

myip bulletin

April 2011
Issue 01/2011

An agency under
Ministry of Domestic Trade,
Co-operatives and Consumerism (MDTCC)

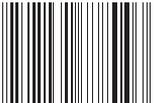


An interview
with Minister of
Domestic Trade,
Co-operatives and
Consumerism

**WIPO Director General
Addresses the Future
of Copyright**



ISSN 2231 - 7783



9 778831 778003



Henry Goh

Patent | Trademark | Design
IP Specialist

www.henrygoh.com



Intellectual property is the most
valuable possession of all.
Trust us to protect yours.

*Voted No. 1 Firm for Patent & Trademark Prosecution in Malaysia
in Managing Intellectual Property's
2011 World IP Survey*

Henry Goh & Co Sdn Bhd
House of Henry Goh, 217 Jalan Imbi, 55100 Kuala Lumpur, Malaysia
Tel : +60 3 2118 8688 Fax : +60 3 2118 8777 Email : hgoh_kl@henrygoh.com

IP Specialists: Mr Dave A Wyatt (Patent), Ms Azlina A Khalid (Trademark)

CONTENTS

april 2011



Editors-in-Chief

Mohd. Shahar Osman
Shamsiah Kamaruddin

Managing Editor

Siti Eaisah Mohamad

Editors

Nur Mazian Mat Tahir
Noor Mohamad Hazman Hamid

MyIP Bulletin Team

Azami Ab Rahman
Dinie Najwa Bero
Farida Cheryl Faizal
Hani Syamira Abdul Hamid
Intan Adila Badrul Hisham
Mazlinda Mat Darus
Mohd. Effendi Md. Noor
Noor Aida Aminshah
Nur Soleha Md. Yushof
Shahida Nafishah Jamaludin

While every effort has been taken to ensure the accuracy of the information contained in the MyIP Bulletin, neither the publisher, editors or their employees can be held liable for any errors, inaccuracies, and/or omission howsoever caused. We shall not be held liable for any actions taken based on the view expressed, or information provided within this publication. Views expressed are that of the authors and do not necessarily reflect the publisher, editors or their employee's opinion on the issues. This publication may not in whole or in part be copied, reproduced or translated without prior permission of the publisher.

MyIPO welcomes original and previously unpublished contributions which are of interest to IP experts, IP agents, academicians, corporate and professional bodies. Manuscript should be submitted in English and Malay Language, ranging from 1,500 to 2,500 words and appreciate to be submitted in softcopy.

For feedback/enquiries:
Tel: 603-2299 8964 / 8962
Fax: 603-2299 8989
e-mail : myip@myipo.gov.my

3 MESSAGES

i. Minister of Domestic Trade, Co-operatives and Consumerism

ii. Chairman of Intellectual Property Corporation of Malaysia

iii. Director General of Intellectual Property Corporation of Malaysia

7 AN INTERVIEW

with Minister of Domestic Trade, Co-operatives and Consumerism

11 WIPO Director General: The Future of Copyright

13 Of Magic Wands, Spell Binding Stories and Copyright Creative Expression and Copyright

16 Of Burden of Proof, Aggrieved Person and Invalidation

20 Intellectual Property Rights ... to a layman

23 IP News in Brief

25 IP Awareness in Malaysia

26 Recent Amendments of Patents Regulations and Trade Marks Regulations

29 Invalidation of Patent on the Ground of Insufficiency

33 MyIPO New Office and Intellectual Property Training Centre (IPTC) Room Facilities

35 Intellectual Property Training Centre (IPTC) Programs

37 Key Corporate Events

39 From Patent Office to Court - Patents Come Alive

Harta Intelek

Memacu Daya Saing Malaysia

Perbadanan Harta Intelek Malaysia (MyIPO)
bertanggungjawab dalam memajukan sistem perlindungan
dan pengurusan harta intelek di Malaysia.

Bagi melaksanakan tanggungjawab ini, MyIPO menyediakan
perkhidmatan - perkhidmatan berikut:

- Pendaftaran paten, cap dagangan,
reka bentuk perindustrian dan petunjuk geografi
- Khidmat nasihat dan perundingan
- Menyediakan maklumat harta intelek dan statistik
- Menyediakan program latihan
- Mengelolakan peperiksaan ejen paten
- Kempen kesedaran harta intelek
- Perkhidmatan atas talian (*online search & filing*
dan semakan status permohonan)
- *Helpdesk*



Perbadanan Harta Intelek Malaysia (MyIPO)
Mezzanine, Level 12-19, (Tower B) Menara UOA Bangsar
No. 5, Jalan Bangsar Utama 1
59100 Kuala Lumpur
Laman Web : www.myipo.gov.my
Tel No : +603 - 2299 8400 ((Talian am/General line)
Faks No : +603 - 2299 8989





Dato' Sri Ismail Sabri Yaakob

Minister of Domestic Trade, Co-operatives and Consumerism

Salam Sejahtera and Salam 1 Malaysia,

Intellectual property rights are crucial to foster creativity and innovation through an effective regime which form the core mission of the Ministry. It has in recent years become increasingly relevant in diverse policy areas, and various socio- economic environments. It is therefore important to promote the creation of new technologies and services, protect the rights of the authors and encourage people to enjoy economic gain.

The role of intellectual property law in the progress of societies is undeniable. In reality, appropriate intellectual property protection can contribute to the advancement of Malaysian economy and human capital.

The Ministry is committed through Intellectual Property of Malaysia (MyIPO) to create awareness, understanding and appreciation of intellectual property rights in Malaysia. The administration of intellectual property system in the country was initiated more than four decades ago, but magnitude of awareness, respect and appreciation of IP are still relatively low.

Therefore, it is my hope that MyIPO to undertake the challenges in enhancing awareness in particular, to be at par with developed nations. The biggest responsibility is to ensure that Malaysian IP creators and authors are aware of and understand their rights, and are able to get protection for those rights.

I believe that the articles published in this volume are an important contribution to disseminate information of these issues. Each contribution addresses an emerging, complex and crosscutting issues related to intellectual property and current scenarios.

Lastly, I wish to congratulate MyIPO for coming up with the IP Bulletin and hope that such move in promoting MyIP Bulletin will be continuously an outreach agenda for economic, cultural and social development.

Thank you.

 A handwritten signature in black ink, consisting of a stylized, fluid script that starts with a large initial 'S' and ends with a horizontal line and a small flourish.

Dato' Sri Ismail Sabri Yaakob



Dato' Haji Abdul Manan Ismail

Chairman

Salam Sejahtera and Salam 1 Malaysia,

First and foremost, I feel very proud to pen down a few words in this first edition of MyIP Bulletin which is a creation of another important MyIPO's milestone. MyIP Bulletin clearly portrays our continuous commitment to instil awareness among Malaysians on the importance of intellectual property. It is hoped that the bulletin will reach Malaysians and serve as a medium to convey important messages and become discussions platform on intellectual property current issues with the aim to establish a nation that respect and regard intellectual property as very significant in their everyday life.

As a developing country, Malaysia strives to strengthen her intellectual property regime to better protect the rights of the intellectual property authors which includes their moral rights as well as their economic rights.

Since the corporatization of MyIPO as an autonomous agency, it encourages and invites dialogue sessions with the public that takes into account their feedback on intellectual property issues. It is by pooling resources and sharing of information that we can broaden our steps to strengthen our intellectual property regime.

As with the first edition of bulletin, it is hoped that it will encourage writers from all walks of life to participate and discuss on intellectual property issues more effectively which are vital in today's knowledge-driven society.

Last but not least, I would like to express my heartiest appreciation to the writers for their contributions and we look forward to our continued cooperation in the future.

Thank you.

Dato' Haji Abdul Manan Ismail



Dato' Azizan Mohamad Sidin

Director General

Salam Sejahtera and Salam 1 Malaysia,

It is an honour for us to inform that Intellectual Property Corporation of Malaysia (MyIPO) has extended another medium to disseminate knowledge on intellectual property rights by introducing our first edition of MyIP Bulletin in conjunction with the National Intellectual Property Day on 26th April 2011.

Malaysia's field of intellectual property has undertaken a progressive development throughout these years. Since its incorporation in 2003, MyIPO shoulders the responsibility for the development and management of the intellectual property system and protection in Malaysia. It is with the assistance of comprehensive regulatory frameworks, that Malaysia has seen its first trade marks, patents, industrial designs and geographical indication registration in 1913, 1986, 1999 and 2003 respectively.

In furtherance to this, MyIP Bulletin will serve as a platform for writers from the intellectual property landscape which comprised of intellectual property practitioners, academicians, corporate bodies as well as MyIPO's personnel to discuss, put forward commentaries on the various intellectual property current issues.

MyIP Bulletin will establish a bridge to the Malaysian public in raising awareness of the value of intellectual property and it is our hope that as a result of this, it will encourage them to protect their intellectual property rights. We want to create a nation that respects intellectual property and realises that intellectual property is a powerful tool for the growth of the economy.

I wish to extend my deepest gratitude to all writers who have contributed their articles for this first edition of MyIP Bulletin and I am very looking forward for future participation.

Thank you.

Dato' Azizan Mohamad Sidin



BANKRAKYAT
بيڤڠڠه وڠعيبه

Bank Pilihan Anda

Kad *Orchid* Kad Debit-i

Berbelanja Secara Bijak & Efisien dengan Kad *Orchid*

Kini segalanya lebih mudah, hanya dengan satu kad.

Kad Orchid boleh digunakan untuk pembelian runcit, transaksi internet dan pengeluaran tunai di semua premis saudagar dan institusi kewangan yang menerima urusanniaga *MasterCard* di seluruh dunia.

Dapatkan *Kad Orchid* di semua cawangan Bank Rakyat hari ini.



Orchid
ONE RETAIL CAS ISLAMIC DEBIT CARD



*Tertakluk kepada terma dan syarat



www.bankrakyat.com.my

PUSAT KAD **BANKRAKYAT**
CARD CENTRE
03-2693 6880

Perbankan Internet • Internet Banking
 RAKYAT
www.irakyat.com.my

AN INTERVIEW WITH

YB Dato' Sri Ismail Sabri YaakobMinister of Domestic Trade,
Co-operatives and Consumerism**1. YB Dato' Sri, in conjunction with this year's National IP Day, what is the Government's strategy to improve IP awareness among Malaysian and what are the challenges faced?**

In order to create and improve awareness among the public, the Government is scaling up outreach programs through seminars, workshops and trainings, print and electronic media. In conjunction with the celebration of the World Intellectual Property Day, the Government has declared 26 April as the National Intellectual Property Day (NIPD) in Malaysia. It is to enable the public to understand about IP rights and its development. This is to encourage creative culture among the public and to stimulate the IP sector as one of the major contributors in the nation's economy.

For instance, as part of MyIPO's extensive outreach programs to reach out to school children and educate them on intellectual property, a mobile clinic was launched during NIPD 2009 to serve as a mobile IP information centre for students, travelling throughout the year to schools and public places.

MyIPO also utilises new media and social networks such as Facebook, Twitter and YouTube to spread information on IP to the public at large, to provide direct interaction with lower costs.

In our effort to enhance IP awareness, we also face challenges. One of the challenges is to balance the right between providing incentive for creativity and innovation and ensuring access to knowledge. We have to ensure that the system rewards the creativity but the bar should not be set too high that it might suppress creativity and innovation.



The second challenge is the institutional capacity. It takes time and requires substantial financial resources to develop a smooth-running institution to administer and enforce an effective IP system. Awareness activities alone require huge financial resources and is time consuming.

2. What are the Government's efforts in embracing the intellectual property culture among Malaysians?

The IP culture should be assimilated in Malaysia community as it is known to be a good culture. Seminars and workshops are usually organized in cooperation with WIPO, WTO and intellectual property offices of developed countries such as JPO, USPTO, and KIPO. In addition, the Government is also keen in introducing the IP subject at schools and higher learning institutions.

In Malaysia, it is quite difficult to change the public's mentality, the Government remains optimistic that people will be aware and more conscious of the need to respect intellectual property rights. To address the issue of piracy, the Copyright Act 1987 is being amended to strengthen the existing copyright laws while the Enforcement Division of the ministry continuously conducts piracy-curb operations in high-profile piracy activities areas.

3. As 2011 approaches, and four important legislations (Patents Act 1983, Trade Marks Act 1976, Copyright Act 1987, and Industrial Designs Act 1996) that have been duly amended are aimed to be read and passed by the Parliament soon. In Dato' Sri's opinion, what is the significance of the amendments towards the development of IP in Malaysia?

By amending the laws, the most significant difference noted is that the delivery system would improve and become more efficient and this is also to strengthen adherence to international standards and treaties. Together with that, the Ministry aims to improve the procedures and shorten the pendency period for the registration of patent and trademark.

The duration for the process of application of patents has been shortened from 39 months as of last year to 26 months effective Feb 15. But for those applying on a fast track basis where there is a clear-cut case without any form of objections, it would take 20 months.

For trade marks, the duration has been shortened from 18 months in 2010 to 12 months this year, and six months and three weeks for the fast track. There were more than 14,000 applications for local trade marks and more than 15,000 applications for foreign trade marks last year. For patents, foreign applications stood at more than 5,000 compared with over 1,200 for local ones.

To further boost the awareness of the importance of intellectual property, MyIPO would soon be embarking on an awareness programme at all levels, right from the small and medium enterprises (SMEs) to companies and at tertiary level.

Besides these, other reason of the amendments is to adhere to the international standards of protection in line with WIPO Copyright Treaties (WCT) and WIPO Performances and Phonograms Treaty (WPPT) for copyright, Madrid Protocol for trade marks and Budapest Treaty for patents procedures.

Implementation of the treaties could be beneficial for developing countries in particular, in the sense that it encourages foreign direct investment (FDI) and puts in place the IP legal framework which is at par with international standards.

4. In your opinion, what are the approaches that should be taken by MyIPO as the custodian of IP in creating business opportunities in Malaysia?

The importance of IP to economic growth has long been recognized. As a valuable asset, IP has to be effectively managed in order to ensure that it is protected, further developed and its economic potential exploited to the maximum.

MyIPO plays an important role in convincing the business people to invest on R&D, creative industry and thus, create more business opportunities in Malaysia. As the custodian of IP, MyIPO is responsible to administer IP regime by providing strong IP infrastructure in order to support competitive business environment.

The first approach is to strengthen the IP legal framework. We have all the IP legislation in place. Our IP legislations are in compliance with the standard set by the World Trade Organisation (WTO) under the Trade Related Aspect of Intellectual Property Rights (TRIPs) since 2002. The IP legislations are also being reviewed periodically under the Trade Policy Review by members of WTO. However, due to proximity of IP and

technology, this has raised the need to review and amend the IP legislation in order to be at par with the rapid changes in technologies.

The IP legislations should also balance the rights of the owners and the need of the public as the users to promote further development of IP through access of knowledge as well as to encourage creativity and innovation among Malaysians. I believe that the amendments of the IP legislations would help to create a more conducive and competitive business environment which in turn will create more business opportunities in Malaysia.

The second approach is to instil IP awareness and understanding on the importance of IP rights not only to the owner of IP but also to the users of IP particularly the public. The owners must know their exclusive rights, how to protect the rights and what is the limitation of such rights whereas the users of IP are responsible to respect the owner's rights. Although IP protection gives monopoly to the owners of IP under the exclusive rights, we must remember that the users of IP contribute on the profit gained from the commercialization of the IP. The give-and-take situation exists between the owner and the users of IP. Therefore, there should be a win-win situation for both of them. MyIPO's efforts in organizing IP outreach programs should be done continuously with proper objectives and target group. By enhancing awareness and understanding on the importance of IP rights, each of us is aware of our rights and responsibilities and this will influence the investors in creating business in Malaysia.

The third approach is improving IP service delivery system. The ICT infrastructure needs to be enhanced. For instance, MyIPO has introduced the IP online system for submission of patent and trade mark applications and other related documents with cheaper fees compared to manual filing. IP online system will encourage applicants to file their applications easier and cost effective. In addition, MyIPO targets to reduce pendency period for processing patent and trade mark applications as well

as introducing a fast track system for a clear cut case. The efficiency of IP service delivery system is the major concern of the stakeholders. MyIPO is at its best effort to deliver fast, accurate and reliable service to the stakeholders to ensure their IP rights are protected for a better business environment.

5. YB Dato' Sri, from your observations at the grassroots level, what is the magnitude of IP awareness?

IP is accepted as an important and valuable asset in the national socioeconomic development and catalyst to progress in knowledge and technology that will ensure a long-term competitiveness of the nation. It is also one of the priorities of IP in Malaysia to promote and instil **IP Culture** among the business and industrial community as well as the public.

In 2010, the number of applications by the locals indicated an increment of 2.4% with 15,111 applications (2009:14,743) which comprised of trade marks, patents and industrial designs. The increment in number of local applications indicated shows that the level of awareness among Malaysians has increased. However, the number of local applications is still relatively low as to against foreign applications. There is still a need to enhance the level of awareness by organizing continuous IP outreach programs with new initiatives.

I believe that the knock-door approach which will be adopted by MyIPO is a good initiative. With this, MyIPO officials will approach the local community to disseminate information on IP and to assist them on IP registration process. This proactive approach aims to reach the public personally. MyIPO also intends to provide IP Clinic in collaboration with several non-governmental organizations in the near future. The IP Clinic will provide advisory services to individuals who do not know about IP.

Besides that, we also have a long-term goal to establish cooperation at the grassroots level with various parties including non-governmental organisations such as Malaysian Foundation for Innovation (YIM) and Malaysian Association on Creativity & Innovation (MACRI). Our aim is to build up a creative and innovative society who is aware on the importance of protecting their inventions.

6. Lastly, what is your opinion on IP as a tool for economic growth which will contribute towards achieving high-income nation?

In the current knowledge-based economy and towards promoting creative-economy, IP is a valuable economic asset as well as a critical business tool that drives competitiveness. With a strong legal framework, enhancement of ICT infrastructure and effective service delivery system, I am positive that Malaysia will be the best platform to attract investors based on the ability to provide a competitive investment climate.

The Ministry aims to enhance the socio-economic prosperity of the community by harnessing IP as a new economic growth through effectively protect and enforce, to properly manage and to maximize the exploitation of IP.

I strongly believe that IP's role is vital in supporting business environment in Malaysia. It can expand the commercial sector that could generate business opportunities which will create quality jobs, higher wages and salaries. Based on its potential that can generate higher returns, intellectual property can be a catalyst for the transformation of Malaysia into a high income nation by 2020.

WIPO Director General The Future of Copyright

Courtesy of WIPO
Geneva, February 24, 2011

WIPO Director General; Francis Gurry today said that **copyright needs to evolve to current technological realities or risk becoming irrelevant.** Speaking at a conference hosted by Australia's Faculty of Law of the Queensland University of Technology (QUT) on the future of copyright, Mr. Gurry said there is no "single magical answer" to the development of a successful policy response to the challenges facing copyright in the digital age, but a combination of "law, infrastructure, cultural change, institutional collaboration and better business models." Central question facing the evolution of copyright policy is how to maintain a **balance between availability of cultural works at affordable prices while assuring a dignified economic existence for creators and performers.** Digital technology is having a radical impact on those balances. "Rather than resist it, we need to accept the inevitability of technological change and to seek an intelligent engagement with it," he said. "There is, in any case, no other choice – either the copyright system adapts to the natural advantage that has evolved or it will perish."

The Director General said there are three main principles that should guide the development of a successful policy response. The first is **"neutrality to technology and to the business models developed in response to technology."** He said the purpose of copyright is not to influence technological possibilities for creative expression or the business models built on those technological possibilities, nor to preserve business models established under obsolete technologies. "Its purpose is...to work with any and all technologies for the production and distribution of cultural works and to extract some value from the cultural exchanges made possible by those technologies to return to creators and performers and the business associates engaged by them to facilitate the cultural exchanges through the use of the technologies. Copyright should be about promoting cultural dynamism, not preserving or promoting vested business interests."

A second principle, he said is **"comprehensiveness and coherence in the policy response."** Mr. Gurry recognized the limitation of law to provide a comprehensive answer and said that "infrastructure is as important a part of the solution as law." In this respect, he said collective management societies

"need to re-shape and to evolve" as their present infrastructure is out-dated as "it represents a world of separate territories and a world where right-holders expressed themselves in different media, not the multi-jurisdictional world of the Internet or the convergence of expression in digital technology."

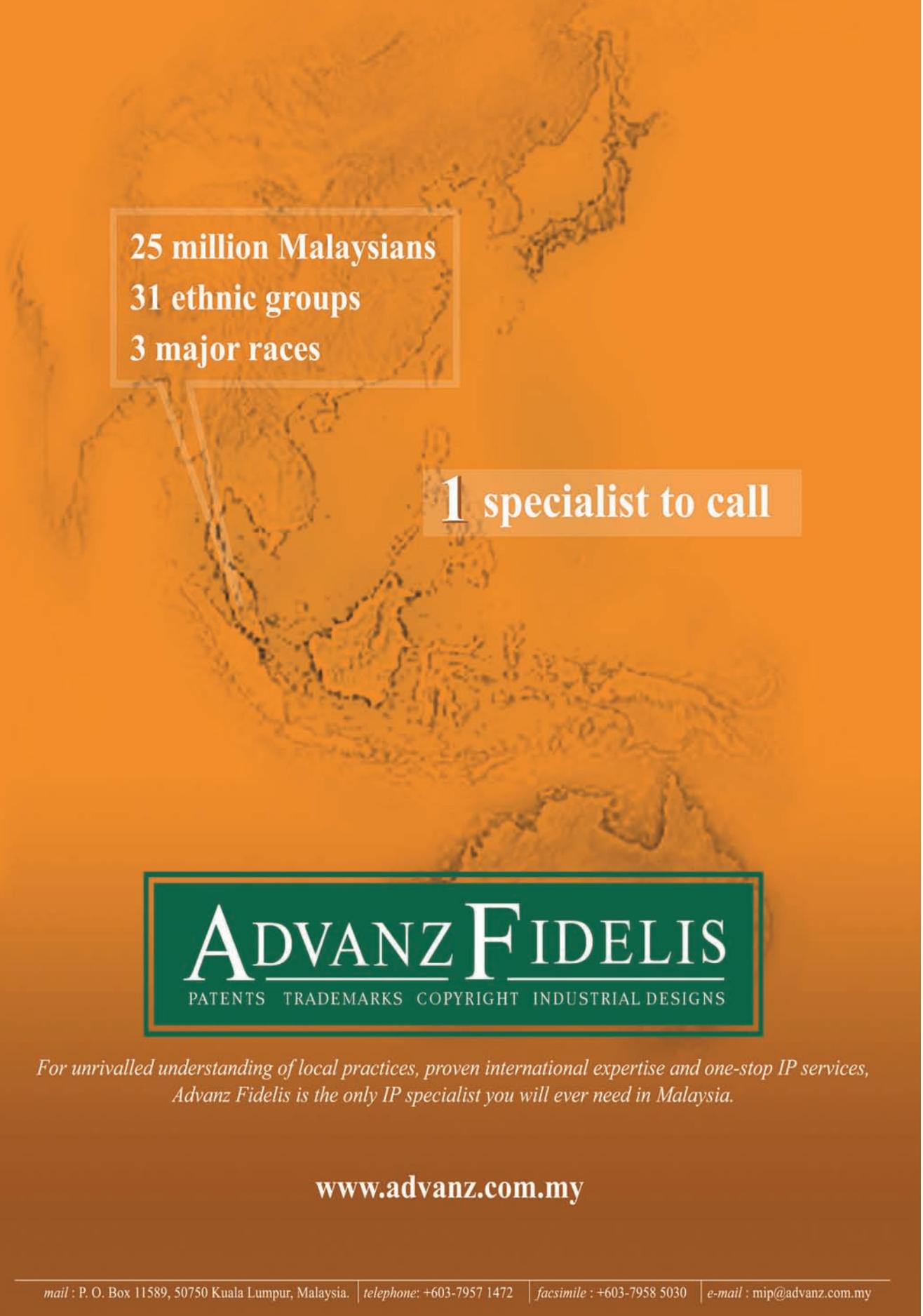
"We need a global infrastructure that permits simple, global licensing, one that makes the task of licensing cultural works legally on the Internet as easy as it is to obtain such works there illegally," he said.

In this respect, Mr. Gurry said "an international music registry -- a global repertoire database -- would be a very valuable and needed step in the direction of establishing the infrastructure for global licensing. And, secondly, in order to be successful, future global infrastructure must work with the existing collecting societies and not seek to replace them."

The culture of the Internet also needs to be taken into consideration. Referring to the high rates of illegal downloading, Mr. Gurry said "In order to effect a change in attitude, I believe that we need to re-formulate the question that most people see or hear about copyright and the Internet. People do not respond to being called pirates.

They would respond, I believe, to a challenge to sharing responsibility for cultural policy. We need to speak less in terms of piracy and more in terms of the threat to the financial viability of culture in the 21st Century, because it is this which is at risk if we do not have an effective, properly balanced copyright policy."

The third guiding principle **for a successful response to the digital challenge is the need more simplicity in copyright.** Mr. Gurry said "Copyright is complicated and complex, reflecting the successive waves of technological development in the media of creative expression from printing through to digital technology, and the business responses to those different media," warning "We risk losing our audience and public support if we cannot make understanding of the system more accessible.

A stylized map of Malaysia in shades of orange and brown, serving as the background for the advertisement.

25 million Malaysians

31 ethnic groups

3 major races

1 specialist to call

ADVANZ FIDELIS

PATENTS TRADEMARKS COPYRIGHT INDUSTRIAL DESIGNS

For unrivalled understanding of local practices, proven international expertise and one-stop IP services, Advanz Fidelis is the only IP specialist you will ever need in Malaysia.

www.advanz.com.my

Of Magic Wands, Spell Binding Stories and Copyright Creative Expression and Copyright

Prof. Dr. Ida Madieha Abdul Ghani Azmi

International Islamic University Malaysia

After teaching copyright law for more than 20 years, I find that the age gap between myself and the students increasing. I always try to find copyright items that would interest my group of 20 year old undergraduate students. To my delight, I could share my children's passion in Harry Potter with my copyright students. Good enough that there are many copyright suits involving Harry Potter. Take early this year for example, we read that the Harry Potter's US Publisher, Scholastic Corp won a copyright infringement lawsuit. The claim was that J.K. Rowling's "Harry Potter and the Goblet of Fire", the fourth of the seven novels in the series, copied an unknown UK's work, "The Adventures of Willy the Wizard- No.1 Livid Land" (WTW).

From the opinion of the presiding judge, US District Shira Scheindlin, there was a total contrast between the concept and feel of the two works. Whilst both books dealt with wizard contests, J.K. Rowling dealt with a teenager and the other involved adult competition.

In a corresponding UK case, *Allen (acting as Trustee of Jacobs (deceased) v Bloomsbury Publishing plc and another*¹, Kitchin J had to determine whether the plot, sub-plots, themes and incidents in WTW had been copied into Goblet. The learned judge addressed the five main elements of plot architecture.

In summary they are:

- i) the main characters of WTW and HPGF are wizards who are to compete in a wizard contest which they ultimately win (element 1);

- ii) the main characters are required to deduce the exact nature of the main task (element 2);
- iii) the main characters uncover the nature of the main task covertly in a bathroom (element 3)
- iv) the main characters complete the main task using information gained from helpers (element 4);
- v) the main task for the main characters involves the rescue of human hostages imprisoned by a community of half-human, half animal creatures (element 5).

Kitchin J finally summed up the main task which was whether the similarities listed above amounted to a substantial part of WTW. If they were not then the claim must necessarily fail even if those similarities were the result of copying. The judge noted the difficulty in this case where there was no allegation of language copying but rather textual copying. Applying *Da Vinci Code (Micheal Baigent & Anor v The Random House Group Ltd*², Kitchin J held that the similarities alleged seem to constitute ideas which were relatively simple and abstract and of such a high level of generality that they fall on the ideas rather than the expression side of the line.

Equally controversial is the *Da Vinci Code's* case, *Micheal Baigent & Anor v The Random House Group Ltd*³. In this case the claim of taking the central theme of a historical conjecture entitled the Holy Blood and Holy Grail was not made out. However, Mummery LJ made useful observations on textual copying and noted that substantial

¹ [2010] EWHC 2560

² [2007] EWCA Civ 247, [2007] FSR 579, [2008] EMLR 251

³ [2007] EWCA Civ 247, [2007] FSR 579, [2008] EMLR 251

copying could take place when items of information, facts, ideas, theories, arguments or even themes were derived from another work. Ultimately he propounded (at p 156):

"Original expression includes not only the language in which the work is composed but also the original selection, arrangement and compilation of the raw research material. It does not, however, extend to clothing information, facts, ideas, theories and themes with exclusive property rights, so as to enable the Claimants to monopolise historical research or knowledge and prevent the legitimate use of historical and biographical material, theories propounded, general arguments deployed, or general hypotheses suggested (whether they are sound or not) or general themes written about."

Perhaps, one could still remember the 2007 suit against Van Der Ark, the founder of an online web site that originally started as a fan web site.⁴ On that web site, Van Der Ark started an online Lexicon, which contains a descriptive list of the spells, characters, and fictional objects in Harry Potter to share with fellow fans. The list grew into an encyclopedia that collected and organized information from the Harry Potter books in one central source for fans to use for reference. To make searching for entries easier, he developed an A-to-Z index to each list to allow users to search for entries alphabetically. At this stage, Van der Ark did not pose any problems to J.K. Rowling. However, when the Lexicon was published by RDR Books, J.K. Rowling sued him for copyright infringement.

On a finding of copyright infringement, it was found that as the Lexicon contained 2,400 elements from the Harry Potter world, extracted and synthesized fictional facts related to each element from all the seven Harry Potter books, it was held that it was an infringement of the latter. One of the issues raised was, of course, fair use. It was alleged that the writing of the Lexicon amounted to a transformative use of an original work and hence allowed under the law. For this to succeed, it must be proven that the

Lexicon amounts to a new work; an original creation and adds something new, with a different purpose, or different character. Was there a totally new work altogether? Different arguments were raised by both sides of the lawyers. But ultimately, the presiding judge took note of the fact that there had been too much language copying, which includes aesthetic expression. Verbatim copying was in excess of what was reasonably necessary and this diminished the finding of a transformative use. Out of the 4,100 page Harry Potter series, the Lexicon had reproduced 450 pages.

The finding of the Lexicon case received much criticism among copyright specialist. Some criticize that one should not be given to strong a monopoly that could restrict other's creativity. Especially in a situation where a derivative work is created. To what extent can one stop others from developing an additional useful work from an original piece of composition? One compelling argument raised is that the derivative work poses no adverse affect on the market of the original work. If more, it might even enhance the market of the original work. Yet, such argument was rejected by the court.

Olson, meanwhile argues that copyright interest should give way to freedom of expression on many grounds. Firstly, copyright law exists to encourage the creation of works of authorship by granting exclusive rights. But copyright's incentive function seems to be in tension with freedom of expression. In such a situation, internal balances such as fair use defense and idea/expression dichotomy should be utilized to the fullest.

Another similar situation where 'transformative use' can be raised is in the context of fan fiction. On this, Mc Cardle, argues that the legality of fan fiction depends on two issues. First, the exact boundary of copyright of the original expression or to be more exact the copyrightability of characters in the original work. Second, the precise right of the copyright holder upon which this piece of fan fiction infringes. As it is now clear

⁴ *Warner Bros and J.K. Rowling vs. RDR Books* (575) F. Supp.2d 513

that characters can be copyrighted, the ability of others to borrow characters from an original work is diminished. She adds that a fan fiction author infringes the owner's exclusive right in reproduction every time she reproduces a character in fan fiction. Thus in most likelihood, the court will likely consider a fan fiction as a derivative work because it takes the copyright holder's original creation and adds new characters, settings or plotlines, thus creating a new and different work⁵.

On the other hand, some argues that when a creative work becomes popular culture, one could not stop derivative use of such work as it would tantamount to restriction on freedom of expression⁶. On this, Bambauer argues that from an economic perspective, giving copyright holders the right to control production of derivative works that transform their expression, such as the movie version of a novel is unjustified, even harmful. He argues that the since that right prevents production of attractive, diverse, cheaper new expression, and blocks the promise of remix culture, it should be eliminated.⁷

However, one could see that the Lexicon decision only endorse further the entrenched position of creative expression within the domain of copyright. It has often been questioned how recognition of copyright over characters blurs the boundary between ideas and expression. How do you describe characters? Are they expression or ideas? How do you distinguish between specific characters say Harry Potter vis a vis any boy wizard? On this point, the US Court in *Nichols v Universal Pictures*⁸ expressed the view that fictional character could be the subject of copyright if the character was distinctively delineated. One specific example is in the case of Rocky in *Anderson v Stallone*⁹. The Court held that the physical and emotional characters of 'Rocky' was delineated in tremendous detail and hence could not be appropriated by others even if transposed into a sequel by another author.

The test is further elaborated in *Warner Brothers Pictures v Columbia Broadcasting Systems*¹⁰, where not only the character must be delineated but it must be so as if a story is being told.

Thus, Biswas argues that a character that is clothed with unique features, attributes and a particular combination of how he feels, says, does and thinks, it no longer remains an idea, but becomes an expression of the idea¹¹.

It is interesting to note that UK Courts, prior to the Harry Potter era, seems to take an opposite view. Such were the fate of Falstaff and Sherlock Holmes in *Kelly v Cinema Houses Ltd* [1928-35]¹² and Sherlock Holmes again and 221 Baker Street in *Conan Doyle v London Mystery Magazine Ltd* [1949]¹³. This is in contrast to plot and sequence of events as found in *Harman Pictures v Osborne* [1967]¹⁴ and Ravenscroft and Herbert [1980]¹⁵.

It brings to light the favourable position of fiction writers vis a vis academic writers. Perhaps, it is high time that I change profession into fiction writing. Not only I get to earn more from my books, I get to be famous as well!

⁵ Meredith McCardle, Fan Fiction, Fandom and Fanfare: What's all the Fuss. 9 B.U.J. Sci & Tech. L. 433.

⁶ David S Olson, 'Symposium Article: First Amendment Interests and Copyright Accommodations, 50 B.C.L. Rev 1393

⁷ Derek E. Bambauer, Faulty Math: The Economics of Legalising the Grey Album, 59 Ala.L. Rev. 345.

⁸ 45 F.2d 119 (2d. Cir. 1990), cert. debied, 282 US 902 (1931)

⁹ 11 USPQ 2d 1161 (C.D. Calif. 1989)

¹⁰ 216 F.2d 945, 104 US P Q 103 (9th. Cir. 1954), cert. denied, 348 US 971, 99. L.Ed 756, 75 S. Ct. 532 (1955)

¹¹ Sourav Kanti De Biswas, Copyrightability of Characters, Journal of Intellectual Property Rights, Vol, 9, March 2004, pp. 148-156.

¹² [1928-35] MCC 362.

¹³ [1949] RPC 312.

¹⁴ [1967] 1 W.L.R, 723

¹⁵ [1980] RPC 193.

Of Burden of Proof, Aggrieved Person and Invalidation

Prof. Dr. Lim Heng Gee

Universiti Teknologi MARA

Introduction

The past three years in the intellectual property litigation scene have brought about much welcomed and useful opinions and guidelines in relation to the construction of various provisions of the relevant intellectual property laws. In the copyright arena, two interesting cases were decided recently, one on moral rights and the other on the application of the public interest defence in relation to the use of a copyright work by the Government.¹ For industrial design, the controversial decision relating to the question when “features of shape or configuration” of an article are excluded from design registration on the ground that those features are “dictated solely by the function which the article has to perform” was determined with the court adopting the “multiplicity of forms” approach.² In the trade mark arena, the court espoused the doctrine of functionality in dismissing the plaintiff’s passing off action, holding that purely functional designs could not form the basis for a valid distinctive get up for passing off.³ Most of the litigated patent cases concerned how various provisions in the Patents Act 1983 are to be construed and applied. Except for four cases, most of these are run of the mill cases which are neither controversial nor do they create new legal principles.

The first case of note, which concerned the applicability of section 36(4) of the Patents Act 1983 in relation to an application for interim injunction, was considered by the court in *Aventis Farma Sa (Malaysia) Sdn Bhd & Anor v. Rohibul Sabri Abas & Anor*.⁴

The court construed the phrase “any proceedings” in section 36(4) to mean that the statutory reversal of the presumption of proof also applied to an application for an interim injunction. The second concerned the liability of directors for breach of a consent order in relation to patent infringement.⁵ The court held that the personal defendant, being a director of the defendant company, was liable for the breach. Imprisonment of five days was imposed. In the third case, the court in *Kendek Industry Sdn Bhd v. Ecotherm (TFT) Sdn Bhd*⁶ held that the validity of a utility innovation could be relitigated on different grounds. Further, the grounds for invalidation

of a patent under section 56 were equally applicable to the invalidation of a utility innovation. The fourth case is discussed below.

This short paper focuses only on two controversial cases which have been reported. The first relates to the issue of who bears the burden of proof when there is an application to invalidate a registered industrial design. The second involves the definition of a “person aggrieved” and the important question of whether there is a discretion not to invalidate a patent even though the conditions for patentability have not been satisfied.

Whither Section 22(3), Industrial Designs Act 1996?

In *Buncho (M) Sdn Bhd v. Q-Stationers Sdn Bhd*,⁷ the proprietor of a registered industrial design for a pencil lead casing sued the defendant for infringement of its registered design. The defendant’s defence and counterclaim was that the design was not new as stated in the Industrial Designs Act 1996 (IDA 1996) and ought to be revoked pursuant to section 27(1)(a) and (b) of the IDA 1996.

In dismissing the plaintiff’s claim and allowing the defendant’s counterclaim, the court made two controversial rulings. First, the court held that for the plaintiff to succeed it must first establish that it was the owner of the industrial design. The court further held that “the legal burden was on the plaintiff to show that at the time of registration it had satisfied the requirements of section 12 of the IDA 1996. This it could have shown by calling witnesses such as the consultant and the factory which was instrumental in producing for the plaintiff the mould to the lead case, to say that the product was never manufactured at least before the priority date. The failure to do so would not only invoke the law in respect of legal burden but would also attract the jurisprudence in relation to adverse presumption.”⁸ On the facts, the court held that the plaintiff had not established in law that it was the owner of the industrial design and that the registered design was new as required under section 12 of the IDA 1996. In consequence, the defendant was successful in having the registered industrial design revoked pursuant to section 27(a) and (b) of the IDA 1996.

¹ See *Syed Ahmad Jamal v. Dato Bandar Kuala Lumpur* [2010] 1 LNS 837 and *Ultra Dimension Sdn Bhd v. Ketua Pengarah, Lembaga Penggalangan Pelancongan Malaysia & Ors* [2010] 8 CLJ 245 respectively.

² See *Anchorol Sdn Bhd v. Nehemiah Reinforced Soil Sdn Bhd* [2008] 10 CLJ 49.

³ See *Alfa Laval (M) Sdn Bhd v. Ng Ah Hai & Ors* [2009] 7 CLJ 1, per Ramiy Ali J.

⁴ *Aventis Farma Sa (Malaysia) Sdn Bhd & Anor v. Rohibul Sabri Abas & Anor* [2008] 7 CLJ 525, per Vincent Ng J.

⁵ *Fortune Pacific Engineering Co Ltd v. Gajatakrav Industries Sdn Bhd* [2010] 5 CLJ 590.

⁶ See *Kendek Industry Sdn Bhd v. Ecotherm (TFT) Sdn Bhd* [2010] 10 CLJ 219, per Azahar Mohamed J.

⁷ *Buncho (M) Sdn Bhd v. Q-Stationers Sdn Bhd* [2010] 7 CLJ 359.

⁸ *Buncho (M) Sdn Bhd v. Q-Stationers Sdn Bhd* [2010] 7 CLJ 359, per Hamid Sultan Abu Backer JC, at page 368.

It is submitted that by imposing the legal burden on the plaintiff to show that at the time of registration it had satisfied the requirements of section 12 of IDA 1996 is to impose an unbearable burden. It is easier to prove that a design is not new rather than to prove that a design is new. For example, even if the registered owner could produce one million published designs to show that his design is different, how does he prove that there is not in existence an additional published document or prior art which anticipates his design? By contrast, if the defendant has the burden to show that the design was not new, he merely needs to produce one anticipatory published document to prove the lack of novelty.

More importantly, section 23(3) of the Industrial Design Act provides that "The certificate of registration shall be prima facie evidence of the facts stated therein and of the validity of the registration." This means that on registration, the design is deemed to have satisfied all the substantive conditions for registration, including that it is new, and that the owner is the rightful owner. The burden of proof is on the person seeking invalidation to prove otherwise.⁹

However, in the case under discussion, the court said, "[t]he failure of the plaintiff to call all persons who were instrumental for the design to be registered is fatal to the case."¹⁰ By a judicial fiat, the court has reversed the statutorily provided burden of proof. The report of the case did not mention any arguments relating to the application of section 23(3). So it is not known whether counsels brought to the notice of the court this provision. If this had not been done, then it is highly regrettable.

Mandatory or Directory Nature of Invalidation Proceeding

The plaintiffs in *Lim Choong Huat & Ors v. Syntz Enterprise Sdn Bhd & Ors*,¹¹ who were granted patent for an 'Automatic Electronic Baby Cradle' alleged that the defendants had infringed their patent. The defendants argued that they had a registered patent of their own, *inter alia*, for an improved structure of a Hammock Type Infant cradle. The defendants counterclaimed for the plaintiffs' patent to be invalidated and expunged for lack of novelty and inventive step. On the facts, the Court held that both the patents did not satisfy the conditions for novelty and inventive step. However, the Court then went on to hold that 'the justice of the case did not require the plaintiffs' as well as the defendants' patent to be

invalidated because, although section 56(2) says the court "shall" invalidate, it is trite that the word "shall" or "may" is not conclusive on the question whether the particular requirement of law is mandatory or directory. The word "shall" in section 56(2) need not be construed as mandatory if the justice of the case requires court not to interfere in relation to competing claims. The court may exercise its discretionary power to judicially not to invalidate the relevant patent in an invalidation proceeding. More so when there is nothing to protect as envisaged within the spirit and intent of the Act.¹²

"Shall" or "May"?

His Lordship, in coming to the conclusion that the word "shall" should be construed as "may", *inter alia*, referred to the patent statutes of the United Kingdom and India. In both these statutes,¹³ the word "may" is used. With respect, it is submitted that the fact that the drafters of the Act and the legislators chose "shall" instead of "may" despite the above fact is highly indicative of the intended mandatory nature of the power given to the court. It is pertinent to note also that section 45(1) of the Malaysian Trade Marks Act 1976 uses the word "may" in relation to rectification of a registered trade mark. Similarly, section 27(1) of the Malaysian Industrial Designs Act 1996 also uses the word "may" in the revocation provision.

To repeat the above argument, the fact that the drafters of the Patents Act and the legislators, being fully cognizant of this fact, still chose to use the word "shall" instead of "may", should be of great significance when construing the provision of section 56(2). It evinces a clear intention that the invalidation of a patent is mandatory when any of the grounds mentioned in section 56 is satisfied.

Quid pro quo

A patent is granted as part of a bargain between the applicant for a patent and the State. In exchange for the State conferred monopoly, the inventor reveals the secret of his invention. However, when the invention is neither new nor inventive, there is no consideration provided by the inventor in exchange for a patent. In this situation, should the patent be allowed to stand? The answer is a clear "NO".¹⁴ This principle is in fact alluded to by his Lordship when he said, "It is trite that the protection afforded by patent law is to reward those who make substantial discovery which can qualify as invention under the Act."¹⁵ Despite having said this, his Lordship inexplicably declined to invalidate. By not invalidating, the court is, in essence, allowing the

⁹ See, for example, the judgment of Vincent Ng J in *Arensi-Marley (M) Sdn Bhd v. Middy Industries Sdn Bhd* [2004] 8 CLJ 20, where the burden of proof that the respondent's registered industrial design was not new and hence should be invalidated was placed on the applicant for revocation of the registered industrial design under section 27. At page 24, the Judge said, "The burden on the applicant is two-fold: they have to show that:

(i) the Design 372 was not new because it was similar to their own Gutter Design which was prior art and
(ii) any differences in the designs was only in immaterial details and in features commonly used in the trade."

See also *Kandek Industry Sdn Bhd v Ecotherm (TFT) Sdn Bhd* [2010] 10 CLJ 219, per Azahar Mohamed J, at para 29, in relation to a patent case. "Now, there can be no doubt that on the issue of invalidity, the onus of proof lies with the defendant."

¹⁰ *Buncho (M) Sdn Bhd v. Q-Stationers Sdn Bhd* [2010] 7 CLJ 359, per Hamid Sultan Abu Backer JC, at page 360.

¹¹ *Lim Choong Huat & Ors v. Syntz Enterprise Sdn Bhd & Ors* [2010] 1 CLJ 860, per Hamid Sultan Abu Backer JC.

¹² *Lim Choong Huat & Ors v. Syntz Enterprise Sdn Bhd & Ors* [2010] 1 CLJ 860, per Hamid Sultan Abu Backer JC, at 890-891.

¹³ See section 72(1), Patents Act 1977 United Kingdom and section 64(1) Patents Act 1970 India.

¹⁴ See *SKB Shutters Manufacturing Sdn Bhd v Seng Kong Shutter Industries Sdn Bhd & Anor* [2010] 1 LNS 1071, per Azahar Mohamed J, "The aim of novelty is that the conferral of a monopoly will do two things. First is to create an incentive and, secondly in exchange for requiring a patentee to make known new details of the invention".

¹⁵ *Lim Choong Huat & Ors v. Syntz Enterprise Sdn Bhd & Ors* [2010] 1 CLJ 860, per Hamid Sultan Abu Backer JC, at 887

owners of the patents to continue to enjoy an undeserved monopoly over a product which is already in the public domain. Surely there is no legal basis for this generosity?

“Justice of the case”

The doctrine of “justice of the case” is usually applied where there is inequitable conduct between the parties. This doctrine may also allow for an order to strike out certain claims when the patent as a whole could be saved. This in fact is provided for under section 56(3). But “justice of the case” has no application in relation to the invalidation of a patent which is found to be wrongly granted because it has not satisfied the substantive conditions for patentability. It is difficult to see how his Lordship could in his wisdom apply the doctrine of justice of the case here.

“Public interest”

It is in the public interests that a patent which has been found not to have satisfied the requirements for novelty and inventive step be invalidated. In *Abbott Laboratories (Chu's) Patent*,¹⁶ the patent in suit was the subject of an application for revocation under section 72(1) of the Patents Act 1977, United Kingdom, on the grounds, *inter alia*, that it did not relate to a patentable invention. The applicant for revocation withdrew before the Comptroller had decided the matter. It was held that whenever, in properly launched proceedings, the Comptroller became aware of the potential for an invalid patent to be granted or maintained, it was his public duty to raise those issues. In *Norprint Ltd v SPJ Labels Ltd*,¹⁷ a case under the Patents Act 1949, United Kingdom, Whitford J said, “... I am bound to say that I think the public interest would demand, irrespective as to whether there was a counterclaim or not, that the court should take into consideration the question as to whether it ought not to issue an order for revocation in any event.”

From the above, it is clear that a patent which has been found to have been wrongly granted because it has not satisfied the basic requirements for novelty and inventive has to be invalidated and removed from the Register. This decision is mandatory and not discretionary. It is, therefore, incumbent upon the court to order invalidation of the patent. His Lordship in *Lim Choong Huat & Ors v. Syntz Enterprise Sdn Bhd & Ors*, by declining to invalidate the patent, had basically made a non judgment, resulting in an abdication of judicial duty.

Implications of the patents not invalidated

The *Lim Choong Huat* case raises more questions than provides answers. Not invalidating the patent means that in principle the parties are still free to sue third parties since the judgment is binding only *inter partes*. The owners of these patents are still in a position to attempt to restrict or prevent legitimate competitions by threatening to unleash the power of their “invalid but not invalidated” patents against their competitors. Is a defendant, when sued, able to apply under Order 18 rule 19 of the Rules of the High Court to strike out the action on the ground that it either discloses no reasonable cause of action, that it is scandalous, frivolous or vexatious or that it is otherwise an abuse of the process of the Court? Furthermore, both parties are still able to use the word “Patented” on their products without being held criminally liable under section 84 of the Patents Act.

Concept of “Aggrieved Person”

Another reason why the Court in *Lim Choong Huat* did not invalidate both the patents was because, in his Lordship’s words, “...for section 56 to apply the plaintiff or defendants must be an aggrieved person. The plaintiffs or defendants cannot be said to be an aggrieved person within the context of their pleadings because their product prima facie ought not to have been patented....”¹⁸

With respect, this “after the fact” approach to deciding when a person is deemed to be an aggrieved person is highly unorthodox and, it is humbly submitted, wrong. That question has to be decided as a preliminary question before the issue of the validity of a patent is delved into. Following his Lordships approach could lead to an absurd situation, as here, where the court has reached a stage where the patent in suit is found not to be properly granted, for example, because of the lack of novelty. The patent is then liable to be invalidated. However, since the patent is not valid, the defendant could not be an “aggrieved person” as required under section 56(1) of the Patents Act. The patent cannot then be invalidated because of the absence of anyone with the required locus standi to apply for invalidation. This is a classic example of a perfect circular argument.

Conclusion

It is hoped that judges in future cases dealing with these three aspects will rectify the problem. The approaches in relation to who bears the burden of proof in an invalidation proceeding, determination of the status of an “aggrieved person”, and the “directory” as opposed to the “mandatory” power of invalidation are inconsistent with the express provisions and underlying policies of the Industrial Design Act as well as the Patents Act. If allowed to stand or is adopted in other cases, it would unbalance the finely tuned structure of the industrial designs and patents system.

¹⁶ *Abbott Laboratories (Chu's) Patent* [1992] RPC 487. See also *General Motors (Turney & Barr's) Application* [1976] RPC 659, at 668, “The Comptroller is not in such circumstances as are here being considered or, indeed, in any other circumstances, standing in the same sort of position in relation to an opposition or belated opposition as an opponent might be. The interest of the Comptroller is to protect the public as well as to decide differences between parties. The statute as a whole, plainly contemplates that it must be appropriate that matters coming to the attention of the Comptroller may be acted upon by him if they affect or may touch the validity of patents or patents that might be granted on applications.”

¹⁷ *Norprint Ltd v SPJ Labels Ltd* [1979] FSR 126, at 126.

¹⁸ *Lim Choong Huat & Ors v. Syntz Enterprise Sdn Bhd & Ors* [2010] 1 CLJ 860, per Hamid Sultan Abu Backer JC, at 891.

practising in all aspects of

INTELLECTUAL PROPERTY

from **value creation** to **value extraction**

patents • trade marks
industrial designs
geographical indications
copyright
domain names

layout designs of integrated circuits
confidentiality & trade secrets
ip management policies
ip audits and due diligence
licensing • ict • franchising
entertainment & media law
technology transfer
corporate & commercial
litigation & enforcement



intellectual property & technology law



lot c9-3 jalan selaman 1, dataran palma, 68000 ampang
t: 603 4270 1819 f: 603 4270 1821 e: bustaman@tm.net.my

www.bustaman.com

PYPRUS

www.pyprus.com

Malaysia office
PYPRUS SDN BHD
Suite 8.02, 8th Floor,
Plaza First Nationwide,
161 Jalan Tun H.S. Lee
50000 Kuala Lumpur Malaysia
Tel: +603 2072 6789
Fax: +603 2072 9789
malaysia@pyprus.com

Singapore office
PYPRUS PTE LTD
30 Bideford Road
#07-01 Thongsia Building
Singapore 229922
Tel: +65 6734 8523
Fax: +65 6734 8521
singapore@pyprus.com

Key Areas of Practice

Intellectual Property matters

Patent Specification Drafting and Prosecution
Trademark Registration
Industrial Design Registration

Litigation Support

relating to Intellectual Property Disputes

Advisory Services

Technology Transfer
Due Diligence
Valuation
Freedom to Operate/Infringement analysis

Intellectual Property Rights ... to a layman

Norhayati Hassan

SIRIM Malaysia

At exactly six in the morning, you were awakened by a loud ringing of the alarm clock. As you sat at the edge of the bed, with a clap of hands the room is brightly lit and you paved your way to the bathroom. By half past six you are already in your car, reversing and automatically locked the gate by a push of a button of the gate's remote control. On the way, you drove through *McD's DriveThrough*, ordered your Breakfast Meal and off to work. At the office, by pushing a button at the telephone, you got connected to your subordinate almost immediately. A client from Japan, connected through *Skype*, needed your opinion on a certain business dealing. Another client from Australia, needed a report to be completed in two hours and to be calm, played *Mozart* on your *Walkman* mp3. By nine in the evening, you headed home. While watching football games on the high definition television, you ate dinner comprises of milk, cereal and *blackberries* while at the same time checked and answered your emails using the *Blackberry*. By midnight, as you sat at the edge of your bed, with a clap of hands the room is dark and you soon dozed off. Tomorrow another day.

Have we not realised that through our lifetime, technology evolves in so many ways. Take for example, from black & white television to coloured television to plasma television to LED television. Present generation would be at lost, or even dead, without the Internet and mobile telephones. What we are experiencing now is the era of exploding intellectual property. Inventions, trade marks, industrial designs, copyrights are just a part of the intellectual property rights. Our encounter with intellectual property is almost unappreciative in that we take for granted of things around us. We forget to stop for a while, ponder and realise that without such things we may still be living in the stone age. Do we have any respect to those who have painstakingly and tirelessly created (or invented) these things?

To some of us, since these creative minds are God -sent, why bother, just imitate, it is free for all. Then, what if this creative thinking ability is being given to you, how would you feel if someone just grab and use your creation without even acknowledging your existence? If you feel fine, no problem then you must have landed on a wrong planet or you happened to be an angel. Planet Earth works differently. It is not just the tangible part of the property but the intangible as well which needs to be highlighted to encourage better and improved property.

The very fact that the source of any property, be it tangible or intangible, is enough to ascertain ownership of the property, marks the importance of information retrieval in determining not only the source but the details of the property. As such, information has been documented and compartmentalized to provide ease of reach and understanding. Why do we go at length to providing this information to the public when we know the public would exploit it? We encourage public exploitation because there is bound to be improvement. The beauty about intellectual property is that it is not a perpetual right. There is an expiration point due to reason of usage or by law. To be eligible for intellectual property rights, we need to be certain with the type of rights we are dealing with. Each type of rights is bounded by its own law and legislation. Of course for each product we may have more than one type of rights but each type must be dealt with separately. Why? Because each right has its own expiration point. Why do we need this expiration point at all? Because there is not a single technology that does not evolve. Business transaction differs with time, due to needs and wants, sometimes we need to modify our marks to give the added oomph!! We may need to redesign our products. We may need to give a different tune to a known song. So what? So that the public keeps returning to us to purchase our products. Higher purchasing power means higher profits.

So going back to information retrieval, each intellectual property office in the world has its own information depository. The information was gathered by the registration mechanism of the respective rights namely patents, trade marks and industrial designs. The public is allowed to search through a certain database and verify the existence of a certain right. If none, then the public could make use of the right and offer for sale. However if such right is available either pending registration (or pending grant) or registered (or granted), the public is advised not to use and offer for sale. Provided the rights have expired by law, only then they are allowed to use and offer for sale.

There are so many reasons why the public would embark on retrieving information. This would depend on the sector of public in question.

If it is a researcher, the patent information is very helpful in that it would help him/her to decide whether his/her invention is new and worth continuing the research. This kind of search allows him/her to determine whether he/she is not reinventing the wheel. With the degree of newness in Malaysia being new in the world, the patent search to be carried out is borderless, even though the patent right is territorial, that is, the patent right in Malaysia is only protected in Malaysia. He/she may embark on searching to find solutions to problems encountered during his/her research.

For a business entity, the patent search is important if it needs to search for a reliable source of technology, equipment or solution relating to its business activities. The information retrieved may have already expired where in this case the entity can proceed to use the information without having to sign for an agreement for permission to use or a licence agreement. If the information retrieved is still pending or granted and still enforceable then the entity may choose to enter into a license agreement or wait for the patent to expire.

To search for a certain company's activities, information retrieved may be in the form of number of patents applied for within a certain duration of time, or the trend of research it is heading to, or the location of the patent filed, which could mean business transaction in the planning.

For a certain person's research activity, by searching we may retrieve the person's patenting portfolio in numbers, location, pending, granted or even any assignment activity where the person may have sold off his patent right to a company.

To a patent manager, information retrieved may be in the form of likeable infringement or freedom to use or equivalent filings in other countries which could prevent his company from initiating a business transaction.

The patent protection in Malaysia is twenty years from date of filing and is renewable every year upon grant of a patent.

What if the invention is a ready product and the invention is an internal mechanism? How can the public be influenced into buying such product? A design search is encouraged to determine if such design is already in existence, that is, it is already registered. If yes, then some redesigning needs to be made and have it applied for registration. The degree for newness is only in Malaysia, thus by searching through the Malaysian Design Registry and upon none similar design cited, a design registration can be applied for. The Design Act would soon be amended and the best part is the degree of newness is that of the world. When the time comes, we may need to carry out design searches within international design databases.

The design can comprise of a two dimensional work, such as a wallpaper, batik design on a sheet of cloth among others, or a three dimensional work. The requirement is that the design is appealing to the eyes, of the consumer, new in Malaysia and does not form part of a industrial process. The duration of a design registration is fifteen years from date of filing and is renewable every five years. The Act could be amended to prolong the duration of protection to twenty five years.

To sell a product or service, we may need a reliable and catchy name which can withstand the test of time. Certain requirements need to be fulfilled before a trade mark can be registered. First and foremost, the mark must be used in trade. Two prominent requirements are the absolute ground and the relative ground. The absolute ground is that the chosen mark must be inventive, or distinctive, or not describe the nature

of the product or service, or not form part of a geographical location. As for the relative ground, the chosen mark must not be similar or the same with any existing mark already at the Trade Marks Registry.

Another hurdle to overcome before a trade mark can be registered is the Opposition Stage where at this stage any third party irrespective whether it has filed for a trade mark registration or otherwise is allowed to oppose the intention of the Trade Marks Registry to register the trade mark as advertised. Smooth sailing here means a registration certificate will be awarded to the Proprietor. So having decided upon a name is not enough. A trade mark search needs to be carried out to see if there is already available a similar or same mark.

A trade mark is protected from date of filing and is renewable every ten years. If the registered trade marks discontinued to be in use, then the registration shall expires. The Trade Marks Act is to be amended to include non-traditional trade marks namely three dimensional mark, sound, smell and taste. Wonder how are we going to carry out search for these types of marks?

If your product has been identified to be marketed out of Malaysia, a search covering patents, industrial designs and trade marks in the country of interest should be carried out as well. This is to prevent for consequence of infringement action should there be a similar or same rights already existed in that country.

Another prominent type of intellectual property is copyright. What is it? It is a bundle of rights where all kinds of work created by the mind, with a certain degree of effort such that there appears sweat at the eye brow, is original and written onto any permanent media such as paper, magnetic tapes, compact discs and so forth. A face is considered not a permanent form because you will need to wipe it clean after completion of the work. The works here may include literary, drawings, adaptation, translation, broadcasting, engineering drawings and many others. Is copyright a right to copy? In a way, however due acknowledgement must be given, if not, the act of the copying of the work is considered an infringement. The copyright protection period is life of the author plus fifty years or fifty years from date of disclosure if the author is an employee.

There is no registration mechanism in place. However, it provides for an international protection due to Malaysia being a member to the Berne Convention. This simply means that once a work is published in Malaysia it is as if the work is published, on the very same day, in member countries under the Berne Convention.

There are other types of intellectual property but they are not mentioned here. The above mentioned types are those practised in abundance. So, in conclusion, what can we say about intellectual property? As we speak, it is being churned out in thousands, if not millions, all over the world.

Just to leave you with these thoughts, as you go about using, eating, drinking and admiring intellectual property:

Can we trade mark a patent?

Can we trade mark a design?

Can we trade mark a copyright?

Can we copyright a trade mark?

Can we copyright a patent?

Can we copyright a design?

Can we patent a design?

Can we patent a trade mark?

Can we patent a copyright?

Can we design a patent?

Can we design a trade mark?

Can we design a copyright?

IP NEWS IN BRIEF



Switzerland WIPO

India is prepared to work with WIPO and interested countries in sharing its expertise on Traditional Knowledge Digital Library (TKDL). TKDL is an excellent example of a technical platform which can work alongside legislative frameworks. India's TKDL could be a good model for others and that WIPO was ready to facilitate international collaboration for countries which were interested in establishing their own TKDLs. In a conference, it was stated that it is now up to WIPO member states to provide feedback to the WIPO secretariat on which direction to take and whether they wish the Secretariat to enter into an institutional arrangement with India's Council of Scientific and Industrial Research (CSIR) to facilitate the sharing of the TKDL model with other countries.

Australia Integrated Patent Examination with New Zealand

Australia's Prime Minister Julia Gillard and New Zealand's Prime Minister John Key, have announced a new initiative that results in a single patent examination process for both countries. This initiative is part of the Single Economic Market outcomes framework, which aims to make things easier for Australian and New Zealand businesses, and also to help innovators and businesses getting the protection to expand and compete globally. The benefits for innovators are the potential savings in professional fees and patent protection costs and faster examination process - which may help an innovator get their invention to market more quickly.

Canada Rules Governing the Expedited Examination of Patent Applications related to Green Technology

The Proposed Amendments to the Patent Rules - Expedited Examination of Patent Applications Related to Green Technology came

into force on 3 March 2011. One of the amendments is to expedite the prosecution of an application when the invention is related to green technology.

China First Law on Intangible Cultural Heritage

China has made its first attempt to enact a law that safeguards heritage that is of historical, literary, artistic or scientific value. It stipulates that foreign organisations and individuals have to first obtain approval from cultural authorities at least on the provincial level before conducting surveys of Intangible Cultural Heritage (ICH) in China. The draft law supports the representative heirs in carrying out claims during the exploitation and utilisation of ICH projects.

Malaysia MyIPO Expansion Program

The establishment of the regional offices represents MyIPO's continuous effort to ensure that its services are available to a wider segment of the public. MyIPO marked another milestone with the opening of its latest regional office in Johor Bahru (Southern Region) on 26 April 2011 in conjunction with the National Intellectual Property Day. MyIPO will also expand its services to Penang (Northern region) and Kuantan, Pahang (East Coast region) before end of 2011. It is MyIPO's objective to provide effective administration regime and to enhance its delivery system.

Norway Why Norway is attractive for generics?

Norway is an interesting market for producers of generic medicaments produced by synthetic routes that differ from and do not infringe the methods claimed and exemplified by patent owners. The attractiveness will continue so long as the "analogous method of preparation" patent are in force.

UK Reform of the Patents County Court

Patents County Court has recently been revamped with new rules that are intended to provide access to justice for those with less deep pockets, procedure has also been streamlined in order to speed it up, and to engage the judge at an earlier stage in proceedings. Many of the new procedures appear to be based on those used at the European Patent Office, which are very familiar to patent attorneys in the UK. The new rules will provide better certainty for businesses that are forced into litigation at the Patents County Court. It is hoped that these new rules will widen access to justice so that small and medium sized companies have an affordable forum for enforcing their IP rights.

US USPTO will launch its Fast- Track Patent Processing

The United States Patent and Trademark Office (USPTO) will begin accepting requests for prioritised examination of patent applications - allowing inventors and businesses to have their patents processed within 12 months after the launching of the program on 4 May 2011. The program, called Track One is part of a new Three - Track system, which will provide a comprehensive, flexible patent application processing model to the nation's innovators, offering different processing options that are more responsive to the real-world needs of its applicants. The Three-Track program will bring the most important new products and services to market more quickly, helping to build businesses and create new jobs in America.



norunnuha sdn bhd

Patent.Trademark.Industrial design

Dari jauh kami datang,
Sokongan padu kami serahkan,
Harta intelek negara patut ditatang,
Geran dan penguatkuasaan kami harapkan.

We are vibrant Malaysian,
Rich in tradition and bio-diversity,
We protect our IP and execute our National plan,
To bring Malaysia marks to international community.

Pantun Seloka NSB

Arena Harta Intelek Kami Ceburi,
Norunnuha Sdn. Bhd. nama diberi,
Aset Intelektual Negara wajib dilindungi,
Untuk manfaat generasi kemudian hari.

Gincu dan celak adalah alat solek,
Digunakan diwajah Hawa untuk menambahseri,
Ketahuilah hak anda dalam harta intelek,
Agar kelak idea anda tidak dicuri.



Intellectual Property Consultation and Services

Patent

Plant Variety

Copyright

Trademark

Domain name

Industrial design

Geographical Indication

Contact us:

Norunnuha Sdn Bhd
No.17-2, Jalan Medan Pusat 2D,
Persiaran Bangi, 43650 Bandar Baru Bangi,
Selangor, Malaysia.
T: +603 8922 2518 F: +603 8925 8171
E: info@norunnuha.com

Contact Person:

Norunnuha Datuk Hj Nawawi
Raja Muhazam Farid Raja Mukhtar
Nur Amalina Zamani
Nur Hazwah Mohd Amin

IP Awareness In Malaysia

Mohd. Shahar Osman

Deputy Director General (Corporate)

The largest economies in the world have a lot of their wealth and influence tied up with the protection of intellectual property (IP). IP is also one of the indicators for science and technology development which can contribute to the foreign investment rates to the country's Gross Domestic Product (GDP). Thus, the Government of Malaysia is very committed towards developing intellectual property as a new engine growth for the enhancement of social and economic prosperity.

In line with the vision, mission and objective to provide strong legal infrastructure and effective administration regime in enhancing greater creativity and exploitation of IP, Intellectual Property Corporation of Malaysia (MyIPO) also plays an important role in creating awareness about the opportunities that IP can serve as one of the economic enablers in the development of the economy in Malaysia.

MyIPO is consistent in supporting and encouraging innovation through aggressive awareness programs which focus on women, youth and students. Media has been chosen as one of the mainstream to channel the information on the importance of IP to the target

groups. Through a close cooperation with the agencies under Ministry of Domestic Trade, Co-operatives and Consumerism with NGOs, MyIPO is able to meet every segment in our society including the grassroots level by using our IP Mobile as one of the attempts in order to reach the people in rural areas.

IP is a valuable asset which needs to be made realized of its opportunities and benefits through the registration at the Intellectual Property Office. By protecting your creation of minds, it gives an exclusive right to the owner to make, use or sell his creation and to stop others from manufacturing, using and/or selling the owner's creation in Malaysia without the owner's consent or permission. This is also in line with Malaysia New Economic Model, whereby intellectual property plays an important role in the value chain and creating a convincing business environment that would be beneficial to investors, businessmen as well as the SMEs.

To complement the Government's efforts towards empowering and inculcating innovation and creativity, MyIPO will continuously put its extra efforts to establish a broad sense of respect and responsibility in developing a smart and ethical intellectual property citizen.



Recent Amendments of Patents Regulations and Trade Marks Regulations

Shamsiah Kamaruddin

Deputy Director General (Industrial Property)

MyIPO has taken another step forward in improving the registration system of intellectual property to be more efficient, promoting foreign investment and economic growth.

On 15 February 2011 the Patents Regulations (Amendment) 2011 and the Trade Marks Regulations (Amendment) 2011 were enforced. The main amendment in both Patents and Trade Marks Regulations is the introduction of new provision for expedited examination. This provision gives the option to the qualified applicant to request either to the Registrar of Patents or the Registrar of Trade Marks to have his/her application to be expeditiously examined.

With this provision of expedited examination, the patent owner is able to get his patent application granted within 20 months from the date of filing of application. Similarly, the trade mark owner is able to get his trade mark registered within 6 months 3 weeks from the filing date of his application.

However, one has to bear in mind that the 20 months pendency period for patent and 6 months 3 weeks pendency period for trade mark are only for applications that have fulfilled all the requirements of the Acts at the time of filing the applications (clear cut case).

The registration system of intellectual property requires the applicants to abide or fulfill the statutory procedures such as specific time is given to the applicant to request for examination, to respond to any objections made by the Registrar or to make any corrections or amendments to the applications and this allow the lengthy process of the applications.

In order to improve the pendency period for the granting of patents, the provision to request for substantive examination is now 18 months from date of filing of application (24 months before the patents regulations was amended).

The time period to respond to any objections by the Registrar of Patents or to make any amendments to the applications is 2 months from the date of the examination report (3 months previously). With the new deadlines and improvements in the Standard of Procedures (SOP) processing time by the examiners, it is targeted that the pendency period for the granting of patent is 26 months (39 months in 2010).

As for trade marks, to shorten the pendency period for the registration of trade mark, the provision of acceptance process by the applicant on his application which is considered for registration was abolished. Instead, the applicant is required to request the Registrar to advertise his trade mark in the government gazette once his trade mark application is accepted by the Registrar.

With this improvement as well as reducing the time of search and examination and preparation of gazette in the SOP of examiners, the pendency period for registration of trade mark is 12 months (18 months in 2010).

The new process flow of patent and trade mark application procedures as well as the guidelines on requesting for expedited examinations are available at MyIPO's website www.myipo.gov.my.

In line with the era of digitization, MyIPO has also introduced the online filing not only for submissions of applications but for all filings of documents related to patents and trade marks in this new amendments of Patents and Trade Marks Regulations. To encourage applicants to file online, e-filing fee is introduced where the fees are cheaper than the manual filing.

regizmark 

We Deliver Results. Not Just Reports.

We are a boutique Intellectual Property practice based in Kuala Lumpur dedicated to the complete protection of our clients' trade marks, patents, designs, copyright and associated Intellectual Property rights. We focus exclusively on all aspects of Intellectual Property matters in Malaysia, Asia and elsewhere in the world. Our prompt, personalized and results-orientated service at very competitive pricing are our major strengths. Our clients have complete confidence and satisfaction in our services. For more information, kindly contact us as follows:-

REGIZMARK IP CONSULTANTS
Suite 206, GF-16, The Waterfront
No. 5 Persiaran Residen, Desa ParkCity
52200 Kuala Lumpur
Malaysia

Tel : +6 012 378 3276 (Contact Person: Stephanie Leong)
Fax : +6 03 6272 5957 / +6 03 6280 8304
Email : contact@regizmarkmalaysia.com
Website : <http://regizmarkmalaysia.com>

Trade & Service Marks | Patents | Designs | Copyright | Geographical Indications
Protecting Intellectual Property Is Our Priority.

MarQonsult®

"Intellectual Property Strategies
that Drive your Success"
"让您迈向成功之路的知识产权规划"



Voted 2006~2010 Asialaw Leading Lawyer in Intellectual Property

**MARK YOUR GLOBAL PRESENCE
THROUGH OUR EXPERTISE**
透过我们的专才标示出您的世界地图

- ✓ Quick Response Time | 快捷的回应
- ✓ Affordability & Adaptability | 价格合理, 迎合需求
- ✓ Quality & Integrity Assured | 优质服务, 绝佳诚信
- ✓ In-depth client counselling | 深入客户咨询
- ✓ International Representation | 国际代理

B706, Level 7, Block B, Kelana Square, Jalan SS7/26, Kelana Jaya,
47301 Petaling Jaya, Selangor Darul Ehsan
TEL: 603-788 20 456 | EMAIL: ip@marqonsult.com | WEB: www.marqonsult.com



- **Franchisor Financing Scheme**
 - Franchisor Financing Scheme
 - Pre-Franchise Financing Scheme
- **Franchisee Financing Scheme**
 - Executive Franchise Scheme
 - Youth Franchise Scheme
 - Franchisee Financing Scheme
 - Women Franchise Programme
 - Graduate Franchise Programme
 - Micro Franchise Financing Scheme
- **Licensor and Licensee Financing Scheme**
- **Contract Financing Scheme**
- **Equity Investment Scheme**
 - Pre-IPO Investment Scheme
 - Mezzanine Investment Scheme
 - Franchise Investment Scheme

Financing
from
to **RM 3,000**
RM 2 million

www.pns.com.my
Toll Free Line
1800-88-5300





‘Malaysian Nuclear Agency

(Nuclear Malaysia),

Leading the R&D and

Innovation Centre on

Development of

Nuclear Technology’

For future information
kindly contact :

Director General
Malaysian Nuclear Agency (Nuclear Malaysia)
Bangi, 43000 Kajang, Selangor Darul Ehsan

Tel : 03-89250510

Fax : 03-89258262

Nuclear Malaysia is an R&D organization provides services in industry, medical, agriculture, manufacturing and the environment in support for socio-economic development of the country.

TECHNICAL SERVICES

- Personal and Environmental Radiation Monitoring
- Quality Assurance
 - Industrial
 - Medical
 - Biological
- Medical Quality Assurance
- Waste Management
- Non-Chemical Sterilization

CONSULTANCY

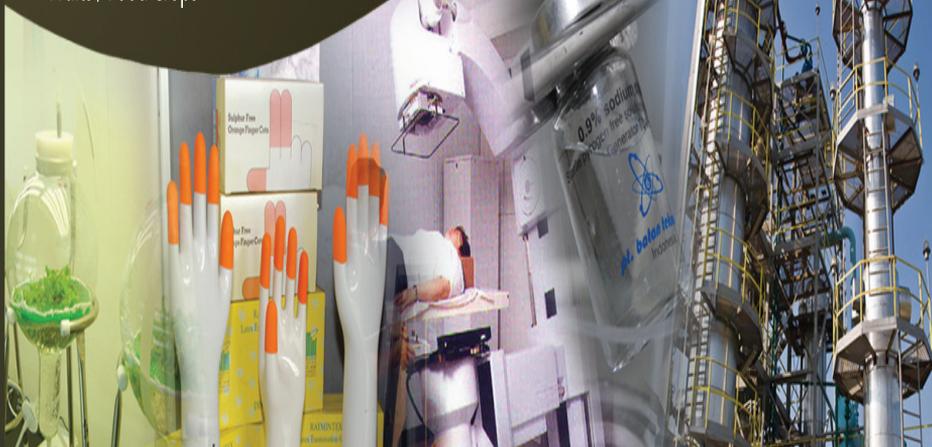
- Occupational Safety & Health
- Radiation Monitoring
- Environmental Pollution & Assessment
- Management of Waste & Water Resources
- Engineering Design & Development
- Nuclear Advisory & Policy Planning

TRAINING

- Professional in Radiation and Medical Personnel

PRODUCTS

- Medical Diagnostic Kits and Medical Radioisotopes
- Radiation Pre vulcanized Natural Rubber Latex
- New Varieties of Ornamental and Fruits / Food Crops



Invalidation of Patent on the Ground of Insufficiency

Teo Bong Kwang

Wong Jin Nee & Teo

In the 19th century, in the case of *Plimpton v Malcolmson*,¹ Jessel M.R. of the English Court of Appeal made this famous remark: “*You must not give people mechanical problems and call them specifications.*” In the 21st century, Aldous LJ said, “*I do not believe that the patent system should be used to enable a person to monopolise more than that which he has described in sufficient details to amount to an enabling disclosure. If it was, it would stifle research.*”²

Statutory Requirements for Sufficient Descriptions

On the local front, we have Regulation 12 of the Patents Regulations 1986 which provides that:

- (1) The description shall first state the title of the invention as appearing in the request and shall - ...
- (c) disclose the invention in such terms that it can be understood and in a manner sufficiently clear and complete for the invention to be evaluated and to be carried out by a person having ordinary skill in the art, and state any advantageous effects of the invention with reference to the background art;
- (d) briefly describe figures in the drawings, if any;
- (e) describe the best mode contemplated by the applicant for carrying out the invention, using examples where appropriate and referring to the drawings, if any; and
- (e) indicate explicitly, when it is not obvious from the description or nature of the invention, the way in which the invention is industrially applicable and the way in which it can be made and used or, if it can only be used, the way in which it can be used”.

Regulation 13(1) further provides that “the claims must be clear and concise and fully supported by the description; and the number of claims shall be reasonable taking into consideration the nature of the invention”.

¹ (1876) 3 Ch D 531 at 576.

The failure to observe the above-said regulations may have dire consequences as the resultant patent may be declared invalid. Section 56 (2)(b) of the Patents Act 1983 provides that it is a ground for invalidation if the description or the claim does not comply with the requirements of section 23. Section 23 of the Patents Act in turn provides that “*every application for the grant of a patent shall comply with the regulations as may be prescribed by the Minister under the Act.*”

Case Laws Pertaining to Insufficiency

In Heveaform Asia Sdn Bhd v PF (Teknologi) Sdn Bhd,³ the High Court of Shah Alam had the opportunity of examining the issue of, *inter alia*, insufficiency of descriptions of a utility innovation (UI).⁴ The brief facts of this case are as follows. The defendant has registered a UI pursuant to the Patents Act. The UI relates to a foam product with annular bores extending from the surface of the foam product into the general body of the foam and is alleged to be an improvement of the conventional foam products. The defendant alleged that the objective of the innovation is to overcome the disadvantages of *inter alia*, poor weight support, bad circulation of air, poor ventilation and limited ability to fold. It claimed that the plaintiff had infringed its UI. In a counter-strike, the plaintiff took out an originating summons praying *inter alia*, for a declaration under sections 56 and 57 of the Patents Act 1983 that the defendants’ UI is invalid and a declaration of non-infringement under section 62 of the Act. Besides relying on the usual ground of lack of novelty, the plaintiff had relied on the ground of insufficiency as well. On the issue of insufficiency, the learned judge, Justice Low Hop Bing (now JCA) observes:

“*Section 56(2)(b) provides that it is a ground for invalidation if the description or the claim does not comply with the requirements of section 23 of the Act.*”

² *American Home Products v Novartis Pharmaceuticals* [2001] RPC 159 at 179.

³ [2001] 2 MLJ 660.

⁴ According to section 17 of the Malaysian Patents Act, 1983, a utility innovation is an innovation which creates a new product or process or any new improvement of a known product or process which is capable of industrial application. It is not to be equated as a patent and is more in the nature of an exclusive right granted for a ‘minor’ invention that falls short of inventive step as required for a full patent protection. It is sometimes called a “petty patent” or “utility model”.

Section 23 of the Act provides as follows:

23 Requirements of application.

Every application for the grant of a patent shall comply with the regulation as may be prescribed by the Minister under this Act.

More specifically, it is incumbent upon the defendant to comply with the requirement prescribed in Reg 12(1)(c), (e) and (f) of the Patent Regulations, failing which, the plaintiff would be in a position to raise insufficiency for the purpose of invalidating the defendant's UI."

The learned judge then proceeded to set out the provisions of Reg 12(1)(c) (e) and (f) of the Patent Regulations and then continued to explain the rationale for such requirements:

"It was explained by the English Court of Appeal in Tetra Moletric Ltd's Application (1997) RPC 290 that 'if you cannot achieve the promised result because of deficiencies in the information given in the specification, there is insufficiency'. Insufficiency, in my view, means something which is insufficiently described. In Vidal Dyes Syndicate v Levinstein Ltd (1966) RPC 532; Same v Read Holliday & Sons Ltd 29 RPC 245, at p 265, the English Court of Appeal emphasised the importance of a sufficient description as follows:

Two duties are incumbent upon a patentee in preparing his complete specification. In the first place, he must particularly describe and ascertain the nature of the invention, and, in the second place, he must particularly describe and ascertain in what manner the same is to be performed."

After examining the evidence adduced by the expert witnesses, the learned judge came to the following conclusion:⁵

"In my view, the purpose and meaning of the specification is to put the public in possession of the secret of the UI as ample and beneficial a way as the patent himself uses it. Therefore the failure of the [inventor] to state the parameters such as diameters, thickness and, the pattern distribution of the annular bores clearly puts the secret of the UI out of the public's reach and as such ought to be invalidated on the ground of insufficiency, as it fails to comply with reg 12(1)(c) of the Patent Regulations in that it has failed to disclose the invention in such terms and in a manner sufficiently clear and complete for the invention to be evaluated and carried out by a person having ordinary skill in the art."

The issue of insufficiency of patent surfaced again recently in two decisions emanated from the Intellectual Property Court of Kuala Lumpur. The first case is *Kendek Industry Sdn Bhd v Ecotherm (TFT) Sdn Bhd*⁶ and the second case is *Ranbaxy (Malaysia) Sdn Bhd v E.I. Du Pont De Nemours and Company*.⁷

The subject matter of *Kendek* case is again a UI. The UI relates to the composition of a "movable part" (presumably a roller) which is used in the dipped latex industry to produce dipped latex products such as gloves, condoms and balloons. The Claim of this UI reads as follow: "A composition for movable parts in a dipped latex products industry, such as rollers made from a composition of 5 to 60% fibre-glass mixed with 95 to 40% polymer selected from nylon, PC (polycarbonate), PET (polyethylene terephthalate), PPO (polyphenylene oxide), PBT (polybuthelene terephthalate) and ABS (acrylonitrile butadiene styrene) and other like polymers." According to *Kendek Industry Sdn Bhd* (the plaintiff), the UI discloses a "movable part" with a composition consisting of plastics and fibre glass as mixture. It claimed that the defendant had infringed its UI. The defendant counterclaimed for an order to invalidate the UI. The defendant first pleaded that the UI is incapable of industrial application. In addition, the defendant pleaded that there is no demonstrable or acknowledged success for the innovation found in the UI and the claim is insufficient contrary to Reg 12(c) of the Regulations. The reasons for insufficiency were that the Claim did not set out the innovation with any reasonable degree of precision and particularity and that a skilled person would not understand what is claimed nor would he understand the scope of the Claim read in the light of the description. The Claim is confined to a broad range of compositions used for the movable parts but does not, in particular specify the exact or permissible workable range in percentage terms of the compositions for each and different type of named polymers and fibre glass.

The learned judge, Azahar Mohamed J apparently grounded the rationale for sufficiency in descriptions and clear disclosure of an invention in the need for a balancing of interests between the private rights of the patent owner and interests of the third parties:

"It is true that a rigid approach to interpretation of the UI could deprive the Plaintiff of effective protection. But to my mind, providing effective protection for the Plaintiff must be balanced by the interests of third parties who need to be able to see, from the claim, the extent of the monopoly

⁵ At page 685 of the decision.

⁶ Kuala Lumpur High Court Civil Suit No. D-22(IP)-1487-2005 (unreported). Decision handed down on 9 April 2010. The decision is available from CLJ unreported decisions.

⁷ Kuala Lumpur High Court Civil Suit No. D5(IP)-22-16-2009 (unreported). Decision handed down on 18 February 2011.

granted so that they can be reasonably certain that any activities they are contemplating do not fall foul of the Act."

The learned judge first of all pointed out that a patent specification or UI specification is addressed to this notional person called "a person having ordinary skill in the art" (or "skilled person" or "man skilled in the art" for short) and the Court must interpret them through the eyes of this person. As such the court requires the assistance of the man skilled in the art in the exercise of construing the subject UI. However, *"at the end of the day, all question in connection with the interpretation of the claim and specification of the UI must be resolved by this court. It is for the court, not for DW1 and PW2 [the expert witnesses] to come to a decision on the matter of construction."*

On the issue of insufficiency, the learned judge made the following very pertinent observations at pages 23, 24 and 25 of the grounds of decision:

"Non-compliance with the regulations is a ground for a invalidation of the utility innovation, pursuant to section 56(2)(b) of the Act. That provision says that the court shall invalidate any registered UI if the description or the claim does not comply with the requirements of section 23, which section provides that the grant of the UI must comply with the Regulations..."

One of the principles of construction is that the specification should be read and construed objectively through the eyes of the persons to whom it is addressed and to whom common general knowledge is imputed (see: Narayanan (2006) Patent Law). Sufficiency is decided by the court judged through the eyes of a person skilled in the art (see: Intellectual Property Law by L. Bentley and B Sherman, (3rd ed.) Oxford)."

In the case of Mentor Corporation and Anor v Hollister Inc. [1993] RPC 7, Lloyd J has this to say:

"The question for decision in the present case is whether the specification discloses the invention clear enough and completely enough for it to be performed by a person skilled in the art. This obviously involves a question of degree. Disclosure of an invention does not have to be complete in every detail, so that anyone, whether skilled or not, can perform it. Since the specification is addressed to the skilled man, it is sufficient if the addressee can understand the invention as described, and can perform it. In performing the invention the skilled man does not have to be told what is self-evident, or what is

part of common general knowledge, that is to say, what is known to persons versed in the art. But then, comes the difficulty. How much else may the skilled man be expected to do himself?"

What I gathered from decided cases is that [the skilled person] is not required to undertake any detailed analysis, research, experimentation or inquiry to determine what the subject of the innovation attempted to be described in the description and sought to be claimed in the claim "(see Mentor Corporation and Anor v Hollister Inc. [1993] RPC 7 and Valensi v British Radio Corporation [1973] RPC 337)."

After perusing the Claim (particularly the term used "movable parts") and examining the evidence adduced, the learned judge ruled that the Claim is not clear and the person skilled in the art would have problem understanding the language used in the Claim in light of common general knowledge.⁸ The learned judge therefore struck down the patent as being insufficient in descriptions.

In the case of *Ranbaxy* case, the learned judge came to a different decision on the issue of sufficiency. The invention involved is much more sophisticated in this case. It is about a chemical compound called losartan potassium in crystalline form. These chemical compounds are used for treating hypertension and congestive heart failure. The plaintiff, *Ranbaxy* is a well-known generics drug manufacturer. It has marketed a generics drug called "COVANCE". The active ingredient of this drug is none other than losartan potassium. The Defendant, *E.I. Du Pont De Nemours and Company* is the owner of a Malaysian patent which claimed a monopoly over the said losartan potassium. The plaintiff took the preemptive measure of seeking a declaration to declare that certain claims (Claims 7 and 8) of the subject patent as invalid on the grounds of inter alia, insufficiency. It has also sought an additional declaration of non infringement, specifically to declare that COVANCE drug does not infringe the defendant's subject patent. The defendant counter-claimed for infringement of patent.

The learned judge, *Azhar Mohamed J* before embarking on the substantive issues relating to the validity of the subject patent, made some very insightful remarks on the basic philosophy behind the whole patenting system, which are worth reproducing:

"A patent is a set of exclusive rights granted by the Registrar of the Patent Office, Intellectual Property Corporation of Malaysia (MyIPO) to an inventor for a period of 20 years from the date of filing in exchange for the public disclosure of an

⁸ See pages 18 to 19 of the Grounds of Decision.

invention. Patent rewards a patentee for making and disclosing the invention (see: SKB Shutters Manufacturing Sdn Bhd v Seng Kong Shutters Industries Sdn Bhd & Anor [2011] 1 AMCR 287). The process of granting patents, the requirements placed on the patentee and the exclusive rights are clearly set out in the Act and the 1986 Regulations.”

On the substantive issue of insufficiency, the learned judge held that both regulations 12(1) and 13(1) of the Patent Regulations 1986 are intended to be mutually dependent on one another. It is therefore permissible to look at the description of the specification to ascertain if it discloses the invention sufficiently and in a clear and complete manner to support the claims. It is submitted that this is a correct approach as a patent specification must be read as a whole and as such the claims must be read in the light of the descriptions.

The learned judge then alluded to the established principle of law that a patent is to be read by a person skilled in the art. Reliance is placed on English cases such as *Lubrizol Corp v Esso Petroleum Co Ltd & Others*⁹ and *Technip France SA's Patent*¹⁰.

After carefully examining the evidence of the experts (who are held to be persons skilled in the art as well), the learned judge concluded that there were in fact sufficient descriptions of the crystalline form of losartan potassium and the relevant Claims (Claims 7 and 8) for it are indeed supported by the descriptions. One of the interesting issues raised is whether a disclosure can be inherent before it can form part of the claimed monopoly? The plaintiff argued that the relevant example (namely example 316 Part D) given in the descriptions, which is heavily relied on by the defendant to justify Claims 7 and 8, does not expressly state that the crystalline form of losartan potassium would be produced. As such, according to the plaintiff, it follows that claim 7 does not claim crystalline form of losartan potassium. The Court relied on the US case of *Continental Can Co USA v Monsanto Co*¹¹ and the UK decision of *Synthon BV v Smithkline Beecham plc*¹² and held that inherent disclosure is sufficient to support a claim found in a patent specification. It should be pointed out that the scope of inherent disclosure is not a wide one. The learned judge is mindful of this and cited the following principles as laid down in the US case of *Re Oelrich*¹³:

“Inherency however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient. If...however, the

disclosure is sufficient to show that natural result flowing from the operation as taught would result in the performance of the questioned function, it seems to be well settled that the disclosure should be regarded as sufficient.”

In *Ranbaxy's* case, we believe that one of the important factors which influenced the decision of the learned judge was that there was positive evidence adduced by the persons skilled in the art which demonstrated that upon performing the experiment as taught by example 316 Part D, crystalline losartan potassium was indeed produced.

Conclusion

From the cases discussed above, it is very clear that one of the matters to be taken very seriously while embarking on a costly exercise of patenting is to ensure that the patent specifications are correctly and carefully drafted to fulfill the requirements of the Act. The descriptions and claims should contain sufficient details to withstand any possible challenge. The engagement of a well qualified patent agent or a competent patent specification drafter is of utmost importance to any good and effective patenting programme. Failure to do that may result in a granted patent being challenged and invalidated subsequently. It is also important for the Patent Office to take a more vigorous and stringent approach while examining the issue of sufficient disclosure to ensure that no spurious patents are being granted. The reason for the insistence on full disclosure and sufficient descriptions is very obvious: a granted patent is a monopolistic right given by the state in exchange for public disclosure of a workable invention. It cannot be disputed that any monopoly is anti-competition in nature. However the basic assumption of a patent system is that such a trade-off will benefit the society at large in the long run as the members of public will get to enjoy the fruits of innovation of the inventors. There is therefore absolutely no reason to grant someone a monopolistic right over a questionable invention, more so if the alleged invention cannot be put to practice and therefore does not advance the state of the technology.

⁹ [1998] R.P.C. 727.

¹⁰ [2004] R.P.C. 46.

¹¹ 948 F.2d 1264, 1268; 20 USPQ 2d 1746, 1749 (Fed. Cir., 1991).

¹² [2006] 1 All ER 685.

¹³ 666 F.2d 578, 581; 212 USPQ (BNA) 323, 326 (CCPA, 1981).

MyIPO's NEW OFFICE

In line with our expansion plans, MyIPO has moved to its new office at Menara UOA Bangsar in November 2010. With this new environment MyIPO aims to be more efficient in improving its delivery system to better serve the public.



Level 19 foyer features corporate look



New service counter: attractive and comfortable



Advancement of ICT

Intellectual Property Training Center (IPTC) Room Facilities



1. TRAINING ROOMS

IPTC has 5 training rooms: Camelia, Lavender, Tulip, Cempaka and Kenanga for various functions as trainings, meetings, courses, workshops, seminar, conferences and other functions. Each room is fully equipped with advanced audio visual equipment such as PA system, LCD projector, plasma TV and WiFi for internet connection.

Rooms	Seating Capacity
Camelia	60 participants
Lavender	50 participants
Tulip	50 participants
Cempaka	50 participants
Kenanga	38 participants

2. COMPUTER TRAINING LAB

This computer training lab known as Kenanga room provides a total of 38 computers with high speed internet connection.

3. IPTC BALLROOM

Spanning an area of more than 3,626 square metres, IPTC Ballroom that can accommodate up to 200 people is equipped with the latest audio visual teaching aids such as PA system, LCD projector, plasma TV and speedy internet connection.

Rooms	Seating Capacity	Style
IPTC Ballroom (3,626 sq. ft)	200 participants	Seminar style
IPTC Ballroom (3,626 sq. ft)	300 participants	Theatre style



4. PUBLIC SEARCH ROOM

The Public Search Room facility is located at mezzanine floor to provide public access to patents, trade marks and industrial designs information. It can accommodate 34 people at one time and open from 8.30 am - 5.15 pm on Monday to Thursday. On Friday, the operating hours is from 8.30 am - 5.15 pm on Monday to Thursday. On Friday, the operating hours is from 8.30 am - 12.15 noon and 2.45 pm - 5.15 pm. Trained staff are available to assist public users.

5. MUSOLLA

IPTC also accentuates on the comfort of performing prayers by providing musolla which can accommodate 50 people at a time.



6. INTELLECTUAL PROPERTY LIBRARY (IP LIBRARY)

Intellectual Property Library (IP Library) provides a total of 10,000 reference books on intellectual property and general, newspapers, journals and magazines. The collection consists of both local and international publications. Our library also provides computer facilities with high speed internet connection that allow visitors to access information with ease.

Intellectual Property Training Centre Programme (January - April 2011)

JANUARY

- 1 IP Online Training
- 2 Briefing on Patents and Trade Marks Regulations

FEBRUARY

- 3 Workshop on Patent Competition - 'Innovative Solutions for Everyday Life'
- 4 WIPO Training of Trainers
- 5 Better Intellectual Properties (IPs), Better Economies
- 6 Franchising for All

MARCH

- 7 Training on STN
- 8 Training on Global Patent Index
- 9 Course on Introduction to Trade Marks
- 10 WIPO Strategy and Program on IP Infrastructure and Information
- 11 Franchising for All

APRIL

- 12 Intermediate Franchise Operations Management
- 13 Franchising For All
- 14 Franchise Your Business Choice
- 15 Franchising For All
- 16 World Creativity & Innovation Week & Innovation Forum
- 17 Franchisee Business Plan
- 18 Franchising For All
- 19 Franchise Strategic Management
- 20 Franchising For All
- 21 National Intellectual Property Day Seminar

Intellectual Property Training Centre Programme (May - December 2011)

MAY 2011

- 1 MyIPO-BiotechCorp, Basic Patent Drafting Workshop for the Life Sciences and Biotechnology Industry
- 2 MyIPO-National Library of Malaysia, World Book Day, Seminar on Copyright Awareness Among the Librarian
- 3 MyIPO-EPO, Regional Course on Patent Search
- 4 MyIPO-Universiti Sains Malaysia, Intellectual Property Seminar in Conjunction with the National Research and Innovation Competition

JUNE 2011

- 5 MyIPO-FMM, Workshop on Trade Mark, Branding and Labelling
- 6 MyIPO-WIPO, Training on Search and Examination for Patent Examiners
- 7 MyIPO-Pharmaceutical Association of Malaysia, Seminar on Intellectual Property for Pharmaceutical Industry
- 8 MyIPO - Universiti Utara Malaysia, Intellectual Property Awareness for University Community and Empowering SMEs Through IP

JULY 2011

- 9 MyIPO-BiotechCorp, Advanced Patent Drafting Workshop for the Life Sciences and Biotechnology Industry
- 10 MyIPO-WIPO, National Seminar on PCT
- 11 MyIPO-WIPO, National Workshop on the Importance of Geographical Indication Protection
- 12 MyIPO-WIPO, National Workshop on the Importance of Geographical Indication Protection
- 13 Seminar on Examination Preparation for Patent Agent
- 14 Workshop on Patent Drafting (Level 1- Introductory)
- 15 MyIPO - Universiti Malaysia Kelantan, Intellectual Property Awareness for University Community and Empowering SMEs Through IP

Note:

The above programs are tentatively scheduled. MyIPO has the right to make any changes without prior notice. For further details, please call 03-2299 8585 / 8593

AUGUST (RAMADHAN - FASTING MONTH)

SEPTEMBER 2011

- 16 Patent Drafting (Level 2)
- 17 MyIPO - Universiti Malaysia Sabah, Intellectual Property Awareness for University Community and Empowering SMEs Through IP
- 18 MyIPO-WIPO, National Seminar on Budapest Treaty
- 19 Certificate in Trade Mark Law (Level 1)
- 20 MyIPO-BiotechCorp, Seminar on IP Strategy & Management

OCTOBER 2011

- 21 MyIPO-BiotechCorp, Seminar on Basic Licensing Workshop
- 22 Patent Agent Examination
- 23 Seminar on Madrid System for Trade Marks
- 24 Intellectual Property Management (Patent, Trade Marks, Industrial Designs)
- 25 Briefing on Amendment of Industrial Design Act

NOVEMBER 2011

- 26 MyIPO - Universiti Teknologi MARA, Intellectual Property Awareness for University Community and Empowering SMEs Through IP
- 27 Seminar for Industrial Design Eastern Zone
- 28 MyIPO - Universiti Selangor, Intellectual Property Awareness for University Community and Empowering SMEs Through IP
- 29 Certificate in Trade Mark Law (Intensive) (Level 2)

DECEMBER 2011

- 30 MyIPO - Universiti Malaya, Intellectual Property Awareness for University Community and Empowering SMEs Through IP
- 31 Training Course on Commercialization of IP Assets
- 32 MyIPO-WIPO, National Seminar on Hague Agreement on International Registration of Industrial Design

Key Corporate Events

(January - April 2011)



Minister's visit to MyIPO new office

7 January 2011 - The Intellectual Property Corporation of Malaysia (MyIPO) is honoured to have the official visit by YB Dato' Sri Ismail Sabri bin Yaakob, Minister of Domestic Trade, Co-operative and Consumerism to the new office located at Menara UOA Bangsar. YB Dato' Sri was given a tour of the

service counters which are located on the ground and mezzanine floor, the Trade Mark and the Patent Department. During the tour, YB Dato' Sri was given a brief explanation on the system used by examiners of the respective department. With the visit by YB Dato' Sri, it became a kick start for MyIPO to continually drive the organization's vision and mission.



Briefing Session on the Amendment of Patents and Trade Marks Regulations 2011

25 January 2011 - A briefing session on the amendment of the Patents and Trade Marks Regulations 2011 was organized at the Intellectual Property Training Centre (IPTC), Menara UOA Bangsar, Kuala Lumpur. There were 140 participants from IP stakeholders have attended the briefing session. The session began with the opening remark by the

Director-General, Y.Bhg. Dato' Azizan Mohamad Sidin, and a briefing on the amendment of trade mark regulations was presented by Senior Director of Trade Mark Division, Encik Abdul Aziz Ismail while the amendment of patents regulations was presented by Senior Director of Patent Division, Encik Zulkarnain Muhammad. Participants have received a clear explanation on the expedited examination for patents applications from the briefing session.



Orientation Workshop – Patent Competition “Innovative Solutions for Everyday Life”

8 February 2011 - An orientation workshop was organized at Intellectual Property Training Centre (IPTC), Menara UOA Bangsar with the presence of our honourable guest speakers from World Intellectual Property Office (WIPO), Mr. Omar Katbi and

Mr. Konrad Lutz Mailänder. The objective of this workshop was to provide further details regarding the Patent Competition that was launched on 15 November 2010 with the theme “Innovative Solutions For Everyday Life”. MyIPO has received an overwhelming response with 200 registration forms submitted before its closing date on 31 January 2011.

WHAT WOULD HAPPEN IF YOU DON'T PROTECT YOUR INTANGIBLE ASSETS



TM

COPYRIGHT

Need to know HOW?
Speak to our consultants
+ 6016-212 1095

- OUR SERVICES:
- + PATENT
 - + TRADE MARK
 - + DESIGN REGISTRATION
 - + COPYRIGHT & OTHER IP
 - + IPOCOMMERCIALIZATION



PINTAS
" Today's Asset, Tomorrow's Value "

Market Offerings:
IP Audit • IP Strategy • IP Protection • IP Structure
IP Grant • IP Tax • IP Value • IP Enforcement
Singapore • Malaysia • China • Brunei • United States

今日资产，明日价值
PINTAS IP GROUP
Suite 6.03, 6th Floor, Wisma Mirama, Jln Wisma Putra, 50460 Kuala Lumpur.
Tel: 03-2148 5050 Fax: 03-2143 3386
Website: www.pintas-ip.com | Email: marketing@pintas-ip.com



Asia Calling!
Visit us at  **pmc**
Connecting ASIA

patrick mirandah co.

SINGAPORE
MALAYSIA
INDONESIA
THAILAND
PHILIPPINES
VIETNAM
INDIA

Visit us at
www.mirandah.com

From Patent Office to Court Room – Patents Come Alive

Dave A Wyatt

Henry Goh & Co. Sdn. Bhd.

The Malaysian Patents Act 1983 entered into force on 1 October 1986 and will thus reach the age of 25 later this year. The Act marked the introduction of the country's independent patent law that replaced the earlier system of re-registering UK patents. Obviously, 25 years or one quarter of a century is a long period of time. The country has progressed remarkably over this period, and the intellectual property (IP) scene is no exception.

Since the Patents Act came into force, and as of February 2011, over 108,000 patent applications have been filed and over 43,000 patents have been granted. The Act was amended significantly in 1993, 2001 and 2006 to modernize and keep the law in line with changing international standards and obligations.

2003 was a significant year in that it saw the formation of the Intellectual Property Corporation of Malaysia, now best known as MyIPO. The Corporation is fully autonomous in its administration and finance. Its establishment facilitated a great expansion in the workforce and manpower of the patent registry. The result was a much more efficient and customer-oriented organization that was better able to cope with its growing workload. The results of this change are well demonstrated by the statistics for grant of patents in the following years. More than 20,000 patents were granted in the 5-year period from 2004-2008.

In 2006, Malaysia joined the Patent Cooperation Treaty (PCT). The PCT provides a more convenient route for foreign parties to get patent protection in Malaysia. It also allows Malaysian companies and individuals to file international patent applications for the first time. So far, over 900 such international applications have been filed through MyIPO.

In February 2011, further change occurred with a revision of the official fees payable to MyIPO, changes to some of the procedures and timeframes, plus the addition of a formal procedure for expediting examination in certain circumstances such as when infringement is occurring or the invention relates to green technologies. Yet more changes to the Act are also on the horizon.

The growth in the number of patents granted and a greater awareness of the importance of IP in Malaysia have led to an increase in the number of patent-related court cases in recent years. The setting up of IP Courts in Malaysia in 2007, having specialist judges, has unquestionably also been a significant factor. For years, IP litigation was dominated by trademark disputes, but now patent cases are cropping up more often. Although parties will strive to avoid the cost and uncertainty of court action, sometimes it is unavoidable to sort out their respective legal rights. Indeed, the fact that some Malaysian patents have become the subject of litigation just goes to show that the patents are serving their intended function of providing economic benefits to their owners as valuable intangible assets.

Patent litigation has brought challenges for the lawyers representing the parties in dispute, as many IP lawyers were more familiar and comfortable with trademark cases. They have had to learn how to deal with the wide range of technologies covered by patents, as well as various legal issues surrounding patent interpretation, validity and infringement. Due to the technical nature of inventions, it is normal for each party to call one or more expert witnesses. These witnesses may be purely technical experts such as engineers or academicians, or they may be experienced patent agents.

A recent decision from the Kuala Lumpur IP High Court well illustrates the use of such expert witnesses, and some of the issues that arise in assessing the evidence they present to the Court. In *SKB Shutters Manufacturing Sdn Bhd v Seng Kong Shutter Industries Sdn Bhd & Anor* ([2010] MLJU 1263), the plaintiff (SKB) sued the defendant (Seng Kong) for infringement of SKB's patent for a panel that can be interconnected with other panels to form a rolling door curtain of the kind used to cover and protect a shopfront. The defendant did not deny infringement but instead counterclaimed for the patent to be revoked on the ground of lack of novelty and inventive step. Among the witnesses called by the parties were two inventors. The plaintiff relied partly on testimony from the inventor of their patent, whereas Seng Kong called as witness a well-known Malaysian inventor with some patents in his name.

The Judge favoured the testimony of SKB's inventor, who explained the background to the invention and the problems he had had to address. The inventor admitted that some features of the patented invention were known by themselves. SKB's inventor was considered to have the relevant common general knowledge of those in the roller shutter industry. On the other hand, Seng Kong's inventor-witness sought to show that the claimed invention lacked inventive step from a combination of two earlier patent publications. His evidence was less persuasive to the Judge as the combination proposed was found to be born from an imaginative and inventive combination of various elements. The witness had an inventive faculty that cannot be attributed to a notional person skilled in the art. The patent was thus upheld as valid, and as a result the infringement pleading succeeded.

In testing the validity of any patent, the Court has to adopt the mantle of the so-called person skilled in the art. Such a person is knowledgeable in the field of the invention yet lacks any imagination. The prior art must be looked at through the eyes of this skilled person to determine the novelty of the invention and whether the inventive step was an obvious one. As rightly pointed out in the above decision, the skilled person is a legal creation and not a real person. People with extensive knowledge and zero imagination do not exist. Therefore, it is not possible to find a real skilled person and put him in the witness box. This is one of the inherent difficulties of using technical witnesses. Although indispensable for assisting the Court in understanding what was known in the relevant field at the time the invention was made, such a witness's evidence must be examined carefully so as to filter out any possible insight, imagination or lateral thinking that may creep into his statements and opinions.

On the other hand, patent agents are experts in assessing inventive step since it is part of their daily work to assess whether clients have patentable inventions. Although patent agents may not have such complete technical expertise, they can provide the objectivity needed for properly assessing inventive step. So, patent agents will continue to have a valuable role to play as witnesses in the course of patent litigation.

After 25 years, patents have truly come alive in Malaysia. No longer merely prestigious certificates to hang on the wall, patents are now part of the economic currency of the country as we adapt to an age in which knowledge is king. We can expect further developments in the local patent case law in the years to come.

www.henrygoh.com



MyCoID



Identiti Korporat

Perkongsian Pintar Bersama
Pelbagai Agensi Kerajaan

**Rakyat Didahulukan
Pencapaian Diutamakan**

MyCoID adalah nombor syarikat yang dikeluarkan oleh SSM dan digunakan untuk berurusan di semua agensi berkaitan.

Dengan Kerjasama:



Your premier choice, When IP Matters, Matter.

Adastra and the new MyIPO office are in the same building. Our service delivery will be faster and we will be able to serve you even better!

Services:

- **Strong Legal and Technical Expertise**
- **One Stop Center at an Affordable Price**
- **Genuine and Personalized Service**
- **Workable Solution**
- **Reasonable Cost**



Adastra Group of Companies

Unit 28-10-A, Menara UOA Bangsar,
No. 5, Jalan Bangsar Utama 1, 59000 Kuala Lumpur.

Tel: +603-2284 2281 Fax: +603-2284 2287

E-mail: info@adastra.com.my Web: www.adastra.com.my