

MARCH 2008

Henry Goh & Co Sdn Bhd (332744-A)
House of Henry Goh,
217, Jalan Imbi,
55100 Kuala Lumpur
MALAYSIA.

Phone: +(603) 2118 8688
Fax: +(603) 2118 8777
E-mail: hgoh_kl@henrygoh.com
Web: www.henrygoh.com

Henry Goh (S) Pte. Ltd. (199203221-E)
20, Science Park Road,
#03-34/35, TeleTech Park,
Singapore Science Park II,
SINGAPORE 117674.

Phone: +(65) 6333 9525/6
Fax: +(65) 6333 9527
E-mail: henryspl@singnet.com.sg
Web: www.henrygoh.com



吳亨利
商標專利
事務所

KDN NO: PP 12637/10/2008

PCT NATIONAL PHASE ENTRY IN MALAYSIA

As highlighted previously, the PCT came into force for Malaysia (country code: MY) on 16th August 2006. All PCT applications with an international filing date on or after 16th August 2006 may enter the national phase in Malaysia within a term of 30 months from the earliest claimed priority date.

The prescribed official language for national phase entry is English. Our basic requirement for initiating national phase entry is thus a copy or translation of the PCT application in English. Please contact our Patent Department for further information and assistance.

INSIDE THIS ISSUE:

- *McLaren Loses Pole Position in Class 25*
- *PCT National Phase Entry in Malaysia*
- *Enforcement Updates*
- *Trade Mark Registration Accelerated*
- *Change to Malaysian Patent Grant Procedure*
- *News at Henry Goh*

MCLAREN LOSES POLE POSITION IN CLASS 25

by Lim Eng Leong

This is a case review on the Court of Appeal decision's for **McLaren International Limited v Lim Yat Meen [2007] 7 MLJ 581**.

McLaren International Limited ("the Appellant") appealed after the High Court dismissed its application to remove and expunge trade mark registration No. 92002266 "MCLAREN" in Class 25 ("the Respondent's mark") in accordance with sections 14, 25, 45 and/or 46(1) of the Trade Marks Act 1976 ("the Act").

The grounds of the appeal was based on the fact that Appellant is the registered proprietor of the mark "McLaren" overseas, a well-known mark for Formula 1 races. In Malaysia, however it has a 1999 pending application. The Appellant only became aware of the Respondent's mark in 2001.

The Respondent's mark filed on 11 April 1992 was a combination of the words "LARRIE" brand of men's footwear and "McCann-Erikson", an international advertising agency. The Respondent averred that at the point of coining his mark, he was not aware of the Appellant or its mark since the word "McLaren" was virtually unknown by the general Malaysian public in 1992.

Suriyadi Halim Omar, JCA found there must be locus standi before one may apply for a rectification action. Relying on local cases **Fazaruddin bin Ibrahim v Parkson Sdn Corp [1997] 4 MLJ 360** and **Service Master (M) Sdn Bhd v MHL Service Master Sdn Bhd [1998] 5 MLJ 378** the Appellant submitted that the fact that its pending application is being obstructed qualified it as a "person aggrieved".

The judge found the rather liberal approach of Fazaruddin to be in conflict with the strict pre-conditions of Service Master. He held the best

approach was to consider all the available evidence. Based on the facts, it was determined that the Appellant was not a "person aggrieved". The judge also held that since the Appellant had not used the mark in Malaysia prior to the Respondent's registration, the Respondent was not bound by a duty to "impractically scour the globe and enquire if the Appellant intended to register the mark here."

The Appellant raised a point on Registered Users and relied on Section 48 of the Act which reads "...by lawful contract, a right to any person to use the trade mark...that person may be entered on the Register as a registered user...".



They submitted that the Respondent's failure to register his contract-manufacturers as the mark's registered users meant the mark was not used and even if it is used, it was not by its registered or permitted user. However, the judge disagreed with the Appellant's submission that it is mandatory to register a user. He drew comparison with the wordings of section 28 of the English Trade Marks Act 1938

which had similar spirit and content. Two English cases **Bostitch Trade Mark [1963] RPC 183** and **British Petroleum Co Ltd v European Petroleum Distributors Ltd [1968] RPC 54**, which held that the word "may" is permissible rather than mandatory were approved.

Conclusion

This judgement goes a long way to show that the success of a suit or application hinges on the facts of the case and the evidence provided. As the Appellant had not used its mark at the time the Respondent had filed its mark, they were unable to stop an individual who since 1992 had used the mark in the course of trade.

ENFORCEMENT UPDATES

by Azlina A Khalid

“Malaysia is on the right track to the effective management and enforcement of counterfeiting and piracy.”

Kuala Lumpur recently played host to the WIPO Asia-Pacific Regional Symposium on the Protection and Enforcement of Intellectual Property Rights in Combating Counterfeiting and Piracy on 24-25 January 2008.

The event was made possible with the close collaboration of World Intellectual Property (WIPO) with the Malaysian Ministry of Domestic Trade and Consumer Affairs and the Intellectual Property Corporation of Malaysia (MyIPO). The main objective of the symposium was to provide updates and information to governmental agencies such as the customs, enforcement agencies and the IP owners in countries around the region on the effective measures as well as tools that can be adopted in the ongoing fight against piracy of intellectual property rights.

The symposium was graced with regional speakers from Pakistan, Philippines and Vietnam and included a talk by a representative from the US Customs and Border Protection. All contributed to the event by giving insight on their country's

strategies in combating counterfeiting. With each country being different from one another in terms of implementation, the participants were able to gauge the various experiences of enforcement and border measures undertaken by the respective countries. As for the host, there were speakers from the national enforcement agency, which falls under the purview of the Ministry of Trade and Domestic Affairs, MyIPO and from the Attorney General Chambers. With the long awaited Intellectual Property Court finally in operation, it can be said that Malaysia is on the right track to the effective management and enforcement of counterfeiting and piracy.

In all, participants came away satisfied with the quality of speakers and topics covered. It is hoped that the concerted efforts of all parties will ensure that intellectual property rights are well defended in this part of the world.

STATISTICS: NUMBER OF ANTI PIRACY ACTIONS IN MALAYSIA

Year	Total Premises	Total Cases	Confiscated Value (USD)
2004	25,508	4,390	15,583,297
2005	38,069	3,812	26,413,315
2006	38,166	3,792	33,333,640
2007	70,863	2,720	15,687,745

Source: www.kpdnhep.gov.my

“Goods and services in Malaysian Trade Mark Applications are classified according to the current Ninth Edition of the ICG.”

TRADE MARK REGISTRATION ACCELERATED

by Tham Sau Yin

Since the corporatisation of the Malaysian Registry, there have been significant changes in their operating system, which agents and applicants alike may view with welcome relief.

The Malaysian Registry now has a larger workforce to man their daily operations resulting, for instance, in an almost updated database. With an increased number of officers in the organization's employment, the processing period has shortened considerably. Applications are examined and registered within two years or less. Where just slightly more than 11,000 marks were registered each year from 2002 to 2005, about 25,500 marks were registered in 2007 (see table, opposite page).

The Registry recently made available their online search system, PANTAS. Manual searches might soon be a thing of the past! Goods and services in Malaysian Trade Mark Applications are specified according to the current Ninth Edition of the ICG. This is an important contributing factor towards speedy and efficient examination.

Finally, we note the yearly increase in the number of Trade Mark applications filed, by both foreign and Malaysian applicants. A total of 16,600 applications were filed in 2001, increasing steadily through the years to 26,000 in 2007 alone and 12,000 of these were filed by Malaysians.

CHANGE TO MALAYSIAN PATENT GRANT PROCEDURE

by Jason Cheah

During 2007, MyIPO introduced a change in the patent grant process, resulting in patents being granted after the issue of the 'Substantive Examination - Clear Report' (commonly referred to as the 'Notice of Allowance'), regardless whether the prescribed 'certificate fee' (also referred to as the 'grant fee') has been paid or not.

In situations where an applicant has decided not to proceed with an application beyond the allowance stage, and the application is allowed to lapse supposedly, through the non-payment of the 'certificate fee', a 'Notice of Grant' is now issued in respect of the patent granted on that application, stating that the patent certificate will only be issued upon payment of the prescribed 'certificate fee'.

Before this, a patent would only be processed for grant upon payment of the 'certificate fee' within two months of the mailing date of the 'Substantive Examination - Clear Report'.

The change takes Section 31(2) of the Patents Act quite literally, noting that it does not refer to the payment of the 'certificate fee', as a precondition for the grant of a patent.

While this change may be viewed both positively and negatively, there are serious ramifications to consider.

Firstly, the timeframe within which a patent is expected to proceed to grant after an application is allowed has now become somewhat unpredictable, affecting the possibility of pursuing

divisional applications divided from a parent application that has been allowed.

A divisional application may be voluntarily filed within 3 months from the mailing date of the first substantive examination report. However, MyIPO has generally allowed the later filing of divisional applications, under an extension of time, while the parent application remains pending.

There have been occasions when an applicant only decides on pursuing divisional applications when the parent application is allowed, and does so before making payment of the 'certificate fee', to ensure that the divisional application is validly filed while the parent application is still pending.

The change now makes it possible for a parent application to be granted even before the payment of the 'certificate fee', since the official view is that it is not a precondition for the grant of a patent, thus making it impossible to validly file any divisional application.

In adapting to this change, consideration should be given to the filing of divisional applications at the earliest opportunity, preferably before an application is allowed.

Secondly, since an application that has been successfully examined will eventually be granted regardless of whether the 'certificate fee' is paid, in order to prevent an application from proceeding beyond the allowance stage, the application must be formally withdrawn.

"It is now possible for a parent application to be granted even before the payment of the certificate fee."

STATISTICS: APPLICATION AND REGISTRATION OF TRADE MARKS, 1934 TO 2007

Year	Applications			Registrations		
	Malaysia	Foreign	Total	Malaysia	Foreign	Total
1934 - 1982	-	-	162,415	-	-	132,273
1983 - 1998	72,362	90,462	162,824	13,598	45,145	58,743
1999	5,053	8,660	13,713	439	1,226	1,665
2000	6,303	12,500	18,803	449	1,328	1,777
2001	6,525	10,078	16,603	1,570	5,341	6,911
2002	7,661	8,785	16,446	4,056	7,072	11,128
2003	8,327	9,439	17,766	3,014	9,108	12,122
2004	10,406	10,337	20,743	3,243	8,473	11,716
2005	10,479	11,668	22,147	3,683	7,771	11,454
2006	11,209	12,840	24,049	5,651	10,108	15,759
2007	12,289	13,605	25,894	8,108	17,382	25,490
Total	150,614	188,374	501,403	43,811	112,954	289,038

Source: www.myipo.gov.my

IS YOUR TRADE MARK AT RISK?



The Q&A session at the seminar.

Henry Goh organised a trade mark seminar at the firm's Training Centre at Sri Damansara as part of Henry Goh's continued efforts towards creating IP awareness. The topics covered included how to choose a good trade mark, the proper use of a trade mark, how to prevent trade marks from becoming generic, as well as trade mark registration procedures and protecting and enforcing trade mark rights.

The day ended with a challenging and lively Q&A session moderated by the speakers.

DAVE WYATT IN ASIALAW



Dave A Wyatt, Executive Director of Henry Goh.

Dave A Wyatt was once again judged as one of the Asia-Pacific region's leading Intellectual Property Law experts by clients and fellow practitioners in *Asialaw Leading Lawyers 2007*, the foremost authority on corporate and commercial lawyers in the Asia-Pacific region. The management and staff of Henry Goh congratulate Mr Wyatt on this achievement and wish him ever more future success.

THE HOUSE OF HENRY GOH

It was with much more than the usual excited flutter of relocation that we moved into our very own corporate office in a bungalow designed and built more than a hundred years ago. A relic of British colonialism, it is one of the few remaining structures of a bygone era right within the commercial heart of the nation's capital city.

In his address at the soft launch on a warm Sunday morning in November, the firm's Founder and President Mr Henry Goh spoke of the early years, the teething problems and the achievements of the firm in the last thirty years. In a visibly moved voice he paid tribute to his staff, "without whose loyalty and dedication, none of this would have been possible".

There was a moment of reflective silence and quiet pride which was interrupted by the happy



The staff of Henry Goh outside the House of Henry Goh.

colourful noise of firecrackers before everyone settled to enjoy the buffet lunch.

CHINESE NEW YEAR FESTIVITIES

by Alvin Boey

Henry Goh had a busy Chinese New Year, first with the Staff Annual Chinese New Year Luncheon and then hosting a splendid dinner for fellow associates from the IP industry. Ms. Ambiga Sreenevasan, President of the Malaysian Bar Council, was among the honoured guests to grace the dinner. The evening's entertainment included a Malay traditional dance called *joget* and a middle-eastern cultural dance by Henry Goh staff. However, the highlight of the night was a special rendition of a Mandarin song by Mr and Mrs Henry Goh.



Mr and Mrs Henry Goh flanked by the firm's staff after the function.

Meanwhile, at the Staff Annual Chinese New Year Luncheon everyone was dressed in shades of red to mark the annual festival. In his speech, Mr Goh announced that Henry Goh & Co was once again voted the No. 1 firm for patent prosecution work in Malaysia in Euromoney's annual Managing Intellectual Property Survey. He also expressed his confidence in the firm's ability to continue to set ever higher standards in the IP industry, and wished everyone a prosperous year ahead.

100 TREES FOR MONTFORT

Henry Goh was proud to participate in Montfort Boys Town's tree-planting project by donating over 100 rambutan trees to the boys' home in Shah Alam.

"We are very happy to know that the boys and girls in this Institute are taught and trained in a variety of vocations, crafts and skills that help them make a good living in society," said Ms Goh at the event. "Community service is a noble duty of every citizen. We hope that these trees will be nurtured with tender love and care, and that from them the boys will get a bountiful harvest, both for your enjoyment and as a constant enhancement of revenue for your Institute."



Karen Goh, Executive Director of Henry Goh, plants the first rambutan tree.

Montfort Boys Town houses some 350 youths between 16 and 18 from under-privileged homes.