

TRADEMARK LEGAL REMEDIES, OFFENCES AND ENFORCEMENT IN MALAYSIA



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TRADEMARK2U
INTELLECTUAL PROPERTY

Welcome to IP seminar

LAWRENCE YIP

Chief Executive Officer

- Adjunct Professor (Lincoln U.C.)
- Trademark, Industrial Design,
Patent Agent
- Advocate & Solicitor (non-practising)
- Bachelor of Law (Bond, Aust.)



 trademark2u.com

1. Trademark Infringement;

2. Remedies for TM infringement actions;

3. Trademark Offences;

4. Corporate responsibilities in TM Offences;

5. Trademark Enforcement Authority.

Based on the Malaysian Trademark Act 2019 & recent authorities.

CIVIL LITIGATION



Trademark Infringement

Based on the Malaysian Trademark Act 2019

Trademark Infringement

S.54 (1) TMA - A person infringes a registered trademark [if he uses](#) a sign which is **identical** with the trademark in relation to **goods or services** which are identical with those for which it is registered proprietor.



Trademark Infringement

S.54(2) TMA – A **person infringes** a registered trademark if, **without the consent** of the proprietor of the TM, **he uses in the course of trade** a sign :-

- (a) That is **identical with the TM** and is used in relation to goods / services similar to those for which the TM is registered; or
- (b) That **is similar to the TM** and is used in relation to goods / services identical or similar to those the trademark is registered.

Resulting in the **likelihood of confusion** on the part of the **public**

 **TRADEMARK
INFRINGEMENT**

Trademark Infringement

S.54(3) TMA – a person uses a sign if he :-

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



Trademark Infringement

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

(h) uses the sign in advertising.



(4) A Person who :-

- (a) Applies a registered trademark to **any material used or intended to be used for labelling** or packaging goods; or
- (b) uses a sign in advertising or on any document described in **para (3)(g)**,

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

Acts not amounting to infringement.

S.55 (1) TMA – a person **does not infringe** a reg. TM when –

(a) he uses in **good faith** –

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

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

(b) He uses in good faith a sign **to indicate** –

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

Acts not amounting to infringement

S.55(2) TMA – A **person does not infringe** a registered TM by **using an unregistered TM** that is **identical or similar** to the registered TM in relation to goods / services identical or similar to those for which the TM is registered if he has, or he and his predecessor in business have, **continuously used in the course of trade** the unregistered TM in relation to those goods or services **from a time before** ---

(a) The **date of registration of the registered trademark**; or

(b) the date the registered proprietor, or a predecessor in business, or a person who was a registered user under the old ACT, **first used the trademark**,

whichever is earlier.



Acts not amounting to infringement

S.55(3) TMA – a person who uses a registered TM **does not infringe** the trademark if such use –

(a) is for a **non-commercial purpose**;

(b) Is for the purpose of **news reporting or news commentary**;

© has at any time **expressly or impliedly been consented** by registered proprietor;

(d) Of a trademark, which is one of two or more registered TMs which are substantially identical, in the exercise of the right to the **use of that trademark given by registration as provided by this Act.**

Acts not amounting to infringement

S.55(4) TMA - a registered TM is not infringed by the use of another registered TM in relation to goods / services for **which the latter is registered.**





TRADEMARK LEGAL REMEDIES

Action for infringement

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



S.56 (2) TMA – The registered proprietor shall have the same right of action in (1) against any person who has performed acts which will make it **likely that an infringement will occur.**

S.56(3) TMA – In an action for an infringement, **the Court may grant relief including the following:**

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

(b) damages;

(C) **an account of profits;** or

(d) the award of such **additional damages** as it considers appropriate in the circumstances by the Court.

S.56(5) TMA – When the Court awards any damages under 3(b), the Court may also make an order under 3(c) for an **account of profits** attributable to the infringement **that have not been taken** into account in computing the damages.



S.56(7) TMA - In any action for infringement of a registered TM where infringement involves the use of a **Counterfeit trademark** in relation to goods or services, the plaintiff shall be entitled, at his election, to:-

- (a) **Damages** and an **account of profits** attributable to the infringement that have not been taken into account in computing the damages;
- (b) **An account of profits**; or
- (c) **Additional damages** as it considers appropriate in the circumstances.



S.56(9) TMA – the registered proprietor shall not recover any relief under (3) for infringements or any **happening prior to the date** on which the application for protection of the **trademark is made and become registered in Malaysia.**

Action for infringement

ORDER FOR ERASURE, ETC OFFENDING SIGN

S.58 (1) where a person is found to have infringed a registered TM, the Court may make an order requiring him –

- (a) To erase, remove or obliterate the offending sign from any infringing goods, materials, etc; or
- (b) If can't erased, to secure the destruction of the infringing goods, materials, etc in question.



DELIVERY UP ORDER

S.59(1) TMA – The Court may grant an order that any infringing goods, materials or articles in the possession of the defendant or before the Court to be delivered up to the Plaintiff.

S.60(1) where infringing goods, materials or articles have been delivered up pursuant to an order under S.59, an application may be made to the Court –

- (a) For an order that they be destroyed or forfeited to such person as the Court may think fit; or
- (b) No order shall be made.

Groundless Threats of Infringement Proceedings

S.61(1) TMA Where a person **threatens another** with proceedings for infringement of a registered TM **other than**:-

- (a) The application of the TM to goods or to material used or intended to be used for labeling or packaging goods;
- (b) The importation of goods to which, or to the packaging of which the TM has been applied; or
- (c) The supply of services under the TM,

Any **aggrieved person** may bring proceedings for relief under this section .



Groundless Threats of Infringement Proceedings

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

(a) a declaration that the threats are unjustifiable;

(b) An injunction against the continuance of the threats; or

© damages in respect of any loss he has sustained by the threats.



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

Groundless Threats of Infringement Proceedings



(4) The plaintiff shall nevertheless be entitled to relief if **he shows** that the registration of trademark **is invalid or liable to be revoked** in a relevant respect.

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

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



TRADEMARK OFFENCES

Based on the Malaysian Trademark Act 2019

Counterfeiting a trademark



S.99 (1) TMA –Any person who **counterfeits** 假冒 a registered trademark by –

(a) making a sign **identical with or similar to** a registered trademark with the **intent to deceive**; or

(b) falsifying a genuine registered trademark 伪造正品注册商标, whether by **alteration, addition, effacement, partial removal or otherwise**,

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

不超过一百万令吉特的罚款或不超过五年的监禁，或两者兼施。

Falsefully applying a registered trademark to goods or services 未授权使用他人注册商标

S.100 (1) TMA –For the purposes of this section and **s.102**, a person falsefully applied a registered trademark to goods or services when –

(a) he applies the trademark or a sign likely to be mistaken for that trademark to the goods or services **without the consent of the registered proprietor** 在未经注册商标拥有者的同意下使用他人的商标; and

(b) in the case of an application to goods, **the goods are not the genuine goods of the registered proprietor or licensee of the trademark.** 商品不是注册商标拥有者或使用被许可人的真正商品。

Falsefully applying a registered trademark to goods or services 未授权使用他人注册商标

S.100 (2) TMA –For the purposes subsection (1), a trademark **shall be deemed to be applied to goods or services** if it is used in-

(a) any **sign or advertisement**; or

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

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

Falsefully applying a registered trademark to goods or services 未授权使用他人注册商标

S.100(3) TMA -

(a) TMA - a sign shall be deemed to be applied to goods if :-

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

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

In (3), (a) “Covering” includes any stopper, glass, bottle, vessel, box, capsule, case, frame or wrapper; and

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



S.100 (4) TMA –Any person who falsely –

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

Body Corporate

Fine : < RM15,000.00 for each of the goods and for a second or subsequent offence, to a Fine <RM30,000.00

Individual

Fine : < RM10,000 for each of the goods or to imprisonment for < three years or to both, and for a second or subsequent offence, to a Fine : < RM20,000 **or to imprisonment for < five years or to both..**

Falsefully applying a registered trademark to goods or services 未授权使用他人注册商标

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

- (i) if the person is a **body corporate, to a fine not exceeding one hundred thousand ringgit**; or
- (ii) if the person is **not a body corporate, to a fine not exceeding seventy thousand ringgit or to imprisonment for a term not exceeding three years or to both.**

Making or possessing of article for committing offence.

S.101 TMA - Any person who—

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

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

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



Importing or selling, etc goods with falsely applied trademark

S.102 TMA - (1) Any person who—

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

any goods to which a registered trademark is falsely applied under section 100, unless he proves that having taken all reasonable precautions against committing an offence under this section,...



Importing or selling, etc goods with falsely applied trademark

S.102(2) TMA – For the purpose of (1)(c), a person having in his **possession three or more of the goods** to which a registered trademark is falsely applied is deemed to have in possession of the goods for the purpose of trade or manufacture.



Importing or selling, etc., goods with falsely applied trademark 进口或销售带有虚假商标的货物

Body Corporate

Fine : < RM15,000 for each of the goods, and for a second or subsequent offence, to a fine < RM30,000

Individual

Fine : < RM10,000.00 for each of the goods or to imprisonment for < three years or to both, and for a second or subsequent offence, to a fine < RM20,000.00 for each of the goods, or to **imprisonment for < five years or to both.**

Corporate Responsibility

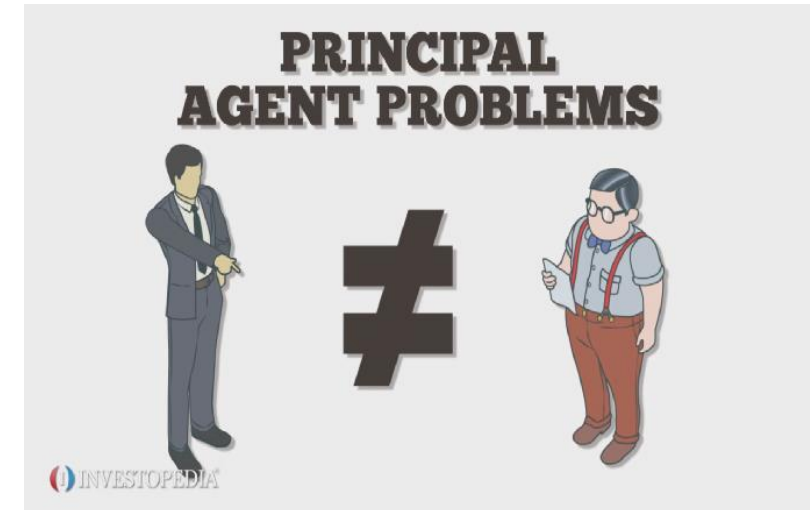


S.137 – Principal liable for acts of servant or agent

Where the **servant or agent of a person** commits an offence or does anything or omits to do anything which if done or omitted to be done by that person **would constitute an offence** under this Act,

that person shall, notwithstanding that he has no knowledge of the offence, **be deemed to be guilty of the offence** and shall be liable to punishment for the offence **unless he proves that** ---

- (a) the act or omission complained of **was not within the ordinary scope of the employment of the servant or of the agency of the agent**; or
- (b) the act**was done without his consent** and that he exercised all such diligence to prevent the commission or omission as he ought to have exercised having regard to all circumstances of the case.

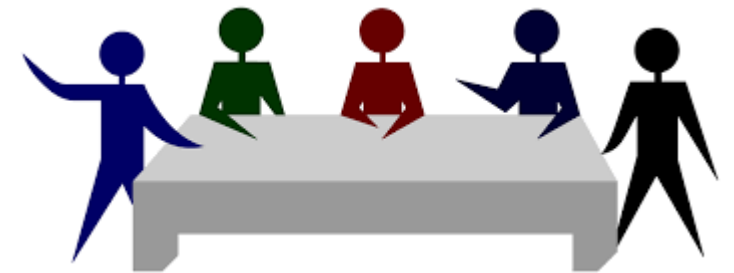


S.138 TMA – Offences committed by Body Corporate

(1) If a body corporate **commits an offence** under this Act, **any person** who at the time of the commission of offence **was a director, CEO, COO, manager, secretary or other similar officer of the body corporate** or was purporting to act in any such capacity or was in any manner or to any extent responsible for the management of any of the affairs of the body corporate or was assisting in such management :-



(a) May be charged **severally or jointly** in the same proceedings with the body corporate; and



S.138 TMA – Offences committed by Body Corporate

(1)(b) If the body corporate is **found guilty** of the offence, shall be deemed to be guilty of that offence **unless**, having regard to the nature of his functions in that capacity and to all circumstances, **he proves** –

(i) That the *offence was committed without his knowledge*, consent or connivance; and

(ii) that **he had taken all reasonable precautions and exercised due diligence** to prevent the commission of the offence.



S.138 TMA – Offences committed by Body Corporate

(2) If ***any person would be liable*** under this Act to any punishment or penalty for his act, omission, neglect or default,

he shall be liable to the same punishment or penalty for every such act, omission, neglect or default ***of any employee or agent*** of his or of the employee of the agent, **if the act**, omission, neglect or default **was committed** –

- (a) By that person's employee ***in the course of his employment***;
- (b) by the agent when ***acting on behalf of that person***; or
- (c) ***by the employee of the agent*** in the course of his employment by the agent or otherwise on behalf of the agent ***acting on behalf of that person***.





Enforcement

商标执法

Power of investigation

S.111(1) TMA

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

(2) May exercise all or any of the powers in relation to police investigation in seizable cases given by CPC.



Complaints to the Assistant Controller

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

S.112(3) ...is in relation to a trademark which is not identical with the registered trademark, any registered proprietor or licensee shall obtain the **Registrar's Verification ...to be submitted to the AC.**

S.112(4) The Registrar's verification under (3), shall be prima facie evidence in any proceedings before any court of law.



S.112(3) ...is in relation to a trademark **which is not identical** with the registered trademark, any registered proprietor or licensee shall obtain the **Registrar's Verification** ...to be submitted to the AC.

S.112(4) The Registrar's verification under (3), shall be prima facie evidence in any proceedings before any court of law.

	PERBADANAN HARTA INTELEK MALAYSIA INTELLECTUAL PROPERTY CORPORATION OF MALAYSIA (Agensi di bawah KPONHEP) Unit 1-7 & Mezzanine, Aras 12 - 19 Tower B, Menara UOA Bangsar No 5, Jalan Bangsar Utama 1 59000 KUALA LUMPUR MALAYSIA	
	Tel : +603 - 2299 6400 Faks (Fax) : +603 - 2299 6988 Laman Web (Web) : www.myipo.gov.my	
<hr/> PENENTUSAHAN PENDAFTAR (REGISTRAR'S VERIFICATION) <hr/>		
Fail Tuan :	TM/F05.57/LG/RV/MW	
Fail Kita :	RV.38/2022 (2016003849)	
Tarikh :	13 DISEMBER 2022	
PEMOHON :	SECRET RECIPE CAKES & CAFE SDN BHD	
ALAMAT :	NO. 42, 1ST FLOOR JALAN SS25/28 TAMAN MAYANG 47301 PETALING JAYA SELANGOR	
EJEN :	YIP JIUN HANN	
ADDRESS :	TRADEMARK2U SDN BHD NO.1, BLOCK C, JALAN DATARAN SD 1 DATARAN SD PJU 9, BANDAR SRI DAMANSARA 52200 KUALA LUMPUR	
<p>Tuan,</p> <p>PENENTUSAHAN PENDAFTAR (REGISTRAR'S VERIFICATION) BAGI CAP DAGANGAN NO. 2016003849</p> <p>Dengan hormatnya merujuk kepada permohonan pihak tuan untuk mendapatkan Penentusahan Pendaftar (Registrar's Verification) mengenai cap dagangan di atas.</p> <p>2. Bersama-sama ini disertakan Penentusahan Pendaftar bernombor RV.38/2022 (2016003849) bertarikh 13 Disember 2022 bagi cap dagangan 2016003849 tersebut. Penentusahan Pendaftar ini sah sehingga 13 Disember 2023.</p> <p>Sekian, terima kasih.</p> <p>'BERKHIDMAT UNTUK NEGARA'</p> <p>Saya yang menurut perintah,</p> <p style="text-align: center;"></p>		

Power of Assistant Controller

S.113(2) TMA... AC by written notice, may direct any person ...

(a) to provide the AC, within the period provide any info or document referred to (1);

(b) ... whether in physical or electronic form;

(d) ... to appear before the AC at a time and place to give info either orally or in writing, and produce any document...



A.C. may retain documents

S.114(1) The AC may take and retain for such duration as he deems necessary, any documents obtained under this part.

(2) &(3) ... certified copy of the document shall be admissible as evidence ...



Giving false or misleading info, evidence, or document

S.117 TMA - ...providing false or misleading info, documents and evidence in the course of investigation by the AC, commits an offence.

Penalty: Not exceeding **one hundred thousand Ringgit (<RM100k)**



POWER OF ARREST, SEARCH, SEIZURE, ETC.

S.119 (1) AC may arrest **Without Warrant** any person whom he reasonably believes has committed or in attempting to commit an offence under S.99 – 102 TMA.

(2) ... after arrest, must bring the person arrested to the **nearest police station.**



POWER OF ARREST, SEARCH, SEIZURE, ETC

S.120 (1) Any AC may, at all reasonable hours, exercise the following powers:-

(a) AC may inspect any goods, docs, materials, articles or things and enter any premises other than premises used only for dwelling;

(b) AC may seize and detain any goods, docs, material, articles and things for the purpose of ascertaining, testing or otherwise, whether the offence has been committed;

(d) ... require any person having authority to do so to break open any container or open any vending machine, and if that person does not comply with the req., he may do so himself.



POWER OF ARREST, SEARCH, SEIZURE, ETC



S.120(3) TMA – Where the goods, documents, material, articles or things seized by the A.C. in the exercise of his power under this section are by reason of their nature, size or amount not practical to be removed from where they are found, he may **by any means seal** such goods, documents, materials, articles or things in the premises or container in which they are found....

It shall be an offence for any person without lawful authority to break, tamper, or damage such seal..

Magistrate may issue search warrant



S.121(1) ... the Magistrate may issue a warrant authorizing any AC to **enter the premises at anytime**, with or without assistance, and if need be by force to search for and seize any such evidence or thing.

(3) Magistrate may authorize the **search and seizure** of any goods, documents, material, articles or things which contains or is reasonably suspected to contain information as to any offence...

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

(5) The AC making a search of a person under (4) may seize, or take possession of, and place in safe custody all things other than the necessary clothing found upon the person, ... such things may be detained until the order by the court for its disposal.

Magistrate may issue search warrant

(6) if it is not practical to remove any goods, docs, materials, articles or things seized under this section, the AC **may seal the premises or containers.**

(7) any attempt to unlawful tampers or removes any goods, docs commits an offence.

Penalty < not exceeding RM100k fine.



Search Without Warrant



S.122 TMA –

If the A.C. is satisfied upon information received that **has reasonable cause to believe** that by reason of delay in obtaining the search warrant under S.121 the investigation would be adversely affected,

the AC may enter the premises and exercise in, upon and in respect of the premises all the powers referred to in S.121 as if he were authorised to do so by a warrant issued.

OBSTRUCTION

S.131(a)&(b) TMA – refuse to give any AC access to any premises under investigation

assault, obstructs, hinders or delays any AC in effecting any entry ...

Penalty: not exceeding RM100k



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