

# legalTAPS

AXCELASIA GROUP

KDN PP 13829/6/2007

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## Launch of IP Courts in Malaysia

*The Intellectual Property (IP) protection regime in Malaysia has received a boost with the official launch of the IP Courts on the 17th July 2007. There will be 21 IP courts set up in total. These comprise 15 Sessions Courts with criminal jurisdiction, with 1 in each state including Putrajaya, and 6 High Courts with civil and appellate jurisdictions which will be specifically established in 6 states in the country with the highest number of IP infringement cases – Kuala Lumpur, Selangor, Johor, Perak, Sabah and Sarawak. The Courts will handle cases under the Trade Description Act 1972, Patents Act 1983, Copyright Act 1987 and Optical Disc Act 2000, amongst others.*

The new Kuala Lumpur IP High Court has already been designated (the former Commercial Court 5) and the Kuala Lumpur Sessions Court which was specifically designated as a test IP Court since 1st January 2006 continues to hear criminal IP cases. All new cases filed on or after the launch date will be heard in the newly designated IP Courts. Meanwhile, the IP Court system is scheduled to be introduced in Selangor by the end of the year or early next year, followed by Johor, Perak, Sabah and Sarawak.

Previously, IP cases were heard by judges who handled a variety of civil and/or criminal cases, particularly in courts outside of Klang valley. This resulted in delays in the disposal of IP cases as priority was not given to IP infringement cases or offences. Furthermore, judges who do not hear IP cases on a regular basis are unable to gain expertise in the area, which could be highly complex both legally and technically. This inevitably led to delays and a massive backlog of cases, both criminal and civil. IP infringement

matters are unique in that delayed enforcement negate the rights of IP owners and the damage suffered by the owners is often irreparable, such as loss of goodwill. As a result of the compromise on the effectiveness of IP enforcement actions in the country, Malaysia continues to be maintained on the international watch list of countries with a high number of IP offences.

At the national level, it is hoped that the step towards greater and speedier protection of IP rights would ensure a steady social and economic growth and development of creativity and innovation. It is also hoped that with the setting up of the IP courts, Malaysia will realize its aim to being removed from the international watch list for intellectual property infringement.

The establishment of the IP Courts underscores Malaysia's continued commitment to promote and protect IP rights and in fulfilling its international IP obligations. The Prime Minister, Datuk Seri Abdullah Ahmad Badawi had earlier announced in April this year the setting up of a RM5 billion fund for protection of IP and a part of the fund would be used for the setting up of IP courts to allow cases to be disposed of quickly. The establishment of specialized IP Courts will hopefully provide a responsive platform for IP owners to protect their interests in Malaysia.



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## Contents

- 1 [Launch of IP Courts in Malaysia](#)  
*by Choy Sook Yee*
- 2 [IP Updates - Recent Amendments to Malaysian IP Laws](#)  
*by Julia Low*
- 3 [Interpreting the recent amendment to the Housing Development \(Control & Licensing\) Act](#)  
*by Looi Yen Li*
- 5 [Disclaiming Your Rights Away?](#)  
*by Julia Low*
- 8 [Commentary on New Approval Timeframes for MGO Exemptions](#)  
*by Genevieve Lau*
- 9 [A Case of Traditionalism versus Commercial Realism: Review of Walton International Ltd v Yong Teng Hing B/S Hong Kong Trading Co & Anor](#)  
*by Sia Teng Teng & Su Siew Ling*
- 12 [An Employment Law Perspective: Sexual Harassment In The Workplace](#)  
*by pupils in chambers*
- 14 [The Malaysian Biosafety Bill 2006](#)  
*by Tepee Phuah*
- 15 [Effect of Delay in Registering Foreign Judgments in Singapore](#)  
*by Christopher Buay*

# IP Updates - Recent Amendments to Malaysian IP Laws



The new TRADE MARKS (AMENDMENT) REGULATIONS 2007 came into force on 11 July 2007.

The only amendment made was to the Third Schedule of the Regulations, in relation to classification of goods and services. Previously the classes of goods and services from Classes 1 to 45 were listed in Schedule 3, in accordance with the Nice Classifications.

With the current 2007 amendment to the Third Schedule, the classes of goods and services are no longer listed. In its place, reference is made to the International Classifications pursuant to the Nice Agreement and Vienna Agreement including any amendments made to them from time to time.

In brief, the Nice Classification is based on a multilateral treaty administered by the World Intellectual Property Organization (WIPO). This treaty is called the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks, which was concluded in 1957. The Classifications are continuously revised and a new edition is published every five years. It comprises about 10,000 indications referring to goods and 1,000 indications referring to services.

The Vienna Classification is also based on a multilateral treaty administered by WIPO and the treaty is called the Vienna Agreement Establishing an International Classification of the Figurative Elements of Marks, which was concluded in 1973 and entered into force in 1985. The classification comprises a total of 29 categories, 144 divisions and 1,887 sections in which the figurative elements of marks are classified.

Malaysia was neither a signatory to the Nice Agreement nor to the Vienna Agreement, but the Malaysian Trade Mark Registry has adopted these international classifications as guidelines for a long time, pursuant to **Regulation 5, Subregulation 17(2) and 18(2)** of the **Trade Mark Regulations 1997**.

When the new 9th Edition of the Nice Classifications came into effect in January 1, 2007, there were uncertainties whether the Malaysian Trade Mark Registry would adhere to the new

classifications. These concerns needed to be addressed as specification of the accurate class for a particular trade mark would affect the scope of protection and rights of the trade mark proprietor. A notable amendment in the 9th Edition includes the removal of the specification "legal services" from Class 42 and the inclusion of the same into Class 45.

Currently the 5th Edition of the Vienna Classification has been in force since January 1, 2003, and is expected to be replaced by the 6th Edition on January 1, 2008.

*With the new amendment, the Trade Mark Registry would therefore automatically adopt every new edition of the Nice and Vienna Classifications, as and when they enter into force. This amendment is applauded as it brings Malaysia in line with the trade mark practice of many foreign countries, so as to streamline the trade mark application process in Malaysia.*

For more information on the Nice and Vienna Classifications, please visit [www.wipo.int](http://www.wipo.int) or contact Tay & Partners.



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# Interpreting the recent amendment to the Housing Development (Control & Licensing) Act

On 12 April 2007, the existing Housing Development (Control & Licensing) Act 1966 (“the Act”) was amended by the Housing Development (Control & Licensing) Amendment Act 2007 (“the 2007 Amendment”). Amongst the amendments to the Act, was the introduction of the new section 22D.

## The Scope Of Section 22d

S22D subsection (9) states that “this section shall apply to any *housing accommodation* where *separate or strata title for the housing accommodation has not been issued* by the appropriate authority”. Clearly, this section will not apply to commercial properties, such as office and retail parcels, nor will it apply in cases where the separate or strata title has been issued.

Furthermore, the definition of “housing accommodation” has been amended to include residential units erected on land designated or approved for commercial development. This will cover service apartments erected on top of shopping centres or malls and also such apartments partly intended for human habitation and partly for use as a business premise.

Prior to the 2007 Amendment, the definition of “housing development” meant “the sale of more than 4 units of housing lots by the landowner or nominee with the view of constructing more than 4 units of housing accommodation *by the said landowner or his nominee*”. In the 2007 Amendment, the words “by the said landowner or his nominee” are deleted. As such, with this amendment, the sale of “bungalow plots”, whereby the purchaser, and not the developer, is to construct a “housing accommodation” on the said plot, now falls under the Act.

As property developers have been quick to innovate new types of residences, which may not fall strictly under the definition of “housing accommodation” under the Act, section 3A of the 2007 Amendment confers upon the Minister the power to “prescribe any type of accommodation to be housing accommodation” from time to time. The intention of this amendment is to give the Minister greater discretionary power to amend the definition of “housing accommodation”.

## The Developer’s Consent To Assignment Is No Longer Required

S22D subsection (1) dispenses with the developer’s consent to absolute assignments of the housing accommodation.



Previously, it was the duty of the assignor (i.e. the current owner) to obtain the consent of the developer as a condition precedent to the sale or assignment. There were many complaints by both lawyers and their clients of the delay on the developer’s part to respond to such applications and also the imposition of stringent terms and conditions, including payment of the RM500-00 administrative charge for the consent as well as the developer’s lawyer’s legal fees for processing the consent.

*Now, instead of seeking the developer’s consent, the assignor will be required to give the developer notice of the assignment at or after completion of the sale and purchase between the assignor and the assignee by delivering to the developer: (1) a stamped copy of the sale and purchase agreement (if applicable); (2) a copy of the duly executed deed of assignment, with a letter of undertaking from the assignee or the assignee’s financier to deliver a duly stamped copy of the deed of assignment within fourteen (14) days after the same has been stamped; and (3) full payment of all sums and outgoings due to the housing developer.*

In addition to sales and purchases, the Act is also relevant to assignments to beneficiaries of an estate, assignments without consideration and financing of housing accommodation that are without separate or strata titles. The 2007 Amendment also applies to the reassignment of properties upon full settlement of loans.



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### Practical Implications

Obtaining the developer's consent is akin to conducting a title search on a property with a title deed, as the developer's letter of consent, usually conditional, will confirm the particulars of the owner and if the property has been assigned to any bank/financial institution. However, in cases where the property has a title deed, such searches are normally done at the purchasers cost. Prior to the 2007 Amendment, it was the vendor or his solicitor who had to obtain the consent and bear the related charges. With the 2007 Amendment, the purchaser or his solicitor may request from the housing developer a "confirmation of the records in the register" subject to a payment of a fee not exceeding RM50-00. The type of particulars that are to be furnished by the developer in such a confirmation are set out at S22D(4). As with properties with separate title deeds, it should now become the norm for the purchaser's solicitors to obtain this confirmation prior to execution of the sale and purchase agreement and another after delivery of the notice under S22D(2) to confirm that the new purchasers have been properly recorded by the developer as the owner of the property.

The obligation of the vendor to ensure that all outgoings due to the developer are paid up to the date of completion remains. However, it also now the duty of the vendor or his solicitors to give the notice in accordance with S22D(2) to the developer upon completion. In light of this, it would be prudent for the release of the balance purchase price to the vendor to be conditional upon fulfilment of this obligation. Indeed, some banks have already made the release of the loan conditional upon proof that the vendor has given the aforementioned notice to the developer or has authorised his/the purchasers solicitor to do so on his behalf.

*To date, the relevant sections of Schedules G and H of the Housing Development (Control and Licensing) Regulations 1989 ("the Regulations") pertaining to the requirement of the developer's consent to subsequent assignments, have yet to be amended to be in line with the 2007 Amendment. Nevertheless, the penal sanctions imposed on against developers requiring consent to assignments against the provisions of the 2007 Amendment, should prevent any unreasonable enforcement of the existing contradictory provisions in the aforementioned Schedules G and H.*

It has been the practice for some lawyers to obtain the developer's undertaking to deliver the strata title and a valid and registrable instrument of transfer for subsequent assignments. However, even before and especially after the 2007 Amendment, it is clear that such an undertaking is not necessary. The reason behind this is that the principal sale and purchase agreement from the developer would be in the form provided for in Schedules G and H of the Regulations, which already contains a clause to this effect. As all assignments thereafter would assign all rights and interests from the aforementioned principal sale and purchase agreement, it would not be necessary to repeat this in a separate letter for subsequent assignments.

### The Transitional Period

As with all change, there will be a period of adjustment for developers, purchasers, banks and their lawyers and it is during this time that all parties will have to devise a new and efficient procedural precedent for perfecting future assignments in accordance with the 2007 Amendment.



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# Disclaiming Your Rights Away?

## The Lemon Drop Kid



Suppose the 3 fictional trade marks above are being presented to the Trade Mark Registry by proprietors who want to secure Shoe World and globe device for “footwear”; The Lemon Drop Kid for “Lemon drops being non-medicated sweets” and The Cake People and Device for “cakes and confectionary”. The proprietors of the 3 marks above may be disappointed to find that the marks above are not registrable *per se*.

It is unlikely that the above 3 trade marks would be allowed registration in the manner represented by the proprietors as the words “Shoe, Lemon Drop and Cake People” are clearly descriptive of the goods applied for. However, all is not lost for the proprietors of the above 3 marks as the marks would not be denied registration outright. The Registrar would in these cases impose a disclaimer (as discussed below) on the marks as a prerequisite to allowing the marks to proceed to registration.

The Registrar in each trade mark application assumes the task of balancing the scope of monopoly given upon registration to the above words and devices as represented by the proprietors against the need and desire of other traders in the same class to register their goods using the same words / phrase.

Further, the Registry undertakes the task of deciding the inherent registrability of the mark, which includes consideration whether the mark is deemed capable of distinguishing the proprietor’s goods from the goods of other traders. It is settled law that a mark which is inherently non-distinctive will not be allowed registration even with an inclusion of a disclaimer (**Ford-Werke AG’s Application [1955] 72 RPC 191**). In this case it would appear that the Shoe World and The Cake People mark, both bearing devices, would be distinctive and distinguishable. It is arguable that the Lemon Drop Kid mark when viewed as a whole is capable of distinguishing the goods claimed.

Where the mark consists of words that are common to the trade, where it is anticipated that other traders would want to use the same word upon their own goods and services, the word in

question cannot then be monopolized. Imposition of a disclaimer disclaiming exclusive use of the common word from the trade mark is the usual request by the Registrar. The proprietor still retains the right to use the common word (e.g. The Cake People and fork device used together is acceptable, but the proprietor does not own exclusive right over the words “The Cake People” unless when used together with the other elements of the mark).

**Section 18 of the Malaysian Trade Marks Act 1976 empowers the Registrar with the discretion to require a proprietor to disclaim any right to the exclusive use of any part of the trade mark. In almost all instances, the reason for an imposition of a disclaimer is when the trade mark contains any part which is common to the trade or is not distinctive (Section 18(c)).**

In the three examples above, the words “Shoe”, “Lemon Drop” and “The Cake People” are not distinctive descriptions and thus cannot be monopolised to function as indicators of origin. A disclaimer would thus free them to be used by any other trader.

However, a disclaimer cannot be imposed just because a word in the trade mark is not distinctive. A direct reference to the character and quality of the goods, for example a laudatory epithet is *prima facie* unregistrable and the inclusion of a disclaimer in this case would be superfluous. There is no hard and fast rule as to whether to disclaim exclusive use or otherwise of a word or element in a trade mark and very often, it is a subjective exercise by the Registrar as to finding words which are inherently non-distinctive (bearing direct reference to the character or quality of the products) or that it falls on the other side of the fine line, being a word containing merely a covert and skilful allusion to the products.



Although it is settled law following the **Solio** case ([1898] 15 RPC 476) that trade marks do not necessarily have to be meaningless and may contain a covert and skilful allusion to the character and quality of the goods, the overriding consideration remains whether the alluded word in question would be required for use by others. If the above is satisfied, and where a direct description is objected to and disallowed on the ground of non-distinctiveness, the next recourse would be to decide whether an imposition of a disclaimer may save the mark.

*The manner of phrasing the disclaimer and also the prominence of the element to be disclaimed also plays an important role, so as to avoid riding on disclaimers as a back-door route to registering marks which are not registrable under the law.*

For example in the Shoe World mark above, the word Shoe is a prominent feature. As the proprietor intends to use the mark for footwear, the Registrar may require that the mark be modified to reduce the size of the words “Shoe World” in addition to a disclaimer on the word “Shoe” except in the manner represented in the mark, failing which, the trade mark may be refused registration.

A disclaimer on the words “The Cake People” would be sufficient to enable the mark to proceed for registration since it is the fork device that would leave a strong impression on the minds of people rather than the tagline which is in smaller print.

Similarly, “Lemon Drop” in “The Lemon Drop Kid” must be disclaimed so that the proprietor does not unfairly gain exclusive rights to use the common words Lemon Drop.

Case law such as the Ford-Werke case mentioned earlier have been referred to in Malaysia for the valuable guidelines that were established, and in particular adoption of the four rules of practice of the UK Trade Marks Registry as to whether a disclaimer should be imposed on certain types of letter marks. The UK Trade Marks Registry has discontinued the practice of imposing disclaimers for a number of years now, and generally in countries where the practice has been discontinued, there is treatment of “silent disclaimer” to words or features of a mark which are non-distinctive and it is accepted that such words or features will not be protected on their own or monopolized by any one party.

Undeniably the presence of a disclaimer (express or silent) plays an important part in defining a proprietor’s rights, especially when a trade mark is being challenged. In the recent case of **Bata Ltd v Sim Ah Ba [2006] 3 CLJ 393**, Bata Ltd sought to expunge and remove the “Power” mark owned by Sim Ah Ba.



Bata’s mark was the earlier registration, being registered since 1971. Sim Ah Ba’s mark was subsequently filed in 1988. The Court of Appeal took the view that the presence of the disclaimer on both parties’ trade marks which reads ‘registration of this mark shall give no right to the exclusive use of the word “Power”’ weakens Bata’s claim to exclusivity.

*Bata argued that although none of the parties have monopoly over the word “Power”, the word only forms one of the features of the mark, and when taken together as a whole, the mark is distinguishable of the goods of Bata. This argument was not accepted by their Lordships, who took the view that the proposition by Bata, which to a certain extent nullifies the effect of a disclaimer, was an exception and not the general rule.*

Their Lordships took the position that close scrutiny must be made of the features of Bata’s mark. “Power” was opined to be the prominent feature of the mark and the device of the arrow only plays a secondary role which enhances the mark. As such, their Lordships decided that Bata’s mark would not be distinctive but for the presence of the “Power” word and therefore, Bata relies on the word “Power” to distinguish their goods.

Their Lordships were correct in stating that the word “Power” is not an invented word but a generic and common word. However, it is not a corollary in trade mark law that a common word may not become distinctive and function as a source identifier. “Power” is arguably distinctive as it is not a common word used to describe shoes, boots and parts thereof, slippers and sandals, which are the goods applied for by Bata. It may have laudatory connotations but any reference to the character or quality of the products registered is arguably indirect. The disclaimer ought not to have been imposed or if there had been justification for its initial imposition, that may no longer exist. Unfortunately, the propriety of the disclaimer was not challenged by Bata. It is possible for a registered proprietor to apply to the Registrar or the court to remove a condition for registration if the basis for the imposition of the condition no longer exists. In the case, as there has been extensive use of the mark, even a common word would

have become distinctive over time by virtue of use. Being a non-invented word per se should not be the basis for the imposition of a disclaimer, as due consideration should be given as to whether the word would ordinarily be required for use by other traders.

*Was the approach adopted by the Court of Appeal in placing such importance to the presence of the disclaimer to the word "Power" correct, when considering whether the later registration should be expunged in light of the earlier registered mark? After all, the public or consumers are not aware of any disclaimed right, and the ultimate test should be whether they would be misled by the presence of another similar mark. This must be the overriding test in considering whether a later mark should be registered in the face of an earlier conflicting mark.*

Reliance on the disclaimer per se to limit Bata's rights and allow Sim Ah Ba's registration would not be the proper approach. Disclaimers would play a major role in the case of trade mark infringement (which Bata would not be able to commence against Sim Ah Ba in any event as its registration did not extend to socks) as the registered proprietor's rights, and the extent of such rights, are at the heart of the matter. The distinction may not have been adequately addressed in the case.

However, the Court of Appeal did give prime consideration as to whether Sim Ah Ba's mark was confusingly similar to Bata's mark. Their Lordships took the view that there is no confusion between the two marks and held that the idea of a mark is influenced by the trade channels through which the respective



parties' products are sold. Sim Ah Ba's registration was in respect of socks and are sold. Sim Ah Ba's registration was in respect of socks and underwear whilst Bata's registration was principally in respect of footwear. Based on the evidence adduced, Bata's products were sold only in its own or franchised outlets. The court's findings were constrained by the evidence presented before it and one gets the feeling when reading the judgment that evidence in favour of Bata's case may have been thin or wanting as Bata's products are ubiquitous in the country. Based on the material differences in the design of the two marks and the trade channels,

the court held that there will be little likelihood of confusion.

*Another important point to note is that the Court placed great reliance on and importance to the Registrar's decision at the examination stage of Sim Ah Ba's application. It appears that at the examination stage, Bata's mark was cited by the Registrar in objection but Sim Ah Ba succeeded in persuading the Registrar that deception and confusion would not arise. The court held that the decision of the Registrar bore substantial weight. Thus, the examination stage of every trade mark should be taken seriously, particularly in cases involving cited marks.*

It would appear to follow from the reasoning of the Court that Bata's registration is basically a registration on paper without much bite, since the arrow device on its own is not regarded as distinctive and the disclaimed word "Power" is too prominent to be considered a secondary feature.

The practice of disclaimer, as shown in the Bata case, is not without its difficulties, especially issues touching on whether a disclaimer ought to have been imposed and the legal effect of a disclaimer in considering registration of a subsequent mark. Many Registries in other countries have dispensed with the practice. However, the tradition of imposing disclaimers is very much alive at the Trade Marks Registry in Malaysia and the Bata case serves a useful reminder that it is a condition of registration that has serious ramifications.



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# Commentary on New Approval Timeframes for MGO Exemptions



On 20 March 2007, the Securities Commission (the “SC”) announced that more than 60% of applications for exemptions from having to undertake mandatory offers will now be approved within one working day. The SC said that this new timeframe for approval would come into effect immediately. Previously, such approvals took 21 working days.

Under section 33B of the Securities Commission Act 1993 (the “SCA”) and the Malaysian Code on Takeovers and Mergers 1998 (the “Code”), where a person has acquired more than 33% but less than 50% of the voting shares in a company and that person acquires more than 2% of such shares within 6 months, that person must make a general takeover offer to all the shareholders of the company. However, under section 33C of the SCA, the SC has the authority to grant certain exemptions to this rule.

In this case, the shorter approval timeframe applies to applications for exemption from having to undertake mandatory offers in the following circumstances:

- i) under Practice Note 2.9.1 of the Code, for the issuance of new securities for, amongst others, purchase of assets or subscription of new shares for cash;
- ii) under Practice Note 2.9.8 of the Code, where the person intends to compulsorily acquire the remaining shares of a company pursuant to section 180 of the Companies Act 1965; or
- iii) under Practice Note 2.9.10 of the Code, in circumstances where a holder of voting shares who, as a result of a reduction of the voting shares of the company through a buy back scheme under the Companies Act 1965, has increased his holding of voting shares to more than 33% or, if his existing holding of voting shares is more than 33% but less than 50%, by more than 2% in any 6 month period, will be exempted if the increase in his holding is inadvertent and as a result of any action that is outside his direct participation.

The SC has said that these measures are being implemented in response to the growth and continued sophistication of the Malaysian capital market which is best served by minimising regulatory friction to enable market intermediaries to respond quickly to changing market demands.

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***This announcement will surely be welcomed by various participants in the Malaysian capital market. However, it remains to be seen whether the SC can achieve this ambitious timeframe for approval in practice with its existing manpower. If it does, this would undoubtedly help to encourage the exercises which are covered by this new timeframe.***

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This announcement is just one of the initiatives taken by the SC to improve its performance. In all cases, the demand in the participation in the Malaysian capital market is escalating and SC’s initiatives to expedite timeframe approvals and also for other regulatory matters is essential.



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## A Case of Traditionalism versus Commercial Realism: Review of Walton International Ltd v Yong Teng Hing B/S Hong Kong Trading Co & Anor

### Introduction

In a recent decision in the case of Walton International Ltd v Yong Teng Hing t/a Hong Kong Trading Co [2007] 3 CLJ 253, the High Court gave its judgment upholding the decision of the Registrar of Trade Marks in favour of the applicant of the GIORDANO trade mark in class 9, Yong Teng Hing (“HK Trading”). The case was an appeal made by the appellant, Walton International Ltd (“Walton”) against the decision of the Registrar of Trade Marks, Malaysia (“the Registrar”) for dismissing their Notice of Opposition filed against the 1st respondent’s, HK Trading application to register the trade mark “GIORDANO” for optical and sun glasses in Class 9.

### Background

Walton is the registered proprietor of the GIORDANO trade mark in Malaysia in respect of articles of clothing, footwear and headgear in Class 25 a Walton is also the common law owner and has applied for the registration of various other trade marks such as GIORDANO LADIES, GIORDANO KIDS & Device and “GIORDANO – World without Strangers” for garments, wearing apparel, articles of clothing, jeans, T-shirts, pouch, accessories, footwear and headgear in Class 25 and products in classes 3 and 18 comprising of soaps, deodorants, leather and imitations of leather.



The trade mark GIORDANO is also pending registration in respect of leather and imitations of leather and goods made of these materials in class 18 Apart from the above registrations and applications made in Malaysia, Walton is also the registered proprietor and applicant of the mark for the above goods in many other countries around the world.

HK Trading, on the other, is a sole proprietor who had ventured into the business of selling watches with leather and imitation leather straps in 1986. HK Trading applied for registration of the GIORDANO mark in Class 9 for optical and sun glasses which application was filed in 1992. The application was accepted and advertised in 1995. Following the gazette notification, Walton proceeded to file a notice of opposition to oppose the application. Walton did not lodge any application in class 9 for its GIORDANO trade mark.

Walton’s ground of opposition includes the contention that HK Trading cannot in law and in fact be the bona fide proprietor of the mark GIORDANO since Walton has used, and continues to use the trade mark GIORDANO since shortly after the mark was created in 1985. Walton also argues that HK Trading should not have been allowed to register the mark because:

1. Walton is the true owner of the GIORDANO mark.
  - a. The GIORDANO mark originates from Hong Kong Giordano Limited – an associate company of Walton in which both Hong Kong Giordano Limited and Walton are owned by Giordano Holdings Hong Kong.
2. By copying Walton’s GIORDANO mark, HK Trading has misappropriated the reputation, goodwill and commercial advantage of the Walton’s GIORDANO mark.
  - a. Goods bearing the GIORDANO mark including articles of clothing, bags, umbrellas and other accessories have been extensively advertised and promoted in Malaysian newspapers, magazines and television commercials.

HK Trading responded that they had prior use of the GIORDANO mark in respect of goods in Class 9 in Malaysia as he had begun selling optical and sun glasses since 1992. The main contention is that the first person to use the mark in the particular class should be the proprietor of the mark.

### Decision of the Court

The High Court upheld the decision made by the Registrar of Trade Marks in dismissing Walton’s opposition to HK Trading’s application to register the GIORDANO mark under Class 9.

His Lordship, Raus J, now presiding at the Court of Appeal based

his decision on the following grounds:

1. HK Trading was the first person who used the GIORDANO mark in Class 9 in Malaysia.
2. Walton had not adduced any evidence to show that it has in fact sold goods bearing the said mark in Class 9 in Malaysia:
  - a. *Prior to HK Trading's trade mark application or*
  - b. *After HK Trading's trade mark application*
3. Walton's reputation and goodwill only extended to goods in Class 25 for clothing footwear and headgear. As such, his lordship considered there was no element of confusion or deception arising as the goods did not compete in the same market in the course of trade.
4. Walton had not filed for any appeal against the decision of the registrar to dismiss its opposition application for the registration of the GIORDANO mark for goods in Class 14 in Malaysia.

### Analysis of Issues

The decision to allow HK Trading's registration of the GIORDANO mark to remain on the register under Class 9 strictly on a "first come first serve" approach appears to encourage unscrupulous traders to cash in on the goodwill and reputation of well known brand names by registering first in any class of goods which the well known brand names have not already registered in or do not intend to. However, in the present case, on the finding of fact, the court held that there was use by HK Trading, as opposed to mere bad faith registration. The decision must be seen in the context of our trade mark law as of 1995, where the concept of well-known trade marks was still alien.

The current Trade Marks Act 1976, as amended on 1.8.2001, incorporates well-known trade marks as defined in accordance with the principles set out in Article 6 bis of the Paris Convention and Article 16 of the TRIPs Agreement, so as to raise a bar to registration marks which are identical with or resemble a trade mark well-known in Malaysia.

*The protection of well-known trade marks extends to goods or services not the same as those sought in the application provided that use of the mark in relation to those goods would indicate a connection between the goods and those of the owner of the well-known trade mark and that the interests of the proprietor of the well known mark are likely to be damaged by such use. A connection in this context may be indicated without the need for the goods to be competing in the same market. This is a well-established principle in the common law action for passing off where similar fields of activity between the parties need not necessarily be present in order for the requisite misrepresentation and deception to be established.*



Even under the passing off concept, the English courts have long accepted the broader notion of misrepresentation, likelihood of confusion and deception through false association where the products are not directly competing with each other or where the businesses are not necessarily allied. This approach has been similarly adopted by the Malaysian courts.

On the facts of the case, the court took a very narrow approach that since the goods are not competing in the same market, there could be no confusion. Other than the approach being inconsistent with the common law principles of passing off, it is also no longer viable in today's commercial environment where brand and line extension practices and licensing are common forms of exploitation of trade marks. It could very well be that the issues were not fully canvassed and explored by the parties such that a decision based on a more wholesome and contemporary approach was not possible before his lordship. The case may have been decided differently if the broader approach to issues of confusion was argued or adopted, and even today, it may not be necessary to go to the extent of proving GIORDANO as a mark that is well-known in Malaysia.

If such an opposition were to be commenced today, the Registry's approach will most likely be different given the change in legislative landscape and commercial realism that should weigh in the decision on issues concerning likelihood of confusion. The argument that a consumer may be misled or deceived into thinking that optical products and sunglasses bearing the GIORDANO trade mark has the same source of origin or is related to products such as clothing bearing an identical trade mark is not far-fetched and absolutely normal by today's commercial standards. It is commonly known that fashion houses making clothing have expanded their product lines to encompass optical wear.

Basically, the defendants had relied on cases such as *inter alia* *Lim Yew Sing v Hummel International Sports & Leisure A/S* [1996] MLJ, otherwise known as the "Hummel" case and other English cases such as *The Seven Up Co v OT Ltd* [1947] 75 CLR 211 and

Aston v Hartee Manufacturing Co [1960] 3 CLR 391.

In the Hummel case, registration of the trade mark by the appellant was allowed in Malaysia because the “Hummel” mark had not been recognized or used in Malaysia at all. As a result of which the respondent was found to have had no goodwill in Malaysia although he was the registered proprietor of the “Hummel” mark in 55 countries since 1983.

The decision was based on the fact there was nothing unlawful under the Trade Marks Act 1976 for a Malaysian trader to become the registered proprietor of a foreign mark used for similar foreign goods provided that foreign mark has not been used at all in Malaysia. This was similarly the case for the other cases cited by the defendants.

In contrast, the brand name GIORDANO has been present in Malaysia since the 1990s and has been extensively advertised and, promoted in newspapers, magazines and commercials. Thus, it can hardly be said that the GIORDANO mark is not recognizable as its use of the mark has been extensively promoted. The facts of the GIORDANO case are clearly distinguishable from that of the Hummel case.

The facts of this case is rather similar to that of Walton’s. The plaintiffs had been using the “TAMIN” mark for a significant period of time in relation to soya sauce and mainly food products. The defendants on the other hand claimed that they had been using the mark since 1991 and were in fact the first in time to use “TAMIN” in relation to syrups, cordials and flavourings. By virtue of their first use of “TAMIN” in relation to syrups and cordials, the mark was claimed to be distinctive of them.

In reaching his decision, Justice Ramly Ali opined that the use of the defendants of the “TAMIN” mark had resulted in confusion and deception resulting in damage to the goodwill and reputation of the plaintiffs.

*More importantly, his Lordship made an important observation that even if he were to accept the defendants contention that they had in fact introduced their “TAMIN” syrup in 1990 and that at the time of introduction, the plaintiffs had not used the “TAMIN” mark in relation to the syrups, the defendants would still not necessarily have the rights to the “TAMIN” trade mark in Malaysia when used in relation to syrups, drinks and cordials. His Lordship based his reasoning on the concept of misrepresentation not being dependant on whether the goods traded in are the same or that they needed to be a common field of activity. The main issue for contention was whether confusion and deception would arise out of the usage of the mark by the defendants.*

His Lordship cited a few English cases with approval.

In the case of Harrods v Harrodian School (196) RFC 697, Millet LH was of the view that there is no requirement that the defendant should be carrying on a business which competes with that of the plaintiff nor which would compete with any natural extension of the plaintiffs’ business. His Lordship was of the view that the absence of a common field of activity would not be fatal. More importantly, in deciding whether there was a likelihood of confusion or not, the question that should be posed is whether there would be any kind of association or in the minds of the public any kind of association between the fields of activities of the plaintiff and the fields of activities of the defendants. This approach mirrors Russell LJ’s in the Court of Appeal decision of Annabel’s v Schock (1972) RFC 838. Likewise, it was held in the case of Lego System A/S v Lego M Lemelstrich Ltd (1983) FSR 155 that the proximity of the defendant’s activity to that of the plaintiff was a factor to be taken into account when deciding on whether the defendant’s conduct would cause confusion.

The “TAMIN” case illustrates the broad approach that should be taken in ensuring that famous marks would not be so easily marked for infringement. Walton International Ltd v Yong Teng Hing B/S & Anors on the other, serves as a reminder that if a more traditionalistic approach would be taken in future trade mark infringement cases, famous brand names would need to rethink their strategy when branding and classifying their products in ensuring that mark is well protected.



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# AN EMPLOYMENT LAW PERSPECTIVE: SEXUAL HARASSMENT IN THE WORKPLACE

## THE DEFINITION OF SEXUAL HARASSMENT & CODE OF PRACTICE ON THE PREVENTION AND ERADICATION OF SEXUAL HARASSMENT IN THE WORKPLACE

Sexual harassment may arise in two forms namely sexual coercion and sexual annoyance. The difference between these forms of sexual harassment is that the former would directly affect employment while, the latter would indirectly affect the employment. Sexual harassment which directly affects the employment is categorized as sexual coercion. Sexual coercion exists in situation where the harasser insist on sexual favours in exchange of benefits he can dispense because of his position in the company's hierarchy for instance, getting or keeping a job, favourable comments, recommendation, promotions and other types of opportunities. Meanwhile, the other type of sexual harassment is known as sexual annoyance. Sexual annoyance is a sexually related conduct that is offensive, hostile or intimidating to the recipient but has no direct link to the employment. Both forms of sexual harassment can either be physical, verbal or even depicted visually without actual physical contact.

Sexual harassment in the workplace is a serious offence that violates a person's dignity, creating an intimidating and offensive environment, not only limited to the affected parties, but potentially to others who may witness or be aware of such harassment. Sexual harassment in the workplace includes unwelcome attention of sexualized professional relationship subjected to those of lower positions in the company's hierarchy which is made as a requirement towards their employment which would subsequently create an offensive and threatening working environment.

*In viewing that this social disease is becoming more rampant and serious, the government together with the employers (companies), trade union and various women organizations have taken measures to eradicate the spread of such disease. As a result, in August 1999, the Code of Practice on the Prevention and Eradication of Sexual Harassment in the Workplace (the Code) was successfully launched by the then Minister of Human Resources Dato' Lim Ah Lek. The Code operates as a guideline to the relevant parties on the protection of the dignity of men and women at work with the aim of ensuring sexual harassment does not occur and, if it does occur, adequate procedures are available in dealing with the problem and prevent its recurrence.*

## HOW WOULD THE CODE OF PRACTICE ON THE PREVENTION AND ERADICATION OF SEXUAL HARASSMENT IN THE WORKPLACE BENEFIT THE EMPLOYERS

Contrary to popular belief that the introduction of the Code would only benefit the employees, the employer is the one who would stand to benefit substantially if it chooses to adopt it. Such misconception was confirmed by the statistic released by the Ministry of Human Resources which transpires that as of May 2007, only 1225 employers have endorsed the Code. Many employers are ignorant of the fact that the implementation of the proposed comprehensive in-house mechanism provided under the Code would greatly minimize the risk of the companies being exosed to industrial suits for constructive dismissal and unjust dismissal.



The law imposes essential contractual obligation towards an employer to provide a safe and conducive working environment for its employees. Therefore, the employer owes a duty arising from the contracts of employment existing between the employer and its employees to investigate any complaints on sexual harassment which had been duly brought to its attention. In the event the employer fails to respond to the complaints, the sexually harassed employees who are forced to resign are entitled to seek their remedies in law by taking actions against the employer for constructive dismissal. In contrast, the employer is prohibited from dismissing an employee without notice by merely relying on an allegation without producing any evidence that an investigation had been performed to ascertain truthfulness of the allegation. Furthermore, the employers must always bear in mind that there is a requirement of adequate corroboration in sexual harassment allegations. In law, it is a basic principle of industrial jurisprudence that in a dismissal case the employer



must produce concrete evidence that the alleged misconduct for which an employee was dismissed has indeed been committed by him. The burden of proof lies on the employer to prove that the dismissal was for just cause or excuse. Moreover, in this competitive business world, a company which is being linked to occurrence of sexual harassment within its cooperation will face negative publicity that is damaging to its goodwill, productivity as well as the business. In view thereof, it would be prudent for preservation of the employers' goodwill as well as in sustaining a healthy employer-employee relationship that the guidelines for setting up a comprehensive in-house mechanism provided under the Code be adopted.

The process of setting up a comprehensive in-house mechanism demands hard work and time because it is important to ensure that the mechanism formulated is procedurally legal and fair. The court has impressed upon the need for the inquiry conducted by the employers to be transparent and fair as no employee shall be denied their right of natural justice. Aside from that, factors such as workability, confidentiality, efficiency and effectiveness of the mechanism should be given more emphasis. This is important to encourage victimized employees to advance their problems relating to sexual harassment to the appropriate person. In other words, a comprehensive in-house mechanism is a mechanism that is able to cover all aspects to meet its primary objectives as mentioned earlier.

## THE LAW GOVERNING SEXUAL HARASSMENT IN THE WORKPLACE IN MALAYSIA

*In Malaysia, there are provisions in the statutes which may cover the offences relating to sexual harassment such as expressed in the sections 509, 354 and 355 of the Penal Code as well as section 15(1) of the Occupational Safety and Health Act 1994. Unfortunately, the existing laws have their own weaknesses which contribute to the difficulty in charging and securing conviction for the said offence.*

At this juncture, the introduction of the Code is not totally adequate considering that it does not have the force of law. Thus, seeing that Malaysia has yet to implement specific law governing the offences relating to sexual harassment in the workplace, proactive actions have been taken by employers (companies), trade unions and various women organizations to secure implementation of such law in the near future. In fact, the attempts proved to be progressing positively as can be seen through the proposed amendments to the Employment Act 1955 which states that employers who fail to investigate their workers' sexual harassment complaints can be slapped with a RM10,000.00 fine. Aside from that, various parties including the employers, trade unions and various women organizations are currently advancing their proposal to the Parliament to give the Code the force of law. The said parties are of the view that such implementation will send a clear message that sexual harassment especially in the workplace is unacceptable and will not be tolerated. Hopefully, by having an enforceable law together with the existence of comprehensive in-house mechanism, a better and healthier working environment can be secured. In the meantime, employers can still rely on case law to justify dismissal of sexual harassers in the workplace summarily after adopting or being guided by the Code. In the long run, the extinction of sexual harassment in the workplace would be beneficial not only to the employees, but also to the employers, organizations and the country in numerous ways.

*By the firm's pupils in chambers*

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# The Malaysian Biosafety Bill 2006

The Biosafety Bill 2006 was tabled recently in Parliament but it has now been circulated to the industry and other government agencies for comment.

The Biosafety Bill came about after Malaysia ratified the Cartagena Protocol on Biosafety on 3rd September 2003. The said Protocol provides for a framework for minimizing the adverse effects on modern biotechnology, particularly on the environment and human health.

The proposed new piece of law will provide for the establishment of a National Biosafety Board to regulate the release, importation, exportation and contained use of living modified organisms, and the release of products of such organisms, with the objectives of protecting human, plant and animal health, the environment and biological diversity.

Unlike the Cartagena Protocol on Biosafety which regulates only the release of genetically modified organisms (GMOs) into the environment via planting and field trials and excludes GMOs meant for food, feed and processing, the scope of the Biosafety Bill in its current language is rather broad and is aimed at regulating **all** activities involving GMOs and products made from them. Activities such as importation, production and processing of food products involving GMOs will be regulated under the proposed legislation.

Whilst most consumers may find the all-encompassing bill to be welcoming, many representatives from the industry and research organizations have however questioned the need to have such extensive regulations over GMO products. The fear in the industry is that the Bill would create a negative impact not only on the development of biotechnology in the country but would also hinder trade investment by potential investors.

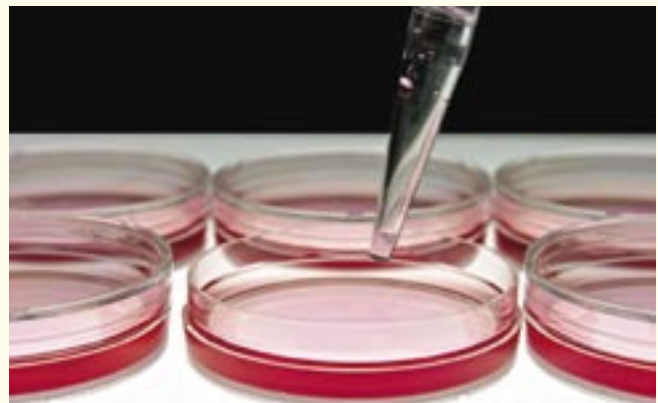
One of the main concerns raised is the mandatory requirement to label genetically modified food products. It was argued that the labeling of food as genetically modified would imply that such products are inferior and hazardous in nature.

Many have also questioned the need for the said mandatory requirement to be included in the Biosafety Bill since the same labeling requirement will also be included in the proposed amended Food Regulations. Food manufacturers will be unduly burdened by the need to obtain and seek approval from more than one authority. The Bill in its current language seems to impose

obligations on parties ranging from food producers to research institutions (in relation to contained use activity) to obtain approval before carrying out activities falling within the scope of the Bill.

In respect of the requirement to label all genetically modified food products, the food industry has raised concerns of the added financial strain it would impose on the industry since the process of labeling such products would entail careful testing and identification at every step of the product chain.

The Bill has so far not been presented for its second reading in Parliament pending comments and feedback from the relevant public. It remains to be seen whether some of the provisions of the Bill will be watered down so as to ensure that compliance with its provision is possible and practical without sacrificing its goal of protecting the human health and environment.



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# Effect of Delay in Registering Foreign Judgments in Singapore

## Case Commentary: Westacre Investments Inc v Yugoimport-SDPR (also known as Yugoimport -SPDR) [2007] 1 SLR 501

The High Court of Singapore recently disallowed the registration of an English judgment pursuant to the Reciprocal Enforcement of Commonwealth Judgments Act (Cap. 264) (“**RECJA**”), on grounds that the application for registration by **Westacre** Investment Inc (“**Westacre**”) was made out of time and that **Westacre** had failed to explain satisfactorily the long delay in registering the judgment in Singapore.

A chronology of key events is helpful in appreciating the facts of the case:

- **Westacre**’s case concerned the enforcement of an ICC arbitration award obtained against Yugoimport-SDPR (“**Yugoimport**”) in February 1994;
- Further to the award, **Westacre** commenced proceedings in the UK in 1996, and on 13 March 1998, the English High Court ordered that judgment be entered against Yugoimport and another, but stayed execution of the judgment pending appeal;
- The English Court of Appeal dismissed the appeal by Yugoimport in May 1999 and the stay of execution of the judgment was lifted on 15 November 1999, following the House of Lords’ refusal to allow leave to appeal in October 1999;
- On 5 October 2004 **Westacre** applied to the Singapore High Court to register the English judgment for purposes of enforcing the judgment in Singapore;
- At first instance, **Westacre**’s application was allowed, and the English judgment registered, but its enforcement was limited to “by way of garnishee proceedings only”.

On Appeal, the Singapore High Court had to consider section 3(1) RECJA which reads:

*“Where a judgment has been obtained in a superior court of the United Kingdom of Great Britain and Northern Ireland the judgment creditor may apply to the High Court at any time within 12 months after the date of the judgment, or such longer period as may be allowed by the Court, to have the judgment registered in the Court, and on any such application the High Court may, if in all the circumstances of the case it thinks it is*

*just and convenient that the judgment should be enforced in Singapore ... order the judgment to be registered accordingly.”*

The High Court explained that this section did not impose a time limit for applications to register foreign judgments in Singapore. Where an application is made more than 12 months after the date of the judgment, the applicant has to show that it was “just and convenient” for the judgment to be registered.

While “just and convenient” is not a precise phrase, the High Court felt that it was not given an unfettered discretion in deciding whether to allow an application made apparently out of time.

Although the Court noted that “the starting point must be the delay”, it was reluctant to grant an order to register a judgment out of time where the only reason proffered is that the judgment debtor will not suffer prejudice.

While the Court would accept delays arising from the administration of justice, such as procedural law or pending appeals, a delay of almost 5 years (as opposed to the 12 month period stipulated under section 3(1) RECJA) before **Westacre** applied to register the English judgment was found to be inexplicable.

Parties must accordingly note that in the absence of valid reasons for any delay in applying for registration, the Court is unlikely to find it just and convenient for such judgments to be registered in Singapore. Additionally, where reasonable steps could have been taken which might have alleviated the delay, and where applicants fail to take those steps, the burden will lay on such applicants to demonstrate that they had acted reasonably in failing to take those steps.

This decision is presently the subject of an appeal to the Singapore Court of Appeal, scheduled to be heard in May 2007.



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## T & P Announcements and News



**Leonard Yeoh** attended the Annual Conference of the Inter-Pacific Bar Association (IPBA) held in Beijing, China between 20th and 23rd April 2007. He was invited and chaired LexisNexis' Labour Laws and Industrial Relations Conference held in Kuala Lumpur on 19th April 2007. He was also invited to be the Chairperson for the Annual In-House Legal Counsel Conference 2007 held at The Ritz Carlton Kuala Lumpur on 21st and 22nd March 2007. Leonard is once again nominated by clients and peers as one of Asia Pacific's leading lawyers for Dispute Resolution and will feature in AsiaLaw's Leading Lawyers 2007.



**Lim Pui Keng** attended the Annual Meeting of the International Trademark Association (INTA) held in Chicago between 28th April 2007 to 2nd May 2007. She also conducted training in relation to the law and practice of trade marks to participants on behalf of the Malaysian Intellectual Property Association on 28th June 2007.



**Linda Wang** attended the Annual Meeting of the International Trademark Association (INTA) held in Chicago between 28th April 2007 to 2nd May 2007. She also attended the launch and opening ceremony on 17 May 2007 of Malaysia's first IP Court at the new Court Complex in Kuala Lumpur. IP Courts are expected to be established in the other states within the next 2 years.



**Siew Ling** attended the Annual Meeting of the International Trademark Association (INTA) held in Chicago between 28th April 2007 to 2nd May 2007 and presented a paper on "Recent Developments in Trade Mark Registration and Enforcement in Southeast Asia: the Malaysian and Indonesian perspectives". She also attended the BIO

International Convention held in Boston from 6th to 9th May 2007 as part of the Malaysian delegation. Siew Ling also conducted training in relation to the law and practice of passing off to participants on behalf of the Malaysian Intellectual Property Association on 28th June 2007.

**Neoh Lay Choo** attended the ICC Banking Commission Meeting on April 24-25, 2007 in Singapore.

## New Associates

**Elizabeth Choong** completed her pupillage with Tay & Partners in 2007 and was retained as a legal assistant in the Dispute Resolution practice group. She focuses on banking litigation.

**Khor See Lin** practises in the area of corporate and conveyancing.

**Olivia Oh** completed her pupillage with Tay & Partners in 2007 and was retained as a legal assistant in the Intellectual Property and Technology practice group. Olivia practises in the area of Intellectual Property Laws.

**Teo Boon Hai** practises in the area of corporate and commercial law, with focus on financial transactions and due diligence.

**Tina Ong** joins the Dispute Resolution practice group and practises mainly in the areas of banking, bankruptcy and debt recovery.