

**IN THE HIGH COURT OF MALAYA AT KUALA LUMPUR
(COMMERCIAL DIVISION)
IN THE FEDERAL TERRITORY OF KUALA LUMPUR
CIVIL SUIT NO. WA-22IP-31-05/2018**

BETWEEN

30 MAPLE SDN BHD

PLAINTIFF

AND

SITI SAFIYYAH BINTI MOHD FIRDAUS CHEW

DEFENDANT

GROUND OF JUDGMENT

Introduction

1. This is a trademark infringement case involving headscarves.

2. The Plaintiff is a private limited incorporated under the laws of Malaysia involved in the business of manufacturing, supplying and promoting the sale of clothing.
3. The Defendant is an individual.
4. The Plaintiff is the registered proprietor of the following trademarks in class 25 for clothing, footwear and headgear:

“

”, “DUCKSCARVES” and “” which are registered

in Class 25 for “clothing, footwear, headgear” Malaysia in the following numbers:-



(1) No. 2016066466 for  (in a series of marks);

DUCKSCARVES

(2) No. 2015057890 for **duckscarves** (in a series of marks);

and

(3) No. 2015057891 for  “

(collectively “Plaintiff’s Trademarks”)

5. In this Suit, the Plaintiff claimed against the Defendant for the following reliefs in paragraph 16 of the amended statement of claim:

(1) A declaration that the Defendant has infringed the Plaintiff's

The logo consists of the lowercase letters 'dUcK' in a purple, sans-serif font. The letter 'U' is stylized with a small duck head icon inside its upper curve.

trade mark registration no. 2016066466 () and/or

no. 2015057891 () and/or no. 2015057890 (

DUCKSCARVES

duckscarves) all for goods in Class 25 (collectively referred as the "Plaintiff's Trade Marks");

(2) A perpetual injunction to restrain the Defendant from doing or attempting to do, whether directly or indirectly, the following acts:-

(a) infringing the Plaintiff's Trade Marks;

(b) making or procuring the making of, distributing, selling, importing, exporting, disposing of, parting with possession otherwise than to the Plaintiff or their solicitors or authorised agents, offering or advertising for sale, or in any way dealing with products not being the products of the Plaintiff bearing the Plaintiff's Trade

Marks or any trade mark that is so nearly resembling the Plaintiff's Trade Marks ("**Infringing Products**");

- (c) advertising in any form whatsoever products not being the products of the Plaintiff bearing the Plaintiff's Trade Marks or any such trademark which is identical or so nearly resembling to the Plaintiff's Trade Marks that is likely to deceive or cause confusion; and
 - (d) using the Plaintiff's Trade Marks or any such trade mark that is so nearly resembling the Plaintiff's Trade Marks that is likely to deceive or cause confusion in the course of trade.
- (3) An order compelling the Defendant to disclose to the Plaintiff within fourteen (14) days from the date of this Order, by way of an affidavit affirmed by the Defendant, information not limited to:-
- (a) the names and addresses of all third parties who supplied to the Defendant directly or indirectly, including suppliers, manufacturers and distributors, of the Infringing Products; and

- (b) the number of items of the Infringing Products which have been sold by the Defendant.

- (4) An order compelling the Defendant to deliver up on oath to the Plaintiff or their solicitors or nominated agent within fourteen (14) days of the order of the Infringing Products and all materials including correspondence, messages, equipment and parts, catalogues, brochures, advertisements, invoices, purchase orders, other commercial documents, computer records, computer files, computer programs, or other documents of any kind whatsoever now or hereafter in the possession, power, custody or control of the Defendant relating to the manufacture, supply or sale by or from a third party of the Infringing Products;

- (5) At the Plaintiff's option, destruction of all or any Infringing Products in the possession, power, custody and care of the Defendant at the Defendant's cost and verification on oath that the Defendant is not in possession, power, custody or control of any Infringing Products;

- (6) An order compelling the Defendant to remove, delete or cause to be removed or deleted all publications relating to the Plaintiff's Trade Marks, Plaintiff's Products and Infringing Products;

- (7) An inquiry as to damages or, at the Plaintiff's option, an account of profits and an Order for payment of all sums found due upon the making of such inquiry or that taking of such account together with interest thereon at such rate and for such period as this Court deems fit;
- (8) Where the Plaintiff elects for an account of profits under prayer 7, an Order that the Defendant prepares all necessary accounts and make all necessary enquiries;
- (9) The Defendant shall pay the costs and expenses for the preparation and publication of notices in the local Malay, Chinese and English press to notify the trade and public that goods bearing the Plaintiff's Trade Marks sold or offered for sale by the Defendant are not authorised by the Plaintiff and to express regret of the Defendant's activities within fourteen (14) days from the date of this order;
- (10) Aggravated and/or exemplary damages;
- (11) Interests at the rate of 5% per annum from the date of filing the summon until the date of full settlement;
- (12) Costs; and

(13) Such further and other orders, directions or relief as to this Honourable Court sees fit.

Preliminary

6. The trial of this suit took 2 days on 20 and 21 February 2019. The trial documents are contained in bundles A to D including the documentary evidence in bundle A which has been consented to carry status B.
7. The Plaintiff called Jasmine Kho Min Jee ("PW1") and Syahidah binti Shahrudin ("PW2") who are its general manager and admin executive cum assistant to the general manager respectively as witnesses.
8. After the close of the Plaintiff's case, the Defendant submitted she has no case to answer.
9. Thereafter and after having heard oral submissions of counsel, I entered judgment for the Plaintiff in terms of prayers (1) to (8) and (11) of the amended statement of claim and costs of RM30,000.00.
10. I now furnish below my grounds of judgment.

Contentions and Findings

11. The Plaintiff contended from the evidence adduced at the trial that it has since 2014 manufactured, supplied, distributed and sold clothing particularly headscarves bearing the Plaintiff's Trademarks in Malaysia. Around May 2017, the Plaintiff discovered that the Defendant was actively advertising, distributing, offering for sale, promoting and selling headscarves and snow cap bearing the Plaintiff's Trademarks or any one of them which were not the Plaintiff's products ("Infringing Products") through her Instagram account at <https://www.instagram.com/safeeyachew> ("Infringing Page"). Consequently the Plaintiff directed PW2 who made a trap purchase of the Infringing Products from the Defendant. Upon confirming that these purchased products were not the Plaintiff's products, the Plaintiff instructed its solicitors to send a cease and desist letter dated 26 December 2017 to the Defendant via email and Whatsapp Messenger demanding that the Defendant, amongst others, cease infringing the Plaintiff's Trademarks. Albeit having initially ignored the Plaintiff's aforesaid letter, the Defendant subsequently by email dated 4 January 2018 replied that she had taken down all postings relating to the Infringing Products from the Infringing Page. However the Defendant failed, refused or neglected, amongst others, to reveal the source of the Infringing Products and deliver them up as well as pay compensation to the Plaintiff. Sometime in May 2018, the Plaintiff again discovered that the Defendant had again re-commenced to promote and sell the Infringing Products on the Infringing Page through her Instatories

as well as Facebook account at http://www.facebook.com/profile.php?id=100000612100879&ref=br_tf with the name of Safeeya Chew. Consequently the Plaintiff initiated this Suit.

12. The Defendant has however submitted that it has no case to answer and the consequence of so doing is found in the Court of Appeal case of ***Yoong Tze Fatt v Pengkalen Securities Sdn Bhd*** [2010] 1 CLJ 484 wherein Abdul Malik Ishak JCA held as follows:

“[5] In our judgment, it is trite law that once a defendant in civil proceedings makes a submission of no case to answer and elects not to call evidence, then all the evidence led by the plaintiff must be assumed to be correct: per Gopal Sri Ram, JCA in Jaafar bin Shaari, supra, citing Wasakah Singh, supra. This principle has found similar expression in a number of judgments handed down in the motherland of common law. These cases include Alexander v. Rayson [1936] 1 KN 169; Boyce v. Wyatt Engineering [2001] EWCA Civ. 692; Miller (t/a Waterloo Plant) v. Cawley [2002] EWCA Civ. 1100; and Benham Limited v. Kythirra Investments Ltd [2003] EWCA Civ 1794.”

13. In the circumstances and based on the evidence as adduced by the Plaintiff, their contentions are deemed correct and true and I so find and hold accordingly.
14. The relevant law is set out in ss. 35(1), 36 and 38(1)(a) and (b) of the Trade Marks Act 1976 (“TMA”) which read:

“35. Rights given by registration

(1) Subject to the provisions of this Act, the registration of a person as registered proprietor of a trade mark (other than a certification trade mark) in respect of any goods or services shall, if valid, give or be deemed to have been given to that person the exclusive right to the use of the trade mark in relation to those goods or services subject to any conditions, amendments, modifications or limitations entered in the Register.

(2) Where two or more persons are proprietors of registered trade marks which are identical or nearly resembling each other rights of exclusive use of either of those trade marks are not (except so far as their respective rights have been defined by the Registrar or the Court) acquired by any one of those persons as against any other of those persons by registration of the trade mark but each of those persons have the same rights as against other persons (not being registered users) as he would if he were the sole registered proprietor.

36. Registration prima facie evidence of validity

In all legal proceedings relating to a registered trade mark (including applications under section 45) the fact that a person is registered as proprietor of the trade mark shall be prima facie evidence of the validity of the original registration of the trade mark and of all subsequent assignments and transmissions thereof.

38. Infringement of a trade mark

(1) A registered trade mark is infringed by a person who, not being the registered proprietor of the trade mark or registered user of the trade mark using by way of permitted use, uses a mark which is identical with it or so nearly resembling it as is likely to deceive or cause confusion in the course of trade in relation to goods or services in respect of which the trade mark is registered in such a manner as to render the use of the mark likely to be taken either-

(a) as being use as a trade mark;

(b) in a case in which the use is use upon the goods or in physical relation thereto or in an advertising circular, or other advertisement, issued to the public, as importing a reference to a person having the right either as registered proprietor or as registered user to use the trade mark or to goods with which the person is connected in the course of trade; or

(c) in a case in which the use is use at or near the place where the services are available or performed or in an advertising circular or other advertisement issued to the public, as importing a reference to a person having a right either as registered proprietor or as registered user to use the trade mark or to services with the provision of which the person is connected in the course of trade.”

15. In **Leo Pharmaceutical Products Ltd a/s (Lovens Kemiske Fabrik Produktionsaktieselskab) v Kotra Pharma (M) Sdn Bhd [2012] 10 CLJ 507**, Low Hop Bing J (later JCA) held as follows:

“[84] In order to succeed in this cause of action, it is incumbent upon the plaintiff to prove that:

(a) the defendant is neither the registered proprietor nor the registered user of the trade mark;

(b) the defendant used a mark identical with or so nearly resembling the plaintiff's registered trade mark as is likely to deceive or cause confusion;

(c) the defendant was using the offending mark in the course of trade;

(d) the defendant was using the offending mark in relation to goods or service within the scope of the registration; and

(e) the defendant used the offending mark in such a manner as to render the use likely to be taken either as being used as a trade mark or as importing a reference to the registered proprietor or the registered user or to their goods or services.

*(See **Fabrique Ebel Societe Anonyme v. Sykt PerniagaanTukang Jam City Port & Ors [1989] 1 CLJ 919; [1989] 1 CLJ (Rep) 537, 540 & 541 per Zakaria Yatim J (later FCJ) and applied by the same judge in **A Clouet & Co Pte Ltd v. Maya Toba Sdn Bhd [1996] 1 BLJ 239**).***

16. From the evidence adduced before me, I find that the Infringing Marks looked identical with the Plaintiff's Trademarks; hence infringement is deemed established if used without authorization following ***Tohtonku Sdn Bhd v Superace (M) Sdn Bhd [1992] 1 CLJ (rep) 344.***

17. Based on the active conduct of the Defendant as found which was done without the license, consent and/or authority of the Plaintiff, I therefore find that the Defendant has infringed the Plaintiff's Trademarks pursuant to s.38(1)(a) of the TMA. This is because the Defendant used the Plaintiff's Trademarks in the course of trade in relation to the goods registered under the Plaintiff's Trademarks by selling them including to the Plaintiff via a trap purchase. In addition, the Defendant chose and continued to sell and offering to sell the Infringing Products on the Infringing Page in the social media despite she was duly warned not to do so. This is done in breach of the Plaintiff's exclusive right as conferred by s.35 of the TMA that debarred anyone else from so using the trademark without the Plaintiff's approval following ***Tien Ying Hong Enterprise Sdn Bhd v Beenion Sdn Bhd [2009] 1 LNS 1409.***

18. Additionally by the Defendant having published for sale Infringing Products bearing the Plaintiff's Products in the social media such as Instagram, Instatories, Facebook, etc. I find that they amount to advertising circulars or other advertisement representing the Plaintiff as registered proprietor or user using the Plaintiff's Trademarks in breach of s.38(1)(b) of the TMA. Although the

words “advertising circular” and “advertisement” used in ss. 38(1)(b) and (c) of the TMA are not statutorily defined therein, I hold that the ordinary meaning ascribed to the verb “advertising” such as that described in the Black’s Law Dictionary (8th edn.) p.168 is applicable to interpret the provision, viz. :-

- (i) the action of drawing the public’s attention to something to promote its sale;
- (ii) the business of producing and circulating advertisements.

Consequently, the Defendant’s offering for sale of the Infringing Products in her social media platforms amounted to the use of the Plaintiff’s Trademarks on an advertisement. It is undoubtedly to promote the sale of the Infringing Products; see also ***Abercrombie & Fitch & Anor v Fashion Factory Outlet KL Sdn Bhd & Ors*** [2008] 7 CLJ 413 where it was held that sale of goods bearing a trademark over the internet or via a website has been recognised as use of the trademark.

19. Premised on the above, I am satisfied that the Plaintiff met the elements and requirements to sustain and succeed in its cause of action of trademark infringement against the Defendant based on s.38 of the TMA read together with ***Leo Pharmaceutical Products Ltd a/s (Lovens Kemiske Fabrik Produktionsaktieselskab) v Kotra Pharma (M) Sdn Bhd*** (supra).
20. For completeness, I also find that the Defendant has neither led any evidence nor contention in defence to demonstrate that her

acts did not amount to infringement as provided in s.40 of the TMA.

Conclusion

21. It is for the foregoing reasons that I entered judgment for the Plaintiff against the Defendant as so ordered.

Dated this 1 March 2019

t.t

**LIM CHONG FONG
JUDGE
HIGH COURT KUALA LUMPUR**

COUNSEL FOR THE PLAINTIFF: FOONG CHENG LEONG (LOW LI QUN WITH HIM)

SOLICITORS FOR THE PLAINTIFF: FOONG CHENG LEONG & CO

COUNSEL FOR THE DEFENDANT: MOHD SHAKIR BIN ESRATI

SOLICITORS FOR THE DEFENDANT: HISHAM & PARTNERS