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### SINGAPORE RATIFIES WIPO TRADE MARKS LAW TREATY.

Singapore has acceded to and ratified the WIPO Singapore Trade Marks Law Treaty. The amendments previously discussed in the article "Changes to the Singapore Trade Marks Regime" published in the June 2007 edition of this publication have been effected and are in force, as of 2 July 2007.

Any queries regarding the new amendments may be directed to our Singapore Office.

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## CHANGES TO SINGAPORE PATENTS LAW: AN OVERVIEW

by Ameen Kalani

In line with some of the changes to the PCT Regulations which came into force on 1 April, 2007, Singapore introduced amendments to her patents legislation which include, inter alia, restoration to priority claim, correction of priority claim and incorporation of missing parts.

#### Restoration of priority claim

The amendment allows priority claim to an earlier filed application even if the present application is filed outside the priority year. Where previously it was not possible to extend the 12 month priority claiming period under the Paris Convention for the Protection of Industrial Property, an applicant may now request for restoration of the right to claim priority within 14 months from the date of the relevant priority application. For a PCT international application which was filed after the 12 month priority claiming period under the Paris Convention which then proceeds to enter the national phase in Singapore; the applicant may request for restoration of the right to claim priority within 31 months from the date of the relevant priority application. The Singapore legislation has stipulated one of two criteria in assessing a request for restoration of priority; namely if failure to file the application occurred in spite of due care having been taken or if failure to file the application was unintentional.

#### Correction of priority claim

The amendment enables rectification of priority claims. Where an application is filed within the 12 month priority claiming period under the Paris Convention but a claim to priority was omitted at the time of filing the application; the applicant may request to add a priority claim. A request may also be made to correct a priority claim so as to bring the declared priority date to an earlier date provided either request is made within 16 months of the newly declared priority date and the application has not been published.

#### Incorporation of missing parts

The amendment makes possible inclusion of

*"Singapore ranks among the top 20 nations in the world for number of patent filings."*

accidentally omitted parts without affecting the filing date. Where after an application has been accorded a date of filing, the applicant realizes that any drawing or any part of the description was left out from the patent specifications, a request may be made within 3 months from the date of filing to have such missing part(s) included in the patent specifications. Although the filing date of the application may be changed to the later date when the missing part is filed, a request may be made to maintain the original filing date subject to the following conditions:

1. File request to maintain original filing date;
2. File statement that missing part(s) is incorporated in the application by reference to, and is completely contained in, the priority application as filed;
3. Furnish details of priority application and its English translation (if applicable).

As at the end of year 2006, it has been reported that Singapore had more than 45,500 patents in force, which is twice the number for the year 2000. The country also ranks among the top 20 nations in the world for number of patent filings, though more than 90% were granted to non-Singapore residents. These figures serve to highlight the growing popularity among foreign applicants to file patent applications in the island nation. Whether these latest changes will further bolster the filing statistics remains to be seen.

## PCT NATIONAL PHASE ENTRY IN MALAYSIA

by Dave A. Wyatt

As readers may know from previous issues, the PCT came into force for Malaysia (country code: MY) on 16th August 2006. Any PCT application with an international filing date on or after 16th August 2006 may enter the national phase in Malaysia. Earlier-filed PCT applications will not however qualify.

The term for PCT national phase entry is 30 months from the earliest claimed priority date. This time limit applies irrespective of whether a Demand for international preliminary examination has been filed in the international phase.

Based on the above timeframe, it is expected that national phase applications will start to be filed in significant numbers from February 2008 onwards. It is therefore timely to set out the filing requirements.

The official language for national phase entry is English. The minimum requirements to be met within the 30-month time limit are:-

- the details of the PCT application (suitably, the bibliographic page as published by WIPO);

- one copy of the PCT specification as originally filed (in or translated to English);
- one copy of any amendments filed in the international phase (in or translated to English); and
- payment of the official filing fees and the fees for any claims in excess of 10.

Other requirements, that are preferably addressed at the time of filing but may be dealt with later if necessary, are:-

- an Appointment of Agent form signed by the applicant; and
- if the applicant is not the inventor, brief information explaining how the applicant derives its right to the patent from the inventor, normally by virtue of assignment or employment.

There are no maintenance fees payable prior to grant. A request for substantive examination falls due 4 years from the international filing date. The examination options are the same as for a regular national application.

*“It is expected that national phase applications will start to be filed in significant numbers from February 2008 onwards.”*

## FIRST USER STILL REIGNS

by Azlina A Khalid

In the case of **Walton International Ltd v Yong Teng King b/s Hong Kong Trading Co & Anor** [2007] 4 MLJ 133, an appeal was made to the Courts after the Registrar of Trade Marks had dismissed the Appellant's Opposition. The Appellant is part of a group of companies belonging to Giodarno International Limited. The Respondent is a sole proprietor of a Hong Kong trading company.

The Respondent had originally applied to register the mark GIORDANO in Classes 9, 14 and 18; both Class 9 and Class 14 applications were opposed. This appeal relates to only the Class 9 application even though both Oppositions were dismissed.

It was submitted that the Respondent had plagiarized the mark GIODARNO and used it to usurp the Appellant's goodwill and reputation. The Court held otherwise. On evidence it was shown that the Appellant's goodwill and reputation extends to only Class 25 goods. The Appellant did not have any business with regards to optical wear and sunglasses at any time before or after the Respondent's mark was filed.

Evidence also showed that the Respondent had begun use of the mark GIORDANO for his goods of interest in Malaysia since 1992. His claim as first user for Class 9 goods in the market was upheld. There was no likelihood of confusion arising as alleged by the Appellant since clothing and optical wear are not sold side by side or even in the same stores.

This case illustrates the Courts' willingness to extend protection to traders who are able to show that they are the first user of a mark in the market where the goods are totally different from another entity's goods even if the marks concerned may be similar or identical.

Though the conclusion may not sit well with brand owners who face situations akin to the above, it must be remembered that the Court is bound to assess and decide a case based on its own peculiar facts and evidence adduced. Claims of misappropriation must be backed by evidence showing that the use of a similar or identical mark for similar goods or of the same description has resulted in loss of goodwill or reputation occasioned by confusion and/or deception.

*“It must be remembered that the Court is bound to assess and decide a case based on its own peculiar facts and evidence.”*

## COPYRIGHT OWNERS’ NEW BEST FRIENDS

by Lim Eng Leong

Counterfeiters beware! Two highly-trained black Labradors, Lucky and Flo, are Malaysia’s latest weapon in tackling rampant optical discs piracy. They have been specially trained to sniff out polycarbonates, a chemical ingredient extensively used in the disc-manufacturing process. Although unable to tell the difference between genuine and counterfeit discs, using Lucky & Flo is a quicker and more effective measure than having to go through the cargoes, which may or may not have a contraband assignment. In a recent demonstration, the dogs managed to find a pirated box-set among more than 50 boxes scattered around the cargo complex of Kuala Lumpur International Airport. Once the scent of polycarbonate is detected, Lucky & Flo will freeze or stay still besides a haul.

The canine friends were a loan from the Motion Picture Association of America (MPA) whose movie industry-members lose over billions of dollars to pirates every year. The dogs’ short stint in Malaysia has helped to uncover more

than 1.3 million counterfeit optical discs worth more than USD4.4 million in nationwide raids on warehouses and shops. This is a remarkable feat considering this is the first time that dogs have been used by enforcement authorities anywhere in the world to detect optical discs although their fellow canine counterparts have long been trained to sniff out drugs and narcotics.

The Irish-trained Labradors are proving to be such a real threat and a force to be reckoned with that crime lords have put a huge bounty on their heads. The VIDs (Very Important Dogs) are now afforded round the clock protection.

The anti-piracy exercise has been so successful and effective that Malaysia hopes to obtain specially-trained dogs to form the government’s first official canine anti-piracy unit as a permanent replacement for Lucky & Flo. All these efforts are testament to Malaysia’s continuous solid commitment in strengthening the protection of intellectual property rights.



Man’s best friend, unless you are a pirate.

## AUTOMATIC COPYRIGHT PROTECTION IN MALAYSIA

by Stephanie Leong

Copyright is different from other types of intellectual property such as patents and trademarks. Whilst trademarks relate to protection of brands and patents relate to protection of new and novel inventions, copyright relates to the protection of creative works such as literary, artistic, musical and dramatic works as well as broadcasts, sound recordings, films and derivative works.

There is no official system of registration to obtain copyright protection in Malaysia. Therefore, proving ownership of a work in Malaysia, may be difficult. This contrasts with patents and trademarks where registration of the same is a pre-condition to protection. Copyright in Malaysia is governed by the Copyright Act 1987 and protection is automatic if the following pre-requisites are satisfied, namely, sufficient effort has been expended to make the work original in character; the work has been written down, recorded or otherwise reduced to a material form; and the author is a qualified person or the work is first published in Malaysia or any member country of the Berne Convention besides many other countries where an international agreement exists.

Works which are not protected by copyright law include ideas or procedures; business operations or procedures; scientific or technical discoveries; mathematical concepts or formulas; or any other concept, process, or method of operation. However, the expression of any of the said

works may be protected as long as the above said pre-requisites are satisfied.

It is therefore pertinent to note that it is not *ideas* but the *original expression* of those ideas that are protected by copyright law. For example: the first person to create a table mat with a hologram pattern may be able to protect the original artistic appearances of the said table mat with copyright, but he/she cannot use the copyright to preclude others from creating their own and original hologram-patterned table mat. Nevertheless, section 42 of the Copyright Act 1987 provides a means of asserting the copyright by way of a Statutory Declaration or Affidavit which is admissible as evidence in any proceedings under the Copyright Act 1987 and shall be prima facie proof of the facts stated therein.

Proving ownership of the work is easier if there is proper record-keeping of copies of all working drafts and any other materials used in connection with the development of the work. It is also best practice to prominently display a copyright notice, such as marking it with a © symbol, the name of the copyright owner and the year of first publication. With such copyright notice, others would know when the term of protection began and thus whether copyright still subsists, and who to seek permission from to use the work. Copyright notices may also serve to discourage would-be copyright infringers.

*“It is not ideas but the original expression of those ideas that are protected by copyright law.”*

## PRESENTATION AT AKER KVAERNER'S IN-HOUSE IP WORKSHOP



Mrs Vicky McNiff (left) of Aker Kvaerner with Dave Wyatt (right) of Henry Goh & Co.

At the invitation of our client Aker Kvaerner, Mr Dave A Wyatt, Head of Patent Department in our Malaysian office, gave an opening presentation entitled Introduction to IP at their 2-day in-house training workshop on IP awareness. The workshop was held at the Prince Hotel in Kuala Lumpur for the benefit of Aker Kvaerner staff from various locations in Asia.

An introduction by the course leader Mrs Vicky McNiff, of Aker Kvaerner Subsea Ltd, Scotland, emphasized the importance and value the company attached to intellectual property. This was followed by Dave's presentation that guided participants through a whistle-stop tour of the key IP rights - copyright, knowhow, trade secrets, trade marks, industrial designs and patents - and concluded with a simple illustration of patent claim amendment in the face of prior art.

## HENRY GOH @ SINGAPORE SCIENCE PARK

Our Singapore operations will be relocating to Teletech Park, in the Singapore Science Park from 13 August 2007, adding to the vibrancy of the Science Park Community and lending our technical expertise in intellectual property rights in transforming ideas and innovations into successful businesses. Shaped like a samurai's helmet and face mask, the Teletech Park Building is also set in lushly landscaped surroundings and in the vicinity of various historical sites, such as the Battle of Pasir Panjang and the Tiger Balm Gardens.

The Singapore Science Park is one of Asia's most prestigious research and development



The TeleTech Park Building in Singapore.

and technology hub, established under a government initiative in 1980 to provide solid infrastructure conducive for the flourishing R&D sector in Singapore. Located in the heart of Singapore's technology corridor and at the doorstep of one of Asia's premier universities, the National University of Singapore, the Singapore Science Park is a surprisingly short scenic drive from the Central Business District.

## MALAYSIA OBSERVES NATIONAL INTELLECTUAL PROPERTY DAY

by Alicesa John

In conjunction with the National Intellectual Property Day on 26 April 2007, both the Ministry of Domestic Trade and Consumer Affairs and the Intellectual Property Corporation of Malaysia (MyIPO) organized an Expo on Intellectual Property. Henry Goh & Co.'s Dave A. Wyatt, Alicesa John, Ivy Pang and Julia Abong represented the firm at the event.

The Expo was launched by the Prime Minister of Malaysia Datuk Seri Abdullah Ahmad Badawi, who based his opening address on innovation, the development of new ideas, and a knowledge-based economy. This was followed by a video presentation highlighting the National Intellectual Property Plan.

Domestic Trade and Consumer Affairs Minister, Datuk Shafie Apdal remarked on MyIPO's success in the 16% increase in patent applications under the PCT from May 2006 to March 2007. He also commended the organisation on its efforts to expedite trademarks processing, shortening the waiting period to 12 months.

"Whether the idea is big or small, technological or mechanical, agricultural or medical, systems or processes, all have an economic value and can make a substantial contribution to the nations economic health," said Datuk Shafie Apdal in his speech. "This is one of the reasons why the government is so strongly promoting the importance of intellectual property protection."

## MYIPO DIALOGUE 2007

by Lim Eng Leong



MyIPO Dialogue 2007 participants in action.

The Malaysian Intellectual Property Office (MyIPO) organized a dialogue with fellow trade mark and/or patent agents in Kuala Lumpur recently. Approximately 60 intellectual property practitioners (including 6 representatives from Henry Goh & Co.) and MyIPO officers attended the dialogue, which was chaired by Associate Professor Rohazar Wati Zuallcoble, the Deputy Director-General of MyIPO.

Amongst the issues on the agenda were increasing the administrative efficiency of MyIPO, minimizing delay, and clarifying procedural matters. The dialogue was testament to MyIPO's open-door policy and their efforts to maintain a channel of communication with the agents and practitioners.