



# Brunei Darussalam Perspective

Judicial Symposium on Intellectual Property

21 October 2021

# XBC Co Ltd v YBCM Inc

## Case Study Question 1

### Plaintiff's Claim

- Damages (s.16)
- Injunction (s. 16)
- Erasure of offending sign (s. 17)
- Delivery up of infringing goods (s. 18)

### Allegations

- Infringement of a TM (s. 13(2))
  - Offending marks are **identical** or **similar** to the registered TM
  - Used on **similar goods** the TM is registered under
  - Likelihood of **confusion** exists

# XBC Co Ltd v YBCM Inc

## Case Study Question 2

### Defence / Counterclaim

- There is no infringement
  - Marks are distinct and unique
  - Unlikely to cause confusion
- Acquired an “earlier right” that predates the TM registration (s. 14(3))
- Registration is invalid and seek revocation of the TM (s. 48)
  - Made in bad faith (s. 6(6))
  - Unregistered mark used in the course of trade (s. 8(4)(a))
  - ABCM has acquired passing off rights (s. 5(2))

# XBC Co Ltd v YBCM Inc

## Case Study Question 3

### Trademark infringement in the Bruneian context

- Issue of similarity yet to be deeply tested in Brunei Darussalam
- Adopt common law theories
- *Ayamas Convenience Store Sdn Bhd v Ayamas Sdn Bhd* [HCCS 38 of 1992]
  - Is there a registered TM? (s. 67 Prima Facie evidence)
  - Has there been actual unauthorised use of the TM or is there a likelihood?
  - Was it used for the designated good or otherwise?
  - Has there been actual confusion or is there a likelihood?
- *International Coffee & Tea Leaf Llc v The Coffee Bean & Tea Leaf Sdn Bhd* [2001] JCBD 510
  - Is the mark recognised as a trade mark by the public?
  - Distinctiveness, proximity, quality of goods
  - Was there an earlier right?
    - Extent of use; honest concurrent use; degree of confusion likely from resemblance of marks; any actual confusion

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Case Study Question 4

## Infringement & Damages in Theory

- Different stages
- (1) Liability
  - Establish infringement
- (2) Damages
  - General Damages
  - Special Damages

# XBC Co Ltd v YBCM Inc

## Case Study Question 5

### Calculation of Damages

- Remains untested.
- General rule:
  - To put plaintiff in the position it would have been if the wrong had not been committed; plaintiff's burden to prove the loss
  - Compensatory v Punishment
- Inquiry of damages may include:
  - Account of profits and all sums found
  - Direct losses i.e. foreseeable loss of sales
  - Sum they would have reached for any licensing agreement

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## Case Study Question 6

### Proper & continuous use

- TM can be revoked (s. 47(1)(a))
  - Not used within the past 5 years
  - Not used for designated goods/service
  - No proper reason for non-use

# XBC Co Ltd v YBCM Inc

## Case Study Question 7

### Final Judgment

- If reputation for ABCM products cannot be established, passing off/“earlier right” defence unlikely to succeed.
- Claim is **successful** – first to file rule:
  - Marks 1 & 2 are deceptively similar with registered TM; will cause misrepresentation
  - Mark 3 is likely to cause confusion due to direct translation to first language; goods are identical
- If TM was successfully registered on the basis of XBC’s fiduciary relationship with ABCM, TM will be revoked due to fraud; Re Chanchai Aroontanawongse (Sanita Manufacturing Co Ltd, Bangkok) v Re Lim Yin Fui (Sanita Manufacturing (M) Sdn Bhd, Kuala Lumpur) [HCOM 2 of 1986]



# Brunei Darussalam Legislation

- Registration to Brunei Intellectual Property Office
- Trade Marks Act (Chapter 98)
- 45 different classes
- Protection is territorial and for 10 years from filing and renewable for subsequent 10 years each
- Exclusive rights to use, sell or license
- IP's can be searched on BruIPO website
- Subsidiary Legislations:
  - Trade Marks (Importation of Infringing Goods) Regulations
  - Trade Marks (International Registration) Rules, 2018

# Thank you

**Supreme Court of Brunei Darussalam**

**Hazirah Yusof, Senior Magistrate**

**[hazirah.yusof@judicial.gov.bn](mailto:hazirah.yusof@judicial.gov.bn)**

**Raheebah Wahab, Registrar**

**[raheebah.wahab@judicial.gov.bn](mailto:raheebah.wahab@judicial.gov.bn)**