

HENRY GOH

Intellectual Property Updates

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MEET US AT
APAA
SINGAPORE,
18-21
OCTOBER

We are happy to announce that both the Malaysia and Singapore offices of Henry Goh will be represented at the upcoming Council Meeting of the Asian Patent Attorneys Association in Singapore.

The event will be held at the Suntec Singapore International Convention Centre from 18-21 October 2008. We look forward to meeting you there. Please contact us should you wish to schedule an appointment.

INSIDE THIS ISSUE:

- *Translation of the PCT Request Form for National Phase Entry in Malaysia*
- *Patent Term – Annuity Payers Short-Changed*
- *Malaysia IP Court in Session*
- *IP Court Case Updates*
- *News at Henry Goh*

TRANSLATION OF THE PCT REQUEST FORM FOR NATIONAL PHASE ENTRY

by Andrew Siew

Even before Malaysia acceded to the PCT on 16th May 2006, the most basic of questions regarding the requirements for the Malaysian national phase entry had started arriving at our email servers and facsimile machine along with local inquiries for requirements for filing PCT applications directly in Malaysia.

PCT applicants that are interested in pursuing national entry in Malaysia should take note of this somewhat unusual but critical requirement: A copy of the PCT request form, needs to be submitted at the Malaysian patent office by the 30-month national phase entry deadline. The remaining documents we require for national phase entry include the bibliographic page as published by the WIPO, a copy of the PCT specification as published (in or translated into English) and a copy of any amendments filed in the international phase, in or translated into English.

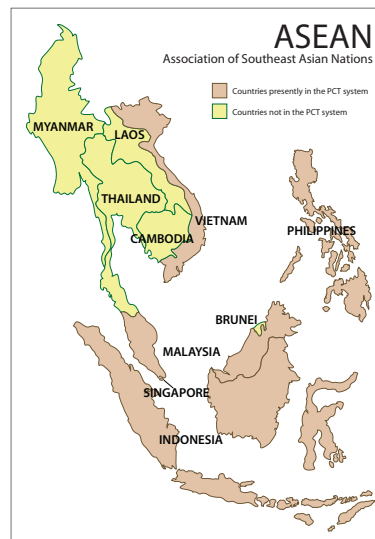
According to the Malaysian Patent Office, under Section 780(1)(a), if the original PCT request form is not in English, the applicant is required to submit a full English translation of the request form. Therefore, applicants for PCT applications that were filed in languages other than English will be required to provide an English translation of the entire completed request form. This is a strange if not a redundant requirement as the information is normally readily available in English from WIPO, including romanised versions of names and addresses where needed. If this requirement is not met by the above 30-month deadline, the PCT application will be deemed withdrawn and the appli-

cant will need to file an application to have the national phase application reinstated, along with the full English translation of the PCT request form.

The above requirement under Section 780(1)(a) follows a discretionary requirement as laid out by PCT Rule 49.5. It is indicated that the designated office may require the applicant to provide a translation of the request form itself should the content of the request form not be in one of the official languages sanctioned by the designated office. The designated office is in return required to provide copies of the request form in the language of the translation free of charge to the applicants. Despite being legally permitted under the PCT Rules, it appears that the current Malaysian practice on translation of the Request form does not go hand in hand with that of its ASEAN neighbours. It is to be noted that according to the PCT Applicant's Guide, this discretionary requirement is not applied by the other ASEAN

countries (Indonesia, Philippines, Singapore and Vietnam) presently in the PCT system.

The purpose of the PCT system is to simplify the process of filing, prosecuting and obtaining granted patents in multiple countries, whereby the duplication of documents and information are avoided wherever possible, as opposed to filing patent applications separately in multiple countries. However, the current Malaysian practice indicates that the filing of a PCT national phase may in fact involve more work than the filing of a regular convention application.



PATENT TERM - ANNUITY PAYERS SHORT-CHANGED

by Dave A Wyatt

“There are now old patents that have had their life extended, but for which the final annuity payment will extend the protection for a period of less than one year.”

In line with obligations under TRIPs, the term of Malaysian patents was changed to 20 years from filing date on 1st August 2001 by the Patents (Amendment) Act 2000. Any patent granted on an application filed on or after that date has a 20-year term. The 2000 Act contained a transitional provision under which any patent with a filing date prior to 1st August 2001 kept the original term of 15 years from date of grant.

As an oddity, the base date for annuities was not changed by the 2000 Act. It remained the date of grant whether the patent had the new 20-year term or the old 15-year term. Since the date of filing and the date of grant will almost always be different, this meant that for any 20-year patent kept in force for its full term, the final renewal fee paid will not buy a full year of protection. The inconsistency was recognized by the Malaysian Patent Office. However, the need to fix it by further legislation was not seen as pressing since no 20-year patent would

reach the end of its full term before 1st August 2021.

Thus far, the law made a clear distinction as to which term applied to any particular patent. One only had to check the filing date. On 14th August 2003, the waters were muddied. The above transitional provision was qualified by an amendment introduced under the Patents (Amendment) Act 2003. 15-year patents that were in force (or pending as applications) on 1st August 2001 were now given a 20-year term from their filing date if this would give a longer period of protection. This further change to the law brought the above inconsistency to the fore. There are now old patents that have had their life extended, but for which the final annuity payment will extend the protection for a period of less than one year. This is clearly inequitable. And the time for yet another change is overdue.

MALAYSIA IP COURT IN SESSION

by Lim Eng Leong

The climate of IP litigation in Malaysia has seen much welcomed fair weather for almost a year, ever since the Intellectual Property (IP) Court was established in July 2007. After Thailand, Malaysia is one of the early nations in this region to establish a specialized court tasked to deliberate on IP cases. Little is publicized but early steps were actually taken even as early as 1 January 2006 to reduce the backlog of IP cases. Efforts include designating one of the Sessions Court in capital Kuala Lumpur i.e. Criminal Sessions Court No.4 to hear such IP cases.

Thus far, a total of 15 Sessions Courts (IP), one in each state including the administrative capital Putrajaya, and 6 High Courts (IP) in the main states of Kuala Lumpur, Selangor, Johor, Perak, Sabah and Sarawak have been set up. The Sessions Court (IP) presides over criminal IP cases which have largely include the prosecution of, inter alia, optical disc counterfeiters, and copyright or trade mark infringers whose premises have been raided and goods seized. On the other hand, the High Court (IP) is empowered to hear both criminal and civil IP cases.

It makes good sense to have a court that specializes in IP as it is better suited to administer trial and pass more relevant and comprehensive judgment. An obvious advantage of the IP courts, to both litigants and practitioners alike, is that delay in proceedings will be minimized. Gone are the days where an IP legal suit is reg-

istered together with other cases and would have to wait its turn for its day in court. The legal process becomes more effective and judgments are expected to be delivered within a more reasonable time frame.

For example, according to the Executive Director of MyIPO (Intellectual Property Corporation of Malaysia), Mr. Kamel Mohamad, the Kuala Lumpur Sessions Court managed to clear only about 14% of the IP cases registered with it in the year 2005. In comparison, with the setting up of the IP court, some 70% (163 out of 236) of registered cases have been settled. As an indirect result of such effectiveness, the Federal Court has also deliberated on 28 IP cases out of 142 appeals registered with it.

The existence of the IP court in Malaysia is a significant milestone and highlights the country's continuous efforts to improve legal protection of IP rights here. It is hoped that this will facilitate the socio-economic development of the country and educate the public on the importance of respecting intellectual property rights.

* statistics obtained from NST Online.

“An obvious advantage of the IP courts, to both litigants and practitioners, is that delay in proceedings will be minimized”

IP COURT CASE UPDATES

by Azlina A Khalid

1. IEV International Pty Ltd V Sadacharamani A/L Govindasamy [2008] 2 MLJ 754

This is a recent judgment given for a patent case which comes from a small list of litigated patent cases in Malaysia. It concerned an application made by the Plaintiff to invalidate the Defendant's granted patents No MY-119064-A and MY-119147-A.

The Plaintiff started business in Malaysia in 1988 and manufactured certain products referred to as 'Apparatus for the Combating of Marine Growth on Offshore Structures' ("their products"). Their products were granted patent registration under Patent No MY-103283-A on 29 May 1993 with a priority date of 15 May 1987. The patent was also granted in 14 other countries worldwide.

The grounds of invalidation were based on Sections 11, 12, 14 and Section 15 of the Patent Act ("the Act"), which included amongst others lack of novelty and inventive step. The Plaintiff had particularly strong grounds in objecting the Defendant's patents based on the disclosure of the Plaintiff's earlier drawings and articles to the public and that there were users of their products before the Defendant filed his patent applications.

Perhaps, the straw that broke the Defendant's case was the fact that the Defendant was the Plaintiff's Marketing and Contracts Manager between January 1991 and December 1992 and had access to manufacturing drawings and specifications, installation instructions etc from which he wrongly made use of documents and confidential information. Soon after resigning, the Defendant took only 7 months to file for a patent which was alleged to be for an improved product. The defendant filed his patent applications on 1 September 1993 (Malaysia Patent No MY-119147-A) and on 3 September 1993 (Malaysia Patent No MY-119064-A). The Defendant's patents were granted after a lapse of 12 years, on 31 March 2005 and 30 April 2005 respectively.

The Plaintiff's claims were backed by the testimony of three expert witnesses who are well recognized as patent professionals. In summary, the evidence they gave was not successfully refuted by the Defendant who instead relied on the opinion of two patent agents which were rendered more than 10 years ago.

Although the Defendant submitted arguments that there were several differences between his inventions and those of the Plaintiff's patent, after due consideration of all evidence and submissions by both counsel, the Court held there was indeed no novelty in the Defendant's inventions and he was not the original inventor of his patents. The Plaintiff's claims were thus allowed with costs.

2. New-West Management Group S/B & Another V. Ng Ah Kow & Another [2008] 8 CLJ 18

This latest case on trade marks and passing off issues concerns an interlocutory injunction application over the trade name of a clinic.

The first plaintiff is in the business of owning and operating general medical practices and related medical services. The Second Plaintiff is in the business of investment holding and provisions of management services. The Defendants initially set up the practice identified under the name and style "Klinik Ng dan Lee" in the 1970s. Ownership of the practice was then transferred to K&V Sdn Bhd where the Defendants were its shareholders. The company subsequently sold the business to the First Plaintiff together with the goodwill and reputation attached to it.

There were various agreements entered to regulate the sale and transfer of the business operating under the name and style "Klinik Ng dan Lee". Substantial sums were paid as consideration to the Defendants pursuant to these agreements.

The practice continued at the previous premise to ensure that the goodwill and reputation attached to the business that was acquired continued to be enjoyed by the Plaintiffs. The Defendants continued to practice in the clinics identified under the name and style "Klinik Ng dan Lee" until January 2007 when the services of the First Defendant was not renewed. At this juncture, the Defendants had become employees of the clinic. Subsequent to the non-renewal of the services of the First Defendant, the First Plaintiff was given notice to vacate the premises of "Klinik Ng dan Lee" operating from the Jalan Pudu branch.

The Defendants then set up a business under the name "Ng-Lee Medical Centre" that operated out of the same premise vacated by the First Plaintiff. The Plaintiffs claimed that in addition to the fact that "Ng-Lee Medical Centre" carried a name and style that was confusingly and deceptively similar to the trade name "Klinik Ng dan Lee", the Defendant's actions were in clear disregard of their previous agreement to not compete with the Plaintiffs.

Upon consideration of the facts and evidence presented, the application for interlocutory injunction was granted on the basis there were serious issues to be tried and that the balance of convenience lied heavily with the Plaintiff. The Court acknowledged that the business was duly transferred to the Plaintiffs in return for a substantive consideration. The Defendants were also bound by promissory estoppel due to their cognizance of being mere employees when they accepted salaries paid by the First Plaintiff.

"The Plaintiff's claims were backed by the testimony of three expert witnesses who are well recognized as patent professionals."

NEW BUSINESS DEVELOPMENT MANAGER AT HENRY GOH



Oon Yen Yen, Henry Goh's new Business Development Manager

Henry Goh is pleased to congratulate Ms. Oon Yen Yen on her appointment as the new Business Development Manager of the firm.

"The IP industry is very dynamic and I am very honoured to have been selected for the job," said Ms. Oon. "I look forward to playing a greater role in the firm's and industry's future."

"Ms. Oon possesses a keen understanding of our clients' needs," said Ms. Karen Goh, Executive Director. "We are confident that she will excel in her new role as Business Development Manager for the firm."

ENFORCEMENT UPDATES

By Lim Eng Leong

Henry Goh, acting as a trade mark agent for a renowned Italian gate-automation manufacturer, once again assisted the Enforcement Division of the Ministry of Domestic Trade and Consumer Affairs in a successful raid and seizure of counterfeits in Bukit Mertajam, Penang.

The infringer had been found to be manufacturing and selling gate-automation devices bearing a trade mark that is highly confusing and similar to the client's trade mark.

All goods seized are now in the possession of the Enforcement Division and we expect speedy criminal action to be taken against the infringer.

OFFICIAL OPENING OF THE HOUSE OF HENRY GOH

by Alvin Boey

The afternoon of the 29th June 2008 will go down in history as one of Henry Goh & Co's most important milestones as the company unveiled its new home, the House of Henry Goh. The Minister of Transport, Yang Berhormat Datuk Ong Tee Keat, was pleased to officiate the opening, which included a wonderful lion dance performance from Khuan Loke Dragon & Lion Dance Association. In his speech, YB Datuk Ong expressed his high regard for the President of the firm Mr. Henry Goh, admiring both his courage and his perseverance in stamping his mark on the Intellectual Property industry.



YB Datuk Ong Tee Keat (left) cutting the ribbon along with Mr. Henry Goh (right).



Madam Pang Siew Fian (right) receiving the cheque from Mr. Henry Goh (left).

All the guests who attended the ceremony were treated to a short tour of the building. This was followed by a brunch reception. Later that evening, the opening celebrations continued with a dinner at the Flower Drum restaurant, punctuated by singing performances by invited guests, vendors, friends and long-time business associates. Mr. Henry Goh made a donation to the Hainan Education fund, represented at the occasion by Madam Pang Siew Fian, President of the Federation of Hainan Association Malaysia. It was a splendid evening to mark a joyous and significant day in Henry Goh's history.

130TH INTA IN BERLIN

by Lim Eng Leong

Henry Goh once again made its presence felt at the INTA Annual Meeting. Our representatives, Mr. Dave A. Wyatt and Mr. Lim Eng Leong, joined approximately 8000 delegates who gathered from 140 countries at this year's meeting in historical and beautiful Berlin, Germany from the 17th to the 21st of May 2008. Business ties and rapport with long-standing foreign associates were strengthened through a series of meetings and networking events. Many of our foreign associates used the conference as an avenue to discuss the progress of pending trade mark applications and explore possible enforcement actions with us. New friends were also made at various cocktail receptions and dinner parties held around the city.

We say "Auf wiedersehen" (goodbye) to Berlin for being a kind host and "Hello" to Seattle for the forthcoming 131st Meeting in 2009.



At the Gala with Jenny Wang (China Patent Agent HK Ltd) and M Yameen Khan (Gulf IP)

BNC VISITS HENRY GOH

Henry Goh was proud to receive a visiting entourage of 26 members of the Business Networking Club (BNC), Kuala Lumpur. The members were given a tour of Henry Goh's new corporate office.

The President, Mr. Henry Goh also presented a cheque to the BNC President, Mr. Quek N K, in support of their Education Fund.

The BNC members were then hosted to a buffet dinner at a hotel across the road from the House of Henry Goh.



Mr. Henry Goh presenting the cheque to BNC.