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Excerpt from Judgement:

"What the Registrar had done is exactly what is prohibited. The registrar had broken up or dissected the Appellant's mark into three components... that the Appellant's mark is not distinctive because "HIGH" on its own means something, "TEMP" on its own means something and "RED" on its own means something. By taking the individual meanings of each component... the Registrar concluded that it is not distinctive."

REGISTRAR'S DECISION REVERSED

Judge rules in favour of Appellant in appeal against Registrar.

BY AZLINA A KHALID The IP Court recently issued a judgment for an appeal by Illinois Tool Works Inc (the Appellant) against the Registrar's refusal of the Appellant's Trade Mark Application Number 02005832 for HIGH TEMP RED in Class 17.

Procedural irregularities formed the basis of appeal. The 2002 application was initially examined and duly advertised in the May 2005 edition of the Government Gazette. The Registrar then retracted its acceptance and raised fresh objections in 2006. The appeal was filed following written submissions, a Hearing and upon receipt of the Grounds of Decision.

Two important issues were discussed; the exercise of the Registrar's discretionary powers and the registrability of the mark itself. The Registrar relied on Section 25(12) that empowers withdrawal of acceptance and Section 30(1) that states the Registrar cannot register an application if it had been accepted in error.

The refusal came about when the Registrar decided that the first acceptance was made in error - the mark was now deemed to contravene Sections 10(1)(c), (d) and (c) of the Trade Marks Act 1976, on the grounds that the mark consists of non invented words, is descriptive and non distinctive. The Judge effectively dealt with the first objection by pointing out that the Appellant's trade mark must be seen and considered singularly. Though consisting of three separate and individual words, it is the *combination* of these words that the Appellant sought to register.

With regards to the descriptiveness objection, the Learned Judge stated the Registrar had taken an over presumptuous approach based on a wrong and narrow proposition of the Appellant's trade mark. The mark when considered does not directly refer to gasket silicones, the goods applied for. In fact, he adjudged that there is no meaning at all to the mark HIGH TEMP RED.

As for the third objection, the Court gently chided the Registrar for using the wrong method of breaking up the Appellant's mark into individual words namely "HIGH", "TEMP" and "RED" and considering each word separately when the correct methodology was to consider the Appellant's mark in one singular fashion.

The Court also took judicial notice of the fact that the Kuala Lumpur High Court had in 2005 declared the mark HIGH TEMP RED as distinctive under a granted Trade Description Order based on the Appellant's Class 1 registration. Thus, in refusing to grant registration to the Class 17 application rendered the Registrar's decision irrational, a mistake the Court felt obliged to rectify.

Concluding with a caution that the Registrar should maintain consistency and certainty in deciding to allow or refuse a mark for registration, the Learned Judge stated that arbitrary decisions, over presumptuous and over cautious assessment and treatment of a trade mark would not enable businessmen and members of the public at large to conduct their business with confidence.

NOTE: This case is especially meaningful to this firm as Henry Goh is the Appellant's agent on record.

10 YEARS OF INDUSTRIAL DESIGN

Malaysia celebrates the Industrial Designs Act.

BY DAVE A WYATT On 1st September 2009, one day after celebrating her 52nd anniversary of independence from British rule, Malaysia will see another anniversary: it will be 10 years since the Industrial Designs Act 1996 ("the Act") came into force.

Introduced as one of a suite of new IP laws in line with TRIPs requirements, the Act also brought independence to the local design legislation. It replaced the earlier laws and ordinances that conferred automatic extension of UK registered designs to Malaysia.

Continuity with the old law was ensured by the Act adopting many of the substantive provisions of the UK's Registered Designs Act 1949. This has certainly been helpful in court, as counsel could quote from a wealth of UK case law in support of their arguments. Registration under the Act is thus for a design applied to an article. A design is defined as features of shape, configuration, pattern or ornament applied industrially to the

article and having eye appeal. So-called "must-fit" and "must-match" features are excluded from the definition of a design and thereby from contributing to its registrability. A statement of novelty is required, though this is not a claim to what is protected exactly, but rather a claim as to the features that qualify the design for registration. The scope of protection is for the whole design and is determined essentially by what is shown in the representations and the name given to the article.

Apart from the shorter 15-year term, other notable differences over the former UK law include a requirement to name the author of a design and make a declaration of entitlement where the applicant is not the author; a provision for filing a multiple-design application, with lower filing and renewal fees for the second and subsequent designs; and an infringement standard whose scope extends to "any fraudulent or obvious imitation" of the registered design.


The novelty standard is local novelty. A design must not have been prior-disclosed to the public in Malaysia, nor be the subject of an earlier-filed Malaysian design registration. According to the Act, an application will undergo only formal examination and will proceed to registration if all formal requirements are met. There are no provisions for search or substantive examination. In practice, however, MyIPO examiners do raise objections of a substantive nature from time-to-time, questioning novelty or whether there is a design or article within the meaning of the

THE TAKE AWAY

- Malaysia's Industrial Designs Act 1996 adopted many of the substantive provisions of the UK's Registered Designs Act 1949.
- Malaysia's act provides for only a 15-year term
- As of April 2009, 13,438 applications have been filed under this Act, out of which 4 out of 5 have already proceeded to registration.

Act. While such objections clearly fall outside the scope of examination that is laid down in the Act, having to deal with them prior to registration may valuably strengthen the validity of the final registration. Indeed, registrations under the Act have fared well in the High Court in terms of validity. Judges have given considerable weight to the presumption of validity and to the fact that MyIPO had issued a certificate of registration. Validity has been upheld under challenge in a number of reported cases.

Overall, the local design registration system has been managed successfully and efficiently in its first ten years of operation. Official statistics show a total of 13,438 applications filed up to April 2009. Almost 4 out of 5 have already proceeded to registration.

The IP world however never stands still. Change is overdue. The time is ripe to modernize the law in terms of the definition of a design and the standards for its registrability so as to be more in line with those of other jurisdictions such as Europe and Australia. 



ASTRO TRIUMPHS IN SERVICE MARK TUSSLE

Malaysian satellite TV service provider successfully defends its "A" service mark.

BY LIM ENG LEONG
Malaysia's leading satellite television provider, ASTRO, successfully defended its "A" device trade mark application in a Singapore opposition proceeding brought by MediaCorp News Pte Ltd.

The Singapore High Court upheld the Intellectual Property Office of Singapore's decision that although ASTRO's mark is visually but not aurally similar to the



Astro All Asia
Networks plc



MediaCorp
News Pte Ltd

appellant's mark, there was no likelihood of confusion amongst the intended consumers to whom the Class 35 services are provided. The customers comprise of businesses and

organizations and are not ordinary retail customers. In the Court's opinion, these type of customers are discerning especially when they choose their service-provider relating to publicity and business information.

The High Court did however establish that MediaCorp's Channel NewsAsia logo qualified as a well-known mark in Singapore.

For the full judgment, please visit <http://lwb.lawnet.com.sg>.

ASEAN PATENT EXAMINATION CO-OPERATION AND THE PATENT PROSECUTION HIGHWAY

Association of South East Asian Nations launches inaugural regional patent cooperation initiative.

BY AMEEN KALANI
Eight Association of South East Asian Nations (ASEAN) member countries including Malaysia, Singapore, Indonesia and Thailand have launched an inaugural regional patent cooperation initiative called the ASEAN Patent Examination Co-operation (ASPEC) on 15 June 2009. It aims to allow participating Patent Offices to share search and examination results of patent applications. The aim is to reduce duplication of work, enable faster prosecution of the patent applications and hopefully produce higher quality search and examination.

Under the ASPEC initiative, Patent Offices in participating ASEAN countries will be able to consider the other search and examination documents they receive under the programme. However, it important to note that they will not be obliged to adopt any of the findings or conclusions reached by the other IP Office(s). They will each proceed with and conclude their own search and examination work as well as decide on whether to grant the patent in a manner that is consistent with their national laws.

ASPEC will run concurrently with another framework of cooperation between the Intellectual Property

Office of Singapore (IPOS) and the Japan Patent Office (JPO) called the Patent Prosecution Highway (PPH) programme. The PPH framework, due to commence on 1 July 2009, is not unlike ASPEC in that it will allow the two Patent Offices to share their search and examination results.

Under PPH, where an applicant first files a patent application with IPOS which contains claims that are patentable, the applicant may request accelerated examination of the corresponding application filed at the JPO. Alternatively, where an applicant first files an application with the JPO and the final results of the search and examination or patent grant of the application are available, the applicant may request accelerated prosecution of the corresponding application filed with IPOS.



Henry Goh Celebrates!

There was a special significance attached to the cocktail reception hosted by the Firm for their clientele at the Zang Toi West 57th Café @ The Pavilion on 17 June 2009. The coming together was to celebrate the firm's recent achievement in being awarded Tier 1 ranking for both patent and trade mark prosecution work in Malaysia by the Managing Intellectual Property (MIP) World IP Survey 2009.

In a short welcoming speech, Karen Goh, our Managing Director gave thanks to the continuous support the Firm has been receiving from the clients present and finished it off with toast to more successes ahead. Great food, great company combined with just the right ambience made it an altogether memorable event for those who attended!



INTA 2009 at Seattle, USA



Joyce Goh (left) and Azlina A Khalid (right) at the registration booth.

Held from 16-20 May 2009, Azlina Aisyah Khalid, Senior Legal Counsel and Joyce Goh, Trademark Administrator represented the firm this time round. With the main theme focusing on environmental issues, Seattle, WA was the perfect venue due to its lush greenery in the city's surrounding areas.

Home to Starbucks coffee, they found themselves literally 'sleepless in Seattle' as a result of the usual rounds of networking, cocktail receptions, educational seminars and scheduled meetings with clients. Nonetheless, both confessed the pure enjoyment derived from meeting numerous people from different parts of the world, catching up with long-time friends and associates whilst gaining invaluable experience there.

Henry Goh Special Award for Best Invention In Environmental Innovation

University Malaysia Pahang won the "Henry Goh Special Award for Best Invention In Environmental Innovation" for an invention relating to the Potential of Natural Waste for Production of Environmental Friendly Biodegradable Film.

Mr Dave A Wyatt, Executive Director, presented the award at the 20th International Invention, Innovation and Technology Exhibition, ITEX 2009 gala dinner. The exhibition



Dave A Wyatt presenting the award to the winner.

was held from 15-17 May 2009 at Kuala Lumpur Convention Centre. Over 600 inventions from 8 countries covering 24 industry categories were showcased.

We would like to take this opportunity to congratulate all winners at ITEX. Keep up the good work!

MALAYSIA

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