



# HENRYGOH

## Intellectual Property Updates

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#### Notice:

Our address is House of Henry Goh, 217 Jalan Imbi, 55100 Kuala Lumpur, Malaysia and has been so for the past 3 years. Please send all postal correspondence to this address for our immediate attention.

*Thank you*

## NEW IP REGULATIONS UNVEILED

**BY DAVE A WYATT** The Intellectual Property Corporation of Malaysia (MyIPO) recently announced amendments to the Trade Marks and Patents Regulations on 15 February 2011. Major changes of interest include the following:-

### Official Fees

A noticeable change is a significant increase in official fees across the board by about 30%-60%. This is the first fee increase in more than 13 years for trade marks and 15 years for patents in Malaysia. It is hoped that the extra funds will help towards expanding the workforce and productivity of MyIPO that will ultimately translate into benefiting IP owners.

### Expedited Examination

There are now formal provisions for requesting expedition of examination of both trade marks and patents. For trade marks, such a request has to be filed within four months from the initial application date, whereas for patents there is no time limit as such provided the application has already been laid open to public inspection and a request for examination has been submitted. In any event, the expedited process is not available at all for trade mark applications filed prior to 15 February 2011.

Justification for the expedited examination is required in the form of a Statutory Declaration. A non-refundable official fee is payable. The grounds on which expedited examination may be considered are:

- 1) national or public interest;
- 2) evidence of potential infringement or ongoing infringement proceedings;
- 3) registration is a condition to obtaining monetary grants from the Government or institutions recognized by the Registrar; or
- 4) other reasonable grounds.

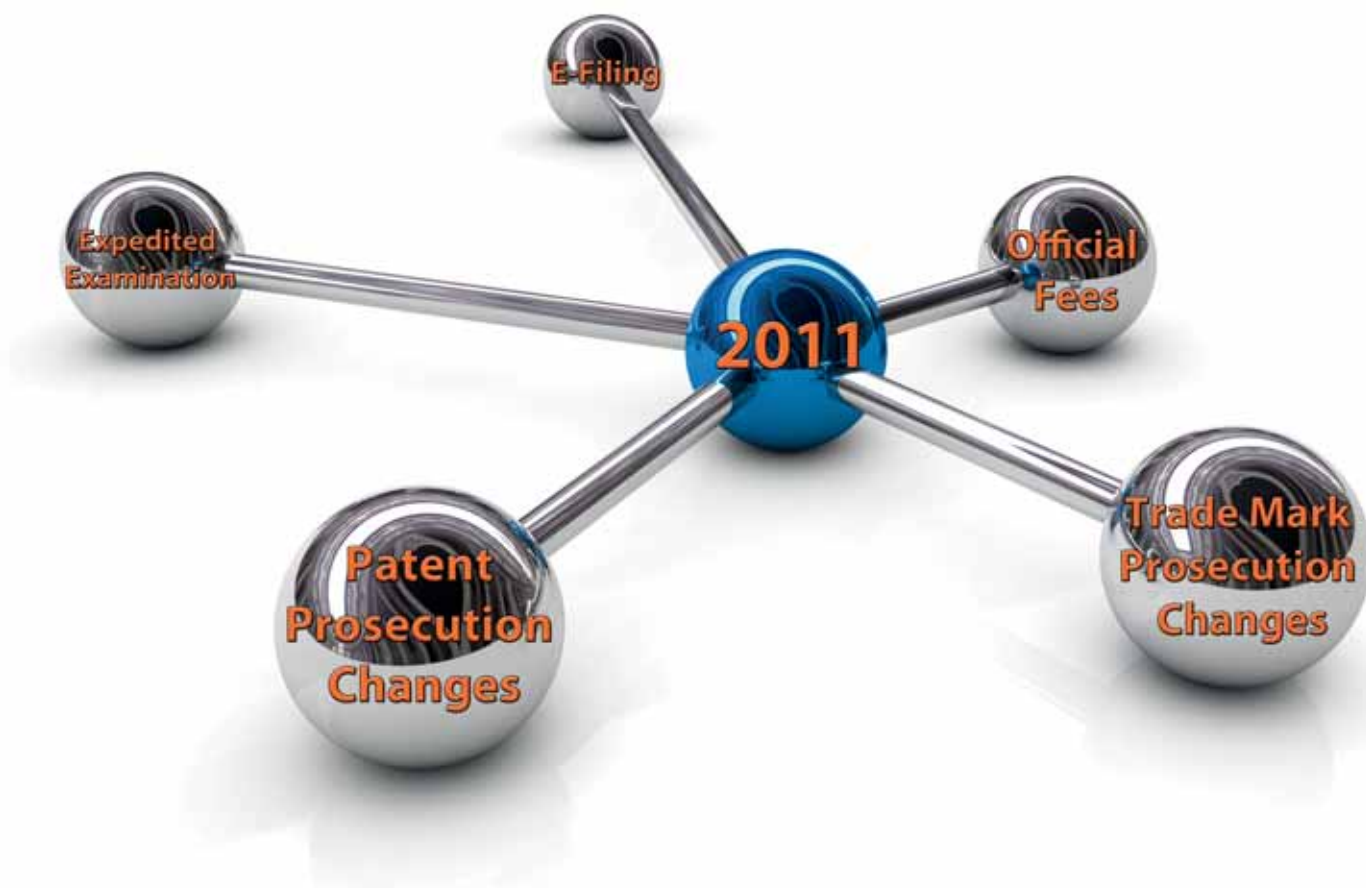
The above grounds are common for both trade marks and patents. For patents, two additional grounds are available:

- 5) the invention has already been commercialized or the applicant intends to do so within two years of requesting expedition; or
- 6) the invention relates to green technologies that will enhance the quality of the environment or conservation of energy sources.

Upon approval of the request by MyIPO, the applicant must pay a further, substantial official fee for the expedited examination.

For trade marks, it must be noted that the process expedited is the examination of the mark, not its registration. The mark is still subject to acceptance, open to opposition and final registration. Moreover, the new process is only expected to be of value if there are no or minimal objections, since the real backlogs in trade marks relate to those applications where an objection has been maintained and a hearing is necessary.

For patents, the applicant can expect an office action within four weeks of paying the expedition fee. A term of three weeks is given for response and no extension of time will be allowed. If a response is not filed within this shortened timeframe, the



application will revert to the regular examination pace. In view of the considerable expense, it is not envisaged that expedited patent examination will be used frequently. There is no indication from MyIPO that, apart from the tighter timeframes, the examination will be conducted any differently from the norm. Substantive examination of patents in Malaysia relies heavily on prosecution results from counterpart foreign applications. As such, using the existing modified examination option, based on a granted foreign patent, may be a more cost-effective route to early grant for many applicants.

### **E-Filing**

In keeping with the digital age, MyIPO has put in place an online system to allow certain transactions to take place electronically. As an incentive, official fees payable for e-filing are given a token discount. The system is totally new and most agents have concerns on its reliability and capability, so there may be a lengthy transition period before the majority of applications are filed and prosecuted electronically. Nevertheless, the first steps have been taken.

### **Trade Mark Prosecution Changes**

There are some changes affecting the prosecution of trade mark applications. In a single trade mark application for each class of goods/services, there is a new official fee payable for the third and subsequent mark in a series of marks. An official fee is also now payable when an applicant requests for an ex-parte hearing to prosecute an application further when the Registrar maintains any objection previously raised.

### **Patent Prosecution Changes**


With a view to completing the formalities of an application as soon as possible, the Power of Attorney and statement of entitlement are now required to be filed with the initial application. Otherwise, an adverse formalities report will be issued. Previously, the filing of these documents was only checked at the substantive examination stage. Regrettably, both documents are now subject to the payment of official fees. The additional fees only serve to add to the administrative burden on both agents and MyIPO, which is contrary to the overall theme of the other rule

changes in streamlining procedures and shortening prosecution timeframes.

The term for requesting examination of a direct (non-PCT) application has been reduced to 18 months from the filing date. MyIPO has advised that the previous two-year term can still be relied on for applications filed prior to 15 February 2011. The term for requesting examination of a PCT national phase application remains four years from the international filing date.

The term for responding to a substantive examination report has been reduced from three months to two months. Although not governed by the regulations as such, MyIPO has indicated it may take a tougher stance on the grant of extensions of time, which remain at the discretion of the Registrar.

Upon grant, the official fee to obtain the patent certificate has been abolished. This change will help to speed up the final grant process. However, the patent certificate will still be issued on paper.

The next wave of IP law reform is expected to be in the copyright arena, with a Copyright Bill due to be tabled in the Parliament in March 2011.

# HENRY GOH

## LEGAL SNIPPETS

BY AZLINA A KHALID

In the past year, the firm had successfully handled several legal cases on behalf of its clients by filing various actions and appeals at the Malaysian IP Court. Below are some highlights of such cases:-

### 1 Opposition appeal

**Soo Juan Choon & Co.**  
**v La Pointique International Ltd**

Our client's trade mark application was initially opposed by the Opponent La Pointique on the grounds that they are not the original owner of the mark. The proceeding was heard by MyIPO's Opposition unit and following a successful opposition by the Respondent, our client appealed against the Registrar's decision to the IP Court. The Court subsequently allowed the client's appeal and ordered that the client's opposed trade mark No. 92006838 be registered. The grounds given by the Learned Judge in his decision was that client had positively and qualitatively disassociated themselves from the Respondent as the first user of the mark in the market and no longer played the role of a product distributor.

*\*This case is being appealed by the Respondent\**

### 2 Rectification actions

**Tsurumi Manufacturing Co. Ltd**  
**v Yek Fong Aquarium Accessories Sdn Bhd**

This is an interesting case whereby our client, Tsurumi Manufacturing Co. Ltd discovered that

their trade mark TSURUMI had already been registered by a local company since 2006. They proceeded to file for rectification actions against the said Trade Mark Registration Numbers 06005661 and 06005662 for TSURUMI in Classes 7 and 11 respectively. When the matter was heard at the IP Court, the Learned Judge held that the client, the Applicant in the rectification action was the rightful owner to the mark TSURUMI after client adduced evidence of substantial use for the said mark prior to the date of registration of the above mentioned marks. Both registrations were subsequently ordered to be expunged from the Malaysian Trade Marks Register.


*\*Both cases are being appealed by the Respondent\**

### 3 Trade Mark Infringement actions

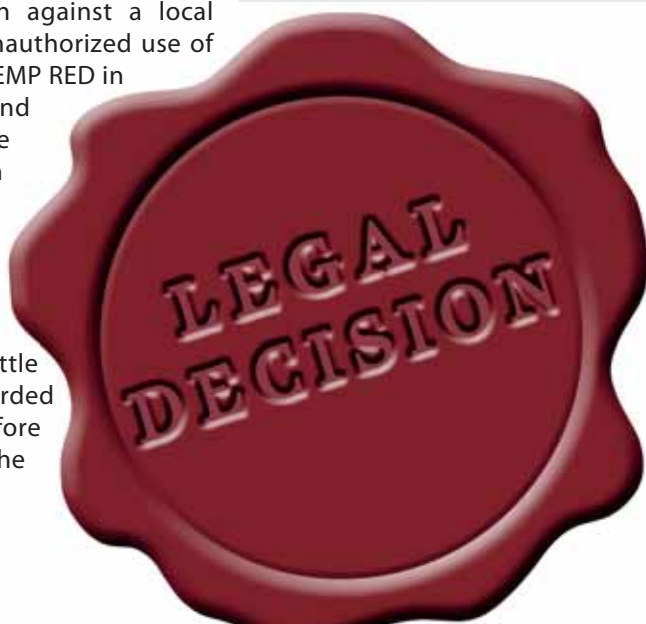
**Illinois Tool Works Inc**  
**v Hardex Corporation Sdn Bhd**

In 2006, HG on behalf of its client had pursued a trade mark infringement action against a local company for the unauthorized use of the trade mark HI TEMP RED in respect of silicone and epoxy glue. The case was finally set down for trial on 7 and 8 March 2011. Clients had come prepared but on the morning of the trial, both parties agreed to settle the matter and recorded a Consent Order before the Judge hearing the case at the Kuantan High Court.

**Agatha Diffusion**  
**v Chamelon Sdn Bhd**

HG's clients had lodged a complaint regarding the misappropriation of its intellectual property right in the trade mark DOG Device. A trade mark infringement action was initiated and once the Writ was served, the Defendant immediately settled the suit which included payment of legal costs and damages, publication of a Notice in Support and signing a Letter of Undertaking to refrain from any future infringement. 

*The above cases reflect that registration of intellectual property rights would be hollow if there were no avenue for owners to protect and enforce their statutory rights. HG is proud that we are able to assist our clients, not only in registering their valuable assets but also concluding contentious legal issues in their favour.*







## MIPA ExCo Appointment

**T**owards the end of 2010 Mr Dave A Wyatt, Head of Patents in our Malaysian office, was unanimously co-opted onto the Executive Committee (ExCo) of the Malaysian Intellectual Property Association (MIPA) for the 2010-2012 term. This is the second time that Dave has served on the Executive Committee, having previously been co-opted for the 2006-2008 term, during which he chaired MIPA's IP Practice Subcommittee that liaised with MyIPO on various operational and practice issues.

In his latest position, Dave has already been active in addressing interpretation of the newly amended patent and trade mark rules (please read the feature article on the front page). He joined other members of the ExCo for a recent meeting between MIPA and MyIPO that discussed the new rules. MIPA was established in 1989 and is one of the key bodies in Malaysia that represents IP owners and practitioners. It plays an important role in promoting and enhancing IP awareness in Malaysia, in particular by organizing regular seminars and training courses, as well as having ongoing dialogues with MyIPO and other bodies charged with the administration and enforcement of IP rights. 📞

## 2011 JPAA IP PRACTITIONERS SEMINAR

**T**he Japan Patent Attorneys Association (JPAA) held the 2011 edition of its IP Practitioners Seminar for the first time in the Philippines recently. It was conducted in cooperation with The Intellectual Property Office of the Philippines and the Intellectual Property Association of the Philippines.

HG's Senior Legal Counsel, Ms Azlina Aisyah Khalid participated in the two-day seminar which ran from 28 February till 1 March 2011 at the New World Makati City Manila Hotel. The attendees gained a comprehensive overview of the Japanese IP system and had stimulating breakout sessions,



discussing recent developments for patent and trade mark practice areas.

The occasion drew a lot of interest and good participation from Malaysia, Singapore, Indonesia, Vietnam, India, Pakistan and Thailand; including the host country. It was a successfully organized event that allowed the attendees to come together and enhance their IP knowledge as well as make new friends and business associates within the Asian IP community. 📞



## Amongst the Greenery - Patent Search Workshop

**M**s Oon Yen Yen and Mr Alvin Boey of Henry Goh conducted a patent search workshop for the research officers of the Biodiversity & Conservation Division of the Forest Research Institute Malaysia (FRIM) on 21 March 2011. The workshop was well received with active participation from the researchers.

Effective internet patent searching is an important aid to researchers in avoiding duplication of R&D efforts, avoiding infringement of third party patents as well as determining patentability of inventions and estimating the commercial value of inventions.

The researchers were advised on the intricacies of various available online databases. Careful choice of a search database is vital since each database covers only a particular set of patent documents and no database has complete coverage of all documents ever published. They were also guided on the formulation of various search strategies and on the use of those strategies.

The informative workshop concluded with an interactive search demonstration: firstly, with a keyword search on a mechanical invention and followed by a keyword+classification search on a biological material invention. 📞

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