

# IPO TENTIAL

## ASEAN INTELLECTUAL PROPERTY NEWS UPDATE



*Happy Eid al-Fitri*

To All Muslims Friends, Clients and Partners

May Eid al-Fitr bring  
abundant joy and  
happiness to you and  
your family. Eid  
Mubarak!



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Greetings from Pintas IP Group.

#### Selamat Hari Raya Aidilfitri

Pintas IP Group wishes you a joyous celebration and prosperous days ahead.

We are monitoring closely new directions from IP Offices in Asean countries.

As of 20 May 2020, most of the jurisdictions in Asean are extending deadlines in order to support applicants and their attorneys affected by the pandemic. Singapore and Indonesia are the two latest countries in Asean Countries to extend their IP filing deadlines. Details of the Official Deadlines Extension are summarized in the Appendix A enclosed.

In the interim, we are giving our best endeavors in ensuring operational continuity for your Asean IP needs through our customer service and e-services platforms, Pintas Digital Platform (e-commerce) and IP Hall Case Management System (management and monitoring module) accessible 24 hours every day.

Once again we thank you for your continued support in this uncertain time, our thoughts go out to those who have affected from this difficult time and we pray for your good health and well-being.

# COVID- 19 – Asean IP Office Updates

IPO	Situation on 20 May 2020
<b>Singapore (IPOS)</b>	Effective from 7 April 2020, the physical offices of IPOS will be closed, all filing deadlines are extended to 4 June 2020, inclusive of those required to respond between 7 April 2020 and 7 May 2020. This extended deadline also applies to cases under their Hearings and Mediation Department. All online services remain operational.
<b>Malaysia (MyIPO)</b>	In accordance with the Restriction of Movement Order announced by the Government, MyIPO implemented a temporary closure of operations at the head office and all other branches from the 18th of March until the 16 June 2020. Nonetheless, online registrations will continue to operate as usual, all timelines set for 1 April 2020 will be extended to 16 June 2020, subject to the Government's directive from time to time.
<b>Brunei (BruIPO)</b>	BruIPO has implemented proactive precautionary measures, the reception area will be temporarily closed and BruIPO will only accept documents, filing submissions and payments.
<b>Indonesia (DGIP)</b>	The Indonesian IP Office has suspended all physical services until the end of March, all E-Filing services are still in operation. All deadlines in March have also been postponed until April 21st, 2020 or until further notice.
<b>Philippines (IPOP HL)</b>	IPOP HL shifts to online-only services and has suspended manual filings* until further notice. *except for IPSOs
<b>Thailand (DIP)</b>	<p>DIP issued a notification allowing the submission of requests for extensions of time with valid reasons for extension, for filing applications and other submissions after the deadline has already passed. The extension request must be filed within 15 days of the COVID-19 event which prevented the initial submission.</p> <p>Thai IP Office urged the applicants to use e-filing system. However, it is reported that there are some difficulties using the e-filing system as it does not support some tasks.</p>
<b>Vietnam</b>	All procedures for registration of industrial property rights which are due in the period from 30 March 2020 to 30 April 2020 shall be automatically extended to 30 May 2020. All transactions between IP Viet and applicants will only be conducted via the postal service or through online filing system until further notice.
<b>Cambodia</b>	The Cambodian intellectual property offices remain open with limited capacity and has requested that all trademark agents to make use of the e-filing services. To date, there has been no official announcements regarding closures, extensions or other changes in practices.
<b>Laos</b>	All services remain operational.
<b>Myanmar</b>	All the Government departments are still operating, albeit the reduction of working staff in the relevant departments, deadlines and operation are as per usual.

# IP CASE UPDATE

## Emerico Uses Utility Innovation to protect market shares and profit margin.



Earlier this year, in *Emerico Sdn Bhd v Maxvigo Solution Sdn Bhd*, the High Court of Malaya ruled in favour of the Plaintiff (Emerico) in a patent infringement proceeding. Emerico, the owner of Utility Innovation (UI) No. MY-163605A for a utility innovation comprising of a protective sleeve carried out an action against the Defendant (Maxvigo) for infringement of the UI. Pintas IP Group assisted in the drafting of the UI and Mr John Hepworth, a patent attorney at Pintas, also acted as expert witness for Emerico in the legal proceeding.

In order to establish patent infringement under section 58 of the Patents Act 1983, it must be proven that the alleged infringing act falls within the scope of protection of the patent. In determining the scope of protection of the patent, the Malaysian courts have consistently adopted the purposive approach laid out in the House of Lords' decision in *Catnic Components Ltd v Hill & Smith Ltd*, and later reformulated by Mr Justice Hoffmann in *Improver Corporation v Remington Consumer Product Limited* as a series of three questions (hereinafter referred to as 'Improver's test') to establish whether the alleged infringing article infringes the claims of a patent, namely:-

- I. Does the variant have material effect upon the way the invention works? If no, then...
- II. Would this have been obvious to the skilled person as at the date of publication of the patent? If yes, then...
- III. Would the skilled person nevertheless have understood from the language of the claim that the patentee intended that strict compliance with the primary meaning was an essential requirement of the invention? If no, then infringement.

However, In 2018, the High Court of Malaya in *Kingtime International Ltd v Petrofac E&C Sdn Bhd* (Kingtime) applied for the first time the "doctrine of equivalents" also known as the 'Actavis test'. The test is a reformulation of the improver questions by the English Supreme Court in *Actavis UK Limited and others v Eli Lilly[2] and Company*, with the aim of widening the scope of protection afforded to patentees.

Emerico case embedded the notion that the doctrine of equivalence is applicable in patent and utility innovation infringement cases in Malaysia. In establishing whether the Defendant had infringed the UI, the Court applied the 'Actavis Questions' (the Test) of which both parties had to apply. Through application of the Test, and evaluation between arguments by both parties, it was found that although the defendant's product does not have a protective sleeve per se, but the electronic device sits in a protective recess which the Court viewed as a variant of a "protective sleeve". The infringing product also does not have a connector tab but the Court, relying on a disassembly demonstration, concluded that there is a male USB port connected to the infringing product which is an equivalent of a connector tab.

The two-fold Actavis Test are as follows:

- i. Does the variant infringe any of the claims as a matter of normal interpretation?
  - If yes, infringement. If no...
- ii. Does the variant nonetheless infringe because it varies from the invention in a way or ways which is or are immaterial?
  - If yes, infringement.

The Court found both of the questions to be yes, and as a consequence held that the Defendant's infringing product does in fact infringe the Plaintiff's UI and dismissed the Defendant's counterclaim.

Following the doctrine of equivalence, although the defendant's product does not have a protective sleeve per se, but the electronic device sits in a protective recess which the Court viewed as a variant of a "protective sleeve". The infringing product also does not have a connector tab but the Court, relying on a disassembly demonstration, concluded that there is a male USB port connected to the infringing product which is an equivalent of a connector tab. Thus the Court ruled in favour of the Plaintiff based on the application of the doctrine of equivalence.

Patent or Utility Innovation documents are technical-legal documents due to the nature of the information provided. The technical aspects of inventions are mentioned in the Patent/UI application for which the protection is sought and it is a legal document since it provides exclusive right by the government to the inventor and prevents use by others. In order to secure the Rights it is important on the part of inventor to decide what components are to be protected. This protection is sought based on claims. Claims define the boundaries of invention and provide legal protection. Thus, claims define the scope of subject matter. Claims drafting is one of the most important element of patent application. Claims drafting is an art as well as science because during the drafting it is important to ensure that the scope of protection is adequately mentioned and scientific knowledge of what is to be protected should be known.



# Two new initiatives by the USPTO to combat COVID-19 through IP

Highlighting the significance of utilizing intellectual property (IP) in the ongoing fight against COVID-19, the US Patent and Trademark Office (USPTO) launched two new initiatives to support COVID-19 innovations:

- 1) A COVID-19 Prioritized Examination Pilot Program, and
- 2) Patents 4 Partnership that provides a searchable forum to list COVID-19 related published applications and patents available for licensing

## COVID-19 Prioritized Examination Pilot Program

On the 8th of May 2020, the United States Patent and Trademark Office (USPTO) announced the 'COVID-19 Prioritized Examination Pilot Program', authorizing applications related to COVID-19 by small and micro entities to be put on a fast track for patent examination.

Under the program, the USPTO will grant requests for prioritized examination to patent applications that qualify for small or micro entity status without having to incur the typical charges associated with other prioritized examination. In addition, the USPTO will make efforts to reach final disposition of applications in the program within six months provided applicants respond promptly to communications from the USPTO.

The program will begin accepting requests for prioritized examination on the 13th of July 2020 and will end when the USPTO has accepted a total of 500 requests. The USPTO has full discretion to extend the pilot program (with or without modifications) or terminate it depending on the workload and resources needed to administer the program, feedback from the public, and the effectiveness of the program. Should the USPTO wish to extend or terminate the program, a notice will be provided to the public.

## Patents 4 Partnership

The second initiative announced by the USPTO is the "Patents 4 Partnerships" program which aims to bring together patent owners who want to make their technologies available for licensing and entities who have an interest in and the ability to commercialise these technologies. Such technologies include those which relate to the prevention, diagnosis, and treatment of COVID-19.

The program was said to potentially contribute towards battling the pandemic by helping to bring new products and technologies for the prevention, treatment and diagnosis of COVID-19 to the market place.

"Patents 4 Partnerships is a meeting place that enables patent owners who want to license their IP rights to connect with the individuals and businesses who can turn those rights into solutions for our health and wellbeing," said Andrei Iancu, Under Secretary of Commerce for Intellectual Property and Director of the USPTO. "With an initial focus on COVID-19, the platform shows how innovation can contribute to the nation's response to this critical health emergency."

Companies with the financial resources, manufacturing capacities, and ability to operate within a space outside of their traditional business models may take advantage of the opportunity the program provides to cross-collaborate and license innovative technologies that work towards the prevention, cure, and continued fight against the effects of COVID-19 on the United States and the rest of the world.



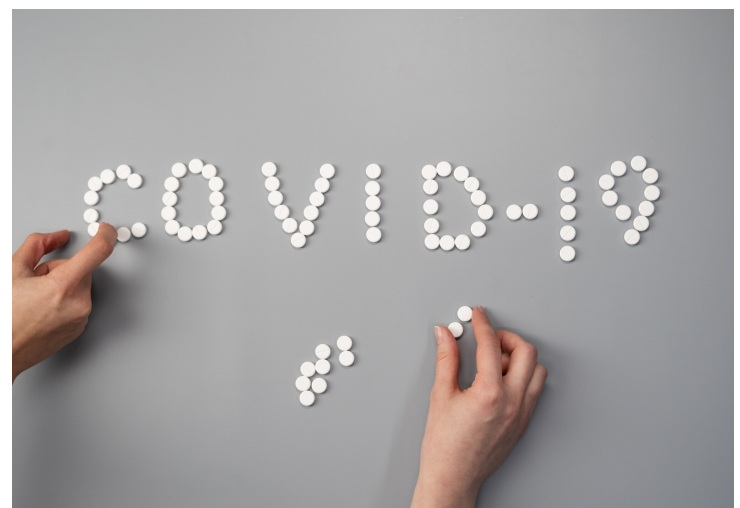
# WHO embraces COVID-19 Intellectual Property Pool

On the 15th of May 2020, in a means to combat the COVID-19 outbreak, the World Health Organization (WHO) announced progress on a technology platform that aims to lift access barriers to effective vaccines, medicines and other health products to fight against COVID-19. The idea was proposed by Costa Rican officials earlier in the outbreak, due to the increasing concerns that some COVID-19 medical products may not be accessible for poorer populations, and is now being backed up by several other countries.

By establishing a voluntary mechanism under the auspices of the WHO, the goal is to establish a pathway that will attract numerous governments, as well as industry, universities and non-profit organizations.

The function of the platform is to pool data, knowledge and intellectual property for existing or new COVID-19 health products to deliver 'global public goods' for all people and countries. Numerous companies will have access to the information required to produce the technologies through the open sharing of science and data, thus, scaling up availability worldwide lowering costs and increasing access.

The official launch of the platform will be on the 29th of May 2020, of which a Solidarity Call to Action will be published on WHO's website where governments, research and development funders, institutions and companies can express their support.



# Brexit and Intellectual Property

On the 31st of January 2020, the United Kingdom left the European Union, bringing an end to a 47 year membership and the institutions that preceded it. The transition period, which started on the 1st of February 2020, will end on the 31st of December 2020. During this time, EU law will continue to operate as usually in the UK. The relationship between the UK and the EU is predicted to undergo tremendous changes in the future. One of the important changes would be in regards to Intellectual Property (IP) which is fundamental to trade and innovation within and across borders.

In a 2016 study conducted by the European Union Intellectual Property Office (EUIPO) attributed 28% of jobs (60 million) in the EU to IP intensive industries. That accounts for 42% (€5.7 trillion) of total EU economic activity and 90% of EU trade with the rest of the world. The study further showed that, in Ireland, IP intensive industries accounted for 24% of employment and contributed to 53.8% of GDP.

## The Impact of Brexit on Intellectual Property

IP is territorial, such that IP rights only apply in the territories where the IP is registered or legally recognised. IP frameworks in the EU have gone through various attempts throughout the years to provide harmony across EU member states in order to grant companies predictable and efficient protection for their innovation throughout the economic area. Such as the EU Trade Mark (EU TM) and the Registered Community Design (RCD) of which are IP protections that apply across the whole EU territory via a single application, thereby reducing cost and administration. The impact of Brexit on several key IP protections will be discussed in turn:

### I. Trade marks (TM) & Registered Community Designs (RCD)

Throughout the transition period, the UK will continue to remain part of the EU TM and RCD system. EU TMs and RCDs will immediately and automatically be granted comparable rights in the UK.

Applications which are pending at the end of the transition date, however, will not be automatically granted equivalent rights. Businesses, organisations or individuals that have pending EU TM or RCD applications on the 1st of January 2021 will be able to apply to register for comparable UK rights within nine months from the said date.

### II. Unregistered Community Designs (UCD)

The UK will remain part of the EU UCD system throughout the transition period. This means that two- and three-dimensional designs which include, clothing designs and patterns that are disclosed in the UK or an EU Member State can be automatically protected in both territories as UCD. This right provides three years of protection from copying.

In accordance with the Withdrawal Agreement, UCDs arising before the 1st of January 2021 will continue to be protected in the UK for the remainder of their three-year term. Designs disclosed in the UK after the end of the transition period may be protected in the UK through the supplementary unregistered design, which will protect two- and three-dimensional designs for three years.

### III. Patents

Unlike the previously discussed IP protections, Patents will to a great extent continue as before Brexit even after the transition period ends. Applications for patents can be filed directly with the UK Intellectual Property Office (UKIPO) for or the European Patent Office (EPO), or can be made pursuant to an international patent application filed under the Patent Cooperation Treaty (PCT).

The EPO is an international organisation established on the basis of the European Patent Convention (EPC) and is independent of the EU with a current total of 38 member states, 28 of which are of the EU whilst 10 are not.

Furthermore, UK citizens and natural persons domiciled in the UK, as well as legal persons based in the UK (as governed by its national law) will still be able to file European patent applications. Under the EPC, anyone can file a patent application with the EPO, irrespective of nationality, residence or place of business.

The UK's status as a contracting state to the Agreement on the application of Article 65 of the Convention on the Grant of European Patents (London Agreement) will likewise remain unaffected by its withdrawal from the EU. Consequently, patent holders will remain exempt from filing any translations of European patents granted for the UK, after its withdrawal from the EU.

### IV. Copyright

A significant part of UK copyright law is derived from the EU copyright framework. As such, there are references in UK law to the EU, the European Economic Area (EEA), and member states. Several of these references occur in the UK's implementation of EU cross-border copyright arrangements. Such arrangements apply only within the EU and EEA and provide reciprocal protections and benefits between member states.

In addressing the issues, the UK Government introduced the Intellectual Property (Copyright and Related Rights) (Amendment) (EU Exit) Regulations 2019 (Intellectual Property (Copyright and Related Rights) (Amendment) (EU Exit) Regulations 2019) under the powers of the European Union (Withdrawal) Act 2018. These regulations remove or correct references to the EU, EEA, or member states in UK copyright legislation to preserve the effect of UK law where possible.

The reciprocal cross-border arrangements may be amended or brought to an end, depending on the negotiations during the transition period. The regulations are due to come into force on 1 January 2021.

Majority of UK copyright works (such as books, films and music) will continue to be protected in the EU and the UK because of the UK's participation in the international treaties on copyright. Similarly, EU copyright works will continue to be protected in the UK. This applies to works made before and after the end of the transition period.

### Conclusion

With the divorce of UK from the European Union, any UK legislation, which has until now been dependent on EU legislation, will have to be re-evaluated. Beyond this, the key development in the IP field is the likely exclusion of the UK from pan-European rights systems. Separation presents the opportunity for the UK's laws to diverge from those of Europe, and such separation may be embraced in some areas. However, in IP, this is unlikely to happen to any significant extent given the interconnection of trade and the universal recognition that harmonisation is beneficial.

As the exact impact of Brexit remains uncertain, the long term future is still difficult to evaluate. With that said, IP owners should identify which of their rights are now likely to be affected and may need further applications or registrations in order to achieve maximum protection over that right.



# UPCOMING EVENT

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