

This is NON-PAYABLE document
H0272101 WA1319432278 23/09/2019 18:39:10
WA-22IP-3-01/2018
TSS096.....0.00 x 1
Jumlah RM*****0.00

Foong Cheng Leong

Low Li Qun
Hee Pau Ling
Rachel Fung Wan Ching

Our Ref: FCL/D/904/2017/LLQ
Your Ref: WA-22IP-3-01/2018

24 September 2019

Timbalan Pendaftar
Tuan Dalwinder Singh A/L Mohinder Singh
Mahkamah Tinggi Kuala Lumpur

Secara E-Filing

Tuan,

Mahkamah Tinggi Kuala Lumpur Dagang 7 (Harta Intelek)
Guaman Sivil No. WA-22IP-3-01/2018 (Bahagian Dagang)
Plaintif : NEXGEN BIOPHARMA RESEARCH & INNOVATION SARL
Defendan : CELCOM PLANET SDN. BHD.

1. Kami mewakili pihak Plaintiff.
2. Untuk makluman Mahkamah yang Mulia ini, pada hari keputusan 12 Julai 2018 di Mahkamah Tinggi Kuala Lumpur, Yang Arif Dato' Wong Kian Kheong telah memberi alasan lisan terhadap Lampiran-lampiran 9, 10 dan 13 yang terdapat isu novel terutamanya berkenaan dengan liabiliti pengusaha platform dalam talian.
3. Dalam perkara ini, kami telah menyediakan Nota Prosiding yang mengandungi alasan lisan tersebut untuk tujuan penyediaan kes lain yang mempertikaikan isu novel yang sama.
4. Kami telah menghantar sesalinan Nota Prosiding tersebut kepada peguam cara Defendan untuk kelulusan mereka. Walau bagaimanapun, mereka telah memaklumkan kami bahawa mereka tidak mempunyai arahan daripada Defendan untuk meluluskan Nota Prosiding tersebut. Kami lampirkan disini surat-menyurat emel antara kami dan peguam cara Defendan untuk rujukan Mahkamah yang Mulia ini.

Foong Cheng Leong & Co

Registered Trade Mark, Patent & Industrial Design Agent

Lot No-13, 26, 3rd Floor, Pearl Point Shopping Complex, Old Klang Road, 58000 Kuala Lumpur, Malaysia

S/N p00ABSTaAU6bQES6m56Xg

**Note : Serial number will be used to verify the originality of this document via eFILING portal

TEL +60379879495

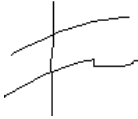
FAX +60320349495

EMAIL mail@fcl-co.com

WEBSITE www.fcl-co.com

5. Maka, dengan segala hormatnya, kami memohon supaya Mahkamah yang Mulia ini boleh meluluskan Nota Prosiding tersebut. Kami lampirkan disini Nota Prosiding tersebut untuk tindakan lanjut Mahkamah yang Mulia ini.
6. Segala pertimbangan dan kerjasama yang diberikan kami dahului dengan ucapan ribuan terima kasih.

Yang benar,



Foong Cheng Leong

Talian Terus: +60379879495

Emel: fcl@fcl-co.com

Lampiran

s.k. **Tetuan Lee Hishammuddin Allen & Gledhill**

Dengan Emel

Foong Cheng Leong & Co

Registered Trade Mark, Patent & Industrial Design Agent

Lot No-1, 3, 26, 3rd Floor, Pearl Point Shopping Complex, Old Klang Road, 58000 Kuala Lumpur, Malaysia

S/N p00AbSTaAU6bQES6m56Xg

**Note : Serial number will be used to verify the originality of this document via eFILING portal

TEL +60379879495

FAX +60320349495

EMAIL mail@fcl-co.com

WEBSITE www.fcl-co.com

DALAM MAHKAMAH TINGGI MALAYA DI KUALA LUMPUR

(BAHAGIAN DAGANG)

NO GUAMAN: WA-22IP-3-01/2018

ANTARA

NEXGEN BIOPHARMA RESEARCH & INNOVATION SARL ...PLAINTIF

DAN

CELCOM PLANET SDN. BHD.

(No. K/P: 1113867-K) ...DEFENDAN

TARIKH : 12.07.2018

MASA : 02:35PM

NOTA KETERANGAN

Koram

Hakim	Yang Arif Datuk Wong Kian Kheong	YA
Peguam Plaintiff	Foong Cheng Leong Low Li Qun	FCL LLQ
Peguam Defendan	Lim Zhi Jian	LZJ

Jurubahasa - JRB

Penterjemah - PTJ

Court Staff - CS

MULA

FCL May it please My Lord, Foong Cheng Leong together with Low Li Qun,
Q-U-N

YA Just hold on Mr Foong, just hold on. Yes carry on please.

1

2 **FCL** And my learned friend, the Defendant, Lim Zhi Jian.

3

4 **YA** You're alone today, Mr Lim?

5

6 **LZJ** Yes I am, my Lord.

7

8 **FCL** We seek for clarification of Enclosure 9, 10 and ...

9

10 **YA** This is a chamber's matter. How come the lawyer for Suaran Singh is

11 here?

12

13 **CS** ***inaudible* (00:57)**

14

15 **YA** Ok, it's alright. You have no objection?

16

17 **LZJ** I have no objection, My Lord.

18

19 **FCL** I have no objection.

20

21 **YA** This is a chamber's matter. Alright, I'll hold in the open court so there's

22 a CRT recording as well. You can say out you have no objection.

23 Alright, I'm going to hear in this order the three applications. I'm going

24 to hear the application to strike out under Order 18 rule 19(1)(a)

25 without affidavit Enclosure 10 first. Continued immediately by

26 Enclosure 9 – application to strike out under Order 19 rule 19(1)(b)

27 and (d) and then lastly your summary judgment application. Anything

28 to add?

29

30 **FCL** Nothing to add.

31

32 **YA** How about you Mr Lim?

33

34 **LZJ** Nothing to add, My Lord.

35

36 **YA** Alright, do you want the order of grounds in English or Malay Mr

37 Foong?

1
2
3
4
5
6
7
8
9
10
11
12
13
14
15
16
17
18
19
20
21
22
23
24
25
26
27
28
29
30
31
32
33
34
35
36
37

FCL

English.

YA

Mr Lim?

LZJ

English, My Lord.

YA

Alright. I'm going to write a judgment because there's no case in respect of sale online through what is called online market... what do you call that...

FCL

Online market place.

YA

Online market place whereby the Defendant is not the manufacturer, producer or distributor. Just a purely online service. Alright, first of all, Enclosure 9 is the Defendant's application to strike out based on Order 18 Rule 19 (1)(b) and (d). Enclosure 10 is the Defendant's application to strike out the suit based on Order 18 Rule 19 (1)(a), no reasonable cause of action. In *Kapten Lam Chee Keong*, it's a reported case, the appeal was withdrawn. This case was handled by your former partner, Ms Himalini, Mr Lim. I think she left and opened her own firm. Appeal was withdrawn. I decided in *Kapten Lam Chee Keong*, I struck out the suit against MAS on the ground that, you don't file two separate applications. Alright, you can file the application under paragraph (a), (b), (c) or (d), but when the court considers paragraph (a), the court cannot consider any affidavit evidence by reason of Order 18 Rule 19 (2). I'll decide Enclosure 10 first because the grounds to strike out the statement of claim under Order 18 Rule 19 (1)(a) is based on the fact that the statement of claim does not disclose any reasonable cause of action. The court cannot consider affidavit evidence. The second reason I'll decide Enclosure 10 first is that for the purpose of paragraph (a) the court presumes the contents of the statement of claim to be true. I rely on *Tuan Haji Ishak Ismail* in the Court of Appeal decision by Justice of the Court of Appeal Mahadev Shankar. I now turn to Enclosure 10 and I peruse statement of claim paragraph 6 subparagraphs 1 and 2, the Plaintiff is the registered proprietor of 2 registered trade marks in Class 5 –

pharmaceutical products, medical skincare products and so forth. And this later will be more relevant in respect of the claim for summary judgment, the Class 5 trade mark. The second trade mark is Class 3 – bleaching preparations and other substances for laundry use. In paragraph 14 the Plaintiff has alleged trade mark infringement, particulars were given in paragraphs (a) to (d) in paragraph 14. In particular paragraph (a) alleged breach of the Plaintiff's registered trade mark in Class 5. Paragraphs 19 to 20(a) concern the breach of the Plaintiff's registered trade mark. Based on paragraph (a), Order 18 Rule 19 (1)(a), I have to presume the contents of the statement of claim are true ex facie on the face of the statement of claim, it discloses a reasonable cause of action of trade mark infringement. On this ground, I dismiss Enclosure 10. How much cost are you asking for?

FCL I'll go for five thousand.

YA So much? Only pleadings, you know. Alright, how much do you offer?

LZJ Two thousand my Lord.

YA Alright, three thousand. Enclosure 10 dismissed with cost, three thousand. I come to Enclosure 9. That's why when you file applications separately, everything is very difficult.

LZJ Sorry my Lord.

YA No need to apologise. It's alright. You look at Kapten Lam Chee Keong's suit against MAS. I think your firm handled at the time was Ms Himahlini before she left. They withdrew the appeal. I struck out the whole suit because there was no cause of action. Alright, Enclosure 10, no I mean, Enclosure 9 is based on two grounds: paragraph (b) on the ground that the statement of claim is scandalous, frivolous, and vexatious and paragraph (d) that the statement of claim constitutes an abuse of court process. Right, Enclosure 9, I can consider the affidavits. In this case, the Plaintiff's affidavit had disclosed trade mark Infringement of the Plaintiff's registered trade mark in Class 5, exhibits

1 P-7, P-10 and P-11. There is also admission of sale of the infringing
2 product in paragraph 20 of the Defence. I'll read paragraph 20 of the
3 Defence. I'll come to the elements of 38(1)(a) and I can't find any case
4 on 38(1)(b). Earlier, I decided on one case but I didn't have time to
5 write a judgment. How come there are different lawyers now?

6
7 **FCL** Conflicted out.

8
9 **YA** Oh, why? Cause of Celcom?

10
11 **FCL** Celcom.

12
13 **YA** Oh, right. Alright paragraph 20, of the defence Mr Lim. "Perenggan 27
14 dan 28 adalah dinafikan setegas-tegasnya, dan Plaintiff diletakkan di
15 atas beban bukti yang kukuh. Pada hakikatnya, hanya 1 unit produk
16 tersebut pernah dijual di atas platform terbuka 11Street." I refer to the
17 letter dated 6 June 2017, letter by the Defendant to the Plaintiff's
18 solicitors. Letter dated 6 June 2017, exhibit "T-16" in the Plaintiff's
19 Affidavit in Support of the enclosure for summary judgment, enclosure
20 14. Letter dated 6 June, from the General Manager of Legal
21 [*inaudible (8:04)] Department, Haslyna Hashim – "We refer to your
22 letter dated 29 May 2017, we have had the occasion to consider your
23 client's assertion regarding the unauthorised use of the mark "M-F-I-L-
24 L", is it?

25
26 **FCL** M-F-Three.

27
28 **YA** Oh, "M-F-triple L, trade mark and/or advertisement, offer for sale,
29 distribution, sale and/or dealing with products bearing the trade mark
30 on our website, particularly with regard to the following listings. One,
31 the first listing. Two, the second listing. Kindly note that our checks
32 show that the first listing was no longer available on our Website on
33 the day of receipt of your letter." That means very clearly, the first
34 listing was available earlier. "As such we trust no further action needs
35 to be taken with regard to the same. With regard to the second listing,
36 this is not a listing by a local seller pharmacy, Park City bla bla bla, as
37 stated in your letter, but a listing by a foreign seller based overseas.

1 We have removed the second listing as requested. Once again,
2 however as a matter of clarification, please note that foreign listings
3 are generally uploaded automatically to our website from other online
4 marketplaces via the application's programming interface API without
5 human intervention." It's very clear this is not a plain and obvious case
6 to strike out. On this ground alone and on grounds which I will
7 elaborate in respect of the summary judgment application, I dismiss
8 Enclosure 10, oh sorry, Enclosure 9. How much cost are you asking
9 for? There are affidavits.

10
11 **FCL** Five thousand.

12
13 **LZJ** Two, My Lord.

14
15 **YA** I give four, because there are affidavits. I come now to Enclosure 13 –
16 the Plaintiff's Order 14 application. First of all, 3 conditions have been
17 fulfilled under Order 14 rule 1 paragraph 1 and rule 2 paragraph 1, the
18 statement of claim has been served on the Defendant. Defendant has
19 entered appearance. There is an affidavit by the Plaintiff's deponent
20 verifying the facts on which the statement of claim is based and the
21 deponent's belief that the Defendant has no defence to the statement
22 of claim. Upon the fulfillment of these three conditions, the evidential
23 burden shifts to the Defendant to raise triable issue. I refer to 2
24 Federal Court judgments in *National Company For Foreign Trade*
25 (*10:18) by Federal Judge Judge George Seah which is followed by
26 Chief Judge of Sabah and Sarawak Steve Shim in *Cempaka Finance*
27 *Berhad*. Even assuming the Defendant cannot raise any triable issue,
28 if there's any other reason for trial under Order 14 rule 3 paragraph 1,
29 Order 14 application should be dismissed and the case should go for
30 trial and I refer to the Federal Court's judgment *United Merchant*
31 *Finance Berhad* by Federal Court Judge Mohammad Dzaidin as his
32 Lordship then was. There are 2 causes of action I can identify from the
33 statement of claim. The Enclosure 13 and the written submission of
34 the Plaintiff - Section 38 subsection 1(a) and 38 subsection 1(b). Am I
35 right? In respect of Section 38 subsection 1(a) the Federal Court's
36 Judgment in *Low Chi Yong* by Federal Court judge Suriyadi Halim
37 Omar ruled that for Section 38 (1)(a) there are 5 elements. The

1 Defendant is neither the registered proprietor nor the registered user
2 of the trade mark. Second, the Defendant has used the trade mark
3 which is identical with or so nearly resembles the Plaintiff's registered
4 trade mark as likely to deceive or cause confusion, second element.
5 Third element – the Defendant was using the offending mark in the
6 course of trade. Fourth, the Defendant was using the offending mark
7 in relation to goods or services within the scope of the registration.
8 Fifth element, the Defendant used the offending mark in such a
9 manner as to render the use likely to be taken as a trade mark. The
10 fifth element is actually paragraph (a).

11
12 I come to a second possible cause of action under Section 38 (1)(b).
13 There is no case in Malaysia. Still the same 5 elements. The first 4
14 elements as decided in *Low Chi Yong* and other High Court decisions.
15 The fifth element is paragraph (b). Alright paragraph (b) I held in oral
16 judgment, the same Plaintiff but there's no time to write the written
17 judgment. The fifth element for Section 38(1)(b): In a case in which the
18 use is used upon the goods, (in this case it's used upon goods, it's not
19 used upon services) or in physical relation thereto or in an advertising
20 circular, or other advertisement, issued to the public. I held that
21 website in that case constitutes use of an advertising circular or other
22 advertisement, issued to the public, but this is the element, as
23 importing a reference to a person having the right either as registered
24 proprietor or as a registered user to use the trade mark or to goods
25 with which the person is connected in the course of trade. So the fifth
26 element for Section 38 (1)(b), I paraphrase here, the first four
27 elements are the same, is that the Plaintiff must prove that the
28 Defendant has used the mark in relation to goods in such a manner as
29 to render the use of the mark likely to import a reference to a person
30 who is a registered proprietor, or a person who's a registered user or
31 to use the goods which is connected to the registered proprietor or the
32 registered user.

33
34 I come now to the facts of the case, as disclosed in the affidavit.
35 Defendant owns and operates an electronic portal "11Street" the
36 website. Through the Defendant's website, the Defendant conducts
37 online shopping. Access to the Defendant's website could be through

1 internet or by way of a mobile app. The Defendant's website
2 constitutes an online shopping mall through which vendors sell various
3 goods and products. Defendant has sole control over the website.
4 These are the facts. I have nothing rebutting. If I'm wrong, you can tell
5 me Mr Lim. Third parties, I call them "Third Parties", the Defendant
6 uses the word "Sellers", I use "Third Parties" because in the context
7 that the Third Parties are not parties to this action. Various parties
8 advertise, sell or offer to sell various goods and products through the
9 Defendant's website. I come to Exhibit "P-6" of the website, exhibited
10 in the Plaintiff's affidavit of support in Enclosure 13. First of all, there is
11 availability of access browsing in the upper right hand column: "star
12 brands", "shocking deals", "hot selling", "coupon street", "promotions",
13 then their goods: "shop now", "buy now", "add to cart", "e-voucher",
14 "Recommendations for you". I'll just highlight the words I rely on.
15 "About 11street" - and this is perhaps relied on by the Defendant.
16 "11street is Malaysia's latest one stop online shopping mall that
17 connects customers to a variety of quality products at competitive
18 prices in a trustworthy and secure environment. I can't read the last
19 part. The identity of the Third Parties or Sellers using the term used by
20 the Defendant are not disclosed. Then I come to the payment mode,
21 Exhibit P-9. "Shipping process will begin upon confirmation of
22 payment. Your order number is - . Please check the payment
23 information below. Your order will be cancelled automatically if
24 payment is not made within 2 working days. Payment method,
25 account number, account name, Celcom Planet Sendirian Berhad,
26 Collection - Defendant's name. "Payment details", "discount amount",
27 "rewards", "customer service", "telephone number", "Buyer support",
28 "seller support". Alright I'm of the view that the website and the
29 payment method, there is a contract of the sale of goods between the
30 purchaser and the defendant, not the seller. I quote the Sale of Goods
31 Act 1957, Section 4(1): "The contract of sale of goods is a contract
32 whereby the seller transfers or agrees to transfer the property in
33 goods to the buyer for a price. There may be a contract of sale
34 between one part-owner and another." Section 5(1): "A contract of
35 sale is made by an offer to buy or sell goods for a price and the
36 acceptance of such offer." I find that when a purchaser logs in, "shop
37 now", "buy now", "put into cart", there is an offer and upon payment,

1 there is acceptance. The contract may provide for the immediate
2 delivery of the goods or immediate payment of the price or both or for
3 delivery of payment by installments or that the delivery of payment or
4 both shall be postponed. Section 5(2): "Subject to any law for the time
5 being in force, a contract of sale may be made in writing or by word of
6 mouth, or partly in writing and partly by word of mouth or may be
7 implied from the conduct of the parties." In this case, it's made in
8 writing and also implied from the conduct of payment. I cannot accept
9 that there is a contract between the Third Party or Seller with the
10 Purchaser for these reasons. Firstly, there is no name of the Third
11 Party in the website. There is no payment to the Third Party. How can
12 the customer enforce any contract against a nameless Third Party
13 when there is no evidence of payment by the customer to the third
14 Party. There is evidence of payment to the bank account number of
15 the Defendant. There is no evidence of any interaction between the
16 customer and the Third Party. If I hold, that there is a contract
17 between the Third Party and the Seller, in other words, that contract
18 cannot be enforced for the simple reason that the Third Party's identity
19 is not known to the customer and there is no evidence of payment by
20 the customer to the Third Party, I reject such a contention.

21
22 In respect of the first element of Section 38(1)(a) and (b), I find that it
23 is satisfied, the Defendant is neither a registered proprietor nor a
24 registered user of the Plaintiff's registered trade mark for Class 5. It
25 doesn't involve Class 3.

26
27 Second element, concerns use of the trade mark. In Section 3(2)(a)
28 there are two limbs. I read Section 3(2)(a) of the Trade Marks Act
29 1976: "In this act, references to the use of a mark shall be construed
30 as references to the use of a printed", I don't apply the first limb, "or
31 other visual representation of the mark." The second limb of Section
32 3(2)(a) clearly applies, there is use of the mark on the Defendant's
33 website. Later, I will find that it is an infringing mark. So, use in
34 38(1)(a) as defined in the second limb of 3(2)(a), visual
35 representation, includes a visual representation through the website
36 and this was held by *Hyundai Motor Company* affirmed by the Court of
37 Appeal last month. And the use of the infringing mark so nearly

resembles the Plaintiff's registered trade mark for Class 5 as is likely to cause confusion and/or likely to deceive. Second element is proven.

Third element is that the Defendant must use the infringing mark in the course of trade. Section 3(1) Trade Marks Act 1976 defines the course of trade but only for services, not for goods so I cannot use that definition. But I use the definition of course of trade given in *Mesuma Sports Sdn Bhd* by the Court of Appeal by judge of Court of Appeal Mah Weng Kwai which was affirmed by the Federal Court, by Federal Court Judge Azahar Mohamed which I adopted in *Phillip Morris*. According to *Mesuma Sports*, the Court of Appeal and Federal Court, "in the course of trade" is not confined to the manufacture and distribution. I find that "in the course of trade" includes offer for sale through the website. If I hold that offer for sale through the Defendant's website when the Defendant is not the manufacture or distributor is not in the course of trade, this will exclude all sales throughout the internet. I don't accept that. So, I find the third element fulfilled. The third element of Section 38(1)(a) and (b) fulfilled.

I come to the fourth element – the Defendant uses the infringing mark in relation to goods within the scope of registration of the Plaintiff's registered trade mark for Class 5. Very clearly, the documentary evidence shows and the Defendant's letter 6th June, the Defendant's Defence, the Defendant's affidavit shows that they admit that there was some publication in respect of the Plaintiff's registered trade mark for Class 5.

I come now to the fifth element of 38(1)(a) – the Defendant uses the offending mark in such a manner as to render its use likely to be taken as being used as a trade mark and here I use the definition of trade mark in Section 3(1) Trade Marks Act 1976, like in *Phillip Morris*, very clearly, when the Defendant's website advertises the use of the offending marks, it is used as a trade mark within the meaning of the definition of Section 3(1) and also within the meaning of Section 38(1)(a).

1 I come now to the fifth element of 38(1)(b) that the Defendant must
2 have used the offending mark in such a manner as to render its use
3 likely as to be taken to import a reference, (these are the words used,
4 different from paragraph (a)) to the registered proprietor, alternative
5 limb, second, registered user, third, to goods whereby the registered
6 proprietor or registered user is connected in the course of trade. Very
7 clearly, when the offending trade mark regarding the goods, admitted
8 by the Defendant, (only one good, later I will confine the summary
9 judgment only to the admission), the fifth element of 38(1)(b) clearly is
10 satisfied because the Defendant uses the offending mark in such a
11 manner as to render its use likely to be taken as importing a reference
12 to either one of the three limbs.

13
14 The five elements of 38(1)(a) and/or (b) are satisfied and supported by
15 the Defendant's admission of sale of infringing products in the
16 Defendant's website in paragraph 20 of the Defence. The Defendant
17 is bound by paragraph 20 of its pleadings, paragraph 9(c) of the
18 Defendant's affidavit in Enclosure 16, Defendant's letter dated 6th June
19 2017 which I have read, the first listing and second listing.

20
21 The third reason to support that the Plaintiff has proven its case in
22 respect to those matters that are admitted by the Defendant is that the
23 Plaintiff first sent a letter dated 10th February 2017, (Plaintiff, not the
24 Plaintiff's solicitors), 6th March 2017 the Plaintiff's solicitors sent a
25 demand, their first demand, alleging trade mark infringement. On 13th
26 March 2017, the Defendant's first reply, the Defendant stated that the
27 Defendant initiated investigation and sought time to reply. 26th March
28 2017 there's a second letter by the Plaintiff's solicitors: what's your
29 reply. Then on 29th May 2017, there is another letter by the Plaintiff's
30 solicitor. Then the 6th June 2017 letter without admission of liability,
31 they only admit the first and second listing. Now this is the part, the
32 third reason which supports the summary judgment application, on
33 29th September 2017, Exhibit "P-17", there is a demand by the
34 Plaintiff's solicitors against the Defendant for trade mark infringement,
35 paragraph 3, 4, 5 and 6, very clear, demanded that the Defendant
36 cease and desist and so forth. On 16th October 2017, "P-18", there is a
37 reminder from the Plaintiff's solicitor, no reply. In a commercial setting,

1 when there is a demand and there is no reply, it supports the
2 allegations in the demand. I refer to the Court of Appeal's decision in
3 *Wong Hon Leong* and by Judge of the Court of Appeal Gopal Sri Ram
4 which was followed by the Court of Appeal in *Jetara Sdn Bhd* by
5 Judge of the Court of Appeal Hasan Lah as his Lordship then was. In
6 the Defendant's Defence that the contract was between the customer
7 and the third party, the Defendant could have easily replied to the
8 demand on 29th September 2017, reminder on 16th October 2017, no
9 reply at all. Defendant could have stated all the defences now raised
10 in respect of opposition to Enclosure 13 that there was no sale of
11 infringing products containing infringing trade marks. Plaintiff did not
12 actually purchase the infringing products, no reply. I am satisfied that
13 there is no triable issue nor is there any other reason for trial. The
14 cases cited by learned counsel for the Plaintiff *Abercrombie & Fitch*
15 *Company* by Judge Ramly Ali, *Hew Chai Seng* by Justice Azizah as
16 her Ladyship then was could be distinguished. These are all sales by
17 the manufacturer of the goods themselves on the websites. The
18 decision of the Judicial Commissioner Hanipah in *Jacmoli Designs &*
19 *Jewellers* have been reversed by the Court of Appeal. There's no
20 written judgment?

21
22 **LZJ** There's no written judgment, my Lord.

23
24 **YA** Once it is reversed, I can't use it. The Singapore High Court decision
25 of *Calvin Klein* by Justice Chan Seng Onn cited by learned counsel for
26 the Plaintiff has to be treated with caution. In *Munchy Food* I have
27 decided Section 27(1) of the Singapore Trade Marks Act, the wording
28 is materially different from 38(1)(a). Our 38(1)(a) follows the old
29 English provision of Trade Marks Act 1938 so I cannot use *Calvin*
30 *Klein* but the facts are very similar. Except the facts actually support
31 the fact that there is a contract between the customers and the
32 Defendant. What's this website in Singapore. I place no reliance on
33 *Calvin Klein* because the wording of the trade mark infringement in the
34 Trade Marks Act Section 27(1) of Singapore trade marks is different.
35 In respect of the Defendant's contention that the Plaintiff has not
36 actually inspected the actual infringing goods, none of the five
37 elements in Section 38(1)(a) and none of the five elements in 38(1)(b)

requires actual production of infringing goods. I do not accept this contention. In respect of the Plaintiff's contention regarding the breach of Consumer Protection (Electronic Trade Transactions) Regulations 2012 Regulation 3 Paragraph 1 which requires matters stated in the Schedule to be disclosed, I find this not relevant. A breach of Regulation 3 Paragraph 1 is solely punishable as a criminal offence under Regulation 3 Paragraph 2. It is not an element in Section 38(1)(a) nor is it an element in Section 38(1)(b). I refer to the Seller's agreement between the Defendant and the Third Party. Clause 4.2 - the Seller agrees and undertakes that all products sold by the Seller - 4.2.1.3 paragraph (c) do not infringe intellectual property, (that's what the agreement says), do not infringe the intellectual property rights of any third party. 4.2.2 - when requested by the Defendant the Third Party shall, (the Seller, I call them Third Parties), shall immediately furnish such evidence, 2(b) that he is the owner and/or authorized or licensed to use the IP rights. The agreement between the Third Party and the Defendant has no relevance. This is between the Seller or Third Party with the Defendant. But this agreement is relevant to show that, as I allow the Order 14 summary judgment application against the Defendant, by virtue of 4.2.1.3 paragraph (c) Defendant is entitled to seek indemnity under Order 16 rule 1 paragraph 1 sub-paragraph (a) Rules of Court 2012, the contract is solely enforceable between Defendant and the Third Party. Nothing has been disclosed in the affidavit to justify an order for aggravated damages or exemplary damages. Plaintiff has prayed for in Prayer 7 Enclosure 13, I'll read it, "Defendan hendaklah menerbit dan membayar kos dan perbelanjaan bagi penyediaan dan penerbitan notis-notis dalam surat khabar Melayu, Cina dan Inggeris tempatan untuk memaklumkan bidang perdagangan dan orang awam yang berkaitan bahawa produk-produk yang mempunyai Cap Dagangan Plaintiff yang dijual atau ditawarkan untuk jualan oleh Defendan adalah tidak dibenarkan oleh Plaintiff, serta menyatakan kesal...". By the way Mr Foong, expression of regret is different from an apology you know. It's not an apology. Ok, never mind. "...atas aktiviti-aktiviti Defendan, dan notis-notis tersebut juga dikehendaki diterbitkan di portal(-portal) elektronik Defendan seperti di laman utama 11street.my dalam tempoh empat belas (14) hari dari tarikh perintah ini." The decision of Judicial Commissioner Lim Chong

1 Fong as his Lordship then was, was cited in respect of the case of *St.*
2 *John Ambulance* whether the court exercises discretion to grant
3 publication of apology, publication of remorse is an exercise of
4 discretion. I exercise my discretion not to do so. Cost of publication in
5 the newspaper portal could be better used for the Defendant to pay
6 damages or profits, whichever may be elected by the Plaintiff. I
7 decline to give Prayer 7. Alright, in respect of Enclosure 13 I allow
8 Prayer 1 to 6, only for the matter admitted by the Defendant in the
9 letter dated 6th June 2017. Only for that matter. Because that's the
10 only admission. If the Defendant didn't admit, I would have dismissed
11 Enclosure 13. But since they admitted in Paragraph 20 and the
12 affidavit and the letter is very clear also, so I allow... how long do you
13 need to elect?

14
15 **FCL** Can elect now.

16
17 **YA** I take some time. I need to draft judgment anyway. So, you take your
18 time, alright? So, I allow Prayer 1 to 6 only in respect of the admission.
19 I give time to elect, put in another paragraph in this judgment today.
20 Assessment of damages, account of profits to be conducted by me.
21 Not by Land Registrar. Take it out from Order 37. I will give directions.
22 How much cost for Order 14 are you asking for?

23
24 **FCL** Ten thousand.

25
26 **YA** Ten thousand? You shouldn't have admitted Mr Lim.

27
28 **L** We were being forthcoming, My Lord. May I..

29
30 **YA** Yes, sorry, you were being honest.

31
32 **LZJ** May I suggest four, My Lord.

33
34 **YA** A lot actually. I give six thousand. I give costs 5% interest from today
35 to be fair. Alright, costs of the assessment of damages or inquiry to be
36 paid by the Defendant to the Plaintiff to be decided by me. How long
37 do you need to elect? I'll give a draft judgment. I'll give one month. I'll

1 give one month to give to them then another two weeks. Can parties
2 agree time to appeal has not run?
3
4 **LZJ** I agree, My Lord.
5
6 **YA** To submit the draft judgment?
7
8 **CS** 13 August, My Lord.
9
10 **YA** Is it a working day?
11
12 **CS** Working day.
13
14 **YA** Alright then give 2 weeks for ...
15
16 **CS** (inaudible) One month is the 11th, the 11th is a Saturday.
17
18 **YA** Monday. Monday is alright. No urgency.
19
20 **CS** 13th August.
21
22 **YA** Two weeks, ask them. Give me my diary. Hopefully parties can settle.
23 This is a small matter, right? I think your damages may not be
24 substantial.
25
26 **FCL** There was a case which I cited in which they, it was the first in
27 Malaysia that I read, is that the loss of exclusivity of a trade mark
28 seems to be a claimable damage. So I thought I want to explore that
29 more.
30
31 **YA** It's up to you. Then you explore then you have to go for an
32 assessment of damages and account of profits already. Wow, Mr Lim,
33 you hear that?
34
35 **LZJ** Yes, My Lord.
36

1 **YA** Alright, after 13th August give a date. But to be fair, in this case, not
2 only did they admit but the payment is due to them. *Calvin Klein* in a
3 sense does apply but *Calvin Klein* is a different provision of trade mark
4 infringement. Never mind, it's alright.
5

6 **CS** 27th August, sir.
7

8 **YA** Alright, can you all come back on 27th August, afternoon 2.30pm. Mr
9 Lim?
10

11 **LZJ** Yes, My Lord.
12

13 **YA** Ok, 2.30pm, 27th of August. Alright, trial dates vacated. You want to
14 proceed with trial? No right?
15

16 **FCL** No.
17

18 **YA** You agree?
19

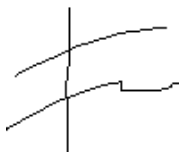
20 **LZJ** Yes, my Lord.
21

22 **YA** Trial dates vacated. I think Mr Foong ...
23

24 **AKHIR**
25

26 **MASA : 3:13PM**
27

28 Peguam cara Plaintiff dan Defendan bersetuju bahawa Nota Keterangan ini adalah
29 tepat dan betul.



.....
Peguam cara Plaintiff

.....
Peguam cara Defendan

30

31 Mahkamah dengan ini mengesahkan bahawa Nota Keterangan ini adalah sah.