

# MY NEWS

MALAYSIA & SINGAPORE INTELLECTUAL PROPERTY NEWS  
FROM HENRY GOH & CO SDN. BHD.

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## MALAYSIA

### UPDATES

## MALAYSIA MOVES TO PROVIDE FOR TRIPs

By Clara C.F. Yip



CLARA C.F. YIP

Realising the need to comply with the TRIPs Agreement, Malaysia has enacted as law several provisions relating to renowned trademarks, geographical indications, performers' rights and layout-designs of integrated circuits.

Following are some major legislative changes:

### LAYOUT-DESIGNS OF INTEGRATED CIRCUITS ACT 2000

This specialised legislation is introduced to protect without the need for registration, layout-designs which are original in the sense that they are the result of their creators' own intellectual effort and are not commonplace among creators of layout-designs and manufacturers of integrated circuits at the time of creation.

Protection lasts for 10 years from the time of first commercial exploitation of the layout-design in Malaysia or elsewhere but nevertheless shall lapse 15 years after its creation.

Consequential amendments have also been made to the Industrial Designs Act 1996 to exclude integrated

circuits, parts thereof or masks used for making integrated circuits from industrial design protection.

### TRADE MARKS (AMENDMENT) ACT 2000

One of the significant changes in this amending Act is the abolition of the two-part trademarks register and adoption of the old Part B test for assessing a trademark's distinctiveness and hence, registerability.

The amending Act also introduces a new prohibition against registration of trademarks that are identical or even close to well-known trademarks in Malaysia, especially if these are for the same products or services.

This prohibition is extended to misleading geographical indications that state, a particular product originates from a specific area, when it does not.

Measures are also being implemented at the border and entry points to prevent goods with counterfeit trademarks, not being goods in transit, from being imported into Malaysia.

### GEOGRAPHICAL INDICATIONS ACT 2000

This Act introduces registration requirements for geographical indications. However, protection is extended to all geographical indications irrespective of whether these are registered.

Registration would raise a presumption that such indication is a geographical indication, as defined in the Act.

Under this Act, the use of misleading geographical indications and the use of geographical indications that constitutes unfair competition within the meaning of Paris Convention's Article 10*bis* are not allowed.

### COPYRIGHT (AMENDMENT) ACT 2000

This amending Act provides various protections for performers in relation to fixation of their unfixed performance and reproduction of such fixation, amongst others.

It also limits the distribution rights of owners to the act of circulating copies that have never before been locally circulated.

*These new Acts and amendments are expected to be enforced by the end of this year. We will come up with a more comprehensive write-up for our clients and associates to help you better understand the changes.*

TRADE MARK

## TWO SEWING MACHINES BEARING SIMILAR MARK

### COURT RULES USE OF REGISTERED MARK NOT INFRINGEMENT OF ANOTHER SUBSTANTIALLY IDENTICAL REGISTERED MARK

*Oh Beng Hai & Anor v Dickson Wong (M) Bhd. & Anor*  
By Clara C.F. Yip

The applicants sought an order declaring that the respondents' use of the mark in suit is a false trade description under the **Trade Descriptions Act 1972** on the ground that a trademark infringement case had been made out. The applicants had registered their mark for *domestic* sewing machines and the first respondent, *industrial* sewing machines. Both marks bore the image of a flying horse.

The applicants argued that infringement had occurred as the respondents' sewing machines were not designed for *industrial* use as claimed but instead functioned as *domestic* sewing machines, thereby coming within the scope of the applicants' specification of goods as registered. However, the judge found that the respondents' sewing machines were specialised machines and properly classified as *industrial* sewing machines.

In any event, the judge felt that the word 'PEGASUS' written below the respondents' red

flying horse clearly distinguished the two marks and eliminated any possibility of deception or confusion.

In finding for the respondents, the judge further relied on two provisions in the **Trademarks Act 1976**:

1. the applicants cannot prevent the respondents from using the 'flying horse' mark since Section 35(2) clearly provides that registration of marks that are identical or resemble one another do not give any one of those proprietors rights of exclusive use of either of those marks as against any other of those proprietors; *and*
2. the respondents' use of their registered mark, being one of two or more registered marks that are substantially identical and the use of which is in exercise of their right given by registration is not considered as an infringement under Section 40(1)(f).

# SINGAPORE

## PATENT

### AMENDMENTS TO SINGAPORE PATENT RULES

by Neville Young



NEVILLE YOUNG

Several amendments to the Singapore patent rules came into force on Dec 20, 1999. These amendments principally serve to extend the period of prosecution procedure between application and grant, giving applicants and the Registry more time to comply with certain requirements of the Act and Rules. The main changes are summarised below:

#### PRIORITY DOCUMENT

The time for filing a certified copy of a priority document and a verified English translation of priority document has been extended from 22 months to 28 months from the priority date.

For PCT national phase cases, the time for filing a verified English translation of a priority document has been extended from 22 to 28 months from the priority date for Chapter I entry, and from 32 to 38 months for Chapter II entry.

#### SEARCH AND EXAMINATION

The time for filing an examination request or a combined search and examination has been extended from 22 months to 28 months from the priority date.

Also, the time for filing the search and/or examination results of a prescribed corresponding foreign application has been extended from 22 to 28 months.

The time for filing a request for examination or a combined search and examination has been extended from 22 months to 28 months from the priority date, for PCT Chapter I national phase cases.

An IPC symbol is no longer required in respect of each prescribed corresponding foreign patent application whose details are filed at 16 months from the priority date, in the search and examination prosecution procedure under Section 29(1)(c).

#### WRITTEN OPINION

The time for filing a response to a written opinion has been extended from three or four months, to five months from the date of the Registrar's letter.

#### GRANT

The time for paying the grant fee and requesting the Certificate of Grant has been extended from 42 months to 54 months from the priority date.

#### SAVING PROVISIONS

Any pending application having a deadline under the existing rules, that is due on or after Dec 20, 1999, may be able to take advantage of the above more generous time provisions of the new rules. We shall advise our clients individually on this issue, on a case-by-case basis.

## ANNOUNCEMENTS & NEWS HIGHLIGHTS

### SINGAPORE TRADE MARKS & PATENTS REGISTRY RENAMED

The Registry of Trade Marks and Patents has been re-structured and renamed as the Intellectual Property Office of Singapore (IPOS). IPOS will function as the national resource centre and regulatory authority for intellectual property.

### IPOS INTRODUCES ePATENTS ON-LINE SERVICE

IPOS recently introduced its "ePatents" service on the Internet. This service, which currently allows limited patent searches to be conducted online, will eventually facilitate on-line patent applications and renewals. The service will soon include online access to the electronic Register, patent specifications and the downloading of such information.

### HENRY GOH & CO. RECEIVES INDUSTRY EXCELLENCE AWARD (EXPORT SERVICES) FOR 1999

We are proud to announce that we are the first Intellectual Property firm in Malaysia to be awarded the Industry Excellence Award (Export Services) for 1999. Our president and CEO, Mr. Henry

Goh personally received the award from the Prime Minister, Y.A.B. Datuk Seri Dr. Mahathir Mohamad at a dinner and awards presentation hosted by the Ministry of International Trade and Industry.

### HENRY GOH & CO. IS NO.1 FIRM FOR PATENT WORK IN MALAYSIA

For the third consecutive year, we have been nominated the *No.1 Firm for Patent Work* in Malaysia, in a 'Managing Intellectual Property Survey.'

HENRY GOH & CO'S PATENT TRAINEE  
NAIDU APPANAN OBTAINED PATENT &  
REGISTERED DESIGN LICENCE and is now a  
qualified agent.

DAVE WYATT OF HENRY GOH & CO.'S  
PATENT DEPARTMENT IS ELECTED AS  
MEMBER OF UNITED KINGDOM'S  
INSTITUTION OF ELECTRICAL ENGINEERS.

Dave is also registered with UK's Engineering Council, giving him the Chartered Engineer title.

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#### Disclaimer

*The information contained herein is based on data believed to be reliable and published in good faith to give a general overview of current intellectual property issues in Malaysia and Singapore.*

*Specific advice should be sought from Henry Goh & Co Sdn Bhd prior to relying on the contents of this newsletter.*

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#### MALAYSIA



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