

Another Country

ABCM Corp.
(Manufacturer & Seller of
Construction Machineries)

YBCM (Def)
(Wholly Owned
Subsidiary)

⑥ Incorporation

⑦ Import of CM

① The Exclusive
Distributorship
Agreement

② Import of
Construction
Machineries ("CM")

⑧ Sales & Lease
of CM

Def's Mark1: **ABCM**

Def's Mark2: **ABCM + Images
of CM**

Def's Mark3: **The Word which
is expressed "ABCM" in the
Language of your Country**

⑤ Termination

⑨ Lawsuit

XBC (Plf)
(The Former Sole
Distributor)

ABCM
(Plf's Trademark)

The IP Authority
of your Country

③ Exclusive Distribution of CM

④ Registration of the Trademark

The Designated Goods

"Construction Machineries etc."

Your Country

What kind of claims and allegations might XBC (Plaintiff) raise regarding trademark infringement in your country (for example, injunction and compensation for damages against the sale of the defendant's products in your country on the grounds of trademark infringement)?

- A declaration that the Plaintiff is the lawful owner of the trademark of 'ABCM'.
- A Permanent Injunction to restrain the Defendant from infringing the Plaintiff's registered mark, namely 'ABCM' by the use thereof and/ or use of marks which are identical with the Plaintiff's registered marks or so nearly resembling the Plaintiff's registered marks as is likely to deceive or cause confusion in the course of trade;
- An order for the full discovery of all documents in connection with and in particular all contracts and/ or invoices, in relation with the distribution and sale of the Infringing Goods;
- An Order for delivery up of all infringing Goods and articles of the Plaintiff's goods that is in the Plaintiff's possession, power, custody or control of the Defendant.
- General Damages, Exemplary Damages and/ or Aggravated Damages to be assessed by court.
- An inquiry for damages or at the Plaintiff's choice for a calculation of profits made by the Defendant.

What kind of defenses and allegations might YBCM (Defendant) raise regarding trademark infringement in your country (for example, non-similarity of the trademark, cancellation of registration or invalidation of plaintiff's trademark, license, etc.)?

- A declaration that the Defendant is the rightful and lawful owner of the 'ABCM' mark.
- A declaration that the Plaintiff has committed tort of passing off against the Defendant by using the Defendant's 'ABCM' mark.
- A declaration that the Plaintiff's trademark be revoked and/ or invalidated and removed from the Register.

How the trademark infringement cases are judged in your country, and how you judge trademark infringement in the hypothetical case above, including the following points.

- What factors are taken into account in making decisions on the similarity of the Plaintiff's and the Defendant's marks?
 - a) Whether the marks may deceive or cause confusion to the public.
 - b) whether the use is likely to be associated with an earlier trademark.
 - c) Whether the use is likely to be associated with a registered trademark.
- Is the similarity regarding designated goods or services considered? If so, what factors are taken into account?
 - Yes. The factors that may be considered are the distinctiveness of the mark and whether the marks may deceive or cause confusion to the public.

How are infringement and damages theories asserted, proven, and refuted in the course of litigation? [For instance, are they respectively determined on two different stages?]

- Usually, parties will request for 2 separate proceedings which will be determined in 2 different stages i.e. liability stage and damages stage.

How damages for trademark infringement are calculated in your country

- Damages are calculated by Assessment of Damages Proceedings or by assessing an Account of Profits.

If the Plaintiff had registered the Plaintiff's Trademark but has not actually been used for the sale of construction machinery, would the decision in Q1 to Q5 be affected

- Yes. Usually, the Defendant will also file counterclaim for unlawful interference with the trade.

If this case were filed in your country, what final judgment would you expect by taking into account the Defendant's defenses available?

Please briefly explain your conclusions and reasons

- Plaintiff's claim may be dismissed and Defendant's counterclaim may be allowed.
- The reasons for such conclusion are as follows:
 - a) the Plaintiff used a mark identical with or so nearly resembling the Defendant's registered trademark as is likely to deceive or cause confusion;
 - b) the Plaintiff was using the offending mark in the course of trade;
 - c) the Plaintiff was using the offending mark in relation to goods or service within the scope of the registration

Please explain the enactment or amendment of any trademark laws in your country within the last five (5) years, including the recent legislation to be compliant with treaty obligations (e.g., the TPP Agreement).

In addition, please kindly provide information on the characteristics of the registration and use of trademarks in your country as compared to other countries.

- The Trademarks Act 2019 came into force on December 27, 2019 and has repealed the Trade Marks Act 1976.
- Malaysia has acceded to the Madrid system on September 27, 2019.
- With its accession to the Madrid Protocol, international trademark registration is now available, which provides mark owners with an opportunity to protect their marks across 121 countries (which are member states of the Madrid system) by filing one application, in one language and paying one fee.
- Mark owners who wish to register its trademark in several Classes now have the option of applying for registration of the trademark by way of a single application covering all the Classes of interest.
- Non-traditional marks such as scent, colour, shape, hologram and motion marks can now be registered.
- Criminal offences relating to trademark infringement (previously found under the Trade Descriptions Act 2011) are now consolidated and provided for under the Trademarks Act 2019.