



ICLG

The International Comparative Legal Guide to:

Trade Marks 2019

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General Chapters:

1	Ranging Abroad: a Spotlight on Infringements Online, and Where to Fight Them – Nick Aries & Tristan Sherliker, Bird & Bird LLP	1
2	Use It or Lose It: Truer Than Ever in the U.S.A. – Karen Lim & Jason D. Jones, Fross Zelnick Lehrman & Zissu, P.C.	6

Country Question and Answer Chapters:

3	Australia	McCullough Robertson: Belinda Breakspear & Peter Stokes	11
4	Austria	Hule Bachmayr-Heyda Nordberg Rechtsanwälte GmbH: Emanuel Boesch	19
5	Barbados	Clarke Gittens Farmer: Rosalind K. Smith Millar QC	30
6	Belgium	Lydian: Annick Mottet Haugaard & Blandine de Lange	37
7	Bolivia	Bolet & Terrero: Juan Ignacio Zapata	47
8	Brazil	Daniel Law: Robert Daniel-Shores & Roberta Arantes	56
9	Canada	Miller Thomson LLP: Catherine M. Dennis Brooks & David Reive	67
10	Cayman Islands	HSM IP Ltd.: Sophie Peat & Huw Moses	76
11	Chile	PORZIO · RIOS · GARCIA: Cristóbal Porzio & Marcelo Correa	84
12	China	East & Concord Partners: Charles (Chao) Feng	93
13	Cyprus	Koushos Korfiotis Papacharalambous LLC: Eleni Papacharalambous & Georgia Charalambous	103
14	Czech Republic	KOREJZOVA LEGAL v.o.s.: Dr. Petra de Brantes & Mgr. Ivana Toningrová	112
15	Finland	Borenus Attorneys Ltd: Åsa Krook & Ben Rapinoja	119
16	France	Gowling WLG: Céline Bey & Clémence Lapôtre	126
17	Germany	Lubberger Lehment: Anja Wulff	138
18	Greece	Law Offices of Patrinos & Kilimiris: Maria Kilimiris & Manolis Metaxakis	146
19	India	Subramaniam & Associates (SNA): Hari Subramaniam & Philip Abraham	154
20	Ireland	LK Shields: Peter Bolger & Jane O'Grady	163
21	Israel	Ehrlich, Neubauer & Melzer (EN&M), of Ehrlich Group: Yehuda Neubauer & Keren Rubinstein	172
22	Italy	FTCC Studio Legale Associato: Filippo Canu & Pierluigi Cottafavi	182
23	Jamaica	DunnCox: Joanne Wood Rattray & Kelly Akin	192
24	Japan	Fukami Patent Office, P.C.: Yoshitake Kihara & Miki Tomii	202
25	Korea	Lee International IP & Law Group: Mi-Cheong Lee & Robert M. Kim	209
26	Malaysia	Shearn Delamore & Co.: Karen Abraham & Janet Toh	216
27	Malta	Camilleri Preziosi Advocates: Steven Decesare & Sharon Xuereb	227
28	Mexico	OLIVARES: Alonso Camargo & Daniel Sanchez	235
29	Netherlands	Le Poole Bekema: Anne Bekema & Laura Broers	245
30	Nigeria	S. P. A. Ajibade & Co.: John Chike Onyido & Oluwasolape Owoyemi	254
31	Norway	Acapo AS: Kjersti Rogne & Kjersti Staven-Garberg	263
32	Philippines	SyCip Salazar Hernandez & Gatmaitan: Vida M. Panganiban-Alindogan	270
33	Poland	Softysiński Kawecki & Szlęzak: Dr. (hab.) Ewa Skrzydło-Tefelska & Karol Gajek	279
34	Portugal	Baptista, Monteverde & Associados, Sociedade de Advogados, SP, RL: Filipe Teixeira Baptista & Joana Cunha Reis	287
35	Russia	Papula-Nevinpat: Annikki Hämäläinen	295
36	Saudi Arabia	Kadasa Intellectual Property: Mohammad Jomoa & Asif Iqbal	302
37	Serbia	Moravčević Vojnović and Partners in cooperation with Schoenherr: Andrea Radonjanin	312

Continued Overleaf ➡

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Country Question and Answer Chapters:

38	Slovenia	Patentna pisarna d.o.o.: Irena Kadunc & Vesna Kovič	319
39	South Africa	Bouwers Inc.: Deon Bouwer & Adele Els	327
40	Spain	ELZABURU: Fernando Iardia & Ana Sanz	334
41	Sweden	Hannes Snellman Attorneys Ltd.: Christopher Tehrani & Nedim Malovic	346
42	Switzerland	Nater Dallafior Rechtsanwälte AG: Dr. Mathis Berger	354
43	Taiwan	TIPLo Attorneys-at-Law: J. K. Lin & H. G. Chen	362
44	Turkey	OFO VENTURA: Özlem Fütman	373
45	Uganda	OSH Advocates, Solicitors & Legal Consultants: Fredrick K. Sentomero & Doreen Mwesige	383
46	Ukraine	Advance Partners: Oleg Zhukhevyeh & Maksym Kravchenko	389
47	United Arab Emirates	United Trademark & Patent Services: Maria Farrukh Irfan Khan & Sarmad Hasan Manto	400
48	United Kingdom	Bird & Bird LLP: Nick Aries & Daisy Dier James	408
49	USA	Arent Fox LLP: Michael A. Grow & James R. Davis, II	416
50	Vietnam	Pham & Associates: Pham Vu Khanh Toan	424
51	Zimbabwe	Samuriwo Attorneys: Nancy Samuriwo	433

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1 Relevant Authorities and Legislation

1.1 What is the relevant trade mark authority in your jurisdiction?

The Intellectual Property Corporation of Malaysia (“MyIPO”) oversees the administration of trade marks in Malaysia. The Director General of MyIPO is the Registrar of Trade Marks. The Ministry of Domestic Trade and Consumer Affairs (“MDTCA”) oversees the administrative enforcement of trade marks in Malaysia by way of, among others, investigating complaints, executing raids against infringing parties and the provisional seizure of goods.

Civil matters concerning registered trade mark infringement and the validity of trade mark registrations are heard at the High Court. The High Court also hears appeals from the decisions of the Registrar at MyIPO and criminal intellectual property (“IP”) appeals from the decisions of the Sessions Court (IP). The Sessions Court (IP) hears only criminal IP matters.

1.2 What is the relevant trade mark legislation in your jurisdiction?

The sources of Malaysian trade mark law are found in primary and secondary legislation and common law. The Trade Marks Act 1976 (“TMA 1976”) forms the primary legislative framework for the registration of trade marks in Malaysia, with the Trade Marks Regulations 1997 (“TMR”) being the subsidiary legislation made thereunder. The Trade Descriptions Act 2011 (“TDA 2011”) came into force on 1 November 2011 and provides for criminal enforcement against trade mark infringement.

2 Application for a Trade Mark

2.1 What can be registered as a trade mark?

Type of registrable trade marks

A mark is defined under Section 3 of the TMA 1976 to “include a device, brand, heading, label, ticket, name, signature, word, letter, numeral or any combination thereof”. Traditional marks such as word marks, device marks and composite marks come to mind and are certainly registrable. However, whether or not non-traditional marks such as three-dimensional (“3D”) marks and colour marks are registrable is still up for debate. The High Court decision of *Kraft Foods Schweiz Holding GmbH v. Pendaftar Cap Dagangan* [2016]

11 MLJ 702 suggests that the interpretation of the definition of a mark may include 3D trade marks, although it is important to note from this decision that the mere association of a trade mark with a product by consumers is not enough to prove acquired distinctiveness.

Content of marks

Section 10(1) of the TMA 1976 states that in order for a trade mark to be registrable, it must contain or consist of at least one of the following:

- the name of an individual, company or firm represented in a special or particular manner;
- the signature of the applicant for registration or of some predecessor in his business;
- an invented word or words;
- a word having no direct reference to the character or quality of the goods or services not being, according to its ordinary meaning, a geographical name or surname; or
- any other distinctive mark.

2.2 What cannot be registered as a trade mark?

The marks that are not registrable by virtue of statutory restriction pursuant to the TMA 1976 and TMR 1997, include a mark:

- which will be likely to deceive or cause confusion to the public;
- which contains any scandalous or offensive matter;
- which is identical to, is confusingly similar to, so closely resembles, or constitutes a translation of the mark which is well-known in Malaysia for the same goods or services of another proprietor;
- which is well known and registered in Malaysia for goods or services which are not the same as those in respect of which the registration is applied for, provided that the use of the mark in relation to those goods or services would indicate a connection between those goods or services and the proprietor of the well-known mark is likely to be damaged by such use;
- with misleading geographical indication with respect to goods as to its origin;
- with misleading geographical indication with respect to wines and/or spirits as to the origin;
- which is prejudicial to the interest or security of the nation;
- that contains the words “Patent”, “Patented”, “By Royal Letters Patent”, “Registered”, “Registered Design”, “Registered Trade Mark”, “Registered Service Mark”, “Copyright”, “To counterfeit this is a forgery”, or any words to the like effect in any language;

- i) that contains the words “*Bunga Raya*” and the representations of the hibiscus or any colourable imitation thereof;
- j) being a representation of or words referring to the King or State Ruler or any colourable imitation thereof;
- k) being representations of any of the royal palaces or of any building owned by the Federal Government or State Government or any other government or any colourable imitation thereof;
- l) containing the acronym “ASEAN” and the representation of the ASEAN logotype or any colourable imitation thereof;
- m) containing the words “Red Crescent” or “Geneva Cross” and representations of the Red Crescent, the Geneva Cross and other crosses in red, or of the Swiss Federal Cross in white or silver on a red background, or such representations in a similar colour or colours;
- n) being representations of, or mottoes of or words referring to, the royal or imperial arms, crest, armorial bearings or insignia or devices so nearly resembling any of them as to be likely to be mistaken for them;
- o) being representations of, or mottoes of or words referring to, the royal or imperial crowns, or of the royal, imperial or national flags;
- p) being representations of, or mottoes of or words referring to, the crests, armorial bearings or insignia of the Malaysian Army, Royal Malaysian Navy, Royal Malaysian Air Force and of the Royal Malaysia Police, or devices so nearly resembling any of the foregoing as to be likely to be mistaken for them;
- q) being representations of the name, initials, armorial bearings, insignia, orders of chivalry, decorations or flags of any international organisation, state, city, borough, town, place, society, body corporate, institution or person appearing on a mark;
- r) containing the name of a single chemical element or compound; and
- s) containing direct reference to the character or quality of the goods or services.

2.3 What information is needed to register a trade mark?

The information required to register a trade mark is as follows:

- a) the full name and address of the applicant(s);
- b) a clear representation of the mark. If the representation of trade mark is in colour, it should be stated whether the mark should be limited to the colour(s) in the representation;
- c) the classification and description of goods or services for which the mark is applied for in accordance with the Nice International Classification of Goods and Services;
- d) the full name and address of the trade mark agent and his registration number and reference (if applicable);
- e) the priority date, Convention country priority date and priority application number for an International Convention priority claim (if applicable);
- f) the date of the first use of the mark in Malaysia (if applicable);
- g) a statutory declaration, signed by the applicant or its representative, that the applicant is the *bona fide* proprietor of the mark and that the application is filed in good faith; and
- h) if the representation of the trade mark consists of a word or words in non-Roman characters or in a language other than English, a certified translation and transliteration, as appropriate, must be submitted to the Trade Marks Registry within a year from the filing date.

2.4 What is the general procedure for trade mark registration?

(i) Formality examination

An applicant may submit to the Registrar the relevant documents in support of his application – namely, form TM5, a Statutory Declaration affirming that the applicant is the *bona fide* proprietor of the mark and is entitled to be registered as the proprietor, and the prescribed fee. After an application for a trade mark has been submitted to MyIPO and allotted an application number, the application will undergo a formality examination. If all the documents are in order, the application will proceed to the search and examination stage. However, if the documents are incomplete, a notification is sent to the applicant to address the same. The Trade Marks Registry will abandon the application if the formalities are not complied with within 12 months from the date of application by reason of default on the part of the applicant.

(ii) Search and examination

If the documents are complete, the examiner will conduct a search of the Register of Trade Marks (Register) to determine if the trade mark is in conflict with any existing marks, either prior registrations or pending applications. The trade mark will also be examined to ascertain whether it fulfils the requirements of a registrable trade mark as mentioned in question 2.1 above. The burden of proof lies with the applicant to show that his mark should be registered, and the Registrar is empowered with the discretion to accept or object to the application according to whether, in the Registrar’s opinion, the onus has been discharged by the applicant.

(iii) Objection

If the mark conflicts with an existing mark or is not in compliance with the requirements of a registrable trade mark, the examiner will issue an office action notification which allows the applicant to file a written response to overcome the office action. The office action may be in the form of an outright refusal or a conditional acceptance. The usual grounds for an office action can include similarity to a registered mark or a prior pending application, or that the proposed specification of goods and services is to be amended prior to acceptance. Upon the submission of the response to the examiner, a decision will be made by the examiner either to allow the registration of the mark or to maintain the objection. If the applicant’s response is accepted by the Registrar, the application will proceed to the next stage.

(iv) Hearing

Where the applicant’s response is not accepted, the applicant will be allowed to request and attend an oral hearing before a hearing officer to address the Registrar’s objections. A further appeal is possible and is discussed in questions 3.3 and 3.4 below.

(v) Acceptance and advertisement

Where the trade mark has passed the search and examination stage, and is found to meet all the requirements, or if the objections raised were successfully overcome, a Notice of Acceptance will be issued by the Trade Marks Registry to the applicant, following on from which the application will be advertised in the Government Gazette upon payment of the prescribed advertisement fees within the prescribed time.

(vi) Opposition

The advertisement in the Government Gazette is for opposition purposes. Any person may file a Notice of Opposition to the Registry and Form TM 7, accompanied by the prescribed fee, within two months of the advertisement date in the Government Gazette, subject to an extension of time. Where such a Notice of Opposition is filed, both the applicant and the opposing party (“the opponent”) will

engage in opposition proceedings and file written submissions. As above, the burden of proof rests with the applicant to show that their mark should be registered. If the officer decides in favour of the opponent, thus making the opposition successful, the trade mark will not proceed to registration. A further appeal against the officer's decision is possible and is discussed in questions 3.3 and 3.4 below.

(vii) Registration

Where a trade mark has not been opposed within the two-month period, or if the opposition was unsuccessful, the trade mark will be registered and the Registrar will issue the Certificate of Registration for the trade mark. The date of registration will be the date of filing the application, unless a priority date is claimed, and will be registered for a period of 10 years and may be renewed.

Please note that it is open to the Registrar to withdraw acceptance of the application or reissue a new conditional acceptance up until the registration of the mark.

2.5 How is a trade mark adequately represented?

Pursuant to Regulation 19 of the TMR 1997, a representation of the trade mark shall be affixed to the form of application in the space provided for the purpose, and the representation shall be clear and mounted on durable material.

2.6 How are goods and services described?

Pursuant to Regulation 5 and Schedule 3 of the TMR 1997, goods and services are to be classified according to the Nice Classification and any amendments made from time to time. Section 25(2) of the TMA 1976 states that an application shall not be made in respect of goods or services falling under more than one class. The applicant is therefore not encouraged to list or claim the entire class heading of each class of goods or services in the application form.

Regulation 18(3) of the TMR 1997 further provides that in the case of an application for registration in respect of all the goods or services in one class, or a large variety of goods or services, the Registrar may refuse to accept the application unless he is satisfied that the specification is justified by the use of the mark which the applicant has made, or which he intends to make if and when it is registered.

2.7 What territories (including dependents, colonies, etc.) are or can be covered by a trade mark in your jurisdiction?

A trade mark registered in Malaysia covers only Malaysia.

2.8 Who can own a trade mark in your jurisdiction?

Any individual and body corporate claiming to be the proprietor of the mark may apply for registration of its trade mark, provided that he is either using the mark already or proposes to use it.

2.9 Can a trade mark acquire distinctive character through use?

Yes, a trade mark can acquire distinctive character through use. There is no specified period of time under which distinctiveness is acquired under the TMA 1976 or TMR 1997, and this will be judged on a case-by-case basis.

2.10 How long on average does registration take?

In cases of a smooth registration (where there are no objections raised during the examination and no opposition proceedings are filed), it can take an average time of 12 to 18 months before a trade mark is registered and the certificate of registration is issued by MyIPO.

2.11 What is the average cost of obtaining a trade mark in your jurisdiction?

The average cost for obtaining a trade mark in Malaysia can range from USD 600 to USD 1,000, depending on whether any objections are raised and, if so, the nature of these objections.

2.12 Is there more than one route to obtaining a registration in your jurisdiction?

At present, registration may only be obtained by way of filing an application to MyIPO.

Besides the general procedure for registration outlined in question 2.4 above, an applicant may request the Registrar to undertake an expedited examination of an application within four months from the date of filing of the application pursuant to Regulation 18A of the TMR 1997. The request for expedited examination must be supported by an affidavit or statutory declaration setting out the specific circumstances and reasons for the request as stated in the Regulations, namely:

- the request is in the national or public interest;
- there are infringement proceedings taking place or evidence showing potential infringement in respect of the trade mark applied for under Regulation 18;
- registration of the trade mark is a condition to obtain monetary benefits from the Government or institutions recognised by the Registrar; or
- there are other reasonable grounds which support the request.

2.13 Is a Power of Attorney needed?

A Power of Attorney is not needed for trade mark registration in Malaysia.

2.14 If so, does a Power of Attorney require notarisation and/or legalisation?

This is not applicable; please see question 2.13 above.

2.15 How is priority claimed?

An applicant wishing to claim priority must provide the details of the relevant international Convention priority or any other prescribed foreign country. The application for registration in Malaysia must be made within six months from the date of filing of the earlier application for protection in the Convention country and on which the priority is based. A certified copy of the priority document, together with its certified English translation (if the application is in another language), must be filed as soon as is reasonably practicable, and no later than 12 months from the date of filing of the Malaysian application, or the formalities shall be deemed incomplete.

2.16 Does your jurisdiction recognise Collective or Certification marks?

The TMA 1976 recognises Certification trade marks but not Collective marks.

3 Absolute Grounds for Refusal

3.1 What are the absolute grounds for refusal of registration?

The TMA 1976 does not demarcate between absolute grounds and relative grounds for refusal. All of the reasons why a mark may not be registered, as set out in question 2.2 above, are the same reasons a mark may be objected to by the Registrar. An objection based on a prior-cited mark is usually premised on Sections 14(1) (a), 19(1) and 19(2) of the TMA 1976.

Section 14(1)(a) of the TMA 1976 precludes a mark, or part of a mark, from being registered as a trade mark if the use thereof is likely to deceive or cause confusion to the public or would be contrary to law. Sections 19(1) and 19(2) of the Act prohibit the registration of any trade mark in respect of any goods or services that is identical to a trade mark belonging to a different proprietor in respect of the same or closely related goods or services or description of goods or services. These sections also prohibit registration of a trade mark that so resembles a registered trade mark as to be likely to deceive or cause confusion.

3.2 What are the ways to overcome an absolute grounds objection?

To overcome an absolute grounds objection, the applicant is required to submit a written reply which may, but need not necessarily, include proposals, conditions, amendments, modifications or limitations.

Relevant evidence may be also adduced, including: evidence of honest, concurrent use; evidence of prior and/or continuous use; proof of distinctiveness acquired through use; evidence of the mark being well known within the jurisdiction; registration in foreign jurisdictions; and coexistence of the mark and other identical or similar marks in foreign registries, etc.

3.3 What is the right of appeal from a decision of refusal of registration from the Intellectual Property Office?

Pursuant to Section 25(5) of the TMA 1976, an applicant may appeal the refusal of registration to the High Court. Once the decision of the Registrar following a hearing is communicated to the applicant in writing, and if the applicant objects to the Registrar's decision, the applicant will have to apply for the statement of the grounds of the decision of the Registrar, pursuant to Regulation 29(1) of Trade Marks Regulations 1997, within two months from the date of its receipt. The appeal will only be heard on the material stated by the Registrar to be used by him in arriving at his decision, and no other grounds of objection are permitted. The applicant, however, may be permitted to correct any error in his application as the Court sees fit.

3.4 What is the route of appeal?

The appeal must be lodged by way of originating summons within one calendar month of the Registrar's notification of refusal at the

High Court, and must be served on the Registrar. Prior to the filing of an appeal, the applicant may, within two months from the notification of refusal by the Registrar, request the Registrar's written statement of grounds of his decision and any material used in reaching the said decision, accompanied by a prescribed fee. If the applicant subsequently withdraws his appeal, he must give written notice of such intention to the Registrar and all interested parties.

A further appeal against the decision of the High Court may be filed at the Court of Appeal and Federal Court, provided that leave to appeal is granted.

4 Relative Grounds for Refusal

4.1 What are the relative grounds for refusal of registration?

Please see question 3.1 above.

4.2 Are there ways to overcome a relative grounds objection?

Please see question 3.2 above.

4.3 What is the right of appeal from a decision of refusal of registration from the Intellectual Property Office?

There is a right of appeal to the High Court against the refusal of registration by the Registrar. Please see question 3.3 above.

4.4 What is the route of appeal?

Please see question 3.4 above.

5 Opposition

5.1 On what grounds can a trade mark be opposed?

An opposition to a trade mark may be based on any of the grounds stated in question 2.2 above. Therefore, the opposition can be based on the ground that the trade mark does not fulfil the registrability requirements prescribed by the Trade Marks Act, which include that the:

- trade mark is not distinctive;
- use of the trade mark is likely to deceive or cause confusion to the public or would be contrary to law;
- trade mark is identical to, or so nearly resembles, a prior trade mark belonging to a different proprietor and entered in the Register in respect of the same goods/services or goods/services that are closely related to those goods/services;
- trade mark is identical to, or so nearly resembles, a mark which is well known in Malaysia; or
- applicant of the trade mark is not the *bona fide* proprietor of the subject mark.

5.2 Who can oppose the registration of a trade mark in your jurisdiction?

A trade mark can be opposed by any person once the trade mark has been advertised in the Government Gazette.

5.3 What is the procedure for opposition?

Within two months from the publication in the Government Gazette, the opponent may file a Notice of Opposition to the Registrar along with the grounds of opposition. Within two months from the receipt of the Notice of Opposition, the applicant may file and serve a counter-statement, which includes a statement setting out the grounds relied upon in support of the application. Within two months from the receipt of the counter-statement, the opponent may file and serve a statutory declaration to adduce evidence in support of his opposition.

The applicant then has his turn to file evidence in support of the application, also by way of a Statutory Declaration, and this is also to be done within a two-month timeline. The opponent then has a right to reply, and is to file his evidence in reply, by way of Statutory Declaration in Reply, within two months from the date of receipt of the applicant's Statutory Declaration. Upon completion of the evidence filed, the Registrar of Trade Marks will set a date for both parties to file their written submissions respectively.

The Registrar will consider the evidence before her and any written submissions, and deliver a written decision and notify the parties accordingly. All of the time periods stated above are subject to an application for an extension of time. The opposition is usually disposed of after consideration of documents filed, without the need for an oral hearing.

The decision of the Registrar of Trade Marks can be appealed to the High Court.

6 Registration

6.1 What happens when a trade mark is granted registration?

For each registration, a certificate is issued under the hand and seal of the Registrar. The applicant's trade mark will be entered into the Register, with the applicant being named as the registered proprietor.

6.2 From which date following application do an applicant's trade mark rights commence?

The applicant's rights will commence from the date of filing of the original registration, unless a priority date is claimed.

6.3 What is the term of a trade mark?

Trade mark registration is valid for 10 years from the date of application and may be renewed every 10 years.

6.4 How is a trade mark renewed?

At any time not less than three months before the expiration of a registered trade mark, the registered proprietor or his authorised agent may submit Form TM 12, together with the prescribed fee, to the Trade Marks Registration Office for the renewal of the mark.

7 Registrable Transactions

7.1 Can an individual register the assignment of a trade mark?

Yes. The individual becoming entitled to the trade mark by way of assignment may register the assignment, subject to the Registrar being satisfied of his proof of title.

7.2 Are there different types of assignment?

Under the TMA 1976, assignment may be done with or without goodwill. There may also be partial assignment of rights over the trade mark.

7.3 Can an individual register the licensing of a trade mark?

An individual who is the registered proprietor of a mark may register his licensees as registered users of the mark.

7.4 Are there different types of licence?

Although not specifically outlined in the TMA 1976, in practice, licences may consist of sole licences, exclusive licences and non-exclusive licences.

7.5 Can a trade mark licensee sue for infringement?

Subject to any agreement between the trade mark licensee (registered user) and the licensor (registered proprietor), the registered user has the right to commence a civil suit in his own name for trade mark infringement if the registered proprietor refuses or neglects to take any legal action within two months upon request by the registered user to do so.

7.6 Are quality control clauses necessary in a licence?

Under Section 48(6)(c) of the TMA 1976, quality control provisions in a licence are necessary for the purposes of registration of the licensee as a registered user.

In the case of *Playboy Enterprises International, Inc v. Zillion Choice Sdn Bhd & Anor* [2011] 2 CLJ 329, the High Court recognised that quality control is key to a licensing agreement which a trade mark proprietor is obliged to enforce. The High Court held that "the plaintiff's contractual right to approve products using its trademarks in advance of sales and distribution by the first defendant is a quality control measure, and quality control is a material term of any trademark licence".

7.7 Can an individual register a security interest under a trade mark?

There are currently no express provisions in Malaysian law allowing for the registration of security interests, although MyIPO is considering granting security interests (whether fixed or floating) over a registered trade mark or any right in or under a new TMA.

7.8 Are there different types of security interest?

Please see question 7.7 above.

8 Revocation

8.1 What are the grounds for revocation of a trade mark?

In Malaysia, revocation of a trade mark is done by way of cancellation or removal from the Register of the entry of a trade mark. There are two possible grounds for expunging, namely:

- (1) The first ground is that the entry was made without sufficient cause and ought not to have been registered in the first place.
- (2) The second ground is that of non-use pursuant to Section 46 of the TMA 1976:
 - a) the trade mark was registered without intention in good faith to use it and there has been no use in good faith for at least one month from the date of application to cancel the entry of the registered trade mark; and
 - b) there has been non-use for a continuous period of at least three years prior to the cancellation application.

8.2 What is the procedure for revocation of a trade mark?

An application for revocation of a trade mark shall be filed to the High Court by way of originating summons, supported by affidavit evidence pursuant to Order 87 r2 of the Rules of Court 2012.

8.3 Who can commence revocation proceedings?

An aggrieved person who has used the mark or has a genuine intention to use the mark is entitled to commence the relevant proceedings. In deciding what is a “person aggrieved”, the Federal Court explained in *McLaren International Ltd v. Lim Yat Meen* [2009] 4 CLJ 749, at paragraph 22, as follows:

“[22] We understand that passage as laying down the principle that a person aggrieved is a person who has used his mark as a trade mark - or who has a genuine and present intention to use his mark as a trade mark - in the course of a trade which is the same as or similar to the trade of the owner of the registered trade mark that the person wants to have removed from the register.”

8.4 What grounds of defence can be raised to a revocation action?

The Respondent has to produce evidence that he has used the mark or that the failure to use was due to special circumstances in the trade and not to an intention not to use or to abandon the trade mark in relation to the goods to which the application relates.

8.5 What is the route of appeal from a decision of revocation?

The High Court’s decision may be appealed to the Court of Appeal. The Court of Appeal’s decision may be appealed further to the Federal Court, subject to leave being granted.

9 Invalidity

9.1 What are the grounds for invalidity of a trade mark?

Pursuant to Section 45 of the Trade Marks Act 1976, an aggrieved person may bring an action to rectify or invalidate a registered trade mark on the grounds that the trade mark has been registered without sufficient cause or is an entry wrongfully remaining in the Register. Where the trade mark has been registered for more than seven years, there is a presumption as to the validity of the registration of the trade mark, unless it can be shown that:

- a) the original registration was obtained from fraud;
- b) the trade mark offends against Section 14 of the Trade Marks Act 1976 in that it is a mark that should not have been registered; or
- c) the trade mark was not, at the commencement of the proceedings, distinctive of the goods or services or the registered proprietor.

9.2 What is the procedure for invalidation of a trade mark?

An invalidation procedure can be initiated at the High Court by way of an Originating Summons supported by an affidavit.

9.3 Who can commence invalidation proceedings?

An aggrieved person/party can commence invalidation proceedings.

9.4 What grounds of defence can be raised to an invalidation action?

The common grounds of defence raised against an invalidation action would include proof of distinctiveness of the subject mark and evidence to rebut Section 14 of the TMA 1976, depending on the grounds relied upon.

9.5 What is the route of appeal from a decision of invalidity?

A party may appeal against a decision of invalidity from the High Court to the Court of Appeal. Subject to the granting of leave, the party may further appeal to the Federal Court against the decision of the Court of Appeal. Leave is only granted where either:

- there is a question of general principle decided for the first time or a question of importance on which a decision of the Federal Court would be of advantage to the public; or
- the decision relates to the effect of any provision of the constitution.

10 Trade Mark Enforcement

10.1 How and before what tribunals can a trade mark be enforced against an infringer?

A party may bring a civil action against the infringer in the High Court or file a complaint at the Ministry of Domestic Trade, Cooperatives and Consumerism (“MDTCC”) for criminal enforcement.

10.2 What are the key pre-trial procedural stages and how long does it generally take for proceedings to reach trial from commencement?

It will generally take about six months to one year for the proceeding to reach trial from commencement, depending on the complexity of the case at hand. Upon filing of the Writ and Statement of Claim, the Defendant will be required to file its Counterclaim or Statement of Defence. The Plaintiff is given the opportunity to file a reply to the Counterclaim or Statement of Defence. There will be pre-trial directions from the Judge to file, and exchange documents including the Statement of Agreed Facts and a Summary of Case by both parties.

10.3 Are (i) preliminary, and (ii) final injunctions available and if so on what basis in each case?

Both preliminary and final injunctions are available in Malaysia. Imminent infringement and irreparable harm that cannot be compensated with costs need to be shown for a preliminary injunction to be granted. The party seeking it must show that there has not been a delay in making the application, that there is a serious issue to be tried, and that if the infringing activities are not prevented immediately, damages will not be adequate compensation for the Plaintiff.

Generally, the Judge will consider the following in deciding whether to grant an injunction:

- a) *bona fide* serious issue to be tried;
- b) whether compensation would be insufficient;
- c) whether there is undertaking as to damages;
- d) full and frank disclosure;
- e) balance of hardship; and
- f) prompt application.

10.4 Can a party be compelled to provide disclosure of relevant documents or materials to its adversary and if so how?

Yes, a party can be compelled to provide disclosure of relevant documents or materials. An application can be filed by the other party for discovery of documents or materials at the High Court. Order 24 of the Rules of Court 2012 sets out the mechanism for the discovery and inspection of documents at any stage of the proceedings when the Court is of the opinion that the order is necessary for disposing fairly of the cause or matter. Order 24 rule 3 of the Rules of Court 2012 states that the Court may, at any time, order any party to a cause or matter (whether begun by writ, originating summons or otherwise) to give discovery by making, and serving on any other party, a list of the documents which are or have been in his possession, custody or power and may, at the same time or subsequently, also order him to make and file an affidavit verifying such a list and to serve a copy thereof on the other party.

10.5 Are submissions or evidence presented in writing or orally and is there any potential for cross-examination of witnesses?

Submissions or evidence may be presented in writing or orally, and cross-examination of witnesses is possible.

10.6 Can infringement proceedings be stayed pending resolution of validity in another court or the Intellectual Property Office?

Yes. Infringement proceedings may be stayed pending resolution of the validity of a trade mark.

10.7 After what period is a claim for trade mark infringement time-barred?

According to Section 6 of the Limitation Act 1953, actions of contract and tort, and certain other actions, shall not be brought after the expiration of six years from the date on which the cause of action accrued. A claim for trade mark infringement is time-barred after six years from the act of infringement. Any fresh act of infringement is considered a fresh accrual of action.

10.8 Are there criminal liabilities for trade mark infringement?

Yes. The Trade Descriptions Act 2011 provides for criminal remedies where a false trade description has been applied to a product. Any person who commits an offence under this Act for which no penalty is expressly provided shall, on conviction, be liable:

- (a) if such person is a body corporate, to a fine not exceeding RM 25,000, and for a second or subsequent offence, to a fine not exceeding RM 50,000; or
- (b) if such person is not a body corporate, to a fine not exceeding RM 10,000 or to imprisonment for a term not exceeding one year or to both, and for a second or subsequent offence, to a fine not exceeding RM 20,000 or to imprisonment for a term not exceeding three years, or to both.

10.9 If so, who can pursue a criminal prosecution?

The Attorney General may choose to prosecute on the advice of the MDTCC, the penalties being a fine of up to RM 10,000 or imprisonment for up to one year, or both, for the first offence; and a fine of up to RM 20,000 or imprisonment for up to three years, or both, for any subsequent offence.

10.10 What, if any, are the provisions for unauthorised threats of trade mark infringement?

There are no specific provisions.

11 Defences to Infringement

11.1 What grounds of defence can be raised by way of non-infringement to a claim of trade mark infringement?

Pursuant to Section 40 of the Trade Marks Act 1976, the following are acts that do not constitute an infringement of a trade mark:

- a) the use in good faith by a person of his own name or the name of his place of business or the name of the place of business of any of his predecessors in business;
- (b) the use in good faith by a person of a description of the character or quality of his goods or services, and in the case of goods not being a description that would be likely to be taken as importing any reference as is mentioned in paragraph 38(1)(b) or (b);

- (c) the use by a person of a trade mark in relation to goods or services in respect of which he has, by himself or his predecessors in business, continuously used from a date before:
- (i) the use of the registered trade mark by the registered proprietor, by his predecessors in business or by a registered user of the trade mark; or
 - (ii) the registration of the trade mark, whichever is the earlier;
- (d) the use in relation to goods connected in the course of trade with the registered proprietor or a registered user of the trade mark if, as to those goods or a bulk of which they form part, the registered proprietor or the registered user, in conforming to the permitted use, has applied the trade mark and has not subsequently removed or obliterated it;
- (dd) the use by a person of a trade mark in relation to goods or services to which the registered proprietor or registered user has, at any time, expressly or impliedly consented;
- (e) the use of the trade mark by a person in relation to goods or services adapted to form part of, or to be accessory to, other goods or services in relation to which the trade mark has been used without infringement of the right given or might, for the time, being so used, if the use of the trade mark is reasonably necessary in order to indicate that the goods or services are so adapted, and neither the purpose nor the effect of the use of trade mark is to indicate otherwise than in accordance with the facts a connection in the course of trade between any person and the goods or services; and
- (f) the use of a trade mark, which is one of two or more registered trade marks which are substantially identical, in exercise of the right to the use of that trade mark given by registration as provided by the Trade Marks Act 1976.

11.2 What grounds of defence can be raised in addition to non-infringement?

A party may counterclaim for cancellation on grounds of non-use, or may dispute the validity of the registered trade mark.

12 Relief

12.1 What remedies are available for trade mark infringement?

Remedies available for trade mark infringement would include an account of profits, an assessment of damages, and the delivery up and destruction of any offending materials. An Anton Piller Order is a mandatory order permitting the Plaintiff to enter specific premises to inspect and take into custody documents or articles relevant to the infringing action which may be destroyed or otherwise concealed by the Defendant. Its purpose is to preserve documentary evidence essential to the Plaintiff's case. Once proceedings have concluded, a final or perpetual injunction may be granted to prohibit further infringing activities.

12.2 Are costs recoverable from the losing party and, if so, how are they determined and what proportion of the costs can usually be recovered?

Yes, costs are recoverable from the losing party. In determining the costs usually awarded, the Court will take into consideration several factors, including the complexity of the case, the interlocutory applications filed, the number of witnesses, the time and knowledge required, the evidence tendered, and the conduct of the parties.

Upon a finding of infringement, the Courts may, in awarding and assessing damages, use different computations to determine the loss suffered by the trade mark owner or the gain obtained by the infringer, including the computation of any royalty which should have been paid, loss of profits and account of profits.

13 Appeal

13.1 What is the right of appeal from a first instance judgment and is it only on a point of law?

The right of appeal from a first instance judgment is not only on a point of law. Any party who is not satisfied with a decision or judgment can appeal from the High Court to the Court of Appeal. However, an appeal from the Court of Appeal to the Federal Court can only be brought in respect of a point of law.

13.2 In what circumstances can new evidence be added at the appeal stage?

Pursuant to Order 56 rule 1(3A) of the Rules of Court 2012, fresh evidence shall not be admitted at the hearing of an appeal from certain decisions of the Registrar of the High Court to a Judge in Chambers, unless the Judge is satisfied that:

- (a) at the hearing before the High Court or the subordinate Court, as the case may be, the new evidence was not available to the party seeking to use it, or that reasonable diligence would not have made it so available; and
- (b) the new evidence, if true, would have had or would have been likely to have had a determining influence upon the decision of the High Court or the subordinate Court, as the case may be.

In deciding whether to introduce fresh evidence, the Courts have generally applied the conditions set out in *Ladd v. Marshall [1954] 3 All ER 745*, namely: first, it must be shown that the evidence could not have been obtained with reasonable diligence for use at the trial; second, the evidence must be such that, if given, it would probably have an important influence on the result of the case, although it need not be decisive; and third, the evidence must be such as is presumably to be believed, or in other words, it must be apparently credible, although it need not be incontrovertible.

14 Border Control Measures

14.1 Is there a mechanism for seizing or preventing the importation of infringing goods or services and, if so, how quickly are such measures resolved?

There are border measure provisions in place in Malaysia under the TMA 1976, with specific provisions governing the seizure of counterfeit goods being imported into Malaysia. Under Section 70D of the TMA 1976, a registered trade mark owner, or its agent in Malaysia, must file an official objection to the importation of counterfeit goods with the Trade Marks Registrar. The application must provide very specific details of the shipment, including details of the importer, the registration number of the vehicle/aircraft/ship and the place where the goods would be arriving.

Upon receipt of the application, the Trade Marks Registry will determine the application and shall, within a reasonable period of time, inform the applicant as to whether the application has been approved. Once approved, the Trade Marks Registry shall immediately take the necessary measures to notify Customs, and they shall take the

necessary action to prohibit any person from importing goods identified in the notice, and shall seize and detain the identified goods. Such application/recordal shall remain in force for 60 days, commencing on the day on which the approval was given, and the importation of any counterfeit trade mark goods into Malaysia for that duration shall be prohibited.

15 Other Related Rights

15.1 To what extent are unregistered trade mark rights enforceable in your jurisdiction?

Section 82(2) of the TMA 1976 makes it clear that infringement rights are additional to, and not in substitution for, the right to sue for passing off. The main avenue for the enforcement of unregistered trade mark rights is therefore through commencing a civil action in common-law tort of passing off against the infringing party. Further, the proprietor of an unregistered trade mark may enforce his rights either by opposing the registration of a trade mark at publication stage or by applying to expunge a registered trade mark from the Register after the latter mark has been registered.

He may rely on his common-law rights of first use to do so.

15.2 To what extent does a company name offer protection from use by a third party?

A registered company name will prevent the registration of another company name sharing an identical name. No IP rights are conferred by virtue of registration of a company name.

15.3 Are there any other rights that confer IP protection, for instance book title and film title rights?

No such rights exist in Malaysia outside of the usual IP rights in trade mark, copyright, patents, etc.

16 Domain Names

16.1 Who can own a domain name?

Domain names may be owned by either any Malaysian organisation or individual or any organisation or individual residing in Malaysia, depending on the type of domain name applied for. Alternatively, a Malaysian individual applicant residing outside Malaysia may be registered, as long as he is over 18. Non-Malaysian companies have to have a presence in Malaysia in order to be registered.

Generally, a domain name ending with the extension “.my” is the top-level domain (“TLD”) for Malaysia. According to the Malaysian Network Information Centre Berhad (“MYNIC”), the following is the breakdown of who may apply for domain names of a particular type:

- All Malaysian entities, whether they are an organisation or individual, may apply for the second-level domain name “.my”.
- Organisations may apply for “.com.my”, “.net.my” and “.org.my”.
- Individuals aged 18 and above, holding a Malaysian National Registration Identity Card (“NRIC”), may apply for personal domain names under “.name.my”.
- Only certified agencies under the education, military and government sectors can apply for “.edu.my”, “.mil.my” and “.gov.my”; the registrations are directly under MYNIC.

16.2 How is a domain name registered?

MYNIC is the only body that registers the “.my” TLD for Malaysia, and all applications may therefore only be made with MYNIC or through their officially appointed partners, called resellers. In order to obtain registration for the Malaysia country code top-level domain (“ccTLD”), the registrant must have some form of “local presence” here; for example, a Malaysian company, registered business or a society. In the case of an application for “.my” by a company, the name and address of the company, the registration number at the Registrar of Companies, and the relevant Certificates of Incorporation are required.

In the case of a registration by a business, a certification by the Registrar of Business is required and, in the case of a registration by a society, the certification by the Registrar of Society. Applications for a domain name for “.gov.my”, “.mil.my” and “.edu.my” must be submitted online via MYNIC’s online registration system, whereas domain name applications for commercial activities or organisations under “.com.my”, network-related organisations/activities under “.net.my” and individuals’ personal use of “.name.my” are made through MYNIC’s officially appointed partners, called resellers.

Before making an application, the applicant should meet all of the prerequisites, including:

- having a live Internet link;
- setting up the primary and secondary name server and configuring them for the domain name to be registered;
- having Administrative, Technical and Billing Contacts; and
- complying with any other requirements on regulated names.

Within 14 days from the submission of the application, the applicant should submit any further supporting documents where required. Rejected applicants will be informed by way of a notice of rejection along with the reasons for rejection, and the applicant will be required to submit a new application if he wishes. Successful applications will also be notified and will have to pay the required fees to ensure the domain name is registered.

16.3 What protection does a domain name afford *per se*?

With the advent of the Internet in e-commerce and retail, the domain name has become an invaluable asset and has been considered the equivalent of a trade mark or trade name used to identify a commercial service or product on the Internet. No other person can register an identical domain name as long as the registrant continues to pay the annual subscription. Where a dispute arises, MYNIC’s Domain Name Dispute Resolution Policy (“MYDRP”) outlines the relevant administrative process applicable.

If a registrant believes that a domain name is identical or similar to his registered trade mark or service mark, or if the domain is being used in bad faith, he may lodge a complaint to the Kuala Lumpur Regional Centre of Arbitration (“KLRCA”), along with the prescribed fees. Any disputes shall be resolved at the KLRCA, the failure of which may invite other dispute resolution methods, including arbitration or Court proceedings.

At KLRCA, where a Complainant can successfully prove the above, and subject to the Respondent to the Complaint proving its rights and legitimate interests in the disputed domain name, the registration of the disputed domain name will be transferred to the Complainant or deleted. MYNIC does not play a role in the dispute resolution process other than to enforce the decisions passed to MYNIC by the Provider in accordance with the MYDRP Policy and Rules.

17 Current Developments

17.1 What have been the significant developments in relation to trade marks in the last year?

In 2018, the Malaysia Competition Commission (“MyCC”), an independent body established under the Competition Act 2010, published a draft guideline in respect of competition issues that may arise in relation to the use and exploitation of intellectual property rights. MyCC has requested feedback from the public on the draft guideline, and the draft guideline is expected to be finalised this year.

17.2 Please list three important judgments in the trade marks and brands sphere that have been issued within the last 18 months.


In the Federal Court case of *Merck KGaA v. Leno Marketing (M) Sdn Bhd* [2018] 2 CLJ 567, the Appellant (the Plaintiff in the High Court) was an international pharmaceutical company based in Germany. In Malaysia, the Appellant is the registered owner of the trade marks “BION” and “BION 3” in Classes 5, 29 and 30. On 18 July 2008, the Respondent (the Defendant in the High Court) applied *vide* application No. 08014118 to register the trade mark “Bionel” in Class 5 for goods of “pharmaceutical, veterinary and sanitary substance; infants’ and fat and invalids’ foods; plasters, materials for bandaging, materials for stopping teeth, dental wax; all included in Class 5”.

The Registrar accepted the Respondent’s application. Upon the publication of the Respondent’s application in the Gazette, the Appellant filed a notice of opposition before the Registrar under Section 28 of the TMA 1976. The main grounds of the Appellant’s opposition were that the Respondent’s mark was confusingly or deceptively similar to the Appellant’s mark, and that the registration would likely deceive or cause confusion amongst the public.

On 13 April 2015, having heard the parties, the Registrar dismissed the Appellant’s opposition and accordingly registered the Respondent’s trade mark. The Appellant appealed against the decision of the Registrar to the High Court pursuant to Sections 28(5) and 28(6) of the TMA 1976. On 22 January 2016, the High Court agreed with the findings of the Registrar and dismissed the Appellant’s appeal.

Dissatisfied, the Appellant appealed to the Court of Appeal. On 7 November 2016, the Court of Appeal dismissed the appeal, noting the concurrent findings of the High Court and the Registrar. The Appellant then appealed against the decisions of the High Court and Court of Appeal to the Federal Court. The respondent raised a preliminary objection in respect of whether the Appellant had the right to appeal all the way up to the Federal Court.

The Federal Court held that the High Court, in hearing an appeal from the Registrar’s decisions made pursuant to Section 28 of the TMA 1976, is, in actual fact, exercising its appellate jurisdiction. This decision is significant as it means that any cause or matter brought to the High Court under Section 28 of the TMA 1976 will end at the Court of Appeal and no further appeal can be taken to the Federal Court.

In the recent High Court case of *Korea Wallpaper Sdn Bhd v. Pendaftar Cap Dagangan* [2018] MLJU 1845, the High Court heard an appeal against the decision of the Registrar of Trade Marks in rejecting the trade mark application for “” (“the Mark”) on

the basis that it was not a distinctive mark stipulated in Section 10(1)(e) of the TMA. The High Court held that the supporting documents adduced by the Plaintiff were inadequate to connect the Mark with the general public, including consumers of the Plaintiff’s product. The High Court further held that the documents were principally self-serving documents which merely highlighted the Plaintiff’s or its subsidiary company’s corporate successes and achievements that may have nothing to do with the Mark whatsoever.

The Court concluded that there was no cogent evidence that supported the Plaintiff’s claim of public association of its product with the Mark and that, in the circumstances, the Plaintiff had failed to prove actual or factual distinctiveness in the Mark too. Hence, the Plaintiff did not succeed in establishing the registrability of the Mark pursuant to Section 10(1)(e) of the TMA 1976. This case suggests that in proving factual distinctiveness of a trade mark, it will be useful to have a detailed market survey by an independent researcher, with statistical results that connect the uninformed public and the Plaintiff’s product via the trade mark.

Finally, in the recent case of *Kong Kin Loong & Anor v. Kong Sou Keet & Ors* [2018] MLJU 1152, the High Court considered the novel question of whether a party can be subsequently cited as a co-defendant in an appeal to the High Court if the said party was not previously a party in the opposition proceedings before the Registrar. It was held that an appeal can only be instituted against a party who was previously a party in the opposition proceeding before the Registrar.

17.3 Are there any significant developments expected in the next year?

Malaysia’s accession to the Madrid Protocol has been much anticipated and discussed in the past few years, as it will provide the occasion to introduce several amendments to the TMA 1976. MyIPO has not yet announced a timeline for implementation of the Madrid Protocol, but it is expected to take place sometime this year or next year.

There is also a lot of publicity surrounding the Digital Free Trade Zone (“DFTZ”). Alibaba Cloud, the cloud computing arm of Alibaba Group, have established a new digital hub in Malaysia, together with the Malaysia Digital Economy Corp (“MDEC”), a co-working space that would position the country as a regional hub for start-up companies including small and medium-sized enterprises (“SMEs”). This is the first digital hub under the Electronic World Trade Platform (“eWTP”) initiative, and marks an advance in the realisation of the eWTP vision of empowering SMEs around the world and providing them with fair access to global markets. Brand owners doing business in Malaysia will need to step up their focus on anti-counterfeiting and IP rights protection in the area of global e-commerce.

17.4 Are there any general practice or enforcement trends that have become apparent in your jurisdiction over the last year or so?

The MDTCC has continued to be proactive in conducting trade mark enforcement activities in cooperation with Complainants and their legal counsel, including conducting raids and making referrals for criminal prosecution to the Deputy Public Prosecutor.

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Karen has broad experience in contentious IP work, IP litigation, enforcement and licensing programmes, anti-counterfeiting, exploitation of IP rights, competition law and broadcasting. She frequently appears in the High Court, Court of Appeal and the Federal Court representing local and global companies. She negotiates and advises on the exploitation and enforcement of IP rights for leading multinational companies around the world. Karen has also designed and crafted anti-piracy and anti-counterfeiting programmes, as well as brand management schemes from small to leading local and global companies. She further provides legal counsel on all allied IP rights relating to matters such as food and drugs, domain name disputes, licensing, agency franchising, merchandising, commercial sales contracts, sponsorship, advertising and entertainment, and media broadcasting laws.

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Janet is a partner with expertise in IP protection and ownership, advertising, consumer protection, copyright, domain names, franchising, gaming and regulatory approvals for food, drugs and cosmetics, as well as distributorship, licensing, outsourcing, service and consultancy agreements. She has also conducted due diligence for various acquisition projects. She regularly advises clients on regulatory matters in the e-commerce and telecommunications industries. She represents clients in the pharmaceutical, tobacco, retail and Internet-related services industries.

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