

See Hau Global Sdn Bhd vs Mah Sing Plastics Industries Sdn Bhd

[2018] 3 CLJ 359

Court of Appeal
Court Second Instance**Keywords:** Invalidation – Novelty - Inventive step - Infringement**Type of Intellectual Property Rights:** Patent**Legal Basis:**

Patents Act 1983 ss 14, 15, 56(2)(a)

Facts:

This is an appeal against the decision of the High Court in respect of a claim seeking to invalidate a Malaysia Patent ('MY-055') registered by the appellant ('defendant'). Both the respondent ('plaintiff') and the defendant were in the business of manufacturing, selling and distributing of pallets. The defendant published a warning notice asserting its rights as the owner of the MY-055 patent. Therefore, the plaintiff filed a claim to invalidate the MY-055 patent. The High Court Judge ('HCJ') concluded that MY-055 was novel, not obvious nor lacking in an inventive step. The plaintiff's claim to invalidate MY-055 was therefore dismissed with costs. However, the trial judge allowed the plaintiff's prayer in para. 19(c) of its statement of claim that the wing shaped pallets manufactured by the plaintiff did not constitute an infringement of the MY-055 patent.

The defendant filed an appeal against the grant of prayer 19(c) and the plaintiff cross-appealed against the decision in respect of the dismissal of its claim for the invalidation. The issues that arose for the court's consideration in the cross-appeal were whether the HCJ was correct in limiting the plaintiff's claim to para. 5.1 of the statement of claim; whether the MY-055 patent was novel and was not anticipated by prior art as set out in s. 14 of the Patents Act 1983 ('PA'); and whether the MY-055 patent involved an inventive step in that it was not obvious to a person having ordinary skill in the art as provided for in s. 15 of the PA.

Substance:

Having applied s. 15 of the PA and the test in *Windsurfing*, the Court is satisfied that MY-055 is obvious and does not contain nor incorporate any inventive step. In the instant case, the Court on a balance of probabilities held that the combination of the three essential features which are the treads, the protruding ribs and the anti-slip was obvious and did not produce a new or improved result so as to give rise to a patentable claim in MY-055. In determining that MY-055 is not patentable, the Court have also considered the evidence of the patent examiner. The Court found that the patent examiner could not adequately justify the basis for registering the patent, MY-055. Hence, the Court are of the unanimous view that MY-055 is invalid as it is not novel, as it is anticipated by prior art and does not involve any inventive steps or ideas.

As concluded above that MY-055 is invalid, the issue of the infringing of MY-055 no longer arises. The issue raised in this appeal is contingent upon the trial courts finding that MY-055 is valid. The net result is that the plaintiff is entitled to manufacture and supply wing-shaped pallets with or without protruding ribs in the course of its business. No question of limiting it to any one model arises, in any event.

Result:

The cross-appeal is allowed and the appeal is dismissed. The decision of the High Court is set aside and the Federal Court grant prayers 19(a), (b), (c) and (d) only together with costs of RM150,000 to the respondent here and below subject to allocatur. The High Court costs are to be paid back.

Decision Date: 25/7/2017