

**IN THE HIGH COURT OF MALAYA AT KUALA LUMPUR
(COMMERCIAL DIVISION)**

ORIGINATING SUMMONS NO. WA-24IP-12-07/2016

In the matter of Trade Mark Registration No. 03000523 in Class 12 registered in the name of Sun Yuen Rubber Manufacturing Co. Bhd. of 41, Jalan Medan Ipoh 6, Bandar Baru Medan, Ipoh, 31400 Perak or 111/113, Hala Perusahaan Menglembu 13, Taman Perindustrian Chandan Raya 31450 Menglembu, Perak, Malaysia.

And

In the matter of an application pursuant to Section 46(1) of the Trade Marks Act, 1976 (Act 175)

And

In the matter of Order 87 of the Rules of Court 2012

BETWEEN

HYUNDAI MOTOR COMPANY

... PLAINTIFF

AND

SUN YUEN RUBBER MANUFACTURING CO. SDN. BHD.
(Co. No.: 73032-H)

... DEFENDANT

JUDGMENT

(Court enclosure No. 25)

A. Introduction

1. In this amended originating summons in court enclosure no. 25 (**This Action**), the plaintiff company (**Plaintiff**) applied to remove the mark “*GENESIS*” which has been registered in the Register of Trade Marks (**Register**) in favour of the defendant company (**Defendant**) with the registration no. 03000523 for goods in Class 12 (among others, inner tubes and tyres for motor-cycle, scooter, motorcar, light truck, lorry and bus, forklift and tractor and curing tubes) (**Registered Mark**).
2. This Action is brought pursuant to s 46(1)(a) and/or (b) of the Trade Marks Act 1976 (**TMA**).

B. Issues

3. The following questions, among others, arise in This Action:
 - (1) whether the Plaintiff is aggrieved by the Registered Mark under s 46(1) TMA so as to be entitled to file This Action to remove the Registered Mark from the Register;
 - (2) whether the Defendant may rely on s 37 TMA (which provides for the conclusiveness of the registration of a trade mark for more than 7

years) to resist This Action. This issue entails a discussion on “*trade mark squatting*”;

- (3) whether the Plaintiff can rely on the following 2 reports prepared by private investigators (**PI**) to support This Action –
 - (a) an investigation report (**Investigation Report**); and
 - (b) a market survey report (**Market Survey Report**);

- (4) whether Defendant can rely on documents which have been exhibited in the Defendant’s affidavits but their original documents have not been produced for the Plaintiff’s inspection as requested by the Plaintiff under O 24 r 10(1) of the Rules of Court 2012 (**RC**). This involves a discussion of the court’s power under O 24 r 16(1) and (5) RC regarding the Defendant’s failure to produce original copies of exhibits in the Defendant’s affidavits for the Plaintiff’s inspection;

- (5) whether the Plaintiff has proven under s 46(1)(a) TMA that –
 - (a) the Registered Mark was registered without any intention in good faith on the Defendant’s part, to use the Registered Mark in relation to all or part of rubber tubes, air bags and similar products for all types of motor vehicles manufactured by the Defendant (**Defendant’s Goods**); and

- (b) there has been in fact no use in good faith of the Registered Mark by the Defendant in relation to all or part of the Defendant's Goods for the time being up to 1 month before 29.7.2016 (the date of filing of the OS);
- (6) whether the Plaintiff has proven under s 46(1)(b) TMA that up to 1 month before 29.7.2016, a continuous period of not less than 3 years had elapsed during which there has been no use in good faith of the Registered Mark in relation to all or part of the Defendant's Goods by the Defendant; and
- (7) assuming the Plaintiff has proven s 46(1)(a) and/or (b) TMA, does the court have a discretion not to remove the Registered Mark from the Register?

C. Plaintiff's case

4. The Plaintiff –

- (1) is incorporated under the laws of Republic of Korea (**South Korea**) with its headquarters in South Korea;
- (2) is involved in the business of manufacturing automobiles;
- (3) is one of the companies in the Hyundai Motor Group and is one of the world's leading manufacturers of automobiles with a brand value of

US\$9 billion in 2013. The Plaintiff's automobiles are sold in more than 200 countries; and

- (4) has business presence in many countries in the world, including Malaysia.
5. The Plaintiff is the proprietor of the registered trade mark "*GENESIS*" for goods in Class 12 in 45 countries outside Malaysia. The Plaintiff has used the "*GENESIS*" mark as follows:
 - (1) the "*GENESIS*" mark is the brand name of one of the cars manufactured by the Plaintiff (**Plaintiff's Genesis Cars**) which was first used by the Plaintiff in 2008;
 - (2) the Plaintiff's Genesis Cars have been manufactured, exported, supplied, distributed and sold throughout the world, including Malaysia. Since the launch of the Plaintiff's Genesis Cars in 2008, their sales around the world have been increasing;
 - (3) the Plaintiff has a website for its "*GENESIS*" mark, <http://genesismotors.com> which is accessible worldwide, including Malaysia;
 - (4) the Plaintiff has expended considerable time, effort and money to advertise, promote and market the "*GENESIS*" mark. The Plaintiff's "*GENESIS*" mark is prominently advertised, promoted and marketed in

all of the Plaintiff's websites (Hyundai websites) which are accessible worldwide, including Malaysia;

- (5) due to the extensive use, advertisement, promotion and marketing of the Plaintiff's "*GENESIS*" mark throughout the world, members of the automobile trade and public recognise and associate that mark exclusively with the Plaintiff's goods and business;
 - (6) a general Google search on the internet for "*GENESIS*" cars would reveal substantial results which associate the "*GENESIS*" mark with the Plaintiff's goods and business;
 - (7) the Plaintiff's "*GENESIS*" mark has won many awards and accolades; and
 - (8) in view of the above, the Plaintiff is the Common Law owner of the "*GENESIS*" mark in Malaysia for goods in Class 12.
6. On 20.7.2015 the Plaintiff applied to the Registrar of Trade Marks (**Registrar**) to register the "*GENESIS*" mark for goods in Class 12 (**Plaintiff's Application**). The Plaintiff alleged that the Plaintiff first became aware of the Registered Mark when the Registrar objected to the Plaintiff's Application. In view of the Registered Mark, the Registrar objected to the Plaintiff's Application because the Plaintiff's "*GENESIS*" mark is likely to confuse and/or deceive the public.

7. The Plaintiff alleged that the Defendant had not used the Registered Mark within the meaning of s 46(1)(a) and/or (b) TMA due to the following reasons:

- (1) the Plaintiff had appointed ZB Security Services Sdn. Bhd. (**ZBSS**) as PI in this case;
- (2) the PI had conducted investigations between 1.3.2016 and 3.3.2016 to ascertain whether the Defendant had used the Registered Mark in Malaysia;
- (3) the PI had prepared the Investigation Report dated 4.3.2016 which stated that since the registration of the Registered Mark, the Defendant had not used the Registered Mark on the Defendant's Goods in the course of trade in Malaysia; and
- (4) the Plaintiff had also instructed the PI to prepare the Market Survey Report dated 18.4.2016 which alleged that there was no use of the Registered Mark on the Defendant's Goods in the course of trade in Malaysia by the Defendant.

D. Defendant's case

8. The Defendant was founded in 1956 and was then known as Sun Yuen Rubber Works. In the early 1960s, the Defendant's name was changed to

Sun Yuen Rubber Manufacturing Company. On 15.7.1981, the Defendant was incorporated with the above-mentioned name.

9. The Defendant's director, Mr. Chan Chak Yong (**Mr. Chan**), affirmed an affidavit on 19.8.2016 (court enc. no. 5) (**Defendant's 1st Affidavit**) to oppose This Action. According to the Defendant's 1st Affidavit, among others -

(1) the Registered Mark had been registered in good faith by the Defendant on 15.1.2003 and its validity had been renewed for another period of 10 years until 15.1.2023; and

(2) the Defendant had used the Registered Mark on the Defendant's Goods. The Defendant's 1st Affidavit exhibited, among others, the following documents to show the Defendant's use of the Registered Mark on the Defendant's Goods –

(a) an undated document (**Exhibit CCY-2**) which stated that the Registered Mark had been used on the Defendant's Goods;

(b) the 46th and 47th editions of the Federation of Malaysian Manufacturers' (**FMM**) directory in 2015 and 2016 respectively (**Exhibit CCY-3**), stated that "*GENESIS*" was one of the brand names of the Defendant;

- (c) photographs of T-shirts (**Exhibit CCY-4**) which had the imprints of the Defendant's logo and the word "*GENESIS*" under the title "*QUALITY BRANDS*";
- (d) invoices, packing lists, bills of lading, Customs Declaration Forms and Certificates of Origin issued by Perak Chinese Chamber of Commerce and Industry (**Certificates of Origin**) regarding sales of Defendant's Goods to purchasers in South Africa, Mauritius, Germany and Taiwan (**Exhibit CCY-5**); and
- (e) a photograph (**Exhibit CCY-7**) which showed a display of the Defendant's Goods bearing the Registered Mark in the Defendant's factory and office.

10. The Defendant's second affidavit affirmed by Mr. Chan on 4.10.2016 (court enc. no. 8) (**Defendant's 2nd Affidavit**) exhibited –

- (1) packing lists, invoices and delivery orders (**DO's**) regarding sales of Defendant's Goods bearing the Registered Mark (**Exhibit CCY-9**); and
- (2) photographs of Defendant's packages which used the Registered Mark (**Exhibit CCY-10**).

E. This Action

11. After the Plaintiff's solicitors had received the Defendant's 1st and 2nd Affidavits, the Plaintiff's solicitors served on the Defendant's solicitors a notice dated 14.10.2016 (Form 41 in Appendix A to RC) (**Form 41**) for the Defendant to produce the original copies of Exhibits CCY-5 and CCY-9 for inspection by the Plaintiff. The letter dated 14.10.2016 from the Plaintiff's solicitors to the Defendant's solicitors (which enclosed Form 41) also requested for the Plaintiff's inspection, all original documents related to the invoices in Exhibits CCY-5 and CCY-9 (**Related Documents**).
12. In response to Form 41, on 18.10.2016, the Defendant's solicitors served Form 42 (in Appendix A to RC) on the Plaintiff's solicitors which stated that the Plaintiff could inspect documents mentioned in Form 41 in the office of the Defendant's solicitors in Ipoh from 4.00 to 5.00 pm, 24.10.2016 (**Form 42**).

F. Whether Plaintiff is aggrieved by Registered Mark

13. The Defendant's learned counsel, Mr. Gerald Peter Samuel (**Mr. Samuel**), has contended that the Plaintiff is not aggrieved by the Registered Mark within the meaning of ss 45(1)(a) and 46(1) TMA because the Plaintiff has not been prejudiced by the Registered Mark. There was no prejudice to the Plaintiff because the Plaintiff has not shown any use of the "*GENESIS*" mark in Malaysia prior to the filing of the Plaintiff's Application. Mr. Samuel relied on the following 2 judgments of the Court of Appeal:

- (1) **McLaren International Ltd v Lim Yat Meen** [2007] 7 MLJ 581; and
- (2) **Al Baik Fast Food Distribution Co SAE v El Baik Food Systems Co SA & another appeal** [2016] 5 MLJ 768.

14. The relevant parts of ss 45(1)(a) and 46(1) TMA are reproduced below:

“s 45 Rectification of the Register

(1) Subject to the provisions of this Act -

(a) the Court may on the application in the prescribed manner of any person aggrieved by the non-insertion in or omission from the Register of any entry or by any entry made in the Register without sufficient cause or by any entry wrongfully remaining in the Register, or by any error or defect in any entry in the Register, make such order for making, expunging or varying such entry as if thinks fit; ...

s 46 Provisions as to non-use of trade mark

(1) Subject to this section and to section 57, the Court may, on application by a person aggrieved, order a trade mark to be removed from the Register in respect of any of the goods or services in respect of which it is registered on the ground -

(a) that the trade mark was registered without an intention in good faith, on the part of the applicant for registration or, if it was registered under subsection 26(1), on the part of the body corporate or registered user concerned, to use the trade mark in relation to those

goods or services and that there has in fact been no use in good faith of the trade mark in relation to those goods or services by the registered proprietor or registered user of the trade mark for the time being up to the date one month before the date of the application; or

(b) that up to one month before the date of the application a continuous period of not less than three years had elapsed during which the trade mark was a registered trade mark and during which there was no use in good faith of the trade mark in relation to those goods or services by the registered proprietor or registered user of the trade mark for the time being.

(2) Except where an applicant has been permitted under section 20 to register an identical or a nearly resembling trade mark in respect of the goods or services to which the application relates or the Court is of the opinion that the applicant can properly be permitted to register the trade mark, the Court may refuse an application made under subsection (1) -

(a) in relation to any goods, if there has been, before the relevant date or during the relevant period, as the case may be, use in good faith of the trade mark by the registered proprietor of the trade mark for the time being in relation to goods of the same description, being goods in respect of which the trade mark is registered; and

(b) ...

(3) Where in relation to goods in respect of which a trade mark is registered -

- (a) ***the matter referred to in paragraph (1)(b) are shown as far as regards failure to use the trade mark in relation to goods to be sold or otherwise traded in in a particular place in Malaysia (otherwise than for export from Malaysia) or in relation to goods to be exported to a particular market outside Malaysia; and***
- (b) ***a person has been permitted under section 20 to register an identical or nearly resembling trade mark in respect of those goods under a registration extending to the use in relation to goods to be sold or otherwise traded in in that place (otherwise than for export from Malaysia) or in relation to goods to be exported to that market, or **the Court is of the opinion that that person might properly be permitted to register the trade mark,*****

the Court may, on application by that person, direct that the registration of the first mentioned trade mark shall be subject to such conditions, amendments, modifications or limitations as the Court thinks proper for securing that that registration shall cease to extend to use of the trade mark in relation to goods to be sold or otherwise traded in that place (otherwise than for export from Malaysia) or in relation to goods to be exported to that market.

(3A) ...

(4) ***An applicant is not entitled to rely for the purpose of paragraph (1)(b) or for the purpose of subsection (3) or (3A) on any failure to use a trade mark if failure is shown to have been due to special circumstances in the trade and not to an intention not to use or***

to abandon the trade mark in relation to the goods to which the application relates.”

(emphasis added).

15. Firstly, This Action is based on s 46(1) TMA and not s 45(1)(a) TMA. Section 45(1) TMA is different from s 46(1) TMA. Section 45(1) TMA provides for the court’s general power to rectify the Register whereas s 46 TMA is a specific provision regarding the court’s power to rectify the Register based on the non-use of a registered trade mark. I rely on the Federal Court’s judgment in **McLaren International Ltd** [2009] 5 MLJ 741, at paragraph 7, delivered by Abdul Aziz Mohamad FCJ as follows:

[7] The essential difference between ss 45(1)(a) and 46(1) is that in an application under s 45(1)(a), some legally-recognised fault has to be shown to have been made in respect of the entry, whereas, in an application under s 46(1), no such fault has to be shown. What has to be shown is non-use of a trademark that may have been properly and faultlessly registered.”

(emphasis added).

16. Secondly, the Plaintiff bears the evidential burden under ss 103 and 106 of the Evidence Act 1950 (**EA**) to prove that the Plaintiff is aggrieved by the Registered Mark under s 46(1) TMA. This is because the Plaintiff alleges a “*particular fact*” that the Plaintiff is aggrieved by the Registered Mark within the meaning of s 103 EA. Furthermore, whether the Plaintiff is aggrieved or

not by the Registered Trade Mark is “*especially within the knowledge*” of the Plaintiff as provided in s 106 EA. If the Plaintiff fails to prove that the Plaintiff is aggrieved by the Registered Mark under s 46(1) TMA, This Action can be dismissed on this ground alone.

17. The Federal Court in **McLaren International Ltd**, at paragraphs 18 and 22, has affirmed the Court of Appeal’s decision but has given a wide meaning of “*aggrieved person*” in s 46(1) TMA as follows:

[18] ... The appellants have decided not to rely on their application under s 45. Therefore the references to that section in the two questions are to be disregarded. The appellants rely only on their application under s 46(1), and they rely only on para (b) of the section. Paragraph (a) is therefore not involved in this appeal. Only para (b) is involved in this appeal.

...

[22] We understand that passage as laying down the principle that a person aggrieved is a person who has used his mark as a trademark - or who has a genuine and present intention to use his mark as a trademark - in the course of a trade which is the same as or similar to the trade of the owner of the registered trademark that the person wants to have removed from the register.”

(emphasis added).

18. The Plaintiff’s learned counsel, Mr. Ong Boo Seng (**Mr. Ong**), has relied on the Court of Appeal’s judgment in **Liwayway Marketing Corporation v**

Oishi Group Public Co. Ltd. [2017] 2 CLJ 286 to support This Action. In the course of preparing this judgment, I discovered that the Federal Court in a judgment dated 27.3.017 (delivered by Balia Yusof Hj. Wahi FCJ) has reversed the Court of Appeal's decision in **Liwayway Marketing Corporation** [2017] 1 LNS 374. The Federal Court in **Liwayway Marketing Corporation**, at paragraphs 11-13, has affirmed the following trilogy of Federal Court cases regarding the meaning of "*aggrieved person*" in ss 45(1)(a) and 46(1) TMA:

- (1) **McLaren International Ltd**;
- (2) the judgment of Zulkefli CJ (Malaya) in **LB (Lian Bee) Confectionary Sdn Bhd v QAF Ltd** [2012] 4 MLJ 20; and
- (3) Azahar Mohamed FCJ's judgment in **Mesuma Sports Sdn Bhd v Majlis Sukan Negara Malaysia (Pendaftar Cap Dagangan Malaysia, interested party)** [2015] 6 MLJ 465.

19. Mr. Ong had relied on Ramly Ali J's (as he then was) judgment in the High Court case of **Godrej Sara Lee Ltd v Siah Seong Teck & Anor (Part 2)** [2007] 7 MLJ 164, at paragraph 16, which held that a party was aggrieved by a registered trade mark (in favour of another party) if the party's application to register a trade mark had been obstructed by the registered trade mark. I am not able to accept this contention in view of the Federal Court's judgment in **McLaren International Ltd**, at paragraph 20, as follows:

“[20] ... A person whose application for registration of his trademark is jeopardised by s 19(1) cannot, without more, qualify as a person aggrieved, because he could be a mere busybody. An answer in the affirmative that the appellants want to question (a) would uphold Abdul Malik Ishak J's statement in Fazaruddin, which was made without any supporting authority. The proposal in the statement had been rejected ten years before in Re Arnold D Palmer, in the following passage at p 686 which contains the words that the Court of Appeal cited:

... The registration of a trademark in the name of a proprietor, once effected, ought not to be disturbed by persons who have no trading interest in the goods concerned. If an applicant for rectification has no such interest to begin with, and therefore cannot suffer any damage at all by the existence of a conflicting trademark on the register, it cannot be right, in principle, that the mere filing of his application can confer the necessary locus standi on the applicant for the purpose of rectifying proceedings. Otherwise, the test of grievance propounded in Powell's Trade Mark (1894) 11 RPC 7; [1894] AC 8 would be completely nullified by resorting to the simple expediency of applying to register the very mark the applicant seeks to expunge ...”

(emphasis added).

20. I am of the view that the Plaintiff has succeeded to discharge the evidential onus to prove that the Plaintiff is aggrieved by the Registered Mark under s

46(1) TMA. This decision is premised on one or more of the following 3 reasons:

(1) the Plaintiff has proven extensive use of “*GENESIS*” mark on Plaintiff’s Genesis Cars as a trade mark in the course of the Plaintiff’s trade in Malaysia which is **similar** to the Defendant’s trade in tyres. I find that there is a close similarity between car and tyre industries in respect of

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(a) the nature, purpose and use of cars and tyres; and

(b) the nature of the distributors, retailers and users of cars and tyres.

In the Federal Court case of **Yong Teng Hing B/S Hong Kong Trading Co & Anor v Walton International Ltd** [2012] 6 CLJ 337, at paragraphs 24, 31 and 33, Zulkefli Makinudin CJ decided that a registered proprietor of a trade mark of one class of goods can be aggrieved by the registration of another trade mark for a different class of goods. In this case, the Plaintiff’s “*GENESIS*” mark and the Registered Mark concern the same class of goods (Class 12).

In view of the above reasons, I find that the Plaintiff is a “*person aggrieved*” by the Registered Mark within the first part of the meaning of “*person aggrieved*” as explained by the Federal Court in **McLaren International Ltd**;

(2) the Plaintiff has a “*genuine and present intention*” to use “*GENESIS*” mark on Plaintiff’s Genesis Cars as a trade mark in the course of the Plaintiff’s trade in Malaysia which is similar to the Defendant’s trade in tyres, within the second part of the meaning of “*person aggrieved*” in **McLaren International Ltd**. The second part of the meaning of “*person aggrieved*” in **McLaren International Ltd**, does not require an actual use of the mark in question. As explained in **LB (Lian Bee) Confectionary**, at paragraph 14 –

“[14] *The threshold question for the purposes of s 46(1)(b) of the TMA is whether the applicant is a 'person aggrieved' such as to have the necessary locus standi to make the application and to invoke the court's jurisdiction. We are of the view that this is not an issue of 'competing rights' as in the way the question is posed by the appellant. A 'person aggrieved' under s 46(1) of the TMA need not be a person with any specific right. A 'person aggrieved' in this context may include someone with simply a bona fide intention to use a trademark that is registered but which has not been used by the registered proprietor or any registered user for a continuous period of not less than three years up to one month before the date of an application under s 46(1)(b) of the TMA to expunge. ...*

...

Thus a 'person aggrieved' may have no rights at all but merely a genuine intention to use a trademark that is registered but which has not been used by the registered proprietor.”

(emphasis added).

I refer to Azizah Nawawi J's judgment in the High Court case of **Philip Morris Brands Sarl v Rothmans Brands Sdn Bhd & Anor** [2016] 9 MLJ 98, at paragraph 20 (cited by Mr. Ong), as follows –

“[20] Having considered the affidavits and the submissions of the parties, I am of the considered opinion that the plaintiff is an aggrieved party as the plaintiff has been using its trademark Parliament in many jurisdictions with the intention of expanding its business in Malaysia under the said mark. The plaintiff had first introduced the Parliament trade mark in 1931 in the United States of America, and it has been/is selling its cigarettes bearing the trade mark Parliament in approximately 40 countries around the world. It has also registered its trade marks comprising the word Parliament in approximately 60 jurisdictions around the world. Added to that, the plaintiff has filed an application to register its trademark Parliament in Malaysia on 5 March 2007. All these clearly show the commercial intention of the plaintiff to expand the use of its trademark Parliament into the Malaysian market.”

(emphasis added).

In this case, the Plaintiff's genuine and present intention to use “GENESIS” mark on Plaintiff's Genesis Cars as a trade mark in the course of the Plaintiff's trade in Malaysia is evidenced by –

- (a) the Plaintiff's registration of “GENESIS” trade mark in Class 12 goods in 45 countries outside Malaysia;

- (b) the Plaintiff has used and is still using “*GENESIS*” mark on Plaintiff’s Genesis Cars in the course of the Plaintiff’s trade throughout the world since 2008; and
- (c) the Plaintiff’s time, effort and money in advertising, promoting and marketing “*GENESIS*” mark worldwide; **and/or**
- (3) it is decided in **Mesuma Sports**, at paragraph 28, as follows –

“[28] A person aggrieved is a person who has used his mark as a trademark or who has a genuine and present intention to use his mark as a trademark in the course of a trade which is the same as or similar to the registered trademark that the person wants to have removed from the register. The person must be someone who has some element of legal interest, right or legitimate expectation in its own mark which is being substantially affected by the presence of the registered trademark. The interest and right must be legal or lawful.”

(emphasis added).

The Registered Mark applies to **all** goods in Class 12 (including motorcars) without any condition or limitation which can restrict the Defendant’s exclusive right to use the Registered Mark under s 35(1) TMA. In other words, the Defendant has an exclusive right under s 35(1) TMA to use the Registered Mark on cars in Malaysia. In fact,

paragraphs 11 and 20 of the Defendant's 2nd Affidavit have alleged that if the Plaintiff has goodwill and reputation in the "GENESIS" mark in Malaysia, this means that the Plaintiff has infringed the Registered Trade Mark wherein the Defendant is entitled to take action against the Plaintiff. It is therefore clear that the Plaintiff's "*legal interest, right or legitimate expectation*" in the "GENESIS" mark is adversely and substantially affected by the Registered Mark because the Defendant is entitled to file a trade mark infringement suit against the Plaintiff under s 38(1)(a) TMA. Accordingly, the Plaintiff is aggrieved by the Registered Mark under s 46(1) TMA as explained in **Mesuma Sports**.

21. Before I discuss the next issue in This Action, it is to be noted that whether an applicant is a "*person aggrieved*" under s 45(1)(a) or s 46(1) TMA is a question of fact – please see Hamid Sultan JCA's judgment in **Al Baik Fast Food Distribution**, at sub-paragraph 57(b).

G. Does s 37 TMA apply to an application under s 46(1) TMA?

22. Mr. Samuel has contended that as the Registered Mark has been registered for more than 7 years, the Registered Mark is conclusive under s 37 TMA and can only be removed if the Plaintiff is able to prove any one of the 3 circumstances stated in s 37(a) to (c) TMA. According to Mr.

Samuel, the Plaintiff has failed to prove the application of s 37(a) to (c) TMA in this case. The Defendant has relied on the following High Court decisions:

- (1) Ramly Ali J's (as he then was) judgment in **Abercrombie & Fitch Co & Anor v Fashion Factory Outlet KL Sdn Bhd & Ors** [2008] 4 MLJ 127; and
- (2) Azizah Nawawi J's decision in **Bonia International Holdings Pte Ltd & Anor v Simson Trading Sdn Bhd & Ors**, Kuala Lumpur High Court Civil Suit No. 22IP-11-03-2014.

23. Section 37 TMA provides as follows:

*“s 37 **Registration conclusive***

In all legal proceedings relating to a trade mark registered in the Register (including applications under section 45) the original registration of the trade mark under this Act shall, after the expiration of seven years from the date thereof, be taken to be valid in all respects unless it is shown –

- (a) that the original registration was obtained by fraud;*
- (b) that the trade mark offends against section 14; or*
- (c) that the trade mark was not, at the commencement of the proceedings, distinctive of the goods or services of the registered proprietor,*

except that this section shall not apply to a trade mark registered under the repealed Ordinances and incorporated in the Register pursuant to subsection 6(3) until after the expiration of three years from the commencement of this Act.”

(emphasis added).

24. I am not able to accept the contention that the Defendant can rely on s 37 TMA to resist This Action based on s 46(1) TMA. My reasons are as follows:

- (1) as explained in **McLaren International Ltd** and the above paragraph 15, s 45(1)(a) TMA is distinct from s 46(1) TMA;
- (2) the court’s general power to rectify the Register under s 45(1) TMA is subject to s 37 TMA. This is clear from the following –
 - (a) the words in s 37 TMA (*including applications under section 45*);
 - (b) the opening words in s 45(1) TMA (*Subject to the provisions of this Act*); and
 - (c) the judgment of James Foong JCA (as he then was) in the Court of Appeal case of **Bata Ltd v Sim Ah Ba & Ors** [2006] 3 CLJ 393, at paragraph 18;

- (3) based on the wording in s 46(1) TMA, s 46(1) TMA is only subject to the provisions of ss 46 and s 57 TMA [s 57 TMA concerns the registration of well known trade marks (**Well Known Trade Marks**) which has no relevance in This Action]. Consequently, except for ss 46 and 57 TMA, s 46(1) TMA is not subject to any other provision in TMA, including s 37 TMA. The Defendant cannot therefore rely on s 37 TMA to oppose This Action; and
- (4) if this court has accepted the above submission by Mr. Samuel, this will indirectly encourage the undesirable practice of trade mark squatting in the following manner –
- (a) X is a proprietor of a trade mark (**Mark “Z”**) which has been registered outside Malaysia;
 - (b) X has used extensively Mark “Z” on X’s goods or services outside Malaysia wherein Mark “Z” is distinctive of X’s goods or services;
 - (c) Y is unrelated to X but Y has managed to register Mark “Z” in Y’s name in Malaysia (**Y’s Registered Mark**);
 - (d) Y has not used Y’s Registered Mark on Y’s goods or services in Malaysia. The registration of Y’s Registered Mark is purely a trade mark squatting by Y with Y’s intention to benefit improperly by “*expecting*” a substantial payment from X to Y for the removal of Y’s Registered Mark from the Register; and

- (e) Y's Registered Mark has been registered for more than 7 years. If X intends to use Mark "Z" on X's goods or services in Malaysia, X has to apply to remove Y's Registered Mark from the Register under s 46(1)(a) and/or (b) TMA based on Y's non-use of Y's Registered Mark.

If s 46(1) TMA is subject to s 37 TMA (as contended by the Defendant), X has an additional burden to prove any one of 3 exceptions in s 37(a) to (c) TMA (**Additional Burden**). The Additional Burden will make it more difficult for X (in terms of time, effort and costs) to expunge Y's Registered Mark from the Register. This will indirectly encourage trade mark squatting.

- 25. The 2 High Court cases cited by Mr. Samuel, **Abercrombie & Fitch Co** and **Bonia International Holdings**, did not decide that s 46(1) TMA is subject to s 37 TMA. In fact, **Abercrombie & Fitch Co** concerned a summary judgment application for trade mark infringement under s 38(1) TMA [not an expungement application under s 46(1) TMA].

H. Application of s 46(1)(a) and (b) TMA

- 26. I am of the following view regarding the application of s 46(1) TMA:

- (1) paragraphs (a) [**Paragraph (a)**] and (b) [**Paragraph (b)**] of s 46(1) TMA provide 2 separate grounds to remove a registered trade mark

from the Register based on the non-use of the registered trade mark. This is supported by the following 2 reasons -

- (a) the use of the disjunctive word “or” between Paragraphs (a) and (b) shows that both Paragraphs (a) and (b) are intended by the legislature to be distinct – please see **Godrej Sara Lee**, at paragraph 10; and
- (b) a semicolon has been employed in demarcating Paragraph (a) from Paragraph (b). Courts may rely on a punctuation mark in the construction of statutes – please see Abdoolcader SCJ’s judgment in the majority decision of the Supreme Court in **Dato Mohamed Hashim Shamsuddin v Attorney-General, Hong Kong** [1986] 2 MLJ 112, at 122;

(2) Paragraph (a) applies in the following manner –

- (a) Paragraph (a) cannot be used to expunge Well Known Trade Marks from the Register – please see ss 46(1) and 57(1) TMA;
- (b) a trade mark has been registered by a party (**W**) without an intention in good faith on the part of the following persons to use the trade mark in relation to the goods or services for which the trade mark has been registered –
 - (i) W; or

- (ii) the body corporate to which W intends to assign the trade mark [please see s 26(1)(a) TMA]; or
- (iii) registered user [please see ss 26(1)(b), 48(1) and (5) TMA].

In the High Court case of **E-Toyo Global Stationery Sdn Bhd v Toyo Ink Sdn Bhd & Ors, The Registrar of Trade Marks (Interested Party)** [2005] 1 MLJ 445, at paragraph 43, Ramly Ali J (as he then was) interpreted “*good faith*” as follows –

“43. In both sub-paras (a) and (b) of s 46(1), the words 'good faith' play a role. In this context, the Law of Intellectual Property by Staniforth Ricketson, at para 37.13 at p 727 states as follows:

In this context, 'good faith' means 'genuine', rather than 'honest' or 'without deceit or intention to defraud'. Thus, the intended or actual use must not be colourable, as would be the case where the mark is used in advertisements without the goods or services in respect of which it is used being made available.”

(emphasis added);

- (c) there has in fact been no use in good faith of the trade mark up to the date 1 month before the date of the application to remove the trade mark under Paragraph (a) (**Relevant Date**) [please see s 46(1)(a), (2)(a) and (b) TMA]; and
 - (d) the court has a discretion –
 - (i) not to remove the trade mark from the Register [please see s 46(1), (2)(a) and (b) TMA]; or
 - (ii) to remove the trade mark from the Register; and
- (3) Paragraph (b) operates in the following manner –
- (a) Paragraph (b) cannot be used to remove Well Known Trade Marks from the Register – please see ss 46(1) and 57(1) TMA;
 - (b) up to 1 month before the Relevant Date, a continuous period of not less than 3 years had elapsed (**Relevant Period**) during which there was no use in good faith of the trade mark (in relation to the goods or services for which the trade mark has been registered) by –
 - (ba) W [please see **McLaren International Ltd** (at paragraph 28), **LB (Lian Bee) Confectionary** (at paragraph 21) and **Al Baik Fast Food Distribution** (at paragraphs 69-72)]; or

- (bb) registered user [please see s 48 TMA, **McLaren International Ltd** (at paragraph 29) and **LB (Lian Bee) Confectionary** (at paragraph 27)].

The following cases have explained the above requirement of Paragraph (b) –

- (i) it was decided in **E-Toyo Global Stationery**, at paragraphs 44 and 45, as follows -

“[44] It is the onus of the applicant in this case to establish a prima facie case of 'non-use' of the trade mark 'TOYO' both by the first respondent as the registered proprietor as well as by the second respondent as registered user. ...

[45] If the applicant fails to establish such prima facie case of 'non-use' of the trade mark, there would be no requirement for the registered proprietor (the first respondent) to show that it had used the mark in question during the relevant period. ...”

(emphasis added);

- (ii) the Federal Court in **Liwayway Marketing Corporation**, at paragraphs 30 and 35, has applied the above ruling in **E-Toyo Global Stationery**; and
- (iii) it was decided in **Godrej Sara Lee**, at paragraph 19 -

“[19] Case law has suggested that all the applicant for rectifications have to prove at the outset is prima facie case of non-use. Once this is done, the burden falls upon the registered proprietor being the first respondent (in the present case) to show evidence of use during the material period of time (Trina Trade Mark (1977) RPC 131).”

(emphasis added).

I must point out that **Godrej Sara Lee** concerns the shifting of the **evidential burden** and not the **overall legal burden** of proof. The overall legal burden of proof in an application under s 46(1) TMA remains solely with the plaintiff as provided in ss 101(1) and (2) EA – please see Jeffrey Tan FCJ’s judgment in the Federal Court case of **Letchumanan Chettiar Alagappan [as executor to SL Alameloo Achi (deceased)] & Anor v Secure Plantation Sdn Bhd [2017] 5 CLJ 418**, at paragraphs 51-59;

- (c) Paragraph (b) does not apply if the failure to use the trade mark is shown to have been due to special circumstances in the trade

and not to an intention not to use or to abandon the trade mark [please see s 46(4) TMA]. It was decided in **Godrej Sara Lee**, at paragraphs 31-33, as follows -

“[31] There are no Malaysian decisions on this point [s 46(4) TMA], but there are some UK decisions which have interpreted a pari materia provision under s 26 of the UK Trade Marks Act 1938 which could shed light on this issue.

*[32] In the decision in **BULOVA Trade Mark** (1967) RPC 29, Ungood Thomas J held relying on the decision of Evershed LJ in the case of **Aktiebolaget manus v Fullwood & Blkand Ltd** (1949) 66 RPC 71 as follows:*

It seems to me that both what Evershed LJ refers to as 'the ordinary and common sense meaning of the words' of the section and his own observations lay down that, if 'peculiar or abnormal', 'external' circumstances exist due to which there is non-use, then the requirement of the section is satisfied. Thus it is enough that there are special circumstances in the sense circumstances making any ordinary usage of international trade impracticable, if that is the reason for the trader's non-use of a mark.

[33] Two conditions thus have to be satisfied which are as follows:

- (i) the special circumstances must be peculiar or abnormal and must be external in nature: and**
- (ii) the non-use must be as a result of those circumstances.”**

(emphasis added); and

(d) the court has a discretion –

- (i) not to remove the trade mark from the Register [please see s 46(1), (2)(a) and (b) TMA];
- (ii) to remove the trade mark from the Register – please see **Godrej Sara Lee**, at paragraph 43; or
- (iii) to order a registered trade mark to be subject to “*conditions, amendments, modifications or limitations*” [please see s 46(3)(a), (b), (3A)(a) and (b) TMA].

In **Tokai Corporation v DKSH Malaysia Sdn Bhd** [2016] MLJU 621, at paragraphs 89-91, I have followed the English Court of Appeal case of **J. Lyons & Coy Ltd’s Application (Hostess)** [1959] RPC 120 as follows –

“89. On the assumption that there was no use in good faith of the Registered Trade Mark in relation to goods in Class 34 by the Defendant during the Relevant Period, I will now consider the question of whether the Court has a discretion not to remove the Registered Trade Mark under s 46(1)(b) TMA.

90. As explained above, s 26(1)(b) TMA 1938 (UK) is similar to our s 46(1)(b) TMA. Hence, the persuasiveness of English cases on this matter. **In the English Court of Appeal case of J. Lyons & Coy Ltd’s Application (Hostess) [1959] RPC 120 -**

(1) Evershed MR (as he then was), at p. 130,

(2) Romer LJ (as he then was), at p. 134, and

(3) Ormerod LJ (as he then was), at p. 136

- **had decided that the Court had a discretion under s 26(1) TMA 1938 (UK) not to expunge a registered trade mark from the Register for non-use by its registered proprietor.** On the facts in **J. Lyons & Coy Ltd’s Application**, the Court of Appeal reversed the High Court’s decision and exercised its discretion to expunge a registered trade mark from the Register for non-use by its registered proprietor.

91. **I accept J. Lyons & Coy Ltd’s Application and hold that the Court has a discretion under s 46(1)(b) TMA to remove or otherwise a registered trade mark from the Register for non-use**

by its registered proprietor. Such a decision is supported by the following:

(1) s 46(1) TMA employs the permissive term “may”; and

(2) s 46(1) TMA is expressly made subject to, among others, the other sub-sections in s 46 TMA. Section 46(2) TMA clearly confers a discretionary power on the Court to refuse an application under s 46(1) TMA in the circumstances stated in s 46(2)(a) or (b) TMA.”

(emphasis added).

I. Whether Plaintiff can rely on Investigation Report

27. Mr. Tam Tuck Ming (**Mr. Tam**) is a PI for ZBSS. Mr. Tam affirmed an affidavit on 29.7.2016 (**Mr. Tam’s Affidavit**) which alleged, among others, as follows:

(1) the Investigation Report dated 4.3.2016 contained the results of investigations carried out by Mr. Tam and his team from 1.3.2016 to 3.3.2016 on whether the Defendant had used the Registered Mark on the Defendant’s Goods in the course of trade in Malaysia;

(2) the Market Survey Report dated 18.4.2016 had been prepared based on investigations carried out by Mr. Tam and his team on 12.4.2016; and

- (3) Mr. Tam confirmed that the Investigation Report and Market Survey Report were correct in respect of the conduct and results of the investigations.

28. According to the Investigation Report –

- (1) the PI visited the Defendant's factory and office premises in Ipoh (**Defendant's Premises**) on 1.3.2016;
- (2) the PI managed to fix an appointment to meet the Defendant's General Manager (**GM**), Mr. Vincent CE Chan (**Mr. Vincent**), at 11 am, 3.3.2016 at the Defendant's Premises;
- (3) on 3.3.2016, the PI met Mr. Vincent at the Defendant's Premises and the following transpired –
 - (a) Mr. Vincent gave his business card to the PI (**Mr. Vincent's Business Card**). Mr. Vincent's Business Card stated that Mr. Vincent is the Defendant's GM. A copy of Mr. Vincent's Business Card had been annexed to the Investigation Report;
 - (b) Mr. Vincent informed the PI, among others, that the Defendant had not manufactured any product bearing the Registered Mark (**Mr. Vincent's Statement**); and

(c) the Registered Mark was not seen anywhere in the Defendant's Premises; and

(4) a photograph of Mr. Vincent was annexed to the Investigation Report (**Mr. Vincent's Photograph**).

29. Mr. Samuel had submitted that the Investigation Report was a market survey report which was subject to the guidelines laid down by Whitford J in the English High Court case of **Imperial Group Plc v Philip Morris Ltd** [1984] RPC 293 (**Whitford's Guidelines**). With respect, the Investigation Report is not a market survey report which is subject to Whitford's Guidelines. The Investigation Report contained evidence obtained by Mr. Tam as a PI from Mr. Vincent during the PI's visit to the Defendant's Premises.

30. Firstly, I am of the view that Mr. Tam's Affidavit is admissible under O 41 r 5(1) RC as the averments in Mr. Tam's Affidavit contained only facts as Mr. Tam was able of his own knowledge to prove – please see **Tokai Corporation**, at sub-paragraph 16(2).

31. Sections 17(1) and 18(1) EA provide as follows:

“Admission and confession defined

17(1) An admission is a statement, oral or documentary, which suggests any inference as to any fact in issue or relevant fact, and

which is made by any of the persons and under the circumstances hereinafter mentioned.

Admission by party to proceeding, his agent or person interested

18(1) Statements made by a party to the proceeding or by an agent to any such party whom the court regards under the circumstances of the case as expressly or impliedly authorized by him to make them are admissions.”

(emphasis added).

I find Mr. Vincent’s Statement to be an admission by the Defendant within the meaning of ss 17(1) and 18(1) EA. This decision is based on the following reasons:

- (1) as explained in s 17(1) EA, Mr. Vincent’s Statement was an oral statement which suggested an inference as to a “*fact in issue*” (defined in s 3 EA to mean “*fact from which, either by itself or in connection with other facts, the existence, non-existence, nature or extent of any right, liability or disability asserted or denied in any suit*”), namely the Defendant did not manufacture any product bearing the Registered Mark. In other words, Mr. Vincent’s Statement proved that -

- (a) the Registered Mark had been registered by Defendant without an intention in good faith on the Defendant's part to use the Registered Mark in relation to the Defendant's Goods; and
 - (b) there had in fact been no use in good faith of the Registered Mark by the Defendant on the Defendant's Goods;
- (2) Mr. Vincent is an agent of the Defendant for the purpose of s 18(1) EA because Mr. Vincent is the Defendant's GM; and
- (3) Mr. Vincent's Statement had been made to Mr. Tam on the Defendant's Premises during working hours regarding the Defendant's business concerning the Registered Mark. In other words, Mr. Vincent's Statement had been made under circumstances which was expressly or impliedly authorized by the Defendant within the meaning of s 18(1) EA.

32. I attach weight to Mr. Tam's Affidavit regarding Mr. Vincent's Statement because -

- (1) Mr. Tam's allegation regarding Mr. Vincent's Statement is supported by the following undisputed documentary evidence –
 - (a) Mr. Vincent's Business Card;
 - (b) Mr. Vincent's Photograph; and

- (c) the 46th and 47th editions of FMM directory in 2015 and 2016 (Exhibit CCY-3 in the Defendant's 1st Affidavit) stated that Mr. Vincent was the Defendant's GM; and
- (2) none of the 4 affidavits of the Defendant deny Mr. Vincent's Statement. More importantly, the Defendant did not adduce any affidavit from Mr. Vincent to deny the truth of Mr. Vincent's Statement. Any factual averment in a party's affidavit which has not been denied by the opposing party, is deemed to have been admitted by the opposing party – please see the Federal Court's judgment delivered by Chong Siew Fai CJ (Sabah & Sarawak) in **Sunrise Sdn Bhd v First Profile (M) Sdn Bhd & Anor** [1996] 3 MLJ 533, at 541. Accordingly, the Defendant is deemed to have admitted Mr. Vincent's Statement.

In the High Court case of **USA PRO IP Ltd v Montford Services Sdn Bhd & Anor** [2016] 9 MLJ 258, in paragraphs 30-33, Azizah Nawawi J held that the first defendant company's failure to challenge the PI's affidavit (regarding, among others, the PI's visit to the first defendant company's address as stated in the records of the Companies Commission of Malaysia) meant that the first defendant company was deemed to have accepted the PI's affidavit.

J. Effect of Market Survey Report

33. According to the Market Survey Report –

- (1) prior to the market survey, the PI conducted online searches in Johore, Perak and Klang Valley whereby 17 outlets were selected with high possibility of possessing tyre products (**17 Outlets**);
- (2) the PI enquired from the relevant personnel in the 17 Outlets (**Personnel**) and verbally mentioned about the Registered Mark;
- (3) none of the 17 Outlets possessed goods bearing the Registered Mark;
and
- (4) all the Personnel who had been interviewed, had not come across or seen the Registered Mark.

34. Mr. Samuel urged this court to reject the Market Survey Report on the following grounds:

- (1) the Market Survey Report was inconclusive, flawed and misleading because it did not explicitly conclude whether there was use or non-use of the Registered Mark;
- (2) the Market Survey Report did not comply the Whitford Guidelines as follows –

- (a) the 17 Outlets had not been selected in such a manner so as to represent a relevant cross-section of the public;
 - (b) the Market Survey Report was not of a size which was statistically significant;
 - (c) the survey was not conducted fairly; and
 - (d) the Market Survey Report did not provide the questions asked of the Personnel. Furthermore, the Market Survey Report did not include a questionnaire to be answered by the Personnel; and
- (3) reliance had been placed on the Court of Appeal's judgment delivered by Mahadev Shankar JCA in **Lim Yew Sing v Hummel International Sports & Leisure A/S** [1996] 3 MLJ 7.

35. Regarding results of market survey, market research, market study or market inquiry, I adopt the following approach:

- (1) in **Chocosuisse Union Des Fabricants Suisses De Chocolat & Ors v Maestro Swiss Chocolate Sdn Bhd & Ors** [2013] 6 CLJ 53, at paragraphs 50 and 51, Zaharah Ibrahim JCA (as she then was) held in the Court of Appeal as follows -

- (a) the court must be cautious in accepting a market survey conducted by a party in a dispute; and
- (b) being cautious with a market survey does not mean that the market survey should be totally disregarded.

The above comments by the Court of Appeal on the results of market survey, have been affirmed on appeal by Richard Malanjum CJ (Sabah and Sarawak) in the Federal Court in **Maestro Swiss Chocolate Sdn Bhd & Ors v Chocosuisse Union Des Fabricants Suisses De Chocolat & another appeal** [2016] 2 MLJ 359, at paragraph 62.

Maestro Swiss Chocolate is a case on the tort of passing off and does not concern s 46(1) TMA. Having said that, I adopt the general approach laid down by the Court of Appeal in **Maestro Swiss Chocolate** regarding market surveys in respect of trade marks;

- (2) Whitford's Guidelines are merely guidelines laid down by case law and do not constitute a mandatory statutory requirement intended by Parliament to be applicable to all market surveys. A market survey's compliance with Whitford's Guidelines or otherwise, **may** constitute a reason for the court to accept or reject the market survey. In other words, a market survey's compliance with Whitford's Guidelines does not necessarily mean that the court must accept the results of the market survey. Similarly, the fact that a market survey has not

complied with Whitford's Guidelines, does not *ipso facto* mean that the market survey has to be rejected by the court;

(3) the court must give reasons in accepting or rejecting a market survey. If a market survey has complied with Whitford's Guidelines, the court may still refuse to give any weight to the market survey if there is a reason to reject the market survey. Conversely, if a market survey has failed to comply with Whitford's Guidelines, the court may still attach weight to the market survey if there is a reason for the court to do so; and

(4) whether the court accepts or rejects a market survey depends on the particular facts of the case in question. As such, decided cases on this matter are not binding precedents from the view point of the *stare decisis* doctrine.

36. Based on **Maestro Swiss Chocolate**, I am cautious regarding the Market Survey Report. I am aware that the Plaintiff had relied on a self-serving Market Survey Report which had been prepared at the Plaintiff's behest. After having cautioned myself as above, I accept the Market Survey Report in This Action for the following reasons:

(1) the results of the Market Survey Report are supported by Mr. Vincent's Statement. In the above paragraph 32, I have explained why I have attached great weight to Mr. Vincent's Statement; and

(2) the Defendant's 4 affidavits did not deny the truth of the Market Survey Report. As such, the Defendant is deemed to have admitted the truth of the Market Survey Report – please see **Sunrise**, at p. 541. In **USA PRO IP Ltd**, at paragraphs 30-33, the High Court has held that the first defendant company was deemed to have accepted the plaintiff company's affidavit regarding the results of a market survey because the first defendant company's affidavit did not dispute the truth of the market survey.

37. In **Lim Yew Sing**, at p. 16, the contents of the market survey had been disputed by the appellant. Consequently, **Lim Yew Sing** is easily distinguishable from this case and the Defendant cannot therefore rely on **Lim Yew Sing**.

K. Whether Plaintiff has proven a *prima facie* case of non-use of Registered Mark by Defendant

38. The Relevant Date for the application of Paragraph (a) was 29.7.2016 while the Relevant Period for the operation of Paragraph (b) was from 29.6.2013 to 29.6.2016.

39. Based on Mr. Vincent's Statement (please see the above paragraph 32), this court is satisfied that the Plaintiff has proven a *prima facie* case that the Defendant had not used the Registered Mark –

(1) up to the Relevant Date [regarding Paragraph (a)]; and

(2) during the Relevant Period [as regards Paragraph (b)].

The above decision is fortified by the Market Survey Report (please see the above paragraph 36). I rely on **USA PRO IP Ltd**, at paragraphs 37 and 38, as follows:

[37] It is also the submission of the first defendant that premised on the decision in Lam Soon Edible Sdn Bhd v Hup Seng Perusahaan Makanan (M) Sdn Bhd [2011] 7 MLJ 366; [2010] 5 CLJ 975, the investigations relied upon by the plaintiff did not meet the standard required of survey evidence.

[38] However, I agree with the plaintiff that unlike Lam Soon case, where the principal and only evidence of non-use was the market survey, the market investigations in this case were merely to supplement the other evidence of non-use. In this case, the principal evidence of non-use took the form of direct investigations into the activities of the defendant (just as in the case of Godrej Sara Lee)."

(emphasis added).

I am mindful that the Market Survey Report concerned investigations conducted by the PI from 1.3.2016 to 3.3.2016 which was not the Relevant Period. Mr. Vincent's Statement is the sole basis for deciding that there is a *prima facie* case that the Defendant had not used the Registered Mark

during the Relevant Period and the Market Survey Report is only relied upon by this court to fortify the above decision.

40. In accordance with **Godrej Sara Lee**, the **evidential burden** now shifts to the Defendant to prove the Defendant's use of the Registered Mark in good faith. I remind myself that the **overall legal burden** to prove This Action on a balance of probabilities still remains solely with the Plaintiff.

L. **Whether Defendant can rely on documents which had not been produced for Plaintiff's inspection**

41. O 24 rr 10, 12 and 16 RC provide as follows:

"O 24 r 10 Inspection of documents referred to in pleadings and affidavits

(1) Any party to a cause or matter shall be entitled at any time to serve a notice in Form 41 on any other party in whose pleadings or affidavits reference is made to any document requiring him to produce that document for the inspection of the party giving the notice and to permit him to take copies of that document.

(2) The party on whom a notice is served under paragraph (1) must, within four days after service of the notice, serve on the party giving the notice, a notice in Form 42 stating a time within seven days after the service thereof at which the documents, or such of them as he does not object to produce, may be inspected at a place specified in the

notice, and stating which of the documents he objects to produce and on what ground.

O 24, r 12 **Order for production to Court**

(1) At any stage of the proceedings in any cause or matter the Court may, subject to rule 13(1), order any party to produce to the Court any document in his possession, custody or power relating to any matter in question in the cause or matter that falls within one of the following descriptions:

- (a) *documents on which the party relies or will rely;*
- (b) *documents which could –*
 - (i) *adversely affect a party's case; or*
 - (ii) *support a party's case; and*
- (c) *documents which may lead to a series of inquiry resulting in the obtaining of information which may –*
 - (i) *adversely affect a party's case; or*
 - (ii) *support a party's case.*

O 24 r 16 **Failure to comply with requirement for discovery**

(1) If any party who is required by any of the foregoing rules, or by any order made thereunder, to make discovery of documents or to produce any documents for the purpose of inspection or any other purpose fails to comply with any provision of that rule or with that order, as the case may be, then, without prejudice, in the case of a failure to comply with any such provision, to rule 11(1), the Court may make such order as it thinks just including, in particular, an order that the action be dismissed or, as the

case may be, an order that the defence be struck out and judgment be entered accordingly.

...

(5) A party who is required by any rule in this Order, or by any order made thereunder, to make a discovery of documents or to produce any document for the purpose of inspection or any other purpose, but who fails to comply with any provision of that rule or with that order, as the case may be, may not rely on those documents save with the leave of the Court.”

(emphasis added).

42. According to the Plaintiff's affidavit affirmed by Mr. Wonhee Lee on 7.11.2016 (court enc. no. 14), the Defendant did not produce all the original documents of Exhibits CCY-5, CCY-9 and Related Documents for the Plaintiff's inspection on 24.10.2016 (**Inspection**).

43. Form 41 requested for original copies of certain –

- (1) invoices;
- (2) packing lists;
- (3) bills of lading;
- (4) Certificates of Origin;
- (5) Customs Declaration Forms; and
- (6) DO's

- exhibited in Exhibits CCY-5 and CCY-9.

44. Paragraph 6 of the Defendant's third affidavit affirmed by Mr. Chan on 28.10.2016 (court enc. no. 13) and paragraph 4 of the Defendant's fourth affidavit affirmed by Mr. Chan on 2.2.2017 (court enc. no. 27) stated that the Defendant only provided original copies of the Customs Declaration Forms and receipts by the Royal Customs Department (**Customs Receipts**) for the Inspection. It is clear that the Defendant did not produce at the Inspection –

(1) original copies of invoices, packing lists, bills of lading, Certificates of Origin and DO's exhibited in Exhibits CCY-5 and CCY-9 (**Defendant's Non-production of Original Exhibits**); and

(2) original copies of Requested Documents.

L(1). Effect of Defendant's Non-production of Original Exhibits

45. Under O 24 r 10(1) RC, the Plaintiff "*shall be entitled*" to inspect the original Exhibits CCY-5 and CCY-9 and to take copies thereof – please see the Court of Appeal's judgment delivered by Abdul Malik Ishak JCA in **Ong Boon Hua @ Chin Peng & Anor v Menteri Hal Ehwal Dalam Negeri, Malaysia** [2008] 3 MLJ 625, at paragraphs 23-25, regarding O 24 r 10(1) of the Rules of the High Court 1980 (**RHC**). O 24 r 10 RHC is similar to O 24 r 10 RC. The Plaintiff is not required by RC to apply to court for an order to compel the Defendant to produce original copies of Exhibits CCY-5 and

CCY-9 for the Plaintiff's inspection. In any event, the Defendant had agreed to the Inspection by serving Form 42 pursuant to O 24 r 10(2) RC.

46. I am of the following view regarding the Defendant's Non-production of Original Exhibits:

- (1) there is a breach of O 24 r 10(1) RC by the Defendant (**Defendant's Breach**) which **may** attract the application of O 24 r 16(1) **or** (5) RC;
- (2) under O 24 r 16(1) RC, the court "*may make such order as it thinks just*" – please see **Ong Boon Hua**, at paragraphs 27 and 60. As a result of the Defendant's Breach, the court has a discretion under O 24 r 16(1) RC to order that judgment in favour of the Plaintiff be entered against the Defendant in This Action. This court will not however exercise its discretion under O 24 r 16(1) RC to enter judgment against the Defendant in This Action as a consequence of the Defendant's Breach. This is because other than Exhibits CCY-5 and CCY-9, the Defendants' affidavits had also exhibited other documents and photographs regarding the Defendant's use of the Registered Mark (**Defendant's Other Documentary Evidence**). It is therefore unjust to enter judgment against the Defendant in This Action in favour of the Plaintiff based solely on the Defendant's Breach and without the Defendant's Other Documentary Evidence being considered by this court; and

(3) according to O 24 r 16(5) RC, except with leave of court, the Defendant may not rely on invoices, packing lists, bills of lading, Certificates of Origin and DO's when the original copies of these documents had not been produced for Inspection [**Defendant's Documents (Not Produced For Inspection)**]. O 24 r 16(5) RC is a new provision which not found in RHC. I am not able to find any previous Malaysian case which has interpreted O 24 r 16(5) RC.

The Defendant had not applied for leave of this court to rely on Defendant's Documents (Not Produced For Inspection) in This Action. Accordingly, in view of the Defendant's Breach, I exercise my discretion under O 24 r 16(5) RC to disallow the Defendant from relying on Defendant's Documents (Not Produced For Inspection) in this case.

L(2). Effect of Defendant's non-production of Related Documents

47. I accept Mr. Samuel's submission that the Defendant was only obliged under O 24 r 10(1) RC to produce for Inspection the original Exhibits CCY-5 and CCY-9. The Defendant has no obligation under O 24 r 10(1) RC to produce original copies of Related Documents for the Plaintiff's inspection. The Plaintiff should have applied to court under O 24 r 12(1) RC to order the Defendant to produce original copies of Related Documents to the court. The Plaintiff however did not make such an application pursuant to O 24 r 12(1) RC.

M. Whether Defendant had discharged evidential burden to prove use in good faith of Registered Mark

M(1). Meaning of “use in good faith of the trade mark” in s 46(1) TMA

48. I reproduce below the definition of “trade mark” in s 3(1) TMA as well as the meaning of the word “use” in s 3(2)(a) and (b) TMA:

“ “trade mark” means, except in relation to Part XI, a mark used or proposed to be used in relation to goods or services for the purpose of indicating or so as to indicate a connection in the course of trade between the goods or services and a person having the right either as proprietor or as registered user to use the mark whether with or without an indication of the identity of that person, and means, in relation to Part XI, a mark registrable or registered under the said Part XI;

3(2) *In this Act –*

(a) references to the use of a mark shall be construed as references to the use of a printed or other visual representation of the mark;

(b) references to the use of a mark in relation to goods shall be construed as references to the use thereof upon, or in physical or other relation to, goods; ...”

(emphasis added).

49. I am of the view that the phrase “*use in good faith of the trade mark*” in s 46(1)(a) and (b) TMA should be interpreted based on the definition of “*trade mark*” in s 3(1) TMA as well as the meaning of the word “*use*” in s 3(2)(a) and (b) TMA. Hence, for the purposes of s 46(1)(a) and (b) TMA, there is only “*use in good faith of the trade mark*” if the following 4 cumulative matters are proven:

(1) the trade mark is represented in print or visual form [s 3(2)(a) TMA] (**1st Limb**). In **Ooi Siew Bee & Ors v Zhu Ge Kong Ming Sdn Bhd & Anor** [2017] 2 AMR 161, at sub-paragraph 64(7)(b), I have decided as follows -

“64(7)(b) ... *If this Court gives credence to invoices which do not specifically refer to any trade mark, this will give rise to spurious claims of 1st User of trade marks based on invoices which may be issued for any goods (other than for the goods for which the trade marks are claimed).*”;

(2) the trade mark is used –

(a) “*upon*” goods [s 3(2)(b) TMA];

(b) the trade mark is used “*in physical*” relation to goods [s 3(2)(b) TMA]; **or**

(c) the trade mark is used in “*other relation to*” goods [s 3(2)(b) TMA]

(2nd Limb);

- (3) the trade mark is used “*for the purpose of indicating or so as to indicate a connection in the course of trade between the goods ... and a person having the right either as proprietor or as registered user to use the mark*” within the meaning of the definition of “*trade mark*” in s 3(1) TMA (**3rd Limb**); **and**
- (4) the trade mark is used in good faith (**4th Limb**) – please see **E-Toyo Global Stationery**, at paragraph 43 .

50. The above view is supported by the following cases:

- (1) the English High Court case of **Hermes Trade Mark** [1982] RPC 425 concerned the application of, among others, ss 26(1), 68(1) and (2) of the then United Kingdom’s Trade Marks Act 1938 [**TMA 1938 (UK)**]. Section 26 TMA 1938 (UK) is similar (not identical) to our s 46 TMA while the definition of “*trade mark*” in s 68(1) TMA 1938 (UK) is similar (not identical) to our definition of “*trade mark*” in s 3(1) TMA. Section 68(2) TMA 1938 (UK) is similar to our s 3(2)(a) and (b) TMA. Accordingly, I have no hesitation to apply **Hermes** in the construction of the phrase “*use in good faith of the trade mark*” in s 46(1)(a) and (b) TMA.

Falconer J (as he then was) held as follows in **Hermes**, at p. 429-430 -

“For use of a mark to constitute use which can be relied upon to defeat an attack of non-use under section 26(1)(b) it must be use in the course of trade. That is plain, I think, from the definitions which we find in section 68(1) and (2) of the Act. It will be remembered from section 26(1)(b), which I read earlier, that in order to defeat an application for removal the registered proprietor must show bona fide use of the mark in relation to the goods for which it is registered.

...

Subsection (2) of section 68 explains the term “use of a mark” in relation to goods as it is used in many sections in the Act. It says this, and again I miss out parts of the subsection which are not relevant for present purposes: “References in this Act to the use of a mark ... in relation to goods shall be construed as references to the use thereof upon, or in physical or other relation to, goods”, and if we take those words, “other relation” there - something other than actually being upon the goods or in physical relation to them - that would cover the use of the mark, as it seems to me, for example, in advertisements, in invoices, in orders and so on.

Putting those two definitions together, it seems to me that the use of a trade mark must be use upon or in physical or other relation to the goods in the course of trade.”

(emphasis added); and

(2) it was decided in **Godrej Sara Lee Ltd**, at paragraph 25, as follows –

“[25] Firstly, if the provisions of s 46 are to be considered, for us to be constituted and taken into account, the use must be in relation to the goods claimed in the registration. Merely seeking approval and obtaining it does not translate to actual use of the mark in the course of trade. A party may or may not follow up with use of the mark after approval has been secured. For actual use to arise, there must be use of the mark on or in relation to goods. This would include affixing the mark to the goods or in an advertisement, circular or a catalogue.”

(emphasis added).

M(2). Defendant’s contention

51. Mr. Samuel has relied on the following evidence to constitute the Defendant’s use of the Registered Mark so as to resist This Action:

- (1) the use of the Registered Mark in the Defendant’s website (Exhibit CCY-8);
- (2) the use of the Registered Mark in Exhibit CCY-3 (FMM’s directories);
- (3) the use of the Registered Mark on t-shirts (Exhibit CCY-4);
- (4) the use of the Registered Mark on packaging of the Defendant’s Goods (photographs in Exhibits CCY-7 and CCY-10); and

- (5) the use of the Registered Mark in commercial documents (Exhibits CCY-5, CCY-9 and CCY-10).

M(3). Publication in Defendant's website

52. I am not able to accept the Defendant's contention that the Defendant had used the Registered Mark in relation to the Defendant's Goods in the Defendant's website. My reasons are as follows:

- (1) Exhibit CCY-8 does not refer to the Registered Mark. Hence, the 1st Limb has not been fulfilled; and
- (2) there is no evidence in the Defendant's website that the Registered Mark has been used in relation to the Defendant's Goods so as to indicate a connection in the course of trade between the Defendant's Goods and the Defendant. In other words, the 2nd and 3rd Limbs have not been complied with. I rely on **Abercrombie & Fitch Co**, at paragraphs 73-75 (cited by Mr. Ong), as follows –

[73] Sale of goods bearing a trademark over the internet or via a website has been recognised as a use of the trademark.

[74] On appeal in 1-800 Flowers Inc v Phonenames Ltd [2002] FSR 12 CA, Buxton LJ has provided obiter these guidelines on whether use of a mark on the internet might be sufficient to constitute use of the mark in the United Kingdom for the purpose

of trademark law. Placing a mark on the internet from a non-United Kingdom location would not suffice. An active move, like direct encouragement to purchase the product or advertisement, would be necessary in order to establish the necessary use. In the United States personal jurisdiction cases can be divided into three categories:

- (1) Active Web Sites: cases ... where defendants actively conduct business on the internet in the forum state and personal jurisdiction is found;*
- (2) Intermediate Web Sites interactive web site cases ... where a user exchanges data with the host computer. In such cases, jurisdiction is determined by examining the level of interactivity and commercial nature of the information exchange;*
- (3) Passive Web Sites: sites that merely provide information or advertisements. Decisions ... refuse to find personal jurisdiction in such cases.*

[75] The learned author Teo Bong Kwang, in his book - Trade Mark Law and Practice in Malaysia(Butterworth, 2001) at p 364 says the following:

One thing is clear from the decisions of Jacob J and Buxton LJ stated above, that is, mere access of a web site which carries a particular trademark within the

United Kingdom is not sufficient to constitute use of that mark in the United Kingdom. There must be some 'additional steps' taken by the website owner in order to bring the mark into use in the United Kingdom. What these additional steps are, will presumably depend on the circumstances of each case. The most probable 'additional steps' are of course the actual provisions of the goods for sale over the Internet. Thus, if consumers access the web site and order the goods, as a result of the advertisement or information on the website, such transaction definitely qualifies as use of the trademark.”

(emphasis added).

M(4). Use of Registered Mark in Exhibits CCY-3 and CCY-4

53. Exhibit CCY-3 (FFM's directories) merely referred to the Registered Mark as one of the Defendant's brand names. Similarly, the t-shirts in Exhibit CCY-4 only stated the Defendant's logo and the Registered Mark. Exhibits CCY-3 and CCY-4 did not state that the Registered Mark had ever been used in relation to the Defendant's Goods so as to indicate a connection in the course of trade between the Defendant's Goods and the Defendant. It is clear that Exhibits CCY-3 and CCY-4 have not complied with the 2nd and 3rd Limbs. On this point, I accept Mr. Ong's contention based on **Hermes**, at p. 430, as follows:

“The directory advertisements in the present case were not advertisements by the proprietors put out in the course of trade in the goods covered by the registration at all. ... That was not use in the course of trade and, therefore, in my judgment, the registered proprietors cannot rely upon these directory advertisements at all, either standing alone or as part of the use as a whole to be taken account with the use relied upon in the steps of the re-launch.”

(emphasis added).

M(5). Photographs of Registered Mark on Defendant’s packages

54. The photographs in Exhibits CCY-7 and CCY-10 only showed the use of the Registered Mark on packages of the Defendant’s Goods. I am not able to accept Exhibits CCY-7 and CCY-10 as the Defendant’s use of the Registered Mark for the purposes of Paragraphs (a) and (b). This is because Exhibits CCY-7 and CCY-10 were not dated. Hence, Exhibits CCY-7 and CCY-10 cannot prove the Defendant’s use of the Registered Mark on the Defendant’s Goods -

(1) up to the Relevant Date [regarding Paragraph (a)]; and

(2) during the Relevant Period [as regards Paragraph (b)].

M(6). Exhibits CCY-2, CCY-5, CCY-9 and CCY-12

55. The Defendant cannot rely on the commercial documents in Exhibits CCY-5, CCY-9 and CCY-12 (Customs Declaration Forms and Customs Receipts) due to the following reasons:

- (1) as explained in the above sub-paragraphs 46(1) and (3), the Defendant cannot rely on Defendant's Documents (Not Produced For Inspection); and
- (2) Exhibit CCY-12 did not expressly refer to the Registered Mark. The 1st Limb has therefore not been fulfilled by Exhibit CCY-12.

56. I have not overlooked Exhibit CCY-2. I gave no credence to Exhibit CCY-2 because Exhibit CCY-2 did not state when the Registered Mark had been used on the Defendant's Goods. As such, Exhibit CCY-2 cannot prove the Defendant's use of the Registered Mark on the Defendant's Goods -

- (1) up to the Relevant Date [regarding Paragraph (a)]; and
- (2) during the Relevant Period [concerning Paragraph (b)].

M(7). Is there evidence of Defendant's use of Registered Mark in good faith?

57. In the event that I am wrong in deciding the way I did in the above Parts M(3) to M(6), I am of the view that there is no use in good faith of the Registered Mark by the Defendant. Such a finding of fact is fortified by the following evidence:

- (1) Mr. Vincent's Statement; and
- (2) the Defendant's Non-production of Original Exhibits.

M(8). Has Defendant discharged evidential burden to prove use of Registered Mark in good faith?

58. I find that the Defendant has failed to discharge the evidential onus to prove the Defendant's use in good faith of Registered Mark on the Defendant's Goods. Such a finding is premised on the following evidence and reasons:

- (1) the Defendant cannot rely on the evidence adduced in the Defendant's affidavits for reasons explained in the above Parts M(3) to M(7); and
- (2) if the Defendant had indeed manufactured the Defendant's Goods bearing the Registered Mark and had sold and exported such goods to various countries, it would have been easy for the Defendant to adduce the following evidence –

- (a) dated photographs regarding the manufacture, export and sale of the Defendant's Goods bearing the Registered Mark would have been exhibited in the Defendant's affidavits;
- (b) the Defendant would have filed in This Action affidavits from customers, distributors, retailers and shippers of the Defendant's Goods bearing the Registered Mark; and
- (c) genuine purchase orders, invoices, DO's, packing lists, bills of lading, Customs Declaration Forms, Customs Receipts and documentary proof of payment for the Defendant's Goods, would have been adduced by the Defendant in this case.

N. Whether Plaintiff has proven Paragraph (a) and/or (b)

59. In view of the above evidence and reasons, this court finds that the Plaintiff has proven on a balance of probabilities –

(1) Paragraph (a), namely -

- (a) the Registered Mark was registered without any intention in good faith on the Defendant's part, to use the Registered Mark in relation to all or part of the Defendant's Goods in Class 12; and

(b) there has been in fact no use in good faith of the Registered Mark by the Defendant in relation to all or part of the Defendant's Goods in Class 12 for the time being up to the Relevant Date; and

(2) Paragraph (b), namely there has been no use in good faith of the Registered Mark in relation to all or part of the Defendant's Goods in Class 12 by the Defendant during the Relevant Period.

O. Should court exercise discretion to remove Registered Mark from Register?

60. As explained in the above sub-paragraphs 26(2)(d) and (3)(d), even if a plaintiff has proven the application of Paragraphs (a) and/or (b), the court nevertheless has a discretion not to remove the registered trade mark from the Register.

61. Mr. Samuel has relied on **Al Baik Fast Food Distribution** to contend that the court should exercise its discretion to dismiss This Action solely on the ground of a delay of 13 years by the Plaintiff in filing This Action [from the time the Registered Mark was registered on 15.1.2003 to 29.7.2016 (when This Action was filed)]. I am not able to accede to this submission for the following reasons:

(1) the Defendants' affidavits did not specifically allege delay on the Plaintiff's part in the institution of This Action. Accordingly, the

Defendant cannot now raise the Plaintiff's delay at the submission stage; and

- (2) the Plaintiff had given a reasonable explanation in the Plaintiff's affidavit that the Plaintiff only became aware of the Registered Mark when the Registrar objected to the Plaintiff's Application based on the Registered Mark. Thereafter, the Plaintiff had acted with reasonable promptitude by filing This Action. In other words, the Plaintiff had not been guilty of unexplained and inordinate delay in filing This Action.

62. I exercise my discretion to remove the Registered Mark from the Register under s 46(1) TMA based on the following reasons:

- (1) based on Mr. Vincent's Statement, the Defendant has not used at all the Registered Mark on the Defendant's Goods. As such, the removal of the Registered Mark from the Register will not cause any prejudice to the Defendant;
- (2) if the Registered Mark remains on the Register, this means that the Defendant would have an unjust monopoly over the use of the Registered Mark when the Defendant has not used the Registered Mark at all. I accept VK Rajah JA's judgment in the Singapore High Court case of **Weir Warman Ltd v Research & Development Pty Ltd** [2007] 2 SLR 1073, at paragraph 42 (cited by Mr. Ong), as follows –

“42. Finally, the register is also meant to notify rival traders dealing in similar products of the rights over particular trade marks possessed by the registered proprietor. As such, it is also important that these registered marks be in actual use or be bona fide intended to be used by the registered proprietors; any contrary approach would result in unjust monopolies where devious registered proprietors could prevent the use of a mark by others despite not having any intention to use it, simply by reason of prior registration. Indeed, such "squatting" situations are addressed by most modern trade mark registration statutes, which require that the registrant has at least a bona fide intention to use a mark before registering it. ...”

(emphasis added);

- (3) the Plaintiff has adduced evidence regarding the wide use of the Plaintiff’s “GENESIS” mark throughout the world, including Malaysia. If the Registered Mark remains on the Register, there exists a real likelihood of confusion and/or deception among the Malaysia public regarding the Plaintiff’s “GENESIS” mark and the Registered Mark. As explained in the above sub-paragraph 20(1), there is a close similarity between car and tyre industries in respect of -
- (a) the nature, purpose and use of cars and tyres; and
 - (b) the nature of the distributors, retailers and users of cars and tyres; and

- (4) the Plaintiff is a genuine, reputable and extensive user of “GENESIS” mark on Plaintiff’s Genesis Cars throughout the world. There is no valid reason why the Plaintiff should not be allowed to use “GENESIS” mark in Malaysia.

P. Court’s decision

63. In summary –

- (1) the Plaintiff is aggrieved by the Registered Mark within the meaning of s 46(1) TMA;
- (2) s 37 TMA cannot be invoked to resist an application under s 46(1) TMA;
- (3) the Plaintiff could rely on the Investigation Report and Market Survey Report as the Defendant had not denied the truth of their contents. Accordingly, by way of Mr. Vincent’s Statement in the Investigation Report (supported by the Market Survey Report), the Plaintiff has proven a *prima facie* case that the Defendant has not used the Registered Mark within the meaning of Paragraphs (a) and (b);
- (4) this court exercises its discretion under O 24 r 16(5) RC to disallow the Defendant from relying on Defendant’s Documents (Not Produced For Inspection) in This Action;

- (5) for the purposes of Paragraphs (a) and (b), the Defendant has failed to discharge the evidential burden to prove the Defendant's use in good faith of Registered Mark on the Defendant's Goods;
- (6) Plaintiff has discharged the overall legal burden by proving Paragraphs (a) and (b) on a balance of probabilities; and
- (7) the court exercises its discretion under s 46(1) TMA to expunge the Registered Mark from the Register.

64. Based on the above evidence and reasons, the following order is made:

- (1) a declaration that the Registered Mark -
 - (a) was registered without any intention in good faith on the Defendant's part, to use the Registered Mark in relation to all or part of the Defendant's Goods in Class 12 and that there has been in fact no use in good faith of the Registered Mark by the Defendant in relation to all or part of the Defendant's Goods for the time being up to the Relevant Date; and
 - (b) there has been no use in good faith of the Registered Mark during the Relevant Period in relation to all or part of the Defendant's Goods in Class 12 by the Defendant; and

- (c) the Registered Mark is an entry that is wrongfully remaining in the Register;
- (2) an order that the Registrar shall –
- (a) rectify the Register by removing the Registered Mark from the Register and the whole of the entry relating to the Registered Mark within 14 days from the date of filing by the Plaintiff or the Plaintiff's solicitors of a copy of this judgment with the Registrar together with such form and payment of fees as may be required by the Registrar; and
 - (b) gazette the removal of the Registered Mark from the Register; and
- (3) costs of RM25,000 (**Costs Sum**) shall be paid by the Defendant to the Plaintiff and an allocatur fee shall be imposed on the Costs Sum.

65. In closing, I wish to place on record my gratitude to Mr. Ong and Mr. Samuel for their detailed written submission, without which this judgment is not possible.

WONG KIAN KHEONG
Judicial Commissioner
High Court (Commercial Division)
Kuala Lumpur

DATE: 26 MAY 2017

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