



HENRYGOH

Intellectual Property Updates

KDN NO.: PP12637/08/2013(032554)

Issue #2, August 2012

*"New Patent Law
in Brunei from
01 January 2012"*

*"Brunei joins the Paris
Convention effective
17 February 2012"*



*"Brunei joins the
Budapest Treaty
effective
24 July 2012"*

*"Brunei joins the
PCT effective
24 July 2012"*

CONTENTS:

- All Change for Brunei Patents
- Voluntary Notification of Copyright
- The TWISTER Industrial Design Cases
- Prospective Infringement under Medicines Act
- Conferences and Seminar
- News at Henry Goh

All Change for Brunei Patents



BY DAVE A WYATT Brunei Darussalam's Patents Order, 2011 came into force on 01 January 2012. Following that, on 17 February 2012 Brunei became bound by the Paris Convention, and on 24 July 2012 the country's accession to the PCT and Budapest Treaty took effect.

The Patents Order repeals the Inventions Act 1925 and establishes for the first time an independent patent system for the receipt, processing and grant of patents by a new Patent Registry Office (PRO) under the care of the Brunei Economic Development Board.

The substantive and procedural aspects of the new law closely mirror those of the Singapore Patents Act 1994. English is the official language of the patent grant procedure.

Brunei's accession to the PCT will be of particular interest to foreign

IP owners. It will allow applicants in many cases to pursue a streamlined prosecution process by relying on the results of the international preliminary examination.

Under the old Inventions Act 1925, patent protection was secured in Brunei by re-registration of a patent granted in the United Kingdom (including via the EPC), Malaysia or Singapore within three years of its grant. The transitional provisions allow for continued re-registration of such a patent ("qualifying patent"), as follows:

1) Any re-registration application filed before 01 January 2012 will be processed under the old Act.
2) Any qualifying patent that is granted no more than three years before 01 January 2012, and is in force on that date, may be made the subject of an application for re-registration under the old Act within two years of

01 January 2012, that is until 31 December 2013.

3) An application for a qualifying patent that is pending as of 01 January 2012 may be made the subject of an application for re-registration under the old Act within 12 months of the grant of that patent.

All existing re-registration patents, and those obtained under provisions 1) to 3) above are now subject to the payment of local annual fees. Under current PRO practice, an application for renewal must be accompanied by evidence that the basic foreign patent has not been revoked.

For further information, please do contact us or refer to our website's Law and Practice Updates section where there is now a dedicated page for Brunei. 

Voluntary Notification of Copyright

BY LIM ENG LEONG Since 01 June 2012, copyright stakeholders can now voluntarily notify the Copyright Controller of their claims and deposit a copy of an eligible work with the Intellectual Property Corporation of Malaysia (MyIPO) for recording. The types of work acceptable include literary, musical and artistic works, films, sound recordings, broadcasts and derivative works recognized by the Copyright Act 1987.

A notification shall contain particulars such as details of the copyright owner, details of the author(s), a Statutory Declaration to assert the applicant's locus standi, a copy of the work, date and place of first publication, and accompanied by the prescribed fee. Accuracy of the information entered into the Register

is dependent on the information provided by the applicant.

Either hard or electronic copies are permitted, depending on the nature of the work to be deposited. Official fees also depend on how voluminous the work deposited is. If a replacement is required by the Controller, it must be provided within 30 days of the request; otherwise the notification is deemed as withdrawn.

If the notification is in order and upon its successful entry into the Register, the Controller shall inform the Applicant in writing. The Applicant may go one step further and request for a proper certificate to this effect by filing a form and paying the prescribed fee.

Despite its voluntary nature, the notification does have a profound

effect on admissibility of evidence. This is because the original presumption of ownership under the Act is maintained and any certified extracts from the Register shall be prima facie evidence of the particulars therein and shall be admissible in all courts.

Since there is no substantive examination of the work deposited, the process of having the notification recorded should be quick and painless. No doubt there are still no actual formalities to register copyright here because of automatic protection from the Berne Convention. However, since most copyright owners have for years been demanding for a more tangible form of protection similar to their trade mark and patent peers, the new Regulations can be seen as a fulfillment of such a request. 

The TWISTER Industrial Design Cases

BY AZLINA A KHALID Tropicana Products, Inc (a subsidiary of PepsiCo, Inc) obtained a Malaysian Industrial Design (ID) Registration MY 06-00624 on 10 February 2006. The registered ID was used in relation to the TROPICANA TWISTER bottle products launched in 2008 where the product with its novel and attractive bottle design enjoyed significant commercial success. Subsequently it was discovered that some parties had infringed the registered ID. Tropicana then issued various Writ actions for industrial design infringement against four different entities at the Kuala Lumpur High Court bearing the following Suit Numbers:

1. Civil Suit No. D-22IP-12-2010
2. Civil Suit No. D-22IP-41-2010
3. Civil Suit No. D-22IP-59-2010
4. Civil Suit No. D-22IP-66-2010

Tropicana also initiated invalidation actions against two registered IDs which belonged to one of the Defendants in the abovementioned suits and another foreign Respondent under Kuala Lumpur High Court Originating Motion No. D-25IP-10-2010 and Kuala Lumpur High Court Originating Motion No. D-25IP-1-2011 respectively.

All the six actions were filed at the Malaysian IP High Court and there was a decision by the presiding Judge to



* Image reproduced with permission from Tropicana Products, Inc/PepsiCo Malaysia Sdn Bhd.

hear these cases simultaneously. The trial commenced in August 2011 and stretched until October 2011, covering three separate sittings with nine days of trial in total.

On 03 July 2012, the Court pronounced a Judgment in favour of Tropicana, affirmed and confirmed that it had succeeded in establishing industrial design infringement in all the four suits where the Defendants' bottles were adjudged and deemed as obvious imitations of Tropicana's registered ID. In summary, the following orders were granted against the Defendants:

- (a) Injunction;
- (b) Discovery;
- (c) Delivery-Up;
- (d) General Damages; and
- (e) Costs.

As for both invalidation actions, the Court also agreed with Tropicana and subsequently revoked the relevant Respondents' registered industrial designs for lack of novelty.

Henry Goh is proud to be part of these landmark cases wherein we had acted as Tropicana Products, Inc's Industrial Design Agent. From day one, we provided our client with various industrial design opinions, advisory and full litigation support services for all the six cases. 

PROSPECTIVE INFRINGEMENT UNDER MEDICINES ACT

BY AMEEN KALANI In the Singapore case of *AstraZeneca AB (SE) v Sanofi-Aventis Singapore Ltd* [2012] SGHC 16, plaintiff and defendant were engaged in research, development and manufacture of healthcare products. The plaintiff owns a patent for a pharmaceutical composition which is composed of an active ingredient called Rosuvastatin Calcium and a stabilizer composed of an inorganic salt in which the cation was multivalent.

The defendant had applied to the Singapore Health Sciences Authority (HSA) for product licenses in respect of Rosugard film-coated tablet in various dosages. In their application, the defendant declared that the plaintiff's patent will not be infringed by doing of the acts for which the licenses were sought.

As required by HSA, the defendants served a notice on the plaintiff stating that to the best of their belief, the plaintiff's patent will not be infringed since the compositions for which the licenses were sought do not comprise an inorganic salt in which the cation was multivalent.

It was undisputed that there was no past act of infringement by the act of the defendant in applying for product licenses and as such no action could be brought under the Patents Act.

The plaintiff had commenced an action under Section 12A of the Singapore Medicines Act which it alleged provided a separate and independent cause of action from the Patents Act. The Medicines Act is a legislation that was enacted in 2004 to enable Singapore to fulfill part of its obligations arising from the United States-Singapore Free trade Agreement.

According to the Plaintiff, Section 12A allowed commencement of pre-emptive action in anticipation of the defendant committing the patent infringement by carrying out of the acts for which the product licences were sought.

The Court analysed the provisions of Section 12A together with its accompanying subsidiary legislation and concluded that it allows for taking out of an action for declaration of prospective or future infringement which is separate from the civil action

for patent infringement under the Patents Act. It was concluded by the Court that under this Section, it will be necessary to assess the theoretical aspect of infringement, that is, whether the products for which the product licences were sought fall squarely (pith and marrow) within the claims of the patent.

The Court noted that Section 12A is pro-patentee as the applicant for a product licence is forced to reveal the composition of its product upon taking out of an action by the plaintiff and that until that point it is not possible to strike out the plaintiff's case. The defendant's risk of revealing such confidential information may be mitigated by applying to the Court for the information to be restricted to certain persons or for the plaintiff to undertake not to use the information for purposes outside the Court action. Defendant's application to strike out plaintiff's Statement of Claim was dismissed. 

Conferences & Seminar



Melbourne, Australia



Washington, USA



Kuala Lumpur, Malaysia

It has been a busy first half of the year for the Firm.

Our Director, Mr. Ameen Kalani, Senior Legal Counsel, Ms. Azlina Aisyah Khalid and Business Development Manager, Ms. Oon Yen Yen, attended the FICPI World Congress in Melbourne, Australia from 17 to 20 April 2012. The Congress was an excellent opportunity to exchange views and participate in discussions with our IP peers from around the globe.

Henry Goh was also represented at the 134th INTA Meeting held in Washington D. C. from 05 to 09 May 2012 by our Executive Director, Mr. Dave A. Wyatt, Director, Mr. Ameen Kalani and Legal Counsel, Mr. Lim Eng Leong. With a record attendance of more than 9,500 this year, it proved to be a fruitful time of renewing old ties and establishing new contacts amongst fellow professionals.

On 10 July 2012, we co-hosted an IP seminar with the Malaysian

Dutch Business Council at the Holiday Inn Kuala Lumpur Glenmarie. In addition to our speakers, the audience had the opportunity to hear from Dr. Woon Weng Chuen, representing the Forest Research Institute Malaysia, who gave an IP owner's perspective on IP management and commercialization. The seminar ended with a briefing on the upcoming developments in Malaysia's IP laws by the Deputy Director General of the Malaysian IP Office, Pn. Shamsiah Kamaruddin. 



Continuing the year-long 35th Anniversary celebration!



Event: "One Earth, One Home Run" Date: 22 April 2012

Organised by Space U8 Mall, Shah Alam, the People of Henry Goh participated in support of the run's green theme. Even the T-shirts worn were green in colour, made of 100% organic cotton. The run ended with pledges to sustain a greener environment.



Event: Bowling @ Tropicana Golf & Country Resort Date: 23 June 2012

We struck the bowling alleys at Tropicana Golf & Country Resort that Saturday morning for a friendly competition involving 7 teams. Team "Mama Vogue & Boy" emerged victorious with an impressive score. All winners went home with cash prizes and trophy-bowls.



Event: Visit to Rumah Jalanan Kasih, Cheras. Date: 14 July 2012

A home established for underprivileged children run by a charitable organisation. The children were treated to a fast food lunch and received goodie bags containing shoes and clothes for the coming Hari Raya celebration, toys and cash contributions from the staff and management of Henry Goh.

MALAYSIA

Henry Goh & Co Sdn Bhd (332744-A)
House of Henry Goh, 217, Jalan Imbi,
55100 Kuala Lumpur, MALAYSIA.

☎ + (603) 2118 8688
☎ + (603) 2118 8777
✉ hgoh_kl@henrygoh.com

SINGAPORE

Henry Goh (S) Pte Ltd (199203221-E)
20, Science Park Road, #03-34/35, TeleTech Park,
Singapore Science Park II, SINGAPORE 117674.

☎ + (65) 6333 9525/6
☎ + (65) 6333 9527
✉ henryspl@singnet.com.sg

© 2012 Henry Goh & Co Sdn Bhd. All rights reserved. Information herein is based on reliable data, published in good faith to give an overview of events and issues in intellectual property. Interested parties are advised to contact the company for further details prior to relying on the contents of this newsletter. Views expressed by the writers herein are their own and do not necessarily reflect those of Henry Goh. Other trademarks and images are the registered property of their respective proprietors and used here merely for illustrative purposes.