

Trade mark litigation in Malaysia: overview

Karen Abraham, Indran Shanmuganathan and Yap Khai Jian
Shearn Delamore & Co

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SOURCES OF LAW

1. What are the principal sources of law and regulation relating to trade marks and trade mark litigation?

The sources of Malaysian trade mark law are found in primary and secondary legislation and common law.

The principal trade mark legislation in Malaysia is the Trade Marks Act 1976 (Trade Marks Act) which deals with registration rights in Malaysia. There are also some relevant provisions in the Trade Descriptions Act 2011 (TDA) which deal with administrative and criminal sanctions for registered trade mark violations.

The common law is made up of judicial decisions of the courts of Malaysia as well as English cases, subject to the limitations set out in *Question 6*.

Malaysia has also acceded to a number of international agreements, conventions and treaties concerning trade marks, which include the:

- Paris Convention for the Protection of Industrial Property 1983 (Paris Convention).
- Trade Related Aspects of Intellectual Property Rights Agreement 1994 (TRIPS Agreement).
- Nice Agreement concerning the International Classification of Goods and Services for the Purpose of Registration of Marks 1957 (Nice Agreement).
- Vienna Agreement establishing an International Classification of the Figurative Elements of Marks 1973 (Vienna Agreement).

Malaysia's obligations under the above treaties and agreements have been substantially incorporated into Malaysian law by means of statutes made by Parliament.

COURT SYSTEM

2. Can third parties oppose/request cancellation of a national or supranational trade mark application/registration? If so, on what grounds?

Third parties can oppose an application for a national trade mark as well as apply to court for the cancellation of a national trade mark. The Madrid Agreement and Protocol have yet to be applied although there are strong indications that Malaysia will accede to the Madrid Protocol soon.

Oppositions

A trade mark can be opposed by any person once the trade mark has been advertised in the Government Gazette. The opposition must be based on the ground that the trade mark does not fulfil the registrability requirements prescribed by the Trade Marks Act which includes 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 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.
- Applicant of the trade mark is not the bona fide proprietor of the subject mark.

Opposition proceedings are commenced by filing of a Notice of Opposition at the Trade Marks Registry and serving it on the applicant. On receipt of the Notice of Opposition, the applicant can file a counter statement in support of the application.

Then evidence is filed and exchanged by both parties by way of Statutory Declarations. On the completion of the filing of evidence, the Registrar gives directions to the parties to file their respective written submissions. 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.

Cancellation/rectification

Trade mark cancellation actions are commenced at first instance at the High Court by any person aggrieved by the registration of a trade mark. The mode of action is by Originating Summons supported by affidavit evidence. The action can be converted into a writ action if the court decides that the case involves substantial disputes of fact, which can be best resolved only by way of oral witness testimony. Such cases are, however, rare.

The power of the court to cancel a trade mark is set out in sections 45 and 46 of the Trade Marks Act.

The court has a general power to, among others, cancel an entry wrongfully entered or wrongfully remaining on the register maintained under the Trade Marks Act (*section 45(1)(a)*). Other provisions including those governing the registrability and the right to claim ownership of a trade mark can be relied on to determine the validity of the registration.

A trade mark can be cancelled either on the basis that it was registered without genuine intention on the part of the registered proprietor to use the trade and/or where there has been no bona fide use of the mark for a continuous period of at least three years up until one month before the application for cancellation.

3. Which courts/government bodies enforce registered trade mark rights?

Civil matters concerning registered trade mark infringement and the validity of trade mark registrations are heard at the High Court.

There is an IP Court in Kuala Lumpur to hear civil IP disputes, including registered trade mark disputes. Criminal prosecutions under the Trade Descriptions Act 2011 (TDA) are heard at the Sessions Court. Opposition proceedings commence at the Trade Mark Registry.

4. Who can represent parties before each court set out above?

As matters concerning trade mark infringement and the validity of trade mark registrations are heard before the courts of Malaysia, only an advocate and solicitor of the High Courts of Malaya and the High Courts of Sabah and Sarawak can represent the litigating parties.

On the other hand, registered trade mark agents can represent parties in contentious matters (for example, opposition proceedings) at the Trade Mark Registry.

5. What is the language of the proceedings? Is there a choice of language?

All proceedings, other than the giving of evidence orally by a witness in court are conducted in Bahasa Malaysia, which is the national language of Malaysia as provided under the National Language Act 1963/67. However, the court can permit the proceedings to be conducted in English where warranted in the interest of justice. In practice, the use of English is permitted and is frequently used in the courts, especially in the superior courts.

Any document filed in the High Court of Malaya has to be in Bahasa Malaysia. The document can be accompanied by an English translation. On the other hand, any document filed in the High Court of Sabah and Sarawak must be in English and can be accompanied by a translation in Bahasa Malaysia.

6. To what extent are courts willing to consider, or are bound by, the decisions or opinions of other national or foreign courts that have handed down decisions in similar cases?

By virtue of section 3(1) of the Civil Law Act 1956, only English common law as administered in England and Wales up until 7 April 1956 is binding in Malaysia (subject to different findings in the superior courts in Malaysia). Further developments or changes in English common law after the said date are not binding in Malaysia but may be of persuasive value.

As Malaysia is a common law country and part of the British Commonwealth, the shared English common law heritage has allowed the decisions of other British Commonwealth countries, in particular, the UK, Singapore and Australia to constitute persuasive authority and are frequently relied on in the case of trade mark matters especially where the respective legislative provisions in question are similar to or where the subject matter is the same.

Limitation periods

7. What limitation periods apply to registered trade mark infringement actions?

Limitation for civil actions is governed by the Limitation Act 1953. The limitation period for an action to recover damages for registered trade mark infringement is six years from the last act of infringement.

SUBSTANTIVE LAW

8. Are unregistered trade marks protected in your jurisdiction?

Unregistered trade marks are protected under the common law tort of passing off. The Trade Marks Act explicitly provides that none of its provisions can be deemed to affect right of action for passing off or the remedies in respect of such an action.

The law of passing off essentially recognises and protects business goodwill which is usually identified by a trade mark, trade name or get-up from being unlawfully misappropriated thereby resulting in damages.

9. How is a registered trade mark infringement assessed?

Registered trade mark infringement occurs if a party other than the registered proprietor or registered user of a trade mark uses in the course of trade (either as a trade mark or to import a reference to the registered proprietor) a trade mark which is identical to or confusingly and deceptively similar to that registered trade mark in relation to goods covered by the registration.

Unless the third party's trade mark is identical to the registered trade mark, there is the need to show confusion and deception which is determined by comparing and viewing the marks in totality and taking into account factors including:

- The idea conveyed by the marks.
- The phonetic and visual effect of the marks.
- The principle of "imperfect recollection".
- A comparison the essential features of the marks.

Protection can extend to cover translations or to conceptually identical but graphically different trade marks if these are found to cause confusion. Likewise, the trade mark can be enforced against domain names, trade names, pseudonyms so long as such use is trade mark use and results in confusion and deception.

10. On what grounds may a proprietor lose rights in a registered trade mark?

Rights to a registered trade mark can be lost if it is not renewed, or if it is revoked or cancelled (*see Question 2*). A trade mark can be cancelled on the application of an aggrieved person on the grounds of non-use or where the trade mark is an entry wrongfully entered or wrongfully remaining on the register. The registered proprietor can also seek voluntary cancellation of a registered trade mark.

11. What defences, if any, are available to an alleged infringer?

Defences available in a registered trade mark infringement action include the following:

- Use in good faith by a person of his or her own name.
- Use in good faith of a description of the character and quality of goods or services or which is not deemed as trade mark use.
- Prior use.
- Implied consent.
- Use of a trade mark in the exercise of rights conferred by registration.

12. Can a trade mark holder plead registered trade mark infringement and passing off/unfair competition in the alternative in the same action?

It is common for both trade mark infringement and passing-off actions (based on unfair competition) to be filed in the same proceedings based on the same or similar set of facts.

PARTIES TO LITIGATION

13. Who can sue for trade mark infringement?

Trade mark holder

The general rule is that an action for trade mark infringement must be commenced by the registered owner of the trade mark.

Exclusive licensee

Apart from the owner of a trade mark, a registered user of the trade mark, subject to any agreement between the registered user and the registered owner, can bring an action for trade mark infringement in its own name where the registered proprietor:

- Has been called on by the registered user to take proceedings for trade mark infringement.
- Refuses or neglects to do so within two months of being called upon.

In the above circumstances, the registered owner is made a defendant in the proceedings brought by the registered user in its own name. The registered owner so added as a defendant is not liable for costs unless it enters an appearance and takes part in the proceedings.

Thus any licensee of a trade mark must be a registered user before it has the rights to commence an action for infringement as outlined above.

Non-exclusive licensee

The position of a non-exclusive licensee is similar to that of an exclusive licensee.

14. Who can be sued for trade mark infringement?

An action for registered trade mark infringement is taken against the party who uses the trade mark and/or a confusingly and deceptively similar trade mark in Malaysia in relation to goods covered by the registration. By this definition, registered trade mark infringement actions are usually commenced against manufacturers and importers of infringing products or any party who "uses" the offending trade mark within the definition of "use" prescribed by the Trade Marks Act.

Company directors can be sued personally for registered trade mark infringement where they are held and found to be the directing minds of the company which is indulging in acts of trade mark infringement (*Chanel v Melwani2 International Sdn Bhd* [2017] MLJU 344).

15. What type of acts amount to primary and secondary registered trade mark infringement?

There are no provisions in the Trade Marks Act prescribing liability for secondary infringement or causing infringement (unlike in the Copyright Act 1987). Primary infringement would be the acts carried out by parties as referred in *Question 14*.

However, based on the recent High Court case of *Chanel v Melwani2 International Sdn Bhd* [2017] MLJU 344, a director, shareholder or officer of a company can be held to be personally liable for infringement of trade mark by their company if it can be shown that they are the directing minds of the company.

16. Under what conditions, if any, can an alleged infringer bring proceedings to obtain a declaratory judgment on non-infringement?

The Courts have unlimited discretionary powers to make declaratory orders of non-infringement (*section 41, Specific Relief Act 1950, read together with order 15, rule 16, Rules of Court 2012*). For the court to grant a binding declaration of the rights, three conditions must be satisfied:

- The question under consideration is a real question.
- The party seeking the declaration has a real interest or *locus standi*.

While negative declarations are generally not granted as a matter of course, declarations of non-infringement of intellectual property rights have been granted so as long as it can be shown that the aims of justice are achieved by the declaration.

17. Is it possible to add or remove parties during litigation?

Parties may be joined in an action either as claimants or defendants with leave from the court where (*order 15, rule 4, Rules of Court 2012*):

- Some common question of law or fact arises in all the actions, even if separate questions are bought by or against each of them.
- All rights to relief claimed in the action are in respect of or arises out of the same transaction or a series of transactions.

The court can order separate trials where the joinder of causes of action or the parties can embarrass or delay the trial or otherwise delay the trial (*order 15, rule 5, Rules of Court 2012*).

Further, the court may, at any stage of the proceedings, order any writ or pleadings to be struck off in an action against a defendant that (*order 18, rule 19, Rules of Court 2012*):

- Discloses no reasonable cause of action or defence.
- Is scandalous, frivolous or vexatious.
- May prejudice, embarrass or delay the fair trial of the action.
- Is otherwise an abuse of process of the court.

ENFORCEMENT OPTIONS

18. What options are open to a trade mark holder when seeking to enforce its rights in your jurisdiction?

Civil proceedings

A registered proprietor may initiate a civil action in the High Court for trade mark infringement, passing-off or cancellation of a trade mark.

Criminal proceedings

There is also the criminal enforcement option under the Trade Descriptions Act 2011 (TDA).

The TDA prescribes offences for applying, supplying, offering to supply or exposing for supply goods or services bearing false trade

descriptions. A trade mark which infringes the Trade Marks Act could amount to a false trade description rendering the applying, supplying, offering to supply or exposing for supply goods or services bearing the infringing trade mark to be offences under the TDA.

Where the infringing trade mark is not identical to the registered trade mark, the registered proprietor can apply to the court for a Trade Description Order (TDO) to declare that the infringing trade mark is a false trade description under the TDA as this would be necessary in support of any further enforcement action.

Enforcement actions are initiated by lodging a complaint with the enforcement wing of the Ministry of Domestic Trade Cooperative and Consumerism (MDTCC), supported by the relevant supporting documents (including the TDO if necessary). The MDTCC would then conduct enforcement action, including search and seizure followed by prosecution if necessary. Offences under the TDA attract the penalties of a fine and/or imprisonment.

Border measures

There are border measures available under Part XIVA of the Trade Marks Act and section 31 of the Customs Act.

A registered trade mark owner must file an official objection to the importation of counterfeit goods with the Trade Mark's Registrar (*section 70D, Trade Marks Act*). If it is approved, the Registrar notifies an "authorised officer" at the customs who then takes the necessary action to prohibit the importation of goods identified in the notice, and conducts the necessary raids and seizures and detain the identified goods.

The Minister of Domestic Trade Cooperative and Consumerism is permitted by order to prevent the import into and export from Malaysia of any prohibited goods both absolutely and conditionally (*section 31, Customs Act 1967*). While "counterfeit goods" have not been expressly included as "prohibited goods" within the definition of the Customs Act, "prohibited goods" have been defined to include goods which are prohibited by any other written law, which could in this case include the Trade Marks Act.

19. Is it advisable to send a letter before action (cease and desist letter) to an alleged infringer before commencing registered trade mark infringement proceedings?

It is not compulsory to send a cease and desist letter to an alleged infringer before registered trade mark infringement proceedings are initiated. However, this may be advisable in certain instances, particularly where there is a wish to resolve the dispute without the necessity of litigation or where the claimant wishes to show the court that attempts were made to resolve the dispute.

There are currently no provisions in the Trade Marks Act in relation to the unjustified threats of registered trade mark infringement.

20. To what extent are your national courts able to grant cross-border or extra-territorial injunctions (preliminary or permanent)?

The Malaysian courts do not grant cross-border or extra-territorial injunctions as trade mark rights are territorial in nature.

21. To what extent are arbitration and alternative dispute resolution (ADR) methods (such as mediation) available to resolves trade mark disputes?

Arbitration

Arbitration in Malaysia is governed by the Arbitration Act 2005 which is based on the UNCITRAL Model Law on International Commercial Arbitrations. The said Arbitration Act applies to all arbitral proceedings with their seats in Malaysia.

Arbitration is frequently used in construction matters where arbitration clauses are present in standard forms of building contracts, and to resolve shareholder, commodities, joint venture, information technology and other large commercial disputes. Most disputes can be arbitrated in Malaysia and there is no requirement that the dispute must be of a commercial nature or arise from a contractual dispute and can therefore apply to trade mark disputes. However, arbitration is rarely chosen by parties in a trade mark dispute.

ADR

Mediation is also available for parties in a dispute. Mediation in Malaysia is governed by the Mediation Act 2012. All disputes can be resolved via mediation except for matters specifically excluded in the Schedule to the Mediation Act.

The Mediation Act expressly states it does not apply to proceedings involving injunctions. As injunctions would often be the principal remedy in trade mark infringement or passing-off actions, mediation may not be ideal for such disputes.

PROCEDURE IN CIVIL COURTS

22. What is the format of trade mark infringement proceedings?

Trade mark infringement proceedings are started at the High Court by a writ action. This is done by filing a writ and statement of claim. The defendant can file a defence if it wishes to contest the claim and if necessary a counterclaim. The claimant then files its reply and/or defence to the counterclaim. Once this is done, the pleadings are deemed closed.

Following the close of pleadings, the court gives directions at case management stage on the conduct of proceedings up to trial. This includes discovery and agreement of the parties on facts and issues so that the facts in dispute and issues for trial are narrowed. The parties are usually required to provide their list of witnesses as well as witness statements before trial.

Trial is conducted by an examination of the witnesses in open court. The witnesses are subject to examination in chief, cross examination and re-examination if necessary.

On completion of the trial, the court usually provides directions for the filing of written submissions and then fixes a date for oral submissions/clarification before giving its decision.

23. Is a fast-track procedure available?

Generally, the courts can at any time before the commencement of proceedings direct parties to attend pre-trial case management relating to the matters arising in the action. During the pre-trial case management, the court can direct the parties to comply with certain directions within a period of time in order to secure a just, expeditious and economical disposal of the action or proceeding.

Generally, there are no fast-track proceedings for trade mark disputes, although any party or parties can apply to court on a Certificate of Urgency to expedite the proceedings or any particular application. The grant of expedited proceedings is at the discretion of the judge hearing the case who would require cogent reasons before proceeding on an expedited basis.

24. What are the rules and practice concerning evidence in trade mark infringement proceedings in your jurisdiction?

Documents

Documents are largely used as evidence in support of the parties' respective cases. The court gives directions on the filing and exchange of documents between the parties during pre-trial case management sessions. The documents filed are usually classified as follows:

- Part A: documents where the contents and authenticity are not disputed.
- Part B: documents where the authenticity is not disputed but the contents are disputed.
- Part C: documents where the authenticity and contents are disputed.

Witness evidence

Witness evidence is given in cases begun by writ or where there is an application to cross examine the deponent of an affidavit. In writ actions, evidence in chief is usually given by way of a witness statement which is either read out by the witness in court or confirmed by the witness in court. The witness is then subject to cross-examination and can later be re-examined.

Expert evidence

Expert evidence can be given and the procedure for its introduction is governed by section 45 of the Evidence Act 1950 and order 40/order 40A of the Rules of Court 2012.

25. To what extent is survey evidence used (for example, to support acquired distinctiveness, or likelihood of confusion)? What is its evidential value?

Survey evidence is admissible as evidence and given sufficient weight as proving a public state of mind on a specific question or as proving an external fact, namely that a designated opinion is held by the public or a class of the public.

Survey evidence is often scrutinised and viewed with caution by the court (*Syarikat Zamani Hj Tamin Sdn Bhd & Anor v Yong Sze Fun & Anor* [2006] 5 MLJ 262).

The admissibility and weight of such evidence depends on its compliance with the guidelines for the survey as stipulated in the case of *Imperial Group Plc & Anor v Phillip Morris* [1984] RPC 293 (as applied by the Malaysian Federal Court in *Liwayway Marketing Corporation v Oishi Group Public Company Limited* [2017] 5 CLJ 133). The following factors are taken into account:

- Methodology of the survey must be disclosed.
- Totality of all answers must be disclosed.
- Questions posed to the interviewees must not be leading.
- Exact answers and not abbreviations must be provided.
- Coding must be accurately carried out and coding methods disclosed.
- Instructions given to interviewers must be disclosed.

Where the survey evidence does not comply with the above guidelines, it will either be disregarded or given very little or no weight.

The survey cost is generally not recoverable.

26. Is evidence obtained for criminal proceedings admissible in civil proceedings, and vice versa?

Evidence obtained from criminal proceedings is admissible in civil proceedings and vice versa.

27. To what extent is pre-trial discovery permitted and what other mechanisms are available for obtaining evidence from an adverse party or third parties?

Pre-trial discovery

Order 24 of the Rules of Court 2012 sets out the mechanism for the discovery and inspection of documents.

However in practice, directions on discovery usually take place at the pre-trial case management (see *Question 24*).

Other mechanisms

The High Court is empowered to order the discovery of documents on the application of any party to an action upon the failure by the other party to comply with the requirements for discovery under the Rules of Court 2012.

Failure to comply with the rules of discovery may, in more serious cases, result in an action being dismissed, or a defence being struck out and judgment entered accordingly.

Notwithstanding these provisions, usually directions on discovery are given at the case management stage.

28. Can an order be made to establish proof of infringement (saisie-contrefaçon)? If not, what other mechanisms, if any, are available?

Where there is a risk that evidence essential to a claimant's case may be destroyed or concealed, the claimant can apply to the courts for an Anton Piller Order. The Anton Piller Order permits the claimant to enter into the defendant's premises to inspect and take into custody any documents and articles specified in the order. Any document or article taken into custody can be used by the claimant as evidence.

29. How long do trade mark infringement proceedings typically last?

Trade mark infringement proceedings from the time the writ is filed up to the conclusion of the case when the decision is rendered typically take between 12 and 18 months, depending on the number of witnesses and the complexity of the claim. As mentioned, it is possible to expedite proceedings by filing a Certificate of Urgency (see *Question 23*).

The parties can, conferring with the court, agree on a binding timetable for the proceedings. This is however still subject to the discretion of the court and the availability of dates.

30. What options, if any, are available to a defendant seeking to stay the proceedings?

The defendant can apply to stay proceeding in certain circumstances by making a formal application to court by way of notice of application supported by affidavit. The court in deciding on the application has the discretion to stay proceedings although valid and cogent reasons have to be provided. Usually proceedings are stayed if there are pending issues in another suit or matter which could have an impact in the case before the court.

PRELIMINARY RELIEF

31. Is preliminary relief available?

Pre-emptive remedies such as interlocutory injunctions (ex parte and inter partes) are available on application to court. The principles for the granting interlocutory injunctions laid down in the landmark case of *American Cyanamid Co v Ethicon Ltd [1975] AC 396* have been adopted by the Court of Appeal in Malaysia in *Keet Gerald Francis Noel John v Mohd Noor bin Abdullah [1995] 1 MLJ 193*. The judge should consider whether:

- There is a *bona fide* serious issue to be tried.
- The balance of convenience favours the grant of the interlocutory injunction.
- The award of damages at the end of the trial to a successful claimant would not offer adequate relief.

The claimant will usually be required to give an undertaking as to damages before the interlocutory injunction is granted which would be called upon if the injunction is granted and the claimant fails to sustain the action after full trial.

Injunctive relief is equitable in nature. An interlocutory injunction must be applied for as soon as the claimant becomes aware that its trade mark is infringed. Any inordinate delay in the application may be fatal unless it is justified and adequately explained.

In an ex parte application for an interlocutory injunction, all material facts must be disclosed. Any suppression or misrepresentation of any material fact, even due to an error of judgment, may be fatal and result in the ex parte injunction being set aside and the claimant being liable for all damages suffered. Ex parte injunctions however are for a limited period of time and the court will subsequently have to hear arguments by both parties if the interlocutory injunction is to be extended beyond the limited period.

Apart from the interlocutory injunction, a Mareva injunction can also be obtained if the claimant has evidence that the defendant is dissipating its assets to avoid having to pay damages likely to be ordered against it. The defendant's bank accounts can be frozen and the order can extend to assets outside Malaysia. The onus is on the claimant to establish the need for such an order.

32. Can a protective writ be filed at the court at which an ex parte application may be filed against that defendant?

All writs must disclose a reasonable cause of action and are necessary if ex parte relief is sought against the defendant.

33. What is the format for preliminary injunction proceedings?

General

An application for preliminary/interlocutory injunction is made by way of a Notice of Application accompanied by an affidavit in support. An inter partes interlocutory application will be heard in chambers by the judge, based on affidavit evidence filed by both parties. If the application is made ex parte, it is heard on the basis of the applicant's affidavit evidence only.

Level of proof

At the interlocutory injunction proceedings, a claimant is required to establish infringement on a prima facie basis and the judge is not required to decide on the full merits of infringement. The claimant is required to show that there is serious issue to be tried and the balance of convenience favours the grant of the injunction.

Evidence

Evidence at interlocutory injunction proceedings is provided by way of affidavit evidence.

Trade mark validity

The validity of the trade mark may have a bearing on the case although the court is unlikely to decide on the merits of validity at the interlocutory stage. However this may in certain cases tilt the balance of convenience one way or the other.

Length of proceedings

Ex parte injunctions on a certificate of urgency can be disposed of fairly quickly, in urgent cases within days or weeks. However ex parte injunctions last only for a few weeks and would have to be extended by the court upon hearing both parties.

Inter partes interlocutory injunctions, either in its original form or to extend an ex parte injunction take between two and six months to be concluded. This varies depending on various issues including the urgency or complexity of the matter.

FINAL REMEDIES

34. What remedies are available in a registered trade mark infringement action?

Permanent injunction

Permanent injunctions are available against a registered trade mark infringer.

Monetary remedies

Damages in the form of monetary remedies are recoverable. Damages are usually assessed at a separate stage after the conclusion of the trial on liability. However, there have been instances when both liability and quantum are decided at the same time at the conclusion of the trial.

Delivery up or destruction of infringing goods

The registered proprietor can seek for an order for delivery up of the goods bearing the infringing trade mark or destruction of the same on oath.

Publication of the decision

The decision of the court in relation to trade mark cancellation, infringement and passing off cases are normally reported and/or published in law journals.

Recall order

The registered proprietor can seek a recall order against the infringer.

Declaration of infringement and validity

A declaration of infringement and validity can be sought against a registered trade mark infringer.

Others

In certain circumstances, a public apology can also be sought against a registered trade mark infringer. The court can also exercise its discretion to consider other reliefs as it thinks just and fit.

35. How are monetary remedies assessed against a registered trade mark infringer?

Damages are either assessed based on the losses suffered by the claimant as a result of the infringing activities of the defendant or in the alternative for the defendant to account its profits from its infringing activities. In certain circumstances, exemplary or aggravated damages can also be ordered by the court based on the facts of the case.

Appeal remedies

36. What routes of appeal are available to the unsuccessful party?

A defeated party can appeal against a judgment or order from the High Court to the Court of Appeal on both questions of fact and law. The appeal from the High Court to the Court of Appeal is a re-hearing based on the record of appeal so filed.

A further appeal from the Court of Appeal lies with the Federal Court. Appeal is not as of right and prior leave has to be obtained from the Federal Court. 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.

However, if the appeal arises from a judgment or order of the Sessions Court, the defeated party can appeal to the High Court and then to the Court of Appeal. There is no further right to appeal to the Federal Court.

Appeals from the High Court to the Court of Appeal usually conclude within one year and thereafter appeals to the Federal Court (if leave is granted) take another year.

Litigation costs

37. What level of cost should a party expect to incur to take a case through to a first instance decision, preliminary injunction proceedings and appeal proceedings?

The legal costs for trade mark litigation largely depend on a number of factors such as the complexity of the matter, facts and issues involved, the number of witnesses and days of hearing and the seniority and reputation of the solicitors and counsel engaged.

Cost of the proceedings can be recovered from the losing party at the discretion of the judge. Costs are taxed by the court and often the full cost is not recoverable.

REFORM

38. What are the important developing and emerging trends in your country's trade mark law?

One of the major developments in the law is the possible amendment of the Trade Marks Act 1976 as Malaysia has signed but not acceded to the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks (Madrid Protocol).

ONLINE RESOURCES

Legislation

W <http://www.parlimen.gov.my/>

Description. Official website of the Malaysian Parliament. Order papers, Bills to be Tabled, Acts of Parliament and verbatim reports of daily proceedings, in English as well as Malay.

W <http://www.msc.com.my/cyberlaws/>

Description. Statutes in relation to cyberlaws and intellectual property

Practical Law Contributor profiles

Karen Abraham, Head of IP

Shearn Delamore & Co
T +603 2027 2893
E karen@shearndelamore.com
W www.shearndelamore.com

Professional qualifications LLB (Hons) degree, University of Adelaide; Graduate Diploma in Legal Practice; Barrister and solicitor, South Australia Supreme Court; Advocate and solicitor, High Court of Malaya; Industrial Design Agent; Trade mark Agent.

Areas of practice Contentious IP work; litigating IP disputes; anti-counterfeiting; enforcement and licensing programmes; exploitation of IP rights; competition law; broadcasting; all aspects of information technology; telecommunications.

Indran Shanmuganathan, Partner

Shearn Delamore & Co
T +603 2027 2873
E indran@shearndelamore.com
W www.shearndelamore.com

Professional qualifications LLB (Hons), University of Leicester; Advocate and solicitor, High Court of Malaya; Advocate and solicitor, Supreme Court of Singapore; Barrister-at-Law, Lincoln's Inn; Industrial Design Agent; Trade mark Agent.

Areas of practice. Trade marks; copyright; industrial designs; industrial designs and patent infringement litigation; rectification and invalidation proceedings relating to registered trade marks; industrial designs and patents; enforcement of IP rights through the relevant government agencies; agreements related to intellectual property and IT; consumer laws; prosecution of trade mark and industrial design applications.

Yap Khai Jian, Associate

Shearn Delamore & Co
T +603 2027 2806
E yapkhaijian@shearndelamore.com
W www.shearndelamore.com

Professional qualifications LLB (Hons), University of Malaya; Advocate and solicitor, High Court of Malaya.

Areas of practice Trade marks; copyright; trade mark and patent infringement litigation; rectification and invalidation proceedings relating to registered trade marks and patents; enforcement of IP rights through the relevant government agencies; agreements related to intellectual property and IT; franchise; advisory on IP or IT related matters; prosecution of trade mark applications.