

**IN THE HIGH COURT OF MALAYA AT KUALA LUMPUR
(COMMERCIAL DIVISION)
IN THE FEDERAL TERRITORY OF KUALA LUMPUR, MALAYSIA
CIVIL SUIT NO: 22IP-36-07/2015**

BETWEEN

- 1. SRI PAANDI RESTAURANT SDN BHD**
(Co. No.: 570118-K)
- 2. SELVI RANI A/P KANDIAH**
(NRIC No.: 750723-07-5034) ... **PLAINTIFFS**

AND

- 1. SARASWATHY A/P KESAVAN**
(NRIC No.: 690810-08-5036)
[as sole proprietor of
Sri Paandi PJ (No.: 001271563-X),
Restoran Sri Paandi Corner (No.: 001485858-K),
Restoran Sri Paandi Kajang (No.: SA0002118-V),
Sri Paandi Music (No.: 001416971-H) dan
Restoran Sri Paandi Gasing (No.: SA0251873-U)]
- 2. SRI PAANDI HOLDINGS SDN BHD**
(Co. No.: 627532-K)
- 3. SRI PAANDI CASH & CARRY SDN BHD**
(Co. No.: 594082-V)
- 4. RESTAURANT & KATERING SRI PAANDI SDN BHD**
(Co. No.: 690765-A) ... **DEFENDANTS**

JUDGMENT

(Court enclosure No.122)

A. Introduction

1. Court enclosure no. 122 (**This Application**) is an application by the Registrar of Trade Marks (**Registrar**) to set aside a subpoena issued by the defendants (**Defendants**) to the Registrar to testify and produce documents in this case (**Subpoena**).

B. Issues

2. The following issues arise in This Application:
 - (1) whether a breach of reg. 74 of the Trade Marks Regulations 1997 (**TMR**) (which requires the Plaintiffs and Defendants to serve the cause papers of this suit on the Registrar) has any effect on This Application;
 - (2) whether the Defendants are barred by reg. 64(4) TMR from obtaining documents regarding the assignments of the Plaintiffs' trade marks which have been filed by the Plaintiffs with the Registrar (**Plaintiffs' Assignments**);

- (3) whether the court should set aside the Subpoena on the ground that the Subpoena is frivolous, vexatious and/or an abuse of court process due to one or more of the following reasons -
- (a) under s 65(1) of the Trade Marks Act 1976 (**TMA**), the Defendants may tender copies of searches (of Plaintiffs' trade marks) of the Register of Trade Marks (**Register**) as evidence in this case;
 - (b) the Defendants may apply for a Registrar's certificate regarding the Plaintiffs' trade marks (**Registrar's Certificate**) under s 65(2) TMA and reg. 89(1) TMR and admit the Registrar's Certificate as evidence in this suit;
 - (c) the Defendants should have applied for discovery of documents from the Registrar pursuant to O 24 r 7A(2) of the Rules of Court 2012 (**RC**); and/or
 - (d) the Federal Court has decided in **Ho Tack Sien & Ors v Rotta Research Laboratorium SpA & Anor, Registrar of Trade Marks (Intervener) & Another appeal** [2015] 4 CLJ 20, that the Registrar should not be made a party in an application to court to rectify the Register (**Rectification Suit**); and

- (4) whether the court should appoint the Registrar as a court expert to assist the court in this case under O 40 r 1 RC read with s 62(1) and (2) TMA.

C. Background

3. In this case –

- (1) the plaintiffs (**Plaintiffs**) have claimed, among others, that the Defendants have infringed certain trade marks registered by the Registrar in favour of the Plaintiffs (**Plaintiffs' Trade Marks**); and
 - (2) the Defendants have filed a counterclaim (**Counterclaim**) to expunge the Plaintiffs' Trade Marks under ss 45 and/or 46 TMA.
4. The trial of this case has commenced and in the midst of the Plaintiffs' case, the Defendants applied for and obtained the Subpoena.
 5. When This Application was first heard, I invited the Plaintiffs' learned counsel, Mr. Suaran Singh, to submit, in writing and orally, regarding This Application. Mr. Suaran has submitted in support of This Application.

D. Relevant provisions

6. The following provisions in TMA, TMR and RC will be discussed in this judgment:

“TMA

s 4 *Registrar, Deputy Registrars and Assistant Registrars*

...

(4) ***Subject to the general direction and control of the Registrar and to such conditions or restrictions as may be imposed by the Registrar, a Deputy Registrar or an Assistant Registrar may exercise any function of the Registrar under this Act, and anything by this Act appointed or authorized or required to be done or signed by the Registrar may be done or signed by any Deputy Registrar or Assistant Registrar and the act or signature of a Deputy Registrar or an Assistant Registrar shall be as valid and effectual as if done or signed by the Registrar.***

...

s 8 ***Inspection of Register***

(1) ***The Register shall be open to the inspection of the public at such times and in accordance with such conditions as may be prescribed.***

(2) ***Certified copies or extracts of any entry in the Register sealed with the seal of the Registrar shall be given to any person requiring the same on payment of the prescribed fees.***

...

s 62. *Hearing of Registrar*

(1) *In any legal proceedings in which the relief sought includes alteration or rectification of the Register, the Registrar shall have the right to appear and be heard, and shall appear if so directed by the Court.*

(2) *Unless otherwise directed by the Court, the Registrar, in lieu of appearing and being heard, may submit to the Court a statement in writing signed by him, giving particulars of the proceedings before him in relation of the matter in issue or of the grounds of any decision given by him affecting the same or of the practice of the office in like cases, or of such other matters relevant to the issues, and within his knowledge as Registrar, as he thinks fit, and such statement shall be deemed to form part of the evidence in the proceedings.*

s 65 *Sealed copies to be evidence*

(1) *Printed or written copies or extracts of or from the Register purporting to be certified by the Registrar and sealed with his seal shall be admissible as evidence in any proceedings before any court of law without further proof or production of the originals.*

(2) *A certificate purporting to be under the hand of the Registrar as to any act which he is authorized under this Act to perform and which he has or has not performed, as the case may be, shall be prima facie evidence in any proceedings before any court of law of his having or not having performed the act.*

TMR

reg. 63 Application for entry of subsequent proprietor.

(1) Where a person becomes entitled by assignment or transmission to a registered trade mark he shall make application to register his title by filing Form TM 15 accompanied by the prescribed fee.

...

reg. 64 Particulars to be provided

...

(2) There shall be filed with the application for retention by the Registrar, an attested copy of the instrument under which the applicant claims his entitlement.

(3) The Registrar may at any time, by notice in writing sent to the applicant, require him to produce for inspection any instrument of which an attested copy has been filed.

(4) An instrument or attested copy of the instrument furnished in accordance with this regulation shall not be opened for public inspection.

...

reg. 74 Application to the court

A copy of every application to the court under the Act shall be filed at the Office by the applicant.

reg. 89 Certificate by Registrar

(1) Subject to subregulation (2), any person may, by filing Form TM 25 accompanied by the prescribed fee, request the Registrar to give

a certificate as to any entry, matter or thing which the Registrar is authorised or required by the Act or these Regulations to make or do, other than a certificate of registration issued under subsection 30(2) of the Act.

(2) *Before giving a certificate under subregulation (1), the Registrar may, if he thinks fit, require the person making the request to show to his satisfaction an interest in the entry, matter or thing in question and if he is not so satisfied he may decline to furnish the certificate.*

...

RC

O 24 r 7A ***Discovery against other person***

...

(2) ***An application after the commencement of proceedings for an order for the discovery of documents by a person who is not a party to the proceedings shall be made by a notice of application, which shall be served on that person personally and on every party to the proceedings.***

...

O 38 r 14 ***Form and issue of subpoena***

(1) ***A subpoena shall be in Forms 63, 64 and 65, whichever is appropriate.***

...

O 38 r 16 ***Subpoena to produce documents***

(1) ***A subpoena to produce documents shall contain the name of one person only.***

(2) Any person served with a subpoena to produce documents shall sufficiently comply if he causes the document to be produced without attending personally.

O 40 Court Expert

r 1 Appointment of expert to report on certain question

(1) In any cause or matter in which any question for an expert witness arises, the Court may at any time, on its own motion or on the application of any party, appoint an independent expert or, if more than one such question arises, two or more such experts, to inquire and report upon any question of fact or opinion not involving questions of law or of construction.

...

O 92 r 4 Inherent powers of the Court

For the removal of doubt it is hereby declared that nothing in these Rules shall be deemed to limit or affect the inherent powers of the Court to make any order as may be necessary to prevent injustice or to prevent an abuse of the process of the Court.”

(emphasis added).

E. Whether reg. 74 TMR affects This Application

7. I am of the view that reg. 74 TMR has no bearing on This Application because the Registrar could have easily requested for both the Plaintiffs and Defendants to serve the cause papers of this suit on the Registrar. Furthermore, even if it is assumed that reg. 74 TMR has been breached by

the Defendants, I fail to see how such a breach can prejudice the Registrar in any manner in This Application.

F. Does reg. 64(4) TMR bar Defendants from obtaining Plaintiffs' Assignments?

8. The Registrar's Legal Officer, Cik Iylia bt. Hashim, has contended that by reason of reg. 64(4) TMR, the Defendants are not entitled to a copy of the Plaintiffs' Assignments. Accordingly, This Application should be allowed in respect of the Plaintiffs' Assignments, namely, the Registrar should not be compelled by the Subpoena to produce a copy of the Plaintiffs' Assignments in this suit.
9. Learned counsel for the Registrar, Plaintiffs and Defendants did not refer to any previous Malaysian case which has interpreted reg. 64(4) TMR. My research has also failed to find any Malaysian precedent on reg. 64(4) TMR.
10. I am unable to accede to the Registrar's above construction of reg. 64(4) TMR. My reasons are as follows:
 - (1) according to reg. 63(1) TMR, an assignee of a registered trade mark (**Assignee**) may file an application in Form TM15 (**Form TM15**) to the Registrar to register the assignment. Regulation 64(2) TMR requires the Assignee to file with Form TM15 an "*attested copy of the*

instrument” under which the Assignee claims his or her entitlement. The Registrar has the power under reg. 64(3) TMR to require the Assignee “*to produce for inspection any instrument of which an attested copy has been filed*”.

Regulation 64(4) TMR merely provides that the instrument or attested copy of the instrument regarding the assignment of trade mark which has been furnished by the Assignee to the Registrar (**Assignment Documents**) “*shall not be opened for public inspection*”. Regulation 64(4) TMR does not state that the Assignment Documents cannot be admitted as evidence by the Registrar in any suit. In other words, a literal interpretation of reg. 64(4) TMR does not support This Application so as to bar the admissibility of the Plaintiffs’ Assignments in this case;

- (2) TMR are made by the “*Minister*” [defined in s 3(1) TMA as the Minister for the time being charged with the responsibility for intellectual property]. If the Minister had intended for reg. 64(4) TMR to exclude the admissibility of Assignment Documents in all suits, such an intention would have been clearly and expressly stated by the Minister in reg. 64(4) TMR. This was however not the case;
- (3) a party in a pending action may apply for discovery of documents against the Registrar (who is not a party to the action) under O 24 r 7A(2) RC – please see **Billion Prima Sdn Bhd & Anor v Nutech Co Ltd & Anor** [2017] 1 CLJ 179, at sub-paragraphs 7(2), 9(2), (3), 10

and 11. A party may also apply for a subpoena under O 38 r 14(1) read with O 38 r 16(1) and (2) RC to compel the Registrar to produce documents in a trial.

There is nothing in reg. 64(4) TMR, expressly or by necessary implication, which excludes the court's power under O 24 r 7A(2) and/or O 38 r 14(1) RC to compel the Registrar to produce the Assignment Documents in a trial; and

(4) if I have accepted the above submission by the Registrar, this may cause an injustice in the following manner –

(a) an Assignee may have filed with the Registrar -

(i) forged Assignment Documents; or

(ii) Assignment Documents which have contravened the law

(Unlawful Assignment Documents);

(b) based on the Unlawful Assignment Documents, the Registrar has registered the Assignee as the proprietor of the registered trade mark under s 47(1) TMA (**Registration of Assignee**); and

(c) a party aggrieved by the Registration of Assignee (**Aggrieved Party**) may wish to apply to court to set aside the Registration of

Assignee (**Aggrieved Party's Suit**). In the Aggrieved Party's Suit, the Aggrieved Party will suffer an injustice by being barred by reg. 64(4) TMR from obtaining evidence of the Unlawful Assignment Documents from the Registrar. More importantly, the court in the Aggrieved Party's Suit will be deprived of the Unlawful Assignment Documents in deciding that suit in a just manner.

In **Owen Sim Liang Khui v Piasau Jaya Sdn Bhd & Anor** [1996] 4 CLJ 716, at 743, the Federal Court in a judgment given by Gopal Sri Ram JCA (as he then was) referred to the maxim that Equity will not permit a statute to be used as an engine of fraud. Similarly, reg. 64(4) TMR should not be construed in a manner wherein that provision may be abused to facilitate fraud and/or illegality.

G. Does Subpoena require Registrar to testify personally in this case?

11. Deputy Registrars of Trade Marks (**Deputy Registrar**) and Assistant Registrars of Trade Marks (**Assistant Registrar**) are appointed by the Intellectual Property Corporation of Malaysia pursuant to s 4(2) TMA. Section 4(4) TMA provides that subject to the general direction and control of the Registrar, Deputy Registrars and Assistant Registrars may exercise any function of the Registrar.
12. In view of s 4(4) TMA, at the hearing of This Application, I inquired from the Defendants' learned counsel, Mr. Benjamin J. Thompson, on whether the

Registrar is required by the Subpoena to testify personally in this case. Mr. Thompson magnanimously conceded that if This Application is dismissed, the Subpoena only requires the Deputy Registrar or Assistant Registrar who is in charge of the Plaintiffs' Trade Marks, to give oral evidence and to produce documents in this case.

H. Is Subpoena frivolous, vexatious and/or an abuse of court process?

13. Firstly, the following cases have held that the Defendants have the legal burden to satisfy this court that the Registrar is able to give evidence which is relevant to the just decision of this case:

(1) Mohamed Azmi SCJ's judgment in the Supreme Court case of **Wong Sin Chong & Anor v Bhagwan Singh & Anor** [1993] 3 MLJ 679, at 687; and

(2) the judgment of Hamid Sultan J (as he then was) in the Court of Appeal case in **ECM Libra Investment Bank Bhd v Foo Ai Meng & Ors** [2013] 3 MLJ 35, at sub-paragraphs 7(e).

14. I am of the view that the Registrar cannot rely on s 65(1), (2) TMA and reg. 89(1) TMR to support This Application. This is due to the following reasons:

(1) s 65(1), (2) TMA and reg. 89(1) TMR, either expressly or by necessary implication, do not bar the Defendants from obtaining the Subpoena.

Nor do these provisions state that the Registrar cannot be subpoenaed to testify and/or produce documents in pending actions;

(2) if this court has acceded to the Registrar's submission based on s 65(1), (2) TMA and reg. 89(1) TMR, as explained in the above sub-paragraph 10(4), the Aggrieved Party will suffer an injustice due to Unlawful Assignment Documents. Section 65(1), (2) TMA and reg. 89(1) TMR should not be interpreted in a manner which will facilitate fraud and/or illegality; and

(3) in **World Grand Dynamic Marketing Sdn Bhd v FJVAA Spa Sdn Bhd & Ors** [2017] 1 AMR 94, at sub-paragraphs 16(3) and (4), the Registrar had applied to set aside 2 subpoenas issued to the Registrar's officers based on, among others, s 65(1) and (2) TMA. In **World Grand Dynamic Marketing**, I have dismissed the Registrar's application with costs and this decision has been affirmed by the Court of Appeal (except that the order of costs awarded against Registrar has been set aside by the Court of Appeal).

15. I accept Mr. Thompson's submission that the Registrar is required to testify and to produce documents regarding, among others, the following matters which are relevant to the Counterclaim:

(1) whether the Registrar had complied with ss 14 and/or 19 TMA in registering the Plaintiffs' Trade Marks;

- (2) whether the Registrar had complied with an earlier High Court judgment of Azahar Mohamed J (as he then was) in this case; **and/or**
 - (3) whether the Plaintiffs' Assignments are valid and can be registered by the Registrar.
16. In view of evidence (relevant to the Counterclaim) which may be adduced by the Registrar (as explained in the above paragraph 15) –
- (1) the Subpoena is not frivolous and vexatious;
 - (2) the Subpoena does not constitute an abuse of Court process; and
 - (3) the Defendants have successfully discharged the legal onus to prove that the Registrar is able to give evidence which is relevant to the just decision of the Counterclaim.

Based solely on the ground that the Registrar's evidence is relevant to the Counterclaim, I have no hesitation in dismissing This Application.

17. I accept the following judgment of Ramly Ali J (as he then was) in the High Court case of **Godrej Sara Lee Ltd v Siah Teong Teck & Anor (Part 1)** [2007] 7 MLJ 153, at paragraph 32 (cited by Mr. Thompson):

"[32] If the assistance of the Registrar of Trade Marks is required at any stage of the court proceedings, a subpoena may be served on the

Registrar of Trade Marks for purposes of assisting the court in explaining any matters relating to the trade mark in issue without the need to make the Registrar of Trade Marks a party to the action.”

(emphasis added).

Godrej Sara Lee Ltd clearly supports a dismissal of This Application.

18. Regarding Cik Iylia’s other contentions -

(1) I am not able to see how the Subpoena can oppress the Registrar in any manner. Even if it is assumed that the Subpoena oppresses the Registrar (which is not proven in this case) –

(a) the relevancy of the Registrar’s evidence to the Counterclaim (please see the above paragraph 15) clearly outweighs any oppression which may be caused to the Registrar - **World Grand Dynamic Marketing**, at paragraph 19; and

(b) if the Registrar has suffered any loss or damage due to the Subpoena which constitutes an abuse of court process, the Registrar may subsequently file a suit against the Defendants to claim damages for the tort of abuse of court process – please see Gopal Sri Ram JCA’s (as he then was) judgment in the Court of Appeal case of **Malaysia Building Society Bhd v Tan Sri General Ungku Nazaruddin Ungku Mohamed** [1998] 2 CLJ

340, at 352-356. In other words, the Registrar has an adequate remedy in the event the Subpoena constitutes an abuse of court process and has indeed caused loss or damage to the Registrar;

- (2) the Registrar cannot rely on O 24 r 7A(2) RC (discovery of documents against third parties) to support This Application. This is because the Subpoena not only compels the Registrar to produce documents but also compels the Registrar give oral evidence in this case; and
- (3) **Ho Tack Sien** has decided that the Registrar should not be made a party in Rectification Suits. **Ho Tack Sien** however did not decide that the Registrar could not be compelled by a subpoena to produce documents and to testify in pending suits.

I. Should Registrar be appointed as a court expert under O 40 r 1 RC?

19. Cik Iylia has submitted that the court should allow This Application to set aside the Subpoena and appoint the Registrar as a court expert to assist the court under O 40 r 1 RC read with s 62(1) and (2) TMA. According to Cik Iylia, the Subpoena would put the Registrar in an “*invidious*” position in this case by favouring one side over the other and this will “*destroy the neutrality*” of the Registrar’s office. Cik Iylia relied on the following cases:

- (1) **Ho Tack Sien**;

- (2) the English Court of Appeal case of **Fishenden v Higgs and Hill Ltd** [1935] All ER Rep 435; and
- (3) Tengku Maimun JC's (as she then was) decision in the High Court in **Lian Chen Fah @ Lian Chen Lee & Ors v Gimo Holdings Sdn Bhd** [2008] 1 MLJ 135.
20. Firstly, the Subpoena does not compromise the independence of the Registrar in any manner. Nor does the Subpoena place the Registrar in any invidious or adverse position.
21. Secondly, s 62(1) and (2) TMA do not support an application for the Registrar to be appointed as a court expert under O 40 r 1(1) RC.
22. The material facts of **Ho Tack Sien, Fishenden** and **Lian Chen Fah** do not concern the court's power to appoint the Registrar as a court expert under O 40 r 1(1) RC.
23. I am of the view that this court should not appoint the Registrar as a court expert under O 40 r 1(1) RC. This decision is premised on the following reasons:
- (1) a court expert can only be appointed in a case under O 40 r 1(1) RC when a "*question for an expert witness arises*" in the case. In this case, there is no question for an expert witness to assist this court. I refer to s 45(1) and (2) of the Evidence Act 1950 (**EA**) as follows -

“Opinions of experts

s 45(1) When the court has to form an opinion upon a point of foreign law or of science or art, or as to identity or genuineness of handwriting or finger impressions, the opinions upon that point of persons specially skilled in that foreign law, science or art, or in questions as to identity or genuineness of handwriting or finger impressions, are relevant facts.

(2) Such persons are called experts.”

(emphasis added).

In **Junaidi Abdullah v Public Prosecutor** [1993] 3 MLJ 217, at 229, Mohamed Azmi SCJ held as follows in the Supreme Court –

“In our view, the test to be applied for the purpose of s 45 [EA] is this. First, does the nature of the evidence require special skill?”

(emphasis added).

It is to be noted that the Registrar has statutory powers, functions and duties under TMA and TMR. Such statutory powers, functions and duties, in my view, do not mean that the Registrar is an “*expert*” within the meaning of s 45(1) and (2) EA. In any event, as stated above, there is no question in this case for an expert witness to assist this court; and

(2) assuming that there is a relevant question for an expert witness to answer in this case, the words “*on its own motion*” in O 40 r 1(1) RC are sufficiently wide to empower the court to act on its own motion (without an application by any party) to appoint a court expert to answer the question. However, in our adversarial litigation system, the court should be slow to act *suo motu* and appoint a court expert under O 40 r 1(1) RC when parties are legally represented and have made an informed decision not to apply to appoint a court expert under O 40 r 1(1) RC. In the Supreme Court case of **Teng Boon How v Public Prosecutor** [1993] 3 MLJ 553, at 562, Edgar Joseph Jr SCJ decided as follows –

“It was Lord Greene MR who explained that justice is best done by a judge who holds the balance between the contending parties without himself taking part in their disputations. If a judge, said Lord Greene, in Yuill v Yuill, should personally conduct the examination of witnesses, ‘he, so to speak, descends into the arena and is liable to have his vision clouded by the dust of the conflict’.

And, it was Lord Denning MR who, in Jones v National Coal Board, emphasized the importance of the judge not descending into the arena and thereby depriving himself of the ability to take a detached view when forming his conclusion.”

(emphasis added).

In this case, the Plaintiffs and Defendants are represented by senior and specialized Intellectual Property counsel. If the Plaintiffs and Defendants have made an informed decision [not to apply to court to appoint a court expert under O 40 r 1(1) RC], there is no reason for this court to act on its own motion (the Registrar is not a party in this case) and appoint the Registrar as a court expert.

J. Court's decision

24. Premised on the above reasons, This Application is dismissed with no order as to costs (because the Registrar is performing statutory duties and functions under TMA and TMR in the public interest).

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

DATE: 17 APRIL 2017

Counsel for Applicant:

Cik Iylia bt. Hashim (Legal Officer)

Counsel for Respondents/Defendants:

*Mr. Saha Deva, Mr. Benjamin J. Thompson,
Ms. Ajeet Kaur & Cik Hannah bt. Ariffin
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Counsel for Plaintiffs:

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(Messrs Sri Dev and Naila)*