



Getting Down and Personal

BY AZLINA A KHALID The Personal Data Protection Act (PDPA), passed by Parliament in June 2010 is expected to come into force within the year. Previously, information of a personal nature was protected as confidential information through contractual obligations or the common law, save for certain sectors. With the coming enforcement of the PDPA, there will now be a regulatory framework as to how personal data is allowed to be used.

The key objective of the PDPA is to control the processing of personal data by data users in the context of commercial transactions with the intention of safeguarding the data subject's interests.

Processing has been defined in the PDPA to include collecting, recording, holding or storing personal data or carrying out any operation or set of operations on the personal data which can include, among others, the disclosure and alteration of personal data. Personal data processed by an

individual for personal, family, household and recreational purposes are excluded from the provisions of this Act. Interestingly, the Federal and State Governments are also exempted from the PDPA provisions.

The PDPA has introduced 7 Principles of data protection. In addition, the scope of the PDPA will encompass the registration of Data Users, the creation of a Consumer Data Forum, the establishment of a PDP Commission and the appointment of a PDP Commissioner. A Provident Fund will also be created together with the PDP Advisory Committee and Appeal Tribunal. Procedures on inspection, complaints, investigation and enforcement are also in the pipelines.

To date, the Ministry of Information, Communications and Culture (MICC) in Malaysia has set up a Data Protection Department to oversee the implementation of the PDPA. Detailed guidelines and codes of practice are expected to be issued by MICC. This would be considered as critical in clarifying more precisely the extent of application and practical recommendations for compliance. A breach of any of the data protection principles is tantamount to a criminal offence and can attract significant penalties.


The PDPA will have a strong impact on a broad spectrum of business and companies as well as regulating cross-border commercial transactions. Its efficacy will only be realized in time and it is hoped that the law will achieve its objectives once enforced. 



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THE 7 PDPA PRINCIPLES

- 1. The General Principle**
Personal data cannot be processed without consent.
- 2. Principle of Notice and Choice**
Data user must give information and purpose of data used and data subject has the right to request access.
- 3. The Principle of Disclosure**
Data user must disclose the purpose for which data is collected and use it for the said purpose only.
- 4. The Principle of Security**
There must be adequate protection and precautionary measures to ensure collected data is safe from any loss, misuse, modification, unauthorised access or disclosure, alteration or destruction.
- 5. The Principle of Storing**
Any personal data shall not be kept in a processing system longer than needed.
- 6. The Principle of Data Integrity**
All personal data must be accurate, complete, non-confusing and up-to-date in line with the purpose of its storing and processing.
- 7. The Principle of Access**
A user must be given access to his/her own personal data if kept by another user and allowed to update said data. 

The Industrial Designs (Amendment) Act 2013



BY JASON CHEAH **T**he Industrial Designs Bill was passed by the Malaysian Parliament on 20 December 2012 and subsequently gazetted on 22 January 2013 as the Industrial Designs (Amendment) Act 2013, which will come into force on 01 July 2013.

In conjunction with the amended Act, the Malaysian IP Office is also expected to introduce amendments to the Malaysian Industrial Design Regulations which are required for consistency with the amended Act.

The primary changes included in the amended Act are as follows:

1. Standard of novelty is now worldwide;
2. Period of registration extended to 25 years;
3. Replacement of the Government Gazette with an Intellectual Property Office Journal;
4. Industrial design registrations are now classified as personal property, capable of being assigned, transmitted as well as be used as a security interest transaction; and
5. Introduction of a time limit for recording any assignment, transmission, other operation of law or security interest transaction.

We now briefly discuss the changes:

Firstly, the adoption of a worldwide novelty standard brings Malaysia in line with the practices of most other jurisdictions, including our neighbours Indonesia, Philippines, Thailand and Singapore.

Secondly, the extension of the period of registration from the current maximum of 15 years to the new maximum of 25 years is a welcome change as it will also be applicable to any industrial design registered prior to 01 July 2013, and is on par with the maximum registration period for United Kingdom and European Community design registrations. This is in contrast with Indonesian and Thai design registrations (maximum period of ten years) as well as Philippine and Singaporean design registrations (maximum period of fifteen years).

The timing of the introduction of the Amendment will no doubt benefit the owners of industrial design registrations filed when the Industrial Designs Act 1996 was enforced on 01 September 1999. These early registrations which are due to expire at the end of the fifteenth year, will instead be eligible for another two consecutive 5-year terms.


Thirdly, the introduction of a dedicated Intellectual Property Journal is another welcome change aimed at expediting the publication of

intellectual property related matters including industrial designs that have proceeded to registration.

Next, in line with the new emphasis placed on recognizing an industrial design registration as personal property, the Malaysian IP Office has also launched a new initiative to develop the necessary knowledge and skills to determine the value of intellectual property rights.

Finally, the amended Act further introduces a six-month time limit by when any assignment, transmission, other operation of law or security interest transaction should be recorded.

In conclusion, although the Industrial Designs (Amendment) Act 2013 will be well received, a much needed amendment to update the legal definition of an industrial design (which is presently limited to the features of shape, configuration, pattern or ornament applied to an article by any industrial process or means) has yet to be undertaken. It is hoped that this aspect of industrial design protection will be given due attention come the next round of amendments.

A follow up article looks to be in order after the amended Act and new regulations are enforced. 

Imminent Changes To Singapore Patents Law

BY AMEEN KALANI
Legislative changes to Singapore patents law will see a shift from "self assessment" regime to a "positive grant" system. These changes will affect prosecution and examination of patent applications filed on or after commencement date of the new legislation which is expected to be in the third or fourth quarter of 2013.

The salient points to note for changes to patent prosecution include:

- Every patent application having to undergo substantive examination;
- Every claim in a patent application satisfying patentability requirements;
- Patent application qualifying for grant through a Notice of Eligibility;
- Possibility of patent application being refused due to unresolved patentability issues.

The patent prosecutions options available to the applicant are:

1. By 13 months file a request for a new search report and subsequently by 36 months file a separate request for substantive examination report;
2. By 36 months file a request for combined new search and substantive examination report;
3. By 36 months file a search report from foreign route application or PCT application together with a request for substantive examination report;
4. By 54 months file prescribed information and documents together with a request for supplementary examination.

Time periods are calculated from the priority date, international filing date or actual filing date, whichever is applicable. Deadlines for all

prosecution options can be extended by 18 months subject to payment of extension fees and further extensions may be possible.

While the first 3 options are not new, their associated time periods will change. The fourth option is new and will require applicants intending to rely on a positive International Preliminary Report on Patentability (IPRP), grant of a prescribed corresponding foreign patent or allowed claims from such an application to undergo substantive examination in Singapore. The present fixed deadline for grant of a patent will be replaced by a 2-month period from date of issuance of a Notice of Eligibility.

This is only a summary of the legislative changes and is not intended to constitute legal advice. For more information, kindly contact us at singapore@henrygoh.com.

Swiss Bliss Now Restored

BY LIM ENG LEONG
Following the High Court battle reported in our August 2010 issue "The Swiss Bliss is Dismissed", the Chocosuisse case (Civil Appeal No. W-02-602-2010) has now prevailed.

To recap, the High Court had earlier decided that the use of the words 'Maestro Swiss' on the Respondents' chocolate products would not lead the ordinary chocolate-buying public in Malaysia into believing that such chocolates were made in or imported from Switzerland. This was premised on the finding that the trade description 'Swiss chocolates' did not appear anywhere on the Respondents' product packaging and the chocolates were made in Malaysia. It was also decided that the market survey conducted by the Appellants was unreliable and that the first Appellant has no locus standi to commence the suit because they did not carry out any form of chocolate business here.

The quorum of three judges in the Court of Appeal nevertheless unanimously decided in favour of the Appellants. Zaharah binti Ibrahim JCA held that the first Appellant does have the requisite locus standi to initiate the action under common law and the Geographical Indications Act 2000, though the latter was inapplicable in

this instant. The court relied heavily on a similar action in the English case (*Chocosuisse Union des Fabricants Suisses de Chocolat & Others v Cadbury* [1998] RPC 117) and held that members of the first Appellant share a common interest and goodwill. Thus Swiss chocolate traders are entitled to safeguard their interests against any misdirected designation of Swiss origin.

As for the Appellants' plea of extended passing-off, the Court relied on the same case where the test was whether those members of the public, for whom 'Swiss chocolates' have a reputation, will be confused into believing that the Respondents' chocolate products can legitimately bear that designation because of recognizable and distinctive qualities. The answer was 'YES'. The panel further concurred with the High Court judge that caution must be exercised before accepting a survey conducted by or on behalf of only one party in a dispute. However, this is not the same as total disregard of such surveys and the Panel found that the High Court had erred when it did not at all consider the results of the random survey conducted.



Upon examination of the evidence adduced and on a balance of probabilities, the Court of Appeal held that the Respondents had consciously used the phrase 'Maestro Swiss' on the packaging so as to give a connotation of links to Switzerland. Evidence further showed that the Respondents had even registered a Swiss company, Chocolate Vochelle S.A, which is now in liquidation. Thus it was perceived that the choice of using the word "Swiss" was deliberate and misleading since the products were wholly manufactured in Penang.

It is this writer's view that the decision reached by the Court of Appeal was correct. This case will be welcomed by foreign brand owners and lends credence to Malaysia's ongoing efforts to have a strong intellectual property protection system.



No. 1 Celebration!



For the 5th consecutive year, HG has been ranked Tier 1 Firm for patent and trade mark prosecution work in Malaysia. The People of Henry Goh celebrated this double achievement on 04 April 2013. First, they took off from work early and enjoyed a delicious East West Fusion Hi-Tea spread at Zang Toi Café. There was also a complimentary lucky draw of two special edition T Shirts by the famed designer himself. The evening continued when the staff caught the latest action flick "G.I. Joe : Retaliation". With popcorn and drinks in hand, all the HG Joes and Janes had a thrilling end to a wonderful evening.



Lucky Winners!



Happy faces @ the movie

IPharm Seminar & Workshop

Henry Goh recently conducted a one-day Intellectual Property seminar and Patent Search Workshop for the Institute of Pharmaceuticals and Nutraceuticals, Penang (IPharm) of the Ministry of Science, Technology and Innovation (MOSTI) on 26 March 2013. The seminar, attended by 40 researchers of IPharm was very well received.

Ms. Oon Yen Yen started off with an introduction to plant variety protection and patents followed by a stimulating talk on interpreting the scope of protection of a granted patent. A brief insight on trademarks, copyright and geographical indications presented by Pn. Azlina Aisyah Khalid concluded the morning session. Later, an interactive patent search workshop conducted by Ms. Oon and Ms. Shiela Ho introduced the various search databases covering patent and non-patent literature available online. Coaching on formulating effective search strategies to ascertain research trends, checking competitors' activities, assessing patentability of an invention and/or validity of a granted patent were also provided. The exchange of information and ideas during the Q&A sessions wrapped up a day of training that was enjoyable and productive for the participants and presenters alike.



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