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"Under Rule 41, corresponding applications filed or patents granted by the European Patent Office and Canada are only recognised if they are originally filed in the English language."

RELIANCE ON "CORRESPONDING" APPLICATIONS/PATENTS

BY AMEEN KALANI Under Section 2 of the Singapore Patents Act and Rule 41 of the Singapore Patents Rules, a "corresponding patent application" or a "corresponding patent" is defined as one that is filed in a recognized country or Patent Office that is linked to a Singapore patent application through a priority claim. A corresponding application must be one that forms the basis for a priority claim or is subject to a priority claim based on the application in suit.

Further under Rule 41, corresponding applications filed or patents granted by the European Patent Office and Canada are only recognized if they are originally filed in English language. It would be sagacious to remove the English language restriction for corresponding applications and patents filed in Europe and Canada and instead call for the applicant to furnish a verified English translation of the corresponding application which has been issued with final search and examination results or patent. This would take into cognizance all official filing languages of the European and Canadian Patent Offices and allow the applicant greater flexibility in relying on such non-English language patent applications to satisfy grant requirements in Singapore. In neighbouring Malaysia, it is noted that there is no English language requirement when prosecuting an application by relying on a corresponding European application under their modified substantive examination route.

An outcome of the current definition of a "corresponding application or patent" is in a situation

where the applicant files a PCT International application in the first instance with no claim to priority. Let us assume that such an application then enters the PCT national phase in Singapore and in a recognized country under Rule 41 where it is subsequently allowed. Under the current statutory definition, the applicant will not be able to rely on such a PCT national phase application that is allowed or its resulting patent in that recognized country to satisfy grant requirements in Singapore. This appears to place the applicant in a disadvantageous position when filing a PCT International application in the first instance without a priority claim and goes against the *raison d'être* for allowing applicants freedom to prosecute their Singapore applications by relying on corresponding applications. Again in Malaysia, there is no requirement for the application in suit whether filed under the PCT national phase or otherwise to be linked through a priority claim to a prescribed corresponding application before the latter can be relied upon under their modified substantive examination route.

Where the applicant chooses to rely on a prescribed corresponding application under Rule 41 to fulfill grant requirements in Singapore, two requirements are of paramount importance, that is, each claim in the Singapore application proceeding to grant must be "related" to at least one claim in the prescribed corresponding application and must have been "examined" to determine whether the claim appears to satisfy the criteria of novelty, inventive step and industrial applicability.

ORIGINALS VS. GENERICS

A Malaysian perspective on the battle between patented drugs and their generic counterparts.

BY OON YEN YEN **T**he battle between original pharmaceuticals and their generic counterparts has always been about balancing public interest against a robust Intellectual Property regime. This balancing act is particularly important and challenging for developing countries such as Malaysia.

Original drugs are generally protected by patents to ensure a return on investment through a fixed term market monopoly. On average, it can take between 7 to 10 years for an original drug to get from the laboratory to the market, and a Malaysian patent confers a non-extendible 20-year monopoly onto the drug calculated from the filing date of the patent application. However, delays in patent prosecution and regulatory approvals invariably render this 20-year monopoly insufficient to recoup the substantial investments poured into the drug's development. Furthermore, unlike in the US or Europe, Malaysian patent law contains no provisions for granting either Supplementary Protection Certificates (SPC) or Patent Term Extensions (PTE) for a patent pertaining to any industry including pharmaceuticals.

A Bolar-type exemption similar to Section 271(e)(1) of the US Hatch-Waxman Act was introduced into the Malaysian Patents Act with effect from August 1, 2001. In September 2001, the Drug Control Authority (DCA), an executive body of the National Pharmaceutical Control Bureau (NPCB), issued a statement allowing

generic drug manufacturers to submit their applications for regulatory approval up to 24 months before expiry of the patent term.

Data exclusivity, used in some countries to compensate for insufficient patent protection by preventing health authorities from accepting applications for generics during the period of exclusivity, is not yet available in Malaysia.

Yet it would be wrong to assume that Government policy and legislature always favours generics above originals, as the dispute between Aventis Pharma and local manufacturer Dabur Enterprise showed [Aventis Farma SA (M) Sdn Bhd & Anor versus Rohibul Sabri Bin Abas @ Megat (Dabur Enterprise) & Anor; [2008] 3 MLJ 451; Suit No D1-22-317 of 2006].

In this case, Justice Vincent Ng decided in favour of Aventis Pharma, owner of Malaysian patent no. MY-118481-A, which described a method of producing docetaxel trihydrate, the active ingredient in a cancer drug sold under the brand name Taxotere. The defendants manufacture and sell the generic version of the drug under the brand name Daxotel.

The plaintiffs claimed that the defendants had infringed their Malaysian patent and applied for an interim injunction to restrain the defendants from marketing

Daxotel pending the disposal of the infringement suit. The defendants contended that the manufacturing process they employed was different and distinct from that claimed in the plaintiffs' Malaysian patent. They further contended that cancer patients would suffer if the substantially cheaper Daxotel were taken off the market. When delivering his decision to allow an application for preliminary injunction in view of patent infringement, Justice Ng said that:

"It may be true that the defendants' drug cost less to cancer patients here, but pirated compact disks, watches and DVDs sold in Petaling Street, Kuala Lumpur are also famously dirt cheap. It does not then follow that because such pirated goods could save our consumers considerable sums of money, it is in the public interest to condone such activities."

The manufacture and export of off-patent generic drugs is a significant market in Malaysia. Malaysia's admission as a member of the Pharmaceutical Inspection Convention and Pharmaceutical Inspection Cooperation/Scheme (PIC/S) further boosted the country's exports of off-patent generics, especially to PIC/S member countries, with total exports in 2008 amounting to RM 513 million.

To the general public, including medical professionals, there is no great difference between original drugs and generics. The only distinguishing factor is cost. Can originals and generics co-exist in a developing market like Malaysia's? Only time will tell.

This is an edited version of the full text. The article may be read in full on our website at www.henrygoh.com.

THE SWISS BLISS

Local chocolatier wins right to use the word "SWISS" on product packaging.

IS DISMISSED

BY LIM ENG LEONG Recently the Malaysian IP Court was called upon to decide on the following issues:-

- Whether the term "SWISS" used on chocolates had any goodwill protected by a passing-off action in its extended form; and
- Whether the use of the words "Maestro SWISS" on the Defendant's chocolates led the public to believe them to be made in Switzerland.

Such was the case of **Chocosuisse Union des Fabricants Suisses de Chocolat & Ors v Maestro Swiss Chocolate Sdn Bhd & Ors [2010] 3 MLJ 676** where the first Plaintiff is a Swiss co-operative society comprising of Swiss chocolate manufacturers formed to protect its members' worldwide reputation and goodwill.

The 2nd and 3rd plaintiffs are Kraft Foods Schweiz and Nestlé Suisse SA respectively. They are manufacturers and exporters of Swiss chocolates worldwide, including Malaysia. The dispute arose when the plaintiffs discovered the use of "Maestro SWISS" by the Defendant on their chocolate products.

The crux of the Plaintiffs' case was that they are interested persons in respect of the geographical indication "SWISS" for chocolates, which denotes Swiss-made chocolates conveying a certain significance that they are of premium quality. The first Plaintiff's members have expended incalculable time, effort and money to promote and protect the goodwill associated with these products they manufacture. Thus, any person who consumes the Defendant's chocolate products may be led into thinking that they originate from Switzerland and/or the lack of quality of the Defendant's products may be adversely associated with actual Swiss-made chocolates.

The Defendant on the other hand contended that the first Plaintiff had no goodwill associated with their business in Malaysia and that the term "Swiss chocolate" was generic; not a source indicator.

The High Court referred to a gamut of English cases (including the *Spanish Champagne*, the *Advocaat* and the *Scotch* cases) that recognised the extended form of the tort where:

1. Parties who are members of a class with the right to use a name are entitled to protect the same with a passing-off action; and
2. Unlike the classic passing-off action, the misrepresentation in this instance is not that the defendant's product is the product of the plaintiffs but that the product is the kind that enjoys the goodwill attached to a trade mark in which the plaintiffs have a proprietary right.

This *ratio decidendi* had been adopted in the cases of *Wembley Gypsum Products Sdn Bhd v MST Industrial Systems Sdn Bhd and Meidi (M) Sdn Bhd v Meidi-Ya Co Ltd, Japan*.

Regretfully, the Court held that the first Plaintiff had no *locus standi* to sue because they did not have any form of chocolate business here, hence they do not have any goodwill. However, the remaining Plaintiffs successfully adduced unchallenged evidence to show and establish that the term "Swiss chocolates" affixed on the products they sold here, that were made in Switzerland could be protected by a passing-off action in its extended form.

In deciding the second issue, the judge concurred with the Court of Appeal's decision in the *McCurry*

case. Marks must be compared in their entirety and their respective use in trade when determining likelihood of confusion or deception. As the phrase "Swiss chocolate" did not appear on the Defendant's product, the court agreed with Defendant's argument that its packaging get-up has distinct elements in terms of graphics and labelling details. Moreover the phrase "Maestro SWISS" was acknowledged as the Defendant's corporate identity and even so, it is less prominent than the Defendant's "Vochelle" trade mark.

Whilst we agree with the court's observation that the respective chocolates are differently priced and targeted at different consumers, one should not assume that the relevant classes of consumers will not overlap. We do not see how the general public can easily perceive the word "SWISS" to be a local corporate name rather than a geographical indication when it is presented in red and white akin to the Swiss flag and popularly associated with many Swiss-made products. The case is now on appeal and we wait for the Court of Appeal's decision with bated breath. 🙏



132nd INTA Annual Meeting: Boston, MA

In keeping with tradition, almost 8400 IP practitioners descended into Boston for INTA's annual event held on 22-26 May 2010.

As always, the occasion remains a valuable investment in meeting up with clients and associates, new and old as well as learning more about worldwide IP practice trends. The personal discussions were incredibly productive and the numerous receptions were good networking opportunities. Although last held there 12 years ago, the home to the Boston Celtics and Red Sox once again proved to be the perfect host city. Attendees were warmly welcomed by scenic harbours, red stone buildings and fresh seafood. Henry Goh's representatives - Tham Sau Yin, Lim Eng Leong and Oon Yen Yen - would like to thank each individual they met in Boston who made this year's trip such a successful one for the firm.

See you in San Francisco 2011!



From left: Lim Eng Leong, Tham Sau Yin and Oon Yen Yen.

National IP Day Seminars

In conjunction with this year's National Intellectual Property Day, Henry Goh in collaboration with the Malaysian Intellectual Property Office (MyIPO) and the Associated Chinese Chambers of Commerce and Industry of Malaysia (ACCCIM) presented several Mandarin seminars to the public. It was one of the Firm's contributions to the Government's ongoing efforts in increasing the level of IP awareness amongst the Malaysian public.

Andrew Siew, a patent agent at Henry Goh Malaysia, spoke on two occasions - the first on 26 April 2010 during the National IP Day celebrations in Kuala Lumpur and thereafter on 7 May 2010 in Sibu, Sarawak. The latter seminar, attended by the former Director-General of MyIPO, was subsequently closed by the Minister of Domestic Trade, Co-operatives & Consumerism, Dato' Sri Ismail Sabri Yaakob.

The ensuing Q&A session was lively with questions from the audience regarding the seminar content, trade mark and copyright protection.



Andrew Siew speaking at the seminar.



Henry Goh welcomes new Patent Engineer

Henry Goh is pleased to welcome a new member into its family of professionals, Ms. Juria Toramae.

An Honours graduate in Biochemical - Biotechnology Engineering, Juria joins Henry Goh Singapore as a Patent Engineer. She will assist in the management, operations and supervision of the firm's portfolios of patents, trademarks and registered designs while helping to draft patent specifications and provide opinions.

An avid photographer and theatre buff, Juria is also pursuing a Graduate Certificate in Intellectual Property Law.

MALAYSIA

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