

# IPOTENTIAL NEWSLETTER SPRING EDITION 2017

## Pintas IP Group

"Today's Asset, Tomorrow's Value"

*Happy Chinese New Year*



恭賀新禧

*Happy Chinese New Year 2017*

From the Management & Staffs of  
**PINTAS IP GROUP**

**Pintas IP Group Wishes You A Happy And  
Prosperous Chinese New Year**

# **SINGAPORE IP CASE UPDATE**

## **KEY DEVELOPMENTS IN COPYRIGHT AND PASSING OFF**

**Singsung Pte Ltd v LG 26 Electronics Pte Ltd (trading as LS Electrical Trading) [2016] SGCA 33 – A Case Summary**

This is an appeal from the High Court judgement in 2015. In this Court of Appeal case, the appellant, Singsung Pte Ltd (“Singsung”) sued the respondent, LS Electrical Trading (“LS”), for passing off, copyright infringement and defamation. LS counterclaimed for malicious falsehood and for groundless threats of copyright infringement. Singsung claimed that LS was liable for passing off as the get-up for eight of LS’ electrical products (“LS Get-Up”) was identical or confusingly similar to the get-up of Singsung’s electrical products (“Singsung Get-Up”) and LS had infringed the copyright of Singsung’s White Get-Up Picture, Blue Get-Up Picture and the TV Stickers. The Court explored how a plaintiff may prove the elements of the tort of passing off, the operation of the doctrine of instruments of deception, and the scope of liability for issuing groundless threats under s 200 of the Copyright Act.

### **I) *Passing-off: Goodwill; Misrepresentation; and Damage***

Goodwill can be established if Singsung can prove that the Singsung Get-Up has become specifically distinctive of its business. Contrary to the High Court decision, the Court of Appeal found that there was goodwill in the Singsung Get-up because goodwill exists when a business offers a product or service for sale and a customer purchases the product or uses the service in Singapore. In the present case, buyers bought the goods from Singsung’s shop in Singapore and the large volume of sales was sufficient to establish goodwill. The issues of where the buyers reside or if the goods purchased were ultimately used in Singapore were irrelevant in establishing goodwill. The Court held that evidence showed LS had taken steps to deliberately copy the Singsung Get-ups with an intention to deceive customers was sufficient to find misrepresentation. Lastly, Singsung must prove damage, or a real likelihood of damage, to Singsung’s goodwill. LS’ misrepresentation and the fact that the parties were competing in the same line of products and export jurisdictions proved that damage was likely to Singsung’s business. Accordingly, Singsung succeeded in establishing passing off.

### **II) *The Doctrine of Instruments of Deception***

The law of passing off recognises the doctrine of instruments of deception, which addresses the issue of whether the Defendant would have committed the tort of passing off if it had put into circulation goods which are inherently likely to deceive ultimate purchasers or consumers, even though the immediate purchasers may be middlemen who are not themselves deceived and may have ultimately disposed of the goods in a manner which does not deceive anyone at all. The Court applied this doctrine to the present case and held that LS’ Get-Up was inherently deceptive, being identical to the corresponding Singsung Get-Up. LS was therefore liable for passing off even though the middlemen in the supply chain were not confused as to the origin of the goods in question.

### **III) *Copyright Infringement and Groundless Threats***

The Court overruled the High Court’s decision and found that LS had infringed the copyright in Singsung’s White Get-Up Picture and the TV Stickers. Ownership of copyright in the White Get-Up Picture had been validly assigned to Singsung and LS knew or ought reasonably to have known that they were infringing the Singsung’s copyright in the TV Stickers. However, there was no infringement of Singsung’s Blue Get-Up Picture which was a straightforward representation of a commonplace object (i.e. a DVD player) and required identical copying for copyright infringement.

The Court held that it does not necessarily follow that a groundless threat of infringement must be found when there was no infringement of Singsung’s Blue Get-Up Picture. On the facts, there was no conceivable damage flowing from the demand which cannot be compensated by a cost order against Singsung for having made an unwarranted threat. Therefore, a declaration that the threat was groundless is unnecessary. This decision would protect the rights owner from being penalised merely because he has made a good faith attempt to enforce his rights.

Furthermore, this case established that grant of relief under Section 200 of the Copyright Act is discretionary in nature. We may, therefore, draw an analogy of this decision to similar provisions under Sections 35, 77 and 44 of the Trade Marks Act, Patents Act and Registered Designs Act respectively.

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## **SINGAPORE IP CASE UPDATE**

### **THE CONNECTION OF TRADEMARK INFRINGEMENT IN SINGAPORE**

**Calvin Klein, INC. And Another v. HS International Pte Ltd And Others**

This case concerns the Plaintiff's (Calvin Klein, Inc. and Calvin Klein Trademark Trust) application for summary judgement against the Defendants (HS International Pte Ltd, Global PSM Pte Ltd and Mr Jeffrey Tan) for trade mark infringement. The central feature in the Plaintiff's suit is the Defendants involvement in selling counterfeit goods on the SGbuy4u Website. Chan Seng Onn J. set out 3 important principles in determining whether the Plaintiff's would succeed in their application:

- (a) whether the requirement of double identity under s 27(1) of the Trade Marks Act 1976 ("TMA") is satisfied;
- (b) whether the relevant signs have been "use[d]" within the meaning of ss 27(1) and (4) of the TMA; and
- (c) which, if any, of the Defendants carried out the infringing use.

On the first issue, the High Court held that the appearance of the 'Calvin Klein' sign on the goods obtained from the First Sample Purchase and those seized during the raid is a reproduction of the registered 'Calvin Klein' trade mark without any modification or addition, thus satisfying the double identity requirement.

Secondly, the High Court accepted that the Plaintiff's counterfeit goods being offered on SGbuy4u website was in accordance to ss 27(1) and (4)(b) of the TMA, as a sign identical with its trade mark was used in the course of trade. The Defendants assertion of the SGbuy4u Business being a courier or freight forwarding service like FedEx, DHL or SingPost; and a customer-to-customer ("C2C") platform facilitating the sale and purchase of goods similar to eBay, Carousell, Taobao and 65daigou as a defence was rejected as different services are provided upon comparison.

Lastly, upon Chan Seng Onn J.'s analysis it was decided that only the Second Defendant, Global PSM Pte Ltd was involved in offering the infringing goods for sale because of its sole and whole control, management and involvement in the SGbuy4u Business and Website where payment was made to the Second Defendant and the User Agreement states that any legal notices shall be served on the Second Defendant. The High Court held that a slight connection between the First and the Third Defendant (HS International Pte Ltd and Mr Jeffrey Tan) and the infringing use of the Plaintiff's trade mark is inadequate to demonstrate that the Plaintiffs have adduced sufficient evidence for a prima facie case - that the First and Third Defendant had carried out the infringing use, and to shift the burden of proof to the First and Third Defendant.

Following from the above, a summary judgement was granted in respect of the Plaintiffs' claim for trade mark infringement against the Second Defendant, whereas the application for summary judgement against the First and Third Defendant was disallowed. The court further ordered the First and Third Defendant to be given unconditional leave to defend the Plaintiffs' claims against them.

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# **MALAYSIA IP CASE UPDATE**

## **IS THE FIRST USER OF A TRADE MARK THE ULTIMATE USER?**

**Huan Schen Sdn Bhd v SRAM, LLC [2016] - A Case Summary**

Huan Schen Sdn Bhd ("Plaintiff") filed an originating summons ("OS") under s 45(1)(a) of the Trade Marks Act 1976 ("TMA") to expunge 5 trade marks ("Defendant's TMs") registered in the Register of Trade Marks ("Register") under the name of SRAM LLC ("Defendant"). Previously, the Plaintiff had obtained the Registrar's decision to dismiss the Defendant's application to oppose the registration of the Plaintiff's trade mark because the Defendant had failed to establish the use of its trade marks in Malaysia before the date of Plaintiff's application to register its trade mark. Upon successful registration of the Plaintiff's trade mark, the Plaintiff alleged that the Defendant's TMs were entries wrongfully made and remaining in the Register and therefore, applied to expunge and remove the Defendant's TM from the Register. The Court considered the following issues:

*Can the Plaintiff file this OS?*

The Court held that the Plaintiff's failure to oppose the Defendant's TM under s 28(1) TMA and reg. 37(a) TMR and temporary cessation of the use of its trade mark do not estop or bar the Plaintiff from filing the OS. Registration of a trade mark is not a defence to an expungement application under s 45(1)(a) of TMA when the trade mark had been wrongfully entered in the Register. Furthermore, the Registrar's decision is not final and conclusive, hence it cannot attract the application of the estoppel principle against the Plaintiff and the Plaintiff cannot rely on the Registrar's dismissal of the Defendant's opposition to support this OS.

*Who is the first user and common law proprietor of "SRAM" mark?*

It was held that the Plaintiff had adduced copies of sales invoices and an invoice dated 2nd January 2002, which bore the Plaintiff's trade mark proved that it was the first user of the "SRAM" mark in the course of trade in Malaysia on 2nd January 2002. The Plaintiff's subsequent conduct to register its trade mark on 26th December 2003 was relevant to support the fact that the Plaintiff had indeed used its trade mark in the course of trade in Malaysia since 2nd January 2002. The fact that the Plaintiff did not author, create or design the mark, does not affect the Plaintiff's right as the first user of the mark. The most crucial point was the Defendant had failed to prove first use of the mark on or before 2nd January 2002 in Malaysia, despite the Defendant's TMs had been registered and used extensively in countries outside Malaysia. The Plaintiff was, therefore, the first user of the "SRAM" mark.

*Whether the Plaintiff had successfully challenged the Defendant's TMs' conclusive registration under s 37 TMA? If so, does the Court has a discretion not to expunge Defendant's 1st to 4th Trade Marks under s 45(1)(a) TMA?*

The Court held that the Plaintiff had failed to prove the original registration of the Defendant's 1st to 4th trade marks was obtained by fraud under s 37(a) TMA because the Defendant was the creator of the "SRAM" mark, the Defendant had used upon and in relation to the Defendant's goods in the course of trade outside Malaysia before or at the time of registration of its trade mark, and the Defendant's act of opposing the Plaintiff's application to register the mark. However, the Plaintiff had succeeded to prove under s 37(b) and (c) TMA that the use of Defendant's 1st to 4th trade marks were likely to deceive or confuse the public because the Defendant's 1st to 4th trade marks were not distinctive. Hence, the Court held that it had no discretion but rather it was compelled to order for the removal of the Defendant's 1st to 4th trade marks from the Register in accordance with s. 45(1)(a) TMA based on the grounds for the expungement of a registered trade mark as the Plaintiff had successfully proven under s 37(b) and (c) TMA.

The Court ordered the Registrar to expunge and remove the Defendant's 1st to 4th trade marks from the Register.

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## **MALAYSIA IP CASE UPDATE**

### **A BANKRUPT'S TRADEMARK ASSIGNMENT IS NOT A GOOD ASSIGNMENT**

**NCV Technologies Sdn Bhd v NCTech Int Berhad & Another (Case Summary)**

This case concerns the Plaintiff's (NCV Technologies Sdn Bhd) claim against the Defendants (NCTech Int Berhad and Chan Yuet May) for trade mark infringement and passing off. The Plaintiff claimed that the infringement and/or passing off was due to the involvement of the registered "VELLUX" and "NCV" trade mark in the Defendants' business. The issues tried is summarised as follows:-

- (A) Whether the registration and assignment of the "VELLUX" trade marks by CYM was unlawful;
- (B) Whether the "VELLUX" trade marks ought to be expunged from the Register of Trade Marks;
- (C) Whether the Defendant had infringed and/or passed off the "VELLUX" trade marks;
- (D) Whether the Defendant had infringed and/or passed off the "NCTech" trade mark; and
- (E) Whether the Defendant's registered "NVC" trade mark ought to be expunged from the Register of Trade Marks.

Firstly, Azizah Nawawi J. found that in pursuant to s.35 of the Trade Marks Act 1978 ('TMA 1976') and the registration records, Chan Yuet May (CYM) is the registered proprietor of the "VELLUX" trade marks. The Plaintiff's claim that they are the owner of the "VELLUX" trade marks by virtue of the Deed of Trust and Deed of Assignment is invalid as it was not expressly stated in both Deeds and that CYM is merely a trustee of trademark "VELLUX". Moreover, the assignment by CYM, an undischarged bankrupt, to the plaintiff was also unlawful as it breaches s.109(1)(b) of the Bankruptcy Act 1967 where her property, "VELLUX" trademarks should be assigned to the Director General of Insolvency. Thus, following s.24 of the Contracts Act 1950, the Deed of Assignment is void.

Premised on the reason above, the High Court held that the Plaintiff's who is not the registered proprietor of the "VELLUX" trademarks cannot maintain their action against the Defendant for trademark infringement under s.35 read with s.38 of the TMA 1976. The pleaded case of the Plaintiff's ownership of "VELLUX" was premised on the Deed of Trust and Deed of Assignment and not on common law, thus the Plaintiff had no right to sue the Defendants for the tort of passing off.

Despite CYM's "VELLUX" trademark being conclusive upon being registered for more than 7 years under s.37 of the TMA 1976, it was decided that CYM's registration falls within the exception of s.37(a) and (b) of the TMA 1976 making its validity subject to challenge.

Lastly, upon consideration of the Plaintiff's claim that the first Defendant's "NCV" trademark infringed the Plaintiff's "NCTech" trademark, the judge considered that by looking at the marks as a whole, it is neither identical nor similar to the Plaintiff's "NCTech" trademark. Therefore, the Plaintiff had failed to establish its case on a claim of trade mark infringement, passing off and rectification.

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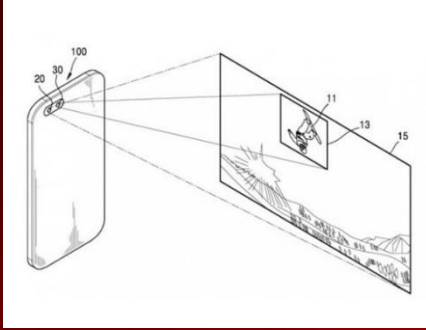
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## Samsung Patent Shows Dual-camera Tracking Feature



2016 was a breakthrough-year for the dual-camera concept on smartphones, with several models being launched. Notably the largest manufacturer of Android smartphones, Samsung, has so far not participated in the dual-camera game. This appears to be changing however, as a patent application has been filed with the South Korean Patent Office suggests that the tech giant is at least considering smartphone models with dual-cameras. The patent suggests that the phone would feature two different focal lengths, similar to what we have already seen on the LG G5 or Apple iPhone 7 Plus.

The patent application is for a specific dual-camera feature that allows for tracking a moving subject with the preview-image of the wide-angle lens and then capturing it larger in the frame with the tele-lens. In the images included in the patent application the frame lines of the tele-image are superimposed onto the wide-angle image, which should make it easier to follow a fast moving subject.

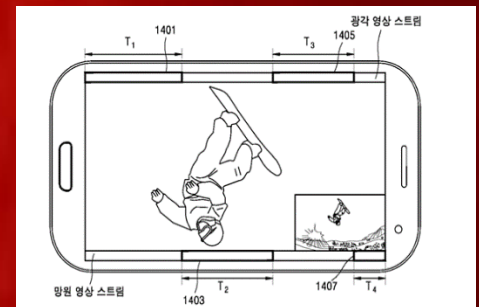
As usual, there is no way of knowing if the concept will ever make it into a final product but the system certainly looks possible to implement with current technologies. We probably should not expect a dual-cam in Samsung's upcoming Galaxy S8 flagship but after the Galaxy Note 7 disaster the Korean manufacturer could certainly do with a stand-out feature in one of its next models to recover lost market share.

Source : Digital Photography Review

## Amazon Wins Patent For Using Subterranean Network To Deliver Packages

Forget drones and flying warehouses, Amazon has been granted another patent for package deliveries. A little more than a month ago, the patent application for using a subterranean network to deliver packages was finally published.

The planned network delivery system may be configured to transport a parcel or container and may be driven by or along one or more conveyors or rails, or even through pneumatic tubes.



Transporting parcels from an origin to a destination via underground tunnels can definitely help improve Amazon's delivery system and avoid congestion experienced by traditional transportation networks. However, boring a hole under the grounds of Seattle is not easy as some might think.



But when it comes to Amazon, everything is possible. They've always been known to make the impossible happen.

As of today, Amazon hasn't confirmed yet if they are actually planning to build such network anytime soon. Let's just wait and see.

Source : Amazopia

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## **Family Sues Apple for Not Making Thing It Patented**

A lawsuit filed against Apple this week argues that, by not actually making a product that it patented, the company is partly responsible for an automobile accident. According to Jalopnik, James and Bethany Modisette are suing the tech company after a car crash two years ago that killed one of their daughters and injured the rest of the family. The driver of the car who hit them had been using Apple's FaceTime video chat at the time.

The patent in question was first applied for in 2008, and describes "a lock-out mechanism to prevent operation of one or more functions of handheld computing devices by drivers when operating vehicles," such as texting or video chatting.

The complaint cites Apple's "failure to design, manufacture, and sell the Apple iPhone 6 Plus with the patented, safer, alternative design technology" — in other words, lack of the program's inclusion — as a "substantial factor" in the crash.



Source : New York Media LLC

## **Adidas Springs A Lawsuit On Skechers For Patent Infringement**

Adidas has filed a lawsuit against Skechers for what it calls blatant copying of its products and infringement of its valuable intellectual property. The new lawsuit was filed today in the U.S. District Court for the District of Oregon (Portland Division), with Adidas claiming that Skechers stole its concept of a "Springblade" shoe.



In June 2013, Adidas created its Springblade shoe -- a running shoe with individually turned blades that has an innovative look and purportedly propels runners forward with one of the most effective energy returns in the shoe industry. Skechers now sells a "Mega Flex" shoe that contains the "Mega Blade 2.0". The shoes from competing companies draw many similarities, with the main differentiating factor being that Adidas' shoe contains the trademark three stripes while Skechers' shoe has an italicized "S".

Adidas alleges that Skechers copied Adidas' Springblade technology in creating the Mega Flex. The company cites to articles and consumer comments to demonstrate its point. One such comment from a Skechers YouTube video states, "stop copying other shoe brands adidas made those shoes first."

The footwear industry is full of intellectual property-related lawsuits.

Earlier in 2016, Nike NKE +1.85% also sued Skechers for allegedly copying sneaker designs that purportedly infringe on eight Nike design patents.

Adidas recently settled a case against Under Armour UA +1.26% wherein Adidas claimed that Under Armour and its subsidiary MapMyFitness were infringing on Adidas patents by use of a location-aware fitness training device, methods and program products that support real-interactive communication and automated route generation. That case had been litigated for two years prior to reaching settlement.

Adidas also has a case against Skechers for allegedly ripping off its classic Stan Smith shoe. It was awarded a preliminary injunction against Skechers, preventing it from selling those allegedly infringing shoes.

In 2014, Skechers sued Adidas' Reebok brand for patent infringement concerning the company's Go Walk shoes.

Needless to say, there is a lot of bad blood between these two companies. Adidas has made it a point to press Skechers on allegedly infringing lines of product in the past and its recent move to sue related to the Springblade is further proof that Adidas will take such matters to court.

Source : Forbes

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## Google Is Trying to Trademark the Word 'Glass'—and It's in Good Company

This week, the Wall Street Journal reported that Google, which long ago trademarked "Google Glass," is experiencing some difficulty in the next stage of its IP journey: trademarking the word "glass" itself.

I know, I know—get out your small violin™.

But while it's tempting to, as many have, make fun of Google's attempt to trademark a word that has been with us since the 12th century ... it's also worth remembering that Google isn't alone in its attempts to make all the world a mark. On the contrary: trademarking is a time-honored, and in many ways legally responsible, tradition among the major tech companies.



Here, with that in mind, is an extremely partial list of tech trademarks both attempted and won :

- Apple has tried to trademark the word "startup."
- Apple and Amazon have faced off in court over the use of the term "app store."
- Amazon has successfully filed for trademarks for the terms "Prime," "I want one!," "of note," "look inside," and "Earth's biggest."
- Facebook has tried to trademark the word "book."
- Facebook has successfully trademarked "F," "Face," "FB," and "Wall." Oh, and also "Facepile."
- Instagram has tried to stop other apps from using "Insta," "Gram," and "IG."
- Microsoft has trademarked the word "haunt."
- Microsoft has tried to trademark the term "age of mythology" and the words "natural" and "rare."
- Samsung has filed for trademarks on the terms "dark screen" and "finger scanner."
- Skype has trademarked the word "silk."
- Twitter has trademarked the word "tweet."
- Zynga has trademarked the term "with friends"—and has sued other companies over their use of it.

Source : The Atlantic

## McDonald's Wins EU 'Mac' Trademark Case - EU's General Court upheld ruling challenging Singapore company's registry of 'MACCOFFEE'

BRUSSELS— McDonald's Corp. won a legal case in the European Union's second highest court, allowing the U.S. fast food chain to prevent the registration of trademarks for food and beverages with the prefix "Mac" or "Mc."

McDonald's had won a case in 2013 the European Union Intellectual Property Office challenging Singapore-based company Future Enterprises' registry of the name MACCOFFEE for its food and beverage products.



The EU's General Court on Tuesday upheld that ruling for similar reasons the Intellectual Property Office had given.

The General Court said the trademark MACCOFFEE and McDonald's are phonetically similar and that the combination of "mac" with the name of a drink can lead the public to link that trademark to McDonald's.

It said the products designed by MACCOFFEE, such as ice cream, muffins, filled sandwiches "aren't simple ingredients serving as the basis for dishes served in fast-food restaurants, but correspond to the goods offered... on the menu" of fast-food chains.

The court therefore ruled that the use of the MACCOFFEE trademark "takes unfair advantage of the repute of McDonald's trade marks."

The decision can be appealed to the bloc's highest court, the European Court of Justice.

Source : The Wall Street Journey

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## Pintas-IP Protection Services

### Trademarks

A trademark is a sign used for the purpose of indicating a connection between a person having the right to use the sign for his goods and services, distinguishing it from those of others. A sign includes words, logos, labels, names, letters, numbers or a combination of the above.

### Patents

A patent is an exclusive right granted for an invention, which is a product or a process that provides a new way doing something or that it offers a new technical solution to an existing problem.

### Industrial Design

Industrial design means features of shape, configuration, pattern or ornament applied to an article by any industrial process or means.

### Copyright

The exclusive and assignable legal right given to the originator for a fixed number of years, to print, publish, perform, film or to record literary, artistic, or musical material.



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## Pintas Upcoming Event

### Seminar: Patentproofing Your Innovation & Invention

**Date** : 16 February 2017 (Thursday)  
**Time** : 2.00 p.m.  
**Venue** : Networking Lounge @ Resource Centre  
Technology Park Malaysia  
Resource Centre  
Lebuhraya Puchong-Sg Besi,  
Bukit Jalil, Kuala Lumpur

To RSVP, kindly contact 012-7975077(Ms. Yong)/03-78765050,  
or email us at [marketing@pintas-ip.com](mailto:marketing@pintas-ip.com)

### Seminar: 商标 : 您企业的护身符 (Pintas Intellectual Property Seminar)

**Date** : 3 March 2017 (Friday)  
**Time** : 2.00 p.m.  
**Venue** : 25, Jalan Persiaran Skudai 8,  
Pusat Perusahaan Skudai 8,  
81300 Skudai, Johor

To RSVP, kindly contact 010-5666077 (Mr. Wong),  
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