

# MY NEWS

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

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## MALAYSIA

### IP ENFORCEMENT BETWEEN 1/04/1999 AND 25/02/2002

- Total inspections : 44,884
- Total cases: 12,058
- Value of confiscated goods: USD 30,258,005

### EDITORIAL

BY CAROLINE COURONNE

On behalf of Henry Goh & Co Sdn Bhd, I would like to welcome all new readers to MY NEWS. It is an exciting time for the Intellectual Property market, with Malaysia opening its doors even wider to trade with foreign countries. The need for protection of identity and of creativity is stronger than ever. Henry Goh & Co is keeping at the edge of the latest developments in the IP market, in Malaysia and worldwide to guarantee an always satisfactory service to our clients & partners. MY NEWS allows us to share with you the market and business news that are placing IP at the center stage of trade relationships.

Enjoy your reading.

### MALAYSIA REMOVED FROM US WATCH LIST OF PIRACY

In January 2002, the Domestic Trade and Consumer Affairs Ministry announced the removal of Malaysia from the US top priority watch list for piracy and counterfeit. Malaysia was listed in 2001, and the removal is a direct result of Malaysia's national enforcement against traders and of the constitution of a "special-copyright" task force. This "sweet-success" is another step towards the improvement of trade relationships between Malaysia and the US.

Summarized and edited by Caroline Couronne

### NEW MALAYSIAN DESIGNS LAW



DAVE A WYATT

Since the coming into force of Malaysia's industrial designs law on 1st September 1999, many of the initial issues of interpretation and practice have now been resolved. On the other hand, the substantial changes to United Kingdom designs law under the EU Directive 98/71/EC have raised totally new issues of whether there is any effect on residual UK-derived design rights in Malaysia. At the time of writing, the Designs Registry is still discussing the matter with their legal adviser. It is hoped that a position will be announced shortly.

The process of registration of new designs under the Malaysian Act is, however, proceeding generally smoothly. Registrations have a maximum life of 15 years, with renewal necessary after 5 and 10 years. There is a local novelty standard, but no search or substantive examination. Although the examination of Malaysian design filings is supposed to be restricted to formal matters, in the early days objections were made from time to time on substantive issues such as lack of novelty. The Registry reconsidered its practice after being challenged to cite prior art to substantiate an alleged lack of novelty.

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## LEGAL CASES



MARY SYBLE  
LOUIS

From a common law perspective there has been no dramatic departure from the current trademark law and practice. However, the following case bears some significance as far as the interpretation of the law is concerned.

In the case of *Caitlin Financial Corporation NV versus CA Seimer (M) Sdn. Bhd. and Another* (2001) 3 MLJ on appeal to the High Court from the Registrar of Trademarks involving opposition proceedings it was held that it does not matter that the goods of one opponent and of the applicant are of different description. The test is simply whether the opponent by the use of its mark, has established that if similar marks were used in relation to the applicants' goods, the public would be confused. In the context of this case, as the 'Kiwi' word and the Kiwi bird device used together or singly have acquired a reputation, the word 'Kiwi' and the Kiwi bird device, if used on different goods in a normal and fair manner will likely to cause deception and confusion on a substantial number of persons, the purchasing public.

From the common law approach it is quite clear that the law is not stringently interpreted or applied.

## NEWS-NEWS-NEWS-NEWS-NEWS-

### IMPLICATIONS OF THE AMENDMENTS TO MALAYSIA'S PATENT ACT

Enforced since 1st August 2001, the major amendments are

- Duration of patent becomes 20 years from filing date instead of 15 years from date of grant-this does not affect patents filed before 1st August 2001
- Now allows parallel import of patented products
- Acts relating to obtaining marketing approval from the Drug Control Authority will not be an infringement
- The power of government to use a patented invention without consent of patentee is more restricted.

Summarized and edited by Dave A. Wyatt

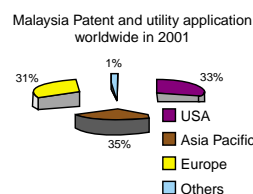
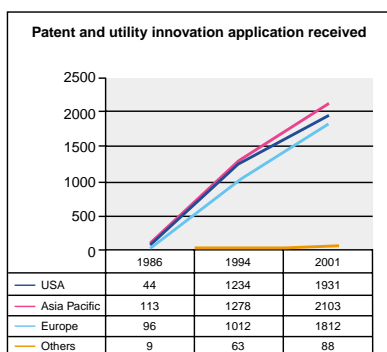
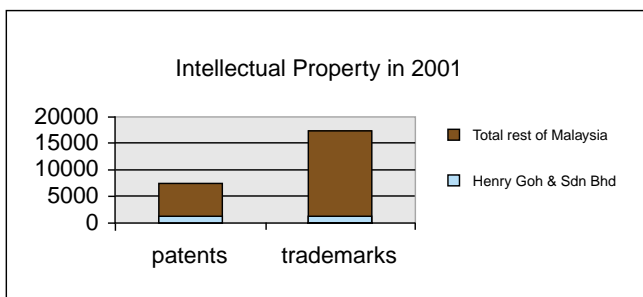
### BACK OF THE BACKLOG BROKEN

The Malaysian Trademark Registry has managed to break the back of the backlog of trademark cases dating back to the late seventies. We are told that the only "old" unexamined cases are those applications filed in 1998, 1999 and some from 1997. There is, of course, the other category of old cases with objections raised and submissions filed, and the outcome years waited for is still being waited for. The Registry proposed to add more examiners to deal with this and the long-awaited decisions might finally be forthcoming. The officers at the Registry have been processing applications filed in 2000 and even those filed early in 2001 this year, especially the unobjectionable cases, with praiseworthy speed and efficiency. With this piece of good news, it is hoped that the years and years of waiting between filing and registration will truly be a thing of the past.

F. Germaine Anthony-Muthu

## STATISTICS

### IP applications in 2001



### THE ROLE OF IP ENFORCEMENT IN BIOTECHNOLOGY INDUSTRY

A recent survey conducted by the World Intellectual Property Organization states that the main limitations to technology transfer to Developing Countries are the inadequacy of examination of patents and the painstaking and inadequate court systems. Smaller markets require stronger IP protection to attract foreign investments in Biotechnology. As a result, if Malaysia is to become the "Next Platform of Growth" in the worldwide biotechnology industry, it is crucial for IP Rights to be strongly enforced by competent agents.

Summarized and edited by Caroline Couronne

### WHAT IS CYBERSQUATTING

Cybersquatting occurs when an individual purchases domain names that reflect the name of a business or a famous person with the intent of selling the name back to the business or celebrity for a profit. Companies like Panasonic, Hertz, Avon have been victims of Cybersquatters. In the U.S, companies can either use the Anticybersquatting Consumer Protection Act ACPA, or fight using an international arbitration system created by the ICANN (Internet Corporation of Assigned Names and Numbers). In Malaysia, there is no act yet protecting from Cybersquatting, so companies are advised to register their domain names as trademarks. Keeping a close watch on the Internet activity will help avoid cases such as [www.maybank2u.rvx.net](http://www.maybank2u.rvx.net), where an individual illegally used the Maybank trademark to lure users and obtain logins and passwords.

# SINGAPORE

## NEW DESIGN LEGISLATION



MARY YAP YUNG  
YUNG

In response to an increasing demand for registration of industrial designs in Singapore, the **Singapore Registered Designs Act 2000** came into force on **13<sup>th</sup> November 2000**. This legislation introduced a system of local registration of designs in Singapore.

Prior to this, to protect a design in Singapore, one had to register the design in the United Kingdom, and this registration would automatically extend to Singapore.

Key features of the Singapore Registered Designs Act 2000 are worldwide novelty standard, provision for claiming priority from the first application filed in a member country of the Paris Convention or WTO, and no novelty search or substantive examination.

The legislation has transitional provisions covering the extension to Singapore of a United Kingdom registered design having a date of registration prior to 13<sup>th</sup> November 2000. At the date of commencement of the Act, this United Kingdom registered design is deemed a registered design under the Act, but only for an *initial period*. The initial period will expire on the first renewal date of the United Kingdom registration to occur on or after 13<sup>th</sup> November 2000. At that time, an application for renewal of the design in Singapore will be necessary to continue the protection in Singapore.

To conform to the European Designs Directive, any UK design registered before 1<sup>st</sup> August 1989 and in force on 9<sup>th</sup> December 2001 will be eligible for renewal to a maximum life of 25 years instead of 15 years. This change took effect on 9<sup>th</sup> December 2001. These UK designs will similarly be eligible for renewal to a maximum life of 25 years in Singapore.

Also in line with the Directive, the renewal due date of a UK registered design will be calculated from its filing date instead of its priority date. This change also took effect on 9<sup>th</sup> December 2001. The Singapore Registry will similarly adopt this change for the renewal of UK registered designs in Singapore. However, this change will not affect designs filed in Singapore, the same which may be extended for a second and third period of 5 years calculated from the priority date or from the filing date if there is no priority claim.

## TRADEMARK UPDATES



THAM SAU YIN

### E-FILING

For the convenience of the applicants, the Intellectual Property Office of Singapore (IPOS) has with effect from 15 January 2002 introduced electronic filing of trademark applications and various other forms. This is only an alternative: manual filing of application forms is still allowed.

### PRIORITY CLAIM

From 15 January 2002, it is no longer necessary for applicants to file priority documents for trademark applications in support of priority claims. Instead, they are allowed to file a declaration in Form TM5 to verify particulars of the said claim. Priority documents need to be filed only on the Registrar's specific request.

### 8TH EDITION OF THE NICE CLASSIFICATION

Singapore has adopted the 8th edition of the Nice Classification which came into effect on 1 January 2002. Class 42 has been revised and three new service classes 43, 44 and 45 have been added.

## PATENT UPDATES

### PCT CHAPTER II



AMEEN KALANI

The time limit for entering PCT Chapter I/II national phase in Singapore remains as 20/30 months respectively from the earliest declared priority date. Thus the recent modifications to the time limit under PCT Article 22(1) are not yet

applicable in Singapore.

### NEW RULES FOR PATENT AGENTS

Rules have now been provided for the application and registration of patent agents (including transitional provisions), the application and issuance or practicing certificates. The New Rules also regulate the professional conduct and practice of registered patent agents.

### PROVISIONAL APPLICATIONS

Provisions have now been introduced for periods prescribed for formulating claims to complete patent applications if they were not furnished at the time of filing. This would mean that "provisional" patent applications may now be filed.

## HENRY GOH & CO GROUP NEWS

### NEW STAFF

#### ABDUN NIZAR AHMAD



ABDUN NIZAR  
AHMAD

Mr. Ahmad graduated in 1998 with a BEng (Hons) in electronic and electrical engineering from the University of Manchester, England. Before embarking on his career in Intellectual Property with Henry Goh & Co., Abdun worked in the information technology field. He now works as a patent and design executive with responsibility for handling the filing, prosecution and maintenance of patent and design rights.

#### WONG HUEI NIANG



WONG HUEI  
NIANG

Ms Wong graduated with a LL.B (Hons) from the University of London and she has been in practice for six years. She has been admitted to the Malaysian Bar and is also registered as a Patent, Trade Mark and Design Agent. Ms Wong is also a member of the Malaysian Intellectual Property Association and the Licensing Executive Society and was a committee member for the National Conference entitled "Recent developments in intellectual property." She is a legal advisor handling the prosecution of trade mark applications in Malaysia, Brunei and Singapore and other intellectual property matters.

#### Editorial Committee:

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Ms Mary Syble Louis	Mr Dave A Wyatt
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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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