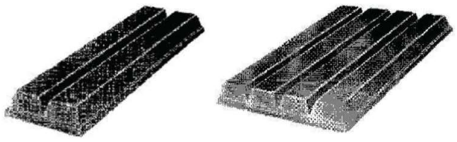
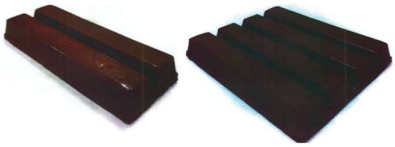
F. Whether difficulties may arise even when enforcing trade mark rights relating to a three-dimensional mark or design rights against imitation of product shapes/configurations, assuming that the rights holder can obtain those rights.

Difficulties enforcing shape marks

32. A successful registration may not necessarily guarantee enduring protection. A shape mark registration remains vulnerable to an invalidation by a third party if the shape, or a substantial part of it, is found to be primarily functional (*i.e.*, necessary to obtain a technical result), under section 7(3)(b) of the TMA. Defendants frequently invoke this defence in infringement proceedings involving three-dimensional marks, and it can be difficult for a rights holder to rebut, especially where the shape is closely linked to the product's function.

33. A shape mark registration may also be invalidated under section 7(1)(b) of the TMA for being "devoid of any distinctive character", although unlike the section 7(3) exclusions, a section 7(1)(b) objection can in principle be overcome: under the proviso in section 7(2), the proprietor can show that the mark has acquired a distinctive character through use. That said, as consumers do not usually treat a shape as a badge of origin, the evidential burden is heavy. Showing that the relevant public recognises the shape, or associates it with the proprietor, is not enough. The proprietor must show that the public has come to rely on the shape itself, independently of any other mark, to identify the origin of the goods.

34. *Societe des Produits Nestle SA v Petra Foods Ltd* [2017] 1 SLR 35 ("***Kit Kat***") illustrates the difficulty in enforcing shape marks. The claimant alleged that the defendant's chocolate bars infringed its registered two-finger and four-finger shape marks. The defendant counterclaimed for invalidation of those registrations on both grounds discussed above: that the shapes were primarily functional under section 7(3)(b) of the TMA, and that they lacked distinctive character under section 7(1)(b) of the TMA.

The claimant's registered shape marks	The defendant's product when unwrapped
 The Two-Finger Mark The Four-Finger Mark	

35. On the first ground, the Court of Appeal held that the registered shape marks were primarily functional and had therefore been registered in breach of section 7(3) of the TMA. In particular, the breaking grooves along the bar, which together with its width determine the number of fingers, served the technical function of allowing the bar to be broken easily into suitably sized portions.[12]

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[11] Intellectual Property Office of Singapore, *Trade Marks Work Manual*, Chapter 3: 'Shape Marks' (November 2022) at 8.3.
[12] *Kit Kat* at [115].

36. On the second ground, the Court of Appeal also upheld the invalidation of the two-finger and four-finger shape marks for being devoid of any distinctive character.[13] The Court observed that consumers generally understand even unusual product designs as intended to make the product more useful or appealing, not to identify its source. While the same test applies to all marks, it may therefore be harder in practice to show that a shape mark is distinctive, especially where it is the shape of the product itself.[14] The key question is whether the average consumer would appreciate the shape's trade mark significance without being educated that it is used for that purpose. A shape that is merely "unusual, new or visually distinctive" does not suffice.[15] Applying this, the Court found that the KIT KAT shapes did not depart significantly from the norms and customs of the chocolate confectionery sector. In any event, there was no evidence that the average consumer perceived them as conveying trade mark significance.[16]

37. The claimant's alternative case, that the shapes had acquired distinctive character through use, also failed. The Court of Appeal held that the evidence adduced by the claimant did not show that the relevant public relied on the registered shape, as opposed to the "KIT KAT" word mark and other brand identifiers, to identify the products' trade origin. At most, the evidence established a "mere association" between the registered shapes and the claimants and/or the "KIT KAT" mark. A key factor was that the shape had never been presented to consumers on its own. The chocolate bar had always been sold in a wrapper bearing the "KIT KAT" logo, and the logo was embossed on the bar itself. Most of the marketing materials likewise showed the bar with the embossed logo, alongside other brand identifiers such as the slogan "Have a break, have a Kit Kat".[17]

Difficulties enforcing design rights

38. Design protection under the Registered Designs Act covers an article's visual appearance (shape, configuration, pattern, and ornament), but does not extend to features of shape or configuration dictated solely by the function the article must perform.[18] Where a product's shape is largely functional, the scope of design protection is narrow because those functional elements must be discounted when assessing infringement.[19]

39. In Singapore, design applications do not undergo substantive examination. Only formality examination is carried out and design applications typically proceed to grant without issue. The trade-off is that registration offers little assurance of validity. As the Registrar does not assess the merits of an application, a registered design remains vulnerable after grant. A defendant in infringement proceedings may challenge its validity, typically on the ground that the design lacked novelty at the filing or priority date. This uncertainty matters because, like any property right, a registered design is only as valuable as the certainty it offers about what has been claimed and taken out of the public domain.

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[13] *Kit Kat* at [34] and [69].
[14] *Kit Kat* at [24].
[15] *Kit Kat* at [33].
[16] *Kit Kat* at [34].
[17] *Kit Kat* at [68].
[18] Section 2(1)(b)(i) of the RDA.
[19] *Hunter Manufacturing Pte Ltd and another v Soundtex Switchgear & Engineering Pte Ltd and another appeal* [1999] 3 SLR(R) 1108 at [69].