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Excerpt from Judgement:

"A person who files a patent application for an invention is afforded the privilege of claiming priority only if he himself filed the earlier application from which priority is claimed or if he is the successor in title to the person who filed that earlier application. If he is neither the person who filed the earlier application nor his successor in title then he is denied the privilege.

"Moreover, his position is not improved if he subsequently acquires title to the invention. It remains the case that he was not entitled to the privilege when he filed the later application and made his claim. Any other interpretation would introduce uncertainty and the risk of unfairness to third parties."

CARE NEEDED WHEN CLAIMING PRIORITY

Court's decision has potential implications worldwide.

BY DAVE A WYATT In the recent English High Court case of **Edwards Lifesciences AG vs Cook Biotech Incorporated ([2009] EWHC 1304 (Pat))**, the honourable Mr Justice Kitchin decided that the priority claim in Cook's European patent was invalid on the ground that at the time of filing their application, Cook were not the successor in title of the applicants of the priority application.

The European patent was derived from a PCT application filed one year after the priority US application. As required by US patent law, the three inventors were named as joint applicants of the US application. At the time of making the invention, one of the inventors was an employee of Cook, UK law thereby giving Cook title to that inventor's interest. However, the other two inventors were not employees and Cook only acquired title from them by virtue of an assignment executed after filing the PCT application, though before grant of Cook's European patent.

The Judge found the effect of the priority provisions of the Paris Convention and the UK Patents Act to be clear (see excerpt, left). Cook argued that Section 7 of the UK Patents Act allowed a defect in the applicant's entitlement to a patent to be remedied prior to grant. They contended that the position on priority entitlement should be the same. The Judge rejected this submission as entitlement to a patent



and entitlement to a priority claim were separate issues.

The effect of the loss of the priority claim opened the floodgates to additional prior art published in the priority interval. This contributed to a finding by the Judge that Cook's patent was invalid for obviousness over the prior art.

Under Section 27(1) of the Malaysian Patents Act, an application may include a declaration claiming the priority of an earlier application filed by the applicant or his predecessor in title. The above decision would not be binding on a Malaysian Court. Like Malaysia, however, the requirements for claiming priority in most countries are derived from Article 4 of the Paris Convention, under which only the person who filed the priority application, or his successor in title, enjoys the right of priority. There are potential implications worldwide.

This decision serves as a salutary reminder to patent agents that while establishing their client's right to file a patent application is important, equal attention needs to be paid to the right to claim priority.

CHANGES IN SINGAPORE PATENTS LEGISLATION

The year 2010 may see some changes to Singapore's patent laws.

Singapore Supreme Court building.
Photo credit: Sengkang.

BY AMEEN KALANI
Singapore's patent laws are due to undergo important changes possibly in the year 2010. Of the myriad of proposed changes two are examined here in greater detail.

BY AMEEN KALANI Post-Grant Amendment

Under current Singapore patents legislation, post-grant amendments are merely requested by the patentee which are advertised in the journal and where no objection is lodged by third parties, the amendments will be generally be accepted. Under proposed legislative changes, such amendments will be subjected to an assessment of allowability through an examination process. Only where the amendments are deemed allowable will they be advertised for opposition and in the absence of objection by third parties, the amendments will be accepted. The patentee may appeal to the court where the amendments are deemed not allowable. This is in line with other changes to convert the present the patent regime to one of positive examination.

Restoration of lapsed patent

Presently, a patent owner in the restoration of a lapsed patent must satisfy the Registrar that he took reasonable care to see that any renewal fee was paid within the

prescribed period or that that fee and any prescribed additional fee were paid within the 6 months immediately following the end of that period. Under proposed legislative changes, Singapore appears to be in favour of following the January 2005 change in UK patents law relating to the standard required for restoration of a lapsed patent from reasonable care to unintentional. The "unintentional" test is generally accepted to be less stringent than that of "reasonable care". As with the present standard of reasonable care, it is doubtful if the proposed standard of "unintentional" will be defined in the legislation.

In the UK case of **Matsushita Electric Industrial Co. v Comptroller General of Patents [2008] EWHC 2071 (Pat), [2008] RPC 35**, applications for restoration were filed stating that it had never been the proprietor's intention to allow the patents to lapse. A statement to the same effect from the proprietor was provided, but no other supporting evidence was filed. The UK Patent Office requested information on the circumstances in order to establish if the lapse was indeed unintentional. The proprietor argued that this was unnecessary under Section 28(3) of the UK Patents Act 1977. Justice Mann gave some guidance on the level of evidential burden required to "satisfy"

the standard of "unintentional". In this case, he said "...the Act requires a judgment to be formed by the Comptroller so that he can be satisfied of the relevant matters. A judgment usually has to be made on the basis of evidence... The evidence required in any particular case where satisfaction is required depends on the nature of the enquiry and the nature and purpose of the decision to be made... A significant matter requires significant proof. I repeat, the Act does not require a statement that the failure to pay fees was unintentional. It requires the Comptroller to be satisfied of that fact."

It is clear from this judgment that while the new test may be easier to fulfil, there can be no universal rule as to what level of evidence has to be provided to satisfy the standard of "unintentional", some evidence above and beyond a bald assertion of the law is required. Under the "unintentional test", it may suffice to show that the non payment of renewal fees was unintentional or unavoidable, or due to reasons not attributable to the original patentee or that non payment was due to accident, mistake or other unforeseeable circumstances. However, the proposed change will arguably be of little help to a proprietor who allows a patent to lapse and then changes his mind. ☹️

WELCOME "INN"

Generic drug names used as trade marks.

BY LIM ENG LEONG
International Nonproprietary Names (INN) are recognized by the World Health Organization (WHO) to identify pharmaceutical substances or ingredients; globally recognized as public property. These generic names cannot be registered as trade marks to avoid confusion and jeopardizing public health & safety. However, in **Leo Pharmaceutical Products Ltd A/S v Kotra Pharma (M) Sdn Bhd [2009] 5 MLJ 703**, the High Court held that the Malaysian Trade Marks Act 1976 (TMA 1976) does not specifically prohibit the registration of trade marks which are or confusingly similar to INN. This is unlike Section 13(b) of the Indian Trade Marks Act 1999, for example.

In this case, the defendant (in a trade mark infringement action) counterclaimed to expunge the plaintiff's registered trade marks for "FUCIDIN" and "FUCICORT". One of the grounds raised being these 2 marks cannot be registered since they bear deceptive or close resemblance to the INN "fusidic acid" and "corticosteroid". The court held that the INN prohibited, if at all, should be "fusidic acid" and "corticosteroid" and not "FUCIDIN" and "FUCICORT" since the latter are not "the

commonly used and accepted names of any single chemical element or compound" [Section 33(4) TMA 1976] but instead they function as trade marks distinctive of the plaintiff. This is supported by ample evidence from licensed pharmacists and authoritative medical literature tendered.

Moreover, the court finds the marks as a whole to be "portmanteau words", i.e. words that are coined by blending two generally descriptive words (for example, "Whisqueur" derived from "whisky" and "liqueur"). Although INN are generic in nature and cannot be monopolized, this does not prevent pharmaceutical trade mark applicants from adopting names which allude to INN (for example, "Amoxil" from amoxicillin); the trite law being a trade mark cannot be directly descriptive but it need not be absolutely un-suggestive. A term can acquire a secondary meaning

or perform dual function to show the characteristics of the goods (for example, containing fusidic acid) and at the same time to indicate trade origin.

Until there is statutory enactment, WHO's INN Guidelines cannot become part and parcel of our TMA 1976, and companies can continue to choose marks based upon pharmaceutical compounds, provided there is no risk of confusion. ☹️



ID QUICKIE

When the tort of passing off meets with registered industrial design.

BY AZLINA A KHALID
The case of **Koh Chui Ngoh t/a Perniagaan Lily v Magicboo Beauty Sdn Bhd [2009] MLJU 0168** is one unusual case that intertwined the tort of passing off with a registered industrial design.

The Plaintiff is the owner of a registered industrial design for the packaging of its product being glue for eyelashes, selling them since 1995. The registered industrial design and the bottle containing the product had since then become distinctive to the extent the Court acknowledged that the Plaintiff had acquired goodwill and reputation in the get-up attached to the registered design.

The Defendant's premises were initially raided by the Enforcement Office. The Plaintiff subsequently sued the Defendant for registered industrial design infringement.

During trial it was shown that that both parties' packaging were strikingly similar in appearance. In addition, the Defendant's products were marked with the Plaintiff's details, which the Defendant contended was a genuine mistake by their supplier.

At trial however, the said supplier was not called to give evidence. In the circumstances, the Court invoked the adverse presumption under paragraph (g) of section 114 of the Evidence Act 1950. Further evidence

adduced showed that the Defendant had continued to sell the infringing products even after their premises had been raided.

The Court subsequently allowed Plaintiff's claim of passing off as it was found that there was a real likelihood of the Plaintiff's customers being diverted by the Defendant.

In summary, whilst this common law tort is usually related to trade marks, an owner of a registered industrial design may still assert passing off subject to the requisite criteria of goodwill and reputation, misrepresentation and likelihood of damages being established and proved. ☹️

Wild, Wild West at Henry Goh

The "Henry Goh County" sent its legion of cowboys, cowgirls, sheriffs, saloon gals, Native American chiefs and warriors to hustle the Royale Chulan Hotel, Kuala Lumpur on 24 October 2009 for a "Wild Wild West" night of celebration. They let their hair down as IP practitioners to become stylish and fashionable masquerade artists.

One of the highlights of the enjoyable evening was a video presentation of the many memorable and cherished moments of 2008/2009. Besides being spoilt with a sumptuous BBQ-buffet, everyone was entertained throughout the night by the showmanship and hidden talents of the staff through a Wild Wild West-themed dancing competition and music performances. No one went home empty-handed after generous rounds of lucky draw.

"Yee Haw!" from the People of Henry Goh.

Seminar Against Design Copycats



A participant asking the panel a question.

In conjunction with the 10th Anniversary of Malaysia's Industrial Designs Act, Henry Goh hosted a seminar at the Bankers Club in Amoda Building, Kuala Lumpur on 1 October 2009.

The half-day seminar was another corporate social responsibility initiative by Henry Goh to educate the public about Malaysia's intellectual property laws. Attendees received an important primer on

Malaysia's Industrial Design Act and the international conventions it applies to. Participants also took the opportunity to query the presenters on specific issues that affected their businesses in an interactive session after the seminar.

The worldwide economic loss due to fakes and imitations is estimated to be between EUR200 and EUR300 billion a year, or about 10-percent of global commerce.



APAA 15th General Assembly Hong Kong, 18-22 November 2009

Henry Goh was privileged to join attorneys from all over the world at the 15th APAA conference. We were represented by our Managing Director Ms Karen Goh, Executive Director & Head of Patent Department Mr Dave Wyatt, Director of Henry Goh Singapore, Mr Ameen Kalani and Patent Agent Alvin Boey.



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