



Trek's Thumbdrive Patent Held to be Valid and Infringed

In a widely watched patent infringement case, main board-listed Trek 2000 International, an innovator and a patentee in Universal Serial Bus (USB) portable mass storage technology, achieved a significant victory in enforcing its patent against four defendants.

The case concerned various infringing acts alleged to have been committed by the defendants in relation to Trek's Singapore Patent No 87504 (WO 01/61692) ("the Patent") in respect of Trek's data storage device known as "ThumbDrive". In a decision dated 12 May 2005, the Patent was held to be valid and infringed by the defendants.

The case provides clarification and guidance on several

important features of Singapore patent practice. In particular, the circumstances under which post-grant amendments may be made and what acts constitute a "misrepresentation" (which is a ground of revocation in Singapore) were considered.

During the proceedings, the defendants cited various prior art documents in order to challenge the novelty and inventiveness of the Patent. Amendments were sought by Trek in order to adequately distinguish the Patent from these documents. However, under Singapore law, post-grant amendments can only be made at the discretion of the Registrar or the Court. The defendants argued that the Court should not allow Trek to amend its Patent. The Court in considering its discretionary powers took guidance from various UK decisions concerning the same. The Court decided that as there were no "compelling reasons" against amendment then Trek should be allowed to amend its Patent.

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Biotechnology Asia 2005 Kuala Lumpur, Malaysia

As part of our increasing commitment and expansion into Malaysia, Kristian Robinson and Heidi Aston recently delivered presentations at the prestigious Biotechnology Asia 2005 conference at the Putra World Trade Centre, Kuala Lumpur. Kristian provided an overview of the Intellectual Property system in addition to chairing the second day of the conference. Our biotechnology specialist, Heidi Aston provided an insight into some of the challenges and problems encountered in the biotechnology area.

The conference featured a distinguished panel of speakers of international repute comprising industry players, government officials and policy makers and attracted some 100 delegates from various parts of the world, whilst the associated exhibition aimed to attract some 6,000 trade visitors. The conference was opened by the Minister of Science, Technology and Innovation Y.B. Dato' Sr Dr. Jamaludn Dato' Mohd Jarjis.

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The defendants further alleged that Trek had, during the prosecution of the Patent, made misrepresentations over inventorship and ownership. On this basis, it was argued that the Patent had been obtained on a misrepresentation and, as such, should be revoked. In considering what constitutes “misrepresentation”, the Court held that any misrepresentation did not provide grounds for revocation. Only material misrepresentations which deceived the Registrar of Patents into granting the Patent provided grounds for revocation. The Court held that there had been no material misrepresentation by Trek and accordingly dismissed the defendants’ counterclaim.

The Trek case is one of a growing number of cases which demonstrate the enforceability of Patents in Singapore. With its robust intellectual property laws, and its position as a leading high tech hub, Singapore is becoming an increasingly attractive territory for patentees.

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TM “Paolo Simmons” Found to be Confusingly Similar to TM “Simmons”

In an opposition under the Singapore Trade Marks Act (Cap. 334), the Singapore Registrar refused registration of the trade mark “Paolo Simmons” on the ground that it was confusingly similar to the trade marks incorporating the word “SIMMONS”.

The Applicant applied to register the following mark in Class 24 for, inter alia, bed clothes, bed covers, bed linen, bed spreads, furniture coverings of plastic and mattress covers.

The Opponent, Simmons Company, was founded in America in 1876 and is a multi-national company which manufactures beds, mattresses, sofa beds, mattress covers, quilts, pillows, pillow covers, towels and other bedding accessories. The Opponent and its Singapore subsidiaries own various trade mark registrations incorporating the word “SIMMONS” in Singapore in Classes 20 and 24.

The Registrar found the Applicant’s mark to be confusingly similar to the Opponent’s mark registered in Class 24 for goods similar to those covered by the Applicant’s application (i.e. bed linen, bedspreads, pillow cases, quilts, quilt covers and bed covers).

The Registrar was of the view that while there may be visual differences between the two marks, the marks were similar aurally and conceptually. The Registrar found that the dominant and distinctive part of both marks is the word “SIMMONS”. When an average consumer sees the Opponent’s Class 24 mark, he is likely to remember the distinctive component “SIMMONS”. Similarly, the part of the Applicant’s mark that will strike him first is the word “SIMMONS”, as the word “PAOLO” is quite illegible and not the dominant part of the mark.

The Registrar also found that the Applicant’s mark is confusingly similar to the Opponent’s “SIMMONS” word mark registered in Class 20 for mattresses, transformable sofas, and parts thereof. The Registrar held that similar goods need not necessarily belong to the same class and goods from different classes may be considered to be similar. She found that while the goods covered by the Applicant’s Class 24 application and the goods covered by the Opponent’s Class 20 registration may not be the same goods in terms of their physical nature, they are similar goods in that they have the same uses, the same users, and the same trade channels.

The Registrar also found that the whole of the Opponent’s prior registered mark (i.e. “SIMMONS”) is incorporated in the Applicant’s mark. The additional elements in the Applicant’s mark like the word “PAOLO” and the dot and wavy line device do not detract from the fact that the marks are similar visually, aurally and conceptually.

Comment

As this case illustrates, trade mark proprietors should not hesitate to exert their prior trade mark rights in opposing a trade mark application in cases where the application mark incorporates a distinctive element of the prior mark and is sought to be registered for goods that are marketed in the same trade channels as the goods covered by the prior application/registration, even though the prior application/registration and the later application are in different goods classes.

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Vietnam – Official Trade mark Fees Amended

From the start of this year, the Ministry of Finance of Vietnam restructured the official fees for Intellectual Property services. The method of calculation of the fees for trade mark applications is now based on the number of items of goods / services claimed and the number of classes per mark.

A basic fee is levied on the first 6 items in a specification of goods / services; thereafter, each additional item attracts an additional charge. Where an applicant files the same mark in more than one class, additional charges, including the above-mentioned additional item charges, are levied for every class filed after the first class. Professional fees for trade marks have also increased.

In view of the fee revisions, trade mark owners may wish to review their specification of goods/ services prior to filing applications in Vietnam.

Apart from the fee amendments, there have also been several laws and regulations passed over the past 6 months concerning IP in Vietnam. Appended below is a short summary of these new laws and regulations:

- (i) Circular on border measures
Any holder of industrial property rights can now request the Custom Office to inspect and discover counterfeit goods. The Customs Office may also suspend the release of alleged infringing goods upon payment of a deposit amounting to 20% of the value of the seized goods, or 20 million Dongs (est US\$1,300) if the value of the seized goods cannot be determined.

- (ii) Law on publishing
A new Law on publishing entered into force on 1 July, 2005. The salient provisions of the new Law are:
 - Foreign publishing houses, through their representative office in Vietnam, may partake in publishing in some limited fields.
 - The Internet is now expressly included as an area which falls within the ambit of Vietnam's publishing law.
 - Copyright infringement is a criminal offence and carries a fine. Compensatory damages may be also ordered.

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OUR PEOPLE



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Blayne recently joined ECSF as a Senior Associate. He is a specialist in electronics patents and provides strategic advice to his clients from product conception through to commercialisation. Blayne also has a strong track record over a range of industries including electronic hardware and manufacture, communications hardware and infrastructure, ICT, computer and internet related technologies, white-ware appliances, medical products, food processing, marine instruments and infrastructure, nanotechnology, vehicle navigation, robotics and sports and exercise equipment.

Blayne has extensive experience in patent drafting, patent advice, patent prosecution and patent litigation in a variety of jurisdictions including Singapore, US, Europe, Australia and New Zealand. Recently, he has been involved with an intellectual property audit and educational seminar series, a patent infringement defence, a complex patent opposition, a utility model revocation, and an international patent licence negotiation.





Updates

Myanmar – Introduction of New Intellectual Property laws

As Myanmar approaches its February 2006 deadline to comply with the TRIPs Agreement, trade mark owners are poised to secure trade mark registration rights in Myanmar. It is anticipated that notarisation and legalisation of documents required for filing an application and publication

of cautionary notices may no longer be needed. We will be providing you with updates on developments in Myanmar in our future newsletter.

Nepal – New Official Fees

With effect from 16 September 2005, the official fees for trade mark, design and patent matters will be increased in Nepal. The new fees will apply to pending applications for registration as well.

We are pleased to inform that there are no corresponding increases in our service fees. For more information, please contact us.

events

Recent Events

ECSF seminar – Protecting & Managing your IP

11 August 2005
Kuala Lumpur, Malaysia



From left, Puan Siti Eaisah, Director of Policy & Planning of Malaysia Intellectual Property Office (MyIPO) and Ms Ella Cheong, Chairman of ECSF



Panel discussion
From left Mr Roy Joseph, Mr Alex Tan, Puan Siti Eaisah, Dr Andrew Blattman, Mr Soh Kar Liang and Mr Kristian Robinson

Biotechnology Asia 2005

16 – 18 August 2005
Kuala Lumpur, Malaysia



Mr Kristian Robinson and Ms Heidi Aston as speakers

Upcoming Events

Ella Cheong Spruson & Ferguson will be participating as an exhibitor

21 – 23 September 2005



Booth No.: 4E 3-7

NUS' Technology Commercialisation Forum 2005 In Conjunction with Global Entrepolis 2005

29 September 2005
Dr Michael Koch will be speaking on "Current Practice & Issues for Licensing in IT"

BioProcess International Asia Pacific

7 – 9 November 2005
Ms Heidi Aston will be speaking on "Patenting issues in the Biopharmaceutical Areas"

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We welcome your feedback and comments on our newsletter. For further questions on any intellectual property matters, please feel free to contact us or visit our website. This newsletter is for the general information of our clients. Its contents are not a complete statement of the law on any subject. Advice should be sought before any course of action is pursued.