

The background of the cover features a golden scale of justice and a wooden gavel resting on a stack of books. The scale is positioned in the upper left, and the gavel is in the lower right. The books are stacked in the center and right. The entire scene is set on a wooden surface.

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Review

# Trademark dispute settlement in Malaysia: A comparative analysis with the TRIPS and the Paris convention

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Trademark is a mark, name, sign, smell or a sound, which distinguishes goods and services of one undertaking, from goods and services of other undertakings. Malaysia had the trademark ordinance 1950; which is repealed by the trademark act 1976 and thereunder, the trademark regulations are made in 1997. The trademark dispute arises between the parties, at the time of the registration of the trademark and at later stages; when the infringement of the registered trademark is occurred. The aggrieved party may settle the trademark dispute in Malaysia, through the civil procedure, the administrative procedure and through the criminal procedure; to protect his right of trademark in Malaysia. The substantive law; dealing with the civil procedure of the trademark dispute settlement in Malaysia; includes the trademark act 1976 and the Specific Relief Act 1950 and the procedural laws include the Order 87 of the Rules of the Court 2012 and the Order 100 of the Rules of the High Court 1980. The substantive criminal law; for the settlement of the trademark dispute through the criminal procedure; in Malaysia; is the Trade Description Act 2011 and the procedural law is the code of criminal procedure 1935. The trade description act states that a false trade description includes the trademark infringement and the false trade indication is also an infringement which is a misleading statement in an advertisement for the purpose of trade. The administrative procedure runs under the trademark regulations 1997, the intellectual property corporation of Malaysia act 2002 and the relevant provisions of the trademark act 1976 and the relevant provisions of the Customs Act 1967. The Paris convention contains provisions related to the border measures and the Agreement Trade Related Aspects of Intellectual Property Rights TRIPS includes a comprehensive chapter on the enforcement of Intellectual Property (IP) rights in member states. This article compares the current trademark dispute settlement structure in Malaysia with the relevant provisions of the TRIPS and the Paris Convention.

**Key words:** Intellectual Property (IP), trademark, intellectual property corporation of Malaysia (My IPO), trademark Act 1976, trademark regulations 1997, trade description Act 2011.

## INTRODUCTION

The trademark is a mark, name, sign, smell or a sound, which distinguishes goods and services of one undertaking from goods and services of other undertakings. The trademark is required to be distinctive

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and not descriptive. The trademark loses its distinctiveness, when the registered owner of the trademark does not take a prompt action against its infringement. The trademark dispute arises at the time of the registration, before the Intellectual Property Corporation of Malaysia or at the later stage; when the infringement of the registered trademark is occurred by the unauthorized user.

Initially, there was a trademark ordinance, which was passed in 1950 for the Malaysian territories, except for the Sabah and the Sarawak states; they had their own separate Trademark Ordinance, but in 1976; with the enactment of the Trademark Act 1976; the trademark ordinance 1950 is repealed. Now, the trademark act 1976 applies on the whole Malaysian territories including the Sabah and the Sarawak. The provisions of the trademark act 1976 apply on all trademarks; whether registered or not; in the whole territories of Malaysia. The trademark ordinance 1950 has been repealed but the appointments made under the repealed ordinance, as well as the certificates issued under the repealed ordinance are continue to enforce. Previous record of the registered trademarks under the trademark ordinance 1950 used to be kept in a previous register but after the establishment of the intellectual property corporation of Malaysia in 2002, the previous entries are made part of the current register and all entries are considered as the registration and entries under the new trademark act 1976, and the registration date is the same as written in the previous register. In case, if two trademarks are identical, which cause confusion, the one registered first prevails except if it is not abandoned, refused or successfully opposed. The registration application and required documents; for the registration of the trademark; may be submitted by hand or may be send to the registrar by post or may be submitted online through electronic means. All trademark entries are required to include the name of the proprietor and the name of the registered user, address and description as well as the assignment and transmission record with disclaimers, conditions and limitations.

The trademark regulations is made in 1997, to regulate practices, pertaining to trademark; before the registrar; to classify goods and services, to make or require duplication of documents, to secure and regulate publishing, to prescribe the fee, to regulate other matters, pertaining to trademark and to make the qualification of the agent. The agent must be domiciled or resident of Malaysia or has a principal place of business in Malaysia or an advocate or a solicitor in Malaysia or holds a recognized degree in the field and has over three years of an experience in the field of industrial property. The agent may be removed from the register if he loses the prescribed qualification or if he is convicted or if he is declared a discharged bankrupt. It is pertinent to mention here that the classification of goods and services is mentioned in the third schedule of the trademark regulations 1997, which is the same as mentioned in

the Nice Agreement 1957 and the Vienna Agreement 1973.

The intellectual property corporation of Malaysia is established under the intellectual property corporation of Malaysia Act 2002, for the purpose of the implementation of the intellectual property rights in Malaysia. The head office is located in Kuala Lumpur and there are several regional offices, which are located in Sabah, Sarawak, Johor Bahru, Kuantan, Penang and Melaka. All regional offices receive applications for the entry into the register of the trademark. Submitting application at the regional office is deemed as the submission of the application at the head quarter, but the register of the trademark is kept at the headquarter in Kuala Lumpur.

The registrar of the trademark is the director general of the intellectual property corporation of Malaysia. Assistant registrars, deputy registrars and other officers are appointed from time to time. They are allowed to do all actions as are prescribed for the registrar. The official seal of the Intellectual Property Corporation of Malaysia is kept with the registrar and any document contains that seal is admissible evidence before the competent authority. The Intellectual Property Corporation of Malaysia can use the property of the corporation, can impose the fee and charges for its services, can appoint an agent, consultant and expert to assist it, can grant loans to its employees, can co-operate with any other corporation or a government, can appoint and regulate examiner for the purpose of the Patents Act 1983 and can appoint a committee to assist it.

Initially, there was a trade description act 1972, which is repealed by the trade description act 2011. The trade description act 2011 deals with the settlement of disputes; through the criminal procedure; in Malaysia. It is partially substantive and partially procedural as the exhaustive criminal procedural act of Malaysia is the Code of Criminal Procedural 1935. The investigation under the Trade Description Act 2011 is required to be done by the controller, assistant controller and the deputy controller; appointed by the federal minister of domestic trade, cooperatives and consumerism.

The basic purpose of the trade description act 2011 is to promote good trade practice in Malaysia and to prohibit a false trade description and a false and misleading statements, conducts and practices. The registered trademark owner; in Malaysia; is required to apply; before the concerned high court; for the attainment of the trade description order, in case if there is an apprehension that an infringement may occur. The trade description order is a requirement in case if the apprehension of an infringement is with the non-identical mark and if the apprehension of the infringement is with the identical mark then there is no need to obtain a trade description order prior to start the criminal proceeding in Malaysia.

The sessions court has the jurisdiction to try the cases registered under the trade description act 2011, after the investigation conducted by the controller, assistant

controller and the deputy controllers; appointed by the Federal Minister of the Domestic Trade, Cooperatives and Consumerism, under the trade description Act 2011. It is pertinent to mention here that no prosecution can be instituted under the provisions of the trade description act 2011, without the prior permission of the public prosecutor.

The Paris convention is the first international treaty, which contains the provisions, related to the enforcement of the intellectual property rights in member states. The basic purpose of the Paris Convention is to form a union of all member states, to protect industrial property; includes the trademark. As per articles 9 and 10 of the Paris Convention (1967), the trademark owner has a right to take legal action against the infringement of his registered trademark in member countries of the union. The TRIPS contains a comprehensive provisions related to the enforcement of Intellectual Property rights. The member states are generally obliged to follow the general principles of the due process and fair trial.

The civil procedure is required to be available in member states, for the trademark dispute settlement. Civil procedure must consist the right of notice; timely and contains all sufficient details, the right of representation; through independent counsel, right to produce evidence; right to obtain injunctions, to prevent further infringement and to protect evidence.

Observance of the civil procedure provisions is compulsory as the observance of the administrative procedure provisions is optional as every state is given liberty to adopt administrative structure for the settlement of the trademark disputes. The provisional measures may be adopted by the trademark right holder if he provides a sufficient proof of ownership and the proof of the imminent infringement as the innocent infringement is not considered an offence. The counterfeited trademark goods are either prevented to import/export or seized for 10 to 20 days to give the parties chance to prove their claim before the competent authority.

Finally, the criminal procedure may be adopted, for the settlement of the trademark disputes, by the registered trademark owner in Malaysia. The infringer may be granted the punishment of imprisonment, fine, prevention from import and export, seizure and destruction of goods. This manuscript analyses the trademark dispute settlement in Malaysia, in comparison with the relevant provisions of the TRIPS and the Paris Convention.

## Trademark in Malaysia

Trademark includes a device, brand, heading, label, ticket, name, signature, word, letter, numeral or any combination. It also includes a well-known mark, which is consisted of an invented word; in respect of any goods or services and while deciding the authority of the well-known mark, the registrar is required to take into account, the knowledge and the recognition of the mark; in the

relevant sector; duration, extent and the geographical area of the use and the promotion, advertisement, publicity and the presentation of the goods and services of the mark, the record of the successful enforcement of the rights of the mark and the value associated with the mark.<sup>1</sup>

Other subject matters of the trademark include the name of the natural or a juristic person, as well as the signature which is used for the purposes of business, an invented word; which does not describe the goods and services and does not indicate a geographical name or a surname; and any distinctive mark; which distinguishes goods and services of one undertaking from those of other undertakings. The subject matter of the trademark also includes the defensive trademark, which is used in respect of other goods and services and that defensive trademark is deemed as associated trademark.

It is pertinent to mention here that the subject matter of the trademark includes the trade names, which are protected; under the Paris Convention; in the countries of the union, whether they are filed and registered or not. Service marks are also protected and there is no compulsory requirement for its registration as the registration gives a complete monopoly.<sup>2</sup>

The subject matter of the trademark also includes the certification trademarks, which must be capable of distinguishing in respect of origin, material, mode, quality, accuracy and other characteristics; inherently or due to continuous usage. Permitted use of a trademark is allowed to a registered trademark owner and a registered trademark user and it is subjected to some limitations with respect to the mode of use, use within a territorial area and use in relations to exported goods and services.<sup>3</sup>

If there is an identical trademark; which causes confusion; registered in the name of more than one proprietor, that trademark is considered an associated trademark and that association can be dissolved by the registrar, if an application; for the registration of a similar kind of a trademark; is submitted; before the registrar; and that does not cause a deception or a confusion. Association of trademarks can be transferred through assignment and transmission as a whole and not separately. If many trademarks are identical to each other and do not differ from other, except in representation as to goods, services, number, price, quality, name of place and color, the proprietor; who applied for the registration of those identical trademarks; may ask for the registration

<sup>1</sup> Regulation 13B, (1997). The Trade Marks Regulations. Malaysia. [http://www.myipo.gov.my/documents/10180/22873/Trade%20Marks%20Regulations%201997\(incorporated\).pdf](http://www.myipo.gov.my/documents/10180/22873/Trade%20Marks%20Regulations%201997(incorporated).pdf)

<sup>2</sup> Article 7 and 8, (1967). The Paris Convention for the Protection of Industrial Property. World Intellectual Property Organization.

[http://www.wipo.int/wipolex/en/treaties/text.jsp?file\\_id=287556](http://www.wipo.int/wipolex/en/treaties/text.jsp?file_id=287556)

<sup>3</sup> Sections 56 to 60, (1976). The Trade Marks Act. Malaysia.

<http://www.myipo.gov.my/documents/10192/2322945/Trade%20Marks%20Act%201976%20Act%20175.pdf>



as series in in the register and those would be considered associated trademarks.

Identical trademarks; which deceive or causes confusion; cannot be registered, if applied together by two different persons, unless they have decided themselves or the court of law decides the matter. In certain circumstances the court of law or the registrar may allow the registration of a trademark for the concurrent use to more than one proprietor; subject to modifications, limitations and conditions; decided by them. If a single trademark is registered to two persons at the same time, they would be considered joint proprietors of that trademark.<sup>4</sup>

### Trademark registration in Malaysia

Any trademark user or a proposed user, may make an application; by hand, by post or through online means; for the registration of the trademark, before the Intellectual Property Corporation of Malaysia. A combined application cannot be made for the registration of the trademark of goods and services of same class. The registrar is required to decide, whether to accept or reject the application for the registration of the trademark in Malaysia. If the registrar refuses the application or accepts the application conditionally, he would give grounds on which he has decided so. The aggrieved party may apply; in a prescribed manner; before the court of law, against the decision of the registrar and the court of law is required to decide the matter, after observing the right of hearing to both parties (Malaysia, I.P.C.O. 2016). The grounds given by the registrar; for the rejection of the trademark application; would be taken into consideration, during the court proceeding. If any other ground is taken into consideration, the applicant is allowed to withdraw his application without paying the costs. The court of law or the registrar may amend the application; at any stage; or allow the applicant to amend it himself. The date of the submission would be the original date; when the application was first submitted. The registrar may withdraw the acceptance of application at any stage; after the acceptance; if he feels that the application is accepted in error or accepted in different terms and conditions and circumstances, the registrar is required to issue a new acceptance letter with amended terms and conditions. The application for the registration of the trademark cannot be refused on the mere basis that the applicant does not use it because the trademark is about to be assigned to the corporation; which is about to begin its business.<sup>5</sup>

The trademark cannot be registered if it is contrary to law, deceives or causes confusion to the general public, consists any scandalous or offensive matter, prohibited to be protected by a court of law, against the interest and

security of the nation, identical to a well-known mark and already registered mark or consists a thing which misleads the general public as to its original place except if it is applied in good faith or if the geographical indication has ceased to be protected or if it contains words: patent, patented, by royal letters patent, registered, registered design and copyright.

It is pertinent to mention here that the Paris convention contains provisions from articles 6 to 10; about the trademark protection in member states. It states that conditions for the registration of the trademark are required to be determined by the member states themselves. It further states that the trademark identical to state official signs or intergovernmental organizations is not allowed to be registered in member states.<sup>6</sup> It further states that the registration of the trademark cannot be denied except if it infringes rights acquired by third parties, it does not have any distinct character, contrary to morality and public order and deceives the general public at large.<sup>7</sup> It further states that the registration of the trademark cannot be refused just on the mere basis of the nature of goods. A collective mark of associations can be registered if it is not unlawful under the law of the country of origin but the registration of the collective mark can be refused if it is against the public interest.<sup>8</sup>

If an application is made; for the registration of another person's name; that person's consent is required; for the registration; if he is alive otherwise his legal representative may give their consent, for the registration of a trademark. If a trademark is registered but it is not of a distinctive nature and it is common to trade and business and contains any part which is not separately registered, the registrar or the court of law may require the owner to disclaim some of the exclusive rights granted to him and that disclaimer would be recorded in the register of the trademark.<sup>9</sup>

If the corporation; which is the proposed user of the trademark; does not begin its business within a period of 06 months, the registrar is required to cancel the registration. After the acceptance of the registration, the registrar may allow the advertisement in the prescribed manner, if the advertisement has not been made before the acceptance. If the applicant does not fulfill the requirements of the registration within 12 months, the registrar is prescribed to abandon his application after observing the right of notice. It is pertinent to mention here that the registrar cannot abandon the application, if the matter is pending before the court of law as well as 3 months after the determination of the matter by the court of law.<sup>10</sup>

A certificate of registration is required to be issued by the registrar if the application has not been opposed or

<sup>6</sup> Article 6, (1967). The Paris Convention for the Protection of Industrial Property. World Intellectual Property Organization.

<sup>7</sup> Article 6, *ibid*.

<sup>8</sup> Articles 7 & 8, *ibid*.

<sup>9</sup> Sections 14 to 18, (1976). The Trade Marks Act. Malaysia.

<sup>10</sup> Section 27, 28 and 29, *ibid*.

<sup>4</sup> Sections 19 to 24, *ibid*.

<sup>5</sup> Sections 25 and 26, (1976). The Trade Marks Act. Malaysia.

the opposition time has been elapsed or the opposition has been decided in favor of the applicant. The time limit for the registration of the trademark is 12 months from the date of the submission of the application or if opposed; the extended time period given by the registrar or by the court of law. The registry in the register of the trademark is a prima facie evidence in all legal proceeding in favor of the registered trademark owner or the registered trademark user, except the registration is taken by fraud or the registration is illegal or not of a distinctive character.<sup>11</sup>

The registrar may amend the entry of the trademark register if there is any clerical mistake, obvious error but the amendment cannot be done in a way to effect the identity of the trademark.<sup>12</sup> An entry of the trademark in the register of the trademark, may be modified, on the request of the owner of the registered trademark and that amendment is appealable in a court of law. The owner of the trademark may request the registrar to amend or alter his trademark thus the registrar may accept or refuse his request and in case of acceptance, the registrar advertises that thing and gives such time for any opposition and if any party opposes the alteration in the trademark, the registrar is required to resolve the matter and that decision of the registrar is also appealable in a court of law.<sup>13</sup>

The registered proprietor; who is not residing in Malaysia; must appoint any natural resident person or a legal person; who has a business head office in Malaysia; and is required to provide his address to the registrar, for the purpose of correspondence.<sup>14</sup> Subject to terms and conditions and time period, the register is open to public; for inspection. Copy of any entry can be provided on the submission of the prescribed fee.<sup>15</sup> The owner of the registered trademark has exclusively all the rights to assign the trademark to the registered user. Joint owners of the trademark also have exclusive right separately and no one can use the exclusive right of the other owner.<sup>16</sup>

A registered owner of the trademark may authorize; through a contract; any person to be a registered user of his registered trademark, in respect of all or any of the registered goods or services but the owner retains the exercise control regarding the quality of goods and services. The owner of the registered trademark is required to submit an application; which consists a representation of the trademark, name and address of the contracting parties, description of goods and services, any condition or restriction and whether the usage is for a limited time period or unlimited time period and if limited time period, the duration must be written in an application to the registrar, for the entry of the registered user in the

trademark register.<sup>17</sup>

If the registered user of the registered trademark feels that the owner of a registered trademark is making hurdles in the usage of the trademark, he may apply; in the court of law; for the relief. The owner of the registered user may apply; before the registrar; for the alteration in the usage of a registered user or may apply for the extension of the usage time period or may apply for the cancellation of the registration of the registered user. The registrar may cancel the registration of the registered user when the time period of the registered trademark is elapsed. The registered user may call upon the registered proprietor to start infringement proceeding, if the owner does not do so; within 02 months; the registered user may start the proceeding with his own name as a registered proprietor and make the original proprietor; the defendant, but the original registered proprietor is not liable for any costs in this case. The registered user of the trademark does not have a right of an assignment and transmission; under the Trademark Act 1976.<sup>18</sup>

The registered trademark is transmissible and assignable with or without goodwill but the transfer is not valid if the trademark is not used in a good faith but this does not apply in case if the registration is made to give that trademark to any corporation or to any registered user for usage. The limitation time period for the transfer of the registered trademark is 6 months from the date of registration. The identical trademark or a trademark which causes confusion or so nearly resembles each other is also not transferable. On the application of an assignment by the owner of the registered trademark, the registrar may accept the application if it is not against the public interest and the decision of the registrar in this respect is appealable before a court of law. The application of an assignment; without goodwill; must be advertised before sending it to a registrar, for the entry in the trademark register.<sup>19</sup> The registered trademark in Malaysia can be used for the exportation of goods from Malaysia and where the form of trade changes and the owner uses his trademark, such uses does not deem to be created deception or confusion.<sup>20</sup>

The protection time of the registered trademark is 10 years, which is renewable after expiration. The registrar may send a notice to the prescribed owner of a trademark; before the expiration of the protection time period; which includes the date of expiration of registration as well as conditions of extension of protection. A renewal of the trademark can be granted for the further period of 10 years, if a trademark registered owner applies in a prescribed manner, within a prescribed time period, and fulfills the prescribed conditions.<sup>21</sup> It is

<sup>11</sup> Sections 30 to 37, *ibid.*

<sup>12</sup> Section 75, *ibid.*

<sup>13</sup> Sections 43 & 44, *ibid.*

<sup>14</sup> Sections 79 & 80, *ibid.*

<sup>15</sup> Section 08, *ibid.*

<sup>16</sup> Sections 34 & 35, *ibid.*

<sup>17</sup> Sections 48 & 49, *ibid.*

<sup>18</sup> Sections 51 & 52, *ibid.*

<sup>19</sup> Section 55, *ibid.*

<sup>20</sup> Sections 71 & 72, *ibid.*

<sup>21</sup> Section 32, *ibid.*

pertinent to mention here that article 18 of the TRIPS states that the term of protection for the registered trademark is at least for seven years and renewable after expiration for indefinite time. It is therefore recommended that the renewal time should be increased to indefinite time period in Malaysia, under the Trade Marks Act 1976.<sup>22</sup>

The renewal of the trademark registration, cannot be granted, if applied for, after expiration of one year from the expiration of the initial protection time of 10 years. When the trademark is not renewed; by the owner; due to nonpayment of the renewal fee, the trademark would remain in the register, until expiration of one year; if it does not cause confusion or deception.<sup>23</sup>

The right of priority can be claimed; within 06 months; in Malaysia as it is one of the member states of the Paris Convention. A temporary protection can be granted to the trademark of the goods and services that are the subject matter of the official international exhibition and a right of priority can also be claimed upon the temporary protected trademarks within 06 months from the date of the first exhibition day.<sup>24</sup>

### **Trademark dispute settlement during registration in Malaysia**

Any opposing party to the registration of the trademark may give a written notice to the registrar and to the applicant, within a prescribed time limit, given in a relevant statute, after the issuance of the advertisement. Notice should include the statement of grounds of opposition. The applicant is required to submit the counter statement; after receiving the notice; to the registrar and to the opponent. Thereafter the parties submit evidences within a prescribed time period. If the counter statement and evidences are not submitted, the application of registration would be abandoned. After hearing both the parties, the registrar is required to accept the application fully or with some conditions or reject it.

The decision of the registrar; in this regard; is appealable before a court of law; within a prescribed time, and the court of law is required to decide the matter, after hearing both the parties and the registrar. If additional grounds are taken; in a court of law, during an appeal proceeding; the applicant can withdraw the application without costs. If the applicant, opponent or an appellant are not residents of Malaysia, the registrar may require them to submit a security; for the costs of the proceeding; while giving notices, providing counter statements and submitting appeal in a court of law, failing which the notices, counter statements and the appeal

would be abandoned.<sup>25</sup>

Any interested party, may apply in a court of law, against any wrong entry in the register which remains there without a sufficient cause, even the registrar may apply before a court of law against any assignment, transmission or a registration of the trademark. The court of law, if decides in favor of the plaintiff, issues notices to the registrar, to rectify the register of a trademark. A trademark can be removed on the order of the court of law, if it decides in favor of the aggrieved party; if the trademark is registered in bad faith as it is not in use for a continuous 03 years.<sup>26</sup>

It is pertinent to mention here that article 6 of the Paris Convention states that the registration of a trademark can be cancelled, if it creates confusion and the request of the cancellation must be made within five years from the date of the registration but the limitation does not run against the mark registered in bad faith. It is also pertinent to mention here that the mark cannot be cancelled if it is registered in good faith before the entry into force of the Paris Convention and it does not mislead the general public at large.<sup>27</sup>

One case is the case of the Federal Court Putrajaya between Ho Tack Sien v/s Rotta Research Laboratorium (2015). The trademark VIARTIL drug and its packaging was registered as trademark in 1976 in favor of the plaintiff Ho Tack Sien. It was later on used by the defendant in 2013 for the same packaging of Artil-250 drug which was registered in 2002. A trademark dispute arises, and the parties went to the court of law because the matter went out from the registration process and both trademarks are registered under the Trademark Act 1976. The trial court decided the matter in favor of the plaintiff and asked the registrar to expunge the entry of the defendant from the trademark register. The defendant filed an appeal against the decision of the trial court. The appellat court up-held some part of the decision of the trial court in favor of the plaintiff but did not upheld that part of the decision which stated that the entry should be expunged from the trademark register. The defendant asked the Federal Court to interfere, the Federal Court rejected the court of appeal's decision and upheld the decision of the trial court; in favor of the plaintiff; and asked the registrar of the trademark to expunge the entry of the defendant's trademark from the trademark register.<sup>28</sup>

One more case is also the case of the Federal Court Putrajaya where the trademark dispute arises between the Mesuma Sports and the Majlis Sukan Negara Malaysia (2015). The defendant is the statutory body which is formed under the National Sports Council of Malaysia Act 1971 to make clothes, to be wearied by the

<sup>25</sup> Section 28, *ibid.*

<sup>26</sup> Section 45, *ibid.*

<sup>27</sup> Article 6, (1967). The Paris Convention for the Protection of Industrial Property. World Intellectual Property Organization.

<sup>28</sup> (2015). Ho Tack Sien & Ors v Rotta Research Laboratorium SpA & Anor *Malaysian Law Journal*, The Federal Court Putrajaya. 04: 166.

<sup>22</sup> Article 18, (1994). The Agreement on Trade Related Aspects of Intellectual Property Rights. World Trade Organization.

<sup>23</sup> Sections 41 & 42, (1976). The Trade Marks Act. Malaysia.

<sup>24</sup> Sections 70, 70A & 70B, *ibid.*

Malaysian Athletes, which are carrying a tiger stripes design. The defendant first assigned the work to one of the manufacturer and later on it was assigned to the plaintiff Mesuma Sports. The plaintiff; after sometimes; applied for the registration of a tiger stripes design and later on the defendant applied for the same. The registrar of the trademark objected the application of the defendant. The defendant filed a suit in the court of law, against the decision of the registrar of the trademark. The court of law decided the matter in favor of the defendant; the Majlis Sukan Negara Malaysia; and ask the registrar to register the tiger stripes design in favor of the defendant.<sup>29</sup>

The court of law or the Registrar; when a validity of a registered trade mark comes in question; may order in favor of the owner of all the expenses, charges and costs, unless the court of law decides the contrary, but the registrar cannot be ordered to pay the costs. If the relief of an alteration or rectification of the register is granted, the registrar; when asked; has to appear before the court of law. He may also be directed to submit similar nature cases presented before him and that can be taken as evidences in the proceeding.<sup>30</sup>

The registrar may take evidences through declaration or through a viva voce examination; provided no direction is given for that purpose; and those evidences may be used; in a court of law; through an affidavit as well as the copies of the original work sealed by the registrar are acceptable as an evidences before a court of law. The certificate issued by the registrar is also admissible evidence before a court of law. The foreign document is also admissible evidence, if the document is sealed by the authorized officer or a foreign government or if a certificate issued by an authorized officer regarding the validity of that document. The foreign state is under a reciprocal agreement with the government of Malaysia, for the acceptance of documents and this does not mean that Malaysian Government is bound to accept the recognition of all foreign trademarks.<sup>31</sup>

The registrar may be asked to give his advice, regarding any trademark, whether it is distinguishable or not and the person asked for the advice may on the negative advice of the registrar may withdraw his application of registration with the fee reimbursed.<sup>32</sup> The decision of the registrar is not appealable except if an appeal is given under the provisions of the Trademark Act 1976, provided that the court of law has the power of review in all orders of the registrar, passed related to the entry in question or correction. The court of law enjoys all powers; given to a registrar under the Trademark Act 1976; in an appeal upon the decision of a registrar.<sup>33</sup>

One case which demonstrates this situation of the trademark dispute and its settlement during the registration is the case of the High Court of Malaya, between the PELITA Samudra Pertama v/s Venkatasamy (2012). The PELITA is the hotel and has a right to sale food and related things at its premises under the trademark PELITA; a common law trademark; as well as the PELITA oil lamp. The respondent applied for the same trademark PELITA and the PELITA oil lamp's registration; before the registrar of the trademark. A trademark dispute arises thus the owner of PELITA trademark opposed the application of registration of the respondent; before the registrar of trademark. The owner of PELITA asserted that he is already the owner of the well-known mark PELITA. The registrar of the trademark rejected the plea of the owner of PELITA and accepted the application of registration of the respondent. Later on, the owner of PELITA filed an appeal; against the decision of the registrar of the trademark; before the High Court of Kuala Lumpur and contended that the subsequent trademark causes confusion and deception at the market place and it damages the goodwill and reputation of the appellants. The court of law decided the case in favor of the owner of PELITA, with costs RM 10.000.<sup>34</sup>

It is pertinent to mention here that the trademark dispute arises during the registration of the trademark in Malaysia, when the application of the registration is opposed by the owner of the identical trademark. Both parties are required to present their pleas before the registrar of the trademark thus it is an administrative method which is not exhaustively mentioned in the TRIPS and the Paris Convention, as the member states are free to choose and adopt their own administrative procedure; for the settlement of the trademark dispute. The administrative authority is empowered to order any civil remedy during the administrative proceeding. The TRIPS states that the infringer may be compelled to pay the damages, the expenses of the attorney's fee, the generated profit from the infringed and counterfeited trademark goods and services and the infringed goods may be disposed of or destroyed. On the contrary, if the infringement allegations are not proved, the registrar may require the applicant to pay the indemnification to the accused as well as the cost of the attorney's fee.<sup>35</sup>

One case, which elaborates the clear picture about the settlement of the trademark dispute during registration. It is the case of the High Court of Malaya between Yong Teng Hing v/s Walton International (2012). The dispute arises between both the parties of the case, during the registration, because both parties applied for the registration of the trademark GIORDANO for the trade of their leather garments. The registrar of the trademark refused to register both applications until their claim is to

<sup>29</sup> (2015). *Mesuma Sports Sdn Bhd v Majlis Sukan Negara Malaysia*. *Malaysian Law Journal*, The Federal Court Putrajaya. 06: 465.

<sup>30</sup> Sections 61 to 63, (1976). *The Trade Marks Act*. Malaysia.

<sup>31</sup> Sections 64, 65 & 66, *ibid*.

<sup>32</sup> Section 73, *ibid*.

<sup>33</sup> Sections 67 & 69, *ibid*.

<sup>34</sup> (2012). *PELITA Samudra Pertama (M) Sdn Bhd v Venkatasamy a/l Sumathiri* *Malaysian Law Journal*, The High Court Kuala Lumpur. 06: 114.

<sup>35</sup> Article 49, (1994). *The Agreement on Trade Related Aspects of Intellectual Property Rights*. World Trade Organization.

be decided by the court of law. The matter went to the High Court of Kuala Lumpur, where the applicant claimed that he has been using the trademark GIORDANO since 1986 and the respondent claimed that the trademark GIORDANO is first used in Hong Kong in 1982 and it is assigned to him by the GIORDANO Ltd of Hong Kong, furthermore, the respondent asserted that he is the registered owner of the similar kind of trademark since 1982 and he has been using the trademark GIORDANO since 1990. The Kuala Lumpur High Court settled the dispute between the parties and allowed the respondent to register the trademark as the court of law gave a decision in favor of the respondent with costs.<sup>36</sup>

It is not necessary that the application of the registration can only be opposed by the owner of the identical trademark, it can also be rejected by the registrar himself, if it is incomplete and if the applied trademark is non-registrable as per the provisions of the relevant laws. The registrar may refuse the registration application of the trademark; in Malaysia; if the trademark includes words "to counterfeit this is a forgery", the registered trademark, registered service mark, BUNGA Raya, Seri PADUKA BAGINDA Yang di-PERTUAN AGONG and similar words, ASEAN, Red Crescent, Geneva Cross, Swiss Federal Cross and similar words and the representation of any government owned property.<sup>37</sup> The registrar may refuse to register a mark if it is identical or similar to a well-known mark, misleads the general public as to nature, quality, characteristic and false indication of the geographical origin of goods or services.

The entry in the register of the trademark would be abandoned if the owner does not remain competent to certify goods or services, has failed to observe provisions of the deposited rules, the registration of the trademark is no longer in the public advantage and the variation in the rules must be made in the public advantage.<sup>38</sup> The registrar of the trademark is also required to expunge the registry of the registered trademark from the trademark register, if the registered trademark is not used; by the owner or by his assignee; for consecutive 03 years. The entry may also be expunged if the proposed corporation; for the use of the registered trademark; does not start its business and does not use the registered trademark for consecutive 06 months, after the registration of the trademark. It is pertinent to mention here that the registration of a trademark cannot be invalidated just on the mere fact that any word of the trademark has been used for the description of any article, substance or service, by the registered owner or by the registered trademark user.<sup>39</sup>

One case which provide us a clear picture about the

resolution of the dispute; during the registration; is the case of the High Court of Malaya, between Wieland Electric GMBH v/s Industrial Automation (2014). GMBH was established in 1920, for the manufacturing of Electrical Connection Technology. It entered into a contract to be a part of Wieland Group; which has subsidiaries in more than 70 countries of the world. It entered into an agency agreement; with the defendant; who was appointed as a sales agent of Wieland in Malaysia. The defendant applied for the registration of the identical trademark, with the mark of Wieland Group. Plaintiff requested him not to do so but the defendant undertook that it would assign it to the plaintiff after registration but he did not do so after taken the registration. The plaintiff relinquished the agency agreement and applied in the court of law for the expunging of the registered trademark from the trademark register. The court of law orders the registrar of the trademark to expunge the entry of the defendant from the trademark register and decided the matter in favor of the plaintiff with costs.<sup>40</sup>

One last case regarding the trademark dispute and its settlement during the registration process before the registrar; in Malaysia; is also the case of the High Court of Malaya, between (A K Koh 2015). Enterprise and A1 Best One Food Industry. The plaintiff A K Koh Enterprise is the manufacturer and merchant of BAK KUT the spices in Malaysia since 1983 and used the A1 sign for the trade of its products. The plaintiff and the defendant, both applied for the registration of the BAK KUT trademark; before the registrar of the trademark in Malaysia. The registrar of the trademark allowed the registration of the BAK KUT the spices, in favor of the defendant and rejected the application of the plaintiff. The plaintiff appealed against the decision of the trademark registrar before the High Court of Kuala Lumpur. The court of law decided the matter in favor of the plaintiff and ordered the registrar of the trademark to expunge the registry of the defendant's trademark from the trademark register and register the trademark BAK KUT in favor of the plaintiff.<sup>41</sup>

### **Trademark dispute settlement after infringement in Malaysia**

If a person uses the registered trademark of a registered proprietor illegally as a trademark in the course of a trade and portrays to the public that he is the actual registered owner of that trademark and misrepresents, would be considered an infringer. The registered owner or the registered user of the trademark may issue a statement prohibits the infringer to abstain from the infringement of the trademark, but the buyer who does not have any

<sup>36</sup> (2012). Yong Teng Hing v Walton International Ltd. *Malaysian Law Journal*, The High Court Kuala Lumpur. 10: 244.

<sup>37</sup> Regulations 13 & 13A, (1997). The Trade Marks Regulations. Malaysia.

<sup>38</sup> Section 56, (1976). The Trade Marks Act. Malaysia.

<sup>39</sup> Section 33, *ibid*.

<sup>40</sup> (2014). Wieland Electric GMBH v Industrial Automation (M) Sdn Bhd. & Anor. *Malaysian Law Journal*, The High Court Kuala Lumpur. 10: 445.

<sup>41</sup> (2015). A K Koh Enterprise Sdn Bhd v A1 Best One Food Industry Sdn Bhd *Malaysian Law Journal*, The High Court Kuala Lumpur. 09: 715.

information regarding the infringement and he agrees to buy goods in good faith is not liable to the infringement. The trademark would not be considered infringed if a person uses the trademark in a good faith of his own name or the name of his business or the person uses the trademark which is the description of his goods or services or if the user uses the trademark continuously before the registration date of the registered trademark or the registered owner expressly or impliedly agrees to give permission for the use of a registered trademark or if the use of a trademark is reasonably necessary for the time being and the purpose and the effect of the use does not indicate an infringement.<sup>42</sup>

The owner of the registered trademark; in Malaysia; has the right to take a prompt action against the infringement of his registered trademark, he may obtain the civil procedure under the relevant provisions of the Trademark Act 1976 and the Specific Relief Act 1950. The criminal procedure may be adopted by the owner of the trademark in Malaysia, under the Trade Description Act 2011 and the administrative procedure runs under the Trademark Regulations 1997 and the relevant provisions of the Trademark Act 1976 and the Customs Act 1967.

There are three types of remedies of the trademark infringement in Malaysia. The civil remedies, the criminal remedies and the administrative remedies. All of the three remedies further are classified into several types. The civil remedy includes the damages and the injunctions, the criminal remedy includes the fine and the imprisonment and the administrative remedy includes the seizure and the destruction of infringed goods. When the right of the registered trademark owner or the registered trademark user is infringed; in Malaysia; he may take the remedy of the injunction through the civil court under the Specific Relief Act 1950, to stop the infringer from the further infringement and to protect the evidence in his favor. He may also take the criminal remedy and complain before the assistant controller against the infringer and provide him the description of the infringer, the premises and the committed offence under the provisions of the Trade Description Act 2011. He may also apply before the registrar, against the registration of the identical mark. He may apply before the registrar or may ask the custom authority to seize the infringed goods; for 10 to 20 days; to start the legal proceeding against the infringer.

A trade description order can be obtained; from the concerned High Court; by the registered trademark owner; if he feels that there is a person who has applied for the registration of the non-identical mark or an infringement occurs with the non-identical trademark but can cause confusion in the mind of the consumer related to the goods and services of the registered trademark owner. The Trade Description Order is useable for one year from the date of its entry into the trademark register but renewable after the expiry. The Trade Description

Order is an admissible evidence in favor of the registered trademark owner. It is pertinent to mention here that if the infringement of the trademark occurs; with the identical trademark; then there is no need to obtain a Trade Description Order and the owner can start the criminal legal proceeding, without the Trade Description Order.

The owner of the registered trademark in Malaysia has the right to start a criminal proceeding against the infringer. The assistant controller may start the investigation of an offence committed or about to be committed under the provisions of the Trade Description Act 2011, if he has a reasonable ground to believe that the offence has been committed or about to be committed. An aggrieved person may lodge a complaint before the assistant controller against the accused and give details of the accused, the premises where the offence is committed or about to be committed and details of the alleged offence.<sup>43</sup> If the assistant controller has sufficient cause to believe that any person or any document is relevant with the investigation, he may order for the production of that document and that information within a specified time and at the specified place. If the person is not in possession of the document, he may be required to inform the assistant controller about the person; in whose possession the document is or in whose possession that document was at last. The assistant controller may retain that document as long as he deems fit for the purposes of investigation and he may release that document when the investigation is completed and there is no further need for retaining that document. Any person can be asked to allow the assistant controller to access his computerized data, books, accounts, documents, goods or other things, for the purposes of the investigation, under the Trade Description Act 2011.

No person can compel the accused to provide and disclose the communication between the client and his advocate. No person is allowed to disclose a confidential information except with the permission of the owner of the document, except if the source cannot be ascertained or if the information is in public domain or if the information is already known by the public or if the disclosure facilitates the performance of the controller, deputy controller or an assistant controller or if the disclosure is in connection with an offence; during the proceeding; under the Trade Description Act 2011 and not in contradiction with the directions of the controller, deputy controller or an assistant controller.<sup>44</sup>

When a person fails, omits, destroys, conceals, mutilates, alters, the required document, an evidence or an information or sends, conspires or attempts to send the required document, evidence or an information, would be considered an offender under the provisions of the Trade Description Act 2011.<sup>45</sup>

<sup>42</sup> Sections 38, 39 & 40, (1976). The Trade Marks Act. Malaysia.

<sup>43</sup> Sections 30 & 31, (2011). The Trade Description Act. Malaysia.

<sup>44</sup> Section 126, (1950). The Evidence Act. Malaysia.

<sup>45</sup> Sections 32 to 38, (2011). The Trade Description Act. Malaysia.

One case which provide us a clear picture about the disclosure of the confidential information, is the case of the High Court of Malaya between Plastech Industrial System v/s N and C Resources (2012). The plaintiff is the manufacturer of plastic foam and the defendant is also manufacturing plastic products. Defendant no.2, 3 and 4 left the plaintiff and joined the defendant no.1 in his work in 2009. They used the confidential information of the plaintiff and make similar kind of products and trading it at the market place with their names. A dispute arises and the plaintiff filed a claim of the infringement and passing off against the defendants. The court of law decided the case in favor of the plaintiff with costs and stated that the act of the defendant has damaged the good will of the plaintiff resultantly loss the sale at the market place thus it was a clear cut case of passing off in favor of the plaintiff.<sup>46</sup>

Apart from the civil and the criminal procedure, for the settlement of the trademark dispute in Malaysia, the registered owner or the user of the trademark may obtain the administrative procedure to stop the infringement of his registered trademark. The administrative procedure either runs before the registrar; when the owner applies against the registration of the identical trademark; or runs before the customs authority; when the owner applies before it for the seizure of the counterfeited trademark goods. Below is the explanation of the civil, criminal and administrative procedures of the trademark dispute settlement in Malaysia, in comparison with the TRIPS and the Paris Convention.

### Civil procedure

The owner of the registered trademark in Malaysia may apply for obtaining the injunctions before the court of law through the civil procedure under the provisions of the Specific Relief Act 1950. It is pertinent to mention here that the Specific Relief Ordinance was first enacted in 1950 and it was ordinance number 29, thereafter it was revised in 1974 and changed into the present form by an act number 134 of 1974.

The granting of the injunctions; by the civil court of law; in Malaysia; whether perpetual, mandatory or temporary; is called the preventive relief. The temporary injunctions are those injunctions and stay orders; of the court of law; which are applicable until a specified time mentioned in the order or when the time is not mentioned in the order, until the further order of the civil court of law. The temporary injunctions can be awarded at any time of the proceeding by the civil court of law. The perpetual injunctions can be granted by the civil court of law, at the time of the decree upon the merits of the case, to stop the defendant perpetually from asserting the right; which actually is the right of the plaintiff; and to stop the

defendant from doing any other act perpetually.

The perpetual injunction can be granted at the time of the decree on the merits of the case; by the civil court of law; to prevent the breach of an expressed or an implied obligation; which is in existent in favor of the plaintiff through a contract; or when the defendant is the trustee of the property of the plaintiff or when the damage of an invasion cannot be ascertained or when the pecuniary relief; of the damage; is not adequate or when the pecuniary compensation cannot be granted or when the injunction is required to prevent the multiplicity of the legal proceeding. To prevent the breach of the performance, it is necessary to stop the breach of an obligation as well as to compel someone to do some act and that compelling is through the civil court of law, under the mandatory injunction.

An injunction; whether temporary, perpetual or mandatory; can be refused if it is required to stay the judicial proceeding, except if it is required to stop the multiplicity of the judicial proceeding or can be refused if it is required to stop the judicial proceeding; pending before the upper court of law; or if it is required to stop any person to apply before any legislative body or if it required to stop the public authorities of any department of the Malaysian government to perform their public duties or if it is required to stay the criminal proceeding; before the court of law; or if it is required to prevent the breach of a contract; whose performance is not specifically enforceable; or if it is required to stop a nuisance when it is not clear whether it comes under the definition of the nuisance or not or if it is required to prevent the continuing breach of a contract or if there is any other effective relief, which can be obtained through the normal procedure of law; except in case of the breach of the trust; or if it is required to disentitle the applicant or his agent to assist the court of law or when the applicant has no personal interest in the matter.<sup>47</sup>

The TRIPS states; regarding the injunctions; that the court of law may order an injunction, on the request of the party when there is a reasonable cause to believe that if the injunction does not order it would harm the applicant or the evidence concerning the proceeding would be destroyed. The court of law may ask the plaintiff to provide a security or surety, before ordering the injunction. The defendant's right of notice and the right of hearing, would be accorded, before pronouncing the injunction order and he may also have the opportunity of review, upon the decision of the court of law and if the injunction order is overruled, the court of law may order the plaintiff to give compensation to the defendant.<sup>48</sup>

One case, which demonstrates the civil procedure of the trademark dispute settlement in Malaysia is the case of the High Court of Malaya, between Oriental and Motolite Marketing Corp v/s Syarikat Asia Bateri (2012).

<sup>46</sup> (2012). Plastech Industrial Systems Sdn Bhd v N & C Resources Sdn Bhd & Ors. *Malaysian Law Journal*, The High Court Kuala Lumpur. 05: 258.

<sup>47</sup> Sections 50 to 55, (1950). The Specific Relief Act. Malaysia.

<sup>48</sup> Article 50, (1994). The Agreement on Trade Related Aspects of Intellectual Property Rights. World Trade Organization.

The plaintiff is a company in Philippines for the production of automotive batteries and trading it with a mark MOTILITE since 1950. Since 2000, the company was selling its products in Malaysia, through the defendant. Both parties signed a deed of assignment by which all the rights and interests of the defendant in MOTIOLITE trademark was assigned to the plaintiff and signed a memorandum of understanding by which the defendant was appointed as the local distributor of the plaintiff in Malaysia for five years and continue to be in his position if the distributorship agreement is signed afterwards between them but it was not happened and the defendant continue to distribute the batteries with the trademark MOTIOLITE.

The trademark dispute arises and the plaintiff adopted the civil procedure and filed a suit of an infringement and passing off; against the defendant; before the court of law. The infringement claim was taken in his favor but the passing off claim was dismissed with costs.<sup>49</sup>

One more case is the case of the High Court of Malaya, between Shaifubahrim bin Mohammad v/s EM Exhibitions and Anor (2012). The plaintiff Shaifubahrim bin Mohammad is the president of PIKOM, who appointed the defendant number two as project executive in his company. He left the company and set up his own company PC EXPO for the organization of computer related exhibition. The trademark dispute arises thus the plaintiff filed a claim before a court of law that the defendant is using his registered trademark PC FAIR which was denied by the court of law as it is the common term for computer related exhibitions. The term which was registered and legalized with the name of the plaintiff is PIKOM PC FAIR and not only PC FAIR.<sup>50</sup>

The TRIPS states that the member states are required to provide an opportunity of civil proceeding to the right holder and the defendant has the right of notice before the start of the legal proceeding, which must be made, within a time, and contains adequate details on the basis of the claim. Personal appearances of the parties must not be obligatory and they may be represented through independent lawyers and present evidences. If the constitution of the member states does not stop the member state, it may provide a mean to identify and protect the confidential information.

The court of law may order the party; in whose possession the evidence is; to present before it; with conditions: if the evidence contains confidential information; which affirms the claim of the opposing party. When a party is not participating in the proceeding and use delaying tactics voluntarily, without good reason or otherwise does not provide necessary information, the court of law is required to announce its judgment preliminary or finally by fulfilling the right of hearing of the

parties. Furthermore, the member states are required to prevent the infringement of intellectual property to protect the trade of imported goods and the infringer is required to pay damages to the right holder as compensation for the injury caused due to his infringement as well as he may also be required to pay the expenses of the fee of the attorney and the generated profit, due to infringement. The infringing material may be disposed-of for destroyed; to minimize the possibility of the further infringement; taking into account the interest of the right holder and the third party.<sup>51</sup>

One case is the famous case of Malaysian trademark history, it is the case of the Court of Appeal Putrajaya, between Yong Sze Fun and Anor v/s Syarikat Zaman Haji Tamin and Anor (2012). Mr. Haji. Mohammad Tamin bin Wahi used the trademark TAMIN in 1951; for the sale of his food products; which was latter on taken by the plaintiffs. Defendants used the same trademark TAMIN for the sale of their food products. A trademark dispute arises and the Plaintiffs applied before the court of law against the use of the identical trademark by the defendants. Defendants counter claimed against the plaintiffs that they have applied before the Enforcement Division of the Ministry of Domestic Trade, Cooperatives and Consumerism, against the use of the trademark and the authority raided on their premises and seized the products. The High Court of Malaya gave a decision in favor of plaintiffs. Defendants filed an appeal, against the decision of the High Court. The appellant court upheld the decision of the High Court.<sup>52</sup>

### Criminal procedure<sup>50</sup>

The owner or the user of the registered trademark in Malaysia is eligible to acquire a criminal procedure; for the settlement of the trademark dispute; under the Trade Description Act 2011. The trademark infringement comes under the ambit of the false trade description. A false trade description is defined as a direct or an indirect false indication to goods or part of goods; in an advertisement; in relation to its nature or designation, length, height, width, area, volume, capacity, weight, size, quantity, gauge, method of production and manufacturing, processing and reconditioning, composition, strength, fitness, standard of fitness, performance, behavior or accuracy or any other technological characteristic or the date of expiration of the product.<sup>53</sup>

Any person, applies a false trade description to any goods, takes a possession of those goods, exposes that for supplying and supplies those goods, is punishable and in case of a legal person first time punishment is two hundred and fifty thousand ringgit fine and second time

<sup>49</sup> (2012). Oriental & Motolite Marketing Corp v Syarikat Asia Bateri Sdn Bhd. *Malaysian Law Journal*, The High Court Kuala Lumpur. 05: 87.

<sup>50</sup> (2012). Shaifubahrim bin Mohd v EM Exhibitions (M) Sdn Bhd & Anor. *Malaysian Law Journal* The high court Kuala Lumpur. 09: 84.

<sup>51</sup> Article 42 to 48, (1994). The Agreement on Trade Related Aspects of Intellectual Property Rights. World Trade Organization.

<sup>52</sup> (2012). Yong Sze Fun & Anor v Syarikat Zamani Hj Tamin Sdn Bhd & Anor. *Malaysian Law Journal* The Court of Appeal Putrajaya. 01: 585.

<sup>53</sup> Sections 6 & 7, (2011). The Trade Description Act. Malaysia.



five hundred thousand ringgit fine and in case of a natural person: one hundred thousand ringgit fine or imprisonment for three years or both and for second time two hundred and fifty thousand ringgit fine or imprisonment for five years or both. Any person applies a false trade description to goods, take a possession of those goods, exposes that for supplying and supplies those goods; in violation of the trademark rights of the registered trademark owner; is punishable and in case of a legal person first time punishment is fifteen thousand ringgit fine and second time thirty thousand ringgit fine and in case of a natural person ten thousand ringgit fine or imprisonment for three years or both and for the second time twenty thousand ringgit fine or imprisonment for five years or both. Any person applies, takes possession, exposes and supplies goods bearing an identical mark with the registered trademark would be considered as he has applied a false trade description and is required to be dealt accordingly.

A registered trademark owner may apply before the High Court for the attainment of the trade description order, prior to start the criminal proceeding against the trespasser; if the accused has been using a non-identical mark; but in case of the infringement of the identical trademark, then there is no need to apply for the attainment of the trade description order. The High Court may grant the trade description order; to the registered trademark owner; initially for one year but can be renewed for further period and that entry would be made before the registrar and he is required to keep that in the register and that trade description order is an admissible evidence before the competent authority, in favor of the registered trademark owner.<sup>54</sup>

A minister charged with the Domestic Trade, Cooperatives and Consumerism is required to appoint the controller, assistant controller and the deputy controller; for the purpose of the investigation of the false trade description and false and misleading advertisement offences; under the Trade Description Act 2011. The minister is also required to appoint a registrar; who is the director of the Intellectual Property Corporation of Malaysia; for making, keeping and maintaining the Trade Description Order entries.<sup>55</sup>

One case which provide us the clear picture about the attainment of the Trade Description Order is the case of the Federal Court Putrajaya between Lian Bee Confectionery v/s QAF Limited (2012). The Lian Bee is a seller of bakery items and among them is a filled cream bun, which he has been selling under a trademark Squiggle since 2007. The QAF Company limited is a Singaporean company which has been using the same mark for its bakery items since 2004. The Gardenia Bakeries is the subsidiaries of the Singaporean company, which has been using the Squiggle trademark for selling the cream filled bun since 2003. The QAF Limited applied;

before the concerned High Court; for the attainment of the trade description order in 2008. Later on, the dispute went to the trial court, which gave a decision in favor of the QAF Limited. Lian Bee filed an appeal and the court of appeal upheld the decision of the trial court in favor of the QAF Limited.<sup>56</sup>

It is pertinent to mention here that when a trade description is made; whether orally or in writing; a person who supplies those goods would be considered as he applies the trade description to those goods. While determining the class of the goods of the trade description the form, consent, time, place, manner and other related matters would be taken into consideration.<sup>57</sup> The minister may exempt any description of goods which does not fall under the definition of the false trade description, for the purpose of the exportation or for any other specific purpose mentioned in the order issued by the minister.<sup>58</sup>

Any person, initiating a false entry in the trademark register, in its copy or make a false document identical to register or produce a false document as evidence is guilty of an offence and if proved would be fined of five thousand ringgit or imprisonment for five years or both.<sup>59</sup> No person is allowed to misrepresent himself as the registered owner or the registered user of the registered trademark if he does so, it is an offence and he is liable to imprisonment for two months or five hundred ringgit fine or both. If a trademark user wants legal benefits, he must register his trademark in the trademark register; in a prescribed manner; but the registration is not necessary in respect of legal benefits as to passing off.<sup>60</sup>

Any conduct, practice, statement, representation or an indication; direct or indirect; which leads a person to an error about the price, supply or an approval of goods or services, is a misleading and a false statement. The burden of proving or disproving of the false or misleading statement; in an advertisement; is upon the accused and not on the accuser. The person convicted on the charge of the false or misleading statement would be fined; if the offender is a body corporate; of five hundred thousand ringgits for the first time and one million ringgits for the subsequent times. If the offender is a natural person, would be fined; for the first time; two hundred and fifty thousand ringgit or imprisonment for three years or both and for the second time, five hundred thousand ringgit fine or imprisonment for five years or both.<sup>61</sup>

The accused may take the defense that the offence was done, due to the default of another person; and identify the another person; within fourteen days; through a notice to the prosecutor; or a natural person may take

<sup>54</sup> Sections 5, 8 & 9, *ibid*.

<sup>55</sup> Sections 3 & 4, *ibid*.

<sup>56</sup> (2012). Lian Bee Confectionery Sdn Bhd. v QAF Ltd. Malaysian *Law Journal*. The Federal Court Putrajaya **04**: 20.

<sup>57</sup> Sections 10 & 11, (2011). The Trade Description Act. Malaysia.

<sup>58</sup> Section 56, *ibid*.

<sup>59</sup> Section 9, (1976). The Trade Marks Act. Malaysia.

<sup>60</sup> Sections 81 & 82, *ibid*.

<sup>61</sup> Sections 13 to 21, (2011). The Trade Description Act. Malaysia.

the defense that the false trade description or a false or misleading statement is used personally or domestically or the offence was occurred due to the mistake or an accident beyond the control of the accused and the accused has taken all precautions and due diligence to avoid the commission of an offence or the natural born accused was unaware of the false trade description even after a reasonable diligence or the accused publisher received the misleading advertisement in the normal course of business and he was unaware of its illegality, under the Trade Description Act 2011.<sup>62</sup>

The minister; charged with the Domestic Trade, Cooperatives and Consumerism; may issue a definition order, a certification order or an informative marking, in the interest of the rightful importer and exporter of the goods and services. If the body corporate uses the expression in contravention of the definition order, it would be fined for five million ringgits for the first time and ten million ringgits for the subsequent time and if the offender is a natural person, would be fined; for the first time; one million ringgit or imprisonment for three years or both and for the second time five million ringgit fine or imprisonment for five years or both. If the body corporate contravenes the informative marking and certification order, it would be fined two hundred thousand ringgits for the first time and five hundred thousand ringgits for the second time and in case the offender is a natural person, one hundred thousand ringgit fine or imprisonment for three years or both for the first time and two hundred thousand ringgits fine or imprisonment for five years or both for the second time.<sup>63</sup>

The assistant controller also has the right to investigate the infringement of the false trade description and other related offences under the provisions of the Trade Description Act 2011 and for that purpose, he has a right to arrest the offender, enter the suspected premises with or without a warrant, search and seize the suspected goods. An assistant controller may arrest the suspected person when he reasonably believes that an offence of a false trade description is committed or is about to be committed and then he is required to hand over that suspected person to the nearest police station and thereafter the criminal procedure would be followed without unreasonable delay and the arrest would be considered as done by the police officer.

The assistant controller may enter the suspected premises; on the search warrant issued by the magistrate or without a search warrant; to inspect as well as to seize the suspected goods to ascertain whether the offence is committed or not or it is useful for the ascertainment of the evidence, to put a light in the investigation process.

The search warrant and actions done under it are admissible evidence before the competent authority. The assistant controller is also authorized to access the

suspected person and his computerized suspected data for the purpose of an investigation under the provisions of the Trade Description Act 2011.

Any person; who has some knowledge about any information related to the investigation under the assistant controller; gives information to any other person, who mutilates the investigation process, is considered an offender under the relevant provisions of the Trade Description Act 2011, except an assistant controller and people working under him for the purpose of investigation or disclosure of an information for any legal purpose. After searching the premises and seizing goods, the assistant controller would make a list of seized goods and hand over one of its copies to the occupier of the premises or his agent or his servant and if there is no occupier of the premises, the assistant controller would paste the list conspicuously on the premises. If the offence is proved before the court of law, the court of law would order for the forfeiture of the seized goods and if the offence is not proved, the court of law is required to order for the release of the seized goods.

If no prosecution proceeding starts; related to the seized goods; the seized property would be consider forfeited, after expiration of one month from the date of the seizure except if the owner of the property gives a written notice to the assistant controller that he is the owner of that property, the assistant controller would refer that notice to the controller who is required to direct whether the property should be forfeited or should be released or may directs the assistant controller to put the matter before the court of law; for its decision; and the court of law would decide the matter after due course of law. The forfeited property would be handed over to the assistant controller and would be disposed-off, in accordance with the directions of the controller. The perishable goods or the goods require unreasonable expenses and inconvenience can be sold out at any stage and proceed of the sale would be dealt in accordance with the decision of the controller or the court of law. In case of the release of the seized goods, if the owner reasonably believes that the seizure affected his goods may apply before the court of law against the controller or the federal government if the damage is occurred due to unreasonable cause. A person who hinders and create hurdles in the legal actions of the assistant controller under the provisions of the Trade Description Act 2011 is an offender. The assistant controller is authorized to make test purchases to comply with the provisions of the Trade Description Act 2011.

No agent is considered untrustworthy of credit if he abetted the commission of an offence for the purpose of securing an evidence and this act is an admissible evidence in his favor, before the court of law. If the suspected goods are found in more than one packing and more than one species, inspection of one centum or five samples are sufficient enough to believe that the remaining contains the same. The assistant controller has all the powers of an investigation as the police has

<sup>62</sup> Section 22 to 25, *ibid.*

<sup>63</sup> Sections 28 & 29, *ibid.*

under the Criminal Procedure Code 1935.<sup>64</sup>

For ascertaining the opinion of the participant; at the market place; a research is required to be conducted, regarding goods and things related to goods. If no plenty; of an offence; is given, under the provisions of the Trade Description Act 2011, the body corporate would be liable to pay twenty-five thousand fine for the first time and not more than fifty thousand ringgits fine for the second and the subsequent times. If the offender is a natural person, would be liable to ten thousand ringgits fine or one-year imprisonment or both for the first time and twenty thousand ringgits fine or not more than three years' imprisonment or both for the subsequent times. The controller or the deputy controller may delegate their powers under the provisions of the Trade Description Act 2011 to the assistant controller but this does not stop the controller or the deputy controller to exercise their powers; at any stage; under the provisions of the Trade Description Act 2011.

The money paid by the offender under the provisions of the Trade Description Act 2011 would be compounded by the controller on the written request of the public prosecutor and would be submitted to the federal consolidated fund. The principal is responsible of the offence committed by his agent or his servant if they commit an offence while exercising the due course of employment except if there is a reasonable cause to believe that the offence has been committed without the consent of the principal.<sup>65</sup>

The director, chief executive officer, chief operating officer, secretary of the corporation or other similar designated officers of the body corporate are responsible for the offences committed by the body corporate except if the offence committed by the body corporate has been done without their knowledge, consent and connivance and they have taken the necessary precautions to stop the commission of the offence. The controller may give some money of the fine to the person; on the order of the court of law, but in no case, more than one half of the total money of the fine; who gave an information against the offender which leads the offender to the conviction.<sup>66</sup>

Article 61 of the TRIPS deals with the criminal enforcement of the trademark in member states. It states that a useful criminal procedure should be adopted by the member states to deter the infringers, counterfeiters and pirates from doing wrongful acts. It is convenient to say that the criminal settlement of the trademark dispute in Malaysia under the Trade Description Act 2011 is sufficient enough to protect the Intellectual Property rights of the trademark owner, but it is not exhaustive to deter enough the infringer to prevent the further infringement of the trademark in Malaysia. Useful steps should have been taken to deter the infringers from the subsequent infringements. The criminal remedies include the

imprisonment, fine, destruction, seizure and forfeiture of the infringed material.<sup>67</sup>

### Administrative procedure

The administrative procedure for the settlement of the trademark dispute in Malaysia is either before the registrar of the trademark; under the Trademark Act 1976 and the Trademark Regulations 1997; or before the Customs Authority under the Customs Act 1967 for the seizure of the infringed goods from import and export; to provide the time to the parties to settle their trademark dispute before the court of law.

The opposing party may apply before the registrar against the registration application of the trademark through the written notice consisted of the grounds of opposition following a counter statement from the applicant of the registration of the trademark. The registrar is required to hear both the parties and take evidences from them, prior to announce his decision on merits of the case and that decision of the registrar is appealable before the court of law. The registrar may summons witnesses or summons for the production of any document, takes evidences from witnesses on oath or award costs. Any person summons by the registrar and does not comply with it is an offender and may be liable to the imprisonment for three months or one thousand ringgits fine or both. If a cost is awarded by the registrar in favor of the aggrieved party, it can be recovered through the court proceeding of default payment. The registrar may not give his verdict on any matter in issue ex-parte without hearing the opposite party as the right of hearing is the fundamental right of every party in proceeding. The registrar may extend the prescribed limitation time period if applied for in a prescribed manner and by submitting the prescribed fee but if the prescribed time period has expired due to the negligence of the trademark office or due to the circumstances beyond the control of the person, the registrar is duty bound to extend the limitation time period.<sup>68</sup>

It is pertinent to mention here that the administrative procedure is mentioned in article 49 of the TRIPS, which states that all administrative authorities; who conduct a give any civil remedy. In civil judicial proceeding, there is no punishment of imprisonment, there is only damages, compensation, remuneration and the destruction of goods, articles and material. The applicant may be required to pay the indemnification to the defendant, if there is no infringement, and may also be required to pay the expenses of the attorney's fee but this does not apply to the public authorities and officials who did so; in good faith and in the course of the administration of law.

<sup>64</sup> Sections 39 to 55, *ibid*.

<sup>65</sup> Sections 56, 58, 59, 61, 63 & 64, *ibid*.

<sup>66</sup> Sections 65 & 66, *ibid*.

<sup>67</sup> Article 61, (1994). The Agreement on Trade Related Aspects of Intellectual Property Rights. World Trade Organization.

<sup>68</sup> Section 75 to 78, (1976). The Trade Marks Act. Malaysia.

## Border measures

One mode of the administrative procedure is the border measures, according to which, if any counterfeited trademark is about to be imported in Malaysia, the registered trademark owner or his agent may inform the registrar; through a written application; and provide the documented evidence and relevant information with the payment of the prescribed fee. Upon receiving the application, the registrar may notify the authorized officer to prohibit the import of the counterfeiting goods and seize and detain them. The approval letter by the registrar upon the application of the owner of the trademark would remain intact for sixty days unless withdrawn by the applicant. The registrar may require the applicant to deposit the security to prevent abuse and to protect the importer as well as to pay compensation or to reimburse the expenses likely to incur on the seizure of the counterfeiting goods. The seized goods would be stored at a secured place; by the authorized officer; and he is liable to inform the registrar regarding it.

An authorized officer; for the implementation of the border measures; is the custom officer under the Customs Act 1967 or any public officer appointed by the minister to work in the Intellectual Property Corporation of Malaysia. The authorize office would issue a notice to the importer, registrar and the registered trademark owner which precludes that if within a prescribed time, the applicant does not start the legal proceeding against the counterfeiter, the authorized officer would release the goods. The time period may be extended by the request of the applicant within two working days. The authorized officer may give permission to the applicant or to the importer to inspect the seized goods, if they give surety that they would provide a sample to the registrar as well as they would not damage the seized goods. The seized goods may be forfeited and disposed-off before the institution of the legal proceeding, if it is consented by the importer and he gives notice to the registrar to that effect. The registrar would issue notices for the release of the seized goods, if the legal proceeding has not been instituted against the importer within a prescribed time period or if the applicant consented for the release of the seized goods. The aggrieved party may apply in the court of law; after release of the seized goods; for the compensation and the court of law may order the applicant to pay to the importer compensation for the damages and the suffering he has faced. The compensation granted to the aggrieved party; if exceeds; is due upon the applicant.

The court of law on the application of the importer may order for the release of the seized goods or may order for the forfeiture of the goods and thereafter for the disposal of the goods.<sup>69</sup> A minister may order for the prohibition of the importation of goods bearing a false trade description

or a false trade indication, to stop them from importation and any person commits or induces the commission of an offence; of a false trade description or a false trade indication; outside the territory of Malaysia from Malaysia is considered an offender under the provisions of the Trade Description Act 2011.<sup>70</sup>

The Paris Convention and the TRIPS contain the comprehensive provisions about the border measures. Articles 9 of the Paris Convention states that imported goods bearing an unlawful trade name or trademark would be seized in all the countries of the union on the request of the public prosecutor, competent authority or an interested party under the domestic legislation. If seizure is not allowed under the domestic legislation, the prohibition on importation would be invoked and if this remedy is also not available any sufficient remedy would be invoked, which is available under the domestic legislation and the country of the union is required to take steps to amend the domestic law as early as possible. Goods would be seized if there is a false indication with respect to the source of the goods and the identity of the producer.<sup>71</sup>

The TRIPS states that an import and export of goods consisted of counterfeiting trademarks or pirated copyright or other intellectual property infringement, may be suspended through the judicial authority, by the administrative authorities, on the application of the right holder. The owner of the registered trademark must provide adequate evidence that shows that the good which is importing is also considered an infringement of intellectual property law in that country. He is also required to submit a detailed description of an infringed goods so the custom authorities may stop the importation. The judicial or the administrative authorities are required to inform the applicant, regarding the acceptance or rejection of his application; within a reasonable time; and they are also required to inform the time period in which they would take action against the infringer. An applicant may be required to submit a security or a surety to protect the defendant or to prevent the abuse. Importer or consignee may be allowed to release material, if no order or proceeding has been successful against him by submitting a security for the right holder in case of infringement and it does not stop the right holder to obtain any other relief available under the law of the land. The notice of the suspension of release of goods would be delivered to both parties. If the execution proceeding has not been initiated by the applicant within 10 working days after the suspension of the importation of goods by the customs authority, the authority is required to release the goods. In certain cases, 10 more days may be given to the applicant to start an execution proceeding, which can be extended to 31 calendar days if the suspension is continued on the

<sup>69</sup> Sections 70C to 70P, *ibid.*

<sup>70</sup> Sections 26 & 27, (2011). The Trade Description Act. Malaysia.

<sup>71</sup> Article 9, (1967). The Paris Convention for the Protection of Industrial Property. World Intellectual Property Organization.

basis of the injunction; ordered by the court of law or by an administration.

The authority may be ordered the applicant to pay the appropriate compensation; because of the wrongful legal proceeding initiated by the applicant; which caused harm; to the owner, importer or consignee. The right holder and the importer have right of inspection of all the imported goods upon which a claim of right holder has been initiated. The custom authority may be required to tell the name and address of consignor, consignee and the importer as well as the quantity of goods; after receiving request from the right holder. All actions related to the suspension of goods would be taken on the request of the right holder but the relevant authorities may take action based on their own initiative in good faith and may require the right holder to provide sufficient information which would help them to take necessary actions and he would be notified for that action. The authorities may be ordered to dispose-off or destruct the infringing goods and in case of counterfeiting trademark the re-exportation would not be allowed without alteration. Application is required in case of goods of small quantity which can be either sent through small consignment or can be carried in a personal luggage.<sup>72</sup>

## CONCLUSION AND RECOMMENDATIONS

Trademark includes a device, brand, heading, label, ticket, name, signature, word, letter, numeral or any combination, a certification mark, an associated mark, trade name, well-known mark and a service mark. The owner of the trademark may apply; before the Intellectual Property Corporation of Malaysia; for the registration of his trademark in Malaysia. The application for the registration of the trademark cannot be accepted if the proposed trademark is contrary to law, deceives or causes confusion, consists offensive matter, against the security and interest of the nation, identical to already registered mark, identical to state official signs or intergovernmental organizations, does not have any distinct character, contrary to morality and public order and deceives the general public at large.

The trademark protection is 10 years in Malaysia under section 32 of the Trademark Act 1976 and renewable for the same time. Article 18 of the TRIPS states that the renewal time of the trademark should be increased for indefinite period thus it is recommended that the renewal time of the trademark protection should be increased to indefinite period as mentioned in article 8 of the TRIPS.

Trademark dispute arises during registration; before the registrar; and after the registration; before the court of a law; and before the concerned administrative authorities. The registration of the trademark can be challenged by

the effected party; due to registration of the identical trademark. The opposing party is required to submit the written notice to the registrar and to the applicant. The applicant is required to give a counter statement, thereafter evidences would be recorded by both sides; before the registrar of the trademark; and the registrar is then required to give a decision; which is appealable before a court of law. The entry of the trademark can be removed from the trademark register, if the proposed corporation does not use the trademark for consecutive 6 months or if the owner does not use the trademark for consecutive 3 years in Malaysia. It is pertinent to mention here that the Paris Convention states that the registrar may expunge the entry from the trademark register if the trademark has not been in use for consecutive 5 years thus it is recommended that the time limit of 3 years should be increased to 5 years; as per the provisions of the Paris Convention.

The member states are required to provide a civil procedure, for the settlement of the trademark dispute. A civil procedure is adopted to obtain the injunctions; to protect the evidence and to prevent the further trademark infringement. The certificate of the trademark registration is a prima facie evidence; in favor of the trademark owner; except if the registration is illegal, obtained through fraud or not of a distinct character. The civil remedies include the damages, compensation, attorney's fee and the generated profit from the infringement as well as the deposing off and destruction of the infringed material as a mere removal of the infringed trademark is not a sufficient remedy.

The owner of the trademark is required to issue a statement; prohibiting the infringer from the use of his registered trademark; and lodge a complaint before the assistant controller and give the details of the infringer, the premises; where the offence is committed or about to be committed; and the offence. The trade description order is required to be obtained; prior to start the criminal procedure in Malaysia; if the apprehension of trademark infringement is with the non-identical mark as the apprehension of the infringement with identical mark does not require the trade description order. The criminal remedies include the imprisonment, fine, destruction, seizure and forfeiture of the infringed material.

The administrative procedure of the trademark dispute settlement is either before the registrar under the Trademark Act 1976 and the Trademark Regulations 1997 or before the customs authority under the Customs Act 1967 for the seizure of the infringed trademark goods, thereafter the parties would be allowed to prove their claim before the court of law.

The infringement does not occur if the person uses the trademark with the consent of the trademark owner or if the use is occurred by the user of his own name or of his business name or of the description of his goods and services in good faith or if the use is necessary in public interest or if the buyer does not have knowledge about the goods he bought.

<sup>72</sup> Articles 51 to 60, (1994). The Agreement on Trade Related Aspects of Intellectual Property Rights. World Trade Organization.

## CONFLICT OF INTERESTS

The authors have not declared any conflict of interests.

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