

TRADE MARKS ACT 1976

(Act 175)

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TRADE MARKS ACT 1976*

(Act 175)

An Act to make better provisions in the law relating to trade marks and for other matters connected therewith.

[1st Sept. 1983]

BE IT ENACTED by the Duli Yang Maha Mulia Seri Paduka Baginda Yang di-Pertuan Agong with the advice and consent of the Dewan Negara and Dewan Rakyat in Parliament assembled, and by the authority of the same, as follows:

PART I PRELIMINARY

1. Short title, commencement and application.

(1) This Act may be cited as the **Trade Marks Act 1976**, and shall come into force on such date as the Minister may, by notification in the *Gazette*, appoint.

(2) This Act shall apply throughout Malaysia.

2. Extent of application.

(1) This Act shall apply to applications for trade marks made after the commencement of this Act and to the registrations of trade marks made on such applications.

(2) Subject to subsection (4) of section 6, this Act shall also apply to trade marks registered under the respective repealed Ordinances. ^[Subs. Act A881]

(3) Notwithstanding their repeal, the repealed Ordinances shall apply to applications for trade marks made before the commencement of this Act and to the registrations of trade marks made on such applications after the commencement of this Act.

3. Interpretation.

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

*As amended by Act A881, A1078.

“assignment” means assignment by act of the parties concerned;

“component regions of Malaysia” means the regions of West Malaysia, Sabah and Sarawak;

[*Ins. Act*
A881]

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

“Court” means the High Court;

[*Ins. Act*
A1078]

“geographical indication” means an indication which identifies any goods as originating in a country or territory or a region or locality in that country or territory, where a given quality, reputation or other characteristic of the goods is essentially attributable to their geographical origin;

[*Ins. Act*
A881]

“in the course of trade”, in relation to the provision of services, means in the course of business;

“limitations” means limitations of the right to the exclusive use of a trade mark given by the registration of the trade mark including limitations of that right as to—

(a) mode of use;

(b) use within a territorial area within Malaysia; or

[*Am. Act*
A881]

(c) use in relation to goods to be exported to a market outside Malaysia or use in relation to services to be provided in a place outside Malaysia;

“mark” includes a device, brand, heading, label, ticket, name, signature, word, letter, numeral or any combination thereof;

[*Ins. Act*
A1078]

“Paris Convention” means the Paris Convention for the Protection of Industrial Property of 20 March, 1883 as revised at Stockholm on 14 July 1967;

“permitted use” in relation to a registered trade mark means the use of the trade mark by a registered user thereof in relation to goods or services with which he is connected in the course of trade and in respect of which the trade mark remains registered and he is registered as a registered user, being use which complies with any conditions or restrictions to which his registration is subject;

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

“prescribed foreign country” means a country declared by the Minister, by order published in the *Gazette*, as having made arrangements with Malaysia for the reciprocal protection of trade marks; [Ins. Act
A881]

“previous registers” means the registers of trade marks kept under the repealed Ordinances;

“Register” means the Register of Trade Marks kept under this Act;

“registered proprietor” in relation to a trade mark means the person for the time being entered in the Register as proprietor of the trade marks;

“registered trade mark” means a trade mark which is actually upon the Register;

“registered user” means a person who is registered as such under Part IX;

“registrable trade mark” means a trade mark which is capable of registration under the provisions of this Act;

“Registrar”, “Deputy Registrar” and “Assistant Registrar” mean respectively the Registrar of Trade Marks, the Deputy Registrar of Trade Marks and the Assistant Registrar of Trade Marks appointed under section 4;

“repealed Ordinances” means the Trade Marks Ordinance 1950, the Trade Marks Ordinance of Sabah and the Trade Marks Ordinance of Sarawak;

“specification” means the designation of goods or services in respect of which a trade mark or a registered user of a trade mark is registered or proposed to be registered; [Ins. Act
A881]

“trade mark” means, except in relation to Part XI, a mark used or proposed to be used in relation to goods or services for the purpose of indicating or so as to indicate a connection in the course of trade between the goods or services and a person having the right either as proprietor or as registered user to use the mark whether with or without an indication of the identity of that person, and means, in relation to Part XI, a mark registrable or registered under the said Part XI;

“transmission” means transmission by operation of law, devolution on the personal representatives of a deceased person and any other mode of transfer not being assignment;

[Ins. Act
A1078]

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

“word” includes an abbreviation of a word.

(2) In this Act—

- (a) references to the use of a mark shall be construed as references to the use of a printed or other visual representation of the mark;
- (b) references to the use of a mark in relation to goods shall be construed as references to the use thereof upon, or in physical or other relation to, goods; and
- (c) references to the use of a mark in relation to services shall be construed as references to the use thereof as a statement or as part of a statement about the availability or performance of services.

[*Ins. Act*
A881]

PART II ADMINISTRATION

4. Registrar, Deputy Registrar and Assistant Registrar.

[*Am. Act*
A881]

(1) The Minister may appoint a person to be the Registrar of Trade Marks who shall, in addition to the powers and functions conferred by this Act, have superintendence over all matters relating to trade marks.

(2) The Minister may appoint such number of Deputy Registrars of Trade Marks as may be necessary for carrying out the provisions of this Act and the Deputy Registrars shall, subject to the control of the Registrar, have all the powers and functions of the Registrar under this Act except the power of delegation referred to in subsection (4).

(3) The Minister may appoint such number of Assistant Registrars of Trade Marks as may be necessary for carrying out the provisions of this Act and the powers and functions of an Assistant Registrar shall be as prescribed by the Minister or delegated by the Registrar pursuant to subsection (4).

(4) The Registrar may in relation to a particular matter or class of matters by writing under his hand delegate all or any of his powers or functions under this Act, except his power of delegation, to an Assistant Registrar so that the delegated powers and functions may be exercised by the Assistant Registrar so delegated but a delegation made under this subsection is revocable at the discretion of the Registrar and does not prevent the exercise of that power or function by the Registrar or Deputy Registrar.

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

4A. Protection of officers.

No action or prosecution shall be brought, instituted or maintained in any Court against—

[*Ins. Act*
A1078]

- (a) the Registrar of Trade Marks;

- (b) a Deputy Registrar of Trade Marks; or
- (c) an Assistant Registrar of Trade Marks,

for any act or omission done in good faith in the performance of his functions and the exercise of his powers under this Act.

5. Central and regional trade marks offices.

(1) For the purposes of this Act there shall be established a Central Trade Marks Office which shall be located at Kuala Lumpur.

(2) In each of the States of Sabah and Sarawak there shall be established one regional trade marks office.

*[Ins. Act
A881]*

(2A) In addition to the regional trade marks office established in the States of Sabah and Sarawak, there may be established such number of trade marks offices as may be necessary for the purposes of this Act.

*[Am. Act
A881]*

(3) A document required or permitted by this Act to be submitted at the Central Trade Marks Office may be submitted at any trade marks office and reference in this Act to the submission at the Central Trade Marks Office includes reference to the submission at a trade marks office.

PART III

THE REGISTER OF TRADE MARKS

6. The Register.

(1) There shall be kept and maintained at the Central Trade Marks Office a Register of Trade Marks which shall contain—

(a) all registered trade marks with the names, addresses and descriptions of their proprietors, notifications of assignments and transmissions, the names, addresses and descriptions of all registered users, disclaimers, conditions, limitations; and

(b) such other matters relating to the trade marks as the Minister may from time to time prescribe.

[Act A1078]

(2) *(Deleted).*

*[Am. Act
A1078]*

(3) The previous registers of trade marks kept under the repealed Ordinances shall be incorporated with and form part of the Register in accordance with the entries in the previous registers immediately before this Act comes into force.

(4) The incorporation of the previous registers into the Register shall have the following effect:

- (a) where a trade mark has been registered and entered in all the previous registers by a proprietor for all three component regions of Malaysia, such a trade mark shall in its incorporation into the Register be deemed to be a registered trade mark in the name of such proprietor under this Act;
- (b) where a trade mark has been registered and entered in any of the previous registers by a proprietor for any one or two of the component regions of Malaysia, such a trade mark shall in its incorporation into the Register be deemed to be a registered trade mark in the name of such proprietor under this Act if on the date on which this Act comes into force—
 - (i) no identical trade mark or trade mark so nearly resembling the first-mentioned trade mark in respect of the same goods or same description of goods as is likely to deceive or cause confusion has been registered and entered in the remaining previous register or registers prior to the date of the coming into force of this Act by a different proprietor or proprietors for any of the remaining component regions of Malaysia; and
 - (ii) no application for the registration of an identical trade mark or trade mark so nearly resembling the first-mentioned trade mark in respect of the same goods or same description of goods as is likely to deceive or cause confusion has been made prior to the date of the coming into force of this Act by another person for any of the remaining component regions of Malaysia or, where it has been made, it is subsequently refused, abandoned or successfully opposed;

- (c) where a trade mark has been registered and entered in any of the previous registers by a proprietor for any one or two of the component regions of Malaysia and an identical trade mark or trade mark so nearly resembling the first-mentioned trade mark in respect of the same goods or same description of goods as is likely to deceive or cause confusion has been registered and entered in any of the previous registers by a different proprietor or proprietors for all or any one of the remaining component regions of Malaysia both the first-mentioned trade mark and the identical trade mark or trade mark so nearly resembling the first-mentioned trade mark in their incorporation into the Register shall be deemed to be registered trade marks in the names of the respective proprietors under this Act subject to concurrent use of the trade marks by their respective proprietors in accordance with subsection (1) of section 20;
- (d) where a trade mark has been registered and entered in any of the previous registers by a proprietor for any one or two of the component regions of Malaysia and only an application or applications for the registration of an identical trade mark or trade mark so nearly resembling the first-mentioned trade mark in respect of the same goods or same description of goods as is likely to deceive or cause confusion has been made prior to the date of the coming into force of this Act by another person for any of the remaining component regions of Malaysia, the first-mentioned trade mark in its incorporation into the Register shall be effective only in respect of the component region or regions of Malaysia in which it was originally registered unless the application or applications has or have been subsequently refused, abandoned or successfully opposed in which case the first-mentioned trade mark shall be deemed to be a registered trade mark in the name of such proprietor under this Act.

(5) Notwithstanding section 30 the date of the entry of a trade mark in any of the previous registers incorporated and forming part of the Register shall be deemed to be the date of the original registration of the trade mark.

7. Notice of trust.

Notice of a trust express, implied or constructive shall not be entered in the Register or be received by the Registrar.

8. Inspection of Register.

(1) The Register shall be open to the inspection of the public at such times as the Minister may by regulations prescribe.

(2) Certified copies or extracts of any entry in the Register sealed with the seal of the Registrar shall be given to any person requiring the same on payment of the prescribed fees.

(3) Certified copies of the Register shall be deposited in any trade marks office for the purpose of facilitating any search to be made by the public at such times as the Minister may by regulations prescribe and no copy or extract of any entry in such copies shall be made or given to any person. *[Am. Act
A881]*

9. False entries in Register.

Every person who—

- (a) makes or causes to be made a false entry in the Register;
- (b) makes or causes to be made a false entry in any certified copy of the Register deposited in a trade marks office; *[Am. Act
A881]*
- (c) makes or causes to be made a false document purporting to be a copy of an entry in the Register;
- (d) produces or tenders or causes to be produced or tendered in evidence any such document knowing such document or any entry therein to be false,

is guilty of an offence and is liable, on conviction, to a fine not exceeding five thousand ringgit or to a term of imprisonment not exceeding five years or to both.

PART IV

REGISTRABLE TRADE MARKS

10. Registrable trade marks.

(1) In order for a trade mark (other than a certification trade mark) to be registrable, it shall contain or consist of at least one of the following particulars: *[Am. Acts
A881,
A1078]*

- (a) the name of an individual, company or firm represented in a special or particular manner;

- (b) the signature of the applicant for registration or of some predecessor in his business;
- (c) an invented word or words;
- (d) a word having no direct reference to the character or quality of the goods or services not being, according to its ordinary meaning, a geographical name or surname; or
- (e) any other distinctive mark.

[Am. Act
A1078]

(2) A name, signature or word which is not described in paragraph (a), (b), (c) or (d) of subsection (1) is not registrable unless it is by evidence shown to be distinctive.

[Ins. Act
A881;
Am. Act
A1078]

(2A) For the purposes of this section, “distinctive”, in relation to the trade mark registered or proposed to be registered in respect of goods or services, means the trade mark must be capable of distinguishing goods or services with which the proprietor of the trade mark is or may be connected in the course of trade from goods or services in the case of which no such connection subsists, either generally or, where the trade mark is registered or proposed to be registered, subject to conditions, amendments, modifications or limitations, in relation to use within the extent of the registration.

[Subs. Act
A1078]

(2B) In determining whether a trade mark is capable of distinguishing as aforesaid, regard may be had to the extent to which—

- (a) the trade mark is inherently capable of distinguishing as aforesaid; and
- (b) by reason of the use of the trade mark or of any other circumstances, the trade mark is in fact capable of distinguishing as aforesaid.

[Subs. Act
A1078]

(3) A trade mark may be registered in the Register in respect of any goods or services.

[Act A1078] **11. (Deleted).**

[Subs. Act
A881]

12. Use by proposed registered user to be considered for the purpose of determining distinctiveness, etc.

(1) Where an application for registration of a trade mark has been made by a person, and before the date of the application the trade mark had been used by a person other than the applicant under the control of and with the consent and authority of the applicant, and where an application is made by the applicant and that other person for the registration of that other person as a registered user of the trade mark immediately after the registration of the trade mark and the Registrar is satisfied that the other person is entitled to be registered as a registered user of the trade mark, the Registrar may, for the purpose of determining whether the trade mark is distinctive of or capable of distinguishing the goods or services of the applicant, treat use of the trade mark by that other person as equivalent to use of the trade mark by the applicant and may make an order that the trade mark is so distinctive or capable of distinguishing.

(2) An order of the Registrar under subsection (1) is subject to appeal to the Court.

(3) Where an order is made under subsection (1), the registration of the trade mark shall cease to have effect if at the expiration of the prescribed period, or such further period not exceeding six months as the Registrar may allow, that other person has not become registered as the registered user of the trade mark.

13. Colour of trade mark.

(1) A trade mark may be limited in whole or in part to one or more specified colours and, in any such case, the fact that the trade mark is so limited shall be taken into consideration for the purpose of determining whether the trade mark is distinctive.

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

14. Prohibition on registration.

(1) A mark or part of a mark shall not be registered as a trade mark—

(a) if the use of which is likely to deceive or cause confusion to the public or would be contrary to law;

(b) if it contains or comprises any scandalous or offensive matter or would otherwise not be entitled to protection by any court of law;

[Ins. Act
A881]

(c) if it contains a matter which in the opinion of the Registrar is or might be prejudicial to the interest or security of the nation;

[Ins. Act
A1078]

(d) if it is identical with or so nearly resembles a mark which is well-known in Malaysia for the same goods or services of another proprietor;

[Ins. Act
A1078]

(e) if it is well-known and registered in Malaysia for goods or services not the same as to those in respect of which registration is applied for:

Provided that the use of the mark in relation to those goods or services would indicate a connection between those goods or services and the proprietor of the well-known mark, and the interests of the proprietor of the well-known mark are likely to be damaged by such use;

[Ins. Act
A1078]

(f) if it contains or consists of a geographical indication with respect to goods not originating in the territory indicated, if use of the indication in the mark for such goods in Malaysia is of such a nature as to mislead the public as to the true place of origin of the goods; or

[Ins. Act
A1078]

(g) if it is a mark for wines which contains or consists of a geographical indication identifying wines, or is a mark for spirits which contains or consists of a geographical indication identifying spirits, not originating in the place indicated by the geographical indication in question.

[Ins. Act
A1078]

(2) Article 6*bis* of the Paris Convention and Article 16 of the TRIPS Agreement shall apply for the purpose of determining whether a trade mark is a well-known trade mark.

[Ins. Act
A1078]

14A. Where registration shall not be refused.

(1) A trade mark shall not be refused registration by virtue of paragraphs (f) and (g) of section 14 if the application for

its registration had been made in good faith, or if it had been used continuously in good faith in the course of trade by the applicant for its registration or his predecessor in title, either—

(a) before the commencement of the Geographical Indications Act 2000; or

(b) before the geographical indication in question is protected in its country of origin.

(2) A trade mark shall not be refused registration by virtue of paragraphs (f) and (g) of section 14 if the geographical indication in question—

- (a) has ceased to be protected; or
- (b) has fallen into disuse,

in its country of origin.

15. Where registration may be refused.

The Registrar shall refuse to accept an application for the registration of a trade mark which contains or consists of any of the following marks or a mark so nearly resembling any of those marks as is likely to be taken for that mark:

- (a) the word or words “Patent”, “Patented”, “By Royal Letters Patent”, “Registered”, “Registered Design” and “Copyright” or a word or words to the like effect in any language whatsoever; or
- (b) any mark which is specifically declared by the Minister in any regulations made under this Act to be a prohibited mark.

16. Use of name of another person.

Where a person makes an application to register a trade mark which consists of or includes the name or representation of another person whether living or dead the Registrar may require the applicant to furnish him with the consent of that person if living or of the legal representative of that person if deceased before permitting the name or representation to be used as a trade mark. ^[Am. Act A881]

[Subs. Act
A881]

17. Registration for particular goods or services.

(1) A trade mark may be registered in respect of any or all of the goods comprised in a prescribed class of goods or in respect of any or all of the services comprised in a prescribed class of services.

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

18. Disclaimer.

(1) If a trade mark—

(a) contains any part—

(i) which is not the subject of a separate application by the proprietor for registration as a trade mark; or

(ii) which is not separately registered by the proprietor as a trade mark; or

(b) contains matter which is common to the trade or business or is not distinctive,

the Registrar or the Court, in deciding whether the trade mark shall be entered or shall remain in the Register, may require as a condition of its being upon the Register, that the proprietor shall disclaim any right to the exclusive use of any such part or matter, to the exclusive use of which the Registrar or the Court holds him not to be entitled or that the proprietor shall make such other disclaimer as the Registrar or the Court may consider necessary for the purpose of defining his rights under the registration.

(2) No disclaimer on the Register shall affect any right of the proprietor of a trade mark except a right arising out of the registration of the trade mark in respect of which the disclaimer is made.

[Subs. Act
A881]

19. Identical trade marks.

(1) No trade mark shall be registered in respect of any goods or description of goods—

- (a) that is identical with a trade mark belonging to a different proprietor and entered in the Register in respect of the same goods or description of goods or in respect of services that are closely related to those goods; or
- (b) that so nearly resembles such a trade mark as is likely to deceive or cause confusion.

(2) No trade mark shall be registered in respect of any services or description of services—

- (a) that is identical with a trade mark belonging to a different proprietor and entered in the Register in respect of the same services or description of services or in respect of goods that are closely related to those services; or
- (b) that so nearly resembles such a trade mark as is likely to deceive or cause confusion.

(3) Where separate applications are made by different persons to be registered as proprietors respectively of trade marks which are identical or so nearly resembling each other as are likely to deceive or cause confusion and—

- (a) such applications are in respect of the same goods or description of goods; or
- (b) at least one of such applications is in respect of goods and the other or others is or are in respect of services closely related to those goods,

the Registrar may refuse to register any of them until their rights have been determined by the Court or have been settled by agreement in a manner approved by him or by the Court.

(4) Where separate applications are made by different persons to be registered as proprietors respectively of trade marks which are identical or so nearly resembling each other as are likely to deceive or cause confusion and—

- (a) such applications are in respect of the same services or description of services; or
- (b) at least one of such applications is in respect of services and the other or others is or are in respect of goods closely related to those services,

the Registrar may refuse to register any of them until their rights have been determined by the Court or have been settled by agreement in a manner approved by him or by the Court.

20. Concurrent use.

[Subs. Act
A881]

(1) Notwithstanding subsection (1) of section 19, in the case of honest concurrent use or of the circumstances described in paragraph (c) of subsection (4) of section 6 or of other special circumstances which, in the opinion of the Court or the Registrar, make it proper so to do, the Court or the Registrar may permit the registration of more than one proprietor in respect of trade marks which are identical or so nearly resembling each other as are likely to deceive or cause confusion where the registration of the different proprietors—

- (a) is in respect of the same goods or description of goods;
or
- (b) in the case of at least one proprietor, is in respect of goods, and in the case of the other or others, is in respect of services closely related to those goods,

subject to such conditions, amendments, modifications or limitations, if any, as the Court or the Registrar, as the case may be, may think right to impose.

[Ins. Act
A881]

(1A) Notwithstanding subsection (2) of section 19, in the case of honest concurrent use or of other special circumstances which, in the opinion of the Court or the Registrar, make it proper so to do, the Court or the Registrar may permit the registration of more than one proprietor in respect of trade marks which are identical or so nearly resembling each other as are likely to deceive or cause confusion where the registration of the different proprietors—

- (a) is in respect of the same services or description of services; or
- (b) in the case of at least one proprietor, is in respect of services, and in the case of the other or others, is in respect of goods closely related to those services,

subject to such conditions, amendments, modifications or limitations, if any, as the Court or the Registrar, as the case may be, may think right to impose.

(2) The Registrar shall not refuse to register a trade mark which is identical to or so nearly resembling another trade mark in the Register if the applicant of the first-mentioned trade mark or his predecessor in business has continuously used that trade mark from a date before—

- (a) the use of that other trade mark by the registered proprietor or his predecessor in business or by a registered user; or

- (b) the registration of that other trade mark by the registered proprietor or his predecessor in business,

whichever is the earlier.

21. Jointly owned trade mark.

(1) Where two or more persons are interested in a trade mark and none of them is entitled as between himself or the other or others to use the trade mark except—

- (a) on behalf of both or all of them; or
 (b) in relation to goods or services with which both or all of them are connected in the course of trade,

both or all of them may be registered as joint proprietors of the trade mark and this Act has effect in relation to any rights of such persons to the use of the trade mark as if those rights were rights of a single person.

(2) Subject to subsection (1), nothing in this Act authorises the registration of two or more persons who use a trade mark independently, or propose so to use it, as joint proprietors of the trade mark.

22. Association of trade marks.

(1) Where a trade mark which is registered or is the subject of an application for registration in respect of any goods— *[Subs. Act
A881]*

- (a) is identical with another trade mark which is registered or is the subject of an application for registration in the name of the same proprietor in respect of the same goods or description of goods or in respect of services that are closely related to those goods; or
 (b) is so nearly resembling it as is likely to deceive or cause confusion if used by a person other than the proprietor,

the Registrar may at any time require that the trade marks be entered on the Register as associated trade marks.

*[Ins. Act
A881]*

(1A) Where a trade mark which is registered or is the subject of an application for registration in respect of any services—

- (a) is identical with another trade mark which is registered or is the subject of an application for registration in the name of the same proprietor in respect of the same services or description of services or in respect of goods that are closely related to those services; or
 (b) is so nearly resembling it as is likely to deceive or cause confusion if used by a person other than the proprietor,

the Registrar may at any time require that the trade marks be entered on the Register as associated trade marks.

(2) On application made in the prescribed manner by the registered proprietor of two or more associated trade marks the Registrar may dissolve the association as respects any of them if he is satisfied that there would be no likelihood of deception or confusion being caused if that trade mark were used by another person in relation to any of the goods or services in respect of which it is registered and may amend the Register accordingly.

(3) A decision of the Registrar under subsection (2) is subject to appeal to the Court.

23. Assignment of associated trade marks.

(1) Associated trade marks shall be assignable or transmissible only as a whole and not separately but they shall for all other purposes be deemed to have been registered as separate trade marks.

(2) Where under this Act use of a registered trade mark is required to be proved for any purpose, the Court or the Registrar may, if and so far as it or he shall think right, accept use of an associated trade mark or of the trade mark with additions and alterations not substantially affecting its identity as an equivalent for such use.

(3) The foregoing provisions apply in relation to proof of use of any registered trade mark and not in relation only to proof of use of a trade mark which is one of two or more associated trade marks.

24. Series of trade marks.

(1) Where several trade marks in respect of the same goods or description of goods in a single class or in respect of the same services or description of services in a single class resemble each other in material particulars but differ in respect of— [Am. Act 1981]

(a) statements or representations as to the goods or services in respect of which the trade marks are used or proposed to be used;

(b) statements or representations as to number, price, quality or names of places;

(c) other matter which is not distinctive and does not substantially affect the identity of the trade marks; or

(d) colour,

and a person who claims to be the proprietor thereof seeks to register the trade marks, the trade marks may be registered as a series in one registration.

(2) All trade marks registered in a series shall be deemed to be and shall be registered as associated trade marks.

PART V
APPLICATION FOR REGISTRATION

25. Registration.

(1) Any person claiming to be the proprietor of a trade mark used or proposed to be used by him may make application to the Registrar for the registration of that mark in the Register in the prescribed manner. *[Am. Act
A1078]*

*[Am. Act
A881]* (2) An application shall not be made in respect of goods or services comprised in more than one class.

(3) Subject to the provisions of this Act, the Registrar may refuse the application or may accept it absolutely or subject to such conditions, amendments, modifications or limitations, if any, as he may think right to impose.

(4) In the case of refusal or conditional acceptance the Registrar shall, if required by the applicant, state in writing the grounds of his decision and the material used by him in arriving at the same.

(5) A decision of the Registrar under subsection (3) is subject to appeal to the Court.

(6) An appeal under this section shall be made in the prescribed manner and the Court shall, if required, hear the applicant and the Registrar, and shall make an order determining whether, and subject to what conditions, amendments, modifications or limitations, if any, the application is to be accepted.

(7) The appeal shall be heard on the material stated by the Registrar to have been used by him in arriving at his decision and no further grounds of objection to the acceptance of the application shall be allowed to be taken by the Registrar other than those so stated except by leave of the Court.

(8) Where any further grounds of objection are taken the applicant shall be entitled to withdraw his application without payment of costs on giving notice in the prescribed manner.

(9) The Registrar or the Court, as the case may be, may at any time, whether before or after acceptance, correct any error in or in connection with the application or may permit the applicant to amend his application upon such terms as he or it may think fit.

(10) Any application submitted and accepted under this section shall notwithstanding any correction or amendment permitted by the Registrar or the Court to be made in such application be deemed to have been made on the date of its original submission.

(11) *(Deleted)*.

[Act A1078]

(12) Without prejudice to subsection (10) where after the acceptance of an application for registration of a trade mark but before the registration of the trade mark the Registrar is satisfied—

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

the Registrar may withdraw the acceptance and proceed as if the application had not been accepted or, in respect only of a trade mark which shall be registered subject to additional or different conditions or limitations, reissue a new acceptance subject to additional or different conditions or limitations. [Am. Act
A881]

26. Application may be accepted where trade mark is to be used by assignee or registered user.

(1) An application for the registration of a trade mark in respect of any goods or services shall not be refused nor shall permission for such registration be withheld on the ground that it appears that the applicant does not use or propose to use the trade mark—

- (a) if the Registrar is satisfied that a body corporate is about to be constituted and that the applicant intends to assign the trade mark to the corporation with a view to the use thereof in relation to those goods by the corporation; or
- (b) if an application has been made for the registration of a person as a registered user of the trade mark, and the Registrar is satisfied that the proprietor intends it to be used by that person in relation to those goods or services and the Registrar is also satisfied that that person will be registered as a registered user thereof immediately after registration of the trade mark. [Am. Act
A881]

(2) The Registrar may, as a condition of the exercise of the power conferred by subsection (1) in favour of the applicant, require him to give security for the costs of any proceedings before him relative to any opposition and, in default of such security being duly given, may treat the application as abandoned.

(3) Where a trade mark is registered in respect of any goods or services under the power conferred by subsection (1), then unless the corporation has been registered as the proprietor of the trade mark in respect of those goods or services within a period of six months, the registration shall cease to have effect in respect thereof at the expiration of that period and the Registrar shall amend the Register accordingly.

27. Advertisement of acceptance of application.

(1) When an application for registration of a trade mark has been accepted whether absolutely or subject to conditions, amendments, modifications or limitations, the Registrar shall, as soon as may be after acceptance, cause the application as accepted to be advertised in the prescribed manner.

*[Subs. Act
A881]*

(2) The advertisement shall set forth all conditions, amendments, modifications and limitations subject to which the application has been accepted except that the Registrar may cause an application for registration of a trade mark to be advertised before acceptance thereof if the considerations in subsection (2B) of section 10 or subsection (1A) of section 11 apply or in any other case where it appears to him that it is expedient by reason of any exceptional circumstances to do so.

(3) Where an application has been advertised under subsection (2) the Registrar may, if he thinks fit, advertise it again when it has been accepted but he shall not be bound to do so.

28. Opposition to registration.

(1) Any person may, within the prescribed time from the date of the advertisement of an application for the registration of a trade mark, give notice to the Registrar and applicant of opposition to the registration.

(2) The notice shall be given in writing in the prescribed manner and shall include a statement of the grounds of opposition.

(3) The applicant shall, within the prescribed time after the receipt of the notice of opposition, send to the Registrar and the opponent a counter-statement, in the prescribed manner, of the grounds for his application, and, if he does not do so, he shall be deemed to have abandoned his application.

*[Subs. Act
A881]*

(3A) If the applicant submits a counter-statement under subsection (3), the opponent and applicant shall file evidence and exhibits in the prescribed manner and within the prescribed time in support of the opposition or the counter-statement, as the case may be, to be adduced in the prescribed manner, and if the opponent or applicant fails to do so, the opposition or application, as the case may be, shall be treated as abandoned. *[Ins. Act
A881]*

(3B) If the applicant files evidence and exhibits under subsection (3A), the opponent may, within the prescribed time, send to the Registrar and applicant evidence in reply to be adduced in the prescribed manner. *[Ins. Act
A881]*

(4) After considering the evidence and exhibits and after giving the applicant and the opponent an opportunity of making written submissions, the Registrar shall decide whether— *[Subs. Act
A881]*

- (a) to refuse to register the trade mark;
- (b) to register the trade mark absolutely; or
- (c) to register the trade mark subject to such conditions, amendments, modifications or limitations as he may think fit.

(5) A decision of the Registrar under subsection (4) is subject to appeal to the Court.

(6) An appeal under this section shall be made in the prescribed manner and the Court shall, if required, hear the parties and the Registrar, and shall make an order determining whether, and subject to what conditions, amendments, modifications or limitations, if any, registration is to be permitted.

(7) On the hearing of an appeal under this section any party may, either in the manner prescribed or by special leave of the Court, bring forward further material for the consideration of the Court but no further grounds of objection to the registration of a trade mark shall be allowed to be taken by the opponent or the Registrar other than those stated by the opponent except by leave of the Court.

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

(9) In any appeal under this section the Court may after hearing the Registrar, permit the trade mark proposed to be registered to be modified in any manner not substantially affecting the identity of the trade mark, but in any such case the trade mark as modified shall be advertised in the prescribed manner before being registered.

[Am. Act
A881]

(10) If a person giving notice of opposition or an applicant sending a counter-statement after receipt of such a notice, or an appellant, neither resides nor carries on business in Malaysia, the Registrar or the Court may require him to give security for costs of the proceedings relative to the opposition, application or appeal, as the case may be, and in default of such security being duly given, may treat the opposition, application, or appeal, as the case may be, as abandoned.

29. Non-completion of registration.

[Am. Act
A881]

(1) When an application for registration of a trade mark is not completed within twelve months from the date of the application by reason of default on the part of the applicant, the Registrar may, after giving notice in writing of the non-completion to the applicant in the prescribed manner, treat the application as abandoned unless it is completed within the time specified in that behalf in the notice.

[Am. Act
A881]

(2) Where an appeal under any of the provisions of this Act has been instituted in respect of an application for registration of a trade mark, the Registrar shall not give notice of non-completion of the application until the expiration of three months after the determination of the appeal or until the expiration of such further time as the Court may allow.

PART VI

REGISTRATION AND EFFECT OF REGISTRATION

30. Registration of trade mark.

(1) When an application for registration of a trade mark in the Register has been accepted and either— [Am. Act
A1078]

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

the Registrar shall, unless the application has been accepted in error, register the trade mark in the Register on payment of the prescribed fees in the name of the proprietor, and the trade mark so registered shall be registered as of the date of application for registration and that date shall be deemed for the purpose of this Act to be the date of registration.

(2) On the registration of a trade mark the Registrar shall issue to the applicant a certificate of the registration of the trade mark in the prescribed form under the seal of the Registrar.

31. Time for registration.

(1) Subject to subsection (2) a trade mark shall not be registered after twelve months from the date of the advertisement of the acceptance of the application for registration of the trade mark.

- (2) Where the registration of a trade mark is delayed by—
- (a) opposition to the registration of the trade mark;
 - (b) any appeal made to the Court; or
 - (c) an action on the part of the Central Trade Marks office [Ins. Act A881] or any trade marks office,

that trade mark may be registered within such time as directed by the Registrar or the Court respectively.

(3) Where a trade mark has not been registered within the time applicable to it the application shall lapse.

32. Duration of registration.

[Am. Act A881]

(1) The registration of a trade mark shall be for a period of ten years but may be renewed from time to time in accordance with this Act.

(2) Where a trade mark is registered under the repealed Ordinances and is incorporated into and forms part of the Register under this Act the registration of such trade mark unless renewed under this Act shall be for a period equal to the unexpired portion of the period for which the trade mark was registered or renewed under the repealed Ordinances.

(3) The registration of a trade mark may be renewed from time to time in accordance with Part VII.

33. Words used as name or description of article, substance or service.

[Subs. Act
A881]

(1) The registration of a trade mark shall not be deemed to have become invalid by reason only of any use after the date of the registration of a word or words which the trade mark contains or of which it consists as the name or description of an article, a substance or a service.

(2) If it is proved either—

(a) that there is a well known and established use of the word or words as the name or description of the article or substance by a person or persons carrying on a trade therein, not being use in relation to goods connected in the course of trade with the proprietor or a registered user of the trade mark on, in the case of a certification trade mark, goods certified by the proprietor;

(b) that the article or substance was formerly manufactured under a patent, that a period of two years after the cesser of the patent has elapsed and that the word or words is or are the only practicable name or description of the article or substance; or

[Ins. Act
A881]

(c) that there is a well known and established use of the word or words as the name or description of some service by a person or persons providing services which include that service, not being use in relation to services the provision of which the proprietor or registered user of the trade mark is connected to in the course of trade,

subsection (3) shall have effect.

(3) When the facts mentioned in paragraph (a), (b) or (c) of subsection (2) are proved with respect to any word or words then—

(a) if the trade mark consists solely of that word or those words, the registration of the trade mark, so far as regards registration in respect of the article, substance or service in question or of any goods or service of the same description, shall be deemed for the purpose of section 45 to be an entry wrongly remaining in the Register;

(b) if the trade mark contains the word or those words and other matter, the Court or the Registrar in deciding whether the trade mark shall remain on the Register so far as regards registration in respect of the article, substance or service in question or of any goods or service of the same description may in case of a decision in favour of its remaining on the Register require as a condition thereof that the proprietor shall disclaim any right to the exclusive use in relation to that article, substance or service in question or any goods or service of the same description of that word or those words so, however, that no disclaimer on the Register shall affect any right of the proprietor of a trade mark except such as arising out of the registration of the trade mark in respect of which the disclaimer is made; and

(c) for the purposes of any other legal proceedings relating to the trade mark—

(i) if the trade mark consists solely of that word or those words, all rights of the registered proprietor to the exclusive use of the trade mark in relation to the article, substance or service in question or to any goods or service of the same description; or

(ii) if the trade mark contains that word or those words and other matter, all rights of the registered proprietor to the exclusive use of the word or those words, in such relation as in subparagraph (1),

shall be deemed to have ceased on the date at which the use mentioned in paragraph (a) or (c) of subsection (2) first became well known and established or at the expiration of the period of two years mentioned in paragraph (b) of subsection (2).

(4) No word which is the commonly used and accepted name of any single chemical element or single chemical compound, as distinguished from a mixture, shall be registered as a trade mark in respect of a chemical substance or preparation except that this subsection shall not have effect in relation to a word which is used to denote only a brand or make of the element or compound as made by the proprietor or a registered user of the trade mark as distinguished from the element or compound as made by others and in association with a suitable name or description open to the public use.

34. Powers of registered proprietor.

Subject to the provisions of this Act,—

- (a) the person for the time being entered in the Register as registered proprietor of a trade mark shall, subject to any rights appearing from such Register to be vested in any other person, have power to assign the same and give good discharges for any consideration for the assignment;
- (b) any equities in respect of a trade mark may be enforced in like manner as in respect of any other personal property.

35. Rights given by registration.

[Am. Act
A1078]

(1) Subject to the provisions of this Act, the registration of a person as registered proprietor of a trade mark (other than a certification trade mark) in respect of any goods or services shall, if valid, give or be deemed to have been given to that person the exclusive right to the use of the trade mark in relation to those goods or services subject to any conditions, amendments, modifications or limitations entered in the Register.

(2) Where two or more persons are proprietors of registered trade marks which are identical or nearly resembling each other rights of exclusive use of either of those trade marks are not (except so far as their respective rights have been defined by the Registrar or the Court) acquired by any one of those persons as against any other of those persons by registration of the trade mark but each of those persons have the same rights as against other persons (not being registered users) as he would if he were the sole registered proprietor. [Am. Act
A881]

36. Registration *prima facie* evidence of validity.

In all legal proceedings relating to a registered trade mark (including applications under section 45) the fact that a person is registered as proprietor of the trade mark shall be *prima facie* evidence of the validity of the original registration of the trade mark and of all subsequent assignments and transmissions thereof.

37. Registration conclusive.

In all legal proceedings relating to a trade mark registered in the Register (including applications under section 45) the original registration of the trade mark under this Act shall, after the expiration of seven years from the date thereof, be taken to be valid in all respects unless it is shown— [Am. Act
A1078]

- (a) that the original registration was obtained by fraud;
- (b) that the trade mark offends against section 14; or
- (c) that the trade mark was not, at the commencement of the proceedings, distinctive of the goods or services of the registered proprietor,

except that this section shall not apply to a trade mark registered under the repealed Ordinances and incorporated in the Register pursuant to subsection (3) of section 6 until after the expiration of three years from the commencement of this Act.

38. Infringement of a trade mark.

(1) A registered trade mark is infringed by a person who, not being the registered proprietor of the trade mark or registered

user of the trade mark using by way of permitted use, uses a mark which is identical with it or so nearly resembling it as is likely to deceive or cause confusion in the course of trade in relation to goods or services in respect of which the trade mark is registered in such a manner as to render the use of the mark likely to be taken either—

- (a) as being use as a trade mark;
- (b) in a case in which the use is use upon the goods or in physical relation thereto or in an advertising circular, or other advertisement, issued to the public, as importing a reference to a person having the right either as registered proprietor or as registered user to use the trade mark or to goods with which the person is connected in the course of trade; or
- (c) in a case in which the use is use at or near the place where the services are available or performed or in an advertising circular or other advertisement issued to the public, as importing a reference to a person having a right either as registered proprietor or as registered user to use the trade mark or to services with the provision of which the person is connected in the course of trade.

[*Ins. Act*
A881]

[*Act A1078*]

(2) (*Deleted*).

39. Infringement of trade mark by breach of certain restriction.

[Am. Act
A1078]

(1) Where, by notice upon goods or upon the container of goods, the registered proprietor or a registered user of a trade mark registered in the Register makes a statement prohibiting the doing of an act to which this section applies, a person who, being the owner for the time being of the goods, does that act, or authorises it to be done, in relation to the goods in the course of trade or with a view to a dealing with the goods in the course of trade, shall be deemed to infringe the trade mark unless—

(a) at the time when he agreed to buy the goods he acted in good faith without notice that the statement appeared on the goods; or

(b) he became the owner of the goods by virtue of a title derived from another person who had agreed to buy the goods.

(2) The acts to which this section applies are—

(a) the application of the trade mark upon goods after they have suffered alteration to their state, conditions, get-up or packing;

(b) in a case in which the trade mark is upon the goods the alteration, partial removal or partial obliteration of the trade mark, the application of some other trade mark to the goods or the addition to the goods of other matter in writing or otherwise that is likely to injure the reputation of the trade mark; and

(c) in the case in which the trade mark is upon the goods and there is also other matter upon the goods indicating a connection in the course of trade between the registered proprietor or registered user and the goods, the removal or obliteration, whether wholly or partially, of the trade mark unless that other matter is wholly removed or obliterated.

(3) In this section references in relation to goods to the registered proprietor, to a registered user, and to the registration of a trade mark shall be construed, respectively, as references to the registered proprietor of the trade mark, to a registered user of the trade mark and to the registration of the trade mark in respect of those goods and the expression “upon” includes, in relation to goods, a reference to physical relation to the goods.

40. Acts not constituting infringement.

(1) Notwithstanding anything contained in this Act, the following acts do not constitute an infringement of a trade mark—

[Am. Act
A881]

(a) the use in good faith by a person of his own name or the name of his place of business or the name of the place of business of any of his predecessors in business;

(b) the use in good faith by a person of a description of the character or quality of his goods or services, and in the case of goods not being a description that would be likely to be taken as importing any reference as is mentioned in paragraph (b) of subsection (1) of section 38 or paragraph (b) of subsection (3) of section 56;

(c) the use by a person of a trade mark in relation to goods or services in respect of which he has by himself or his predecessors in business, continuously used the trade mark from a date before—

(i) the use of the registered trade mark by the registered proprietor, by his predecessors in business or by a registered user of the trade mark; or

(ii) the registration of the trade mark,
whichever is the earlier;

[Am. Act
A881]

(d) in relation to goods connected in the course of trade with the registered proprietor or a registered user of the trade mark if, as to those goods or a bulk of which they form part, the registered proprietor or the registered user in conforming to the permitted use has applied the trade mark and has not subsequently removed or obliterated it;

[Ins. Act
A881]

(dd) the use by a person of a trade mark in relation to goods or services to which the registered proprietor or registered user has at any time expressly or impliedly consented to;

(e) the use of the trade mark by a person in relation to goods or services adapted to form part of, or to be accessory to, other goods or services in relation to which the trade mark has been used without infringement of the right given or might for the time being be so used, if the use of the trade mark is reasonably necessary in order to indicate that the goods or services are so adapted and neither the purpose nor the effect of the use of trade mark is to indicate otherwise than in accordance with the facts a connection in the course of trade between any person and the goods or services; and

- (f) the use of a trade mark, which is one of two or more registered trade marks which are substantially identical, in exercise of the right to the use of that trade mark given by registration as provided by this Act.

(2) Where a trade mark is registered subject to conditions, amendments, modifications or limitations, the trade mark is not infringed by the use of the trade mark in any manner in relation to goods to be sold or otherwise traded in in a place or in relation to goods to be exported to a market or in relation to services to be provided in a place or in any other circumstances to which having regard to those conditions, amendments, modifications or limitations the registration does not extend. *[Am. Act
A881]*

PART VII RENEWAL OF REGISTRATION

41. Renewal of registration.

(1) The Registrar shall, on application made by the registered proprietor of a trade mark in the prescribed manner and within the prescribed period, renew the registration of the trade mark for a period of ten years from the date of expiration of the original registration, or of the last renewal of registration, as the case may be, and this date shall hereinafter be referred to as “the date of expiration of the last registration”. *[Am. Act
A881]*

(2) At the prescribed time before the date of expiration of the last registration of a trade mark the Registrar shall send notice in the prescribed manner to the registered proprietor of the date of expiration of the last registration and the conditions as to payment of fees upon which the renewal of the registration may be obtained and if such conditions have not been duly complied with, the Registrar may remove the trade mark from the Register subject to such conditions, if any, as to its restoration to the Register as may be prescribed upon payment of fees for restoration. *[Am. Act
A881]*

(3) Notwithstanding subsection (2), the registration of a trade mark shall not be renewed where the application for renewal is made after one year has lapsed from the date of expiration of the last registration. *[Ins. Act
A881]*

42. Status of unrenewed trade mark.

[Am. Act
A881]

Where a trade mark has been removed from the Register for non-payment of the fee for renewal, it shall, nevertheless, for the purpose of an application for the registration of a trade mark within one year from the date of expiration of the last registration be deemed to be a trade mark which is already on the Register except that this section shall not have effect when the Registrar is satisfied either—

- (a) that there has been no use in good faith of the trade mark which has been removed during the two years immediately preceding its removal; or
- (b) that no deception or confusion is likely to arise from the use of the trade mark which is the subject of the application for registration by reason of any previous use of the trade mark which has been removed.

PART VIII

CORRECTION AND RECTIFICATION OF REGISTER

43. Correction of Register.

(1) The Registrar may, on request made in the prescribed manner by the registered proprietor of a trade mark, amend or alter the Register—

- (a) by correcting an error or entering any change in the name, address or description of the registered proprietor of a trade mark;
- (b) by cancelling the entry of a trade mark in the Register;
- (c) by amending the specification of the goods or services in respect of which the trade mark is registered or entering a disclaimer or memorandum relating to the trade mark without extending in any way the rights given by the existing registration of the trade mark,

and may make any consequential amendment or alteration in the certificate of registration and for that purpose may require the certificate of registration to be submitted to him.

(2) The Registrar may on the request made in the prescribed manner by a registered user of a trade mark correct an error or enter any change in the name, address or description of that registered user.

(3) A decision of the Registrar under this section is subject to appeal to the Court.

44. Alterations of registered trade mark.

(1) The registered proprietor of a trade mark may apply in the prescribed manner to the Registrar for leave to add to or alter the trade mark in any manner not substantially affecting the identity thereof and the Registrar may refuse leave or may grant it on such terms and subject to such limitations as he may think fit.

(2) The Registrar may cause an application under this section to be advertised in the prescribed manner in any case where it appears to him that it is expedient to do so, and if within the prescribed time from the date of the advertisement any person gives notice to the Registrar in the prescribed manner of opposition to the application, the Registrar shall, after hearing the parties if so required, decide the matter.

(3) A decision of the Registrar under this section is subject to appeal to the Court.

(4) Where leave under subsection (1) is granted the trade mark, as altered, shall be advertised in the prescribed manner unless it has already been advertised in the form to which it has been altered in an advertisement under subsection (2).

45. Rectification of the Register.

(1) Subject to the provisions of this Act—

(a) the Court may on the application in the prescribed manner of any person aggrieved by the non-insertion in or omission from the Register of any entry or by any entry made in the Register without sufficient cause or by any entry wrongfully remaining in the Register, or by any error or defect in any entry in the Register, make such order for making, expunging or varying such entry as it thinks fit;

- (b) the Court may in any proceeding under this section decide any question that may be necessary or expedient to decide in connection with the rectification of the Register;
- (c) in case of fraud in the registration, assignment or transmission of a registered trade mark or if in his opinion it is in the public interest to do so, the Registrar may himself apply to the Court under this section;
- (d) an order of the Court rectifying the Register shall direct that notice of the rectification be served on the Registrar in the prescribed manner and the Registrar shall upon receipt of the notice rectify the Register accordingly.

[Act A1078] (2) (*Deleted*).

46. Provisions as to non-use of trade mark.

[Am. Act
A881]

(1) Subject to this section and to section 57, the Court may, on application by a person aggrieved, order a trade mark to be removed from the Register in respect of any of the goods or services in respect of which it is registered on the ground—

- (a) that the trade mark was registered without an intention in good faith, on the part of the applicant for registration or, if it was registered under subsection (1) of section 26, on the part of the body corporate or registered user concerned, to use the trade mark in relation to those goods or services and that there has in fact been no use in good faith of the trade mark in relation to those goods or services by the registered proprietor or registered user of the trade mark for the time being up to the date one month before the date of the application; or
- (b) that up to one month before the date of the application a continuous period of not less than three years had elapsed during which the trade mark was a registered trade mark and during which there was no use in good faith of the trade mark in relation to those goods or services by the registered proprietor or registered user of the trade mark for the time being.

(2) Except where an applicant has been permitted under section 20 to register an identical or a nearly resembling trade mark in respect of the goods or services to which the application relates or the Court is of the opinion that the applicant can properly be permitted to register the trade mark, the Court may refuse an application made under subsection (1)—

[Subs. Act
A881]

- (a) in relation to any goods, if there has been, before the relevant date or during the relevant period, as the case may be, use in good faith of the trade mark by the registered proprietor of the trade mark for the time being in relation to goods of the same description, being goods in respect of which the trade mark is registered; and
- (b) in relation to any services, if there has been, before the relevant date or during the relevant period, as the case may be, use in good faith of the trade mark by the registered proprietor of the trade mark for the time being in relation to services of the same description, being services in respect of which the trade mark is registered.

(3) Where in relation to goods in respect of which a trade mark is registered—

- (a) the matters referred to in paragraph (b) of subsection (1) are shown as far as regards failure to use the trade mark in relation to goods to be sold or otherwise traded in in a particular place in Malaysia (otherwise than for export from Malaysia) or in relation to goods to be exported to a particular market outside Malaysia; and
- (b) a person has been permitted under section 20 to register an identical or nearly resembling trade mark in respect of those goods under a registration extending to the use in relation to goods to be sold or otherwise traded in in that place (otherwise than for export from Malaysia) or in relation to goods to be exported to that market, or the Court is of the opinion that that person might properly be permitted to register the trade mark,

[Am. Act
A881]

the Court may, on application by that person, direct that the registration of the first-mentioned trade mark shall be subject to such conditions, amendments, modifications or limitations as the Court thinks proper for securing that that registration shall cease to extend to use of the trade mark in relation to goods to be sold or otherwise traded in in that place (otherwise than for export from Malaysia) or in relation to goods to be exported to that market.

[Am. Act
A881]

*[Ins. Act
A881]*

(3A) Where in relation to services in respect of which a trade mark is registered—

- (a) the matters referred to in paragraph (b) of subsection (1) are shown as far as regards failure to use the trade mark in relation to services provided in a particular place in Malaysia; and
- (b) a person has been permitted under section 20 to register an identical or a nearly resembling trade mark in respect of those services under a registration extending to the use in relation to services provided in that place, or the Court is of the opinion that that person might properly be permitted to register the trade mark,

the Court may, on application by that person, direct that the registration of the first-mentioned trade mark shall be subject to such conditions, amendments, modifications or limitations as the Court thinks proper for securing that that registration shall cease to extend to use of the trade mark in relation to services provided in that place.

(4) An applicant is not entitled to rely for the purpose of paragraph (b) of subsection (1) or for the purpose of subsection (3) or (3A) on any failure to use a trade mark if failure is shown to have been due to special circumstances in the trade and not to an intention not to use or to abandon the trade mark in relation to the goods to which the application relates.

47. Registration of assignment.

(1) Where a person becomes entitled by assignment or transmission to a registered trade mark he shall make application to the Registrar to register his title and the Registrar shall, on receipt of the application and proof of title to his satisfaction, register that person as the proprietor of the trade mark in respect of the goods or services in respect of which the assignment or transmission has effect and cause particulars of the assignment or transmission to be entered in the Register.

(2) A decision of the Registrar under subsection (1) is subject to appeal to the Court.

(3) Except in the case of an appeal under this section or of an application under section 45 a document or instrument in respect of which no entry has been made in the Register in accordance with subsection (1) shall not, unless the Court otherwise directs, be admissible in evidence in Court to prove title to a registered trade mark.

PART IX
REGISTERED USER

48. Registered users.

(1) Subject to the provisions of this section, where the registered proprietor of a trade mark grants, by lawful contract, a right to any person to use the trade mark for all or any of the goods or services in respect of which the trade mark is registered, that person may be entered on the Register as a registered user of the said trade mark whether with or without any conditions or restrictions, provided that it shall be a condition of any such registration that the registered proprietor shall retain and exercise control over the use of the trade mark and over the quality of the goods or services provided by the registered user in connection with that trade mark. [Subs. Act
A881]

(2) Where it is proposed that a person shall be registered as a registered user of a trade mark, the registered proprietor shall submit an application to the Registrar for the registration of that person as a registered user of the trade mark and such application shall be accompanied by the prescribed fee and the following information:

- (a) the representation of the registered trade mark;
- (b) the names, addresses, and addresses for service of the parties;
- (c) the goods or services in respect of which the registration is proposed;
- (d) any conditions or restrictions proposed with respect to the characteristics of the goods or services, to the mode or place of permitted use or to any other matter; and
- (e) whether the permitted use is to be for a period or without limit of period, and if for a period, the duration of that period.

(3) The registered proprietor shall furnish the Registrar with such further documents, information or evidence as may be required by the Registrar or any regulations made under this Act.

(4) On receipt of an application for registration of a person as a registered user of a trade mark under subsection (2), the Registrar shall enter on the Register all the particulars required to be provided thereunder.

(5) Where a person has been registered as a registered user of a trade mark, the use of that trade mark by the registered user within the limits of his registration shall be deemed to be use by the registered proprietor of the trade mark to the same extent as the use of the trade mark by the registered user and shall be deemed not to be use by any other person.

(6) The provisions of subsection (5) shall cease to have effect with regard to any registered user of a trade mark—

(a) if the trade mark ceases to be a registered trade mark for any reason;

(b) if the goods or services for which the trade mark is registered are subsequently limited so as to exclude any or all of the goods or services in respect of which the registration of the registered user has been made;

(c) if the registered proprietor ceases to exercise control over the use of the trade mark and over the quality of the goods or services provided by the registered user concerned in relation to that trade mark;

(d) at the date of expiration of the last registration of the trade mark unless a fresh application under subsection

(2) accompanies any application for renewal of the registration of that trade mark;

(e) at the date of any assignment or transmission of the registered trade mark, unless and until the devolution of title is recorded on the Register in accordance with the provisions of this Act and the subsequent proprietor of the registered trade mark makes a fresh application under subsection (2).

(7) If the registered proprietor of a trade mark fails to exercise any of the rights conferred on him by his registration to the prejudice of any registered user of that trade mark, the registered user may apply to the Court for such relief as the Court may consider just, including rectification of the Register by ordering that the registered user be recorded as the registered proprietor of the trade mark, and in any case where use of the trade mark by any person entitled to use it would be likely to deceive or cause confusion, the Court may order that the trade mark shall be removed from the Register, notwithstanding the provisions of section 37.

(8) The provisions of section 62 shall apply to any proceedings under subsection (7) that might lead to any alteration or rectification of the Register.

49. Powers to vary, extend or cancel registration of a registered user.

(1) Without prejudice to section 45, the registration of a person as a registered user—

(a) may be varied by the Registrar on the written application in the prescribed manner of the registered proprietor with respect to the goods or services for which or with respect to any conditions or restrictions subject to which the registration has effect;

(b) may be extended by the Registrar on the application in writing of the registered proprietor for such period as the Registrar thinks fit;

[Subs. Act
A881]

(c) may be cancelled by the Registrar on the application of the registered proprietor.

(2) The Registrar may at any time cancel the registration of a person as a registered user of a trade mark for any goods or services in respect of which the trade mark is no longer registered.

[Ins. Act
A881]

(3) Any decision of the Registrar under subsection (1) or (2) is subject to appeal to the Court.

[Act A881]

50. (Deleted).

51. Infringement proceeding.

(1) Subject to any agreement subsisting between the registered user of a trade mark and the registered proprietor of the trade mark, the registered user is entitled to call upon the registered proprietor to take proceedings for infringement of the trade mark, and if the registered proprietor refuses or neglects to do so within two months after being so called upon, the registered user may institute proceedings for infringement in his own name as if he were the registered proprietor and shall make the registered proprietor a defendant.

(2) A registered proprietor so added as a defendant is not liable for costs unless he enters an appearance and takes part in the proceedings.

52. Registered user not to assign.

This Part does not confer on the registered user of a trade mark an assignable or transmissible right to the use of that trade mark.

[Act A881]

53. (Deleted).

[Act A881]

54. (Deleted).

PART X
ASSIGNMENT OF TRADE MARKS

55. Assignment and transmission of trade marks.

(1) Subject to this section, a registered trade mark shall be

assignable and transmissible with or without the goodwill of the business concerned in the goods or services in respect of which the trade mark is registered or in part of the goods or services.

(1A) Subsection (1) shall have effect in the case of an unregistered trade mark used in relation to any goods or services as it has effect in the case of a registered trade mark registered in respect of any goods or services, if at the time of the assignment or transmission of the unregistered trade mark it is or was used in the same business as a registered trade mark, and if it is or was assigned or transmitted at the same time and to the same person as that registered trade mark and in respect of goods or services all of which are goods or services in relation to which the unregistered trade mark is or was used in that business and in respect of which that registered trade mark is or was assigned or transmitted. *[Ins. Act
A881]*

(2) Notwithstanding subsection (1), an assignment of a registered trade mark without goodwill whether before or after the commencement of this Act is invalid if the trade mark has not at any time before the assignment been in use in good faith in Malaysia by the assignor or his predecessor in title except that this subsection does not apply where—

- (a) the trade mark was registered with the intention that it shall be assignable to a body corporate yet to be formed and the trade mark has been assigned; or
- (b) the trade mark was registered with the intention that a person shall be permitted to use it as a registered user and such registered user has been registered in respect of the trade mark within six months after the registration of the trade mark and has used that trade mark within that period.

(3) Notwithstanding subsections (1) and (1A), a trade mark shall be deemed not to be assignable or transmissible if, as a result of the assignment or transmission, whether under common law or by registration, more than one of the persons concerned would have exclusive rights to the use of an identical trade mark or to the use of trade marks so nearly resembling each other as are likely to deceive or cause confusion. *[Subs. Act
A881]*

(4) Where an application is made in the prescribed manner by the registered proprietor of a trade mark who proposes to assign it or by a person who claims that a trade mark has been transmitted to him or to a predecessor in title of his since the commencement of this Act, the Registrar, if he is satisfied that in all circumstances the use of the trade marks in exercise of the said rights would not be contrary to the public interest, may in writing approve the assignment or transmission and an assignment or transmission so approved shall not be deemed to be or to have been invalid under this section but this provision shall not have effect unless application for the registration under section 47 of the title of the person becoming entitled is made within six months from the date on which the approval is given or, in the case of a transmission, was made before that date.

[Subs. Act
A881]

(5) Where an assignment in respect of any goods or services of a trade mark which is at the time of the assignment used in a business in those goods or services is made otherwise than in connection with the goodwill of that business, the assignment shall not be deemed to have taken effect unless the assignment has been advertised in the prescribed manner and the application for the assignment without goodwill, accompanied by the advertisement, has been sent to the Registrar.

[Act A881]

(6) *(Deleted).*

(7) A decision of the Registrar under this section is subject to appeal to the Court.

PART XI

CERTIFICATION TRADE MARKS

56. Certification trade marks.

[Am. Act
A1078]

(1) A mark must be capable, in relation to any goods or services, of distinguishing in the course of trade goods or services certified by any person in respect of origin, material, mode of manufacture, quality, accuracy, or other characteristic, from goods or services not so certified shall be registrable as a certification trade mark in the Register in respect of those goods or services in the name of that person as proprietor thereof except that a mark shall not be so registrable in the name of

a person who carries on a trade in goods or services of the kind certified.

(2) In determining whether a mark is capable of distinguishing, the Registrar may have regard to the extent to which— [Subs. Act
A1078]

(a) the mark is inherently capable of distinguishing in relation to the goods or services in question; and

(b) by reason of the use of the mark or any other circumstances, the mark is in fact capable of distinguishing in relation to the goods or services in question.

(3) Subject to paragraphs (a) and (b) of section 37, paragraphs (a) to (c) of subsection (1) of section 40 and this Part, the registration of a person as registered proprietor of a certification trade mark in respect of any goods shall, if valid, give to that person the exclusive right to the use of the trade mark in relation to those goods, and without prejudice to the generality of the foregoing words, that right shall be deemed to be infringed by any person who, not being the registered proprietor of the trade mark or a person authorised by him under the rules in that behalf using it in accordance therewith, uses a mark identical with it or so nearly resembling it as is likely to deceive or cause confusion, in the course of trade, in relation to any goods in respect of which it is registered and in such manner as to render the use of the mark likely to be taken either—

(a) as being use as a trade mark;

(b) in the case in which the use is use upon the goods or services or in physical relation thereto or in an advertising circular, or other advertisement issued to the public, as importing a reference to some person having the right either as registered proprietor or by his authorisation under the relevant rules to use the trade mark or to goods or services certified by the registered proprietor; or

(c) in a case in which the use is use at or near the place where the services are available or performed or in an advertising circular or other advertisement issued to the public, as importing a reference to a person having a right either as proprietor or as a registered user to use the trade mark or to services with the provision of which such person is connected in the course of trade. *[Ins. Act
A881]*

*[Am. Act
A881]*

(4) The right to the use of a certification trade mark given by registration shall be subject to any conditions, amendments, modifications or limitations entered on the Register and shall not be deemed to be infringed by the use of any such mark in any mode, in relation to goods to be sold or otherwise traded in in any place, in relation to goods to be exported to any market, in relation to services to be provided in a place or in any circumstances to which having regard to any such conditions, amendments, modifications or limitations, the registration does not extend.

(5) The right to the use of a certification trade mark given by registration shall not be deemed to be infringed by the use of any such mark by a person—

(a) in relation to goods certified by the registered proprietor of the trade mark if, as to those goods or a bulk of which they form part, the proprietor or another in accordance with his authorisation under the relevant rules has applied the trade mark and has not subsequently removed or obliterated it;

[Ins. Act
A881]

(aa) where the registered proprietor has at any time expressly or impliedly consented to the use of the trade mark; or

(b) in relation to goods or services adapted to form part of, or to be accessory to, other goods or services in relation to which the trade mark has been used without infringement of the right given or might for the time being be so used, if the use of the mark is reasonably necessary in order to indicate that the goods or services are so adapted and neither the purpose nor the effect of the use of the mark is to indicate otherwise than in accordance with the fact that the goods or services are certified by the registered proprietor,

except that paragraph (a) shall not have effect in the case of use consisting of the application of any such mark to any goods or services notwithstanding that they are such goods or services as are mentioned in that paragraph, if such application is contrary to the relevant rules.

(6) Where a certification trade mark is one of two or more registered trade marks which are identical or nearly resembling each other, the use of any of those trade marks in exercise of the right to the use of that trade mark given by registration shall not be deemed to be an infringement of the right so given to the use of any other of those trade marks.

(7) An application for the registration of a trade mark under this section must be made to the Registrar in writing in the prescribed manner by the person who proposes to be registered as the proprietor thereof.

(8) The provisions of subsections (2) to (8) and subsection (10) of section 25 shall have effect in relation to an application under this section as they have effect in relation to an application under subsection (1) of that section. [Am. Act
A881]

(9) In dealing with an application under this section the Registrar shall have regard to the like considerations, as far as relevant, as if the application were an application under section 25 and to any other considerations relevant to applications under this section, including the desirability of securing that a certification trade mark shall comprise some indication that it is such a trade mark.

(10) An applicant for the registration of a trade mark under this section shall transmit to the Registrar draft rules for governing the use thereof, which shall include provisions as to the cases in which the proprietor is to certify goods or services and to authorise the use of the trade mark and may contain any other provisions that the Registrar may require or permit to be inserted therein (including provisions conferring a right of appeal to the Registrar against any refusal of the proprietor to certify goods or services or to authorise the use of the trade mark in accordance with the rules) and such rules, if approved, shall be deposited with the Registrar and shall be open to inspection in like manner as the Register.

(11) The Registrar shall consider the application with regard to the following matters, that is to say—

- (a) whether the applicant is competent to certify the goods or services in respect of which the mark is to be registered;
 - (b) whether the draft rules are satisfactory; and
 - (c) whether in all the circumstances the registrations applied for would be to the public advantage,
- and may either—
- (i) refuse to accept the application; or
 - (ii) accept the application and approve the rules, either without modification and unconditionally or subject to any conditions, amendments, modifications or limitations of the application or of the rules, which he may think requisite,

but except in the case of acceptance and approval without modification and unconditionally, the Registrar shall not decide the matter without giving to the applicant an opportunity of being heard and the Registrar may, at the request of the applicant, consider the application before authorisation to proceed with the application has been given, so that he shall be at liberty to reconsider any matter on which he has given a decision if any amendment or modification is thereafter made in the application or in the draft rules.

(12) Where an application has been accepted the Registrar shall, as soon as may be after such acceptance, cause the application as accepted to be advertised in the prescribed manner and section 28 shall have effect in relation to the registration of the mark as if the application had been an application under section 25 except that, in deciding under section 28, the Registrar shall have regard only to the consideration referred to in subsection (9), and a decision under section 28 in favour of the applicant shall be conditional on the determination in his favour by the Registrar under subsection (13) of any opposition relating to any of the matters referred to in subsection (11).

(13) When notice of opposition is given relating to any of the matters referred to in subsection (11), the Registrar shall, after hearing the parties, if so required, and considering any evidence, decide whether, and subject to what conditions, amendments, modifications or limitations of the application or of the rules, if any, registration is, having regard to those matters, to be permitted.

(14) (a) The rules deposited in respect of a certification trade mark may, on the application of the registered proprietor, be altered by the Registrar.

(b) The Registrar may cause an application for his consent to be advertised in any case where it appears to him that it is expedient to do so, and, where the Registrar causes an application to be advertised, if within the prescribed time from the date of the advertisement any person gives notice to the Registrar of opposition to the application, the Registrar shall not decide the matter without giving the parties an opportunity of being heard.

(15) The Court may, on the application in the prescribed manner of any person aggrieved, or on the application of the Registrar, make such order as it thinks fit for expunging or varying any entry in the Register, relating to a certification trade mark, or for varying the deposited rules, on the ground—

- (a) that the registered proprietor is no longer competent, in the case of any of the goods or services in respect of which the trade mark is registered, to certify the goods or services;
- (b) that the registered proprietor has failed to observe a provision of the deposited rules to be observed on his part;
- (c) that it is no longer to the public advantage that the trade mark should be registered; or
- (d) that it is requisite for the public advantage that, if the trade mark remains registered, the rules should be varied,

but the Court shall not have any jurisdiction to make an order under section 45 on any of these grounds.

(16) The Registrar shall rectify the Register and the deposited rules in such manner as may be requisite for giving effect to an order made under subsection (15).

(17) Notwithstanding anything in subsection (2) of section 63 the Registrar shall not have any jurisdiction to award costs to or against any party on an appeal to him against a refusal of the registered proprietor of certification trade mark to certify goods or services or to authorise the use of the trade mark.

[Act A1073] (18) *(Deleted)*.

(19) The provisions of this Part shall be construed subject to section 19 of the Standards Act 1966.

PART XII DEFENSIVE TRADE MARKS

57. Defensive registration of well known trade marks.

(1) Where a trade mark consisting of an invented word or words has become so well known as regards any goods or services in respect of which it is registered and, in relation to which it has been used, that the use thereof in relation to other goods or services would likely to be taken as indicating a connection in the course of trade between the other goods or services and a person entitled to use the trade mark in relation to the first-mentioned goods or services, then, notwithstanding that the proprietor registered in respect of the first-mentioned goods or services does not use or propose to use the trade mark in relation to the other goods or services and notwithstanding anything in section 46 the trade mark may, on the application in a prescribed manner of the proprietor registered in respect of the first-mentioned goods or services, be registered in his name in respect of the other goods or services as a defensive trade mark and while so registered, shall not be liable to be taken off the Register in respect of other goods or services under section 46.

(2) The registered proprietor of a trade mark may apply for the registration thereof in respect of any goods or services as a defensive trade mark notwithstanding that it is already registered in his name in respect of the goods or services otherwise than as a defensive trade mark, or may apply for the registration thereof in respect of any goods or services otherwise than as a defensive trade mark notwithstanding that it is already registered in his name in respect of the goods or services as a defensive trade mark, in lieu in each case of the existing registration.

58. Defensive trade mark deemed to be associated trade mark.

A trade mark registered as a defensive trade mark and that trade mark as otherwise registered in the name of the same proprietor shall notwithstanding that the respective registrations are in respect of different goods or services be deemed to be, and shall be registered as, associated trade marks.

59. Rectification of Register.

The Registrar may at any time cancel the registration of a defensive trade mark of which there is no longer any registration in the name of the same proprietor otherwise than as a defensive trade mark.

60. Application of Act.

Subject to this Part, this Act applies in relation to the registration of a trade mark as a defensive trade mark and a trade mark registered as a defensive trade mark but it is not necessary for the registered proprietor of a defensive trade mark to prove use of the trade mark for the purpose of obtaining renewal of the registration.

PART XIII**LEGAL PROCEEDINGS, COST AND EVIDENCE****61. Certificate of validity.**

In any legal proceedings in which the validity of a registered trade mark comes into question and is decided in favour of the registered proprietor of the trade mark, the Court may certify to that effect, and if it so certifies then in any subsequent legal proceedings in which the validity of the registration comes into question the registered proprietor of the trade mark on obtaining a final order or judgment in his favour shall have his full costs, charges and expenses as between solicitor and client, unless in the subsequent proceedings the Court certifies that he ought not to have them.

62. Hearing of Registrar.

(1) In any legal proceedings in which the relief sought includes alteration or rectification of the Register, the Registrar shall have the right to appear and be heard, and shall appear if so directed by the Court.

(2) Unless otherwise directed by the Court, the Registrar, in lieu of appearing and being heard, may submit to the Court a statement in writing signed by him, giving particulars of the proceedings before him in relation of the matter in issue or of the grounds of any decision given by him affecting the same or of the practice of the office in like cases, or of such other matters relevant to the issues, and within his knowledge as Registrar, as he thinks fit, and such statement shall be deemed to form part of the evidence in the proceedings.

63. Costs.

(1) In all proceedings before the Court under this Act, the Court may award to any party such costs as it may consider reasonable and the costs as it may consider reasonable and the costs of the Registrar shall be in the discretion of the Court, but the Registrar shall not be ordered to pay the costs of any of the other parties.

(2) In all proceedings before the Registrar under this Act, the Registrar shall have power to award to any party such costs as he may consider reasonable and to direct how and by what parties they are to be paid, and any such order may, by leave of the Court, be enforced in the same manner as a judgment or order of the Court to the same effect.

64. Mode of giving evidence.

(1) In all proceedings before the Registrar under this Act, the evidence shall be given by statutory declaration in the absence of directions to the contrary, but, in any case in which he thinks fit, the Registrar may take evidence *viva voce* in lieu of or in addition to evidence by declaration.

(2) Any such statutory declaration may, in the case of appeal,

be used before the Court in lieu of evidence by affidavit, but if so used, shall have all the incidents and consequences of evidence by affidavit.

(3) In any action or proceedings relating to a trade mark or trade name, the Registrar or the Court, as the case may be, shall admit evidence of the usages of the trade concerned or evidence of business usages in the provision of the services in question, and evidence of any relevant trade marks or trade name or business name or get-up legitimately used by other persons. [Subs. Act
A881]

65. Sealed copies to be evidence.

(1) Printed or written copies or extracts of or from the Register purporting to be certified by the Registrar and sealed with his seal shall be admissible as evidence in any proceedings before any court of law without further proof or production of the originals.

(2) A certificate purporting to be under the hand of the Registrar as to any act which he is authorised under this Act to perform and which he has or has not performed, as the case may be, shall be *prima facie* evidence in any proceedings before any court of law of his having or not having performed the act.

66. Minister may declare documents of foreign state pertaining to trade marks to be admissible. [Am. Act A881]

(1) The Yang di-Pertuan Agong may by order published in the *Gazette* declare any documents or class of documents of a foreign state to be admissible as evidence in any proceedings before a Court if—

- (a) the document is sealed with the seal of the authorised officer or the government of the foreign state and the seal pertains to the trade marks registered in or otherwise recognised by the foreign country or if there is no such seal there is enclosed a certificate signed by the authorised officer to the effect that the document is evidence of the matter contained therein; and
- (b) the foreign state or part thereof has entered into reciprocal arrangements with the Government of Malaysia in respect of the admissibility of the documents.

(2) For the purpose of this section—

“authorised officer” means a person or authority authorised by the government of the foreign state to keep and maintain a register or other record of trade marks under any written law in force in the foreign state relating to trade marks;

“document” means—

(a) a printed or written copy of extract or other record of trade marks kept and maintained in the foreign state under any written law in force in the foreign state relating to trade marks; or

(b) any other document pertaining to any matter or act in relation to trade marks registered in or otherwise recognised by the foreign state as trade marks;

“trade mark” means any device, brand, heading, label, ticket, name, signature, word, letter, numeral or any combination thereof which is used or proposed to be used in relation to goods or services for the purpose of indicating or so as to indicate a connection in the course of trade between the goods or services and a person having the right either as proprietor or as registered user to use the trade mark (in the foreign state) whether with or without any indication of the identity of that person and which is registered or otherwise recognised by the foreign state as a trade mark (under any written law in force in the foreign state relating to trade marks) but does not include the trade marks of another foreign state registered in or otherwise recognised by the foreign state by virtue of a reciprocal arrangement between the foreign state and that other foreign state.

(3) For avoidance of doubt this section shall not be construed to confer recognition of the trade marks of any foreign state for the purpose of registration under this Act but shall be construed only with references to the admissibility of evidence in any proceedings before a Court of the documents of the foreign state.

67. Discretionary power.

In any appeal from the decision of the Registrar under this Act the Court shall have and exercise the same discretionary powers as are conferred upon the Registrar under this Act.

68. *(Deleted)*.

[Act A881]

69. Appeal from Registrar.

Except where expressly given by the provisions of this Act or regulations made thereunder there shall be no appeal from a decision of the Registrar but the Court, in dealing with any question of the rectification of the Register (including all applications under section 45), shall have power to review any decision of the Registrar relating to the entry in question or the correction sought to be made.

PART XIV

CONVENTIONS AND INTERNATIONAL
ARRANGEMENTS

[Am. Act
A881]

70. Right of priority under Convention, etc.

[Subs. Act
A881]

(1) Where any person has applied for protection of any trade mark in a Convention country or prescribed foreign country, such person or his legal representative or assignee, after furnishing a declaration within the prescribed time indicating the date of the application and the country in which it was made, shall in respect of the application for registration of his trade mark, be entitled to a right of priority and such application in Malaysia shall have the same date as the date of the application for protection in the Convention country or prescribed foreign country concerned, as the case may be, subject to the following:

- (a) that the application for registration is made within six months from the date of application for protection in the Convention country or prescribed foreign country concerned, as the case may be; and where an application for protection is made in more than one Convention country or prescribed foreign country, the period of six months referred to herein shall be reckoned from the date on which the earlier or earliest of those applications is made;
- (b) that the applicant shall be either a national or resident of, or a body corporate incorporated under the laws of, the Convention country or prescribed foreign country concerned, as the case may be; and

(c) that nothing in this section shall entitle the proprietor of a trade mark to recover damages for infringements or any happening prior to the date on which the application for protection of the trade mark is made in Malaysia.

(2) Notwithstanding any other provision of this Act, the registration of a trade mark in respect of which a right of priority exists shall not be refused or revoked by reason only of use of the trade mark by some other person in Malaysia during the said period of six months.

(3) The application for the registration of a trade mark in respect of which a right of priority exists—

(a) shall be made and dealt with in the same manner as an ordinary application for registration under this Act; and

(b) shall specify the Convention country or prescribed foreign country, as the case may be, in which the application for protection, or the first such application, was made and the date on which such application for protection was made.

(4) As regards prescribed foreign countries, this section shall apply only for the duration of the period the order continues in force in respect of that country.

(5) For the purposes of this Act, the Minister may, by order published in the *Gazette*, declare a country as having made arrangements with Malaysia for the reciprocal protection of trade marks.

[Ins. Act
A881]

70A. Temporary protection of trade marks in respect of goods or services which are the subject matters of international exhibitions.

(1) Notwithstanding anything in this Act, temporary protection shall be granted to a trade mark in respect of goods or services which are the subject matters of an exhibition at an official or officially recognised international exhibition held in Malaysia or in any Convention country or prescribed foreign country.

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

(3) An applicant for registration of a trade mark whose goods or services are the subject matters of an exhibition at an official or officially recognised international exhibition in Malaysia or in any Convention country or prescribed foreign country and who applies for registration of that mark in Malaysia within six months from the date on which the goods or services first became the subject matters of the exhibition shall, on his request, be deemed to have applied for registration on the date on which the goods or services first became the subject matters of the exhibition.

(4) Evidence that the goods or services bearing the trade mark are the subject matters of an exhibition at an official or officially recognised international exhibition shall be by a certificate issued by the competent authorities of the exhibition.

70B. Protection of well-known trade marks.

[Ins. Act
A1078]

(1) The proprietor of a trade mark which is entitled to protection under the Paris Convention or the TRIPS Agreement as a well-known trade mark is entitled to restrain by injunction the use in Malaysia in the course of trade and without the proprietor's consent of the trade mark which, or the essential part of which, is identical with or nearly resembles the proprietor's mark, in respect of the same goods or services, where the use is likely to deceive or cause confusion.

(2) Nothing in subsection (1) shall affect the continuation of any *bona fide* use of a trade mark begun before the commencement of this Act.

(3) In this section, references to a trade mark which is entitled to protection under Article 6*bis* of the Paris Convention or Article 16 of the TRIPS Agreement as a well-known trade mark are to a mark which is well-known in Malaysia as being the mark of a person whether or not that person carries on business, or has any goodwill, in Malaysia, and references to the proprietor of such a mark shall be construed accordingly.

[Ins. Act
A1078]

PART XIVA
BORDER MEASURES

[Ins. Act
A1078]

70c. Interpretation.

In this Part, unless the context otherwise requires—

“authorised officer” means—

- (a) a proper officer of customs as defined under the Customs Act 1967; or
- (b) any officer appointed by the Minister by notification in the *Gazette* to exercise the powers and perform the duties conferred and imposed on an authorised officer by this Part;

“counterfeit trade mark goods” means any goods, including packaging, bearing without authorisation a trade mark which is identical with or so nearly resembles the trade mark validly registered in respect of such goods, or which cannot be distinguished in its essential aspects from such a trade mark, and which infringes the rights of the proprietor of the trade mark under this Act;

“goods in transit” means goods imported, whether or not landed or transshipped within Malaysia, which are to be carried to another country either by the same or another conveyance;

“import” means to bring or cause to be brought into Malaysia by whatever means;

“retention period”, in relation to seized goods, means—

- (a) the period specified in a notice given under section 70G in respect of the goods; or
- (b) if the period has been extended under section 70G, that period so extended;

“security” means any sum of money in cash;

“seized goods” means goods seized under section 70D.

70D. Restriction on importation of counterfeit trade mark goods. [Ins. Act
A1078]

(1) Any person may submit an application to the Registrar stating—

- (a) that he is the proprietor of a registered trade mark or an agent of the proprietor having the power to submit such application;

- (b) that, at a time and place specified in the application, goods which, in relation to the registered trade mark, are counterfeit trade mark goods are expected to be imported for the purpose of trade; and
- (c) that he objects to such importation.

(2) An application under subsection (1) shall be supported by such documents and information relating to the goods as to enable them to be identified by the authorised officer, and accompanied by such fee as may be prescribed.

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

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

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

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

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

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

[Ins. Act
A1078]

70E. Security.

The Registrar shall, upon giving his approval under section 70D, require the applicant to deposit with the Registrar a security which in the opinion of the Registrar is sufficient to—

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

[Ins. Act
A1078]

70F. Secure storage of seized goods.

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

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

[Ins. Act
A1078]

70G. Notice.

(1) As soon as is reasonably practicable after goods are seized under section 70D, the authorised officer shall give to the Registrar, importer and the applicant, either personally or by registered post, a written notice identifying the goods, stating that they have been seized and the whereabouts of the goods.

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

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

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

(5) Subject to subsection (6), if—

- (a) a request is made in accordance with subsection (4); and
- (b) the Registrar is satisfied that it is reasonable that the request be granted,

the Registrar may extend the initial period.

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

70H. Inspection, release, etc., of seized goods.

[Ins. Act
A1078]

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

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

- (a) return the sample of the seized goods to the Registrar at a specified time that is satisfactory to the Registrar; and
- (b) take reasonable care to prevent damage to the sample.

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

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

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

- (a) damage to any of the seized goods incurred during that inspection; or
- (b) anything done by the applicant or any other person to, or in relation to, a sample removed from the custody of the Registrar or any use made by the applicant or any other person of such a sample.

[*Ins. Act*
A1078]

70i. Forfeiture of seized goods by consent.

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

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

(3) If the importer gives such a notice, the seized goods are forfeited to the Government and shall be disposed of in the manner prescribed by regulations made under this Part.

[*Ins. Act*
A1078]

70j. Compulsory release of seized goods to importer.

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

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

(2) If—

(a) an action for infringement has been instituted in relation to the seized goods; and

(b) at the end of a period of thirty days commencing on the day on which the action for infringement was instituted, there is not in force an order of the Court in which the action was instituted preventing the release of the goods,

the Registrar shall release the goods to the importer.

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

70K. Compensation for failure to take action.

*[Ins. Act
A1078]*

(1) Where goods have been seized pursuant to a notice given under section 70D and the applicant fails to take action for infringement within the retention period, a person aggrieved by such seizure may apply to the Court for an order of compensation against the applicant.

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

70L. Actions for infringement of registered trade mark.

*[Ins. Act
A1078]*

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

(a) order that the seized goods be released to the importer subject to such conditions, if any, as the Court thinks fit;

(b) order that the seized goods be not released to the importer before the end of a specified period; or

(c) order that the seized goods be forfeited to the Government,

depending on the circumstances of the case.

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

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

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

(5) If—

(a) the action is dismissed or discontinued, or if the Court decides that the relevant registered trade mark was not infringed by the importation of the seized goods; and

(b) a defendant to the action for infringement satisfies the Court that he has suffered loss or damage as a result of the seizure of the goods,

the Court may order the applicant to pay compensation in such amount as the Court thinks fit to that defendant.

[Ins. Act
A1078]

70M. Disposal of seized goods ordered to be forfeited.

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

[Ins. Act
A1078]

70N. Insufficient security.

(1) If the reasonable expenses incurred by the Registrar in relation to any action taken by the Registrar under this Part, or taken in accordance with an order of Court under this Part, exceed the amount of security deposited under section 70E, the amount of the excess is a debt due to the Government.

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

[Ins. Act
A1078]

70O. Ex-officio action.

(1) Any authorised officer may detain or suspend the release of goods which, based on *prima facie* evidence that he has acquired, are counterfeit trade mark goods.

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

- (a) shall inform the Registrar, the importer and the proprietor of the trade mark; and
- (b) may at any time seek from the proprietor of the trade mark any information that may assist him to exercise his powers.

(3) Subject to section 70J, an importer may lodge an appeal against the detention of goods or suspension of the release of goods under subsection (1).

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

70P. Regulations relating to border measures.

*[Ins. Act
A1078]*

(1) The Minister may make such regulations as may be necessary or expedient for the purpose of this Part.

(2) Without prejudice to the generality of subsection (1), regulations may be made for—

- (a) prescribing and imposing fees and providing for the manner for collecting such fees;
- (b) prescribing forms and notices;
- (c) providing for the manner for depositing security;
- (d) prescribing anything required to be prescribed under this Part.

PART XV

MISCELLANEOUS

71. Use of trade mark for export trade.

(1) The application in Malaysia of a trade mark to goods to be exported from Malaysia and any other act done in Malaysia in relation to the goods which if done in relation to goods to be sold or otherwise traded in in Malaysia would constitute use of a trade mark in Malaysia shall for the purpose of this Act be deemed to constitute use of the trade mark in relation to those goods.

(2) Subsection (1) shall be deemed to have had effect in relation to an act done before the date of the commencement of this Act as it has effect in relation to an act done after that date, but does not affect a determination of a Court which has been made before that date or the determination of an appeal from a determination so made.

72. Use of trade mark where form of trade changes.

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

73. Preliminary advice by Registrar.

[Am. Act
A1078]

(1) The power to give to a person who proposes to apply for the registration of a trade mark in the Register advice as to whether the trade mark appears to the Registrar *prima facie* to be capable of distinguishing shall be a function of the Registrar under this Act.

(2) Any person who is desirous of obtaining the advice shall make application to the Registrar in the prescribed manner.

[Am. Act
A1078]

(3) Where an application for the registration of a trade mark is made within three months after the Registrar has given advice in the affirmative and the Registrar, after further investigation or consideration, gives notice to the applicant of objection on the ground that the trade mark is not capable of distinguishing the applicant shall be entitled, on giving notice of withdrawal of the application within the prescribed period, to have any fee paid on the filing of the application repaid to him.

74. Powers of Registrar to amend document.

(1) The Registrar may on such terms as to costs as he thinks just whether for the purpose of correcting a clerical error or an obvious mistake, permit the correction of an application for the registration of a trade mark or notice of opposition or other document submitted at any trade marks office.

(2) An amendment of an application shall not be permitted under this section if the amendment would substantially affect the identity of the trade mark as specified in the application before amendment.

(3) A decision of the Registrar under subsection (1) is subject to appeal to the Court.

75. Other powers of Registrar.

(1) The Registrar may, for the purpose of this Act—

(a) summon witnesses;

(b) receive evidence on oath;

(c) require the production of a document or article; and

(d) award costs as against a party to proceedings before him. *[Am. Act
A881]*

(2) Any person who without any lawful excuse fails to comply with any summons, order or direction made by the Registrar under paragraphs (a), (b) and (c) of subsection (1) is deemed to have committed an offence and is liable, on conviction, to a fine not exceeding one thousand ringgit or to a term of imprisonment not exceeding three months or to both.

(3) Costs awarded by the Registrar may in default of payment be recovered in a court of competent jurisdiction as a debt due by the person against whom the costs were accorded to the person in whose favour they were accorded.

76. Exercise of discretionary power.

Where any discretionary power is given to the Registrar by this Act or by any regulations made thereunder, he shall not exercise that power adversely to the applicant for registration or the registered proprietor in question without (if duly required to do so within the prescribed time) giving to the applicant an opportunity of being heard.

77. Extension of time.

*[Subs. Act
A881]*

(1) Where by this Act or any regulations made thereunder, a time is specified within which an act or thing is to be done, the Registrar may, unless otherwise expressly provided or directed by the Court, upon application in the prescribed manner, extend the time either before or after its expiration upon payment of the prescribed fee.

(2) Subsection (1) shall not apply to section 29, subsection (3) of section 31, section 70 and section 70A except where the circumstances mentioned in section 78 apply.

78. Extension of time by reason of error in trade marks office etc.

(1) Where by reason of—

(a) circumstances beyond the control of the person concerned; or

[Am. Act
A881]

(b) an error or action on the part of the Central Trade Marks Office or any trade marks office,

an act in relation to an application for the registration of a trade mark or in proceedings under this Act (not being proceedings in a Court) required to be done within a certain time has not been so done the Registrar may extend the time for doing the act.

(2) The time required for doing an act may be extended under this section although that time has expired.

79. Address for service.

[Subs. Act
A881]

(1) Where an applicant for the registration of a trade mark does not reside or carry on business in Malaysia, he shall give to the Registrar an address for service in Malaysia which shall be the address of his agent, and if he fails to do so, the Registrar may refuse to proceed with the application.

(2) An address for service stated in the application or a notice of opposition shall, for the purposes of the application or notice of opposition, be deemed to be the address of the applicant or opponent, as the case may be, and all documents in relation to the application or notice of opposition may be served by leaving them at, or sending them by post to, the address for service of the applicant or opponent, as the case may be.

(3) An address for service may be changed by notice in writing to the Registrar.

(4) Subject to subsection (1), the registered proprietor of a trade mark shall from time to time notify the Registrar in writing of any change in the Register and the Registrar shall alter the Register accordingly.

(5) The address of the registered proprietor of a trade mark as appearing for the time being in the Register shall for all purposes under this Act be deemed to be the address of the registered proprietor.

80. Agent.*[Subs. Act
A881]*

(1) Where an applicant for registration of a trade mark does not reside or carry on business in Malaysia, he shall appoint an agent to act for him.

(2) Where by this Act any act has to be done by or to any person in connection with a trade mark or proposed trade mark or any procedure relating thereto, the act may, under and in accordance with this Act and any regulations made thereunder or in particular cases by special leave of the Registrar, be done by or to an agent of that person duly authorised in the prescribed manner.

(3) No person, firm or company shall be authorised to act as an agent for the purposes of this Act unless that person is domiciled or resident in Malaysia or the firm or company is constituted under the laws of Malaysia and such person, firm or company carries on business or practice principally in Malaysia.

81. Falsely representing a trade mark as registered.

(1) A person who makes a representation—

- (a) with respect to a mark, not being a registered trade mark, to the effect that it is a registered trade mark;
- (b) with respect to a part of a registered trade mark, not being a part separately registered on a trade mark, to the effect that it is so registered;
- (c) to the effect that a registered trade mark is registered in respect of goods or services in respect of which it is not registered; or
- (d) to the effect that the registration of a trade mark gives a right to the exclusive use of the trade mark in circumstances in which, having regard to conditions or limitations entered on the Register, the registration does not give that right,

is guilty of an offence and is liable, on conviction, to a fine not exceeding five hundred ringgit or to a term of imprisonment not exceeding two months or to both.

(2) For the purpose of this section, the use in Malaysia in relation to a trade mark of the word “registered” or of any other word referring whether expressly or impliedly to registration shall be deemed to import a reference to registration in the Register except—

- (a) where the word is used in physical association with other words delineated in characters at least as large as those in which that word is delineated and indicating that the reference is to registration as a trade mark under the law of a country outside Malaysia being a country under the law of which the registration referred to is in fact in force;
- (b) where the word (being a word other than the word “registered”) is of itself such as to indicate that the reference is to registration as mentioned in paragraph (a); or
- (c) where that word is used in relation to a mark registered as a trade mark under the law of a country outside Malaysia and in relation to goods or services to be exported to that country.

82. Unregistered trade marks.

(1) No person shall be entitled to initiate any action to prevent or to recover damages for the infringement of an unregistered trade mark.

(2) Notwithstanding subsection (1), nothing in this Act shall be deemed to affect the right of action against any person for passing off goods or services as those of another person or the remedies in respect thereof.

83. Regulations.

(1) Subject to the provisions of this Act, the Minister may make regulations for the purpose of carrying into effect the provisions of this Act.

(2) In particular and without prejudice to the generality of subsection (1), such regulations may provide for all or any of the following:

- (a) to regulate the practice (other than that relating to proceedings before the Court or connected therewith) under this Act including service of documents;
- (b) to classify goods or services for the purpose of registration of trade marks;
- (c) to make or require duplication of trade marks or other documents;
- (d) to secure and regulate the publishing and selling or distributing in such manner as the Minister may think fit of copies of trade marks and other documents;
- (e) to prescribe the fees to be paid in respect of any matter or thing required for the purposes of this Act;

*[Subs. Act
A881]*

- (*ea*) to provide for the registration and qualifications of agents; *[Ins. Act A881]*
- (*f*) to regulate generally on matters pertaining to the business of trade marks carried on in any trade marks office whether or not specially prescribed under this Act but so as not to be inconsistent with any of the provisions of this Act.

(3) (*Deleted*). *[Act A881]*

(4) Subject to the provisions of this Act, the Rules Committee constituted under the Courts of Judicature Act 1964, may make rules of court regulating the practice and procedure in relation to proceedings before the Court or connected therewith and the costs of the proceedings.

84. Repeal and saving.

(1) The Trade Marks Ordinance 1950, the Trade Marks Ordinance of Sabah and the Trade Marks Ordinance of Sarawak are hereby repealed.

(2) Notwithstanding the repeal of the Ordinances specified in subsection (1):

- (*a*) any subsidiary legislation made under any of the repealed laws shall insofar as such subsidiary legislation is not inconsistent with the provisions of this Act continue in force and have effect as if it had been made under this Act and may be repealed, extended, varied or amended accordingly;
- (*b*) any appointment made under the repealed laws or subsidiary legislation made thereunder shall continue in force and have effect as if it had been made under this Act unless the Minister otherwise directs;
- (*c*) any certificate issued under any of the repealed laws and is in force immediately prior to the coming into force of this Act shall, subject to the terms, conditions and the period of validity specified in the certificate, continue in force and have the like effect as if it had been issued under this Act and the Registrar may amend, modify, renew, cancel or revoke such certificate in accordance with the powers conferred upon him by the relevant provisions of this Act relating thereto.