

IN THE HIGH COURT OF MALAYA IN KUALA LUMPUR
(COMMERCIAL DIVISION)
IN THE FEDERAL TERRITORY OF MALAYSIA
ORIGINATING SUMMONS NO: 24IP-16-09/2016

IN THE MATTER of Louis Vuitton
Malletier, 2, rue du Pont-Neuf,
75001 Paris, France

IN THE MATTER of s 46(1)(b) of the
Trade Marks Act 1976

IN THE MATTER of Trade Mark
Registration No. 95010243 in Class 25
registered in the name of Renown
Incorporated

BETWEEN

LOUIS VUITTON MALLETIER

... PLAINTIFF

AND

RENOWN INCORPORATED

... DEFENDANT

JUDGMENT

(Court enclosure no. 1)

A. Introduction

1. The plaintiff company (**Plaintiff**) is an international fashion house renowned for its high-end fashion goods under the brand "*Louis Vuitton*".

2. The defendant company (**Defendant**) is incorporated in Japan and has no business or office in Malaysia.
3. The Defendant had applied to the Registrar of Trade Marks (**Registrar**) to register a combination mark “ZEPHYR” (**ZEPHYR Mark**) for goods in class no. 25 (**Defendant’s Application**). In the Defendant’s Application, the Defendant had given to the Registrar the following addresses:
 - (1) the Defendant’s address in Japan, 8-8-20, Nishi-Gotanda, Shinagawa-ku, Tokyo, Japan (**Japanese Address**); and
 - (2) an address of service at Drewmarks Patents & Designs (Malaysia) Sdn. Bhd., 9th floor, Bangunan Getah Asli, 148, Jalan Ampang, 50450 Kuala Lumpur (**Defendant’s Address With Registrar**).
4. The Registrar had allowed the Defendant’s Application and consequently, ZEPHYR Mark with trade mark registration no. 95010243 had been registered in the Defendant’s favour in the Register of Trade Marks (**Register**) with effect from 28.9.1995 (**Defendant’s Registered Trade Mark**).
5. In this OS, the Plaintiff applies to court to expunge the Defendant’s Registered Trade Mark from the Register under s 46(1)(b) TMA on the ground that the Defendant has not used the Defendant’s Registered Trade

Mark in good faith. Initially, the OS was only served on the Defendant's Address With Registrar.

B. Sole issue

6. The only question raised in this case is whether by reason of s 79 of the Trade Marks Act 1976 (**TMA**) read with reg. 10 of the Trade Marks Regulations 1997 (**TMR**), the OS may be lawfully served by the Plaintiff only on the Defendant's Address With Registrar. If the answer to this issue is "yes", the Plaintiff need not apply for leave of this court to serve the OS on the Defendant out of jurisdiction of Malaysian courts as required by O 11 r 9(1) of the Rules of Court 2012 (**RC**).

C. Relevant provisions

7. Section 79 TMA, regs. 4, 9, 10 TMR, O 1 r 2(2), O 11 r 9 and O 62 r 4 RC are reproduced below:

*"s 79 TMA **Address for service***

*(1) **Where an applicant for the registration of a trade mark does not reside or carry on business in Malaysia, he shall give to the Registrar an address for service in Malaysia which shall be the address of his agent, and if he fails to do so, the Registrar may refuse to proceed with the application.***

*(2) **An address for service stated in the application or a notice of opposition shall, for the purposes of the application or notice of opposition, be***

deemed to be the address of the applicant or opponent, as the case may be, and all documents in relation to the application or notice of opposition may be served by leaving them at, or sending them by post to, the address for service of the applicant or opponent, as the case may be.

(3) *An address for service may be changed by notice in writing to the Registrar.*

(4) *Subject to subsection (1), the registered proprietor of a trade mark shall from time to time notify the Registrar in writing of any change in the Register and the Registrar shall alter the Register accordingly.*

(5) ***The address of the registered proprietor of a trade mark as appearing for the time being in the Register shall for all purposes under this Act be deemed to be the address of the registered proprietor.***

reg. 4 **Forms**

(1) *The forms referred to in these Regulations are those contained in the Second Schedule.*

(2) ***The forms shall be used in all cases in which they are applicable.***

reg. 9 **Address**

Where any person is, by the Act or these Regulations, bound to furnish the Registrar with an address, the address given shall in all cases be as full as possible for the purpose of enabling the place of trade or business of such person to be found easily.

reg. 10 TMR **Address for service**

(1) An applicant, opponent, registered proprietor or registered user of a trade mark who does not reside or carry on business in Malaysia shall file Form TM1 giving an address for service in Malaysia and such address may be treated as the actual address of the person for all purposes connected with the matter in question.

(2) Any other applicant, opponent, registered proprietor or registered user of a trade mark may, if he so desires; file Form TM 1 giving an address for service in Malaysia.

(3) Subject to regulation 7, Form TM 1 filed under these Regulations may be signed by an authorised agent and in any case in which the Registrar so requires shall be signed by the applicant, opponent, registered proprietor or registered user, as the case may be.

(4) In any case in which no address for service is filed at the Office, the Registrar may treat the business address in Malaysia, if any, of the person concerned as his address for service for all purposes connected with the matter in question.

(5) Any written communication addressed to a person at an address given by him or treated by the Registrar as his address for service shall be deemed to be properly addressed.

(6) The Registrar may, at any time that a doubt arises as to the continued availability of an address for service entered in the Register, request the person for whom it is entered, by letter addressed to his business address in the Register, to confirm the address for service or to provide another by filing Form TM 1, and if within two months of making such a

request the Registrar receives no confirmation or substitution of that address, he may strike the address off the Register.

O 1 r 2 RC **Application**

...

r 2(2) *These Rules do not have effect in relation to proceedings in respect of which rules have been or may be made under any written law for the specific purpose of such proceedings or in relation to any criminal proceedings.*

...

O 11 r 9 RC **Service of originating summons**

(1) *Subject to paragraph (2), service out of the jurisdiction of an originating summons is permissible with the leave of the Court.*

(2) *Where any proceedings begun by an originating summons might have been begun by writ, service out of the jurisdiction of the originating summons is permissible as aforesaid only if service of the notice of the writ out of the jurisdiction would be permissible had the proceedings been begun by writ.*

...

O 62 r 4 RC **Service on corporation**

(1) *Where an action is against a corporation, the writ may be served –*

(a) *by leaving a copy of it at the registered office (if any) of the corporation;*

(b) *by sending a copy of it by registered post addressed to the corporation at the office, or, if there are more offices than one at the principal office of the corporation, whether such office is situated within Malaysia or elsewhere;*

(c) *by handing a copy of it to the secretary or to any director or other officer of the corporation; or*

(d) *in the case of a foreign company registered under Part XI of the Companies Act 1965 by handing a copy of it to, or sending the same by registered post to, a person authorized to accept service of process on behalf of the foreign company.*

(2) ***The rule does not restrict the operation of the provisions of any written law as to service on any particular person or authority.***

...”

(emphasis added).

D. Plaintiff’s contentions

8. Ms. Chew Kherk Ying, the Plaintiff’s learned counsel, submitted as follows:

(1) the present s 79(1) TMA has been introduced by Trade Marks (Amendment) Act 1994 (Act A881). According to s 79(1) TMA, if an applicant to register a trade mark is a foreign person without an address in Malaysia (**Foreign Applicant**), the Registrar may refuse to register the Foreign Applicant’s trade mark if the Foreign Applicant does not provide “*an address for service in Malaysia which shall be the address*” of the Foreign Applicant’s trade mark agent. Such a statutory interpretation is fortified by reg. 10(1) and (5) TMR;

- (2) s 79(3) and (4) TMA provide the burden on a Foreign Applicant to update its address for service in Malaysia. The words “*Subject to subsection (1)*” in s 79(4) TMA means that a Foreign Applicant is still required to give an address for service in Malaysia (which shall be the address of the Foreign Applicant’s trade mark agent);
- (3) paragraphs 2.56 and 21.10 of the “*Manual of Trade Marks Law & Practice in Malaysia*” (**Manual**) published by the Malaysian Intellectual Property Corporation, support the above construction of s 79 TMA and reg. 10 TMR;
- (4) O 62 r 4(2) RC provides that O 62 r 4 RC “*does not restrict the operation of the provisions of any written law as to service on any particular person or authority*”. The term “*person*” is defined widely in s 3 of the Interpretation Acts 1948 and 1967 to include “*a body of persons, corporate or unincorporated*”; and
- (5) as there is no Malaysian case on the above statutory construction, Ms. Chew relied on Mummery J’s (as he then was) judgment in the English High Court case of **Johnson & Johnson’s Application** [1991] RPC 1. In **Johnson’s** case –
- (a) the appellant company had unsuccessfully opposed before the Registrar the application to register a trade mark by the respondent company (**Registrar’s Decision**);

- (b) the appellant company had appealed to the High Court against the Registrar's Decision by way of a notice of originating motion (**OM**);
- (c) the respondent company is an American company which does not reside or carry on business in the United Kingdom (**UK**);
- (d) the appellant company's solicitors served the OM on the respondent company's trade mark agent in UK. The respondent company raised, among others, a procedural objection that the service of the OM on the respondent company's trade mark agent in UK, was defective; and
- (e) the above procedural objection was dismissed on the ground that r 13 of UK's then Trade Mark Rules 1986 [**TMR 1986 (UK)**] allowed the OM to be served on the respondent company's trade mark agent in UK.

E. Initial decision

9. When the OS was first heard, I formed the view that the Plaintiff could not circumvent O 11 r 9(1) RC by serving the OS on the Defendant's Address With Registrar. Hence, I did not proceed to hear the OS despite the Plaintiff's service of the OS on the Defendant's Address With Registrar.

10. The Plaintiff subsequently applied for and obtained leave of court to serve the OS out of jurisdiction on the Japanese Address. Upon the service of the OS on the Japanese Address, the Defendant wrote a letter dated 19.1.2017 which stated that the Defendant had not used the Defendant's Registered Trade Mark in Malaysia and had no intention to oppose this OS. Accordingly, this OS is allowed with no order as to costs.

F. Construction of s 79 TMA and reg 10 TMR

11. After reconsidering this matter, except for the reliance on the Manual and O 62 r 4(2) RC, I am of the view that Ms. Chew is correct in the interpretation of s 79 TMA and reg. 10 TMR.

12. The Manual does not constitute "law" and cannot be resorted to in the construction of s 79 TMA and reg. 10 TMR. It is decided in **Kraft Foods Schweiz Holding GmbH v Pendaftar Cap Dagangan** [2016] 11 MLJ 702, in paragraph 27, as follows:

"Firstly, the Construction Issue cannot be answered by reference to the Registrar's Manual. This is because the Registrar's Manual does not constitute "law". Section 3 of the Interpretation Acts 1948 and 1967 (IA) provides that the term "law" has the meaning assigned by Article 160(2) of the Federal Constitution (FC). Article 160(2) FC provides -

" "law" includes written law, the common law in so far as it is in operation in the Federation or any part thereof, and any

custom or usage having the force of law in the Federation or any part thereof; ”

(emphasis added).

The term “written law” is defined in s 3 IA to mean, among others, FC, State Constitutions, Acts of Parliament and subsidiary legislation made thereunder.

It is clear that the Registrar’s Manual is not “law” and “written law” within the meaning of s 3 IA read with Article 160(2) FC. In any event, paragraph 1.3 of the Registrar’s Manual states that the Registrar’s Manual “is intended primarily for the guidance and instruction of the staff of the Trade Marks Registry”.

(emphasis added).

13. O 62 r 4(1) RC applies to service of writs (not the service of OS) on corporations. As such, O 62 r 4(2) RC permits other modes of service of writ (not the service of OS) on corporations as provided by any other written law.
14. Firstly, s 79(1) TMA provides that where a Foreign Applicant does not reside or carry on business in Malaysia, the Foreign Applicant “*shall give to the Registrar an address for service in Malaysia which shall be the address of his agent*”. The use of the mandatory term “*shall*” in s 79(1) TMA, in my view, means that the legislature has intended for this provision to be

mandatory. In the Federal Court case of **Public Prosecutor v Yap Min Woie** [1996] 1 MLJ 169, at 172-173, Mohd. Dzaidin FCJ (as he then was) gave effect to the mandatory term “*shall*”.

15. Secondly, Parliament has provided in s 79(5) TMA that the Defendant’s Address With Registrar “*shall for all purposes under [TMA] be deemed to be the address of the registered proprietor*”. Section 79(5) TMA –

(1) is a mandatory provision by reason of the use of the mandatory term “*shall*”; and

(2) has effect “*for all purposes*” under the TMA, including an application to expunge a registered trade mark under s 46(1)(b) TMA (such as this OS).

16. Regulation 10(1) TMR has the following 2 limbs:

(1) according to the first limb of reg. 10(1) TMR -

(a) a Foreign Applicant “*shall file Form TM1 giving an address for service in Malaysia*”. The use of the imperative term “*shall*” in reg. 10(1) TMR clearly means that this provision is mandatory; and

(b) Box no. 7 of Form TM 1 in the Second Schedule to TMR (**Form TM 1**) states that “*I request that all communication concerning the above trade mark be sent to the address indicated, which is the*

address for service". When a Foreign Applicant fills up Form TM 1, this means that the Foreign Applicant expressly requests that "*all communication*" concerning the Foreign Applicant's trade mark be sent to the address for service as stated in Form TM 1. The Foreign Applicant cannot subsequently insist on another mode of service regarding "*all communication*" regarding the Foreign Applicant's trade mark. It is to be noted that according to reg. 4(2) TMR, all forms in the Second Schedule to TMR, including Form TM 1, "*shall be used in all cases in which they are applicable*"; and

(2) the second limb of reg. 10(1) TMR provides that the Foreign Applicant's address for service in the Register "*may be treated as the actual address*" of the Foreign Applicant "*for all purposes connected with the matter in question*".

17. Regulation 10(5) TMR provides that any "*written communication addressed*" to the Foreign Applicant's "*address for service shall be deemed to be properly addressed*". Regulation 10(5) TMR has the following effect:

(1) reg. 10(5) TMR is a mandatory provision by reason of the employment of the mandatory term "*shall*"; and

(2) reg. 10(5) TMR deems any "*written communication addressed*" to the Foreign Applicant's "*address for service*" "*to be properly addressed*".

Regulation 10(5) TMR is similar to r 13(5) TMR 1986 (UK) which reads as follows –

“Anything sent to any person at an address filed by him as his address for service shall be deemed to be properly sent.”

(emphasis added).

Johnson’s case was based on r 13(5) TMR 1986 (UK). In view of the similarity between r 13(5) TMR 1986 (UK) and our reg. 10(5) TMR, I am of the view that **Johnson’s** case may be resorted to in the construction of reg. 10(5) TMR. As such, reg. 10(5) TMR deems any service of document on the Foreign Applicant’s address for service in the Register to be *“properly addressed”*.

It is to be noted that r 13(5) TMR 1986 (UK) is now replaced by rr 11 and 12 of the Trade Marks Rules 2008 (UK). Rule 11(8) of Singapore’s Trade Marks Rules, GN No. S 635/1998, provides as follows –

“Anything sent to or served on a person at his address for service shall be taken to have been duly sent to or served on the person.”

(emphasis added).

18. Regulation 9 TMR provides that where any person is bound to furnish to the Registrar with an address [in this case, bound by s 79(1), (4) TMA and

reg. 10(1) TMR], “*the address given shall in all cases be as full as possible for the purpose of enabling the place of trade or business of such person to be found easily*”.

19. As explained above –

(1) s 79(1) TMA;

(2) s 79(5) TMA;

(3) the first limb of reg. 10(1) TMR; and

(4) reg. 10(5) TMR

(4 Provisions)

- have expressly provided for service of any “*written communication*” “*for all purposes*” on the Foreign Applicant’s address for service in the Register. Accordingly, in view of the wording in the 4 Provisions, O 11 r 9(1) RC cannot apply by virtue of O 1 r 2(2) RC. In the Supreme Court case of **Lai Kim Loi v Dato’ Lai Fook Kim** [1989] 1 CLJ (Rep) 61, at 69-70, Gunn Chit Tuan SCJ (as he then was) did not apply the then applicable Rules of the High Court 1980 in a petition under s 218 of the Companies Act 1965 but instead applied the specific Companies (Winding Up) Rules 1972.

20. I acknowledge that the above interpretation of the 4 Provisions may result in possible injustice against foreign owners of registered trade marks (**Foreign Owners**) in the following circumstances:

(1) a plaintiff may only serve the originating process (**Suit**) on the Foreign Owner's address of service in the Register;

(2) for various reasons, the Foreign Owner may not have actual notice of the Suit; and

(3) the Foreign Owner may suffer the following possible injustice –

(a) judgment in default of appearance may be entered against the Foreign Owner; or

(b) the Suit may be heard and decided against the Foreign Owner in the absence of the Foreign Owner.

21. Despite the above construction of the 4 Provisions, a prudent plaintiff may still resort to O 11 r 9(1) RC and apply for leave of court to serve the OS out of the jurisdiction of Malaysian court.

G. Regulation 51 Patents Regulations 1986 (PR)

22. Regulation 51(1) and (2) PR provide as follows:

“reg 51. Address for service.

(1) Every person concerned with any proceedings under the Act or any regulation made thereunder and every owner of a patent shall furnish to the Registrar, on Form 20 together with the payment of the prescribed fee, an address for service in Malaysia, which may be treated for all purposes concerning or connected with such proceedings or patent as the address of the person concerned.

(2) Notwithstanding sub-regulation (1), where a patent agent has been appointed, the address for service shall be the address of the patent agent.

...”

(emphasis added).

23. In closing, I must refer to reg. 51(1) and (2) PR. I am of the view that in light of the wording of reg. 51(1) and (2) PR, these 2 provisions should be interpreted along the lines of the 4 Provisions.

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

DATE: 21 MARCH 2017

*Counsel for Plaintiff: Ms. Chew Kherk Ying, Mr. Woo Wai Teng & Mr. Yeoh Yao Huang
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