

Act A1078
Trade Marks (Amendment) Act 2000

Long Title & Preamble

An Act to amend the Trade Marks Act 1976.

ENACTED by the Parliament of Malaysia as follows:

Section 1. Short title and commencement

(1) This Act may be cited as the **Trade Marks (Amendment) Act 2000**.

(2) This Act shall come into operation on a date to be appointed by the Minister by notification in the *Gazette*.

Section 2. Amendment of section 3

The Trade Marks Act 1976 [*Act 175*], which in this Act is referred to as the "principal Act", is amended in subsection 3(1) -

(a) by inserting after the definition of "Court" the following definition:

' "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;'

(b) by inserting after the definition of "mark" the following definition:

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

(c) by inserting after the definition of "transmission" the following definition:

' "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;'

Section 3. New section 4A

The principal Act is amended by inserting after section 4 the following section:

"Protection of officers.

4A. No action or prosecution shall be brought, instituted or maintained in any Court against-

- (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. "

Section 4. Amendment of section 6

Section 6 of the principal Act is amended-

- (a) by deleting subsection (2) ; and
- (b) in subsection (3) by deleting the words "of Part A or Part B".

Section 5. Amendment of section 10

Section 10 of the principal Act is amended-

- (a) by substituting for the marginal note the following marginal note:

"Registrable trade marks. ";

- (b) in subsections (1) and (2) by deleting the words "in Part A of the Register";

- (c) in subsection (2A) by substituting for the words "it is adapted to distinguish" the words "the trade mark must be capable of distinguishing";

- (d) by substituting for subsection (2B) the following subsection:

"(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. "; and

- (e) by substituting for subsection (3) the following subsection:

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

Section 6. Deletion of section 11

Section 11 of the principal Act is deleted.

Section 7. Amendment of section 14

Section 14 of the principal Act is amended-

(a) by renumbering the existing section as subsection (1) of that section;

(b) in subsection (1) -

(i) by deleting the word "or" at the end of paragraph (b) ;

(ii) by substituting for the full stop at the end of paragraph (c) a semicolon; and

(iii) by inserting after paragraph (c) the following paragraphs:

"(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;
(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;
(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
(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. "; and

(c) by inserting after subsection (1) the following subsection:

"(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. ".

Section 8. New section 14A

The principal Act is amended by inserting after section 14 the following section:

"Where registration shall not be refused.

14A. (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[Act 602];
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. "

Section 9. Amendment of section 25

Section 25 of the principal Act is amended-

(a) in subsection (1) by deleting the words "Part A or Part B of"; and

(b) by deleting subsection (11) .

Section 10. Amendment of section 30

Subsection 30(1) of the principal Act is amended-

(a) by deleting the words "Part A or Part B of"; and

(b) by substituting for the words "on payment of the prescribed fees in the name of the proprietor in Part A or Part B of the Register, as the case may be," the words "in the Register on payment of the prescribed fees in the name of the proprietor,".

Section 11. Amendment of section 35

Subsection 35(1) of the principal Act is amended by deleting the words "in Part A or Part B".

Section 12. Amendment of section 37

Section 37 of the principal Act is amended by deleting the words "Part A of".

Section 13. Amendment of section 38

Section 38 of the principal Act is amended by deleting subsection (2) .

Section 14. Amendment of section 39

Subsection 39(1) of the principal Act is amended by deleting the words "Part A or Part B of".

Section 15. Amendment of section 45

Section 45 of the principal Act is amended by deleting subsection (2) .

Section 16. Amendment of section 55

Section 55 of the principal Act is amended in the national language text by substituting for the word "muhibbah" wherever appearing the words "nama baik".

Section 17. Amendment of section 56

Section 56 of the principal Act is amended-

(a) in subsection (1) -

- (i) by substituting for the words "A mark adapted in relation to any goods or services to distinguish" the words "A mark must be capable, in relation to any goods or services, of distinguishing"; and
- (ii) by deleting the words "Part A of";

(b) by substituting for subsection (2) the following subsection:

"(2) In determining whether a mark is capable of distinguishing, the Registrar may have regard to the extent to which-

(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. "; and

(c) by deleting subsection (18) .

Section 18. New section 70B

The principal Act is amended by inserting after section 70A the following section:

"Protection of well-known trade marks.

70B. (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. "

Section 19. New PART XIVA

The principal Act is amended by inserting after PART XIV the following Part:

"PART XIVA

BORDER MEASURES

Interpretation.

70C. In this Part, unless the context otherwise requires-

"authorised officer" means-

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

Restriction on importation of counterfeit trade mark goods.

70D. (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 application has been approved.

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

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

(6) Where an approval has been given under this section and has not lapsed or been withdrawn, the importation of any 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.

Security.

70E. (1) 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.

Secure storage of seized goods.

70F. (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.

Notice.

70G. (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.

Inspection, release, etc. , of seized goods.

70H. (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.

Forfeiture of seized goods by consent.

70I. (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.

Compulsory release of seized goods to importer.

70J. (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.

Compensation for failure to take action.

70K. (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.

Actions for infringement of registered trade mark.

70L. (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.

Disposal of seized goods ordered to be forfeited.

70M. 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.

Insufficient security.

70N. (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.

Ex-officio action.

70O. (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.

Regulations relating to border measures.

70P. (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. "

Section 20. Amendment of section 73

Section 73 of the principal Act is amended-

(a) in subsection (1) -

(i) by deleting the words "Part A or Part B of"; and

(ii) by substituting for the words "inherently adapted to distinguish, or capable of distinguishing, as the case may be," the words "capable of distinguishing"; and

(b) in subsection (3) by substituting for the words "adapted to distinguish, or capable of distinguishing, as the case may be," the words "capable of distinguishing,".