

MALAYSIA
MANUAL of TRADE MARKS LAW & PRACTICE
Kuala Lumpur2003 Second Edition

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CHAPTER 1 - INTRODUCTION

Legal Basis

1.1

This Manual is a reference work on the law and practice on all matters relating to the registration of trade marks under the current laws of Malaysia. It is published primarily for the use of Assistant Registrars and above in the Office of the Registrar of Trade Marks, but is also available for use by lawyers and practitioners concerned with the prosecution of applications to register trade marks in Malaysia and with the maintenance of registration rights granted under the applicable laws in force.

1.2

The Manual is based on the Trade Marks Act 1976 (the Act), as amended 1994, the Trade Marks Regulations 1997, made under section 83 of the Act (The Regulations), the applicable case law stemming from judicial and quasi-judicial decisions interpreting the statutory provisions, the Registrar's Practice Notes published in the Government Gazette from time to time, and internal instructions issued by the Registrar for the guidance of examining staff.

1.3

The Manual is intended primarily for the guidance and instruction of the staff of the Trade Marks Registry. All matters arising for the Registrar's decision under the Act will be decided within the law and on their own facts so far as they are established. The statements of practice contained in the Manual do not fetter in any way the general discretion given to the Registrar by the Trade Marks Act 1976.

Layout and Maintenance of the Manual

1.10

Whenever amendments to the Manual become necessary, revised pages will be issued and/ or changes made to the disk copy. To facilitate their incorporation, the Manual is published in loose-leaf form. Also, in some of the longer chapters, groups of paragraph numbers are reserved for possible additions;

1.11

The Government of Malaysia does not guarantee to maintain future updates of the Manual for sale to practitioners.

1.12

Each member of the Registry staff holding of a copy of the Manual is responsible for keeping it up-to-date and in good condition.

Statutory Authorities

1.15

Section 1(2) of the Act states: "This Act shall apply throughout Malaysia". It thus applies to each of the component regions of Malaysia, which are defined in section 3(1) as the regions of West Malaysia, Sabah and Sarawak. The Act came into force on 1st September, 1983. Prior to that date, separate Ordinances relating to trade marks had effect in each component region, and these were repealed by section 84. However, special provisions were made for applications for registration, which were filed under the repealed Ordinances while they were still in force, and to registrations obtained from such applications, even if the marks concerned were not actually entered on the register until after 1983. These special provisions are dealt with, as required, in the relevant chapters of the Manual.

1.16

Because the statutory provisions applicable in Malaysia use language similar to that employed in the corresponding legislation of the United Kingdom, and some other jurisdictions, decisions of the judicial authorities there, while not binding in Malaysia, constitute persuasive authorities for the interpretation of the similar provisions here, and are commonly cited in argument both by the Registrar and by practitioners in this country. Decided cases, which throw new light on the meaning of particular provisions in the law, are published and form precedents, which are followed in subsequent cases where the facts are sufficiently similar. Cases, which arise under the United Kingdom legislation, are published by the United Kingdom Patent Office in The Official Reports of Patent, Trade Mark and Design Cases, known as the R.P.C.s for short. A full set of R.P.C.s is held in the Registrar's Office and may be

consulted by all examining staff. Quotations from a number of these leading cases are used throughout this manual. These may be cited in argument at hearings and in correspondence; they (and others) will often be cited by applicants and their agents, in both ex parte and inter partes proceedings.

1.17

References to R.P.C.s are made in two ways and this can sometimes cause confusion. Up to the year 1957, each year's issue of R.P.C.s was given a volume number, and it is usual to refer to these both by the year, in curved brackets, and by the volume number, as, for example, (1938) 55 R.P.C. 326. From 1957, volume numbers were discontinued and references are in the form, for example [1977] R.P.C.503, with the year being placed in square brackets. The final figure in each reference is the number of the page in that volume where the report of the cited case begins. This convention is followed in the Manual. Each case starts with a summary of the facts and decision; this is called the head note.

1.18

References are also made to cases included in other reported series. Among these are: Fleet Street Reports, in the form: [year] F.S.R. page number.

1.19

A table of all leading cases cited in the Manual is given in Appendix 4. Each is cross-referenced to the paragraph(s) concerned. Malaysian trade marks case law will also be incorporated into the manual as appropriate.

Practice

1.25

This manual covers matters of practice, as well as the law. However, it is important to appreciate that practice as applied in the United Kingdom cannot always be transplanted intact to other jurisdictions. Market conditions (including its size) the degree of sophistication of prospective customers, the language (and the meanings of words in the same language), the moral and religious climate, may all differ from those obtaining in the United Kingdom. Each of these differences can have an important,

even decisive, effect on the registrability of a mark, and that is a question that has to be decided for itself by each jurisdiction. It has rightly been said that the outcome of any application for registration must depend on its own facts. Wherever possible, examples of practice have been chosen that, it is believed, will have the widest possible application, and have been adapted, wherever possible, to Malaysian conditions.

1.26

In fairness to applicants generally, every endeavour should be made to apply consistent rules of practice. Those having responsibility for the application of the law, therefore, must make themselves familiar with the contents of this Manual and the rules of practice contained in it. They should not be departed from without good cause. Otherwise, in time, opposing parties will be able to quote different examples in support of their respective views and the Registrar might as well decide between them on the toss of a coin.

CHAPTER 2 - ADMINISTRATION AND ORGANIZATION

The Registrar and his Powers

2.1

The Act establishes the office of Registrar of Trade Marks who has superintendence over all matters relating to trade marks and on whom are conferred specific powers and functions. The Registrar may, in writing, delegate all or some of these powers (except the power to delegate). The Minister appoints sufficient Deputy Registrars and Assistant Registrars to carry out the statutory provisions of the Act. Deputy Registrars have all the powers and functions of the Registrar, except the power to delegate. The powers and functions of Assistant Registrars are derived by written individual delegations from the Registrar, which take into account the specific duties assigned to them.

2.2

Many of the powers of the Registrar are discretionary in nature. For example, the granting or refusal of an application for an extension of time to deal with a matter is entirely within the Registrar's discretion; there is no statutory right to an extension. However, the discretion is a judicial one. That is to say, it must be exercised judiciously and not capriciously. Moreover, if the decision is adverse to an applicant for registration, or a registered proprietor, the party concerned must be given an opportunity of being heard on the matter before any final decision is given - section 76. The subject of the Registrar's discretion is dealt with at greater length in chapter 15, and it is important that all officers exercising delegated powers are aware of the manner in which the discretionary power is to be exercised.

Places and Hours of Business

2.5

A Central Trade Marks Office is located in Kuala Lumpur, as part of the Ministry of Domestic Trade & Commerce.

The address is:

10, 27, 29, 30 & 32, Menara Dayabumi,
Jalan Sultan Hishamuddin,
50623 Kuala Lumpur.

Tel:(603) 22748671

Fax:(603) 22741332

A regional Trade Marks Office is established in each of the States of Sabah and Sarawak. Section 5(3) of the Act provides that documents may be submitted at a regional office in lieu of submission at the central office. Thus applications to register trade marks may be filed at a regional office, although they will be examined at the central office. The day-to-day administration of each regional office is under the control of a resident Assistant Registrar.

2.6

Each office is open to the public at prescribed times for the transaction of business, including searches of the register. Assistant Registrars may be deputed, in rotation, to attend the public counter as part of their duties.

The current regulations do not prescribe any opening times.

The Office hours for the conduct of public business are:

Monday to Thursday: 8.15 a.m. - 1.00 p.m.

2.00 p.m. - 4.45 p.m.

Friday: 8.15 a.m. - 12.15 p.m.

2.45 p.m. - 4.45 p.m.

Saturday: 8.15 a.m. - 1.05 p.m.

2.7

Any day when the office is closed, e.g., on public holidays, is known as an excluded day and is not taken into account in determining the expiry of time limits, etc.

The Register

2.10

The principal function of the Registrar is to keep, and maintain, a register of trade marks at the central office. The register comprises the marks, the names and addresses of their proprietors, notifications of any changes of ownership, the names and addresses of all registered users (licensees) of marks, and any disclaimers, conditions or limitations to which a registration may be subject - section 6(1). The register is open to public inspection - section 8(1). Certified copies of

the register are deposited at each regional office to facilitate public access thereto - section 8(3).

Indexes to the Register

2.15

As well as maintaining the register itself the registry keeps a number of indexes to enable access to it. The most important of these are the search indexes, used to identify certain deceptive trade marks as defined in section 19(1). The indexes are maintained in three distinct forms:

1. the alphabetical index of word marks (sometimes called the forward index)
2. the terminal index (in which word marks are indexed according to their endings)
3. the index of device marks (sometimes called the device index).

Wherever practical, these indexes are divided into classes according to the Nice Classification of Goods and Services for the Purposes of the Registration of Marks (referred to in the manual as the Nice, or International, Classification).

2.16

The alphabetical index consists of loose-leaf slips containing sufficient details of the registered entry to enable possible conflicts to be identified. Within each international class, the slips are kept in alphabetical order of the mark. Where a mark consists of a word in a foreign language, or of characters in a foreign alphabet, the Registrar will always call for a translation and transliteration under regulation 23, if it has not already been supplied (as it should have been). This is not only so that he may know what it is that he is being asked to consider, it is also to avoid the registration of conflicting marks. Translation and transliteration are, therefore, included in the forward search index, even although they are not, themselves, registered trade marks.

2.17

The device index exists in card form. It contains the same information as the alphabetical index, and is also separated into Nice classes. It differs from the alphabetical index in having an accurate pictorial representation of the mark, and

being kept in categories according to the nature of the device. Further information regarding the device index is given in chapter 11, dealing with the search procedure. At this stage it should be noted that where a mark consists of more than one element it is necessary to index it under each one. Thus a mark consisting of a device of a monkey in a rowing boat would be indexed under animals (monkeys) as well as under shipping (rowing boats).

2.18

The terminal index was established only recently and is not yet fully in operation. Its function is to pick up those word marks, which closely resemble other marks, either visually or phonetically, although they do not begin with the same letter of the alphabet. For example, an application to register the invented word BRISTINO would undoubtedly lead to public confusion and deception if another proprietor were to use the invented word PRISTINO on the same or similar goods. A purely alphabetical index would never uncover this conflict.

2.19

Accurate indexing is vital to the efficient discharge of the statutory duty of the Registrar not to register marks, which, by their resemblance to those owned by other proprietors, are liable to confuse the public.

2.20

Where applications for registration are still pending, copies of the form TM.5, which accompany such applications (see paragraph 6.4) are used as the index slips. These, too, are divided into international classes, but are not further subdivided into word or device marks. They are, however, added to the terminal indexes.

2.25

Copies of the search indexes are kept at each regional office and forms TM.5 are sent to them for the purpose of including the pending applications in the search material.

2.26

The search indexes for each international class are kept by the

Assistant Registrar with the responsibility for dealing with applications to register marks in those classes. However, the search for conflicts to any given application goes wider than the class in which the application was made, since it is necessary to discover confusingly similar marks registered, or applied for, in respect of goods or services similar to those of the application, and these may be classified in a different international class. This matter is dealt with fully in chapter 11 dealing with searching; see also Appendix 2. For the present, it is sufficient to note that the requirement for cross searching into other classes means that the various indexes must be kept up-to-date and in common form. Failure to do so would have serious repercussions on the work of all sections.

2.27

While the public has a statutory right of access to the register, there is no corresponding right of access to the search indexes. Nevertheless copies of the indexes are maintained as a service to the public and to practitioners wishing to conduct searches of the register on behalf of their clients.

Organisation of the Work of the Registry

2.30

Most of the Assistant Registrars are principally engaged in the examination of applications to register trade marks, including searches for prior conflicting rights. Other specific duties, such as computerisation, issue of certificates of registration, assignments of registered trade marks, and renewals may be allocated to individual officers, depending on their capacities and workloads.

Accounting for Fees

2.35

The Act, and regulations made there under, prescribe a system of fees payable by those who wish to have marks entered on the register, to alter any registered entry, or to receive certified copies of any entry on the register. The table of fees is set out in the first schedule to the regulations. These fees must be paid before the matter they refer to can be carried out.

Correspondence

2.40

In order that correspondence received in the office may be directed to the person responsible for dealing with the matter, a system for reference is employed and correspondents are requested to quote these when writing to the office. Where the matter concerns an application to register a trade mark, the reference usually consists of the unique application number, assigned chronologically to each filing, and retained as the registration number if the application is successful - see paragraph 8.5.

2.43

Each day's correspondence is sorted on receipt and pass to the appropriate officer for attention. Letters addressed to the Registrar by name, or for his personal attention, are passed immediately by hand to the Registrar who will direct the manner of response.

Forms and other Documents

2.45

To ensure the orderly conduct of public business, uniform procedures are laid down by statute regarding the filing of certain documents. Forms in a standard layout must be used for all-important actions. The relevant forms are all listed and reproduced in the second schedule to the regulations.

2.46

It is not specifically provided for in the Act or regulations, but the Registrar will usually approve minor variations in any of these forms where practitioners wish to modify them to suit their own internal arrangements. In such cases, the Registrar's prior written approval must be obtained and production of the modified forms will be at the cost of the person desiring the modification. They may not be further modified without the express prior approval of the Registrar.

2.47

All documents, other than ordinary correspondence, must normally be in ISO A4 size, with a left margin of at least 4 cm.

- regulation 6. The Registrar may, in a particular case, accept documents with different dimensions, but this would be unusual. Approved private modification of official forms should conform in all respects to the dimensions of the official version.

2.48

Although the central and regional offices are open to the public during normal business hours, when documents may be filed in person, documents may also be sent by prepaid post. In such cases, the date of filing is not the date of posting, even if a certificate of posting is produced. Instead, the filing date is deemed to be the day when the item would have been received in the ordinary course of post - regulation 8. This provision may be of some importance where time limits are involved, including the period of six months for claiming priority under the Paris Convention. See also paragraph 7.51.

2.49

Once filed, documents become official property and are not returnable to the sender. In certain circumstances, copies of documents may be furnished to any interested person, on payment of the relevant fee - see item 4 of part II of the first schedule to the regulations. If a filed document contains an obvious error or clerical mistake, the Registrar may permit it to be amended, provided that no other person's interests are affected adversely - section 74(1). Regulation 85 provides that Sunday, any day specified as or proclaimed to be a public holiday, or any day proclaimed to be an excluded day by a notice displayed to public view at an office of the Registrar are excluded days. Where such an application or request of any kind could be expected to arrive on such a day, the next working day is taken as the appropriate day instead. (For the method of correcting an error in the register itself, see paragraph 2.7).

2.50

Documents, including correspondence, are placed in chronological order on the file to which they relate. In the case of registered marks, the file is retained so long as the mark remains on the register, and for at least three years after its removal. After that time, the file should be

destroyed, unless it contains material likely to be use in dealing with other cases, such as, for example, a cross-reference to an opposition or a rectification file. In the case of a failed application for registration, the file may be destroyed after the lapse of two years from the date of the last action taken on it, unless there are special reasons for keeping the file, as, for example, where there has been an appeal. From time to time, general correspondence files should be weeded by removal of out-of-date material. As a general rule, correspondence of an ephemeral nature need not be retained longer than two years.

Address for Service

2.55

To ensure that judicial notice may be taken of the service of documents, they are properly served on the Registrar only when they are filed at the office, including a regional office - section 5(3). Conversely, documents and notices sent by the Registrar to a party must be sent to his address for service, which must be an address within Malaysia. In the case of a foreign applicant or proprietor, this will usually be the address of his agent in Malaysia. Regulation 10 sets out the statutory provisions regarding addresses for service; they are summarised in the next following paragraph.

2.56

Where the party is a registrant, whether as proprietor of a registered trade mark or as a registered user of it, his address for service is entered on the register. In this way, third parties desirous of serving notices etc. on the registrant can ascertain the address to which they must be sent. If the Registrar should have any doubt about the correctness of any address for service, which is entered on the register, he may write to the registrant's business address requiring the address for service to be confirmed. If no such confirmation is received within the next two months, the recorded address for service may be struck from the register. The onus of informing the Registrar of his address for service, and of any changes in it, is firmly on the applicant or registrant, as the case may be. If he fails to do so, the Registrar may treat his business address as the address for service. The effect is that any

written communication sent by the Registrar, or anyone else, to a party at the address which is either his address for service, or treated as such, is deemed in law to have been properly addressed.

2.57

Request to the Registrar to enter, amend or cancel an address for service on the register must be made on form TM.1 and the prescribed fee paid. If the address is to be entered in respect of more than one registration, extra fees are payable. Forms TM.1 must be signed by the proprietor, or registered user, in person, unless the Registrar allows otherwise - regulation 10(3). In practice, forms TM.1 signed by a recognised agent who declares that he is acting on behalf of the applicant or proprietor may be accepted without question.

2.58

Where an application, for registration or otherwise, is received from abroad and no agent or address for service in Malaysia is given in the application, the applicant should be requested to furnish an address for service before any other action is taken to deal with the application.

Agents

2.60

Section 80 provides that an agent may stand in the place of proprietors and others (such as opponents and applicants for rectification). Section 80(1) requires an applicant for registration who does not reside or carry on business in Malaysia to appoint an agent to act for him. Regulation 2 defines an agent as one who is duly authorised to the satisfaction of the Registrar. This refers to an authorisation by the proprietor or other person concerned.

2.61

Only practitioners specialising in trade mark law may act as agents, and they must have a place of business in Malaysia. The question of whether an agent may claim professional privilege for communications with his clients is an open one but the indications are that he does not - "Dormeuil" T.M., [1983] R.P.C. 131; " Wilden Pump v. Fusfield" [1985] F.S.R. 159.

2.63

The detailed provisions governing the role of agents vis-à-vis the registry are contained in regulation 11.

CHAPTER 3 - THE REGISTER

Entries in the Register

3.1

The register of trade marks is an official record of marks, which have been accepted by the Registrar as meeting the criteria for registration laid down by the legislation. In respect of each mark the register includes a representation of the mark (or a specimen or a copy of the mark where it cannot conveniently be shown by a representation), the names, addresses and descriptions of its proprietor and of any registered users, their address for service where that is different from their business address, any changes in address, any disclaimers, condition or other limitations to which the registration is subject, the history of the registration, including any changes of ownership, all renewals, and any rectifications or variations of the entry- sections 6(1), 45(1)(a) and regulations 10(2), 21(1), 52, 67, 70(1) and (2), 77, 81.

3.2

The register is a permanent record, i.e., no part of it is ever destroyed.

Registers in the Component Regions of Malaysia

3.10

Registers of trade marks were kept in each component region of Malaysia under the repealed ordinances, i.e., the Trade Mark Ordinance 1950, applicable in West Malaysia; the Trade Mark Ordinance of Sabah; and the Trade Marks Ordinance of Sarawak. These three registers are referred to as the "previous registers"- section 3(1). Special provisions were necessary to deal with any conflict of rights consequent upon the granting throughout Malaysia of rights, which had hitherto existed only within the respective component regions, and these are examined in chapter 7.

Registration and Other Rights

3.15

The proprietor of a registered trade mark has certain rights, which arise out of his registration. Principal among these is

the exclusive right to use the mark in relation to the goods or services for which it is registered. This means that he has the right to exclude use of the mark by others. Anyone who uses the mark without his consent infringes that right and can be sued in the Court-section 35(1). Infringement actions are not the concern of the registry, although the matter is touched on again in chapter 24 dealing with oppositions.

3.16

Registration of trade marks is not compulsory in Malaysia. The owner of an unregistered mark may use it, but he cannot sue for infringement-section 82(1). This inability to initiate any action for infringement of an unregistered mark applies even if registration has been applied for but the application is still pending, notwithstanding the fact that, under section 30(1), the date of application will be deemed to be the date of registration if the mark is eventually registered. This effect stems from the definition of the registered trade mark in section 3(1) as a trade mark "which is actually upon the register". (This view of the law is supported by a decision of Graham. J, given on 14 November 1980 in the unreported U.K. case of Henry Denny & Son Ltd. v. United Biscuit (UK) Ltd.-M14 No. 268 Folio 36). Many applications for registration are refused and it would be contrary to the intention of the act if infringement rights were to be acquired by all applicants, regardless of the merits, or, indeed, the outcome, of their application.

3.17

Trade marks, which are in use, acquire common law rights, whether or not they are registered. It is well established at common law that no person is entitled to pass off his goods as those of another. Thus, where a business has acquired goodwill through the use of a trade mark, and that goodwill is damaged by another's use of the same or similar mark, the injured party can apply to the Court to restrain the offender. Section 82(2) makes it clear that infringement rights are additional to, and not in substitution for, the right to sue for passing off. The right to sue for infringement of the registered trade mark is an absolute one and does not depend on the proprietor making any use of the mark (although failure to do so may make him

liable to lose his registration-see chapter 25 - Rectification). The owners of registered trade marks which are in use commonly sue for passing off simultaneously with an action for infringement.

3.18

Once an application has been accepted, it is advertised in the Government Gazette, and, provided that there is no (successful) opposition to it by a third party, it is ready to be placed on the register. Before a mark is registered and entered upon the register, a registration fee is payable, which is in addition to the fee payable at the time of application. Failure to pay the registration fee in respect of an application, which has been accepted by the Registrar, will, after one reminder, result in the application being deemed abandoned-regulation 53(1) (2) &(3).

Registration Certificates

3.24

For each registration a certificate is issued under the hand and seal of the Registrar. The Registrar's seal embodies a device approved by the Minister and impression of it are judicially noticed and admitted in evidence-section 4(5). This means that the certificate of registration is sufficient evidence of the fact and can be used to initiate infringement action without the Registrar, or someone from his office, having to attend the Court and testify to the fact of the registration.

3.25

Where someone other than the holder of the certificate of registration wishes to refer to an entry in the register in the course of proceedings before the Court, he may apply to the Registrar for a certified copy. A sealed copy is admissible as evidence without any further proof or production of the originals-section 65(1).

3.26

It follows from what is said in paragraphs 3.24 and 3.25 that great care must be taken in making any entries in the register, in order to ensure their complete accuracy. Should anyone be so

foolish as to make, or cause another to make, a false entry in the register (including a certified copy of the register deposited in a regional office), he would be guilty of a criminal offence, and liable, on conviction, to a fine of up to RM 5,000.00 or to up five years imprisonment, or both-section 9. The same penalties could be exacted for making a false document purporting to be a copy of an entry in the register.

3.27

Of course, honest mistakes can occur in making entries in the register. This may happen through human error on the part of the Registrar's staff, or on the part of proprietor himself. In either case the registered proprietor must apply to the Registrar on form TM17, 18 to have the error corrected, and must also submit the original certificate of registration for consequential amendment - section 43(1) and sub regulation 71(3). (For the correction of an application before registration, see paragraph 2.49).

Duration of Registration

3.30

The initial duration of a registration is for a period of ten years - section 32(1). This is calculated from the date of filing of the original application, however long it takes to deal with it.

3.31

Trade marks registered, or registered and renewed, under the repealed ordinances, were incorporated into the single register created by the 1976 Act, and became trade marks registered under that Act for a period equal to the unexpired portion of their registration under the repealed provisions- section 32(2). At the end of that period, they become renewable under the later provision, subject to any prohibition of the duplicate registrations.

3.32

All registrations are renewable, whether they were originally obtained under the 1976 Act or under the repealed ordinances. The subject of renewals is dealt with in detail in chapter 20.

CHAPTER 4 - WHAT CONSTITUTES A TRADE MARK

Definition of a Trade Mark

4.1.

Section 3(1) of the act contains a number of definitions, in alphabetical order, of terms used in the legislation. Two of these must be considered in determining what constitutes a trade mark. They are:

"mark" includes a device, brand, heading, label, ticket, name, signature, word, letter, numeral or any combination thereof.

"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 the person, and means, in relation to Part XI, a mark registrable or registered under the said Part XI.

4.2

Understanding these definitions is fundamental to the correct treatment of many applications for registration, and they are considered in detail in the following paragraphs. At this point it is sufficient to note that the references to Part XI are to a special kind of mark, called a certification trade mark, which is dealt with in chapter 26.

4.3

Taking the two definitions together, it is clear that a mark is not necessarily a trade mark. A trade mark is a mark used in a particular way and for a particular purpose. It is necessary, therefore, to deal first with the definition of a mark.

Meaning of Mark

4.5

The first thing to notice about the definition of a mark is the word "includes". This shows that the definition is not exhaustive. Nevertheless, a mark must be ejusdem generis with the examples given in the statutory definition. The only one of

these, which might give rise to some difficulty, is the word "device". Two well-known decided cases are probably sufficient to indicate the bounds of the definition. These are described in the next paragraph and in paragraph 4.9.

4.6

In the case of *Smith, Kline & French*, reported in [1976] R.P.C. 511, the goods were pharmaceutical capsules, one half of which were coloured, the other half being transparent. Inside the capsule, and visible through the transparent half, were many tiny multi-coloured pellets. Applications were made to register the appearance of these capsules as trade marks, and the question was: were they marks at all. There was no dispute that, through prolonged use, the trade had come to recognise that the capsules emanated from the applicant and from no-one else. The U.K. Court of Appeal held that the capsules could not be a mark, on the ground that what was sought to be registered was simply the whole visual appearance of the goods themselves. However, on appeal, the House of Lords decided that the mark was a particular colour combination and that the fact that it was applied to the whole visible surface of the goods was, in itself, no objection. Note that the capsules themselves were not the mark. The case is authority for the propositions that: marks may be three-dimensional, colour alone may be a mark; and a mark may cover the whole surface of the goods.

4.7

It was in the light of this decision that a subsequent application by the French firm, *Camping Gaz*, to register the colour blue applied to the whole surface of the containers in which the gas was sold, was allowed.

4.8

Although Malaysia, unlike some other administrations, does not specifically include colour among the examples of a mark, there is no doubt that the capsule kind of mark would qualify as a mark here. In fact, colour is one of the things that must be taken into account in considering whether a mark qualifies for registration - section 13(1). (The questions of whether such marks are used as trade marks, and whether they are distinctive are additional matters to be considered before registration can

be allowed).

4.9

In the written judgment in the capsule case it was explicitly stated that a distinctive moulding round the neck of a bottle would qualify as a mark, and if it were put there to indicate that the contents of the bottle were placed on the market by a single enterprise, could be a trade mark. The second reported case for consideration involved a complete bottle, the famous Coca-Cola bottle. It has long been recognised that a drawing of a bottle, or other container, could constitute a mark. The question in the Coca-Cola case, however, was whether the bottle itself could do so. Some administrations do include the shapes of containers in their definitions of a mark, and allow registration provided that the shape is not dictated by functional reasons. Malaysia is not one of them, and neither is the United Kingdom, where the Coca-Cola case fell to be decided. That case, too, went all the way to the House of Lords, and at every stage it was decided that a mere container, no matter how original in design, nor how famous, could not be a mark. It is reported in [1987] R.P.C. 245. A picture of the bottle was allowed to be registered - see paragraph 12.232.

4.10

Other unusual devices which have been held to be marks are: coloured threads running the length of hose, Reddaway's Application (1927) 44 R.P.C. 27; the colour blue applied to paraffin, "Blue Paraffin" T.M. [1977] R.P.C. 473.

4.11

The registrability as trade marks of other devices, and of labels, names, signatures, words, letters and numerals, is fully considered in chapter 12 under the heading of distinctiveness. Before leaving the definition of a mark, however, it should be noted that it includes "any combination" of items listed there. Many marks are made up of more than one element; labels on bottles of drink or on tins of food are common examples. Such marks are referred to as composite marks. At some stage, however, composite marks may cease to be capable of being used as trade marks. A book is a combination of words, and may also contain pictures, or other devices, but it could

never serve as a trade mark. Less extreme, a slogan can perfectly well be a mark and many such are registered as trade marks. Section 3(1) also makes it clear that "word" includes an abbreviation of a word; so registrable marks cover the whole range from a single letter to a slogan.

Marks must be Visible

4.20

Before turning to the definition of a trade mark, it should be noted that the definition of a mark does not allow for sounds or smells. In Malaysia, there can be no doubt; neither sounds nor smell can be registered. This is made clear by the definition of use of a mark contained in section 3(2)(a). This states that only printed or other visual use can be taken into account for all purposes of the Act, and without use, or intention to use, a mark cannot be registered.

4.21

The fact that a trade mark must be visible in use has an important bearing on the size and placing of marks. The requirement does not mean that marks have to be visible all the time they are in use. Those placed on goods, which are then incorporated into other goods before being placed on the market, such as microchips in a computer, are none-the-less trade marks. In "Everglide", [1964] R.P.C. 37, the mark was in very tiny lettering on a pen and could not readily be seen. It was, nevertheless, a trade mark. It is also common practice for magazines to be stacked for display with their titles (which may well be trade marks) overlapping. Trade marks are placed on goods for identification, not necessarily for advertisement. (See paragraph 6.5 concerning the size of representations of marks submitted for registration).

Use in Relation to Goods

4.25

A mark tendered for registration does not have to be in use at the time of the application; it is clear from the opening words of the definition of a trade mark that an intention to use it will suffice. At the application stage, it will not normally be necessary to enquire whether the applicant has used his mark, except where it is necessary for him to establish that it has

acquired distinctiveness through such use. This aspect of the matter is dealt with in detail in chapter 13. Nor will it normally be necessary at this stage to delve into whether the applicant intends to use his mark; his statement on the application form may usually be taken at face value. An exception may occur where the Registrar has reason to believe that the applicant does not carry on a trade. This matter is fully dealt with in chapter 9.

4.26

The phrase "in relation to" goods or services indicates that it is not necessary that a trade mark be used on the goods or services themselves. This is made even clearer by section 3(2)(b) which states explicitly that "references to the use of a mark in relation to goods shall be construed as references to the use thereof upon, or in physical relation to, goods." Use on, for example, swing tickets attached to the goods, or in advertising, is not use on the goods themselves but it is use in relation to the goods. The question of whether advertising without actually having goods available for sale constitutes use is considered in chapter 13.

Use in Relation to Services

4.27

As with goods, the mark does not need to have been used at the date of application. The Registrar will not normally check whether the applicant intends to use his mark and his application may be taken at face value.

4.28

Section 3(2)(c) sets out the requirements for use of a mark in relation to services. Use is seen as a statement or as part of a statement about the availability or performance of services. This covers use in advertisements, or letterheads, on business cards or in brochures, leaflets and similar items.

Indicating a Connection

4.30

The next phrase in the definition of a trade mark that needs comment is: "for the purpose of indicating or so as to indicate a connection in course of trade between the goods or services

and a person having the right ... to use the mark". This is the heart of the definition and is fundamental to the nature of a trade mark. The mark must form a connecting link between the goods or services and the owner of the mark, and that connection must be a trade connection. In other words, a trade mark is an indication of trade source. To do that successfully, it must be capable of indicating a single trade origin, and this aspect of the matter will be considered in chapter 12, dealing with distinctiveness. For the moment, it is important to consider some other phrasing in the definition a little more closely.

4.31

Use of a trade mark for the purpose of indicating a trade connection is clear enough, but what extra is added by the words "or so as to indicate"? These words first appeared in the United Kingdom Act of 1938 as a result of the case of *Bass v. Nicholson*, (1932) 49 R.P.C. 88. Nicholson marked barrels of beer with a letter N in a triangle in order to indicate a particular type of beer, which he sold. Bass, who owned a registered trade mark consisting of a triangle, sued for infringement. The evidence showed that traders recognised the N mark as indicating beer sold by Nicholson, notwithstanding that it was used primarily as a quality mark. Irrespective of the original intentions of the owner, the mark indicated a particular trade connection and was held to be a trade mark. This decision was given statutory effect by the phrase "or so as to indicate".

Connection in the Course of Trade

4.35

The required connection between the mark and its owner must be one "in the course of trade". This eliminates marks, which indicate some other connection, such as mere ownership, or quality, unless, like Nicholson's mark, they also indicate a trade connection. There is no inherent reason why a mark cannot perform more than one function at the same time. The question of whether a mark functions as a trade mark is a question of fact, and, in any case of doubt, may be the subject of evidence.

4.36

There can be no trade in goods which are given away free. "Hospital World" for example, was the name of a magazine which the applicant distributed without charge, making his profit from advertising revenue, and it was held that he did not trade in magazines; [1967] R.P.C. 595. An Irish decision the other way is "Golden Pages" T.M., [1985] F.S.R. 27. There, the compiler of a classified telephone directory who paid the telephone authority for the privilege of producing it and derived his income from the advertisers, the directory being distributed free by the authority, was held to be engaged in trade.

4.37

It may be necessary to distinguish between a trade in goods and the provision of a service. In *Aristoc v. Rysta*, (1943) 60 R.P.C. 45, the House of Lords decided that a mark placed on stockings to indicate that they had been repaired by the owner of the mark, was not a trade mark. Lord Macmillan states that a trade connection required that there be "an association with the goods in the course of their production and preparation for the market" and went on to indicate that preparation covered selection and offering in the market goods manufactured by another. The Amended Act provides for service marks so such an application may now be registered in Class 37 specifying "repair of hosiery".

4.38

Where the connection is between the goods or services and a licensee of the proprietor, see chapter 19.

4.40

In "Revue" T.M., [1979] R.P.C. 27, the U.K. Registrar held that orders for goods to be manufactured for the trade mark owner and his instructions that they bear his trade mark, was sufficient to constitute use of the mark "in the course of" trade, although no goods actually existed at the relevant time, and this decision was subsequently approved by the Court in "Hermes" T.M., [1982] R.P.C. 425.

4.41

An unusual case on this aspect of the law was that of "Unilever (Striped Toothpaste) [1980] F.S.R. 280. In the tube as sold, the toothpaste was white, but on extrusion, red stripes were added to it by means of a device in the nozzle. The applicants wished to register a visual representation of toothpaste with red stripes. (A reference to this mark is at paragraph A63 in the WIPO Publication, Introduction to Trade mark Law and Practice, The Basic Concepts.) The U.K. Registrar held that the mark was not used in the course of trade since it did not come into existence until after the purchaser had taken the goods home, at which time trade in them had ceased. This view was upheld on appeal.

Connection with Goods or Services.

4.45

The definition of a trade mark requires that the trade connection be between the goods or services and the owner. The reference here is to the goods or services of the application. In most cases, no question will arise under this head, but occasionally the Registrar may be put on enquiry as to whether the necessary trade connection exists. The claim may be so wide, for example, that the Registrar will need to be convinced that the applicant trades, or intends to trade, in all the goods or services claimed. The Registrar would not allow any trader to claim the class heading of any service class, as a broad range of services is included in each class. It is unlikely that there could be a connection between all these services and the owners. Unjustified claims are further examined in chapter 9.

Connection with a Person

4.50

Sometimes, a trade mark proprietor will authorise some other person to use his mark. Under certain conditions, including the important one of maintaining the trade connection, such an arrangement can be entered on the register, and the licensee will be known as a registered user. Use by a registered user comes within the definition of a trade mark; use by an unregistered user may not. The subject of registered users is fully dealt with in chapter 19.

4.51

Although the definition of a trade mark requires that the connection must be with a single trade source (whether or not that source has licensed use of the mark), there is no requirement that the identity of owner of the mark be disclosed. (Of course, for a registered trade mark, this could always be ascertained from an inspection of the register.) Many marks are in daily use without the public having the faintest idea of who owns them. This does not prevent such marks performing their function; the public can purchase goods or services simply by using the mark alone.

CHAPTER 5 - WHAT CANNOT BE REGISTERED

Prohibited Marks

5.1

There are many signs which fall within the definition of a mark, and which are capable of being used as trade marks, but which are specifically prohibited from being registered as trade marks for one reason or another. The largest group comprises those marks, which are likely to confuse or deceive the public, and these are considered in chapter 11 (extrinsic deception, based on section 19) and chapter 14 (intrinsic deception, based on section 14(a)). In addition to these general categories, there are certain specific prohibitions. For some, refusal is mandatory; for others, refusal is a matter for the Registrar's discretion. Even where refusal is mandatory, it may often be a question of judgment whether a given mark falls foul of the prohibition. Sometimes a mark may be refusable both on specific grounds and under the Registrar's discretion.

Scandalous or Offensive Matter

5.5

Section 14(b) provides that a mark, or part of a mark, shall not be registered as a trade mark "if it contains or comprises any scandalous or offensive matter or would not otherwise be entitled to protection in any court of law". Just what matter might be considered scandalous or offensive is often a subjective decision. Evil, as much as beauty, is often in the eye of the beholder. The wording also begs the question: offensive to whom ?

5.6

The wording of the United Kingdom statute is not the same as that employed in the Malaysian Act; it prohibits marks, which are "contrary to law or morality, or any scandalous design". Nevertheless, allowing for the difference in wording, a useful approach to the problem may be found in some decisions of the U.K. Registrar. The first is "Hallelujah" T.M., [1976] R.P.C. 605. That word means, "praise to Jehovah", which is one of the names of the Christian and Jewish god. The mark was intended to be used on women's clothing, including underclothing. There was some evidence that a not insubstantial number of people had

objected to the use of (other) religious names on articles of clothing. In refusing the application, the Registrar held that the mark would offend the "generally accepted mores of the time" and said:

"When religious and moral standards are changing, sometimes quite rapidly, it seems to me that the Registrar should only follow where others have given a clear lead. While he must not remain isolated from the day-to-day world, frozen in an outmoded set of moral principles, he must equally not presume to set the standard. He must not act as a censor or arbiter of morals, nor yet as a trendsetter. He must not lag so far behind the climate of the time that he appears to be out of touch with reality, but he must at the same time not be so insensitive to public opinion that he accepts for registration a mark which many people would consider offensive."

5.7

In seeking to apply these principles to trade mark registration in Malaysia, it should be remembered that Malaysia is a multi-racial country and proper regard should be had to the religious susceptibilities of substantial minorities. On the other hand, a mark should not be objected to merely on the ground that it has a religious connotation. For example, there are many pictures of monks on wine and liqueur labels and they cause no offence. Many such beverages are brewed or distilled by members of religious orders and are placed on the market by them. Examples are 'Benedictine' (made by the monks of that order) and 'Chartreuse'.

5.8

The second U.K. decision that might be of assistance in construing the prohibition of section 14(b), concerned a mark consisting of the words "Weekend Sex" and devices of a naked man and women, albeit in the form of classical statues. The applicant used it on magazines. On enquiry, the Registrar ascertained that in fact the magazines were pornographic. There was no way that a suitable condition of registration could be framed (or policed) that would restrict use of the mark to non-offensive publications and the mark was refused, partly on the ground that the phrase 'weekend sex' indicated casual sex and

was therefore immoral. This case may, perhaps, be regarded as the edge of what is inadmissible.

Contrary to Law

5.15

Determining which marks are contrary to law or unprotectable in a court presents more of a problem. If a mark consists of a device, it may be assumed that the applicant owns the copyright in it. However, if there is evidence to the contrary, a ground of refusal would be that to register it, and so to confer exclusive rights in it on the applicant would be contrary to law. Marks, which are likely to deceive, are not protectable in a court, but these are considered separately in chapters 11 and 14.

Prejudicial to the Interest or Security of the Nation.

5.16

This is a new provision, which may be used infrequently during examination. Section 14(c) gives the Registrar the responsibility of determining what matter, in a trade mark, is or might be prejudicial to the interest or security of the nation. It may be that a mark contains an inflammatory statement or words, which could be considered so. It is unlikely that the Registrar could know that a state secret was included in a trade mark unless advised of this by a responsible government department. Each case must be considered on its own merits.

Marks Claiming Intellectual Property Rights

5.20

Section 15(a) provides that any trade mark, which consists of, or contains, any of the following marks must be refused registration:

Patent, Patented, By Royal Letters Patent;

Registered, Registered Design;

Copyright;

Or a word or words to the like effect (as any of the above), in any language whatsoever.

5.21

The section also prohibits any mark so nearly resembling any of

those listed in paragraph 5.20 as is likely to be taken for that mark. Although the section refers only to words it is the practice to refuse registration to marks which incorporate symbols "to the like effect", such as the letter C, or R, in a circle, denoting copyright and registered respectively. Where a mark tendered for registration contains such a symbol, the applicant is requested to remove it before acceptance. Failure to do so would entail refusal of the application, not under section 15, for that does not refer to symbols, but under the Registrar's general discretion.

5.22

Anyone who falsely represents that an unregistered mark is in fact registered is guilty of a criminal offence and liable to a fine or period of imprisonment, or both - section 81.

5.23

Section 15(b) adds to the list of mandatory refusable marks any mark, which is specifically declared by the Minister in any regulations made under the act to be a prohibited mark. Regulation 13 was made under this power. Paragraphs (1)(a)(b) (c) (d)(e) and (f) of regulation 13 provides a list of additional prohibited marks including; "To counterfeit this is a forgery", "Registered Trade Mark", "Registered service mark" or any words to the like effect of these prohibited words as well as "Bunga Raya" and the representations of the hibiscus or any colourable imitations.

5.24

Sometimes, a label containing a signature mark may also have the words "None genuine without this signature". It is a moot point whether that phrase comes within the prohibition but it is probably safer to request that the phrase be removed before registration; it adds nothing to a mark's distinctiveness and any registration, which included it, might be vulnerable to an action for invalidity.

Protected Representations and Emblems

5.30

Paragraph (1)(c)(d)(e) and (f) regulation 13 adds the following to the list of prohibited marks:

representations of or words referring to Seri Paduka Baginda Yang di-Pertuan Agong, Ruler of a State of any colourable imitation therefore; representations of any of the royal palaces or of any building owned by the Federal Government or State Government or any other government or any colourable imitation thereof; the word ASEAN and the representation of the ASEAN logotype or any colourable imitation thereof; the words ASEAN and the representation of the ASEAN logotype or any colourable imitation thereof; the words "Red Crescent" or "Geneva Cross" and representations of the Red Crescent, the Geneva Cross and other crosses in red, or of the Swiss Federal Cross in white or silver on a red ground or such representation in a similar colour or colours.

5.31

It can readily be understood that official sanction should not appear to be given to the use of representations of members of the Royal family as trade marks by permitting their registration, no matter how popular among traders such subject might be. Such commercial usage affronts the dignity of the nation's rulers. Similar considerations apply to the prohibition on the commercial exploitation of the national flower by individual traders.

5.32

The symbol of the International Red Cross Organization is widely protected by national and international agreements. The original symbol is a colour reversal of the Swiss national flag. In Islamic countries, the symbol of the Red Crescent takes the place of the Red Cross, because of the Christian connotations attached to the device of a cross. The latter view may be the reason why the prohibition in regulation 13(1) extends to "other crosses in red", an expression, which embraces crosses of any shape. Although not expressly included, the prohibition is, in practice, extended to the words "Red Cross".

5.33

Section 13(2) provides that where a trade mark is registered without limitations as to colour, it shall be deemed to be registered for all colours. In view of this, a mark which consisted of a cross, or a crescent, and for which an ordinary

representation in black and white was included on the application form could, after registration, be used in red. To cater for this possibility, paragraph (2) of regulation 13 states that the Registrar may require the applicant, as a condition of registration, to undertake not to use the cross device in red, or in white on a red ground, or silver on a red ground, or in any similar colour or colours.

5.34

A second category of prohibited emblems and words is given in regulation 14, although regulation 14 provides that the following devices "shall not" appear on a trade mark subject to an application for registration. The list is as follows:

(a) representations of, or mottoes of or words referring to the royal or imperial arms, crest, armorial bearings or insignia or devices so nearly resembling any of them as to be likely to be mistaken for them;

(b) representations of, or mottoes of or words referring to, the royal or imperial crowns, or any of the royal, imperial or national flags;

(c) representations of, or mottoes of or words referring to the crests, armorial bearings or insignia of the Malaysian Army, Royal Malaysian Navy, Royal Malaysian Air Force and of the Royal Malaysia Police, or the devices so nearly resembling any of the foregoing as to be likely to be mistaken for them.

5.37

Under Article 6ter of the Paris Convention for the Protection of Industrial Property, to which Malaysia acceded in 1988, the Registrar is under an obligation to refuse to register any mark which consists of, or contains, the armorial bearings, flags or other State emblems of countries which are parties to the Convention, unless the applicant can supply the written consent to registration from the appropriate official authority in the country whose flag or other emblem appears in the mark. The obligation extends to the armorial bearings, flag, other emblems, abbreviations, or title of international intergovernmental bodies of which one or more countries of the Union are members. It does not extend to emblems of government bodies. The emblem of the International Olympic Committee is protected by a separate convention.

5.38

Illustrations of flags of member countries are kept in a special record in the registry, as are copies of the protectable emblems, which the signatory countries and international intergovernmental bodies have furnished through the International Bureau at Geneva. They should be treated as part of the search material whenever there is a possibility that a mark is, or resembles, a prohibited emblem under the Paris Convention.

Private Rights

5.40

Where the name or representation of a living person appears on a mark, the Registrar may require the applicant to furnish him with the consent of that person. If the person is recently dead, the consent must be supplied by his legal representatives. In the absence of consent, the Registrar may refuse to register the mark - regulation 15.

5.41

Some guidance as to the meaning of the phrase "recently dead" may be gained from the case of "Edward VII" T.M., [1966] R.P.C. 1. The U.K. Registrar refused to register the mark (for cigars), basing his decision on a rule worded similarly to that of regulation 15. At the time of the application the English King of that name had been dead for over 60 years, but was "still a regal figure in the public mind". The Registrar's decision, however, was reversed on appeal.

5.42

Famous historical characters, especially where they have universally admired attributes, are popular subjects for trade marks, and there is usually no objection to the practice. Where, however, use of a name or representation of a character in a commercial context is like to cause offence, such as, for example, the name or picture of a revered religious character, refusal might be appropriate under the Registrar's general discretionary power, or under the prohibition of scandalous marks - see paragraph 5.5.

5.43

Regulation 15 does not apply to the use as a trade mark, or as part of a trade mark, of the name or representation of a property belonging to another, other than his name or likeness. Nevertheless, in an appropriate case, refusal of the application unless the consent of the owner of the property is supplied might be a proper course in the exercise of the Registrar's discretion, or as a mark likely to deceive the public. Into this category would come marks such as those using a picture of any well-known Public Building, a famous painting, a particular vineyard (if the goods were wine), unless the applicant could show that he owned the property or had the permission of the owner. Before any such application is refused, enquiry should be made of the facts and, where appropriate, the applicant should be given an opportunity of providing the consent of the owner of the property concerned, or of proving his own ownership in a statutory declaration.

CHAPTER 6 - REPRESENTATIONS OF MARKS

Form of Representation

6.1

Marks tendered for registration as trade marks are commonly in two dimensions only, and are ordinarily represented in plain black and white, as marks on a surface. If the mark consists of a word in plain lettering, it is usually typed onto the application form and is easily represented in the register, and in the Gazette where all accepted marks must be advertised. If, however, the mark is a word or character in a particular typeface, or is in a special language script such as Chinese, or is a device, then exact representations of it must be supplied to the Registrar. This chapter sets out the law and practice regarding representations of all marks, including those in three dimensions and other unusual cases.

6.2

The form of application to register a trade mark, form TM.5, includes a space where a representation of the mark must be affixed. A similar space is provided on other forms of application, such as an application to register a Certification Trade Mark, form TM.5 (see chapter 26), and an application to register an invented word as a Defensive Trade Mark, form TM.5 (see chapter 27). Representations must also be furnished in other cases, such as on a sheet accompanying a request to the Registrar on form TM.4 for his preliminary advice on mark's distinctiveness, and on Certificates of Registration issued by the Registrar on forms TM.10. Further, every application for registration of a trade mark must be accompanied by five extra representations of the mark on form TM.5. The contents of this chapter apply principally to applications for registration, but also apply, *mutatis mutandis* to the other cases.

6.3

If a representation of a trade mark cannot be affixed to the form of application, regulation 19 requires that it be mounted on durable material, or other suitable material, and annexed to the form. This will most often be necessary when the mark is larger than will fit into the space provided on the form. If linen is not used, and the Registrar is of the opinion that the

material used will not preserve the features of the mark over a time, he may require a further representation to be supplied on a material specified by him - regulation 19(2).

6.4

Six Exact copies of the representation affixed or annexed to the form of application must be supplied on forms TM.5 - regulation 18(1). In practice, additional, original, representations are usually furnished. These, too, must be of a permanent nature, since they are used to create the search indexes etc. - see paragraph 2.20

6.5

All representations of a trade mark must be large enough to enable every element in it to be seen easily, both when it is first examined and when it is printed in the Government Gazette for opposition purposes. If any representation is unsatisfactory in this respect, the applicant should be asked to substitute larger ones - see paragraph 6.11.

Photocopies

6.10

It is not unusual for an applicant to furnish photocopies of his mark instead of a representation of the mark itself, even on the application form. These should not be accepted, if any part of a mark is not clear. If the original mark is in colour, the copying process may not even produce a true impression of the mark. This may prevent a proper consideration, at the examination stage, of whether the mark is distinctive, or whether it too closely resembles the mark of another proprietor. Applicants must furnish original representations of their marks. The Registrar must know what it is that he is being asked to consider, and members of the public who consult the register, or search through the indexes of marks, must know exactly what the mark, as it will be used, looks like.

6.11

Even if an original representation of the mark is supplied, the Registrar may call for a better one if he is dissatisfied with it - regulation 20. If this is not supplied he may refuse to proceed with the application. (The effect of this is that,

eventually, the application will be deemed to have been abandoned under section 29(1).)

Coloured Representation

6.15

Where a coloured representation is supplied, there may be some doubt about the applicant's intentions. Sometimes, use of the mark is to be limited to certain colours, either because the Registrar imposes that condition in order to make the mark distinctive - section 13(1) or because the applicant wishes it. Without such a limitation, a mark is deemed to be registered for all colours, even if the representation on the register is a coloured one - section 13(2).

6.16

When a case with a coloured representation is first taken up for examination, the application form should be examined to see whether the applicant has endorsed it with a colour limitation. If there is none, it will be necessary to consider whether any distinctiveness added by the colour will detract from a proper consideration of the mark as it might be used in any other colours which registration would permit. If there is any doubt about this, the applicant should be asked to state his intentions. If he replies that he does not wish to be restricted in his use of the mark, to the exact colours of the representation supplied, he should be asked to furnish a representation in good black and white, subject to what is said in the next paragraph. The coloured representation on the forms TM.5 should also be changed.

6.17

Although section 13(2) states that a mark registered without a colour limitation is deemed to be registered for all colours, it does not mean that a two-colour mark represented simply in black and white, can be used in three or more colours. It means only that such a mark can be used with any colour substituted for black and any colour substituted for white. If a proprietor wishes to be able to use his mark in more than two colours his representations must indicate that fact in some way.

Unusual Marks

6.18

Special treatment must be accorded to marks, which cannot be represented in one of the ways described above. In these cases, there are two problems: how to represent the mark, and how to refer to it in the register. The manner of dealing with them may be illustrated by the following examples.

6.19

Where a mark is in three dimensions, the Registrar will require a specimen of it to be deposited in the office. If it is very large, he will require a model of it on a reduced scale - regulation 21(1). A description of the mark, sufficient to identify it uniquely, is entered on the application form; the accompanying forms TM.5, and any subsequent advertisement or entry on the register. Request from applicants and their agents for assistance in framing such descriptions should readily be given, but the last word concerning what goes into the register will always lie with the Registrar - regulation 21(2). Examples of such descriptions are given below.

1. "The mark consists of the colour blue applied to the whole surface of the container in which the goods are sold, a specimen of which has been deposited at the office." (The goods claimed were liquefied gas.)

2. "The mark consists of the colour red applied in five evenly spaced longitudinal stripes to white toothpaste on extrusion in circular cross-section from the container in which the toothpaste is sold." (The goods claimed were toothpaste and model of a length extruded coloured paste was supplied; the application was refused - see paragraph 4.41).

3. "The mark consists of the shape and appearance applied to a bottle when used as a container for the goods, characterised by vertical flutes or ribs throughout the surface of the bottle and interrupted by a smooth middle panel dividing the upper and lower fluted areas, the whole being contained in a configuration comprising an upper section to which a cap or closure may be affixed; a neck; a relatively broad central section; a waist; and a base having a tapering effect". (This was the famous Coca-Cola bottle case. The description reads as if it were drafted by a patent lawyer! A simpler approach would have been to deposit a specimen of the bottle and to describe

the mark as consisting of "a bottle of the shape shown in the representation".

(The application was refused - see paragraph 4.9)

Multiple Applications

6.20

Each application for registration must relate to a single class of goods. If an applicant wishes to register his mark for goods falling within more than one international class he must make separate applications. Similarly, if he wishes to register different marks for the same goods in the same class, he must make separate applications. Every one of these must contain a representation of the mark - regulation 18(2). Even where an applicant applies to register a series of marks under Section 24, he must supply a representation and five copies of every mark in the series - regulations 18(1) & 22. (The circumstances in which an applicant may register a series are explained in chapter 16.)

Transliteration and Translation

6.21

Where a trade mark contains a word or words in characters other than Roman, regulation 23(1) states that a sufficient transliteration and translation must be endorsed on the application form and on each of the accompanying forms TM.5, unless the Registrar otherwise desires. A transliteration will indicate what the word sounds like in the original language, while a translation will indicate its meaning in the English language. Together, they enable the Registrar to determine whether any objection needs to be taken to the mark, when it is judged, as it must be, both by its sound and by its sense. Without this provision, an applicant might be able to register, say, the word "new" by representing it in Chinese or Russian (Cyrillic) characters, and so gain an unjustified monopoly.

6.22

Under a government directive, every trade mark whose registration is applied for in Malaysia and which consists of, or contains, Chinese characters, must include a translation.

6.23

Where a trade mark contains a word or words in a language other than English, the Registrar may ask for an exact translation thereof-regulation 23(3). In practice, the Registrar will not normally ask for a translation of words in Bahasa Malaysia. Every other language must be translated, and the translation and the name of the language must be entered on the application form and signed by the applicant or his agent. The translation, and the name of the language, will be given in any subsequent advertisement of the mark and any entry of it in the register. Whether or not a translation is required, the English meaning is added to the search indexes.

Representations of the Mark

6.24

For the purposes of advertisement of an accepted application in the Gazette, the applicant is required, at the appropriate time, to supply a satisfactory representation of his mark - regulation 34.

6.25

Where the application relates to a series of marks under section 24, each mark in the series must be advertised and accompanied, if the Registrar thinks fit, by a statement of the manner in respect of which the marks differ from one another. Usually, the differences will be obvious, and a statement of them will not be necessary. Where they are not obvious, or where there may be some doubt whether the several marks form a single series within the terms of section 24, a statement should be included. In such a case, the statement should be agreed with the applicant or his agent, if possible.

Amended Marks

6.26

In certain circumstances, an applicant may be permitted to amend his mark before it is advertised. This is most often done to overcome an objection taken to it. For example, extraneous and non-trade mark matter on a label mark may be removed, a slight amendment may be allowed in order to avoid a citation (provided that the alteration does not substantially affect the identity of the mark - section 74(2)), or the change may be

simply one of supplying better representations, such as when coloured ones were submitted in error. In all cases, the applicant, or his agent, must complete form TM. 26 and pay the appropriate fee - regulation 24.

Fresh representations should also be supplied on forms TM.5 and substituted for the original forms TM.5.

6.27

In no circumstances may an applicant be permitted to amend his mark after it has been advertised and before it is registered, even in opposition proceedings. Such a change might prejudice the interests of another proprietor who had no objection to the original mark, (and is not a party to the opposition) but who might be aggrieved by the amendment. Alterations of registered marks are subject to special provisions - see chapter 15.

CHAPTER 7- APPLICATIONS TO REGISTER

Persons Who May Apply

7.1

Every application for registration of trade mark must be made on the appropriate form, or an authorised substitute (which must bear the TM. number of the official equivalent) and the form must be signed by the applicant or his agent- regulations 4 and 18(1). Acceptable representations of the mark must be furnished- see chapter 6. The correct fee must be paid- regulation 3. An application may not cover more than one mark (except where it is made under section 24 - see chapter 16) and may not cover goods or services within more than one international class - regulation 18(2) and section 25(2).

7.2

Any person claiming to be the proprietor of the mark may apply for its registration provided that he is either using the mark already or proposes to use it. The meaning of 'proposing to use', and the only three statutory exceptions to the use requirement are dealt with in chapters 12, 19 and 27.

7.3

Only the legal entity, which owns the mark, can apply to register it. Any person signing on behalf of the owner must state the capacity in which he does so. (The role of agents is examined in chapter 2). Applicants may be natural persons or juristic persons. Juristic person includes all bodies capable of suing or being sued at law. Individuals and incorporated bodies are thus both 'persons' within the meaning of the Act.

7.4

An individual validates a legal document whether or not it is under seal, by his signature (which is unique to him). A body corporate cannot have a signature and normally validates documents by its seal. However, officials of the corporate body may sign on its behalf. Documents submitted to the office by a body corporate must normally be signed by a director, the Secretary, or by some other principal officer- regulation 7(1).

Partnerships

7.10

Partnerships may own trade marks and may apply for their registration. The application must contain the full names of all the partners and must be signed by all of them or by a qualified partner who states that he signs on behalf of the partnership- regulation 7(1).

7.11

Documents signed on behalf of bodies corporate or partnerships by persons other than those mentioned in paragraphs 7.4 and 7.10 will be accepted by the Registrar only if he is satisfied that the signatory has the authority of the owner to do so. Except in the case of an authorised agent, enquiry should be made in all cases coming within this paragraph.

Joint Ventures

7.15

Occasionally, two or more legal entities will combine in a particular enterprise and may use a trade mark solely within that joint venture. In such a case, any application to register the mark must be signed by, or on behalf of, all members of the venture. See section 21 for a statement of the registration rights accruing to the members of such an enterprise.

Unincorporated Bodies

7.16

Unincorporated bodies, such as associations, clubs, unions, etc., may wish to own and register marks. Applications must be signed on behalf of the association by a responsible person who states the capacity in which he does so - regulation 7(1). A problem sometimes encountered in such a case is that the affairs of the organisation are frequently run by a committee whose members are elected and may change from time to time. The solution is to ensure that the application is signed by a holder of one of the permanent officer ships at the time and who states that he does so on behalf of that office. An appropriate wording would be:

Signed by (signature) Secretary for the time being, on behalf of (name of the organisation).

It is incumbent on the owner of the mark (the members, through the committee which manages its affairs) to ensure that any changes in the holder of the office (Secretary, or whatever) are notified promptly to the registrar under section 43(1)(a).

Government and other Official Bodies

7.20

Government departments, municipalities, organisations created by the State, and similar bodies operating with government authority may apply to register marks which they own, whether they are of Malaysian or of foreign origin. If there is any doubt as to the nature of the applicant, an appropriate enquiry should be made.

National treatment under the Paris Convention

7.21

Nationals of other contracting States of the Paris Convention must be given the same treatment as that given to nationals of Malaysia. This is one of the obligations undertaken by adherence to the Paris Convention and the same treatment as given to their nationals is required to be accorded by other member countries to applications made of them by Malaysian nationals. The principle of national treatment also applies to nationals of non-member countries if they are domiciled in or have a real and effective industrial or commercial establishment in a member State. An application made in another member state may be accorded priority in certain circumstances—see paragraphs 8.24 and 11.11.

7.22

The question of whether a foreign applicant is a legal entity is decided, if it arises, according to the laws of the country where the applicant is resident, or has its principal place of business.

Death of an Applicant before Registration

7.25

Where an application is made by an individual and he dies before his mark is registered, the application may be prosecuted by the deceased's personal representative, on proof of his appointment being furnished to be Registrar. A copy of

the grant of probate, or the letters of administration, will usually suffice. Regulation 55 provides that the name to be entered on the register in place of the deceased applicant is that of the owner of the trade mark. This means the beneficial owner, and the mark cannot be registered in the name of a personal representative. This is because section 7 prohibits the entry of a trust in the register. It will be necessary to ascertain the name of the beneficial owner of the mark and this should be obtained from the personal representative. It is not normally necessary to enquire further into the disposal of the assets of the deceased.

Body Corporate about to be Constituted

7.30

One of the exceptions to the rule that only a person who uses, or intends to use, the mark himself may apply for registration is where the Registrar is satisfied that the applicant intends to assign the mark to a body corporate which is about to be constituted - section 26(1)(a). The procedure is subject to a number of special conditions.

7.31

Within six months of the mark being registered in the name of the applicant, it must have been assigned to the new corporation and that body must be entered on the register as proprietor - section 26(3). There is absolutely no power to extend this period since it is one 'expressly provided in the Act" and so does not come within the general power to grant extensions of time conferred by regulation 84. Failure to record the new corporation as the owner within the prescribed period results in the registration ceasing to have effect (i.e., the infringement right cease), and the Registrar must amend the register accordingly.

Application Simultaneous with Registered User Application

7.35

The second exception to the requirement that the owner must use the mark himself is contained in section 26(1)(b), and is concerned with particular category of what are referred to in the Act as registered user applications. These are governed by sections 48 to 54 and are dealt with in chapter 19. It is

sufficient for the purposes of this chapter to recall that a registered user is one who uses the mark under the direct superintendence of the owner, who is responsible for maintaining the quality of goods sold under the mark.

7.36

An application by a registered proprietor to register a user may be made at any time, but an application to do so made by the applicant for registration of a trade mark must accompany the application for registration. The registered user application is examined in the usual way, and, if it is accepted, the fact that the owner of the mark will never use it himself is not a ground of objection to his application for registration. The mark must meet all the criteria for registration independently of the merits of the registered user application.

7.37

The requirement that the registered user application and the application for registration must be made together, means that the parties have reached a written agreement before the applications are filed at the office. It is not open to the applicant to finalise his arrangements after submitting his applications for examination. In those circumstances he must re-apply.

Proposed to be Used 'by Him'

7.40

In the case of "Pussy Galore" T.M., [1967]R.P.C.265, the widow of the novelist Ian Fleming, creator of the character James Bond, Special Agent 007, applied to register the names of several of the characters in his books as trade marks, intending to appoint various merchants as registered user. It was held that the applicant did not have any intention to use the mark to indicate the necessary trade connection with her, and the U.K. equivalent of section 26(1)(b) did not apply, as the licensees had not been secured. In dealing with this kind of application, it must be kept in mind that section 25(1) requires that, subject to the two explicit exceptions already mentioned above, a person may make an application for registration only if the mark is used or proposed to be used

"by him".

7.41

Another leading case on meaning of the words 'proposed to be used' in section 25(1) is that of "Notox" T.M.(Duckers),(1928)45 R.P.C.397. In that case, the applicant is ought to register marks, which might turn out to be useful some day. It was held that was insufficient to bring the applications within the statutory provisions. A proposal to use did not mean a contingent possibility; what was required was a fixed intention to use the mark at the time its registration was applied for. (Failure to use a mark within three years of its registration is a ground to have the registration declared invalid - section 46).

Receipt of Documents

7.50

If requested, all documents, including applications for registration, that are accompanied by a fee should be acknowledged and a receipt given. Agents may prefer to provide their own pre-printed receipts at the time of filing, and these may be completed by giving them the office chop, or date stamp.

7.51

All documents, including correspondence, should be chopped with the date of receipt, whether or not a receipt is given. This becomes the official date of filing of the document and is important if any questions of priority or time limits should later be raised. For documents sent by post, the date of receipt may, on rare occasions, be deemed to be different from the actual date - see regulation 8 - but any case where the difference is vital should be discussed with Registrar before any final decision is taken.

7.52

If a document has to be amended, the appropriate form should be submitted;
the original form should not be returned. In such a case, the original filing date stands - section 25(10).

7.53

Documents filed at one of the regional offices in Sabah or Sarawak are treated in the same way as those filed at the central office in Kuala Lumpur. The date of filing remains unchanged notwithstanding the fact that the document may have to be sent on to Kuala Lumpur to be dealt with -section 5(3).

The Repealed Ordinances-Transitional Provisions

7.60

Section 84(1) repeals the Trade Marks Ordinance, 1950, the Trade Mark Ordinance of Sabah and the Trade Marks Ordinance of Sarawak. Any subsidiary legislation made under the repealed laws, however, such as regulations, continues in force and has effect as if it had been made under the 1976 Act, but only insofar as it is not inconsistent with that Act - section 84(2)(a).

7.61

In addition to the general provisions of section 84, the Act contains special provisions regarding applications filed under the repealed ordinances, and registrations obtained under them. They are to be found in sections 2(2)(3), 6(3)(4)(5) and 32(2). Taken together with the other provisions of the Act, including, most importantly, section 1(2), which applies the Act throughout Malaysia, the manner of dealing with filings and registrations under the repealed ordinances is set out in the following paragraphs.

7.62

Notwithstanding their repeal, applications filed under any of the repealed ordinances and which were still pending when the 1976 Act came into force on 1st September, 1983, have to be examined according to the criteria established by the former laws - section 2(3). In practice, this does not mean that different examination criteria apply, since the laws had a common origin and contain the same or very similar wording. The most obvious result of the provisions is that any subsequent registration dates back to the date of the original filing in the component region involved and becomes a registration under the appropriate repealed law. As such, the present Act's transitional provisions relating to registrations in the

component regions, apply to it.

7.63

Section 2(2) provides that the Act applies to trade marks registered under the respective repealed ordinances, but that is 'subject to subsection (4) of section 6". The latter provision deals with the consequences of section 6(3), which reads:

"The previous registers of trade marks kept under the repealed ordinances shall be incorporated with and form of the register in accordance with the entries in the previous registers immediately before this Act comes into force".

Before examining the effect of subsection (4), therefore, it is necessary to look at the effect of subsection (3).

7.64

Section 6(3) merges the three previously separate registers into a single register, which is the register created under the 1976 Act. It does not merge the individual registrations. Thus, if a mark was registered under all three previous registers in the name of the same proprietor, he continues to have three registrations, but after 1st September 1983, they are on the new register where they live side-by side. If the registrations are identical in all respects they will, in effect, be duplicate (or triplicate) registrations.

Of course, the previous registrations may not be identical in all respects. The marks may differ slightly, the dates of filing may not be the same, the list of goods may not be identical, one may have a registered user, the others may not, or they may have different registered users, or registered user with different terms, and so on. In themselves, such differences do not create any problems, since each registration is independent of the others.

7.65

The independent existence on the new register, of registrations formerly existing on the old registers, is shown by section 6(5). Section 30 provides that the date of registration is deemed to be the date of the application to register the mark under the 1976 Act. Section 6(5) provides that, notwithstanding section 30, the date of entry in the new register is deemed to

be the original registration, i.e., the dates of registration in the regional register or registers concerned.

7.66

This is reinforced by section 32(2), which provides that the renewal date of any previous registration, which is incorporated into the new register, is the date on which it would have been renewable in the old register. Plainly, if the same mark were registered by the same proprietor in all three-component regions but on different dates, they would be renewable on different dates, and this could only come about if they retained their separate identities.

7.67

Since, by section 6(3), registrations obtained under the repealed ordinance form part of the register established under the 1976 Act, and since, by section 1(2), that Act applies throughout Malaysia, the registration rights obtained in respect of the former registrations are after 1st September, 1983, enforceable throughout Malaysia instead of, as formerly, only within the component region where registration was originally obtained. As stated above, one consequence of this is that a proprietor may have duplicate or overlapping registrations. This result was not sufficiently dealt with in the 1976 Act. (Section 6(4)(a) deals only with the case of a single ownership of registrations of the same mark in all three component regions, but leaves the consequences of deeming the mark to be 'a' registered trade mark unclear).

The much more difficult problem of what to do about similar registrations in the different ownerships, which hitherto had co-existed without conflict because of the geographical separation of their rights, but whose rights would now exist throughout Malaysia unless special measures were taken to deal with them, is the purpose of section 6(4) which must now be examined in detail.

7.68

Apart from paragraph (a), mentioned in the preceding paragraph, section 6(4) deals with three broad categories of case existing on 1st September 1983. These are:

(i) registration held in one, or two, component regions and, in

the remaining region or regions, there is neither any conflicting registration nor any surviving conflicting application - section 6(4)(b);

(ii) as (i) above, but there is a conflicting registration in the remaining region or regions - section 6(4)(c);

(iii) as (i) above, but there is a conflicting application in the remaining region or regions - section 6(4)(d).

No conflicting registration or application

7.69

The first of the three categories in paragraph 7.68 does not pose any fundamental problem. The registration rights are safely extended throughout the whole of Malaysia without detriment to the existing interests of any other trader. (It might just be possible that the owner of an unregistered mark used by him in the remaining region or regions might have wished to oppose the extension of the registered owner's rights. In such case, it is still open to him to apply for an appropriate rectification of the register).

7.70

If, on 1st September 1983, there, existed a pending conflicting application and/or registration of application filed in the same region, or one of them, as the registration considered under paragraph 7.69, the application would have been dealt with in accordance with the provisions of the relevant ordinance effective at the time of filing. These provision are similar to those applicable to citations made under section 19 in respect of filings made after 1st September, 1983, and the honest concurrent user provision of the former equivalent of section 20 applied to the pending application.

7.71

If, on 1st September, 1983, there existed a pending conflicting application made, not in the same region as the registration considered under paragraph 7.69, but in the remaining region or regions, the matter would have been dealt with under the third category listed in the paragraph 7.68 - see paragraph 7.74. However, if the pending application was subsequently refused, or abandoned, or successfully opposed, the situation became one where there was no conflict with another's rights and paragraph

7.69 applied.

Conflicting registration

7.72

The second category mentioned in paragraph 7.68 is dealt with by permitting the newly conflicting registration rights to co-exist, subject to the marks having been in concurrent use by their respective proprietors. In judging this, the provisions of section 20(1) are applied - section 6(4)(c). The effect of section 20(1) is considered in detail in chapter 13, but in the Act requires that some evidence of the concurrent use must be furnished; it is not sufficient to assume that the registrations in the component regions were in actual use by their proprietors. Section 6(4)(c) refers to concurrent use and the question of whether there is any or not is one of fact, susceptible of evidence.

7.73

Where concurrent use is shown to the satisfaction of the Registrar to have occurred, the Registrar still has a discretion, conferred by section 20, to impose such conditions, limitations, amendments or modifications as he thinks fit. This is made clear by expressly referring to section 6(4)(c) in the opening words of section 20(1) as one of the cases where this discretionary power exists. In exercising this power, the Registrar is guided by the same considerations as apply to potential conflicts dealt with wholly under the 1976 Act. In particular, he may require that the registration rights be limited to the component region or regions in which the respective proprietors formerly had their registrations. The overriding consideration is whether or not the concurrent registrations would lead to confusion or deception of the public. If they would, some limitation is appropriate.

Conflicting application

7.74

The third category of case mentioned in paragraph 7.68 restricts the existing registration to the component region or regions in which it was originally registered, leaving the application made by the other proprietor in the remaining region or regions to proceed to registration. If it does not do

so because, for example, it is refused, abandoned or successfully opposed, the situation reverts to that described in paragraph 7.68(i) and there is no barrier to the existing registration rights being extended throughout Malaysia.

7.75

Where, in the situation posed by the third category, the conflicting application proceeds to registration, it is, of course, a registration made under the relevant repealed ordinance. As such, it is one of those incorporated into the new register created by the 1976 Act., and hence has to be considered anew under the second category. Whether or not there is any concurrent user, the applicant's registration rights should be limited to the region in which the original application was filed. This is only equitable, in view of the restriction imposed on the prior registrant by section 6(4)(c). Should this practice be queried, it may be justified on equitable grounds; these are quite adequate for the exercise of the Registrar's discretionary powers.

7.76

In dealing with question of whether or not there is a conflict, within the meaning employed in the above paragraphs, between registrations obtained, or applications filed, the ordinance in force at the relevant dates must be applied. However, the criteria applicable are the same in all regions, and are, in practice, the same as those employed in the corresponding provisions of the 1976 Act. They are considered in detail in chapter 11.

7.77

The Trade Marks (Amendment) Act 1994 contains savings provisions as follows:

"The amendment to section 11, section 14, subsections 19(1) and 19(3), subsection 20(1), subsections 22(1), subsection 26(1), section 27, section 28, section 42, subsections 46(1), 46(2), 46(3) and 46(5), section 48, paragraphs 49(1)(c) and 49(1)(d), section 50, section 53, section 54, subsections 55(5) and 55(6), section 68, section 70, subsection 77(1) and subsection 79(1) of the principal Act shall not affect any applications for registration of a trade mark, or for registration as a

registered user, or the registration of a trade mark, or a registered user, as the case may be, made under this principal Act before the commencement of this Act and those provisions shall apply to that application or registration, as the case may be, as if they have not been so amended.

CHAPTER 8 EXAMINATION OF APPLICATIONS FOR REGISTRATION (GENERAL)

Outline of Procedure

8.1

A full explanation of the examination process applied to applications to register a trade mark or service mark is contained in chapters 9 to 15 inclusive. This chapter provides a broad outline, or overview, of the routine procedure to be followed, although some important points of examination practice are also indicated.

8.2

It may be necessary to issue detailed, temporary, instructions from time to time for the benefit of individual officers, particularly while undergoing training, but the flow of work explained in this chapter will apply generally. If any permanent changes to it become necessary, revised paragraphs will be provided.

Application Numbers

8.5

Each application is allocated a number by the receipts clerk. These numbers are in chronological order of filing date. (The date of filing of an application for registration is explained in chapter 2, and paragraph 7.51.) The next number to be used is taken from a master record kept in the registry. The lodgement date and brief particulars of the application are entered in the master record by the receipts clerk. He is also responsible for issuing any receipts and for recording the fees paid.

8.6

If an applicant wishes to register his mark in more than one international class, he must make a separate application, together with eight forms TM.5 (5 copies) - Regulation 18 (1), for each class, even if the mark is identical in each application. Such groups of applications filed on the same day should be sorted into international class order before being numbered.

8.8

Should the application succeed, the assigned number is retained and becomes the registration number. Not all applications will proceed to registration; some will be refused, others will be successfully opposed, or withdrawn. This means that there will be gaps in the numbering of actual registrations, but that has no detrimental consequences in practice; gaps will occur under any system, eg., removals for non-renewal or for any other reason. The advantages of a unitary numbering system are that files constitute the complete history of any given mark; they do not have to be renumbered when registration is made and new files do not have to be opened; and a possible source of confusion over which number to quote in correspondence is avoided.

Computer Record

8.15

After its receipt has been recorded, the numbered application is passed to the data capture clerk who updates the database and generates the necessary index cards. When that is done, he passes the case to the file-opening clerk.

Initial Contents of File

8.20

Each application is placed in an orange file cover, or jacket, and the appropriate particulars are entered on the outside front of the cover in the spaces provided. These consist of:

- the application number and year (nombor cap dagangan)
- the international class (kelas)
- the application date (tarikh permohonan)
- the international convention priority date claimed (tarikh tuntutan prioriti)
- the applicant's name (nama pemohon)
- the address for service (alamat permohonan/penyampaian)

8.21

The other spaces on the front cover are completed later and dependent on the outcome of the examination process. If the application is accepted for advertisement (or is advertised before acceptance), particulars of the advertisement in the Government Gazette (rujukan warta kerajaan), are entered in the

spaces provided on the file cover. These consist of the date of the Gazette number (nombor warta kerajaan) and the page (muka surat).

8.22

Provision for other entries (lain-lain) to be made on the cover is made by ruled boxes, which have no captions. One of these is always used to indicate the reason why a mark never reaches the register, or if it does so, why it was removed. This outcome is indicated briefly; e.g., 'refused', 'abandoned', 'cancelled', 'expired'. Another of the boxes are used as appropriate, e.g., to indicate any association requirements - see chapter 17.

8.23

Inside the cover, a blank minute sheet is attached at the left side. This will be used by the examiner and others to record: receipt and despatch of forms; correspondence with the applicant or his agent; and any internal minutes. A blank search report form is also placed on the inside left side of the file. On the right side, the application form and the remaining forms TM.5 are attached. (Some of the forms TM.5 will have been used to add to the indexes kept in the central and regional offices and for use of the public - see chapter 1.).

8.24

The documents accompanying any priority application under the Paris Convention should be placed on the right-hand side of the file and the minute sheet should be noted with the date of their filing. The date must not be later than six months after the date of filing of the earlier application in a Convention country and on which the priority is based; if it is, the minute sheet should be prominently noted to draw the Examiner's attention to it.

Examination Report

8.40

The examination report records the results of searches among the standard reference works and any specialist reference works, which may be indicated by the nature of the mark or by the specification of goods or services. These reference works, and their relevance, are considered below. It is important that

this work be undertaken thoroughly, and that all possible relevant information is recorded for the ultimate consideration of the Assistant Registrar who has to make the final decision on the acceptability or otherwise of the application.

Reference Works

8.41

The prime source to be used in the examination of any word mark, or of a mark which includes a word, is a dictionary of the appropriate language. Where the language is other than Bahasa Malaysia or English, the applicant may be asked to furnish a translation, under the power conferred by regulation 23, but this does not absolve the Registrar from checking its accuracy where there may be some doubt. Words and signs in foreign languages often do not have exact equivalents in Bahasa or English, and it is not unknown for applicants to supply somewhat free translations which obscure meanings that might be considered inimical to the success of their applications.

8.42

It should not be overlooked that many words, especially in English, have more than one meaning. Where one of these is well known and the other is not, the rarer meaning may be overlooked if familiarity with the common meaning leads the examiner to assume that it is the only one. It should be a routine practice to ascertain the meaning, if any, of every word tendered for registration, bearing in mind that its registration will confer on the applicant the exclusive right to it, and to any closely resembling words.

8.43

Where a word has more than one meaning, only one of which could serve as the basis of an objection, it is not open to an applicant to claim that the non-objectionable meaning must prevail, even if that is the commoner one. The meaning of any mark must always be considered in the context in which it is, or will be, used. If the objectionable meaning might be understood as having a reference to the goods or services, objection must be taken. For example, an application to register the word "Box" for kites in class 28 must fail; the word is descriptive of a kind of kite, and it is not open to an

applicant to argue that it means an evergreen shrub; at least, not successfully.

8.44

Any English dictionary, together with their supplements, may be relied on to provide meanings of English words.

8.45

Words which are newly coined, or which acquire fashionable new meanings, may not get into the dictionaries for some time, since editors of those works will wait to see whether the new acquisition establishes itself. Yet traders are ever eager to attach themselves to prevailing fashions, especially if they have laudatory connotations, in their effects to persuade the public to buy their goods rather than those of their competitors. The Registrar must bear this endemic habit in mind and not rely exclusively on dictionaries to ascertain the meanings of words. In "Heavenly" T.M., [1967] R.P.C. 306, the word had come to be used in a purely laudatory sense and its application for registration as a trade mark for cosmetics was refused, although only the religious sense appeared in the dictionaries. As well as his general knowledge, the Registrar may make reference to newspapers, magazines and radio or television programmes, in keeping abreast of changes in language.

8.47

Words in a foreign language, unless they are very obscure, are treated in the same way as their English or Bahasa Malaysia equivalents. If there is any indication that the word may be a foreign one, the relevant dictionary should be consulted, including that of the country of residence of the applicant.

8.48

Latin or archaic Greek words are not usually objected to, unless they are likely to have a generally well-understood meaning, such as "Nulli Secundus" (second to none) or "Pro Bono Publico" (for the public goods), which are plainly objectionable because of their laudatory meanings.

8.49

The Act includes a special prohibition on the registration of names and geographical names as trade marks, unless they are proved to be distinctive or at least capable of distinguishing. These subjects are considered in detail in chapter 12, but the initial search procedure should cover the relevant reference works in order to establish whether a word is a surname or geographical name and, if so, whether it is well known as such.

8.50

Telephone directories are a useful means of ascertaining on how frequent or how common the name is in an appropriate Malaysian directory, normally that for Kuala Lumpur. The results of the surname search should be noted on the report form.

8.51

Where the application form indicates that a mark might be a foreign name, (it might be part of the applicant's own name), appropriate inquiries must be made to ascertain whether it is well-known as a surname and whether it has any other meaning. The relevant foreign language dictionary should always be consulted in such a case.

8.52

In order to ascertain whether a word mark might be objected to on the ground that it is a geographical name, it will not normally be sufficient to consult an atlas. A decision on the registrability or otherwise of a geographical name will largely depend on what manufactures or produce, if any, it is noted for, as well as its size and location.

8.53

General application, which should be consulted as necessary by all examiners, is:

- Dictionary of Scientific and Technical Terms

Examination

8.60

When all the necessary searches and enquiries have been made and noted on the report forms and minute sheet, the case is ready to be examined. This involves some or all of the

following stages:

- (i) scrutiny and any necessary editing of the specification of goods or services - see chapter 9;
- (ii) applying the criteria for determining whether a prior conflicting right exists - see chapter 11;
- (iii) examination of any evidence of factual distinctiveness on registrability - see chapter 12;
- (iv) examination of any evidence of factual distinctiveness on usage and other circumstances - see chapter 13;
- (v) consideration of inherent deceptiveness - see chapter 14;
- (vi) the possible imposition of any limitations, etc. - see chapter 15. Some special cases are considered in chapters 10, 16 and 17.

Burden of Proof

8.65

The onus of showing that his mark is registrable is firmly on the applicant. Should the Registrar have any doubts, it is incumbent on the applicant to dispel them. Thus, where the Registrar remains in dubio even after taking into account any representations or evidence that the applicant brings forward in support of his application, the application must be refused because, in that event, the applicant has not discharged the legal onus which is on him. It is not up to the Registrar to prove that a mark does not meet the requirements of the Act. Of course, any objections, which the Registrar has, must not be fanciful, but must be based on reasonable grounds and the Registrar will be required to state those grounds in writing if the applicant wishes to appeal - section 25(4).

Objection Procedure

8.70

If the Registrar objects to an application, or requires any limitation, disclaimer, condition or modification, these must be conveyed to the applicant, who has a limited time in which to respond - regulations 27 and 28. This time may be extended for good reason - regulation 86. The applicant's response may be either a considered reply in writing or by way of arguments of submission or the next stage a request for a hearing. If no response is made within the time allowed, the application is deemed to have been abandoned.

8.71

After considering the applicant's response, if any, the Registrar reaches his final decision in the case and this is conveyed in writing to the applicant - regulation 29. If the applicant is aggrieved by the decision he can appeal it to the Court. Sometimes an applicant will wish to withdraw his application instead of having it formally refused, believing that this course of action preserves his right to make a fresh application at a later date. Such a request may be acceded to, although, in law, formal refusal would not prevent a fresh application from being made if the facts or the law were different.

8.72

Those applications which are refused or withdrawn (whether actually withdrawn or deemed to be so) are removed from the record of pending applications and no longer form part of the search material. If an application is under appeal, however, it remains on record until the appeal, or any further appeal, is determined.

8.73

The remaining provision, which ensures that applications do not remain on record sine die applies to those to which the Registrar has no objection. Section 29(1) and regulation 53(1) provide that, where non-completion is caused by default on the part of the applicant, and more than 6 months have passed from the date of the advertisement of the application, the Registrar may give notice in writing to the applicant at his address for service of the non-completion, and if after twelve months from the date of the advertisement the registration is not completed by reason of default on the part of the applicant, the application shall lapse and shall be removed from record.

8.74

Notice the difference between deemed abandonment under regulation 53, and deemed abandoned under regulations 27 and 28. Taken together, these three regulations cater for the final disposal of all applications, which do not make it onto the register. Without them, there would be no means of ensuring

that derelict applications did not remain a permanent part of the search material.

Post Examination Procedure

8.80

The manner in which responses to any objections taken to the application are dealt with, are set out in chapter 15. Marks to which no objections are taken, or which are accepted subject to limitations etc., are advertised for opposition purposes. The subject of advertisement is dealt with in chapter 6. Appeals against a refusal to accept or to advertise a mark are the subject of chapter 23. The handling of oppositions is set out in chapter 24.

CHAPTER 9 - CLASSIFICATION

Quick Guide to Classification Procedures

A checklist adapted from the Draft Work Manuals of the Australian & U.K. Lists

- 1) Are the goods or services claimed in the correct class? (see 9.11)
- 2) Is it clear from the NICE list which class the goods or services fall into? (9.26)
- 3) If the service cannot be classified using the NICE alphabetical list is it possible to classify the service using the guide at 9.27?
- 4) Does the specification include goods/ services that do not relate to the class listed on the application (see 9.10)
- 5) Is it clear what the specification proposed by the applicant is meant to cover? If not further inquiry will have to be made. (9.26)
- 6) Is the claim made in the specification too broad? (e.g. all services in class 42) (9.20) (9.23) (9.24).

The Specification

9.1

The list of goods or services in respect of which an applicant wishes to register his mark is known as the "specification"-section 3(1). Any rights derived from the registration are strictly limited to the specification. Section 38(1) states that these rights are, "in relation to goods or services in respect of which the trade mark is registered." This is to be contrasted with the legislation of some other jurisdictions, which extends infringement rights to goods or services, which are "similar" (or some other equivalent phrase) to those on the register. The interpretation of a specification in an infringement action is matter for the Court and not the Registrar, but it would clearly be embarrassing if the Court were to be presented with specifications approved by the Registrar that were ambiguous or unclear. It is very important, therefore that the specification be clear and unambiguous with consistent phrasing used wherever possible.

9.2

There is another reason why great care must be taken in examining the specification. The distinctiveness, or otherwise, of a trade mark will frequently depend on the nature of the goods or services in relation to which it is to be used. If the specification is vague, it may be impossible to make an adequate judgment of a mark's acceptability for registration.

9.3

Badly worded and vague specifications have another deleterious effect on the work of the office. Unless the specification of goods or services can be construed without difficulty, it may be impossible to determine whether it conflicts with rights belonging to, or sought by, another proprietor.

The Classification system

9.4

For the purposes of the registration of trade marks, goods are classified in the manner prescribed in the third schedule to the Trade Mark Regulations 1997- regulation 5.

Section 25(2) states that an application shall not be made in respect of more than one class. Regulation 18(2) states that each application shall be for registration in respect of goods or services in one class of the Third Schedule only.

9.5

The third schedule to the regulations reproduces the relevant class headings of the International Classification of goods and services under the Nice Agreement, which is applied in Malaysia. The Nice Classification consists of a list of classes, together with explanatory notes, and an alphabetical list of goods and services indicating the class into which each listed item falls. There are 34 classes of goods and 11 classes of services. Some general remarks provide guidance on the construction of the classification system, and these are used to determine the classification of any item which is not specifically mentioned in the alphabetical list.

Changes including additions to the Classification are determined by a Committee of experts on which all contracting countries are represented and which meet from time to time under arrangements made by the International Bureau of the

World Intellectual Property Organisation (WIPO) at Geneva, Switzerland.

Applications are classified on the basis of the classification in effect at the time of the application. Changes are not made retrospectively to existing registrations. Since changes in the NICE classification are always introduced from a specific date, applications made before that date are subject to the previous editions of the classification. This is confirmed in both the Australian Wine Importers Trade Mark (1889) 6 RPC 311 and "Cal-U-Test" (1967 FSR 39). In the "Cal-U-Test" case the classification had changed since the date of registration but the case was decided with reference to the practice at the date of registration.

9.6

All questions of correct classification in the registry are determined according to the criteria established by the Nice Agreement. However, for the purposes of interpretation within Malaysia, any question that arises as to the class in which the goods are comprised is determined by the Registrar, whose decision is final- section 17(2).

An example of the application of an identical provision in the U.K. Act is provided by the unreported "Instant Whip" trade mark. In that case, the applicant applied to register the mark for puddings in class 29 and class 30. Because of the descriptive nature of the mark, evidence of factual distinctiveness acquired by use was required. The U.K. Registrar formally determined that the product on which the applicants had used their mark, namely "dry powder mixes consisting principally of sugar and starch for use in making desserts or desert toppings" was classified in class 30 and not in class 29. Accordingly, since there had been no use of the mark on any goods within class 29, the mark was not distinctive for those goods and the application in that class was refused. An appeal to the court was dismissed, Nourse J. accepting that he could not interfere with the Registrar's decision on the classification point.

The possibility of changes to classification of the individual items should be kept in mind when searching for earlier trade marks. Since the classification in force at the date of registration of any conflicting trade mark is the relevant one,

examiners should not rely entirely on the class nominated when deciding whether citation is appropriate; note should also be taken of the actual goods or services nominated.

9.7

In construing the meaning of terms contained in a specification, they are given their ordinary and natural meaning - see the remarks of Pennycuick, J in "Ofrex v. Rapesco", [1963] R.P.C. 169. This should be borne in mind in editing specifications. Standard phrases used in edited specifications are contained in examples used in this chapter - see, for example, paragraph 9.40.

Goods or Services in more than one class

9.10

All goods or services should fall within a single international class.

9.11

Where the claimed goods or services fall within a single class but this is not the one entered on the application form, the applicant should be informed, and given the opportunity of amending his application by transferring it to the correct class. Since the search for anticipations will not normally have been made at this juncture, the applicant may be permitted to retain his original filing date. If, however, the rights of any other party may be adversely affected by such a decision, a fresh application with a fresh date will be necessary - regulation 88.

9.12

Where companion applications- see paragraph 8.30 are made on the same day, and one or more of them lists goods or services belonging to classes other than the one of the application concerned, the applicant may be permitted to make the necessary transfers to rearrange his specification. Any goods or services falling within a class which is not among those of the group will, however, have to be made the subject of fresh applications, with new filing dates.

9.13

Amendments of specifications or class numbers must be made in the indexes and on the computer database as well as on the forms TM.5.

9.14

Apart from the cases mentioned in paragraphs 9.10 to 9.12, an applicant is not allowed to enlarge the specification of his original claim under any circumstances. In particular, transfer of goods or services between filed applications on different dates is not permitted even if the marks are identical.

Wide claims

9.20

Regulation 18(3) provides that where an application is made for all the goods or services in a class (a class claim) or for a large variety of goods or services (whether or not comprising the whole of a class), the Registrar may refuse to accept the application unless the claim is justified. This provision stems from the requirement that a proprietor must, at the time of his application, either be using the mark or have a fixed intention to do so, and is in line with the intention of section 46(1) which enables the Court to expunge the registration if it was obtained by an applicant without any bona fide intention to use the mark " in relation to those goods or services", i.e. the goods or services for which it is registered.

9.21

The restrictions applicable under the preceding paragraph are in the interests of the public generally as well as of the applicant himself. Claims, which are too wide, constitute an obstacle to the registration of other claims, which would not otherwise be in conflict. The result of them is unnecessary citations at the examination stage, with all the delays that they involve. Even if there are no citations, an unjustified registration is vulnerable at any time to an action for rectification by any person aggrieved by it.

9.22

Where applications in different classes are made by the same proprietor, whether or not at the same time and whether or not

for the same mark, the Registrar may need to ask whether all of the claims are justified. If the goods or services are all " of the same description" no inquiry need be made. If, on the other hand, they range over wide categories of goods and services, the applicant should be asked to justify the width of his claim. In assessing this, the nature of the applicant's business should be taken into account. A departmental store will trade in a much wider range of goods or services than will, say, a greengrocer. If a simple letter of explanation does not settle the Registrar's doubts, the applicant should be asked to furnish catalogues, brochures or other evidence of his activities. A recital in a company's Memorandum of Association of the objects for which it was established will not provide the necessary evidence; a contingent intention to use will not meet the requirements of the statute.

Class claims for Goods

9.23

Class claims should receive particular attention unless the class concerned embraces only a limited range of goods. Claims covering the whole of class 15 or 23, for example, need not be objected to. On the other hand claims for class 5, 7, and 9 should be queried, it is highly unlikely that any single concern will trade in all the goods of that class. Even when a class seems to cover only a limited range, because of the brevity of the class heading, inquiry may be made.

9.24

Class claims include those, which simply reproduce the class headings, as well as those, which read: "All goods in class (number)".

Class claims for services

9.25

Claims for the class heading for services should be queried. The services included in each service class are very broad and it is unlikely that one trader will be able to perform all the services included in the class heading. A claim for "all services in class (number)" should also be queried and the applicant asked to specify the services of interest.

Clarity of the specification of goods or services

9.26

All terms used to specify the goods or services for which cover is sought must be readily understandable. Terms used in the NICE listing or Office Determination listing can be accepted. Other terms are acceptable if they can be found in mainstream or specialist dictionaries, or are terms common to particular trades.

If part or all of the specification is vague or ambiguous and cannot be classified, the examiner should request further information regarding the problem part(s) of the specification. A request should be made for further information in the form of brochures or pamphlets published by the applicant, which are directly relevant to the application.

Classification of Services

9.27

If a service cannot be classified in accordance with the alphabetical list, the following criteria should be applied:

Services are classified in principle, according to the BRANCHES OF ACTIVITY specified in the headings of the service classes (e.g. Medical insurance would be classified according to the branch of activity to which it relates. Thus it would be classified in class 36 as an insurance service and not class 42 which relates to medical services)

Alternatively, services are classified by ANALOGY with other COMPARABLE services contained in the alphabetical list.

(e.g. accounting services would be classified by ANALOGY with business services in class 35)

RENTAL services are classified, in principle, in the same classes as the services provided by means of the RENTED OBJECT.

(e.g. (a) rental of telephones is classified in CLASS 38 as this is the same class in which telecommunication services appear. (b) Rental of vehicles is proper to CLASS 39 however rental of road sweeping vehicles is proper to Class 37 because it will be regarded as a CLEANING SERVICE)

9.29

Another indication of an unjustified claim may be provided by the mark itself. If, for example, it is a wine label but the specification is "Wines, spirits (beverages) and liqueurs" the

application may need to be limited to wine. Such a case should, however, be regarded as a candidate for a variation clause. (Variation clauses are dealt with in chapter 15). Some times, however, the mark would clearly be unsuitable for the other goods, which have been included in the specification applied for. For instance, if the mark consists of the printing on a cigarette pack, including such non essential matter as " Filter tip" but the claim is for " Tobacco, whether manufactured or unmanufactured", a variation clause would not be appropriate, and in such cases consideration should be given to taking an objection under section 14(a) on the ground that it would be likely to be deceive or confuse. (Such an objection could, however, be easily overcome by a suitable voluntary limitation of the goods of the original claim.)

Editing Specifications

9.40

It is desirable that a consistent practice be adopted by all Assistant Registrars when agreeing the wording of edited specifications, no matter which classes they are responsible for. To that end, certain standard phrases and rules are applied. These are set out in the following paragraphs. They are considered under two main heads: qualifications and exclusions.

Qualification of Consultancy services

9.46

In general consultancy services will belong to the same class as the service or field on which they are being consulted. The fact that the advice or information obtained through the service may be used for commercial purposes is not a relevant factor.

All services relating to the management or administration of a commercial undertaking are in class 35. " Management" and " administration" refer to the way the business is organised or run. The consultancy services for management are in class 35 regardless of the nature of the business using the consultancy service, whereas consultancy services for technical matters concerning the nature of a business may fall into a number of classes.

Therefore as a general guide " consultancy services may fall in

all the service classes and should be qualified to the service or field on which they are being consulted to enable correct classification.

Qualification of Advisory and Information services

9.47

Advisory and information services are classified according to the subject or content of the advice or information being provided. e.g. business advisory services are in class 35, insurance advice in class 36, transport information falls in class 39, weather information in class 42. This classification practice applies even if the advice or information is provided by electronic means, e.g. by way of a computer database or over the telephone. It should also be noted that the gathering together of information e.g. market research or opinion polling, falls in class 35 regardless of subject matter. For example:

- Advisory services on insurance - class 36
- Advisory services on security- class 45

Qualification of Rental or Hire Services

9.48

The "General Remarks" page 5 of the NICE classification 8th edition state that the criterion to be applied where there is no specific alphabetical listing is:

"Rental services are classified, in principle, in the same classes as the services provided by means of the rented objects (e.g. Rental of telephones, class 38).

Rental or hire services are classified, in principle, in the same class as the services provided, e.g. rental of cars falls in class 39, rental of telephones in class 38, rental of vending machines in class 35. Leasing in the form of financial leasing falls into class 36 i.e. where the customer does not own the goods until the final payment-, which is essentially a financial service.

Qualification of mail order services

9.49

The goods with which the services are connected must be included in the specifications and the services will be classified in class 35.

Telecommunications services

9.50

These services are in class 38 for which the class heading is "Telecommunications". However, it should be noted that this class only covers the means of communication (e.g. land lines, satellite transmission facilities, rental of communications systems) and not information or advice provided via telecommunications such as entertainment lines (class 41), financial information (class 36), traffic news (class 39) and so on. Class 38 does include, however, information or advice about telecommunications.

9.59

In addition to qualifications and exclusions, there are a few common practices adopted in editing specifications to meet particular circumstances. These are dealt with in the following paragraphs.

Parts and Fittings

9.60

General remark (c) in the Nice Classification establishes that goods intended to form part of another product are, in principle, classified in the same class as that product only in cases where the same type of goods cannot normally be used for another purpose. Many manufactured products are comprised of, contain, or are fitted with, parts which may also be used for other purposes. One has only to look at a motorcar to see what is involved here. Cars are classified in class 12, but engine parts, windows, upholstery, radios, wires, lamps, sparking plugs etc, fall into many classes other than 12. To ensure that any given claim covers only one international class, the standard expression to be used is "; parts and fittings included in (the class number) for the aforesaid goods". Note the semi-colon at the beginning of the phrase; the reason for it is explained in paragraph 9.63. This expression should be placed after the list of goods to which it relates, normally at the end of the specification itself (but see the next paragraph).

9.61

A reference to parts and fittings should not be made where it

is clearly inappropriate. For example, the goods may themselves be parts or fittings such as screws. Or the goods may not have any parts, such as "textile piece goods" in class 24. Where such goods are contained in a specification along with other goods for which the inclusion of parts and fittings is appropriate, they should be placed last. In the following specification, the inclusion of parts and fittings for the lenses would be inappropriate:

"spectacles, spectacle frames and sunglasses; fitted cases for spectacles; parts and fittings included in class 9 for all the aforesaid goods; optical lenses."

Precise Punctuation

9.62

Precise punctuation is imperative in framing or editing specifications, in view of the legal results, which flow from them. The use of a comma instead of a semi colon may alter the entire sense of a specification. Goods listed in a specification, which are not sui generis are separated by semicolons; this is the reason for the semicolon in the standard expression used in paragraph 9.61. Exclusions are preceded by a semicolon if they apply to the whole specification and not just part of it. The principles may be made clear by the following examples:

- (i) diagnostic preparations and substances for in vivo use. (class 5)
- (ii) non- medicated toilet preparations, perfumes, soaps, all scented with roses. (class 3)
- (iii) veterinary preparations; medicated additives and medicated supplements; all for foodstuffs for animals. (class 5)
- (iv) providing casino facilities. (class 41)

9.63

In example (i) of paragraph 9.62 it must be made clear that the diagnostic preparations as well as the substances are for in vivo use, since those preparations for in vitro use are in class 1. It is also desirable that the qualification " diagnostic" refers to the substances as well as to the preparations. The edited version is:

"diagnostic preparations and diagnostic substances, all for in vitro use."

9.64

In example (ii) of paragraph 9.62, the correct wording depends on what is the objective of the exclusion. If as is likely, it is to avoid an objection under section 14(e) because of the presence in the mark of an element that would lead the public to expect goods sold under it to be rose scented, the qualification does not go far enough. To make it clear that all the goods are qualified, the edited version would be:

"non- medicated toilet preparations; perfumes; soaps; all scented with roses." The last semicolon applies the qualification to all the listed goods and not, as in the original version just to the perfumes and soaps.

9.65

Example (iii) in paragraph 9.63 illustrates the reverse of example (ii). It is probable that only the additives and supplements are intended for the foodstuffs and that the applicant intends to trade under his mark in veterinary preparations at large. The correct way of indicating this is by the wording:

"veterinary preparations; medicated additives and medicated supplements, all for foodstuffs for animals"

In this version, the qualification is not preceded by a semicolon and so does not go back to include the veterinary preparations. However, in a case such as this, it is not permissible to correct the error if it is not on the original claim, for to do so would widen the claim after filing and this is prohibited- see paragraph 9.14.

9.66

In example (iv) "providing casino facilities" could include accommodation, restaurant and bar services which are often available at casino facilities but would be classified in class 42. In this example it would be wise to add the word " gambling " in brackets as in the NICE classification entry to indicate that class 41 is applicable.

Materials in Different Classes

9.70

General remark (d) of the Nice Classification states that where goods, whether finished or not are classified according to the material of which they are made and where they are made of different materials, such goods are in principle classified according to the material, which predominates.

9.71

Where any doubt exists concerning the correct classification of any goods made of more than one material and those materials fall into different classes, it is for the Registrar to determine it - section 17(2)- but it is for the applicant to establish the materials employed, and their proportions to enable him to do so. The standard phrase to be used in a specification in such a case is "wholly or principally of" the named material which predominates.

9.72

However, the meaning of the word "predominates" in this context is not always clear. Any given material could predominate in any one or more of weight, area, volume or value. For example in "Vac-U-Flex" T.M. [1965] F.S.R 176, the U.K. Registrar expunged a registration for "flexible tubing wholly or principally of metal" on those grounds. The evidence showed that it has been used on plastic tubing reinforced with metal wire, and the metal comprised 56% of the total weight of the tubing. However, the Registrar held that the area and volume of the metal had to be taken into account, as well as its weight, and that the tubing was not "wholly or principally" of metal.

Wholly or principally of

9.73

The words "wholly or principally of" are also used whenever a limitation is required to overcome an objection under section 14(a) on the ground that the mark contains an element which would lead the public to expect that the goods were made of the named material. For example if a mark contains or features the description WOOL for articles of clothing in class 25 it would be deceptive if the goods were not made of wool. By limiting the specification to articles of clothing made wholly or

principally of wool the possibility of public deception is avoided. If the mark were to be used on cotton goods it would be an unregistered use relying on common law protection.

It may be preferable to use an endorsement stating, "It is condition of registration that the trade mark will only be used on goods made of wool."

The use of the words "containing" is also acceptable and allows a certain proportion of non-woollen material to be used e.g. for linings and buttons without any deception ensuing.

Another option would be to use a claim to vary if for example the goods were socks of cotton or wool. This would of course depend on the presentation of the word WOOL or COTTON in the mark.

Terms To be Avoided in Specifications

9.80

Certain words and phrases should be avoided in framing or editing specifications. They are either vague, redundant or ambiguous. If they occur in an original specification submitted by an applicant they should be edited out. The commoner ones are listed and commented upon in the following paragraphs.

Machinery

9.82

This is a wide term covering goods in more than one class. If "machines" is meant, that word should be used.

Peripheral

9.83

This is too vague. Even in class 9, in relation to computers, where the words is sometimes used, it may cover goods in other classes, such as, for example, printing machines. The actual goods should be specified. Peripheral is also not acceptable as a description for services.

Media

9.84

This is a vague term although it is frequently used in the world of communications. Phrases such as: " sound recording media" should not be accepted; the goods should be specified. An exception occurs in class 5, where the expression "contrast

media" is sufficiently well known to identify the goods precisely.

Accessories

9.85

This would cover many goods not included in the class of the claim. The phrase "parts and fittings" should be used instead-see paragraph 9.61

Kits

9.86

When the goods are sold in the form of a kit of parts, which the customer assembles, the individual parts may fall into more than one international class yet the kit is sold as a unit. If the proprietor wishes to ensure that he has infringement rights against another party using the mark on some, but not all of the items comprised in the kit, he must register his mark in all the appropriate classes. Enquiry may be necessary to establish the exact constituents of the kit. The applicant may need to make additional applications but that is matter for him. If the word KIT appears as part of an otherwise distinctive mark, it may be necessary to take an objection under section 14(a) on the ground that the mark would confuse or deceive a purchaser looking for a kit part. In such a case the qualification "all for inclusion in kits" would suffice.

System

9.87

This term should be allowed only when the goods are clearly understood to be a complete system and all the constituents are in a single class. For example, the specifications: "Fire alarm systems and burglar alarm systems" would be quite acceptable in a class 9 application. However, the term "heating systems in class 11" should not be accepted. A better statement would be "Installations and apparatus, all included in class 11 and all for heating".

Perfumery

9.88

Although this word appears in the heading to class 3 it is not always clear what it covers. If he intends to claim more than

just perfumes, the applicant should specify his goods more particularly, by such terms as: cosmetics, essences included in class 3, soaps, etc. Where a particular perfume is indicated by the mark, a suitable qualification should be required - see paragraph 9.65.

Foreign Words and Expressions

9.90

These should not be permitted to remain in a specification. If the applicant argues that the goods or services have no generic name in English, an appropriate sort of description should be substituted which makes it clear that the goods or services come within the class claimed and no other.

Registered Trade Marks

9.91

If a registered trade mark appears in a specification of an application made in respect of goods in the same class as the registration, the applicant should be asked to remove it. The removal of a registered trade mark from a specification should be required even if the applicant owns the registration concerned, since a subsequent assignment of one or the other mark could not be objected to on the grounds that the registrations were linked in this way.

Permissible General Descriptions of Goods or Services

9.92

Sometimes applicants will make a broad claim on their specifications when the applicant is only actually using some of the goods or services within a more general description. For example, he may have applied to register his mark for fruit but used it only on mangoes. The applicant may intend in the future to use the mark on other types of fruit. It is in the public interest that an applicant's infringement rights should not be too narrowly stated. In the example given, a restriction to mangoes could mean that the applicant is not able to prevent another's use of the mark on star fruit, which would confuse or deceive the public. Of course if the applicant has originally claimed mangoes he cannot later enlarge the claim to fruit. A fresh application will be necessary.

Annexure 9.4

HISTORY OF THE CLASSIFICATION SYSTEM

The International Classification and the Nice Agreement

At the International Conference held under the auspices of the United International Bureau for the Protection of Intellectual Property (BIRPI), a predecessor of the World Intellectual Property Organisation (WIPO), a new classification for international purposes was drawn up in London in 1934. The International Classification became the subject of the Nice Agreement in 1957 when a number of countries agreed to adopt it for the registration of trade marks.

Malaysia has not acceded to the Nice Agreement, however, Malaysia uses the Nice classification system for classifying the goods or services claimed in trade mark applications.

The latest revision of the Nice Agreement was drawn up at Geneva in 1977, which is reproduced in the WIPO publication "International Classification of goods and services for the purposes of the Registration of Trade Marks."

Amendments to the International Classification

There have been the following editions of the International Classification published subsequent to the Nice Agreement:

First edition 1963

Second edition 1971

Third edition 1981

Fourth edition 1983

Fifth edition 1987

Sixth edition 1992

Seventh edition 1997

Eight edition 2001

The first and second editions were only published in French as the official text.

An official English translation was published separately in 1965. This was updated in 1967, 1970, 1971, and twice in 1974.

The third edition of the International Classification was published in both English and French with both languages being authentic texts. This became effective on 1st February 1981. No changes of goods or services from one class to another were involved.

The changes introduced in the fourth edition became effective

on 1st June 1983. The changes introduced in the fifth edition became effective on 1st January 1987. The changes introduced in the sixth edition became effective on 1st January 1992. Further changes to the 6th edition were introduced in 1995.

The changes introduced in the seventh edition became effective on 1st January 1997.

Amendments to Class 42 and the creation of classes 43 to 45 have been adopted by the Malaysian Office. The amended Regulations include classes 1 to 45.

CHAPTER 10 - REGISTRAR'S PRELIMINARY ADVICE

Matters Covered

10.1

The Amended Act allows an applicant to ask for the Registrar's opinion on the inherent distinctiveness of the mark. Form TM.4 and Form TM4A is the appropriate form. The Amended act does not allow the applicant to ask the Registrar for a search for anticipations. However applicants can conduct their own searches, and the staffs of the Registry are always willing to explain the layout of the search indexes to any member of the public unfamiliar with them. The provisions are contained in section 73 and regulation 17 and 17A.

CHAPTER 11 - THE SEARCH FOR PRIOR RIGHTS

Sub-sections 19(1) and (2) prohibit the registration of a trade mark that is either identical with a trade mark belonging to a different proprietor, or so closely resembles it as to be likely to deceive or cause confusion, where that other trade mark is entered in the register in respect of goods or services of the same description or services that are closely related to those goods as those of the application to register.

11.1

The examination of every application for registration includes a search for prior rights

11.2

Regulation 25 extends the search to include pending applications. The procedure to resolve any conflict existing between two pending applications is governed by section 19(3) and 19(4).

11.3

The search should also include any registered trade mark, which is removed from the register for non-payment of the renewal fee. (Refer Section 42). Such a mark is deemed to be still on the register" for the purpose of an application for a trade mark within one year from the date of removal".

Similarity Criteria - General Principles

11.5

In deciding any question of possible conflict between two applications or between an application and a registered trade mark, there are two main factors before raising an objection under this section. These are:

- whether the marks are identical or so nearly resemble each other as to be likely to deceive or cause confusion ; and
- whether the marks are used on the same goods or services, the same description of goods or services, or whether the goods and services are closely related.

Parker J discussed these factors in the Pianotist Co.'s Application (1906) 23 R.P.C. 774 at page 777. He said:

"You must take the two words or devices. You must judge of them

both by their look and by their sound. You must consider the goods or services to which they are to be applied. You must consider the nature and kind of customer who would be likely to buy those goods or services. In fact, you must consider all the surrounding circumstances; and you must further consider what is likely to happen if each of these trade marks is used in the normal way as a trade mark for the goods or services of the respective owners of the marks. If, considering all those circumstances, you come to the conclusion that there will be a confusion- that is to say, not necessarily that one man will be injured and the other will gain illicit benefit but that there will be a confusion in the mind of the public, which will lead to confusion in the goods or services - then you may refuse the registration, or rather you must refuse the registration in that case."

The principles set out in the above-quoted passage apply *mutatis mutandis* to device marks and service marks.

Comparing Cases

11.6

When comparing cases, examiners should always consider each mark as a whole. It is clear that marks are identical if they are the same in every detail when compared side by side. The tests for deciding whether the marks so nearly resemble each other are established in case law and are explained in the following paragraphs.

Imperfect Recollection

11.7

Consumers who know two marks are not likely to confuse them. It is the ordinary consumer with an ordinary memory, who pays ordinary attention to the details of any trade marks, and who knows only one of the marks who is likely to be deceived or confused. Consumers do not recall or remember every detail of the trade marks they know. Consequently they may confuse a similar mark with the one they know even if there are minor differences between them. The principle is known in case law as the doctrine of imperfect recollection and applies equally to word, device and composite marks. Luxmoore, L.J. discussed this doctrine in *Aristoc v. Rysta* (1943) 60 R.P.C. at page 108. He said:

"The answer to the question of whether the sound of one word resembles too nearly the sound of another ... must nearly always depend on the first impression, for obviously a person who is familiar with both words will neither be deceived nor confused. It is the person who only knows the one word, and has perhaps an imperfect recollection of it who is likely to be deceived. Little assistance therefore is to be obtained from a meticulous comparison of the two words, letter-by-letter and syllable-by-syllable, pronounced with the clarity to be expected from a teacher of elocution. The Court must be careful to make allowance for imperfect recollection and the effect of careless pronunciation and speech on the part not only of the person seeking to buy under the trade description but also of the shop assistant ministering to that person's wants."

Appearance and Sound

11.8

Consumers may confuse marks, which are similar in appearance or sound. The appearance or visual similarity, of word and device marks carries greater weight if a consumer selects goods from, for instance, supermarket shelves, or services through telephone directories.

If consumers are likely to order goods or services by spoken means, the sound, or aural similarity, of marks is more important than their appearance because the words may be distorted in telephone or other conversations.

Case law states that consumers usually place emphasis on the beginning of words and slur the pronunciations or drop the endings. Therefore consumers may confuse marks if their beginnings are similar and the endings are slurred when spoken. Sargant, L.J. in "London Lubricant's Application (Tripcastron)", (1925) 42 RPC 264 at 279, stated that similarities in the beginning of words generally make a deeper impression than do similarities of their endings. He said:

"The tendency of persons using the English language to slur the termination of words also has the effect that necessarily the beginning of words is accentuated in comparison, and, in my judgement, the first syllable of a word, is as a rule, far the most important for the purpose of distinction."

When comparing marks the similarities of the beginning of the words carries greater weight if the endings are common to the

trade and unlikely to be lost in speech. Alternatively, if the beginnings of the words are common or descriptive, emphasis is on their endings if these are clearly pronounced. Lord Russell, in *Coca Cola of Canada v. Pepsi Cola of Canada* (1942) 59 R.P.C. 127, stated that the marks COCA COLA and PEPSI COLA were not confusingly similar because the suffix COLA is descriptive for soft drinks. Similarly, FRIGIKING and THERMO-KING in *Frigiking T.M.* [1973] RPC 739, were allowed to co-exist on the Register for air-conditioning and refrigerating apparatus because the word KING, common to both marks was commonly used in trade.

Essential feature

11.10

A mark may resemble another mark as to be likely to deceive or cause confusion if it incorporates the essential or distinguishing feature of that mark. The essential feature may either be a word or device. A case which supports this principle is *Saville Perfumery Pty Ltd v June Perfect Ltd*, (1941) 58 RPC 147. The judge decided that a composite mark containing the word JUNE was confusingly similar to the word mark. If consumers remember a mark by some feature in it, they are likely to confuse it with another mark, which adopts that essential feature.

In the matter of *Dewhurst's Application (Golden Fan)* (1896) 13 RPC 288, the applicant wished to register a mark containing Burmese characters which meant "The Golden Fan Brand" in Burmese. There was already on the register a mark consisting of a device of a fan. The evidence showed that this was used with the fan in gold colour. Refusal of the application was upheld on appeal. The Court held that the mark applied for must be calculated to deceive because it only expressed in words what the golden fan of the registered proprietor expressed to the eye. Lindley L.J. added:

"It does not matter what the language is, nor what the hieroglyphics are, if the meaning of the hieroglyphics or the meaning of the foreign language is a mere verbal description of a mark already on the register.... of a golden fan, you cannot have another mark called a "Golden Fan" in any language or in any hieroglyphics."

At the *ex parte* stage, there would be no evidence of how the registered marks were used. However, this would not lead to a

different result, since an uncoloured mark may be used in any colour, and the Registrar must take into account any possible legitimate use of a registered mark. This early case is still good case law and explains the modern requirement for transliteration and translations, which are entered in the search indexes.

Composite marks

11.11

Composite marks must each be compared as a whole. Because consumers generally remember and refer to composite marks by the word elements rather than device elements, the words are usually more important. Composite marks may be similar if they consist of the same words even though the devices are different. Composite marks may also be similar if they consist of the same or similar predominant element. In *Taw v Notek* (1951) 68 RPC 271, the judge compared two composite marks consisting of different words, TAW and NOTEK, and similar devices. He decided that the two marks were likely to deceive or cause confusion because they both incorporated a device in which motor headlamps are substituted for eyes in a cat's head. These devices were essential and distinctive elements and were therefore too similar.

Idea of Marks

11.12

Two marks, which are different when viewed side by side, may be confusingly similar if they contain common features that convey the same idea. This principle particularly applies to device marks. Consumers recall device marks by the ideas conveyed by them rather than the precise details of the marks. For example consumers may confuse a device mark consisting of an athlete grasping a javelin with a device mark consisting of an athlete running or throwing a discus because the marks convey the same idea, that is, an athlete.

Examiners should apply this "same idea" principle cautiously to word marks. Traders commonly use words such as KING and MASTER, to convey an idea that their goods or services are of a good quality. Consumers are not likely to confuse them even though they convey the same idea because they are known English words with dictionary meanings.

Consumers can easily distinguish word marks with dissimilar meanings and similar marks where one has a meaning and the other none. However they may not easily distinguish two similar invented words marks, such as ALGECCEL or ALGESILL, which have no readily apparent meaning

Device Marks

11.13

Consumers often remember or recall device marks by words, which describe them. Consumers may confuse devices, which are ordinary representations of objects or animals with word marks, which are the names of those objects, or animals. For example a registration of the word LION would prevent another trader in the field from registering a device of a lion, or even a device of a lion's head.

Related Marks - Confusion

11.14

If a trader owns several registered marks with a common element, such as the word HYPER, consumers may expect a new mark with the same element and for the same or similar goods or services to be another mark in a series of marks from the same trade source. They would be deceived if another proprietor registers this new mark. For example, if a proprietor uses HYPERPAD, HYPERBAT and HYPERGLOVES on cricket equipment, consumers would believe that a mark HYPER BALL, used by a different proprietor on cricket balls, came from the same trade source. Cases which relate to this principle are Beck Koller & Co Ltd's Appn (1947) 64 RPC 76 and Flowstacka Trade Mark [1968] RPC 66.

However, if registered trade marks with the same prefix, suffix or device co-exist on the register in the names of different proprietors for similar goods or services, a new application in the name of a different proprietor could also co-exist with them if it consists of other distinctive elements. For instance HYPERDAY, HYPERWICK and HYPERLIFE may co-exist on the register in the names of different proprietors for similar goods or services.

Contextual Confusion of Marks

11.15

In Broadhead's Application (1950) 67 RPC 209, the mark "Alka-

vescent" was refused in the face of "Alka-Seltzer". In the context of actual commercial conditions, it was held that there was a real possibility of confusion between "Alka-Seltzer effervescent tablets" and "Alka-vescent Seltzer tablets", and that this was a fair use of the mark.

Comparing Goods And Services

11.20

If examiners use the above tests and find that marks are identical or similar they must then consider the goods or services. Identical marks or marks which resemble each other as to be likely to deceive or cause confusion may co-exist on the register if the goods or services are not the same, or of the same description, or closely related. However examiners must cite identical or similar marks if they are applied to closely related goods and services, or the same goods and services, or same description of goods and services. Tests to decide this are set out below.

Comparison of Goods and Services and the Nice Classification 11.21

The division of goods and services into classes under the Nice classification is not necessarily a guide to determine whether goods or services are of the same description, as often goods or services of different descriptions are found in the same classes. The Nice classification divides goods into classes according to several factors such as the materials they are made from, their uses, and whether they are processed, or semi-processed or raw goods. (Classification is discussed in detail in chapter 9). Building materials of metal are not of the same description as metal ores both of which are in class 6.

Goods of the same Description

11.22

The test examiners must consider deciding whether goods are of the same description is established in Jellinek's Application (Panda), (1946) RPC 59. In that case, Romer J considered the following matters to decide whether shoes and shoe polish were goods of the same description:

- the nature of the goods
- the respective uses of the articles
- the trade channels through which the commodities are

respectively bought and sold

These are the primary criteria. Other matters, which may need to be considered, are:

in Beck, Koller & Company's Application ("Plio") 64 RPC 76 at page 78, the assistant Comptroller enlarged on the factors set out by the Romer J. as follows:

- the nature and characteristics of the goods
- the origin of the goods
- the purpose of the goods
- whether the goods are usually produced by one and the same manufacturer
- whether the goods are distributed by the same wholesale houses
- whether the goods are sold in the same shops, over the same counter, during the same season and to the same class or classes of customer;
- whether by those engaged in their manufacture and distribution the goods are regarded as belonging to the same trade.

The above matters which are to be considered when determining whether goods are of the same description have been confirmed in cases such as John Crowther & Sons (Milnsbridge) Ltd's Appln (1948) 65 RPC 369 at 372 where it was observed that " no single factor is conclusive in itself."

Services of the same description

11.25

The test to decide whether services are of the same description is similar to that for goods. Examiners apply the test established in the Panda case. The examiner will have to consider:

- the nature and characteristic of the services
- the origin of the services
- the purpose of the services
- whether the services are usually provided by one and the same business or person
- whether the services are provided from the same sources, in the same area or district, during the same season or in relation to the same related goods or services and to the same class or classes of customers; and
- whether the services are regarded as the same by those who

provide them

For example wallpapering and home decorating services are of the same description. The nature of these services is the same as they are both decorating services. Consumer use both to re-decorate homes and may expect the same trader to perform both of the services.

In *American Express & Co v N.V. Amev* (1985) A.I.P.C. 90-258 (an Australian case available in the IPD Trade Mark Resource Centre) the judge decided that insurance and travel services was of the same description because the same business will provide both. For example, travel agents provide a travel insurance service to customers.

Theatre restaurants and entertainment services are also of the same description, as are seminars about computers and services relating to the installation of computer software and hardware.

Closely related goods and services

11.26

The term "closely related" refers to whether consumers may believe that the goods and services have a connection or common trade origin. The relationship between goods and services must be close and not a tenuous or remote connection. Goods and services are closely related if traders perform the services, upon, or in relation to, or even by means of certain goods. For example:

- Film development (class 40) and printing services (class 40) and films (class 9 - exposed) (class 1 - unexposed), photographic chemicals (class 1).
- library services (class 41) and books (class 16) , correspondence courses (class 41(education)) (class 42).
- painting services (class 37) and paint (class 2).
- retail services in respect of sporting goods (class 35) and sporting goods (class 28).

The examiner will need to consider the following questions:

- Are the services performed upon or by means of the goods? (For example film development and printing services (class 40) and films or photographic chemicals.)
- Are the goods and services generally regarded by the ordinary consumer as being part of one industry or trade, or a closely related trade or industry? (For example measurement and

installation of domestic or office blind services and blinds.)

- Are the goods and services of matching technical complexity? Is the technical training of the people who make the goods or provide the services the same? (For example satellite telecommunication services and satellites.)

- Do the people who make the goods or provide the services belong to the same associations or professional bodies? (For example pathology services (class 44) and pathology diagnostic tests (class 44 - normal) (class 41 - education).

- Would consumers expect that the goods would have this service as a related service agreement or package? (For example it would be most unusual for a person buying a very expensive piece of machinery not to enter some sort of service agreement such as telecommunications equipment via a telecommunications service provider.)

- Conversely are the goods usually offered as part of the service agreement? (For example air conditioning unit maintenance services and filters for air conditioning units.)

- Is the nature of the goods or service such that they would cease to exist without each other thus creating an expectation of a common source? (For example takeaway restaurant services and take away food.)

- Does the service consist of altering, matching and or installing the goods to a consumer's requirements? (For example the installers of domestic and industrial equipment are often employed either indirectly or directly by the manufacturer.)

- Are the goods and services commonly offered by one company or organization? (For example retail sales and the equivalent goods, or telephone communication services and telephones.)

- Are the goods a necessary adjunct to a particular service or the only tangible result of it? (For example advertising services and directories and directories)

Australian Trade Mark Office decisions, which discuss closely related goods and services are available in the Resource Centre and a few examples are discussed below:

a) Starnet Decision. In this decision the Hearing Officer decided that services involving the communication of data, sound and images by satellite are closely related to apparatus for transmission of sound and images. In the decision the Hearing Officer discussed the nature, uses and trade channels of the services and goods. The questions listed above are based

on the questions the Hearing Officer recommended that examiners consider to decide whether the goods and services are closely related.

b) *Amart* decision. In this decision, a Hearing Officer discussed whether sporting goods and retailing of sporting equipment are closely related. She decided that retailing services are closely related to any goods, which are sold in the outlets because some traders produce their own goods and sell them through speciality retail outlets. They often apply the same mark to their goods and retail outlets. Similarly retailers of large department or grocery stores often sell their own "House" brands in addition to other goods. These "house" brands often bear the same mark as the retail services.

c) *Rowntree Plc v. Rollbits Pty Ltd* (1988) 10 IPR 539 (also in Resource Centre). In this court case Neeham J decided that snack food items are closely related to takeaway services as traders who perform the services often prepare and sell through these outlets.

Cross Search List

11.27

A useful guide to examiners to decide whether goods and services are closely related or of the same description is a cross search list. It is available at Appendix 1 of this manual. Examiners must search for conflicting marks in the related classes specified in the cross search list. Classes are related if they include goods or services of the same description and goods and services that are closely related. Examiners cite the same or similar marks in different classes if the goods or services are of the same description or closely related. The cross search list can be used as a basic starting point.

Occurrence of the phrase "goods or services of the same description" in the Act

11.28

The phrase goods or services of the same description also occurs in other sections of the Act and has the same meaning there. These other provisions are :

- section 6(4) effect of incorporating the previous registers;
- section 19(3) and 19(4) conflicting co- pending applications;
- section 20(1) and section 20(1)(A) honest concurrent use with

a registered trade mark.

- section 33(3) loss of registration rights through generic use;

- section 46(2) protection of a mark unused for other goods

These expressions are to be contrasted with the wording used in other sections of the Act notably; "registrations in respect of different goods" used in:

- section 58 defensive and non-defensive registrations of a mark.

Co-pending Conflicts - Right of Priority

11.29

Sub-sections 19(3) and (4) apply if identical or similar marks are the subject of pending applications. These provisions allow the Registrar to refuse to register either of the co-pending marks until the rights of the proprietors are determined by a Court and/or are settled by agreement in a manner approved by the Registrar or by the Court. In practice examiners are obliged to object these applications. Before the 1994 amendments to the Trade Marks Act (1983), Examiners applied these provisions to any co-pending marks filed within six months of each other. Examiners cross cited them in the event that the proprietors of the later marks filed Convention documents claiming priority dates earlier than the filing dates of the first co-pending marks. Examiners should not cross cite marks filed under the amended Act for this reason. Sub-section 70(3) of the amended Act states that proprietors must at the time of filing their applications claim the convention priority dates on their forms. This means that proprietors cannot claim priority dates after they have filed their applications.

The sub-section 19(3) and (4) provisions are useful if the marks have the same filing date. Examiners cross cite the applications and allow the proprietors to arrive at some mutual agreement to settle the conflict. The objections may be overcome if the proprietors decide to limit their specification of goods or services, or the geographical areas in which they use the marks to avoid a clash. They may also provide evidence of honest concurrent use to show that the marks do not conflict in trade. In some cases one of the proprietors may decide to withdraw his/ her application and allow the other proprietor's application to proceed.

Examiners may give extensions of time to applications where the proprietors are in the process of reaching an agreement. However, examiners should only give lengthy extensions of time if the proprietors produce evidence to show that they are in the process of forming an agreement. If it appears that one of the proprietors is not willing to come to an agreement, the Registrar may require both proprietors to refer the conflict to a court.

The Registrar may also require both parties to refer the dispute to a court if both are claiming to be the proprietor of the same mark, or if there is evidence of misappropriation or fraud. Both applications will be refused if no action is commenced.

Conflicting Marks - Other Considerations

11.30

In the passage quoted in paragraph 11.5, Lord Parker stated that, in deciding whether two marks were confusingly similar, it was necessary to consider all the surrounding circumstances. These will be additional to the questions of whether the marks are confusingly similar and whether the goods are of the same description, or whether the services are closely related to the goods. Some of the matters, which have to be taken into consideration, are discussed in the following paragraphs.

11.31

If the goods or services of the respective parties are of the kind which persons of all types, education, age, and social background might purchase, the possibilities for confusion among them will obviously be greater than if the prospective purchasers were limited to a specialised market. The former is sometimes referred to as a "bag of sweets" case.

11.32

Confusion is less likely where a great deal of thought, or enquiry, as to the fitness of the goods or services for their purpose might precede the purchase and where, accordingly, the trade mark enters into the matter only to a relatively small extent. This is to be contrasted with a case where the goods or services are frequently subject to impulse buying.

11.33

The growth in the number of self-service stores, and the increase in the range of products one might find in a single establishment, is also relevant in deciding whether confusion or deception is likely. Where customers simply help themselves and take their chosen goods to the checkout, selection may be made wholly by the trade marks, making their visual appearance more important than their phonetics. On the other hand, if the goods or services are, or may be sold over the counter, oral use may assume greater importance. Under such conditions, the potential to mishear or be misheard must be taken into account, particularly where the establishment is apt to be a busy or noisy one. Much the same effect may be experienced where goods or services are ordered over the telephone, and where pronunciation or bad telephone lines can be an issue.

11.34

The standard to be applied may differ for different goods or services. For example, the consequences of confusing two medicines through confusing their marks might be dire, even fatal. Consequently, the Registrar will be more willing to consider that confusion is likely where pharmaceuticals are involved. Ethical drugs are usually available only on prescription, where the likelihood of confusion is less than in the case of drugs sold direct to the public at a chemists or a pharmacy.

However, specifications in trade mark applications are rarely limited in that way, and it has to be assumed, for the purposes of citing or maintaining, anticipations, that a proprietor may use his mark on all the goods or services for which it is registered or for which registration is sought. Citations may be overcome (where the respective marks are not too close) by qualifying one party's specification by limiting it to ethical drugs, and by excluding ethical drugs from the others, but such procedures should be adopted with care; if there remains any likelihood of confusion, the conflict should be regarded as unavoidable and registration should be refused.

11.35

The stricter standard mentioned in the preceding paragraph should also be applied where one mark is for pharmaceuticals

and the other is for disinfectants, weed killers and the like, since these are often poisonous substances, and the consequences of mistaking one for the other can be as harmful as if they were both medicines.

11.36

When a single application in class 5 covers both pharmaceuticals and weed killers etc., an objection should be taken under regulation 18(3) requiring an applicant to satisfy the Registrar that he intends to trade in all these goods under the same trade mark. If the proprietor shows that he does indeed do so, it may be assumed that he is aware of the danger of selling poisons under the same mark as harmless substances, and that he will mark his goods accordingly. Nevertheless, in appropriate cases, consideration should be given to the imposition of a suitable condition or limitation.

11.37

Such conditions are usually more appropriate as a possible means of overcoming a citation of a deceptively resembling mark. Examples of suitable conditions that might be considered capable of reducing the likelihood of the public confusing the goods, and so of minimizing the danger to the public, are:

(i) "It is a condition of registration that the mark shall be used in relation only to goods sold on the prescription of registered medical practitioner." (Where say, an application is for medicines and the cited mark is registered for food for babies, both in class 5).

(ii) "It is a condition of registration that the mark shall be used in relation only to goods sold in containers each holding not less than 45 gallons and supplied direct to laundries for use therein." (Where say, the application is for bleaches, and the cited mark is registered for cosmetics, both in class 3).

(iii) "It is a condition of registration that the mark shall be used in relation only to goods sold in aerosol containers or in containers adapted to dispense their contents by puffing or by spraying." (Where say, the application is for cosmetics and the cited mark is registered for bleaches, both in class 3).

11.38

There is authority for stating that all goods in class 5 (other

than bandaging) are goods of the same description- "Floradix" TM [1974] R.P.C 583- but even if they are not, an application which, if allowed, might lead to a danger to public health may be refused in the exercise of the Registrar's general discretion- "Jardex" T.M. (1946) 63 R.P.C. 19. In that case "Jardex" for a poisonous disinfectant was refused in the face of a registration of "Jardox" for meat extract. The same result should apply to applications for soft drinks and liquid weedkillers, such as paraquat. Of course, these are goods of very different descriptions, and in different classes. The search made to comply with the statutory provisions would be unlikely to discover such cases, and section 19 has no application to them, which is why it is necessary to exercise the general discretionary powers when they come to notice. The point is more likely to arise during opposition proceedings, but should be borne in mind.

House Marks

11.45

There is no reason in law why a proprietor should not use more than one mark on the same goods. In modern trading conditions, substantial enterprises often employ what they term a "house mark", designed to convey a corporate identity, alongside different marks used on particular products. This practice also has the advantage, for the proprietor, of allowing the side-by-side use of a (distinctive) house mark and a (more or less non-distinctive) product mark. One reported case is of relevance in this context. It is "Bulova Accutron" T.M.[1969] R.P.C.152. In "Accutron" TM, [1966] R.P.C.152 it had been held that "Accutron" was similar to "Accutrist". The later application was for "Bulova Accutron" and it was held that the marks were still confusingly similar. In a passage adopted in toto by the Court, the Registrar said :

"The present issue is not simply a comparison of two words; but the comparison of one word with a composite mark, the second component of which has been held to be confusingly similar to Accutrist. Can this component be said to be rendered innocuous now that it appears with, and is preceded by, Bulova? I do not think that I can hold that it is and that there is any less risk of deception or confusion. I think that a person having, for example, an imperfect recollection of Accutrist is just as

likely to confuse it with accutron in the composite mark. As Bulova and Accutron do not hold together as a phrase or present a wholly different meaning from the separate components, I think that their combination will be taken by many person on first impression as an indication that the manufacturer of the watches is using two separate trade marks in connection with his products. A person meeting Bulova Accutron and confusing the latter word with Accutrist is, I think, likely to consider that Bulova is another mark which he had not previously observed or which had not been drawn to his attention before. There is no evidence to support Mr. Loftus' assertion that the trade and public will refer to the watches by the name Accutron alone, but I think that there is a tangible danger that a substantial number of persons will confuse the Accutron component of the mark applied for with Accutrist, and consequently will conclude that the goods emanate from the same trade source as Accutrist watches, believing that the Bulova component, it makes an impact, is a house mark or another mark of the same concern."

CHAPTER 12 NOT AVAILABLE

CHAPTER 13 - USE & OTHER CIRCUMSTANCES

Factual Distinctiveness

13.1

The use of the word "extent" in section 10(2B) means that both inherently capable of distinguishing and factual distinctiveness are matters of degree. Where the extent of capable of distinguishing is insufficient to carry the mark to registration by itself, the extent to which the mark has any capacity to distinguish or factual capacity may need to be established by the applicant. That, of course, assumes that there is at least some inherent quality present in the mark and that it is not a priori unregistrable. It is impossible for use to create the inherent factor. (See, for example, the "Yorkshire", "York" and "Weldmesh" cases referred to in chapter 12.)

13.2

Factor (b), set out in section 12(2B)(b), refers to "the use of the trade mark or of any other circumstances". It will be convenient to treat use and other circumstances separately. In practice, almost all marks that proceed under this provision do so on evidence of use.

13.3

The phrase "use... or any other circumstances" in section 12(2B)(b) is to be compared with "honest concurrent use ... or other special circumstances" in section 20(1). They do not have quite the same meaning and are also, therefore, dealt with separately. The honest concurrent use provisions are dealt with in paragraph 13.65 et. seq.

13.4

If the mark under examination is a name, signature or word, which is not acceptable under paragraph (a), (b), (c) or (d) of section 10(1), it is expressly excluded from registration unless it is shown by evidence to be distinctive-section 10(2). The effect of this is that no mark whose ordinary meaning, or one of whose ordinary meanings, is a surname or geographical

name can be registered without such evidence. The same is true of words having direct reference to the characteristic or quality of the goods, as they too are not within paragraph (d) of the subsection.

Mode of Giving Evidence

13.10

Section 64(1) provides that the evidence shall be given by statutory declaration in all proceedings before the Registrar, in the absence of directions to the contrary. The use of the words "all proceedings" makes it clear that the provisions apply to ex parte proceedings such as those under sections 12 and 20, as well as to inter partes proceedings. Evidence other than by statutory declaration will not normally be accepted. (A possible exception may occur in inter partes proceedings, where the Registrar may be given viva voce and be made subject to cross-examination.)

13.11

Evidence may sometimes be submitted by affidavit. Strictly, this is inadmissible without a direction by the Registrar under section 64(1). In practice, no objection need be taken to evidence filed in this form, provided that it is made clear, either in the heading or a covering letter that it refers to the particular proceedings for which it is tendered in the registry.

13.12

Regulation 90(1)(a) requires that all statutory declarations furnished for the purposes of the Act and sworn in Malaysia, must be made in accordance with the provisions of the Statutory Declarations Act 1960. This requires that the declaration begin: "I (name), of (address), hereby solemnly and sincerely declare as follows..." It should end by invoking the Act as follows: "and I make this solemn declaration conscientiously believing the same to be true and by virtue of the Statutory Declarations Act 1960".

13.13

If the witness is not within the jurisdiction at the time of making his declaration, he should make it "before any court,

judge, justice of the peace, or any officer authorised by law to administer an oath for the purpose of a legal proceeding" - regulation 90 (1)(b). A commissioner for oaths and a notary public are authorized officers for this purpose and many foreign declarations will be made before such an official.

13.14

The person taking a declaration will attest the document and state the capacity in which he acted. The form of attestation will be either his signature, or seal of office, or both. No proof of the genuineness of such a signature or seal is required - regulation 90(2) - but any document that is not attested at all should be returned to be resworn.

13.15

In very exceptional circumstances, the Registrar is empowered by regulation 87 to dispense with evidence. This does not apply to requirements under the Act, as distinct from under the regulations. Any case in which it is alleged that evidence in proper form cannot be furnished, accompanied by a request to admit an un-sworn statement, should be submitted to the Registrar for advice before any indication is given that regulation 87 will be invoked. A full statement of the precise reason why the normal form cannot be followed should first be obtained.

13.16

If a declaration is in English and is made by a person whose native language is some other language, the declarant should include a statement that he has a reasonable understanding of English. Where a declaration is made in a language other than English or Bahasa Malaysia, a certified translation should be supplied by the person filing the evidence, and a copy of the declaration should be exhibited to the certificate.

Nature and Extent of Evidence Required

13.20

It is a truism that the success or otherwise of any application must depend on its own facts. The extent of use that will prove to be sufficient in one case might be hopelessly inadequate in another. So much will depend on the nature of the goods or

services, the extent to which inherent distinctiveness is present in the mark, and the strength of the objection. There exists no blueprint or scale by which it can be determined that a given period of years use will suffice for this or that kind of case.

13.21

It sometimes happens that when a prima facie objection is maintained after a hearing or a written response, the applicant or his agent will ask whether the extent to which the mark has been used would assist the application if it were to be put into evidential form, before going to the trouble and expense of preparing it. Care should be taken not to give a definite answer (that must await filing a examination of the evidence itself), but it may sometimes be appropriate to give a general indication. Three instances are mentioned in the next following paragraphs.

13.22

If the Registrar is of the opinion that no amount of use would assist the application, i.e., if he considers the mark to be unregistrable, he should say so and add that he could not encourage any to be filed. Should the applicant nevertheless wish to file evidence in such a case he must be allowed to do so (within a reasonable time) before formal refusal is issued. This is to enable the evidence to be taken into account in any appeal against the refusal - see paragraph 23.37.

13.23

Evidence of use submitted to prove factual distinctiveness can be taken into account only if it occurred prior to the date of the application, for that is the date from which registration will take effect if it ensues. In a case where it seems that sufficient use occurred prior to the 'relevant date', as it is known, but considerable use was made of the mark subsequently (on a much larger scale, for example), the applicant should be advised that it can be taken into account for registration only on the filing of a fresh application. Where he desires to take this course, formal refusal of the earlier application may be held back until the new application is on file, provided that the applicant is not dilatory. It is possible to accept a mark

where evidence is available after the filing date as the evidence must show the mark is capable of distinguishing. This can be demonstrated after the mark is filed but before it is accepted.

13.24

Another kind of case where some preliminary indication of what may be desirable can sometimes be given concerns the matter of whether evidence from someone in addition to the applicant would be required. Where the objection to the mark is very strong, corroborative evidence is nearly always desirable. If, for example, the Registrar is of the opinion that the mark, or something close to it, is likely to be required in normal use by others in the trade, declarations from the applicant's competitors that this not so would be very persuasive.

13.25

Apart from the types of case mentioned in the three preceding paragraphs, no firm view should be expressed in answer to an enquiry concerning the nature or extent of the evidence required. In particular, nothing should be said that would indicate that a fixed minimum number of years' use would suffice for particular categories of mark. The nature and extent of any evidence submitted to overcome an official prima facie objection to an application is entirely a matter for the applicant. Advice should always be given however, if it is requested, as to the form evidence might take. This is dealt with in paragraphs 13.30 and 13.35.

Form of Evidence - Main Declaration

13.30

Evidence of the use made of a mark should normally be given by the applicant himself, or by a director or other official who has (and who should state in his declaration that he has) access to all the relevant records. This declaration is known as the 'main declaration'. Any statements within the declarant's personal knowledge should be identified as such. The declaration should include the following minimum information:

- (a) the precise list of goods on which the mark has been used;
- (b) the turnover or volume of sales, separately for each of the

last five years at least, prior to the date of the application, (or shorter period where less than five years use is available);

(c) the amount spent on advertising and making the mark known, separately for each of the years at (b) above;

(d) exhibits showing actual use of the mark in relation to the goods, including examples of the goods themselves bearing the mark, and ancillary material such as labels, point-of-sale material, and copies of advertisements in which the mark appears;

(e) a list of the towns etc. in which the mark has been used in Malaysia.

(f) some history of the mark i.e. when it was adopted and first used in Malaysia.

13.31

Invoices and letterheads are not usually very weighty evidence of trade mark usage but may be admitted.

13.32

If an applicant claims use of the mark by a predecessor in title, he should indicate the date he acquired it and from whom. It should be remembered that not all transfers of a trade mark are accompanied by the goodwill of the business in which it was used. (See chapter 18 concerning assignments without goodwill.)

13.33

Where the application is accompanied by one for a registered user, prior use by the intended licensee may be taken into account in certain circumstances - section 12(3). See chapter 19 concerning registered users generally.

Form of Evidence - Supporting Declarations

13.35

Where a mark is very descriptive, independent evidence will usually be necessary to show that the concerned public have come to recognise the mark as a trade mark of the applicant. Its usual purpose is to corroborate statements by the main declarant, e.g., as to knowledge of the mark, date of first known use, use in particular area, placing of orders for goods or services under the mark, etc.

13.36

Supporting declarations may be submitted from members of the trade or from the purchasing public. They should be way of statutory declaration etc. as set out in paragraphs 13.10 to 13.16.

Examination of Evidence

13.40

Declarations should be in proper form - see paragraph 13.14. Only the evidence, which the applicant has elected to file, should be examined. There is no question of requiring him to file further and better evidence. He may, however, be given the opportunity, if he wishes, of filing supplementary evidence if that which has been supplied is not enough to overcome the objections to his application.

13.41

The list of goods or services claimed on the application form should be compared with those in the evidence. Where the evidence does not support the full claim, it should be limited appropriately. (It is not necessary to be too restrictive in this matter, if, for example, the mark has been used on bread, cakes and biscuits, a specification of 'flour confectionery' would be perfectly acceptable. See chapter 11 concerning the editing of specifications generally.)

13.42

Similarly, the mark applied for should be compared with that in the exhibits. Unless they correspond in every essential particular, the evidence should be refused.

13.43

The area and extent of the use made of the mark should be carefully assessed. It should be remembered that the applicant is required to prove factual distinctiveness in Malaysia and not in some other country. Allegations that the mark's reputation has 'spilled over' into Malaysia may be considered.

13.44

Only use prior to the date of the application can be taken into

account - see paragraph 13.23. In assessing the extent to which the mark has acquired factual distinctiveness by the date of the application, the size of the potential market for the goods or services concerned should be borne in mind. The degree to which this has been penetrated by the applicant's mark may be quite extensive over a comparatively short period, or may be insignificant over a prolonged period. The volume of sales, and advertising, and the area covered by them, will be as important, if not more so, than the length of time the mark has been used. An important consideration also is maintenance and/ or growth of market share over say a 5 year period. This demonstrates the strength of the mark in the market place.

13.45

Depending on the strength of the original objection and the extent of the use made, the application will either be acceptable, or not acceptable at all. The power to require a disclaimer, limitation, condition, etc, applies just as much to an application proceeding on evidence as to one accepted prima facie, and the principles in chapter 15 should be borne in mind in reaching a conclusion as to the effect of the evidence. If this is less than what the applicant is contending for, he should be offered a hearing on the evidence, even if he has had one on the prima facie application. Strictly, this is not a second bite at the cherry but a continuation of an adjourned hearing.

13.46

Trade marks accepted and proceeding to registration on evidence of use should carry an endorsement to that effect. "The provisions of sub-section 10(2B) apply."

Any Other Circumstances

13.50

The "other circumstances" mentioned in section 10(2B)(b) must be such as to show that the mark in question is "in fact capable of distinguishing". The meaning of the latter phrase has been discussed at length in chapter 12 and must be borne in mind in ascertaining whether circumstances other than actual use of the mark have resulted in factual distinctiveness. They must be peculiar to the applicant and the mark. They must be

judged in relation to the specification for which registration is sought.

13.51

The circumstance most often applicable under this provision is a prior registration, which proceeded upon evidence of actual use. It applies either where the new application is for the same mark but slightly different goods, or is for the same goods but a slightly different mark. Thus, if a proprietor achieved registration of a prima facie non-distinctive mark and, subsequent to that registration, used the same mark on goods, which, although not within the earlier claim, were not too different from them, he might be able to claim that the public would readily associate the new goods with his mark. Similarly, it is reasonable to believe that the reputation gained by the use made of the earlier mark would spill over to the introduction of another mark that differed only slightly from the one already known to the public. This is, after all, the rationale for refusing registration of such a mark to another proprietor.

13.52

The practice referred to in the preceding paragraph is sometimes known as 'extending equities'. It cannot be invoked where both the mark and the goods differ from those of the earlier registration; in such a case the factual distinctiveness of the new application will have to be fully proved by evidence. Nor can it be invoked by citing an earlier registration that was itself obtained under the practice. A succession of so-called 'creeping equities' could result eventually in the proprietor obtaining rights in a range of goods or services far removed from those for which he was required to prove factual distinctiveness by evidence. This does not mean that a proprietor cannot make more than one application under the practice, but each one must be tied to the original registration and considered on its own, apart from any other registration.

13.53

Most applications under the "other circumstances" provision involve an extension of the registered goods or services. There

has to be some practical limit to what is permissible without actual evidence being produced. The practice is to allow only such claims as do not go wider than goods or services of the same description as those of the earlier registration. (See chapter 11 for the meaning of goods or services of the same description.)

13.54

A useful guide to the reasonable limits of equity extension, and the principles applicable, is provided by "Esso T.M.", [1972]R.P.C. 283. The word 'Esso' could not be registered without evidence of use, since it was practically the exact phonetic equivalent of the two letters SO, and so was not distinctive - see the "Ogee" case reviewed in chapter 12. Those letters were also the initials of the applicants, Standard Oil. The proprietors had achieved registrations of the mark for motor fuels, oils and maps. They produced evidence from the public to the effect that they would think that any goods whatsoever marked Esso were made by them, and argued that they should be allowed to register it for trousers and chocolate if they wanted to. In dismissing an appeal against the Registrar's refusal to register it for a range of goods in class 12, Whitford J. said:

"The present application should be allowed to proceed so as to cover those categories of goods falling within the specification of the present application which can on a reasonable basis be said to be fairly closely allied to the pre-existing fields of the applicants' activities ... There must be some limitation. I think the application should be allowed to proceed in respect of tyres for vehicle wheels, having regard to the undoubted evidence in this case of the extent of the applicants' activities in the motoring field and having regard also to their existing registration covering fillers for use in the manufacturing of rubber and artificial rubber, but so far as the rest of the specification of goods is concerned, I do not think it would be right to allow them to proceed in respect of parts and fittings included in class 12 for land vehicles and watercraft, because, as I have already indicated, it seems to me that this covers altogether too extensive a field."

Honest Concurrent Use

13.65

Normally, an application to register a mark, which is confusingly similar to one that is already registered in the name of a different proprietor for the same goods or services, or for goods or services of the same description, must be objected under section 19. Section 20(1), however, provides an exception. It gives the Registrar a discretion to register such a mark "in the case of honest concurrent use or of ... other special circumstances", if he thinks it proper. The discretion includes the power to make the registration subject to such conditions, amendments, modifications or limitations as he may think right. (Conditions and limitations, etc. are dealt with in chapter 15.) The phrasing makes it clear that honest concurrent use is itself a special circumstance. What other circumstances are special in this connection is considered in paragraph 13.80.

13.66

'Concurrent' is not the same thing as 'contemporaneous' - see "L'amy T.M.", [1983] R.P.C. 137. As is frequently the case throughout trade mark legislation, the Registrar is concerned with the public interest, particularly the protection of the public from confusion and deception, and some evidence that the relevant public know both marks is required.

13.67

The rationale of the 'honest concurrent user' provision was considered by the U.K. Registrar in the unreported case of "Eltreva v.B & N (Engineers) Ltd. (Insal doubleclad)" in connection with section 12(2) of the U.K. Act which is, for all practical purposes, in identical terms to section 20(1). He said:

"The essence of compatible registration of conflicting trade marks under section 12(2) is, it seems to me, that user of each of them has been such that the relevant public has had sufficient opportunity to become aware that there are two such marks in use and so be able to be alert to the possibility of confusion and that in these circumstances some degree of actual confusion may be tolerated, although whether concurrent registration can follow is a matter of discretion. In my view

the word 'concurrent' as used in the subsection necessarily involves user that is not only concurrent in the sense that it took place during the time that the opponents' registration was in force, but also in the sense that it occurred in the same market. Unless the user was concurrent in both time and place it is impossible to judge the extent to which public awareness of the likelihood of confusion reduces the potentiality to something that can not only be tolerated by them but also should be tolerable by the owners of the marks."

13.68

This view that both marks need to be known in the same market before the provisions can be applied is supported by the following passage from the speech of Lord Diplock in the matter of "GE" Trade Mark, [1973] R.P.C. 297, at page 326:

"In the early nineteenth century trade was still largely local; marks which were identical or which closely resembled one another might have been innocently adopted by traders in different localities. In these, their respective products were not sold in competition with one another and accordingly no question of deception of the public could then arise. With the rapid improvement in communications, however, in the first half of the nineteenth century, markets expanded; products of two traders who used similar marks upon their goods could thus come to be on sale to the same potential purchasers with the consequent risk of their being misled as to the origin of the goods. Furthermore, it was accepted that as an adjunct of the goodwill of the business the right to use a trade mark might be acquired by more than one successor if the goodwill of the business were divided, as it might be, for instance, where the business had formerly been carried on in partnership or from more than one manufactory or shop. To meet this kind of situation the doctrine of honest concurrent user was evolved."

13.69

The factors which should be considered in examining evidence supplied to support a claim to the benefit of section 20(1), whether ex parte or inter partes, were delineated by Lord Tomlin in "Pirie's Application", (1933) 50 R.P.C. 147. These are:

(a) the extent of use in time and quantity and the area of the

trade;

(b) the degree of confusion likely to ensue from the resemblance of the marks, which is to a large extent indicative of the measure of public inconvenience;

(c) the honesty of the concurrent use;

(d) whether any instances of confusion have in fact been proved;

(e) the relative inconvenience which would be caused if the mark were registered, subject if necessary to any conditions and limitations.

13.70

The applicant's main declaration filed in support of his claim should enable the first of Lord Tomlin's criteria to be assessed. His reference to the need to take account of the area of trade should be particularly noted. It provides support for the view expressed in paragraph 13.67 concerning the meaning of 'concurrent'.

This is relevant to claims for registration of service marks, where reputation is often local.

13.71

The extent of the use required can no more be stated in advance than it can in the case of an application proceeding under section 10(2B)(b) - see paragraph 13.20. It must have been long enough for the relevant public to have had adequate opportunity of becoming aware of both marks and of being able to distinguish them. If the applicant can show, for example, that his and the other proprietor's products have been advertised, under their respective marks, contemporaneously in the same journal, it would undoubtedly assist his application.

13.72

The degree of likely confusion will depend on how close the marks and goods or services are to one another, and will obviously vary from case to case. Where the marks, goods or services and markets are all identical, there can be no way that the public could distinguish between them; confusion would be inevitable. There seems to be little chance that evidence could overcome such closeness, however, the Registrar must consider evidence an applicant wishes to submit for honest

concurrent use. In other cases, the imposition of some condition or limitation (such as a geographical separation) may suffice.

13.73

The applicant's honesty will always need to be assessed. If he can furnish some evidence that his mark was independently conceived, it will be beneficial to him. Even if he created his mark with full knowledge of the registered mark it will not necessarily mean that he was dishonest, although it might mean that the Registrar's discretion should not be exercised in his favour. That was the outcome of "Bali v. Berlei" - Bali T.M. (No.2), [1978] F.S.R. 193.

13.74

It is unlikely that any evidence pertaining to actual confusion will be available at the ex parte stage. The most that the applicant is likely to be able to provide is a declaration that no confusion has come to his notice. (See paragraph 13.93 re opposition.) The fact that the registered proprietor has the exclusive right to his mark for all the goods for which it is registered must never be lost sight of. If the applicant alleges that the registered proprietor is not using it on some of these goods that cannot be taken into account at the application stage. The applicant must first take the necessary steps to have the unused goods struck from the registration.

13.75

Once the Registrar has decided the extent of any likely confusion or deception of the public, after taking full account of the evidence provided, he must consider what relative inconvenience would be caused if the mark were registered. The Registrar must take into account the inconvenience of both parties not just that of the owner of the registered mark. If evidence shows factual co-existence over a period of years, the applicant would be caused great inconvenience if this mark is not registered. In doing so, the effect of section 40(1)(f) must be borne in mind; use of either mark will not infringe the other registration and cannot, therefore, be excluded. Until the registration is achieved, however, the applicant's use will, in all probability, be an infringing use.

13.76

One condition that should always be imposed in cases proceeding under section 20(1) is a condition of Notice - see paragraph 13.92.

Other Special Circumstances

13.80

It would not be prudent to attempt any all-embracing definition of the meaning of this expression. All that is feasible is a note of the more important cases in which circumstances other than use have been held to come within the subsection. Some of them may come to light only in contested proceedings, but they are included here for convenience.

13.81

The applicant's use of his mark from a date prior to the date of the conflicting registration (or from the registered proprietor's first use if that is earlier than his registration) is always a special circumstance. This is the effect of section 20(2), which provides that the Registrar shall not refuse the later application if the applicant's use has been continuous. Of course, at the application stage, the Registrar will have no knowledge of the date of the registered proprietor's first use (unless that registration proceeded on evidence of use under section 10(2B)(b)). Accordingly, the Registrar cannot normally have regard to section 20(2) in ex parte proceedings.

13.82

In "Granada T.M.", [1979] R.P.C. 303, an application to register the word 'Granada', (a geographical name) was opposed by the proprietor of a registered composite mark in which the word was disclaimed. The U.K. Registrar held that the disclaimer did not lessen the likelihood of confusion, since the public would be unaware of it, but it did mean that the applicant's use of the word could not be stopped since it was a non-infringing use. This was held to be a special circumstance permitting registration under the honest concurrent user provision, despite the relatively short period, 2 years and 10 months, of use by the applicant. There was no reason, in the

circumstances, to require him to wait until he could make a fresh application with the benefit of longer use. (In "Pirie's" case, supra, a period of 6 years use was considered sufficient; the marks were Abermill and Hammermill for identical goods.)

13.83

Where the registered mark is proved not to have been used for all or some of the goods or services, it is sometimes argued that this is a special circumstance permitting registration of the conflicting application. This argument cannot be accepted. While the goods or services remain within the registration, its proprietor may recommence use of his mark on them at any time and confusion of the public, which section 19 is designed to prevent, would ensue. The applicant's proper course in such a case is to apply under section 46 to have the register rectified by striking out the unused goods or by total removal of the registration. See also, in this connection, "Electrix T.M.", [1957] R.P.C. 369 at 380.

13.84

The Australian Trade Marks Office accepts that special circumstances occur where deceptively similar marks are used by sporting teams for different sports. The rationale is that the likelihood is that supporters of one sport will know the trade marks used in their particular sport and so would not be deceived or confused to see a similar mark used by other sporting bodies.

Advertisement

13.90

Section 27(2) states that the Registrar may cause an application for registration of a trade mark to be advertised before acceptance if it is made under section 10(2)(B) or "in any other case where it appears to him that it is expedient by reason of any exceptional circumstances to do so". In practice, this provision is applied only to cases proceeding under section 12(2) or 20(1). All other cases should be advertised as accepted.

13.91

Unaccepted applications should be advertised in the Gazette

accompanied by whichever of the following statements fits the case:

- Advertised before acceptance by reason of use; sections 10(2B) and 27(2)
- Advertised before acceptance by reason of other circumstances; sections 10(2B) and 27(2)
- Advertised before acceptance by reason of use and special circumstances; sections 10(2B) and 27(2).

13.92

A condition of Notice should be imposed on any case proceeding to advertisement following the application of section 20(2). This means that the applicant will be required to give a written assurance that he will send a copy of the advertisement to the registered proprietor of the cited mark at his address for service. In a case where no opposition is subsequently filed, the notice is sent. He may do this most conveniently by enclosing a copy of the letter of notice with the registration fee.

13.93

In inter partes proceedings; the Registrar is not bound by any decision he may have made at the ex parte stage. If opposition is entered to a mark advertised following the application of section 20(1), the opponent (usually the registered proprietor of the conflicting mark) will have an opportunity of filing evidence, and this may cause a different view to be taken of the factors to be considered under paragraph 13.69. In particular, evidence of actual confusion, or of prior use, may be available.

13.94

Provided that no successful opposition results from the advertisement of an unaccepted application it will be accepted. Section 27(3) empowers the Registrar, if he thinks fit, to readvertise such an application. In practice, this power is never exercised.

CHAPTER 14 - INHERENTLY DECEPTIVE MARKS

Intrinsic Deception

14.1

Section 14(a) contains a very short but very powerful mandatory prohibition on the registration of any mark use of which is likely to deceive or cause confusion to the public. It extends to parts of marks. This general provision in addition to specific prohibitions, many of which could also lead to such confusion or deception, and which are examined in chapter 5.

14.2

Confusion caused by the resemblance of marks where one mark is registered and the goods or services are similar is the subject of section 19 and is covered in chapter 11. Section 14 is also applicable to cases where the confusion is caused by the similarity of the marks, but, because it makes no mention of registered marks of goods of the same description or services that are closely related to the goods, it goes wider than section 19 and so is a very common ground on which most oppositions are founded; this aspect is examined in chapter 24. This present chapter deals with deception likely to be caused by the mark itself, without making any comparison with other marks - so - called inherent or intrinsic deception.

14.3

Objections to marks on the ground that they are inherently deceptive, should only be taken, or maintained, if it is reasonably clear that the mark, or a part of it, would be likely to influence the relevant public to choose or to prefer the applicant's goods or services.

14.4

Where it would clearly not be in the applicant's own interests to use the mark in a deceptive fashion, the objection need not be taken, or, if taken, may be waived at a hearing. A series of semi descriptive marks is often used to indicate variations in a vendor's range and it is to be expected that will trade sensibly as well as honestly. For example, no objection need be taken to the descriptive suffixes in the marks Trilchoc and Trilcheez for biscuits. They are both perfectly good vice versa.

No confusion or deception of the public is likely.

14.5

The fact that consumer protection may be governed by other domestic laws is rarely a matter that can be taken into account under the section. Any regulatory provisions in such legislation are not a matter for the Registrar. Nevertheless, if it is clear that a mark would offend such a statute, objection to it would be taken under section 14(b) on the ground that it is not "entitled to protection by any court of law", in addition to any likelihood of deception under section 14(a).

Direct Reference

14.10

Objection should be taken under the section to any mark which, by its very nature, would be likely to deceive the public as to the place of origin, composition, purpose, or any other characteristic of the goods or services. Where, therefore, objection is taken on the ground that a mark has a direct reference to the character or quality of the goods or services, it will nearly always be necessary to add an objection under section 14, for if they do not in fact possess the indicated characteristic or quality, the mark will deceive.

14.11

It may be argued that if a mark is deceptive it cannot at same time be descriptive, and vice versa. This is superficially attractive if one were considering only a single item. However, specifications are drafted in more general terms and usually in the plural, e.g., 'optical instruments' and not 'a microscope'. It is, therefore, perfectly possible for the mark to describe some of the goods or services and to be deceptive for others, within the same specification. On rare occasions, a specification will also include goods or services for which the mark is neither descriptive nor deceptive, and if it is limited to these goods or services by removal of those in respect of which the mark offends, the objections will be removed with them.

14.12

The deception/description dilemma in which many applicants are placed is well illustrated by "Orlwoola T.M.", (1909)26R.P.C.850. The mark was to be used on clothing. Fletcher Moulton L.J. held it to be "Utterly unfit for use as a trade mark" as it was directly descriptive for goods that were all wool and hopelessly deceptive for those which weren't. The misspelling of 'all wool' was held to be quite immaterial. This double objection cannot be overcome by any limitation of the goods. If woollen goods are excluded, the mark remains deceptive for what is left; if non-woollen goods are excluded, it remains descriptive for what is left; if both are excluded, nothing is left.

14.13

A more recent case was "China-Therm T.M'." [1980]F.S.R.21, where the goods were insulated drinking vessels made of plastics materials. The word 'therm' has a direct reference to the capacity of the goods to keep drinks warm, but this objection was not insuperable and could have been overcome by a disclaimer of the word had the rest of the mark been registrable. The real mischief was the presence in the mark of the word 'China'. This is a generic word for a semi-transparent white earthenware or porcelain. Were the goods not of this kind; the plastics materials made therm look like real thing and so deception was unavoidable.

14.14

It was argued in the "China-Therm" case that there could be no deception in use as, on close examination, customers could tell that the cups were not genuine China. This was rejected, on the authority of Hack's Application (Black Magic)" (1940) 58R.P.C.91. The words 'Black Magic' were registered for chocolate confectionery, and were desired by another proprietor for a laxative. Although there is such a thing as a chocolate laxative, the goods are not of the same description, and it was submitted that one could not be confused with the other. Morton J. held the fact that customers were not ultimately deceived was of no consequence; it was sufficient if the public were caused to wonder whether or not the goods had a common commercial origin.

14.15

Moreover, the likelihood of confusion is not eradicated by accompanying material attempting to make it clear that the goods do not possess the indicated characteristic. As Whitford J. said in the "China-Therm" case:

'People are likely to think that goods advertised as China-Therm ... are likely to be made of China; and the mere fact that they could be so advertised so that it is made plain that they are not made of china or that upon receipt, in the even or an order being placed under a misapprehension, it would be ascertained that they were not made of China, cannot save the position so far as the applicants are concerned".

14.16

The ratio decidendi of the 'Black magic" case is sometimes paraphrased as "a mark will offend against the section if it is likely to lead to an abortive enquiry for the other proprietor's goods". This interpretation was applied in "Krystal T.M"., [1960] R.P.C.184 for chemical plant. The word "Krystal" directly described a certain crystallisation process but was also held to be deceptive for chemical plant generally because persons wanting to purchase crystallisation plant might be deceived by the mark into making enquiries.

14.17

Misspelling does not assist an otherwise deceptive mark; cf. "Orlwoola" above. The mark in the "BBI Litetrac"[1971] R.P.C.1 was held to be deceptive for light fittings, which did not incorporate light tracks. "Ombrella" was rejected for shower curtains because it not only described the applicant's umbrella-shaped goods but would be deceptive for shower curtains of other shapes- [1974]R.P.C.371.

14.18

In class 16, devices of animals, flowers. Etc. are commonly used as trade marks for printed publications. No objection need be taken under section 14(a). The public would not expect the goods be concemed with the subject depicted in the mark. Where, however, the mark could be used as pattern on the goods, such as textiles, or chinaware, it will be necessary to ensure that

the mark is not used descriptively, as that would also limit the ability of other traders to use similar marks in the normal way of trade. This achieved by requiring the specification to be limited. For example, a mark consisting of a device of an orchid and to be used on textiles, would require the specification to be limited to "none decorated with orchidaceae". (it would be insufficient just to exclude the particular variety depicted in the mark, even assuming that it was clear enough to be identified). The use of the word 'decorated' allows the mark itself to be used on the goods. If the mark is a word, the exclusion should be, in this example, 'none relating to orchidaceae'.

Variation clauses

14.20

An otherwise acceptable mark may contain an element naming, describing or picturing the goods. Unless the application can be brought within one of the cases in paragraphs 14.21 to 14.26, the specification must be limited to those goods, or to goods within the description, as appropriate-regulation 16(1). Use of the mark on any other goods would be bound to deceive. For example, "Black Gold" for jewellery would be deceptive if used on jewellery that was not made of gold, and the argument that the phrase hangs together and has a meaning of its own cannot be accepted as overcoming the objection under section 14 (although it does overcome any objection under section 10 that the mark is descriptive). Trade marks are most commonly used adjectivally, so that phrases such as "a black gold ring, please" and "Black gold rings are the best" are likely to confuse, whether it is the customer or the vendor who uses them. The specification must be limited to rings "made wholly or substantially wholly of gold" - see paragraph 9.73. The objection would be not be applicable if the mark were, say, "Gold Mountain "; here the world gold qualifies the word mountain and does not carry into the goods.

N.B. Application in classes 14,22,24 25, 26 and 34 where the mark contains a reference to precious metals should be examined with particular care if the goods could be (not necessarily are) made of the metal or could contain threads of the metal.

14.21

Where the descriptive element in the mark names the goods or services and is separate from what is otherwise registrable, it may be appropriate to require a variation clause to remove the possibility of deception in use. This provision is an alternative to an outright refusal under regulation 16(1) and is contained in regulation 16(2). It empowers the Registrar to accept the application for all the goods or services claimed provided that the application states in his application that the name will be varied when the mark is used upon goods or services other than those named in the mark as submitted for registration. For example, if the marks were 'Sandobis Lager' and the goods were 'Beer, ale, stout and lager', it could be accepted only if the applicant stated on his application (preferably before he submitted it);

"In use in relation to goods covered by the specification other than lager the mark will be varied by the substitution of the name of such goods for the word 'lager'."

14.22

Where an element in a mark describes the goods or services instead of naming them, the wording of the variation clause must be altered accordingly. For example, if registration of the mark 'Portalin Orange' were desired for 'fruit juices', it could be accepted, subject to a variation clause worded;

"In use in relation to fruit juice other than orange fruit juice the mark will be varied by the substitution of the description of such fruit juice for the word 'orange'."

14.23

Some times the mark will contain both a description and the name of the goods or services. In such a case, the variation clause must be worded appropriately. For example, if the mark were 'Portalin Orange Juice' and the specification were 'non-alcoholic drinks, fruit syrups, and preparations for making drinks, all included in class 32', the wording should be:

"In use in relation to goods covered by the specification other than orange fruit juice the mark will be varied by the

substitution of the name and description of such goods for the words 'orange juice'."

14.24

The same principles apply if the descriptive (and therefore potentially deceptive) wording is in foreign language. For example, if the words 'vino da tavala blanco secco' appeared on a wine label, they would have to be translated (under regulation 25) and the following variation clause entered:

"In use in relation to wine other than dry white table wine the mark will be varied by the substitution of the Italian description of such wine for the words 'vino da tavala blanco secco'."

14.25

Where the potentially deceptive element is a device, the wording of any variation clause will be drafted to fit the case, along the lines of the above examples.

For example, a label mark for 'canned fruit' may have on it a picture of a pineapple. The variation clause in such a case would read:

"In use in relation to canned fruit other than canned pineapple the mark will be varied by the substitution of the device of such fruit for the device of pineapple".

14.26

If label mark contains both descriptive wording and a device of the goods or services, both of which will be varied in use, two variation clauses will be necessary; one for the words and another for the device.

14.27

A variation clause makes it unnecessary to require a disclaimer of non- distinctive devices. The same applies to descriptive words, provided that they are in Bahasa Malaysia or the English language. However, the usual practice of requiring descriptive words in foreign languages to be disclaimed should be followed. An appropriate wording of a disclaimer where the disclaimable element may be varied in use is:

"Registration of this trade mark shall give no right to the exclusive use of the words[here quote the disclaimed element as

it appears on the application form]."

Composition of the goods or services

14.30

An objection that a mark, or part of a mark, has a direct reference to some of the goods, and so would be deceptive if used on other goods within the specification, may be overcome in several ways. There are two main alternatives. One is to limit the specification, the other is to agree to a condition. The difference is in the effect on the proprietor's infringement right and is explained below.

14.31

If a mark contains a direct reference to the material of which the goods or services are made and the case is not in the "Orlwoola" category-see paragraph 14.12- a suitable limitation of the specification may suffice. For example, anyone looking for a rubber doormat and hearing a reference to "Magrubba" doormats is likely to think that they are made of rubber. This is no guarantee in this case that an unscrupulous proprietor will not sell mats made of artificial rubber under the mark. If the specification applied for is 'door mats' at large, it must be amended to 'doormats made wholly or substantially wholly of rubber'. This restricts the proprietor's infringement right to those goods or services on which he may validly use the mark. The "China-Therm" mark might just have been acceptable if the application had been willing to limit his goods or services to chinaware; it was his unwillingness, or inability, to do so that made the mark deceptive - see paragraphs 14.13 and 14.14. As to the effect of actual use on such a mark as 'Magrubba" see paragraph 14.51.

14.32

If a mark contains a direct reference to a characteristic or quality of the goods or services other than the material of which they are made, it will usually be sufficient to impose a suitably worded condition under section 25(3). This leaves the specification unchanged and so does not affect the proprietor's infringement rights.

The public interest served by this approach is the proprietor can prevent deceptive, but otherwise lawful, use of the mark by

others.

Geographical Origin/Indication

14.35

A mark may indicate geographical origin, and if it is not itself a geographical name may be registrable as fulfilling the requirements of section 10. The geographical indication need not be a place name, it could be a word or device associated with particular town, region or country. If, however the place indicated has a reputation for the goods or services claimed, the mark will be deceptive if the goods or services are not manufactured there or are not the produce of that place, or the services are not provided there and so would offend against section 14. A condition limiting use of the mark to goods or services having the origin indicated by it will usually be necessary. The circumstances in which a condition will usually be required may be summarized as;

- where the public would expect the goods or services to come from the named area, i.e., where the place has a reputation for the goods or services concerned;
- where it matters, i.e., where the goods or services are natural products;
- where the mark states the origin in plain language. An exception to the practice is given in paragraph 14.38.

14.36

Wines produced in different countries have different characteristics of flavour, bouquet, colour, etc., depending not only on the variety of grape used, but also the nature of the soil in which the grapes are grown and the method of manufacture. Sparkling wine produced by the 'methode champagnoise', for example, is quite different from wine in which the bubbles are achieved by adding a gas after maturation. Wine producers may try to register a mark, which falsely indicates that, their produce emanates from one of the great wine producing countries, or estates. Even if their intentions are honest, a condition limiting use of the mark on wine coming from the indicated area will be necessary; a later assignment could enable the new proprietor to trade deceptively. For example, the mark 'Zavrofrench' for wines at large may be accepted, subject to a condition worded;

"It is a conditions of registration that the mark shall be used in relation only to wine the produce of France".

14.37

A geographical origin may also be indicated by a map of a region or country forming part of the mark, e.g., on a label. In such a case, a similar condition may be necessary. In addition, the non-distinctive device of a map of (name of place) will have to be disclaimed.

14.38

Countries with a worldwide reputation for their wines have legislation, which imposes very strict quality control over all aspects of production and marketing. Resident producers, subject to such controls, very jealous to preserve the reputation, which they share with all other wine producers in the same country, are unlikely to market wine that comes from some other country. In such a case, therefore, a condition of origin need not be imposed. This practice, as well as the practice of requiring a condition in other cases, is reported in "Tonino T.M.", [1973] R.P.C.568.

14.39

Indications of geographical origin in a trade mark (for which a single trading entity is seeking exclusive right) may have reference to other goods or services than wine, of course, and a condition will be necessary. Where the goods or services are natural produce the wording will be similar to that used in paragraph 14.36. Where the goods or services are manufactured, an appropriate wording would use in the words 'manufactured in ' in place of 'the produce of'.

14.40

If the specification includes goods or services for which the geographical indication would not be deceptive as well as goods or services for which it would be, the applicant may either delete the latter or submit to a condition. For example, a mark such as 'Hopscotch' for spirits and liqueurs' could be deceptive in view of the international reputation of Scotland for whisky, despite the fact that the word hopscotch, on its

own and not in relation to alcoholic drinks, means a children's game. An appropriate condition would be;

"It is a condition of registration that the mark shall, when in use in relation to whisky or to whisky-based liqueurs, be used in relation only to Scotch whisky or to Scotch whisky-based liqueurs"

14.41

A more liberal attitude may be adopted where the geographical origin is indirect. For example, objection need not be taken just because the mark is a word in a foreign language. The question is; is confusion likely? If not; is it remotely possible? Section 14 exists primarily to protect the public, and it will be necessary in the each case, therefore, to assess what the public in the market for the goods or services concerned will be likely to make of the mark. Sometimes, as in "Tonino" above, the foreign word will suffice to carry a source of confusion ('tonino' is an Italian affectionate diminutive of the name Antonio, as well as being an Italian surname). In other cases, an association between the mark and a particular geographical source will not be seen. In "Roman Holiday T.M"., [1964] R.P.C.129, for example, the mark was held to indicate no geographical origin for the goods or services (cosmetics). It is matter for judgment in each case, bearing in mind that if the Registrar has any doubt he must object to the application.

Literary and Artistic Works

14.45

In use, device trade marks on books are likely to be placed in subsidiary position (compared with the book's title, say), and to be of a relatively small size. The likelihood of the device being taken as the subject of the book is small. If, therefore, the goods or services of the application are books or other printed matter and the mark consists of a device, there is no need to object on the ground that the device indicates the content of the book (descriptiveness) or would be deceptive if the content is otherwise. Publications issued by the World Wildlife fund may or may not be about pandas; the device of a panda on them is not likely to be taken either way.

14.46

Descriptive words, on the other hand, may be mistaken in some cases as the title of the publication. However, even here, objection under section 14 need not be taken. In such a case, objection will be taken under section 10(2) and the mark could be accepted only on evidence of distinctiveness being supplied. If satisfactory, it will show that the descriptive element is true and taken to be so by the public. Marks such as 'Practical Computing', 'Amateur Photographer' and so on, used in respect of periodicals, will not prove deceptive in practice.

14.47

Where literary or artistic works other than books or printed matter are included in the specification, (e.g., films, paintings, computer programmes), the matter may not be so clear-cut. Some marks may imply, if not directly state, the content of the work. It will be a matter for decision in each case whether to take objection under section 14. Marks should be judged by the way they are likely to be used in actual commerce. Fanciful or obscure references may be ignored and a limitation or condition need be imposed only where there is a real possibility that the public would be confused. There would be need, for example, to object to the mark "space invaders" for computer software, requiring a condition that use be limited to computer games; the allusion is obvious and the proprietor is not likely to sell a database programme under the mark.

Evidence of Use

14.50

Subject to what is said in paragraph 14.46, evidence of use will rarely overcome an objection of inherent deceptiveness. It is not what the applicant has done that matters; it is what he may do. Similarly it is not what the applicant believes his mark to mean; it is what the public may think it means.

14.51

No amount of use of the mark 'Magrubba' - see paragraph 14.31- on doormats made of cork or reed will remove the objection. The applicant may produce witnesses who say that they are familiar with the mark and do not expect to get the rubber mats when

using it. That ignores those who meet the mark for the first time. Until familiarity has educated them into realising that the mark does not mean rubber mats, they will be liable to be confused by it. Since there are always new customers coming in to the market, the inherent deceptiveness of the mark is never cured. And what if the proprietor began to use the mark on rubber mats?

14.52

On the other hand there may be some circumstances where evidence of a different nature may assist on otherwise unregistrable mark. An application to use the mark "Consarc" on 'electrical welding apparatus' was refused on the ground that unless the apparatus were for use in arc welding (as distinct from, say spot welding or resistance welding) potential customers were likely to be confused by it. The applicants' name was Consarc Corporation, and it was argued on their behalf that purchasers would realise that and not take the mark to indicate anything more than the goods or services emanated from them, especially as they were of a kind where prior detailed enquiry was likely to be made, at the end of which a purchaser would have no illusions about the nature of the goods. An appeal against the refusal was dismissed "Consarc T.M". [1969] R.P.C.179. In the course of judgment, Tookey Q.C., said;

"I could quite understand a case where a company had established a reputation in a mark ... upon a variety of goods, such that no miss-understanding arose on the ground that the mark had some descriptive reference to particular goods or services in connection with which the company had first established a reputation. That would be a case where the circumstances had developed in such a way that the original descriptive reference in the trade mark had lost its significance".

14.53

It was also claimed that "Consarc" was an invented word. If so, it only shows that even an invented word can deceive.

CHAPTER 15 - THE REGISTRAR'S DISCRETION

Statutory Basis

15.1

The Act, and the regulations made thereunder contain many provisions, which confer discretionary powers upon the Registrar. These powers are delegated to all Deputy Registrars and Assistant Registrars.

15.2

Many instances of the way the Registrar's discretion is exercised in practice are included in other chapters of this Manual. These have been mainly limitations or conditions. In this chapter, further examples of these are given to show different circumstances where they are appropriate, and a special form of condition, a disclaimer, is examined. Together, they demonstrate the flexibility of the discretionary power, which enables the Registrar to accept many applications that would otherwise be refused. The chapter begins, though, with the nature of the discretion and the general manner in which it should be exercised.

Nature of the Discretion

15.5

Section 67 states that, in any appeal from a decision of the Registrar under the Act, the Court shall have and exercise the same discretionary powers as are conferred on the Registrar. Section 3(1) defines Court as the High Court. In exercising his discretionary powers, therefore, the Registrar should proceed upon the same principles as motivate the Court in like case.

15.6

The discretion is thus seen to be a judicial one. As Younger J. said in "Stanwal T.M.", (1918) 35 R.P.C. 53:

"The discretion must be exercised upon judicial principles and affected neither by caprice nor over caution."

Another helpful passage is the following from Cross J. in "Rawhide T.M.", [1962] R.P.C. 133:

"All three members of the Court of Appeal held that the Registrar had a general discretion to refuse to register a trade mark which satisfied all the positive conditions laid

down by the Act. But though the Registrar in exercising his discretion is not, I think, limited to any particular type of consideration, he must exercise it judicially on reasonable grounds which are capable of being clearly stated. A vague feeling of distaste for the applicant or his methods of business cannot justify a refusal to register a mark which satisfies the conditions laid down in the Act."

15.7

It may be added that a feeling of distaste for the mark itself would not suffice for the adverse exercise of the Registrar's discretion, unless it came within the prohibition in section 14 against immoral or scandalous marks - see chapter 5.

15.8

A case where the applicant's methods of business did affect the way the discretion was exercised is "Arthur Fairest Ltd.'s Application", (1951) 68 R.P.C. 197. The mark was used mainly on lottery tickets whose distribution was, under the law applicable at the time, illegal. It was held that the mark did not offend against section 11 (the U.K. equivalent of section 14) as being "disentitled to protection in a court of justice," as that provision contemplated some illegality in the mark itself. However, registration was refused in the exercise of discretion because a reference to registration when the mark was in use might lead some persons to believe that judicial approval had been given to the tickets themselves. It would not have been appropriate to require a condition limiting the mark to legal use.

15.9

The effect of an exercise of the discretion is almost always to leave the register in the state in which it existed before the question arose. Thus, on an application to register a mark it will be to refuse; on an unsuccessful opposition it will also be to refuse the application nevertheless; on a successful application to rectify the register it will be to refuse to make the desired alteration.

15.10

Section 76 states that the Registrar shall not exercise any

discretionary power adversely to the applicant for registration or the registered proprietor in question without giving the applicant an opportunity of being heard, provided that a request for a hearing is made within the time prescribed in the circumstances. Clearly, a registered proprietor has as much right to a hearing as does an applicant.

15.11

Despite the apparently restrictive wording of section 76, the same policy should be adopted toward other persons having legitimate business at the registry, such as applicants for rectification, opponents basing their case other wise than upon a registration of theirs, and so on. This is only natural justice, and it would be odd, if not improper, to treat litigants differently according to their status or the nature of the business being conducted.

Non-discretionary Decisions

15.15

The finding of questions of fact is not an exercise of discretion. Nor, if an application comes within a statutory prohibition, is there any room for the exercise of discretion; the provision is mandatory.

15.16

In dealing with conflicts of marks, regard must be had to whether they are confusingly similar and to whether the goods or services are of the same description - chapter 11. Both are questions of fact; the latter perhaps more obviously so as it may be the subject of evidential proof. As to the former, Luxmoore L.J. said in "Aristoc v. Rysta", (1943) 60 R.P.C. 87: "In the course of the argument it was suggested that the Assistant Registrar, in coming to his decision on this point, had exercised a discretion; but this is not, I think, the proper view of the law. What has to be done under section 12 of the (U.K.) Act is to ascertain whether there is a resemblance between two marks such as would be likely to deceive or cause confusion. If the answer to the question to be put is in the affirmative, registration of the mark sought to be registered must be refused."

Discretion is Unfettered

15.20

Where a matter is properly within the discretion, it would not be right to set up a general rule that would prevent a particular case from being considered on its merits. The discretion is not to be fettered by previous decisions on other cases and other facts. Nevertheless, discretion is to be exercised consistently and not waywardly.

15.21

While consistency of treatment is a desirable objective, the Registrar is not prevented from refusing or limiting an application, in the exercise of his discretion, by the fact that another application was treated differently in the past, even if the circumstances seem identical. The Registrar is not bound by earlier acceptances, which, on further consideration and experience, he considers to have been in error. If asked to take a mark on that basis, he will invariably decline the invitation. Still less is he bound by a decision in another jurisdiction where the law or the facts may well be different.

Withdrawal of Acceptance

15.25

Section 25(12) gives the Registrar power to withdraw acceptance of an application if he considers that it was accepted in error and this comes to light at any stage before registration. The Registrar may also withdraw acceptance if adding or requiring different restrictions or limitations and re-issue a new acceptance with the new requirements. This power seems to be in addition to those cases where an accepted application is successfully opposed under section 28. There is no corresponding provision in the U.K. Act.

The word error could apply where:

- the appropriate search for conflicting marks was not carried out thoroughly and a citation was missed.
- the surname, geographical or descriptiveness search was not carried out thoroughly

The words "special circumstances" would apply for example where a methodical and thorough research did not provide the relevant information since it was not in the available Trade Marks

Office resources.

15.26

Section 30(1) provides that, if there has been no successful opposition, and the registration fee has been paid, the Registrar must register the mark "unless the application has been accepted in error."

15.27

The applicant should be given an opportunity for a hearing and appeal on the new objection. (It would certainly be ultra vires for the Registrar to retake the identical objection that he had waived at an earlier stage of the proceedings.)

15.28

There may well be occasions where it appears that a serious error has occurred during the examination of the application, or in making the search for anticipations. The procedure to be adopted will depend on the circumstances and is broadly as follows:

- a) the formal date of acceptance of all applications will be the date of their advertisement in the Gazette, except in the case of those applications which are advertised "before acceptance" under section 27(2) - see paragraph 13.90;
- b) if the error comes to light before advertisement, there will be no question of invoking section 25(12) in view of (a) above, since the application will not have been accepted; the late objection will be communicated in writing to the applicant who will be offered of response in writing and thereafter a hearing, confined to the new matter, to be requested within the time prescribed in accordance with regulation 29 or 30, according to the nature of the objection;
- c) if the error comes to light after advertisement, otherwise than as a result of representations made by a third party, the late objection should be dealt with as at (b) above; if it cannot be overcome to the satisfaction of the Registrar he will refuse to proceed with the registration, under the power conferred by section 30(1);
- d) if the error comes to notice as a result of representations by a third party after advertisement, that party should be invited to communicate the objection to the applicant and to

say that if the application is not withdrawn, formal opposition will be entered; it will be open to an applicant in such a case to seek an ex parte hearing before the Registrar and to make such voluntary amendments to his application as will satisfy the Registrar that the objection could not be sustained. Any such amendment to the application will be made under section 25(9), which expressly enables an error to be corrected before or after acceptance. The amendment must be communicated to the other party who may still enter formal opposition if he wishes.

Disclaimers

15.35

Section 18 empowers the Registrar to require a proprietor to make such disclaimer, as he may consider necessary for the purpose of defining his rights under the registration. Subsection 1 of that section sets out three particular circumstances when the Registrar may hold the proprietor not to be entitled to the exclusive right that registration would otherwise confer upon him, and in which, therefore, a disclaimer of the exclusive right may be required. These are:

- (a) if a trade mark contains any part which is not the subject of a separate application by the proprietor;
- (b) if a trade mark contains any part which is not separately registered by the proprietor;
- (c) if a trade mark contains any part which is common to the trade or business or is not distinctive.

15.36

Strictly speaking; no disclaimer is ever necessary. The exclusive rights given by registration are derived from the mark as it appears on the register. This is a matter for the Court, which will have regard to the totality of the mark. In practice, however, proprietors are apt to claim exclusive rights to parts of marks which in themselves are non-distinctive or common to the trade. The function of a disclaimer is to prevent this and to protect those uninstructed in the niceties of trade mark law, and who may be unable to judge when the bounds of infringement rights have been exceeded.

15.37

Where a mark consists of more than one element, its

registration may be infringed if another trader takes only one of those elements, provided that it is distinctive. If, therefore, there is any doubt about the distinctiveness of any of the elements comprising a composite mark, exclusive rights to it will need to be disclaimed in order that the other traders may know what they are free to use.

15.38

Infringement rights go wider than the mark as registered; use of a deceptively resembling mark would be a cause of action. The difference between disclaimer of 'a letter' and 'the letter', and between 'a device' and 'the device', has already been explained in paragraphs 12.178 and 12.233 respectively. The use of the indefinite article in such cases, by limiting the proprietor's rights to the exact form in which the matter appears in his mark, prevents his taking unjustified infringement action against a trader who uses the normal form of the letter or device.

15.39

In practice, almost every disclaimer required by the Registrar falls within (c) of paragraph 15.35. The wording makes it clear that disclaimers apply only to parts of marks, i.e., the mark must be comprised of more than one element. If a non-distinctive element forms an integral part of the mark and is not separated off in some way, no disclaimer will be necessary; the mark will either be registrable as a totality (perhaps with a suitably worded condition), or it will not. The principle may be illustrated by the four marks below, applied for in respect of the stated goods:

- i) Apollo-Life, for electric light bulbs;
- ii) Consilite, for electric light bulbs;
- iii) Pirek-Lite, for telephone handsets.
- iv) Apollo Bank for financial services

A disclaimer is required only in the first and last examples. Although the syllable 'lite' is non-distinctive for goods, which are for producing light, it is not 'picked out' or emphasised in the second one. ('Picking out' must be visual and not auditory, since it is infringement and not deception that is to be guarded against; there can be no infringement if the use complained of is not visual - see paragraph 4.20). In the

third example, the word has no reference to the goods; any suggestion that, in this case, it has a reference to lightness of weight or colour is fanciful. In the fourth example the word Bank is descriptive in relation to financial services.

15.40

If a mark is composed of several elements, none of which is distinctive on its own, the mark can be registered as an unused mark only if the combination of the elements presents an entirely new idea - see the "Diamond T" mark in chapter 12.

15.41

A disclaimer will not assist an applicant to register a mark, which, both in its parts and as a whole, is non-distinctive. In "Ford-Werke A.G.'s Application" (1955) 72 R.P.C.191, the judge said:

"Nor would the position be any different were the applicants' offer to enter a disclaimer to the exclusive right to the use of these letters to be accepted. Such a disclaimer, while affecting the scope of the monopoly conferred by the registration, could not affect the significance, which the mark conveyed to others when used in the course of trade. If it be right to conclude that it is the letters 'F' and 'K' which constitute the feature of the mark which would strike the eye and fix in the recollection, this cannot be affected by what is or is not entered upon the register housed at the Patent Office. Attention must, therefore, be focused upon the content of the mark, and not upon the content of the protection sought for the mark".

The mark is illustrated at paragraph 12.85.

15.42

A similar point occurred in the "Ogee" case. There, the applicants offered to disclaim the letters 'OG', but Warrington L.J. said:

"If the goods of someone with the same initials were to be sold with the letter 'OG' upon them, persons asking for these goods as 'OG' might well obtain the applicant's goods and vice versa. The disclaimer of the right to use the letters themselves as a mark does not meet the case."

15.43

On the above authorities, the Registrar should not require, or permit, a registration with a disclaimer, which could lead to a probability that the rights of a registered proprietor would be misconceived by the public. It has to be remembered that disclaimers do not go into the marketplace with the goods or services, and the ordinary members of the public have no notice of them. The Registrar's practice is, therefore, to require a disclaimer where there is, or may be, a reasonable doubt over the extent of the exclusive rights which will be given by registration. This approach has to be sensibly balanced with the need to avoid cluttering the register with unnecessary disclaimers.

15.44

Where an element is so plainly non-distinctive or common to the trade, that no one would think that registration removed it from the public domain, (even if the proprietor claimed that it did) a disclaimer would be superfluous. Parts of marks in this category are:- unregistrable laudatory epithets; the names of the goods or services; words which directly describe the goods or services or a characteristic of them; and ordinary representations of goods or services commonly associated with those of the application (such as glasses for wines, test tubes for chemicals and so on). However, unregistrable geographical names should always be disclaimed, even if they are also the name of an accompanying device (such as Buffalo). (For another exception to this general rule, see paragraph 15.50)

15.45

If a non-distinctive element is misspelt, applicants commonly claim that the misspelling confers a degree of distinctiveness on the mark as a whole. A disclaimer will always be required in such a case, even if the element is one, which, under the previous paragraph, would not normally be disclaimed. A similar practice is applied to non-distinctive words in a foreign language.

15.46

If the disclaimable matter is very prominent, consideration must be given to whether the goods or services will be named by

it instead of by the distinctive element. If there is a reasonable likelihood of that, the application must be refused unless the applicant modifies his mark so as to reduce the size or position of the non-distinctive element sufficiently to alter the way the mark will be perceived and used in practice. Such modification is unlikely to be possible on any mark being examined. The owner must file a new application for the amended mark, as he will use it. Amending an application without ensuring that the mark in use is amended could complicate infringement action and disadvantage an owner. Some idea of where the borderline is to be drawn may be gauged from the following examples.

15.47

In the examples below, a disclaimer of the non-distinctive words 'The Clear Leaders' and 'The Freezer People' would enable the respective marks to be accepted as they stand; neither detracts from the impression which the other, and distinctive, elements convey, either visually or orally. (The device of a freezer in the center example is too fanciful to require a disclaimer.) In the third mark the words are too prominent to disclaim - see paragraph 15.48.

[Figure is omitted]

15.48

Applications for marks consisting of a distinctive device and non-distinctive words require careful examination. The difficulty is caused by the fact that words will enter into verbal references more readily than will devices. The 'Freezer' mark above illustrates a useful rule of thumb in deciding whether the non-distinctive element in such cases is too prominent to disclaim. If the words are clearly subservient to the device and are no wider than it, a disclaimer will be sufficient. Otherwise, the mark will need to be modified to reduce the prominence of the non-distinctive matter to a tolerable level. In the third example, assuming that the specification included leather goods, the non-distinctive words are too large to disclaim. Failing modification, the application must be refused. Modification of the mark will need a fresh application.

15.49

Non-distinctive words may be combined with unobjectionable ones as parts of marks consisting of a well-known phrase. (See paragraphs 12.117 and 12.151 for what is meant by 'well-known' in this context.) In such cases, there is no need to disclaim the non-distinctive word. For example, 'Kiss and Make Up' is acceptable for 'cosmetics,' without a disclaimer even although the word 'make-up' is an alternative for some cosmetics. Similarly, there is no need for a disclaimer of the word 'brew' in the mark 'Witches' Brew' even if the goods are brewed.

15.50

The effect of disclaiming two or more non-distinctive elements separately has been mentioned - see paragraph 12.224. This practice is not appropriate where there are no rights in the combination. In such a case, the mark must have other, registrable, elements. Where the non-distinctive elements are words making an existing phrase, the disclaimer should be of the phrase; otherwise it should be of each word, so that use of any one of them alone will not infringe. For example, the mark 'Moxen Button Up' for 'shirts' could proceed only on disclaimer of the words "Button Up". If the mark were 'Moxen Button Check' the disclaimer should be of 'the words "Button" and "Check"'.

15.51

Where a disclaimable element is well separated from the rest of the mark, it may be that a disclaimer alone will not afford sufficient protection for other traders. The addition of the words 'registered trade mark' when the mark is in use may, if they are placed next to the non-distinctive element give a false impression of the proprietor's rights. In such a case, the mark must be modified in addition to the disclaimer. Either the parts of the mark should be moved closer together or the mark as a whole should be unified by the addition of a line border - see paragraph 15.70.

15.52

The need for a disclaimer of a device of the goods or services has been mentioned in paragraph 12.230. Where the mark includes the names of the goods or services, no disclaimer is necessary unless the name is misspelt, is in a foreign language, is a

slang term, or is used in a trade mark manner.

For example, the words 'Lemon Drop' in the mark 'The Lemon Drop Kid' for 'Lemon drops being non-medicated sweets' must be disclaimed as they are being used in a trade mark manner and so may be thought, wrongly, to confer infringement rights on the owner of the mark.

15.53

A disclaimer is not required if the non-distinctive element is included in the specification, otherwise than a case coming under paragraph 15.52. For example, there is no need to require the word 'fresh' to be disclaimed in the mark 'Radio Fresh' for a class 29 specification reading: 'eggs and dairy products (for food); all being fresh'. If such an application is made without a limitation of the specification to fresh products, it would not be necessary to require it (since there is no real likelihood that the mark would be used deceptively) but, in that case, the disclaimer must be entered.

15.54

When dealing with companion applications, it should be remembered that the same mark may require a disclaimer in some classes but not in others. For example, if a mark included an ordinary device of a football (but was distinctive as a whole), and was applied for in class 25 for 'articles of sports clothing' and in class 28 for 'balls (playthings)', the class 28 application could proceed only on disclaimer of 'the device of a ball',

15.56

Where an application is proceeding upon evidence of acquired factual distinctiveness, a disclaimer will be required only if the non-distinctive element is quite unregistrable. This contrast with the treatment on prima facie applications - see paragraph 15.44 and is necessary for the removal of doubt. Without the disclaimer, it may appear from the Gazette advertisement that use has bestowed distinctiveness upon the unregistrable part of the mark.

15.57

If a proprietor of a mark, which is entered on the register

with a disclaimer, makes a later application for registration based on use, the mark may be registered without a disclaimer, unless it is one falling within the previous paragraph. If all other particulars of the registration, are identical, the proprietor may, instead apply under regulation 71(1) and 77(1) to have the entry in the register corrected by the removal of the disclaimer.

15.58

An applicant cannot overcome an objection that his mark contains deceptive matter, by disclaiming it. The objection is founded in the presence of the offending matter, not in its legal effect.

Modifications - General

15.60

A modification refers to the mark itself. Before registration, an applicant may alter his mark only with the permission of the Registrar. After registration, he may alter it only if the alteration comes within the provisions of section 44. The degree of permitted amendment is practically the same in each case and is governed by the need to avoid prejudicing the rights of others.

15.61

Because it is the practice to include pending applications in the material available for public inspection, although there is no legal requirement to do so, a mark will be known to interested parties, whether it is registered or not. A substantial alteration may bring it into conflict with a mark, which was not previously thought to be so. This would catch the owner of such a mark unawares. It would also mean that the search for anticipations would have to be carried out again in order to be sure that the statutory prohibition on the registration of confusingly similar marks was adhered to. Regulation 25(1) states that the Registrar may cause the search to be renewed at any time before acceptance but shall not be bound to do so. In practice, he never does; it is a procedure for which no fee would have been paid and for which no staff resources will have been allocated. Only quite minor modifications to a pending mark are, therefore, allowed. The

wording of section 44(1) is, in practice, applied to them - see paragraph 15.58. If the desired modification is outside those limits, the applicant should be informed that he should make the modified mark the subject of a fresh application, or should seek the Registrar's preliminary advice on Form TM4 under regulation 17.

15.62

No modification of an advertised mark is permitted, even to overcome the threat of an opposition, if the proposed modification will substantially affect the identity of the trade mark.. In such a case, the applicant should be informed that the modified version should be made the subject of a fresh application.

15.63

Section 44(1) enables a registered proprietor to apply to the Registrar for leave to add to or alter his trade mark "in any manner not substantially affecting the identity thereof'. The Registrar may refuse the application, or grant it on such terms and subject to such limitation as he may think fit. He thus has a discretion in the matter. The practice regarding section 44 is further examined in paragraph 15.75.

Modification Prior to Advertisement

15.65

Where an official objection has been taken to a mark on the ground that it is not distinctive, or not capable of distinguishing, the applicant may be permitted, as a matter of practice, to make up to two modifications of the mark in an endeavour to overcome the objection. If two modifications are made, they must be submitted together. This figure is purely arbitrary, but there must be some limit. Should the Registrar not be satisfied with either modification, any further alteration must be the subject of a fresh application.

15.66

One of the commonest modifications at the application stage is where a descriptive and unregistrable mark is applied for and the applicant already has another mark registered for the same goods or services. The mark applied for is allowed to be

modified by prefixing it with the registered mark. The mark added must already be registered on its own simpliciter, or with no additional elements, for exactly the same goods covered by the application. Otherwise the amendment may not proceed. It will also be necessary to disclaim the descriptive element and, where appropriate, to limit the application to avoid the likelihood of deception if the goods or services are not as described. In addition, the marks must be registered as associated marks under section 22 - see chapter 17.

15.67

To illustrate the practice stated in the previous paragraph, suppose an applicant uses 'Plexitan' as a 'house' mark, has registered it in class 3 for; "non-medicated toilet preparations; cosmetics; soaps; perfumes; hair lotions; dentifrices", and applies to register the following marks for the goods indicated:

- (i) Nailfixer, for cosmetics
- (ii) Natural Garden, for non-medicated toilet preparations
- (iii) Natural Action, preparations for the hair
- (iv) Natural curl, hairdressing services. (Class 44)

None of the marks is acceptable for registration as it stands. The applicant may be permitted to amend each one by prefixing it with the word 'Plexitan', subject to what is said in paragraphs 15.68 and 15.69. The amended applications could then proceed to advertisement on condition that exclusive right to the original words were disclaimed, and that the marks will be associated on the register with the registration of Plexitan simpliciter. To avoid any likelihood of confusion or deception of the public, the specification of (i) would need to be limited to 'cosmetics for use on the nails', and (ii) would need to be subject to a condition limiting use of the mark to goods 'all containing natural plant extracts'. No further limitation or condition is required in the third case; the words 'natural action', although likely to be required by other traders, are too vague for one to be sensibly phrased.

15.68

The above practice cannot be applied if the specification applied for is wider than that of the registered mark. If, for example, non-medicated toilet preparations were not included in

the registration of Plexitan, the specification of 'Plexitan Nature's Garden' would have had to be limited to: 'soaps; perfumes; hair lotions; dentifrices'. These are the only goods or services common to the application and the registration.

15.69

Nor can the practice be applied if the date of registration of the mark to be added is later than the date of the application of the mark to be modified. If the 'house' mark is the subject of a pending application, but still of an earlier date than that of the mark to be modified, the latter may be suspended pending the outcome of the earlier mark. The minute sheet of the latter should be noted:

"May be accepted as modified on registration of application (number)". The minute sheet of the former should be noted:

"On registration, bring forward application (number)".

It is important to complete the cross-reference by noting both files.

15.70

If the features of a composite mark are widely separated in the representation, the applicant should be requested to make it clear that a single mark is intended. He may do this either by bringing the elements closer together, or by adding a line border around the whole. A line border should be requested in any case where the mark consists of devices or patterns, which could be used, in a non-trade mark manner to decorate the goods of the application. This latter requirement is of particular importance in the clothing and household goods classes.

15.71

It is not possible to provide a complete guide to what is a permissible modification in cases not coming within paragraph 15.66 or paragraph 15.70. In practice, the limits will be the same as are applied to applications under section 44 - see paragraph 15.77. No new element, which is adapted to distinguish or is capable of distinguishing, may be added except for the house mark example above. An amendment, which requires a fresh search for similar marks, would not be allowed.

15.72

No modification should be allowed if there is any reason to believe that the proprietor has no fixed intention to use the mark as modified. This is because the registration of 'ghost' marks is not permitted - see chapter 12, paragraphs 12.280. For example, if the original mark is being used, or if it is part of the applicant's name, or is his initials, a written assurance that the new mark will be used as a bonafide trade mark should be obtained before it is accepted.

15.73

The computer and index records of a modified application are updated only after the application form has been amended following submission of Form TM 26 under section 25(9). A set of fresh representations must be provided. Section 25(10) provides that the date of the original application is unchanged.

Modification of a Registered Mark

15.75

Section 44(1) permits a registered mark to be altered on the application of its proprietor. The Registrar is given discretion to refuse the application, to accept it absolutely, or to accept it conditionally. He may also cause the modified mark to be advertised for opposition purposes, whether or not he has accepted it - section 44(2). The procedure is set out in paragraphs 21.40.

15.76

A modification of a registered mark under section 44(1) does not affect the date of registration; this means, in effect, that the alteration is backdated for the purpose of any infringement action. Nor is there any provision for a fresh search of the register to be made on such an application. For these reasons, no change can be permitted if the rights of other traders could be prejudiced by it.

15.77

A registered mark cannot be altered under the subsection if to do so would "substantially affect its identity". The word 'substantially' does not refer to the quantity of the alteration but to its effect. Sometimes a quite minor change

will have a substantial effect on the way the mark is perceived or spoken. In practice, no alteration is allowed unless both the look and the sound are unchanged. The next paragraph shows how this provision has been interpreted by the English Court.

15.78

An application to modify the registered mark 'Otrivin' to 'Otrivine' was refused by the Registrar as the change in pronunciation was substantial - "Otrivine T.M.", [1967] R.P.C. 613. An appeal was dismissed. On the other hand, an appeal against a refusal to allow a change from the English word 'Pelican' to the German equivalent 'Pelikan' was allowed - [1978] R.P.C. 424. These two cases are probably as close to their respective sides of the borderline as one could get.

15.79

The dividing line between permissible and impermissible amendments to registered marks may be further gauged by the following cases, taken from the U.K. Registrar's precedent books. In each case, the registered mark is given first. The reason for the refusal or acceptance is also given.

Quartz Assortment Quartz Assorted

The goods were sweets, and the word 'Assortment' was disclaimed. Allowed, subject to amendment of the disclaimer.

Leebelle Lebelle

Refused. The amendment is too close to the laudatory French words 'le belle (despite the bad grammar).

Briltak Bril-Tak

Advertised before acceptance.

Arog-Lo Aro Glo

Refused. While the removal of typographical symbol alone would probably be acceptable, the further amendment makes the mark merely two groups of non-distinctive letters. The look and sound are altered.

Goldray Gold Ray

Refused. The original mark was registered under the honest concurrent user provisions (the equivalent of section 20(1) in the Malaysia Act). Had the original evidence shown that the mark was sometimes used in the altered form, the modification could probably have been advertised before acceptance on a condition of notice to the proprietor of the other mark.

Evidence of use of the altered form subsequent to the registration could be admitted only in support of a fresh application.

Yarner's Yarner

Advertised before acceptance.

Polyblond Polyblonde

Accepted. Nearly identical, both visually and phonetically.

Minos Mino's

Refused. A good example of how the addition of a single apostrophe can substantially affect the identity of a mark. It has transformed the name of a Greek mythological figure to the possessive form of a Spanish surname.

Kacel KACEL

Allowed. A mere change from upper to lower case letters (or vice versa) does not affect the mark's identity.

Kacel KaceL

Refused. The prominence given to the laudatory word 'ace' completely alters the identity of the mark.

5-pointed star 6-pointed star (device) (device) Refused.

Poulivac Poulvac

Refused. The alteration from three syllables to two is too great.

Durabell Durable

Refused. The amendment is too close to the laudatory word 'durable'.

Clan Brand Clan

Allowed. The word 'brand' is totally non-distinctive in a trade mark.

15.80

The following rules of practice will usually enable it to be decided whether a proposed alteration of a word mark substantially affects its identity, but the examples in the previous paragraph must be borne in mind.

(i) In view of the importance of the first letter in judging the impact of marks, no alteration of that letter can be permitted. (In such a case, a search for anticipations would have had to be made).

(ii) No modification should normally involve the addition or removal of more than one letter, or the substitution of more than two letters.

(iii) An insertion of a hyphen at a normal syllable break may usually be allowed.

15.81

Any modification that affects the alteration or removal of purely non-distinctive matter (whether word or device) may normally be allowed. The only exception to this rule would be if the mark had been registered as one conveying a new idea in total although made up entirely of non-distinctive elements. For example, no amendment of the "Diamond T" mark - see paragraph 12.224 - could be permitted.

15.82

The procedure to effect a modification of a registered mark is set out in paragraphs 21.40 et. seq.

Special Conditions

15.85

Section 25(3) empowers the Registrar to impose such conditions on an application for registration as he may think right. The most frequently occurring reason for this is to prevent any likelihood that the mark will confuse or deceive, and examples of such conditions are contained in earlier chapters. Some of these are:

Paragraph	condition
5.33	Red Cross/Red Crescent
6.15	Colour limitation, general
11.12	Cross-notice re co-pending applications
12.222	Colour limitation, simple shape
13.71	Geographical separation
13.92	Notice to proprietor of cited registration
14.36	Geographical origin, produce
14.39	Geographical origin, manufactures
14.40	Scotch whisky condition
15.62	Restricting use of the mark to avoid deception

15.86

Other situations which occur with some regularity and which call for a standard form of condition are covered in paragraphs 15.90.

Blank Space Conditions

15.90

Where a prominent feature of a mark is a blank space, the Registrar is put on enquiry as to whether it will be filled with added matter when the mark is in use and, if so, whether the added matter will be distinctive or non-distinctive. Moreover, the addition of any matter at all may substantially affect the identity of the mark as registered. Provided that the mark as a whole has some registrable feature apart from the blank space, the Registrar will allow such an application to proceed but only on the following condition:

"It is a condition of registration that the blank space(s) in the mark shall, when the mark is in use, be occupied only by matter of a wholly descriptive and non-trade mark character."

15.91

Apropos this practice, Tookey Q.C., in "Time T.M.", [1961] R.P.C. 381 said:

"In my view it is a good general practice to be applied in cases where the Registrar considers that the nature and extent of a blank space in the representation of a trade mark indicates that it is intended to be filled with matter which may affect the identity and consequently the distinctiveness of the mark. The Registrar must be in a position to know with certainty what it is that he is registering. It would not be right for a trade mark owner to be able to represent as being a registered trade mark a label or device containing, as a substantial feature or element in its makeup, matter which the Registrar has had no opportunity of considering in accordance with the requirements of the Trade Marks Act.

"In my view as a general rule, where the Registrar sees in a mark a blank space clearly intended to be filled in with undisclosed matter which might affect the identity of the mark unless it were of a wholly descriptive non-trade mark character, he is justified in requiring an undertaking that, when the mark is used, the blank space will be occupied only by matter of such a character."

15.92

A variation of the standard blank space condition was devised to meet the special circumstances of the 'Time' case, above.

The mark was the cover of the well-known periodical of that name and included the border associated with the masthead. The applicants could not give the normal condition for, on occasion, the cover might feature trade mark goods which had no connection with them, but which were the subject of an article in that issue of the magazine. The agreed wording in that case was:

"It is a condition of registration that the blank space in the mark as shown in the form of application shall, when the mark is used, be occupied only by matter that has no trade mark significance in relation to goods in respect of which the mark is registered".

15.93

Blank spaces, which are formed purely fortuitously, can be ignored. A mark, which consists of a mere border, is not registrable, with or without a condition. A condition will be required only when the space is intended for, or seems to invite, added matter, or when the space in the mark as originally applied for contained matter which was removed on a subsequent modification. Of the examples below, no blank space condition is necessary for the first mark, and no such condition will make the one in the centre registrable. Only the lower one may proceed subject to the condition.

[Figure is omitted]

15.94

In "Renold Chains Ltd.'s Application", [1966] R.P.C. 487, the Court of Appeal considered the effect of putting trade marks in a blank space in a mark. The Court upheld the Registrar's refusal to accept the mark, with or without a condition, on the ground, inter alia, that insertions of the kind contemplated by the applicant would alter the identity of the mark.

15.95

Another case involving the insertion of registered trade marks in the blank space was "Castrol's Application", [1970] F.S.R. 510. The mark consisted of the applicants' 'half-flash' device. It was proved by evidence that they had habitually used the device with other registered trade marks of theirs inserted in the horizontal white space, and they stated that they intended

to so use the mark in future. The normally worded condition was not, therefore, applicable. On appeal, the High Court ordered that the application could proceed subject to the following condition:

"It is a condition of registration that the blank space in the mark shall, when the trade mark is in use in relation to the goods or services of the present application, either be left vacant or be occupied only by matter of a wholly descriptive and non-trade mark character or be occupied only by one or more associated trade marks registered in respect of goods or services included in the specification with or without the addition of a wholly descriptive and non-trade mark character."

15.96

Although 'control-type' conditions have been imposed in Malaysia in the past, usually at the request of the applicant, they should not be required of the applicant, or agreed to, in future. Instead, applications of this sort should be accepted, if they can be accepted at all, without a blank space condition of any kind. If the applicant wishes to use a mark consisting of the device and a registered trade mark he should apply to register the combination as a separate mark. This is because it is considered that any proprietor, who represented that the combination was a registered mark when in fact it is not, would be in breach of section 81(1), which makes such a representation a criminal offence.

15.97

A blank space in the representation of a trade mark does not have to be white before a condition can be imposed. Where the blank area is black, a condition might well be appropriate.

15.98

A blank space condition should not be required, or agreed to, where a mark is subject to a colour limitation - see paragraph 12.222. Such a mark is always limited to the named colours "as shown in the representation on the form of application". That limitation is also entered in the register. If any matter at all were to be added to the mark, it would cease to be the one referred to in the application and on the register.

Varietal Condition

15.100

International class 31 includes seeds and natural plants. In "Wheatcroft Bros. Ltd.'s T.M.s", (1954) 71 R.P.C.43, the Court ordered that several registrations of words as trade marks for rose plants should be removed from the register and held that an intention to use words as variety names was inconsistent with an intention to use them as distinguishing the goods of a particular person. The judge stated that:

"the free operation of normal trade channels must be safeguarded from such interference".

15.101

Any plant vendor as well as the breeder must be free to refer to the plant, or its seeds, by its varietal name. In order to ensure this, applications for registration of trade marks for these goods are made subject to an appropriate condition. The wording depends on whether the mark consists of a word alone, or of a word plus a device. The standard varietal clauses in these cases are:

"It is a condition of registration that the mark shall not be used as varietal name."

(Marks consisting of a word or words alone.)

"It is a condition of registration that the words(s) appearing in the mark shall not be used as a varietal name."

(Composite marks consisting of a device and a word or words.)

Packaging Condition

15.105

Marks referring to getup cannot usually be accepted without evidence of use (but see paragraph 15.106). Those which are allowed to proceed to advertisement before acceptance on proof of factual distinctiveness, must be made subject to a special condition, framed to make clear what the limits of the proprietor's rights will be if he succeeds in obtaining his registration. The wording will need to be adapted to each case, but the following are two typical examples:

Gold Box

"Registration of this trade mark shall not prevent any person using a box coloured (gold) or from describing such a box as a

(gold) box."

Black Label

"Registration of this trade mark shall not prevent the use by other traders of labels of the colour (black)."

15.106

If the mark is proceeding as an unused mark (because it has other, and distinctive elements), the words describing the getup must be disclaimed. No 'packaging condition' will be necessary; the disclaimer will suffice. See also paragraph 12.255.

'Light' Condition

15.107

The word 'light', and its American spelling 'lite', are non-distinctive and common to the trades in cigarettes, beer and non-alcoholic drinks. In the first case they refer to low tar cigarettes. In the others they refer to low alcohol and low calorie drinks respectively. There is no need to disclaim the word in either spelling but a suitable condition or limitation should be required in order to prevent confusion or deception of the public, who are increasingly health conscious. The wording should be adapted from the following examples, and appropriate figures substituted if legislative requirements change. (Evidence of trade usage may be admitted under section 64(3)).

"It is condition of registration that the mark shall be used in relation to cigarettes yielding not more than 10 milligrams of tar per cigarette."

"It is a condition of registration that the mark shall be used only in relation to drinks containing less than 2% alcohol by volume."

"It is a condition of registration that the mark shall be used in relation only to drinks containing not more than 10 calories per litre."

Music Groups

15.110

Many music groups identify themselves by adopting distinctive and unusual names. Application to register well-known names of this kind, whether or not made by members of the group

concerned, must be made subject to a condition designed to prevent deception of the public, where the goods or services concerned are, or could be, connected with music. Suitable wording for applications made for the mark 'Small Faces', for example, would be:

Class 9 - "It is a condition of registration that the mark shall, when in use in relation to (gramophone records and sound recorded tapes) be used in relation only to such recording performed, written or produced by members of the Small Faces Group."

Class 16 - "It is a condition of registration that the mark shall, when in use in relation to (printed matter, books, pictures, and photographs) be used in relation only to such goods relating to the Small Faces Group and shall, when in use in relation to (sheet music) be used in relation only to music written by members of the Small Faces Group."

15.111

The relevant goods or services of the application should be substituted for those in parenthesis, and the name of the appropriate group should replace the name of the Small Faces Group. The above wording is also suitable if the specification includes goods or services for which the mark would not be thought deceptive, as, for example, sound reproducing apparatus (in class 9) and writing instruments (in class 16).

'Star' Marks

15.115

Devices of stars are common to the trades in spirits and tobacco, and cannot be registered except as part of a distinctive mark. Star marks are also common to some accommodation services e.g. 4 and 5 star hotels. Star devices may be quite distinctive on their own for most other goods. In all cases, however, the Malaysian Government require that the proprietor submit to a condition preventing his use of the device in the colour red. The wording follows that applicable to marks containing a crescent device or the Geneva cross, and is:

"It is a condition of registration that the stars device(s) appearing in the mark shall not be used in red or any similar colour."

Section 21 Condition

15.120

Where an application is made under section 21 (which provides for the registration of jointly owned trade marks) a condition should be imposed that reflects the nature of the arrangement entered into by the parties. For a joint venture this might be as follows:

"It is a condition of registration that the mark shall be used in relation only to goods manufactured by (A) and sold by (B)." with the names of the parties being substituted for '(A)' and '(B)'.

15.121

If the registration is to be in the name of an unincorporated body, a similar condition will be necessary. For a partnership, the condition should be as follows, worded according to the number of partners:

"It is a condition of registration that (neither/no one) of the applicants shall use the mark except on behalf of (both/all) of them."

Consents

15.125

Where the Registrar considers that an application attracts a fatal citation of a prior registered right, he may accept the written consent of the registered proprietor to the registration of the pending application as evidence that there will be no likelihood of public confusion or deception in fact. The fact that the owner of the prior registration consents to the current application proceeding is not binding on the Registrar. He has to consider the public perception of the two marks and the likelihood of confusion or deception. It is an indication that the two traders do not consider that deception and confusion is likely. In such cases, the advertisement of the application must include the words "by consent" - regulation 33(3). If registration ensues, the entry on the register will also state "by consent" and must give the number of the consenting registration - regulation 52(4).

15.126

It is sometimes said that a consent is a condition of proceeding. This is erroneous. A condition is something imposed by the Registrar. A letter of consent is merely evidence which the Registrar may take account of in reaching his decision as to the probability of deception.

15.127

Consents are not binding on the Registrar. In "Dewhurst's Application (Golden Fan)", (1896) 13 R.P.C. 288, Lopes L.J. said:

"I do desire to say one word about a matter which I consider a very important one. We have been told here that rival traders ... have consented to this registration. Now, to my mind, those consents are absolutely immaterial. It may be, and I think it is, properly said that those consents are some evidence of there not being a probability of persons being deceived. I think to that extent they may be used; but to say that they are to have any greater effect, I think would be most mischievous. The public have no notice of these consents. The general public are to be protected as well as traders ... these consents might be bought and sold to any extent; and anything more mischievous than that it would be impossible to imagine, having regard to the principal object of this Act of Parliament."

15.128

In "Linpac T.M.", [1973] R.P.C. 66, the Registrar called for consent. This was offered to the applicant on terms, which he rejected so he did not get the consent. He asked the Registrar to proceed without the consent, arguing that the registered proprietor's demand for a large sum of money indicated only that he wished to profit from the situation and did not have any real fear that confusion with his mark would follow the registration applied for. The Registrar refused and was upheld on appeal.

15.129

Letters of consent must be checked to ensure that they correctly identify the application concerned and are in unequivocal terms. Qualified consents are not acceptable.

15.130

A proprietor who consents to the registration of an application is stopped from opposing it.

CHAPTER 16 - SERIES OF MARKS

Definition

16.1

Under section 24(1) of the Act, several trade marks which resemble each other in material particulars, but differ in respect of one or other of certain criteria set out in the subsection, may be registered as a series in one registration. The subsection states that the trade marks may be in respect of the same goods or services of the same description of goods or services. (The meaning of the phrase " goods or services of the same description is explained in chapter 11). However, since a registration must be in a single international class, applications for a series registration cannot cover goods or services in more than one class even if they are goods or services of the same description.

16.2

There are four categories in respect of which a series of marks may differ. These are :

- (a) statements or representations as to the goods or services in respect of which the trade marks are used or to be used; (see paragraph 16.10).
- (b) statements or representations as to number, price, quality or names of places, (see paragraph 16.11)
- (c) other matter which is not distinctive and does not substantially affect the identity of the trade marks; (see paragraphs 16.12- 16.15)
- (d) colour

Advantages of a Series Registration

16.5

The ability of a proprietor to register slight variations of his mark as a series is an alternative to his relying on the width of the infringement rights arising from the registration of only one form of his mark; he may not feel sure that these would embrace all the variations that he uses. Another alternative would be to register all the variations separately, but the advantage of a series registration is that it is cheaper to achieve and maintain.

What Constitutes a Series

16.10

Series registrations under (a) of paragraph 16.2 are uncommon. Whether the mark varies only in respect of the attributes listed there, the proprietor will usually register one of the labels and agree to a variation clause- see paragraph 14.20- to cover the others.

16.11

The varying item in applications made under paragraph (b) of 16.2 will need to be disclaimed. The wording of a disclaimer in a series registration must take account of the fact that the disclaimable element will appear in each mark but will vary from mark to mark. If, for example, the varying element is a place name, a suitable disclaimer would be:

"Registration of these trade marks shall give no right to the exclusive use of the geographical names, or any of them, appearing on any mark in the series."

16.12

Most series applications are made under (c) of paragraph 16.2. The question of what degree of variation is permissible without "substantially affecting the identity" of a trade mark is examined in Chapter 15 and the criteria set out there should be applied in examining marks under section 24. A claim that several marks form a single series is valid only if the essential distinctive and trade mark feature is virtually identical in each and every mark comprising the series).

16.13

Marks, which are a mirror image of each other, would be acceptable. Refer to the bird example below.

[Figure is omitted]

16.14

Examples of acceptable series of three four and five marks are illustrated below. There is no theoretical limit to the number of marks which may be registered as a series and as many as 25 have been known.

[Figure is omitted]

16.15

The need for disclaimers in series registrations is not confined to applications made under (b) of paragraph 16.2. For example, if the series of four marks in the previous paragraph were for "household furniture" in class 20, the following disclaimer would be necessary:

"Registration of these trade marks shall give no right to the exclusive use of the devices of a table and chairs."

16.16

The fourth attribute by which the marks may differ and still form a series is colour- (d) of paragraph 16.2. Although section 13(2) provides that any mark registered without a colour limitation is deemed to be registered for all colours, the number of those colours has to be represented in some way. If there is any difficulty about that, or if the proprietor wishes to be sure that a particular representation of a multicoloured mark is protected, he may apply for that colour combination, and the normal uncoloured one, to be registered as a series. An example of this is below; the lower mark is limited to the colours green, red, light blue, dark blue, white, purple, yellow and black as depicted in the representation by the heraldic convention.

[Figure is omitted]

Marks not forming a Series

16.20

Where one or more of the marks in a group which the applicant claims to form a single series, varies from the rest in a material particular, objection should be taken on the ground that the application does not fall within section 4 unless the odd man out is removed. If the applicant wishes to register that mark, an ordinary, non-series application for it should be made. If two or more marks differ from the rest, but form a separate series of their own, they will still have to be removed before the application can proceed, but a fresh series application may be made to cover them. Consider, for example, the following six marks.

[Figure is omitted]

They are not represented in accordance with the heraldic convention and there is, in any event no colour limitation.

Some of them vary from the other in respect of an essential particular, and do not therefore, constitute a single series under (d) of paragraph 16.2- see paragraph 16.12. A minimum of four applications is needed to cover all six marks. The first two in the top row may be considered to constitute a series since they are mirror reversals. Similarly, the first two in the lower row also constitute a (different) series of "2 colour" marks. The 1-colour mark in the top row and the 3-colour mark in the lower series do not make a series, either together or with the others.

16.21

A sure sign that a mark probably does not belong to the series is if a condition, disclaimer or limitation applies to it but not to the others. For example, if only one of the marks had an obvious blank space, requiring the imposition of a blank space condition, it would need to be separately registered. The two marks below, for example, submitted for "electric sockets, electric plugs, fuse boxes and junction boxes" in class 9 do not form a series. The word " power part" is non-distinctive for these goods and must be disclaimed; the other mark requires a blank space condition. It would be overly difficult to frame a condition and disclaimer that applied to both marks of the "series"

[Figure is omitted]

16.22

Even purely word marks, which differ by a single letter, may not form a series. For example, the marks PORTAFAX, PORTEFAX and PORTOFAX (submitted for "pocket diaries, wallets, holders made of plastics, stationery, information sheets, all included in class 16"), do not form a series within the meaning of section 24(1)(c)

16.23

The applicant is entitled to the normal right of a considered reply in writing or a hearing in respect of any objection taken on the ground that the marks of his application do not form a series- see chapter 23.

Other series

16.30

Care should be taken not to confuse the statutory meaning of a series under section 24 with the use of the word "series" to indicate marks, whether or not in common ownership, which have a common feature and which affect the question of whether another mark bears a deceptive resemblance to one or more of the series- see chapter 11. For example, the marks HYPERBAT, HYPERGLOVE, HYPERBALL could not form a series under section 24. The differences substantially affect their individual identities.

If differing elements require a separate search to locate conflicting marks there is no series.

Association

16.35

Section 24(2) provides that all trade marks registered in a series shall be deemed to be registered as associated trade marks. The normal requirements for association, and the effect of association, are covered in chapter 17.

16.36

There is no need to enter the fact of association on the register in respect of a series of marks; they will be registered under a single registration number in any event.

16.37

The reason for deeming a series to be associated is to bring in section 23(1) which prohibits the separate assignment of any mark in the series. It is because, each of them has a common distinctive feature and is registered in respect of the same goods, or goods of the same description.

Advertisement

16.40

A representation of each trade mark forming the series must be affixed to the application form and to each of the forms TM.5 accompanying it - regulation 22.

16.41

The advertisement of a series must be accompanied by a

statement of fact and of the number of marks forming the series, as in the following example:

"Advertisement of a series of (number) trade marks under section 24"

If other statements accompany the advertisement, e.g. disclaimers, they should always follow.

CHAPTER 17 - ASSOCIATION

Requirements for Association

17.1

Section 22(1) provides that trade marks in the same ownership shall be entered on the register as associated marks if:

- (a) the marks are identical or are confusingly similar, and
- (b) the goods are the same or are goods of the same description
- (c) the services are the same or of the same description and
- (d) the goods are closely related to the services.

17.2

The similarity criteria for determining whether two marks are confusingly similar, and the rules for ascertaining whether goods are of the same description or whether services are closely related to goods are contained in chapter 11. The same criteria and rules are applied for the purpose of determining whether two marks in the same ownership are required to be associated.

Effect of Association

17.5

Section 23(1) states that associated trade marks shall be assignable or transmissible only as a whole and not separately. The intent of this provision is to prevent similar marks, used in relation to similar goods or services being registered in the names of different proprietors to the likely confusion or deception of the public. Assignments are the subject of chapter 18.

Registration Under the Repealed Ordinances

17.10

The Registrar's power to require that two registered marks shall be associated may be exercised "at any time". Accordingly, where similar marks used on similar goods by the same proprietor, have been entered on the register following the incorporation into it of the registers kept in the component regions of Malaysia under the repealed ordinances, they should be associated.

17.11

In practice, the point will probably only occur on a request to make some alteration to the register, such as an assignment.

Registration Procedure

17.15

The wording of section 22(1) makes it clear that the Registrar's power to require association applies to pending applications, as well as to registered marks. A condition of association will be imposed on appropriate pending applications, whether the associated mark is already registered or is the subject of another pending application. Since goods or services of the same description may be found in the same international class, care must be taken to identify all occasions where association is required.

17.16

During the search for anticipations carried out for all applications to register a trade mark, the Association section of the relevant report sheet should be noted with any and all registrations (or other applications) with which the application, if it succeeds, must be associated.

17.17

If the search reveals an apparently associable mark but the address of the proprietor differs, the minute sheet should be noted that enquiry must be made to clarify the matter. If it transpires that the proprietor has failed to notify the registrar of a change of address, or a change of address for service he should be required to furnish the appropriate form, and to pay the statutory fee for the amendment of the register.

17.18

If the name differs, even slightly, the registration or earlier application will be cited under section 19. The applicant may supply evidence that the parties are in fact one and the same and, in that event, the citation may be waived and a condition of association substituted. If the discrepancy is the result of an unrecorded assignment, the registered mark must be considered under the provisions of chapter 18. (Failure to record an assignment can have a seriously adverse effect on the

proprietor's rights - see, for example, sections 47(3) and 55(5).

17.19

The objects of entering particulars of required associations on the report sheet are:

- to ensure that all pending applications are correctly advertised in the Gazette as being associated;
- to enable the registration clerk to enter the associations in the register at the same time that the mark is registered.

Rules of Association

17.25

Association is required when the marks are similar and the goods are of the same description or the services are closely related to the goods. If only two registrations are involved, the procedure is straightforward, even if they are in different classes; they are simply cross-referenced in the register.

17.26

Regulation 54(1) contemplates that all associated marks are linked with a common ancestor and not with each other. It states that the register entry for this registration is to be noted with the numbers of all the marks, which are associated with it, and that its number is to be noted against the register entry of all the associated marks. It does not require that any of the later registrations be noted against each other, there is only one link- the original registration.

17.27

The requirements of regulation 54(1) cater for most of the occasions when association is required, but not all of them. For example, suppose that three marks are registered by the same proprietor for the same goods, but on different dates, and that the first and third have a closer resemblance to the second but not to each other, as in the following illustrations. The situation is not covered by regulation 54(1) and there can be no direct association between the first and third marks.

[Figure is omitted]

17.28

Similarly, suppose a proprietor had three registrations of the identical mark and that they were registered respectively, and successively for:

mark number 1 goods or services A and B

mark number 2 goods or services B and C;

mark number 3 goods or services D.

Suppose also that goods or services C and D are goods or services of the same description but that all the other goods or services are goods or services of different descriptions. Mark number 2 must be associated with mark number 1 (because goods or services B are common to both specifications). Mark number 3 must be associated with mark number 2 (because goods or services C and D are goods or services of the same description); but there is no reason at all for associating mark number 3 with mark number 1. Nevertheless, none of the marks could be assigned without at the same time assigning the other two. Mark 1 would carry mark 2 which in turn would carry mark 3, and vice versa, while mark 2 would carry both of the others.

17.29

This situation must be indicated appropriately on the register. In effect the three registrations must all be cross-referenced. The same solution must be applied to the situation posed in paragraph 17.27.

17.30

The linkages created by the types of case discussed in the previous paragraphs might be automatically dissolved in the event of the specifications of goods or services of one or more of them being part cancelled - see paragraph 17.40

17.31

Similarly, the linkages may also change if one or more of the associated registrations are not renewed. For example, if the registration of mark number 2 in the situation posed in paragraph 17.28 were allowed to lapse, so would all the associations.

Dissolution of Association

17.35

At the request of the registered proprietor, the registrar may also dissolve the association provided that he is satisfied that no confusion or deception would follow upon use of the disassociated mark by another person- section 22(2).

17.36

Any proprietor who wishes to assign a registration that is associated with another, but wishes to retain the later must first ask the Registrar to dissolve the association. He must make an application under regulation 54(2) on form TM.11 and pay the appropriate fee. A statement of the grounds of the application must accompany his application. Of course, if nothing has changed since the association was required, the application must be refused. However, the proprietor may either delete the conflicting goods from one or other of the registrations, or may wish to argue that they are of different description and that, in consequence, association was wrongly required.

17.37

Before the Registrar can dissolve the association between two trade marks, he must be satisfied that there would be no likelihood of confusion or deception being caused if one of the marks were to be used by another proprietor" in relation to any of the goods or services for which it is registered." The onus of satisfying the Registrar in this matter is on the registered proprietor.

17.38

It is not possible to define all the circumstances in which it would be proper to dissolve an association. The guiding principle must always be that, after dissolution there should exist no likelihood of possible confusion of the public, having regard to what the proprietor is then free to do, including making an assignment of one or more of the marks independently of the others.

17.39

Most difficulties in connection with dissolutions are

encountered in ensuring that marks are not still linked with each other by goods of the same description, or services that are closely related to the goods, although no identical goods or services remain in either specification. Any application on form TM.11 that relies on a part cancellation of named goods from a registered specification must also be accompanied by an application on form TM.18 under regulation 71, in order to effect the striking out of the goods or services. Where there is any doubt about the extent of the goods remaining in a registration after the part cancellation, the application on form TM.18 must be refused.

17.40

Referring back to the situation posed in paragraph 17.28, the removal of goods or services B from mark number 2 would enable the association between that mark and mark number 1 to be dissolved, freeing the later for separate assignment. This means that assignment of mark number 2 could occur subject to simultaneous assignment of mark number 3. If, instead goods or services C was deleted from the specification of mark number 2, the association with mark number 1 would remain, but the association with mark number 3 could be dissolved.

Equivalent Use

17.45

Section 23(2) gives the Registrar discretion to accept use of an associated trade mark as equivalent to use of the trade mark with which it is associated. This provides a proprietor with a useful defence if one mark has been used and the other has not, and the unused mark is under attack for that reason. A further reference to this possibility is given in chapter 25 dealing with rectification actions.

Limit of Appeals

17.50

A decision of the Registrar to refuse disassociation under section 22(2) is expressly made subject to appeal to the Court- section 22(3). It follows that no decision to require association under section 22 (1) can be appealed- section 69.

CHAPTER 18 - ASSIGNMENTS

Historical Background

18.1

Although the definition of a trade mark in section 3(1) states specifically that it is not necessary that it carry an identification of the identity of its proprietor, it does have to indicate a connection between him and the goods or services. Moreover, to be a registrable trade mark it has to be able to distinguish his goods or services from those of other traders. Taken together, these requirements mean that, on the face of it, any change in the ownership of a registered trade mark will mean that it can no longer distinguish the former owner's goods or services and, in consequence, has become deceptive.

18.2

Since there are many provisions in the Act to guard the public from confusion and deception, it might be expected that all assignments be prohibited. In the early years of trade mark registration that was indeed the case, the sole exception being where the mark passed to a direct successor of the original proprietor's business.

In time, it was recognized that trade mark registration rights were rights in property and could, therefore, be transferred. However, to protect the public, the legitimacy of such transfers was made dependent on the goodwill of the business in which the mark was used passing with it.

Later still, assignments without goodwill were permitted, subject to certain safeguards. Today, a registered trade mark is assignable and transmissible in Malaysia with or without the goodwill of the business concerned in the goods or services, or in part of them - section 55(1). There are however, some restrictions and qualifications governing changes of ownership. This chapter sets out the present law and the procedure giving effect to it.

Subsection 55(1A) allows assignment of unregistered trade marks if they are linked to a registered trade mark, which is to be assigned or transmitted. All the marks must be assigned or transmitted at the same time and to the same person. The same provisions in respect of assignment with or without goodwill apply and the same restrictions and qualifications apply.

18.3

The title to a registered trade mark usually passes to another person by an assignment for money or money's worth, almost always under deed. Some titles devolve by other means; these are collectively called transmissions in the Act. Section 3(1) defines a transmission as:

"transmission means transmission by operation of law, devolution on the personal representatives of a deceased person and any other mode of transfer not being an assignment."

It therefore includes a transmission by order of the Court. This chapter deals mainly with ordinary assignments, but what is said applies, *mutatis mutandis* to transmissions.

Goodwill

18.5

To be of any value, trade marks must be put to work. The more they are used, the greater will be the reputation and goodwill, which they create. If they are never used, they can never create any goodwill; if they fall into disuse, any goodwill created by them will be dissipated.

18.6

Goodwill has been defined as "the attractive force which brings in custom" per Lord Mcnaghten in "Inland Revenue v. Muller's Margarine" (1901) Tax Cases 217. In the same case, Lord Lindley said:

"Goodwill regarded as property has no meaning except in connection with some trade business or calling. In that connection I understand the word to include whatever adds value to a business by reason of situation, name and reputation, connection, introduction to old customers, and agreed absence from competition or any of these things, and there may be others, which do not occur to me. In this wide sense, goodwill is inseparable from the business to which it adds value and, in my opinion, exists where the business is carried on."

18.7

It seems clear that, where goodwill has been created, at least in part, by the use of a trade mark, the goodwill still is attached to the business in which the trade mark is used and

not to the mark per se, despite the fact that its use may be confined to a particular item of goods or services. This is because trade marks, by their nature as well as by definition must be used in the course of trade.

18.8

Sometime the goodwill of a business may be separable. This can happen when the business is in effect several businesses. Someone who trades in, say, men's and women's clothing may so order his affairs that these are separate trades, each with its own separate and distinct goodwill. This will be relevant if different trade marks are used in each division of the business and on different goods. This subject is pursued further in paragraph 18.26

18.9

While the 1976 Act permits the assignment of a registered trade mark, whether or not the goodwill also passes, a special procedure applies to all assignments without goodwill. These are called assignments "in gross".

The Application Procedure

18.15

A change of ownership of a registered trade mark must be recorded on the register. The Act places a legal obligation on the new owner to apply to the Registrar to register his title-section 47(1). The proprietor of an unregistered mark does not have the same obligation.

The registered proprietor, as assignor, may apply jointly with the assignee on form TM.15 - regulation 63. If no joint application is made, the assignee is obliged to apply him on form TM.15- regulation 63.

In each case, the completed form must state whether or not the assignment took place without goodwill.

18.16

If a document or instrument by which the title to a registered trade mark devolves to another person has not been entered on the register, it cannot be admitted as evidence in Court to prove title, unless either the Court so directs, or the proceedings are by way of appeal against the Registrar's

refusal to register the title, or are for rectification of the register (other than for non-use)- section 47(3)

18.17

The instrument by which title to the registered trade mark passed to the assignee should be supplied to the Registrar. If this is not capable, by itself, of furnishing proof of title, a statement of the full facts supporting the claim must be furnished and verified by a statutory declaration - regulation 64(5).

18.18

When the Registrar is satisfied of the assignee's title, the register is amended and particulars of the assignment are entered in it - regulation 69. However, if the assignment was without goodwill, section 55(5) and regulation 66 provide a special procedure for obtaining the Registrar's prior approval to a proposed assignment. This is explained in paragraph 18.45.

Examination of Documents of Title

18.20

If the Registrar is not satisfied with the documents supplied, he may call on the person claiming to be the new proprietor for such proof or additional proof as he may require- regulation 69(2). This power should be exercised only in cases of genuine doubt. If the registered proprietor is joining in the application, it may usually be assumed that the claim is bona fide.

18.21

There is no need for the Registrar to adopt the role of detective when enquiring into questions of title. The registrar must act on the true construction of the document, which binds the parties. In particular, he is not entitled to go behind its terms and call for further information to test the veracity of information he may have received from other sources- "Cranbux T.M.", (1928) 45 R.P.C. 281. Nor need he enquire into apparent inconsistencies between the recital of a deed and its operative part, unless they flatly contradict each other or are plainly incredible. (If an assignee's title, having been entered on the register, is later to be found to be bad, it can be rectified

at the suit of a person aggrieved by the error- see chapter 25- on the ground that the registration was obtained by fraud. There are also severe penalties for causing a false entry to be made in the register - section 9)

Assignments with Goodwill

18.25

Where the intention of the parties is to transfer only that portion of the goodwill which necessarily passes with the trade mark assigned by itself, the assignment will be in gross- "Sinclair's T.M." (1932) 49 R.P.C. 123 and "George Dobie & Son Ltd", (1935) 52 R.P.C. 333.

18.26

It follows from the above reported cases, that an assignment purporting to transfer the goodwill "of the business concerned in the goods or services" must also transfer the title to any other registered trade marks used in that business, unless the registration of the other marks is cancelled at the same time. Otherwise, the assignment will be in gross, and advertisement will be necessary- see paragraph 18.36.

18.27

Sometimes the phrasing used in a deed of assignment is unclear and even on occasion does not carry out the intentions of the parties. For example, if the document refers only to the "sale of the business" it must be assumed that the goodwill is not covered since the vendor is not prevented from setting up another business and retaining his old customers, i.e., the goodwill.

Again, a deed may state that the goodwill of the vendor's business (at address) is assigned, together with the trade marks used in that business; if that is not the address on the register it will be necessary to obtain a declaration that he carried on no other business, else the deed will not have conveyed the whole of the goodwill of the business concerned.

18.29

A registered proprietor may obtain the Registrar's prior approval to a proposed assignment if he wishes- see paragraph 18.35- and this will show whether the Registrar entertains any

doubt about the effect of the deed. Where there is any unresolved doubt that the whole of the goodwill is to be passed on, the assignment will be treated as one in gross.

Assignments Without Goodwill (In Gross)

18.35

No assignment in gross can take effect unless, within six months of the date of the assignment, the assignee applies to the Registrar for directions to advertise the assignment and in fact so advertises it - section 55(4) and 55(5).

18.36

The purpose of advertising such changes of ownership is to notify them to interested person, who might otherwise be unaware of the change. They can then take whatever steps they consider necessary to protect themselves from any possible changes in quality etc. that the new owner might introduce. The assignee, having paid nothing for the goodwill, has no financial incentive to maintain it and may market inferior goods or services under the mark while the former reputation lasts.

18.37

The best advertisement media would be relevant trade magazines and journals, but it is not always possible to identify appropriate titles. In practice, therefore, the Registrar requires that the assignee advertise the assignment in the New Straits Times (which is distributed throughout Malaysia).

18.38

Any advertisement under section 55(5) must give the number of the mark, the list of goods and services, the names of the parties and the date of the assignment.

18.39

Applications to register an assignment in gross, with or without goodwill will be made on Form TM15 - regulation 63(1) & 69(1).

18.40

Section 26(1)(a) permits an application for registration of an

unused mark to be made by a person who does not intend to use it himself but to assign it to a body corporate about to be formed. Any resulting registration in that person's name must be recorded in the company's name within six months, or the registration will cease to have effect - section 26(3).

These assignments are always in gross, since no goodwill can attach to an unused mark, but, because the mark has never been used, there is no danger of public deception and so no need to advertise the assignment- regulation 66.

Registrar's Prior Approval -

18.45

The Registrar may be asked to give his prior approval to a proposed assignment- section 55(4) and regulation 69(1). The application must be made either by the registered proprietor or by the new owner (on form TM.15). If the Registrar is satisfied that the transfer will not be contrary to the public interest he will give his written approval.

18.46

Provided that an ordinary application to register the assignment is made within six months of the date of the Registrar's approval, and that any subsequent directions for advertisement are carried out in time, the assignment will be registered and it will not be open to the Registrar to object that the assignment will lead to deception of the public.

18.47

The Registrar's written approval under section 55(4) to a proposed assignment is, in effect, a certificate that the assignment will not infringe - section 55(3).

Part Assignments

18.50

Section 55(3) contains an important exception to the general power to transfer a registered trade mark. It is aimed at preventing deceptively similar marks, registered for similar goods or services, from ending up in different ownerships. Consequently, the Registrar has to look at what the result of the assignment will be, both with regard to deceptively resembling marks and the question of goods or services of the

same description. Both these matters are covered in some detail in chapter 11. Those aspects, which affect splitting a registered proprietor's rights, are considered here.

18.51

If a part assignment results in a complete separation of markets, it is permitted. A single registration may be split into different export markets, but an assignment, which would result in exclusive rights in the same mark for the same goods being held separately for different parts of Malaysia, is not permitted.

18.52

Where more than one mark is involved, they will have been associated under section 22 and their separate assignment is already prohibited under section 23 unless the association is dissolved.

18.53

The requirements of section 23 regarding the assignment of associated trade marks apply only where the assignment is of all the goods or services of the registration. Where it relates only to part of the goods or services, it must necessarily be an assignment in gross and section 55(3) and (5) apply instead - "Phantom T.M." [1978] R.P.C 245.

18.54

The more usual type of part assignment involves a splitting of the goods or services of a single registration. This is permitted under section 55 (3) only if the registrar is satisfied that the two resultant registrations do not contain goods or services of the same description. The determination of which goods or services are of the same description as other goods or services is a technical matter- see chapter 11.

Unless they have expert advice, the parties to an assignment may not succeed in sufficiently separating the specifications. For example, suppose that a mark is registered for " articles of clothing" and that it is assigned for " boots and shoes". Left behind in the former registration are:" slippers, sandals, socks and stockings" which are all goods or services of the same description as boots and shoes. The assignment will be

void unless the registered proprietor voluntarily cancels " footwear" from his registration. Of course, had the assignment been for footwear in the first place, there would have been no conflicting goods or services left behind and the assignment would have been in order.

18.55

An assignment of part of the goods or services of a registration accompanied by a request by the registered proprietor to cancel from the registration goods or services of the same description as those assigned will usually enable the assignment to be accepted. The application to cancel goods or services must be made on form TM.17.

Entries in the Register

18.60

Where a single registration is split between two persons as a result of a part assignment, whether by division of markets or by division of goods or services, regulation 68 provides that the new registrations are deemed to be separate registrations for all purposes of the Act (including in particular renewals) despite their having the same official number.

In practice the Registrar will allocate a suffix letter, or letters to the registrations(s) of the assignee(s) in order to avoid confusion in the future, and these numbers will be entered in the register. For example, if some of the goods (or services) of registration M1234 were assigned and the Registrar had no objection to the assignment, the assignee's registration number would be M1234A; the original proprietor's number would be unchanged.

18.61

A part assignment accompanied by a part cancellation of goods or services, such as is mentioned in paragraph 18.60, will require two entries in the register.

These should be worded on the lines of the following entries:

"Registration M1234- In pursuance of an application received on (date of form TM.17) from (name of assignor), entry cancelled under section 43(1)(a) of the Trade Marks Act 1976 in respect of (list of cancelled goods)"

"Registration M1234A- In pursuance of an application received

on (date of TM.15), (name of assignee) registered as proprietors from (date of TM.15 or TM17?) Insofar as it relates to (list of goods or services assigned) by virtue of a deed of assignment dated (date of deed) between (name of assignor) and (name of assignee)."

Some Problem Cases

18.65

The Registrar is concerned with matters of registration of trade marks and the protection of the public from the likelihood of confusion or deception, which might result from the actions of the parties. Apart from that, he must be careful not to get involved in disputes over the interpretation of deeds in what are often matters of commercial law governing rights of property other than just trade marks- see the reference to the Cranbux case in paragraph 18.21. However, a few examples of cases, which are not at all unusual, will assist in determining the correct course of action.

18.68

A mark registered for " Edible oils for export from Malaysia" is assigned to a firm in India. Such an assignment would destroy the mark because it could not be used within the jurisdiction), unless the assignee either:

- (a) sends the goods to Malaysia for re-export there from; or
- (b) has a place of business in Malaysia; or
- (c) appoints a registered user in Malaysia and controls use of the mark in accordance with the registered user agreement.

In view of the " Cranbux" case it is doubtful whether the Registrar could refuse to register the assignment but the parties should be warned that its registration implies no opinion by him of the validity of the assignment. The subject of registered users is dealt with in the next chapter.

CHAPTER 19 - REGISTERED USER

Historical Background

19.1

For many years it was considered that trade mark licensing was improper, because it would lead to deception as to true commercial origin of the goods. As commercial practices developed, it came to be accepted that this view was too strict. There were many instances where use of the trade mark did not lead to confusion or deception, such as use by agents, subcontractors, and associated companies. The factor, which all these had in common, was that the proprietor of the mark kept control over the quality of the goods marketed under it. In these circumstances it came to be recognized that some degree of controlled licensing of trade mark use could be tolerated.

19.2

One problem that even acceptable forms of licensing posed, however, was that, if the proprietor operated entirely through licensees, and never used the mark himself, his registration would be open to an attack after an appropriate period of non-use. Further, the licensee might acquire common law rights of ownership in the mark by virtue of his sole use of it. The legalising of licensed users had to take account of these matters. It did so by the device of "permitted use".

Permitted Use

19.5

Section 3(1) defines "permitted use" in relation to registered trade mark as the use of it by a licensee subject to four conditions, namely:

- (i) the trade mark must be registered;
- (ii) the licensed user must be registered as such;
- (iii) the registered user must be connected with the goods or services in the course of trade; and
- (iv) his use must comply with any conditions or restrictions to which the registration is subject.

19.6

Section 48 (5) of the Amended Act however, provides:

- (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."

19.7

The legal fiction of section 48(5) preserves the registered proprietor's title even if he never uses the mark himself but operates entirely through registered user. In particular, it insulates him from any action to strike the mark from the register on the ground of his non-use. Section 48(6) outlines the situations where section 48(5) will cease to have effect.

Procedure

19.10

An application to register a user must be made on form TM.23, signed by the proposed user and the registered proprietor - regulation 80(1). The application must be accompanied by the prescribed fee and the following information required by the amended section 48(2):

- (a) the representation of the registered trade mark;
- (b) the names, addresses, and addresses for the 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 of place or 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.

19.11

The Registrar is empowered to call for any further documents, information or evidence as he may require, e.g., as to the degree of financial control - section 48(3).

19.13

Section 48(1) states that a person may be registered as a user for "all or any" of the goods or services in respect of which

the trade mark is registered. Separate applications must, however, be made for each and every proposed registered user.

19.14

The list of goods or services on the form TM.23 must be compared with those of the registration or registrations mentioned there. If the registered user application mentions any goods or services for which the trade mark is not registered, they must be deleted before the application can proceed. This does not prevent a wider range of goods or services from being included in the actual registered user agreement, but it would be improper to bring unregistered goods or services within the ambit of permitted use as that phrase is defined in the statute - see paragraph 19.5.

19.15

Should a registered trade mark cease to be registered for any goods or services, e.g., on an application by its proprietor to strike out goods or services, any registered user entries in respect of those goods or services must be cancelled by the Registrar - section 49(2). The appropriate form is TM.24 and the Registrar shall under regulation 82(5) send to the registered proprietor of the registered mark in question notification of the variation or cancellation and may if he thinks fit publish such notification in the Gazette.

19.16

A registered user agreement may limit, the proposed use to a particular territory and it need not be an exclusive agreement. It is perfectly normal and acceptable to appoint one licensee for, say, Sarawak and another for Sabah for the same goods or services.

19.17

Similarly, an agreement may be entered into for a limited period. It is more usual, however, for an agreement to contain no limitation as to time; instead, the parties contract to terminate it on notice, or in default of obligations entered into under its express terms. Where a registered user entry is limited in duration, the Registrar may cancel the entry at the end of that time and notify all parties concerned - regulation

83(1) and (2).

"Contrary to the Public Interest"

19.20

If the Registrar considers that the proposed use by the licensee would not be contrary to the public interest he may register him as a registered user - section 48(3). Before doing so, the Registrar may impose any conditions or restrictions, which he thinks appropriate. In making his decision, the Registrar must have regard to all the documents etc. supplied. The most important factor is to be satisfied that the agreement contains adequate provisions to enable the proprietor to exercise control over the licensee's use of the mark. This is usually expressed as giving the proprietor power to maintain the quality of the goods or services, including rights of inspection and sampling.

19.21

Trafficking in trade marks have been held to be against the public interest. The amended Act 1994 no longer provides the Registrar with the power to refuse to register a person as a registered user of a trade mark if it appears to the Registrar that registration of a person as a registered user would tend to facilitate trafficking in the trade mark. The Act now provides that the Court can order the removal of a trade mark(notwithstanding the provisions of section 37) if any person entitled to use the mark does so in a deceptive or confusing manner. Refer Section 48(7)

19.22

There is no requirement that the Registrar monitor the way the registered proprietor exercises his powers under any registered user agreement. He is concerned with that question only if an aggrieved person attacks the validity of the registration by seeking its removal on the ground that the marks has become deceptive through the blameworthy conduct of its proprietor-see chapter 25 regarding inter partes rectifications.

Entries in the Register

19.25

The entry of a registered user in the register shall state the

date on which it was made - regulation 81(2).

19.26

The register entry should also state;

(i) the name and business address of the registered user , and any approved address for service.

(ii) the list of goods or services in respect of which the registered user is permitted to use;

(iii) any territorial, duration, or other limitations to which the entry is subject.

19.27

An entry should be made against every trade mark, which is the subject of a successful registered user application.

19.28

Every entry of a registered user must be notified to the registered proprietor, the registered user concerned and any other registered user already entered on the register in respect of the same registration of the trade mark, whether or not he is licensed in respect of the same goods or services, territory, etc. It may also be published in the Gazette-regulation 81(1).

Unregistered Trade Marks

19.35

If the proprietor of an unregistered trade mark wishes to appoint a registered user of it, he must first apply for registration in the normal way. Different provisions apply according to whether the proprietor uses, or intends to use, the mark himself.

19.36

If the proprietor intends to use the mark himself, as well as to license its use by others, he may make an application to register a user at any time after applying to register his mark, or he may make both applications together. The application to register the mark is independent of the outcome of the application to register a user.

19.37

Section 26(1)(b) provides "if an applicant 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.

Section 26(1)(b) Cases

19.40

The application for registration is subject to all the normal examination and search requirements set out earlier in this Manual. If that application is acceptable and if the Registrar is satisfied that the registered user application also is in order, the registration of the mark will be allowed to proceed. The application to register a user is subject to the examination requirements of this chapter.

19.42

One important effect of section 26(1)(b) is that a proprietor who intends to operate only via licensees must have them contractually committed before the application to register is made. Otherwise, the applications for registered user cannot accompany the application to register the mark. This provision ensures that an applicant cannot register his mark and then hawk it around looking for possible licensees. In 'Pussy Galore T.M.', [1967]R.P.C.265, the widow of Ian Fleming, creator of the character James Bond, attempted to exploit the names of other characters in his books by registering them as trade marks and then seeking to license use of the names to producers of a wide range of goods. The applications failed on the ground that the intention to use was insufficient. (They could also have been refused on the ground that the registered user applications must fail, since the proprietor was trafficking in the trade mark).

Quality Control does not Establish a Trade Connection

19.55

Section 48 states that a "person may be registered on the Register as a registered user of the said trade mark 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".

The registered proprietor must therefore exercise control over BOTH the use of the trade mark and the quality of the goods or services to meet the requirements of the amended Section 48(1)

Associated Companies

19.65

An applicant who can bring himself within section 25(1) does not need the benefit of section 26(1)(b). In "Radiation T.M." (1930) 47R.P.C.37, a parent company which did not trade was able to secure registration of a trade mark on the basis of use by its wholly-owned subsidiaries, whose directors it could appoint and over whose activities it actually exercised control. In those days, there were no registered user provisions and the registration could only have been obtained by the Court accepting that the degree of financial control meant that the mark was in effect being used by the parent.

19.66

If, therefore, it appears that the applicant and licensee are related companies, enquiry should be made to establish the nature of the relationship. A statement that the companies are, say, holding company and subsidiary, will suffice. It is not necessary to establish the precise degree of financial control or whether such control is in fact exercised. Such cases should be treated as ordinary applications under section 25(1) and not section 26(1)(b).

19.67

Cases where evidence of use is required in order to establish factual distinctiveness, or factual capacity to distinguish, may be treated in either of two ways, according to whether or not the subsidiary company is to be registered as a registered user.

Rights of a Registered User

19.80

A registered user has the following rights. He:

(i) may apply to the Registrar to correct any error in the entry relating to him, or to record any change in his name or address - section 43(2).

(ii) may apply to the Registrar to cancel a registered user entry; this is not confined to the entry concerning himself - section 49(1)(c);

(iii) may institute proceedings for infringement if the proprietor refuses or neglects to do so - section 51;

(iv) must be notified by the Registrar of any action affecting the registered user entry which may be taken by another party - regulation 83(2).

(v) may apply to the court for relief if the registered proprietor fails to exercise any of the rights conferred on him by the registration to the prejudice of the registered user - section 48(7)

19.81

Applications under (i) of paragraph 19.80 must be made on form TM.16 - regulation 70(1).

Rights of Third Parties

19.85

Paragraph (d) of section 49(1) has been deleted from the Amended Act 1994. It is therefore unlikely that a person may apply to the Registrar to cancel a registered user entry in the circumstances set out in section 49 (1) (d).

Cancelling or Varying

19.90

An application to the Registrar under section 43 for making, cancelling or varying an entry in the Register should be made by filing Form TM17, TM 18, or TM 19 (as the case may be) and should be accompanied by the prescribed fee.- regulation 71(1). Every application under this regulation should be accompanied by a statement setting out fully the nature of the applicant's interest, the facts relevant to his case and the relief, which is sought. - regulation 71(2). The Registrar can request that this statement be in Statutory Declaration form in any

particular case - refer regulation 71(4).

19.91

If the Registrar receives a request made on Form TM19 under regulation 71 for the entry of a disclaimer or memorandum, the Registrar has to advertise the request in the Gazette to give any person the opportunity to oppose the entry. The time limit for opposition is two months from date of advertisement - regulation 73.

In practice, applications under regulation 73 should be treated in the same way as oppositions to an application to register a trade mark and the procedure in regulation 45 to 51 applied, mutatis mutandis. In particular, all parties should be able to file evidence, subject to the Registrar's directions-see chapter 24.

Assignments

19.95

In addition to the circumstances, the provision concerning assignments are modified in some respects with regard to registered users. The subject of assignments generally is covered in chapter 18.

19.96

A registered user does not have the right to assign or transfer his use of the mark - section 52.

19.97

An assignment in gross of an unused trade mark is always invalid except in the two circumstances recited in section 55(2). Paragraph (a) of that subsection applies where the trade mark was registered with the intention of appointing a registered user, a registered user entry was made within six months after the trade mark was registered and the registered user used the trade mark within that period. However, such an assignment does not take effect unless the provisions of section 55(5) concerning the advertisement are carried out.

19.98

An assignment of a trade mark in respect of which a registered user entry is recorded must be notified to the registered user

affected, or to all of them if there is more than one.

CHAPTER 20 - RENEWALS

Duration of Registration

20.1

Section 32(1) states that the registration of a trade mark shall be for a period of ten years, but may be renewed from time to time. Section 41(1) provides that the first renewal shall be for a period of 10 years "from the date of expiration of the original registration".

20.2

Although a registered trade mark is defined in section 3(1) as "a trade mark, which is actually upon the register", section 30(1) states that the date of the application for registration "shall be deemed for the purposes of this Act to be the date of registration".

It follows that the date of the first renewal is the tenth anniversary of date of the application to register.

20.3

All renewals are for a period of ten years. Each renewal is, in effect, treated as a fresh registration, and registration" - section 41(1).

When Renewal may be made

20.10

Not more than three months before the expiration of the last registration, any person may pay the renewal fee and file form TM.12 asking that the registration be renewed. If the form is not signed by the registered proprietor the applicant must attach a letter to the effect that he is directed by the registered proprietor to make the application - regulation 57(2).

Registrar's Notices

20.15

If no application on form TM.12 has been received by a date not less than one month and not more than two months before the expiration of the last registration, the Registrar must notify the registered proprietor of the impending expiration - Regulation 58. This statutory obligation is met by sending the

notice to the address for service entered on the register.

20.17

If no renewal fee has been received by the date of expiration of the last registration, the fact must be advertised forthwith in the Gazette - regulation 59. This is the last office warning to which the proprietor is entitled.

Renewal and Late Renewal

20.20

Article 5bis of the Paris Convention provides that a grace period of not less six months shall be allowed for the payment of fees for the maintenance of industrial property rights, subject, if the domestic legislation so provides, to the payment of a surcharge (penalty fee).

20.21

Where the form TM.12 was not filed prior to the expiration of the last registration but was filed within one month from the date of expiration of the last registration - an additional fee must be paid accompanied by form TM.13. In that case, the Registrar will renew the registration without removing the mark from the register. Once removed, a registration must be restored before it can be renewed, subject to a restoration fee as well as a penalty fee - see paragraph 20.40.

20.22

The renewal of a registration must be entered in the register. A certificate of the renewal must be sent to the registered proprietor at his address or at his address for service. This is so even if the renewal fee was paid by someone else.

20.23

All the restoration renewals of registration must be advertised in the Gazette - regulation 62.

The Repealed Ordinances

20.25

Any trade mark registered under the repealed ordinances and incorporated into the register kept under the 1976 Act may be renewed as above. The due date of renewal is the date when the

original registration or last renewal under the repealed ordinance would have expired - section 32(2).

20.26

The fee for renewal of a registration originally obtained under a repealed ordinance is the same as that for renewal of a registration under the 1976 Act for all three component regions - see the fee scale for form TM.12 - Part I of the first schedule to the regulations.

Removal for Non-renewal

20.30

Where a trade mark has been removed for non payment of the renewal fee, the Registrar shall record the removal and the reason for the removal and advertise the removal in the Gazette.- regulation 61.

20.31

The date that the removal of a trade mark for non-renewal is made is also made part of the entry. For example, "Removed for non-renewal as of (date of expiry of last registration) on (date of making the entry)". The purpose of this is explained in paragraph 20.35.

Status of Unrenewed Trade Mark

20.35

A trade mark which has been removed from the register for non-payment of the renewal fee is nevertheless treated as still being a registered trade mark for the purpose of the search for prior rights, for a period of one year from the date of the "expiration of the last registration" - section 42.

20.36

The reason for the one-year prolongation is twofold. First, the trade mark is likely to have a residual reputation, which could still cause confusion with deceptively similar marks applied for during that period. Second, until the mark is actually removed from the register, it is still, for all intents and purposes, a public indication that it is a registered trade mark.

20.37

Any applicant who has a removed mark cited against him under section 42 and who is unable to persuade the Registrar to waive it as wrongly cited, or is unable to avoid the citation by deleting goods from his application has three options. Two are set out in paragraphs (a) and (b) of section 42. A lapsed mark is not deemed to be still on the register for citing purposes if there has been no bona fide use of it in the two years immediately preceding its removal, or if there is no likelihood of confusion, having regard to the use made and to be made of the respective marks. In practice, these provisions are not used as they place a burden of proof on the applicant which is likely to take him more than a year to discharge (if he can), leaving him to rely on his third option. This is simply to wait until the year has lapsed. Although the applicant's registration rights will be backdated to the date of his application, there is no danger to the public, and no danger to other traders since the applicant cannot take infringement action until his mark is actually on the register - see paragraph 3.16.

20.38

While a removed trade mark is no obstacle to an application after the year has expired, even if the application is made during that year, the Registrar will not formally suspend the application until the end of that year if the applicant has put the matter on a formal basis by asking for a statement of grounds preparatory to an appeal - "Runner T.M.", [1978] R.P.C. 402.

Restoration and Renewal

20.40

Once a mark has been removed from the register for non-payment of the renewal fee, it can be restored only at the discretion of the Registrar and on payment of a restoration fee in addition to the renewal fee - regulation 60(2). Any restoration and renewal under this provision must be advertised in the Gazette - regulation 62.

20.41

In view of the statutory notifications of expiration, no lapsed

registration will be restored without some kind of explanation of the late payment. As long as this is reasonable, a strict approach is not necessary. In cases of genuine doubt, a statutory declaration proving continuous use may be required.

20.42

If the stated reason is that the proprietor's address for service is out of date, he should be required to file form TM.1 giving his current address for service, for each registration affected. If it is the proprietor's business address, which has changed, he should be required to file form TM.16. The requirement to file form TM.1 or TM.16 as appropriate should be made a condition of restoration, and the proprietor must pay the appropriate fee in addition to the restoration and renewal fees. Additional fees are payable if more than one entry is involved.

20.43

In no case will a lapsed registration be restored after expiry of the citation year referred to in paragraph 20.35. To do so would prejudice any person who consulted the register and ordered his affairs on the assumption that it correctly showed the status of the expired mark. Moreover, there is no provision for the Registrar to conduct a search for anticipations among the pending applications before deciding to restore the lapsed marks to the register. The proprietor of the lapsed registration must make a fresh application for registration and any necessary search will be conducted, and application. paid for, as part of the normal examination of the new.

Fees

20.45

The fee for renewal is the same whether the mark is an ordinary trade mark, a certification mark or a defensive mark.

20.46

Where two or more marks have been registered as a series they form a single registration - section 24(1). Accordingly, only the fee applicable to a normal registration is payable on each renewal of a series registration. The subject of series marks is dealt with in chapter 16.

Certificates and Representation of Marks

20.50

The only certificate which the Registrar is statutorily obliged to furnish free of any specific charge is the original certificate of registration on form TM.10, - section 30(2). (The fee for this certificate is collected as part of the registration fee payable with form TM.29. Any proprietor, or other person, who desires a certificate of the renewal of a registration must apply for it on form CD 0 and pay the appropriate fee.)

CHAPTER 21 - MAINTENANCE OF THE REGISTER

Original Entries

21.1

The contents of the register of trade marks are defined by section 6(1) as:

- (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.

21.2

Section 3(1) defines 'prescribed', in relation to proceedings before the Registrar, as "prescribed by this Act or any regulations made there under". Regulations 52 to 55 set out the particulars, which must be entered on the register on the occasion of the initial registration of a trade mark. These are:

- the date of the registration;
- the goods or services in respect of which it is registered;
- the proprietor's business address and any approved address for service, and his description, i.e., his business, profession or occupation;
- the name, address and description of the successor in title where the applicant died before registration;
- any undertakings by the proprietor entered on the form of application;
- particulars affecting the scope of the registration or the rights conferred by it;
- the numbers of any associated marks;
- the number of any mark whose proprietor consented to the registration and the fact of that consent;
- such other particulars as are prescribed.

21.3

The most important of the entries that must be made under the requirement to include matters affecting the scope of the rights conferred are: disclaimers, conditions and limitations, including colour limitations.

Recordable Changes

21.5

If it is to perform its function as public document, it is important that the register is kept up to date. The obligation for this is shared by the Registrar, the registered proprietor and certain other persons or authorities.

21.6

The Registrar is required to enter particulars of any additional associations arising from subsequent applications from the same proprietor, of all changes of ownership, of any registered users appointed after the date of the original registration and of all renewals. These subjects are dealt with in chapters 17, 18, 19 and 20 respectively, which show how the information reaches the Registrar and who is responsible for informing him of the change.

21.7

The registered proprietor is responsible for notifying the Registrar of, inter alia, any changes in the content of the information originally entered on the register and derived from him. The content of the register may also be affected in other ways, e.g., by an order of the Court. This chapter deals with all matters affecting the maintenance of the register, which are not specifically covered, elsewhere in the Manual.

Changes of Address

21.10

If the business address, or the address for service, of a registered proprietor or a registered user is changed, the Registrar must be notified on form TM.16 as appropriate - regulation 70(1). This is a mandatory requirement although there is no express time limit, or sanction for non-compliance. It is, however, in the person's own interests to keep the record accurate, as failure to do could lead to loss of the registration, e.g., if renewal notices fail to reach him, or if an application for rectification on the grounds of non-use or abandonment is launched and he cannot be contacted in the matter.

21.11

A fee is payable for each notification except where the change of address is caused by a local authority street renaming scheme, the actual premises remaining unaltered. In that case, no fee is required, provided that a certificate of the alteration, given by the authority concerned, accompanies the form TM.16 - regulation 70(3).

21.12

If a registered proprietor wishes the change to be recorded on his original certificate of registration he must submit it to the Registrar for that purpose - section 43(1). Any other form of certificate must be applied for on form TM.25 - regulation 89.

Change of Name

21.15

A change of name of a registered proprietor, or a registered user, will be recorded on receipt of form TM.16.

21.16

Before acting on a form filed by the registered proprietor, the former name shown on it must be carefully compared with that on the register. Any discrepancy should be cleared up by correspondence in order to ensure that no unrecorded assignment has taken place. Names of associated companies are often very similar. Where there is any unresolved doubt, the Registrar may call for a statutory declaration of the facts before altering the register - regulation 71(4).

21.17

A registered proprietor's original certificate may be amended - see paragraph 21.12.

Voluntary Cancellation

21.20

The registered proprietor may voluntarily cancel the whole registration, or part of the list of goods or services, on form TM.17 respectively. The usual reason for such action is to avoid the expense of defending an action for non-validity or an action for rectification on the ground of non-use. It is not

necessary to establish the reason, however. So long as the form is signed by the registered proprietor himself or by someone duly authorized to act on his behalf, it may be acted on. If some other person signs the form it will usually be necessary to have the reason established by a statutory declaration.

21.21

If the application is to strike out goods or services, and a registered user of the mark is recorded for all or some of the deleted goods or services, form TM.24 should be filed. If more than one registered user is affected, a separate application should be made for each one - regulation 82(3).

21.22

Any application to amend the specification other than a clear deletion of named goods or services must be closely scrutinized. It is important to ensure that the existing registration rights are not enlarged, e.g., by effectively including goods or services that were not within the original specification - section 43(1)(c).

21.23

Any interested party may apply to the Registrar to certify that the register has been amended, or to certify the amended state of the entry. The form to be used is TM.25 but no copy of the mark will be included in the certificate unless one is supplied for the purpose - regulation 89(3).

Entry of a Disclaimer or Memorandum

21.25

The registered proprietor may file form TM.19 requesting the entry of a disclaimer or memorandum relating to a registered trade mark. Both types of application must be advertised in the Gazette before being acted on - regulation 73. If no written representations against such a request have been received two months after the date of the advertisement, it may be acted on as under.

21.26

The wording of any disclaimer should be edited, if necessary, in line with the examples given in chapter 15 and elsewhere in

the Manual. It is desirable that a version should be agreed with the registered proprietor before the disclaimer is advertised in accordance with paragraph 21.25.

21.27

A request to enter a memorandum may pose a problem, depending on the nature of the matter sought to be registered. In "Svenska Gasaccumulator", [1962] R.P.C. 106, the U.K. Registrar's decision not to record a memorandum governing the relationship between the registered proprietor and another company was reversed on appeal, but in a dissenting judgment, Diplock J., expressed the view that such memoranda should be confined to matters set out in section 1 of the 1938 U.K. Act; the corresponding Malaysian provision is section 6(1) of the Trade Marks (Amendment) Act 1994.

21.28

The Registrar has discretion in the matter, subject to appeal to the Court. In deciding whether or not to accede to a request to enter a memorandum, the Registrar will be guided by the nature of the particulars which the statute requires the register to contain, and, although the 'Svenska' case above may be followed, he will be loath to clutter the register with matter quite unrelated to registration rights conferred by the Act and regulations.

Certificate of Validity

21.35

If the validity of a trade mark registration comes into question in an action before the Court (but not the Registrar) and the Court decides the question in favour of the registered proprietor, the Court may go on to certify the fact - section 61. The benefit of this to the proprietor can be considerable; the section explicitly provides that if the validity is attacked in any subsequent proceedings the proprietor's award of cost may be increased. As a warning to potential attackers, the proprietor may ask that the Court's certificate be noted in the register.

21.36

The form of application is TM.20. A copy of the office copy of

the Court certificate (which the registered proprietor obtains from the Court office) must accompany the application. The fact that a certificate was granted and the name of the proceedings concerned are entered in the register. A copy of the register entry must also be published in the Gazette - regulation 76.

Modification of a Registered Mark

21.40

Section 44(1) provides that a registered proprietor may apply to the Registrar for leave to add to or alter a registered trade mark in any manner, which does not substantially affect its identity. The Registrar has discretion in the matter, and, if he agrees to the proposed alteration, he may impose such terms and limitation as he thinks fit. An appeal against his decision lies to the Court - section 44(3).

21.41

The principles to be applied in deciding whether a modification is substantial within the meaning of the statute are discussed in paragraphs 15.75 ff.

21.43

The registered proprietor must apply on form TM.17 and provide five copies of the altered mark - regulation 71(1). The action to be taken by the Registrar in cases where he considers that outright refusal is not appropriate, varies according to whether or not he is completely satisfied that the proposed alteration is not substantial.

21.44

Where the desired modification clearly does not affect the mark's identity, the register entry is altered - regulation 77.

21.45

If the Registrar considers that the proposed modification may be too wide to accept outright but not so great as to warrant refusal, he will advertise it in the Gazette as an unaccepted alteration. If no opposition to the proposed modification is received after the lapse two months from the date of the advertisement, the Registrar will make the alteration in the register without further enquiry of advertisement.

21.46

In cases where the Registrar considers that a verbal description of the proposed alteration may not be understood by persons likely to be interested in the matter, he may call on the registered proprietor to provide a suitable representation of the mark for the Gazette advertisement. A representation of the mark must be included in the advertisement of all cases, which are advertised before acceptance under paragraph 21.45.

21.47

Any third party opposition to a proposed modification, which has not been accepted and is advertised under the previous two paragraphs, must be filed on form TM.22 accompanied by a further statement of the opponent's objections if he wishes. These documents must be supplied in duplicate and the Registrar must send the duplicates to the applicant.

Subsequent proceedings follow, *mutatis mutandis*, those laid down for oppositions to applications for registration - see chapter 24.

Trusts**21.50**

Only beneficial interests may be entered on the register. Any application that would result in notice of a trust, whether express, constructive or implied, must not be entered on the register - section 7. The only exception, which may be admitted, is that of an executor or receiver, who is actually carrying on the business of the deceased, or former, proprietor.

CHAPTER 22 - REGISTRAR'S CERTIFICATES

Seal of Office

22.1

The Registrar is issued with an official seal approved by the Minister. Any document impressed with the seal must be judicially noticed and admitted in evidence - section 4(5). This makes it unnecessary for the Registrar to appear in person in any legal proceedings merely to give evidence of what is on the register, and makes such documents acceptable in lieu of witness statements.

22.2

All certificates issued by the Registrar under the Act or regulations must bear an impression of the Registrar's seal of office. Where a representation of a registered trade mark appears on the certificate, the seal should be impressed in such a way as to take in part of the representation.

22.3

Certificates bearing the Registrar's seal may be signed by any officer of the rank of Assistant Registrar or above.

Sealed Copies as Evidence

22.5

Copies of, or extracts from, the register which bear the Registrar's seal are admissible as evidence in any proceedings before any court of law without further proof or production of the originals - section 65(1).

22.6

Any certificate signed by the Registrar and stating that he has, or has not as the case may be, performed any Act that he is authorized to do, is prima facie evidence of that fact in any proceedings before any court of law - section 65(2). There is no requirement in the subsection that such certificates are sealed, but in price they are.

Certificate of Registration

22.7

The Registrar is required to issue under his seal a certificate

of registration to the proprietor of every mark, which is entered on the register - section 30(2). The certificate will be on Form 10 - regulation 56. In the case of a device mark, and a word mark that is in other than plain letters, a copy of the relevant mark must be affixed to the certificate. This representation is obtained from one of the forms TM.5 supplied under regulation 18 with the application to register, or following an agreed modification prior to registration - see paragraph 15.68.

22.8

When any corresponding entry in the register is amended, the Registrar may amend the certificate of registration, if it is presented to him for the purpose - section 43(1). A new certificate is not issued. If, for example, the mark is modified after registration, a certificate stating that the mark was so modified may be issued under regulation 89(1) (see below) and one of the five copies of the new mark, supplied with the application to modify, will be affixed to it.

22.9

If a registered proprietor claims that he has lost his certificate of registration he may be issued with a duplicate (which must be clearly so marked) on his making a statutory declaration as to the facts.

Other Certificates

22.15

Certified and sealed copies of any entry in the register may be given to any person (not necessarily the registered proprietor) on payment of the prescribed fee - section 8(2). There is no requirement that the person making the request must show that he has an interest in the matter.

22.16

The Registrar may issue a certificate "as to any entry, matter or thing which he is authorized or required by the Act or these regulations to make or do" - regulation 89(1). The person is required to show an interest if the request is for a copy of an entry in the register. In other cases, he will be required to show an interest only if there is reason to believe that the

facility is being abused, or the request is frivolous or vexatious.

22.17

If there is any blank space between the wording of the certificate and the Registrar's seal, it should be ruled diagonally in ink. The object is to prevent matter being added after the certificate has been issued, and to make it clear that nothing could have been added.

22.18

The wording of regulation 89(1) makes it clear that the Registrar is concerned only with statements of fact in connection with his duties. He will not respond to requests to certify matters of opinion, even if they relate to matters within the scope of the legislation. (If a person wishes to know whether a given mark is inherently adapted to distinguish, he must make a special application under regulation 17 - see chapter 10).

22.19

The Registrar will not accept request for certificates, which relate to matters, which have not yet occurred. For example, an applicant who desires to be informed when a pending application is entered on the register should be informed that the Registrar can only certify the present status of the application in question, and the certificate should be issued on that basis. If the mark has been advertised, the date of the relevant issue of the Gazette should be included in the certificate; if the application was advertised before acceptance, that fact should be stated.

22.20

Applications for the Registrar's certificate must be made on form TM.25.

22.21

Certificates required for the purpose of obtaining registration abroad require special attention if the registration is subject to a disclaimer or if the mark on the register is in colour but there is no colour limitation.

Regional Registers

22.25

Certified copies of the register are deposited in the regional trade mark offices for the purposes only of public searching. No copies of such copies may be given to any person - section 8(3). Certified copies should only be made from the register maintained at the central office in Kuala Lumpur - section 6(1).

CHAPTER 23 - APPEALS AND RELATED MATTERS

Right of Appeal

23.1

The Act gives no general right of appeal against any decision of the Registrar. An appeal lies only where the right is expressly given in the Act or regulations - section 69.

23.2

Where a right of appeal exists it must be made to the Court. This is defined in section 3(1) as the High Court. The proceedings will usually be by originating notice of motion.

23.3

A decision of the Registrar made in exercise of his discretion will not be lightly reversed, so long as the discretion was exercised upon proper grounds. An illustration of this occurred in "Union Carbide and Carbon Corporation's Application (Crag)", (1952) 69 R.P.C. 306, where the judge said:

"If I were satisfied that in arriving at that decision the hearing officer had observed the right approach, having regard to the language of the statute and the guidance given by the decided cases, the mere fact that his conclusion would not necessarily be that at which I myself would have arrived without his assistance is no reason whatever for interfering with his decision. Indeed, I think it would be true to say that, even if I came to the conclusion, as I think I might, that his conclusion was fanciful, and indicated failure to appreciate the unsubstantial nature of the objection posed, nonetheless, except upon the footing that in exercising his discretion the hearing officer had failed to exercise it judicially, I should not be justified in interfering with his conclusion."

23.4

The above quoted passage should not be taken as authority for the proposition that any fanciful decision by the Registrar will necessarily be upheld on appeal. Indeed, the Court is required to exercise the same discretionary powers as are conferred on the registrar - section 67. In doing so, it might well come to a different conclusion. Care must always be taken, therefore, that any decision given by the Office, whether or

not in the exercise of a discretionary power, is clearly in accordance with the facts so far as they have been established, with any admissible evidence provided, and that it complies with the tenets of natural justice.

23.5

This chapter sets out the procedures to be adopted when a person wishes to appeal decision of the Registrar, the required steps to be taken precedent to an appeal, and the action to be taken on determination of the appeal.

Right to a Hearing

23.10

The Registrar must not exercise any discretionary power adversely to any party without given him an opportunity of being heard on the matter - section 76, and see also paragraphs 15.10. The Registrar's discretionary powers are applied most frequently in refusing applications to add to or to alter the register, or in imposing some condition or other limitation of the statutory right, which might otherwise be conferred.

23.11

Hearings may be ex parte or inter partes. The conduct of ex parte hearings is described in later paragraphs of this chapter, inter partes hearings are dealt with in chapters 24 (oppositions) and 25 (rectifications).

Right of Audience

23.15

On the hearing of any appeal against a decision of the Registrar, he is entitled to be heard by the Court - section 25(6) and 62(1).

23.16

Section 62(1) also applies to rectification proceedings commenced in the Court. It follows from the wording of the subsection that the Registrar must be served with notice of any such proceedings. On receipt of such a notice, it must be attached to the file of the relevant registration and submitted to the Registrar for consideration of the question of whether he wishes to be represented at the hearing of the action.

23.17

In any legal proceedings seeking alteration or rectification of the register, the Court may direct the Registrar to appear. In the absence of such a direction, the Registrar may submit a signed statement in writing in lieu of appearing and being heard - section 62(2). The statement should set out particulars of any proceedings that took place in the registry with regard to the matter in question, any decision made by him in the matter, and any office practice having a bearing on the issues involved. This statement forms part of the evidence in the Court proceedings.

23.18

If any party to an action before the Court seeks production of any office document or file he should be informed that the Registrar's certificate of the matter should be obtained instead - see chapter 22. If the matter is not appropriate to such a certificate, e.g., if the information is confidential, the request should be refused. In an appropriate case, the applicant may be informed that the Registrar will attend the hearing of the action, on being given notice thereof, with the file and will do as the judge directs.

Responses to Objections to an Application for Registration

23.25

Where the Registrar objects to an application for registration, or will accept it only conditionally, the applicant may make written representations on the matter. If the Registrar, after taking into account the applicant's written representations maintains his objections to the application, he will inform the applicant. The applicant may apply for a hearing on the matter. If the applicant has not applied for a hearing within 2 months from the date of receipt of the Registrar's decision the application shall be deemed to be abandoned. - regulations 27 and 28. (It may be difficult to establish when the applicant received the Registrar's decision - if there are any future amendments to the regulations it could be worthwhile changing this to date of despatch of the Registrar's decision or from the date marked on the Registrar's decision.

23.26

There is no fee for an ex-parte hearing. In inter-parte hearing, a fee is required as in regulation 50(4) as well as regulation 84. Hearings are not open to the general public.

23.27

If the Registrar objects to an application he shall inform the applicant of his objections. The applicant must within two months from the date of receipt of those objections make a considered reply in writing or he shall be deemed to have abandoned his application. If after taking into account any considered reply the Registrar maintains his objections he shall inform the applicant and if the applicant does not apply within 2 months from the date of receipt of the Registrar's decision he shall be deemed to have abandoned his application - regulation 27. The decision of the registrar following a hearing as provided in sub-regulation 27(3) or 28(4) shall be sent to the applicant in writing. If the applicant still objects to the decision he can (within 2 months of the date of its receipt) require on form TM.6 the Registrar to state in writing the grounds of, and the materials used by him in arriving at the decision - regulation 29.

23.28

If no response has been received at the expiration of the time limit, or extended time limit, as the case may be, the application is deemed to have been abandoned. There is no need to inform the applicant or to issue any form of written notification. The blank box on the outside of the file cover containing the application should be noted: "Deemed abandoned under regulation (number)". The regulation number will be either 27 or 28 as appropriate, and should be quoted in the note.

23.29

Where a hearing is taken on the Registrar's objections or requirements, a final decision should normally be given at the end of the hearing and confirmed in writing immediately thereafter. If the applicant wishes to take some agreed action, e.g., to file evidence, or to submit a modification of the mark, a further time limit should be imposed for the purpose, and the

hearing should be adjourned to the new date. This time limit may be extended in the same way as any other. If the agreed action has not been taken within the time allowed, the application should be formally refused. If the applicant wishes to take the matter further, he has the right of appeal to the Court - see paragraph 23.45.

23.30

If, as a result of a hearing, or a considered reply in writing, the application is to be amended in some way, the applicant must file form TM.26 - regulation 24. A time limit for the submission of the form should be imposed, and, if the form is not submitted within that time, or within such an extension of that time as may be granted, formal refusal of the application should be issued.

23.31

Formal refusal of any application, whether or not there has been a hearing, should be noted on the outside of the relevant file cover: "Refused (date)".

23.32

Applications, which are formally refused, should not be removed from record (including the public search material) until the appeal period, or any permitted extension of that period, has expired.

23.33

All applications, which are deemed abandoned, as distinct from being formally refused, should be removed from record. There is no right of appeal in such a case.

Statements of Grounds

23.35

The applicant for registration has the right of appeal to the Court against any formal refusal of this application. He must, however, first obtain the Registrar's written statement of grounds of his decision and of any materials used by him in arriving at it - regulation 29(1). He does this by filing form TM.6 accompanied by the prescribed fee.

23.36

The statement of grounds must be written by the officer who took the hearing, if there was one, or who took the final decision in any other case. Many examples of such statements are held by the Registrar and may be consulted as models. A statement of grounds of refusal should:

- set out all the relevant facts of the case
- summarize, and comment on the value of, any evidence, or other material, filed by the applicant in support of his application
- recite, and deal with, the arguments presented on his behalf
- include references to the applicable legal provisions, and to any decided cases that are considered relevant
- mention all materials used in reaching the decision, and exhibit them, or copies of them, to the decision. ('Materials' in this sense includes extracts from dictionaries, technical and other reference works, advertisements and cutting from newspapers and periodicals showing, for example, use of the mark, or one close to it, in a non-trade mark manner by other traders.)

23.37

It is very important that statements of grounds should refer to all materials used in reaching the decision on the case. This is because any appeal against the decision must be heard only on that materials- section 25(7). It is, for instance, not open to the applicant to produce further evidence or materials at the hearing of an ex parte appeal. In "Disco-Vision T.M.", [1977] R.P.C. 594, the appellant tried to do just this but the Court decided it did not have the power to admit it under section 17(6) of the U.K. Act which is in practically identical terms to those of section 25(7). In his judgment, Whitford J. said:

"The Registrar has to state the grounds and the materials used by him in arriving (at his refusal). Subsection 6 provides that the appeal should be heard on that material and on the face of it, as a matter of construction, it appears to me that there is no provision expressed under this subsection for the bringing in of any other material at all. It was suggested that the words 'except by leave of the tribunal hearing the appeal' may qualify the words 'appeals under this section shall be heard on

the materials stated as aforesaid by the Registrar'. It does not seem to me that as a matter of construction that is very arguable. I think that one must remember this: section 17 is to be contrasted with section 18 which deals with the procedure on opposition where there is an express provision in subsection 8 that on the hearing of an appeal 'any party may either in the prescribed manner or by special leave of the Court bring forward further material or the consideration of the Court'. The contrast between that provision and the provision in section 17, where as a matter of plain language the material to be used upon the appeal is apparently to be the material relied upon by the Registrar in reaching his grounds of decision, is a very sharp one. It may at first sight seem a little bit strange but I do not think that it is."

"It is always a great advantage to a tribunal hearing an appeal from the Registrar that they should have the opinion of the Registrar upon the available material. They do not as in opposition proceedings; although they may be assisted by counsel for the Registrar, have the benefit of the views of possible competitors in trade. There seems to me to be very good reasons for saying that in a matter of this kind, where the question is whether the mark should or should not be accepted, the material to be used in reaching a conclusion on appeal should not be different from that used in the first instance. If other material does become available a refusal at this stage is no bar to a fresh application being made upon such new material as later becomes available."

23.38

The corollary of the judge's view in the above case is that, in reaching his decision, the Registrar may not take account of material that was not before him at the date of the hearing. It is, therefore, imperative that any necessary research should be undertaken prior to the date of any hearing and any material thought to be relevant should be brought to the attention of the applicant before the final decision is made.

23.39

An applicant may sometimes attempt to persuade the Registrar to waive an objection on the ground that a previous application was accepted without that objection having been raised, and may

even produce copies of a certificate of registration relating to the earlier application. If the present objection is soundly based, the argument should be rejected. The previous registration, if it was obtained in the Federation, must be regarded as having been obtained in error and as being vulnerable to action for removal from the register on that ground, at the suit of any person aggrieved by the registration. The argument has even less force if the registration referred to was obtained in another jurisdiction entirely. Copies of certificates of earlier registrations are among the materials, which should be referred to in the decision, but the earlier decision cannot constitute a binding precedent; in most cases it should be dealt with by a statement that the full circumstances leading to the earlier acceptance are not known.

23.40

The date when a statement is sent to the applicant issue of any written statement of grounds is deemed to be the date of the Registrar's decision for the purpose of any appeal - regulation 29(3).

Court Procedure

23.45

The practice and procedure in relation to proceedings before the Court are governed by rules of court made by the Rules Committee constituted under the Courts of Judicature Act 1964 - section 83(4). These rules provide, inter alia, for the granting of extensions of time for filing appeals from decisions of the Registrar.

23.46

On determination of an appeal to the Court, a copy of the court order should be obtained and filed with the application concerned.

23.47

If the appeal is dismissed, the application should be removed from record, unless the applicant states that he is appealing to a higher Court, and has been given leave to do so where that required.

23.48

If the appeal, or any further appeal, is allowed, the Court will state a time within which the application must be registered - section 31(2). Within that time the applicant is free to file form TM.17 and pay the then current fee for registration. If no form TM.27 has been filed within the time allowed by the Court, the application would lapse - section 31(3).

Citation of Refused Applications

23.50

While a refused application for registration is under appeal, it cannot be removed from record and continues to be part of the material searched on receipt of later applications by other proprietors. Where it is cited against such an application, the later applicant should be informed that the earlier application was refused but is under appeal, and the date of issue of any statement of grounds should be given. (A copy of the statement of grounds may be furnished on request and on payment of the pro rata fee prescribed by the regulations - part II of the first schedule) If the refused applicant is dilatory in pursuing his appeal, it may be left to the later applicant to apply to the Court for relief. Although the first application was refused, the later one cannot be allowed to proceed. The procedure is to impose a reasonable time limit on the later applicant and if no action has been taken by him within that time to have the other party's appeal brought on, his application will also be refused. In such a case, he may appeal to the Court in his turn.

Extensions of Time - Ex Parte

Extensions of time now attract a fee. The correct form is TM.27, where the delay was not caused by any action of the Registrar - sub-regulation 84.

23.55

Section 77 gives the Registrar a discretionary power to extend any time specified in the Act or regulations for doing any "act or thing", and he may do so even if the time has expired. There is no appeal against a refusal to extend time limits but the person concerned must be given a hearing on the matter if he so

requires within the prescribed time - section 76.

23.56

Certain days, known as excluded days, are ignored in computing time limits - regulation 85. Days when the office is closed are excluded, and this embraces public holidays and the like. Sunday is always an excluded day. Time limits, which would normally expire on an excluded day, are treated as not expiring until the next day, which is not also an excluded day. Thus, a period which expires on a Sunday is deemed to continue until the close of business on the following Monday (provided that that, too is not a day when the office is closed for any reason).

23.57

The Registrar's general power to extend any time limit does not apply to those periods, which are expressly stated in the Act, or to those in regulations 53, 60(1) or 86(2) - regulation 84. Non-extendible express time limits in the Act are referred to in the appropriate chapters of the Manual.

23.59

No extension of time can be granted unless the Registrar "is satisfied that the circumstances are such as to justify" it - regulation 84.

23.60

The fact that an applicant for an extension must give adequate reasons and satisfy the Registrar that the extension is justified is no mere formality. The conduct of public business, especially at a time when arrears of work exist, demands that expeditious and effective action be taken at all times. The fact that pressure of work in the registry may lead to unavoidable delays in issuing opinions or in answering correspondence is no reason for the applicant or his agent to take the same course. In particular, requests from agents that they need more time because they are awaiting instructions from their client must be rejected as wholly inadequate. It is the client, not the agent, who is asking for the extra time, and if he will not instruct his agent appropriately he cannot have it.

23.61

There are reasons for thinking that some of the time limits in the regulations may be on the short side. Pending any change in the law, first requests for an extension of the period in which to respond to the Registrar's objections to an application for registration may be treated leniently up to a maximum of six months from the date the objection was communicated, especially if the applicant resides overseas. After that, they must be fully justified.

23.62

Whenever a letter is issued from the office in response to representations, other than a considered reply in writing, made following receipt of the Registrar's objections, the writer must ensure that a new time limit is incorporated. Failure to do this will mean that the automatic closure provisions in the regulations cannot be applied and there will be no way the application can be removed from record if the applicant chooses to be dilatory. The period given should be a realistic one having regard to all the circumstances. The longer the period, the more difficult it is likely to be for the applicant to justify a further extension. If no response has been received within the new time limit, the application should be dealt with in accordance with paragraph 23.28 or 23.29 as appropriate.

Extensions of Time - Inter Partes

23.65

Opposition proceedings do not begin until the notice of opposition is actually filed at the registry. Requests for extensions in which to file such a notice are not, therefore, an inter partes matter. Since a notice of opposition merely sets out the grounds on which the opposition is to be based, there is no reason why its filing should take more than a month or so. If opponent wants to file extension of time after the 2 months period is over, the opponent can do so by filing a Statutory Declaration explaining the delay in submitting the request for extension of time. The acceptance of the request for extension of time is at the Registrar's discretion. Often, however, the prospective opponent and the applicant are in negotiation in an endeavour to settle their differences without having to have recourse to a full-blown opposition. If,

therefore, the prospective opponent states that the parties are engaged in meaningful negotiations and that there is a reasonable prospect of a settlement being reached, an extension of not more than six months may be allowed. No further extension will be allowed unless some evidence of the progress of the negotiations is produced and unless the applicant for registration supports the application for an extension. If the parties show no sign of urgency in settling the matter, formal proceedings must be commenced.

23.66

Once opposition proceedings are commenced, they are governed by regulations 37 to 49 and each state is subject to a time limit. Extension of time can be given up to a maximum of 3 times and if additional extension of time is needed, it has to be submitted together with a Statutory Declaration as to the reason the extension of time needed. Although the regulations refer specifically to opposition proceedings against an application for registration, they also apply to other proceedings.

Inter Partes Appeals

23.75

Either party, or both, may appeal to the Court against any decision of the Registrar given in inter partes proceedings. The procedure is usually by originating motion. Notice of the motion must be served on the Registrar. He thus becomes a party and may appear if he thinks fit - see paragraph 23.15.

23.76

On determination of the appeal, the party having carriage of any Court order must provide the Registrar with an office copy of it. The Registrar then acts in accordance with the order, unless its execution is stayed pending a further appeal.

CHAPTER 24 - OPPOSITIONS

Who May Oppose?

24.1

Any person may launch an opposition. He does not have to be a trade mark owner, but may, for example, be a trade organization or a consumers' association.

24.2

Most opposition are to applications to register an ordinary trade mark - section 28. Other oppositions are to: applications to alter a registered trade mark - section 44(2); and applications to register a certification trade mark - section 56(12) and (13).

Opposition Files

24.3

An opposition file, numbered sequentially in a series prefixed OPP, should be opened, no matter which type of opposition is involved. The opposition number should be entered prominently on the minute sheet of the application being opposed, and the file for that application should be kept with the opposition file. If the opponent cites any of his own registered marks in his notice of opposition, those files should also be attached. The location of all attached files should be noted in the computer records.

24.4

All formal notices, correspondence and evidence relating to the opposition should be filed in the opposition file, and not in any of the related files. Superintendence of the conduct of the opposition will be maintained from this file, including requests for extensions of time - see chapter 23 - and the appointment of hearings.

24.5

If opposition is entered against more than one mark, or if more than one opposition is entered against the same mark, a file in the OPP series must be opened for each one. All related opposition files must be kept together.

Procedure

24.10

Regulations 37 to 51 govern the procedure for oppositions to ordinary registrations, and are applied mutatis mutandis to the others mentioned in paragraph 24.2. This chapter shows how oppositions of all types are handled in the registry. It applies principally to oppositions to applications for registration of ordinary trade marks, but where some special provision applied to other types of opposition, they are separately mentioned.

24.11

Opposition proceedings commence on the date that formal notice of opposition on form TM.7 is filed. This must be done within two months of the date the opposed mark was advertised in the Gazette, - regulation 41. The notice of opposition must state the grounds on which the opposition is based and, if it is alleged that the applicant's mark resembles any registered marks belonging to the opponent, the number of those marks and the number of the Gazettes in which they were advertised must be stated in the notice - regulation 37, and sub-regulations 50(1) & 51(1).

24.12

The Registrar no longer provides the post office function of forwarding duplicates of evidence to both parties in oppositions. Refer amended section 28(3).

24.13

Within two months of the date on which he receives the duplicate notice of opposition, the applicant must file his counterstatement on form TM.8. This sets out the grounds on which he relies in support of his application and also any facts in the notice of opposition, which he admits. If no counterstatement is filed in time, the application is deemed abandoned - section 28(3) - and it is removed from record.

24.14

This completes the preliminary stage of the proceedings and may be likened to the pleadings in a Court action. Each side then files its evidence, beginning with the opponent, followed by

the applicant, and finally by the opponent again who has the chance to reply to the applicant's evidence - regulation 40 and 41. The evidence must be by way of statutory declaration - section 64. The mode of giving and attesting evidence follows that already described in chapter 13 for ex parte applications.

24.15

Once the opponent's evidence-in-reply has been filed, no further evidence may be adduced by either side unless the Registrar gives leave. If either side requests leave he should state in broad terms the nature of the proposed evidence, whether it is ready to be filed, the point at issue that it is intended to deal with, and the circumstances in which it could not have been filed at the proper time. If the other side consents to the filing of the additional evidence, a written notice to that effect should be furnished. In deciding whether to give leave, the Registrar will bear in mind that it is desirable to have all the relevant information before making a determination of the dispute and that, if it is excluded, the Court may admit it on appeal.

24.16

Where leave is given, the Registrar has power to impose terms - regulation 43. There will usually be three, via: time limits, right of reply and costs. If the evidence is ready to be filed, a short time limit may be allowed for the purpose. If it is not ready, a reasonable extension may be given, provided that the application is not seen as a mere delaying tactic. The filing of further evidence re-opens the case at that point so that if the other side wishes to deal with the new evidence it should be allowed to do so. The opponent has the right to be the last to file evidence, this being the object of regulation 42. If the request increases the costs of the proceedings, the Registrar may award the increased amount to the other side, regardless of the out-come of the dispute.

24.17

Regulation 44(1) provides that where there are exhibits to any statutory declaration filed as evidence in an opposition, the party filing them shall on the request and at the cost of the other party send him a copy of each exhibit. Alternatively, he

may inspect the original at the registry during normal hours - regulation 44(2). The original exhibits, and not photocopies, should be supplied to the Registrar and these will be produced at the hearing. Valuable exhibits should be stored in a safe place under lock and key while in the registry. At the final determination of the proceedings all exhibits should be returned to the party, which provided them.

24.18

It is important that each stage of the proceedings in closely controlled by the registry, particularly as regards the granting of extensions of time, which should be governed by the principles set out in chapter 23. From time to time it may be necessary to hold an interlocutory hearing to settle matters of procedure. These should always be joint hearings attended by either parties or their advisers. Some reference to the types of decision that might be called for is given in paragraphs 24.95 et. seq.

24.19

On completion of the evidence, the case is ready to be determined. Both sides should be asked whether they wish to send the Registrar any arguments or submissions in writing, or whether they are willing for the Registrar to issue his decision based on the paper evidence and any written representations they may wish to make. A decision should be written by any authorized officer deputed to the task - section 28(4), 76 and regulation 47.

24.20

Section 76 of the Act provides that where any discretionary power is given to the Registrar by this Act or by any regulations made there under he shall not exercise that power adversely to the applicant for registration or the registered proprietor in questions without giving the applicant an opportunity to be heard.

24.21

The order of speeches at the hearing of an opposition, if one is required is:
applicant for registration, opponent, applicant in reply.

24.22

Inter partes hearings are not open to the general public but those having a direct interest in the proceedings, such as the applicant and opponent themselves where they are legally represented, may attend. Any witnesses who are to give evidence viva voce - see paragraph 24.55 - should not be allowed into the hearing room until they are called but may remain, if they wish, after completing their evidence.

24.23

Within 2 months of the completion of evidence under regulation 46(1) the Registrar must issue his written decision and send a copy of it to both sides.

24.24

The Registrar may either refuse to register the mark, register it absolutely, or register it subject to such conditions, amendments, modifications or limitations as he may think fit - section 28(4).

24.25

When the proceedings are determined, either by the Registrar's decision or on any appeal, the decision is given effect to by registering the mark (see the next paragraph) or by removing the application from record, according to the outcome.

24.26

An application, which is free to proceed following an unsuccessful opposition, is not subject to the normal non-completion procedure of regulation 53(1). Instead, the Registrar (or the Court on appeal) will direct that the mark may be registered within a stated time. If the trade mark has not been registered within that time, the application lapses. If the registration fee is not filed by then, the application is removed from record without further notice. - regulation 53(2).

Costs**24.30**

In any proceedings before him, the Registrar has power to award

such costs, as he considers reasonable - section 63(2). It is usual for the written decision to conclude with an award. If either party wishes to make any representations on the matter he should do so before the hearing is concluded, or, where the matter is determined without a hearing, at the time the decision is requested.

24.31

In making any award of costs of proceedings before the Registrar it is not the intention to compensate parties for the whole of the expense to which they have been put. The current scale of costs applied by the Registrar is at Appendix 4. Notice of any change in the scale must be given in the Gazette.

24.32

Costs will normally follow the event, but in particular cases may be mitigated or withheld if the conduct of the successful side warrants it, and the Registrar is satisfied that it is just to do so - section 75(1)(d). An example is given in paragraph 24.16. For example where an uncontested opposition is mounted without notice, and could have been avoided had notice been given, the opponent may be deprived of his costs - regulation 49. A further example may occur if the proceedings are adjourned at any point at the request of one of the parties and against the wishes of the other party; it will usually be the case that the party obtaining the adjournment will be ordered to pay any additional costs caused thereby.

24.33

If any party defaults on payment of costs awarded by the Registrar, they may be recovered as a due debt in a court of competent jurisdiction - section 75(3).

24.34

Where proceedings are settled by agreement between the parties the settlement should deal with the costs of those proceedings.

Security for Costs

24.40

The same scale and considerations, so far as applicable, will be taken into account in determining the amount of any security

for costs that the Registrar may require from any party who neither resides nor carries on business in Malaysia. The Court is given this power under section 28(10) and the same power is conferred on the Registrar by regulation 48. The Act provides that if the required security is not given, the defaulting party may lose the action. This provision is not specifically carried into the regulations, but will usually be applied by the Registrar in similar circumstances.

24.41

The Registrar will require security only if requested to do so by the other party and only if:

- (i) the parties have been unable to reach agreement on the matter between themselves, and
- (ii) the requirement is justified, having regard to the stage reached in the proceedings.

There is nothing to stop a further application for security being made, and granted, if the circumstances warrant it.

24.42

Where an application to register a trade mark is made under section 26(1)(a) and is opposed, the Registrar may require security for costs to be given by the applicant, even if he resides in Malaysia. In default, his application will be treated as abandoned - section 26(2).

Burden of Proof

24.45

The onus of showing that his mark should be registered is on the application for registration - "Aristoc v. Rysta", (1945) 62 R.P.C. 65. The fact that he discharged that onus at the prima facie stage is not conclusive in inter partes proceedings. The Registrar is not bound by any earlier decision in the matter, even if that was reached at a hearing. If, for example, a ground of opposition is that the applicant's mark is neither distinctive nor capable of distinguishing, the question is at large again, and will be decided in the light of any evidence filed by the parties and of any argument at the opposition hearing.

24.46

Where an opponent alleges that the applicant's mark bears a deceptive resemblance to his own, he does not have to prove that the public would be confused or deceived thereby. The applicant has to show that no such confusion or deception is likely; an onerous task and one that is hardly susceptible to evidence.

Admissibility of Evidence

24.50

The Registrar is sometimes called on to rule whether evidence is admissible in law, in addition to dealing with requests under regulation 43 - see paragraph 24.15. Where the defect is purely technical, such as incorrect attestation, it will normally have been noticed at the time of filing and the attention of the party concerned drawn to it. In that case, it may be that it will be excluded from consideration at the hearing, although the Registrar may admit it, especially if the other side have not raised the issue beforehand.

24.51

Under Section 74(1) and regulation 88 the Registrar has power to permit any document to be amended and to excuse any irregularity in procedure if it is not to the detriment of the interests of any person, if he thinks fit and on such terms (e.g., as to costs) as he may direct. This power is considered to cover the curing of defects such as are mentioned in the previous paragraph.

24.52

Allegations that the evidence is hearsay, obtained illegally, etc., should be dealt with on normal lines. It may usually be admitted, but what weight it will carry is another matter.

24.53

Occasionally, evidence may be read de bene esse, although not formally admitted.

Viva Voce Evidence

24.55

While the normal mode of giving evidence in proceedings before

the Registrar is by statutory declaration, section 64(1) empowers the Registrar, if he thinks fit, to take evidence viva voce in lieu of, or in addition to, evidence by declaration. The effect of the section is that oral evidence cannot be admitted unless the Registrar so directs.

24.56

Any party wishing to tender oral evidence or wishing to cross-examine the other side's witnesses must apply to the Registrar to sanction it. Registry proceedings are, in general, intended to be determined in paper evidence only, and the power to order the attendance of witnesses, contained in section 75(1)(a), is rarely used. Oral evidence will not be admitted if the Registrar considers that it will not help him decide the case.

24.57

If the Registrar has no objection, both sides are so advised and the party making the request must make all the necessary arrangements to secure the attendance of the witnesses. Where the witness belongs to the other side and is required to attend for cross-examination, the party concerned should provide an undertaking that they will produce him. In default of such an undertaking, the Registrar may issue a summons under the power conferred by section 75(1)(a), or he may decide to hear the case without oral evidence.

24.58

If the Registrar is minded to grant a request for oral evidence, the number of witnesses must be kept within reason. Where one side has filed numerous declarations all to the same effect, only a representative sample will be ordered to attend, the parties being left to agree which ones to subpoena, up to the limit of the number agreed by the Registrar.

24.59

Any witness who, without lawful excuse, fails to comply with a Registrar's summons to attend the hearing is deemed to have committed an offence punishable by a fine or term of imprisonment or both - section 75(2). More practically, perhaps, the Registrar may discount his written evidence if he fails to attend.

24.60

Section 75(1)(b) empowers the Registrar to receive evidence on oath. Witnesses attending a hearing will be required to be sworn according to the law and their beliefs, and the necessary copies of the Koran, Bible, or other testament or object, and the correct wording of oath or affirmation must be to hand. Where the Registrar has given leave for viva voce evidence to be tendered, an officer of the registry will attend the hearing (in addition to the hearing officer) to administer any oath that may be required.

Evaluation of Evidence

24.65

Evidence should direct to the establishment of facts. Where the witness expresses his opinion, it is relevant only if he is an expert in the matter - see paragraph 24.67. So-called evidence, which consists of non-expert opinion, argument or mere assertion, is of little, if any, value.

24.66

It frequently happens that one or both parties bring forward witnesses who state that they believe others would be confused, although they were not confused themselves. Such opinions are worth practically nothing (although the evidence is technically admissible). They cannot be used as a substitute for the Registrar's own view of the possibility, although, of course, he will take all the evidence into account.

24.67

In reaching a decision on the question of the likelihood or otherwise of deception or confusion occurring, the nature of the goods has a vital bearing on the value of any evidence filed, and the extent to which it may replace the Registrar's own view. In "GE Trade Mark". [1973] R.P.C. 297, Lord Diplock said, apropos this aspect:

"My Lords, where goods are of a kind which are not normally sold to the general public for consumption or domestic use but are sold in a specialized market consisting of persons engaged in a particular trade, evidence of persons accustomed to dealing in that market as to the likelihood of deception or

confusion is essential. A judge, though he must use his common sense in assessing the credibility and probative value of that evidence is not entitled to supplement any deficiency in evidence of this kind by giving effect to his own subjective view as to whether or not he himself would be likely to be deceived or confused ... But where goods are sold to the general public for consumption or domestic use, the question whether such buyers would be likely to be deceived by the use of the trade mark is a 'jury question'. By that I mean: that if the issue had now, as formerly, to be tried by a jury, who as members of the general public would themselves be potential buyers of the goods, they would be required to consider any evidence of other members of the public which had been adduced, but also to use their own common sense and to consider likely to be deceived or confused.

"The question does not cease to be a 'jury question' when the issue is tried by a judge alone, or on appeal by a plurality of judges. The judge's approach to the question should be the same as that of a jury. He, too, would be a potential buyer of the goods. He should, of course, be alert to the danger of allowing his own idiosyncratic knowledge or temperament to influence his decision, but the whole of his training in the practice of the law should have accustomed him to this, and this should provide the safety, which in the case of a jury is provided by their number. That in issues of this kind judges are entitled to give effect to their own opinions as to the likelihood of deception or confusion and, in doing so, are not confined to the evidence of witnesses called at the trial is well established by decisions of this House itself."

24.68

That passage affords valuable guidance to the Registrar in deciding whether an applicant for registration has discharged the burden of showing that his mark will not lead to confusion or deception, inasmuch as he is acting in a quasijudicial capacity in opposition proceedings. In doing so, he will be taking the same approach as will the Court if his decision is appealed.

24.69

he evidence of witnesses that they were themselves confused

will be of some value but may require close scrutiny to ensure that the circumstances were entirely fair. If the wording of any questionnaire survey, used in obtaining the evidence, discloses that witnesses were led or that questions were asked on a false premise, it will very likely destroy the evidential value of the survey.

24.70

Evidence of instances of actual confusion can sometimes be valuable, depending on the circumstances in which it occurred. Such evidence obtained by so-called 'trap orders' should always be regarded with care. In all such cases, the person trapped should immediately be informed of the fact by the person conducting the survey so that he can say why he did what he did. The incident may carry more weight if the person trapped makes a declaration. Otherwise, the person giving the evidence, who is not the person confused, may have his evidence discounted. Evidence of actual confusion is, of course, unnecessary in cases where the Registrar considers confusion to be likely.

24.71

Declarations in common form may be regarded with some suspicion unless the circumstances are fully explained in a covering declaration by the person who obtained the evidence. The danger is that the witnesses are not using their own words and may have been unduly influenced by a prepared questionnaire presented to them to complete, and afterwards to exhibit, to their declaration. (See, in this respect, the words of Evershed L. J. in "Glastonbury's T.M." (1938) 55 R.P.C. 253.)

24.72

The evidence of members of the public and the relevant trade of their knowledge of one or other marks is always valuable, as establishing reputation.

Section 14 and Section 19 - The Difference

24.80

Section 14 prohibits the registration of a mark "the use of which is likely to deceive or cause confusion to the public". Section 19(1) prohibits the registration of a trade mark that

so nearly resembles a registered trade mark belonging to another proprietor "as is likely to deceive or cause confusion", if the goods are the same or of the same description. Opponents commonly claim the benefit of both provisions.

24.81

The effect of section 14 has already been considered in chapter 14 in the context of inherent confusion, i.e., looking at the mark alone. It also applies, however, to comparisons of one mark with another, but that aspect does not concern the Registrar at the ex parte state, where only the effect of section 19 is to be considered. Its application in the context of comparison of marks occurs only in inter partes proceedings. The difference between section 14 and section 19 in that context is explained below.

24.82

Section 14 makes no reference to registration or to the goods or services. It thus applies to both registered and unregistered marks. It also applies even if the goods or services of the respective parties are of different descriptions. Section 19, on the other hand applies only to marks owned by the opponent which are either already on the register or which have priority of application. The questions which must be considered under the two sections are well established by authority and are derived from the judgment of Evershed J. in "Smith, Hayden & Co.'s Application (Ovax)", (1946) 63 R.P.C. 97, as later modified by the House of Lords in "Berlei v. Bali", [1969] R.P.C. 472. Adapted to the Malaysian legislation, they are:

(a) under Section 14 - having regard to the use made of their marks by the opponents, is the Registrar satisfied that the applicants' marks, if used in a normal and fair manner in connection with any of the goods or services covered by their proposed registration will not be likely to cause confusion or deception amongst a substantial number of persons in Malaysia?

(b) under Section 19 - assuming use by the opponents of their registered marks in a normal and fair manner in respect of any of the goods or services covered by the respective registrations, is the Registrar satisfied that there will be no reasonable likelihood of deception and confusion amongst a

substantial number of persons in Malaysia if the applicants also use their marks normally and fairly in respect of any of the goods covered by their proposed registrations, or of any goods of the same description as those goods.

24.83

The onus of satisfying the Registrar that no such likelihood exists rests on the applicants. The relevant date at which any such likelihood must be judged is the date that the opposed application was filed, although events after that date may be relevant as showing whether or not the likelihood existed at the date.

24.84

If the goods of the opposed marks are identical, or are goods of the same description, the question under both sections is identical, namely; are the marks confusingly similar? Both these questions are dealt with at length in chapter 11 and the same principles set out there apply in inter partes proceedings, tempered to the extent that the evidence filed affects the outcome.

24.85

An applicant will sometimes argue that there has been no actual confusion because he sells upmarket goods or services, while the opponent sells in the bottom end of the market, or vice versa. Again, such an argument must fail in the absence of an acceptable separation of the parties' spheres of activity reflected in their specifications. Without that, either party may begin to trade in that part of the market hitherto the sole preserve of the other, and, if the marks bear a deceptive resemblance, public confusion will follow.

24.86

Even if all of an applicant's goods or services are of a different description to those of the opponent, he will still fail if it is likely that the public will think, because of the similarity of the marks, that both parties goods or services have a common commercial origin. This is sometimes referred to as the 'common field of activity' question, and acceptable evidence on the possibility is nearly always helpful.

Interlocutory Proceedings

24.95

In the course of preparing oppositions for determination, the parties may find themselves at odds over various matters. If they cannot resolve their differences, either may apply to the Registrar for directions or for a joint interlocutory hearing. Some indication of the problems that may arise and how they may be dealt with is given in the following paragraphs. Wherever a reference is made to a hearing, the matter may instead be dealt with solely on the basis of written representations from the parties, provided that both agree to it.

24.96

An opposed request for an extension of time that cannot be dealt with under regulation 45 should not be granted without receiving representations from both parties on the matter - section 76. If an extension is granted, it should nearly always be made a final one.

24.97

An opponent who files no evidence is deemed to have abandoned his opposition "unless the Registrar otherwise directs" - regulation 40(2). The usual, and acceptable, reason is that the opponent intends to rely entirely on argument. If the Registrar directs that the matter should proceed, the applicant may file his evidence in the usual way and the opponent does not lose his right to file evidence in reply to it under regulation 42 if he wishes.

24.98

An opposed application to amend a notice of opposition or counterstatement should not be granted without a hearing. It may usually be allowed under regulation 88, but if the applicant for the amendment causes the costs of the proceedings to rise as a result, he may be ordered to pay them, or the increased amount, in any event. section 74(1).

24.99

One party may ask that the proceedings before the Registrar be stayed pending the outcome of some other proceeding elsewhere.

If the other side consents, the request may usually be granted. Otherwise, a joint hearing may be necessary to decide the matter. The principle to be applied is that, for reasons of common sense, equity and cost savings, it is undesirable that contests in which the issues are substantially the same should be pursued concurrently before different courts. A plaintiff (opponent) has the right to seek redress in the court of his choosing and a defendant (applicant for registration) has the right to have the matter determined. It is necessary to balance these sometimes opposing rights. Where the outcome of the other proceedings will clearly settle those before the Registrar, the request may be granted on terms. These will usually be that the other proceedings are pursued without undue delay and a time limit for the stay should be imposed, with either party at liberty to apply for fresh directions at any time.

24.100

Sometimes parallel proceedings are launched in the registry. The most usual is that an opponent is opposing more than one application by the same applicant. Although separate oppositions are necessary - see paragraph 24.4 - it is likely that the issues raised are substantially the same and both sides will wish to avoid the expense of preparing separate declarations for each opposition. In that event, an application to consolidate the proceedings may be agreed; subject to there being a single decision to deal with all matters. If consolidation is agreed to, it will not be necessary for the parties to file more than one form TM.9 or to pay more than one hearing fee each. If consolidation is not agreed to, the cases may still be heard and argued together, but in that case the appropriate number of forms TM.9 must be filed.

24.101

Where several parties are opposing the same application, each opposition constitutes a separate and independent proceeding. An application to consolidate all of them into a single proceeding will usually be denied, as it may introduce complications in the registry and on any appeal. For example, one opponent may withdraw, although he will still technically be joined in the action. Also, the marks of the various opponents, and the extent to which they have been used, may

vary considerably. If all the parties agree to be bound by its outcome, one opposition may be selected as a test case and the others suspended.

24.102

Where two parties have embarked on cross-oppositions, e.g., both have made conflicting applications under section 19(2), their evidence will usually be the same in both proceedings. However, it will not usually be convenient to have them formally consolidated.

24.103

An application whose mark is being opposed on the basis of a registered mark owned by the opponent may counterclaim, by way of defence, for rectification of the register by removing from it the opponent's mark. The ground for such a counterclaim is usually that the opponent's mark was wrongly registered, wrongly remains on the register, or is not used. The conduct of rectification actions is no longer dealt with in the registry but is now a Court matter (refer chapter 25). It is no longer possible to have rectification proceedings and opposition proceedings consolidated to be dealt with by the registry.

24.105

Once a main hearing has been appointed, any request for it to be postponed will be refused unless the most cogent and compelling reasons are advanced. The hearing list is so congested that it would be most unfair to other litigants to, in effect, allow the time given over to clearing the list to be wasted. Once a hearing has begun, it may be adjourned at the discretion of the Registrar if he is satisfied that it is right to do so, e.g., for the admission of further evidence, or until a rectification matter has been determined by the Court, if it is likely that an opposition will fail if the rectification succeeds. It is important to remember that an opposition may prove well founded on other grounds.

Appeals

24.110

An appeal from any decision of the Registrar lies only where one is expressly provided - section 69. There is, for example,

no appeal against any decision under paragraphs 24.95 to 24.103 above. The decision of the Registrar in determining an opposition - see paragraph 24.23 - is appealable under section 28(5) and (6). The Registrar may attend and be heard if he so desires - section 62(1).

24.111

The Court has discretion in the matter of award of costs and will take into account any award made by the Registrar at the registry hearing. The Court may also award the Registrar his own costs if he appears, but he is not liable for the costs of any other party in any event - section 63(1).

24.112

On the hearing of an appeal in an opposition, any party, may bring forward further material 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. 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 - section 28(7) and (8).

24.113

On appeal, the Court may permit the trade mark to be modified so long as its identity is not "substantially" affected. (See chapter 15 for the meaning of this phrase.) It will not make any order to that effect, however, without first hearing the Registrar, who will be able to advise the Court of the practice and precedent in the matter. If a modification is allowed, the trade mark must be advertised again - section 28(9) - and, presumably, be open to opposition all over again.

24.114

The Registrar must be served with a copy of any order of the Court made on the determination of an appeal. The Court cannot order that a mark be registered, only that it be allowed to proceed. Whether it is registered or not, depends on the applicant paying the prescribed fee in the usual way. If he does not do so, his mark will not be registered.

CHAPTER 25 - RECTIFICATIONS

Causes of Action

25.1

Any error or mistake in the register may be rectified at the suit of a person having an interest in the matter. Applications by the registered proprietor himself are normally non-contentious and are dealt with in chapter 21. This chapter deals with inter partes actions.

25.2

Any person who is aggrieved by an entry in the register may apply to have the entry rectified. This usually means complete or partial cancellation of the entry, or the substitution of his name for that of the registered proprietor. The grounds of such applications are set out in sections 45 and 46 of the Act.

25.3

Section 45(1)(a) provides a general power of rectification at the suit of any person aggrieved by:

- (i) the non-insertion in or omission from the register of any entry; or
- (ii) any entry made in the register without sufficient cause; or
- (iii) any entry wrongfully remaining on the register, or
- (iv) any error or defect in any entry in the register

25.4

Section 46 is concerned with non-use and provides that a trade mark may be removed from the register in respect of any of the goods or services for which is registered on application by a person aggrieved if either:

- (i) the mark was registered without a genuine intention to use it and there has in fact been no such use; or
- (ii) there has been no bona fide use of the mark for at least three years prior to one month before the application to remove it.

There are some defences to the action, which are examined later.

25.5

The applicant for rectification begins his action in the Court.

- sections 45(1)(a), 46(1).

Files

25.10

When an action is begun in the Court, a copy of the application must be served on the Registrar, who may attend and be heard if he wishes - regulation 74. A file numbered sequentially in a series prefixed REC will be opened and the proceedings controlled from there.

25.11

If more than one registration is the subject of an application for rectification, a REC file must be opened for each one, even if the applicant for rectification is the same in each case. They will all, however, stay together until the actions have been determined.

25.12

The file(s) of the registered trade mark(s) under attack will be attached to the applicable rectification file(s). The REC file number will be added to the computer record for those registrations. Until the rectification action has been finally determined, the registration of a trade mark which is the subject of a rectification action may be renewed, but no other change in its status other than complete cancellation at the request of the registered proprietor, may be permitted. In particular, no assignment may be recorded. If the assignee is the applicant for rectification he should be informed that the Registrar is unable to act on the assignment until the rectification action has been withdrawn.

25.13

If any files are shown on the register to be associated with the one(s) under attack, the minute sheet in the rectification file should be prominently noted. The parties should be informed and it will be for them to decide whether, and if so, how, their respective cases may be affected. The associated mark may be remembered that, under section 23(2), the use of an associated trade mark may be accepted as use of the other mark and this may be prove an adequate defence to an attack under section 46 for non-use.

Procedure

25.20

The procedure is now to apply to the Court. Before the amendments to the Act and Regulations the procedure applicable to oppositions was applied mutatis mutandis to rectifications but there were certain important differences. In particular:

(i) only a "person aggrieved" had the necessary standing to make the application;

(ii) the notice which started the proceedings was accompanied by a statement of case in support of the application and also stated the grounds on which the applicant claimed to be aggrieved by the existing registration;

(iii) the trade mark was not removed from the register merely because the registered proprietor filed no counterstatement; and

(iv) the burden of proof was reversed, i.e., it was initially on the applicant to rectify to the Registrar who will forward them to the registered proprietor.

Person Aggrieved

25.35

A person (other than the proprietor or Registrar) must be aggrieved by the registration of a trade mark before he can apply for its removal or partial rectification. The phrase 'person aggrieved' should be construed liberally. It includes any person whose own application for registration is blocked by the one in suit, any person who is alleged to have infringed the registration, and anyone whose legitimate business may be adversely affected by a wrongful registration. In "Powell T.M.", (1894) 11 R.P.C. 4, Lord Herschell said:

"Wherever it can be shown, as here, that the applicant is in the same trade as the person who has registered the trade mark, and wherever the trade mark if remaining on the register would or might limit the legal rights of the applicant so that by reason of the existence of the entry on the register he could not lawfully do that which but for the existence of the mark upon the register he could lawfully do, it appears to me that he has a locus standi to be heard as a person aggrieved."

25.36

The reference in the above quoted passage to the parties being in the same trade, received further judicial notice in "Lever v. Sunniwite", (1949) 66 R.P.C. 84. That was an infringement action in which the defendants sued for rectification by way of defence. Romer, J. held that they were not persons aggrieved in respect of any registered goods, which were not goods of the same description as those in which they traded themselves. He said:

"... the defendant's sole activity lies, and has lain for some years past, in the region of soap less detergents. This being so, and in the absence of some evidence to support the view, I am unable to see how they can sensibly be regarded as aggrieved in respect of the plaintiff's mark being on the register in relation to perfumery, cosmetics, preparations for the hair and dentifrices. I have already indicated my opinion that none of these products are goods of the same description as detergents, which have, so far as I am aware, almost nothing in common with any of them."

25.37

The meaning of the phrase 'goods of the same description' is examined in chapter 11. It may be used to determine whether an applicant for rectification has the necessary standing but in any case of doubt, he should be allowed to proceed. It will then be up to the applicant to file evidence relating to the point, and to the registered proprietor to call evidence to show that the applicant is not aggrieved, if so advised.

Burden of Proof

25.50

The onus in an application for rectification is on the applicant. This follows from section 36, which provides that in all legal proceedings relating to a registered trade mark (including applicants 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 and of all subsequent assignments and transmissions thereof.

25.51

The explicit references to section 45, both in section 36 and

section 47(3), show that an unrecorded assignment does not shut out the beneficial owner of the registered trade mark from the proceedings. In practice, his status is regarded in the same way, if the application to rectify is made under section 46.

25.52

The burden of proof may shift during the course of the proceedings. For example, an applicant for rectification under section 46 must establish a prima facie case of non-use - see "George Angus T.M.", (1943) 60 R.P.C.29. Once he has done so, it is for the registered proprietor to show that he has in fact used his mark, or an associated one, on goods for which he has a registration, or that the non-use may be excused under section 46(4) - "Trina T.M.", [1977] R.P.C.131. (As to the section 46(4) defence, see paragraph 25.70.)

25.53

An applicant for rectification on the ground of non-use must show that there has been no use by any registered user, since, if that is permitted use as defined by the statute, it is deemed to be use by the registered proprietor - see chapter 19. See, in this connection, "Autodrome T.M.", [1969] R.P.C. 564. (It is sometimes argued that use by an unregistered user will have the same effect but that cannot necessarily be so since it is only 'permitted use' that unequivocally ensures to the benefit of the proprietor. Use by an unregistered user may, if the Registrar thinks fit to exercise his discretion in that way, result in the name of the user being substituted in the register for that of the registered proprietor, but it is not an inevitable result.)

Undefended Actions

25.55

The removal of a mark from the register at the suit of a third party is always a very serious matter and the Court will not order it unless completely satisfied that it is just to do so. Where an order is made by the Court for rectification or alteration of the Register, the person in whose favour the order is made shall file form TM.28 accompanied by the prescribed fee.

Contested Section 46 Cases

25.60

Where a registered trade mark is registered without a genuine intention to use it as such, i.e., in the course of trade to indicate a connection between the goods or services and the proprietor or a registered user, and where no bona fide use has in fact been made since the date of registration, it may be removed, at the suit of an aggrieved person, under section 46(1)(a). No mark, which was registered on the basis of evidence of factual distinctiveness, can be attacked under this provision. Registrations obtained under the special dispensation from the requirement that the proprietor use the mark himself, which is contained in section 26(1), may be attacked under this provision if the body corporate or the registered user concerned does not make use of the mark in his stead. (Section 26(1) applications are covered in chapter 12.)

25.61

Section 46(1)(b) is concerned with a mark which has been used at some time but which is alleged to have fallen into disuse, either for all the goods for which it is registered or for some of them. If the applicant for rectification can establish that there has been no genuine use of the mark for a continuous period of at least three years ending one month before the date of the application, it may be struck from the register.

25.62

The purpose of the one-month provision is to prevent a proprietor getting wind of the proposed action and attempting to ward it off by use embarked upon solely for the purpose and without any genuine intention to trade under the mark. Those who intend to launch rectification actions must do so without delay.

Use in Good Faith

25.65

Any use of the mark by the proprietor or registered user must be in good faith if it is to be taken into account as a defence under section 46(1). Two contrasting decisions may illustrate where the borderline comes.

25.66

The first is "Electrolux v. Electrix", (1954) 71 R.P.C. 23, Electrolux had a registration of Electrux which they did not use. They delayed replying to a request from the owners of Electrix for their consent to the registration of the mark, in order to begin use of Electrux. When Electrix applied to have Electrux removed on the ground of its non-use, it was held that the use of Electrux was bona fide despite an admission that it had been introduced solely to provide a possible defence to an attack on its registration. The evidence showed that genuine sales had taken place.

25.67

The second case is "Imperial v. Philip Morris", [1982] F.S.R. 72, involving the Nerit and Merit marks. This is discussed in paragraph 12.283 in the context of "ghost" marks. It was held that the token use made of Nerit had no commercial objective and was not designed to establish any goodwill in the mark; accordingly, it was not bona fide.

25.68

Sometimes, however, isolated instances of use may be quite genuine and sufficient to defend the registration. In "Nodox T.M.", [1962] R.P.C. 1, a single act of sale was considered to be sufficient, but the judge expressly stated that it was because the sale was well documented and incontrovertible. If the evidence shows that the sale occurred in the ordinary course of commerce and was not made in contemplation of possible legal proceedings, it may be allowed to carry weight.

Special Circumstances in the Trade

25.70

The Act provides a defence to an action under section 46(1)(b), which does not apply to one under section 46(1)(a). It is expressed in section 46(4) and states that an applicant for rectification cannot rely on any failure to use the trade mark if that failure was "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." Apart from the fact that the minimum period of non-use in Malaysia is three years but is five years in the U.K., the

respective statutes are in practically identical terms. The decided cases on the application of this provision thus provide some assistance in construing it.

25.71

The special circumstances must apply in the trade concerned and not merely in the particular proprietor's business. The non-use must not have been due to some other cause, which would have operated in any case - "James Crean T.M.". (1921) 38 R.P.C. 155. Obvious examples of special circumstances which operate over the whole trade, include: import and other license prohibitions imposed by government; war; unavailability or shortage of essential components or ingredients used in the manufacture of the goods; exchange control regulations preventing the purchase of such essential materials; and so on.

25.72

Even if there is no shortage of materials, funds or other necessities, there may be good reason for the proprietor to refrain from using his mark for a time. As Chitty J. said in "Mouson v. Boehm", (1884) 26 ChD 398:

"A man who has a trade mark may properly have regard to the state of the market and the demand for the goods; it would be absurd to suppose that he lost his trade mark by not putting more goods on the market when it was glutted".

However, a glut that lasts more than three years is some glut.

25.73

The comment in the last paragraph relates to the fact that the special circumstances need not obtain throughout the whole period of three years - "Marshall's Application (Honymol)", (1943) 60 R.P.C. 147 - but that, if they do, the proprietor must show that his non-use was due to those circumstances and not from some other reason. This is especially important when the non-use continues over the whole three years but the special circumstances exist for only part of the period. The proprietor will need to show that his non-use during the special circumstances period was not from the same cause as the non-use, which preceded and followed it.

Goods or Services of the Same Description

25.80

Another defence available to a registered proprietor, who has not used his mark, is provided by section 46(2). It applies where it is established that the non-use relates to some only of the goods or services. If the mark has been used in good faith on goods or services of the same description as the non-used goods or services, the Registrar is given discretion not to strike out the non-used goods or services so long as the used goods or services are "goods or services in respect of which the trade mark is registered".

25.81

The Malaysian provisions are not, in this instance, on all fours with those in the U.K. legislation. Accordingly, the decision in "Atlas T.M.", [1979] R.P.C. 59 is of limited value in construing this provision in the 1976 Act, although it is possible that the case may be quoted in argument, e.g., by an applicant at a Court hearing. The essential requirements prerequisite to the application of section 46(2) are that the used goods or services must be goods or services of the same description as the non-used goods or services and that both should be registered under the same mark. It is not necessary, as it was in the U.K., that they be in the same registration.

25.82

A simple example will illustrate how the Court may proceed in dealing with cases coming within section 46(2). A proprietor who has registered the same trade mark in classes 3 and 5 for deodorants but has used it only on class 3 goods may save the class 5 registration if the Court so directs. In such a plain case the Court will almost certainly refuse to expunge the class 5 registration for to do so will allow another trader to use the mark or a deceptively, similar one on class 5 deodorants, and public deception would be more than likely. The applicant for rectification could not succeed in obtaining a class 5 registration himself, even if the existing class 5 registration were to be expunged, because of the operation of section 19(1), and the fact that both types of deodorant are goods of the same description, despite being classified in two international classes. It is therefore in the public interest

that the class 5 registration is allowed to remain.

25.83

Where the registered proprietor has registered slightly different marks for the same goods or services or for goods or services of the same description, in the same or different classes, the Registrar will have required them to be associated under the provisions of section 22. - see chapter 17. If, in such a case, an applicant for rectification established that one of the registrations has been unused, but the registered proprietor proves use of any of the associated registrations, the Registrar's discretion would probably have applied to leave the register unamended. This is now a matter for the Court to decide. In this instance it is in the public interest to refuse the application for rectification i.e., if a likelihood of public confusion or deception might be increased by rectification and by what the applicant would then be free to do.

Ambit of Section 45

25.85

Section 45 is more than just an enabling provision. On the one hand, it provides that a registered trade mark may be varied or expunged if the entry was wrongly made or wrongly remains. This must refer to other provisions of the Act which a mark must offend before the section can be invoked. For example, if the mark did not meet the requirements for registration at the time it was registered, the registration was wrongly made. In such a case, the applicant for rectification will have to show that the provisions of sections 10, were not met at the time. This may prove to be a fairly simple task and is one reason why it is not in a proprietor's own interests to hide the true facts from the Registrar at the time of making his application for registration, or to pressure a hearing officer into a waiving a good objection against his better judgment.

25.86

On the other hand, the section gives the Court a general jurisdiction to remove or vary any entry, which is unlawful at the time the application to rectify, is made - section 45(1)(b). This is so; whatever the situation was at the time the

registration was effected. In considering the effect of intervening circumstances between the date of registration and date of application to rectify, the incontestability provisions must borne in mind.

Incontestability

25.90

Subject to three exceptions, section 37 provides that, seven years after the date of the original registration, a registration shall be valid in all respects in all-legal proceedings relating to it. (The section does not apply to registrations obtained under the repealed ordinances and incorporated into the current register under section 6(3) until three years after the Act came into effect.). The three exceptions are:

- (i) if the original registration was obtained by fraud;
- (ii) if the trade mark offends against section 14;
- (iii) if the trade mark was not distinctive of the goods or services of the registered proprietor at the commencement of the proceedings.

25.91

If a registration, or assignment is obtained by fraud, the Registrar may himself apply to the Court to remove it - section 45(1)(c). This is one of the few cases where the Registrar may apply for rectification of his own motion.

25.92

A mark registered does not become incontestable if it offends against section 14, that is to say, is not entitled to the Court's protection, is unlawful, or is likely to deceive or cause confusion. The question of what should be done when a mark did not offend against the section at the time of its registration but did so later was considered by the House of Lords in "GE Trade Mark", [1973] R.P.C. 297. In a closely reasoned judgment, which is worth reading in full, Lord Diplock said (page 334):

"The legal status of a registered trade mark the use of which is likely to cause confusion can be summarised as follows:

- (1) The fact that the mark is entered on the register is prima facie evidence of the validity of the original registration and

of the right of the registered proprietor to the exclusive use of the mark, subject however to the rights of concurrent user by any registered proprietor of an identical mark or one nearly resembling it;

(2) If the mark was likely to cause confusion at the time when it was first registered it may be expunged from the register as an 'entry made in the register without sufficient cause' unless the proprietor of the mark at that time would have been entitled to have it entered on the register by reason of his honest concurrent use of the mark as a trade mark before the original registration of the mark;

(3) If the likelihood of causing confusion did not exist at the time when the mark was first registered, but was the result of events occurring between that date and the date of application to expunge it, the mark may not be expunged from the register as an entry wrongly remaining on the register, unless the likelihood of causing deception resulted from some blameworthy Act of the registered proprietor of the mark or of a predecessor in title of his as registered proprietor;

(4) Where a mark is liable to be expunged under (2) or (3) the Court has a discretion whether or not to expunge it and as to any conditions or limitations to be imposed in the event of it being permitted to remain on the register."

25.93

It should be noted, however, that the date when the lack of distinctiveness must be established is the date when the proceedings began. In the case of an action for rectification conducted in the registry that is the date that the form TM.38 was filed. A proprietor of a mark registered must maintain the distinctiveness of his mark at all times - compare this requirement with the situation at the time of registration in paragraph 25.85.

Use where Form of Trade changes

25.95

A registered trade mark cannot be deemed to be likely to cause deception or confusion only on the ground that the form of trade connection changes - section 72. This is in line with the fact that the definitions of a trade mark in section 3(1) states that it is not material if the public is unaware of the

identity of the trade mark owner.

25.96

The use of the word 'only' in the section should be noted. The guiding principle, as always, is whether the public would be deceived as to the origin of the goods or services.

Marks Publici Juris

25.100

Section 33(1) provides that where a trade mark consists of or contains a word or words, its registration shall not be deemed to have become invalid by reason only of any subsequent use of the word(s) as the name or description of an article, service or substance. Subsections (2), (3) and (4) go on to set out the status of a registered trade mark which is so used.

25.101

The full provisions of the section are complicated and difficult to construe. It will usually be the case that any action for rectification which alleges that a mark has lost its distinctiveness and entered the public domain as a generic description and so should be deemed to be a mark wrongly remaining on the register for the purpose of section 45 (see subsection 3(a)), will be referred to the Court.

Appeals etc.

25.105

Section 45 (1)(d) directs that an order of the Court rectifying the register shall be served on the Registrar who must, on receiving it, rectify the register accordingly. The provision is not expressed as applying only to actions commenced under section 45.

25.106

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25.107

There is a prescribed fee that should accompany form TM.28 to have the register amended in accordance with an order of the Court - regulation 75.

CHAPTER 26 - CERTIFICATION TRADE MARKS

Registrability Requirements

26.1

A certification trade mark is a special kind of trade mark, defined in section 3(1) as a mark registrable or registered under part XI of the Act. That comprises a single section, although it is by far the longest one in the Act - section 56. The principal applicable regulations are 30 to 36.

26.2

In brief, the function of a certification trade mark is to serve as an indication that the marked goods attain a standard, or possess some characteristic, defined by the proprietor. The registered proprietor of a certification trade mark does not trade in the goods himself but authorizes others to do so in accordance with published rules. If the proprietor does trade in the goods himself he cannot register the mark as a certification trade mark, although he may, in that case, register it as an ordinary trade mark and appoint registered users of it. (Registered users are dealt with in chapter 19.)

26.3

To be registrable as a certification trade mark, a mark must be adapted to distinguish certified goods or services from non-certified goods or services - section 56(1). The certification must be in respect of origin, material, mode of manufacture, quality, accuracy, or other characteristic. In determining whether a mark is so adapted, regard must be had to the extent to which:

- (a) the mark is inherently so adapted; and
- (b) the mark is in fact so adapted by reason of use or of any other circumstances.

26.4

The similarity of the above wording to that used in section 12(2) and the fact that section 56(1) places all registrable certification trade marks of the register is apt to lead to some misconception of the requirements for registrability. It does not mean that any A mark can be a certification trade mark

or vice versa. The requirements for registration as a certification trade mark and as an ordinary trade mark are quite different.

26.5

The difference between the registrability of an ordinary trade mark and a certification trade can be best be illustrated by the considering a geographical name. As is shown in paragraphs 12.45 and 12.126, such a name cannot be registered as an ordinary trade mark if the indicated geographical origin of the goods or services to which it is applied is credible, no matter how factually distinctive it may have become. The exact opposite is true when registration of such a name is sought as a certification trade mark. There can be no more suitable mark to certify the geographical origin of goods, which is one of the characteristics by which certified goods or services may be distinguished from non-certified goods or services.

26.6

Another striking example of the fact that 'distinctive' has a very different meaning for a certification trade mark is where the mark has a very direct reference to a characteristic or quality of the goods or services. Such a mark cannot be distinctive if it is to be used as an ordinary trade mark. A certification trade mark, on the other hand, must make such a reference.

26.7.

However, a mark which is only capable of distinguishing, is unlikely to prove acceptable as a certification trade mark. A certification trade mark must be a highly distinctive mark.

Certification Requirements

26.10

Any person who wishes to register a certification trade mark must have the resources and the status in the relevant trade to ensure that his certification is authoritative. He must also be able to maintain the reputation of the mark and to prevent its misuse. Control over the use of the mark and must be in his hands and in no others. He must be a legal person, capable of suing and of being sued.

26.11

Use of the mark must be open to any person who is able to produce goods of the required standard or other characteristic and who is willing to abide by the conditions governing its use. There must be a right of appeal to an independent referee if the proprietor excludes a qualified person from using the mark. There must also be some advantage to the general public as a result of the mark's use.

26.12

The above requirements are met by a set of rules which will govern the administration of the scheme and which will, if the application is accepted, be entered on the register and so be open to public inspection.

Procedure

26.15

The applicant must be an organization, such as an association of manufacturers, a government department, or technical institution, which does not trade in the relevant goods and which is capable of setting and controlling authoritative standards. SIRIM is particularly well qualified in this respect.

26.16

An application to register a certification trade mark must be made in triplicate on form TM.5, accompanied by five additional representations of the mark. Only goods or services in one class may be allowed for each application - regulations 34(1) and 21. However, the schedule of fee sets a maximum, which is effectively equivalent to 20 applications.

26.17

The applicant must also send, in duplicate, a statement of case and the draft rules on form TM.5, for which no fee is charged. These should set out the full scheme of certification, which he intends to operate, how he intends to superintend it, and the rules governing the use of the mark. They should normally accompany the application to register, although the Registrar may allow them to be sent later.

26.18

Where the statement of case and draft rules do not accompany the application, the submission may be deferred until after the application has been examined and searched in the usual way. If there is no objection on these grounds the applicant should be given an initial time limit of a further three months in which to submit the case and rules. This may be extended under regulation 96.

The Mark

26.20

The Registrar's discretionary powers to refuse, accept unconditionally, or impose conditions and limitations on the application, and the applicant's rights of appeal, are the same as for an application for an ordinary trade mark - section 56(8) and (9).

26.21

Section 56(9) adds that the Registrar shall consider the desirability of securing that a certification trade mark shall comprise some indication that it is such a mark. In practice, this should be a requirement in all cases. If the mark as submitted does not contain the words 'certification trade mark' the applicant should be asked whether he is willing to amend it in order to include them. If he is not so willing, the following condition of proceeding should be imposed:

"It is a condition of registration that the mark shall be used only in close juxtaposition to the words 'certification trade mark'."

26.22

The search for anticipations should be conducted in the normal way. An ordinary trade mark on the register is capable of blocking a certification trade mark and vice versa, if the marks and goods are confusingly similar on the criteria set out in chapter 11.

26.23

Where registration of a certification trade mark is applied for in several classes, they should all be required to be associated as a condition of proceeding, whether or not the

goods or services are of the same description. Insofar as the goods or services are of different descriptions, this requirement is in exercise of the Registrar's general discretion and not under section 22(1). The overall effect is to apply section 23(1) to the whole group of registrations and so to prevent their separate assignment. It would be against the public interest if two or more proprietors were to have control over the use of the same certification trade mark for different goods or services under the same rules.

26.24

In examining the mark for distinctiveness, the fundamental difference in the applicable criteria between a certification trade mark and an ordinary trade mark - paragraph 26.4 - should be overlooked. However, they may be applied a little less strictly. For example, a two letter monogram, which would normally be acceptable may be accepted as a certification trade mark.

26.25

The mark should be examined in the normal way for any inherent deceptiveness - see chapter 14, although here again the matter must be judged from the different standpoint of a certification trade mark and the fact that its use will be strictly governed by published rules. If these rules have not been supplied at the date of the substantive examination and if there is any doubt on the matter, the minute sheet should be prominently noted to clear the point when the rules are to hand.

26.26

In the case of a composite mark it will still be necessary to require a disclaimer of any non-distinctive matter on the principles set out in chapter 15. The question of imposing conditions, such as a blank space condition, should also receive consideration on the basis of what is said in that chapter.

26.27

If the Registrar has any objection to the mark as such, or if he imposes any condition, limitation, disclaimer etc., the applicant has the usual right to a considered reply in writing

or a hearing.

26.28

Once the mark is acceptable per se or it acceptable on conditions mutually agreeable to the Registrar and the applicant, the statement of case and rules should be examined - see below. If they, too, are acceptable, the subsequent procedure regarding advertisement and opposition is much the same as for an ordinary trade mark - section 56(12) and (13).

Statement of Case

26.35

Where applications are made to register the same mark in more than one class, only two copies of the statement of case (and draft rules) need be submitted so long as it is clear that they apply to all the goods or services covered by the totality of the applications.

26.36

The statement of case should comprise:

- (i) the applicant's submission as to the benefit which is expected to accrue to the public if the mark is registered as a certification trade mark;
- (ii) an assurance, based on reasons, that the applicant is competent to certify that the goods possess the particular characteristic that the mark is intended to indicate;
- (iii) a brief survey of the purpose and organization of the scheme and the type of trade who will be admitted to it.

26.37

If there is no reason to doubt that the applicant will be competent to certify in respect of all the goods to be registered the statement of case may be accepted - section 56(11)(a). In cases of genuine doubt as to the sufficiency of case, some further information should be called for, such as a copy of the applicant's constitution or memorandum of association. The statement may be modified as a result of such enquiries, if necessary after hearing the applicant - regulation 35.

26.38

No specific enquiry should be made to establish that the applicant does not engage in trade in the relevant goods himself. However, if the documents supplied indicate that he does, or may, so trade, the matter should be cleared up before proceeding. There is no objection to the applicant trading in goods other than those, which are the subject of his certification trade mark application.

The Rules

26.45

The Registrar is required by section 56(11)(b) and (c) to consider whether the draft rules are satisfactory and whether in all the circumstances the registrations applied for would be to the public advantage. He may approve the rules, or may require them to be modified either in their form or in their application, and after hearing the applicant, if he wishes.

26.46.

The main considerations will be to see that the rules:

- (i) set out explicitly the characteristic which the mark will certify;
- (ii) ensure that any competent person may apply to the applicant for permission to use the mark; and
- (iii) provide a right of appeal to an independent person if such permission is refused.

26.47

These three matters are briefly considered in the following paragraphs.

26.48

It is not a statutory requirement that membership of a certification scheme should be open to any and every person who is competent to produce goods or services to the applicant's standard and who is willing to abide by the rules. Approval of the rules should not, therefore, be withheld on the ground only that it is limited to members of the applicant body. There are public advantages to be gained by the fact that such a body can exercise disciplinary powers over members who bring the body, or its marks, into disrepute by bad trading practices.

26.49

The appointment of a referee to arbitrate in disputes over a failure of the proprietor of a registered certification trade mark to certify goods or to authorise use of the mark is not specifically required by the Trade Marks Act. Where the rules make no provision for a referee, section 56(10) empowers the Registrar to require that they be amended to appoint him in that role.

26.50

In practice, this power is not exercised. It is not considered to be an appropriate part of his function as Registrar of trade marks. If objection is taken, for example by an opponent, that the rules contain no provision for arbitration of disputes arising in the administration of the scheme, it will be open to the applicant to amend them, or to the Registrar to withhold approval of them. (Under this practice, section 56(17) which provide that the Registrar may not award costs when acting, as a referee in such matters, is inapplicable.)

Opposition**26.55**

All accepted applications for the registration of a certification trade mark must be advertised, as accepted, and the normal provisions for opposition apply - section 56(12).

26.56

Opposition may be either to the registrability of the mark, or to the nature and administration of the scheme, or to both - section 56(13). A person opposed to the mark per se must file form TM.7. An opposition on the grounds that the applicant is not competent to certify, that the draft rules are unsatisfactory, or that registration would not be to the public advantage, must be made by filing form TM.7 - regulation 50. Both types of opposition follow the same procedure but in the latter case the counterstatement must be on form TM.8 and form TM.9 must be filed if a hearing is to be attended. The fees for both types of opposition are the same.

26.57

If both types of opposition are mounted, whether or not by different persons, they must both be decided in favour of the applicant before the mark can be registered - section 56(12).

Post Registration Matters

26.60

The Registrar may alter the deposited rules of a registered certification trade mark on the application of the registered proprietor - section 56(14)(a). Unless the alteration is trivial, the Registrar will cause it to be advertised in the Gazette, and it will be open to opposition - section 56(14)(b).

26.61

The entry of a certification trade mark in the register may be varied or expunged by the Court at the suit of the Registrar or of a person aggrieved - section 56(15). See chapter 25 for the meaning of 'person aggrieved'; it will include a person who has unreasonably been denied participation in the scheme. Actions under this subsection cannot be heard by the Registrar.

26.62

Any order of the Court under section 56(15) must be served on the Registrar, who must then alter the register, or the deposited rules, as appropriate. If the rules are ordered to be amended, the Registrar will require that a copy of the amended version is supplied to him for the purpose.

CHAPTER 27 - DEFENSIVE TRADE MARKS

Definition

27.1

The registrability of a mark as a defensive trade mark is covered by sections 57 to 60 and regulation 32. The purpose of the provisions is to enable the proprietor of a well-known invented word mark to defend the reputation of the mark against someone who trades on that reputation by using it on goods or services with which the proprietor has no connection. By registering it as a defensive mark he can, under certain conditions, take infringement action instead of the more uncertain, costly and lengthy action for passing off.

27.2

The provisions apply only to marks consisting of an invented word or invented words - section 57(1). Although there is no definition of an invented word in the section or in section 3(1), the tests for invention are those used in applying section 10(1)(c) - see chapter 12.

27.3

The mark must have an established reputation for certain goods or services for which it is already registered, and the proprietor must be able to show that if the public saw it on other goods or services they would be likely to think, wrongly, that it indicated a trade connection with him, or with a registered user of his. Since it is not necessary that a mark carry with it any identification of its owner's identity - section 3(a) - this means, in effect, that he must show that use of the mark on other goods or services by another person would be likely to deceive or confuse the public. The test is, therefore, very similar to that arising under section 14 in an opposition - see chapter 24. Further comment on this is made in paragraph 27.15.

27.4

The fact that the proprietor has no intention of using the mark as an ordinary trade mark in relation to the goods or services of the defensive application does not disqualify it (as it would an ordinary application made under section 25). In fact,

section 57(1) goes further and provides that no application under section 46 to remove it from the register on the grounds of non-use shall succeed in respect of the goods of the defensive registration. (Section 46 actions are covered in chapter 25.)

Procedure

27.6

An application to register a defensive mark must be made on form T.M.5 accompanied by the prescribed fee. It must also be accompanied by a statement of case setting out the full particulars of the facts on which the applicant relies in support of his application, and these must be verified by a statutory declaration - regulation 32. The applicant may supplement this with such other evidence as he desires to furnish, and the Registrar must take all the evidence into account before deciding the matter.

27.7

In the all other respects, the regulation applicable to ordinary trade mark application are applied to an application to register a defensive mark - regulation 36. For details of the law and procedure see chapters 12 to 17. Where these are varied to suit the circumstances of a defensive application, special mention is made below.

Search and Association

27.10

The normal search for prior rights should be made and should disclose at least on the registration of the mark in the name of its proprietor. Without this a defensive mark cannot be registered. Indeed, even if a defensive registration is obtained, the Registrar will cancel it if the proprietor ceases to have an ordinary registration as a base for it Section 59.

27.11

The search should cover all international classes, and all existing registrations of the mark should be listed on the report sheet, together with an indication of whether those registrations are as ordinary trade marks or as defensive ones. If the defensive application succeeds, all the registrations

will be deemed to be associated, notwithstanding that they may cover different goods or services. - section 58.

27.12

A defensive registration is citable under section 19(1) against the application by another proprietor for a resembling mark for goods of the same description as those of the defensive registration. In such a case it is impossible for the later applicant to claim the benefit of the honest concurrent user provisions of section 19(2), as there will have been none.

"Taken as Indicating a Connection"

27.15

The burden of showing that use of the marks on goods unconnected with him would nevertheless be taken as an indication of such a connection falls on the applicant. It is not incumbent on the Registrar to show the contrary. This onus is particularly difficult to discharge, which probably accounts for the facts that the provisions are hardly used. The standard of proof was established by Evershed, J. in "Ferodo T.M.", (1945) 62 R.P.C. 111. As taken from the head note to the report, and substituting references to sections in the 1976 Act of Malaysia, he held that:

(I) it was not sufficient for the applicant to show that his mark was widely known; he must also show that its past use for specific goods would lead to the belief that its user on other goods indicated a trade connection with the proprietor of the mark;

(ii) the use of the words 'would be likely to be taken as indicating a connection in the course of trade' in section 57 instead of 'liable to deceive or cause confusion' does not imply that the standard of proof is lower than in the sections where those words as used [e.g., sections 14 and 19], since if the inference suggested in section 57 were drawn, there would be a form of deception;

(iii) registration under section 57 was not confined to goods of the same description as those for which the mark was already registered, but the onus on the applicant was easier to discharge when the goods for which defensive registration was sought were of a similar nature to those for which it had been used.

(iv) generally the evidence in support of such an application should include evidence from persons trading in articles of the class for which registration is sought, showing inter alia the importance attached to brands and names in such traders, and what would be their own belief if they saw the mark used for such articles.

27.16

In applying the above principles, regard should always be had to the extent of the proprietor's existing registrations of the mark as an ordinary trade mark. If these cover wide range of goods or services, and if the evidence in support of the defensive application shows the mark to have been used on all of them, it will be easier to draw the inference, required by section 57, that a connection exists between the proprietor and the additional goods. Conversely, if the mark is registered only for very specialized goods or services, it will be practically impossible to make the desired inference for widely different goods or services.

27.17

Evidence from a declarant that he would believe that goods or services bearing the mark emanated from the applicant (when, of course, they do not) is of little value unless he gives reasons for his belief - "Vono T.M.", (1949) 66 R.P.C. 305

Ordinary Registration of Same Mark

27.20

It is acceptable to have a registration for the same goods or services for which a defensive trade mark is sought. In Australia under the Trade Marks Act 1955 defensive registration was only granted if based on an existing registration for the same mark. It was necessary to prove use of the goods or services covered by the registration to the extent that would justify a defensive registration for related goods or services. Section 57 of the Malaysian Act (Amended) 1994 is very similar to section 93 of the now repealed Australian Trade Marks Act 1955.

The Malaysian Act does not require a registration but section 57(2) states that the registered proprietor of a trade mark may apply for goods or services as defensive trade mark

applications even if he already has ordinary registrations for those goods or services. Similarly, it provides that having obtained a defensive registration the proprietor can still apply for ordinary registration for any goods or services for the same mark even if they are already covered by a defensive registration- section 57(2)

The Registrar may cancel the registration of a defensive mark if there is no longer any other registrations in the name of the same proprietor existing on the Malaysian Register. - section 59

27.21

The basic registration may be renewed without any requirement that the proprietor is still using it as an ordinary trade mark - section 60. By definition, there is no requirement that a defensive mark be used by the proprietor - section 57(1) - and such a registration may be renewed subjected only to a check at the time of renewal that a basic ordinary registration is still on the register, and associated with it.