



## The Trade Descriptions Act 2011 A New Lease of Protection

**BY AZLINA A KHALID/LIM ENG LEONG**  
**M**alaysia took its cue from the United Kingdom by passing the Trade Descriptions Act (TDA) in 1976. It is to essentially prevent manufacturers, retailers and service providers from confusing consumers with false trade descriptions or misleading conduct in the supply of goods and services.

After 35 years in existence, it has been repealed and replaced with the new Trade Descriptions Act 2011. Enforced since 01 November 2011, salient changes have been made whilst maintaining its original objectives.

An important amendment pertains to the Trade Description Order (TDO) being made available to proprietors of trademarks and common law owners. A TDO is a Court Order that declares any infringing mark or get-up as a false trade description when applied to goods specified in the Order. Under the old Act it is valid for a period of 5 years and used for enforcement purposes. It is deemed as admissible evidence or conclusive proof in court proceedings.

The new TDA now allows only a proprietor of a registered trademark to apply for a TDO, which when granted must be recorded with the Registrar of TDO. Further, it is valid for only one year.

On the bright side, such a limitation should spur more trade mark applications and subsequent registrations. To that end, it is most desirable for the Registrar of Trade Marks to put greater effort in making the registration process more efficient. One positive thing is that an applicant whose mark is misappropriated can now apply for expedited search and examination,

made possible through amendments to the Trade Marks Regulations 2011 but subject to fulfilling certain conditions.

Another aspect of consumer protection introduced in the new TDA 2011 is the punishable offence under Section 20 for false or misleading statements in relation to contests and games of chance; for example promising the moon to "winners" when in fact there is no such prize or subjecting the winnings to monetary conditions. To further assist enforcement against false descriptions, the new Section 44 also makes it an offence (with relevant defenses) to tip-off or disclose information that is likely to prejudice an investigation under the Act.

For any offences defined under the new Act, "personal or domestic use" is now a defense (Section 23) to a person charged but the same will not apply to a body corporate. This exception fosters more accountability as corporations have foremost responsibility in stopping false commercial practices.

A new Section 53 is introduced to facilitate investigation and prosecution, by allowing the admissibility of evidence obtained by an agent provocateur (that abets the commission of an offence for the sole purpose of securing evidence) without it being automatically discredited.

Section 66 now allows the Court to reward whistleblowers with part of the fine (not more than 50%) imposed upon a conviction being secured under the Act, thus encouraging public participation in providing actionable information.

Based on the above, the new



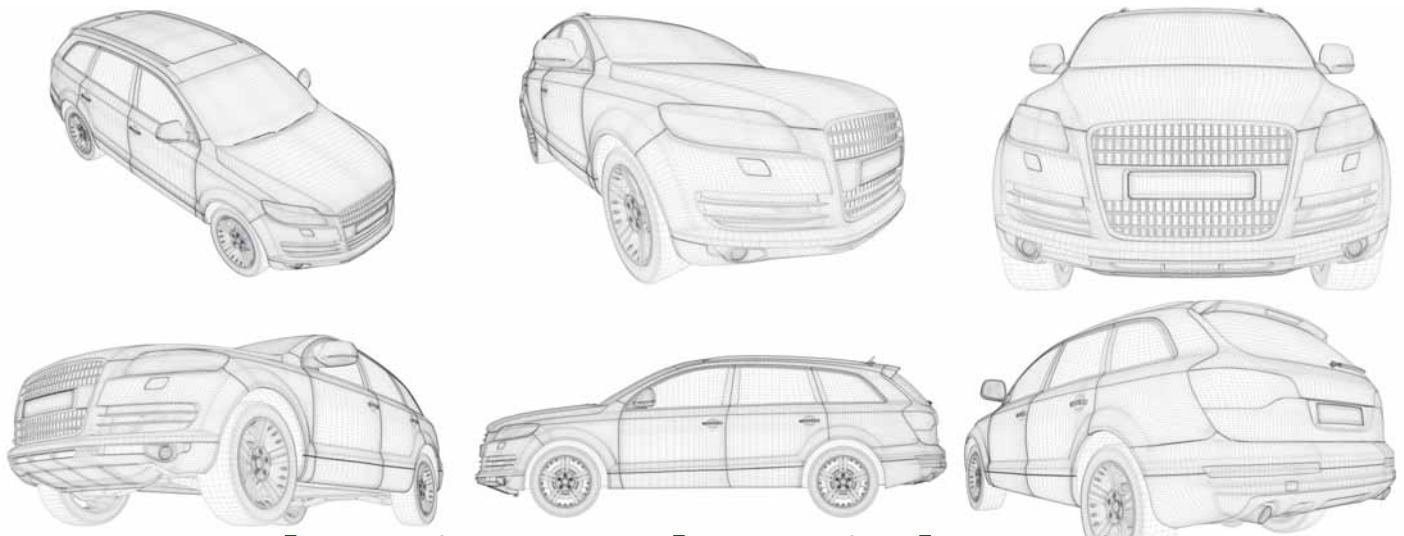
*Thank you for  
voting us Tier 1\*  
in Malaysia again!*

\* Managing Intellectual Property 2012 Survey

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TDA 2011 seems to provide a variety of new features for greater statutory protection and tighter enforcement against false trade descriptions. Being relatively new, it is perhaps too soon to state its effectiveness. We can but hope that the changes brought about will allow more effective protection for Malaysian consumers and foreign brand owners alike. 🏆



## Malaysian Industrial Designs (Amendment) Regulations 2012

**BY JASON CHEAH** **T**he Malaysian Industrial Designs (Amendment) Regulations 2012, which came into force on 15 February 2012, outlined several procedural changes together with a substantial increase in all prescribed official fees.

The key changes in the new fee structure are:

- increased filing fees for a new application;
- increased filing fees for publication of each view of a design;
- increased filing fees for requests for extension of time;
- introduction of a flat fee for renewals, regardless of an industrial design registration's period of renewal;
- removal of official fee reductions for filing and renewal of the second and subsequent designs of a multiple application or registration; and
- introduction of renewal fees for the fourth and fifth renewal periods of UK design registrations that are extended to Malaysia.

With regard to procedural changes, whilst they do not signal any major departure from the previous practice, the amended Regulations have expressly specified or introduced the following:

- an executed Power of Attorney (ID Form 10) is now a filing requirement for all new applications;
- the certified or verified English translation of any non-English priority document must be clear and accurate to the Registrar's satisfaction;

- a maximum of three months is now given to submit the above translation instead of the previous six months;
- a single copy of the representations of an industrial design is now required instead of the previous six; and
- provisions relating to the introduction of e-filing for new applications.

The new Regulations shall affect all applications filed on or after 15 February 2012 and those that have been registered as of that date. Pending applications on the other hand are still subject to the old regulations.

In all, though the amended Regulations will not result in any major change to the way industrial design applications and registrations are handled, it goes without saying that an industrial design registration in Malaysia has now become more costly to file, prosecute and maintain.

In order to avoid incurring unnecessary official fees and to keep them to a minimum, receipt of early filing instructions ought to be regarded as the order of the day. Furthermore, we are adopting the practice of designating only the perspective view(s) of a design for publication by default to further save costs for clients.

Since the submission of an executed Power of Attorney is now a filing requirement, it is imperative to obtain this document from the Applicant before a new application is filed so as to avoid the significant cost of a request for an extension of time.

For the convenience of all our clients, electronic versions of the Power of Attorney (ID Form 10) can be downloaded from our website at <http://www.henrygoh.com/downloads.html>. In addition, MyIPO accepts submission of an advance scanned copy of this form pending receipt of the original.

In the past, Malaysian industrial design law permitted an applicant to file a multiple application for two or more designs belonging to the same International Design Classification with a reduced official fee for the second and subsequent designs. This benefitted those applicants who had a large number of designs to register. However, with the removal of the official fee reduction for the second and subsequent designs, full-rate official filing fees are now being charged for each design in a multiple application, thus appearing to negate the benefit of such an application. Be that as it may, an Applicant still enjoys a modest cost-saving with a multiple application, since only one Power of Attorney is required and payable.

To summarize, it is clear that the amended Regulations will affect the pockets of a prospective Applicant, local or foreign. However, if we were to put things into perspective, the revision in filing fees and the introduction of new ones is timely as this is the very first increase since the Malaysian Industrial Designs Act 1996 and its Regulations came into force on 01 September 1999. 🤖

## WTR 1000 Inclusion



Henry Goh is proud to announce that our Firm is listed as one of Malaysia's Recommended Firms in WTR 1000 The World's Leading Trade Mark Professionals 2012. The WTR 1000 is the only standalone publication to recommend firms and their individual practitioners exclusively in the area of trademarks and identifies the leading players in over 50 key jurisdictions.

Our Senior Legal Counsel and Head of Prosecution, Ms Azlina Aisyah Khalid has been given special mention and is included as one of Malaysia's recommended individuals. Well done and keep up the good work!

# Impending changes in Singapore Patents Law

**BY AMEEN KALANI** **T**his year could very well see the enactment of important legislative changes in Singapore patents law. The proposed changes include the move from self-assessment regime to a positive grant system, requirement for supplementary examination for applicants choosing to rely on a prescribed corresponding application and the lowering of the legal standard for restoration of lapsed patents.

Under the present self-assessment regime, an application that has been examined and found to have claims lacking in novelty and inventive step may still proceed to grant although the merits of doing so are questionable. The legislative changes will introduce the pre-requisite for a Notice of Eligibility before an application can proceed to grant. This Notice will be issued only when each claim in the application satisfies the requirement of Section 13 of the Singapore Patents Act, namely novelty, inventive step and industrial applicability.

Currently, applicants relying on the final search and examination results of a prescribed corresponding

application may request grant of a patent without further search and examination. Under the proposed changes, applicants need to request for Supplementary Examination to ascertain the patentability of each claim. A Notice of Eligibility will be issued only when the requirements of Section 13 are fulfilled after Supplementary Examination.

Introduction of the Notice of Eligibility as a pre-requisite to grant can be seen as an important development to further enhance the quality of patents being granted.

The present legal standard for restoration of a lapsed patent is that the proprietor must demonstrate reasonable care had been taken to pay renewal fees within the prescribed period or that that fee and any prescribed additional fees were paid. This standard is similar to the previous Section 28 of the UK Patents Act 1977. The proposed change could see the standard shifting to a less burdensome one of inadvertent or unintentional failure on part of the proprietor to pay the renewal fee which is contained in current Section 28 of the UK Patents Act. 📄

## Henry Goh Welcomes New Patent Agents

Congratulations and felicitations to Eng Leong, Qi-Guang, Shiela and Wan Sia who are now Registered Patent Agents! In order to qualify, they had to sit for a Patent Agent Examination set by MyIPO and to help them prepare for it, regular tutorials were conducted by Mr. Dave Wyatt, Head of Patents & Industrial Design. Various intellectual property legislations, international conventions and treaties were covered. Assignments were also given to test the candidates' understanding.

The Patent Agent Examination, comprising of technology, patent laws & drafting, trade mark, industrial design & geographical indications and foreign IP papers, took place over the course of one week in October 2011. Our candidates did very well overall and kudos to "Cikgu" Dave for his dedication. Henry Goh is proud that our newly minted agents have achieved another rung in their IP career ladder. 📄



# Soaring with Eagles!

**35**  
YEARS  
1977 – 2012

To kick-off our 35th Anniversary celebrations, the people of Henry Goh were treated to 3D2N trip to Malaysia's fabled Langkawi Island recently.

The accommodation of choice was Holiday Villa Resort and the festivities began with a beach front barbeque dinner on the first night.



Soon after breakfast Saturday morning, the group went island hopping, travelling on speedboats. The first port of call was 'Beras Basah Island' where all had fun in the sun. We then witnessed an eagle feeding session watching those majestic birds circling for food and picking them off the waters. Thereafter it was a visit to the legendary Island of the Pregnant Maiden complete with a tiring trek to its fresh water lake. The morning ended with a simple but delicious lunch on yet another island.



Back on land, next on the itinerary was a tour of the Underwater World followed by a breathtaking cable car ride up the Mat Cincang Cambrian Geoforest Park, which included a walk on the exhilarating Skybridge. A mandatory group photo was later taken at the iconic Dataran Lang in time for sunset. The day wound down with a delicious Thai dinner in Kuah town with some spare time to engage in Malaysians' favourite hobby – shopping!

Come Sunday, the hotel organized a friendly tele-match and competition was stiff. The games were highly entertaining thanks to the participants' antics and congratulations are in order for the winning Team Kuah! Post lunch we boarded our planes back to Kuala Lumpur tired but in high spirits after such an enjoyable week-end.



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