

Japan Patent Office (JPO) Commissioned Survey

**Survey on the Appeal, Opposition, Revocation and
Invalidation Procedures Related to Patents,
Designs, and Trademarks in Malaysia**

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Intellectual Property Division

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A. INTRODUCTION

I. Scope of Survey

- 1.1 This survey report covers procedures concerning appeal, opposition, revocation, expungement, and invalidation procedures for patents, registered designs and trademarks (together referred to as, "**IP rights**") in Malaysia, including:
- (a) The main bodies that adjudicate on IP rights and their binding effect *inter se*;
 - (b) Requirements to be a judge/examiner, challenges to a judge/examiner, removal of a judge/examiner;
 - (c) The applicable actions (i.e., appeal, opposition, revocation or invalidation proceedings) and forum for commencing the actions;
 - (d) The requirements for parties;
 - (e) Time limits for commencing an action;
 - (f) Scope and reasons for commencing an action;
 - (g) Possibility of amendments to filings;
 - (h) Amendments and corrections to the scope of IP (requirements, time limits, etc.);
 - (i) Mode (oral or written) of hearings;
 - (j) Average duration from commencement of an action to a decision;
 - (k) Details on the contents of non-final and final decisions;
 - (l) Effect of decision and when it is finalised;
 - (m) Applicable forms and fees;
 - (n) Publication of decisions and method of publication;
 - (o) Flowchart of procedures;
 - (p) Relationship between types of actions (i.e., certain proceedings that can only arise within the context of other proceedings) and the possibility of a two-track dispute;
 - (q) Statistics on number of dispute cases for each IP right filed at the Malaysian Intellectual Property Office ("**MyIPO**")/court, heard by the MyIPO/court, the success rate of the cases heard by the MyIPO/court, and decisions that were appealed; and
 - (r) Representative cases and strategies to utilize the systems.

II. Method of Survey

- 2.1 We have prepared this survey report based on a desktop survey of the various IP law and regulations.

The survey was conducted by the following consultants:

- Ms.Chew Kherk Ying (Partner, Wong & Partners, a member firm of Baker McKenzie International)

- Ms Woo Wai Teng (Senior Associate, Wong & Partners, a member firm of Baker McKenzie International)
- Ms Koh Shueh Jing (Legal Assistant, Wong & Partners, a member firm of Baker McKenzie International)

The consultants also carried out desk research to gather relevant data and statistics for the relevant subjects of this Survey.

2.1.1 **Desktop survey on IP laws and regulations.** In Malaysia, IP rights are governed by the following statutes:

- (a) *Patents Act 1983 (Act 294) ("**Patents Act**") and Patents Regulations 1986 ("**Patents Regulations**")*;
- (b) *Industrial Designs Act 1996 (Act 552) ("**Industrial Designs Act**") and Industrial Designs Regulations 1999 ("**Industrial Designs Regulations**")*; and
- (c) *Trademarks Act 2019 (Act 815) ("**Trademarks Act**") and Trademarks Regulations 2019 ("**Trademarks Regulations**")*.

III. Results of Survey

3.1 The results of the survey are set out in the following chapters of this survey report:

- (a) **Chapter B: Adjudication bodies and Forum.**
- (b) **Chapter C: Patents.**
- (c) **Chapter D: Registered Designs.**
- (d) **Chapter E: Trademarks.**

B. ADJUDICATORY BODIES AND FORUM

I. Adjudicatory Bodies

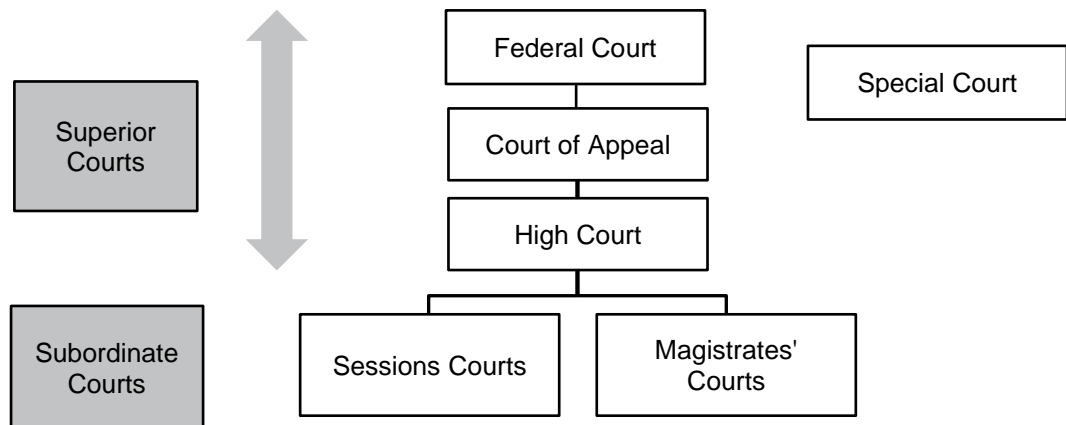
1.1 The two main bodies that adjudicate on IP rights in Malaysia are: (a) the MYIPO; and (b) the Intellectual Property Court.

1.2 The MyIPO.

1.2.1 The MyIPO is an agency under the purview of the Ministry of Domestic Trade and Consumer Affairs ("**MDTCA**"), and is responsible in the development and administration of IP rights.¹

1.2.2 MyIPO is the granting authority for all industrial property rights seeking protection in Malaysia. The Trademarks, and Designs Registries within the MYIPO are responsible for registering IP which qualifies for registration in line with provisions of the IP laws, and maintaining the Registers for each IP.²

1.3 The Malaysia Judicial System.



Flowchart B-1: Structure of the Malaysian Courts.

1.3.1 The Malaysia judicial system is comprised of two tiers which can be broadly divided into the Superior Courts and the Subordinate Courts.³ The Superior Court consists of the Federal Court, Court of Appeal, and High Court. There is a specialised Intellectual Property Court which consists of 15 Sessions Courts with criminal jurisdiction and 6 High Courts with both civil and appellate jurisdictions, designated to deal exclusively with IP disputes. It should be highlighted, however, that the judges sitting in the IP courts are not required to have legal expertise in the realms of intellectual property and therefore, there are no specialist judges or hearing officers sitting in the IP courts.

1.3.2 The Special Court does not fall within the ambit of either the Superior Courts or the Subordinate Courts. The Special Court has exclusive jurisdiction to try all criminal and civil

¹ <http://www.MyIPO.gov.my/en/about/?lang=en>

² <http://www.MyIPO.gov.my/en/about/?lang=en>

³ Section 3, *Courts of Judicature Act 1964 (Act 91)* ("**CJA**"), and Section 3(2), *Subordinate Courts Act 1948 (Act 92)*.

actions by and against the *Yang di-Pertuan Agong* or any of the Ruler of a State in his personal capacity.⁴

- 1.3.3 In general, civil cases involving claims not exceeding RM 10,000 are dealt with by the Magistrates Court. The Sessions Courts deals civil cases involving claims not exceeding RM 1,000,000⁵ with the exception of actions and suits in relation to motor vehicle accidents, landlord and tenant and distress of civil nature wherein the Sessions Court has unlimited jurisdiction.⁶ The High Court generally hear civil cases where the claims exceed RM 1,000,000.
- 1.3.4 The Federal Court is composed of the Chief Justice of the Federal Court, President of the Court of Appeal, the Chief Judges of the High Courts, and 11 other Federal Court judges⁷ which are appointed by the *Yang di-Pertuan Agong* acting on the advice of the Chief Justice of the Federal Court.⁸
- 1.3.5 The Chief Justice of the Federal Court, the President of the Court of Appeal and the Chief Judges of the High Courts are appointed by the *Yang di-Pertuan Agong*, acting on the advice of the Prime Minister upon consulting the Conference of Rulers.⁹ An individual must be a citizen and possess at least 10 years of legal practice as an advocate or as a member of the judicial and legal service of the Federation or of a State to be qualified to be appointed as a Judge of the Federal Court, Court of Appeal, or any one of the High Courts.¹⁰
- 1.3.6 All judges of the Superior Courts must retire when they attain the age of 66 or no later than 6 months after they reach the age of 66 provided that an approval has been obtained from the *Yang di-Pertuan Agong*.¹¹ Alternatively, a judge may resign at any time by writing under his hand addressed to the *Yang di-Pertuan Agong*.¹² A judge of the Superior Courts may be removed on the grounds of any breach of any provision of the code of ethics prescribed by the *Yang di-Pertuan Agong* (on the recommendation of the Chief Justice, the President of the Court of Appeal, and the Chief Judges of the High Court, and after consulting the Prime Minister), or on the grounds of inability, from infirmity of body or mind or any other cause, properly to discharge the functions of his office.¹³ Thereafter, the *Yang di-Pertuan Agong* shall appoint a tribunal of not less than five persons who hold or have held office as judge of the Federal Court, the Court of Appeal or a High Court and refer the representation to it, and may remove the judge from office on the recommendation of the tribunal.¹⁴
- 1.3.7 Proceedings in the High Court are presided by a single judge whereas proceedings in the Court of Appeal are usually heard and determined by a panel of three judges. With regards the Federal Court, potential appellants must first file an application for leave to appeal to the Federal Court. An application for leave to appeal will be heard and disposed of by a panel of three judges, while the actual appeal will be heard and determined by a panel of five judges

⁴ Article 182(2) and (3), Part XV of the Federal Constitution

⁵ Sections 65(1)(b), 73(b), and 93(1), *Subordinate Courts Act 1948 (Act 92)*.

⁶ Section 65(1)(a), *Subordinate Courts Act 1948 (Act 92)*.

⁷ <http://www.jac.gov.my/spk/en/commission/superior-court-judges.html> (as at 23 October 2020)

⁸ Article 122(1) and (IA), Part IX of the Federal Constitution.

⁹ Article 122B(1), Part IX of the Federal Constitution.

¹⁰ Article 123, Part IX of the Federal Constitution.

¹¹ Article 125(1), Part IX of the Federal Constitution.

¹² Article 125(2), Part IX of the Federal Constitution.

¹³ Article 125(3), Part IX of the Federal Constitution.

¹⁴ Article 125(3) and (4), Part IX of the Federal Constitution.

II. Forums

2.1 Litigation.

2.1.1 Presently, IP disputes may be commenced at the High Court, and may be heard in the High Court, Court of Appeal, and the Federal Court, depending on the nature of the IP right, the type of proceeding or the value of the claim. An overview of the appropriate forum to commence an action for each IP right is set out in the table below.

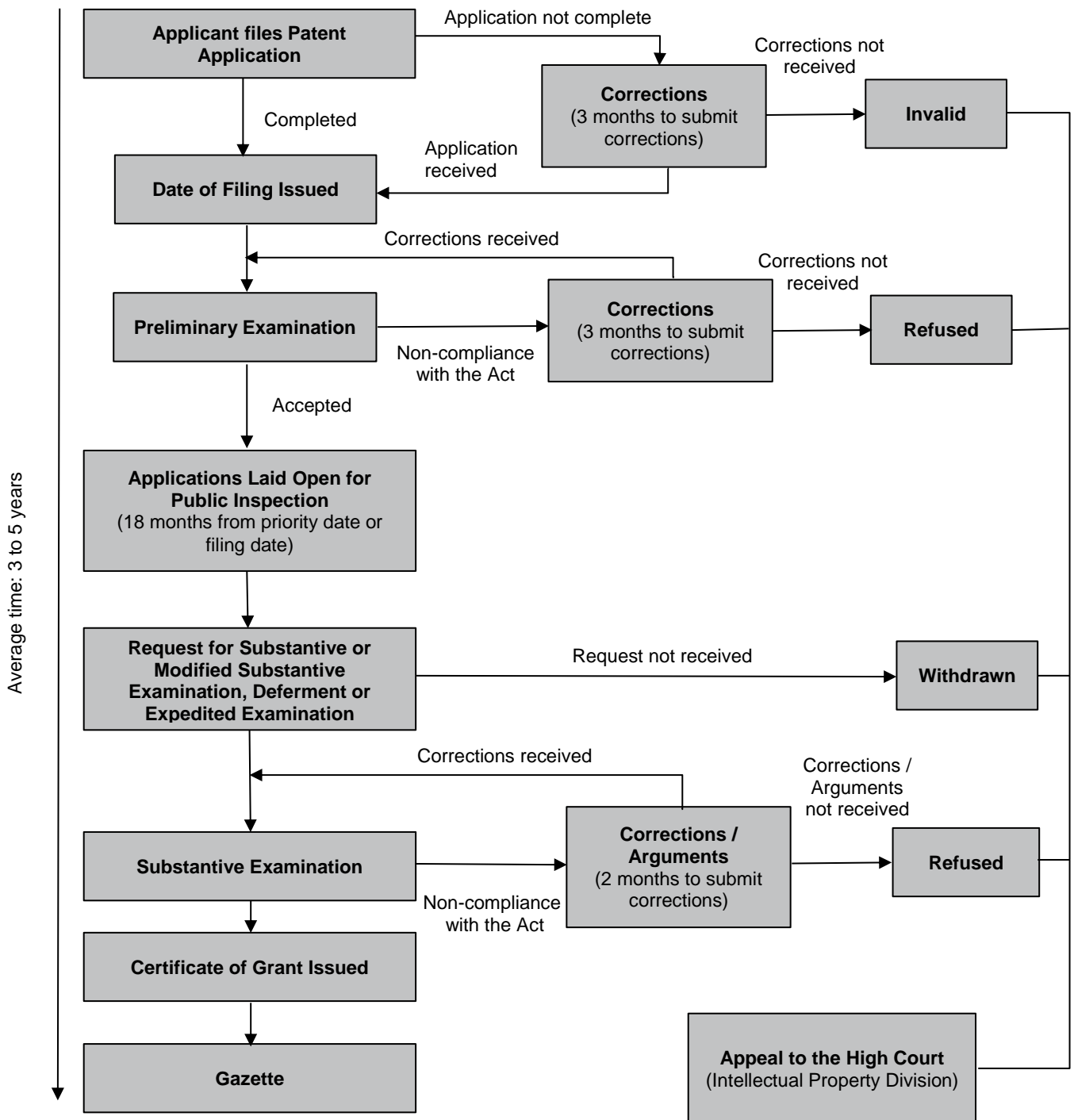
IP Right	Opposition	Invalidation	Revocation	Infringement
Patents	N/A	High Court	N/A	High Court
Designs	N/A	N/A	MyIPO / High Court	High Court
Trademarks	MyIPO	High Court	MYIPO / High Court	High Court

2.2. Alternative Dispute Resolution.

2.2.1 Beyond litigation, parties can consider alternative dispute resolution to settle their IP disputes, using institutions such as the Asian International Arbitration Centre (AIAC) which deals with all types of disputes, including IP disputes. These are alternatives to the adjudication framework described at 1.2 and 1.3

C. PATENTS

I. Overview of the Patent Application Process



Flowchart C-1: Overview of the Patent Application Process

II. Processing of a Patent Application

2.1 **Preliminary Examination.** At this stage, the application is examined for formalities compliance. If the formalities are in order, a Clear Formalities Report is issued. However, if there are deficiencies

in the documentation, an adverse report will be issued and the applicant is allowed a period of three months from the date of mailing of the notification to make any observation on such finding and to amend the application so as to comply with those requirements,¹⁵ otherwise, the application is refused.¹⁶

- 2.2 **Applications Laid Open for Public Inspection.** Once the Registrar is satisfied that the formality requirements are met, the application will be made available for public inspection after eighteen months from the filing date of the application or its priority date, unless the application has been withdrawn earlier or the application contains information which contravenes public order or morality. MyIPO does not publish the application in printed form. The details of the application will be made available for public inspection and a copy of the patent specification with any amendments may be requested from MyIPO with payment of prescribed fee.
- 2.3 **Substantive Examination.** Within 18 months from the filing date of the patent application, the applicant is required to request one of the three Substantive Examinations options (i.e. Modified Substantive Examination, Normal Substantive Examination or Deferred Substantive Examination) by filing Form 5 together with the prescribed fee of RM 950 (if the form is filed online) or RM 1,100 (if the form is filed manually).¹⁷ This 18-month period is absolute and non-extendible, and a failure to make a request for a substantive examination within this period will mean that the application will be deemed withdrawn, and reinstatement will not be possible. For national phase applications in Malaysia, the Applicant is required to file the request for Substantive Examination within four years from the international filing date of the Patent Cooperation Treaty (PCT) application.
- 2.4 **Divisional Applications.** The Applicant has the option to divide the application into two or more applications within a prescribed time.¹⁸ During the substantive examination stage, the Applicant may file divisional application(s) pursuant to an objection made by the Examiner in his examination report during prosecution. The divisional application(s) shall be filed within three months from the date of mailing of the examination report.¹⁹ The Applicant may also voluntarily file divisional application(s) no later than three months from the date of mailing of the first examination report.
- 2.5 **Certificate of Grant issued and Grant Advertised in Gazette.** Upon a successful examination, the patent will be granted and the Registrar will issue the Certificate of Grant and a copy of the patent together with a copy of the Examiner's final report,²⁰ and record the patent in the Register.²¹ Thereafter, the patent particulars and abstract will be advertised in the Government Gazette. Copies of the full patent specification as granted are made available to the public after grant.
- 2.6 **Notification of Refusal of Application** If the Examiner refuses an application or there is no response from the Applicant within the timeline stipulated in the Act or Regulations, the Registrar shall issue a written notification to the applicant of his decision and shall state the reasons therefor.²²
- 2.7 **Applicant files an appeal to High Court.** An Applicant may contest the Registrar's decision the High Court by filing an Originating Summons supported by an affidavit within one month from the date of issuance of the notification of refusal.

¹⁵ Regulation 26(2), *Patents Regulations*.

¹⁶ Section 29(2), *Patents Act*.

¹⁷ Regulation 27(1), *Patents Regulations*.

¹⁸ Section 26B, *Patents Act*.

¹⁹ Regulation 19A(a), *Patents Regulations*.

²⁰ Section 31(2)(a), *Patents Act*.

²¹ Section 31(2)(b), *Patents Act*.

²² Regulation 28, *Patents Regulations*.

- 2.8 **Effect of decision.** Unless the applicant appeals against the Registrar's decision to the High Court, the Registrar's decision will be final.
- 2.9 **Extensions of time.** Unless otherwise expressly directed by the Court, parties may request for extensions of time specified before or after the expiration of the specified time, but such extension may only be granted once and no subsequent extension will be allowed.²³ Under the current practice, the term for responding to a substantive examination adverse report may be extended only once and up to a maximum of six months, with the payment of prescribed fees. The Registrar has discretion to grant or refuse the request for extension. The Registrar may grant such requests upon receipt of Form 21 accompanied by the prescribed fee (RM 290 if the form is filed manually and RM 260 if the form is filed online).²⁴
- 2.10 **Publication of non-final and final decisions.** All decisions by the Registry are usually issued in the English language, but Applicants may also receive decisions in the Malay language for certain applications. The Registry's decisions will be made to the Applicants in writing. Selected documents relating to the Registry's decision may be made available to the public upon request and payment of prescribed fees. Reported judgements issued by the High Court, Court of Appeal, and Federal Court are published in the Official Portal of the Office of the Chief Registrar Federal Court Of Malaysia (<http://www.kehakiman.gov.my/en>), the Malayan Law Journal, and CLJ Legal Network (one of Malaysia's legal online platform for decisions and judgments in Malaysia (see: <http://www.cljlaw.com>)).

III. Opposition Proceedings

- 3.1 There are no formal provisions for either a pre-grant and/or post-grant patent opposition procedure. Any opposition or challenges to the grant of a patent must be filed before the Malaysian High Court.

IV. Invalidation Proceedings

- 4.1 **Grounds for Invalidation.** Section 56(2) of the *Patents Act* provides that an aggrieved person may initiate civil proceedings against the patent owner for the invalidation of a patent on the following grounds:
- (a) the invention as claimed in the patent is not an invention within the definition of the *Patents Act*;
 - (b) the invention is not patentable;
 - (c) the invention is excluded from protection;
 - (d) the performance of the invention would be contrary to public order or morality;
 - (e) the description or the claims do not comply with the Patents Regulations;
 - (f) any drawings which are necessary for the understanding of the claimed invention have not been supplied;

²³ Section 30(4), *Patents Act*.

²⁴ Regulation 53, *Patents Regulations*.

- (g) the right to the patent does not belong to the person to whom the patent was granted; or
- (h) incomplete or incorrect information has been deliberately provided or caused to be provided in relation to the request for substantive examination.

- 4.2 **Eligible Persons.** Any aggrieved person may institute Court proceedings against the owner of the patent for the invalidation of the patent.²⁵
- 4.3 **Procedure for Invalidation of a Granted Patent.** There are no procedures to challenge the validity of a patent at the MyIPO after it has been granted. Any challenges to the grant of a patent would have to be filed before the High Court. An overview of the procedural steps to invalidate a granted patent is set out above (see **Chapter B: Adjudicatory Bodies and Forum, Section II: Forum, paragraph 2.1**).
- 4.4 **Timeline.** The invalidation proceeding at the High Court will usually take between ten to eighteen months from filing of the claim to the delivery of the court's decision. An appeal of the trial court's decision to the Court of Appeal may take another one to two years, and a further appeal to the Federal Court may take an additional one to two years.
- 4.5 **Effect of decision.** If the grounds for the invalidation are proven, the Court will grant an order declaring the patent or the claims or parts thereof, as the case may be, as invalid.²⁶ Pursuant to Section 57 of the *Patents Act*, when the decision of the Court becomes final, the declaration of invalidity will then be recorded in the Register of Patents and also published in the Government Gazette.²⁷ Any invalidated patent or claim or part thereof will be regarded as null and void from the date of grant of the patent.²⁸
- 4.6 **Publication of decisions.** Reported judgements issued by the High Court, Court of Appeal, and Federal Court are published in the Official Portal of the Office of the Chief Registrar Federal Court Of Malaysia (<http://www.kehakiman.gov.my/en>), the Malayan Law Journal, and CLJ Legal Network (one of Malaysia's legal online platform for decisions and judgments in Malaysia (see: <http://www.cljlaw.com>)).

V. Other Procedures to Challenge the Patentability of a Patent / Invention Before and After Grant

5.1 Pre-Grant Third Party Observations.

- 5.1.1 Presently, there are no formal procedures under the *Patents Act* or *Patents Regulations* for submitting pre-grant third party observations or oppositions. Nevertheless, in practice, it is possible for a third party to informally notify the Examiner in writing with reasons why a particular pending patent should not be granted. While there is no obligation on the part of the Examiner to consider the materials forwarded by the third party, such information will likely receive the attention of the Examiner, which the Examiner may rely on at his discretion.

5.2 Post-Grant Patent Re-examination.

²⁵ Section 56(1), *Patents Act*.

²⁶ Section 56(3), *Patents Act*.

²⁷ Section 57(2), *Patents Act*.

²⁸ Section 57(1), *Patents Act*.

5.2.1 Presently, the only recourse for persons to challenge the patentability of an invention is to commence invalidation proceedings (see **Section IV: Invalidation Proceedings**). There is no available procedure that allows for a person to request for patent to be re-examined after grant.

VI. Statistics

6.1 MyIPO Statistics.²⁹

6.1.1 **Filings.** Patent applications filed with MyIPO and granted between years 2010 to Sep 2020:

	2010	2011	2012	2013	2014	2015	2016	2017	2018	2019	2020 (as of Sept)
Application	6,464	6,559	7,027	7,350	7,760	7,907	7,395	7,278	7,493	7,743	4,957
Granted	2,177	2,392	2,501	2,691	2,762	2,908	3,353	5,127	4,382	4,213	4,903

6.1.2 **Court Statistics.** The Malaysian courts do not publish official statistics about the patent dispute hearings before the courts.

VII. Case study

7.1 *Merck Sharp Dohme Group & Anor. v Hovid Bhd [2019] 9 CLJ 1*

7.1.1 In a recent decision, *Merck Sharp Dohme Group & Anor. v Hovid Bhd [2019] 9 CLJ 1*, the Federal Court considered whether the adjudication of an independent claim as invalid would automatically render the claims which were depend on the independent claim invalid, without the need for the court to consider the validity of each and every dependent claim(s) separately.

7.1.2 **Significance.** The Federal Court has reversed its earlier judgement in *SKB Shutters Manufacturing Sdn Bhd v Seng Kong Shutter Industries Sdn Bhd & Anor ("SKB Shutters")*. The legal position expounded in *SKB Shutters* is that in the event an independent claim is invalidated, all other claims would consequently be invalidated, without a need for further evidence to be adduced individually to invalidate each or them; nor was there a requirement for the court to consider the validity of each claim. It must be emphasized that while the Federal Court is vested with the authority to depart from its earlier decision, in practice, this power is used sparingly and hence, it is rare for the Federal Court to overrule its earlier authority.

7.1.3 **Facts.** The Appellant patent proprietor and its local licensee (Plaintiffs) commenced a patent infringement proceeding alleging that the Respondent (Defendant) had infringed the 194 Patent. In response, the Respondent denied the alleged infringement and

²⁹ The data is obtained from MyIPO published statistics set out in Annex A.

counterclaimed for a declaration that the 194 Patent was invalid. The High Court dismissed the Plaintiffs' infringement claim and allowed the Defendant's counterclaim on the grounds that the patent in question is invalid as it is not inventive. On appeal to the Court of Appeal by the Plaintiffs, the Court of Appeal affirmed the High Court's decision.

7.1.4 **Finding.** The majority in the Federal Court laid down the following principles:

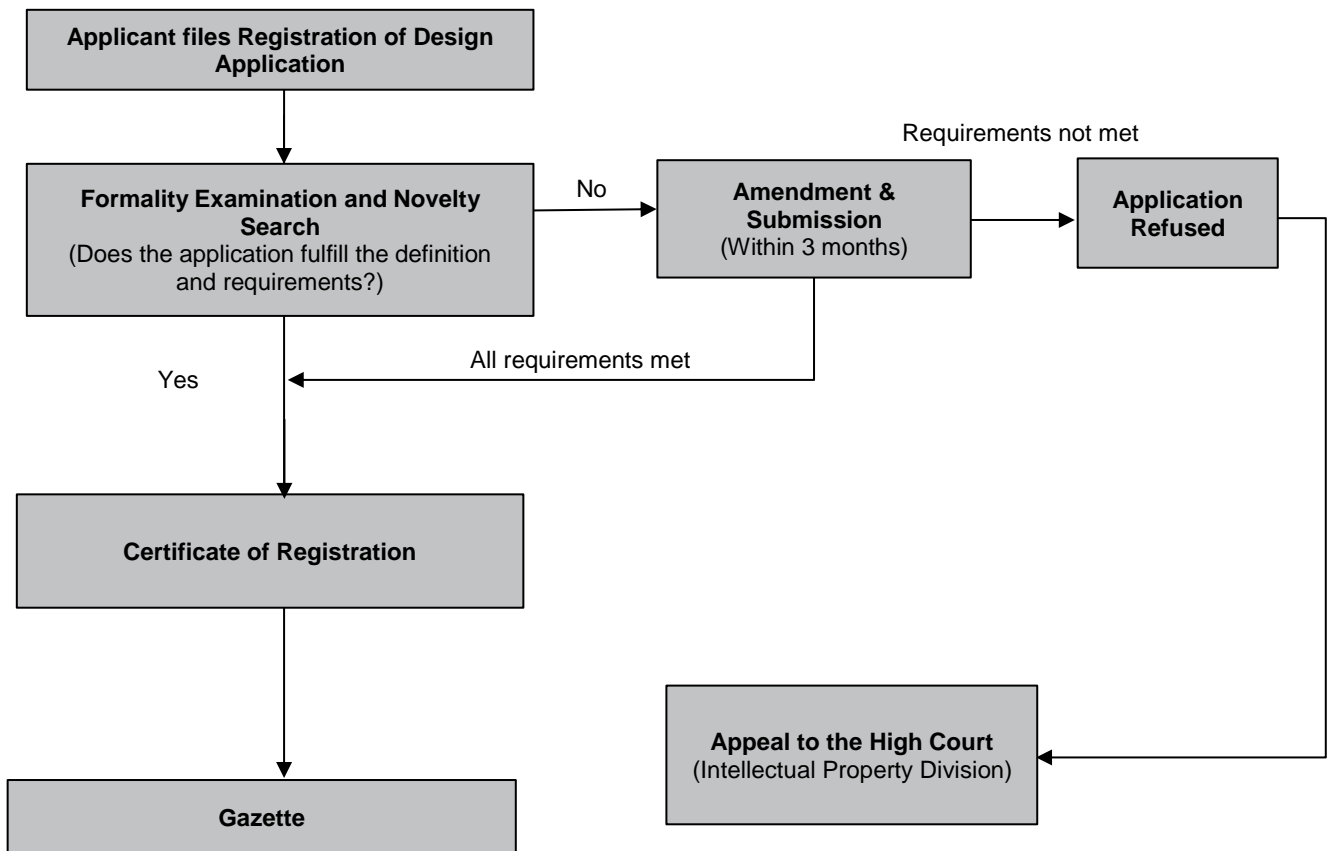
- (a) In determining the validity of a patent, it is essential for the courts to evidentially assess each claim separately (whether independent or dependent claim).
- (b) The validity of the dependent claims is contingent upon the form of claim used - i.e. whether they are completely interdependent claims ('Type 1') or claims with additional features ('Type 2') - and the basis of challenge to their validity. A trial court ought to undertake the evidential process of examining each claim separately to consider the validity of the dependent claims on the basis of merit on each of these claims against the patentability requirements under the Patents Act and to ascertain the type of claim before it or it may well overlook any features that could render such a claim independently valid.
- (c) Further, Section 79A(3) of the *Patents Act* must be read together with Sections 56(3) and 57(2). In essence, amendments *per se* are not prohibited by the Act; in the event of a partial invalidity, applicants may amend a dependent claim after court proceedings.

Accordingly, the case was remitted to the High Court for an assessment on whether each of the dependent claims possessed independent validity.

7.1.5 **Comments.** The invalidation of an independent claim does not necessarily lead to an automatic failure or invalidation of the dependent claims which make reference to the independent claim in question.

D. REGISTERED DESIGNS

I. Overview of the Design Application Process



Flowchart D-1: Overview of the Design Application Process.

II. Processing of a Design Registration Application

2.1 Examination process.

2.1.1 **Formality Examination and Novelty Search.** Design applications are only subject to formality examination and novelty search. Substantive examination is not a requirement for design applications, though in practice, they may be raised by examiners occasionally. During the formality examination and novelty search, the design examiner may notify the applicant in writing of objections raised on the formality and novelty requirements, and allow the applicant an opportunity to make observations on such findings and amend the application within three months from the date of the notification³⁰.

2.1.2 **Applicant responds to the Written Notice within 3 months.** The applicant can respond to the written notice within 3 months from the date of the notice by:

- (a) Making observations on such finding; and

³⁰ Regulation 19(2), *Industrial Designs Regulations*.

- (b) Amend the application so as to comply with the formal requirements.³¹

If the amended application is deemed to be in compliance with the formal requirements, it will proceed to issuance of Registration Certificate and thereafter published in the Gazette.

2.1.3 **Registry issues the Registration Certificate or Notification that the Application is Refused.** The Registry is obliged to provide a written notification to the applicant on his decision to accept or refuse the application or, in the case of a multiple application, to exclude the particular design which has not complied with the requirements.³²

- (a) If the formality requirements are met, the Registry will issue the certificate of registration and the design will be published in the gazette.³³ The registration certificate shall be prima facie evidence of the validity of the registration and the facts stated therein.³⁴
- (b) If any of the formality requirements are not met, the Registry will issue a written notification informing the applicant that the designs application has been refused. The written notification will include a brief summary of the grounds of refusal.

2.1.4 **Appeal to the High Court.** If the applicant wishes to contest the notification of refusal of registration, an appeal may be made to the High Court.³⁵

2.2 **Effect of Decision.** Unless the applicant appeals the Registry's decision to the High Court, the Registry's decision will be final. A registered design is given an initial protection period of five years from the date of filing,³⁶ and can be extended for a further four consecutive terms of 5 years each.³⁷ The maximum protection period in total is 25 years.

2.3 **Publication of Decisions.** All decisions issued by the Registry are issued in the Malay language. Whilst the Registry's decisions will be made to the applicants in writing, they will not be published to the public. Reported judgements issued by the High Court, Court of Appeal, and Federal Court are published in the Official Portal of the Office of the Chief Registrar Federal Court Of Malaysia (<http://www.kehakiman.gov.my/en>), the Malayan Law Journal, and CLJ Legal Network (one of Malaysia's legal online platform for decisions and judgments in Malaysia (see: <http://www.cljlaw.com>)).

III. Opposition Proceedings

3.1 The *Industrial Designs Act 1996* does not provide any provision for opposition proceedings.

IV. Revocation Proceedings

4.1 **Grounds for Revocation.** Section 27 of the *Industrial Designs Act* sets out the grounds upon which a registered design may be revoked:

³¹ Section 25(2), *Industrial Designs Act*.

³² Regulation 19(4), *Industrial Designs Regulations*.

³³ Section 22(1), *Industrial Designs Act*.

³⁴ Section 22(3), *Industrial Designs Act*.

³⁵ Section 46, *Industrial Designs Act*.

³⁶ Section 25(1), *Industrial Designs Act*.

³⁷ Section 25(2), *Industrial Designs Act*.

- (a) the design has been disclosed to the public prior to the priority date of the application for registration of the design;³⁸ or
- (b) the registration of the design has been procured by unlawful means;³⁹ or
- (c) for the grant of a compulsory license on the ground that the industrial design is not applied in Malaysia by any industrial process or means to the article in respect of which it is registered, to such an extent as is reasonable in the circumstances of the case⁴⁰

and the Court is entitled to make such order on the application as it considers just.

4.2 **Eligible Persons.** Any person may apply to revoke a registered design by filing an application for revocation to the Court.⁴¹ The owner of a registered design may also request the Registrar for the revocation of a registered design of which he is the owner to.⁴²

4.3 **Procedure for Revoking a Registered Design.** Procedures for revoking a registered design will differ depending on the relationship of the applicant of the revocation vis-à-vis the design in question.

4.3.1 **Revocation by the Owner**

An application for the revocation of a registered design by the owner of the design in question may be made to the Registrar. A revocation request made to the Registrar shall be made on ID Form 6 accompanied with the prescribed fee (RM 600 if the form is filed manually and RM 580 if the form is filed online)⁴³ and a full statement of the applicant's interest on which he intends to rely upon.⁴⁴

4.3.2 **Revocation by a Third Party**

A revocation application must be made to the Court by Originating Summons. A copy of the application and the ID Form 7 must be given to the Registrar by filing it at the MyIPO.⁴⁵ Upon receipt of ID Form 7, the Registrar will halt any action on the registered design until a decision has been made by the Court. Where an order is made by the Court, the applicant must file an office copy of the order with the Registrar. If an order for the revocation of a registered design is granted, the Registrar will process the Court order and published the revocation notice on the next publication of the Gazette.

4.4 **Effect of decision.** If an order for the revocation of a registered design is granted by the Court, the Court may exercise its discretion and revoke the registration of the registered design with effect from the priority date of the design, the date of the oral decision,⁴⁶ or any other date it considers just.⁴⁷

³⁸ Section 27(1)(a), *Industrial Designs Act*.

³⁹ Section 27(1)(b), *Industrial Designs Act*.

⁴⁰ Section 27(1)(c), *Industrial Designs Act*.

⁴¹ Section 27(1), *Industrial Designs Act*.

⁴² Section 27(2), *Industrial Designs Act*.

⁴³ Regulation 3 and First Schedule, *Industrial Designs Regulations*.

⁴⁴ Regulation 27(1), *Industrial Designs Regulations*.

⁴⁵ Regulation 28, *Industrial Designs Regulations*.

⁴⁶ *So Yin Yit & Anor v Choong Hon Ken & Anor* [2018] 1 LNS 1382, at paragraphs [59]-[61]

⁴⁷ Section 27(1), *Industrial Designs Act*.

V. Rectification of the Register

5.1 **Grounds for Rectification.** Section 24 of the *Industrial Designs Act 1996* sets out the grounds upon which a registered design may be rectified:

- (a) the entry was made in the Register without sufficient cause;⁴⁸
- (b) the entry is wrongfully remaining in the Register,⁴⁹ e.g. where it is contrary to public order or morality⁵⁰;
- (c) there is an element of fraud in the registration, assignment or transmission of a registered design;⁵¹ or
- (d) it is in the interest of the public to do so.⁵²

5.2 **Eligible Persons.** Any aggrieved or interested person may apply to rectify a registered design by filing an application to the Court.⁵³ The Registrar may make an application to the Court in cases involving fraud in the registration, assignment or transmission of a registered industrial design or if, in his opinion, it is in the public interest to do so.⁵⁴

5.3 **Procedure for Rectifying a Registered Design.** Procedures for rectification of a registered design will differ depending on the grounds on which the action is based upon.

5.3.1 **Rectification at the MyIPO.**

An application for the rectification of a registered design on the grounds stipulated in paragraph 5.1 above may be made in the first instance to the Registrar, provided that the Registrar himself is not the applicant of the rectification action.⁵⁵ Further, the Registrar is vested with the power to refer any rectification application to the Court at any time or determine the question between the applicant and the owner of the registered design after hearing both parties.⁵⁶ An overview of the procedural steps and timelines for the rectification of a registered design before the Registrar is set out below.

⁴⁸ Section 24(1)(a), *Industrial Designs Act*.

⁴⁹ Section 13, *Industrial Designs Act*.

⁵⁰ Section 13, *Industrial Designs Act*.

⁵¹ Section 24(1)(c), *Industrial Designs Act*.

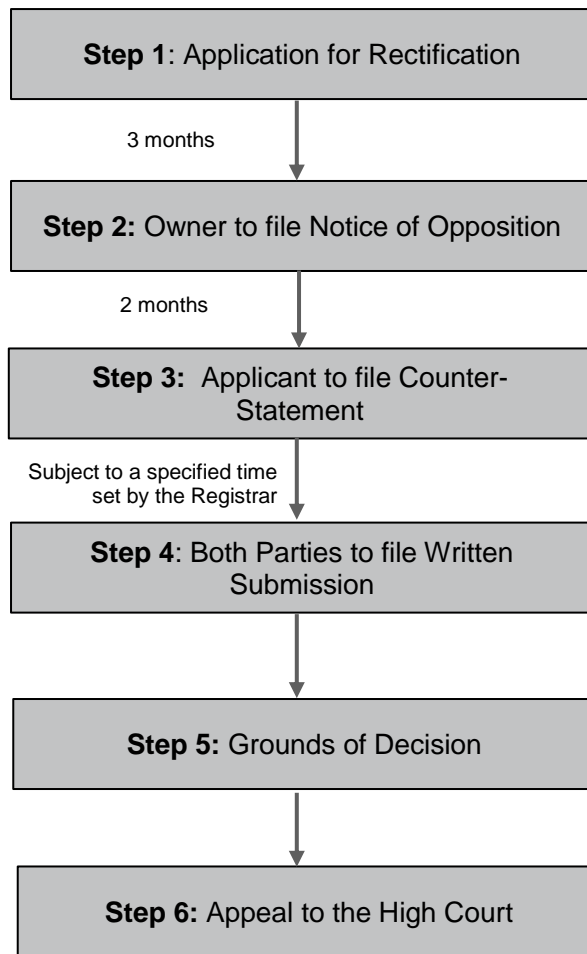
⁵² Section 24(1)(c), *Industrial Designs Act*.

⁵³ Section 24(1)(a), *Industrial Designs Act*.

⁵⁴ Section 24(1)(c), *Industrial Designs Act*.

⁵⁵ Section 24(3), *Industrial Designs Act*.

⁵⁶ Section 24(4), *Industrial Designs Act*.



Flowchart D-2: Overview of the procedural steps and timelines for expunging a registered design.

5.3.1.1 **Step 1: Application for Rectification.** An application shall be made to the Registrar on ID Form 6 accompanied with the prescribed fee (RM 600 if the form is filed manually and RM 580 if the form is filed online)⁵⁷ and a full statement of the applicant's interest on which he intends to rely upon.⁵⁸ A copy of the aforementioned form and statement must be served on the owner of the registration.⁵⁹

5.3.1.2 **Step 2: Owner to file Notice of Opposition.** The owner must, within 3 months from the date of receipt of the application for rectification of registration, file a Notice of Opposition which shall include a statement of the grounds he objects to. A copy of the same must be served on the applicant.⁶⁰ All facts raised in the application for rectification will be deemed accepted if the owner does not file a Notice of Opposition.⁶¹

5.3.1.3 **Step 3: Applicant to file Counter-Statement.** Within 2 months from the date of receipt of the Notice of Opposition, the applicant must file a Counter-Statement enumerating the grounds on which he replies upon to support his application and the facts alleged in the Notice of Opposition which he admits (if applicable), and

⁵⁷ Regulation 3 and First Schedule, *Industrial Designs Regulations*.

⁵⁸ Regulation 27(1), *Industrial Designs Regulations*.

⁵⁹ Regulation 27(2), *Industrial Designs Regulations*.

⁶⁰ Regulation 27(3), *Industrial Designs Regulations*.

⁶¹ Regulation 27(4), *Industrial Designs Regulations*.

serve the owner with a copy of the same at the same time.⁶² The application shall be deemed to be abandoned if the applicant fails to do so.⁶³

5.3.1.4 **Step 4: Both Parties to file Written Submission.** Both the applicant and the owner will be given an opportunity to be heard by filing in their respective written submissions within a specified time imposed by the Registrar.⁶⁴

5.3.1.5 **Step 5: Grounds of Decision.** The Registrar will issue his written decision upon reviewing the written submissions filed the parties.

5.3.1.6 **Step 6: Appeals to High Court.** Should a party wish to appeal against the Registrar's decision, an appeal may be made to the High Court.

5.3.1.7 **Extension of Time.** Unless otherwise expressly directed by the Court, parties may request for extensions of time specified in paragraphs 5.3.1.1 to 5.3.1.4 above before or after the expiration of the specified time.⁶⁵ The Registrar may grant such requests upon receipt of the ID Form 13 accompanied by the prescribed fee (RM 300 if the form is filed manually and RM 280 if the form is filed online).⁶⁶

5.3.1.8 **Publication of decisions.** Whilst the Registry's decisions will be made to the applicants in writing, they will not be published to the public.

5.3.2 **Rectification at the IP Court**

Generally, an application should be made to the Court by Originating Summons. A copy of the application and the ID Form 7 must be given to the Registrar by filing it at the MyIPO.⁶⁷ Where an order is made by the Court, the applicant must file an office copy of the order with the Registrar. If a rectification of the Register is required, in addition to an office copy of the order, the applicant must file ID Form 8 and the prescribed fee (RM 200 if the form is filed manually and RM 180 if the form is filed online).⁶⁸

⁶² Regulation 27(5), *Industrial Designs Regulations*.

⁶³ Regulation 27(6), *Industrial Designs Regulations*.

⁶⁴ Regulation 27(7), *Industrial Designs Regulations*.

⁶⁵ Section 43, *Industrial Designs Act*.

⁶⁶ Section 27(1)(a), *Industrial Designs Act* and Regulation 43, *Industrial Designs Regulations*.

⁶⁷ Regulation 28, *Industrial Designs Regulations*.

⁶⁸ Regulation 29, *Industrial Designs Regulations*.

VI. Statistics

6.1 MyIPO Statistics.⁶⁹

6.1.1 **Filings.** Design applications filed with MyIPO and registrations granted between years 2010 to Sep 2020:

Type / Year	2010	2011	2012	2013	2014	2015	2016	2017	2018	2019	2020 (as of Sept)
Application	1,677	1,871	2,082	2,053	1,882	1,762	1,630	1,814	1,845	1,904	1,213
Registration	1,598	1,641	1,924	2,001	1,891	1,301	1,900	1,379	1,475	1,238	916

6.1.2 **Design disputes.** The MyIPO does not publish official statistics about design disputes decided by MyIPO.

6.2 **Court Statistics.** The Malaysian courts do not publish official statistics about the design dispute hearings before the courts.

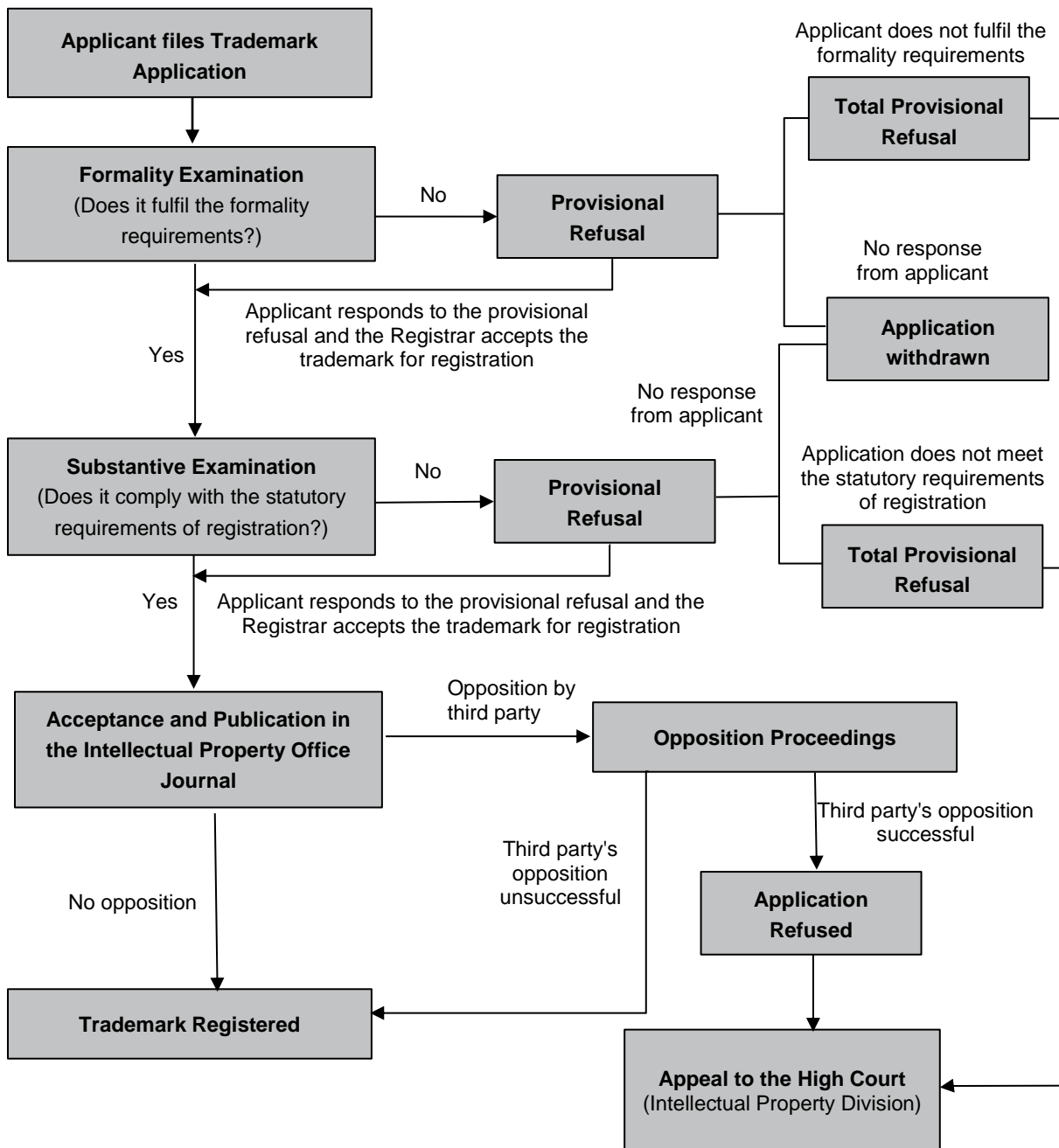
VII. Case Study

There have been no recent Malaysian cases reported in relation to revocation proceedings brought under the *Industrial Designs Act 1996*.

⁶⁹ The data is obtained from MyIPO published statistics set out in Annex A.

E. TRADEMARKS

I. Overview of the Trademark Application Process



Flowchart E-1: Overview of the Trademark Application Process.

II. Processing of a Trademark Application

2.1 Examination process.

2.1.1 **Applicant Responds to Provisional Refusal.** During the examination process, if the application does not fulfil the formality or substantive requirements for registration of a trademark, the Registrar shall inform the applicant the grounds of provisional refusal by a

written notice. The applicant shall be allowed the opportunity to respond to the provisional refusal by:-

- (a) making representations either in writing, or by applying to the Registrar for a hearing by filing form TMC1 with the payment of RM 150 (per class);
- (b) amending the application so as to meet the conditions, amendments, modifications or limitations imposed or directed by the Registrar; or
- (c) furnishing additional or any other information or evidence by way of statutory declaration and/or orally.⁷⁰

2.1.2 **Registry Accepts Application for Publication or Issues a Decision Refusing the Application.**

- (a) If the Registrar is satisfied that the application fulfils the requirements for registration, the Registrar may accept the application, whether absolutely or subject to conditions, amendments, modifications or limitations⁷¹, and thereafter publish the application in the Intellectual Property Office Journal.⁷² The Registrar may issue a written notification of the publication to the applicant.⁷³
- (b) If the Registrar maintains the objections raised, such refusal shall be a total provisional refusal. The total provisional refusal must be notified to the applicant in writing.⁷⁴ The applicant can request for the written grounds of decision by filing Form TMC3/ TMC4 together with a payment of RM 1,000 within two months (non-extendible)⁷⁵ from the date of the Registry's decision.⁷⁶

2.1.3 **Applicant files an appeal to High Court.** An applicant can contest the Registry's grounds of decision by filing an appeal with the High Court within one month from the date of the decision.⁷⁷ Subject to the Registrar's approval and the payment of the prescribed fee of RM 100 (per month), an extension may be obtained for a period not extending two months.⁷⁸

2.2 **Effect of Decision.** Unless the applicant appeals the Registry's decision to the High Court, the Registry's decision will be final.

2.3 **Publication of Decisions.** All decisions issued by the Registry are issued in the English language. Whilst the Registry's decisions will be made to the applicants in writing, they will not be published to the public.

III. **Opposition Proceedings**

3.1 **Grounds for opposition.** Section 34 of the *Trademarks Act* set out the grounds upon which a trademark application which has been accepted for registration by the Registrar of Trademarks and published may be opposed, which include grounds for refusal of registration as set out under Sections 23 and 24 of the *Trademarks Act*.

⁷⁰ Regulation 17(1), *Trademarks Regulations*.

⁷¹ Regulation 18(1), *Trademarks Regulations*.

⁷² Section 31, *Trademarks Act*.

⁷³ Regulation 18(2), *Trademarks Regulations*.

⁷⁴ Regulation 17(5), *Trademarks Regulations*.

⁷⁵ Regulation 17(7), *Trademarks Regulations*.

⁷⁶ Regulation 17(6), *Trademarks Regulations*.

⁷⁷ Regulation 17(9), *Trademarks Regulations*.

⁷⁸ Regulation 17(10), *Trademarks Regulations*.

3.1.1 Section 23: Absolute Grounds for Refusal of Registration.

3.1.1.1 Trademarks that fall under one or more of the following circumstances:

- (a) signs not capable of being represented graphically and not capable of distinguishing goods or services of one undertaking from another;
- (b) devoid of any distinctive character;
- (c) descriptive of the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services;
- (d) generic (common in trade);
- (e) sign consists exclusively of the shape which results from the nature of the good, the shape which is necessary to obtain a technical result, or the shape which gives substantial value to the goods;
- (f) consists exclusively of the name of a country or contains or consists of recognized geographical indications;
- (g) deceptive or likely to cause confusion;
- (h) contrary to public policy or morality; or
- (i) use is prohibited in Malaysia by law.

3.1.2 Section 24: Relative Grounds for Refusal of Registration.

3.1.2.1 Trademarks that are identical to an earlier mark⁷⁹ or likely to cause confusion to the public under the following circumstances:

No.	Application Mark	Goods/Services	Other requirements
(i)	Identical to earlier mark	Goods/Services identical	-
(ii)	Identical to earlier mark	Goods/Services similar	• There exists a likelihood of confusion on the part of the public.
(iii)	Similar to earlier mark	Goods/Services identical or similar	
(iv)	Identical or similar to a well-known trademark which is not registered	Goods/Services identical	• Third party mark is a well-known trademark in Malaysia.

⁷⁹ The following qualifies as an "earlier mark" under the *Trademarks Act*, Section 5: (i) a registered or pending trademark or an international trademark (designating Malaysia) whose date for application is earlier than that of an Application Mark (taking into account any priority claims made in respect of the trademarks). This includes pending applications, provided that the trademark is eventually registered; (ii) a registered trademark which, at the date the Application Mark was filed (taking into account any priority claims made in respect of the trademarks), is well known in Malaysia; or (iii) an unregistered trademark which, at the date the Application Mark was filed (taking into account any priority claims made in respect of the trademarks), is well known in Malaysia and the owner is from a Paris Convention or World Trade Organisation ("WTO") country or is domiciled in and has a real and effective industrial or commercial establishment in a Paris Convention or WTO country. This is regardless of whether the owner of the well-known trademark carries on business, or has any goodwill in Malaysia (see: Section 76(1) of the *Trademarks Act*).

No.	Application Mark	Goods/Services	Other requirements
(v)	Identical or similar to a well-known trademark which is registered	Goods/Services not identical and dissimilar	<ul style="list-style-type: none"> • Third party mark is a well-known trademark in Malaysia; • Use of the application mark would indicate a connection between the applicant's good/services and the proprietor of the earlier trademark; • There exists a likelihood of confusion on the part of the public; and • Such use is likely to damage the interests of the proprietor of the earlier trademark.

3.1.2.2 Trademarks will also not be registered if their use in Malaysia is liable to be prevented by virtue of any law that protects unregistered trademarks (such as the law of passing off) or by virtue of an earlier right (such as the copyright or industrial designs).⁸⁰

3.1.3 Section 34: Grounds of Opposition

3.1.3.1 Prior rights of a registered proprietor by virtue of its continuous use of a trademark before the use of the applicant's trademark or from a date before the filing of the application by the applicant;⁸¹

3.1.3.2 Any grounds under Section 23 or 24 (see: **Section III, paragraphs 3.1.1 and 3.1.2**);

3.1.3.3 The applicant is not the proprietor of the trademark; or

3.1.3.4 The opposed trademark is identical or similar to a well-known trademark would lead to the following circumstances:-

No.	Application Mark	Goods/Services	Other requirements
(i)	Identical to well-known trademark in Malaysia	Goods/Services not identical or not similar	<ul style="list-style-type: none"> • Use of the application mark would indicate a connection between the applicant's good/services and the

⁸⁰ Section 24(4), *Trademarks Act*.

⁸¹ Section 34, *Trademarks Act*.

No.	Application Mark	Goods/Services	Other requirements
(ii)	Similar to well-known trademark in Malaysia	Goods/Services not identical or not similar	<p>proprietor of the earlier trademark;</p> <ul style="list-style-type: none"> • There exists a likelihood of confusion on the part of the public; and • Such use is likely to damage the interests of the proprietor of the earlier trademark.

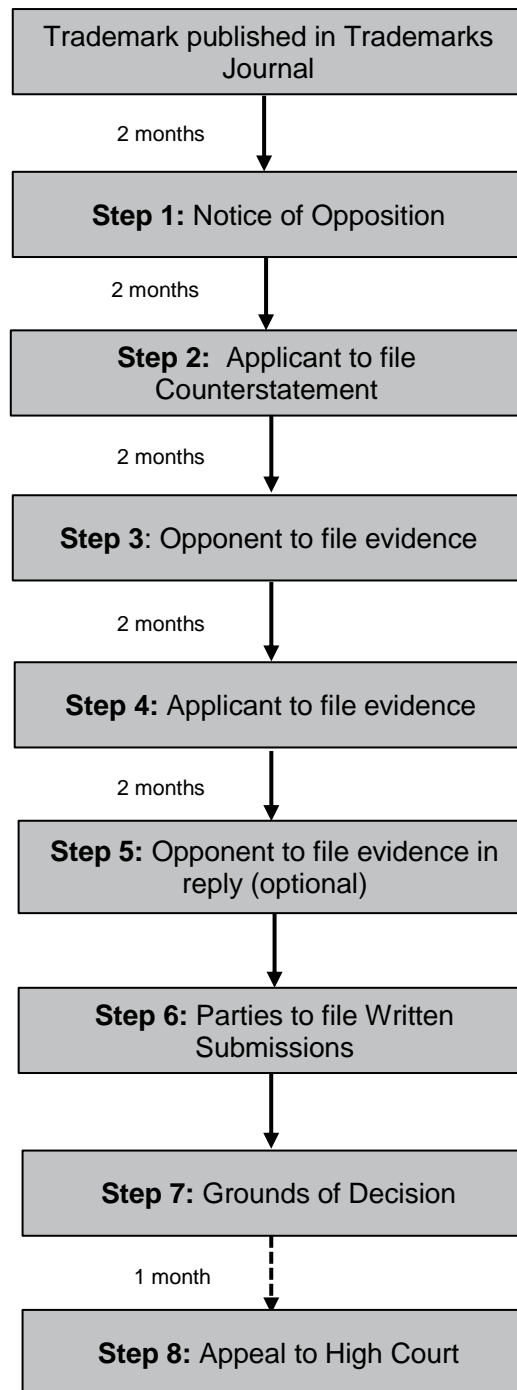
(a) This may only be raised to oppose the registration of an application for registration made on or after 27 December 2019.⁸²

3.2 **Eligible Persons.** Any person may oppose a trademark registration by commencing opposition proceedings.⁸³

3.3 **Procedure for Opposition Proceedings.** An overview of the procedural steps and timelines for opposing a trademark application for registration is set out below.

⁸² Section 34(4), *Trademarks Act*.

⁸³ Section 35(1), *Trademarks Act*.



Flowchart E-2: Overview of the procedural steps and timelines for opposing a trademark application for registration.

3.3.1 **Step 1: Notice of Opposition.** Opposition proceedings can be initiated by filing Form TMD1 (Notice of Opposition) which shall include a statement of grounds setting out the grounds specified in Section 34 upon which the opposition action is based⁸⁴ (together with payment of RM 950 in respect of each class). A copy of the same must be served on the trademark applicant at the time of filing the notice of opposition.⁸⁵

⁸⁴ Section 35(2), *Trademarks Act*.

⁸⁵ Regulation 23(8), *Trademarks Regulations*.

3.3.1.1 Under Regulation 23(4) and (5) of the *Trademarks Regulations*, if an application for opposition is made on the basis of a registered trademark or a trademark in respect of which an application of registration of the trademark has been made, the statement must include the following details: -

- (a) a representation of that trademark;
- (b) details of the authority with which the trademark is registered/ applied for;
- (c) the registration/ application number of that trademark; and
- (d) the goods or services in respect of which that trademark is registered/ applied for and the opposition is based.

3.3.1.2 Any opposition based on an unregistered trademark or other sign or by virtue of earlier rights (see: **Section III, paragraph 3.1.2.2**) must include the representation of that trademark or sign and the goods and services in respect of which protection is claimed in the statement.⁸⁶

3.3.1.3 If the opponent fails to comply with any requirement in relation to the notice of opposition, the opposition shall be deemed never to have been made.⁸⁷

3.3.1.4 The opponent must file an affidavit of service with the Registrar within fourteen days from the date of sending the copy of the notice of opposition to the applicant, where the affidavit of service shall contain the proof of the date of receipt of the notice of opposition by the applicant, failing which, the opposition shall be deemed withdrawn.⁸⁸

3.3.2 **Step 2: Applicant to File Counterstatement.** The applicant must, within 2 months from the date of receipt of the notice for opposition, file a Counterstatement in Form TMD6 with the Registrar to contest the application (together with payment of RM 350 in respect of each class).⁸⁹ A copy of the same must be served on the opponent at the time of filing the document.⁹⁰ The applicant shall file an affidavit of service with the Registrar within fourteen days from the date of sending the copy of the Counterstatement to the opponent, and the affidavit of service must contain proof of the date of receipt by the opponent, failing which, the application for registration shall be deemed withdrawn.⁹¹ The application will be deemed withdrawn if the applicant fails to file the Counterstatement within the specified period.⁹²

3.3.3 **Step 3: Opponent to File Evidence.** The opponent is required to file evidence in support of its opposition via a Statutory Declaration within 2 months from the date of receipt of the Counterstatement.⁹³ A copy of the same must be sent to the applicant at the time of filing the evidence.⁹⁴ It is imperative for the opponent to file an affidavit of service with the Registrar within fourteen days from the date of sending a copy of the evidence to the applicant, where the affidavit of service shall contain proof of the date of receipt of the

⁸⁶ Regulation 23(6), *Trademarks Regulations*.

⁸⁷ Regulation 23(7), *Trademarks Regulations*.

⁸⁸ Regulation 23(9), *Trademarks Regulations*.

⁸⁹ Regulation 24(1), *Trademarks Regulations*.

⁹⁰ Regulation 24(2), *Trademarks Regulations*.

⁹¹ Regulation 24(3), *Trademarks Regulations*.

⁹² Regulation 24(4), *Trademarks Regulations*.

⁹³ Regulation 25(1), *Trademarks Regulations*.

⁹⁴ Regulation 25(2), *Trademarks Regulations*.

evidence by the applicant.⁹⁵ If any of the aforementioned requirements are not met, the opposition shall be deemed withdrawn.⁹⁶

- 3.3.4 **Step 4: Applicant to File Evidence.** The applicant shall file evidence in support of its application via a Statutory Declaration within 2 months from the date of receipt of the opponent's evidence.⁹⁷ A copy of the same must be sent to the opponent at the time of filing the evidence.⁹⁸ It is imperative for the applicant to file an affidavit of service with the Registrar within fourteen days from the date of sending a copy of the evidence to the opponent, where the affidavit of service shall contain proof of the date of receipt of the evidence by the opponent.⁹⁹ If any of the aforementioned requirements are not met, the applicant will be deemed to have withdrawn its application for registration of the trademark.¹⁰⁰
- 3.3.5 **Step 5: Opponent to File Evidence in Reply (optional).** The opponent may, within 2 months from the date of the receipt of the applicant's evidence, file further evidence for the purpose of strictly replying to the applicant's evidence.¹⁰¹ This evidence in reply may be made by way of a Statutory Declaration, a copy of which must be sent to the applicant at the same time.¹⁰² Any further evidence can only be filed with leave from the Registrar thereafter.¹⁰³
- 3.3.6 **Step 6: Parties to file Written Submissions.** Upon completion of the filing of evidence, the Registrar shall give notice to both the opponent and applicant to submit written submissions relating to the opposition within 2 months from the date of issuance of the notice.¹⁰⁴
- 3.3.7 **Step 7: Grounds of Decision.** The Registrar will issue a written decision setting out his decision and its grounds after considering the evidence, exhibit and any written submission.¹⁰⁵
- 3.3.8 **Step 8: Appeal to High Court.** A party can contest the Registrar's decision by filing an appeal to the High Court within 1 month from the date of issuance of the decision.¹⁰⁶ Either party may apply to the Registrar for an extension of time to file an appeal in Court for a period not exceeding 2 months.¹⁰⁷ No further material for consideration or grounds of opposition shall be allowed except by leave of the Court.¹⁰⁸
- 3.4 **Extension of Time.** Parties may request for extensions of time at any point during the proceedings. The Registrar will grant such requests if it is satisfied that the circumstances are such as to justify an extension of time.¹⁰⁹ The applicant or opponent may request for an extension of time by filing form TMK1 with the payment of RM 50 (for each application), and shall explain the circumstances

⁹⁵ Regulation 25(3), *Trademarks Regulations*.

⁹⁶ Regulation 25(4), *Trademarks Regulations*.

⁹⁷ Regulation 26(1), *Trademarks Regulations*.

⁹⁸ Regulation 26(2), *Trademarks Regulations*.

⁹⁹ Regulation 26(3), *Trademarks Regulations*.

¹⁰⁰ Regulation 26(4), *Trademarks Regulations*.

¹⁰¹ Regulation 27(1) and (2), *Trademarks Regulations*.

¹⁰² Regulation 27(1), *Trademarks Regulations*.

¹⁰³ Regulation 28, *Trademarks Regulations*.

¹⁰⁴ Regulation 30, *Trademarks Regulations*.

¹⁰⁵ Section 35(8), *Trademarks Act*, and Regulation 33(1) *Trademarks Regulations*.

¹⁰⁶ Regulation 33(3), *Trademarks Regulations*.

¹⁰⁷ Regulation 33(4), *Trademarks Regulations*.

¹⁰⁸ Section 35(10)(c), *Trademarks Act*.

¹⁰⁹ Regulation 59(2), *Trademarks Regulations*.

in sufficient detail to allow the Registrar to determine if the extension is justified.¹¹⁰ The request for an extension of time may be applied for a period not exceeding 6 months.¹¹¹

- 3.5 **Effect of Decision.** The Registrar's decision will be final, unless parties choose to file an appeal against the Registrar's decision to the High Court (and file a subsequent appeal against the High Court's decision at the Court of Appeal).¹¹²
- 3.6 **Publication of Decisions.** All decisions issued by the Registrar will not be published to the public. Reported judgements issued by the High Court, Court of Appeal, and Federal Court are published in the Official Portal of the Office of the Chief Registrar Federal Court Of Malaysia (<http://www.kehakiman.gov.my/en>), the Malayan Law Journal, and CLJ Legal Network (one of Malaysia's legal online platform for decisions and judgments in Malaysia (see: <http://www.cljlaw.com>)).

IV. Revocation Proceedings

- 4.1 **Grounds for Revocation.** Sections 45 and 46 of the *Trademarks Act* lay down the grounds upon which a registered trademark may be revoked.

4.1.1 Section 45: Revocation of registration by Registrar¹¹³

4.1.1.1 The Registrar had failed to take the notice of opposition filed into account in deciding to register the trademark; or

4.1.1.2 The Registrar had failed to take the application for extension of time for filing a notice of opposition made before the registration into account in deciding to register the trademark.

4.1.2 Section 46: Revocation of registration by Court¹¹⁴

4.1.2.1 Within a period of 3 years following the date of issuance of the notification of registration, the trademark has not been used in good faith in Malaysia, and there are no proper reasons for the non-use;

4.1.2.2 The use of the trademark has been suspended for an uninterrupted period of 3 years and there are no proper reasons for non-use;

4.1.2.3 The trademark has become the common name in the trade due to acts or inactivity of the registered proprietor; or

4.1.2.4 The use of the trademark in relation to goods or services is liable to mislead the public.

- 4.2 **Eligible Persons.** A revocation by the Registrar may be initiated by an opponent to the registration of a trademark or the Registrar on their own motion. An aggrieved person may apply to revoke a registered trademark in whole or in part by filing an application for revocation to the Court.¹¹⁵

¹¹⁰ Regulation 59(1), *Trademarks Regulations*.

¹¹¹ Regulation 31(2), *Trademarks Regulations*.

¹¹² Section 35(10)(c), *Trademarks Act*.

¹¹³ Section 45(1), *Trademarks Act*.

¹¹⁴ Section 46(1), *Trademarks Act*.

¹¹⁵ Section 46(1), *Trademarks Act*.

4.3 **Procedure for Revoking a Registered Trademark.** Procedures for revoking a trademark will differ depending on whether the revocation action is commenced before the Registrar or High Court (see **Chapter B: Adjudicatory Bodies and Forum, Section II: Forum, paragraph 2.1**).

4.3.1 **Revocation of registration by Registrar**

4.3.1.1 **Procedure.** It is mandatory for the Registrar to give a notice of the proposed revocation to the registered proprietor of the trademark and any person who has a right or an interest in the trademark before the revocation of the mark. The Registrar must also allow the registered proprietor of the trademark or any person claiming a right or an interest in the trademark an opportunity to be heard, and they may apply to the Registrar for a hearing by filing Form TMC1 with the payment of RM 150 (for each class).

4.3.1.2 **Effect of Decision.** If the Registrar decides to revoke the registration of the trademark, the registration shall be deemed to have never occurred and it shall be subject to further examination or proceedings as determined by the Registrar. The High Court's decision will be final unless parties choose to file an appeal against the High Court's decision to the Court of Appeal.

4.3.2 **Revocation of registration by Court**

4.3.2.1 **Procedure.** Any person who files an application in the Court for the revocation of registration by the Court must furnish to the Registrar Form TMF3 with the payment of RM300 (for each class) along with the following particulars:-

- (a) the registration number of the subject trademark;
- (b) the goods or services affected by the application;
- (c) the name of the registered proprietor of the of the subject trademark;
- (d) the number of the writ of summons or originating summons;
- (e) the date of filing of the application in Court;
- (f) the Court of hearing;
- (g) the parties to the application; and
- (h) the cause of action of the application.¹¹⁶

4.3.2.2 **Effect of Decision.** If the Court decides to revoke the registration of the trademark, the revocation is deemed to take effect from the date of application to the Court unless the Court is satisfied that the grounds of revocation exists on an earlier date.¹¹⁷ The High Court's decision will be final unless, unless parties choose to file an appeal against the High Court's decision to the Court of Appeal.

4.4 **Publication of Decisions.** Whilst the Registry's decisions will be made to the parties in writing, they will not be published to the public. Reported judgements issued by the High Court, Court of Appeal, and Federal Court are published in the Official Portal of the Office of the Chief Registrar Federal Court Of Malaysia (<http://www.kehakiman.gov.my/en>), the Malayan Law Journal, and CLJ

¹¹⁶ Regulation 51, *Trademarks Regulations*.

¹¹⁷ Section 46(5), *Trademarks Act*.

Legal Network (one of Malaysia's legal online platform for decisions and judgments in Malaysia (see: <http://www.cljlaw.com>)).

V. Invalidation Proceedings

- 5.1 **Grounds for Invalidation.** Section 47 of the *Trademarks Act* sets out the grounds upon which a registered trademark may be invalidated:
- (a) The trademark was registered in breach of the absolute or relative grounds of refusals (see **Section III: Opposition Proceedings, paragraphs 3.1.1 and 3.1.2**); or
 - (b) There was fraud in the registration or the registration was obtained by misrepresentation.¹¹⁸
- 5.2 **Eligible Persons.** An aggrieved person may apply to invalidate a registered trademark in whole or in part by filing an application for invalidation.¹¹⁹
- 5.3 **Procedure for Invalidating a Registered Trademark.** The invalidation proceedings will follow the same procedure as revocation proceedings (see **Section IV: Revocation Proceedings, paragraph 4.3.2.1**)¹²⁰ save that the party initiating the revocation would have to file Form TMF4 with the payment of RM 300 (per class), instead of TMF3.
- 5.4 **Effect of decision.** If the registration of the trademark is declared invalid, the registration shall be deemed never to have been made. However, past and closed transactions shall not be affected. The High Court's decision will be final unless, unless parties choose to file an appeal against the High Court's decision to the Court of Appeal.
- 5.5 **Publication of decisions.** Reported judgements issued by the Malaysian courts are published in the Official Portal of the Office of the Chief Registrar Federal Court Of Malaysia (<http://www.kehakiman.gov.my/en>), the Malayan Law Journal, and CLJ Legal Network (one of Malaysia's legal online platform for decisions and judgments in Malaysia (see: <http://www.cljlaw.com>)).

VI. Statistics

6.1 MyIPO Statistics¹²¹.

- 6.1.1 **Filings.** Trademark applications filed with MyIPO and registrations granted between years 2010 to Sep 2020:

	2010	2011	2012	2013	2014	2015	2016	2017	2018	2019	2020 (as of Sept)
Applications	26,370	28,833	31,876	32,225	34,571	35,923	39,107	41,093	43,656	46,530	28,417
Registrations	14,294	23,819	26,076	26,979	27,428	28,800	32,806	33,225	34,566	19,481	20,505

¹¹⁸ Section 47(6), *Trademarks Act*.

¹¹⁹ Section 47, *Trademarks Act*.

¹²⁰ Regulation 51, *Trademarks Regulations*.

¹²¹ The data is obtained from MyIPO published statistics set out in Annex A.

6.1.2 **Trademark disputes.** The MyIPO does not publish official statistics about trademark disputes (Trademark oppositions) decided by MyIPO.

6.2 **Court Statistics.** The Malaysian courts do not publish official statistics about the trademark dispute hearings before the courts.

VII. Case Study

7.1 ***Ooi Siew Bee (trading under the name and style Sykt Perniagaan Eng Leong) & Ors v Zhu Ge Kong Ming Sdn Bhd [2020] 4 MLJ 815***

7.1.1 The decision of ***Ooi Siew Bee (trading under the name and style Sykt Perniagaan Eng Leong) & Ors v Zhu Ge Kong Ming Sdn Bhd [2020] 4 MLJ 815*** stems from an infringement action (the "**Previous Proceedings**") brought by the Respondent in this case (the "**Current Proceedings**") before the High Court.

7.1.2 **Facts of the Previous Proceedings.** The Respondent of this case (Plaintiff in the Previous Proceedings) is a Malaysian company engaged in the business of manufacturing, wholesaling and retailing Chinese prayer materials, including praying papers bearing the respondent's registered trademarks. The Appellants (Defendants in the Previous Proceedings) consist of a sole proprietor who sells, amongst others, Chinese prayer papers and prayer paper boxes, and the importer and dealer of the aforementioned prayer papers and paper boxes. The Respondent had filed an action for, amongst others, trademark infringement of the Respondent's registered trademark "還債金" (the "**Respondent's Mark**"). The High Court concluded the Respondent's Mark is, amongst others, common words in the Mandarin language and had accordingly dismissed the Respondent's claim for infringement. The Respondent appealed against the High Court's decision to the Court of Appeal, and the Court of Appeal had dismissed the Respondent's claim on the same grounds.

7.1.3 **Facts of the Current Proceedings.** Thereafter, the Appellant of this case (defendant in the Previous Proceedings) has brought a claim against the Respondent in the High Court on the grounds that the Respondent's Mark was registered in contravention of the Sections 10 and 14 of the *Trade Marks Act 1976* (the "**Old Trade Marks Act**") and ought to be revoked in accordance with Section 45 of the *Old Trade Marks Act*. The High Court has dismissed the Appellant's claim on the basis, amongst others, that the Respondent's Mark has been registered for more than 7 years and hence, Section 37 of the *Old Trade Marks Act* applies and accordingly, the Appellant cannot expunge the Respondent's Mark outside of Section 37 of the *Old Trade Marks Act*. The Appellant has hence appealed against the High Court's decision to the Court of Appeal.

7.1.4 **Issue on Appeal.** Whether the findings in the Previous Proceedings that the words "還債金" is a common word used in relation to prayer papers was caught by the doctrine of res judicata.

7.1.5 **Finding.** The Court has found that the current proceedings is estopped by the doctrine of res judicata. Therefore, this is a case for appellate intervention as it was wrong for the High Court in the current proceedings to decide on the issue on whether the Respondent's Mark is descriptive as the Court of Appeal had in the Previous Proceedings dismissed the

respondent's claim for infringement of the Respondent's Mark on the basis that the Chinese characters in the Respondent's Mark are common descriptive words in its context. As this issue has been decided by the Courts in the Previous Proceedings, the parties cannot reopen the case. To allow the parties to reopen the matter would risk conflicting decision on the issue, which is what the doctrine of *res judicata* aims to prevent. Accordingly, the judgment in the Previous Proceedings is upheld, and the appeal is allowed so that the Respondent's Mark can be rectified and expunged.

- 7.1.6 **Comments.** While this case is premised on the *Old Trademarks Act*, it is significant as it illustrates the application of the doctrine of *res judicata vis-à-vis* trademark infringement actions. The doctrine of *res judicata* may apply when the cause of action or the subject matter of the dispute in the earlier proceeding is similar to that in the later proceedings, notwithstanding that the causes of action are premised on different legislative provisions.

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ANNEX A

No.	Year	Statistics' Source
1.	2010 - Sept 2020	http://www.myipo.gov.my/en/statistic-application-registration/#toggle-id-1
2.	2010 - Sept 2020	http://www.myipo.gov.my/en/statistic-application-registration/#toggle-id-3
3.	2010 - Sept 2020	http://www.myipo.gov.my/en/statistic-application-registration/#toggle-id-2

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Invalidation Procedures Related to Patents,
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