

## Enforcement of Trademark Law in Malaysia

Sohaib Mukhtar<sup>1\*</sup>, Zinatul Ashiqin Zainol<sup>2</sup> and Sufian Jusoh<sup>1</sup>

<sup>1</sup>*Institute of Malaysian and International Studies, Universiti Kebangsaan Malaysia (UKM), 43600 Bangi, Selangor, Malaysia*

<sup>2</sup>*Faculty of Law, Universiti Kebangsaan Malaysia (UKM), 43600 Bangi, Selangor, Malaysia*

### ABSTRACT

Enforcement of trademark Law in Malaysia can be categorized as per Part III of Agreement on Trade Related Aspects of Intellectual Property Rights (TRIPS) of World Trade Organization (WTO) into (i) civil procedure, (ii) criminal procedure, (iii) administrative procedure, (iv) provisional measures, and (v) border measures. Important trademark International Treaties dealing with trademark include (i) Paris Convention (ii) TRIPS (iii) Madrid Protocol. Malaysia has ratified Paris Convention and TRIPS but has not ratified Madrid Protocol which provides procedure for International Trademark registration under International Bureau of World Intellectual Property Organization (WIPO). Once trademark registration is made under Madrid Protocol in one-member state, it would be protected in all member states. Important Malaysian trademark laws dealing with enforcement of trademark in Malaysia include (i) Trade Marks Act 1976 (ii) Trade Marks Regulations 1997 (iii) Intellectual Property Corporation of Malaysia Act 2002 (iv) Trade Descriptions Act 2011. This article is qualitative method of research to analyze enforcement of trademark law in Malaysia under relevant Malaysian laws as well as analysis of relevant International Treaties

of trademark solemnized under WIPO and WTO. Paris Convention contains provisions on trademark and its enforcement dealing with Border Measures and TRIPS include comprehensive provisions on trademark (15-21) and enforcement of trademark (41-61) as Madrid Protocol provides procedure for International Trademark registration. Malaysia has ratified Paris Convention and TRIPS but has not ratified Madrid Protocol. It is therefore recommended that Malaysian government should accede to Madrid

### ARTICLE INFO

#### Article history:

Received: 25 March 2017

Accepted: 01 February 2018

Published: 28 September 2018

#### E-mail addresses:

sohaibmukhtar@gmail.com (Sohaib Mukhtar)

shiqin@ukm.edu.my (Zinatul Ashiqin Zainol)

sufian@gmail.com (Sufian Jusoh)

\* Corresponding author

Protocol for protection of trademarks registered in Malaysia to be protected in 98-member countries of Madrid Protocol.

*Keywords:* Agreement on Trade Related Aspects of Intellectual Property Rights, Intellectual Property Corporation of Malaysia, Intellectual property, Madrid Protocol, Paris convention, trademark

## INTRODUCTION

Trademark is mark, name, sign, smell or a sound which distinguishes goods/services of one undertaking from goods/services of other undertakings. Trademark is required to be distinctive and non-descriptive; it loses its distinctiveness when registered owner of trademark does not take prompt action against its infringement. Enforcement procedures of trademark can be categorized as per Part III of TRIPS into (i) civil procedure, (ii) provisional measures, (iii) administrative procedure, (iv) border measures, and (v) criminal procedure. Intellectual Property Corporation of Malaysia (MyIPO) has been working for registration and protection of trademarks in Malaysia. There is no separate body for trademark registration and protection hence it is required to have a separate body like United States Patent and Trademark Office (USPTO) for registration and protection of trademarks in Malaysia.

Trade Marks Ordinance 1950 is repealed by Trade Marks Act 1976 and thereunder Trade Marks Regulations 1997 prescribed and applies on whole Malaysian territory. MyIPO established and works under Intellectual Property Corporation of Malaysia Act 2002. MyIPO Headquarter is

in Kuala Lumpur and regional offices are in (i) Sabah (ii) Sarawak (iii) Johor Bahru (iv) Kuantan (v) Penang and (vi) Melaka. All regional offices receive trademark registration applications as the register of trademark is kept at the Headquarter. Trademark registration application with required documents may be (i) submitted by hand or (ii) send to the Registrar by post or (iii) submitted online through electronic means. All trademark entries are required to include (i) name, details and address of the proprietor (ii) name, details and address of the registered user (iii) assignment and transmission record (iv) disclaimers, conditions and limitations.

Trade Marks Regulations are made in 1997 to (i) regulate trademark practices before the Registrar of trademark (ii) classify goods and services prescribed in third schedule same as prescribed in Nice Agreement 1957 and Vienna Agreement 1973 (34 classes of goods and 11 classes of services) (iii) make or require duplication of documents to secure and regulate publishing (iv) prescribe fee (v) regulate other matters dealing with trademark (vi) make qualification of an agent who must be (a) domiciled or resident of Malaysia (b) has a principal place of business in Malaysia (c) an advocate or a solicitor in Malaysia (d) holds a recognized degree in Industrial Property and has over 3 years of experience. The agent may be removed from the register of trademark if he (a) loses prescribed qualification (b) convicted (c) declared discharged bankrupt.

Trade Descriptions Act 1972 is repealed by Trade Descriptions Act 2011 to promote good trade practices and prohibit false trade description, advertisement, conducts and practices including trademark infringement. Investigation of false trade description offences is required to be conducted by Controller/Assistant Controller/Deputy Controller appointed by the Federal Minister of Domestic Trade, Cooperatives and Consumerism.

WIPO and WTO are two main International Organizations currently work for promotion and protection of IP including trademark throughout the world. WIPO has Paris Convention and Madrid Protocol dealing with trademark, its registration and enforcement. Paris Convention is the first International Treaty contains provisions on enforcement of IP dealing with Border Measures in member states of WIPO as TRIPS contains comprehensive Part III dealing with enforcement of IP in member countries of WTO. TRIPS Part III includes provisions dealing with (i) general obligations, (ii) civil procedure, (iii) administrative procedure, (iv) provisional measures, (v) border measures, and (vi) criminal procedure of trademark enforcement. Madrid Protocol deals with International Trademark registration which has not been ratified by Malaysia. It is therefore recommended that Malaysia should accede to Madrid Protocol so that trademark registration in Malaysia under International Bureau of WIPO would be protected in 98-member states of Madrid Protocol.

## **Trademark**

Trademark is mark capable to distinguish goods/services of one undertaking from goods/services of other undertakings. (Bryer, Lebson, & Asbell, 2011) Intended use and nature of goods/services would not be obstacle in registration of trademark in member countries. Publication would take place before or after registration and if party fails to maintain usage for continuous 3 years, registration would be cancelled (Bodenhausen, 1968). The owner of trademark may assign trademark with or without transferring his whole business with it. Term of protection for registered trademark would be at least for 7 years and renewable indefinitely after expiration of initial time (Articles 16-21 “Agreement on Trade Related Aspects of Intellectual Property Rights” 1994).

Trademark includes device, brand, heading, label, ticket, name, signature, word, letter, numeral or any combination. It also includes well-known mark in respect of goods/services. (Blakeney, 1996) When deciding authority of well-known mark, the Registrar is required to take into account (i) knowledge and recognition of mark in relevant sector, (ii) duration, extent and geographical area of use, (iii) promotion, advertisement, publicity and presentation of goods/services, (iv) successful enforcement record of the mark, and (v) value associated with the mark (Regulation 13B “Trade Marks Regulations,” 1997). Trade names and Service marks are protected under Paris Convention in member countries of the

union (Articles 6,9 “Paris Convention for the Protection of Industrial Property” 1967).

Interested party may make an application of trademark registration (i) by hand, (ii) by post, or (iii) online for the registration of trademark before MyIPO in Malaysia. The Registrar would accept or reject application and if he refuses application or accepts conditionally he would give grounds. The aggrieved party may apply before the Court against decision of the Registrar (Intellectual Property Corporation of Malaysia [MyIPO], 2016). Grounds for rejection of trademark application would be taken into consideration as prescribed under Trade Marks Act 1976 if applied trademark is (i) contrary to law, (ii) deceives or causes confusion, (iii) consists scandalous or offensive matter, (iv) prohibited to be protected by the Court, (v) against interest and security of nation, (vi) identical to well-known mark, (vii) identical with already registered mark, (viii) consists misleading thing of its origin except (a) applied in good faith, (b) geographical indication which ceased to be protected, (c) contains words: patent, patented, by royal letters patent, registered, registered design and copyright. (Sections 14,15,19 “Trade Marks Act,” 1976) Paris Convention also states grounds of trademark rejection including (ix) trademark identical to state official signs or Intergovernmental Organizations, (x) infringes rights acquired by third parties, (xi) does not have distinct character, (xii) contrary to morality and public order, (xiii) deceives public at large, and (xiv) against

public interest. (Article 6 “Paris Convention for the Protection of Industrial Property” 1967)

If application of trademark registration is made for registration of another person’s name, that person’s consent is required for the registration if he is alive otherwise his legal representative may give consent for the registration of trademark. If trademark is registered but not of a distinctive nature and common to trade and business and contains any part which is not separately registered, the Registrar or the Court may require the owner to disclaim some exclusive rights granted to him and that disclaimer would be recorded in the register of trademark. (Section 16 “Trade Marks Act” 1976)

If proposed user of trademark does not begin its business within 6 months, the Registrar is required to cancel his registration. If applicant does not fulfill requirements of trademark registration within 12 months, the Registrar is prescribed to abandon his application after observing right of notice except matter is pending before the Court or not more than 3 months have passed after decision of the Court. (Section 29 “Trade Marks Act” 1976)

The registered owner of trademark may authorize any person to be registered user of his trademark in respect to all or any of the registered goods/services but the owner retains exercise control of quality. The owner of trademark may apply for trademark registration through prescribed application consisting (i) representation of trademark, (ii) name and address of contracting parties,

(iii) description of goods/services, (iv) any condition or restriction, and (v) whether usage is for a limited time or unlimited time. If the registered user feels that the owner is making hurdles in usage, he may apply in the Court for relief. The registered user may call upon the registered proprietor to start infringement proceedings within 2 months otherwise the registered user may start proceedings with his own name as the registered proprietor and make the proprietor defendant. The registered user of trademark does not have right of assignment and transmission under Trade Marks Act 1976. (Sections 51,52 “Trade Marks Act” 1976)

Protection time of registered trademark is 10 years in Malaysia under section 32 of Trade Marks Act 1976 which is renewable after expiration for further 10 years under section 41 of Trade Marks Act 1976. The Registrar may send a notice to the prescribed owner of trademark before expiration of protection time consisting (i) date of expiration, and (ii) conditions of extension. The renewal of trademark can be granted for further 10 years if the owner applies in a prescribed manner within a prescribed time and fulfills prescribed conditions (Section 41(1) “ Trade Marks Act,” 1976). As per article 18 of TRIPS, the term of protection for the registered trademark is at least for 7 years and renewable afterwards indefinitely. It is suggested that the word “indefinitely” should be added in section 32 of Trade Marks Act 1976 after words “from time to time” for clarity. The right of priority can be claimed within 6 months in Malaysia

as it is one of the member states of Paris Convention. Temporary protection can be granted to trademark goods/services that are subject matter of International Exhibitions and right of priority can also be claimed upon temporary protected trademarks within 6 months from the date of first exhibition day. (Sections 70,70A “Trade Marks Act” 1976)

Malaysia has ratified Paris Convention and TRIPS but has not ratified Madrid Protocol. Madrid Protocol is one of the treaties of WIPO made to protect International Trademarks in 98-member states signatories of Madrid Protocol. Initially Madrid Agreement concerning International Registration of trademarks entered force in 1891 which established Madrid System known as International Trademark System (Leaffer, 1998). Madrid Protocol came into being in 1989 and it overtook Madrid Agreement as of September 1 2008 and on October 11 2016 Madrid Union Assembly decided to freeze accessions to Madrid Agreement thus all members now benefit from flexibilities and features of Madrid Protocol. Signatories of Madrid Protocol include United States of America (USA) and European Union (EU) (Dutfield, G., & Suthersanen, U., 2008; Leaffer, 1998).

Entries of International Trademark registration are protected for 10 years from the date of registration and renewable after its expiration for further 10 years and International Bureau (IB) is required to contact right holder 6 months prior to expiry of protection time of 10 years. IB

is required to record name and address of trademark owner and his representative as well as limitation, renunciation, cancellation and invalidation of International Trademark registration which are also required to be recorded in International Register of IB (Roth, 2014; Samuels, 1993).

Malaysia has not ratified Madrid Protocol yet, it is therefore highly recommended that Madrid Protocol should be ratified by Malaysia by following footsteps of USA and EU to accede to Madrid Protocol and amend trademark law as per Madrid Protocol after its accession to give effect provisions of Madrid Protocol for recognition and enforcement of International Trademarks in Malaysia.

### **Enforcement of Trademark**

Part III of TRIPS deals with enforcement of IP rights in member states of WTO under articles 41-61. TRIPS require all member states to follow enforcement procedures prescribed under Part III in their countries to prevent infringement as well as to provide adequate remedies. Enforcement procedures must be (i) fair, (ii) adequate, (iii) expedient, (iv) equitable, and (v) must not be complicated (vi) costly and time consuming. Member states of WTO must allow trademark right holder to take legal action against infringement of his IP right to stop existing infringement as well as to prevent infringement in future and to recover losses beard by him. Member states must put in place effective enforcement procedures and deterrent remedies as well as to empower competent authorities to take

actions. (Article 41-61 “Agreement on Trade Related Aspects of Intellectual Property Rights” 1994)

Enforcement of IP right is one of the parts of enforcement of law in general and there is no requirement to separate them and to create special resources for enforcement of IP rights. Legitimate trade is required to be encouraged through adequate procedures of enforcement by discouraging abuse against it. TRIPS do not affect enforcement capacity of member states in their general domestic law. It is not obligatory upon member states to deal with enforcement of TRIPS separately by redistributing resources as it is enforcement of domestic law in general. (Taubman, 2011)

Fundamental principle of IP enforcement is to maximize national interests by assessing current rules of economics which should be amended to minimize derivation from socially optimal targets and to provide guidance for formulating National Policy on IP rights’ enforcement. Developing countries of WTO have their personal agenda and personal interests on enforcement of IP rights. Member states (163) of WTO have taken an initiative for smooth implementation of trademark rights but have flaws in their agenda, therefore developing countries are required to put more efforts identifying and pursuing their positive interests in enforcement of IP rights as per Part III of TRIPS. (Xuan Li & Correa, 2009)

Enforcement of IP procedures include (i) civil procedure, (ii) provisional measures, (iii) administrative procedure, (iv) border

measures, and (v) criminal procedure. IP enforcement procedures must not be complicated and time consuming and must be based upon due process of law and fair trial which are basic requirements needs to be complied with by member states of TRIPS under article 41. Enforcement procedures of trademark in Malaysia under the light of relevant International Treaties and trademark laws of Malaysia are discussed hereunder.

### **Civil Procedure**

TRIPS contain articles 42-49 in Part III dealing with civil procedure of trademark enforcement in member countries of WTO. Member states of WTO must provide opportunity of civil proceedings to right holder and defendant has right of notice before legal proceedings which must be made within a suitable time and contains adequate details based on claim. Personal appearances of parties must not be obligatory and they may be represented through independent lawyers and present evidences (Yu, 2011). Member states are required to protect trade of imported goods by preventing infringement of IP and infringer is required to pay damages to right holder as compensation for injury caused due to infringement and he may also be required to pay expenses of attorney's fee and profits which he generated due to infringement (Yu, 2009). Infringed goods may be disposed-off or destroyed without causing injury to the right holder if it is not contrary to provisions of the Constitution of member state. (Articles 42-49"Agreement on Trade

Related Aspects of Intellectual Property Rights" 1994)

Aggrieved party may adopt civil procedure before Civil Court in Malaysia against wrong entry in the register of trademark which remains there without sufficient cause. The Registrar may apply before the Court against assignment, transmission or registration of trademark. The Court if decides in favor of plaintiff issues notice to the Registrar to rectify the register of trademark. Trademark can be removed on order of the Court if trademark is registered in bad faith or if it has not been in use for continuous 3 years. The Registrar of trademark may be asked by the Court to submit similar nature cases presented before him and that can be taken as evidence in civil proceedings. The Court may order all expenses, charges and costs in favor of the registered trademark owner. (Sections 41-45, 61-63"Trade Marks Act" 1976)

Section 51 of Trade Marks Act 1976 states that registered user is entitled to call upon registered proprietor to start civil proceedings of trademark infringement and if the registered proprietor refuses or neglects to do so within 2 months after being so called upon, the registered user may institute civil proceedings of trademark infringement with in his own name as he was the registered proprietor and shall make the registered proprietor defendant but the registered proprietor added as defendant would not be liable to pay costs unless he enters, appears and takes part in trademark infringement proceedings. ("Trade Marks Act" 1976)

In the case of *Oriental Motolite Marketing Corporation v Syarikat Asia Bateri*, plaintiff Oriental & Motolite Marketing is a company in Philippines to produce automotive batteries and trading it with trademark "MOTILITE" since 1950. Plaintiff Oriental Motolite Marketing Corporation has been selling its products in Malaysia through defendant Syarikat Asia Bateri since 2000. Both parties signed deed of assignment by which all rights and interests of defendant in "MOTIOLITE" trademark assigned to plaintiff and signed memorandum of understanding by which defendant is appointed as local distributor of plaintiff in Malaysia for 5 years and continue to be in his position if distributorship agreement is signed afterwards between them but it was not solemnized and defendant continued to distribute batteries with trademark "MOTIOLITE" hence Plaintiff filed civil suit of trademark infringement before the Court where trademark infringement claim proved in his favor with costs. (*Oriental & Motolite Marketing Corp v Syarikat Asia Bateri Sdn Bhd*' (2012) 5 MLJ 87)

Section 38 of Trade Marks Act 1976 states that registered trademark is infringed when it is used by a person who is not the registered proprietor/user and does not use it by way of permitted use, uses trademark which is identical with or so nearly resembles as it likely to deceive or cause confusion during trade in relation to goods/services in respect of which trademark is registered. Infringement of trademark occurs when infringer uses

identical trademark as registered trademark upon goods/services in physical relation thereto in an advertising circular in other advertisement issues to public. ("Trade Marks Act" 1976)

In the case of *PELITA Samruda Pertama v Venkatasamy a/l Sumathiri*, appellant PELITA is the owner of hotel and has right to sell food and related things at its premises under trademark PELITA as well as PELITA oil lamp a common-law trademark which is protected under Paris Convention. The Respondent Venkatasamy applied for registration of same trademark PELITA before the Registrar of trademark. The owner of PELITA replied on application of respondent before the Registrar of trademark that he already has ownership of trademark PELITA, but the Registrar rejected his contention and registered subsequent application of PELITA in favor of respondent. Appellant filed appeal before the High Court against decision of the Registrar and contended that registration of subsequent trademark PELITA causes confusion and deception at market place and damages goodwill and reputation of appellant. The High Court held that this case was a clear-cut case of common law mark protection under International Convention and Malaysia was a common-law country thus case was decided in favor of appellant with costs RM 10.000 and the Registrar was directed to expunge entry of respondent from trademark register. (*PELITA Samudra Pertama (M) Sdn Bhd v Venkatasamy a/l Sumathiri* " (2012) 6 MLJ 114)



Section 40 of Trade Marks Act 1976 states that infringement does not occur if there is (i) use of own name or name of business place in good faith, (ii) use by a person describing character and quality of goods/services in good faith, (iii) use of trademark for business for an immemorial time, (iv) part use of trademark with prior permission of trademark proprietor/user, (v) use of trademark necessary to indicate fact that goods/services are adopted, and (vi) use of trademark which is serious of registered identical trademarks. (Moscato-Wolter, 2016)

In the case of *Shaifubahrim Bin Mohd v EM Exhibitions*, plaintiff Shaifubahrim bin Mohammad is president of PIKOM appointed defendant as project executive in his company. Later, defendant left company and set up his own company PC EXPO for organization of computer related exhibitions. Plaintiff filed claim before the Court that defendant was using its registered trademark PC FAIR. The Court held that PC FAIR was common term for computer related exhibitions as registered. Legalized term with the name of plaintiff was PIKOM PC FAIR and not PC FAIR. (“*Shaifubahrim Bin Mohd v EM Exhibitions (M) Sdn Bhd & Anor*” (2012) 9 MLJ 84)

The Court in Malaysia may order all expenses, charges and costs in favor of trademark owner, but the Registrar cannot be ordered to pay costs. The Registrar of trademark is empowered to take evidences through declaration or through viva voce examination and those evidences may be used in the Court through an affidavit as

well as copies of original work sealed by the Registrar and Certificate issued by the Registrar are admissible evidences before the Court. Foreign document is admissible evidence if document is sealed by the authorized officer or foreign government or if certificate issued by the authorized officer on validity of document. Foreign state is under reciprocal agreement with the Government of Malaysia to accept documents but this does not mean that Malaysian Government is bound to accept and recognize all foreign trademarks. (Sections 64-66”Trade Marks Act” 1976)

Section 82 of Trade Marks Act 1976 states that no person is entitled to initiate any action to prevent or to recover damages for infringement of his unregistered trademark except right of action against any person for passing off goods/service of another and remedies in respect thereof (Conlon, 1975). In the case of *Plastech Industrial Systems v N & C Resources*, plaintiff Plastech Industrial System is manufacturer of plastic foam and defendant N & C Resources is also manufacturing plastic products. Defendants 2, 3 and 4 left plaintiffs and joined defendant N & C Resources in 2009. Defendants used confidential information of plaintiff for making similar kind of products and trading it at market place. Plaintiff filed claim of infringement and passing off. The Court held that act of defendants might damage goodwill of plaintiff by loss of sale at market place hence it was a clear-cut case of passing off in favor of plaintiff. (“*Plastech Industrial Systems Sdn Bhd v N & C Resources Sdn Bhd & Ors*” (2012) 5 MLJ 258)

The Registrar of trademark may be ordered by the Court to give his advice on trademark whether it is distinguishable or not and person asked for advice may on negative advice of the Registrar may withdraw his application of registration with fee reimbursed (Section 73"Trade Marks Act" 1976). Appeal against decision of the Registrar lies before the High Court in Malaysia but decision of the Registrar is not appealable except if an appeal is given under Trade Marks Act 1976. The Court has power of review on all orders of the Registrar passed related to entry in question or correction and the Court enjoys all powers given to the Registrar under Trade Marks Act 1976 in an appeal upon decision of the Registrar. (Sections 67-69"Trade Marks Act" 1976)

Norms and practices for enforcement of IP rights should be diversified, flexible and commensurate for development of effective enforcement procedures of trademark in member countries. The Judiciary of member states must provide civil remedies including injunctions, compensatory damages, disposal of infringed goods and other services outside channel of commerce. The legislature of member states is required to make changes in existing domestic laws of IP to provide adequate remedies and relief to the owner/user of registered trademark. IP is a personal property of right holder thus burden and cost for its enforcement is to be borne by right holder himself. (Xuan Li & Correa, 2009)

### **Provisional Measures**

TRIPS contain article 50 in Part III dealing with provisional measures of trademark enforcement in member states of WTO. The Court of member state may order an injunction when there is a reasonable cause to believe that if injunction is not ordered, it may harm applicant or evidence may be destroyed. The Court may ask plaintiff to provide security or surety before ordering injunction to prevent abuse and to protect defendant. Defendant's right of notice and right of hearing are required to be accorded before pronouncing injunction order and he may also have the opportunity of review upon decision of the Court within prescribed time. If injunction order is overruled on review application of defendant, the Court may order plaintiff to give compensation to defendant for the loss he has suffered. The injunction order may be passed by administrative authority keeping in view principles laid down in TRIPS (Taubman, 2012).

Granting injunctions by the Court is preventive relief whether temporary or perpetual. Temporary injunctions are those injunctions and stay orders of the Court which are applicable until specified time mentioned in the order or when time is not mentioned in the order until further order of the Court. Temporary injunctions can be awarded at any time of proceedings before the Civil Court. Perpetual injunctions can be granted by the Court at the time of decree upon merits of the case to stop defendant perpetually from asserting right which is right of plaintiff and to stop defendant from

doing any other act perpetually (Mohamed, 2016). Perpetual injunction can be granted at time of the decree on merits of the case by the Court to prevent breach of an expressed or an implied obligation when (i) defendant is trustee of the property of plaintiff, (ii) damage of an invasion cannot be ascertained, (iii) pecuniary relief is not adequate of damage, (iv) pecuniary compensation cannot be granted, or (v) injunction is required to prevent multiplicity of legal proceedings. To prevent breach of performance, it is necessary to stop breach of an obligation as well as to compel someone to do some act and that compelling is through the Civil Court under mandatory injunction (Mohamed, 2016).

Trademark owner may apply for obtaining injunctions before the Court under Specific Relief Act 1950 to stop further infringement of his trademark. Specific Relief Ordinance number 29 was first enacted in 1950, thereafter it was revised in 1974 and changed into the present form by an act number 134 of 1974 ("Specific Relief Act" 1950). Application for grant of an injunction may be made by any party of proceedings before or after trial by notice of application supported with affidavit and where case is of urgency may be made ex parte and must contain clear and concise statement of (i) facts giving rise to claim, (ii) facts giving rise to application, (iii) facts relied on to justify application ex-parte, (iv) details of given notice to other party, (v) answer by other party, (vi) facts which may lead the Court not to grant application ex-parte, (vii) any similar application made

to another Judge, and (viii) precise relief sought. Interim injunction obtained on ex-parte application shall automatically lapse 21 days from the date it was granted. (Rule 1, Order 29"Rules of Court" 2012)

An injunction can be refused if it is (i) required to stay judicial proceedings except if it is required to stop multiplicity of judicial proceedings, (ii) required to stop judicial proceedings pending before the upper Court, (iii) required to stop any person to apply before any legislative body, (iv) required to stop public authorities of any department of the Malaysian Government to perform their public duties, (v) required to stay criminal proceedings before the Court, (vi) required to prevent breach of contract whose performance is not specifically enforced , (vii) required to stop nuisance when it is not clear whether it comes under the definition of nuisance or not, (viii) required to prevent continuing breach of contract (ix) required to disentitle applicant or his agent to assist the Court, (x) when there is any other effective relief which can be obtained except in case breach of a trust, or (xi) when applicant has no personal interest in the matter. (Sections 50-55"Specific Relief Act" 1950)

Section 70B of Trade Marks Act 1976 states that the proprietor of trademark is entitled to restrain use of trademark which or essential part of which is identical with and nearly resembles with proprietor's trademark in respect of same goods/services and when use is likely to deceive or cause confusion.(McCarthy, 2009) Section 50 of Trade Marks Act 1950 states that injunction is preventive relief which is granted at

discretion of the Court temporarily or perpetually. Section 51 of Specific Relief Act 1950 states that temporary injunction is granted at any time of the suit regulated by law relating to civil proceedings and continue to apply until specified time or until further order of the Court and perpetual injunction is only awarded at Decree of case decided by the Court (McKenna, 2010).

The High Court held in the case of *Muhammad Hilman bin Idham v Kerajaan Malaysia* that an order for temporary injunction could be sought only in aid of prospective order for perpetual injunction. If in event of plaintiff's success, he could not obtain decree for perpetual injunction, it was not competent for him to ask for temporary injunction. Temporary injunction would not be granted in cases where permanent injunction was not available under sections 52-54 of Specific Relief Act 1950 ("*Muhammad Hilman bin Idham & Ors v Kerajaan Malaysia & Ors*" (2011) 6 MLJ 565).

The High Court also held in another case between *Tidalmarine Engineering Sdn Bhd v Kerajaan Malaysia* that Specific Relief Act 1950 recognized distinction between temporary and perpetual injunctions issued by the Court. Judicial views were however divided as to whether temporary injunction or as was commonly referred to interlocutory injunction as opposed to permanent injunction could be issued against government/department of government/government officers/any related party to the government ("*Tidalmarine Engineering Sdn Bhd v Kerajaan Malaysia (Jabatan Kerja*

*Raya Malaysia Cawangan Terengganu)*" (2011) 2 MLJ 400)

Section 53 of Specific Relief Act 1950 states that mandatory injunction is granted to (i) prevent breach of obligation, and (ii) compel performance of certain acts. The High Court held in the case of *Jasmine Food Corporation v Leong Wai Choon* that the Court was clearly empowered and had jurisdiction to grant summary judgment for trademark infringement case even if it involved a claim for permanent mandatory injunction ("*Jasmine Food Corp Sdn Bhd v Leong Wai Choon & Anor*" (2011) 11 MLJ 812 ).

The Court of Appeal Putrajaya held in the case of *Credit Guarantee Corporation Malaysia v SSN Medical Products* that the Court recognized force of argument that defendant should not be compelled to apologize against his will as very spirit of apology was that it must come from heart, something which defendant wished to do because wrong he had done to plaintiff. On the other hand, order compelling defendant to merely withdraw or correct offending statement after trial seems to be of different character or genre from that of an apology. In same way that the Court compels defendant to pay damages for defamation, there is no reason or principle why it cannot compel issue of correction. Of course, cases where the Court should think that justice requires grant of mandatory injunction to issue either letter of withdrawal or correction must be quite exceptional ("*Credit Guarantee Corp Malaysia Bhd v SSN Medical Products Sdn Bhd*" (2017) 2 MLJ 629).

### Administrative Procedure

TRIPS contain article 49 in Part III dealing with administrative procedure of trademark enforcement in member countries of WTO. Trademark may be invalidated by administrative authority of member state if it is consisted of wine or spirit, wrongly indicated to the place which is not its origin by ensuring equitable treatment to producers and not misleading the consumer. If trademark is registered prior to entry into force of TRIPS, it does not validate registered trademark under TRIPS and all member states are required to apply administrative provisions as per their legislative requirements (“Agreement on Trade Related Aspects of Intellectual Property Rights” 1994).

The opposing party to registration of trademark may give written notice to the Registrar and to the applicant within prescribed time after issuance of advertisement. Notice should include grounds of opposition. The applicant for registration of trademark submits counter statement to the Registrar and to opponent after receiving the notice. Parties submit evidences within prescribed time and if counter statement and evidences are not submitted by parties, application for registration would be abandoned and evidences would be recorded, the Registrar accepts application in full or with some conditions or rejects it. Decision of the Registrar is appealable before the High Court and the Court is required to decide matter after hearing disputing parties and

the Registrar (Section 28”Trade Marks Act” 1976).

In the case of *Mesuma Sports v Majlis Sukan*, Majlis Sukan Negara Malaysia is a statutory body established under National Sports Council of Malaysia Act 1971 to make clothes carrying tiger stripes’ design to be wearied by Malaysian Athletes. Defendant Majlis Sukan assigned work to one of the manufacturer and later it was assigned to plaintiff Mesuma Sports. After sometimes, plaintiff applied for registration of tiger stripes’ design and later defendant applied for same before the Registrar of trademark. The Registrar of trademark objected application of defendant. Later, defendant filed civil suit in the Court. The Court decided matter in favor of defendant and ordered the Registrar of trademark to register tiger stripes design in favor of defendant and make its entry in official trademark register (“*Mesuma Sports Sdn Bhd v Majlis Sukan Negara Malaysia*” (2015) 6 MLJ 465).

The Court of law or the Registrar when validity of registered trademark comes in question may order in favor of the owner all expenses, charges and costs unless the Court decides the contrary, but the Registrar cannot be ordered to pay costs. If relief of an alteration or rectification of the register is granted, the registrar when asked must appear before the Court. He may also be directed to submit similar nature cases presented before him and that can be taken as evidences in proceedings. The Registrar may take evidences through declaration or through viva voce examination provided

no direction is given for that purpose and those evidences may be used in the Court through an affidavit as well as copies of the original work sealed by the Registrar are acceptable as an evidence before the Court. The certificate issued by the Registrar is admissible evidence before the Court. The foreign document is also admissible evidence if document is sealed by the authorized officer or a foreign government or if certificate is issued by an authorized officer on validity of that document. The foreign state is under a reciprocal agreement with the government of Malaysia for acceptance of documents, but this does not mean that Malaysian Government is bound to accept recognition of all foreign trademarks. The Registrar may be asked to give his advice on any trademark whether it is distinguishable or not and the person asked for advice may on negative advice of the Registrar may withdraw his application of trademark registration with fee reimbursed. The decision of the Registrar is not appealable except if an appeal is given under provisions of Trade Marks Act 1976 provided that the Court has power of review in all orders of the Registrar passed related to entry in question or correction. The Court enjoys powers given to the Registrar under Trade Marks Act 1976 in an appeal upon decision of the Registrar (Sections 61-69, 73"Trade Marks Act" 1976).

In the case of *PELITA Samruda Pertama v Venkatasamy a/l Sumathiri*, appellant PELITA is the owner of hotel and has right to sale food and related things at its premises under trademark PELITA as

well as PELITA oil lamp a common-law trademark which is protected under Paris Convention. The Respondent Venkatasamy applied for registration of same trademark PELITA before the Registrar of trademark. The owner of PELITA replied on application of respondent before the Registrar of trademark that he already had ownership of trademark PELITA, but the Registrar rejected his contention and registered subsequent application of PELITA in favor of respondent. Appellant filed appeal before the High Court against decision of the Registrar and contended that registration of subsequent trademark PELITA caused confusion and deception at market place and it damaged goodwill and reputation of appellant. The Court held that this case was a clear-cut case of common law mark protection under International Convention and Malaysia was a common-law country thus case was decided in favor of appellant with costs RM 10.000 and the Registrar was directed to expunge entry of respondent from trademark register ("*PELITA Samudra Pertama (M) Sdn Bhd v Venkatasamy a/l Sumathiri*" (2012) 6 MLJ 114).

The Court asks the Registrar to expunge entry of trademark from trademark register and sometimes asks the Registrar to register trademark. In the case of *Yong Teng Hing v Walton International Limited*, appellant Yong Teng Hing and respondent Walton International applied for registration of trademark "GIORDANO" for trade of their leather garments. The Registrar of trademark refused to register trademark of both parties until their claim is to be

decided by the Court. Appellant claimed that he has been using “GIORDANO” trademark since 1986 and respondent claimed that this trademark was first used at Hong Kong in 1982 and it was assigned to him by GIORDANO Limited and he also claimed that he was registered owner of similar trademark since 1982 and he started using objected trademark in 1990. The Court held that contention of respondent is true as appellant failed to prove his claim before the Court hence matter was decided in favor of respondent with costs and the Court ordered the Registrar of trademark to register “GIORDANO” trademark in favor of respondent (*Yong Teng Hing v Walton International Ltd*” (2012) 10 MLJ 244).

### **Border Measures**

TRIPS contain articles 51-60 in Part III dealing with border measures of trademark enforcement in member countries of WTO. Notice for suspension to release counterfeited trademark goods may be delivered to both parties. If execution proceedings are not initiated by the applicant within 10 working days after suspending importation of goods by customs authority, the authority may release seized suspected trademark goods. In certain cases, 10 more days may be given to the applicant for start of judicial proceedings which can be extended to 31 calendar days if suspension is continued based on injunction order passed by the Court. The authority may order the applicant to pay appropriate compensation because of malicious judicial proceedings initiated by the applicant who caused harm

to owner, importer or consignee of seized goods. The right holder and the importer have right of inspection on all imported goods upon which claim of the right holder is initiated (Taubman, 2012).

The customs authority may be required to tell name and address of consignor, consignee and importer as well as quantity of goods after receiving request from the right holder. All actions related to suspension of goods may be taken on the request of right holder, but relevant authorities of member states may act based on own initiative in good faith and may require the right holder to provide sufficient information which may help them to take necessary action and the right holder may be notified for that action. Authorities may be ordered to dispose-off or destruct infringed goods and in case of counterfeited trademark goods, re-exportation cannot be allowed without alteration. It is pertinent to mention that application is required in case of goods of small quantity which can either be sent through small consignment or can be carried in personal luggage (Articles 51-60 “Agreement on Trade Related Aspects of Intellectual Property Rights” 1994).

As per articles 9-10 of Paris Convention, imported goods bearing unlawful trade name or trademark are required to be seized in all member countries of WIPO on the request of public prosecutor, competent authority or an interested party under domestic legislation of member state. Goods may be seized by customs authority of member state if there is a false indication with respect to source of goods and identity of producer.

In case if seizure is not allowed under domestic legislation of member state then prohibition on importation may be invoked and if this remedy is also not available under domestic legislation of member state then any sufficient remedy may be invoked which is available under domestic legislation and member states of WIPO are required to take steps to amend relevant domestic laws to comply with provisions of relevant International Treaties (Articles 9-10 “Paris Convention for the Protection of Industrial Property” 1967).

The Federal Minister of IP may order for prohibition of importation of goods bearing false trade description or false trade indication to stop them from importation and any person commits or induces commission of false trade description offence or offence of false trade indication outside territory of Malaysia from Malaysia is consider an offender under Trade Descriptions Act 2011 (Sections 26-27”Trade Descriptions Act” 2011).

If counterfeited trademark goods are about to be imported to Malaysia, the registered trademark owner or his agent may inform the Registrar through written application with documented evidence and relevant information with payment of prescribed fee. The Registrar either approves or disapproves written application of trademark owner. Approval letter by the Registrar upon application of trademark owner would remain intact for 60 days unless withdrawn by the applicant. Furthermore, the Registrar may require applicant to deposit security to prevent

abuse and to protect importer as well as to pay compensation or to reimburse expenses likely to incur on seizure. Upon receiving application, the Registrar is required to notify the authorized officer of customs. The authorized officer of customs upon receiving request from the Registrar is required to (i) prohibit import of counterfeited trademark goods into Malaysia, (ii) seize and detain counterfeited trademark goods, (iii) store seized counterfeited trademark goods at a secured place, and (v) inform the Registrar, importer and applicant about seizure in a written form (Sections 70D-70G”Trade Marks Act”1976).

Section 70O of Trade Marks Act 1976 empowers authorized customs officer to seize suspected goods if he acts in good faith. The authorized customs officer may detain or suspend release of goods based on prima facie evidence that he has acquired counterfeited trademark goods. Thereupon, authorized customs officer shall inform the Registrar, importer and proprietor of registered trademark and may at any time seek the proprietor of registered trademark to furnish information that may assist him to exercise his powers ( Lakshmi & Patro, 2009).

Furthermore, section 45 of Customs Act 1967 states that if goods other than bona fide ship’s stores are found by authorized customs officer in any vessel in territorial waters and such goods are not correctly accounted for in manifest or other documents which ought to be aboard such vessel then such goods shall deemed to be unaccustomed goods and shall be liable to seizure (Chong, 1998).



In the case of *Goodness for Import and Export v Phillip Morris Brand Sarl*, plaintiff is limited liability Company with seat at Neuchatel, Switzerland. Plaintiff Phillip Morris Brand Sarl is registered proprietor and common law owner of MARLBORO and MARLBORO Roof Lines trademarks “MARLBORO marks” in Malaysia for tobacco products which is valid and subsisting at all material times. Plaintiff has exclusive right to use MARLBORO marks in relation to cigarettes. Royal Malaysia Customs detained and searched 12 containers which were on board vessel CSAV Pyrenes berthed at West Port, Klang on the basis that containers were declared as Omani Marble, its investigation revealed that containers contained cigarettes and 10 MALIMBO containers containing alleged infringing products, namely, MALIMBO cigarettes were searched, seized, and detained by Royal Malaysia Customs and Excise in Malaysia. The Federal Court Putrajaya held that defendant/appellant used “MARLBORO marks” unauthorized as is likely to deceive and cause confusion during trade in relation to cigarettes, constitute misrepresentation, calculated and likely to mislead/deceive members of public. The Court held that resultantly plaintiff has suffered substantial damages and there is real danger that defendant may continue to act in such manner that will cause real likelihood of damage to plaintiff. The Court dismissed appeal of defendant on ground that acts of defendant will injure and have injured reputation/goodwill of plaintiff unless defendant is restrained by the Court

continue to do so (“*Goodness for Import and Export v Phillip Morris Brand Sarl*” (2016) MLJ 350).

The Registrar may issue notices for release of seized goods if legal proceedings is not instituted against importer within prescribed time or if applicant consented for release of seized goods. Aggrieved party may apply in the Court after release of seized goods for compensation and the Court may order applicant to pay compensation to importer for damages and suffering he has faced. Compensation granted to aggrieved party if exceeds is due upon the applicant (Section 70P”Trade Marks Act” 1976).

### **Criminal Procedure**

TRIPS contain article 61 in Part III dealing with criminal procedure of trademark enforcement in member countries of WTO. Useful criminal procedure should be available to the owner of registered trademark in member state to deter infringer/counterfeiter from doing wrongful act against registered trademark owner/user. Criminal remedies of member states must include (i) imprisonment, (ii) fine, (iii) destruction, (iv) seizure, and (v) forfeiture of material (Taubman, 2011).

The High Court stated in the case of *Solid Gold Publishers v Chen Wee Ho* that it was suitable for the owner of registered trademark to adopt criminal enforcement procedure because in criminal enforcement procedure, applicant was only required to give an application and all other preceding acts to be borne by authorized authorities and the case be taken up by the public

prosecutor and in case if he failed in criminal proceedings, he might not be liable to pay costs as in case of failing in civil proceedings, he might end up giving damages for the loss occurred due to institution of civil suit (“Solid Gold Publishers Sdn Bhd v Chen Wee Ho” (2003) MLJ 658).

Counterfeited trademark goods include application of false trade description to goods. Trade Description Order (TDO) can be obtained by the owner of registered trademark if infringement of trademark is with non-identical trademark as it is not a requirement if trademark is identical. TDO can be obtained for 1 year and it is admissible evidence before the competent authority in Malaysia. Limitation for institution of criminal enforcement proceedings in case if offence held under Trade Descriptions Act 2011 is 1 to 3 years from the date of its discovery to proprietor (Section 63”Subordinate Courts Act” 1948).

The Court of first instance in IP offences and their criminal enforcement is the Court of Sessions in Malaysia, the Court of Appeal is the High Court and the Federal Court enjoys certiorari jurisdiction where it can call upon pending matters in subordinate court and it enjoys jurisdiction of Appellate Court on matters decided by High Courts. IP offences may be tried in the High Court as the Court of First instance on *suo motu* order of the Court or on an application of Public Prosecutor (Sections 417, 177-177A, 418A”Criminal Procedure Code” 1935).

First Information Report (FIR) can be filed against infringement/counterfeiting of registered trademark before the competent

authority in Malaysia. Arrest can be made when offence is cognizable, search of body and search of premises can also be made under relevant provisions of Code of Criminal Procedure 1935. Remand order can also be obtained if investigation is not completed within 24 hours. Trademark offences are generally summons cases unlike copyright offences which are mostly warrant cases. A warrant case is that case in which punishment is capital or an imprisonment for more than 6 years and summons case is that case in which punishment is not capital and imprisonment not exceeding 6 years (Section 107”Criminal Procedure Code” 1935).

Trademark infringement comes under the ambit of false trade description which is a direct or indirect false indication to goods or part of goods in an advertisement with relation to its nature, designation, length, height, width, area, volume, capacity, weight, size, quantity, gauge, method of production and manufacturing, processing and reconditioning, composition, strength, fitness, standard of fitness, performance, behavior or accuracy or any other technological characteristic or date expiration of product. Any person applies false trade description to any goods, take possession of those goods, exposes that for supplying and supplies goods is punishable under Trade Descriptions Act 2011 (“Trade Descriptions Act” 2011).

The Minister in charge of the Ministry of Domestic Trade, Cooperatives and Consumerism is required to appoint Controller/Assistant Controller/Deputy

Controller for investigation of false trade description and false misleading advertisement offences under Trade Descriptions Act 2011. The Minister is also required to appoint the Registrar/the Director of MyIPO for making, keeping and maintaining entries of TDO (Sections 3-7"Trade Descriptions Act" 2011).

In the case of *Lian Bee Confectionery Sdn Bhd v QAF Company Limited*, Lian Bee is seller of bakery items and among them is filled cream bun which he has been selling under trademark "Squiggle" since 2007. QAF Company limited is Singaporean company which has been using same trademark "Squiggle" for its bakery items since 2004. Gardenia Bakeries is subsidiaries of Singaporean company which has been using "Squiggle" trademark for selling cream filled bun since 2003 and TDO was taken by QAF Company in 2008 thus Trial Court and Appellant Court decided matter in favor of QAF Company based on TDO ("*Lian Bee Confectionery Sdn Bhd. v QAF Limited*" (2012) 4 MLJ 20).

When trade description is made, a person who supplies goods would be considered as he applies trade description on goods. While determining class of goods in trade description, form, consent, time, place, manner and other related matters would be taken into consideration (Sections 10-11"Trade Descriptions Act" 2011). The Minister may exempt any description of goods which does not fall under the definition of false trade description for exportation or for any other specific purpose mentioned in the order issued by the

Minister (Sections 56"Trade Descriptions Act" 2011).

Any person initiating false entry in the register of trademark in its copy or makes a false document identical to the register or produces a false document as evidence is guilty of an offence and if proved guilty would be punished under Trade Descriptions Act 2011 (Section 9"Trade Marks Act" 1976). No person can misrepresent himself as the registered owner/user of trademark if he does so, it is an offence and he is punishable under Trade Descriptions Act 2011. If a trademark user wants legal benefits, he must register his trademark in the register of trademark in a prescribed manner but registration is not necessary in respect of legal benefits as to passing off (Sections 81-82"Trade Marks Act" 1976).

Any conduct, practice, statement, representation or an indication which leads a person to an error about price, supply or an approval of goods/services is misleading and false statement. The burden of proving or disproving false misleading statement in an advertisement is upon the accused and not on the accuser. The accused might take the defense that the offence was done (i) due to default of another person and identify another person within 14 days through a notice to the prosecutor, (ii) a natural person might take the defense that false trade description or false misleading statement was used personally or domestically, (iii) offence was occurred due to mistake or an accident beyond control of the accused and the accused has taken all precautions and due diligence to avoid commission of

an offence, (iv) the natural born accused was unaware of false trade description even after a reasonable diligence, or (v) the accused publisher received misleading advertisement in normal course of business and he was unaware of its illegality under Trade Descriptions Act 2011 (Sections 13-25 "Trade Descriptions Act" 2011).

No agent is considered untrustworthy of credit if he abetted commission of an offence for securing evidence and this act is admissible evidence in his favor before the Court. If suspected goods are found in more than one packing and more than one species, inspection of one centum or five samples are enough to believe that remaining contains the same. The Assistant Controller has all powers to investigate as Police Officer under Criminal Procedure Code 1935 (Sections 39-55 "Trade Descriptions Act" 2011).

The Principal is responsible of offences committed by his agent or his servant if they commit an offence while exercising due course of employment except if there is a reasonable cause to believe that offence has been committed without the consent of Principal. The Director, Chief Executive Officer, Chief Operating Officer, Secretary of Corporation or other similar designated officers of the body corporate are responsible for offences committed by the body corporate except if offence is committed by body corporate without their knowledge, consent and connivance and they have taken necessary precautions to stop commission of an offence (Sections 56-66 "Trade Descriptions Act" 2011).

## CONCLUSION

Trademark is a mark, name, sign, smell or a sound which distinguishes goods/services of one undertaking from goods/services of other undertakings. It is required to be distinctive and non-descriptive; it loses its distinctiveness when registered owner of trademark does not take prompt action against its infringement. The aggrieved party may adopt different procedures for trademark enforcement including (i) civil procedure, (ii) criminal procedure, (iii) administrative procedure, (iv) provisional measures, and (v) border measures. Important trademark laws of Malaysia include (i) Trade Marks Act 1976 (ii) Trade Marks Regulations 1997 (iii) Trade Descriptions Act 2011 (iv) Intellectual Property Corporation of Malaysia Act 2002. MyIPO works for registration and protection of IP rights in Malaysia as there is no separate body of trademark like USPTO in USA. It is therefore recommended that a specialized body for registration and protection of trademark should be established in Malaysia.

The trademark protection is for 10 years in Malaysia under section 32 of Trade Marks Act 1976 which states that "the registration of trademark shall be for a period of 10 years but may be renewed from time to time" as article 18 of TRIPS states that "the registration of trademark shall be renewable indefinitely", it is therefore recommended that the word "indefinitely" should be added after "time to time" in section 32 of Trade Marks Act 1976.

Malaysia is party to WIPO and WTO which are 2 main International Organizations working for protection and promotion of trademarks all over the world. Main International Trademark treaties include (i) Paris Convention, (ii) Madrid Protocol, and (iii) TRIPS. Malaysia has ratified Paris Convention and TRIPS but has not ratified Madrid Protocol. It is therefore recommended that Malaysia should follow footsteps of USA and EU by acceding to Madrid Protocol and amending Trade Marks Act 1976 accordingly for the implementation of International Trademark registration in Malaysia to be protected in 98-member states signatories of Madrid Protocol.

## REFERENCES

- Agreement on Trade Related Aspects of Intellectual Property Rights (1994).
- Blakeney, P. M. (1996). *Trade Related Aspects of Intellectual Property Rights: A Concise Guide To The TRIPS Agreement*. United Kingdom: Sweet & Maxwell.
- Bodenhause, G. H. C. (1968). *Guide to the Application of the Paris Convention for the Protection of Industrial Property* (Vol. 611). Geneva, Switzerland: United International Bureaux for the Protection of Intellectual Property
- Bryer, L. G., Lebson, S. J., & Asbell, M. D. (2011). *Intellectual property operations and implementation in the 21st century corporation*. New Jersey, US: John Wiley & Sons.
- Chong, J. W. (1998). Malaysian Intellectual Property Laws and their Compliance with the TRIPS Agreement. *The Journal of World Intellectual Property*, 1(6), 1003-1016.
- Conlon, R. C. (1975). Reacting to Worldwide Trademark Developments in Asia. *The Trademark Reporter*, 65, 491.
- Credit Guarantee Corp Malaysia Bhd v SSN Medical Products Sdn Bhd. (2017). *2 Malaysian Law Journal* 629.
- Criminal Procedure Code, Act 593* (1935). (My).
- Dutfield, G., & Suthersanen, U. (2008). *Global Intellectual Property Law*. United Kingdom and United States of America: Edward Elgar Publishing.
- Goodness for Import and Export v Phillip Morris Brand Sarl. (2016). *Malaysian Law Journal* 350.
- Jasmine Food Corp Sdn Bhd v Leong Wai Choon & Anor. (2011). *11 Malaysian Law Journal* 812.
- Lakshmi, V. V., & Patro, A. M. (2009). Intellectual Property Protection at Border. *Journal of Intellectual Property Rights*, 14(4), 330-339.
- Leaffer, M. A. (1998). The new world of international trademark law. *Marquette Intellectual Property Law Review*, 2, 1.
- Lian Bee Confectionery Sdn Bhd. v QAF Limited. (2012). *4 Malaysian Law Journal* 20.
- McCarthy, J. T. (2009). Are Preliminary Injunctions Against Trademark Infringement Getting Harder to Achieve. *Intellectual Property Law Bulletin*, 14, 1.
- McKenna, M. P. (2010). The Normative Foundations of Trademark Law. *Notre Dame Law Review*, 82(5), 78.
- Mesuma Sports Sdn Bhd v Majlis Sukan Negara Malaysia. (2015). *6 Malaysian Law Journal* 465.
- Mohamed, K. (2016a). Prevention of Trademark Counterfeiting through Intellectual Property Enforcement System in Malaysia. *The Debt Financing and Financing Risk Persistency*, 82.
- Mohamed, K. (2016). Protecting Business Interest Against Intellectual Property Rights

- Infringement Through Interim Injunction in Malaysia. *International Business Management*, 10(16), 3619-3626.
- Moscato-Wolter, A. (2016). What is the McLaw in Malaysia? *Akron Intellectual Property Journal*, 5(2), 231-249.
- Muhammad Hilman bin Idham & Ors v Kerajaan Malaysia & Ors. (2011). *6 Malaysian Law Journal* 565.
- Oriental & Motolite Marketing Corp v Syarikat Asia Bateri Sdn Bhd. (2012). *05 Malaysian Law Journal* 87.
- Paris Convention for the Protection of Industrial Property*. (1967). (Fr).
- PELITA Samudra Pertama (M) Sdn Bhd v Venkatasamy a/l Sumathiri. (2012). *06 Malaysian Law Journal* 114.
- Plastech Industrial Systems Sdn Bhd v N & C Resources Sdn Bhd & Ors. (2012). *05 Malaysian Law Journal* 258.
- Roth, C. (2014). Study on the Madrid Protocol System in Japan for Cambodia. *Tokyo University of Science*.
- Rules of Court, P.U. (A)* (2012). (My).
- Samuels, J. M. (1993). The Changing Landscape of International Trademark Law. *Georgh Washington Journal of International Law and Economics*, 27, 433.
- Shaifubahrim Bin Mohd v EM Exhibitions (M) Sdn Bhd & Anor. (2012). *9 Malaysian Law Journal* 84.
- Solid Gold Publishers Sdn Bhd v Chen Wee Ho. (2003). *Malaysian Law Journal* 658.
- Specific Relief Act, Act 137* (1950). (My).
- Subordinate Courts Act, Act 92* (1948). (My).
- Taubman, A. (2011). *A practical guide to working with TRIPS*. United Kingdom: Oxford University Press.
- Taubman, A. (2012). *A handbook on the WTO TRIPS agreement*. United Kingdom: Cambridge University Press.
- Tidalmarine Engineering Sdn Bhd v Kerajaan Malaysia (Jabatan Kerja Raya Malaysia Cawangan Terengganu). (2011). *2 Malaysian Law Journal* 400.
- Trade Descriptions Act, Act 730* (2011). (My).
- Trade Marks Act, Act 176* (1976). (My).
- Trade Marks Regulations, Act 175* (1997). (MY).
- Xuan Li, & Correa, C. M. (2009). *Intellectual Property Enforcement International Perspective*. United Kingdom: Edward Elgar Publishing Limited.
- Yong Teng Hing v Walton International Ltd. (2012). *10 Malaysian Law Journal* 244.
- Yu, P. K. (2009). The Objectives and Principles of the TRIPS Agreement. *Houston Law Review*, 46, 979.
- Yu, P. K. (2011). TRIPS enforcement and the developing countries. *American University International Law Review*, 26, 727-782.