



EXCO MEETING, CAPE TOWN 13 & 18 APRIL 2015

COUNTRY REPORT	
TITLE: Country report for MALAYSIA	QR CODE
DRAWN UP BY: Benjamin Thompson (President) and Timothy Siaw (Vice President) of FICPI Malaysia	
TABLED TO: FICPI delegates	
PURPOSE: For information and consideration	
SNIPPET: News from and activities of the FICPI national group in Malaysia since the Barcelona ExCo in November 2014.	

SECTION A: ACTIVITIES OF FICPI ASSOCIATION/SECTION

The information supplied in Section A will remain confidential on FICPI's website after the ExCo (will require a password).

SECTION B: CHANGES IN LAW

Information supplied under Sections B and C will be published on FICPI's website after the ExCo and will be available to the public.

B1. LEGISLATION

- Please provide details of any changes to IP legislation (patent, trade mark, design and other) in your country implemented or due to be implemented since you reported last in October 2014.

[There has not been any amendment to the Malaysian IP legislations since October 2014.](#)

B2. MAJOR CASES

- Please provide brief details of any new case law in the field of patents, trademarks, design or other IP of general interest.

(a) Patent

[Seng Kong Shutter Industries Sdn Bhd & Anor v SKB Shutters Manufacturing Sdn Bhd \[2014\] 5 MLJ 98, Court of Appeal of Malaysia](#)

The Court of Appeal overturned the High Court's decision in [SKB Shutters Manufacturing Sdn Bhd v Seng Kong Shutter Industries Sdn Bhd & Anor \[2011\] 2 MLJ 781](#) and clarified the issue of lack of novelty in infringement proceedings.

The High Court held that the Plaintiff's patent (for roller doors) was valid and had not been anticipated by prior art. In arriving at this decision, the High Court compared the prior art with



the patented product instead of the patent's claims. The Court of Appeal, however, found that the features of the prior art were found in the patent claim and, as such, the patent was held to be invalid.

The Court of Appeal further found from the evidence that the concept in the Plaintiff's patent was common general knowledge in the field of mechanical engineering which would be obvious to a normally skilled but unimaginative addressee in the art and, thus, the patent was obvious at the priority date. The appeal was allowed and the judgment of the High Court in respect of patent infringement was set aside.

Winthrop Pharmaceuticals (Malaysia) Sdn Bhd v Astrazeneca UK Limited [2015] 1 LNS 9, High Court of Malaya

The Defendant is the owner of Malaysian Patent No. MY-136382-A ("382 Patent") for an invention concerning the use of rosuvastatin or pharmaceutically acceptable salt thereof in the form of an oral dosage form adapted for oral administration as a single once daily dose comprising 5 to 10 mg for the treatment of patients suffering from hypercholesterolemia. The Plaintiff sought to invalidate the 382 Patent under section 56 of the Patents Act 1983 on the grounds that the 382 Patent lacks novelty, does not contain an inventive step, lacks support in the description, lacks enabling disclosure and does not belong to the Defendant. The Defendant on the other hand contested the Plaintiff's invalidity challenges and counterclaimed that the Plaintiff has infringed the 382 Patent by importing, manufacturing and or selling "Rosuvastatin Winthtop" without their authorization.

The Court had allowed the Plaintiff's invalidity claim against 382 Patent. Consequently, the Defendant's infringement claim against the Plaintiff over its Rosuvastatin Winthrop was dismissed.

In essence, the Court agreed that the Plaintiff's witness PW3 was the person skilled in the art (POSITA) for the relevant field of art taught by the 382 Patent. PW3's views as the POSITA were relied upon substantively by the Court which led to the conclusion that the claims of the 382 Patent did not meet the patentability requirements in that they were not novel and did not possess the requisite inventive step at the relevant priority date. The Court also agreed with the Plaintiff that the addition of the phrase of "single once daily dose" by pages 11A and 11B of the specification has widened the originally filed claims rendering the Defendant's pre-grant amendments having gone beyond the 382's initial disclosure. Consequent thereupon and in relation thereto, the claims of the 382 Patent is not fully supported by the description of the 382 Patent disclosed at the initial application stage. And the description of the 382 Patent does not disclose the invention in a manner which is sufficiently clear and complete for the invention to be evaluated and to be carried out by a POSITA. Further, as the invention of the 382 Patent has been disclosed by the Shionogi document, Ali Raza is thus not the inventor of the invention claimed in the 382 Patent. The Defendant is therefore not entitled to the invention of the 382 Patent.

(b) Trade Marks

Mesuma Sports Sdn Bhd v Majlis Sukan Negara, Malaysia (pendaftar Cap Dagangan, Malaysia, Pihak Berkepentingan) [2014] MJU 1130, Court of Appeal of Malaysia

This is a suit by the National Sports Council against Mesuma Sports Sdn Bhd ("Mesuma") over its use of tiger stripes design/motive on sports jerseys. Amongst the crux of the issue is who,



between the two parties, was the first in time to use the tiger stripes design/motive in a trade mark sense. Both the Court of Appeal and High Court found for the National Sports Council.

In the Court of Appeal, it was held that the Respondent succeeded in the balance of probabilities that the Respondent's mark was used as a trade mark in the course of trade. In terms of passing-off, the Court of Appeal held that the Respondent used its mark with goodwill before the Appellant. The Appellant's mark was thus expunged from the Register of Trade Marks.

Wieland Electric GMBH v Industrial Automation (M) Sdn Bhd & Anor [2014] 10 MLJ 445, High Court of Malaya

The Plaintiff was established since 1910 and has been trading under the name of Wieland since the interception and using the mark "Wieland" with the "W" device since 1997 in most of the countries. The First Defendant is sole distributor as well as manufacturer of Wieland products in Malaysia. The First Defendant registered a similar mark bearing the name of "Wieland" with the "W" device without the consultation and knowledge of the Plaintiff.

The Court held in favour of the Plaintiff. Briefly, the Court's decision is as follows:

- (i) That the Plaintiff had established the first use of the Wieland trade marks in Malaysia prior to the registration date of the subject trade mark. Since the Plaintiff was the rightful proprietor of the subject trade mark at all material times, pursuant to section 25 of the Malaysian Trade Marks Act 1976, only the Plaintiff had the legal right to make the application to the Registrar for the registration of "Wieland" mark.
- (ii) That the First Defendant had obtained the registration of the subject trade mark by fraud and that the registration is in contravention of section 14(1)(a) of the Trade Marks Act 1976 as it is likely to deceive and cause confusion to the public. The subject trade mark is also not distinctive of the goods of the Defendant but in fact is distinctive of the goods of the Plaintiff. As such, the registration is in contravention of sections 10(1)(e) and 10(2A) of the Trade Marks Act 1976.

In light of the above, the subject trade mark was ordered to be expunged from the Register of Trade Marks.

(c) Industrial Designs

Veresdale Ltd v Doerwyn Ltd [2015] 7 MLJ 836, High Court of Malaya

The Plaintiff sought a declaration that each of Industrial Design Registration Nos. MY12-01583-0101, MY12-01584-0101, MY12-01585-0101 and MY12-01586-0101 registered for parts for automobile (hood, front bumper, rear bumper and grill) is not an "industrial design" as defined in section 3(1) of the Industrial Designs Act 1996 and cannot be registered for parts for automobile. The issue before the Court is whether the features of shape and configuration of the automobile parts are capable of registration.

The Court referred to the case of Ford Motor Company Limited and Iveco Fiat Spa's Design Application [1993] RPC 399 where it was held that the "must match" exclusion means that where an article (the door panel) is intended to form an integral part (of the vehicle), the said article (the door panel) is excluded from registration.



It was held that pursuant to the “must match” exclusion, the hood, front bumper, rear bumper and grill are excluded from registration as they are statutorily excluded by section 3(1)(b)(ii) of the Industrial Designs Act 1996. The declaration sought by the Plaintiff was granted.

(d) Copyright

Dura-Mine Sdn Bhd v Elster Metering Ltd & Anor [2015] 1 CLJ 887, Federal Court of Malaysia

This is one of very few copyright cases which have been decided by the Federal Court, the highest court in Malaysia.

The subject matter of the case is in relation to the Respondents’ copyright claims in the industrial drawings of the design of their water meters and compliance with the statutory requirements of proving copyright ownership in section 42 of the Malaysian Copyright Act 1987, in particular original industrial drawings which have undergone some revisions over the years.

The Federal Court upheld the decisions of the High Court and Court of Appeal and dismissed the appeal. The Federal Court examined the scope and application of section 42 of the Copyright Act and held that the person claiming to be the owner of the copyright must state that he is the owner of the copyright and that the copy of the work annexed to the affidavit or Statutory Declaration is a true copy of the work in which copyright subsists. An affidavit or Statutory Declaration that does not comply with the requirements as provided in section 42 will not be admissible as *prima facie* evidence.

The Federal Court further held that section 42 is not the sole mean to prove copyright ownership but should also include oral evidence to augment, correct and or even supplant a defective affidavit or Statutory Declaration.

Vision Cast Sdn Bhd & Anor v Dynacast (Melaka) Sdn Bhd & Ors [2015] 1 MLJ 424, Court of Appeal of Malaysia

The Court of Appeal overturned the High Court decision and dismissed the Respondents’ claims that there were alleged breaches of confidentiality and fiduciary duties by the Second Appellant who used information obtained during his previous employment with the respondents to ‘poach’ customers of the Respondents after termination of his employment.

Further, the Court of Appeal dismissed the Respondents’ cross-appeal alleging that the Appellants had infringed their copyright in images or photographs of products found within the Respondents’ promotional material when the Appellants ‘uplifted’ and used the images or photographs on the front cover of the Appellants’ brochure. The Court was of the view that there was no similarity between the layout, title or content of the Respondents’ and Appellants’ promotional materials and, further, because the disputed images or photographs were found on various pages of the Respondents’ promotional material whereas some similar representations were found only on the cover page of the Appellants’ brochure. The mere calling of a witness from the agency that compiled the Respondents’ promotional material was not sufficient to prove the Respondents’ claim of ownership of the copyright to the images or photographs.

It was held that the ownership of the copyright of the disputed images or photographs belonged to the respective photographers or with the other entities which had been attributed to in the Respondents’ promotional material.



Microsoft Corporation v Conquest Computer Centre Sdn Bhd [2014] 6 CLJ 876, High Court of Malaya

This case concerned alleged infringement of the Plaintiff's Microsoft Windows 7 Home Premium operating system software (the work) by the Defendant when it sold a computer hard disc-loaded with the work. The High Court dismissed the Defendant's contention that the work installed into the computer was a trial version which it was entitled to use for free. The Court held, *inter alia*, that the defendant had infringed and would continue to infringe the copyright in the work and further works belonging to the Plaintiff by selling computers pre-installed with the Plaintiff's software, thus re-producing and marketing pirated copies of the Plaintiff's computer software, without the Plaintiff's licence or consent and without providing the paraphernalia that must be given to purchasers of computers pre-installed with the Plaintiff's software in the hard discs.

Sherinna Nur Elena bt Abdullah v Kent Well Edar Sdn Bhd [2014] 7 MLJ 298, High Court of Malaya

In this case, the High Court ruled that the plaintiff did not have *locus standi* to bring and maintain an action against the Defendant as the Plaintiff did not own the copyright of a photograph or image of her and two other women taken during beauty pageants published in a book by the Sabah Tourism Board which subsequently appeared on the packaging of the defendant's products and an advertisement billboard in Kota Kinabalu. The Court held, *inter alia*, that:-

- (i) the Plaintiff was not the photographer or author of the photograph or image used by the Defendant on its products nor did she claim that she arranged or took or produced the photograph or image;
- (ii) the Sabah Tourism Board was the owner of the copyright or had the permission from the author or owner to publish the photograph or image in the book; and
- (iii) neither the Plaintiff nor the Defendant had identified the photographer or author of the photograph or image, or exhibited any agreement or affidavit or declaration showing that she had been assigned or licensed and was the owner of the copyright in the photograph or image.

Although the Plaintiff was at liberty to sue the Defendant for invasion of privacy, the Court found that the Defendant did not intrude onto private property to take photographs of the Plaintiff without her consent. The Plaintiff did not complain that she had been humiliated or ridiculed or was scandalised by the inoffensive photographs which were taken many years ago by someone else at beauty pageants where she participated willingly as a contestant and in public.

B3. OFFICIAL PRACTICE

3. Please provide details of any changes in official patent and trade mark office practice which would be of general interest to other members.

(a) Patent Prosecution Highway (PPH)

With effective from 1 October 2014, the Intellectual Property Corporation of Malaysia (MyIPO) and the Japanese Patent Office (JPO) have commenced the Patent Prosecution Highway (PPH)



pilot program for a period of three years. This program is an initiative for providing accelerated examination procedures by sharing information between both patent offices.

Via the PPH/PCT-PPH program, patent applicants may request for accelerated examination of an application in a Patent Office by submitting the search reports or certificates of grant of the corresponding patent applications filed in the other Patent Office. By doing so, the other Patent Office may allow the corresponding patent applications to proceed to allowance as the first Patent Office has considered the patentability of the claims.

(b) IPR Marketplace Portal

MyIPO has officially launched its IPR Marketplace Portal. This IPR Marketplace or IPR Market enables proprietors of intellectual property rights to put their patents, industrial design, copyright and trademarks up for sale or out-licensing. They can also use the IPR Market to search for IP rights to buy or in-license, or to look for partners for innovation projects.

(c) IP Agents Good Conduct Guidelines

IP Agents Good Conduct Guidelines intends to serve as general guidelines to all trade marks, patents, industrial designs and geographical indications agents practicing in Malaysia on matters stated herein. The Guidelines contains specific instances about some conducts by way of illustration and shall not be deemed exhaustive, and does not diminish an IP Agent's responsibility to act according to law.

B4. PROPOSALS FOR CHANGES

4. Please provide details of any proposed changes in IP laws or practice and indicate if your National Association/Section is involved in providing comments to such changes. Would it be of assistance to have input from the CET on any proposed changes?

Please see attached proposed amendments to the respective Intellectual Property legislations in Malaysia:

- (i) Consultation Paper July 2012 Bil: 1/2012/PC/TM
 - Proposed amendments to the Trade Marks Act 1976
- (ii) Consultation Paper June 2012 Bil: 1/2012/PT/PC/
 - Proposed amendments to the Patents Act 1983
- (iii) Consultation Paper February 2013 Bil: 1/2013/ID/PC
 - Proposed amendments to the Industrial Designs Regulations 1999



SECTION C: OTHER INFORMATION

Please provide details of any other information pertaining to your country or region that would be of general interest to FICPI members and other IP practitioners browsing FICPI's website.

C1. QUALIFICATION AND THE RIGHT TO REPRESENT CLIENTS BEFORE A COURT

1.1 Please describe the qualification process for becoming a patent attorney in your country/region.

Registration as a Patent Agent

In order to be registered in the Register of Patents Agents, the applicant shall satisfy the Registrar the following requirements as provided in section 45C of the Patent Regulations 1986:

- (a) That he is domiciled in or is a permanent resident of Malaysia;
- (b) That he is an advocate and solicitor of the High Court in Malaya or an advocate of the High Court in Sabah and Sarawak, or has a relevant degree or its equivalent in an appropriate branch or engineering or science from an institution of higher learning approved by the Board of Examiners, or has qualifications entitling him to graduate membership of a professional engineering or scientific institution or the like recognized by the Board of Examiners; and
- (c) That he has passed the Patent Agent Examination.

An application to be registered as a patent agent in the Register of Patents Agents shall be made to the Registrar on Form 18 together with the payment of the prescribed fee.

Patent Agent Examination

The Board of Examiners shall conduct an examination which shall consist of the following subjects:

- (a) technology;
- (b) Malaysian patent law and practice;
- (c) Malaysian trade mark and designs law and practice; and
- (d) foreign industrial property law and practice.

An application for registration as a candidate for the examination shall be made to the Board of Examiners of Form 18A together with the payment of the prescribed fee.

1.2 Has the patent attorney qualification process changed in any way in the past 5 years?

No there has not been any changes in the qualification requirements in the past 5 years.

1.3 Does qualification as a patent attorney permit you any right of representation before any Court in your country?

No. Only an advocate and solicitor of the High Court in Malaya or an advocate of the High Court in Sabah and Sarawak have the exclusive right to appear and plead in all the Courts according to the laws in force in those Courts pursuant to the Malaysian Legal Profession Act 1976. A patent agent can only represent a person in proceedings before the Patent Registration Office.



1.4 If so are there any special requirements or restrictions?

Not applicable.

1.5 Are qualified lawyers in your country permitted to work in the patent field without any further qualification?

Yes.

If so are there any restrictions on what they may do?
If so, please describe those restrictions.

Qualified lawyers who work in the patent field may be required to advise on the following:

- (a) Patent registration and filing;
- (b) Patent renewal;
- (c) Recordal of assignment in the Registry of Patent;
- (d) Patent litigation;
- (e) Patent consultancy including technology transfer, franchising etc.;
- (f) Drafting patent claims and specification and patent amendment; or
- (g) Any other works incidental to any of the above.

Where substantive technical input are required, for instance in drafting patent claims and specification, qualified lawyers may not be as well versed as patent agents or lawyers who have scientific background in the relevant fields of technology.

1.6 Please describe what privilege attaches to patent attorney client communications including any restrictions.

It is provided in the Malaysian Evidence Act 1950 that communications between solicitors and their clients are privileged. However, such solicitor-client privilege does not extend to the communications between patent agents and their clients.

Solicitor-client privilege applies to patent agents who are also solicitors.

1.7 Please describe the qualification process for becoming a trade mark attorney in your country/region.

In order to be registered in the Register of Trade Marks Agents, the applicant shall satisfy the Registrar the requirements as provided in regulation 12 of the Trade Marks Regulations 1997 that he is either domiciled or resident in Malaysia or has a principal place of business in Malaysia; and

- (a) is on the Register of Patents Agents maintained in pursuance of regulations made under the Patents Act 1983; or
- (b) is an advocate and solicitor practicing solely in Malaysia; or
- (c) holds a recognized degree in any field of studies and has had at least three years of experience in the field of industrial property; or
- (d) has had at least seven years of experience in the field of industrial property by virtue of he



being an ex-officer of the Office; or
(e) has acted as a trade mark agent to the satisfaction of the Registrar before the Trade Marks Regulations 1997 came into force.

1.8 Has the trade mark attorney qualification process changed in any way in the past 5 years?

No there has not been any changes in the qualification requirements in the past 5 years.

1.9 Does qualification as a trade mark attorney permit you any right of representation before any Court in your country?

No. Only an advocate and solicitor of the High Court in Malaya or an advocate of the High Court in Sabah and Sarawak have the exclusive right to appear and plead in all the Courts according to the laws in force in those Courts pursuant to the Malaysian Legal Profession Act 1976.

If so are there any special requirements or restrictions?

Not applicable.

1.10 Are qualified lawyers in your country permitted to work in the trade mark field without any further qualification?

Yes.

If so are there any restrictions on what they may do?

No.

If so, please describe those restrictions.

Not applicable.

1.11 Please describe what privilege attaches to trade mark attorney client communications including any restrictions.

It is provided in the Malaysian Evidence Act 1950 that communications between solicitors and their clients are privileged. However, such solicitor-client privilege does not extend to the communications between trade mark agents and their clients.

Solicitor-client privilege applies to trade mark agents who are also practicing lawyers.

C.2 CET AND PEC SPEAKERS

2.1 Would your National Section/Association be interested in obtaining assistance from FICPI, through either the CET Work and Study Group or the Professional Excellence Commission (PEC), in providing speakers for seminars organized by your national group in your county?

Yes.



- 2.2 If your group does, or in the future might, require such assistance, please identify topics that might be of interest to your members, with a view to raising FICPI's profile and providing added value from membership of FICPI in your country.

Any IP related topics.

C.3 TOPICS OF INTEREST

- 3.1 Please list three IP topics that are of particular interest to you and/or your national section members.

- (a) Collateralisation of intellectual property rights
- (b) Expedited examination under the Patent Prosecution Highway (PPH)
- (c) Anti-counterfeiting

[End of document]