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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 refusal came about when the Registrar decided that the first acceptance was made in error - the mark was now deemed to consist of non invented words, is descriptive and non distinctive. The Judge ruled that the Appellant's trade mark must be seen and considered singularly, therefore, even though it comprises three words, it is the combination of these words that the Appellant sought to register.

The Judge also stated the Registrar had taken an over presumptuous approach based on a wrong and narrow proposition of the Appellant's trade mark. When considered, it does not directly refer to gasket silicones being the goods applied for.

In addition, it was noted that the Registrar had used 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 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 meant that the refusal for the Class 17 application was irrational, a mistake the Court felt obliged to rectify.

NOTE: This case is especially meaningful to the firm as we are the Appellant's agents on record.

ASTRO TRIUMPHS IN SERVICE MARK TUSSE

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



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>.

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.

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!

Henry Goh Reaches Out in Mandarin

Henry Goh was invited by the Malaysia Chinese Chambers of Commerce & Industry (MCCCI) to speak at a public seminar held at the Kuala Lumpur Convention Center on 25 April 2009 as part of the annual National IP Day awareness roadshow.

Our multi-lingual Mr. Andrew Siew and Ms. Kim Choong gave the attendees a general understanding of patent and trade mark protection in Malaysia. What made the seminar more relevant and applicable was that it was presented in Mandarin to reach out to the local Chinese business community.

The seminar ended with an interesting exchange of views between the attendees and the speakers.

Henry Goh Special Award for Best Invention In Environmental Innovation

The "Henry Goh Special Award for Best Invention In Environmental Innovation" was won by University Malaysia Pahang for an invention relating to the Potential of Natural Waste for Production of Environmental Friendly Biodegradable Film. Mr Dave A Wyatt, Executive Director, presented this award at the 20th International Invention, Innovation and Technology Exhibition, ITEX 2009 gala dinner.

The exhibition was held from 15-17 May 2009 at Kuala Lumpur Convention Centre. Over 600 inventions from



注册局的决定被撤销

法官判决支持上诉人对注册局提出之上诉。

在 伊利诺斯工具工程公司 (Illinois Tool Works Inc, 本案上诉人) 因其商标注册申请 (编号02005832, 在商标类别17之下申请注册其商标“HIGH TEMP RED”) 被注册局驳回而提出上诉的案件中, 知识产权法院宣判上诉人胜诉。

该上诉案的成立要素, 是注册程序的不规则性。该项在2002年提出的申请在起初已经经过审查, 并且其公告也已经刊登在2005年5月版的政府公报内。之后, 注册局却在2006年撤回其批准, 并提出新的拒绝理由。

该项申请被驳回, 是因为注册局认为当初给予批准是错误的

决定—该商标如今被注册局视为是由非自创字眼形成的, 并且是描述性和不具有区别性的。就此, 法官在其判决中指出, 上诉人的商标, 必须被当成一个整体来看待和考虑; 因此, 虽然该商标是由三个单字形成的, 然而, 上诉人申请注册的是这些单字的一个特定组合。

法官也指出, 注册局在考虑上诉人的商标注册申请时, 所采取的处理方式不但过分地专横, 并且是基于错误和狭隘的主观看法的。若加以思考, 就会发现该商标并没有直接地指出相关商品是应用于垫圈的硅胶。

再者, 法官进一步指出, 注册局把上诉人的商标拆开成为独立单字“HIGH” (高) “TEMP” (温度) 和“RED” (红色) 之后才分别

考虑这些个别单字的做法是错误的; 正确的方法应该是把上诉人的商标当成一个整体来考虑。

吉隆坡最高法院曾经在2005年针对该商标“HIGH TEMP RED” (当时已在商标类别1之下获得注册) 授予上诉人一项商品标签庭令(TDO); 这表示该商标是具有区别性的, 因此, 注册局驳回同样商标在类别17之下的注册申请, 是不合情理的; 就此, 知识产权法院认为有责任更正这项错误。

注: 由于本公司是有关上诉人的知识产权代理, 因此, 这案件对本公司有尤其重大的意义。

ASTRO在服务商标纠纷中得胜

马来西亚卫星电视服务公司成功捍卫其基于字母“A”的服务商标。

马 来西亚的首要卫星电视服务公司, ASTRO (寰宇电视), 成功在新加坡新传媒新闻私人有限公司 (MediaCorp News Pte Ltd) 所提出的一项反对诉讼中捍卫其基于字母“A”的服务商标注册申请。

新加坡最高法院支持新加坡知识产权局的决定, 也就是认为ASTRO的商标在视觉上虽然近似



上诉人的商标, 但在听觉上却是相异的, 因此, 不可能在这类服务 (类别35) 的目标消费群当中引起混淆。有关服务的消费群, 是企业机构和组织, 而不是一般的零售消费者。根据法院的看

法, 这类消费群是具有辨识能力的, 尤其是在选择服务提供者来为他们处理宣传事务和企业信息的时候。

尽管如此, 最高法院也确认新传媒的亚洲新闻网 (Channel NewsAsia) 商标在新加坡具有资格被视为一个众所周知的商标。

若要阅读上述宣判的完整内容, 请浏览

<http://lwb.lawnet.com.sg>。

吴亨利进行欢庆!

本公司于
2009年
6月17日

在 Zang Toi West
57th Café @ The
Pavilion 为客户们
预备的鸡尾酒招待
会具有很特别的一
个意义。这一次聚
会,是为了庆祝本
公司在 (知识产权
管理) (MIP) 杂志的 2009 年
世界知识产权调查中获得第
1等级的荣誉,肯定了本
公司在马来西亚的专利
和商标诉讼服务领域中
的成就。

在其简短的欢迎词
中,本公司的常务董
事 Karen Goh 向一直
以来都持续给予本公
司支持的客户们表达
了万分的感谢,并以祈
愿在未来继续攀上更高
成就的祝酒作为结束。对
于出席者来说,桌上的佳
肴美食、身旁的良朋好友、
及场地的完美气氛,都是这一场
欢聚值得细细回味之处。



举行于美国西雅图 市的 INTA 2009



Joyce Goh (左) 和 Azlina A Khalid (右) 在登记处留影。

在这场举行于2009年
5月16日至20日的
会议中,本公司的
代表是资深法律顾问 Azlina
Aisyah Khalid 和商标事务行
政员 Joyce Goh。这一次年度
会议的主题是以环保课题为重
点,因此,被绿意盎然的郊区
环绕着的华盛顿州西雅图市可
称得上是完美的会议地点。

置身于星巴克咖啡的发源
地,本公司的两名代表发现她
们的经历真的是“西雅图不眠
夜”——马不停蹄地四下建立
人际网络、参与鸡尾酒招待
会、出席教育性的讨论会、及
按照预约会晤客户。尽管如
此,她们都承认非常享受此次
经历,因为能够结识来自世界
各地的许多人、与相识已久的
朋友和业务伙伴叙旧、及吸取
许多宝贵的经验。

吴亨利以中文拓展疆界

在2009年4月25日,吴
亨利专利与商标事务
所在马来西亚中华工
商总会 (MCCCI) 的邀请之下,在
举行于吉隆坡会展中心的一年一
度全国知识产权日巡回展的其中
一场公开讨论会上发表了演说。

本公司通晓多种语言的
Mr. Andrew Siew 和 Ms. Kim
Choong 为出席者概略地讲解了

马来西亚法律为专利和商标提供
的保护。这一场讨论会是以华语
来呈现的,以便其内容对出席的
本地华商和 MCCCI 会员而言更
有相关性和实用价值。

该场讨论会以出席者和演说
者之间的自由意见交流作为结
束。

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