

## **ASSIGNMENT**

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**ASSIGNMENT**

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## **1. INTRODUCTION**

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This chapter is concerned with the Registry's practice relating to assignment or transfer of trade mark ownership matters.

## 2. RELEVANT LEGISLATION

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### Trade Marks Act [Cap. 322, 2005 Rev. Ed.]

#### Co-ownership of registered trade mark

**37.—**(1) Where a registered trade mark is granted to 2 or more persons jointly, each of them is entitled, subject to any agreement to the contrary, to an equal undivided share in the registered trade mark.

(2) Subsections (3) to (8) apply where 2 or more persons are co-proprietors of a registered trade mark, by virtue of subsection (1) or otherwise.

(3) Subject to any agreement to the contrary, each co-proprietor is entitled, by himself or his agents, to do for his own benefit and without the consent of or the need to account to the other or others, any act which would otherwise amount to an infringement of the registered trade mark.

(4) One co-proprietor may not, without the consent of the other or others —

...

(b) assign or charge his share in the registered trade mark.

#### Assignment, etc., of registered trade mark

**38.—**(1) A registered trade mark is assignable and transmissible in the same way as other personal or movable property, and is so assignable or transmissible either in connection with the goodwill of a business or independently.

(2) An assignment or transmission of a registered trade mark may be partial, that is, limited so as to apply in relation to some but not all of the goods or services for which the trade mark is registered.

(3) An assignment of a registered trade mark, or an assent relating to a registered trade mark, is not effective unless it is in writing signed by or on behalf of the assignor or, as the case may be, a personal representative.

(4) Subsection (3) may be satisfied in a case where the assignor or personal representative is a body corporate by the affixing of its seal.

(5) Subsections (1) to (4) shall apply to assignment by way of security as they apply to any other assignment.

(6) A registered trade mark may be the subject of a charge in the same way as other personal or movable property.

(7) Nothing in this Act shall be construed as affecting the assignment or transmission of an unregistered trade mark as part of the goodwill of a business.

### **Registration of transactions affecting registered trade mark**

**39.**—(1) On application being made to the Registrar by —

(a) a person claiming to be entitled to an interest in or under a registered trade mark by virtue of a registrable transaction; or

(b) any other person claiming to be affected by such a transaction,

the prescribed particulars of the transaction shall be entered in the register.

(2) The following are registrable transactions under subsection (1):

(a) an assignment of a registered trade mark or any right in it;

...

(d) the making by personal representatives of an assent in relation to a registered trade mark or any right in or under it;

(e) an order of the Court or other competent authority transferring a registered trade mark or any right in or under it.

(3) Until an application has been made for the registration of the prescribed particulars of a registrable transaction referred to in subsection (2)(a), (c), (d) or (e), the transaction is ineffective as against a person acquiring a conflicting interest in or under the registered trade mark in ignorance of the transaction.

(4) A person who becomes the proprietor of a registered trade mark by virtue of any registrable transaction referred to in subsection (2)(a), (c), (d) or (e) is not entitled to damages, an account of profits or statutory damages under section 31(5)(c) in respect of any infringement of the registered trade mark occurring after the date of the transaction and before the date of the application for the registration of the prescribed particulars of the transaction.

### **Trusts and equities**

**40.** — (1) No notice of any implied or constructive trust shall be entered in the register, and the Registrar shall not be affected by any such notice.

(1A) A notice of an express trust or of the beneficiary of an express trust, or both, may be entered in the register; but —

(a) the Registrar shall not be affected by any such notice in the register; and

(b) for the avoidance of doubt, a failure to enter such notice in the register does not affect any rights or duties under the trust.

(2) Subject to the provisions of this Act, equities in respect of a registered trade mark may be enforced in like manner as in respect of other personal or movable property.

### **Application for registration of trade mark as object of property**

**41.** —(1) The provisions of sections 36, 37, 38 and 40 shall apply, with the necessary modifications, in relation to an application for the registration of a trade mark as they apply in relation to a registered trade mark.

...

(3) Any person claiming to be —

- (a) entitled to an interest in or under an application for registration of a trade mark by virtue of a registrable transaction; or
- (b) affected by a registrable transaction,

may give to the Registrar notice of the prescribed particulars of the transaction.

(4) The following are registrable transactions under subsection (3):

- (a) an assignment of an application for registration of a trade mark or any right in it;

...

- (d) the making by personal representatives of an assent in relation to an application for registration of a trade mark or any right in or under it;
- (e) an order of the Court or other competent authority transferring an application for registration of a trade mark or any right in or under it.

(5) The Registrar shall maintain a record of each notice given to him under subsection (3).

(6) Until the notice referred to in subsection (3) has been given to the Registrar in respect of a transaction referred to in subsection (4)(a), (c), (d) or (e), the transaction is ineffective as against a person acquiring a conflicting interest in or under the application for registration of a trade mark in ignorance of the transaction.

### **Registration to be prima facie evidence**

**101.** In all legal proceedings relating to a registered trade mark or any right thereunder (including proceedings for rectification of the register) —

- (a) the register shall be prima facie evidence of anything contained therein;
- (b) the registration of the prescribed particulars of any registrable transaction under section 39 shall be prima facie evidence of the transaction; and

(c) the registration of a person as proprietor of a registered trade mark shall be prima facie evidence of —...

(ii) any subsequent assignment or other transmission of the registration.

## **Second Schedule**

### **Certification Marks**

#### **Consent to assignment of registered certification mark**

**12.** The assignment or other transmission of a registered certification mark is not effective without the consent of the Registrar.

## **Third Schedule**

### **Transitional Provisions**

#### **Existing registered marks**

**2.—(4)** In any other case, any note indicating that an existing registered mark is associated with any other mark shall cease to have effect on 15th January 1999.

**3.—(1)** A condition entered in the register kept under the repealed Act in relation to an existing registered mark immediately before 15<sup>th</sup> January 1999 shall cease to have effect on that date.

#### **Assignment, etc., of registered mark**

**8.—(1)** Section 38 of this Act shall apply to transactions and events occurring after 15th January 1999 in relation to an existing registered mark; and the old law continues to apply in relation to transactions and events occurring before that date.

(2) Entries in the register kept under the repealed Act relating to the assignment of registered trade marks and of the benefits of applications for registration of trade marks shall be deemed to be transferred on 15th January 1999 to the register kept under this Act and have effect as if made under section 39 of this Act.

(3) Provision may be made by rules for putting entries referred to in sub-paragraph (2) in the same form as is required for entries made under this Act.

(4) An application for registration of an assignment of a registered trade mark or of an assignment of the benefits of an application for registration of a trade mark, made to the Registrar before 15th January 1999, shall be treated as an application for registration under section 39 of this Act and shall proceed accordingly.

(5) The Registrar may require the applicant to amend his application so as to conform with the requirements of this Act.



(6) An application for registration under section 43 of the repealed Act which has been determined by the Registrar but not finally determined before 15th January 1999 shall be dealt with under the old law; and sub-paragraphs (2) and (3) shall apply in relation to any resulting entry in the register.

(7) Where before 15th January 1999 a person has become entitled by assignment or transmission to an existing registered mark but has not registered his title, any application for registration after that date shall be made under section 39 of this Act.

(8) In cases to which sub-paragraph (4) or (7) applies, section 43 (2) of the repealed Act continues to apply (and section 39(3) and (4) of this Act do not apply) as regards the consequences of failing to register.

## **Trade Marks Rules**

### **Signature on documents**

**6.**—(1) A document to be signed for or on behalf of a partnership shall contain the names of all the partners in full and shall be signed by —

- (a) all the partners;
- (b) any partner stating that he signs on behalf of the partnership; or
- (c) any other person who satisfies the Registrar that he is authorised to sign the document on behalf of the partnership.

(2) A document to be signed for or on behalf of a body corporate shall be signed by a director, the secretary or other principal officer of the body corporate, or by any other person who satisfies the Registrar that he is authorised to sign the document on behalf of the body corporate.

(3) A document to be signed by or on behalf of an unincorporated body or association of persons may be signed by any person who appears to the Registrar to be qualified to so sign.

(4) For the purposes of this rule, “document” means a document to be given or sent to, filed with or served on the Registrar in respect of any matter under the Act or these Rules.

### **Address for service**

**9.**—(4)

- (j) where an applicant for the registration of a change in the ownership of a registered trade mark furnishes an address for service in Form CM8, the address for service may, at the option of the applicant, be effective —

- (i) for the purposes of all proceedings in respect of the trade mark, including the application for the registration of the trade mark; or
- (ii) only for the purposes of the registration of the change in the ownership of the registered trade mark, in which case the applicant must furnish another address for service for all other proceedings in respect of the trade mark, including the application for the registration of the trade mark, on a separate Form CM8.

### **Entry in register of particulars of registrable transactions**

**54.**—(1) The prescribed particulars of a transaction to which section 39 of the Act applies to be entered in the register are —

- (a) in the case of an assignment of a registered trade mark or any right in it —
  - (i) the name and address of the subsequent proprietor;
  - (ii) the date of the assignment; and
  - (iii) where the assignment is in respect of any right in the trade mark, a description of the right assigned;—
- ...
- (d) in the case of the making by personal representatives of an assent in relation to a registered trade mark or any right in or under it —
  - (i) the name and address of the person in whom the trade mark or any right in or under it vests by virtue of an assent; and
  - (ii) the date of the assent; and
- (e) in the case of an order of the Court or other competent authority transferring a registered trade mark or any right in or under it —
  - (i) the name and address of the transferee;
  - (ii) the date of the order; and
  - (iii) where the transfer is in respect of a right in the trade mark, a description of the right transferred.

(2) In each of the cases mentioned in paragraph (1), there shall be entered in the register the date on which the entry is made.

### **Application to register or give notice of transaction**

**55.**—(1) An application to register particulars of a transaction to which section 39 of the Act applies shall be made, and a notice to be given to the Registrar of particulars of a transaction to which section 41 of the Act applies shall be —

- (a) in the case of any assignment or transaction other than a transaction referred to in sub-paragraphs (b) and (c), in Form CM8;
- ...
- (d) in the case of the making by personal representatives of an assent in relation to a registered trade mark, an application for registration of a trade mark, or any right

in or under a registered trade mark or an application for registration of a trade mark, by way of a written request; or

- (e) in the case of an order of the Court or any other competent authority transferring a registered trade mark, an application for registration of a trade mark, or any right in or under a registered trade mark or an application for registration of a trade mark, by way of a written request accompanied by a copy of the order.

(2) Where an application under paragraph (1) is filed other than by means of the electronic online system, the application shall be —

- (a) signed by or on behalf of all the parties to the assignment or transaction, in the case of an assignment or transaction referred to in paragraph (1)(a);
- (b) signed by or on behalf of the personal representative, in the case of the making by a personal representative of an assent referred to in paragraph (1)(d);
- (c) accompanied by any documentary evidence which in the Registrar's view is sufficient to establish the transaction, in the case of an order of the Court or other competent authority referred to in paragraph (1)(e)

(3) Where an application under paragraph (1) is filed by means of the electronic online system, the application shall be authorised by all relevant parties and be validated by such means as the Registrar considers fit.

(3A) Where an application under paragraph (1) is not signed in accordance with paragraph (2)(a), (b) or (d), or not authorised and validated in accordance with paragraph (3), the application shall be accompanied —

- (a) in the case of an assignment (of a registered trade mark or an application for registration of a trade mark) referred to in paragraph (1)(a), at the option of the applicant, by —
  - (i) a copy of the contract of assignment;
  - (ii) an extract of the contract of assignment, being an extract which shows the change in the ownership of the registered trade mark or application for registration;
  - (iii) a certificate of transfer of the registered trade mark or application for registration in such form as the Registrar may require, being a certificate signed by all parties to the assignment;
  - (iv) a transfer document relating to the registered trade mark or application for registration in such form as the Registrar may require, being a document signed by all parties to the assignment; or
  - (v) a copy of any documentary evidence which in the Registrar's view is sufficient to establish the assignment; —...

(d) in any other case, by a copy of any documentary evidence which in the Registrar's view is sufficient to establish the transaction.

(3B) Where an application under paragraph (1) is filed by means of the electronic online system, the document referred to in paragraph (3A)(a)(i), (ii), (iii), (iv) or (v) shall be filed within such time as the Registrar may specify.

(3C) The Registrar shall refuse to accept an application under paragraph (1) if paragraph (2), (3), (3A) or (3B) is not complied with and in such event, the Registrar may require a fresh application to be made.

(5) The Registrar may require the applicant to furnish such other document, instrument and information in support of the application as the Registrar thinks fit, within such time as the Registrar may specify.

## **Trade Marks (International Registration) Rules**

### **Notification of transactions**

**8.**—(1) The following are notifiable transactions for the purpose of this rule:

...

- (b) an order of the Court or other competent authority transferring –
  - (i) a protected international trade mark (Singapore)
  - (ii) an international registration designating Singapore; or
  - (iii) any right in or under a protected trade mark (Singapore) or an international registration designating Singapore;

(2) On application being made to the Registrar by —

- (a) a person claiming to be entitled to an interest in or under a protected international trade mark (Singapore) or an international registration designating Singapore by virtue of a notifiable transaction; or
- (b) any other person claiming to be affected by such a transaction,

the relevant particulars of the transaction shall be entered in the register.

(3) The following are relevant transactions for the purpose of this rule:

- (a) an assignment of –
  - (i) a protected international trade mark (Singapore);
  - (ii) an international registration designating Singapore; or
  - (iii) any right in a protected international trade mark (Singapore) or an international registration designating Singapore;

- (b) the making by personal representatives of an assent (other than an assent to a license) in relation to –
  - (i) a protected international trade mark (Singapore);
  - (ii) an international registration designating Singapore; or
  - (iii) any right in or under a protected international trade mark (Singapore) or an international registration designating Singapore;

...

- (4) Until —
  - (a) in the case of any notifiable transaction referred to in paragraph (1) (b), an application has been made for the registration of the relevant particulars of the transaction; or
  - (b) in the case of any relevant transaction, the transaction has been recorded in the International Register,  
the transaction is ineffective as against a person acquiring an interest in or under the protected international trade mark (Singapore) or the international registration designating Singapore in ignorance of the transaction.

(5) A person who becomes the proprietor of a protected international trade mark (Singapore) or an international registration designating Singapore by virtue of a notifiable transaction mentioned in paragraph (1)(b) or relevant transaction is not entitled to damages, an account of profits or statutory damages under section 31(5)(c) of the Act in respect of any infringement of the protected international trade mark (Singapore) or the international registration designating Singapore occurring –

- (a) after the date of the transaction and before the date of the application for the registration of the relevant particulars of the notifiable transaction, or
- (b) after the date of the transaction and before the relevant transaction is recorded in the International Register,

as the case may be.

(6) In this rule, “relevant particulars” means –

...

- (b) in relation to a notifiable transaction mentioned in paragraph 1(b) –
  - (i) the name and address of the transferee;
  - (ii) the date of the order; and
  - (iii) where the transfer is in respect of a right in or under a protected international trade mark (Singapore) or an international registration designating Singapore, a description of the right transferred.

**Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks (Adopted at Madrid on June 27, 1989, as amended on October 3, 2006, and on November 12, 2007)**

**Article 2 - Securing Protection through International Registration**

- (1) Where an application for the registration of a mark has been filed with the Office of a Contracting Party, or where a mark has been registered in the register of the Office of a Contracting Party, the person in whose name that application (hereinafter referred to as “the basic application”) or that registration (hereinafter referred to as “the basic registration”) stands may, subject to the provisions of this Protocol, secure protection for his mark in the territory of the Contracting Parties, by obtaining the registration of that mark in the register of the International Bureau of the World Intellectual Property Organization (hereinafter referred to as “the international registration,” “the International Register,” “the International Bureau” and “the Organization,” respectively), provided that,
- (i) where the basic application has been filed with the Office of a Contracting State or where the basic registration has been made by such an Office, the person in whose name that application or registration stands is a national of that Contracting State, or is domiciled, or has a real and effective industrial or commercial establishment, in the said Contracting State,
  - (ii) where the basic application has been filed with the Office of a Contracting Organization or where the basic registration has been made by such an Office, the person in whose name that application or registration stands is a national of a State member of that Contracting Organization, or is domiciled, or has a real and effective industrial or commercial establishment, in the territory of the said Contracting Organization.

...

**Article 9 - Recordal of Change in the Ownership of an International Registration**

At the request of the person in whose name the international registration stands, or at the request of an interested Office made ex officio or at the request of an interested person, the International Bureau shall record in the International Register any change in the ownership of that registration, in respect of all or some of the Contracting Parties in whose territories the said registration has effect and in respect of all or some of the goods and services listed in the registration, provided that the new holder is a person who, under Article 2(1), is entitled to file international applications.

**Article 9ter - Fees for Certain Recordals**

Any recordal under Article 9 or under Article 9bis may be subject to the payment of a fee.

**Regulations under the Protocol relating to the Madrid Agreement Concerning the International Registration of Marks (as in force on February 1, 2020)**

**Rule 25 - Request for Recording**

(1) *[Presentation of the Request]*

- (a) A request for recording shall be presented to the International Bureau on the relevant official form where the request relates to any of the following:
  - (i) a change in the ownership of the international registration in respect of all or some of the goods and services and all or some of the designated Contracting Parties;
  - ...
  - (b) The request shall be presented by the holder or by the Office of the Contracting Party of the holder; however the request for the recording of a change in ownership may be presented through the Office of the Contracting Party, or of one of the Contracting Parties, indicated in the said request in accordance with paragraph (2)(a)(iv).
  - ...
  - (d) Where the request is presented by the holder, it shall be signed by the holder. Where it is presented by an Office, it shall be signed by that Office and, where the Office so requires, also by the holder. Where it is presented by an Office and that Office, without requiring that the holder also sign it, allows that the holder also sign it, the holder may do so.

(2) *[Contents of the Request]*

- (a) A request under paragraph (1)(a) shall, in addition to the requested recording, contain or indicate
  - (i) the number of the international registration concerned,
  - (ii) the name of the holder or the name of the representative where the change relates to the name or address of the representative,
  - (iii) in the case of a change in the ownership of the international registration, the name and address, given in accordance with the Administrative Instructions, of the natural person or legal entity mentioned in the request as the new holder of the international registration (hereinafter referred to as "the transferee"),
  - (iv) in the case of a change in the ownership of the international registration, the Contracting Party or Parties in respect of which the transferee fulfills the conditions under Article 2 of the Protocol to be the holder of an international registration,

- (v) in the case of a change in the ownership of the international registration, where the address of the transferee given in accordance with item (iii) is not in the territory of the Contracting Party, or of one of the Contracting Parties, given in accordance with item (iv), and unless the transferee has indicated to be a national of a Contracting State or of a State member of a Contracting Organization, the address of the establishment, or the domicile, of the transferee in the Contracting Party, or in one of the Contracting Parties, in respect of which the transferee fulfills the conditions to be the holder of an international registration,
  - (vi) in the case of a change in the ownership of the international registration that does not relate to all the goods and services and to all the designated Contracting Parties, the goods and services and the designated Contracting Parties to which the change in ownership relates, and
  - (vii) the amount of the fees being paid and the method of payment, or instructions to debit the required amount of fees to an account opened with the International Bureau, and the identification of the party effecting the payment or giving the instructions.
- (b) The request for the recording of a change in the ownership of the international registration may also contain,
- (i) where the transferee is a natural person, an indication of the State of which the transferee is a national;
  - (ii) where the transferee is a legal entity, indications concerning the legal nature of that legal entity and the State, and, where applicable, the territorial unit within that State, under the law of which the said legal entity has been organized.
- (c) The request for recording of a change or a cancellation may also contain a request that it be recorded before, or after, the recording of another change or cancellation or a subsequent designation in respect of the international registration concerned or after the renewal of the international registration.
- ...
- (4) [*Several Transferees*] Where the request for the recording of a change in the ownership of the international registration mentions several transferees, each of them must fulfill the conditions under Article 2 of the Madrid Protocol to be holder of the international registration.



### 3. BACKGROUND

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A registered trade mark or application for registration of a trade mark or any right in it, is assignable and transmissible in the same way as other personal or movable property. An “Assignor” (or “Current Proprietor”) is the person who makes an assignment and an “Assignee” (or “Subsequent Proprietor”) is the person to whom an assignment is made. The assignment (or “change in ownership”) of a trade mark may relate to all the goods and services covered by the mark, or to some of the goods and services.

While it is not compulsory for parties to record changes in ownership, it is important for new assignees to update the Register when there is a change of ownership. Any delay in recording of the prescribed particulars of the transaction may also affect the assignee’s rights to claim damages, account of profits and statutory damages in the event of trade mark infringement.

#### Assignment of Singapore registered trade mark, or an application for a Singapore registered trade mark

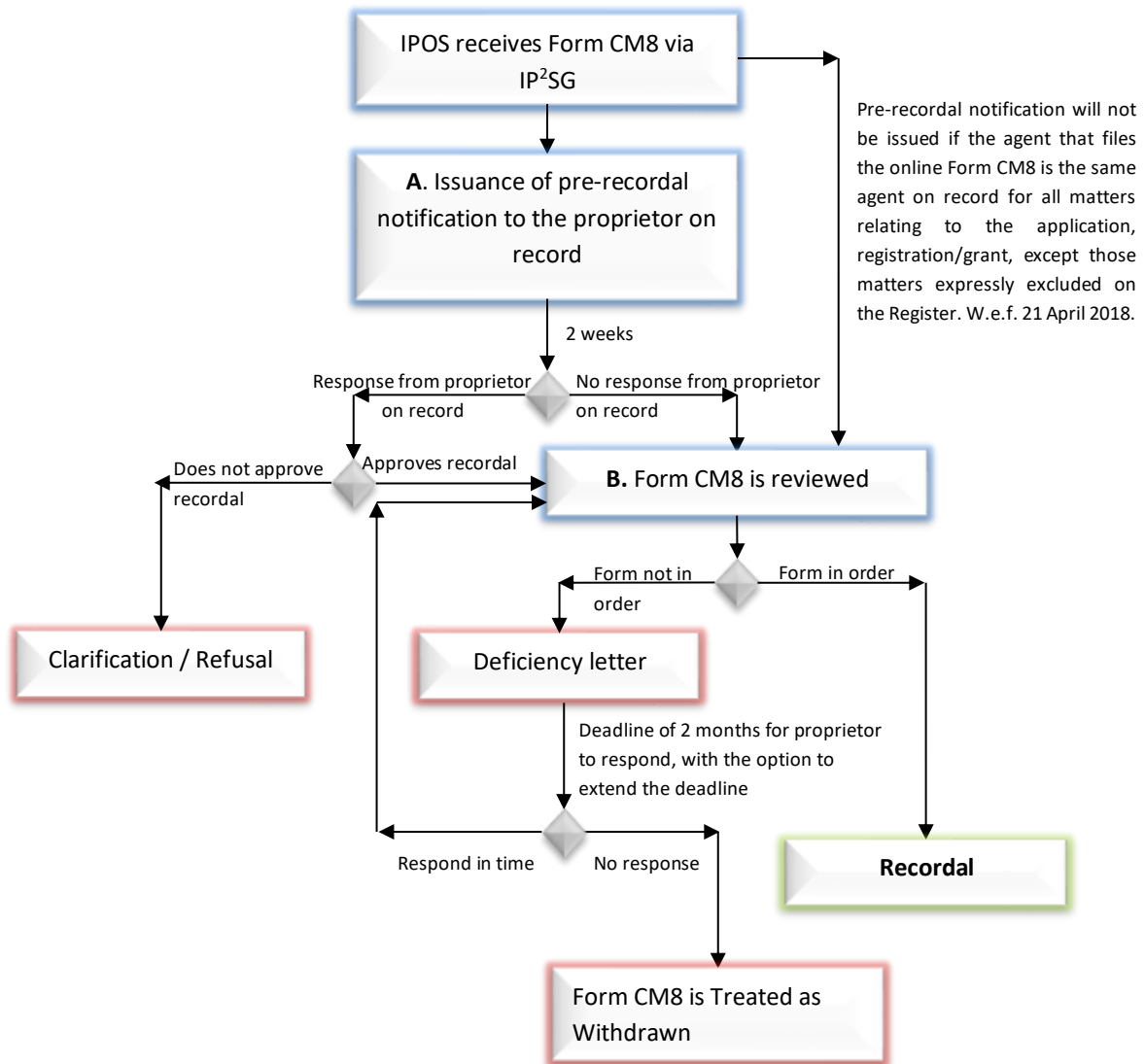
- An application to record an assignment for a Singapore registered trade mark, or an application for a Singapore registered trade mark is to be made on Form CM8.

#### International Registrations (“IR”) designating Singapore filed under the Madrid Protocol

- Requests for recordal of assignments for IRs are strongly encouraged to be presented to the International Bureau of the World Intellectual Property Organization (WIPO) directly by the holder (or his recorded representative) on WIPO’s official Form MM5(E) to avoid any delay which may affect your right to damages or account of profits in respect of infringements. Form MM5(E) is available for download at <http://www.wipo.int/madrid/en/forms/>.

For more information on the Madrid Protocol and International Registrations please refer to “Chapter 19 - International registrations / Subsequent designations designating Singapore” of the Trade Marks Work Manual.

**4. PROCEDURES AND TIMELINES FOR FORM CM8**



**4.1 Lodgement of Form CM8 with the requisite fee via IP2SG**

An applicant (i.e. the current proprietor or subsequent proprietor) or their agent should request to record an assignment of a trade mark by filing Form CM8 (Application to Register Transfer of Ownership) online at <https://ip2sg.ipos.gov.sg>. The filing fee for Form CM8 is \$70 in respect of each trade mark number.

## **A. PRE-RECORDAL NOTIFICATION**

Upon receipt of an application to record an assignment, the Registry will send a pre-recordal notification to the current proprietor on record (or his agent for all matters relating to the application, registration/grant, except those matters expressly excluded on the Register), of the trade mark to be assigned. This notification serves to inform the proprietor that an application to record an assignment in respect of his trade mark has been filed with the Registry, providing the proprietor with the opportunity to object to the assignment if it was not so authorised by him.

If the Registry does not receive any objection from the current proprietor or his agent within the time prescribed in the notification, the Registrar will proceed to review the assignment recordal application.

In the event where the current proprietor objects to the application to record the assignment, the Registry will issue a letter to the applicant seeking the assignment (or his agent, if any) to seek clarification, giving the applicant two months to respond. Thereafter, the Registry will only proceed to process the application if it has received a written authorisation from the current proprietor on record.

To expedite the application process, the current proprietor may reply to our pre-recordal notification via IP<sup>2</sup>SG (and quoting the IPOS reference number indicated on the pre-recordal notification) to confirm his authorisation to the application to record the assignment.

With effect from 21 April 2018, IPOS will cease the sending of pre-recordal notifications if the agent that files the online Form CM8 is the same agent on record for all matters relating to the application, registration/grant, except those matters expressly excluded on the Register.

## **B. PROCESSING OF FORM CM8**

Where the request for assignment under Form CM8 meets the requirements for recordal, the Registry will proceed to record the change of ownership on the Register. A notice will be sent to the applicant who sought the assignment recordal once the Registry approves the assignment recordal application.

Where the request for assignment under Form CM8 does not meet the requirements for recordal, the Registrar may issue a deficiency letter the grounds of refusal and/or the additional information required. The applicant will be given two months to respond to the deficiency letter. As directed by the Registrar, the applicant may be required to provide a written response via IP<sup>2</sup>SG clarifying the matter or through CM4 (Request for Correction of Error) at S\$50 to correct the error(s) in the Form CM8.

Applicants will be notified of the outcome the application through IP<sup>2</sup>SG within 2.5 months from the date of receipt of the application.

*EXTENSION OF TIME*

If the applicant is unable to reply within two months, he may request for an extension of time via Form CM5 (Request for Extension of Time; no charge for first and second filing, S\$50 for third and subsequent filing) via IP<sup>2</sup>SG before the expiry of the deadline. Please note that cogent reasons would be required for the third and subsequent request for extension of time before the extension is granted.

## 5. FILING GUIDE FOR ONLINE FORM CM8

### Step 1: Insert TM No.

- Insert the TM no. to be transferred in Part 2.<sup>1</sup>
- Each Form CM8 can accommodate up to 50 marks (owned by same proprietor). Please file a second Form CM8 if there are more than that.

### Step 2: Insert details of Assignor and Assignee

- The assignor could be the current proprietor on record and the assignee could be the subsequent proprietor; or
- In the case of multi-step recordals, the assignee of a preceding assignment or the assignor of a subsequent assignment

### Step 3: Select person making the request

- Part 6: Please note that the “requestor (interested party other than current or subsequent proprietor) does not refer to an agent who is filing this form on behalf of his/her client.
- Tax invoice will be issued to the entity or individual as selected in Part 6B.

### Step 4: Select Full/Partial transfer

- Full transfer: If all goods and/or services are to be transferred; or
- Partial Transfer: If the assignment does not apply to all the goods/services, clearly demarcate the goods or services for each trade mark.

### Step 5: Insert Effective Date

- The Effective date (or “date of transfer of ownership”) is when the subsequent proprietor took ownership of a trade mark.
- Effective date cannot be earlier than the trade mark application’s filing date.

### Step 6: Contact details – Select Option A/B

- **Option ‘A’:** All official correspondences concerning the trade marks listed in the CM8 for all matters including assignment and renewal will be sent electronically via IP<sup>2</sup>SG
- **Option ‘B’:** All official correspondences relating to the particular assignment will be sent electronically via IP<sup>2</sup>SG account. Complete Part 14.

### Step 7: Validation/Evidence

- Select “Validation” if the assignment has been duly authorised by all relevant parties; or
- Select “Documentary Evidence” and upload the file. Refer to 5(b) on the following page for more information.

### Step 8: Additional Details and Payment

- Submit and payment by eNETs Credit/Debit card/GIRO
- Hear from us soon!

<sup>1</sup> Each entity/individual on record is tagged with a Unique Entity Number (UEN)/Company Code identifier. However, an entity/individual may have multiple UEN/Company Code identifiers if there are slight variations to the name and/or address. When trade mark application numbers with different UEN/Company Codes are inserted in Part 2 of the Form CM8, the following error message will appear: “Part 2 Application No. – This IP No. belongs to a current applicant/proprietor that is different from the IP No(s). keyed in earlier. Please check, and/or file a separate application form”. The user may contact our officer at +65 6339 8616 to request for the consolidation of the multiple UEN/Company Codes to a single identifier. Otherwise, the user may file separate Form CM8.

## **5.1 Address for service (AFS)**

The address for service (AFS) entered in Part 10, (if option ‘A’ of the Form CM8 is selected) will be taken as the contact details for the subsequent proprietor. Thus, other than for situations stated in paragraph 5.1.1 of this guide, Form CM1 (Request to appoint, change or remove an agent) or CM2 (Request to Change Name, Address and Singapore Address for Service of Agent, Applicant, Proprietor or Other Interested Persons) will not be required in general.

### **5.1.1 When is Form CM1/CM2 required?**

Form CM1 will be required when a new agent is appointed for renewal and/or all matters relating to the application(s)/registration(s) after Form CM8 is approved. In other words, the new agent as indicated in Form CM1 (and not the agent as indicated in the Form CM8) will receive official correspondence for the proprietor electronically via their IP<sup>2</sup>SG account.

Form CM2 will be required when there is a change in the subsequent proprietor’s AFS after Form CM8 is approved. In other words, the subsequent proprietor of the Form CM8 will receive official correspondence electronically via their IP<sup>2</sup>SG account.

## **5.2 Validation / Supporting documents**

### **5.2.1 Validation**

If the applicant seeking the assignment is duly authorised by all relevant parties to record the assignment, he may select the ‘validation’ option in the online Form CM8. Documentary evidence would not be required<sup>2</sup>.

### **5.2.2 Documentary evidence / Assignment agreements**

If the online Form CM8 is not submitted via ‘validation’ option, the form shall be accompanied with either of the following<sup>3</sup>:

- i. A copy of the contract of assignment; or
- ii. An extract of the contract of assignment, which shows the change in the ownership of the registered trade mark or application for registration; or

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<sup>2</sup> In such case, while the Registrar does not require the documentary evidence to be furnished, please be reminded that Form CM8 is not a substitute for an assignment agreement.

<sup>3</sup> An electronic copy of the documentary evidence should be attached to the form at Part 13.

- iii. A certificate of transfer of the registered trade mark or application for registration in such form as the Registrar may require, being a certificate signed by all parties to the assignment; or
- iv. A transfer document relating to the registered trade mark or application for registration in such form as the Registrar may require, being a document signed by all parties to the assignment; or
- v. A copy of any documentary evidence which in the Registrar's view is sufficient to establish the assignment.

### **5.2.3 Requirements of an assignment agreement**

As a general guide, an assignment agreement shall contain the following:

- i. The trade mark number(s) being assigned;
- ii. Assignor and assignee's names and addresses;
- iii. The date of the assignment;
- iv. (Where the assignment is made by an agreement) The consideration of the assignment;
- v. (Where the assignment is made by deed) The words "signed, sealed and delivered"<sup>4</sup>;
- vi. Names, designations and signatures of the assignor and the assignee (or their personal representatives, if applicable).

The documentary evidence should substantiate the content of the online Form CM8. If such documentary evidence furnished is found to be deficient or inconsistent with the details on Form CM8, the Registrar may issue a deficiency letter to the applicant seeking the assignment to seek clarification.

To assist users, a sample assignment agreement is attached in Page 44 of this chapter.

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<sup>4</sup> The Registry will also accept a deed of assignment which is not sealed, if consideration is provided for.

#### **5.2.4 Amendment to the assignment agreement**

Amendment(s) made to the original document(s) must be countersigned by the relevant parties. If the original documents evidencing assignment are unavailable despite the parties' best efforts, the assignor and assignee may amend on a certified true copy of the documentary evidence, accompanied with statutory declaration (SD) confirming that the loss of the original document.

The Registrar may exercise his discretion to accept such amended documents which in his view is sufficient to establish the assignment.

#### **5.2.5 Translations of documents not in the English language**

The Registry will accept submissions of documentary evidence which are not in the English language only if it is accompanied by a certified English translation<sup>5</sup>.

The Registry may also accept certified translations from persons who are not professional translators if the following conditions are met:

- i. The name and designation of the translator is stated in the document;
- ii. A declaration by the translator that he or she is proficient in the English language and the language which is used in the documentary evidence;
- iii. A declaration by the translator that the translation provided is true, accurate and complete; and
- iv. The translation is signed by the translator.

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<sup>5</sup> A certified translation refers to a translation which is certified by a professional translator or a translation company.



## 6. PARTIAL ASSIGNMENT

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A registered trade mark, or an application for registration of a trade mark, can be partially assigned/transferred by the assignor to the assignee.

In other words, the assignment or transfer of trade mark ownership may apply to some of the goods, services or right in respect of which the trade mark is registered or applied for.

Where a partial assignment is sought, the goods or services which are to be assigned should be clearly demarcated from the goods or services which will not be assigned with no overlap. This also means that the combined scope of protection of the marks belonging to the resultant assignee(s) (also known as the “Child Marks”) should not exceed that of the original scope of protection of the mark to be assigned (also known as the “Parent Mark”).

After the recordal of the partial assignment, the Parent Mark would bear the status “Split (Partially Assigned)”. The Child Marks will take on the trade mark number of the Parent Mark with a dual-digit suffix extension (e.g. “-01”, “-02” and etc.). The status of the Child Marks will inherit the status of the Parent Mark prior to the partial assignment.

Please refer to illustration below.

	<b>Prior to partial assignment</b>	<b>After partial assignment</b>	
	<i>‘Parent Mark’</i>	<i>‘Child Mark’ 1</i>	<i>‘Child Mark’ 2</i>
<b>TM Number</b>	40201600001A	40201600001A-01	40201600001A-02
<b>Status</b>	Registered	Registered	Registered
<b>Goods</b>	Computer software; computer hardware; cables	Computer software	Computer hardware; cables

Each partially assigned Child Mark will retain the following details of the Parent Mark:

- Filing date;
- Expiration/Renewal date; and
- All clauses, limitations or claims to an interest in or right, in respect to the relevant classes being assigned.

If the Child Marks are pending, each Child Mark will be examined, advertised and registered independently of each other.

If the Child Marks are registered, prior to their expiry, the Registry will send a reminder letters to the assignee(s)/agents of the Child Marks, notifying them of the date of expiry of the registration.

## 7. PARTICULARS OF THE ASSIGNMENT ENTERED IN THE REGISTER

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When the assignment or change of ownership is successfully recorded, the following details are entered in the Register:

- The assignee's name and address;
- An indication of whether the assignment is full or partial;
- Where it is a partial assignment, the description of goods and/or services which have been assigned;
- The contact details of the assignee (or his agent, if applicable);
- The date of assignment (i.e. effective date);
- The date of lodgement of Form CM8;
- The date of entry of the recordal of assignment in the Register; and
- Where it is an assignment of any right in the trade mark, a description of the right assigned.

After the assignment has been recorded, in the case of a registered mark, the registration certificate which was previously issued to the previous proprietor will not be re-generated to be updated with the subsequent proprietor's details. This is because registration certificates are intended to reflect the details of the registration at the moment in which the trade mark is registered.

Nevertheless, the assignee (also known as the subsequent proprietor, or his agent, if any) may request for a *certified copy of the prevailing application or registration* via Form CM12 (Request for Certified Copy of Entry in Register or Certified Extract from Register / Request for Certified Document Relating to Patent or Application for Patent).

The certified copy of the prevailing application/registration will reflect the ownership of the trade mark(s) is now under the name of the assignee(s). The certified copy also contains other essential information of the mark, for example, the trade mark number, mark representation, filing date, specification of goods and/or services, application type and mark clauses (if any).

## 8. CHANGE OF BUSINESS CONSTITUTION AND OWNERSHIP AS DISTINCT FROM CHANGE OF NAME

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Where a corporate proprietor undergoes a change of business constitution or ownership structure, the Registry considers that a new entity has been formed, and the marks belonging to the proprietor should be assigned to the new entity to reflect the change of ownership of those mark(s).

This is distinct from the situation where a corporate proprietor undergoes a mere change of name, with no change to its business constitution or ownership structure. Where there is a change to the name of the proprietor, Form CM2 (Request to change name, address and Singapore address for service of agent, applicant, proprietor or other interested person) should be lodged to change the relevant details of the marks belonging to such proprietor.

The table below sets out some examples (not exhaustive) where filing of Form CM8 is required.

	<p><b>Transfer of ownership of a trade mark application</b> (e.g. “ABC Pte Ltd” transfers ownership of trade mark application/registration to “XYZ Pte Ltd”)</p>
	<p><b>Change in business constitution</b> (e.g., “ABC LLP” becomes “ABC Pte Ltd”)</p>
	<p><b>Addition or removal of partners in a partnership</b> (e.g., “Jonathan Low, Timothy Tan” to “John Low, Timothy Tan, Alvin Chan”)</p>
	<p><b>Merger and Division</b> (e.g., Merger of “Kelly Corporation” and “BAC Corporation” to “Kelly Corporation”)</p>
	<p><b>Sole proprietorship to partnership and vice versa</b> (e.g., “Jonathan Low, Timonthy Tan” to “Jonathan Low”)</p>
	<p><b>Reincorporation of business entity in a new country</b> (e.g., ABC Ltd in Singapore becomes ABC Ltd in France)</p>
	<p><b>Reincorporation of business entity in another States (applicable for United States of America)</b> (e.g., ABC Ltd in Delaware, USA becomes ABC Ltd in California, USA)</p>

Whether there is a change in business constitution or legal entity depends on the laws of the country where the proprietor company is incorporated.

## 9. CO-OWNERSHIP / PARTNERSHIP / SOLE PROPRIETORSHIP

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### 9.1 Co-ownership of a registered trade mark

A registered trade mark can be granted to two or more persons jointly, each person being known as a “co-proprietor”. Each co-proprietor is entitled to an equal undivided share in the mark, subject to any agreement to the contrary.

Subject to any agreement to the contrary, while each co-proprietor is entitled, by himself or his agents, to use or exploit the registered mark, a co-proprietor cannot assign his share in the mark without the consent of the other co-proprietor(s).

#### **Death of a co-proprietor**

In the event of a death of a co-proprietor, the equal undivided share in the registered trade mark passes to his estate.

If such share is intended to be dealt with, for example to transfer the deceased co-owner’s share to the other co-proprietors(s) or to some other person or entity, an assent from the personal representative(s) of the deceased is required.

The particulars of the assent shall be registered by way of a written request and submitted together with the relevant documents proving the capacity of the personal representative(s), for example, a letter of administration or grant of probate.

The effective date of transfer would be the date as indicated on the written request or the issuance date of a letter of administration or grant of probate, whichever is applicable.

Refer to [here](#) for a sample template for registering particulars of assent.

### 9.2 Partnership

For trade marks that belong to a partnership<sup>6</sup>, the ownership of such trade marks among the partners is determined in accordance with the partnership agreement.

Subject to any agreement between the partners, where no fixed term has been agreed upon for the duration of the partnership, a partnership is dissolved if a partner retires from the partnership, and a new partnership must be formed.

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<sup>6</sup> For the definition of “partnership”, please refer to the Partnership Act (Cap. 391). Briefly, a “partnership” is a relation between persons carrying on a business with a view to profit, and exclude a company registered under the Companies Act (Cap. 50) or any association formed or incorporated by any statute or law.

In such case, the trade marks belonging to the former partnership shall be assigned to the new partnership formed.

The supporting documentary evidence, if any, is to be signed by all the partners. It may also be signed by a partner stating that he signs on the partnership's behalf or signed by someone authorised to sign on the partnership's behalf.

#### **Death of a partner**

Subject to any agreement between the partners, the partnership will dissolve in the event of a death of a partner, and a new partnership must be formed.

In such case, the trade marks belonging to the former partnership shall be assigned to the new partnership formed.

### **9.3 Sole Proprietorship**

A sole proprietorship is not considered separate and distinct from the individual running the sole proprietorship. In other words, a trade mark which is owned by the sole proprietorship is in fact owned by the individual running the sole proprietorship.

Trade mark applications for sole proprietors are recorded in the name of the sole proprietor trading under a trade name (e.g. "Peter Tan trading as Priser & Tan").

Therefore, where there is a change to the name of the sole proprietorship, in other words, a change to the trade name for sole proprietors (e.g. "Peter Tan trading as Tommy & Tan" to "Peter Tan trading as Tommy Lee & Tan" or "Peter Tan"), no assignment has taken place. Such change may be recorded using Form CM2 (Request to change name, address and Singapore address for service of agent, applicant, proprietor or other interested person) via IP<sup>2</sup>SG.

#### **Death of sole proprietor**

In the event of a death of a sole proprietor, the ownership of the registered trade mark passes to his estate.

If such registered mark is intended to be dealt with, for example to transfer the mark to another person or entity, an assent from the personal representatives of the deceased is required.

The particulars of the assent shall be registered by way of a written request and submitted together with the relevant documents proving the capacity of the personal representative, for example, a letter of administration or grant of probate.

The effective date of transfer would be the date as indicated on the written request or the issuance date of a letter of administration or grant of probate, whichever is applicable.

Refer to [here](#) for a sample template for registering particulars of assent

## **10. ASSIGNMENT OF CERTIFICATION AND COLLECTIVE MARKS**

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*For more information on the nature of certification and collective marks, please refer to “Chapter 15 - Collective Marks” and “Chapter 16 - Certification Marks” of the Trade Marks Work Manual.*

The assignment of a certification mark is not effective without the consent of the Registrar. This is to ensure that the assignee, or subsequent proprietor, has the necessary competence to certify and administer the certification scheme and is not involved in the supply of the goods and/or services certified.

As an assignment of a collective or certification mark will involve amendments to the regulations, the applicant seeking the assignment shall attach a copy of the draft amended regulations together with the Form CM8 and the requisite fee. Prior to receiving further instruction(s) from the Registrar, applicants are encouraged to withhold from filing Form TM10 (Filing or Amendment of Regulations governing the Use of a Collective mark or Certification mark) to amend the regulations.

If the Registrar does not have any objections to the draft amended regulations, the applicant seeking the recordal of the assignment shall be required to file Form TM10 (Filing or Amendment of Regulations governing the Use of a Collective mark or Certification mark) online to formalise the amendments. The assignment will be recorded after Form TM10 has been submitted and approved.



## 11. ASSIGNMENT OF LOGOGRAMS

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For more information on the nature of logograms, please refer to “Marks used by Government Agencies (Rule 13)” in the [“Trade Marks Infopack”](#).

Proprietors of logograms are encouraged to update the ownership details of these logograms on the Register. This ensures that interested parties seek consent from the correct proprietor to the use of the logogram.

Form CM8 is not required for the assignment of logograms. In most cases, a letter of authorisation from the current proprietor/assignor would suffice for the assignment of logogram(s). In general, the letter of authorisation should contain the following information:-

- i. A representation of the logogram
- ii. The logogram number(s)
- iii. The name and contact details of the assignee
- iv. The name and details of a contact point within the assignee - this is meant for correspondence between IPOS and the assignee of the logogram and will not be reflected on the Register.

A sample letter of authorisation for the assignment of a logogram is attached in Page 45 of this chapter.

**Example 1:** SBX intends to transfer the ownership of a logogram to ZBS. SBX may notify the Registry and provide the details of the new proprietor(s) in writing. Alternatively, ZBS may obtain a letter of authorisation from SBX for the transfer of ownership of the logogram from SBX to ZBS (see Page 45 for a sample template of a letter of authorisation).

**Example 2:** ABS is the owner of a logogram on the Register. ABS will be undergoing restructuring to form two new statutory boards, namely BSB and BSC. ABS will cease to exist on 1 October 2016 and the logogram will be transferred from ABS to BSB and BSC. BSB and BSC are joint owners of the logogram.

Before 1 October 2016, ABS may notify the Registry in writing, stating that pursuant to the dissolution of the ABS into BSB and BSC, the logogram in the name of ABS will be jointly owned by BSB and BSC and to request for the Register to be updated on 1 October 2016.

Alternatively, either BSB or BSC may notify (on behalf of the other party) the Registry on or after 1 October 2016 about the transfer of logogram pursuant to the statute (if any) creating BSB and BSC.

## 12. MULTI-STEP RECORDALS

Where there are multiple transactions involving a change of ownership, to ensure that all transactions are recorded accurately, applicants are strongly encouraged to attach a cover letter with the Form CM8 stating:

- i. Trade mark numbers involved.
- ii. Sequence of events; and
- iii. Exact nature of each transaction

### Scenario 1: Where there are two or more assignments; and when the first assignment (i.e. Company A → B) has not been approved:

- First assignment: Company A → Company B
- Second assignment: Company B → Company C

1. First Form CM8: Applicant is to indicate “Company A” and “Company B” in Parts 4 and 5 of the form respectively. The documentary evidence (if any) should also relate to the assignment from “Company A” to “Company B”.

The screenshot displays two sections of a form, Part 4 and Part 5, each with a table of applicant details.

**PART 4: Details of Current Applicant/ Proprietor**

Site	Name	Address
1	Company A	51 BRAS BASAH ROAD MANULIFE CENTRE Singapore 189524

**PART 5: Details of Subsequent Applicant/ Proprietor**

Site	Name	Address
1	Company B	80 BENDENEER ROAD HYFLIX INNOVATION CENTRE Singapore 339948

2. Second Form CM8: Applicant is to indicate “Company B” and “Company C” in Parts 4 and 5 of the form respectively even though Part 3 of the form reflects “Company A” . Applicant will need to manually remove and insert the correct details in Part 4 of the form. The documentary evidence (if any) should also relate to the assignment from “Company B” to “Company C”.

**PART 4**  
Details of Current Applicant/  
Proprietor\*

Site	Name	Address
1	Company B	88 BENDENEER ROAD HYFLUX INNOVATION CENTRE Singapore 339945

Remove Add

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**PART 5**  
Details of Subsequent Applicant/  
Proprietor\*

Site	Name	Address
1	Company C	1 PARLIAMENT PLACE PARLIAMENT HOUSE COMPLEX Singapore 178880

Remove Add

Upon receiving the approval letters for the transactions, the applicant may verify the records on the Register. Should there be any discrepancy, the applicant may contact us.

**Scenario 2: Where there is a recordal in the change of name (Form CM2) between two assignment transactions; and when the first assignment (i.e. Company A → Company B) has not been approved:**

1. Form CM8: Company A → Company B
2. Form CM2: Company B → Company B1
3. Form CM8: Company B1 → Company C

As Form CM2 will be processed immediately upon submission, it is advisable to lodge Form CM2 only after the first Form CM8 has been approved.

1. First Form CM8: Applicant is to indicate “Company A” and “Company B” in Parts 4 and 5 of the form respectively. The documentary evidence (if any) should also relate to the assignment from “Company A” to “Company B”.

**PART 4**  
Details of Current Applicant/  
Proprietor\*

Site	Name	Address
1	Company A	51 BRAS BASAH ROAD MANULIFE CENTRE Singapore 189524

Remove Add

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**PART 5**  
Details of Subsequent Applicant/  
Proprietor\*

Site	Name	Address
1	Company B	88 BENDENEER ROAD HYFLUX INNOVATION CENTRE Singapore 339945

Remove Add

2. Form CM2: After the first Form CM8 has been approved, the applicant may proceed to lodge Form CM2. Please note that the change in name via Form CM2 is almost immediate (Form CM2 will be processed after 15 minutes) and “Company B1” will be reflected as the proprietor on record.
3. Second Form CM8: Following the submission of Form CM2, applicant may proceed to file the second Form CM8. Applicant is to indicate “Company B1” and “Company C” in Parts 4 and 5 of the form respectively. The documentary evidence (if any) should also relate to the assignment from “Company B1” to “Company C”.

Upon receiving the approval letters for the transactions, the applicant may verify the records on the Register. Should there be any discrepancy, the applicant may contact us for advice.

### 13. CORRECTION, AMENDMENT, RECTIFICATION

The relevant form to correct, amend or rectify the details of an assignment would depend on the circumstances of each case. The tables listed in 13.1 and 13.2 below shows a non-exhaustive list of scenarios and the recommended forms to be lodged to correct, amend or rectify the detail(s) of an assignment request or the Register.

Should the assignment need to be re-recorded and re-examined, a new Form CM8 with the requisite fees may be required.

#### 13.1 Correction of details within a pending Form CM8

**Example 1: Erroneous insertion of subsequent proprietor’s details in Part 5 (“Details of Subsequent proprietors”) of Form CM8. Form CM8 has not been approved.**

- ABC Pte Ltd wishes to record the assignment of its trade mark to DEF Pte Ltd. However, the applicant has erroneously inserted GHI Pte Ltd as the subsequent proprietor in Form CM8.

**What should ABC Pte Ltd do?**

- ABC Pte Ltd may verify the status of the assignment recordal request via IP<sup>2</sup>SG. If Form CM8 has been approved, the proprietor on record will be reflected as “GHI Pte Ltd”. Otherwise, if the register is still showing the proprietor on record as “ABC Pte Ltd”, it indicates that Form CM8 has not been approved.
- If Form CM8 has not been approved and the transaction has not been recorded on the Register, ABC Pte Ltd should contact the Registry immediately to request that the Registry withhold from processing the request. The Registry may direct ABC Pte Ltd to file lodge Form CM4 to correct the error(s) in Form CM8 and attach a new set of documentary evidence (if applicable).

#### **Other Examples - Correction of details within pending Form CM8**

<b>Nature of corrections</b>	<b>Form to effect correction</b>
Effective date of transfer	Form CM4 + new set of documentary evidence (if applicable)
Subsequent proprietor’s details (e.g. name, address, country of incorporation, etc.)	
Scope of transfer – specification of goods and services	

### **13.2 Correction of details after Form CM8 has been approved**

#### **Example 1: Correction of Error in relation to the Effective Date Of Transfer**

- ASL Pte Ltd lodged Form CM8 to record the assignment of its trade marks to DEF Pte Ltd. Following the recordal of the assignment, DEF Pte Ltd notified the Registrar that the effective date of transfer was erroneous.

#### **What should DEF Pte Ltd do?**

- DEF Pte Ltd may lodge Form TM27 accompanied with supporting documents in support for the rectification of the Register.

#### **Example 2: Recordal of Transfer of Ownership Should Not Have Taken Place**

- Agent, ASL Law LLC, was engaged by ABC Pte Ltd and DEF Pte Ltd to be their transfer of ownership agent. Form CM8 was lodged to transfer the mark from ABC Pte Ltd to DEF Pte Ltd. The Form CM8 was subsequently approved and ASL Law LLC remained as the transfer of ownership agent. However, another agent is now representing DEF Pte Ltd for all matters in relation to the registration.
- A year later, ASL Law LLC took the instruction of ABC Pte Ltd to request for the reversion of the assignment as the assignment should not have taken place (i.e. Form CM8 should not have been lodged).

#### **What should ASL Law LLC do?**

- If ASL Law LLC has been instructed by DEF Pte Ltd to act on their behalf, ASL Law LLC may lodge Form CM1 to appoint themselves as the agent for all matters, followed by Form TM27 accompanied with supporting documents in support for the rectification of the Register.
- Examples (not exhaustive) of supporting documents include (i) letter of consent from DEF Pte Ltd informing the Registrar that the recordal of assignment should not have taken place, or (ii) a letter indicating the particular facts and circumstances for the erroneous assignment. The Registrar may call for such written explanation of the reasons for the request or evidence in support of the request in order to be satisfied that there is an error or a mistake. Requestors are advised to contact the Registry before lodging Form TM27.
- Alternatively, ABC Pte Ltd may consider lodging Form TM28 (Application for Revocation/Invalidation/Rectification) and attach a statement of grounds.

**Example 3: Correction of Errors in relation to the Particulars of Subsequent Proprietor(s) – after Form CM8 has been approved.**

- Particulars of subsequent proprietor(s) such as country and/or states of incorporation, name and/or address may be corrected via Form CM2, provided that the proprietor(s) on record remains the same.
- The filer of Form CM2 for the correction of the particulars of the proprietor on record shall be the agent/proprietor on record.

#### **14. WITHDRAWAL OF ASSIGNMENT APPLICATION**

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The application to record an assignment may be withdrawn before the recordal on the Register. Applicants may verify the status of the assignment recordal request via IP<sup>2</sup>SG. The transaction will be recorded on the register if Form CM8 has been approved.

In the event where an applicant seeking an assignment does not wish to proceed, he/she should contact the Registry immediately to request that the Registry withhold from processing the request.

Once an assignment request has been approved and recorded on our register, it cannot be withdrawn.



## **15. EFFECTS OF BANKRUPTCY OR INSOLVENCY ON THE OWNERSHIP OF TRADEMARKS**

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(a) Proprietor (individual) is bankrupt

In the case where an individual (being the proprietor of a mark) is bankrupt, the High Court will usually appoint Official Assignee to deal with the assets of the individual including the ownership of trade mark(s) belonging to the bankrupt.

In the event that the Official Assignee intends to assign the trade marks in the name of the bankrupt, he should file Form CM8.

(b) Proprietor (company) is insolvent

The Official Receiver or liquidator (as the case may be) may step into the shoes of the trade mark owner to assign the mark to a third party. In this case, the Official Receiver or liquidator may lodge Form CM8 on behalf of the trade mark owner. Please note that the assignment of the trade mark(s) as part of the sale of the asset precedes the dissolution of the company.

For more information on bankruptcy and corporate insolvency, please refer to Ministry of Law's website.

## **16. EFFECTS OF CORPORATE MERGERS ON THE OWNERSHIP OF TRADEMARKS**

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Assignments or transfers of trade mark ownership may occur as a result of a corporate merger. In such situations, the applicable law governing the merger may provide that the transfer of the merging company's trade marks, to the new corporate entity, is effective upon the registration of the merger with the corporate registration authority in the jurisdiction where the new corporate entity is incorporated.

To record the transfer, the new corporate entity may:

- (i) File Form CM8 online and validate the application to record the assignment on the Register;

Or

- (ii) File Form CM8 online accompanied by a copy of any document evidencing the transaction, e.g. a Certificate of Merger or a certified extract from the companies' or commercial register, or Notary Public as appropriate in such cases.

## **17. ASSOCIATION OF MARKS**

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All conditions, including association clauses, ceased to have effect on 15 January 1999 when the new Act came into effect (Section 3(1) of Third Schedule). Therefore, a mark can be assigned independently from other associated marks.

## 18. INTERNATIONAL REGISTRATIONS

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For international registrations (“IR”) designating Singapore, in accordance with Rule 25 of the “Regulations under the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks”, a request for the recordal of a change in ownership may be presented to the International Bureau of the World Intellectual Property Organisation (WIPO) directly by the holder (or his recorded representative) on WIPO’s official Form MM5(E), through the Office of the Contracting Party of the (recorded) holder, or through the Office of the Contracting Party of the new holder (transferee). Form MM5(E) is available for downloading at <http://www.wipo.int/madrid/en/forms/>.

Form CM8 should not be lodged for such recordation of change in ownership.

Where Singapore is the Office of Origin, requests for recording of changes in the ownership in respect of the international registration must also be presented to the International Bureau of the World Intellectual Property Organisation (WIPO) directly by the holder. However, Form CM8 may be lodged (if appropriate) to record the change in ownership of the basic application or basic registration.

In order for the transfer to be recorded on the international register, the assignee must also be entitled to own the mark under the Madrid Protocol. In a transfer of ownership request to be recorded in respect of an IR, the assignee must indicate the Contracting Party or Parties in which he fulfils any of the following requirements (where appropriate):

- a) Have a real and effective industrial or commercial establishment in the Contracting Party;  
or
- b) Be domiciled in the contracting party; or
- c) Be a national of the contracting party.

The aforesaid requirements known as the entitlement to hold the mark must be indicated on the Form MM5(E). Where the request for the recording of a change in the ownership of the IR mentions several transferees, that change may not be recorded in respect of a given designated Contracting Party if any of the transferees does not fulfill the requirements to be the holder of the IR in respect of that contracting party.

Detailed information on changes in ownership can be found in the section ‘Change of ownership’ of the “Guide to the International Registration of Marks under the Madrid Protocol” via this link: <https://www.wipo.int/publications/en/>.

**SAMPLE ASSIGNMENT AGREEMENT**

*[Draft/Sample Only]  
Without prejudice*

**ASSIGNMENT OF TRADE MARK**

\_\_\_\_\_ *[Please state the Assignor's company name in full]*, having its registered office address at \_\_\_\_\_ *[Please state the Assignor's company address in full]* (Assignor), now wishes to assign Trade mark \_\_\_\_\_ *[Please state the Trade Mark no.]*

to

\_\_\_\_\_ *[Please state the Assignee's company name in full]*, having its registered office address at \_\_\_\_\_ *[Please state the Assignee's company address in full]* (Assignee).

NOW THEREFORE, for good and valuable consideration, the receipt and sufficiency of which is hereby acknowledged,

The Assignor hereby sells, assigns, transfer to the Assignee all right, title, and interest in and to the Trademarks, together with all of the good will of the business, including common law rights, for consideration of \_\_\_\_\_ *[Please state the amount in the relevant currency]*.

The Assignor hereby assigns, sells, transfer all claims for damages for reason of past infringement of the Trademarks, as well as the right to sue for and collect the same for its own use and enjoyment, without further obligation to Assignor with respect thereto.

IN WITNESS WHEREOF, Assignor has caused this Assignment of Trademark to be executed on its behalf by its duly authorized representative on this \_\_\_\_\_ *[Please state the date in day, month, year]*.

.....  
**Assignor :**

\_\_\_\_\_ *[Please state the Assignor's company name in full]*

..... [Name]

..... [Designation]

**Assignee :**

\_\_\_\_\_ *[Please state the Assignee's company name in full]*

..... [Name]

..... [Designation]

**This document is signed in front of a notary public.**

.....

Notary Public

Notary Seal

**SAMPLE TEMPLATE FOR LETTER OF AUTHORISATION (ASSIGNMENT)**

**Authorisation letter**

In the matter of *[Insert Logogram No.]*

*[Insert mark  
representation]*

*[Insert name of current proprietor]* hereby authorises the change of ownership of *[Insert Logogram No.]* (the “logogram”) from *[Insert name of current proprietor]* to *[Insert name of subsequent proprietor]*, *[Insert address of subsequent proprietor]*.

**Signed for and on behalf of the**

***[Insert Name of current proprietor of  
logogram]***

Name of Authorised personnel:

\_\_\_\_\_

Signature of Authorised personnel:

\_\_\_\_\_

Designation of the Authorised personnel:

\_\_\_\_\_

Date:

\_\_\_\_\_