



HENRYGOH

Intellectual Property Updates

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NEW Email Addresses

**Effective 01 January 2013,
our new corporate
email addresses are**



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Dear Clients and Associates

Welcome to this latest edition of our in-house newsletter Henry Goh Intellectual Property Updates where we keep you updated on IP matters in our corner of the world. I do hope you find the content useful and informative.

This year we have been celebrating our 35th anniversary and in 2013, our Singapore office will turn 15. As one of the longest established IP agencies in Malaysia, our select teams of professionals with their combined knowledge and extensive practical experience from various disciplines make us the prime choice for protecting vital IP assets.

Indeed, our depth of experience and quality of service has been recognized once again in 2012. We were ranked in Tier 1 of MIP's World-wide Survey of IP Firms for both our trade mark and patent prosecution work in Malaysia, and listed in WTR 1000 where our Senior Legal Counsel Ms Azlina A Khalid was highly recommended. Azlina and our Head of Patents Mr Dave A Wyatt were also nominated for Asialaw's Leading Lawyers Guide.

2012 has certainly brought about significant IP developments. Brunei's new independent patent law came into force and the Singapore Patents (Amendment) Act 2012 was passed as the first step towards adopting a positive grant system. As for Malaysia, we look forward to the country's accession to the Madrid Protocol under the proposed law reforms.

In this current challenging economic climate, IP assets acquire an even greater importance for the competitive advantage they provide. Accordingly, I invite you to keep Henry Goh on your IP radar and experience our award-winning professional services.

Lastly, I would like to take the opportunity to thank all our clients and associates for the business you have entrusted to us in 2012, and to wish everyone a peaceful and happy New Year. 🎉

Yours truly

Karen Goh
Managing Director



PC FAIR VS PC EXPO

BY LIM ENG LEONG In *Shaifubahrim b. Mohd v EM Exhibitions (M) Sdn Bhd & Wong Lee Chen* [2012] 9 MLJ 84, we witness the tussle between the use of the trade marks PC FAIR and PC EXPO. The Plaintiff represented PIKOM, which is the acronym for "Persatuan Industri Komputer dan Multimedia Malaysia" – an association representing the information and communication technology (ICT) industry in Malaysia. PIKOM had secured a 1998 trade mark for PC FAIR in respect of computer exhibitions and publication of materials relating to ICT in Class 41.

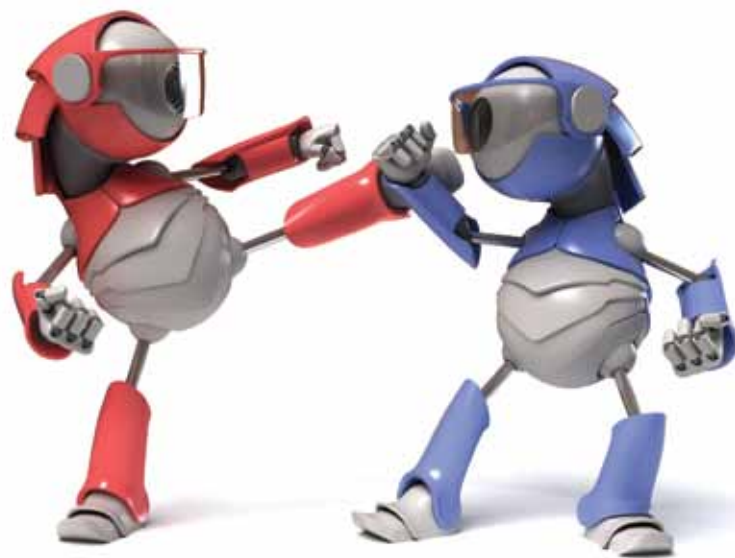
The First Defendant is a company that started organising a computer-related exhibition called 'PC EXPO' since October 2010. Interestingly, the Second Defendant was a former employee of PIKOM until May 2010 when she left to establish the First Defendant. The suit thus dealt with the

Plaintiff's claims of confusion between the trade marks used and the confidentiality which resides in its exhibitors database, pricing information and layout plans obviously known to the Second Defendant.

The High Court held that the mark 'PC FAIR' would mean computer fair to the public and such descriptive words are commonly used within the ICT industry. Notwithstanding the registration owned by the Plaintiff (which actually included a disclaimer to the separate words) it would deprive others from using generic words that are part of the English and IT vocabulary.

The Judge then decided that on comparison, there was no likelihood of confusion as alleged since the marks are different in expression. Thus, there was neither infringement nor passing-off by the Defendants.

Nevertheless, it was found that the Defendants had violated the Plaintiff's confidential information for a variety of reasons, which included the Second Defendant having been an ex-PIKOM employee and the fact that the exhibitors database was accessible only to limited personnel. It was proven during trial that almost 90% of the PC EXPO exhibitors are regular PC FAIR exhibitors. 🤖



India's Traditional Knowledge Digital Library

BY AMEEN KALANI India's Traditional Knowledge Digital Library (TKDL) which was established in 2001 is a home-grown effort to ensure patent offices around the world do not grant patents for applications founded on India's wealth of traditional systems of medicine and contains to date more than 262,000 formulations.

The idea to establish TKDL came to the fore amid India's efforts to revoke the patent granted by the United States Patent and Trademark Office on wound healing properties of turmeric and the patent granted by the European Patent Office (EPO) on the antifungal properties of neem.

The TKDL connects patent examiners around the world with India's books of traditional knowledge in five international languages which are English, German, French, Japanese and Spanish. It is available to all patent offices that have signed a TKDL Access Agreement which

non-disclosure mechanisms to safeguard India's interests and counter any possible misuse. Under such an agreement, patent examiners may use the TKDL for search and examination purposes only and its contents may only be revealed to third parties for the purposes of citation. India has signed TKDL Access Agreements with the EPO and the patent offices of Australia, Canada, Germany, the United Kingdom and

the United States.

Since its inception, the TKDL has achieved numerous successes. In 2009 Swiss giant Nestle applied for a patent to protect a product based on cow's milk to treat constipation. TKDL fought off Nestle's attempt at the European Patent Office to secure a patent on the grounds that using cow's milk as a laxative was mentioned in ancient texts and was therefore not new. In 2012, the Procter & Gamble Company withdrew their patent application "Personal care compositions comprising an antimicrobial blend of essential oils or constituents thereof" based on TKDL evidence.

TKDL has become a model for other countries on defensive protection of their traditional knowledge from misappropriation. Countries and organizations such as South Africa, African Regional Property Organization (ARIPO), Mongolia, Nigeria, Malaysia and Thailand have expressed their keen desire to replicate TKDL. 🤖



Patents Come Alive The Sequel



BY DAVE A WYATT

Last year (HGIPU, August 2011, Patents Come Alive), we reported on the Kuala Lumpur IP High Court patent case of Ranbaxy (Malaysia) Sdn Bhd v E.I. Du Pont de Nemours and Company.

The plaintiff (Ranbaxy) had obtained marketing approval from National Pharmaceutical Control Board for its generic drug COVANCE that contained potassium losartan as active ingredient. The defendant (Du Pont) was the owner of Malaysian patent MY-110414-A that protected the original drug COZAAR. Ranbaxy applied to invalidate claims 7 and 8 of the patent that related to potassium losartan in crystalline form. Du Pont counterclaimed for infringement of those claims. In the High Court, the validity of the two claims at issue was upheld and infringement found. An injunction was granted as well as orders for delivery up and destruction of Ranbaxy's existing stock and recall of their product from the market.

Ranbaxy appealed to the Court of Appeal, initially based on the whole of the lower court's findings but later confining their case to two grounds: a procedural issue that the respondent (Du Pont) did not make any physical appearance in court before the trial judge to defend the action or prosecute the counterclaim, and the alleged invalidity of the claims in suit.

The Court of Appeal dismissed the procedural point. There was no law to the effect that a party to a civil action must personally attend court and give evidence to support its claims. The respondent (Du Pont) had called a total of seven witnesses and tendered

numerous exhibits in support of its defence. The fact that no representative of the respondent had attended court for the trial was not fatal in any way.

On the validity of the claims, the appellant had argued there was insufficiency of disclosure, i.e. that the specification of the patent did not disclose adequately how to obtain potassium losartan in crystalline form. However, at trial the respondent had called two technical experts as witnesses, each of whom had conducted experiments following the instructions in the patent for making the relevant described example. In each case, these experts had obtained crystalline potassium losartan that was the core ingredient of the claims. This evidence had not been challenged or contradicted by Ranbaxy at trial, and the Court of Appeal determined that the trial judge had correctly accepted the findings of these expert witnesses. A further attack on validity, on the basis that counterpart foreign patents did not contain the claims at issue, had been rejected by the trial judge, on the ground that a distinction had to be made between the requirements of normal and modified examination. The Court of Appeal fully endorsed the trial judge's opinion on this aspect. Accordingly, the appeal was dismissed in its entirety and the lower court's judgement affirmed.

It is rare for a patent dispute in Malaysia to reach the Court of Appeal. This decision is a welcome addition in the development of local case law and a strong signal of the growing importance attached to intellectual property in the country. 🇲🇾

APAA 2012 Chiang Mai



L - R : Andrew , Ann , Ameen

The 16th APAA General Assembly was held in the historical city of Chiang Mai, Thailand from 27-31 October 2012. Participating members and foreign observers from various countries converged for an exchange of information, IP updates and networking opportunities. Henry Goh was represented by Singapore Director, Mr. Ameen Kalani, Patent Manager, Ms. Ann Chong and Patent Agent, Mr. Andrew Siew.

The warm hospitality of the host nation coupled with the exotic Thai culture and culinary delights were in tandem with Chiang Mai's generally warm weather. Social events were also organised for the attendees to experience the best that Chiang Mai has to offer namely the lush green mountainside and striking temples around the city. The finale was held at The Royal Flora Ratchapruek where everyone enjoyed a farewell dinner whilst entertained by Thailand's leading contemporary artists. 🇹🇭

35
YEARS
1977 – 2012

HENRY GOH 35 YEARS ANNIVERSARY CELEBRATION

After months of various planned activities, 20th October 2012 saw nearly 200 people come together at the Topaz Ballroom, One World Hotel to enjoy a spectacular dinner evening of pomp and splendour. It was the culmination and final item on the agenda in celebrating the Firm's 35th anniversary.

The night began with a video presentation of the Firm's history showcasing its highlights and accomplishments followed by a welcome speech by our Managing Director. An 8 course dinner was then served topped with a choice of desserts. Interspersed with dinner service was a full night's entertainment that included dance numbers, games and a special performance by Mr. Andrew Siew and Ms. Joanne Wong. The Khoong Brothers were the closing act and had the crowd in stitches with their performance and comedy skits. There was also an Appreciation Award ceremony where each staff was called onto the stage to receive a token of appreciation. Then there was the ceremonial cake cutting and toast led by the Directors and Heads of Departments as well as a lucky draw. The event was especially meaningful to the people of Henry Goh where everyone was pivotal in making the Firm a name in IP excellence. Here's to the next 35 years!



Oppa HG Style ...



The lucky winners.



HG Beauties in a row.



"I do ... I really do!"

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