



# ICLG

The International Comparative Legal Guide to:

## Trade Marks 2016

### 5th Edition

A practical cross-border insight into trade mark work

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EDITORIAL

Welcome to the fifth edition of *The International Comparative Legal Guide to: Trade Marks*.

This guide provides corporate counsel and international practitioners with a comprehensive worldwide legal analysis of trade mark laws and regulations.

It is divided into two main sections:

Three general chapters. These are designed to provide readers with a comprehensive overview of key issues affecting trade mark laws and regulations, particularly from an EU and US perspective.

Country question and answer chapters. These provide a broad overview of common issues in trade mark laws and regulations in 41 jurisdictions.

All chapters are written by leading trade mark lawyers and industry specialists and we are extremely grateful for their excellent contributions.

Special thanks are reserved for the contributing editor John Olsen of Locke Lord LLP for his invaluable assistance.

Global Legal Group hopes that you find this guide practical and interesting.

The *International Comparative Legal Guide* series is also available online at [www.iclg.co.uk](http://www.iclg.co.uk).

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# Malaysia

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## 1 Relevant Authorities and Legislation

### 1.1 What is the relevant trade mark authority in your jurisdiction?

The Intellectual Property Corporation of Malaysia (“MyIPO”) is empowered to appoint Deputy Registrars, Assistant Registrars and other officers for the administration of the Trade Marks Act 1976. The Director General of the Corporation is the Registrar of Trade Marks.

### 1.2 What is the relevant trade mark legislation in your jurisdiction?

Trade mark protection is governed by the Trade Marks Act 1976 (“TMA”) and the Trade Marks Regulations 1997 (“TMR”). The Trade Descriptions Act 2011 was enacted to promote good trade practices by providing additional protection and remedies for registered trade mark owners against trade mark infringement and counterfeiting.

## 2 Application for a Trade Mark

### 2.1 What can be registered as a trade mark?

A mark which constitutes a device, brand, heading, label, ticket, name, signature, word, letter, numeral or any combination thereof is registrable as a trade mark provided that it contains or consists of at least one of the following particulars:

- (a) the name of an individual, company or firm represented in a special or particular manner;
- (b) the signature of the applicant for registration or of some predecessor in his business;
- (c) an invented word or words;
- (d) a word having no direct reference to the character or quality of the goods or services not being, according to its ordinary meaning, a geographical name or surname; or
- (e) any other distinctive mark.

### 2.2 What cannot be registered as a trade mark?

A mark is non-registrable if it contains any of the following traits:

- (a) prohibited mark which will likely to deceive or cause confusion to the public;

- (b) contrary to law;
- (c) scandalous or offensive matter;
- (d) prejudicial to the interest or security of the nation;
- (e) identical to or so closely resembles a mark which is well-known in Malaysia for the same goods or services of another proprietor;
- (f) if it is well-known and registered in Malaysia for goods or services not the same as to those in respect of which the registration is applied for: provided that the use of the mark in relation to those goods or services would indicate a connection between those goods or services and the proprietor of the well-known mark is likely to be damaged by such use;
- (g) misleading geographical indication with respect to goods as to its origin;
- (h) misleading geographical indication with respect to wines and/or spirits as to the origin;
- (i) the word or words “Patent”, “Patented”, “By Royal Letters Patent”, “Registered”, “Registered Design”, “Registered Trade Mark”, “To counterfeit this is a forgery”, “Registered Service Mark” and “Copyright” or a word or words to the like effect in any language whatsoever;
- (j) specifically declared by the Minister in any regulations made under the 1976 Act to be a prohibited mark;
- (k) the words “Bunga Raya” and the representations of or any colourable imitation of the hibiscus flower;
  - (l) representations of or references to the King or State Ruler;
  - (m) representations of, colourable imitation of or references to any of the royal palaces or any building owned by the Federal Government, State Government or any other government;
  - (n) the word “ASEAN” and the representation or colourable imitation of its logo;
  - (o) the words “Red Crescent” or “Geneva Cross” and representations of these and other crosses in red, or of the Swiss Federal Cross in white or silver on a red ground, or such similar representations;
  - (p) representations of, mottos of or words referring to the royal/imperial arms, crest, armorial bearings/insignia/devices resembling any of them;
  - (q) representations of, mottos of or words referring to the imperial/royal crowns, royal/imperial/national flags;
  - (r) representations of, mottos of or words referring to the crests, armorial bearings or insignia of the Malaysian Army, Royal Malaysian Navy, Royal Malaysian Air Force and of the Royal Malaysia Police, or devices so nearly resembling them;
  - (s) representations of the name, initials, armorial bearings, insignia, orders of chivalry, decorations or flags of any international organisation, state, city, borough, town, place, society, body corporate, institution or person appears on a mark;

- (t) the name of a single chemical element or compound;
- (u) non-distinctive; and
- (v) direct reference to the character or quality of the goods or services.

### 2.3 What information is needed to register a trade mark?

Registration of a trade mark requires the following information to be provided:

- (a) a representation of the mark;
- (b) the class of goods or services;
- (c) a list of goods or services;
- (d) the full name and address of the applicant;
- (e) the full name and address of the trade mark agent and his registration number and reference (if applicable);
- (f) the priority date, Convention country registration number for International Convention priority claim (if applicable);
- (g) the date of the first use of the mark in Malaysia (if applicable);
- (h) a statutory declaration signed by the applicant or its representative that the applicant is the *bona fide* proprietor of the mark and that the application is filed in good faith; and
- (i) endorsement of the application with a certified transliteration and/or translation of the mark which contains non-Roman characters.

### 2.4 What is the general procedure for trade mark registration?

Once an application to register a trade mark is filed with the Registrar, it will be subject to a two-stage examination process. The first stage, which is procedural in nature, is concerned with the formalities of the application to ascertain that the formal requirements of the application such as the necessary information and documents have been provided. Once there is compliance with the formalities, the application will proceed to the second stage, which is substantive examination to ensure that the mark applied for is registrable under the TMA 1976. During this stage, a search will be conducted on registered marks and pending applications.

The Registrar has the discretion to decide whether to accept or refuse the application, or accept it with conditions or subject to amendments. If the registration is accepted without any objections, a notification form will be sent to the applicant and the applicant is required to sign and return it to the Registrar accompanied with a prescribed fee. Upon receipt of the payment, the mark will proceed to publication in the Government Gazette for a period of two months where it is then open for opposition during this period. At the end of the opposition period and no oppositions are filed, the Certificate of Registration will be issued to the applicant.

Where the application is objected by the Registrar, the applicant will be required, within two months of the objections, to file a written submission containing arguments in support of the application, proposals, conditions, amendments, modifications or limitations, if applicable. Non-compliance with the said requirement will render the application deemed abandoned. If the Registrar maintains his objection after the written submission is filed, the applicant may, within two months of the maintained objection, request a hearing. Once the hearing date is fixed, the applicant will be notified.

If the applicant is aggrieved by the Registrar's decision in the hearing, an appeal may be filed to the High Court against the Registrar's decision within one calendar month from the date of the decision. The Registrar may be required to state the grounds of his decision and any material used in reaching the decision.

The application may be accepted with conditions. If the applicant objects to the conditions, the applicant may, within two months of the conditional acceptance, file written submissions against the conditions. Failure to respond to a conditional acceptance, whether through acceptance or written submissions, will result in the application being struck out. If the Registrar maintains his objections, the applicant may, within two months of the maintained objections, request for a hearing. Once the hearing date is fixed, the applicant will be notified.

### 2.5 How can a trade mark be adequately graphically represented?

The mark must be clear and durable when it is appended to the application with a preference to the original representation of the mark instead of a photocopy one. A mark registered with colour must be endorsed with sufficient and clear indication as to the limitation of the colour. On the other hand, if a mark is registered without any colour limitation, it is deemed to be registered for all colours. The mark which is advertised must comply with the form and manner prescribed by the Registrar, including the dimensions.

### 2.6 How are goods and services described?

The Third Schedule to the TMR 1997 stipulates that the International Classification of Goods and Services for the Purposes of Registration of Marks pursuant to the Nice Agreement, including any amendments made to it from time to time, and the International Classification of the Figurative Elements of Marks pursuant to the Vienna Agreement, including any amendments made to it from time to time, apply.

### 2.7 What territories (including dependents, colonies, etc.) are or can be covered by a trade mark in your jurisdiction?

Only Malaysia can be covered by a Malaysian trade mark.

### 2.8 Who can own a trade mark in your jurisdiction?

Any person who is the owner of the trade mark, uses or proposes to use the trade mark is eligible to apply for registration of the mark as a proprietor. It applies to individuals, companies or organisations, and includes non-citizens of Malaysia.

### 2.9 Can a trade mark acquire distinctive character through use?

A trade mark can acquire distinctive character through use provided that such use is capable of distinguishing the mark from the mark of other traders taking into consideration the period of time when the mark has been in prior existence in the market or that a secondary meaning has been acquired in law such that the public associates the mark with the goods or services.

### 2.10 How long on average does registration take?

It takes approximately 12 months from application to registration for a smooth application, namely one which does not encounter opposition, objection, and/or office action. If the application proceeds by way of expedited procedure, the applicant may, within four months from the date of filing of the application, make an application for approval to proceed by way of expedited examination of the registration. The application must be accompanied with a prescribed fee and supported

by a statutory declaration stating the reasons for requesting the expedited examination. Further, the applicant is required to show any of the following to the satisfaction of the Registrar:

- (a) the request is in the national or public interest;
- (b) there are infringement proceedings taking place or evidence showing potential infringement;
- (c) registration of the trade mark is a condition to obtaining monetary benefits from the Government or institutions recognised by the Registrar; or
- (d) any other reasonable grounds.

Once approval is granted, the applicant is required to file the request for expedited examination.

### 2.11 What is the average cost of obtaining a trade mark in your jurisdiction?

The average cost for a smooth registration is USD 750.00.

### 2.12 Is there more than one route to obtaining a registration in your jurisdiction?

The conventional route is explained in question 2.4 above whilst the other route, which is the expedited route, is explained in question 2.10 above.

### 2.13 Is a Power of Attorney needed?

Power of Attorney is not needed.

### 2.14 If so, does a Power of Attorney require notarisation and/or legalisation?

This is not applicable. Please refer to question 2.13.

### 2.15 How is priority claimed?

The applicant is entitled to claim priority by stating in the application form the details of the foreign application which consist of the Convention country or relevant foreign country in which the application for protection was first made, the reference number and the filing date of the said application. The application for registration in Malaysia must be made within six months from the date of application of the Convention country or relevant foreign country.

### 2.16 Does your jurisdiction recognise Collective or Certification marks?

Malaysia recognises Certification marks but not Collective marks.

## 3 Absolute Grounds for Refusal

### 3.1 What are the absolute grounds for refusal of registration?

There is no express provision under the TMA 1976 to divide grounds for refusal into absolute or relative grounds. The TMA 1976 provides a list of grounds for refusal of registration as follows:

- (a) the mark is likely to deceive or cause confusion to the public or would be contrary to law;

- (b) the mark is scandalous or offensive or would not be entitled to protection by any court of law;
- (c) the mark contains a matter which might be prejudicial to the interest or security of the nation;
- (d) the mark is identical to or so nearly resembles a mark which is well-known in Malaysia for the same goods or services of another proprietor;
- (e) the mark is identical to or so nearly resembles a mark which is well-known in Malaysia for the goods or services of another proprietor that are not the same as those in respect of which the registration is applied for;
- (f) the mark has geographical indication with respect to goods not originating in the territory indicated and if the use of the indication for such goods in Malaysia is of such a nature as to mislead the public as to the true place of origin of the goods;
- (g) the mark is for wine which has a geographical indication identifying wines, or is a mark for spirits which has a geographical indication identifying spirits, not originating in the place indicated by the geographical indication in question;
- (h) separate applications are made by different applications to be registered as proprietors respectively of trade marks which are identical or so nearly resembling each other as are likely to deceive or cause confusion;
- (i) the mark is identical with a prior trade mark belonging to a different proprietor in respect of the same goods or description of goods or in similar services; and
- (j) the mark is not distinctive.

### 3.2 What are the ways to overcome an absolute grounds objection?

To overcome the grounds of objection, the applicant is required to submit written arguments and/or adduce evidence to prove the contrary. If the mark applied for is identical to or so nearly resembling another trade mark, the applicant may adduce evidence of honest, concurrent, prior and/or continuous use in support of its right to the trade mark. Besides, there is some other evidence which may be tendered in this context, such as proof of the distinctiveness acquired through use, registration in foreign jurisdictions and co-existence of the mark and other identical or similar marks in foreign registries.

### 3.3 What is the right of appeal from a decision of refusal of registration from the Intellectual Property Office?

A decision of the Registrar refusing registration is subject to appeal to the High Court. The appeal must be lodged within one calendar month from the date of the Registrar's decision.

### 3.4 What is the route of appeal?

- (1) Prior to the filing of an appeal, the applicant may, within two months from the notification of refusal by the Registrar, obtain the Registrar's written statement of grounds of his decision and any material used in reaching the said decision, accompanied with a prescribed fee. The date the Registrar's written statement is sent to the applicant is deemed to be the date of the Registrar's decision for the purpose of appeal.
- (2) An appeal is brought by originating summons filed at the High Court and must be served on the Registrar. If the applicant subsequently withdraws his appeal, he must give written notice of intention to the Registrar and all interested parties.

- (3) A further appeal against the decision of the High Court may be filed at the Court of Appeal. Based on the current jurisprudence on appeals to the Federal Court, the Court of Appeal is the final appellate court for decisions of the Registrar of Trade Marks in respect of application to register a trade mark.

## 4 Relative Grounds for Refusal

### 4.1 What are the relative grounds for refusal of registration?

Please refer to question 3.1.

### 4.2 Are there ways to overcome a relative grounds objection?

Please refer to question 3.2.

### 4.3 What is the right of appeal from a decision of refusal of registration from the Intellectual Property Office?

Please refer to question 3.3.

### 4.4 What is the route of appeal?

Please refer to question 3.4.

## 5 Opposition

### 5.1 On what grounds can a trade mark be opposed?

A trade mark can be opposed on the following grounds:

- (a) the trade mark that is applied for is identical or confusingly similar to a trade belonging to the opponent. The opponent who is a registered proprietor of a trade mark may rely on the provisions in section 19 of the TMA 1976 whereas the opponent who is a common law proprietor of a trade mark may rely on section 14 of the TMA 1976 as the basis of opposition. Please refer to question 3.1 for the grounds of opposition; and
- (b) the trade mark is not a registrable mark under the TMA 1976. Please refer to question 2.1 for the requirements for a mark to meet the registrability threshold.

### 5.2 Who can oppose the registration of a trade mark in your jurisdiction?

Anyone may oppose the registration of a Malaysian trade mark.

### 5.3 What is the procedure for opposition?

The opponent may, within two months from the publication in the Government Gazette, file an opposition, endorsed with grounds of opposition, by way of written notice to the Registrar.

A counter-statement may be filed and served by the applicant, within two months from the receipt of the notice of opposition entailing the grounds in support of his application against the opposition.

Within two months from the receipt of the counter-statement, a statutory declaration will be filed and served by the opponent to

adduce evidence in support of his opposition. The applicant is given two months to file and serve his evidence by way of a statutory declaration as a supportive document in response to the opponent's statutory declaration. In turn, the opponent may, within two months from the notification of the applicant's statutory declaration, file and serve evidence in reply in the form of a statutory declaration.

When statutory declarations of both parties are exchanged, the applicant and the opponent are required to send to the Registrar any written submissions on the date fixed by the Registrar. The Registrar will then, within two months from the notification of the written submissions, consider the evidence and any written submissions, and subsequently deliver a written decision.

## 6 Registration

### 6.1 What happens when a trade mark is granted registration?

When a trade mark is granted registration, the Registrar will issue the Certificate of Registration of the Trade Mark, and enter the applicant's trade mark in the Register of Trade Marks ("Register").

### 6.2 From which date following application do an applicant's trade mark rights commence?

The applicant's trade mark is deemed to be registered on the date of application for registration of the trade mark. It means that the applicant's trade mark rights commence on the date of application. If it is a priority application, the date of registration is the priority date.

### 6.3 What is the term of a trade mark?

The registration of a trade mark will last for a period of 10 years from the date of registration. The filing date is deemed to be the date of registration. If it is an application with a priority claim under the Paris Convention for the Protection of Industrial Property, the period of registration is for a term of 10 years from the priority date.

### 6.4 How is a trade mark renewed?

A trade mark may be renewed by making an application for renewal within three months prior to the expiration, accompanied by a prescribed fee.

## 7 Registrable Transactions

### 7.1 Can an individual register the assignment of a trade mark?

Any individual who is assigned a registered trade mark is required to apply to the Registrar to register his title over the mark by filing the prescribed form, accompanied by a prescribed fee and causing particulars of the assignment to be entered in the Register.

The application for registering the assignment of a trade mark shall contain relevant information as to whether the mark was, at the time of the assignment, used in a business in any of the goods or services, and whether the assignment was made with or without the goodwill of the business. With regards to an assignment without goodwill, the assignment shall be advertised in a newspaper or another publication

approved by the Registrar, and a copy of the advertisement shall be filed with the Registrar. It must be stated in the advertisement that the assignment was otherwise than in connection with the goodwill of the business concerned.

## 7.2 Are there different types of assignment?

There are several types of assignment, namely assignment with goodwill of the business, assignment without goodwill of the business and partial assignment. The latter is concerned with the division and separation of the goods or services of a registration, or a division and separation of places or markets in the name of different persons whom shall be treated as registered proprietors separately.

## 7.3 Can an individual register the licensing of a trade mark?

If any individual is granted a right to use the trade mark by the registered proprietor for all goods or services by way of a lawful contract, that person (licensee) is required to be registered with the Registrar as a registered user of the said trade mark.

The licensee shall file an application to enter the licence in prescribed form supported by the necessary information and accompanied by a prescribed fee. Where there is more than one proposed registered user, such application shall be made separately.

## 7.4 Are there different types of licence?

There are different types of licence which consist of one-off licence, sole licence, exclusive licence or a non-exclusive licence.

## 7.5 Can a trade mark licensee sue for infringement?

Subject to any agreement between the trade mark licensee (registered user), and the licensor (registered proprietor), the former has the right to commence civil suit in his own name for trade mark infringement if the latter refuses or neglects to take any legal action within two months upon request of the trade mark licensee to do so. The trade mark licensee may also claim relief against the registered proprietor for failure to exercise any rights conferred on him in order to safeguard the interest of the trade mark licensee.

## 7.6 Are quality control clauses necessary in a licence?

By virtue of the TMA 1976, quality control clauses are necessary in a licence to ensure that the registered proprietor has supervisory power and control over the quality of the goods and services to which the marks are applied by the registered user.

## 7.7 Can an individual register a security interest under a trade mark?

Currently, there is no express provision in the context of Malaysian laws which provide for this.

## 7.8 Are there different types of security interest?

This is not applicable. Please refer to question 7.7.

## 8 Revocation

### 8.1 What are the grounds for revocation of a trade mark?

Revocation of a trade mark is concerned with the cancellation or removal from the Register of the entry of a trade mark. Generally, an order for revocation of a trade mark is made on the following grounds of non-use of the registered trade mark:

- (a) the trade mark was registered without intention in good faith to use it and there has been no use in good faith for at least one month from the date of application to cancel the entry of the registered trade mark; and
- (b) no use for a continuous period of at least three years prior to the application to cancel the entry of the registered trade mark.

See further section 9 below.

### 8.2 What is the procedure for revocation of a trade mark?

An application for revocation of a trade mark shall be filed to the High Court supported by an affidavit.

### 8.3 Who can commence revocation proceedings?

An “aggrieved person” is entitled to commence revocation proceedings. An aggrieved person is one who has used his mark as a trade mark or who has a genuine and present intention to use his mark as a trade mark in the course of trade which is similar or identical to the trade mark of the registered proprietor that intended to be removed by that person.

### 8.4 What grounds of defence can be raised to a revocation action?

The grounds of defence which can be raised are that the mark has been actively used; associated mark that is registered has been used on goods and special circumstances justifying the non-use of the mark.

### 8.5 What is the route of appeal from a decision of revocation?

The decision of the High Court can be appealed to the Court of Appeal and subsequently to the Federal Court, provided leave of the Federal Court is granted.

## 9 Invalidity

### 9.1 What are the grounds for invalidity of a trade mark?

The registration of a person as a registered proprietor of a trade mark is presumably a *prima facie* evidence of the validity of the original registration of the trade mark and all subsequent assignments and transmissions.

Upon expiration of seven years from the date of registration, the original registration of the trade mark shall be presumed to be valid unless:

- (a) the original registration was obtained by fraud;



- (b) the trade mark offends against section 14 of the TMA 1976 as stated in question 3.3; and
- (c) the trade mark was not distinctive when rectification proceedings began.

### 9.2 What is the procedure for invalidation of a trade mark?

Invalidation proceedings are commenced at the High Court by way of an Originating Summons supported by an affidavit.

### 9.3 Who can commence invalidation proceedings?

An “aggrieved person” is entitled to commence invalidation proceedings.

### 9.4 What grounds of defence can be raised to an invalidation action?

The grounds of defence would be evidence contrary to the grounds for the invalidation action, such as the proof of distinctiveness of the mark when rectification proceedings commenced, evidence that rebuts the allegation of offence under section 14 of the TMA 1876 and evidence of registration in good faith and honesty.

### 9.5 What is the route of appeal from a decision of invalidity?

Please refer to question 8.5.

## 10 Trade Mark Enforcement

### 10.1 How and before what tribunals can a trade mark be enforced against an infringer?

There are several ways for a registered proprietor to enforce his trade mark right against an infringer which are as follows:

- (a) initiate a civil action at the High Court;
- (b) apply for a trade description order; and
- (c) lodge a complaint with the Ministry of Domestic Trade, Cooperatives and Consumerism (MDTCC). Upon receipt of the complaint, the Enforcement Division of the MDTCC will conduct a raid and seizure action. Criminal prosecution of the infringer may be brought by the Public Prosecutor.

### 10.2 What are the pre-trial procedural stages and how long does it generally take for proceedings to reach trial from commencement?

- (1) In a Writ action for infringement, the defendant is required to enter his appearance within 14 days after service of the Writ for cases filed in Peninsular Malaysia.
- (2) Within 14 days from entering appearance, the defendant is required to file and serve his defence.
- (3) Within 14 days from service of the defence, the plaintiff may file and serve a reply to the defence.
- (4) Pleadings are deemed closed 14 days after the filing and service of the reply or if there is no reply, within 14 days after filing and services of the defence.

The court will fix case management where the parties are required to appear before the court for directions on the management of the case. Case management directions are typically as follows:

- (a) a statement of the issues to be tried must be filed and served;
- (b) a statement of agreed facts must be filed and served;
- (c) common bundle of documents for trial must be filed and served;
- (d) a list of witnesses must be filed and served; and
- (e) witness statements must be filed and served before the trial.

A case is often set down for trial within six to nine months from the commencement of proceedings.

### 10.3 Are (i) preliminary and (ii) final injunctions available and if so on what basis in each case?

Both preliminary and final injunctions are available at the discretion of the court. Other interlocutory injunctions available include *Anton Piller* orders and *Mareva* injunctions.

The grounds for obtaining an interlocutory injunction are as follows:

- (a) there must be a serious question to be tried;
- (b) compensation *in lieu* of an injunction would be inadequate for the plaintiff;
- (c) the plaintiff must provide an undertaking as to damages;
- (d) balance of convenience must lie in favour of the plaintiff granted the injunction;
- (e) the plaintiff is under a duty to make full and frank disclosure; and
- (f) an application for an injunction must be made promptly.

The grounds for obtaining an *Anton Piller* Order are as follows:

- (a) there must be a *prima facie* case;
- (b) the defendant is in possession of the incriminating evidence;
- (c) the defendant’s act(s) must have caused serious damage to the plaintiff;
- (d) the plaintiff must provide an undertaking as to damages;
- (e) the plaintiff is under a duty to make full and frank disclosure; and
- (f) an application for an injunction must be made promptly.

The grounds for obtaining a *Mareva* injunction are as follows:

- (a) there must be a good arguable case;
- (b) the plaintiff must specify a limit on the amount of the defendant’s assets being dissipated;
- (c) the plaintiff is under a duty to make full and frank disclosure;
- (d) the defendant must have assets within jurisdiction;
- (e) there is a risk of the defendant disposing his assets;
- (f) the plaintiff must provide undertaking as to damages; and
- (g) an application for an injunction must be made promptly.

### 10.4 Can a party be compelled to provide disclosure of relevant documents or materials to its adversary and if so how?

A party can be compelled to provide disclosure of relevant documents or materials by way of discovery process. In an action commenced by Writ, a notice has to be served on the party who is required to produce documents. Privileged documents cannot be disclosed whereas confidential documents may be discoverable subject to confidentiality orders of the court.

### 10.5 Are submissions or evidence presented in writing or orally and is there any potential for cross-examination of witnesses?

For writ actions, oral evidence is given at trial. Parties may also rely on documentary evidence. Witnesses may be cross-examined and subsequently re-examined by counsel.

For actions commenced by Originating Summons, evidence is given by way of affidavit. The deponent of an affidavit may be cross-examined.

The court often directs parties to file written submissions at the close of the trial or other proceedings. Parties may also make oral submissions before the court in addition to written submissions.

### 10.6 Can infringement proceedings be stayed pending resolution of validity in another court or the Intellectual Property Office?

Infringement proceedings may be stayed by the court pending resolution of the validity of a trade mark. However, as invalidation proceedings are often tried before the same court or filed in the same suit by way of counter claim, it is common for both invalidation and infringement actions to be consolidated, if they are commenced separately, and heard together, or for the party seeking invalidation to be heard first.

### 10.7 After what period is a claim for trade mark infringement time-barred?

A claim for trade mark infringement and the tort of passing off is time-barred after six years from the act of infringement or offending act.

### 10.8 Are there criminal liabilities for trade mark infringement?

Criminal liabilities for trade mark infringement are provided via administrative action and criminal prosecution under the Trade Descriptions Act 2011. After a raid and seizure action conducted by the Ministry, the offender may be prosecuted.

Upon conviction for false trade description, a body corporate may be liable for a fine not exceeding RM250,000 or RM500,000 if the body corporate is a repetitive offender, and if it is not a body corporate, there will be an imposition of fine not exceeding RM100,000 or imprisonment not exceeding three years or both, and a repeat offender will be fined up to an amount not exceeding RM250,000 or imprisoned for a term not exceeding five years or both.

### 10.9 If so, who can pursue a criminal prosecution?

Only the Public Prosecutor may institute criminal prosecution.

### 10.10 What, if any, are the provisions for unauthorised threats of trade mark infringement?

Presently, there is no express provision within the context of Malaysian laws which provide for this.

## 11 Defences to Infringement

### 11.1 What grounds of defence can be raised by way of non-infringement to a claim of trade mark infringement?

The grounds of defence include but are not limited to the followings:

- (a) the defendant's mark will not likely deceive or cause confusion;
- (b) the defendant's mark is distinguishable from the plaintiff's; and/or
- (c) the defendant did not use the plaintiff's trade mark.

The statutory grounds of defence of non-infringement are as follows:

- (a) the use in good faith by a person of his own name or the name of his place of business or the name of the place of business of any of his predecessors in business;
- (b) the use in good faith by a person of a description of the character or quality of his goods or services, and in the case of goods not being a description that would be likely to be taken as importing any reference to the registered proprietor;
- (c) the continuous use by a person of a trade mark in relation to goods or services in respect of which he has by himself or his predecessors in business, from a date before:
  - (i) the use of the registered trade mark by the registered proprietor, by his predecessor in business or by a registered user of the trade mark; or
  - (ii) the registration of the trade mark, whichever is earlier;
- (d) use by a person in relation to goods which form part of the bulk of goods connected in the course of trade with the registered proprietor or registered user, where the registered proprietor or registered user has applied the trade mark and has not removed or obliterated it;
- (e) where use is expressly or impliedly consented to by a registered proprietor or registered user;
- (f) where use is expressly or impliedly consented to by a registered proprietor or registered user;
- (g) use in relation to goods or services adapted to form part of, or to be an accessory to, other goods or services in relation to which the trade mark has been used without infringement, if the use is reasonably necessary to indicate that the goods or services are so adapted and such use does not have the purpose or effect of indicating otherwise than in accordance with the facts in connection in the course of trade between any person and the goods or services; and
- (h) use of one of two or more registered trade marks which are substantially identical, in exercise of the right to the use of that trade mark given by registration.

### 11.2 What grounds of defence can be raised in addition to non-infringement?

Please refer to question 9.4.

## 12 Relief

### 12.1 What remedies are available for trade mark infringement?

The remedies available for trade mark infringement are damages or account for profits, injunction, delivery-up and/or destruction

of the infringing items, discovery of all relevant information and documents in connection with the infringement and legal costs. In the case of counterfeits, the court has also granted relief in the form of a public apology by the infringer but this is not a remedy granted as of right.

### 12.2 Are costs recoverable from the losing party and if so what proportion of the actual expense can be recovered?

Yes. Generally, the winning party are awarded costs. The costs recoverable are generally between 40% to 60% of actual incurred legal costs and expenses.

## 13 Appeal

### 13.1 What is the right of appeal from a first instance judgment and is it only on a point of law?

The right of appeal from a first instance judgment is to the Court of Appeal in respect of the whole or any part of judgment, and may be based on a point of fact or law, or both. An appeal from the Court of Appeal to the Federal Court requires leave of the Federal Court and may only be based on a point of law.

### 13.2 In what circumstances can new evidence be added at the appeal stage?

As the general rule, new evidence is not admissible at the appeal stage unless it can be shown that:

- the evidence could not have been obtained with reasonable diligence for use at trial;
- the evidence would probably have an important influence on the result of the case though it may not be decisive; and
- the evidence must be apparently credible although it need not be incontrovertible.

## 14 Border Control Measures

### 14.1 What is the mechanism for seizing or preventing the importation of infringing goods or services and if so how quickly are such measures resolved?

The registered proprietor of a trade mark or an agent of the proprietor may file an application to the Registrar as an objection to the importation of, in relation to the registered trade mark, counterfeit trade mark goods at a time and place specified in the application. The application must be accompanied by the prescribed fee, an affidavit and five copies of the application. The affidavit must contain relevant information such as the applicant is the proprietor of the mark or the agent having the power to submit such application, the registration number of the trade mark, the representation of the mark and interest of the applicant in the mark. Alternatively, the registered proprietor may request customs authorities who are empowered with the right to detain the suspected infringing goods or services.

## 15 Other Related Rights

### 15.1 To what extent are unregistered trade mark rights enforceable in your jurisdiction?

Unregistered trade marks are enforceable through common law under tort of passing off. To succeed in this claim, the claimant must prove:

- goodwill or reputation attached to the goods or services in the mind of the public that is associated with the get-up of the goods and services and distinguishes the goods or services from those of competitors;
- a misrepresentation by the defendant to the public which leads or is likely to lead the public to believe that the goods or services offered by him are the goods or services of the claimant; and
- the claimant has suffered, or is likely to suffer, damage by reason of the erroneous belief engendered by the defendant's misrepresentation.

### 15.2 To what extent does a company name offer protection from use by a third party?

The registration of a company name does not mean that the company name will be automatically protected from third party use. A company has to register its company name as a trade mark or rely on its common law rights to safeguard its interests against the third party.

### 15.3 Are there any other rights that confer IP protection, for instance book title and film title rights?

No, such rights do not exist under trade mark law.

## 16 Domain Names

### 16.1 Who can own a domain name?

A domain name ending with the extension .my is the top-level domain ("TLD") for Malaysia and may be owned by Malaysian organisations, Malaysians and non-Malaysian individuals, commercial organisations or activities, network-related organisations or activities, Malaysian educational organisations, Malaysian governmental organisations and Malaysian military organisations.

In essence, organisations are permitted to apply for [.com.my](http://com.my), [.net.my](http://net.my), and [.org.my](http://org.my) domain names. Individuals aged 18 and above, holding a Malaysian National Registration Identity Card (for Malaysian individuals) or having a valid passport and a valid proof of residing in Malaysia (for non-Malaysian individuals) may apply for personal domain names ([.name.my](http://name.my)). For [.edu.my](http://edu.my), [.mil.my](http://mil.my), and [.gov.my](http://gov.my) domain names, only certified agencies under the education, military and government sectors are eligible to apply for those names.

### 16.2 How is a domain name registered?

A domain name ending with the extension *.my* TLD is registered through the Malaysian Network Information Centre Berhad (MYNIC). Applications for a domain name for Malaysian educational organisations (*.edu.my*), Malaysian governmental organisations (*.gov.my*) and Malaysian military organisations (*.mil.my*) must be submitted online via MYNIC's online registration system. Domain name applications for commercial activities or organisations (*.com.my*), network-related organisations/activities (*.net.my*) and individuals' personal use (*.name.my*) are made through MYNIC's officially appointed partners called resellers. The application has to be supplemented with supporting documents within 14 days from the submission of the application. If the application is rejected, a notice of rejection stating the reasons will be given to the applicant. The unsuccessful applicant will undergo the process all over again from the beginning if he wishes to make a fresh application whereas successful applicants will have to pay the required fees to ensure the domain name remains registered.

### 16.3 What protection does a domain name afford per se?

Upon registration of a domain name, there can be no identical domain with a *'my'* prefix. So long as the subscription is paid, the domain name will remain unique to the registered user.

If a domain name is identical or similar to a registered trade mark or service mark, or if the domain is being used in bad faith, a complaint can be lodged to the Kuala Lumpur Regional Centre of Arbitration (KLRCA), accompanied with the prescribed fees and the dispute shall be resolved at the KLRCA. If the dispute cannot be resolved at the KLRCA, the alternative way is to institute proceedings at the court, resort to arbitration or any other dispute resolution process as agreed by both parties.

The available remedy through proceedings at the KLRCA is the transfer of registration of the domain name to the complainant or deletion of the registration whereas the only available court relief is damages and compensation.

## 17 Current Developments

### 17.1 What have been the significant developments in relation to trade marks in the last year?

The MyIPO has proposed to revise its fees with respect to trade marks due to the escalating costs of upgrading the information and communication technology system. The revision introduces certain changes which include the reduction of certain fees for trade marks as well as an increase of certain other fees at an average of 5% to 50%. There is possible an introduction to an 'upfront fee' for application for registration for a trade mark by combining both the application fee and the fee of request for advertisement of a trade mark. It reflects the proposed deletion of Regulation 33(2) of the TMR which provides for the need to file with the Registrar a request for advertisement of a trade mark (Form 31) and to pay the prescribed fee for the purposes of expediting the process of the registration and avoiding abandonment due to non-response to office action for request for advertisement of a trade mark.

### 17.2 Please list three important judgments in the trade marks and brands sphere that have issued within the last 18 months.

It is noteworthy that the Federal Court in the case of *Mesuma Sports Sdn Bhd v Majlis Sukan Negara Malaysia (Pendaftar Cap Dagangan Malaysia, interested party)* [2015] 6 MLJ 464, in determining the issue of common law ownership of a trade mark in an action for passing off, made a clear demarcation between the creator of a mark and the user of a mark. Unlike copyright and industrial design right wherein first ownership lies with the author or creator, common law ownership of a trade mark requires the party claiming ownership to show not that it had created or designed the identifier but rather that it was the first user of it as a trade mark on goods in the course of its trade. This is the basis which entitles him to claim *bona fide* proprietorship of the mark pursuant to section 25(1) of the TMA which then enables him to file a trade mark application. In this case, the Federal Court held that the respondent was in fact and in law the first user of the trade mark because he had used the mark in his activities and he was directly involved in business activity to commercialise the mark through its contract suppliers. The respondent had established goodwill and reputation through use of the mark in the course of trade in its sports promotional and advancement activities and in purchasing and distribution of sports goods bearing the mark to Malaysian athletes.

In the case of *Ho Tack Sien & Ors v Rotta Research Laboratorium SpA & Anor* (Registrar of Trade Marks, intervener) [2015] 4 MLJ 166, the Federal Court took the opportunity to clarify the scope and functions of the Registrar of Trade Marks ("Registrar"). The questions posed to the Federal Court were: (i) whether the evidence of the Registrar who had approved the registration of the defendant's mark after the commencement of the plaintiff's infringement suit is material to proving trade mark infringement, in that the Registrar is the key witness to establishing likelihood of confusion; (ii) whether it is a pre-requisite to name the Registrar or MyIPO as a party in an application to expunge or rectify the Register; and if the answer is in the affirmative, whether several decisions by the High Court ordering the expungement or rectification of the Register without insisting on the Registrar or MyIPO be named a party in the suits are now bad in law. The Federal Court decided that the evidence of the Registrar was not material to proving the trade mark infringement as the court is ultimately the arbiter. Further, it may put the Registrar in an invidious position and destroy the neutrality of his office. The Federal Court also held that it is not necessary to implead the Registrar as a party to a suit where there is no cause of action against the Registrar unless the Registrar deems it fit or it is so ordered by the court by virtue of section 62 of the TMA. Another important finding is with regards to the Respondents argument that they may rely on the defence under Section 40(1)(f) which provides that use of a trade mark in exercise of the right to use that trade mark given by registration, would not constitute infringement even if that trade mark is substantially identical with another registered trade mark. The Federal Court observed that Section 40(1)(f) is a *non obstante* clause. Therefore, that right is subject to Section 35(1) which provides that the rights given by registration applies only if the registration is valid. Accordingly, the defence under Section 40(1)(f) did not apply in this case as the Federal Court was of the view that the mark was not validly registered.

In the case of *USA Pro IP Limited v Montfort Services Sdn Bhd & Anor* [2015] 7 CLJ 546, the High Court held that for the plaintiff to fall within the definition of ‘aggrieved party’ in an action for expungement of trade mark, the plaintiff only needs to show an intention to use or a genuine trading interest to use its mark in Malaysia. In the present case, the plaintiff was an ‘aggrieved party’ as it was able to prove its commercial intention to expand the use of its mark into the Malaysian market through use of its mark in many jurisdictions and sale of goods bearing its mark in many countries around the world. The High Court further decided that there was non-use of the first defendant’s mark after taking into account the fact that the first defendant was dormant and did not engage in any business or trade, and hence no goodwill and reputation would be generated without which the defendant’s claim for passing off could not be sustained.

### 17.3 Are there any significant developments expected in the next year?

Malaysia is already in the final stages of implementation of the Madrid Protocol to become a Member State concerning international filing for trade marks.

The enactment of new legislation and/or amendment of the current legislation to replace or supplement the current legal framework, and to bring the trade mark law up to date with the current international trade mark regime, such as the introduction of non-traditional marks, security interests and accession to the Madrid Protocol is expected in the next year.

### 17.4 Are there any general practice or enforcement trends that have become apparent in your jurisdiction over the last year or so?

The Ministry of Domestic Trade, Cooperative and Consumerism (“the Ministry”) has taken the initiative to put into effect the ‘Basket of Brands’ scheme which was launched in 2011 as part of the Ministry’s efforts to expedite enforcement actions and to combat the issues of counterfeiting goods in Malaysia. The initiative has now garnered over 290 brand registrations from over 40 companies. In order to qualify for the scheme, the following documents must be furnished to the Ministry:

- (i) the registration certificate or certificates of the relevant marks;
- (ii) a trade description order;
- (iii) a letter of authorisation from the registered proprietor of trade mark if the registered proprietor is represented by an agent; and
- (iv) a signed undertaking to cooperate and complete the investigation for infringing registered trade mark cases.

Following the implementation of a central database, registered proprietors of trade marks who register their respective brands under the scheme will be able to gain priority in the initiation of enforcement actions and prosecution of trade mark infringement cases. The scheme, by “placing genuine brands in one basket”, enables the enforcement officers to easily identify the brands that are at risk of being infringed and the authenticity of the goods sold in the market so that they can take prompt action and effective measures upon receipt of a complaint by the registered proprietor of the trade mark.

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