

Q&A



Patent
Patent Cooperation Treaty
Trade Mark
Industrial Design
Copyright



Henry Goh
& Co. Sdn. Bhd.

PATENT, TRADEMARK & DESIGN AGENTS

MALAYSIA

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About Henry Goh

HENRY GOH was founded in 1977 by Henry H P Goh. We are one of the leading patent and trade mark firms in Malaysia, as well as the longest established.

Our clientele ranges from prominent multi-national companies to innovative individuals in all fields of commerce and industry. We act on behalf of clients from over 45 foreign countries – a track record that speaks for itself.

EXPERTISE

We provide a full range of intellectual property rights (IPR) protection and enforcement services worldwide, particularly in Malaysia, Singapore and Brunei.

We employ customised, up-to-date software to ensure that every part of our organisation responds with maximum speed and efficiency to our clients' requirements.

Our clients can be confident that we have the expertise, knowledge and resources to ensure that their intellectual property portfolio is in the best possible hands.

Our Professional Services

HENRY GOH provides a comprehensive range of services relating to intellectual property. These services are available in Malaysia and abroad to meet the needs of the globalization of Malaysian businesses.

The services cover:

- Initial advice on protecting your new invention, trade mark or design.
- Filing and prosecution of patent, trade mark and design applications on a worldwide basis.
- Maintenance of intellectual property rights after registration.
- Advice as to the proper course of action necessary for exploitation (including licensing and franchising) and enforcement of intellectual property rights.

Introduction

Patents, Trade marks, Industrial Designs and Copyright form the four major areas of intellectual property. Exclusive rights to each of these areas of intellectual property can be conferred on the owner to prevent competitors from enjoying the same rights. Copyright protection is conferred automatically. However, in the case of Patents, Trade marks and Designs, it is critical to register these rights in order to enjoy their benefits.

- It is most important that you protect your intellectual property. It can become a valuable commercial tool.
- More companies are becoming knowledgeable about intellectual property rights, and are realising that they are valuable business assets. They are now including them in their business plans, marketing strategies and balance sheets.
- Intellectual property rights can be used to prevent others from copying and thereby taking advantage of your ideas or the goodwill you have developed for your products and services.
- They can be used to give you a time lead and market advantage over your competitors.
- They can be used to raise funds by selling, or licensing the rights for royalty payments.

Patent

1. WHAT IS A PATENT?

A patent for an invention is a legal right granted by the government. It allows you to stop other people from using your invention during the life of the patent.

2. WHAT IS AN INVENTION?

Patents cover all fields of technology. Basically, an invention is something which is new and is not obvious. It must be technical, but it does not need to be complicated or high tech. An invention can be many things, including a machine, device or any kind of mechanical, electrical or electronic product, a chemical substance, a biotechnological product, or an industrial process.

Some things, although new, cannot be patented. This is usually because they are not technical or they do not have a use in industry. For example, an oil painting, a method of fortune telling and a method of selling insurance are all examples of things which cannot be patented.

3. WHAT IS MEANT BY NEW?

New means that the invention must not be known previously anywhere in the world. If the invention has been published or made public in any way before the patent is applied for, then the patent right generally cannot be obtained. So, you should plan and budget for patenting early on in order that your patent application can be submitted before any publication, advertisement, sale, public demonstration or use of the invention occurs.

In Malaysia, a patent can be applied for up to one year after the first disclosure of the invention by its owner. The invention will still be treated as new and therefore patentable. However, such disclosure will prevent you from obtaining patents in most foreign countries.

4. WHAT IS MEANT BY INVENTIVE STEP?

In addition to being new, an invention must involve what is known as an inventive step. This means that the invention must be something more than a trivial or obvious modification of the existing technology. It does not mean that the invention needs to be ingenious or complicated. In fact, many patentable inventions are based on simple ideas, such as small yet advantageous improvements to existing products or processes.

5. HOW DO I OBTAIN A PATENT FOR AN INVENTION?

In order to obtain a patent, it is necessary for the owner of the invention to file a formal patent application with MyIPO (Intellectual Property Corporation of Malaysia). The invention must be described and defined in a document known as the specification. The specification includes a description and

drawings of working examples of the invention, as well as a set of claims that defines the invention to be protected. 18 months after filing your patent application, the specification becomes a public document - anyone can obtain a copy of it and learn about your invention. However, provided the patent is granted, you may be able to claim compensation for use of your invention by third parties while the application was pending.

6. WHAT IS SUBSTANTIVE EXAMINATION?

All patent applications must go through an approval process before they can be granted. This process is called substantive examination. Examination must be requested within a specific timeframe from the application filing date. A fee is also payable. If the examination request is not made, or not made in time, the application will become abandoned and no patent can be granted.

After requesting examination, the application will be forwarded to a patent examiner at MyIPO. Among other things, the patent application will then be searched for newness and examined for inventive step. Normally, various objections will be raised in an adverse report that needs to be replied to by way of amendment of the specification and/or argument. An adverse report must be replied to within a prescribed term. If no response is made in time, the application will be refused and no patent granted. Otherwise, after making a suitable response and provided the examiner is satisfied that the application meets the requirements of the Patents Act, a patent will be granted.

7. WHAT IS A UTILITY INNOVATION CERTIFICATE?

This is a registration like a patent that protects what is called a utility innovation instead of an invention. A utility innovation is a lower level invention. It must be new, but there is no requirement for inventive step. The specification is restricted to only one claim. The term of protection is up to 20 years, but renewal after 10 years is dependent upon use in Malaysia, or a satisfactory explanation of non-use.

8. WHO IS ENTITLED TO APPLY FOR A PATENT?

Only the owner of the invention, whether an individual or a company, can apply for a patent. You can never patent someone else's invention.

9. HOW LONG DOES A PATENT LAST?

Once a patent has been granted, a renewal fee must be paid to MyIPO every year to maintain the protection. The maximum life of the patent is 20 years from the initial filing date.

10. WHAT PROTECTION DOES A GRANTED MALAYSIAN PATENT PROVIDE?

The scope of protection is defined by the claims contained in the specification. If the claim defines a product, the patent is infringed by making, importing, selling or using the defined product in Malaysia. In the case of a process claim, the patent covers using the defined process in Malaysia, and doing in Malaysia any of the above-mentioned acts in respect of a product obtained directly by means of the process.

11. HOW DO I ENFORCE MY PATENT RIGHTS?

Neither MyIPO nor the Police can enforce your patent for you. You must take action against infringers yourself by having a lawyer start proceedings in the High Court. Patent disputes can often be settled by agreement between the parties without the need for such legal action or before the action proceeds beyond the initial stages.

12. HOW DO I GET PATENTS IN OTHER COUNTRIES?

A Malaysian patent has effect only in Malaysia. To obtain protection in other countries, it is necessary to apply for separate patents in those countries. There is no such thing as a world patent. However, there are international agreements that allow you to defer the costly procedure of applying for patents overseas. These agreements include the Paris Convention and the Patent Cooperation Treaty (PCT). The Paris Convention allows the filing of foreign applications to be deferred up to one year from an initial Malaysian filing date. The PCT is a system for the filing of so-called international patent applications. It is dealt with in the following chapter.

13. WHAT IF I ONLY WANT TO GET PATENTS OVERSEAS, AND NOT IN MALAYSIA?

Malaysian residents are required either to file a first patent application in Malaysia and wait two months before filing overseas, or to obtain in advance written permission from the Registrar of Patents before filing overseas. Contravention of this requirement is an offence, punishable by a fine or jail sentence, or both.

14. WHAT IS THE ROLE OF A PATENT AGENT?

A patent agent is a professional who specialises in patents. A patent agent represents you before MyIPO, so that you do not need to worry about the complexities of the patenting process. Only qualified and experienced individuals are listed in the official government register of Patent Agents.

A patent agent advises on whether an invention is potentially suitable for a patent, writes the specification to meet the exacting legal requirements and to obtain the best protection for the invention, and handles technical objections raised by an examiner in the process of having the patent granted.

Since patents are obtainable only on a country-by-country basis, a patent agent is also familiar with the requirements and procedures of patent filing overseas. The patent agent will work closely with foreign associates to obtain patent protection for you in other countries of interest.

Professional ethics ensure that all the details of your invention that you give to a patent agent will always be treated in strictest confidence.

International Applications
under the

Patent Cooperation Treaty (PCT)

1. WHAT IS THE PCT?

The Patent Cooperation Treaty (PCT) is an international agreement between 144 countries (at 01.01.2012) under which an international patent application may be filed. Such an application is treated as equivalent to a national application in each of the member countries. The international application is governed by a common set of law and rules (the PCT and its Regulations) during the stages of the procedure making up what is called the “international phase”. At the end of the international phase, the applicant must enter the “national phase” in the Patent Offices of the countries of interest, which are obliged to recognize the PCT application including its international filing date. The procedure in the national phase is governed by national law. Each country will make its own determination of whether a patent can be granted. Basically, the PCT is therefore a convenient shortcut to starting the process of obtaining individual patents in various foreign countries. It does not lead to an international patent. There is no such thing currently.

2. WHAT IS COVERED BY “THE INTERNATIONAL PHASE”?

The international phase refers to the stages of the procedure governed by the PCT and its Regulations. The key stages are filing, international search and publication, plus an optional stage of international examination. Further information on each of these stages is given below.

3. WHAT IS COVERED BY “THE NATIONAL PHASE”?

The national phase refers to the stages of the procedure governed by national law, upon expiry of the international phase. The requirements vary from country-to-country. Notably, substantive issues such as patentability are governed solely by national law, with any determination made in the international phase being preliminary and non-binding on the national Patent Offices.

4. WHO IS ENTITLED TO FILE A PCT APPLICATION?

Any person that is a resident or national of a PCT member country may file a PCT application. A company or other legal entity constituted under the national law of a PCT member country also qualifies to file a PCT application. Malaysia joined the PCT system in 2006. Therefore, Malaysian individuals and entities can now file international patent applications.

5. WHERE DOES ONE FILE A PCT APPLICATION?

The International Bureau in Geneva, Switzerland administers the PCT system. PCT applications are also processed by existing national and regional patent offices, but according to the PCT

and its Regulations. A PCT application is filed with a national patent office acting as what is called the Receiving Office. For a Malaysian applicant, MyIPO is the relevant Receiving Office.

6. CAN A PCT APPLICATION CONTAIN A PRIORITY CLAIM?

Yes, because of its effect as a regular national application, a PCT application may claim the priority of an earlier application filed no more than 12 months previously. The effect of the priority claim is to backdate the application date to that of the earlier application. This is beneficial when assessing patentability.

7. WHAT HAPPENS AFTER FILING?

After according an international filing date and application number, the Receiving Office will proceed to conduct a formality examination for compliance with further requirements of the PCT Regulations. The applicant or agent corresponds with the Receiving Office to address any objections. The Receiving Office is also responsible for collecting the filing fees. It keeps one copy of the application (Home copy), sends one copy (Record copy) to the International Bureau and another copy (Search copy) to the International Searching Authority. The latter conducts a search and generates an International Search Report and Written Opinion on patentability, and sends a copy to the applicant and to the International Bureau. After 18 months from the earliest priority date (or the international filing date if no priority is claimed), the International Bureau publishes the application together with the International Search Report.

8. WHAT IS MEANT BY AN INTERNATIONAL SEARCHING AUTHORITY?

The patent offices of certain PCT member countries are designated as International Search Authorities (ISA) that are entrusted with preparing the International Search Report and initial Written Opinion of all PCT applications. For Malaysian applicants, the relevant ISAs are the Australian, European and Korean Patent Offices.

9. WHAT IS MEANT BY CHAPTER I PCT?

The Treaty is divided into eight (8) chapters, of which Chapter I and II contain most of the substantive provisions governing the filing and prosecution of an international application. Chapter I covers the procedures of filing, search and publication.

10. WHAT IS MEANT BY CHAPTER II PCT?

Chapter II covers an optional procedure of International Preliminary Examination (IPE), in which the applicant may have a written dialogue with an Examiner in an International Preliminary Examining Authority (IPEA). Such IPE is initiated by filing what is called a Demand.

11. WHAT IS THE TIME LIMIT FOR ENTERING THE NATIONAL PHASE?

Generally, the time limit for entering the national phase is 30 months from the earliest priority date claimed in the PCT application. The diagram below shows the timeframe.



12. HOW DOES THE PCT BENEFIT MALAYSIAN APPLICANTS?

The principal advantage is the facility to initiate the process of obtaining patents in multiple foreign countries through filing of a single, international application in one language and subject to one set of fees that can be paid in local currency. The International Search Report and Written Opinion also allow an early assessment of the prospects of patenting the invention before decisions on national phase entry need to be made.

Trade Mark

1. WHAT IS A TRADE MARK?

A trade mark is used by a trader or service provider to identify his goods or services and to distinguish them from those of other traders. A trade mark could take the form of, for example, a dictionary word, an invented word, numbers, letters, a logo, a picture, a slogan or any combination of these. Some examples of well-known trade marks are APPLE for computers, ROLEX for watches and COCA COLA for drinks.

A registered trade mark is a legal right granted by the government. It gives the owner a statutory monopoly for the exclusive right to use the mark in relation to the goods or services for which the mark is registered.

2. ARE ALL TRADE MARKS REGISTRABLE?

Not all trade marks are registrable. In general, marks which other traders would legitimately want to use to describe their goods or services are not registrable. Thus, for example, the mark should not be descriptive of the goods, it must be “distinctive”. Examples of unregistrable marks are “PERFECT” or “THE BEST”. Other unregistrable marks include well-known surnames or the name of a large city or country.

Also, the mark should not conflict with earlier filed or registered trade marks.

3. WHAT IS A SERVICE MARK?

The term service mark refers to trade marks which are used in relation to services rather than in relation to products or physical goods. Examples of services include banking, insurance, hotels, restaurants, education, computer programming, cleaning, repairing, advertising and so on.

4. WHY SHOULD YOU REGISTER A TRADE MARK?

It is not compulsory to register a trade mark. However, if someone is infringing your mark, and the mark is not registered, then it will be necessary to take action under the common law of “passing off”. A passing off action can be very expensive, time consuming and the outcome can be very difficult to predict.

It is normally much simpler to prove infringement of a registered trade mark. In many cases, a cease and desist letter from your trade mark agent or lawyer is all that is needed to stop the infringing act.

5. IS IT NECESSARY TO CONDUCT A PRE-FILING SEARCH?

Before filing a trade mark application, or starting to use a new mark, it is advisable to first make a search at MyIPO to ensure that there are no marks identical to, or closely resembling your mark, filed or registered by others for similar goods or services. The search is best handled by Registered Trade mark Agents, who will be able to offer professional advice on the availability and registrability of the mark.

6. HOW DO I OBTAIN A TRADE MARK REGISTRATION?

To obtain registration of a trade mark, it is necessary for the owner of the mark to file a formal trade mark application with MyIPO. The application will be examined by an examiner for conflict with any earlier marks and its registrability will be determined based on various factors such as distinctiveness.

7. WHAT IS THE DURATION OF A TRADE MARK REGISTRATION?

The term or duration of a trade mark registration is initially 10 years from the date of application. Upon payment of a fee, the registration is then renewable every 10 years in perpetuity.

8. WHAT ABOUT PROTECTION IN OTHER COUNTRIES?

A trade mark registered in Malaysia is valid only in Malaysia. If you intend to export your products to other countries, you should consider applying for protection in each country in which protection is desired. However, it is possible to file a single application for a trade mark for all the countries in the European Union, by filing a European Community Trade mark (CTM) application.

9. WHAT CAN A REGISTERED TRADE MARK AGENT DO FOR YOU?

Registered trade mark agents possess skill and knowledge in all phases of trade mark prosecution and registration. They can advise on the registrability of your mark, conduct pre-filing searches, prepare all the necessary paperwork required to file a trade mark application, handle any official objections raised by an examiner and/or any oppositions raised by third parties during the process of registration. Trade mark agents also have close contacts with foreign associates for the purpose of obtaining appropriate trade mark protection in other countries.

10. WHAT IS THE DIFFERENCE BETWEEN TRADE MARKS, DOMAIN NAMES AND COMPANY NAMES?

Trade marks should not be confused with company names or domain names.

Unlike a registered trade mark, company and domain names do not give you statutory monopoly right.

A company name merely serves to identify the owners of the business. A domain name is merely a textual address for a location on the Internet.

Many organisations now register the same mark both as a trade mark and as a domain name.

Industrial Design

1. WHAT IS AN INDUSTRIAL DESIGN REGISTRATION?

An industrial design registration is a form of intellectual property right that protects the novel visual appearance of an article.

2. WHAT IS AN INDUSTRIAL DESIGN?

An industrial design consists of features of shape, configuration, pattern or ornament that are applied to an article by an industrial process and have eye appeal. Shape and configuration refer to 3-dimensional features, whereas pattern and ornament refer to 2-dimensional features such as surface decoration. Note that colour is not currently an aspect of a design that can be protected as such, though contrasting colours may form a protectable pattern.

3. WHAT IS MEANT BY AN ARTICLE?

An article is generally a mass-produced item but it includes a handcraft. Some examples of articles the designs of which are registrable include: furniture, toys, handphones, cars, electronic gadgets and appliances, household utensils, bottles, carpets, wallpaper and textile materials.

4. WHAT PURPOSE DOES A DESIGN REGISTRATION SERVE?

The product you have designed may be attractive in appearance and appealing to your customers. Design registration will allow you to stop others from copying your design and profiting by it. The registered design owner has the exclusive right in Malaysia to make, sell and import the design in relation to the article mentioned in the registration.

5. CAN ANY INDUSTRIAL DESIGN BE REGISTERED?

No. To be registrable a design must be new. This means that the design, or a very similar one, must not have been previously sold or otherwise made public in Malaysia, whether by yourself or another person, before you file your application for registration. The design must also meet the legal definition, including having eye appeal.

6. HOW DO I REGISTER MY DESIGN?

In order to obtain registration of a design, it is necessary to file an application with MyIPO and get it approved. The application papers identify the applicant (design owner), the author (designer), and the type of article, and include representations of the design in the form of drawings or photographs. Applications undergo formal examination. Upon successful completion of the examination process, the design will be registered and a registration certificate issued.

7. CAN I INCLUDE A FEW DESIGNS IN ONE APPLICATION?

Yes, this is possible if the designs are for a set of articles, for example a sofa and armchair, or if the designs are for the same class of article. In the latter case, extra fees are payable for the additional designs.

8. WHO CAN APPLY TO REGISTER AN INDUSTRIAL DESIGN?

Only the owner of the design, whether an individual or a company, can apply for its registration. You can never register someone else's design.

9. HOW LONG DOES A DESIGN REGISTRATION LAST?

The maximum life of a Malaysian design registration is 15 years. A renewal fee must be paid after 5 and 10 years to maintain the protection.

10. WHAT TERRITORY DOES A DESIGN REGISTRATION COVER?

A Malaysian design registration has effect only in Malaysia. To obtain protection in other countries, separate applications must be filed in those countries. If a foreign application is filed within 6 months of a first Malaysian application, it can be backdated to the initial Malaysian filing date.

11. WHY CAN'T I RELY ON COPYRIGHT TO PROTECT MY DESIGN?

Since 01 September 1999, copyright protection of designs is generally no longer available. If a design is registered, copyright protection is lost. If a design is capable of registration but is not registered, copyright protection is lost once the design has been reproduced by making more than 50 articles to the design. Copyright in an engineering drawing of a design is not infringed by making articles based on the drawing. Therefore, it is now necessary to register new designs in order to get them protected.

12. HOW CAN AN INDUSTRIAL DESIGN AGENT HELP ME?

A registered industrial design agent is knowledgeable in the law and practice of design registration. He or she can advise on the suitability of a design for registration, prepare and file the application with MyIPO for you and deal with any objections from an examiner. Design registration may appear simple, but there are many intricacies that call for professional help.

Copyright

1. WHAT IS COPYRIGHT?

Any original work produced with sufficient skill and effort and expressed in material form is entitled to copyright. A book, manual, song, drawing, film, sound recording, computer software can all be protected by copyright.

2. WHAT IS THE PURPOSE OF COPYRIGHT?

Copyright entitles the owner to control the doing of various acts in relation to his created work and to prevent or restrict any use without his consent.

3. WHAT DOES NOT AMOUNT TO COPYRIGHT?

Copyright protection does not extend to any idea, procedure, method of operation or mathematical concept. Copyright does not subsist in any design which is registered under any written law relating to industrial design. Further, copyright in any design which is capable of being registered but which has not been so registered, ceases as soon as any article to which the design has been applied has been reproduced more than fifty times by any industrial process by the owner of the copyright or by any person under the licence of the owner.

4. IS COPYRIGHT REGISTRATION NECESSARY TO OBTAIN PROTECTION IN MALAYSIA?

No. Under Malaysian law, copyright protection is conferred in an original work once it is expressed in material form provided that:

- the author is a citizen or permanent resident of Malaysia or a citizen or resident of any of the Berne Convention member countries at the time his work was made, or
- the work is first made available to the public in Malaysia or in any of the Berne Convention member countries, or
- if the work is first made available to the public elsewhere, it is subsequently made available within 30 days, to the public in Malaysia or in any of the Berne Convention member countries, or
- the work (other than published editions) is made in Malaysia or the work (other than sound recordings, broadcasts and published editions) is made in any of the Berne Convention member countries.

5. IS COPYRIGHT PROTECTION LIMITED TO MALAYSIA ONLY?

By Malaysia's accession to the Berne Convention for the protection of Artistic and Literary Works, a work that is eligible for copyright in Malaysia is accorded reciprocal protection in other member countries.

6. HOW LONG CAN COPYRIGHT PROTECTION LAST?

Generally, for literary, musical or artistic works published during the author's lifetime, the protection period is for the life of the author plus fifty years after his death. However, for such works published after the death of the author, copyright shall subsist until fifty years from the publication of the work.

7. I HAVE PUBLISHED A BOOK IN MALAYSIA LAST MONTH. DO I HAVE WORLDWIDE COPYRIGHT PROTECTION?

Yes. Malaysia is a Berne Convention member country and with first publication in Malaysia, your book is protected by copyright in more than 150 Berne Convention countries.

8. I HAVE DEVISED A STORY LINE FOR A NOVEL. IS MY IDEA PROTECTABLE UNDER COPYRIGHT LAW?

Copyright does not protect the mere ideas underlying a work. You should express the details of your story by having them written down, recorded or reduced to material form.

9. OUR COMPANY HAS A PLAY FOR THE THEATRE, WHAT COPYRIGHT DO WE HAVE? HOW CAN WE EXPLOIT THESE RIGHTS?

You have a right in the literary, musical and / or artistic work and maybe even adaptation of the work. For example, you have exclusive control over the reproduction of the script of the play and the performance. If the play is recorded, you have control over the distribution of copies of the work to the public by sale or other transfer of ownership and the commercial rental to the public.

10. WHAT IS THE BENEFIT OF COPYRIGHT FOR MY WORK?

By virtue of having copyright, one is able to transfer this copyright by assignment, testamentary disposition or by operation of law for monetary value just as one could for property. One could also grant licences for certain acts such as reproducing the literary or musical work, performing, showing or playing the work in public in exchange for royalty.

11. HOW DO I PROVE I HAVE COPYRIGHT?

Affirm an affidavit or statutory declaration before a commissioner for oaths in respect of any of the works eligible for copyright stating that, at the time stated therein copyright subsisted in such works and annex a copy of the work.

12. WHY DO I NEED TO CHECK ON LICENSING OF COPYRIGHT IF I AM TRANSLATING A PIECE OF WORK INTO THE NATIONAL LANGUAGE?

The owner of the copyright has the exclusive right of making or authorising a translation of his work into any language. The right to translate a work into the national language (Bahasa Malaysia) is available for only a year following the first publication of the work. If no such translation has been published by the owner, the Copyright Tribunal may, on application grant a non-exclusive licence to translate and publish the work in the national language.

Apart from Malaysia, Brunei and Singapore, Patent and Trade Mark filing is also available in collaboration with Associates of Henry Goh & Co Sdn Bhd in the following countries:

Bangladesh • Cambodia • China • Hong Kong • India • Indonesia • Japan • Korea • Laos
Macau • Myanmar • Nepal • Pakistan • Philippines • Sri Lanka • Taiwan • Thailand • Vietnam

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