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Newsletter - March 2014

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## ASEAN FOCUS : LATEST IP DEVELOPMENTS



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# STRIKING A BALANCE: PUBLIC HEALTH VS IP RIGHTS IN THAILAND'S CIGARETTE PACKAGE

*By Prathana Rebecca Knapp and Nutthakarn Phongphunpanya, Ananda Intellectual Property*

When faced with conflicting interests regarding consumer products, governments often act through their regulatory bodies to resolve the conflict – either by aligning with one side or by brokering a compromise. For the matter of cigarette packaging and public health, Thailand chose to update its rules to what amounts to, in light of two extreme positions, a compromise between the public health interest and tobacco companies' intellectual property (IP) rights.

Stricter regulation of tobacco products began after it became widely accepted that tobacco consumption was harmful to human health. Efforts to reduce smoking and smoking-related illnesses led to mandatory warnings on cigarette packages.

In 2001, Canada was the first country to require picture warnings on cigarette packages. By 2003, the World Health Organization (WHO) had drafted its Framework Convention on Tobacco Control (FCTC); the FCTC went into force on 27 February 2005. The FCTC included provisions for the packaging and labeling of tobacco products in Article 11, which required that the outside packaging of tobacco products include «health warnings describing the harmful effects of tobacco use», which «may be in the form of or include pictures», that must be at least 30% (but ideally 50% or more) of the «principal display area».

In Thailand, warnings on cigarette packages include text printed on the sides of the packages and photos printed on the front and back. Thailand ratified the FCTC on 08 November 2004 and put it into force on 27 February 2005. Pursuant to Article 11 of the FCTC, cigarette packages in Thailand included graphic warnings that are approximately 55% of the front and back of packages. In March 2013 the

Ministry of Health issued new rules to increase the size of the warning pictures to 85% (5.50 X 7.39 cm.) of the front and back of cigarette packages. The change was to become effective in October 2013, but has been delayed due to litigation initiated by tobacco companies. If the graphic warning on cigarette packages is increased to 85%, the Thai graphic warning would be the largest, as a percentage of the package, in the world.



**Picture Warnings on Cigarette Packages**

<sup>1</sup> Framework Convention on Tobacco Control (FCTC), Article 11, paragraph 1(b). Available at: [http://www.who.int/fctc/text\\_download/en/index.html](http://www.who.int/fctc/text_download/en/index.html)

<sup>2</sup> The list of the countries that are parties to the FCTC is available at: [http://www.who.int/fctc/signatories\\_parties/en/index.html](http://www.who.int/fctc/signatories_parties/en/index.html)

<sup>3</sup> Ministry of Health issued the Notice of Rules, Procedures, and Conditions for the Display of Images, Warning Statements, and Contact Channels for Smoking Cessation on Cigarette Labels, 2013.

<sup>4</sup> John Kell, «Philip Morris Sues Thai Government Over Cigarette Packaging», *The Wall Street Journal*, 26 June 2013. Available at: <http://online.wsj.com/article/BT-CO-20130626-709598.html>

### **The Extremes: the US and Australia**

Government attempts to include graphic warnings on cigarette packages have succeeded to varying degrees. Two extreme cases, on different ends of the spectrum, are that of the United States and Australia.

In the US, the government's attempt to put graphic warnings on the top half of cigarette packages was ruled as violating that country's First Amendment right to freedom of speech. The US Food and Drug Administration (FDA) declined to appeal the decision against it to the US Supreme Court. In the US, cigarette packages continue to display the same small boxed warnings that first appeared in the 1980s.

In contrast, Australia's Tobacco Plain Packaging Act 2011 required that cigarettes be in "plain packaging" since December 2012. The tobacco companies' challenge to the Plain Packaging Act – which requires prominently featured picture warnings and does not allow the use of brands, logos, and trademarks on cigarette packages – was struck down by Australia's High Court. The High Court rejected the tobacco companies' argument that the Act's prohibition of brands, logos, and trademarks on cigarette packages amounted to acquisition of property. The court rejected tobacco companies' argument that the Act's requirement that brands be listed on cigarette packages in a generic, homogenous font amounted to the acquisition of IP. In its reasoning, the court stated that the purpose of IP laws is to serve public policy objectives (such as providing an incentive for innovation), and not merely protect private interests.

The US and Australian courts reached different decisions about cigarette package regulations due to differences in legal traditions and the way each case was framed. In the US, where there is a strong tradition of the First Amendment right to freedom of speech, the picture warning requirement was framed as a type of government-mandated speech – something the government is not permitted to do. In Australia, the tobacco companies framed the issue of plain packaging as the taking of its intellectual property via the prohibition against the use of IP devices on its products.

### **Public Health vs Intellectual Property Rights**

In Thailand, the challenge to the Ministry of Public Health's rule to increase the size of picture warnings on cigarette packages has been framed as an erosion of intellectual property rights. As part of their challenge to the Ministry of Health's rule to increase the space taken by graphic warnings on cigarette packages from 55% to 85%, tobacco companies have claimed that such an increase infringes upon the use of their trademark and IP rights. The argument is that tobacco companies' brands would be damaged, if cigarette package warnings were increased to 85%, because the reduced space (to 15% of the front and back of packages) for trademarks, brands, and logos would make it almost impossible to see such symbols.

<sup>5</sup>RJ Reynolds Tobacco Company, et al. v. Food & Drug Administration, et al., United States Court of Appeals for the District of Columbia, No. 11-5332, 24 August 2012. Available at: [http://www.cadc.uscourts.gov/internet/opinions.nsf/4C0311C78EB11C5785257A64004EBFB5/\\$file/11-5332-1391191.pdf](http://www.cadc.uscourts.gov/internet/opinions.nsf/4C0311C78EB11C5785257A64004EBFB5/$file/11-5332-1391191.pdf)

<sup>6</sup>«Appeals court upholds block on graphic cigarette warnings», AP, 24 August 2012. Available at: <http://www.firstamendmentcenter.org/appeals-court-upholds-block-on-graphic-cigarette-warnings>

<sup>7</sup>The Tobacco Plain Packaging Act 2011. Available at <http://www.comlaw.gov.au/Details/C2011A00148>

<sup>8</sup>JT International SA v. Commonwealth of Australia; British American Tobacco Australasia Limited & Ors v. Commonwealth of Australia, the High Court of Australia, Sydney No S409 of 2011, 17 April 2012. Available at <http://www.austlii.edu.au/au/other/HCATrans/2012/91.html>

<sup>9</sup>Matthew Rimmer, «The High Court and the Marlboro Man: the plain packaging decision», The Conversation, 18 October 2012. Available at <http://theconversation.com/the-high-court-and-the-marlboro-man-the-plain-packaging-decision-10014>

### Constitutional Provisions and Basic Property Rights

Section 41 of the Constitution of Thailand B.E. 2550 (2007) grants basic property rights. It states “The property right of a person is protected. The extent and the restriction of such right shall be in accordance with the provisions of the law” (emphasis added).

If the court finds that the rule is, indeed, a restriction pursuant to Section 41, the government would then have two bases to argue that the restriction is one that is nonetheless valid because it is «in accordance with other laws». The two bases the government could base its argument on are Section 80 of the Constitution and the FCTC.

Section 80 of the Constitution charges the State with the pursuit of policies in relation to public health. Specifically, paragraph (2) of Section 80 states that the State shall «promote, support and develop the health system(.)» Read in a manner supportive of the government’s position, Section 80 of the Constitution grants the state the power to pursue public health policies and Section 41 allows actions taken pursuant to Section 80. The government could argue that the rule to enlarge picture warnings serves Section 80’s provision of pursuing health policy, thereby qualifying as a valid restriction on property rights provided by Section 41.

The rule issued by Ministry of Public Health is also in accordance with the FCTC, a convention to which Thailand is a party. By virtue of having signed and ratified the FCTC, Thailand has adopted the convention as part of the country’s law. Compliance with a ratified international treaty would arguably be a sufficient reason to «restrict» the property rights protected under Section 41 of the Constitution.

### TRIPS and Intellectual Property Rights

Trademarks and other IP receive legal protection as property because of their potential commercial and economic value. IP laws protect the creation and investments made by intellectual property owners by restricting the use of copyrights, trademarks, and patents to the rightful owners. In the case of trademarks, infringement usually means the logo or brand of a product is used by unauthorized

parties for commercial purposes or other financial gain. In addition to infringing on commercial and economic rights, use by unauthorized parties could also confuse the public about the product’s provenance and, as such, harm the rightful IP owner’s financial interests.

Tobacco companies also these same arguments against Australia’s «plain packaging» requirement – that omitting the brand’s logo could confuse consumers or make it easier for cigarettes to be counterfeited. The arguments of «public confusion» and «ease of counterfeit» cannot be made by the tobacco companies in Thailand because the Ministry of Health’s regulation aims to increase the size of the warning label, not omit brands, logos, or trademarks by compelling the use of «plain packaging» as was done in Australia.

Nonetheless, tobacco companies may still argue that restrictions on the use of their IP violates the World Trade Organization’s (WTO) Trade Related Aspects on Intellectual Property Rights (TRIPS) agreement to which Thailand is a party. The TRIPS provides the minimum protection for intellectual property that member countries must provide. However, the TRIPS agreement also provides, in Article 8, public health as an exception to IP protections it requires from member states. Specifically, paragraph 1 of Article 8 states «Members may, in formulating or amending their laws and regulations, adopt measures necessary to protect public health and nutrition(.)» (Emphasis added)

<sup>10</sup> Section 41 of the Constitution of the Kingdom of Thailand BE 2550 (2007). Available at [http://www.senate.go.th/th\\_senate/English/constitution2007.pdf](http://www.senate.go.th/th_senate/English/constitution2007.pdf)

<sup>11</sup> Section 80 of the Constitution of the Kingdom of Thailand BE 2550 (2007).

<sup>12</sup> Article 8 of the TRIPS agreement states:

1. Members may, in formulating or amending their laws and regulations, adopt measures necessary to protect public health and nutrition, and to promote the public interest in sectors of vital importance to their socio-economic and technological development, provided that such measures are consistent with the provisions of this Agreement.»
2. Appropriate measures, provided that they are consistent with the provisions of this Agreement, may be needed to prevent the abuse of intellectual property rights by right holders or the resort to practices which unreasonably restrain trade or adversely affect the international transfer of technology.”

Although the tobacco companies may argue that forcing trademarks, brands, and logos to occupy no more than 15% of the cigarette packages spatially limits the use of IP, it cannot be claimed that such spatial limits cancels IP rights granted by Thai law or the TRIPs. Furthermore, the regulation of trademark rights made in the public interest (in this case public health) cannot be said to deprive the trademark owner of their rights, as the rights are merely being regulated and are not being transferred or used for any other entity's benefit.

### **Looking Forward: Possibility of a Compromise**

The Thai Ministry of Public Health's rule that picture warnings be increased to 85% has not yet been put into effect. The tobacco company Philip Morris sued the Ministry of Public Health and successfully obtained a temporary injunction against the rule's implementation. It is possible that the Ministry of Health and the tobacco companies will come to a compromise and agree that the graphic warning take up less than 85% of cigarette packages. It is also possible that the court is waiting to use the outcome of the WTO complaints – which were filed by Ukraine, Honduras, Indonesia, Dominican Republic, and Cuba – against Australia's «Plain Packaging Act» as guidance in its decision making. Whatever the outcome of the WTO complaints against the Australian tobacco plain packaging law may be, it is extremely unlikely that the status quo of 55% coverage area for cigarette packages in Thailand will be reduced.

<sup>13</sup> Philip Morris (Thailand) Limited et al. v. Ministry of Public Health, Central Administrative Court, Black Case No. 1324/2556, Aug. 23, 2013. The plaintiffs argue that the picture warning rule was not procedurally sound because it did not meet the standards for administrative laws. Unofficial English translation available at: <http://www.tobaccocontrolaws.org/litigation/decisions/th-20130823-philip-morris-thailand-limit-1>

<sup>14</sup> Jonathan Liberman, «Waiting out the legal challenges to plain packaging – playing into the tobacco industry's hands?», Mc Cabe Center, 4 October 2013. Available at: <http://www.mccabecentre.org/blog-main-page/waiting-out-the-legal-challenges>

# INFRINGEMENT OF INTELLECTUAL PROPERTY RIGHTS IN VIETNAM

*By Do Thi My Lien, Havip*



## Actual Situation

In recent years, though there has promulgated regulations, sanctions, procedures for dealing (including administration, civil, criminal, border control) for infringements of Intellectual Property Rights (IPRs), the infringement of IPRs in Vietnam is constantly increasing and increasingly complicated.

According to market management Agency, the infringement state of IPRs is increasing, but the number of IPRs owners propose to handling infringement is so low: only about 40-50 applications for handling infringements every year. Even large businesses who own the famous trademark did not propose to handle infringements.

## Causes

Many businesses that neglect to coordinate with authorities handling the infringements of IPRs and remaining gaps in the regulation and management are main causes for instantly increase of IPRs infringements. Though many goods bearing infringing elements are imported, the Custom Offices are not allowed to proactively stop customs clearance if the right holders do not propose to do. Regarding consumers, there are many limitations in the perception of counterfeits as well as the knowledge of recognizing and distinguishing genuine goods from counterfeits.

In addition, regulations for handling infringement still remain disadvantages, such as in the process of valuating infringement products for prosecution, counterfeiting producers subject to lighter sanction than the traders (meanwhile infringement level and action nature of the producers are higher than the traders).

## Statistics Of IPRs Infringement Handling In 2012

Here are the states (incomplete) on results of handling IPRs infringements of the competent Agencies in 2012:

### 1. Inspectorate specializing in Science and Technology

In 2012, Inspectorate of Science and Technology has inspected 69 enterprises, then detected and sanctioned 36 cases of infringement of IPRs in the amount of 859 million VND. Inspectorate of Science and Technology has forced to remove infringing elements from 25,703 products, destruct and confiscate for destroy 7,462 products contained infringing signs.

Particularly, Inspectorate of Ministry of Science and Technology conducted 38 inspections, discovered and handled 20 cases of infringements with the total fines amount of 831 million VND for budget revenues. Inspectorate of Ministry collaborated with the Market Management Office to handle 01 case; and with the police Office to handle 36 cases.

### 2. Market Management Offices

In 2012, Market Management Offices in local and central handled 9,556 cases of IPRs infringements, specifically 61 infringement cases of copyright related rights, 8,999 cases of trademark counterfeiting, 67 cases of trademark, geographical indication, trade names and industrial design infringements, 422 cases using tags, labels and packages for counterfeit goods. The total fines amount of 3.8 billion VND.

### 3. Custom Offices

In 2012, Custom Offices received and handled about 100 requests of IPRs owners for checking, monitoring goods related their IPRs on the border. Up to 2012, the Custom Offices have 106 applications in total for protection of IPRs related to nearly 300 trademarks on the border. The Custom Offices have handled 101 cases, sanctioned amounts of approximately 300 million VND, and confiscated tens of thousands of infringing products (such as alcohol, tobacco, cosmetics, clothing, mobile ... infringe trademarks protected in Vietnam).

### 4. Police Offices

The Police Offices investigated, detected and arrested 156 cases. In addition, the Police Offices prosecuted many counterfeiters who produced and traded counterfeits such as food, clothes, cosmetics, drugs, wine and accessories. Especially, the Police Office eradicated drug counterfeits bearing trademark Viagra and Cialis which produced in China and imported to Vietnam, 13,600 pills were seized in this case.

According to the report of Economic Police Bureaus, in 2012 Economic Police Forces of 44 cities/provinces detected 276 IPRs infringement cases, in which 66 cases and 74 defendants were prosecuted with fines of over 2.4 billion VND.

### Resolution

Through the above figures, we can see that the administrative measures are used most popularly in comparison with the four measures for enforcing IPRs in Vietnam (civil remedies, administrative measures, criminal measures and control measures on the border). The reason that this measure has many advantages including being simple procedures, fast handling, timely satisfaction of request of right holders and ensuring that it is not only effective in preventing but also caution and deterrence.

To improve the efficiency of enforcement of IPRs by administrative measures, the Government issued Decree No. 99/2013/ND-CP (with effected from October 15, 2013) in order to strengthen of the effective implementation system of IPRs.

This Decree provides regulations on the infringements, sanctions, penalties, remedial measures; filing procedures for handling infringements; jurisdiction, settlement procedures for infringement requests; competent to sanction and enforcement of decisions on sanctioning of administrative violations in the field of Intellectual Property.

According to this Decree, fines for infringement will be adjusted as follows:

The maximum fine for individuals who infringe IPRs is 250 million VND. For a similar violation, the fine for organizations is double that imposed on individuals, the maximum fine is 500 million VND.

This new Decree also stated administration sanction jurisdiction of the Inspectorate of Science and Technology; Inspector of Information and Communications, Market Management Office, Custom Office, Police Office and People's Committees of provinces and districts.

# PATENT PROSECUTION HIGHWAY (PPH) JAPAN - INDONESIA: IS IT A REAL PATENT GRANTING ACCELERATOR?

By Rohaldy Muluk, ChapterOne-IP



## Introduction

A pilot programme of a Patent Prosecution Highway (PPH) between the Japan Patent Office (JPO) and the Indonesian Patent Office (IPO) has started from the 1st of June 2013. The main objective of a PPH programme is to accelerate a patent application to be granted in one country of the parties while reducing other efforts relating to patent substantive examination processes such as office actions.

A PPH is not an agreement concerning the substantive examination, but the examination order only. In a case of a PPH for a patent application firstly filed in Japan and later on will be filed in Indonesia, some requirements have to be met. One of the requirements is that a PPH has to be requested before a substantive examination of the related application has started at Indonesian side. A PPH could be implemented as well to a Paris Convention application as to a PCT application. The application at IPO should have a particular relationship to the application at JPO. For example, an IPO application has priority claims under Paris Convention at the JPO application. A uniqueness of a PPH is that a patent application must have at least one patentable claim determined by JPO that has a correspondence to the claims applied at IPO.

The question is, is the PPH a real accelerator of a substantive

examination phase, or a real patent granting accelerator in Indonesia in compare to the existing examination practice?

## Comparison

Let us compare the practice of PPH and the existing substantive examination in Indonesia. On both facilities, the examination starts after filing a patent application (Paris route or PCT route) and after a publication period.

1. PPH practice For a Paris Convention-PPH patent application, the following documents are required as attachments to a PPH request:

- Copy of all claims determined to be allowable by JPO (possibly available online; the claim(s) is(are) to be in English and should be translated into Indonesian language),
- Copy of all office actions regarding patentability examination issued by JPO (possibly available online; the office action(s) is(are) to be in English and should be translated into Indonesian language),
- Copy of cited documents used by examiners of JPO in English (possibly available online, otherwise the applicant has to submit it, especially for non-patent literatures),
- A claim correspondence table.

For a PCT-PPH patent application, no. 3 and 4 above are the same, additionally, to 1. Copy of claims of the corresponding PCT application which are indicated patentable (in English and in Indonesian language), to 2. Written Opinion of the International Searching Authority (WO/ISA), Written Opinion of The International Preliminary Examining Authority (WO/IPEA) or International Preliminary Examination Report (IPER). However, we assume that after fulfilling the above-mentioned documents, a patent application will be directly granted.

2. Existing IPO substantive examination practice after filing a patent application in Indonesia (Paris route or PCT route) that has a particular relationship with the JPO application, through a publication period, and after requesting a substantive examination, we will come to the same starting point as that of the PPH. However, the existing Indonesian substantive examination practice is:

According to Art. 28 (2) of Indonesian Patent Law, for application with claiming priority, an applicant has to submit to IPO:

- Copy of office actions from the patent office where the application has firstly filed,
- Copy of grant, refusal withdrawal from the patent office of the first filing
- Other documents relating to examining the patentability

IPO examiners are normally recognized the substantive examination results from big

**Patent Offices such as JPO, EPO, USPTO as well as WIPO.**

In regards to point 1. of existing substantive examination practice, it is an obligation for an applicant to submit those documents for applications claiming priority. The required documents are the same to those of PPH.

In regards to point 2. of existing substantive examination practice, an examiner, in his/her office actions, normally suggests the applicant to amend, or the applicant his/herself voluntarily initiated to amend claims and/or a patent specification with the corresponding one of its patent family that has been granted by those big patent offices as long as the scope of the initial invention has not been exceeded, and not infringed the Indonesian Patent Law. What an applicant has to do following this practice is to submit to the IPO the original specification in English (or translated into English if the specification is initially not in English) and an Indonesian version of the specification. That's it!

**Conclusion**

According to the PPH agreement, it is obligatory for the IPO to accept the substantive examination results of the JPO. On the other side, officially, it is not obligatory for the IPO examiners to accept the substantive examination results from other Patent Offices. However, IPO has a long time practice for this kind of "modified substantive examination". In compare to PPH, that has to be initiated earlier before the substantive examination has begun, in the existing substantive examination practice the amendment of claims and/or a patent specification by its granted corresponding patent can be submitted at any time, for example, as a voluntary amendment, before an office action has been issued by IPO, or as a response to an office action, after an office action has been issued by IPO.

Using PPH facility, actually, there are still communications between the applicant and the IPO needed if the required documents are not sufficient or if all claims of the IPO application does not sufficiently correspond to the allowable claims at the JPO. On the other side, communication at the existing substantive examination practice is in form of a voluntary amendment or a response to an office action.

Since all PPH documents needed should be in English and its Indonesian translation, it seems that a PPH application has more documents to be submitted and to be translated into Indonesian language in compare to the existing substantive examination practice where if a correspondent patent application has been granted in those Patent Offices, then only the original granted English specification and its Indonesian language version have to be submitted.

# SINGAPORE PATENTS ACT AMENDMENTS OF FEBRUARY 2014

*By Pintas, Singapore*



The Patents (Amendments) Act 2012 came into force on 14th February 2014, bringing with it some fundamental changes to the Singapore patent practice. It aims to solidify Singapore's intellectual property (IP) system while expanding it to enhance Singapore's reputation as a leading IP hub in the Asian region. It also aligns Singapore's patent prosecution processes with those of other established intellectual property administrations like the European Patent Office as well as those of the US, UK and Japan offices. These changes are expected to improve the quality of Singapore granted patents and strengthen business and investor confidence in the Singapore IP administration. Passed by Parliament on 10th July 2012, the Act amends Singapore's Patent Act (Chapter 221) and bring with it the following key changes.

The most significant amendment is the change from a "self-assessment" patent system to a new "positive grant" patent system. Under the "self-assessment" system, a patent applicant is under no obligation to amend the application in any stage, even in the case of an adverse examination and/or report. Once the formal requirements are met and upon completion of the search and examination procedures chosen for the application, a Singapore patent will be issued, as such the establishment of an adverse examination report with objections to novelty or inventive step, will not prevent an application of proceeding to grant.

The new "positive grant" system requires all patent applications

to have fully positive results before it can proceed to grant. This means the application must fully satisfy Section 13 of the Patents Act where the substantive patentability criteria of novelty, inventive step and industrial application in order to grant.

Under the Amended Patents Act, Singapore's dual-track system of the default "fast-track" and optional "slow-track" has been replaced with a single prosecution track with no provision for block extension of time. A request for examination deadline is fixed to a single deadline for requesting local examination of 36 months from the earliest priority date.

The deadline for submitting prescribed information on a foreign corresponding application is 54 months from the priority date. The "prescribed information" comprises a certificate of grant and a certified copy of the patent specification setting out the final results of search and examination and a copy of the claims allowed, together with verified English translations if required.

It also introduces a new supplementary examination process to ensure compliance with the new positive grant requirements. This applies to where modified examinations are used and not to local examinations. The introduction of Supplementary Examination will increase the cost, the complexity and time needed to obtain a patent in Singapore under the current examination but also increases the quality threshold of being granted a Singapore patent. The new patent application procedures are summarized in the tables annexed hereto as Appendix A and B respectively. Post-grant search and examination is not available under the new Amendments Act.

The Amendments Act will apply to all patent applications filed from 14th February 2014 as well as national phase applications that commence from that date. Existing patent applications filed on or before 13th February 2014 will be treated under the Singapore Patents Act in the form it existed before amendment. PCT applications which entered the Singapore national phase by 13th February 2014 date will be treated the same.

# UNIVERSAL NOVELTY IS NOW APPLICABLE TO INDUSTRIAL DESIGN IN MALAYSIA

*By Pintas, Malaysia*

The Malaysian Industrial Designs (Amendment) Act 2013 was published in the Gazette on 22nd January 2013 and came into force on 1st July 2013. The changes involved now bring Malaysian law closer into line with international jurisdictions like those of the United States and EU administration.

The old law, the Malaysian Designs Act 1996 will still govern any pending design applications but the new Industrial Designs (Amendment) Act 2013 will apply to all designs filed from July 2013.

The new law bring with it the following changes. The previous standard of only having local novelty satisfied for design registration has been broadened to worldwide novelty. This has thus made the issuance of a registration more stringent with international standards. As such a design shall not be considered as "new" if it has been disclosed anywhere else in the world before the priority or application date.

Note however that an industrial design is not considered "disclosed to public" if within 6 months preceding the filing date of application, the design appears in an official or officially recognized exhibition where the design was disclosed by a person other than the applicant as the result of an unlawful act committed by said third party.

With the new amendment, payment of fees for renewal to extend the term of protection of a design can now be made at any time prior to expiry rather than the previous, 6 months before the 5 year expiry limit.

In addition, any industrial design registered before 1st July 2013 can now be extended to 25 years instead of the previous 15 years. The terms of registration for all registrations after 1st of July 2013 is now set at a 5 year initial protection period that is extendable for another further 4 consecutive terms of 5 years each, upon payment of renewal fees.

An additional feature the amendment brings is that provisions are now placed to recognize a design as a personal property. This means a registered design may be treated in the same manner as any personal or moveable property. As such a registered design may be used as a security interest in the same way as other personal property. This would make a design more valuable in terms of securing financing to grow or invest in any entity. Third parties may check with the records of the Register to see if a design has been sold or charged to a bank.

Following the Industrial Design (Amendment) Regulation 2013, is the introduction of new ID forms to which all applications, proceedings relating to the Industrial Designs Act must be used as all application forms prior to 1st July 2013 will no longer be accepted.

## ANANDA IP NEWS

We are pleased to announce the deepening of our regional partnerships with ORBIS LIMITED in Hong Kong and China and with GLOBAL IP SOUTHEAST ASIA in the ASEAN region. Through these partnerships, our newsletters will integrate articles covering IP issues across main ASEAN jurisdictions.

We are also very honored to have won the International Law Office (ILO) Client Choice Award for best patent practice of Thailand and to be listed among Thailand's Leading IP Firms for 2012, 2013 and 2014 by Legal 500 Asia Pacific, WTR 1000 and Asia Law.



Congratulations as well to Franck Fougere for receiving the following distinctions:

Leading Practitioner (Managing Intellectual Property-IP Handbook 2014)

Leading Individual for Enforcement and Litigation- (Managing IP 2014)

Leading Individual IP (Legal 500 2014)

### CONFERENCES AND SEMINARS

Breakfast talk, Intellectual Property in Thailand, February 19, 2014 organized by the ASEAN SME IPR HELPDESK, the Franco-Thai Chamber of Commerce and the Thai-Italian Chamber of Commerce. PowerPoint of our presentation can be downloaded on our website: [www.ananda-ip.com](http://www.ananda-ip.com)



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