

Intellectual Property & Technology Review

Dear Clients & Friends

Patents Law Update

Singapore Patents Law Update

In September 2007, Singapore accepted a 2005 Protocol of the World Trade Organisation (“**WTO**”) General Council to amend the Trade-Related Aspects of Intellectual Property Rights (“**TRIPS**”) Agreement. The Protocol seals a decision on patents and public health originally adopted in 2003, which provides a solution to WTO members who are unable, due to lack of manufacturing capacity in the pharmaceutical sector, to make effective use of compulsory licensing under the TRIPS Agreement. WTO members have up till 31 December 2009 to accept the amendments attached to the Protocol.

In anticipation of Singapore accepting the TRIPS amendments attached to the Protocol, the Intellectual Property Office of Singapore has drafted amendments to the Patents Act. The proposed amendments to the Patents Act aim to give effect to the TRIPS amendments attached to the Protocol, as well as reflect Singapore’s announcement before the WTO General Council. The proposed amendments to the Act, when finalised, are scheduled to be introduced in the Singapore Parliament later this year.

Malaysia Patents Practice Update

Patent Cooperation Treaty (“**PCT**”) applications filed on or after 16 August 2006 would have Malaysia designated as a state for national phase entry.

Applicants must enter the national phase in Malaysia before the expiration of 30 months from the earliest priority date. This 30-month period is not extendable, but if there is a request to enter the national phase after this period, the national phase patent application has to be applied to be reinstated.

The documents required to be submitted at the national phase entry is a copy of the PCT application in English language (i.e. request form PCT/RO/101, description, claim(s), abstract and drawing(s)). If the application was filed in a language other than English, the applicant must file an English translation.

Case File

Patents

Singapore Court of Appeal: *Seiko Epson Corporation V Sepoms Technology Pte Ltd and another* [2007] SGCA 52

This case was an appeal against the decision of the High Court judge upholding the decision of the assistant registrar, who rejected the application by Seiko Epson Corporation (the “**appellant**”) for directions that Sepoms Technology Pte Ltd and JAL Technology (S) Pte Ltd (the “**respondents**”) file a further account of profits for the period from 20 February 1998 (date of publication of patent application) to 30 September 2005.

This case raised important issues of law and statutory interpretation in the context of section 69(1) of the Patents Act. Please [click here](#) to read on.

Trade Mark

Reputation of the SUPER BOWL American Football League insufficient to stop the registration of “SUPERBOWL GOLF SCHOOL” in Singapore

Allen & Gledhill LLP’s Partners, Dr. Stanley Lai and Moi Sok Ling, recently acted for Superbowl Golf School & Country Club Pte Ltd (the “**Applicants**”) and successfully defended an opposition filed by National Football League Properties Inc. (the “**Opponents**”) to their application to register “**SUPERBOWL GOLF SCHOOL**” as a trade mark in Singapore.

The parties engaged in the opposition proceedings as early as June 2001, and after more than six years, negotiations eventually broke down and the case finally proceeded for hearing before the Registrar of Trade Marks. Please [click here](#) to read on.

Domain Name

Successful retrieval of “www.singaporeflyer.com”

In the Decision of the Administrative Panel of the WIPO Arbitration and Mediation Center dated 6 March 2008 in Case No. D2008-0082 between Singapore Flyer Pte Ltd (the “**Complainant**”) and Alan Hartono (the “**Respondent**”), it was ordered that the domain name, www.singaporeflyer.com, be transferred to the Complainant. Allen & Gledhill LLP was appointed to act for the Complainant. Please [click here](#) to read on.

Copyright

Singapore High Court rules that authorised agent of copyright owners does not have legal standing to apply pre-action discovery of documents to identify copyright infringers

In *Odex Pte Ltd v Pacific Internet Ltd*, the Singapore High Court upheld the decision of the district judge which disallowed the authorised agent in Singapore of various copyright owners from applying for pre-action discovery of documents for the purpose of identifying alleged copyright infringers in relation to the downloading / uploading of *anime* titles from the Internet. The judge went on to state that it would have allowed the application had the copyright owners (or their exclusive licensees) made the application themselves, or had added themselves as plaintiffs. Please [click here](#) to read on.

News

USPTO permanently enjoined from enacting new prosecution rules

On 1 April 2008, the United States District Court for the Eastern District of Virginia permanently enjoined the USPTO from enacting the “Changes to Practice for filing Continued Examination Filings, Patent Applications Containing Patentably Indistinct Claims, and Examination of Claims in Patent Applications” published on 21 August 2007 (New Rules) in the Federal Register. As of the time of writing, the USPTO has not announced plans to file or filed an appeal of the decision. Please [click here](#) to read on.

Allen & Gledhill LLP strengthens Intellectual Property & Technology practice

Allen & Gledhill LLP strengthens its Intellectual Property & Technology practice with the appointment of two new Partners and a US Patent Attorney.

Moi Sok Ling and Isaac Tung were appointed as Partners in Intellectual Property & Technology with effect from 1 January 2008. Sok Ling’s expertise centers on contentious and non-contentious aspects of IP work. She has extensive experience in IP protection and management, and has gained substantial experience in the filing and prosecution of trade marks and designs as well as the management of clients’ worldwide IP portfolio. Sok Ling has advised on, negotiated and drafted a wide range of commercial agreements related to IP and has acted for clients in trade mark opposition and revocation proceedings as well as in IP litigation and enforcement matters involving Anton Piller Orders and police raids.

Isaac is experienced in IP protection, as well as portfolio and rights management. His specialisation is in the filing and prosecution of patents, trade marks and designs, as well as the overall management and coordination of his clients’ intellectual property portfolios in Singapore and worldwide. Isaac also advises on contentious IP matters, which include IP infringement matters. He also prepares and reviews IP documentation, such as licensing agreements, transfer of technology agreements as well as the transfer of IP assets.

William P. Wilbar, who joined the Firm as a US Patent Attorney in September 2007, is a registered patent attorney before the United States Patent and Trademark Office and with the State Bar of Colorado in United States and has over 10 years of experience in the preparation and prosecution of patent applications and patent litigation. He graduated from Columbia University in New York with a Bachelor of Science degree in Computer Science and received a Juris Doctorate degree from the University of Colorado. His practice includes working with high technology companies in establishing, enforcing and defending their intellectual property rights. He has extensive experience in the preparation and prosecution of patent applications, patent and trademark litigation, and patent portfolio management. William has also prepared opinion letters for both non-infringement and invalidity of patents, consulted on the technology in various licensing agreements, and has been a consultant with regards to technology in various patent infringement matters.

The practice, which has six Partners, 10 Associates and six Patent Professionals (including a US registered Patent Attorney), also has five patent engineers, who provide the Firm with the capability to review and draft patents applications in-house without the need for external referral.

Should you have any queries as to how this may affect your business, please do not hesitate to get in touch with your usual contact at Allen & Gledhill LLP or any of the following:

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