

# TRADEMARKS BILL 2019

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## ARRANGEMENT OF CLAUSES

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### PART I

#### PRELIMINARY

*Clause*

1. Short title and commencement
2. Interpretation
3. Definition of “trademark”
4. Definition of “well-known trademark”
5. Definition of “earlier trademark”
6. Definition of “infringing goods”, “infringing material”, “infringing articles”, “counterfeit goods” and “counterfeit trademarks”
7. References to use of trademark
8. Use of trademark for export trade or where form of trade changes
9. Determination of likelihood of confusion

### PART II

#### ADMINISTRATION

10. Registrar, Deputy Registrars and Assistant Registrars
11. Protection of Registrar, Deputy Registrars, Assistant Registrars and other officers
12. Trademarks Office and other branch offices
13. Preliminary advice and search by Registrar

### PART III

#### THE REGISTER OF TRADEMARKS

14. Register of Trademarks
15. Inspection of Register

## PART IV

## REGISTRATION OF TRADEMARKS

## Chapter 1

*Introductory**Clause*

16. Registered trademark

## Chapter 2

*Application for registration of trademark*

17. Application for registration of trademark
18. Application in multiple classes
19. Classification of goods or services
20. Colour of trademark
21. Series of trademarks
22. Date of filing

## Chapter 3

*Grounds for refusal of registration*

23. Absolute grounds for refusal of registration
24. Relative grounds for refusal of registration
25. Honest concurrent use, etc.

## Chapter 4

*Priority*

26. Claim to priority of Convention application
27. Claim to priority from other relevant overseas application
28. Claim to priority from temporary protection of trademark which is the subject matters of international exhibition given under Article 11 of Paris Convention

Chapter 5

*Examination*

*Clause*

29. Examination of application
30. Voluntary disclaimer, condition or limitation
31. Publication of acceptance

Chapter 6

*Withdrawal, restriction or amendment of application  
for registration of trademark*

32. Withdrawal or restriction of application for registration of trademark
33. Amendment of application for registration of trademark

Chapter 7

*Opposition*

34. Grounds of opposition
35. Opposition proceedings

Chapter 8

*Registration*

36. Registration

PART V

DIVISION AND MERGER

37. Application for division
38. Application for merger

PART VI

DURATION AND RENEWAL OF REGISTERED TRADEMARKS

39. Duration and renewal of registration
40. Status of unrenewed trademark
41. Cessation of registration

## PART VII

## ALTERATION, CORRECTION, CANCELLATION, REVOCATION AND INVALIDITY

*Clause*

42. Alteration of registered trademark
43. Correction of Register
44. Voluntary cancellation of registered trademark
45. Revocation of registration by Registrar
46. Revocation of registration by Court as to non-use of trademark
47. Invalidation of registration by Court

## PART VIII

## EFFECTS OF REGISTERED TRADEMARKS

## Chapter 1

*Rights of registered proprietor of trademark*

48. Rights conferred by registered trademark
49. Limitation on rights if similar trademarks, etc., registered by different persons
50. Trademark consisting of sign that becomes accepted as sign describing article, etc.
51. Trademark relating to article, etc., formerly manufactured under patent
52. Registration *prima facie* evidence
53. Registration conclusive

## Chapter 2

*Infringement of trademarks*

54. Acts amounting to infringement of registered trademark
55. Acts not amounting to infringement
56. Action for infringement
57. Circumstances in which action may not be instituted
58. Order for erasure, etc., of offending sign
59. Order for delivery up of infringing goods, material or articles
60. Order for disposal of infringing goods, material or articles
61. Remedy for groundless threats of infringement proceedings

PART IX

TRADEMARKS AS OBJECT OF PROPERTY

*Clause*

62. Nature of registered trademark as property
63. Co-proprietorship of registered trademark
64. Assignment, etc., of registered trademark
65. Registration of transaction affecting registered trademark
66. Trust and equities
67. Application for registration trademark as an object of property

PART X

LICENSING

68. Interpretation
69. Licensing of registered trademark
70. Rights of licensees in case of infringement
71. Exclusive licensee having rights and remedies of assignee

PART XI

COLLECTIVE MARKS AND CERTIFICATION MARKS

72. Collective marks
73. Certification marks

PART XII

INTERNATIONAL MATTERS

Chapter 1

*Madrid Protocol*

74. Interpretation
75. Regulations relating to Madrid Protocol

## Chapter 2

*Conventions and International Arrangements**Clause*

76. Protection of well-known trademarks
77. Permitted use of well-known trademarks
78. National emblems, etc., of Convention countries under Article 6ter of Paris Convention
79. Emblems, etc., of certain international intergovernmental organization under Article 6ter of Paris Convention
80. Notification under Article 6ter of the Paris Convention

## PART XIII

## BORDER MEASURES

81. Interpretation
82. Restriction on importation of infringing goods
83. Security
84. Secure storage of seized goods
85. Notice
86. Inspection, release, etc., of seized goods
87. Forfeiture of seized goods by consent
88. Compulsory release of seized goods to importer
89. Compensation for failure to take action
90. Actions for infringement of registered trademark
91. Disposal of seized goods ordered to be forfeited
92. Insufficient security
93. *Ex-officio* action
94. *De Minimis* Imports

## PART XIV

## TRADEMARK AGENTS

95. Recognition of registered trademark agents and circumstances in which a trademark agent shall be required
96. The Register of Trademark Agents
97. Registration of trademark agent
98. Privilege for communications with registered trademark agent

PART XV

OFFENCE

*Clause*

99. Counterfeiting a trademark
100. Falsely applying a registered trademark to goods or services
101. Making or possessing of article for committing offence
102. Importing or selling, etc., goods with falsely applied trademark
103. False entries to Trademarks Office or in Register
104. Falsely representing trademark as registered
105. Offence relating to disobedience to summons or refusal to give evidence
106. Falsely representing trademark as a protected international registration designating Malaysia
107. Misuse of title “Trademarks Office”
108. Unregistered persons practising, etc., as a registered trademark agent

PART XVI

INVESTIGATION AND ENFORCEMENT

Chapter 1

*Investigation and complaints*

109. Interpretation
110. Power of Controller, Deputy Controllers or Assistant Controllers
111. Power of investigation
112. Complaints to the Assistant Controller

Chapter 2

*Information gathering powers*

113. Power of the Assistant Controller to require provision of information
114. Assistant Controller may retain documents
115. Confidentiality
116. Privileged communication
117. Giving false or misleading information, evidence or document
118. Destruction, concealment, mutilation and alteration of records

## Chapter 3

*Powers of arrest, search, seizure and etc.**Clause*

- 119. Power of arrest
- 120. Power to enter premises, inspect and seize goods, etc.
- 121. Magistrate may issue search warrant
- 122. Search may be made without warrant
- 123. Access to recorded information or computerized data, etc.
- 124. Tipping-off
- 125. Warrant admissible notwithstanding defects
- 126. List of things seized
- 127. Forfeiture of seized goods, etc.
- 128. Release of things seized
- 129. Seizure of perishable goods
- 130. No cost or damages arising from seizure to be recoverable
- 131. Obstruction
- 132. Evidence of *agent provocateur* is admissible
- 133. Taking of samples
- 134. Jurisdiction to try offences
- 135. Institution of prosecution
- 136. Compounding of offences
- 137. Principal liable for acts of servant or agent
- 138. Offences committed by body corporate
- 139. Protection of Controller, Deputy Controllers and Assistant Controllers and other persons

## PART XVII

## LEGAL PROCEEDINGS IN COURT, COST AND EVIDENCE

- 140. Service of applications to Court on the Registrar
- 141. Registrar's appearance in proceedings involving the Register
- 142. Costs of proceedings before Court
- 143. Certificate of validity
- 144. Evidentiary value of copies certified by the Registrar



*Clause*

- 145. Sealed copies of document to be evidence
- 146. Electronic information, etc., certified by the Registrar admissible in evidence
- 147. Minister may declare documents of foreign state pertaining to trademarks to be admissible as evidence

PART XVIII

MISCELLANEOUS AND GENERAL

- 148. Intellectual Property Official Journal
- 149. Electronic filing
- 150. Issuing document electronically
- 151. Address for service
- 152. Power of Registrar to allow amendments of documents
- 153. Power of Registrar to allow extension of time
- 154. Mode of giving evidence
- 155. Exercise of discretionary power
- 156. Power of the Registrar to treat documents as confidential
- 157. Adaptation of entries to new classification
- 158. Costs awarded by Registrar
- 159. Unregistered trademarks
- 160. Guidelines or practice directions by Registrar
- 161. Power to amend Schedules
- 162. Power to make regulations

PART XIX

REPEAL, SAVINGS AND TRANSITIONAL PROVISIONS

Chapter 1

*Repeal and savings*

- 163. Repeal and savings

## Chapter 2

*Transitional provisions for trademarks**Clause*

- 164. Interpretation
- 165. Existing registered marks
- 166. Effects of registration in relation to infringement
- 167. Infringing goods, materials or articles
- 168. Rights and remedies of licensee or authorized user
- 169. Co-proprietorship of registered mark
- 170. Assignment, etc., of registered mark
- 171. Licensing of registered mark
- 172. Pending applications for registration
- 173. Conversion of pending application
- 174. Trademarks registered according to old classification
- 175. Claim to priority of Convention application
- 176. Duration and renewal of registration
- 177. Pending application for alteration of registered mark
- 178. Revocation for non-use
- 179. Application for rectification, etc.
- 180. Rules as to use of certification mark
- 181. Agents
- 182. Guidelines, etc., on transitional matters

FIRST SCHEDULE

SECOND SCHEDULE

A BILL

*i n t i t u l e d*

An Act to provide for the registration of trademarks in relation to goods and services and to implement the relevant treaties and for other matters connected therewith.

[ ]

**ENACTED** by the Parliament of Malaysia as follows:

PART I

PRELIMINARY

**Short title and commencement**

1. (1) This Act may be cited as the Trademarks Act 2019.

(2) This Act comes into operation on a date to be appointed by the Minister by notification in the *Gazette* and the Minister may appoint different dates for the coming into operation of different Parts or different provisions of this Act.

**Interpretation**

2. (1) In this Act, unless the context otherwise requires—

“Assistant Registrar” and “Deputy Registrar” mean a person appointed under subsection 10(3) to be an Assistant Registrar of Trademarks or a Deputy Registrar of Trademarks;

“certification mark” has the meaning assigned to it under subsection 73(1);

“collective mark” has the meaning assigned to it under subsection 72(1);

“Convention country” means a country which is a party to any multilateral treaty relating to trademarks to which Malaysia is also a party;

“Convention application” means an application for protection of a trademark in a Convention country;

“Corporation” means the Intellectual Property Corporation of Malaysia established under the Intellectual Property Corporation of Malaysia Act 2002 [*Act 617*];

“Court” means the High Court;

“declared foreign country” means a country declared by the Minister under subsection 27(1);

“distinctive character” means the trademark shall be capable of distinguishing goods of services—

- (a) which the proprietor of the trademark is or may be connected to in the course of trade from goods or services; or
- (b) in the case of which no such connection subsists or where the trademark is registered or intent to be registered, subject to conditions, amendments, modifications or limitations;

in relation to use within the extent of the registration;

“geographical indication” has the same meaning assigned to it under section 2 of the Geographical Indications Act 2000 [Act 602];

“International Register” means the official collection of data concerning international registration of trademarks maintained by the International Bureau;

“international registration” means registration of a trademark in the International Register;

“licensee” means a person who is entitled to exercise his rights under Part X upon being authorized by a proprietor, whether registered or not, of trademark;

“limitations” mean limitations of the right to the exclusive use of a trademark given by the registration of the trademark including limitations of that right as to—

- (a) mode of use;
- (b) use within a territorial area within Malaysia; or
- (c) use in relation to goods to be exported to a market outside Malaysia or use in relation to services to be provided in a place outside Malaysia;

“Paris Convention” means the Paris Convention for the Protection of Industrial Property of 20 March 1883 as revised from time to time;

“prescribed” means, in relation to proceedings before the Court or preliminary thereto or connected therewith, prescribed by rules of court made by the Rules Committee constituted under the Courts of Judicature Act 1964 [Act 91], and in other cases, prescribed by the Minister in the regulations made under this Act;

“protected international registration designating Malaysia” means a trademark to which protection resulting from the international registration of the trademark is extended to Malaysia;

“Register” means the Register of Trademarks kept under section 14;

“registered proprietor” means the person for the time being entered in the Register as the registered proprietor of the registered trademarks;

“registered trademark” has the meaning assigned to it under section 16;

“registrable transactions” mean transactions determined by the Registrar in the guidelines or practice directions under section 160;

“Registrar” means a person appointed as a Registrar of Trademarks under subsection 10(1);

“repealed Act” means the Trade Marks Act 1976 [*Act 175*];

“sign” includes any letter, word, name, signature, numeral, device, brand, heading, label, ticket, shape of goods or their packaging, colour, sound, scent, hologram, positioning, sequence of motion or any combination thereof;

“this Act” includes any subsidiary legislation made under this Act;

“trade” includes any business or profession;

“transmission” means transmission by—

(a) operation of law;

(b) testamentary disposition; or

(c) any other kind of transfer except assignment;

“TRIPS Agreement” means the Agreement on Trade-Related Aspects of Intellectual Property Rights 1994 which constitutes Annex 1C to the Agreement Establishing the World Trade Organization.

**Definition of “trademark”**

3. (1) “Trademark” means any sign capable of being represented graphically which is capable of distinguishing goods or services of one undertaking from those of other undertakings.

(2) A sign may constitute a trademark even though it is used in relation to a service ancillary to the trade or business of an undertaking and whether or not the service is provided for money or money’s worth.

(3) References in this Act to a trademark includes, unless the context otherwise requires, references to a collective mark or certification mark.

**Definition of “well-known trademark”**

4. (1) “Well-known trademark” means any trademark that is well-known in Malaysia and that belongs to a person who—

(a) is a national of a Convention country; or

(b) is domiciled, or has a real and effective industrial or commercial establishment, in a Convention country,

whether or not that person carries on business, or has any goodwill, in Malaysia.

(2) In determining whether a trademark is well-known in Malaysia, the Registrar or the Court shall have regard to the criteria as prescribed.

**Definition of “earlier trademark”**

5. “Earlier trademark” means—

(a) a registered trademark or a protected international registration designating Malaysia, the application for registration of which was made earlier than the trademark in question,

taking into account the priorities claimed in respect of the trademarks, where appropriate; or

- (b) a trademark which, at the date of application for registration of the trademark in question or of the priority claimed in respect of the application, where appropriate, was a well-known trademark,

and includes a trademark in respect of which an application for registration has been made and which, if registered, would be an earlier trademark by virtue of paragraph (a) subject to it being so registered.

**Definition of “infringing goods”, “infringing material”, “infringing articles”, “counterfeit goods” and “counterfeit trademarks”**

**6.** (1) Goods are “infringing goods”, in relation to a registered trademark, if the goods or their packaging bear a sign identical or similar to that trademark and—

- (a) the application of the sign to the goods or their packaging was an infringement of the registered trademark;
- (b) the goods are proposed to be imported into Malaysia and the application of the sign in Malaysia to them or their packaging would be an infringement of the registered trademark; or
- (c) the sign has otherwise been used in relation to the goods in such a way as to infringe the registered trademark.

(2) Material is “infringing material”, in relation to a registered trademark, if it bears a sign identical or similar to that trademark and either—

- (a) it is used for labelling or packaging goods, as a business paper, or for advertising goods or services, in such a way as to infringe the registered trademark; or



(b) it is intended to be so used and such use would infringe the registered trademark.

(3) “Infringing articles”, in relation to a registered trademark, means articles—

(a) which are specifically designed or adapted for making copies of a sign identical or similar to that trademark; and

(b) which a person has in his possession, custody or control, knowing or having reason to believe that they have been or are to be used to produce infringing goods or material.

(4) Goods are “counterfeit goods”, in relation to a registered trademark, if—

(a) they are infringing goods in relation to that trademark; and

(b) the sign borne by them or their packaging is a counterfeit trademark.

(5) A sign is a “counterfeit trademark”, in relation to a registered trademark, if the sign—

(a) is identical with the registered trademark as to be calculated to deceive; and

(b) is applied to goods or services—

(i) without the express or implied consent, conditional or otherwise, of the registered proprietor; and

(ii) to falsely represent the goods or services to be the genuine goods or actual services of the registered proprietor or a licensee of the registered trademark.

**References to use of trademark**

7. (1) References to the use of a trademark shall be construed as references to the use of a printed or other visual or non-visual representation of the trademark.

(2) References to the use of a trademark in relation to goods shall be construed as reference to the use of the trademark upon, or in physical or other relation to, the goods.

(3) References to the use of a trademark in relation to services shall be construed as references to the use of the trademark as a statement or as part of a statement about the services.

(4) Any aural representation of a trademark shall be construed as references to the use of the trademark.

(5) Where a person has used a trademark with additions or alterations, the Registrar or the Court may decide that the person has used the trademark if it does not substantially affect the identity of the trademark as the Registrar or the Court thinks fit.

**Use of trademark for export trade or where form of trade changes**

8. (1) Where a trademark is applied to goods to be exported from Malaysia and any other act is done in Malaysia in relation to the goods which if done in relation to goods to be sold or otherwise traded in Malaysia, such act would constitute use of a trademark in Malaysia in relation to those goods.

(2) The use of a registered trademark in relation to goods or services where a form of connection in the course of trade subsists between the goods or services and the person using the trademark shall not be deemed to be likely to cause deception or confusion only on the ground that the trademark has been or is used in relation to goods or services where a different form of connection in the course of trade subsisted or subsists between the goods or services and that person or predecessor in title of that person.

**Determination of likelihood of confusion**

9. (1) In determining whether the use of a trademark is likely to cause confusion on the part of the public, the Registrar or the Court may take into account all factors relevant in the circumstances, including whether the use is likely to be associated with an earlier trademark.

(2) In determining whether the use of a sign is likely to cause confusion on the part of the public, the Registrar or the Court may take into account all factors relevant in the circumstances, including whether the use is likely to be associated with a registered trademark.

PART II

ADMINISTRATION

**Registrar, Deputy Registrars and Assistant Registrars**

10. (1) The Director General of the Corporation shall be the Registrar of Trademarks and have the control of the Trademarks Office.

(2) The Registrar shall perform the duties imposed and exercise the powers conferred on him under this Act for the proper administration of this Act.

(3) The Corporation may appoint, on such terms and conditions as the Corporation may determine, from amongst persons in the employment of the Corporation, such number of Deputy Registrars of Trademarks, Assistant Registrars of Trademarks and other officers as may be necessary for the proper administration of this Act.

(4) Subject to the general direction and control of the Registrar and to such conditions or restrictions as may be imposed by the Registrar, a Deputy Registrar or an Assistant Registrar may exercise any power of the Registrar under this Act.

(5) The Registrar shall have a seal of such device as may be approved by the Corporation and the impressions of such seal shall be judicially noticed and admitted in evidence.

### **Protection of Registrar, Deputy Registrars, Assistant Registrars and other officers**

**11.** No action, suit, prosecution or other proceedings shall be brought, instituted or maintained in any court against—

- (a) the Registrar, Deputy Registrars, Assistant Registrars or any other officer, in respect of any act ordered or done for the purpose of carrying into effect this Act; and
- (b) any other officer in respect of any act done or purported to be done by him under the order, direction or instruction of the Registrar if the act was done in good faith and in a reasonable belief that it was necessary for the purpose intended to be served by it.

### **Trademarks Office and other branch offices**

**12.** (1) The Central Trade Marks Office and regional trade marks offices established under section 5 of the repealed Act shall be known as Trademarks Office and branch offices, respectively.

(2) In addition to subsection (1), for the purposes of this Act, such number of branch offices of the Trademarks Office as may be necessary shall be established.

(3) A document required by this Act to be filed at the Trademarks Office may be filed at any branch office of the Trademarks Office and reference in this Act to the submission at the Trademarks Office includes reference to the submission at a branch office.

(4) All communication with the Trademarks Office shall be in the national language or English language.

**Preliminary advice and search by Registrar**

**13.** (1) The Registrar may give preliminary advice and search result to any person who proposes to apply for the registration of trademark in the Register as to whether the trademark is *prima facie* a registrable trademark.

(2) Any person may apply for a preliminary advice and search result in the form as determined by the Registrar together with the payment of the prescribed fee.

(3) Notwithstanding that an application for the registration of trademark is made within the prescribed period and the Registrar has given preliminary advice or search result in the affirmative, the Registrar, after further investigation or consideration, may raise any refusal to the effect that the trademark is not registrable.

(4) In the circumstances under subsection (3), the applicant shall be entitled to have any fee paid on the filing of the application refunded to him subject to the prescribed conditions, upon giving notice of the withdrawal of the application within the prescribed period.

(5) The application made by the applicant in subsection (2), and the preliminary advice and search result given by the Registrar are confidential and shall not be made available for public inspection.

**PART III****THE REGISTER OF TRADEMARKS****Register of Trademarks**

**14.** (1) The Registrar shall keep and maintain a register called the Register of Trademarks.

(2) The Register shall contain all such matters and particulars relating to trademarks as prescribed.

(3) The Register shall be kept in such form as determined by the Registrar.

## Inspection of Register

**15.** (1) The Register shall be made available for public inspection subject to the conditions as prescribed upon application in the form as determined by the Registrar together with the payment of the prescribed fee.

(2) Subject to the conditions in subsection (1), certified copies or extracts of any entry in the Register sealed with the seal of the Registrar shall be given to any person upon application in the form as determined by the Registrar together with the payment of the prescribed fee.

## PART IV

### REGISTRATION OF TRADEMARKS

#### Chapter 1

##### *Introductory*

### Registered trademark

**16.** A registered trademark shall be a property right obtained by the registration of trademark under this Act and a registered proprietor of the trademark has the rights and remedies provided under this Act.

#### Chapter 2

##### *Application for registration of trademark*

### Application for registration of trademark

**17.** (1) Any person who claims to be the *bona fide* proprietor of a trademark may apply for the registration of the trademark if—

- (a) the person is using or intends to use the trademark in the course of trade; or
- (b) the person has authorized or intends to authorize another person to use the trademark in the course of trade.

(2) An application for the registration of trademark shall be made in the form as determined by the Registrar within the prescribed period together with the payment of the prescribed fee.

(3) If the trademark applied for registration contains or consists of a word which is not in Roman characters, or the national language or English language, the applicant shall, within the prescribed period, furnish the Registrar with the following:

(a) the transliteration of the trademark;

(b) the translation of the trademark; or

(c) any information as determined by the Registrar.

(4) If the requirements under subsection (2) or (3) are not complied with within the prescribed period, the application shall be deemed withdrawn.

(5) A person who applies for the registration of trademark may request to the Registrar for an expedited examination by filing an application in the form as determined by the Registrar within the prescribed period together with the payment of the prescribed fee.

### **Application in multiple classes**

**18.** (1) An application under subsection 17(2) may be made in a single application listing goods or services belonging to several classes of classification to the Registrar.

(2) An application under subsection (1) shall result in one registration.

### **Classification of goods or services**

**19.** (1) Goods or services shall be classified for the purposes of the registration of trademarks in accordance with a system of classification as prescribed.

(2) If any question arises as to the class within which any goods or services are comprised, that question shall be decided by the Registrar.

### **Colour of trademark**

**20.** (1) The applicant may apply to limit, in whole or in part, to one or more specified colours of the trademark.

(2) For the purposes of subsection (1) or in the case where the applicant does not apply to limit, in whole or in part, to one or more specified colours of the trademark, the Registrar may limit, in whole or in part, to one or more specified colours of the trademark in determining whether the trademark is distinctive.

(3) Where a trademark is registered without limitations as to colour, it shall be deemed to be registered for all colours.

### **Series of trademarks**

**21.** (1) A person may make a single application under subsection 17(2) for the registration of a number of trademarks if the trademarks—

- (a) resemble each other in material particulars; and
- (b) differ only in respect of one or more of the following matters:
  - (i) statements or representations as to the goods or services in relation to which the trademarks are used or intended to be used;
  - (ii) statements or representations as to number, price or quality;
  - (iii) standard fonts which does not substantially affect the identity of the trademarks; or
  - (iv) the colour of any part of the trademark.



(2) If the application meets all the requirements under subsection (1), the Registrar shall register the trademarks as a series in one registration.

(3) A trademark which has been registered as part of a series trademark may be used independently.

### **Date of filing**

**22.** (1) The Registrar shall record the date of receipt of an application for registration of trademark made in accordance with section 17 as the date of filing.

(2) Where the requirement under section 17 is fulfilled on different days, the Registrar shall record the date of filing on the last day of those days.

(3) Any date of priority claimed under section 26, 27 or 28 shall have no effect on the date of filing of application recorded under subsection (1) or (2) except for the purposes of a search under subsection 29(2).

## Chapter 3

### *Grounds for refusal of registration*

#### **Absolute grounds for refusal of registration**

**23.** (1) Subject to subsection (2), the Registrar shall refuse to register a trademark based on the following absolute grounds for refusal of registration:

- (a) signs which are not capable of being represented graphically and not capable of distinguishing goods or services of one undertaking from those of other undertakings;
- (b) trademarks which are devoid of any distinctive character;
- (c) trademarks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, other characteristics of goods or services or the time of production of goods or of rendering of services; or

- (d) trademarks which consist exclusively of signs or indications which have become customary in the current language of the territory or in the *bona fide* and established practices of the trade.

(2) Notwithstanding paragraphs (1) (b), (c) and (d), the Registrar shall not refuse to register an application of a trademark if, before the date of application for registration, the trademark has in fact acquired a distinctive character as a result of its use.

(3) The Registrar shall refuse to register a sign as a trademark if the sign consists exclusively of—

- (a) the shape which results from the nature of the goods themselves;
- (b) the shape of goods which is necessary to obtain a technical result; or
- (c) the shape which gives substantial value to the goods.

(4) Notwithstanding subsections (1) and (2), the Registrar shall refuse to register the following as a trademark if—

- (a) the trademark consists exclusively of the name of a country; or
- (b) the trademark contains or consists of recognized geographical indications.

(5) In addition to the grounds in subsections (1), (3) and (4), the Registrar shall refuse to register a trademark based on any of the following absolute grounds for refusal of registration:

- (a) if the use of the trademark is likely to deceive or cause confusion to the public or contrary to any written law;
- (b) if it is of such a nature as to deceive or mislead the public as to the nature, quality or geographical origin of the goods or services;

- (c) the trademarks are contrary to public interest or to morality;
- (d) the trademarks contain or consist of any scandalous or offensive matter or would otherwise not be entitled to protection by any court of law;
- (e) the trademarks contain a matter which is in the opinion of the Registrar is or might be prejudicial to the interest or security of the country;
- (f) the trademarks contain or consist of the name or representation of another person whether living or dead unless the applicant furnishes the Registrar with the consent of that person, if living, or of the representative of that person if deceased;
- (g) the trademarks contain or consist of flag of a country, national emblem, emblem, insignia or royal arms unless the applicant furnishes the Registrar with the authorization of the competent authorities or international intergovernmental organization as specified in section 78 or 79, as the case may be;
- (h) the trademarks contain or consist of a word which is commonly used as or is the accepted name of any single chemical element or single chemical compound, as distinguished from a mixture, or which is declared by the World Health Organization as an international non-proprietary name or which is deceptively similar to such name unless it is used—
  - (i) to denote only a brand or to make the element or compound as made by the proprietor of the trademark or the licensee as distinguished from the element or compound as made by others; and
  - (ii) in association with a suitable name or description open to public use; or

- (i) the trademarks contain or consist of any of the following signs or a sign similar to any of those signs as is likely to be taken for that sign:
  - (i) the word “Patent”, “Patented”, “By Royal Letters Patent”, “Registered”, “Registered Design”, and “Copyright” or words to the like effect in any language whatsoever; or
  - (ii) any sign as prescribed.

### **Relative grounds for refusal of registration**

**24.** (1) The Registrar shall refuse to register a trademark if it is identical with an earlier trademark and the goods or services for which the trademark is applied for are identical with the goods or services of the earlier trademark.

(2) The Registrar shall refuse to register a trademark if there exists a likelihood of confusion on the part of the public—

- (a) where the trademark is identical with an earlier trademark and is to be registered for goods or services similar to the earlier trademark; or
- (b) where the trademark it is similar to an earlier trademark and is to be registered for goods or services identical or similar to the earlier trademark.

(3) The Registrar shall refuse to register a trademark if—

- (a) it is identical with or similar to a well-known trademark which is not registered in Malaysia for the identical goods or services of the proprietor of the well-known trademark; or
- (b) it is identical with or similar to a well-known trademark and registered in Malaysia for goods or services which are not identical or not similar to those in respect of which the well-known trademark is registered and—
  - (i) the use of the trademark in relation to those goods or services would indicate a connection between

those goods or services and the proprietor of the well-known trademark;

- (ii) there exists a likelihood of confusion on the part of the public because of such use; and
- (iii) the interests of the proprietor of the well-known trademark are likely to be damaged by such use.

(4) Subject to subsection (6), the Registrar shall refuse to register a trademark if, or to the extent that, its use in Malaysia is prevented—

- (a) by virtue of any rule of law protecting an unregistered trademark or other sign used in the course of trade including under the law of passing off; or
- (b) by virtue of an earlier right other than those referred to in paragraph (a) or in subsections (1) to (3) including under the law of copyright or industrial designs.

(5) A person entitled to prevent the use of a trademark is referred to in this Act as the proprietor of an “earlier right” in relation to the trademark in subsection (4).

(6) The Registrar may refuse to register a trademark on any grounds under subsection (4) if that ground is raised in proceedings in opposition to the registration under section 35 by the proprietor of the earlier right.

(7) Notwithstanding the relative grounds for refusal of registration under subsections (1), (2), (3) and (4), the Registrar may register a trademark if the proprietor of the earlier trademark or other earlier right consents to the registration in the prescribed manner and shall take into account the interest of the public and the likelihood of confusion on the part of public.

(8) For the purposes of this section, if the registration of an earlier trademark expires, the Registrar in determining the registrability of a trademark shall continue to take into account the earlier trademark for a period of twelve months after its expiry.

**Honest concurrent use, etc.**

**25.** (1) Nothing in section 24 shall prevent the registration of trademark where the Registrar or the Court is satisfied—

(a) that there has been an honest concurrent use of the trademark and the earlier trademark or other earlier right; or

(b) that by reason of other special circumstances it is proper for the trademark to be registered.

(2) The registration of trademark under subsection (1) shall be subject to such limitations and conditions as the Registrar or the Court thinks fit to impose.

(3) Nothing in this section—

(a) shall prevent the Registrar from refusing to register a trademark on any of the grounds under section 23; or

(b) shall affect the making of an application for a declaration of invalidity under subsection 47(3).

*Chapter 4**Priority***Claim to priority of Convention application**

**26.** (1) A person, or his successor in title, who has duly filed a Convention application, has a right to priority, for the purposes of filing an application for registration of the same trademark for some or all of the same goods or services, for a period of six months from the date of filing of the first of such application.

(2) For the purposes of subsection (1)—

(a) the date of filing of the first Convention application shall be the relevant date in establishing which rights take precedence; and

(b) the registrability of the application of the trademark shall not be affected by any use of the trademark in Malaysia in the period between the date of filing of the first Convention application and the date of the application of the same trademark under this Act.

(3) Where a right of priority is claimed by reason of a Convention application under subsection (1), the application for registration of the same trademark shall specify—

(a) the date of filing of the first Convention application;

(b) the Convention country in which the Convention application was first filed;

(c) the application or registration number of the Convention application accorded by the registering or other competent authority of the relevant Convention country; and

(d) the goods or services to which the claim relates.

(4) Any filing which in a Convention country is equivalent to a regular national filing, under its domestic legislation or an international agreement, shall be treated as giving rise to the right of priority.

(5) A subsequent application concerning the same subject as the first Convention application, filed in the same Convention country, shall be considered the first Convention application (of which the filing date is the starting date of the period of priority), if at the time of the subsequent application—

(a) the previous application has been withdrawn, abandoned or refused, without having been laid open to public inspection and without leaving any rights outstanding; and

(b) it has not yet served as a basis for claiming a right of priority.

(6) For the purposes of subsection (5), the previous application may not serve as a basis for claiming a right of priority.

(7) A right to priority arising as a result of a Convention application may be assigned or transmitted together with the application or independently and the reference in subsection (1) to the applicant's "successor in title" shall be construed accordingly.

(8) For the purposes of this section, a "regular national filing" means a filing which is adequate to establish the date on which the application was filed in that country, whatever may be the subsequent fate of the application.

### **Claim to priority from other relevant overseas application**

27. (1) The Minister may, by order published in the *Gazette*, declare a country as having made arrangements with Malaysia for the reciprocal protection of trademark.

(2) In relation to a declared foreign country, this section shall apply only for the duration of the period the order continues in force in respect of that country.

(3) For the purposes of this section, all requirements and procedures in section 26 shall be applicable.

### **Claim to priority from temporary protection of trademark which is the subject matters of international exhibition given under Article 11 of Paris Convention**

28. (1) Notwithstanding anything in this Act, an applicant for registration of a trademark may apply for temporary protection which shall be granted to a trademark which is the subject matter of an exhibition at an official or officially recognized international exhibition held in Malaysia or in any Convention country or declared foreign country.

(2) The temporary protection granted under subsection (1) shall not extend any period of priority claimed by an applicant in section 26 and where a right of priority is claimed by an applicant subsequent to the temporary protection, the period of priority shall remain six months and which shall commence from the date of the introduction of the goods or services into the exhibition.



(3) An applicant for registration of trademark whose goods or services are the subject matters of an exhibition at an official or officially recognized international exhibition in Malaysia or in any Convention country or declared foreign country and who applies for registration of that trademark in Malaysia within six months from the date on which the goods or services first became the subject matter of the exhibition shall, on his request, be treated as giving rise to the right of priority for search purposes under subsection 29(2) when the goods or services first became the subject matters of the exhibition.

(4) Evidence that the goods or services bearing the trademark are the subject matters of an exhibition at an official or officially recognized international exhibition shall be by a certificate issued by the competent authorities of the exhibition and to be filed with the Registrar upon filing the application for registration of trademark in Malaysia.

## Chapter 5

### *Examination*

#### **Examination of application**

**29.** (1) The Registrar shall examine whether an application for registration of trademark fulfills the requirements for registration under this section.

(2) For the purpose of an examination under subsection (1), the Registrar shall carry out a search, to such extent as he considers necessary, of earlier trademarks.

(3) Upon examination, where the Registrar finds that the application fulfills any of the requirements for registration of trademark, the Registrar shall accept the application.

(4) Where the Registrar accepts the application for registration of trademark, the Registrar shall record the date of filing of the application under section 22 on the date of filing.

(5) If the application for registration of trademark does not fulfill any requirements for registration of trademark, the Registrar shall inform the grounds of provisional refusal to the applicant by a written notice and the applicant shall have an opportunity to—

- (a) make representations;
- (b) amend the application so as to meet the conditions, amendments, modifications or limitations, as the Registrar deems fit to impose; or
- (c) furnish additional or any other information or evidence,

within such period as the Registrar may specify in the written notice.

(6) For the purposes of subsection (5)—

- (a) the application shall be deemed withdrawn if the applicant does not respond within such period as specified by the Registrar in the written notice; and
- (b) the Registrar shall refuse the application if the applicant's response does not satisfy the Registrar that those requirements are fulfilled and the Registrar shall, if required by the applicant, state in writing the grounds of the total provisional refusal.

(7) The Registrar, upon the request of the applicant, may defer any action in relation to the application for registration of trademark under prescribed circumstances and for a prescribed period.

(8) Where an appeal lies to the Court against the decision of the Registrar relating to a total provisional refusal under paragraph (6)(b)—

- (a) the appeal shall be made in the prescribed manner;
- (b) the Court shall, where necessary, hear the applicant and the Registrar; and
- (c) the appeal shall be heard on the material stated by the Registrar to have been used by the Registrar in arriving at his decision and no further grounds of provisional refusal to the acceptance of the application shall be allowed to be taken by the Registrar other than those so stated except by leave of the Court.

(9) For the purposes of paragraph (8)(c), where any further grounds of provisional refusal are taken, the applicant shall be entitled to withdraw his application without payment of costs on giving notice in the prescribed manner.

(10) In determining an appeal under subsection (8), the Court shall make an order subject to any conditions, amendments, modifications or limitations, if any, the application for registration of trademark is to be accepted.

(11) Any application for registration of trademark filed and accepted under this section shall, notwithstanding any conditions, amendments, modifications or limitations permitted by the Registrar or the Court to be made in such application, be deemed to have been made on the date of application.

(12) Without prejudice to subsection (11), where after the acceptance of an application for registration of trademark but before the registration of the trademark, the Registrar is satisfied—

- (a) that the application has been accepted in error; or
- (b) that in the special circumstances of the case the trademark shall not be registered or shall be registered subject to additional or different conditions or limitations,

the Registrar may revoke the acceptance and proceed as if the application had not been accepted or, in respect only of a trademark which shall be registered subject to additional or different conditions or limitations, reissue a new acceptance subject to additional or different conditions or limitations.

### **Voluntary disclaimer, condition or limitation**

**30.** (1) An applicant for the registration of a trademark may apply in the form as determined by the Registrar—

- (a) to disclaim any right to the exclusive use of any specified element of the trademark; or
- (b) to agree that the rights arising out of the registration shall be subject to certain conditions or limitations imposed by the Registrar.

(2) The Registrar may refuse any application under paragraph (1)(a) if the application consists of or contains any matters which is not allowed under the absolute and relative grounds for refusal of registration under sections 23 and 24.

(3) A disclaimer made by the applicant, or condition or limitation imposed by the Registrar, under subsection (1), shall not be revoked if the application has been accepted by the Registrar.

### **Publication of acceptance**

**31.** (1) If the application for registration of trademark is accepted, the Registrar shall publish the application in the Intellectual Property Official Journal.

(2) The publication under subsection (1) shall contain all disclaimers, conditions, amendments, modifications or limitations subject to which the application has been accepted.

## Chapter 6

### *Withdrawal, restriction or amendment of application for registration of trademark*

### **Withdrawal or restriction of application for registration of trademark**

**32.** (1) An applicant may, before the registration of trademark to which his application relates, withdraw his application or restrict the goods or services covered by the application by filing a request in the form as determined by the Registrar.

(2) Any person may withdraw the application or restrict the goods or services if the right or interest relied on in the filing of the application, notice or request has become vested in him.

(3) The person referred to in subsection (2) shall notify the Registrar in the prescribed manner that the right or interest has become vested in him.

(4) If the acceptance of the application for registration of a trademark has been published under section 31, a notice of the withdrawal or restriction of the goods or services of that application shall also be published.

(5) Any withdrawal or restriction made under this section shall not be revoked if the application for withdrawal or restriction has been given effect by the Registrar.

### **Amendment of application for registration of trademark**

**33.** (1) The Registrar may, at the request of the applicant, amend an application for the registration of a trademark at any time before registration.

(2) The request under subsection (1) shall be made in the form as determined by the Registrar together with the payment of the prescribed fee.

(3) Any amendment to an application for the registration of trademark shall only be made in relation to—

- (a) the name or address of the applicant;
- (b) errors of wording or copying; or
- (c) obvious mistakes,

and only where the amendment does not substantially affect the identity of the trademark or extend the goods or services covered by the application.

## Chapter 7

### *Opposition*

### **Grounds of opposition**

**34.** (1) Subject to subsection 35(3), the registration of trademark may be opposed by a registered proprietor if he or his predecessor in business or a person who is under his control or authority has continuously used the trademark—

- (a) from a date before the use of the applicant's trademark or his predecessor in business or by a person who is under his control or authority; or
- (b) from a date before the date of filing of the application by the applicant.

(2) The registration of trademark may be opposed—

(a) on any grounds under section 23 or 24;

(b) on the ground that the applicant is not the proprietor of the trademark; or

(c) subject to subsection (3), on the ground that—

(i) it is identical to a well-known trademark in Malaysia and it is to be registered for goods or services which are similar to the well-known trademark in Malaysia; or

(ii) it is similar to a well-known trademark in Malaysia and it is to be registered for goods or services which are similar to the earlier well-known trademark in Malaysia.

(3) The ground of opposition under paragraph (2)(c) may be raised where the use of the opposed trademark in relation to the goods or services for which the opposed trademark is sought to be registered—

(a) would indicate a connection between those goods or services and the proprietor of the earlier well-known trademark;

(b) would create a likelihood of confusion on the part of the public because of such use by the opposed trademark; and

(c) would likely damage the interests of the proprietor of the earlier well-known trademark.

(4) The ground of opposition referred to in paragraph (1)(c) may only be raised to oppose the registration of an application for registration of trademark made on or after the commencement of this Act.

**Opposition proceedings**

**35.** (1) Any person may file a notice of opposition in the form as determined by the Registrar together with the payment of the prescribed fee and send the notice of opposition to the applicant within the prescribed period from the date of the publication of the acceptance of an application for the registration of the opposed trademark.

(2) The notice of opposition shall include a statement of the grounds of the opposition containing any grounds specified under section 34.

(3) An opposition may proceed in the name of a person other than the person who filed the notice if—

(a) after the person has filed a notice of opposition, the right or interest on which the person relied to file the notice of opposition becomes vested to the other person; and

(b) the other person in paragraph (a)—

(i) notifies the Registrar in the prescribed manner that the right or interest is vested in him; and

(ii) does not withdraw the opposition.

(4) The applicant shall file a counterstatement in the form as determined by the Registrar together with the payment of the prescribed fee, within the prescribed period after the receipt of the notice of opposition and if the applicant does not do so, the application shall be deemed withdrawn.

(5) The counterstatement in subsection (4) shall include the grounds upon which the applicant relies on for the application.

(6) The opponent and applicant shall file evidence and exhibits in the prescribed manner within the prescribed period in support of the opposition or the counterstatement, as the case may be, and if the opponent or applicant does not do so, the opposition or application, as the case may be, shall be deemed withdrawn.

(7) If the applicant files evidence and exhibits under subsection (6), the opponent may file evidence in reply in the prescribed manner.

(8) In considering the evidence and exhibits and after giving the applicant and the opponent an opportunity of making written submissions, the Registrar shall decide whether—

- (a) to refuse to register the trademark;
- (b) to register the trademark absolutely; or
- (c) to register the trademark subject to such conditions, amendments, modifications, disclaimers or limitations as he thinks fit.

(9) The Registrar, upon request by the opponent or applicant in the form as determined by the Registrar together with the payment of the prescribed fee, may defer any action in relation to the opposition proceedings under prescribed circumstances and for a prescribed period.

(10) Where an appeal lies to the Court against the decision of the Registrar refusing to register a trademark or refusing to register a trademark absolutely, or registering the trademark subject to conditions, amendments, modifications, disclaimers or limitations under this section—

- (a) the appeal shall be made in the prescribed manner;
- (b) the Court shall, where necessary, hear the parties and the Registrar; and
- (c) any party may, either in the manner prescribed or by special leave of the Court, bring forward further material for the consideration of the Court but no further grounds of opposition to the registration of trademark shall be allowed to be taken by the opponent other than those stated by the opponent except by leave of the Court.

(11) Where any further grounds of opposition are taken, the applicant shall be entitled to withdraw his application without payment of the costs of the opponent on giving notice as prescribed.



(12) In any appeal under this section, the Court, may after hearing the Registrar, permit the trademark intended to be registered to be modified in any manner not substantially affecting the identity of the trademark, but in any such case the trademark as modified shall be published in the Intellectual Property Official Journal before being registered.

(13) If a person giving notice of opposition, an applicant sending a counterstatement, or an appellant, neither resides nor carries on business in Malaysia, the Registrar or the Court may require him to give security for costs of the proceedings relating to the opposition, application or appeal, as the case may be, and in default of such security being duly given, the Registrar or the Court may deem the opposition, application, or appeal, as the case may be, as withdrawn.

## Chapter 8

### *Registration*

#### **Registration**

**36.** (1) When an application for registration of trademark has been accepted and either—

- (a) the application has not been opposed and the period for opposition has expired; or
- (b) the application has been opposed and the opposition has been decided in favour of the applicant,

the Registrar shall, unless the application has been accepted in error, register the trademark in the Register in the name of the proprietor, and the trademark so registered shall be registered as at the date of filing of application for registration and that date shall be deemed to be the date of registration.

(2) On the registration of trademark, the Registrar shall issue to the proprietor a notification of the registration of trademark with the seal of the Registrar.

(3) If the registered proprietor intends to obtain a certificate of registration, the Registrar shall issue the certificate of registration which shall be equivalent to the notification of registration issued under subsection (2).

(4) An application for a certificate of registration under subsection (3) shall be made by the registered proprietor in the form as determined by the Registrar together with the payment of the prescribed fee.

## PART V

### DIVISION AND MERGER

#### **Application for division**

**37.** (1) An application for the registration of trademark or the registration of trademark may, upon the request of the applicant or registered proprietor, be divided into two or more separate applications for the registration or registration of trademark.

(2) The request under subsection (1) shall be made to the Registrar before or after the trademark is registered in the form as determined by the Registrar together with the payment of the prescribed fee.

#### **Application for merger**

**38.** (1) Two or more separate applications for registration of trademark or registration of trademark may, upon the request of the applicant or registered proprietor, be merged into one application for registration of trademark or one registration of trademark.

(2) The request under subsection (1) shall be made to the Registrar before or after the trademark is registered in the form as determined by the Registrar together with the payment of the prescribed fee.

PART VI

DURATION AND RENEWAL OF REGISTERED TRADEMARKS

**Duration and renewal of registration**

**39.** (1) The registration of trademark shall be for a period of ten years from the date of registration and may be renewed under subsection (2) for a further periods of ten years.

(2) The registration of trademark may be renewed, for some or all of the classes of goods or services, at the request of the registered proprietor in the form as determined by the Registrar together with the payment of the prescribed fee.

(3) If some of the classes of goods or services of the registration are to be renewed, section 37 may be applicable.

(4) Where the request for renewal is made on or before the date of expiry of the registration, the fee payable shall be the renewal fee as prescribed.

(5) Where the request for renewal is made within the period of six months after the date of expiry of the registration, the fees payable shall be the renewal fee as prescribed and a surcharge shall be imposed.

(6) A request for renewal shall be made not later than six months after the date of expiry of the registration.

(7) Renewal shall take effect from the expiry of the previous registration.

(8) If the registration is not renewed in accordance with this section and regulations referred to in subsection (4) or (5), the trademark shall be deemed removed.

(9) Where the trademark has been deemed removed, the registered proprietor may request for restoration for his removed registration within six months from the date of removal in the form as determined by the Registrar together with the payment of the restoration fee as prescribed.

(10) If restoration is not applied for under subsection (9) within six months from the date the trademark is deemed removed, the registration shall cease.

(11) The renewal or restoration of the registration of a trademark shall be published in the Intellectual Property Official Journal.

### **Status of unrenewed trademark**

**40.** (1) In a case of unrenewed trademark where—

(a) the registration of trademark is not renewed; or

(b) the registration of trademark has been deemed removed and has not been restored,

a person other than the person who was registered as the proprietor of the unrenewed trademark may apply for the registration of trademark.

(2) Where an application for the registration of an unrenewed trademark is made by a person other than the person who was registered as the proprietor of the unrenewed trademark, the unrenewed trademark is taken to be a registered trademark for the purposes of an examination in subsection 29(2) of the application at any time when the registration of the unrenewed trademark could have been renewed and restored under section 39.

### **Cessation of registration**

**41.** The registration of a trademark ceases if—

(a) the trademark has ceased under subsection 39(10), been revoked under section 45 or 46 or been invalidated under section 47; or

(b) the registration of trademark is cancelled under section 44.

PART VII

ALTERATION, CORRECTION, CANCELLATION, REVOCATION AND  
INVALIDITY

**Alteration of registered trademark**

**42.** (1) Subject to subsection (2), a registered trademark shall not be altered in the Register.

(2) The Registrar may, at the request of the registered proprietor in the form as determined by the Registrar together with the payment of the prescribed fee, allow the alteration of the registered trademark, and where the trademark includes the proprietor's name or address, the alteration is limited to the alteration of that name or address.

(3) The alteration of a registered trademark shall not substantially affect the identity of the trademark.

**Correction of Register**

**43.** (1) The Registrar may, on the request of the registered proprietor in the form as determined by the Registrar together with the payment of the prescribed fee—

- (a) correct an error or enter any change in the name, address or description of the registered proprietor;
- (b) correct the details of description of the goods or services in respect of which the trademark is registered without extending in any way the rights given by the existing registration of trademark; or
- (c) enter a disclaimer relating to the trademark without extending in any way the rights given by the existing registration of trademark.

(2) The Registrar may, at the request of a licensee of a trademark in the form as determined by the Registrar together with the payment of the prescribed fee, correct an error or enter any change in the name, address or description of that licensee.

(3) The Registrar may make any correction in the Register consequential to subsections (1) and (2) and may, at his discretion, correct any clerical error or omission in respect of any registration of trademark in the Register.

(4) A notification of registration shall be issued by the Registrar on the approval of the corrections as requested under subsections (1) and (2), and the making, if any, of corrections under subsection (3).

### **Voluntary cancellation of registered trademark**

**44.** (1) The Registrar shall cancel the registration of trademark in respect of some or all of the goods or services upon the request of the registered proprietor in the form as determined by the Registrar together with the payment of the prescribed fee.

(2) Before cancelling the registration of the trademark, the Registrar shall notify—

- (a) any person recorded under Part IX as claiming a right in respect of, or an interest in, the trademark; and
- (b) the person to whom the trademark has been assigned or transmitted in the case where the assignment or transmission of the trademark has not yet been recorded by the Registrar after an application has been made to the Registrar to record such assignment or transmission of the trademark.

### **Revocation of registration by Registrar**

**45.** (1) The Registrar shall revoke the registration of trademark—

- (a) where a notice of opposition to the registration was filed, in accordance with subsection 35(1), the Registrar failed to take into account the opposition in deciding to register the trademark; or

- (b) where before the registration, any person had applied for an extension of time for filing a notice of opposition to the registration, the Registrar failed to take into account the application for extension of time in deciding to register the trademark.

(2) The revocation under subsection (1) shall be subject to the Registrar becoming aware of his failure to take into account the opposition or application for extension of time to file a notice of opposition within two months after the notice was filed or the application was made.

(3) The Registrar shall revoke the registration of trademark within one month from becoming aware of his failure to take into account the opposition or the application for extension of time.

(4) Notwithstanding subsections (1), (2) and (3), the Registrar may revoke the registration of trademark, within twelve months from the date of registration of trademark, if the Registrar is satisfied that it is reasonable to revoke the registration, taking into account—

- (a) any relevant obligations of Malaysia under an international agreement or convention; or

(b) any special circumstances making it appropriate—

- (i) not to register the trademark; or

- (ii) to register the trademark only if the registration were subject to disclaimer, conditions, amendments, modifications or limitations to which the registration was not made subject.

(5) Notwithstanding subsection (2), if the Registrar becomes aware of the failure later, he may be able to revoke the registration under subsection (4).

(6) Before the revocation of the trademark, the Registrar shall give a notice of the proposed revocation in the manner as determined by the Registrar to the following persons:

- (a) the registered proprietor of the trademark; and

(b) any person recorded under Part IX as claiming a right in respect of, or an interest in, the trademark.

(7) The Registrar shall not revoke the registration of trademark without giving an opportunity to be heard to the following persons:

(a) the registered proprietor of the trademark; or

(b) any person recorded under Part IX as claiming a right in respect of, or an interest in, the trademark.

(8) Where the Registrar revokes a registration under this section—

(a) the registration shall be deemed to have never occurred; and

(b) the registration which has been revoked shall be subject to further examination or proceedings as determined by the Registrar.

(9) It shall not be the duty of the Registrar to consider whether or not to revoke any registration notwithstanding any request for the Registrar to do so.

### **Revocation of registration by Court as to non-use of trademark**

**46.** (1) The registration of a trademark may be revoked by the Court on an application by an aggrieved person on any of the grounds as follows:

(a) where within a period of three years following the date of issuance of the notification of registration, the trademark has not been put to use in good faith in Malaysia, by the registered proprietor or with his consent, in relation to the goods or services for which the trademark is registered, and there are no proper reasons for non-use;

(b) where the use of the goods or services for which the trademark is registered has been suspended for an uninterrupted period of three years, and there are no proper reasons for non-use;



- (c) where in consequence of acts of inactivity of the registered proprietor, it has become the common name in the trade for the product or service for which it is registered; or
- (d) where in consequence of the use of the trademark by the registered proprietor or with his consent in relation to the goods or services for which the trademark is registered, it is liable to mislead the public, including in respect of the nature, quality or geographical origin of those goods or services.

(2) Subject to subsection (3), the registration of trademark shall not be revoked on the ground under paragraph (1)(a) or (b) if such use as is referred to in that paragraph is begun or resumed after the expiry of the three year period and before the application for revocation is made.

(3) Any such use referred to in paragraph (1)(a) or (b) that has begun or resumed after the expiry of the three year period but within the period of three months before the making of the application for revocation shall be disregarded unless preparations of such use began before the proprietor became aware that the application for revocation might be made.

(4) Where grounds for revocation exist in respect of only some of the goods or services for which the trademark is registered, revocation shall relate to those goods or services only.

(5) Where the registration of trademark is revoked to any extent, the rights of the registered proprietor shall be deemed to have ceased to that extent as from—

- (a) the date of the application for revocation; or
- (b) if the Court is satisfied that the grounds for revocation exists at an earlier date, that date.

### **Invalidation of registration by Court**

**47.** (1) The registration of trademark may be declared invalid by the Court upon the application by an aggrieved person on the ground that the trademark was registered in breach of section 23.

(2) Notwithstanding subsection (1), where the trademark was registered in breach of paragraph 23(1)(*b*), (*c*) or (*d*), it shall not be declared invalid if, the registration of trademark has acquired a distinctive character after its registration in consequence of its use in relation to the goods or services for which it is registered.

(3) The registration of trademark may be declared invalid by the Court upon the application by an aggrieved person on the ground that—

(*a*) there is an earlier trademark under subsection 24(1), (2) or (3); or

(*b*) there is an earlier right under subsection 24(4).

(4) The registration of trademark may not be declared invalid under subsection (3) if the proprietor of that earlier trademark or earlier right has consented to the registration.

(5) Where a trademark has been registered on the ground that there has been an honest concurrent use of the trademark and the earlier trademark or other earlier right, as provided for by section 25, the registration of trademark may not be declared invalid under subsection (3) unless the Registrar or the Court is satisfied that in fact there had been no honest concurrent use of the trademark and the earlier trademark or other earlier right.

(6) The registration of trademark may be declared invalid by the Court upon the application by an aggrieved person or the Registrar on the ground of fraud in the registration or that the registration was obtained by misrepresentation.

(7) Where the ground of invalidity exists in respect of only some of the goods or services for which the trademark is registered, the trademark shall be declared invalid as regards those goods or services only.

(8) Where the registration of trademark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made, but this shall not affect transactions past and closed.

PART VIII

EFFECTS OF REGISTERED TRADEMARKS

Chapter 1

*Rights of registered proprietor of trademark*

**Rights conferred by registered trademark**

**48.** (1) The registered proprietor of trademark has the exclusive rights—

(a) to use the trademark; and

(b) to authorize other persons to use the trademark,

in relation to the goods or services for which the trademark is registered.

(2) The registered proprietor has the right to obtain relief for infringement of his trademark.

(3) The acts amounting to infringement of a trademark are set out in section 54 and references to the infringement of a registered trademark shall be construed accordingly.

(4) The rights shall accrue to the proprietor as from the date of registration of trademark except that—

(a) no infringement proceedings may be begun before the date on which the trademark is in fact registered; and

(b) no offence under sections 99 to 102 is committed by anything done before the date on which the trademark is in fact registered.

(5) If the trademark is registered subject to any disclaimers, conditions, amendments, modifications or limitations, the rights of the proprietor are restricted by the disclaimers, conditions, amendments, modifications or limitations.

**Limitation on rights if similar trademarks, etc., registered by different persons**

**49.** If trademarks that are substantially identical or similar have been registered by more than one person whether in respect of the same or different goods or services under section 25, the registered proprietor of any one of those trademarks does not have the right to prevent the registered proprietor of any other of those trademarks from using that trademark except to the extent that the first-mentioned proprietor is authorized to do so under the registration of his trademark.

**Trademark consisting of sign that becomes accepted as sign describing article, etc.**

**50.** (1) This section applies if a registered trademark contains or consists of, a sign that, after the date of registration of trademark, becomes generally accepted within the relevant trade as the sign that describes or is the name of an article, substance or service.

(2) For the purposes of subsection (1), if the trademark consists of the sign, the registered proprietor—

(a) does not have any exclusive rights to use, or authorize other persons to use, the trademark in relation to—

(i) the article or substance or other goods of the same description; or

(ii) the service or other services of the same description, and

(b) is taken to have ceased to have those exclusive rights from and including the day determined by the Court under subsection (4).

(3) For the purposes of subsection (1), if the trademark contains the sign, the registered proprietor—

(a) does not have any exclusive rights to use, or authorize other persons to use, the sign in relation to—

(i) the article or substance or other goods of the same description; or

- (ii) the service or other services of the same description;  
and

(b) is taken to have ceased to have those exclusive rights from the day determined by the Court under subsection (4).

(4) For the purposes of subsections (2) and (3), the Court may determine the day on which a sign first became generally accepted within the relevant trade as the sign that describes or is the name of the article, substance or service.

### **Trademark relating to article, etc., formerly manufactured under patent**

**51.** (1) This section applies if—

- (a) a registered trademark contains or consists of, a sign that describes or is the name of—

- (i) an article or substance that was formerly exploited under a patent; or

- (ii) a service that was formerly provided as a patented process;

- (b) it is at least two years since the patent has expired or ceased; and

- (c) the sign is the only commonly known way to describe or identify the article, substance or service.

(2) If the trademark contains or consists of the sign in paragraph 1(a), the registered proprietor—

- (a) does not have any exclusive right to use, or authorize other persons to use the trademark or the sign in relation to—

- (i) the article or substance or other goods of the same description; or

- (ii) the service or other services of the same description;  
and

- (b) is taken to have ceased to have those exclusive rights from the end of the period of two years after the patent expired or ceased.

### **Registration *prima facie* evidence**

**52.** In all legal proceedings relating to a registered trademark—

- (a) the Register shall be *prima facie* evidence of anything contained in the Register;
- (b) the registration of the prescribed particulars of any registrable transaction under section 65 shall be *prima facie* evidence of the transaction; and
- (c) the registration of a person as the registered proprietor of the trademark shall be *prima facie* evidence of—
- (i) the validity of the original registration of trademark; and
  - (ii) any subsequent assignments and transmissions.

### **Registration conclusive**

**53.** In all legal proceedings relating to a trademark in the Register, the original registration of the trademark shall, after the expiration of five years from the date of registration be taken to be valid in all respects unless it is shown that—

- (a) the original registration was obtained by fraud;
- (b) the trademark offends paragraph 23(5)(a), (c), (d) or (e); or
- (c) the trademark was, at the commencement of the proceedings, devoid of distinctiveness of the goods or services of the registered proprietor.

Chapter 2

*Infringement of trademarks*

**Acts amounting to infringement of registered trademark**

**54.** (1) A person infringes a registered trademark if he uses a sign which is identical with the trademark in relation to goods or services which are identical with those for which it is registered, in the course of trade, without the consent of the registered proprietor.

(2) A person infringes a registered trademark if, without the consent of the proprietor of the trademark, he uses in the course of trade a sign—

- (a) that is identical with the trademark and is used in relation to goods or services similar to those for which the trademark is registered; or
- (b) that is similar to the trademark and is used in relation to goods or services identical with or similar to those for which the trademark is registered,

resulting in the likelihood of confusion on the part of the public.

(3) For the purposes of this section, a person uses a sign if he—

- (a) applies it to goods or their packaging;
- (b) offers or exposes goods for sale under the sign;
- (c) puts goods on the market under the sign;
- (d) stocks goods under the sign for the purpose of offering or exposing them for sale or of putting them on the market;
- (e) offers or supplies services under the sign;
- (f) imports or exports goods under the sign;

(g) uses the sign on an invoice, catalogue, business letter, business paper, price list or other commercial document, including any such document in any medium; or

(h) uses the sign in advertising.

(4) A person who—

(a) applies a registered trademark to any material used or intended to be used for labelling or packaging goods; or

(b) uses a sign on any document described in paragraph (3)(g) or (h),

shall be treated as a party who uses the material which infringes the registered trademark if when he applied the trademark, he knew or had reason to believe that the application of the trademark was not duly authorized by the registered proprietor of the trademark or a licensee.

### **Acts not amounting to infringement**

**55.** (1) Notwithstanding section 54, a person does not infringe a registered trademark when—

(a) he uses in good faith—

(i) his name or the name of his place of business; or

(ii) the name of his predecessor in business or the name of his predecessor's place of business;

(b) he uses in good faith a sign to indicate—

(i) the kind, quality, quantity, intended purposes, value, geographical origin or other characteristics of goods or services; or

(ii) the time of production of goods or the rendering of services; or



- (c) he uses the trademark to indicate the intended purpose of goods which includes accessories or spare parts or service,

and such use is in accordance with honest practices in industrial or commercial matters.

(2) Notwithstanding section 54, a person does not infringe a registered trademark by using an unregistered trademark that is identical with or similar to the registered trademark in relation to goods or services identical with or similar to those for which the trademark is registered if he has, or he and his predecessor in business have, continuously used in the course of trade the unregistered trademark in relation to those goods or services from a time before—

- (a) the date of registration of the registered trademark; or
- (b) the date the registered proprietor, or a predecessor in business, or a person who was a registered user under the repealed Act, first used the trademark,

whichever is the earlier.

(3) Notwithstanding anything contained in this Act, a person who uses a registered trademark does not infringe the trademark if such use—

- (a) is for a non-commercial purpose;
- (b) is for the purpose of news reporting or news commentary;
- (c) has at any time expressly or impliedly been consented to by the registered proprietor or licensee; or
- (d) of a trademark, which is one of two or more registered trademarks which are substantially identical, in the exercise of the right to the use of that trademark given by registration as provided by this Act.

(4) Notwithstanding anything contained in this Act, a registered trademark is not infringed by the use of another registered trademark in relation to goods or services for which the latter is registered.

**Action for infringement**

**56.** (1) The registered proprietor shall have the right to institute Court proceedings against any person who has infringed or is infringing the registered trademark.

(2) The registered proprietor shall have the same right of action in subsection (1) against any person who has performed acts which will make it likely that an infringement will occur.

(3) In an action for an infringement, the Court may grant relief including the following:

(a) an injunction subject to such conditions as the Court thinks fit which includes to prevent goods that involve the infringement from entering into the channels of commerce;

(b) damages;

(c) an account of profits; or

(d) in any case to which subsection (7) applies, the award of such additional damages as it considers appropriate in the circumstances by the Court.

(4) Notwithstanding paragraph (3)(a), upon the application of the plaintiff for an interim injunction, when the Court is satisfied that the infringement involves the use of a counterfeit trademark in relation to goods or services, the Court may order—

(a) the seizure or taking into custody of suspected infringing goods, materials or articles relevant to the infringement; and

(b) the supply of documentary evidence relevant to the infringement.

(5) When the Court awards any damages under paragraph (3)(b), the Court may also make an order under paragraph (3)(c) for an account of profits attributable to the infringement that have not been taken into account in computing the damages.

(6) Except as provided for in subsection (5), the relief referred to in paragraphs (3)(b), (c) and (d) are mutually exclusive.

(7) In any action for infringement of a registered trademark where the infringement involves the use of a counterfeit trademark in relation to goods or services, the plaintiff shall be entitled, at his election, to—

(a) damages and an account of profits attributable to the infringement that have not been taken into account in computing the damages;

(b) an account of profits; or

(c) additional damages as it considers appropriate in the circumstances.

(8) Pursuant to paragraph (7)(c), the Court shall have regard to—

(a) the flagrancy of the infringement of the registered trademark;

(b) any benefit shown to have accrued to the defendant by reason of the infringement;

(c) the need to punish the defendant for such act of infringement; and

(d) all other relevant matters.

(9) Notwithstanding the claim for priority made under section 26, 27 or 28, nothing in this section shall entitle the registered proprietor to recover any relief under subsection (3) for infringements or any happening prior to the date on which the application for protection of the trademark is made and become registered in Malaysia.

### **Circumstances in which action may not be instituted**

**57.** An action for infringement may not be instituted in respect of an act that was done after the registration of trademark has expired or has been deemed removed and before it was renewed or restored under section 39.

**Order for erasure, etc., of offending sign**

**58.** (1) Subject to subsection (3), where a person is found to have infringed a registered trademark, the Court may make an order requiring him—

- (a) to cause the offending sign to be erased, removed or obliterated from any infringing goods, material or articles in his possession, custody or control; or
- (b) if it is not reasonably practicable for the offending sign to be erased, removed or obliterated, to secure the destruction of the infringing goods, material or articles in question.

(2) If an order under subsection (1) is not complied with or it appears to the Court that it is likely that such an order would not be complied with, the Court may order that the infringing goods, material or articles be delivered up to such person as the Court may direct for the erasure, removal or obliteration of the sign, or otherwise for the destruction of the sign.

(3) Where a person who is found to have infringed a registered trademark has in his possession, custody or control any counterfeit goods, the Court shall order that the counterfeit goods be delivered up to such person as the Court may direct for destruction if—

- (a) the plaintiff applies to the Court for such an order; and
- (b) the Court is of the view that there are no exceptional circumstances which would justify the refusal of such an order.

**Order for delivery up of infringing goods, material or articles**

**59.** (1) The Court may, in addition to any relief granted under sections 56 and 58 in any action for an infringement of a registered trademark, order any infringing goods, material or articles in the possession of the defendant or before the Court to be delivered up to the plaintiff.

(2) Where the Court makes an order under subsection (1), it shall also make an order under section 60 unless it determines that there are grounds for not making such an order.

(3) A person to whom any infringing goods, material or articles are delivered up pursuant to an order under subsection (1) shall, if an order under section 60 is not made at the time of the making of the order under subsection (1), retain them pending the decision of the application under section 60.

### **Order for disposal of infringing goods, material or articles**

**60.** (1) Where infringing goods, material or articles have been delivered up pursuant to an order under section 59, an application may be made to the Court—

(a) for an order that they be destroyed or forfeited to such person as the Court may think fit; or

(b) for a decision that no order under paragraph (a) shall be made.

(2) In considering what order, if any, should be made, the Court shall have regard to—

(a) whether other remedies available in an action for infringement of the registered trademark would be adequate to compensate the plaintiff and protect his interest; and

(b) the need to ensure that no infringing goods, material or articles are disposed of in a manner that would adversely affect the plaintiff.

(3) Notwithstanding subsection (2), where the infringing goods are counterfeit goods, the Court shall order that the goods be destroyed if—

(a) the plaintiff applies to the Court for such an order; and

(b) the Court is of the view that there are no exceptional circumstances which would justify the refusal of such an order.

(4) The Court shall issue directions as to the service of notice on persons having an interest in the infringing goods, material or articles.

(5) Any person having an interest in the infringing goods, material or articles shall be entitled—

(a) to appear in proceedings of an application for an order under this section, whether or not that person is served with notice; and

(b) to appeal against any order made, whether or not that person appears in the proceedings.

(6) An order made under this section shall not take effect until the end of the period within which a notice of appeal may be given or, if before the end of that period notice of appeal is duly given, until the final determination or discontinuance of the proceedings on the appeal.

(7) Subject to subsection (3), where there is more than one person interested in the infringing goods, material or articles, the Court may direct that the infringing goods, material or articles be sold, or otherwise dealt with, and the proceeds divided, and shall make any other order as it thinks fit.

(8) If the Court decides that no order should be made under this section, the person in whose possession, custody or control of the infringing goods, material or articles were before being delivered up, is entitled to their return.

### **Remedy for groundless threats of infringement proceedings**

**61.** (1) Where a person threatens another with proceedings for infringement of a registered trademark other than—

(a) the application of the trademark to goods or to material used or intended to be used for labelling or packaging goods;

(b) the importation of goods to which, or to the packaging of which, the trademark has been applied; or

(c) the supply of services under the trademark,

any aggrieved person may bring proceedings for relief under this section.

(2) The relief which may be applied for shall be any of the following:

- (a) a declaration that the threats are unjustifiable;
- (b) an injunction against the continuance of the threats; or
- (c) damages in respect of any loss he has sustained by the threats.

(3) The plaintiff shall be entitled to the relief in subsection (2) unless the defendant shows that the acts in respect of which proceedings were threatened constitute or if done would constitute an infringement of the registered trademark concerned.

(4) If the defendant shows that the acts in respect of which proceedings were threatened constitute or if done would constitute an infringement of the registered trademark concerned, the plaintiff shall nevertheless be entitled to relief if he shows that the registration of trademark is invalid or liable to be revoked in a relevant respect.

(5) The mere notification that a trademark is registered, or that an application for registration has been made, shall not constitute a threat of proceedings for the purposes of this section.

(6) Nothing in this section shall render an advocate and solicitor liable to an action under this section in respect of an act done by him in his professional capacity on behalf of a client.

## PART IX

### TRADEMARKS AS OBJECT OF PROPERTY

#### **Nature of registered trademark as property**

**62.** A registered trademark shall be a personal or moveable property and may be the subject of a security interest in the same way as other personal or moveable property.

**Co-proprietorship of registered trademark**

**63.** (1) Where a registered trademark is granted to two or more persons jointly, each of them shall be entitled, subject to any agreement to the contrary, to an equal undivided share in the registered trademark.

(2) This section applies where two or more persons are co-proprietors of a registered trademark under subsection (1).

(3) Subject to subsection (4) or any agreement to the contrary, each co-proprietor shall be entitled, by himself or his agents, to do for his own benefit and without the consent of or the need to account to the other, any act which would otherwise amount to an infringement of the registered trademark.

(4) One co-proprietor shall not without the consent of the other—

(a) grant a licence to use the registered trademark; or

(b) assign or charge his share in the registered trademark.

(5) Infringement proceedings may be brought by any co-proprietor, but he may not, without leave of the Court, proceed with the action unless the other, or each of the others, is either joined as a plaintiff or added as a defendant.

(6) A co-proprietor who is thus added as a defendant shall not be made liable for any costs in the action unless he takes part in the proceedings.

(7) Nothing in this subsection affects the granting of interlocutory relief on the application of a single co-proprietor.

(8) Nothing in this section affects the mutual rights and obligations of trustees or personal representatives, or their rights and obligations as such.

**Assignment, etc., of registered trademark**

**64.** (1) A registered trademark shall be transmissible by assignment or transmission in the same way as other personal or moveable property, and shall be so transmissible either in connection with the goodwill of a business or independently.



(2) An assignment or other transmission of a registered trademark may be partial which is limited so as to apply in relation to some but not all of the goods or services for which the trademark is registered.

(3) An assignment of a registered trademark, or an assent relating to a registered trademark, shall not be effective unless it is in writing and is signed by or on behalf of the assignor and assignee, or a personal representative, as the case may be.

(4) Subsections (1), (2) and (3) shall apply to an assignment by way of security as in relation to any other assignment.

(5) A registered trademark may be the subject of a charge in the same manner as other personal or moveable property.

(6) Nothing in this Act shall be construed as affecting the assignment or other transmission of an unregistered trademark as part of the goodwill of a business.

### **Registration of transaction affecting registered trademark**

**65.** (1) The particulars of a registrable transaction as determined by the Registrar shall be entered in the Register upon the approval by the Registrar on application being made in the form as determined by the Registrar together with the payment of the prescribed fee by—

(a) a person claiming to be entitled to an interest in or under a registered trademark by virtue of the registrable transaction; or

(b) any other person claiming to be affected by such a transaction.

(2) Until an application has been made under subsection (1) and approved by the Registrar, the transaction shall be ineffective against a person acquiring a conflicting interest in or under the registered trademark in ignorance of the transaction.

(3) A person who becomes the proprietor of a registered trademark by virtue of any registrable transaction shall not be entitled to damages or an account of profits in respect of any infringement of the registered trademark occurring after the date of the transaction and before the date of the application for the registration made under subsection (1).

(4) Subsections (2) and (3) shall not apply to any registrable transaction relating to a licence under a registered trademark or any right in or under the licence.

(5) The Registrar may amend or remove any particulars relating to a security interest on the application of the registered proprietor and with the consent of the person entitled to the benefit of that interest in the form as determined by the Registrar together with the payment of the prescribed fee.

### **Trust and equities**

**66.** (1) Notice of any implied or constructive trust shall be not be entered in the Register.

(2) Notwithstanding that a notice of an express trust or of the beneficiary of an express trust may be entered in the Register—

(a) the Registrar shall not be affected by such notice in the Register; and

(b) for the avoidance of doubt, a failure to enter such notice in the Register shall not affect any rights or duties under the trust.

(3) Subject to the provisions of this Act, equities in respect of a registered trademark may be enforced in like manner as in respect of other personal or movable property.

### **Application for registration of trademark as an object of property**

**67.** (1) Sections 62 to 66 shall apply in relation to an application for registration of trademark as they apply in relation to a registered trademark.

(2) For the purposes of subsection (1), the reference in section 63(1) to the granting of a registration shall be construed as a reference to the making of an application for the registration of trademark.

(3) In section 65 as it applies in relation to a transaction affecting an application for the registration of trademark, the references to the entry of particulars in the Register, and to the making of an application to register particulars, shall be construed as references to the giving of notice to the Registrar of those particulars.

## PART X

### LICENSING

#### **Interpretation**

**68.** In this Part—

- (a) “exclusive licence” means a licence, whether general or limited, authorizing the licensee to the exclusion of all other persons including the person granting the licence, to use a registered trademark in the manner authorized by the licence, and the expression “exclusive licensee” shall be construed accordingly; and
- (b) “licence” includes a sub-licence and “licensee” shall be construed accordingly and references to a licence or licensee include references to a sub-licence or sub-licensee.

#### **Licensing of registered trademark**

**69.** (1) A licence to use a registered trademark may be general or limited.

(2) A limited licence may apply—

- (a) in relation to some but not all of the goods or services for which the trademark is registered; or
- (b) in relation to use of the trademark in a particular manner or a particular locality.

(3) A licence shall not be effective unless it is in writing and is signed by or on behalf of the grantor.

(4) A licence to use a registered trademark shall be binding on every successor in title to the grantor's interest—

(a) except any person who, in good faith and without any notice, actual or constructive, of the licence, has given valuable consideration for the interest in the registered trademark; or

(b) unless the licence provides otherwise,

and any reference to doing anything with, or without, the consent of a registered proprietor of trademark shall be construed accordingly.

(5) Every person shall be deemed to have notice of a licence if the particulars as determined by the Registrar of the grant of the licence are entered in the Register under subsection 65(1).

(6) Where the licence so provides, a sub-licence may be granted by the licensee.

(7) This section shall apply, with the necessary modifications, to an exclusive licence.

### **Rights of licensees in case of infringement**

**70.** (1) This section has effect with respect to the rights of a licensee in relation to infringement of a registered trademark except for an exclusive licensee under subsections 71(1) and (2), the licensee has the right to bring infringement proceeding in his own name.

(2) A licensee shall be entitled, unless his licence or any license through which his interest is derived, provides otherwise, to call on the registered proprietor of the trademark to take infringement proceedings in respect of any matter which affects his interests.

(3) For the purposes of subsection (2), if the registered proprietor refuses or does not take infringement proceedings within two months after being called upon, the licensee may bring the proceedings in his own name as if he were the registered proprietor.

(4) Where infringement proceedings are brought by a licensee by virtue of this section, the licensee may not, without leave of the Court, proceed with the action unless the registered proprietor is either joined as a plaintiff or added as a defendant.

(5) Subsection (4) does not affect the granting of interlocutory relief on an application by a licensee alone.

(6) A registered proprietor who is added as a defendant under subsection (4) shall not be liable for any costs in the action unless he takes part in the proceedings.

(7) In infringement proceedings brought by the registered proprietor, any loss suffered or likely to be suffered by a licensee shall be taken into account and the Court may give such directions as it thinks fit as to the extent to which the plaintiff is to hold the proceeds of any pecuniary remedy on behalf of a licensee.

(8) The provisions of this section apply in relation to an exclusive licensee if or to the extent that he has, under subsections 71(1) and (2), the rights and remedies of an assignee as if he were the registered proprietor of the trademark.

### **Exclusive licensee having rights and remedies of assignee**

**71.** (1) An exclusive licence may provide that the licensee shall have, to such extent as may be provided by the licence, the same rights and remedies in respect of matters occurring after the grant of the licence as if the licence had been an assignment.

(2) Where or to the extent of the provision referred to in subsection (1), the licensee shall be entitled, subject to the provisions of the licence and this section, to bring infringement proceedings, against any person other than the registered proprietor, in his own name.

(3) Any such rights and remedies of an exclusive licensee are concurrent with those of the proprietor of the registered proprietor and references to the registered proprietor relating to infringement shall be construed accordingly.

(4) In an action brought by an exclusive licensee under this section, a defendant may avail himself of any defence which would have been available to him as if the action had been brought by the registered proprietor of the trademark.

(5) Where proceedings for infringement of a registered trademark brought by the registered proprietor or an exclusive licensee relate wholly or partly to an infringement in respect of which they have concurrent rights of action, the registered proprietor or the exclusive licensee may not, without leave of the Court, proceed with the action unless the other is either joined as a plaintiff or added as a defendant.

(6) Subsection (5) does not affect the granting of interlocutory relief on an application by a registered proprietor of the trademark or exclusive licensee alone.

(7) A person who is added as a defendant under subsection (4) shall not be liable for any costs in the action unless he takes part in the proceedings.

(8) Where an action for infringement of a registered trademark brought relates wholly or partly to an infringement in respect of which the registered proprietor and an exclusive licensee have or had concurrent rights of action—

(a) the Court shall in assessing damages take into account—

(i) the terms of the licence; and

(ii) any pecuniary remedy already awarded or available to either of them in respect of the infringement;

(b) no account of profits shall be directed if an award of damages has been made, or an account of profits has been directed, in favour of the other of them in respect of the infringement; and

(c) the Court shall, if an account of profits is directed, apportion the profits between them as the Court considers just, subject to any agreement between them.

(9) Subsection (8) shall apply whether or not the registered proprietor and the exclusive licensee are both parties to the action, and if they are not both parties, the Court may give such directions as it thinks fit as to the extent to which the party to the proceedings is to hold the proceeds of any pecuniary remedy on behalf of the other.

(10) Subsections (5) to (8) have effect subject to any agreement to the contrary between the exclusive licensee and the registered proprietor of the trademark.

## PART XI

### COLLECTIVE MARKS AND CERTIFICATION MARKS

#### **Collective marks**

**72.** (1) A collective mark shall be a sign distinguishing the goods or services of members of the association which is the proprietor of the mark from those of other undertakings.

(2) The provisions of this Act apply to collective marks subject to the provisions of the First Schedule.

#### **Certification marks**

**73.** (1) A certification mark shall be a sign indicating that the goods or services in connection with which it shall be used are certified by the proprietor of the mark in respect of origin, material, mode of manufacture of goods or performance of services, quality, accuracy or other characteristics.

(2) The provisions of this Act apply to collective marks subject to the provisions of the Second Schedule.

## PART XII

## INTERNATIONAL MATTERS

## Chapter 1

*Madrid Protocol***Interpretation**

**74.** For the purposes of this Part, “Madrid Protocol” means the Protocol relating to the Madrid Agreement concerning the International Registration of Marks, adopted at Madrid on 27th June 1989.

**Regulations relating to Madrid Protocol**

**75.** (1) The Minister may make regulations to give effect to the provisions of the Madrid Protocol in Malaysia.

(2) Without prejudice to the generality of subsection (1), regulations may provide for all or any of the following purposes:

- (a) all matters relating to applications for international registration of trademarks including where the basic Malaysia application or registration fails or ceases to be in force and its renewal;
- (b) all matters relating to requests to extend to Malaysia the protection resulting from international registration of trademark and including the effects of such requests;
- (c) all matters relating to the protection to protected international registration designating Malaysia including the cessation of such protection;
- (d) all matters relating to the transformation of an application for an international registration, or an international registration, into a national application for registration including the effects of such transformation;



- (e) all matters relating to the cancellation of an international registration including the effects of such cancellation;
- (f) all matters relating to a protected international registration designating Malaysia including the application of section 61 and Parts XIII and XV;
- (g) the payment of fees and amounts prescribed in respect of applications for international registrations, extensions of protection and renewals; and
- (h) all other matters as are necessary or expedient to be prescribed for giving effect to this Act.

## Chapter 2

### *Conventions and international arrangements*

#### **Protection of well-known trademarks**

**76.** (1) A well-known trademark shall be entitled to protection under this section—

- (a) whether or not the trademark has been registered in Malaysia, or an application for the registration of trademark has been made to the Registrar; and
- (b) whether or not the proprietor of the trademark carries on business, or has any goodwill, in Malaysia.

(2) Subject to subsections (5) and (6), the proprietor of a well-known trademark shall be entitled to restrain by injunction the use in Malaysia, in the course of trade and without the proprietor's consent, of any trademark which, or an essential part of which, is identical with or similar to the proprietor's trademark—

- (a) in relation to identical or similar goods or services, where the use is likely to cause confusion; or

- (b) in relation to any goods or services, where the use of the trademark would indicate a connection between those goods or services and the proprietor, and is likely to damage the interests of the proprietor.

(3) A proprietor of a well-known trademark may apply to the Court for a declaration of invalidation of a registered trademark on the grounds that the registered trademark is identical with or similar to a well-known trademark in Malaysia and the registered trademark is registered for any goods or services which are not identical or not similar to those in respect of the well-known trademark—

- (a) if the use of the registered trademark in relation to those goods or services would indicate a connection between those goods or services and the proprietor of the well-known trademark;
- (b) there exists a likelihood of confusion on the part of the public because of such use; and
- (c) the interests of the proprietor of the well-known trademark are likely to be damaged by such use.

(4) A proprietor of a well-known trademark may apply to the Court for a declaration of invalidation of a registered trademark on the grounds of fraud in the registration or that the registration was obtained by misrepresentation.

(5) The proprietor of a well-known trademark shall not be entitled to the right referred to in subsection (2) if the use of the trademark began before the proprietor's trademark became well-known in Malaysia unless the trademark has been used in bad faith.

(6) The proprietor of a well-known trademark shall cease to be entitled to the right referred to in subsection (2) if the proprietor of the well-known trademark has acquiesced for a continuous period of five years in the use of the trademark in Malaysia, being aware of that use, unless the trademark has been used in bad faith.

(7) In deciding whether the trademark, has been used in bad faith, it shall be relevant to the Court to consider whether the person who used the trademark had, at the time he began to use the trademark, knowledge of, or reason to know of, the proprietor's well-known trademark.

(8) Nothing in subsection (2) shall affect the continuation of any use referred to that subsection in good faith of a trademark that was begun before 1 December 1997 (when the relevant provisions of the TRIPS Agreement entered into force in relation to the Malaysia).

(9) Nothing in subsection (3) shall affect the continuation of any *bona fide* use of a trademark begun before the commencement of this Act.

(10) For the purposes of this section, "use", in relation to a trademark, means use within the meaning of subsection 54(3).

### **Permitted use of well-known trademarks**

**77.** (1) Notwithstanding section 76, the proprietor of a well-known trademark shall not be entitled to restrain by injunction the use in Malaysia, in accordance with honest practices in industrial or commercial matters, by any person of—

(a) the name of—

- (i) the person himself;
- (ii) the person's place of business;
- (iii) the person's predecessor in business; or
- (iv) the place of business of the person's predecessor in business;

(b) any sign to indicate—

- (i) the kind, quality, quantity, intended purpose, value, geographical origin or other characteristic of goods or services; or

- (ii) the time of production of goods or of the rendering of services; or
- (c) the trademark to indicate the intended purpose of goods which includes accessories or spare parts or services.

(2) Notwithstanding section 76, the proprietor of a well-known trademark shall not be entitled to restrain by injunction the use in Malaysia of—

- (a) any registered trademark in relation to goods or services for which the latter is registered; or
- (b) the trademark if such use—
  - (i) is for a non-commercial purpose;
  - (ii) is for the purpose of news reporting or news commentary; or
  - (iii) has at any time expressly or impliedly been consented to by the proprietor of the well-known mark.

### **National emblems, etc., of Convention countries under Article 6ter of Paris Convention**

**78.** (1) A trademark which consists of or contains the flag of a Convention country shall not be registered without the authorization of the competent authorities of that country, unless it appears to the Registrar that the use of the flag in the manner proposed is permitted without such authorization.

(2) A trademark which consists of or contains the armorial bearings or any other state emblem of a Convention country which is protected under the Paris Convention or the TRIPS Agreement shall not be registered without the authorization of the competent authorities of that country.

(3) A trademark which consists of or contains an official sign or hallmark adopted by a Convention country and indicating control and warranty shall not, where the sign or hallmark is protected under the Paris Convention or the TRIPS Agreement, be registered

of the same, or a similar kind, as those in relation to which it indicates control and warranty, without the authorization of the competent authorities of the country concerned.

(4) References to national flags and other state emblems, and official signs or hallmarks under this section, apply equally to anything which from a heraldic point of view imitates any such flag or other emblem, or sign or hallmark.

(5) Nothing in this section prevents the registration of trademark on the application of a national of a country who is authorized to make use of a state emblem, or official sign or hallmark, of that country, notwithstanding that it is similar to that of another country.

(6) Where by virtue of this section the authorization of the competent authorities of a Convention country is or would be required for the registration of trademark, those authorities are entitled to restrain by injunction any use of the trademark in Malaysia without their authorization.

### **Emblems, etc., of certain international intergovernmental organization under Article 6ter of Paris Convention**

**79.** (1) A trademark which consists of or contains any armorial bearing, flag, emblem, abbreviation or name of international intergovernmental organizations of which one or more Convention countries are members and which is protected under the Paris Convention or the TRIPS Agreement shall not be registered without the authorization of the international intergovernmental organization concerned, unless it appears to the Registrar that the use of the armorial bearing, flag, emblem, abbreviation or name in the manner proposed—

- (a) would indicate to the public that a connection exists between the organization and the trademark; or
- (b) is not likely to mislead the public as to the existence of a connection between the user and the organization.

(2) References to armorial bearing, flag, emblems, abbreviation or name of an international intergovernmental organization under this section, apply equally to anything which from a heraldic point of view imitates any such emblem.

(3) Where under this section, the authorization of an international intergovernmental organization shall or would be required for the registration of trademark, that organization shall be entitled to restrain by injunction any use of the trademark in Malaysia without its authorization.

(4) Nothing in this section affects the rights of a person whose use in good faith of the trademark in question began before 1 January 1989 (when the relevant provisions of the Paris Convention entered into force in relation to the Malaysia).

### **Notification under Article 6ter of the Paris Convention**

**80.** (1) For the purposes of section 78, state emblems of a Convention country, other than the national flag, and official signs or hallmarks, shall be regarded as protected under the Paris Convention or the TRIPS Agreement only if, or to the extent that—

- (a) the country in question has notified Malaysia in accordance with Article 6ter(3) of the Paris Convention, or under that Article as applied by the TRIPS Agreement, that it desires to protect that emblem, sign or hallmark;
- (b) the notification remains in force; and
- (c) Malaysia has not objected to it in accordance with Article 6ter(4) of the Paris Convention or under that Article as applied by the TRIPS Agreement, or any such objection has been withdrawn.

(2) For the purposes of section 79, the armorial bearing, flag, emblems, abbreviations and names of an international intergovernmental organization shall be regarded as protected under the Paris Convention or under that Article as applied by the TRIPS Agreement only if, or to the extent that—

- (a) the organization in question has notified Malaysia in accordance with Article 6ter(3) of the Paris Convention or under that Article as applied by the TRIPS Agreement, that it desires to protect that armorial bearing, flag, emblem, abbreviation or name;

(b) the notification remains in force; and

(c) Malaysia has not objected to it in accordance with Article 6ter(4) of the Paris Conventions or under that Article as applied by the TRIPS Agreement, or any such objection has been withdrawn.

(3) Notification under Article 6ter(3) of the Paris Convention or under that Article as applied by the TRIPS Agreement, shall have effect only in relation to applications for registration of trademarks under subsection 17(2) made more than two months after the receipt of the notification.

(4) The Registrar shall keep and make available for public inspection, at all reasonable hours and free of charge, a list of—

(a) the state emblems and official signs or hallmarks; and

(b) the armorial bearing, flag, emblems, abbreviations and names of international intergovernmental organizations,

which are for the time being protected under the Paris Convention or under that Article as applied by the TRIPS Agreement by notification made under Article 6ter(3) of the Paris Convention or under that Article as applied by the TRIPS Agreement.

## PART XIII

### BORDER MEASURES

#### **Interpretation**

**81.** In this Part—

(a) “authorized officer” means—

(i) a proper officer of customs as defined under the Customs Act 1967 [Act 235]; or

(ii) any public officer, or any person in the employment of the Corporation, appointed by the Minister to exercise the powers and perform the duties conferred and imposed on an authorized officer by this Part;

- (b) “goods in transit” means goods imported, whether or not landed or transshipped within Malaysia, which are to be carried to another country either by the same or another conveyance;
- (c) “import” means to bring or cause to be brought into Malaysia by whatever means;
- (d) “retention period”, in relation to seized goods, means—
  - (i) the period specified in a notice given under section 85 in respect of the goods; or
  - (ii) if the period has been extended under section 85, that period so extended;
- (e) “security” means any sum of money in cash or other monetary instrument as determined by the Registrar; and
- (f) “seized goods” means goods seized under section 82.

### **Restriction on importation of infringing goods**

**82.** (1) Any person may file an application to the Registrar stating—

- (a) that he is the registered proprietor, or the licensee having the power to file such application;
- (b) that, at a time and place specified in the application, goods which, in relation to the registered trademark, are infringing goods are expected to be imported for the purpose of trade; and
- (c) that he objects to such importation.

(2) An application under subsection (1) shall be supported by the documents and information as determined by the Registrar relating to the goods as to enable them to be identified by the authorized officer, and together with the payment of the prescribed fee.



(3) Upon receipt of the application under subsection (1), the Registrar shall determine the application, and the Registrar shall within a reasonable period inform the applicant whether the application has been approved.

(4) In determining the reasonable period under subsection (3), the Registrar shall take into consideration all relevant circumstances of the case.

(5) An approval under subsection (3) shall remain in force until the end of the period of sixty days commencing on the day on which the approval was given, unless it is withdrawn before the end of that period by the applicant by giving a notice in writing to the Registrar.

(6) Where an approval has been given under this section and has not lapsed or been withdrawn, the importation of any infringing goods into Malaysia for the duration of the period specified in the approval shall be prohibited.

(7) Upon giving his approval under subsection (3) the Registrar shall immediately take the necessary measures to notify the authorized officer.

(8) Where an authorized officer has been notified by the Registrar under subsection (7), the authorized officer shall take the necessary action to prohibit any person from importing the infringing goods identified in the notice, not being goods in transit, and shall seize and detain the identified goods.

## **Security**

**83.** The Registrar shall, upon giving his approval under section 82, require the applicant to deposit with the Registrar a security which in the opinion of the Registrar is sufficient to—

- (a) reimburse the Registrar for any liability or expense it is likely to incur as a result of the seizure of the infringing goods;
- (b) prevent abuse and to protect the importer; or
- (c) pay such compensation as may be ordered by the Court under this Part.

**Secure storage of seized goods**

**84.** (1) Seized goods shall be taken to such secure place as the Registrar may direct or as the authorized officer deems fit.

(2) If it is stored on the direction of the authorized officer, the authorized officer shall inform the Registrar of the whereabouts of the seized goods.

**Notice**

**85.** (1) As soon as is reasonably practicable after the infringing goods are seized under section 82, the authorized officer shall give to the Registrar, importer and the applicant, either personally or by registered post, a written notice identifying the infringing goods, stating that they have been seized and the whereabouts of the goods.

(2) A notice under subsection (1) shall also state that the infringing goods will be released to the importer unless an action for infringement in respect of the goods is instituted by the applicant within a specified period from the date of the notice.

(3) If at the time of the receipt of the notice an action for infringement has been instituted by the applicant, the applicant shall notify the Registrar of that fact in the form as determined by the Registrar.

(4) The applicant may, by written notice given to the Registrar before the end of the period specified in the notice (the initial period), request that the period be extended.

(5) Subject to subsection (6), the Registrar may extend the initial period upon a request made in accordance with subsection (4) where the Registrar is satisfied that it is reasonable that the request be granted.

(6) A decision on a request made in accordance with subsection (4) shall be made within two working days after the request is made, but such decision cannot be made after the end of the initial period to which the request relates.

**Inspection, release, etc., of seized goods**

**86.** (1) The Registrar may permit the applicant or importer to inspect the seized goods if the applicant or importer agrees to give the requisite undertakings.

(2) The requisite undertakings under subsection (1) are undertakings in writing that the person giving the undertakings will—

(a) return the sample of the seized goods to the Registrar at a specified time that is satisfactory to the Registrar; and

(b) take reasonable care to prevent damage to the sample.

(3) If the applicant gives the requisite undertakings, the Registrar may permit the applicant to remove a sample of the seized goods from the custody of the Registrar for inspection by the applicant.

(4) If the importer gives the requisite undertakings, the Registrar may permit the importer to remove a sample of the seized goods from the custody of the Registrar for inspection by the importer.

(5) If the Registrar permits inspection of the seized goods, or the removal of a sample of the seized goods, by the applicant in accordance with this section, the Registrar shall not be liable to the importer for any loss or damage suffered by the importer arising out of—

(a) damage to any of the seized goods incurred during that inspection; or

(b) anything done by the applicant or any other person to, or in relation to, a sample removed from the custody of the Registrar or any use made by the applicant or any other person of such a sample.

**Forfeiture of seized goods by consent**

**87.** (1) Subject to subsection (2), the importer may, by written notice to the Registrar, consent to the seized goods being forfeited.

(2) The notice shall be given before any action for infringement in relation to the seized goods is instituted.

(3) If the importer gives such a notice, the seized goods are forfeited and shall be disposed of in the manner as determined by Registrar.

### **Compulsory release of seized goods to importer**

**88.** (1) The Registrar shall release the seized goods to the importer on the expiration of the retention period for the goods if the applicant—

- (a) has not instituted an action for infringement in relation to the goods; and
- (b) has not given written notice to the Registrar stating that the action for infringement has been instituted.

(2) If—

- (a) an action for infringement has been instituted in relation to the seized goods; and
- (b) at the end of a period of thirty days commencing on the day on which the action for infringement was instituted, there shall not be in force an order of the Court in which the action was instituted preventing the release of the goods,

the Registrar shall release the goods to the importer.

(3) If the applicant gives a written notice to the Registrar stating that he consents to the release of the seized goods, the Registrar shall release the goods to the importer.

### **Compensation for failure to take action**

**89.** (1) Where goods have been seized pursuant to a notice given under section 82 and the applicant does not take action for infringement within the retention period, a person aggrieved by such seizure may apply to the Court for an order of compensation against the applicant.

(2) Where the Court is satisfied that the person aggrieved had suffered loss or damage as a result of the seizure of the goods, the Court may order the applicant to pay compensation in such amount as the Court thinks fit to the aggrieved person.

### **Actions for infringement of registered trademark**

**90.** (1) If an action for infringement has been instituted by the applicant, the Court may in addition to any relief that may be granted—

- (a) order that the seized goods be released to the importer subject to such conditions, if any, as the Court thinks fit;
- (b) order that the seized goods be not released to the importer before the end of a specified period; or
- (c) order that the seized goods be forfeited,

depending on the circumstances of the case.

(2) The Registrar or the authorized officer shall be entitled to be heard on the hearing of an action for infringement.

(3) The Court may not make an order under paragraph (1)(a) if it is satisfied that the Registrar or any authority is required or permitted under any other law to retain control of the seized goods.

(4) The Registrar shall comply with an order made under subsection (1).

(5) The Court may order the applicant to pay compensation in such amount as the Court thinks fit to the defendant if—

- (a) the action is dismissed or discontinued, or if the Court decides that the relevant registered trademark was not infringed by the importation of the seized goods; and
- (b) the defendant to the action for infringement satisfies the Court that he has suffered loss or damage as a result of the seizure of the goods.

**Disposal of seized goods ordered to be forfeited**

**91.** If the Court orders that seized goods are to be forfeited, the goods shall be disposed of in the manner as directed by the Court.

**Insufficient security**

**92.** (1) If the reasonable expenses incurred by the Registrar in relation to any action taken by the Registrar under this Part, or taken in accordance with an order of the Court under this Part, exceed the amount of security deposited under section 83, the amount of the excess shall be a debt due to the Registrar.

(2) The debt under subsection (1) shall be due by the applicant, or, if there are two or more applicants, by the applicants jointly and severally.

***Ex-officio* action**

**93.** (1) Based on *prima facie* evidence, any authorized officer may detain or suspend the release of goods bearing, without authorization, a trademark which is identical to the registered trademark and the goods are identical to the goods of a registered trademark, which are to be imported or destined for export.

(2) Where such goods have been detained, the authorized officer—

(a) shall inform the Registrar, the importer and the registered proprietor; and

(b) may at any time seek from the registered proprietor any information that may assist him to exercise his powers.

(3) Subject to section 88, an importer may lodge an appeal to the Director General under the Customs Act 1967 against the detention of goods or suspension of the release of goods under subsection (1).

(4) The authorized officer shall only be exempted from liability if his actions under subsection (1) are done in good faith.

(5) Destined for export referred to in subsection (1) means goods which are to be exported from Malaysia to another country through any mode of transportation.

### ***De Minimis Imports***

**94.** (1) The provisions in this Part shall not apply to small quantities of goods of a non-commercial nature contained in travelers' personal luggage or sent in small consignments.

(2) Small quantities referred to in subsection (1) means not more than two goods.

## PART XIV

### TRADEMARK AGENTS

#### **Recognition of registered trademark agents and circumstances in which a registered trademark agent shall be required**

**95.** (1) Any act which is required or authorized by this Act to be done by or to a person in connection with the preliminary procedure, or application for registration of trademark, or any procedure relating to a registered trademark, may be done by or to a registered trademark agent duly authorized by that person in the manner as determined by the Registrar.

(2) Where a person appearing before the Registrar in a preliminary procedure or applying for registration of trademark or any procedure relating to a registered trademark, does not reside or carry on business principally in Malaysia, he shall appoint and authorize a registered trademark agent to act for him.

(3) Upon being appointed and authorized by the person to act for him under subsection (2), the registered trademark agent shall—

(a) continue to be the agent of the person; and

(b) be answerable for all acts, matters and things that are required to be done by the person under this Act,

unless he is terminated by the person or ceases to act for him in accordance with the prescribed manner.

(4) Where a registered trademark agent acting for a person intends to cease to act on behalf of the said person—

- (a) the registered trademark agent shall file the notice of the intention to cease to act on the said person's behalf with the Registrar in the manner as determined by the Registrar;
- (b) the registered trademark agent shall notify the person; and
- (c) upon complying with subparagraphs (a) and (b), the agent shall cease to be the agent for the said person.

### **Register of Trademark Agents**

**96.** (1) The Registrar shall keep and maintain a register called the Register of Trademark Agents.

(2) The Register of Trademark Agents shall contain the names, addresses and other prescribed matters of registered trademark agents who shall act on behalf of any person for the purposes of section 95.

### **Registration of trademark agent**

**97.** (1) The Registrar shall register a person as a registered trademark agent if he satisfies the prescribed requirements and enters his name in the Register of Trademark Agents.

(2) For the purposes of this Part, the Registrar may—

- (a) cancel the registration of trademark agent on the grounds as may be prescribed;
- (b) allow voluntary cancellation of the registration of a trademark agent upon the application made by the registered trademark agent;



- (c) allow a change of name or address of service of the registered trademark agent upon the application made by the registered trademark agent;
- (d) remove the registration of a trademark agent upon the death of the registered trademark agent; and
- (e) refuse to recognize any person as a registered trademark agent subjected to any circumstances as prescribed.

(3) Any cancellation of the registration of a trademark agent shall result in the removal of the name of the registered trademark agent from the Register of Trademark Agents.

(4) The removal of the registered trademark agent from the Register of Trademark Agents and all the applications for registration or registrations of trademarks handled by the registered trademark agent shall be published by the Registrar in the manner as determined by the Registrar in the Intellectual Property Official Journal.

(5) The Registrar shall register partnerships and bodies corporate as trademark agents if they satisfy the prescribed requirements and upon registration, they shall be bound by the requirements specified in subsections (2), (3) and (4).

### **Privilege for communications with registered trademark agent**

**98.** (1) A communication made between a registered trademark agent and the person appointing and authorizing the agent in matters relating to trademarks, and any record or document made for the purposes of such a communication, are privileged to the same extent as a communication between a solicitor and his client.

(2) A registered trademark agent has, in relation to documents and property of the person appointing and authorizing the agent in a matter relating to trademarks, the same right of lien that a solicitor has in relation to the documents and property of a client.

## PART XV

## OFFENCE

**Counterfeiting a trademark**

**99.** (1) Any person who counterfeits a registered trademark by—

- (a) making a sign identical or similar to a registered trademark with the intent to deceive; or
- (b) falsifying a genuine registered trademark, whether by alteration, addition, effacement, partial removal or otherwise,

without the consent of the registered proprietor of the trademark commits an offence and shall, on conviction, be liable to a fine not exceeding one million ringgit or to imprisonment for a term not exceeding five years or to both.

(2) In a prosecution under this section, the burden of proving the consent of the registered proprietor of the trademark shall be upon the accused person.

**Falsely applying a registered trademark to goods or services**

**100.** (1) For the purposes of this section and section 102, a person falsely applies a registered trademark to goods or services when—

- (a) he applies the trademark or a sign likely to be mistaken for that trademark to the goods or services without the consent of the proprietor of the registered trademark; and
- (b) in the case of an application to goods, the goods are not the genuine goods of the registered proprietor or licensee of the trademark.

(2) For the purposes of subsection (1), a trademark shall be deemed to be applied to goods or services if it is used in—

- (a) any sign or advertisement; or

- (b) any invoice, catalogue, business letter, business paper, price list or other commercial document, including any such document in any medium,

and the goods are delivered, or services provided to a person pursuant to a request or order made by reference to the trademark as so used.

(3) For the purposes of subsection (1)—

(a) a sign shall be deemed to be applied to goods if—

(i) it is applied to the goods themselves; or

(ii) it is applied to any covering, label, reel or thing in or with which the goods are sold, offered or exposed for sale or had in possession for a purpose of trade or manufacture; and

(b) a sign shall be deemed to be applied to goods or services if it is used in a manner that is likely to lead persons to believe that it refers to, describes or designates the goods or services.

(4) Any person who falsely—

(a) applies a registered trademark to goods under subsection (1) commits an offence and shall, on conviction, be liable—

(i) if the person is a body corporate, to a fine not exceeding fifteen thousand ringgit for each of the goods bearing the falsely applied registered trademark, and for a second or subsequent offence, to a fine not exceeding thirty thousand ringgit for each of the goods bearing the falsely applied registered trademark; or

(ii) if the person is not a body corporate, to a fine not exceeding ten thousand ringgit for each of the goods bearing the falsely applied registered trademark or to imprisonment for a term not exceeding three years or to both, and for a second

or subsequent offence, to a fine not exceeding twenty thousand ringgit for each of the goods bearing the falsely applied registered trademark, or to imprisonment for a term not exceeding five years or to both; or

(b) applies a registered trademark to services under subsection (1) commits an offence and shall, on conviction, be liable—

(i) if the person is a body corporate, to a fine not exceeding one hundred thousand ringgit; or

(ii) if the person is not a body corporate, to a fine not exceeding seventy thousand ringgit or to imprisonment for a term not exceeding three years.

(5) In subsection (3)—

(a) “covering” includes any stopper, glass, bottle, vessel, box, capsule, case, frame or wrapper; and

(b) “label” includes any band or ticket.

(6) In a prosecution under this section, the burden of proving the consent of the registered proprietor of the trademark shall be upon on the accused person.

### **Making or possessing of article for committing offence**

**101.** Any person who—

(a) makes an article specifically designed or adapted for making copies of a registered trademark or a sign likely to be mistaken for that trademark; or

(b) has in his possession, custody or control an article as in paragraph (a),

knowing or having reason to believe that it has been, or is to be, used for, or in the course of, committing an offence against sections 99 and 100, commits an offence and shall, on conviction, be liable to a fine not exceeding one million ringgit or to imprisonment for a term not exceeding five years or to both.

**Importing or selling, etc., goods with falsely applied trademark**

**102.** (1) Any person who—

- (a) imports into Malaysia for the purpose of trade or manufacture;
- (b) sells or offers or exposes for sale; or
- (c) has in his possession, custody or control for the purpose of trade or manufacture,

any goods to which a registered trademark is falsely applied under section 100, unless he proves that having taken all reasonable precautions against committing an offence under this section, he had, at the time of the commission of the alleged offence, no reason to suspect the genuineness of the trademark and on demand made by the Assistant Controller, he gave all the information in his knowledge with respect to the persons from whom he obtained the goods, commits an offence and shall, on conviction, be liable—

- (i) if the person is a body corporate, to a fine not exceeding fifteen thousand ringgit for each of the goods with the falsely applied registered trademark, and for a second or subsequent offence, to a fine not exceeding thirty thousand ringgit for each of the goods with the falsely applied registered trademark; or
- (ii) if the person is not a body corporate, to a fine not exceeding ten thousand ringgit for each of the goods with the falsely applied registered trademark or to imprisonment for a term not exceeding three years or to both, and for a second or subsequent offence, to a fine not exceeding twenty thousand ringgit for each of the goods with the falsely applied registered trademark, or to imprisonment for a term not exceeding five years or to both.

(2) For the purposes of paragraph (1)(c), a person having in his possession three or more of the goods to which a registered trademark is falsely applied is deemed to have in possession the goods for the purpose of trade or manufacture.

**False entries to Trademarks Office or in Register**

**103.** Any person who—

- (a) makes or causes to be made a false entry to the Trademarks Office or in the Register;
- (b) makes or causes to be made a false entry in any certified copy deposited in the Trademarks Office;
- (c) makes or causes to be made any thing false purporting to be a copy of an entry in the Register or to be filed with the Trademarks Office; or
- (d) produces or tenders or causes to be produced or tendered in evidence any thing referred to in paragraph (c),

knowing or having reasons to believe that the entry or thing is false, commits of an offence and shall, on conviction, be liable to a fine not exceeding fifty thousand ringgit or to a term of imprisonment not exceeding five years or to both.

**Falsely representing trademark as registered**

**104.** (1) Any person who—

- (a) falsely represents that a trademark is a registered trademark; or
- (b) makes a false representation as to the goods or services for which a trademark is registered,

knowing or having reason to believe that the representation is false commits an offence and shall, on conviction, be liable to a fine not exceeding ten thousand ringgit.

(2) For the purposes of this section, the use in the course of trade in Malaysia in relation to a trademark of the word “registered” or any other word or symbol importing a reference expressly or impliedly to registration shall be deemed to be a representation as to registration under this Act unless it is shown that the reference is to registration elsewhere than in Malaysia and that the trademark is in fact so registered for the goods or services in question.

**Offence relating to disobedience to summons or refusal to give evidence**

**105.** (1) The Registrar may, for the purposes of this Act—

- (a) summon witnesses;
- (b) receive evidence on oath; and
- (c) require the production of a document or article.

(2) Any person who disobeys the summons or request under subsection (1) without any lawful excuse commits an offence and shall, on conviction, be liable to a fine not exceeding two thousand ringgit or to imprisonment for a term not exceeding three months or to both.

**Falsely representing trademark as a protected international registration designating Malaysia**

**106.** (1) A person who—

- (a) falsely represents a trademark as a protected international registration designating Malaysia; or
- (b) makes a false representation as to the goods or services for which a protected international registration designating Malaysia confers protection in Malaysia,

knowing or having reason to believe that the representation is false commits an offence and shall, on conviction, be liable to a fine not exceeding ten thousand ringgit.

**Misuse of title “Trademarks Office”**

**107.** Any person who uses on his place of business or any document issued by him or otherwise, the words “Trademarks Office” or any other words suggesting that his place of business is, or is officially connected with, the Trademarks Office commits an offence and shall, on conviction, be liable to a fine not exceeding fifty thousand ringgit or to imprisonment for a term not exceeding two years or to both.

**Unregistered persons practising, etc., as a registered trademark agent**

**108.** Any person who carries on business, practices, acts, describes himself, holds himself out, or permits himself to be described or held out, as a trademark agent without being registered under this Act commits an offence and shall, on conviction, be liable to a fine not exceeding fifty thousand ringgit or two years imprisonment or both.

## PART XVI

## INVESTIGATION AND ENFORCEMENT

## Chapter 1

*Investigation and complaints***Interpretation**

**109.** For the purposes of this Part—

- (a) “Controller”, “Deputy Controller” or “Assistant Controller” mean the Controller, Deputy Controller or Assistant Controller, of the Trade Descriptions appointed under section 3 of the Trade Descriptions Act 2011 [*Act 730*]; and
- (b) “premises” means any place, stationary or otherwise established or set up by any person, whether such place is with or without enclosure, and includes vehicles, aircrafts, ships and any other vessel.

**Power of Controller, Deputy Controllers or Assistant Controllers**

**110.** (1) The Controller shall perform the duties imposed and exercise the powers conferred on him under this Part subject to the general direction and control of the Minister.

(2) The Deputy Controllers and Assistant Controllers shall be under the direction and control of the Controller.



(3) The Deputy Controllers may perform all the duties imposed and exercise all the powers conferred on the Controller.

(4) The Controller and Deputy Controllers may perform all the duties imposed and exercise all the powers conferred on the Assistant Controllers.

(5) The Controller or the Deputy Controller may in writing delegate all or any of his powers, duties or functions under this Part to any Assistant Controller.

### **Power of investigation**

**111.** (1) Where the Assistant Controller has reasonable grounds to suspect that any offence is or will be committed under this Act, the Assistant Controller may conduct such investigation as the Assistant Controller thinks expedient for the due administration of this Act.

(2) Any Assistant Controller investigating any commission of an offence under this Act may exercise all or any of the powers in relation to police investigation in seizable cases given by the Criminal Procedure Code [*Act 593*].

### **Complaints to the Assistant Controller**

**112.** (1) The Assistant Controller may, upon a complaint by a person, conduct an investigation on any person who has committed or is committing any offence under this Act.

(2) The complaint made under subsection (1) shall specify the person against whom the complaint is made or the premises where the alleged offence is committed and details of the alleged offence under this Act.

(3) If the complaint made under subsection (1) is in relation to a trademark which is not identical with the registered trademark, any registered proprietor or licensee shall obtain the Registrar's verification in the form as determined by the Registrar together with the payment of the prescribed fee to be submitted to the Assistant Controller.

(4) The Registrar's verification under subsection (3), shall be *prima facie* evidence in any proceedings before any court of law.

## Chapter 2

*Information gathering powers***Power of the Assistant Controller to require provision of information**

**113.** (1) This section applies if the Assistant Controller in carrying out an investigation under this Part has reason to believe that any person—

- (a) has any information or any document that is relevant to the performance of the Assistant Controller's powers and functions under this Act; or
- (b) is capable of giving any evidence which the Assistant Controller has reason to believe is relevant to the performance of the Assistant Controller's powers and functions under this Act.

(2) Notwithstanding any provision of any other written law, the Assistant Controller, by written notice, may direct any person—

- (a) to provide the Assistant Controller, within the period and in the manner and form specified in the notice, any information or document referred to in subsection (1);
- (b) to produce to the Assistant Controller, within the period and in the manner specified in the notice, any information or document referred to in subsection (1), whether in physical or electronic form;
- (c) to make copies of, or extracts from, any document referred to in subsection (1) and to produce copies or extracts of such documents to the Assistant Controller within the period and in the manner specified in the notice;
- (d) if the person is an individual, to appear before the Assistant Controller at a time and place specified in the notice to give any information, either orally or in writing, and produce any document referred to in subsection (1), whether in physical or electronic form;

- (e) if the person is a body corporate or a public body, to cause a relevant and competent officer of the body to appear before the Assistant Controller at a time and place specified in the notice to give any information, either orally or in writing, and produce any document referred to in subsection (1), whether in physical or electronic form;
- (f) if the person is a partnership, to cause an individual who is a partner in the partnership or an employee of the partnership to appear before the Assistant Controller at a time and place specified in the notice to give any information, either orally or in writing, and produce any document referred to in subsection (1), whether in physical or electronic form; or
- (g) to make a statement to the Assistant Controller providing an explanation on any information or document referred to in subsection (1) within the period and in the manner and form specified in the notice.

(3) Where the Assistant Controller directs any person to produce any document under subsection (2) and the document is not in the custody of that person, that person shall—

- (a) state, to the best of his knowledge and belief, where the document may be found; and
- (b) identify, to the best of his knowledge and belief, the last person who had custody of the document and to state, to the best of his knowledge and belief, where that last-mentioned person may be found.

(4) Any person directed to provide information under subsection (2) or (3) shall ensure that the information provided is true, accurate and complete and such person shall provide an express representation to that effect, including a declaration that he is not aware of any other information which would make the information provided untrue or misleading.

(5) Any person who refuses or does not comply with the direction made by the Assistant Controller under this section commits an offence and shall, on conviction, be liable to a fine not exceeding fifty thousand ringgit.

**Assistant Controller may retain documents**

**114.** (1) The Assistant Controller may take and retain for such duration as he deems necessary, any document obtained under this Part.

(2) The person who provided the document is entitled to be supplied, as soon as practicable, with a copy certified by the Assistant Controller to be a true copy of the document.

(3) Notwithstanding the provisions of any other written law, the certified copy of the document shall be admissible as evidence as if it were the original document.

(4) If the Assistant Controller is satisfied that it is no longer necessary to retain the document, the Assistant Controller may return the document to the person who provided the document, as soon as practicable.

**Confidentiality**

**115.** (1) Any person who discloses or makes use of any confidential information or document with respect to a particular enterprise or the affairs of an individual obtained by virtue of any provision of this Act commits an offence and shall, on conviction, be liable to a fine not exceeding five hundred thousand ringgit.

(2) Nothing in subsection (1) shall operate to prevent the disclosure of information where—

- (a) the disclosure is made with the consent of the person from whom the information or document was obtained;
- (b) the disclosure is made in circumstances where the information provided is framed in such a manner that the source of the information could not be ascertained;
- (c) the information is already in the public domain;
- (d) the disclosure is made to facilitate the performance of the functions or powers of the Controller, Deputy Controller or Assistant Controller;

- (e) the disclosure is reasonably made during any proceedings under this Act provided that such disclosure is not made against any direction by the Controller, Deputy Controller or Assistant Controller before whom those proceedings are taking place; or
- (f) the disclosure is made in connection with the investigation of an offence under this Act.

(3) For the purposes of this section, “confidential information” means trade, business or industrial information that belongs to any person, that has economic value and is not generally available to or known by others or any information which is regarded as confidential under this Act.

### **Privileged communication**

**116.** (1) No person shall be required, under any provision of this Part, to produce or disclose any communication between a professional legal adviser and his client which would be protected from disclosure in accordance with section 126 of the Evidence Act 1950 [Act 56].

(2) The Controller may require an advocate and solicitor to provide any document under section 114.

(3) Where the document required under subsection (2) contains privileged communication, made by or on behalf of or to the advocate and solicitor in his capacity as an advocate and solicitor—

- (a) the advocate and solicitor shall be entitled to refuse to comply with the requirement; or
- (b) the person to whom or by or on behalf of whom the privileged communication was made or, if the person is a body corporate that is under receivership or is in the course of being wound up, the receiver or the liquidator, as the case may be, may agree that the advocate and solicitor shall comply with the requirement.

(4) Notwithstanding paragraph (3)(b) where the advocate and solicitor refuses to comply with the requirement, the advocate and solicitor shall forthwith furnish in writing to the Controller the name and address of the person to whom or by or on behalf of whom the privileged communication was made.

**Giving false or misleading information, evidence or document**

**117.** A person who does not disclose or omits to give any relevant information, evidence or document, or provides any information, evidence or document that he knows or has reason to believe is false or misleading, in the course of investigation by the Assistant Controller, commits an offence and shall, on conviction, be liable to a fine not exceeding one hundred thousand ringgit.

**Destruction, concealment, mutilation and alteration of records**

**118.** A person who—

(a) destroys, conceals, mutilates or alters; or

(b) sends or attempts to send or conspires with any other person to remove from his premises or send out of Malaysia,

any goods, documents, material, articles or things kept or maintained with intent to defraud the Assistant Controller or to prevent, delay or obstruct the carrying out of an investigation or the exercise of any power by the Assistant Controller under this Act commits an offence and shall, on conviction, be liable to a fine not exceeding one hundred thousand ringgit.

**Chapter 3***Powers of arrest, search, seizure and etc.***Power of arrest**

**119.** (1) Any Assistant Controller may arrest without warrant any person whom he reasonably believes has committed or is attempting to commit an offence under sections 99 to 102 of this Act.

(2) Any Assistant Controller making an arrest under subsection (1) shall, without unnecessary delay, bring the person arrested to the nearest police station, and thereafter the person shall be dealt with in accordance with the law relating to criminal procedure for the time being in force.

**Power to enter premises, inspect and seize goods, etc.**

**120.** (1) Any Assistant Controller may, at all reasonable hours exercise the following powers:

- (a) he may, for the purpose of ascertaining whether any offence under this Act has been committed, inspect any goods, documents, material, articles or things and enter any premises other than premises used only for dwelling;
- (b) if he has reasonable cause to believe that an offence under this Act has been committed, he may seize and detain any goods, documents, material, articles or things for the purpose of ascertaining, by testing or otherwise, whether the offence has been committed;
- (c) he may seize and detain any goods, documents, material, articles or things which he has reason to believe may be required as evidence in any proceedings for an offence under this Act; and
- (d) he may, for the purpose of exercising his powers under this subsection, seize goods, documents, material, articles or things, but only if and to the extent that it is reasonably necessary in order to secure that the provisions of this Act and of any order made under this Act are duly observed, require any person having authority to do so to break open any container or open any vending machine and, if that person does not comply with the requirement, he may do so himself.

(2) An Assistant Controller seizing any goods, documents, material, articles or things in the exercise of his powers under this section shall inform the person from whom they are seized and, in the case of goods seized from a vending machine, the person whose name and address are stated on the machine as being the proprietor or, if no name and address are so stated, the occupier of the premises on which the machine stands or to which it is affixed.

(3) Where the goods, documents, material, articles or things seized by the Assistant Controller in the exercise of his powers under this section are by reason of their nature, size or amount not practical to be removed from where they are found, he may

be any means seal such goods, documents, material, articles or things in the premises or container in which they are found and it shall be an offence for any person without lawful authority to break, tamper with or damage such seal or to remove such goods, documents, material, articles or things or to attempt to do so.

### **Magistrate may issue search warrant**

**121.** (1) Whenever it appears to a Magistrate, upon written information on oath and after such inquiry as he considers necessary, that there are reasonable grounds to believe that any person has committed or is committing an offence under this Act, so that any evidence or thing which is necessary to the conduct of an investigation into any offence may be found in any premises, the Magistrate may issue a warrant authorizing any Assistant Controller named in the warrant to enter the premises at any time, with or without assistance, and if need be by force to search for and seize any such evidence or thing.

(2) An Assistant Controller entering any premises under this section may take with him such other persons and such equipment as may appear to him necessary and on leaving any premises which he has entered by virtue of a warrant under the preceding subsection he shall, if the premises are unoccupied or the occupier is temporarily absent, leave them as effectively secured against trespassers as he found them.

(3) Without affecting the generality of subsection (1), the warrant issued by the Magistrate may authorize the search and seizure of any goods, documents, material, articles or things which contains or is reasonably suspected to contain information as to any offence suspected to have been committed or is otherwise necessary to conduct an investigation into any offence.

(4) The Assistant Controller conducting a search under subsection (1) may, for the purpose of investigating into the offence, search any person who is in or on the premises.

(5) The Assistant Controller making a search of a person under subsection (4) may seize, or take possession of, and place in safe custody all things other than the necessary clothing found upon the person, and any other things, in respect of which there is reason to believe are the instruments or evidence of the offence, and such things may be detained until the order by the court for its disposal.



(6) If, by reason of its nature, size or amount, it is not practicable to remove any goods, documents, material, articles or things seized under this section, the Assistant Controller who effected the seizure shall by any means seal the premises or container in which such goods, documents, material, articles or things is found.

(7) A person who, without lawful authority, breaks, tampers with or damages the seal referred to in subsection (6) or removes any goods, documents, material, articles or things under seal or attempts to do so commits an offence and shall, on conviction, be liable to a fine not exceeding one hundred thousand ringgit.

### **Search may be made without warrant**

**122.** If the Assistant Controller is satisfied upon information received that he has reasonable cause to believe that by reason of delay in obtaining a search warrant under section 121 the investigation would be adversely affected or evidence of the commission of an infringement or offence is likely to be tampered with, removed, damaged or destroyed, the Assistant Controller may enter the premises and exercise in, upon and in respect of the premises all the powers referred to in section 121 in as full and ample a manner as if he were authorized to do so by a warrant issued under that section.

### **Access to recorded information or computerized data, etc.**

**123.** (1) Any Assistant Controller exercising his powers under sections 120, 121 and 122 shall be given access to any recorded information or computerized or digitalized data, whether stored in a computer or otherwise.

(2) In addition, the Assistant Controller exercising his powers under sections 120, 121 and 122 —

- (a) may inspect the operation of any computer and any associated apparatus or material which he has reasonable cause to suspect is or has been used in connection with that information or data; and

(b) may require—

- (i) the person, by whom or on whose behalf the Assistant Controller has reasonable cause to suspect the computer is or has been so used on connection with the information or data; or
- (ii) the person having charge of, or is otherwise concerned with, the operation of the computer, apparatus or material in connection with the information or data,

to provide him with such reasonable assistance as he may require for the purposes of this section.

(3) The Assistant Controller may make copies or take extracts of the recorded information or computerized or digitalized data if he deems necessary.

(4) For the purposes of this section, “access” includes being provided with the necessary password, encryption code, decryption code, software or hardware and any other means required to enable comprehension of recorded information and computerized or digitalized data.

### **Tipping-off**

**124.** (1) Any person who—

- (a) knows or has reason to suspect that an Assistant Controller is acting, or is proposing to act, in connection with an investigation which is being, or is about to be, conducted under or for the purposes of this Act and discloses to any other person information or any other matter which is likely to prejudice that investigation or proposed investigation; or
- (b) knows or has reason to suspect that a disclosure has been made to an Assistant Controller and discloses to any other person information or any other matter which is likely to prejudice any investigation which might be conducted following the disclosure,

commits an offence and shall, on conviction, be liable to a fine not exceeding one hundred thousand ringgit.

(2) Nothing in subsection (1) makes it an offence for an advocate and solicitor or his employee to disclose any information or other matter—

(a) to his client or the client's representative in connection with the giving of advice to the client in the course and for the purpose of the professional employment of the advocate and solicitor; or

(b) to any person in contemplation of, or in connection with and for the purpose of, any legal proceedings.

(3) Subsection (2) does not apply in relation to any information or other matter which is disclosed with a view to furthering any illegal purpose.

(4) In any proceedings against a person for an offence under this section, it shall be a defence to prove that—

(a) he did not know or suspect that the disclosure made under paragraph (1)(b) was likely to prejudice the investigation; or

(b) he had lawful authority or reasonable excuse for making the disclosure.

(5) An Assistant Controller or any other person does not commit an offence under this section in respect of anything done by him in the course of acting in connection with the enforcement, or intended enforcement, of this Act.

### **Warrant admissible notwithstanding defects**

**125.** A search warrant issued under this Act shall be valid and enforceable notwithstanding any defect, mistake or omission in the warrant or in the application for such warrant and any goods, documents, material, articles or things seized under such warrant shall be admissible in evidence in any proceedings under this Act.

**List of things seized**

**126.** (1) Except as provided in subsection (2), where any goods, documents, material, articles or things is seized under this Part, the Assistant Controller who effected the seizure shall as soon as practicable prepare a list of the things seized and immediately deliver a copy of the list signed by him to the occupier of the premises which has been searched, or to his agent or servant, at the premises.

(2) Where the premises are unoccupied, the Assistant Controller who effected the seizure shall wherever possible post a list of the things seized conspicuously on the premises.

**Forfeiture of seized goods, etc.**

**127.** (1) All goods, documents, material, articles or things seized in exercise of any power conferred under this Act shall be liable to forfeiture.

(2) An order for the forfeiture or for the release of any goods, documents, material, articles or things seized in exercise of any power conferred under this Act shall be made by the court before which the prosecution with regard thereto has been held and an order for the forfeiture of the goods, documents, material, articles or things shall be made if it is proved to the satisfaction of the court that an offence under this Act has been committed and that the goods, documents, material, articles or things were the subject matter of or were used in the commission of the offence notwithstanding that no person may have been convicted of such offence.

(3) If there is no prosecution with regard to any goods, documents, material, articles or things seized in exercise of any power conferred under this Act, such goods, documents, material, articles or things shall be taken and deemed forfeited at the expiration of one calendar month from the date of seizure unless a claim to such goods, documents, material, articles or things is made before the date in the manner hereinafter set forth.

(4) Any person asserting that he is the owner of such goods, documents, material, articles or things and that they are not liable to forfeiture may personally or by his agent authorized in writing give written notice to an Assistant Controller that he claims the same.

(5) On receipt of such notice the Assistant Controller shall refer the claim to the Controller who may direct that such goods, documents, material, articles or things be released or forfeited or may direct the Assistant Controller to refer the matter to a court for decision.

(6) The court to which the matter is referred shall issue a summons requiring the person asserting that he is the owner of the goods, documents, material, articles or things and the person from whom they were seized to appear before it and upon his appearance or default to appear, due service of the summons being proved, the court shall proceed to the examination of the matter and on proof that an offence under this Act has been committed and that such goods, documents, material, articles or things were the subject matter or were used in the commission of such offence shall order the same to be forfeited or may in the absence of such proof order their release.

(7) All things forfeited or deemed forfeited shall be delivered to the Assistant Controller and shall be disposed of in accordance with the directions of the Controller.

### **Release of things seized**

**128.** (1) If any goods, documents, material, articles or things has been seized under this Act, the Assistant Controller who effected the seizure may release the goods, documents, material, articles or things to the person as he determines to be lawfully entitled to it, if he is satisfied that the goods, documents, material, articles or things is not otherwise required for the purpose of any proceedings under this Act, or for the purpose of any prosecution under any other written law, and in such event neither the Assistant Controller effecting the seizure, nor the Federal Government, the Controller or any person acting on behalf of the Federal Government or the Controller shall be liable to any proceedings by any person if the seizure and the release of the goods, documents, material, articles or things had been effected in good faith.

(2) A record in writing shall be made by the Assistant Controller effecting the release of anything under subsection (1) specifying in detail the circumstances of, and the reason for, the release, and he shall send a copy of such record to the Public Prosecutor within seven days of the release.

### **Seizure of perishable goods**

**129.** Where any goods seized in exercise of the powers conferred by this Act are of a perishable nature or where the custody of such goods involves unreasonable expense and inconvenience, such goods may be sold by the Assistant Controller at any time and the proceeds of the sale held to abide by the result of any prosecution or claim under this section.

### **No cost or damages arising from seizure to be recoverable**

**130.** No person shall, in any proceedings before any court in respect of any goods, documents, material, articles or things seized in the exercise or the purported exercise of any power conferred under this Act, be entitled to the costs of such proceedings or to any damages or other relief unless such seizure was made without reasonable cause.

### **Obstruction**

**131.** Any person who—

- (a) refuses to give any Assistant Controller access to any premises which the Assistant Controller is entitled to have under this Act or in the execution of any duty imposed or power conferred by this Act; or
- (b) assaults, obstructs, hinders or delays any Assistant Controller in effecting any entry which the Assistant Controller is entitled to effect under this Act or in the execution of any duty imposed or power conferred by this Act,

commits an offence and shall, on conviction, be liable to a fine not exceeding one hundred thousand ringgit.

**Evidence of agent provocateur is admissible**

**132.** (1) Notwithstanding any rule of law or the provisions of this Act or any other written law to the contrary, no agent provocateur shall be presumed to be unworthy of credit by reason only of his having attempted to abet or abetted the commission of an offence by any person under this Act if the attempt to abet or abetment was for the sole purpose of securing evidence against such person.

(2) Notwithstanding any rule of law or the provisions of this Act or any other written law to the contrary, any statement, whether oral or in writing made to the agent provocateur by any person who subsequently is charged with an offence under this Act shall be admissible as evidence at his trial.

**Taking of samples**

**133.** (1) Where any goods which are the subject matter of an offence under this Act are found in two or more packages or receptacles of the same description, it shall be presumed until the contrary is proved that all the packages or receptacles contain goods of the same nature, quantity and quality.

(2) Where packages or receptacles containing goods which contravene the provisions of this Act or are otherwise liable to seizure have been seized, it shall be sufficient only to open and examine one per centum or not less than five samples, whichever is the lesser, of the contents of each package or receptacle seized.

(3) The court shall presume that the remaining samples contained in the package or receptacle is of the same nature as those samples examined.

**Jurisdiction to try offences**

**134.** Notwithstanding anything to the contrary in any written law, a sessions court shall have jurisdiction to try any offence under this Act and to impose the full punishment for any such offence.

**Institution of prosecution**

**135.** No prosecution for an offence under this Act shall be instituted except by or with the written consent of the Public Prosecutor.

**Compounding of offences**

**136.** (1) The Minister may, with the approval of the Public Prosecutor, make regulations prescribing—

- (a) any offence under this Act and any regulations made under this Act that may be compounded;
- (b) the criteria for compounding such offence; and
- (c) the method and procedure for compounding such offence.

(2) The Controller may, with the consent in writing of the Public Prosecutor, at any time before a charge is being instituted, compound any offence prescribed as an offence which may be compounded by making a written offer to the person reasonably suspected of having committed the offence to compound the offence upon payment to the Controller of a sum of money not exceeding fifty per centum of the amount of the maximum fine to which the person would have been liable to if he had been convicted of the offence, within such time as may be specified in the written offer.

(3) An offer under subsection (2) may be made at any time after the offence has been committed but before any prosecution for it has been instituted, and where the amount specified in the offer is not paid within the time specified in the offer, or such extended time as the Controller may grant, prosecution for the offence may be instituted at any time after that against the person to whom the offer was made.

(4) Where an offence has been compounded under subsection (2), no prosecution shall be instituted in respect of the offence against the person to whom the offer to compound was made, and the Controller may forfeit or return the goods seized in connection with the offence, subject to such terms as the Controller thinks fit.



(6) All sums of money received by the Controller under this section shall be paid into and form part of the Federal Consolidated Fund.

### **Principal liable for acts of servant or agent**

**137.** Where the servant or agent of a person commits an offence or does anything or omits to do anything which if done or omitted to be done by that person would constitute an offence under this Act, that person shall, notwithstanding that he has no knowledge of the offence, be deemed to be guilty of the offence and shall be liable to punishment for the offence unless he proves that—

- (a) the act or omission complained of was not within the ordinary scope of the employment of the servant or of the agency of the agent; or
- (b) the act or omission complained of was done or omitted to be done without his consent or connivance and that he exercised all such diligence to prevent the commission or omission as he ought to have exercised having regard to all the circumstances of the case.

### **Offences committed by body corporate**

**138.** (1) If a body corporate commits an offence under this Act, any person who at the time of the commission of the offence was a director, chief executive officer, chief operating officer, manager, secretary or other similar officer of the body corporate or was purporting to act in any such capacity or was in any manner or to any extent responsible for the management of any of the affairs of the body corporate or was assisting in such management—

- (a) may be charged severally or jointly in the same proceedings with the body corporate; and
- (b) if the body corporate is found guilty of the offence, shall be deemed to be guilty of that offence unless, having regard to the nature of his functions in that capacity and to all circumstances, he proves—
  - (i) that the offence was committed without his knowledge, consent or connivance; and

- (ii) that he had taken all reasonable precautions and exercised due diligence to prevent the commission of the offence.

(2) If any person would be liable under this Act to any punishment or penalty for his act, omission, neglect or default, he shall be liable to the same punishment or penalty for every such act, omission, neglect or default of any employee or agent of his, or of the employee of the agent, if the act, omission, neglect or default was committed—

- (a) by that person's employee in the course of his employment;
- (b) by the agent when acting on behalf of that person; or
- (c) by the employee of the agent in the course of his employment by the agent or otherwise on behalf of the agent acting on behalf of that person.

### **Protection of Controller, Deputy Controller and Assistant Controller and other persons**

**139.** No action, suit, prosecution or other proceedings shall be brought, instituted or maintained in any court against—

- (a) the Controller, Deputy Controller, Assistant Controller or any other person in respect of any act ordered or done for the purpose of carrying into effect this Act; and
- (b) any other person in respect of any act done or purported to be done by him under the order, direction or instruction of the Controller if the act was done in good faith and in a reasonable belief that it was necessary for the purpose intended to be served by it.

## PART XVII

### LEGAL PROCEEDINGS IN COURT, COST AND EVIDENCE

#### **Service of applications to Court on the Registrar**

**140.** (1) A copy of every application to the Court, including appeals to the Court of Appeal or Federal Court, relating to the application for registration or registered trademark shall be filed

with the Registrar by the parties to the application to the Court in the manner as determined by the Registrar within the prescribed period, without having to name the Registrar as a party.

(2) Upon receipt of the application under subsection (1), the Registrar may change the status of the application or registration of trademark as the Registrar deems fit, subject to further condition, direction, instruction, order or judgment of the Court.

(3) Any order or judgment made by the Court upon the completion of the application filed under subsection (1) shall be filed with the Registrar in the manner as determined by the Registrar.

(4) The Registrar, under subsection (3), shall comply and give effect to the Court's order or judgment.

(5) If the Registrar considers that publicity should be given upon giving effect to the Court Order, he may publish it in the Intellectual Property Official Journal.

### **Registrar's appearance in proceedings involving the Register**

**141.** (1) In any legal proceedings before the Court which includes involving an application for—

- (a) the revocation of the registration of trademark; or
- (b) the declaration of the invalidity of the registration of a trademark,

the Registrar shall have the right to appear and be heard, and shall appear if so directed by the Court.

(2) Unless otherwise directed by the Court, the Registrar, in lieu of appearing and being heard, may submit to the Court a statement in writing and signed by him, giving particulars of the proceedings before him in relation of the matter in issue or of the grounds of any decision given by him affecting the same or of the practice of the office in like cases, or of such other matters relevant to the issues, and within his knowledge as Registrar, as he thinks fit, and such statement shall be deemed to form part of the evidence in the proceedings.

**Costs of proceedings before the Court**

**142.** In all proceedings before the Court, the Court may, in its discretion, award any party including the Registrar such costs as it may consider reasonable but the Registrar shall not be ordered to pay the costs of any of the other parties.

**Certificate of validity**

**143.** In any legal proceedings in which the validity of a registered trademark comes into question and is decided in favour of the registered proprietor, the Court may certify to that effect, and if it so certifies then in any subsequent legal proceedings in which the validity of the registration comes into question the registered proprietor on obtaining a final order or judgment in his favour shall have his full costs, charges and expenses as between solicitor and client, unless in the subsequent proceedings the Court certifies that he ought not to have them.

**Evidentiary value of copies certified by Registrar**

**144.** A copy or extract from any form or document filed at the trademark office of which the Registrar certified to be a true copy or extract signed and sealed by the Registrar shall be admissible in evidence in any proceedings as of equal validity with the original document.

**Sealed copies of document to be evidence**

**145.** (1) Printed or written copies or extracts of or from the Register purporting to be certified by the Registrar and sealed with his seal shall be admissible as evidence in any proceedings before any court without further proof or production of the originals.

(2) A notification or certificate of registration shall be admissible as evidence in any proceedings before any court of law without further proof or production of the originals.

(3) A certificate purporting to be under the hand of the Registrar as to any act which he is authorized to perform and which he has or has not performed shall be *prima facie* evidence in any proceedings before any court of law of his having or not having performed the act.

(4) No person in the employment of the Corporation shall be required to attend the court for the purposes of producing—

- (a) any documents relating to a trademark application or registered trademark which may be obtained under the provisions of this Act; or
- (b) any documents which are prescribed as confidential, not open for public inspection or to be made available to any third parties in accordance with this Act.

**Electronic information, etc., certified by the Registrar admissible in evidence**

**146.** Any form, information or document, a copy or extract from any form, information or document electronically filed with the Registrar or issued by the Registrar, shall be a true extract from any form, information or documents filed with or submitted to the Registrar as required under this Act shall be *prima facie* evidence of matters specified in that form, information, document, copy or extract.

**Minister may declare documents of foreign state pertaining to trademarks to be admissible as evidence**

**147.** (1) The Minister may, by order published in the *Gazette*, declare any documents or class of documents of a foreign state to be admissible as evidence in any proceedings before a Court if—

- (a) the document is sealed with the seal of the authorized officer or the government of the foreign state and the seal pertains to the trademarks registered in or otherwise recognized by the foreign country or if there is no such seal there is enclosed a certificate signed by the authorized officer to the effect that the document shall be evidence of the matter contained therein; and

- (b) the foreign state or part thereof has entered into reciprocal arrangements with the Government of Malaysia in respect of the admissibility of the documents.

(2) For the purposes of this section—

“authorized officer” means a person or authority authorized by the government of the foreign state to keep and maintain a register or other record of trademarks under any written law in force in the foreign state relating to trademarks;

“document” means—

- (a) a printed or written copy of extract or other record of trademarks kept and maintained in the foreign state under any written law in force in the foreign state relating to trademarks; or
- (b) any other document pertaining to any matter or act in relation to trademarks registered in or otherwise recognized by the foreign state as trademarks;

“trademark” means any sign which includes the following or any combination of the following, namely, any letter, word, name, signature, numeral, device, brand, heading, label, ticket, shape of goods or their packaging, colour (whether single colour or a combination of colours), sound, scent, hologram, positioning, sequence of motion which is used or intend to be used in relation to goods or services for the purpose of indicating or so as to indicate a connection in the course of trade between the goods or services and a person having the right either as proprietor or licensee to use the trademark (in the foreign state) whether with or without any indication of the identity of that person and which is registered or otherwise recognized by the foreign state as a trademark (under any written law in force in the foreign state relating to trademarks) but does not include the trademarks of another foreign state registered in or otherwise recognized by the foreign state by virtue of a reciprocal arrangement between the foreign state and that other foreign state.

(3) For the avoidance of doubt, this section shall not be construed to confer recognition of the trademarks of any foreign state for the purpose of registration under this Act but shall be construed only with references to the admissibility of evidence in any proceedings before a Court of the documents of the foreign state.

## PART XVIII

## MISCELLANEOUS AND GENERAL

**Intellectual Property Official Journal**

**148.** (1) The Registrar shall publish an Intellectual Property Official Journal which shall contain—

- (a) all matters relating to trademarks which are required to be published under this Act; and
- (b) such other information or matters relating to trademarks as the Registrar deems necessary.

(2) The Intellectual Property Official Journal shall be made available to the public on the payment of the prescribed fee.

(3) Publication in the Intellectual Property Official Journal shall constitute sufficient notice of any matter required to be published under this Act.

(4) A copy of the Intellectual Property Official Journal shall on its production be admitted in legal proceedings as evidence without further proof being given that the copy was so published.

(5) A copy of the Intellectual Property Official Journal shall be *prima facie* evidence of the facts stated therein.

(6) Where the Intellectual Property Official Journal is published in more than one form, the date of publication of the Intellectual Property Official Journal shall be deemed to be the date the Intellectual Property Official Journal is first published in any form.

**Electronic filing**

**149.** (1) The Registrar may provide a service for the electronic filing of documents required by this Act to be filed with the Registrar.

(2) A document electronically filed under this section shall be deemed to have satisfied the requirement for filing if the document is communicated or transmitted to the Registrar in such manner as determined by the Registrar.

(3) A document that is required to be stamped, signed or sealed shall, if the document is to be electronically filed, be certified to be true copy or authenticated in such manner as determined by the Registrar.

(4) Where a document that is required to be signed and attested under this Act is to be filed electronically, the requirement for attestation of the signature does not apply.

(5) If a document is electronically filed with the Registrar, the Registrar shall not be liable for any loss or damage suffered by any person by reason of any error or omission of whatever nature or however arising appearing in any document obtained by any person under the service referred to in subsection (1), if such error or omission occurred or arose as a result of any defect or breakdown in the service or in the equipment used for the provision of the service or without the knowledge of the Registrar.

### **Issuing document electronically**

**150.** The Registrar may, by electronic means, issue a document which is to be issued by the Registrar under this Act.

### **Address for service**

**151.** (1) For the purposes of this Act, an address for service in Malaysia of an applicant, any person who opposes the registration of a trademark or any other person who is involved in any proceedings before the Registrar, who is residing or carrying on business principally in Malaysia shall be furnished with the Registrar in the manner as determined by the Registrar.

(2) The address furnished with the Registrar under subsection (1) shall be entered into the Registrar's record or Register and shall be deemed to be the address for service of the person under subsection (1) for all the proceedings before the Registrar.



(3) An address for service may be changed upon notifying the Registrar in the form as determined by him and within the prescribed period which shall be entered into the Registrar's record or Register.

(4) Upon receipt of the request for change in subsection (3) together with the payment of the prescribed fee, the Registrar shall change the address for service of the person under subsection (1) which may affect some or all of his applications for registration or registered trademarks.

(5) The Registrar may refuse to proceed with the application or registration of trademark if the address of service as stated in subsection (1) is not furnished.

(6) If the person stated in subsection (1) is not residing or carrying on business in Malaysia, he shall appoint and authorize a registered trademark agent to act for him in the prescribed manner.

(7) When the person mentioned in subsection (1) appoints and authorizes a registered trademark agent to act for him, the address of service of the registered trademark agent which shall be entered into the Registrar's record or Register, shall be deemed to be the address for service of the person under subsection (1) for all proceedings before the Registrar.

### **Power of Registrar to allow amendments of documents**

**152.** (1) The Registrar may, upon an application in the form as determined by the Registrar together with the payment of the prescribed fee and on such terms as to costs as he thinks just, whether for the purpose of amending a clerical error or an obvious mistake, allow the amendment of—

- (a) an application for the registration of trademark;
- (b) notice of opposition;
- (c) counterstatement; or
- (d) any documents as the Registrar thinks fit.

(2) An amendment applied under subsection (1), shall not be permitted, under this section if the amendment would substantially affect—

- (a) the identity of the trademark as specified in the application before amendment or without extending in any way the rights given by the existing registration of trademark; or
- (b) the content of the documents filed with the Trademarks Office.

### **Power of Registrar to allow extension of time**

**153.** (1) Where by this Act, a time is specified within which an act or thing is to be done, the Registrar may, unless otherwise expressly provided or directed by the court, upon application in the form as determined by the Registrar, extend the time either before or after its expiration upon payment of the prescribed fee.

(2) Subsection (1) shall not be applicable to sections 26, 27 and 28 except where the circumstances under subsection (3) apply.

(3) Where by reason of—

- (a) an error or omission by the person or by his or her registered trademark agent;
- (b) circumstances beyond the control of the person or by his or her registered trademark agent; or
- (c) an error or action on the part of the trademark office,

an act in relation to an application for the registration of trademark or in proceedings under this Act (not being proceedings in a court) required to be done within a certain time has not been so done, the Registrar may extend the time for doing the act.

(4) The time required for doing an act under subsection (3) may be extended even though that time has expired.

**Mode of giving evidence**

**154.** (1) For the purposes of subsection 105(1), in all proceedings before the Registrar, evidence shall be given by statutory declaration in the absence of directions to the contrary but in any case in which he thinks fit, the Registrar may take evidence *viva voce* in lieu of or in addition to evidence by declaration.

(2) Any such statutory declaration may, in the case of an appeal, be used before the Court in lieu of evidence by affidavit, but if so used, shall have all the incidents and consequences of evidence by affidavit.

(3) In any action or proceedings relating to a trademark, the Registrar or the Court, as the case may be, shall admit evidence of the usages of the trade concerned or evidence of business usages in the provision of the services in question and evidence of any relevant trademarks or trade name or business name or get-up legitimately used by other persons.

**Exercise of discretionary power**

**155.** Where any discretionary power is given to the Registrar by this Act, he shall not exercise that power adversely to the applicant for registration of trademark or the registered proprietor in question without, if duly required to do so within the prescribed period, giving to the applicant an opportunity of being heard.

**Power of the Registrar to treat documents as confidential**

**156.** (1) In accordance with the regulations, the Registrar may—

- (a) require that specified information in a document that has been filed, or is to be filed, in relation to a trademark be held in the Trademarks Office confidentially; and
- (b) make such a requirement subject to specified conditions or limitations; and
- (c) vary or revoke such a requirement, condition or limitation.

(2) For the purposes of this section, procedures in connection with the making, varying or revoking of any requirements, conditions or limitations shall be as prescribed.

### **Adaptation of entries to new classification**

**157.** (1) The Registrar may consider the necessary to implement any amendment or substitution of classification of goods or services for the purposes of the registration of trademarks including making the amendment of existing entries on the register so as to accord with the new classification as prescribed.

(2) The amendment made under subsection (1) shall not extend the rights conferred by the registration, except where it appears to the Registrar that compliance with this requirement would involve undue complexity and that any extension would not be substantial and would not adversely affect the rights of any person.

(3) The Registrar may—

- (a) require the registered proprietor, within such prescribed period, to file a proposal for amendment of the Register; and
- (b) cancel any relevant goods or services as identified by the Registrar or refuse to renew the registration of trademark in the event of his failing to do so.

(4) Any proposal made under paragraph (3)(a) shall be published in the Intellectual Property Official Journal and may be opposed in accordance with section 35.

### **Costs awarded by Registrar**

**158.** (1) In all proceedings before the Registrar, the Registrar shall have power to award to any party such costs including taxation of the costs as he may consider reasonable and to direct how and by what parties they are to be paid, and any such order may, by leave of the Court, be enforced in the same manner as a judgment or order of the Court to the same effect.

(2) A party to any proceedings before a Registrar who is desirous to obtain costs or to have the costs taxed shall apply to the Registrar in the prescribed manner.

(3) Costs awarded by the Registrar under subsection (1) may in default of payment be recovered in a court of competent jurisdiction as a debt due by the person against whom the costs were accorded to the person in whose favour they were accorded.

### **Unregistered trademarks**

**159.** (1) No person shall be entitled to initiate any action to prevent or to recover damages for the infringement of an unregistered trademark.

(2) Notwithstanding subsection (1), nothing in this Act shall be deemed to affect the right of action against any person for passing off goods or services as those of another person or the remedies in respect of the goods or services.

### **Guidelines or practice directions by Registrar**

**160.** (1) The Registrar may issue guidelines or practice directions on any matter.

(2) The guidelines or practice directions issued by the Registrar under this section shall be published in the Intellectual Property Official Journal and shall be effective from the date as specified in the guidelines or directions.

(3) Any person who are specified in the provision under this Act shall comply with the guidelines and practice directions.

(4) The Registrar may vary, review or revoke any guidelines or practice directions.

(5) Subject to subsection (4), the procedures set out in subsections (2) and (3) shall apply in respect of any variation, review or revocation of the guidelines or practice directions.

(6) Any person, applicant or registered proprietor who does not comply with any guidelines or practice directions of the Registrar, where such guidelines or practice directions are applicable to such person, applicant or registered proprietor—

- (a) is deemed to have failed to fulfil the requirements as required by the Registrar which renders the application as withdrawn, lapsed, refused, revoked or as determined by the Registrar; or
- (b) commits an offence and shall, on conviction, be liable to a fine not exceeding ten thousand ringgit.

### **Power to amend Schedules**

**161.** (1) The Minister may, by order published in the *Gazette*, amend the First and Second Schedules.

(2) The Minister shall, before making an amendment to the First or Second Schedule—

- (a) publish a notice of his intention in the Intellectual Property Official Journal to make the amendment and the proposed amendment;
- (b) give at least thirty days from the date of notice to allow any submission to be made by members of the association, competent body or the public in relation to the proposed amendment; and
- (c) give due consideration to any submission made.

### **Power to make regulations**

**162.** (1) Subject to the provisions of this Act, the Minister may make regulations for the purpose of carrying into effect the provisions of this Act.

(2) In particular and without prejudice to the generality of subsection (1), such regulations may provide for all or any of the following purposes:

- (a) to regulate the practice, other than that relating to proceedings before the court or connected therewith, under this Act including service of documents;
- (b) to classify goods or services for the purpose of registration of trademarks;
- (c) to provide for all matters relating to registration of trademark including renewal of registered trademark;
- (d) to provide for all matters relating to alteration or voluntary cancellation of registered trademark, revocation or invalidity of registration, or correction of Register;
- (e) to secure and regulate the publishing and selling or distributing in such manner as the Minister may think fit of copies of extracts of trademarks and other documents from the record or Register;
- (f) to prescribe the fees to be paid in respect of any matter or thing required for the purposes of this Act;
- (g) to regulate all matters relating to registered trademarks agents;
- (h) to regulate matters relating to the registration listing goods or services comprising more than one class in one application;
- (i) to regulate all matters relating to division of application for registration or registered trademarks;
- (j) to regulate all matters relating to merger of application for registration or registered trademarks;
- (k) to regulate all matters relating to certification mark and collective mark;

- (l) to regulate all matters relating to a series trademark;
- (m) to regulate generally on matters pertaining to the business operation relating to trademarks carried on in any Trademarks Office whether or not specifically prescribed under this Act but so as not to be inconsistent with any of the provisions of this Act;
- (n) to regulate the matters in determining whether a trademark is well-known and has fulfilled the requirement stipulated under Article 6*bis* of the Paris Convention and Article 16 of the TRIPS Agreement;
- (o) to regulate the use of trademarks including how the trademark is applied to or applied in relation to goods or services;
- (p) to regulate matters relating to use of trademarks on the internet;
- (q) to provide for the manner and effect of a cancellation and for protecting the interests of other persons having a right in the registered trademark;
- (r) to regulate all matters relating to border measures;
- (s) to prescribe the entry, particulars or matters to be entered into the record or Register; and
- (t) to prescribe for all matters relating to appeals filed in Court following the decision of the Registrar relating to the time for starting the action or the manner for an application to be made for an extension of that time, subject to the provisions of the rules of court.

(3) Subject to the provisions of this Act, the Rules Committee constituted under the Courts of Judicature Act 1964, may make rules of court regulating the practice and procedure in relation to proceedings before the Court or connected therewith and the costs of the proceedings.



PART XIX

REPEAL, SAVINGS AND TRANSITIONAL PROVISIONS

Chapter 1

*Repeal and savings*

**Repeal and savings**

**163.** (1) The Trade Marks Act 1976 is repealed.

(2) Notwithstanding the repeal of the Act under subsection (1)—

- (a) any appointment made under the repealed Act shall continue in force and have effect as if it had been made under this Act;
- (b) all decisions, directions and notices made or issued under the repealed Act shall, to the extent that the decisions, directions and notices are consistent with this Act, continue in force until such decisions, directions and notices are revoked or amended;
- (c) any investigation, trial and proceedings done, taken or commenced under the repealed Act immediately before the commencement of this Act shall, on the commencement of this Act, be dealt with as if the repealed Act has not been repealed by this Act; and
- (d) nothing in the repealed Act or this Act shall affect any person's liability to be prosecuted or punished for offences committed under the repealed legislation before the commencement of this Act, or any proceedings brought, sentence imposed or action taken before that day in respect of such offence.

Chapter 2

*Transitional provisions for trademarks*

**Interpretation**

**164.** (1) Notwithstanding the repeal, the following subsections shall be applicable.

(2) In this Chapter, “existing registered mark” means a trade mark, certification trade mark or defensive trade mark registered under the repealed Act immediately before the commencement of this Act.

(3) For the purposes of this Chapter—

(a) an application shall be treated as pending on the commencement of this Act if it was made but not finally determined before commencement of this Act; and

(b) the date on which it was made shall be taken to be the date of filing under the repealed Act.

### **Existing registered marks**

**165.** (1) Any existing registered marks kept in the Register under the repealed Act, subject to the provision of this Part, shall be a registered trademark for the purposes of this Act.

(2) Any existing registered mark registered as a certification trade mark in the Register kept under the repealed Act shall be a registered certification mark for the purposes of this Act.

(3) Any existing registered mark registered as a series of trade marks in the Register kept under the repealed Act shall be similarly registered in the Register kept under this Act for the purposes of this Act.

(4) Any indication that an existing registered mark is associated with any other mark shall cease to have effect on the commencement of this Act.

(5) A condition, disclaimer or limitation entered into the Register under the repealed Act in relation to an existing registered mark immediately before the commencement of this Act shall be incorporated into the Register kept under this Act and have effect as if entered into the Register pursuant to section 36 of this Act.

(6) Sections 37 and 38 of this Act may be applied in relation to an existing registered mark under the repealed Act on the commencement of this Act.

**Effects of registration in relation to infringement**

**166.** (1) Sections 48, 49, 50, 51 and 54 of this Act apply in relation to an existing registered mark as from the commencement of this Act and section 56 of this Act applies in relation to infringement of an existing registered mark committed after the commencement of this Act, subject to subsection (2).

(2) Sections 38 and 51 of the repealed Act continue to apply in relation to infringements committed before the commencement of this Act.

**Infringing goods, material or articles**

**167.** Section 59 of this Act applies to infringing goods, material or articles whether the application for the order is made before or after the commencement of this Act.

**Rights and remedies of licensee or authorized user**

**168.** (1) Section 70 of this Act applies to licences granted before the commencement of this Act only in relation to infringements committed after the commencement of this Act.

(2) Subparagraph 9(2) of the Second Schedule of this Act apply only in relation to infringements committed after the commencement of this Act.

**Co-proprietorship of registered mark**

**169.** (1) Section 63 of this Act applies as from the commencement of this Act to an existing registered mark of which two or more persons were immediately before commencement of this Act registered as joint proprietors.

(2) Where two or more persons are registered as joint proprietors under section 21 of the repealed Act shall continue to exist as if this Act has not been enacted.

**Assignment, etc., of registered mark**

**170.** (1) Section 64 of this Act applies to transactions occurring after the commencement of this Act in relation to an existing registered mark and the repealed Act continues to apply in relation to transactions occurring before the commencement of this Act.

(2) Existing entries under section 47 of the repealed Act shall be transferred on the commencement of this Act to the Register kept under this Act and have effect as if made under section 65 of this Act.

(3) An application for registration under section 47 of the repealed Act which is pending before the Registrar on the commencement of this Act or which has been determined by the Registrar but not finally determined before the commencement of this Act shall be treated as an application for registration under sections 65 and 67 of this Act and shall proceed accordingly.

(4) For the purposes of subsection (3), the Registrar may require the applicant to amend his application so as to conform to the requirements of this Act and subsection (2) shall apply in relation to any resulting entry in the Register.

(5) Where before the commencement of this Act, a person has become entitled by assignment or transmission to an existing registered mark but has not registered his title, any application for registration after commencement of this Act shall be made under section 64 of this Act.

(6) For the purposes of subsections (3) and (5), subsection 47(3) of the repealed Act shall continue to apply as regards the consequences of failing to register.

**Licensing of registered mark**

**171.** (1) Section 69 of this Act applies only in relation to licences granted after the commencement of this Act and the repealed Act continues to apply in relation to licences granted before the commencement of this Act until the expiration of such licences.

(2) Existing entries under section 48 of the repealed Act shall be transferred on the commencement of this Act to the Register kept under this Act and have effect as if made under section 65 of this Act.

(3) An application for registration as a registered user which is pending before the Registrar on the commencement of this Act or which has been determined by the Registrar but not finally determined before the commencement of this Act shall be treated as an application for registration of a licence under section 65 or 67 of this Act and shall proceed accordingly.

(4) The Registrar may require the applicant to amend his application so as to conform to the requirements of this Act and subsection (2) shall apply in relation to any resulting entry in the Register.

(5) Any proceedings pending on the commencement of this Act under subsection 49(1) of the repealed Act shall be dealt with under the repealed Act and any necessary alteration shall be made to the Register under this Act.

### **Pending applications for registration**

**172.** (1) An application for registration of a mark under the repealed Act which is pending on the commencement of this Act shall be dealt with under the repealed Act subject to the following subsections, and if registered, the mark shall be treated for the purposes of this section as an existing registered mark.

(2) Section 22 of the repealed Act shall be disregarded after the commencement of this Act for an application for registration.

(3) Sections 34 and 35 of this Act shall apply to an application for registration of a mark under the repealed Act which is pending publication on the commencement of this Act.

(4) Sections 32, 33 and 155 of this Act shall apply to an application for registration of a mark under the repealed Act which is pending registration on the commencement of this Act.

(5) Section 37 or 38 of this Act may be applied in relation to an application for registration of a mark under the repealed Act which is pending registration on the commencement of this Act.

### **Conversion of pending application**

**173.** (1) In the case of a pending application for registration which has not been examined under the repealed Act before the commencement of this Act, the applicant may give notice to the Registrar claiming to have the registrability of the mark determined in accordance with the provisions of this Act.

(2) The notice shall be filed in the form as determined by the Registrar together with the payment of the prescribed fee within two months from the date of the commencement of this Act.

(3) A notice filed under subsection (2) shall be irrevocable and shall have the effect that the application shall be treated as if the application for registration is made after the commencement of this Act.

### **Trademarks registered according to old classification**

**174.** (1) The Registrar may exercise the powers conferred by regulations under section 162 of this Act to secure that any existing registered marks which do not conform to the system of classification as prescribed under section 19 of this Act are brought into conformity with that system.

(2) Subsection (1) shall apply to existing registered marks classified in accordance with the classification as specified in Third Schedule of the Trade Marks Regulations 1997 [*P.U. (A) 460/1997*].

### **Claim to priority of Convention application**

**175.** (1) Where before the commencement of this Act, a person has duly filed an application for protection of a trademark in a Convention country, section 26, 27 or 28 of this Act shall apply to an application for registration under this Act made after the commencement of this Act.

(2) Nothing in this section affects proceedings on an application for registration under the repealed Act made before the commencement of this Act.

### **Duration and renewal of registration**

**176.** (1) Subsection 39(1) of this Act shall apply in relation to the registration of trademark pursuant to an application made after the commencement of this Act and the repealed law shall continue to apply in relation to a trademark registered before the commencement of this Act.

(2) Subsection 39(2) and section 40 of this Act shall apply where the renewal of existing registered marks under the repealed Act falls due on or after the commencement of this Act and the repealed Act shall continue to apply for existing registered marks where its renewal does not fall due on or after the commencement of this Act.

(3) For the purposes of subsection (2), the renewal fee under this Act shall be applicable regardless that such fee has been paid before the commencement of this Act.

### **Pending application for alteration of registered mark**

**177.** An application under section 44 of the repealed Act which is pending on the commencement of this Act shall be dealt with under the repealed Act and any necessary alteration shall be made to the Register in this Act.

### **Revocation for non-use**

**178.** (1) An application under section 46 of the repealed Act which is pending on the commencement of this Act shall be dealt with under the repealed Act and any necessary alteration shall be made to the Register in this Act.

(2) An application under section 46 of this Act may be made in relation to an existing registered mark after the commencement of this Act.

(3) Notwithstanding subsection (2), the application for the revocation of the registration of an existing registered mark registered under section 57 of the repealed Act may only be made five years after the commencement of this Act.

### **Application for rectification, etc.**

**179.** (1) An application under section 43 or 45 of the repealed Act which is pending on the commencement of this Act shall be dealt with under the repealed Act and any necessary alteration shall be made to the Register in this Act.

(2) For the purposes of proceedings under section 47 of this Act as it applies in relation to an existing registered mark, the provisions of this Act shall be deemed to have been in force at all material times, except there is no objection to the validity of the registration of an existing registered mark may be taken on the ground specified in subsection 24(3) of this Act.

### **Rules as to use of certification mark**

**180.** (1) Rules governing the use of an existing registered certification trademark deposited at the Trade Mark Central Office pursuant to section 56 of the repealed Act shall be treated after the commencement of this Act as if it is filed in accordance with the Second Schedule to this Act.

(2) Any request for amendment of the rules which was pending on the commencement of this Act shall be dealt with in accordance with this Act.

### **Agents**

**181.** (1) Registration of an agent applied under the repealed Act before the commencement of this Act shall continue to be in force and have effect as if made under section 97 of this Act and if registered, the agent shall be treated as a registered trademark agent under this Act.

(2) The requirements for renewal of registration of trademark agents under this Act shall apply to the registration of the agent obtained under the repealed Act.



**Guidelines, etc., on transitional matters**

**182.** The Registrar may issue guidelines or practice directions to provide for any matters in force before the commencement of this Act to be dealt with in such manner to bring them in conformity with this Act.

## FIRST SCHEDULE

[Section 72]

## COLLECTIVE MARKS

**Interpretation**

1. In this Schedule—

“association” means an organization duly registered in accordance with the laws of its incorporation but not incorporated in accordance with the laws relating to companies, and includes club, trade union and society incorporated accordingly.

**Signs of which a collective mark may consist**

2. In relation to a collective mark, the reference in the definition of a trademark under section 3 as to distinguishing goods or services of one undertaking from those of other undertakings shall be construed as a reference to distinguishing goods or services of members of association which is the proprietor of the mark from those of other members of association.

**Collective mark consisting of geographical indication**

3. (1) Notwithstanding paragraph 23(1)(c), 4(a) and (b), a collective mark which consists of geographical indication may be registered as a collective mark, to designate the geographical origin of the goods or services subject to the following grounds:

- (a) it contains an individual term of multi-component terms, which is identical to the common name of any goods or services in Malaysia, where the registration of the collective mark is sought in relation to those goods or services;
- (b) it contains the name of a plant variety or an animal breed;
- (c) the goods or services did not originate from the country, region or locality indicated in subsubparagraph 5(3)(a);

- (d) the use of the collective mark in relation to the goods or services is of such a nature as to mislead the public as to the true place of origin; or
- (e) if there exists a likelihood of confusion on the part of the public because the geographical indication is identical with or similar to, and has the same geographical origin as, an earlier geographical indication which has been registered under the Geographical Indications Act 2000.

(2) The registered proprietor of such a collective mark under subparagraph (1) is not entitled to prohibit the use of the signs or indications of geographical origin in accordance with honest practices in industrial or commercial matters including by a person who is entitled to use a geographical name, provided the use is by the person carrying out their activity in the geographical area specified in the Register which shall be in respect of the goods or services specified in the Register in accordance to the quality, reputation or characteristic specified in the Register.

#### **Collective mark not to be misleading as to character or significance**

4. (1) A collective mark shall not be registered if the public is likely to be misled as regards the character or significance of the collective mark, in particular if it is likely to be taken to be something other than a collective mark.

(2) For the purposes of subparagraph (1), the Registrar may require that a collective mark in respect of which application is made for registration include some indication that it is a collective mark.

(3) Notwithstanding subsection 33(3), an application may be amended so as to comply with any other requirement.

#### **Rules governing the use of collective mark**

5. (1) In addition to the requirements under section 17, an applicant of a collective mark shall file the rules governing the use of the collective mark with the Registrar.

(2) The rules under subparagraph (1) shall specify—

- (a) the persons authorized to use the collective mark;
- (b) the conditions of membership of the association;
- (c) the conditions of use of the collective mark, if any; and
- (d) any sanctions against misuse of the collective mark, if any.

(3) In addition to subparagraph (2), if the application of collective mark consists geographical indication under subparagraph 3(1), the applicant shall file the rules which specify—

- (a) that country, region or locality where the goods or services originated from;
- (b) the quality, reputation or other characteristic of the goods or services which is essentially attributable to its geographical origin;
- (c) the existing protection or registration of geographical indication in the country, region or locality of origin; and
- (d) the use of the geographical indication in the country, region or locality of origin.

(4) For the purposes of subparagraphs (2) and (3), the Registrar may require further requirements to be specified in the rules as he thinks fit.

#### **Approval of rules and application for registration of collective mark**

6. (1) A collective mark shall not be registered unless the rules governing the use of the collective mark—

- (a) specify all the requirements contained in subparagraphs 5(2), (3) and (4);
- (b) are not contrary to public interest or morality;
- (c) do not contain or consist of any scandalous or offensive matter or would otherwise not be entitled to protection by any court of law; and
- (d) do not contain a matter which is in the opinion of the Registrar is or might be prejudicial to the interest or security of the nation.

(2) The applicant shall file the rules under paragraph 5 to the Registrar within the period as prescribed and if the applicant does not do so, the application for registration of collective mark shall be deemed withdrawn.

(3) The Registrar shall consider whether the requirements under subparagraph (1) are fulfilled.

(4) If it appears to the Registrar that the requirements under subparagraph (1) are not fulfilled, he shall inform the applicant and give him an opportunity within the period as determined by the Registrar, to make representations or to file amended rules.

(5) If the applicant responds within the period as determined by the Registrar but fails to satisfy the Registrar that the requirement under subparagraph (1) are fulfilled, or to file rules that has been amended so as to meet those requirements, the Registrar may refuse the application for registration of collective mark.

(6) If the applicant fails to respond within the specified period, the application for registration of collective mark shall be deemed withdrawn.

(7) If it appears to the Registrar the requirements under subparagraph (1) and requirements for registration under Part IV, are met, he shall accept the application and shall proceed in accordance with sections 31 and 35.

(8) The rules shall be published in accordance with section 31 and notice of opposition may be given relating to the matters under subparagraph (1), in addition to any other grounds on which the application may be opposed.

### **Inspection of rules**

7. The rules governing the use of a registered collective mark shall be open to public inspection in the same way as the Register under section 15.

### **Amendment of rules of registered collective mark**

8. (1) An amendment of the rules governing the use of a registered collective mark is not effective unless the amended rules are filed with the Registrar in the form as determined by the Registrar together with the payment of the prescribed fee.

(2) The Registrar shall, after considering the requirement under subparagraph (1), cause the amended rules to be accepted and published in the Intellectual Property Official Journal.

(3) Any person may file a notice of opposition relating to the matters under subparagraph 6(1) in the form as determined by the Registrar within the prescribed period after the amended rules has been published in the Intellectual Property Official Journal under subparagraph (2).

### **Rights of authorized users relating to infringement proceedings**

9. (1) The following provisions shall apply in relation to an authorized user of a registered collective mark as in relation to a licensee of a trademark:

(a) subsection 54(4);

(b) subsection 60(2);

(c) section 70; and

(d) section 87.

(2) In infringement proceedings brought by the registered proprietor of a collective mark, any loss suffered or likely to be suffered by authorized users shall be taken into account and the Court may give such directions as it thinks fit as to the extent to which the plaintiff is to hold the proceeds of any pecuniary remedy on behalf of such users.

### **Limitation on rights given by registered collective mark**

10. A member of an association in whose name a collective mark is registered does not have the right to prevent another member of the association from using the collective mark in accordance with the rules of association.

### **Grounds for revocation of registration**

11. In addition to the grounds of revocation provided for in sections 45 and 46, the registration of a collective mark may be revoked by the Court on the ground—

- (a) that the manner in which the collective mark has been used by the proprietor has caused it to become liable to mislead the public in the manner referred to in subparagraph 4(1);
- (b) that the proprietor does not observe, or to secure the observance of, the rules governing the use of the collective mark; or
- (c) that an amendment of the rules filed by the registered proprietor—
  - (i) no longer complies with subparagraphs 5(2), (3) and (4);
  - (ii) is contrary to public interest or morality;
  - (iii) contain or consist of any scandalous or offensive matter or would otherwise not be entitled to protection by any court of law; or
  - (iv) contain a matter which is in the opinion of the Registrar is or might be prejudicial to public interest or security of the country.

### **Grounds for invalidity of registration**

12. In addition to the grounds of invalidity provided for in section 47, the registration of a collective mark may be declared invalid by the Court on the ground that the collective mark was registered in breach of the provision of subparagraph 4(1) or subparagraph 6(1).

## SECOND SCHEDULE

## [Section 73]

## CERTIFICATION MARKS

**Signs of which a certification mark may consist**

1. In relation to a certification mark, the definition of trademark under section 3 as to distinguishing goods or services of one undertaking from those of other undertakings shall be construed as a reference to distinguishing goods or services which are certified from those which are not.

**Certification mark consisting of geographical indication**

2. (1) Notwithstanding paragraphs 23 (1)(c), 4(a) and (b), a certification mark which consists of geographical indication may be registered as a certification mark, to designate the geographical origin of the goods or services subject to the following grounds:

- (a) it contains an individual term of multi-component terms, which is identical to the common name of any goods or services in Malaysia, where the registration of the certification mark is sought in relation to those goods or services;
- (b) it contains the name of a plant variety or an animal breed;
- (c) the goods or services did not originate from the country, region or locality indicated in subparagraph 5(3)(a);
- (d) the use of the certification mark in relation to the goods or services is of such nature as to mislead the public as to the true place of origin; or
- (e) if there exists a likelihood of confusion on the part of the public because the geographical indication is identical with or similar to, and has the same geographical origin as, an earlier geographical indication which has been registered under the Geographical Indications Act 2000.

(2) The registered proprietor of such a certification mark under subparagraph (1) is not entitled to prohibit the use of the signs or indications of geographical origin in accordance with honest practices in industrial or commercial matters, provided the use is by the person carrying their activity in the geographical area specified in the Register which shall be in respect of the goods or services specified in the Register in accordance to the quality, reputation or characteristic specified in the Register.

**Nature of proprietor's business**

3. A certification mark shall not be registered if the proprietor carries on a business involving supply of goods or services of which the registered proprietor certifies.

**Certification mark not to be misleading as to character or significance**

4. (1) A certification mark shall not be registered if the public is likely to be misled as regards to the character or significance of the certification mark, including if it is likely to be taken to be something other than a certification mark.

(2) For the purposes of subparagraph (1), the Registrar may require that a certification mark in respect of which an application is made for registration include some indication that it is a certification mark.

(3) Notwithstanding subsection 33(3), an application may be amended so as to comply with any such requirement.

**Rules governing the use of certification mark**

5. (1) In addition to the requirements under section 17, an applicant of a certification mark shall file the rules governing the use of the certification mark.

(2) The rules under subparagraph (1) shall specify—

- (a) the persons authorized to use the certification mark;
- (b) the characteristics to be certified by the certification mark;
- (c) how the proprietor is to test those characteristics;
- (d) how the proprietor supervises the use of the certification mark; and
- (e) the procedures for resolving disputes between the proprietor and authorized user.

(3) In addition to subparagraph (2), if the application of certification mark consists of geographical indications in subparagraph 2(1), the applicant shall file the rules which specify—

- (a) the country, region or locality where the goods or services originated from;

- (b) the quality, reputation or other characteristic of the goods or services which is essentially attributable to its geographical origin;
- (c) the existing protection or registration of geographical indication in the country, region or locality of origin; and
- (d) the use of the geographical indication in the country, region or locality of origin.

(4) For the purposes of subparagraphs (2) and (3), the Registrar may require further requirements to be specified in the rules as he thinks fit.

### **Approval of rules and application for registration of certification mark**

6. (1) A certification mark shall not be registered unless—

- (a) the rules governing the use of the certification mark—
  - (i) specify all the requirements contained in subparagraphs 5(2), (3) and (4);
  - (ii) are not contrary to public interest or morality;
  - (iii) do not contain or consist of any scandalous or offensive matter or would otherwise not be entitled to protection by any court of law; and
  - (iv) do not contain a matter which is in the opinion of the Registrar is or might be prejudicial to public interest or security of the country; and
- (b) the applicant is competent to certify the goods or services for which the certification mark is to be registered.

(2) The applicant shall file the rules under paragraph 5 to the Registrar within the period as prescribed and if the applicant does not do so, the application for registration of certification mark shall be deemed withdrawn.

(3) The Registrar shall consider whether the requirements under subparagraph (1) are fulfilled.

(4) If it appears to the Registrar that the requirements under subparagraph (1) are not fulfilled, he shall inform the applicant and give him an opportunity within the period as determined by the Registrar, to make representations or to file amended rules.

(5) If the applicant responds within the period as determined by the Registrar but fails to satisfy the Registrar that the requirement under subparagraph (1) are fulfilled, or to file rules that has been amended so as to meet those requirements, the Registrar may refuse the application for registration of certification mark.

(6) If the applicant fails to respond within the specified period, the application for registration of certification mark shall be deemed withdrawn.



(7) If it appears to the Registrar the requirements under subparagraph (1) and requirements for registration under Part IV, are met, he shall accept the application and shall proceed in accordance with sections 31 and 35.

(8) The rules shall be published in accordance with section 31 and notice of opposition may be given relating to the matters under subparagraph (1), in addition to any other grounds on which the application may be opposed.

### **Inspection of rules**

7. The rules governing the use of a registered certification mark shall be open to public inspection in the same way as the Register under section 15.

### **Amendment of rules of registered certification mark**

8. (1) An amendment of the rules governing the use of a registered certification mark is not effective unless the amended rules are filed with the Registrar in the form as determined by the Registrar together with the payment of the prescribed fee.

(2) The Registrar shall, after considering the requirement under subparagraph (1), cause the amended rules to be accepted and published in the Intellectual Property Official Journal.

(3) Any person may file a notice of opposition relating to the matters under subparagraph 6(1) in the form as determined by the Registrar within the prescribed period after the amended rules are published in the Intellectual Property Official Journal under subparagraph (2).

### **Consent to assignment of registered certification mark**

9. The assignment or other transmission of a registered certification mark shall not be effective without the consent of the Registrar.

### **Rights of authorized users relating to infringement proceedings**

10. (1) The following provisions shall apply in relation to an authorized user of a registered certification trademark as in relation to a licensee of a trademark:

- (a) subsection 54(4);
- (b) subsection 60(2); and
- (c) section 87.

(2) In infringement proceedings brought by the registered proprietor of a certification trademark, any loss suffered or likely to be suffered by authorized users shall be taken into account and the Court may give such directions as it thinks fit as to the extent to which the plaintiff is to hold the proceeds of any pecuniary remedy on behalf of such users.

**Grounds for revocation of registration**

11. In addition to the grounds of revocation provided for in sections 45 and 46, the registration of a certification mark may be revoked by the Court on the ground—

- (a) that the registered proprietor has begun to carry on such a business under paragraph 3;
- (b) that the manner in which the certification mark has been used by the registered proprietor has caused it to mislead the public in the manner referred to in subparagraph 4(1);
- (c) that the registered proprietor has failed to observe, or to secure the observance of, the rules governing the use of the certification mark; or
- (d) that an amendment of the rules filed by the registered proprietor—
  - (i) no longer complies with subparagraphs 5(2), (3) and (4);
  - (ii) contrary to public interest or morality;
  - (iii) contain or consist of any scandalous or offensive matter or would otherwise not be entitled to protection by any court of law; or
  - (iv) contain a matter which is in the opinion of the Registrar is or might be prejudicial to public interest or security of the country;
- (e) that the registered proprietor is no longer competent to certify the goods or services for which the certification mark is registered.

**Grounds for invalidity of registration**

12. In addition to the grounds of invalidity provided for in section 47, the registration of a certification mark may be declared invalid by the Court on the ground that the certification mark was registered in breach of paragraph 3, subparagraph 4(1) or subparagraph 6(1).

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**EXPLANATORY STATEMENT**

The proposed Act seeks to provide for the registration of trademarks in relation to goods and services and to implement the relevant treaties and for other matters connected therewith.

## PART I

2. Part I deals with preliminary matters.
3. *Clause 1* contains the short title of the proposed Act and the power of the Minister to appoint the commencement date of the proposed Act.
4. *Clause 2* contains the interpretation of certain words and expressions used in the proposed Act.
5. *Clauses 3, 4, 5 and 6* seek to provide for the definition of “trademark”, “well-known trademark”, “earlier trademark”, “infringing goods”, “infringing material”, “infringing articles”, “counterfeit goods” and “counterfeit trademarks”.
6. *Clauses 7, 8 and 9* seek to provide for references to the use of trademark, use of trademark where the form of trade changes and the determination of likelihood of confusion on the public relating to the use of a trademark.

## PART II

7. Part II deals with the administration relating to trademark.
8. *Clause 10* seeks to provide for the appointment and the powers of the Registrar, Deputy Registrars and Assistant Registrars of Trademarks.
9. *Clause 11* seeks to provide for the protection of the Registrar, Deputy Registrars and Assistant Registrars of Trademarks against suit and legal proceedings for acts or omission done in good faith in the performance of the functions and the exercise of the power provided under the proposed Act.
10. *Clause 12* seeks to provide for the establishment of the Trademarks Office and other branch offices.
11. *Clause 13* seeks to provide for the power of the Registrar to issue preliminary advice and search to any party who is interested to obtain them before filing for an application for registration of trademark.

## PART III

12. Part III contains provisions relating to the Register of Trademarks.
13. *Clause 14* seeks to provide for the maintenance of the Register of Trademarks.
14. *Clause 15* seeks to provide for the inspection of the Register of Trademarks.

## PART IV

15. Part IV deals with all the matters relating to the registration of trademarks.
16. *Clause 16* seeks to provide for the definition of the registered trademarks.
17. *Clause 17* seeks to set out what is required in an application for registration of trademarks.
18. *Clause 18* seeks to provide that an application which contains multiple classes of goods or services can be applied as one application which was previously not accepted under the repealed Act.
19. *Clause 19* seeks to provide for the classification used to classify the goods or services for the purpose of registration of trademark.
20. *Clause 20* seeks to provide that colour of the trademarks may be limited in whole or in part but where colour is not limited, the trademark shall be deemed to be registered for all colours.
21. *Clause 21* seeks to provide for the requirements for the application for registration of a series of trademarks.
22. *Clause 22* seeks to provide for the procedure and the computation of time to determine the date of filing to be decided by the Registrar of Trademarks.
23. *Clause 23* seeks to provide for the absolute grounds for the refusal of registration of trademark.
24. *Clause 24* seeks to provide for the relative grounds for the refusal of registration of trademark.
25. *Clause 25* seeks to provide for the circumstances when registration may either be refused or accepted in a situation of honest concurrent use.
26. *Clause 26* sets out the procedure to claim priority in Malaysia by member countries of the Paris Convention.
27. *Clause 27* sets out the procedure to claim priority in Malaysia deriving from arrangements made between Malaysia and a foreign country declared by the Minister for reciprocal protection of trademarks.
28. *Clause 28* sets out the procedure to claim priority in Malaysia from the date of an international exhibition which is given by the temporary protection of trademarks which are the subject matters of the international exhibition given under Article 11 of the Paris Convention.
29. *Clause 29* sets out the examination procedure for the application for the registration of trademarks which is to be undertaken by the Registrar of Trademarks.

30. *Clause 30* seeks to provide for the instances where voluntary disclaimers, conditions or limitations may be applied by an applicant for registration of trademark and such disclaimers, conditions or limitations will impact the rights of the registered proprietor of the trademark upon being registered.

31. *Clause 31* seeks to provide for publication of acceptances of applications after examination has been conducted by the Registrar.

32. *Clause 32* sets out the procedure for an applicant to apply for the withdrawal of the application for registration of trademark or restriction of the goods or services covered by the application for registration of trademark.

33. *Clause 33* seeks to allow for amendments to the application for registration of trademark to be made by the applicant.

34. *Clause 34* seeks to provide that a registration of trademark may be opposed on the any grounds as absolute, relative grounds or on the grounds that the application for registration is identical or similar to a trademark which is well-known in Malaysia.

35. *Clause 35* sets out the procedures and manner involved in an opposition proceedings before the Registrar of Trademarks and the appeal against the decision of the Registrar of Trademarks which may be filed in the Court.

36. *Clause 36* seeks to provide for the manner of registration of trademark which will take place in the event there is no opposition filed or the opposition has been dismissed. This registration of trademarks will be issued with a notification of registration with the date of registration being the same as the date of filing in Malaysia.

#### PART V

37. Part V deals with matters relating to division and merger of an application or registration of trademarks.

38. *Clause 37* sets out divisional procedures where an application or registration containing several classes of goods or services are allowed to be divided into several applications or registrations.

39. *Clause 38* sets out merger procedures where multiple applications or registrations to be merged into one application or registration.

#### PART VI

40. Part VII deals with matters relating to duration and related processes for renewal of registered trademark.

41. *Clause 39* seeks to provide the duration of protection of ten years upon registration of trademark and to provide for the renewal of a registered trademark including the effect of failure to renew.
42. *Clause 40* seeks to provide for the status of a trademark which has not been renewed or restored.
43. *Clause 41* seeks to provide for the effect of ceasing of registration following any decision for revocation by the Registrar or on the basis of non-use or where it has been voluntarily cancelled regardless of the fact that the registration is still within the duration of protection of ten years.

#### PART VII

44. Part VII sets out when the trademarks can be altered, corrected, voluntarily cancelled, revoked by the Registrar and revoked or invalidated by the Court.
45. *Clause 42* seeks to provide for the registered proprietor of trademark to apply for an alteration of a registered trademark. However, such alteration is subject to certain limitation.
46. *Clause 43* seeks to provide for the registered proprietor of the trademark to request for a correction of the Register, for instance, to correct any error and to provide for the power of the Registrar to make any consequential correction in the Register and to issue any notification of registration pursuant to such correction.
47. *Clause 44* seeks to provide for the registered proprietor of the trademark to make voluntarily cancellation of the registered trademark for some or all of the goods or services.
48. *Clause 45* seeks to provide for the procedure to revoke a registered trademark by the Registrar whereby such proceedings will take place in the Trademarks Office.
49. *Clause 46* seeks to provide for the procedure to revoke a registered trademark by the Court on the basis of non-use of such registered trademark. Any aggrieved person may file an application to revoke such registration in the High Court.
50. *Clause 47* seeks to provide for the mechanism to invalidate a registered trademark in the event that such registration in breach of any absolute or relative grounds. Any aggrieved person may file an application to invalidate such registration in the High Court.

#### PART VIII

51. Part VIII deals with rights of the registered proprietor of the trademark.

52. *Clause 48* seeks to provide for the rights conferred upon the registered proprietor of trademarks and the circumstances where such exclusive rights can be invoked are also stipulated.
53. *Clause 49* seeks to provide for the limitation of the rights of the registered proprietor of if similar trademarks are registered by different persons.
54. *Clause 50* seeks to provide for the limitation of the rights of the registered proprietor of trademark in the event that the trademark consists of a sign that becomes accepted as a sign describing an article, substance or service.
55. *Clause 51* seeks to provide for the limitation of the rights of the registered proprietor of trademark in the event that the trademark consists of a sign used in relation to an article which is formerly manufactured under patent.
56. *Clause 52* seeks to provide that any registration given to a registered proprietor of trademark shall be *prima facie* evidence of validity of the original registration of trademark and all its subsequent assignments and transmission which shall be applicable to all proceedings in the High Court.
57. *Clause 53* seeks to provide that in all legal proceedings relating to a registered trademark in the Register, the original registration of trademark shall after the expiration of five years from the date of such registration to be taken to be valid in all respect unless it is found otherwise.
58. *Clause 54* seeks to provide the grounds stating the acts which amount to infringement of registered trademarks.
59. *Clause 55* seeks to provide the circumstances of acts which does not amount to infringement.
60. *Clause 56* seeks to provide the right of the registered proprietor to initiate infringement procedures. It also stipulates the relief and remedies which are made available to the registered proprietor of trademark including the consequences that may be ordered by the Court in relation to the goods or services involved in the infringement.
61. *Clause 57* seeks to provide the circumstances for which an action may not be instituted in the High Court.
62. *Clause 58* seeks to provide the circumstances for which the High Court may make an order for the erasure of an offending signs.
63. *Clause 59* seeks to provide the circumstances for which the High Court may order for the delivery up of infringing goods, material or articles.
64. *Clause 60* seeks to provide the circumstances for which the High Court may order for the disposal of infringing goods, material or articles.
65. *Clause 61* seeks to make available remedy for groundless threats of infringement proceedings.

## PART IX

66. Part IX deals with all matters relating to a trademark as an object of property.

67. *Clause 62* seeks to provide for a registered trademark to be treated as a personal or movable property and may be subject to security interest the same way as any other personal or moveable property.

68. *Clause 63* seeks to provide for the circumstances for which a trademark can be owned jointly or by more than two persons including their rights to assign or be involved in any dealings with the co-proprietor registered trademark.

69. *Clause 64* seeks to provide for the mechanism where a registered trademark may be assigned including by way of security.

70. *Clause 65* seeks to provide for certain dealings such as licensing or granting of any security interest, to be accepted and recorded by the Registrar of Trademarks in the Register.

71. *Clause 66* seeks to provide that implied or constructive trust, except express trust, shall not be entered in the Register and that equities in respect of a registered trademark may be enforced in like manner as in respect of other personal or movable property.

72. *Clause 67* seeks to provide for certain dealings such as licensing or the granting of any security interest on an application for registration of trademark, to be accepted and recorded by the Registrar of Trademarks.

## PART X

73. Part X deals with matters relating to licensing and the rights of licensee.

74. *Clause 68* contains the interpretation of certain words and expressions used in Part X.

75. *Clause 69* seeks to provide for the use of a registered trademark to be licensed by the registered proprietor of trademark.

76. *Clause 70* seeks to provide for the general provisions as to rights of licensees in case of infringement where it sets out the mechanism for the licensee to call the registered proprietor of the trademark to institute an action of infringement in the High Court.

77. *Clause 71* seeks to provide for rights and remedies given to an exclusive licensee which is regarded as an assignee.



## PART XI

78. Part XI deals with all matters relating to collective marks which would enable associations to register their sign as a collective mark for the goods or services provided by the associations or their members and all matters relating to certification marks which would enable authorized bodies to register their signs as certification marks used to certify the goods or services in respect of its origin, material, or mode of manufacture of goods or performance of services, quality, accuracy or other characteristics.

79. *Clause 72* seeks to deal with all matters relating to a collective mark as well the applicability of the First Schedule.

80. *Clause 73* seeks to deal with all matters relating to a certification mark as well the applicability of the Second Schedule.

## PART XII

81. Part XII deals with all international matters relating to trademarks such as the Madrid Protocol and Malaysia's obligations under Paris Convention and TRIPS Agreement.

82. *Clause 74* contains the interpretation of certain words and expressions used in Part XII.

83. *Clause 75* seeks to provide for the power to the Minister to prescribe regulations to enable Malaysia to fulfill its obligations under Madrid Protocol as well as to obtain all the advantages and benefits provided in the Madrid Protocol. It also seeks to provide that all references to a registered trademark including the rights and remedies given to the registered proprietor of the trademark shall be applicable to a proprietor of protected International Registration Designating Malaysia.

84. *Clause 76* seeks to provide for the protection given to well-known trademarks including the rights of the proprietor of a well-known trademarks to apply for injunction in Court.

85. *Clause 77* seeks to provide for the permitted use of a well-known trademarks which shall not allow the proprietor of the well-known trademark to invoke his right to apply for the issuance of restraint of injunction of such use in Malaysia.

86. *Clause 78* seeks to set out the prohibition for the registration of trademark which consists of or contains the flag of a Convention country without the authorization of the competent authorities of that country unless the Registrar of Trademarks is of the opinion that the use of such flag is permitted without such authorization.

87. *Clause 79* seeks to set out the prohibition for registration of trademark which consists of or contains any armorial bearings, flags or other emblems and the abbreviations and names of any international intergovernmental

organizations of which one or more convention countries are members without the authorization of such international intergovernmental organizations unless the Registrar of Trademarks is of the opinion that the use of such armorial bearings, flags or other emblems and the abbreviations and names of any international intergovernmental organizations would not suggest to indicate any connection between the international intergovernmental organizations and the trademark or is not likely to mislead the public as to the existence of a connection between the user and the international intergovernmental organizations.

88. *Clause 80* seeks to reflect the observation of Malaysia in protecting state emblems of a Convention country and official signs or hallmarks if such state emblems, official signs or hallmarks have fulfilled all the requirement to be protected under the Paris Convention or TRIPS Agreement.

### PART XIII

89. Part XIII deals with all matters relating to Border Measures.

90. *Clause 81* contains the interpretation of certain words and expressions used in Part XIII.

91. *Clause 82* seeks to provide the right of a registered proprietor of trademark to request for a restriction on importation of infringing goods into Malaysia.

92. *Clause 83* seeks to require an applicant requesting to restrict the importation of infringing goods into Malaysia to pay as security to avoid, among others, abuse of the system.

93. *Clause 84* seeks to provide for the responsibility of an authorized officer or the Registrar to place the seized goods in a secure place.

94. *Clause 85* seeks to provide for the obligation of the authorized officer to inform the Registrar, importer or the applicant, the identity of the seized goods and their whereabouts so that the registered proprietor may begin instituting infringement proceedings and if the said proceedings are not instituted within a certain period, the goods will be released to the importer.

95. *Clause 86* seeks to provide that the importer has the right to inspect the seized goods if they agree to provide certain undertaking including the rights to remove the seized goods from the custody of the Registrar for inspection.

96. *Clause 87* seeks to provide for the consequences related to seized goods where the importer may agree for the seized goods to be forfeited but such consent must be given prior to the institution of any infringement proceedings.

97. *Clause 88* seeks to provide for the power of the Registrar to release the seized goods to the importer in the event that the applicant does not institute any infringement proceedings within the retention period or there is no order from the High Court preventing the release of the seized goods to the importer.

98. *Clause 89* seeks to provide that after the seizure has taken place and no infringement proceedings is instituted after the seizure, any person aggrieved by such seizure may apply to the High Court for an order for compensation for the loss or damage as a result of such seizure of the imported goods.

99. *Clause 90* seeks to provide for the power of the High Court to make orders as it deems fit in consequence of the institution of any infringement proceedings.

100. *Clause 91* seeks to provide the High Court with the power to order the manner of disposal of seized goods.

101. *Clause 92* seeks to provide that any expenses incurred by the Registrar pursuant to any action taken by the Registrar under this Part which exceeds the amount of the security deposited by the applicant, shall be a debt due to the Registrar by the applicant.

102. *Clause 93* seeks to provide for the power of the authorized officer to act on their own initiative to detain, or suspend the release of, goods which bear a trademark which is identical to a registered trademark and that the goods are identical to the goods of a registered trademark which are to be imported into Malaysia or destined for export from Malaysia, as required under the obligation stipulated in the TRIPS Agreement.

103. *Clause 94* seeks to provide for the minimum number of goods carried by travelers in their personal luggage or sent in small consignment upon their arrival at any borders of Malaysia.

#### PART XIV

104. Part XIV deals with all matters relating to trademark agents including matters relating to their registration, renewal, conduct and address of service, where this mechanism aims to facilitate applicants and registered proprietors of trademarks to understand the circumstances and procedures involved for which the services of registered trademark agents are required.

105. *Clause 95* seeks to provide for the recognition of registered trademark agents and the circumstances in which a registered trademark agent is required.

106. *Clause 96* seeks to provide that the Registrar shall maintain a Register of Trademarks Agent which shall contain all the necessary details of the registered trademarks agents.

107. *Clause 97* seeks to set out the requirements to be fulfilled by a person who wishes to be registered as a registered trademarks agent including the power and duties of the Registrar in dealing with the registration of trademark agent.

108. *Clause 98* imposes that all communication made including any record or documents used during the communication between a registered trademark agent and the person appointing and authorising him to act as the agent are privileged communication as a communication between a solicitor and his client.

## PART XV

109. Part XXII deals with all matters which are regarded as offences.
110. *Clause 99* provides for offence of counterfeiting a trademark and the circumstances contributing to the commission of such offence.
111. *Clause 100* provides for the offences of falsely applying a registered trademark to goods or services.
112. *Clause 101* provides for the offence of making or possessing an article for committing offences.
113. *Clause 102* provides for the offence of importing or selling goods or others with falsely applied trademark.
114. *Clause 103* provides for the offence of making false entries in the Register.
115. *Clause 104* provides for the offence of falsely representing trademarks as registered.
116. *Clause 105* provides for offences relating to disobeying summons or refusing to give evidence.
117. *Clause 106* provides for the offence falsely representing a trademark as a protected international registration designating Malaysia.
118. *Clause 107* provides that the misuse of the name “Trademarks Office” is an offence.
119. *Clause 108* provides that a person who describes himself as a registered trademark agent without being registered commits an offence.

## PART XVI

120. Part XVI deals with matters relating to the empowerment of the Controller or Assistant Controller to carry out investigation and other relevant power to take action against an offender.
121. *Clause 109* seeks to provide for the interpretation of certain words and expressions used in Part XVI.
122. *Clause 110* seeks to provide for the power and responsibility of the Controller, Assistant Controllers, etc.
123. *Clause 111* seeks to provide that an Assistant Controller who has reasonable grounds to suspect any offence is or will be committed is to conduct an investigation.

124. *Clause 112* seeks to provide that an Assistant Controller may begin conducting an investigation on any person who has committed or is committing any offence upon receiving a complaint and it also provides an avenue for a registered proprietor of a trademark to make a complaint to the Assistant Controller to begin investigating an offence which involves goods bearing a trademark which is not identical to the registered trademark after obtaining the Registrar's verification from the Registrar of Trademarks.

125. *Clause 113* seeks to empower an Assistant Controller to require any person has any relevant information or documents or is capable of giving such evidence to provide the Assistant Controller with such information, document or evidence and to set the procedures for the requiring of such information, document or evidence.

126. *Clause 114* seeks to empower an Assistant Controller to retain documents for a duration of time whilst conducting his investigation.

127. *Clause 115* provides that any person who discloses or makes use of any confidential information or document with respect to a particular enterprise or the affairs of an individual which is obtained by any provision of the proposed Act commits an offence.

128. *Clause 116* provides that no person shall be required, under any provision of this Part, to produce or disclose any privileged communication between a professional legal adviser and his client which would be protected from disclosure in accordance with the Evidence Act 1950 except for the condition set out which may be exercised by the Controller.

129. *Clause 117* provides that a person who give false or misleading information, evidence or document in the course of an investigation by the Assistant Controller commits an offence.

130. *Clause 118* provides that a person who destroys, conceals, mutilates or alters or sends or attempts to send or conspire with any other person to remove from his premises or send out of Malaysia any book, record, accounts, document, computerized data, goods or thing kept or maintained with the intent to defraud the Assistant Controller or to prevent, delay or obstruct the investigation which is being carried out by the Assistant Controller.

131. *Clause 119* seeks to empower the Assistant Controller with discretionary powers to arrest without warrant any person who he reasonably believes has committed or is attempting to commit an offence under the proposed Act.

132. *Clause 120* seeks to empower the Assistant Controller with power to enter premises and inspect and seize goods and documents in conducting an investigation and performing his functions under the proposed Act.

133. *Clause 121* seeks to empower the Assistant Controller with power to enter premises with a search warrant obtained from the Magistrate to search for any evidence or thing.

134. *Clause 122* seeks to empower the Assistant Controller with power to enter premises without a search warrant being obtained from the Magistrate if he has reasonable cause to believe that by reason that any delay in obtaining the search warrant would adversely affect or the evidence of the commission of an infringement or any offence or that such evidence is likely to be tampered with, removed, damaged or destroyed.

135. *Clause 123* seeks to empower the Assistant Controller with power to access any recorded information or computerized or digitalized data whether they are stored in a computer or on other associated apparatus or material.

136. *Clause 124* seeks to provide that any person who has information or suspects that an Assistant Controller is conducting or has conducted an investigation and discloses such information which would likely prejudice the investigation or the proposed investigation, commits an offence.

137. *Clause 125* seeks to provide that a search warrant which is issued under the proposed Act shall be valid and enforceable notwithstanding any defect, mistake or omission in the warrant or in the application for such warrant and everything seized under the said warrant shall be admissible in evidence in any proceedings under the proposed Act.

138. *Clause 126* seeks to set out the obligation of the Assistant Controller to prepare a list of the things being seized and deliver the said copy of the list to the owner of the premises which have been searched.

139. *Clause 127* seeks to clarify that all the goods, materials, articles or others seized in the exercise of the powers conferred under the proposed Act are liable to forfeiture in accordance with the stipulated procedures.

140. *Clause 128* seeks to provide that the Assistant Controller who effected the seizure may release the seized book, record, accounts, document, computerized data, goods or thing to the person as he determines to be lawfully entitled to it.

141. *Clause 129* seeks to provide that where the goods seized are perishable in nature or the custody of the seized goods involves unreasonable expense and inconvenience, the Assistant Controller is empowered to sell such goods at any time and the proceeds from the sale will be held to abide to the outcome of the prosecution or claim.

142. *Clause 130* seeks to provide that no person shall be entitled to the cost of the proceedings before any court or any damages or other relief in respect of any book, record, accounts, document, computerized data, goods or thing seized in accordance with the provision of the proposed Act unless the seizure was made without reasonable cause.

143. *Clause 131* seeks to provide that any person who refuses to give access to any premises to any Assistant Controller to perform his duty or assaults, obstructs, hinders or delays any Assistant Controller in the conduct of his duty or refuses to give any Assistant Controller any information relating to an offence or suspected offence, commits an offence.

144. *Clause 132* seeks to clarify that an agent provocateur shall not be deemed as unworthy or discredited by reason that he has attempted to abet or abetted the commission of an offence by a person and that such attempt to abet or abetment was for the purpose of securing evidence against that person.

145. *Clause 133* seeks to clarify that any goods which are the subject matter of an offence which are found in two or more packages or receptacles of the same description shall be presumed to contain goods of the same nature, quantity and quality to all packages until and unless it is proved otherwise.

146. *Clause 134* seeks to provide that the Sessions Court shall have the jurisdiction to try any offence under the proposed Act and to impose the full punishment for any offence.

147. *Clause 135* imposes the requirement for all prosecution in relation to any offence under the proposed Act to be instituted with the consent of the Public Prosecutor.

148. *Clause 136* seeks to provide the Controller with the power to compound any offence committed by any person with the consent in writing of the Public Prosecutor and the procedure related to it.

149. *Clause 137* seeks to provide that the servant or agent of a person who commits an offence or does anything or omits to do anything which would constitute an offence under the proposed Act shall be deemed to be guilty of the offence and liable for the punishment for the offence unless he proves that the act or omission is not within the ordinary scope of the employment of the servant or of the agency of the agent or without his consent or connivance and that he has exercised all such diligence to prevent the commission or omission.

150. *Clause 138* seeks to impose that in the event that the offence is committed by a body corporate, the director, chief executive officer, chief operating officer, manager, secretary or other similar officer of the body corporate or was purporting to act in such capacity or was responsible for the management of any of the affairs of the body corporate or was assisting such management may be charged severally or jointly in the same proceedings with the body corporate and if found guilty, shall be deemed to be guilty of that offence unless he is able to prove that the offence was committed without his knowledge, consent or connivance; and that he had taken all reasonable precautions and exercised due diligence to prevent such commission of the offence.

151. *Clause 139* seeks to provide that no action or prosecution shall be instituted or maintained against the Registrar, Controller, Deputy Controller or any officer appointed under the proposed Act.

## PART XVII

152. Part XVII deals with the legal proceedings in the High Court, cost and evidence.

153. *Clause 140* seeks to set out the procedures that should be undertaken by the parties who have filed an application in the High Court including all the appeals filed in the Court of Appeal and Federal Court following the decision made in the High Court, to ensure that all necessary information is recorded by the Registrar of Trademarks in the Trademarks Office including to giving effect to the Court Order and others.

154. *Clause 141* seeks to set out the circumstances when the Registrar of Trademarks' appearance is permitted or required in the High Court.

155. *Clause 142* seeks to provide that the High Court may award cost to any party in the proceedings in the High Court pursuant to the judge's discretionary power but the Registrar of Trademarks shall not be ordered to pay the costs of any other parties.

156. *Clause 143* seeks to provide that in any legal proceedings where the validity of a registered trademark is questioned and the decision has been given in favour of the registered proprietor of the trademark, the High Court may certify to that effect and if the validity of the registered trademark is questioned again in subsequent legal proceedings, the registered proprietor of the trademark on obtaining a decision in his favour in the subsequent legal proceedings shall have the right to seek for his full costs, charges and expenses as between solicitor and client unless the High Court certifies otherwise.

157. *Clause 144* seeks to provide that a copy or extract from any form or document filed at the trademark office where the same has been certified to be a true copy or signed and sealed by the Registrar of Trademarks, shall be admissible in evidence in any proceedings as of equal validity with the original document.

158. *Clause 145* seeks to provide that a printed, written copies or extracts of or from the Register where the same has been certified to be a true copy or sealed by the Registrar of Trademarks, shall be admissible in evidence in any proceedings before any court of law without further proof or production of the original. This clause also seeks to empower the Registrar of Trademarks to issue a certificate of registrar which shall be *prima facie* evidence in any proceedings before any court of law of his having or not having performed the act.

159. *Clause 146* seeks to provide that any form, information or document or extract of the same which was electronically filed with or issued by the Registrar shall be a true extract from any form, information or document filed with or submitted to the Registrar of Trademarks.

160. *Clause 147* seeks to empower the Minister to declare documents of foreign state pertaining to trademarks to be admissible in any court of law.

#### PART XVIII

161. Part XX deals with miscellaneous and general matters.



162. *Clause 148* seeks to provide for the maintenance of the Intellectual Property Official Journal.

163. *Clause 149* seeks to provide discretionary powers to the Registrar to provide a service for the electronic filing of documents which are required to be filed with the Registrar.

164. *Clause 150* seeks to provide the Registrar with the power to issue documents by way of electronic means.

165. *Clause 151* seeks to provide the requirement on any person dealing with the Registrar to provide his address for service.

166. *Clause 152* seeks to provide the Registrar with the power to allow amendments to be made on documents filed with the Registrar in accordance with procedures stipulated in the proposed Act.

167. *Clause 153* seeks to provide the Registrar with the power to allow extension of time for any act required to be done under the proposed Act including the power to allow extension of time in the event of an error on the part of the Trademarks Office, registered trademark agent or circumstances beyond the control of the person or his registered trademark agent.

168. *Clause 154* imposes the requirement on a person to appear before the Registrar of Trademarks or produce any document in the proceedings before the Registrar should the person be summoned to do so and that a person who appears before the Registrar shall not refuse to be sworn or make an affirmation or to produce documents, articles or answer any question which that person is lawfully required to do so.

169. *Clause 155* seeks to impose an obligation on the Registrar of Trademarks to give an opportunity to be heard to any applicant or registered proprietor of trademark before exercising his discretionary power on them.

170. *Clause 156* seeks to empower the Registrar of Trademarks with the power to treat documents as confidential and to empower the Registrar of Trademarks with the power to deal with confidential information before him including to impose requirements or conditions or limitations or vary or revoke such requirements, conditions or limitation.

171. *Clause 157* seeks to empower the Registrar of Trademarks to do anything necessary to implement any amendment or substitution of classification of goods or services in the registration of trademarks regulations.

172. *Clause 158* seeks to empower the Registrar of Trademarks to award cost in accordance with the amount prescribed against any party to proceedings brought before him.

173. *Clause 159* seeks to provide that unregistered trademarks has no right to initiate any action to prevent or to recover damages.

174. *Clause 160* seeks to empower the Registrar of Trademarks to issue guidelines and practice directions which ought to be observed and complied by the applicant and the registered proprietor of trademark in so much as the guidelines or practice directions would set out the test and mechanism used and exercised by the Registrar of Trademarks in performing his duties and functions relating to the registration of trademarks.

175. *Clause 161* seeks to empower the Minister with the power to amend Schedules.

176. *Clause 162* seeks to empower the Minister to make all the necessary regulations as required under the proposed Act.

#### PART XIX

177. Part XIX deals with repeal, savings and transitional matters.

178. *Clause 163* seeks to provide the repeal and savings provision.

179. *Clause 164* contains the interpretation of certain words and expressions used in Part XIX of repeal, savings and transitional matters relating to the transitional provisions for trademarks.

For the purposes of subclause 164(3), the illustrations are as follows:

- (a) Z filed an application with the Registrar and the Registrar, upon receiving the application has yet to make any determination on it. This application is treated as pending.
- (b) The Registrar, after making determination on the application filed by Z, has accepted the application and subsequently issued certificate of registration or refused the application. This application is finally determined.

180. *Clause 165 to 182* seek to provide for the transitional provisions relating to existing registered trademarks and proceedings under the repealed Act.

For the purposes of subclauses 170(3) and 171(3), the illustrations are as follows:

- (a) Z filed an application with the Registrar and the Registrar, upon receiving the application has yet to make any determination on it. This application is treated as pending.
- (b) The Registrar, upon receiving the application filed by Z, has made the first or subsequent determination on the application and issue a letter requiring further information. This application is an application which has not been finally determined.

- (c) The Registrar, after issuing a letter requiring further information and receiving response from Z, has consequently allowed or refused the application. This application is an application which has been finally determined.

*FINANCIAL IMPLICATIONS*

This Bill will not involve the Government in any extra financial expenditure.

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