

# ICLG

The International Comparative Legal Guide to:

## Trade Marks 2014

**3rd Edition**

A practical cross-border insight into trade mark work

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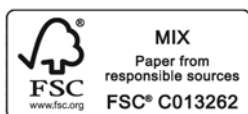
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## EDITORIAL

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Welcome to the third edition of *The International Comparative Legal Guide to: Trade Marks*.

This guide provides corporate counsel and international practitioners with a comprehensive worldwide legal analysis of trade mark laws and regulations.

It is divided into two main sections:

One general chapter entitled *Trade Mark Law Shapes Up for the Thrust into the 21st Century*.

Country question and answer chapters. These provide a broad overview of common issues in trade mark laws and regulations in 42 jurisdictions.

All chapters are written by leading trade mark lawyers and industry specialists and we are extremely grateful for their excellent contributions.

Special thanks are reserved for the consulting editor Paul Walsh of Bristows for his invaluable assistance.

Global Legal Group hopes that you find this guide practical and interesting.

The *International Comparative Legal Guide* series is also available online at [www.iclg.co.uk](http://www.iclg.co.uk).

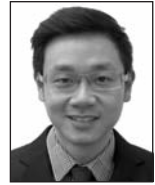
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# Malaysia



Bee Yi Lim



Wee Liang Lim

## Tay & Partners

### 1 Relevant Authorities and Legislation

#### 1.1 What is the relevant Malaysian trade mark authority?

The Office of the Registrar of Trade Marks, under the purview of The Intellectual Property Corporation of Malaysia (MyIPO), has superintendence over all matters relating to trade marks and upon which have been conferred specific powers and functions.

#### 1.2 What is the relevant Malaysian trade mark legislation?

The main legislation is the Trade Marks Act 1976 (“the 1976 Act”), whereas the Trade Description Act 2011 provides additional protection and remedies for trade mark owners. The Trade Mark Regulations 1997 was legislated to carry into effect the provisions of the 1976 Act.

### 2 Application for a Trade Mark

#### 2.1 What can be registered as a trade mark?

A device, brand, heading, label, ticket, name, signature, word, letter, numeral or any combination thereof which contains or consists of at least one of the following particulars:

- a) the name of an individual, company or firm represented in a special or particular manner;
- b) the signature of the applicant for registration or of some predecessor in his business;
- c) an invented word or words;
- d) 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
- e) any other distinctive mark.

#### 2.2 What cannot be registered as a trade mark?

A mark which contains any of the following traits is non-registrable:

- (a) prohibited mark which will likely deceive or cause confusion to the public or would be contrary to law;
- (b) scandalous or offensive matter;
- (c) contrary to law;
- (d) prejudicial to the interest or security of the nation;

- (e) identical with or so nearly resembles a mark which is well-known in Malaysia for the same goods or services of another proprietor;
- (f) if it is well-known and registered in Malaysia for goods or services not the same as to those in respect of which 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, and the interests of the proprietor of the well-known mark are likely to be damaged by such use;
- (g) misleading geographical indication with respect to goods as to its origin;
- (h) misleading geographical indication with respect to wines and/or spirits as to the origin;
- (i) the word or words “Patent”, “Patented”, “By Royal Letters Patent”, “Registered”, “Registered Design”, “Registered Trade Mark”, “To counterfeit this is a forgery”, “Registered Service Mark” and “Copyright” or a word or words to the like effect in any language whatsoever;
- (j) specifically declared by the Minister in any regulations made under the 1976 Act to be a prohibited mark;
- (k) the words “Bunga Raya” and the representations of or any colourable imitation of the hibiscus flower;
- (l) representations of or references to the King or State Ruler;
- (m) representations of, colourable imitation of or references to any of the royal palaces or any building owned by the Federal Government, State Government or any other government;
- (n) the word “ASEAN” and the representation or colourable imitation of its logo;
- (o) the words “Red Crescent” or “Geneva Cross” and representations of these and other crosses in red, or of the Swiss Federal Cross in white or silver on a red ground, or such similar representations;
- (p) representations of, or mottoes of or words referring to the royal/imperial arms, crest, armorial bearings/insignia/devices resembling any of them;
- (q) representations of, or mottoes of or words referring to the imperial/royal crowns, royal/imperial/national flags;
- (r) 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 nearby resembling them;
- (s) 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 appears on a mark;

- (t) a name of a single chemical element or compound;
- (u) non-distinctive; and
- (v) direct reference to the character or quality of the goods or services.

### 2.3 What information is needed to register a trade mark?

The following information is required for the registration of a trade mark:

- (a) a representation of the mark;
- (b) the class of goods or services;
- (c) a list of goods or services;
- (d) the full name and address of the applicant;
- (e) the full name and address of the trade mark agent and his registration number and reference (if applicable);
- (f) the priority date, Convention country registration number for International Convention priority claim (if applicable);
- (g) the date of the first use of the mark in Malaysia (if applicable);
- (h) 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
- (i) endorsement of the application with a certified transliteration and/or translation of the mark which contains non-Roman characters.

### 2.4 What is the general procedure for trade mark registration?

After submitting the application for trade mark registration, the Registrar will cause the application to be examined. The first examination is procedural, as the Registrar will determine if the formalities of the application are complied with and that the class of goods stated in the application is not too wide or general. The second examination is substantive in nature. The Registrar will search amongst registered marks and pending applications to ascertain if the mark applied for complies with the 1976 Act.

The Registrar may then refuse the registration, accept it without conditions or accept it under conditions or subject to amendments. If the Registrar accepts the application absolutely, he will send a notification form to the applicant to be signed and then returned to him with payment of a fee. Upon receipt of the fee, the mark will be advertised in the Gazette, open for opposition for two months from the date of publication. A Certificate of Registration of the Trade Mark, carrying with it the seal of the Registrar, shall be issued after a two-month duration for opposition lapses without any opposition or successful opposition.

If the Registrar objects to the application, the applicant needs to submit a written reply containing arguments in support of the application, proposals, conditions, amendments, modifications or limitations within two months of the objections. The failure of the applicant to do so renders his application abandoned. However, where the Registrar maintains his objections upon receipt of the written reply, the applicant needs to apply for a hearing accompanied with a prescribed fee within two months from the date of receipt of the Registrar's decision. The hearing date will be notified to the applicant.

If the applicant objects the decision of the Registrar following the hearing, the applicant may require the Registrar to state the grounds

of his decision as well as the materials used in arriving at the Registrar's decision.

If the Registrar's acceptance of the application is conditional, the required modifications must be made. However, if the applicant has any objections to the conditions, the applicant needs to submit written objections within two months. Failure of the applicant to do so renders the application abandoned. If the Registrar maintains his objections to the application upon receipt of the applicant's written objections, the applicant needs to apply for a hearing accompanied with a prescribed fee within two months from the date of receipt of the Registrar's decision.

### 2.5 How can a trade mark be adequately graphically represented?

It must be clear and durable. An original representation of the mark instead of photocopies is preferable, although the Registrar may request a better representation if the Registrar is not satisfied with the original representation. A coloured representation must be supplemented with clear endorsement of the colour limitation. A mark registered without any colour limitation means it can be used with any colour. For the purpose of advertisement, the mark must be represented in a form approved or directed by the Registrar or in a manner which he thinks fit and such a representation shall be of such dimensions as the Registrar requires.

### 2.6 How are goods and services described?

The 45 classes of goods and services are classified in the manner prescribed in the Third Schedule to the Trade Mark Regulations 1997, which is in accordance with the International Classification of Goods and Services for the purposes of the Registration of Marks by virtue of Nice Agreement of 15 June 1957 ("the Nice Classification"). Malaysia became a member of this agreement on 28 June 2007.

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

Only Malaysia is strictly covered by a Malaysian trade mark.

### 2.8 Who can own a Malaysian trade mark?

Any person who uses or proposes to use the mark may apply to register the mark as a proprietor. This includes non-Malaysians.

### 2.9 Can a trade mark acquire distinctive character through use?

Yes it can. Such use must be able to distinguish the mark from other traders by taking into account the number of years the mark has been in the market or that a secondary meaning has been acquired in law such that the public associates the mark with the goods or services.

### 2.10 How long on average does registration take?

Approximately two years, assuming the application is a smooth application (i.e. with no oppositions, objections and/or amendments).

The process may, however, be expedited. An application for expedited examination of the registration of a trade mark may be

made within four months from the date of the filing of the application for registration if the Registrar is satisfied that:

- the request is in the national or public interest;
- there are infringement proceedings taking place or evidence showing potential infringement;
- registration of the trade mark is a condition to obtaining monetary benefits from the Government or institutions recognised by the Registrar; or
- any other reasonable grounds;

accompanied with a prescribed fee and a statutory declaration stating the reasons for requesting the expedited examination.

### 2.11 What is the average cost of obtaining a Malaysian trade mark?

Where the application is supplemented with expedited examination, the overall cost will be RM 2,470. Otherwise, the normal cost of a smooth registration is RM 1,020.

### 2.12 Is there more than one route to obtaining a registration in Malaysia?

The route is as explained above.

### 2.13 Is a Power of Attorney needed?

No, it is not.

### 2.14 How is priority claimed?

Priority is claimed by stating in the application for registration of trade mark the Convention country or prescribed foreign country in which the application for protection was made, the reference number of the first application and the date on which such application for protection was made.

### 2.15 Does Malaysia recognise Collective or Certification marks?

Malaysia recognises Certification marks but not Collective marks.

## 3 Absolute Grounds for Refusal

### 3.1 What are the absolute grounds for refusal of registration?

There is no such distinction of absolute and relative grounds for refusal of registration, unlike the United Kingdom. The 1976 Act provides a list of grounds for refusal of registration:

- the mark is likely to deceive or cause confusion to the public or would be contrary to law;
- the mark is scandalous or offensive or would not be entitled to protection by any court of law;
- the mark contains a matter which might be prejudicial to the interest or security of the nation;
- the mark is identical with or so nearly resembles a mark which is well-known in Malaysia for the same goods or services of another proprietor;
- the mark is identical with or so nearly resembles a mark which is well-known in Malaysia for the goods or services of

another proprietor that are not the same as those in respect of which the registration is applied for;

- the mark has geographical indication with respect to goods not originating in the territory indicated and if the use of the indication for such goods in Malaysia is of such a nature as to mislead the public as to the true place of origin of the goods;
- the mark is for wine which has a geographical indication identifying wines, or is a mark for spirits which has a geographical indication identifying spirits, not originating in the place indicated by the geographical indication in question;
- separate applications are made by different applicants to be registered as proprietors respectively of trade marks which are identical or so nearly resembling each other as are likely to deceive or cause confusion;
- the mark is identical with a prior trade mark belonging to a different proprietor in respect of the same goods or description of goods or in similar services; and
- the mark is not distinctive.

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

To overcome the grounds of objection, the applicant needs to adduce evidence contrary to the objections raised by the Registrar. Evidence of honest, concurrent, prior and/or continuous use will be useful if the mark applied for is identical to or so nearly resembling another trade mark in the Register. Other evidence that can be adduced to overcome the grounds of objections consists of proof of the distinctiveness of the mark acquired through use, registration in foreign jurisdictions and co-existence of the mark and other identical or similar marks in foreign registries.

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

The Act 1976 gives no general right of appeal against any decision of the Registrar except where it is expressly provided in the Act. The applicant can appeal against the decision of the Registrar to the High Court in relation to any entry or correction sought to be made.

### 3.4 What is the route of appeal?

- 1) The applicant for registration must obtain the Registrar's written statement of grounds of his decision and any materials used in arriving at the decision, accompanied with a prescribed fee, within two months from the date of notification of refusal by the Registrar.
- 2) Where such appeal is permitted, the appeal is made by way of Originating Summons to the High Court of Kuala Lumpur within one month of the date of the decision appealed against (which is the date when the decision of the Registrar is being sent to the applicant).
- 3) The applicant must serve the notice of appeal to the Registrar.
- 4) The applicant must then apply for appeal to the High Court within the stated one-month period. The failure to do so renders the appeal or application abandoned.
- 5) Subsequent to the appeal, in the event the applicant becomes entitled to registration and intends to withdraw his appeal, he needs to give notice of intention in writing to the Registrar and all interested parties.

## 4 Relative Grounds for Refusal

### 4.1 What are the relative grounds for refusal of registration?

Please refer to question 3.1.

### 4.2 Are there ways to overcome a relative grounds objection?

Please refer to question 3.2.

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

Please refer to question 3.3.

### 4.4 What is the route of appeal?

Please refer to question 3.4.

## 5 Opposition

### 5.1 On what grounds can a trade mark be opposed?

A trade mark may be opposed on these grounds:

- that the trade mark that is applied for is identical or confusingly similar to a trade mark belonging to the opponent. If the opponent is the registered proprietor of a trade mark, the main provision to rely on is Section 19 of the 1976 Act, whereas a common law proprietor of a trade mark may rely on Section 14 of the 1976 Act as his basis of opposition. Please refer to question 3.1 for the grounds of opposition; and
- that the trade mark cannot be registered. Please see question 2.1 for the requirements for a mark to meet the registrability threshold.

### 5.2 Who can oppose the registration of a Malaysian trade mark?

Anyone can launch an opposition of the registration of a Malaysian trade mark.

### 5.3 What is the procedure for opposition?

An opposition may be made by an opponent by giving a written notice to the Registrar within two months from the date of any advertisement in the Gazette of an application for registration of a trade mark. The notice must include a statement of grounds of opposition.

The applicant may file and serve a counter-statement setting out the grounds of supporting his application against the opposition within two months of the receipt of the notice of opposition.

Within two months of the receipt of the counter-statement, the opponent shall file and serve a statutory declaration to adduce evidence in support of his opposition. The applicant must respond to the opponent's statutory declaration within two months of the receipt of the statutory declaration, by filing and serving his evidence in the form of a statutory declaration to support his application. The opponent may, in turn, file and serve evidence in reply to the applicant's statutory declaration by way

of a statutory declaration within two months from the receipt by the opponent of the applicant's statutory declaration.

Upon completion of the exchanges of statutory declarations, the Registrar shall give notice to the parties of a date (at least one month after the date of receipt by the parties) by which they may send to him any written submissions. The Registrar shall consider the evidence and any written submissions and communicate to the parties in writing his decision within two months of receipt of the written submissions.

## 6 Registration

### 6.1 What happens when a trade mark is granted registration?

The Certificate of Registration of the Trade Mark, carrying the seal of the Registrar, shall be issued to the applicant, and his trade mark shall be entered in the Register of Trade Marks.

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

The date of application for registration shall be deemed to be the date of registration. For a priority application, the date of registration is the priority date.

### 6.3 What is the term of a trade mark?

The registration of a trade mark shall be for a period of 10 years from the date of registration. For the applicant that is claiming priority under the Paris Convention for the Protection of Industrial Property, the term of the trade mark shall be 10 years from the date of the application for protection in the Convention country or prescribed foreign country concerned.

### 6.4 How is a trade mark renewed?

An application for the renewal of the registration of the trade mark must be made at least three months before the expiration of the last registration, accompanied by a prescribed fee. A trade mark may be renewed every 10 years from the date of expiration of the original registration or of the last renewal of registration.

If the fee and the appropriate form for renewal have not been received by not less than one month and not more than two months before the expiration of the last registration of the trade mark, the Registrar shall notify the registered proprietor in writing of the impending expiration.

Renewal as late as within one month from the expiration of the last registration of the trade mark must be accompanied with a late renewal fee. The Registrar shall renew the registration without removing the mark from the Register if the late renewal fee and appropriate form have been filed but the renewal fee has not been paid. However if the late renewal fee has not been paid by the end of the period of one month from the expiration of the last registration of the mark, the Register shall remove the mark from the Register. Restoration of the mark in the Register is possible by payment of restoration fee within one year from the expiration date.

## 7 Registrable Transactions

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

An individual who becomes entitled by assignment to a registered trade mark must apply to register his title by causing particulars of the assignment to be entered in the Register and filing the relevant form, accompanied by a prescribed fee.

The application for entering the assignment in the Register shall state whether the mark was at the time of the assignment used in a business in any of the goods or services and whether the assignment was made with or without the goodwill of the business. For an assignment without goodwill, the assignment shall be advertised in a newspaper or other publications approved by the Registrar and the advertisement must state the assignment was otherwise than in connection with the goodwill of the business concerned. A copy of the advertisement must be filed with the Registrar.

### 7.2 Are there different types of assignment?

Yes. An assignment without goodwill of the business is one of them. Another type of assignment is called a partial assignment, where as a result of the division and separation of the goods or services of a registration, or a division and separation of places or markets, different persons become registered as proprietors separately.

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

If the registered proprietor of a trade mark grants a right to any person to use the trade mark for all goods or services by a lawful contract, that person or licensee may be entered on the Register as a registered user of said trade mark.

An application to the Registrar must be made to enter the licensee as the registered user of the trade mark by filing the prescribed form, accompanied by the prescribed fee. Separate applications must be made for each proposed registered user of the mark.

### 7.4 Are there different types of licence?

There are a few types of licences: one-off licence; sole licence; exclusive licence; or a non-exclusive licence.

### 7.5 Can a trade mark licensee sue for infringement?

Subject to any agreement between the registered user (trade mark licensee) and the registered proprietor (licensor), the former may institute proceedings for infringement if the proprietor refuses or neglects to do so within two months from the request. He may also apply to the court for relief if the registered proprietor fails to exercise any of the rights conferred on him by the registration of his licence.

### 7.6 Are quality control clauses necessary in a licence?

It is provided under the 1976 Act that it shall be a condition for the registration of the licence that the registered proprietor shall retain and exercise control over the use of the trade mark and over the quality of the goods or services provided by the registered user.

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

This is not provided under the laws of Malaysia.

### 7.8 Are there different types of security interest?

This is not applicable. Please see question 7.7.

## 8 Revocation

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

A revocation of a trade mark is essentially a cancellation of the entry of a trade mark in the Register. The common grounds of cancelling the entry are:

- that the trade mark was registered without an 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
- no use for a continuous period of at least three years prior to the application to cancel the entry of the registered trade mark.

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

The procedure is to apply to the High Court to rectify the Register, supported by an affidavit.

### 8.3 Who can commence revocation proceedings?

Only an 'aggrieved person' can commence revocation proceedings. 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 trade which is the same as or similar to the trade of the owner of the registered mark that the person wants to have removed from the Register. In other words, a person aggrieved is a person who is in some way or another affected by the existence of the mark to be removed.

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

The grounds of defence would be that there has been use of the mark, use of an associated mark on goods for which he has a registration and special circumstances in the trade and not to an intention not to use or to abandon the trade mark.

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

The decision of the High Court can be appealed to the Court of Appeal. The Federal Court is deemed the final appellate court. However, please see question 17.1 for clarification.

## 9 Invalidity

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

There is a presumption that the registration of a person as proprietor of a trade mark is *prima facie* evidence of the validity



of the original registration of the trade mark and all subsequent assignments and transmissions.

The original registration of the trade mark shall, after the expiration of seven years from the date of registration, be presumed valid unless:

- the original registration was obtained by fraud;
- the trade mark offends against Section 14 of the 1976 Act as stipulated in question 3.3; and
- the trade mark was not distinctive when rectification proceedings began.

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

Invalidation proceedings are initiated at the High Court by way of an Originating Summons supported by an affidavit.

## 9.3 Who can commence invalidation proceedings?

Only an aggrieved person can commence invalidation proceedings.

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

The grounds of defence that can be raised against an invalidation action are generally evidence contrary to the grounds for the invalidation action, such as the proof of distinctiveness of the mark when rectification proceedings commenced, evidence that rebuts the allegation of offence under Section 14 of the 1976 Act and evidence of registration in good faith and honesty.

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

Please refer to question 8.5.

# 10 Trade Mark Enforcement

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

The registered proprietor of a trade mark can either:

- commence a civil action at the specialised Intellectual Property High Court;
- apply for a trade description order; and
- file a complaint with the Ministry of Domestic Trade, Cooperatives and Consumerism (MDTCC). The Enforcement Division of the MDTCC will conduct a raid and seizure action. This is followed by a fine/prosecution against the offender.

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

- 1) The defendant must enter his appearance within eight or twelve days, whichever is prescribed, after the Originating Summons is served.
- 2) The defendant needs to file his defence within 14 days from entering his appearance.
- 3) The plaintiff may reply to the defence within 14 days from service of the defence.

- 4) Pleadings are deemed closed 14 days after the filing of the reply by the plaintiff.
- 5) The plaintiff must then file a case management notice.

Case management usually commences from the moment the plaintiff files its Originating Summons and parties appear before the Registrar of the Intellectual Property High Court for directions. The common case management directions are as follows:

- a statement of the issues to be tried must be filed;
- a statement of agreed facts must be filed;
- common documents for trial, which are separated into three bundles (admitted, agreed and non-agreed bundles), must be filed;
- a list of witnesses must be filed; and
- witness statements must be filed and served before the trial.

A case is often set down for trial within six months to a year from the commencement of proceedings, depending on the availability of the free dates of the court.

## 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. Other interlocutory relief available include *Anton Piller* orders and *Mareva* injunctions. Preliminary or interlocutory injunctions are granted at the discretion of the court. An interlocutory injunction may be obtained on an *ex parte* or *inter partes* basis.

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

A party can be compelled to provide disclosure of documents by discovery process. In a Writ action, discovery is done by serving notice to the other party to produce documents. Documents to which legal privilege is attached are, however, not discoverable. Confidential documents may be disclosed subject to confidentiality orders of the court.

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

In an action for trade mark infringement, proceedings are commenced by an Originating Summons, and therefore witnesses will have to attend court. The examination in chief is now done by way of witness statements, which are taken to be read in the court. The witnesses shall take the stand and be offered for cross-examination by the opposing party.

In an action for revocation or invalidation of a registered trade mark, proceedings are usually commenced by way of an Originating Summons unless there are substantial disputes as to facts in which the more appropriate mode of commencement would be by way of Writ. Evidence is adduced by way of affidavits in actions commenced by way of an Originating Summons. There are provisions for a party to apply to the court to cross-examine a deponent of an affidavit.

At present, all arguments and submissions before the Intellectual Property High Court are to be made in writing, with counsels given an opportunity to make oral arguments or clarification as the court may direct.

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

Infringement proceedings may be stayed pending resolution of the validity of a trade mark. However, as invalidation proceedings are also before the High Court, it is common for both invalidation and infringement actions to be consolidated (if they were commenced separately) and heard together, or for the party seeking invalidation to be heard first.

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

An action for trade mark infringement is time-barred after six years from the act of infringement. In the case of continuing infringement, the limitation period may not actually set in, although there could be other defences, such as laches, delay or acquiescence, that are available to a defendant.

### 10.8 Are there criminal liabilities for trade mark infringement?

Criminal liabilities for trade mark infringement are provided via administrative action of the MDTCC. Upon the successful raid and seizure action by the Ministry, the prosecution may prosecute the offender or offer a compound of the offence.

Upon conviction for false trade description, if it is a body corporate, it may be liable for a fine not exceeding RM 250,000, or RM 500,000 if it is the second or subsequent offence, and if it is not a body corporate, to a fine not exceeding RM 100,000 or to imprisonment not exceeding three years or to both, and for a second or subsequent offence, to a fine not exceeding RM 250,000 or to imprisonment not exceeding five years or to both.

### 10.9 If so, who can pursue a criminal prosecution?

The Public Prosecutor can pursue a criminal prosecution.

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

Currently there are no provisions for unauthorised threats of trade mark infringement under the relevant laws.

## 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?

The grounds of defence include but are not limited to:

- the defendant's mark will not likely deceive or cause confusion;
- the defendant's mark is distinguishable from the plaintiff's; and/or
- the defendant did not use the plaintiff's trade mark.

The statutory grounds of defence of non-infringement are as follows:

- 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;

- 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 to the registered proprietor;
- the continuous 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, from a date before:
  - (i) the use of the registered trade mark by the registered proprietor, by his predecessor in business or by a registered user of the trade mark; or
  - (ii) the registration of the trade mark, whichever is the earlier;
- use by a person in relation to goods which form part of the bulk of goods connected in the course of trade with the registered proprietor or registered user, where the registered proprietor or registered user has applied the trade mark and has not removed or obliterated it;
- where use is expressly or impliedly consented to by a registered proprietor or registered user;
- use in relation to goods or services adapted to form part of, or to be an accessory to, other goods or services in relation to which the trade mark has been used without infringement, if the use is reasonably necessary to indicate that the goods or services are so adapted and such use does not have the purpose or effect of indicating otherwise than in accordance with the facts in connection in the course of trade between any person and the goods or services; and
- use of 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.

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

Please refer to question 9.4.

## 12 Relief

### 12.1 What remedies are available for trade mark infringement?

The remedies available for a trade mark infringement are damages for losses, injunction, delivery-up and/or destruction of the infringing items, discovery of all relevant information and documents in connection with the infringement and legal costs. In the case of counterfeits or blatant infringement, the court has also granted relief in the form of a public apology by the infringer but this is not a remedy that is granted as of right.

### 12.2 Are costs recoverable from the losing party and if so what proportion of the actual expense can be recovered?

The costs awarded to the winning party will be taxed by the court. The successful party is typically expected to recover only between 40% to 60% of actual incurred legal costs and expenses.

## 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 to the Court of Appeal in respect of the whole or any part of judgment, and can be

based on a point of fact or law, or both. However an appeal from the Court of Appeal to the Federal Court can only be based on point of law, and leave to appeal must be sought. However, please take note of question 17.1.

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

The general rule is that new evidence is not admissible at the appeal stage. The exception to this rule is where it can be shown that the evidence could not have been obtained with reasonable diligence for use at trial and the evidence would probably have an important influence on the result of the case though it may not be decisive, and it must be apparently credible although it need not be incontrovertible.

## 14 Border Control Measures

### 14.1 What is the mechanism for seizing or preventing the importation of infringing goods or services and if so how quickly are such measures resolved?

The registered proprietor of a registered trade mark or an agent of the proprietor may submit an application to the Registrar to object to the importation of, in relation to the registered trade mark, counterfeit trade mark goods at a time and place specified in the application. The application must be accompanied by the prescribed fee, an affidavit and five copies of the application. The affidavit must state that the applicant is the proprietor of the mark or the agent having the power to submit such application, the registration number of the trade mark, the representation of the mark and interest of the applicant in the mark. The alternative method is to request Customs authorities who have the relevant authority to detain the suspected infringing good or services.

## 15 Other Related Rights

### 15.1 To what extent are unregistered trade mark rights enforceable in Malaysia?

Unregistered trade marks are enforceable by the tort of passing off. The owner of an unregistered trade mark must establish that the mark has 'goodwill' in Malaysia in relation to goods or services which are the subject of the passing off action. 'Goodwill' is the benefit and advantage of the good name, reputation and connection of a business. In order to commence a passing off action, the owner must prove there is misrepresentation by another party and that damage has been caused to the goodwill of the owner's business through the unlawful association created between the other party and the owner. Goodwill of a business can be licensed and assigned.

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

The registration of a company name does not automatically protect the company name from being used by a third party. A company has to register its company name as a trade mark or rely on its common law right of business goodwill to protect itself against third party use of its company name.

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

No, there are not.

## 16 Domain Names

### 16.1 Who can own a domain name?

Malaysian organisations, Malaysian and non-Malaysian individuals, commercial organisations or activities, network-related organisations or activities, Malaysian educational organisations, Malaysian governmental organisations, and Malaysian military organisations can own a domain name.

### 16.2 How is a domain name registered?

Domain name registration is made through the Malaysian Network Information Centre Berhad (MYNIC) only. Domain name applications for Malaysian educational organisations (.edu.my), Malaysian governmental organisations (.gov.my) and Malaysian military organisations (.mil.my) must be submitted online via MYNIC's online registration system instead of email. Applications for a domain name for commercial activities or organisations (.com.my), network-related organisations/activities (.net.my) and Malaysian individuals' personal use (.name.my) are to be made through MYNIC's officially appointed partners called Resellers. The application needs to be supplemented with supporting documents within 14 days from the submission of the application. If the application is rejected, the applicant will receive a rejection notice stating the reason for rejection. The unsuccessful applicant must go through the process all over again from the start if the applicant intends to apply again. Successful applicants will have to pay the required fees to ensure the domain name remains registered.

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

Once a domain name has been registered, there can be no identical domain with a '.my' prefix. The domain name will remain unique to the registered user so long as the subscription is paid.

If a domain name is identical or similar to a trade mark or service mark in which the proprietor has rights to, or if the domain is being used in bad faith, the dispute can be brought to the Kuala Lumpur Regional Centre of Arbitration (KLRCA) by submitting a complaint and paying the prescribed fees. In cases where disputes are not resolved at the KLRCA, the complainant may institute proceedings at the court, resort to arbitration, or any other dispute resolution process as agreed by both parties.

Available remedies through proceedings at the KLRCA are the transfer of registration of the domain name to the complainant or deletion of the registration. Damages and compensation are only available through court action or arbitration proceedings.

## 17 Current Developments

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

The Federal Court, in a landmark decision last year in the case of *Tio Chee Hing v United Overseas Bank (Malaysia) Bhd* [2013] 2

CLJ 910 held that the decisions of the High Court in an appeal against the decisions of the Land Registrar or, in the context of a trade mark case, the Registrar of Trade Marks, are subject to a final appeal to the Court of Appeal and that the Federal Court is precluded from hearing the matter. It appears from this decision the final avenue to appeal against the decision of the Registrar of Trade Marks is in the Court of Appeal and not the Federal Court.

One of the preconditions to apply for leave to appeal to the Federal Court is that the appeal must be against a judgment or order of the Court of Appeal in respect of any civil cause or matter decided by the High Court in the exercise of its 'original jurisdiction'. The respondent had filed a preliminary objection against the application on the ground that the impugned decision was not made by the High Court in the exercise of its 'original jurisdiction', and therefore the requirement of Section 96(a) was not met. In considering the preliminary objection by the respondent, the Federal Court disapproved of the approach in *Yong Teng Hing v Walton International Ltd; Pendaftar Cap Dagang, Malaysia (Interested Party)* [2011] 7 CLJ 401 FC. The Federal Court held that the main issue was not to consider if the Land Registrar or Registrar of Trade Marks is a subordinate court but to instead determine whether the High Court exercises original jurisdiction or appellate jurisdiction when hearing the appeal from the Land Registrar. The Federal Court reasoned that it was not for the Federal Court to look into the factual matters or to undertake an inquiry of the status of the inferior court in order to categorise it as a subordinate court when that should have been resolved at the High Court.

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#### 17.2 Are there any significant developments expected in the next year?

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There are ongoing plans for Malaysia to join the Madrid Protocol, as the Ministry gave informal indications that this might take place

in 2014. Malaysia is already in the final stages of ratification and/or implementation of the Madrid Protocol to become a Member State. There is likely to be new legislation to replace or supplement the current legal framework, and to bring provisions of the trade mark law up to date with the current international trade mark regime, such as the introduction of non-traditional marks, security interests and accession to the Madrid Protocol.

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#### 17.3 Are there any general practice or enforcement trends that have become apparent in Malaysia over the last year or so?

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Although still short of becoming a Malaysian trend or general practice in trade mark registration, we expect the move by Apple Inc in filing application for registration of trade mark for the term 'startup' will encourage interested applicants to try their luck with registering marks which are conventionally viewed as non-distinctive and non-inventive. The same pattern of applications by Apple Inc has been taken in various jurisdictions, including the United States, Australia and Singapore. This may not surprise experienced IP practitioners due to the sheer amount of unconvincing applications they have been directed to make. A successful registration of 'startup' by Apple Inc will likely attract legal actions for trade mark infringements. It will also open the floodgate to audacious application for words and combinations of words which are generally regarded as generic.

**Bee Yi Lim**

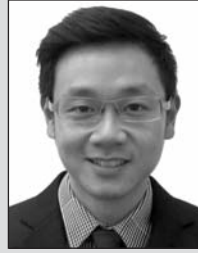
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An integral part of her practice is advising on trade mark, copyright and industrial design infringement matters. She has extensive experience in opposition proceedings in various industries, and has recently worked in the areas of fashion, and the food and beverage and media industries.

Bee Yi read law at the University of West of England, United Kingdom, and was called to the Bar of England and Wales by the Honourable Society of the Inner Temple. She was admitted as an Advocate and Solicitor of the High Court of Malaya in 2008.

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