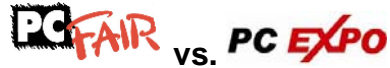


“Fair” Ending for PC Exhibition Organizers?

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As consumer electronics giants Samsung and Apple engage in a global battle over infringement of each other's computer tablet and smartphone patent portfolios, two Malaysian organizers of exhibitions for computer ware have engaged in a legal battle over the selection and use of a name for the trade fairs.

The Association of the Computer and Multimedia Industry of Malaysia (known as “PIKOM”), with a membership of over 1,400 members, has been organizing IT/computer fairs under the name **PIKOM PC FAIR** in the country for 15 years.

Upon leaving her employment with PIKOM, an ex-employee of PIKOM started to organize an IT/PC exhibition under the name **PC EXPO**, which attracted a large number of exhibitors who were in the IT industry, some of whom were members of PIKOM. The **PC EXPO** exhibitions also attracted a large number of visitors to the trade fair. Shortly after the first exhibition was held under the name of **PC EXPO**, PIKOM commenced an action for infringement of their registered trademark **PC FAIR**, tort of passing off and breach of confidential information against its ex-employee and her company.

During the trial, the Defendant argued that the **PC FAIR** mark owned by PIKOM is descriptive of the services the mark is applied to, namely IT and PC trade fairs. The Defendants further argued that the mark **PC FAIR** was always accompanied by the word “PIKOM” and represented as **PIKOM PC FAIR** and that was the distinguishing and distinctive element in the mark. As for the allegation of misuse of confidential information, the Defendant adduced evidence that the information that was claimed to be confidential was in the public domain and therefore there was no issue of breach of confidentiality.

At the end of a three-day trial at the Intellectual Property High Court of Malaya, it was held that the word “PC FAIR” has a primary dictionary meaning, being a “computer fair” and to grant the Plaintiff such a monopoly would deprive the public from using words that are part of the English vocabulary and the IT industry. The Court further held that the mark **PC FAIR** was always used together with the Plaintiff's mark **PIKOM** and therefore, the distinctiveness and goodwill resides with the mark **PIKOM PC FAIR** and not the words “PC FAIR” solely. In this premise, the Plaintiff's infringement action failed. On the claim of passing off, the Court found that the registered mark **PC FAIR** is dissimilar to the mark **PC EXPO** aurally and visually and the Defendants were not passing off their exhibitions as if it originated from PIKOM. As for the confidential information claim, the Court held that

although most of the information claimed to be confidential information fell into the public domain, the information contained in the Plaintiff's exhibitor's database was confidential. As the Defendant had a short period of time between her previous employment and the time she started her company and sent the first introductory email introducing her exhibition to the relevant exhibitors, the Court found that there was an irresistible conclusion that the Defendant contacted exhibitors from the Plaintiff's database.

This decision, which was somewhat in favour of both parties, is currently being appealed at the Court of Appeal.

Trademark owners should analyse the marks they use on their goods and services to ensure that their mark is a distinctive and unique one, which is not descriptive of the goods or services they apply to. Otherwise, actions for infringement or passing off against another party may fail on the same grounds as the Plaintiff did in this case.

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