

Act A881
Trade Marks (Amendment) Act 1994

Long Title & Preamble

An Act to amend the Trade Marks Act 1976.

BE IT ENACTED by the Seri Paduka Baginda Yang di-Pertuan Agong with the advice and consent of Dewan Negara and Dewan Rakyat in Parliament assembled, and by the authority of the same, as follows:

Section 1. Short title and commencement.

This Act may be cited as the **Trade Marks (Amendment) Act 1994** and shall come into force on such date as the Minister may, by notification in the *Gazette*, appoint; and different dates may be appointed for the coming into force of different provisions of this Act.

Section 2. Amendment of section 2.

Subsection 2(2) of the Trade Marks Act 1976 [Act 175], which in this Act is referred to as the "principal Act", is amended by substituting for the words "the registrations of trade marks made" the words "trade marks registered".

Section 3. Amendment of section 3.

Section 3 of the principal Act is amended-

(a) in subsection (1)-

(i) by inserting after the definition of "component regions of Malaysia" the following:

"Convention country" means a country which is a party to any multilateral treaty relating to trade marks to which Malaysia is also a party;";

(ii) by inserting after the definition of "Court" the following:

"in the course of trade", in relation to the provision of services, means in the course of business;";

(iii) in the definition of "limitations" by inserting after the word "Malaysia" in paragraph (c) the words "or use in relation to services to be provided in a place outside Malaysia";

(iv) in the definition of "permitted use" by inserting after the word "goods" the words "or services":

(v) by inserting after the definition of "prescribed" the following:

"prescribed foreign country" means a country declared by the Minister, by order published in the *Gazette*, as having made arrangements with Malaysia for the reciprocal protection of trade marks;

;

(vi) by inserting after the definition of "repealed Ordinance" the following:

"specification" means the designation of goods or services in respect of which a trade mark or a registered user of a trade mark is registered or proposed to be registered;; and

(vii) by inserting after the word "goods" wherever it appears in the definition of "trade mark" the words "or services"; and

(b) in subsection (2)-

(i) by deleting the word "and" at the end of paragraph (a);

(ii) by substituting for the full stop at the end of paragraph (b) the word "-", and"; and

(iii) by inserting after paragraph (b) the following:

"(c) references to the use of a mark in relation to services shall be construed as references to the use thereof as a statement or as part of a statement about the availability or performance of services."

Section 4. Amendment of section 4.

Section 4 of the principal Act is amended-

(a) in subsection (1) by substituting for the words "There shall be a Registrar of Trade Marks" the words "The Minister may appoint a person to be the Registrar of Trade Marks"; and

(b) in subsection (3) by deleting the words "prescribed by the Minister or".

Section 5. Amendment of section 5.

Section 5 of the principal Act is amended-

(a) by inserting after subsection (2) the following:

"(2A) In addition to the regional trade marks office established in the State of Sabah and Sarawak, there may be established such number of trade marks offices as may be necessary for the purposes of this Act."; and

(b) by deleting the word "regional" wherever it appears in subsection (3).

Section 6. Amendment of section 8.

Subsection 8(3) of the principal Act is amended by deleting the word "regional".

Section 7. Amendment of section 9.

Paragraph 9(b) of the principal Act is amended by deleting the word "regional".

Section 8. Amendment of section 10.

Section 10 of the principal Act is amended-

(a) in subsection (1)-

(i) by inserting after the word "goods" in paragraph (d) the words "or services"; and

(ii) by inserting after the word "any" in paragraph (e) the word "other";

(b) by inserting after subsection (2) the following:

"(2A) For the purposes of this section, "distinctive", in relation to the trade mark registered or proposed to be registered in respect of goods or services, means it is adapted to distinguish goods or services with which the proprietor of the trade mark is or may be connected in the course of trade from goods or services in the case of which no such connection subsists, either generally or, where the trade mark is registered or proposed to be registered, subject to conditions, amendments, modifications or limitations, in relation to use within the extent of the registration.

(2B) In determining whether a trade mark is adapted to distinguish as aforesaid regard may be had to the extent to which-

(a) the trade mark is inherently adapted to distinguish as aforesaid; and

(b) by reason of the use of the trade mark or of any other circumstances, the trade mark is in fact adapted to distinguish as aforesaid."; and

(c) in subsection (3)-

(i) by inserting after the words "any goods" the words "or services"; and

(ii) by substituting for the words "or different goods" the words "goods or services or other goods or services".

Section 9. Amendment of section 11.

Section 11 of the principal Act is amended-

(a) by substituting for subsection (1) the following:

"(1) In order for a trade mark to be registrable in Part B of the Register, it must be capable, in relation to goods or services in respect of which it is registered or proposed to be registered, of distinguishing goods or services with which the proprietor of the trade mark is or may be connected in the course of trade from goods or services in the case of which no such connection subsists, either generally or, where the trade mark is registered or proposed to be registered, subject to conditions, amendments, modifications or limitations, in relation to use within the extent

of the registration.";

(b) by inserting after subsection (1) the following:

"(1A) In determining whether a trade mark is capable of distinguishing as aforesaid, regard may be had to the extent to which-

(a) the trade mark is inherently capable of distinguishing as aforesaid; and

(b) by reason of the use of the trade mark or of any other circumstances, the trade mark is in fact capable of distinguishing as aforesaid."; and

(c) in subsection (2)-

(i) by inserting after the words "any goods" the words "or services"; and

(ii) by substituting for the words "or different goods" the words "goods or services or other goods or services".

Section 10. Substitution of section 12.

The principal Act is amended by substituting for section 12 the following:

"12. Use by proposed registered user to be considered for the purpose of determining distinctiveness, etc.

(1) Where an application for registration of a trade mark has been made by a person, and before the date of the application the trade mark had been used by a person other than the applicant under the control of and with the consent and authority of the applicant, and where an application is made by the applicant and that other person for the registration of that other person as a registered user of the trade mark immediately after the registration of the trade mark and the Registrar is satisfied that the other person is entitled to be registered as a registered user of the trade mark, the Registrar may, for the purpose of determining whether the trade mark is distinctive of or capable of distinguishing the goods or services of the applicant, treat use of the trade mark by that other person as equivalent to use of the trade mark by the applicant and may make an order that the trade mark is so distinctive or capable of distinguishing.

(2) An order of the Registrar under subsection (1) is subject to appeal to the Court.

(3) Where an order is made under subsection (1), the registration of the trade mark shall cease to have effect if at the expiration of the prescribed period, or such further period not exceeding six months as the Registrar may allow, that other person has not become registered as the registered user of the trade mark."

Section 11. Amendment of section 14.

Section 14 of the principal Act is amended-

(a) by deleting the word "and" at the end of paragraph (a);

(b) by substituting for the full stop at the end of paragraph (b) the word "; or"; and

(c) by inserting after paragraph (b) the following:

"(c) if it contains a matter which in the opinion of the Registrar is or might be prejudicial to the interest or security of the nation."

Section 12. Amendment of section 16.

Section 16 of the principal Act is amended by substituting for the words "dead or alive" the words "living or dead".

Section 13. Amendment of section 17.

Section 17 of the principal Act is amended-

(a) by inserting after the word "goods" in the marginal note the words "or services":

(b) in subsection (1)-

(i) by substituting for the word "shall" the word "may"; and

(ii) by inserting after the words "prescribed class of goods" the words "or in respect of any or all of the services comprised in a prescribed class of services"; and

(c) by inserting after the word "goods" in subsection (2) the words "or services".

Section 14. Substitution of section 19.

The principal Act is amended by substituting for section 19 the following:

"19. Identical trade marks.

(1) No trade mark shall be registered in respect of any goods or description of goods-

(a) that is identical with a trade mark belonging to a different proprietor and entered in the Register in respect of the same goods or description of goods or in respect of services that are closely related to those goods; or

(b) that so nearly resembles such a trade mark as is likely to deceive or cause confusion.

(2) No trade mark shall be registered in respect of any services or description of services-

(a) that is identical with a trade mark belonging to a different proprietor and entered in the Register in respect of the same services or description of services or in respect of goods that are closely related to those services; or

(b) that so nearly resembles such a trade mark as is likely to deceive or cause confusion.

(3) Where separate applications are made by different persons 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 and-

(a) such applications are in respect of the same goods or description of goods; or

(b) at least one of such applications is in respect of goods and the other or others is or are in respect of services closely related to those goods,

the Registrar may refuse to register any of them until their rights have been determined by the Court or have been settled by agreement in a manner approved by him or by the Court.

(4) Where separate applications are made by different persons 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 and-

(a) such applications are in respect of the same services or description of services; or

(b) at least one of such applications is in respect of services and the other or others is or are in respect of goods closely related to those services,

the Registrar may refuse to register any of them until their rights have been determined by the Court or have been settled by agreement in a manner approved by him or by the Court."

Section 15. Amendment of section 20.

Section 20 of the principal Act is amended-

(a) by substituting for subsection (1) the following:

"(1) Notwithstanding subsection (1) of section 19, in the case of honest concurrent use or of the circumstances described in paragraph (c) of subsection (4) of section 6 or of other special circumstances which, in the opinion of the Court or the Registrar, make it proper so to do, the Court or the Registrar may permit the registration of more than one proprietor in respect of trade marks which are identical or so nearly resembling each other as are likely to deceive or cause confusion where the registration of the different proprietors-

(a) is in respect of the same goods or description of goods; or

(b) in the case of at least one proprietor, is in respect of goods, and in the case of the other or others, is in respect of services closely related to those goods,

subject to such conditions, amendments, modifications or limitations, if any, as the Court or the Registrar, as the case may be, may think right to impose."; and

(b) by inserting after subsection (1) the following:

"(1A) Notwithstanding subsection (2) of section 19, in the case of honest concurrent use or of other special circumstances which, in the opinion of the Court or the Registrar, make it proper so to do, the Court or the Registrar may permit the registration of more than one proprietor in respect of trade marks which are identical or so nearly resembling each other as are likely to deceive or cause confusion where the registration of the different proprietors-

(a) is in respect of the same services or description of services; or

(b) in the case of at least one proprietor, is in respect of services, and in the case of the other or others, is in respect of goods closely related to those services,

subject to such conditions, amendments, modifications or limitations, if any, as the Court or the Registrar, as the case may be, may think right to impose."

Section 15. Amendment of section 20.

Section 20 of the principal Act is amended-

(a) by substituting for subsection (1) the following:

"(1) Notwithstanding subsection (1) of section 19, in the case of honest concurrent use or of the circumstances described in paragraph (c) of subsection (4) of section 6 or of other special circumstances which, in the opinion of the Court or the Registrar, make it proper so to do, the Court or the Registrar may permit the registration of more than one proprietor in respect of trade marks which are identical or so nearly resembling each other as are likely to deceive or cause confusion where the registration of the different proprietors-

(a) is in respect of the same goods or description of goods; or

(b) in the case of at least one proprietor, is in respect of goods, and in the case of the other or others, is in respect of services closely related to those goods,

subject to such conditions, amendments, modifications or limitations, if any, as the Court or the Registrar, as the case may be, may think right to impose."; and

(b) by inserting after subsection (1) the following:

"(1A) Notwithstanding subsection (2) of section 19, in the case of honest concurrent use or of other special circumstances which, in the opinion of the Court or the Registrar, make it proper so to do, the Court or the Registrar may permit the registration of more than one proprietor in respect of trade marks which are identical or so nearly resembling each other as are likely to deceive or cause confusion where the registration of the different proprietors-

(a) is in respect of the same services or description of services; or

(b) in the case of at least one proprietor, is in respect of services, and in the case of the other or others, is in respect of goods closely related to those services,

subject to such conditions, amendments, modifications or limitations, if any, as the Court or the Registrar, as the case may be, may think right to impose."

Section 17. Amendment of section 22.

Section 22 of the principal Act is amended-

(a) by substituting for subsection (1) the following:

"(1) Where a trade mark which is registered or is the subject of an application for registration in respect of any goods-

(a) is identical with another trade mark which is registered or is the subject of an application for registration in the name of the same proprietor in respect of the same goods or description of goods or in respect of services that are closely related to those goods; or

(b) is so nearly resembling it as is likely to deceive or cause confusion if used by a person other than the proprietor,

the Registrar may at any time require that the trade marks be entered on the Register as associated trade marks.";

(b) by inserting after subsection (1) the following:

"(1A) Where a trade mark which is registered or is the subject of an application for registration in respect of any services-

(a) is identical with another trade mark which is registered or is the subject of an application for registration in the name of the same proprietor in respect of the same services or description of services or in respect of goods that are closely related to those services; or

(b) is so nearly resembling it as is likely to deceive or cause confusion if used by a person other than the proprietor,

the Registrar may at any time require that the trade marks be entered on the Register as associated trade marks."; and

(c) by inserting after the word "goods" in subsection (2) the words "or services".

Section 18. Amendment of section 24.

Subsection 24(1) of the principal Act is amended-

(a) by inserting after the words "description of goods" the words "in a single class or in respect of the same services or description of services in a single class"; and

(b) by inserting after the word "goods" in paragraph (a) the words "or services".

Section 19. Amendment of section 25.

Section 25 of the principal Act is amended-

(a) by inserting after the word "goods" in subsection (2) the words "or services"; and

(b) by inserting after the words "had not been accepted" in subsection (12) the words "or, in respect only of a trade mark which shall be registered subject to additional or different conditions or limitations, reissue a new acceptance subject to additional or different conditions or limitations'").

Section 20. Amendment of section 26.

Section 26 of the principal Act is amended-

- (a) by inserting after the word "goods" wherever it appears in subsections (1) and (3) the words "or services"; and
- (b) by substituting for the words "if the application is accompanied by an application" in subsection (1) the words "if an application has been made".

Section 21. Amendment of section 27.

Section 27 of the principal Act is amended by substituting for the words "it is made under paragraph (e) of subsection (1) of section 10" in subsection (2) the words "the considerations in subsection (2B) of section 10 or subsection (1A) of section 11 apply".

Section 22. Amendment of section 28.

Section 28 of the principal Act is amended-

- (a) by inserting after the word "Registrar" in subsection (1) the words "and applicant";
- (b) by substituting for subsection (3) the following:

"(3) The applicant shall, within the prescribed time after the receipt of the notice of opposition, send to the Registrar and the opponent a counter-statement, in the prescribed manner, of the grounds for his application, and, if he does not do so, he shall be deemed to have abandoned his application.";
- (c) by inserting after subsection (3) the following:

"(3A) If the applicant submits a counter-statement under subsection (3), the opponent and applicant shall file evidence and exhibits in the prescribed manner and within the prescribed time in support of the opposition or the counter-statement, as the case may be, to be adduced in the prescribed manner, and if the opponent or applicant fails to do so, the opposition or application, as the case may be, shall be treated as abandoned.

(3B) If the applicant files evidence and exhibits under subsection (3A), the opponent may, within the prescribed time, send to the Registrar and applicant evidence in reply to be adduced in the prescribed manner.";
- (d) by substituting for subsection (4) the following:

"(4) After considering the evidence and exhibits and after giving the applicant and the opponent an opportunity of making written submissions, the Registrar shall decide whether-

 - (a) to refuse to register the trade mark;
 - (b) to register the trade mark absolutely; or

(c) to register the trade mark subject to such conditions, amendments, modifications or limitations as he may think fit."; and

(e) in subsection (10)-

(i) by substituting for the word "counter-claim" the word "counter-statement";

(ii) by deleting the words "a copy of";

(iii) by inserting after the words "business in Malaysia, the" the words "Registrar or the"; and

(iv) by deleting the words "before it".

Section 23. Amendment of section 29.

Section 29 of the principal Act is amended-

(a) by substituting for the word "accepted" in subsection (1) the word "completed"; and

(b) by substituting for the word "non-acceptance" in subsection (2) the word "non-completion".

Section 24. Amendment of section 31.

Subsection 31(2) of the principal Act is amended-

(a) by deleting the word "or" at the end of paragraph (a);

(b) by substituting for the word "Court," in - paragraph (b) the words "Court; or"; and

(c) by inserting after paragraph (b) the following:

"(c) an action on the part of the Central Trade Marks office or any trade marks office,".

Section 25. Amendment of section 32.

Subsection 32(1) of the principal Act is amended by substituting for the word "seven" the word "ten".

Section 26. Amendment of section 33.

Section 33 of the principal Act is amended-

(a) by substituting for the words "an article or substance" in the marginal note the words "article, substance or service";

(b) by substituting for the words "article or substance" in subsection (1) the words "article, a substance or a service";

(c) in subsection (2)-

(i) by deleting the word "or" at the end of paragraph (a);

(ii) by substituting for the comma at the end of paragraph (b) the word "; or"; and

(iii) by inserting after paragraph (b) the following:

"(c) that there is a well known and established use of the word or words as the name or description of some service by a person or persons providing services which include that service, not being use in relation to services the provision of which the proprietor or registered user of the trade mark is connected to in the course of trade,"; and

(d) in subsection (3)-

(i) by substituting for the words "paragraph (a) or (b)" the words "paragraph (a), (b) or (c)";

(ii) by substituting for the words "article or substance in question or of any goods of the same description" in paragraph (a) the words "article, substance or service in question or of any goods or service of the same description";

(iii) by substituting for the words "article or substance in question or of any goods of the same description" in paragraph (b) the words "article, substance or service in question or of any goods or service of the same description";

(iv) by substituting for the words "article or substance or any goods of the same description" in paragraph (b) the words "article, substance or service in question or any goods or service of the same description";

(v) by substituting for the words "article or substance in question or to any goods of the same description" in paragraph (c) the words "article, substance or service in question or to any goods or service of the same description"; and

(vi) by inserting after the words "paragraph (a)" in paragraph (c) the words "or (c)".

Section 27. Amendment of section 35.

Section 35 of the principal Act is amended-

(a) by inserting after the word "goods" wherever it appears in subsection (1) the words "or services"; and

(b) by deleting the words "whether for the same goods or different goods" in subsection (2).

Section 28. Amendment of section 37.

Paragraph 37(c) of the principal Act is amended by inserting after the word "goods" the words "or services".

Section 29. Amendment of section 38.

Section 38 of the principal Act is amended-

(a) in subsection (1)-

(i) by inserting after the words "in the course of trade in relation to goods" the words "or services";

(ii) by deleting the word "or" appearing at the end of paragraph (a);

(iii) by substituting for the full stop at the end of paragraph (b) the word "; or"; and

(iv) by inserting after paragraph (b) the following:

"(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."; and

(b) by inserting after the word "goods" in subsection (2) the words "or services".

Section 30. Amendment of section 40.

Section 40 of the principal Act is amended-

(a) in subsection (1)-

(i) by inserting after the word "goods" in paragraph (b) the words "or services, and in the case of goods"

(ii) by inserting after the word "goods" wherever it appears in paragraphs (c) and (e) the words "or services";

(iii) by inserting after the words "obliterated it" in paragraph (d) a semicolon and deleting the words "or has at any time expressly or impliedly consented to the use of the trade mark; and"; and

(iv) by inserting after paragraph (d) the following:

"(dd) the use by a person of a trade mark in relation to goods or services to which the registered proprietor or registered user has at any time expressly or impliedly consented to;"; and

(b) by inserting after the word "market" in subsection (2) the words "or in relation to services to be provided in a place".

Section 31. Amendment of section 41.

Section 41 of the principal Act is amended-

(a) in subsection (1) by substituting for the word "fourteen" the word "ten";

(b) in subsection (2) by inserting after the words "as may be prescribed" the words ", upon payment of fees for restoration"; and

(c) by inserting after subsection (2) the following:

"(3) Notwithstanding subsection (2), the registration of a trade mark shall not be renewed where the application for renewal is made after one year has lapsed from the date of expiration of the last registration."

Section 32. Amendment of section 42.

Section 42 of the principal Act is amended by substituting for the words "the removal" the words "expiration of the last registration".

Section 33. Amendment of section 43.

Section 43 of the principal Act is amended-

(a) by inserting after the word "goods" in subsection (1) the words "or services"; and

(b) by substituting for the words "of the" in subsection (2) the words "of that".

Section 34. Amendment of section 46.

Section 46 of the principal Act is amended-

(a) in subsection (1)-

(i) by deleting the words "or the Registrar"; and

(ii) by inserting after the word "goods" wherever it appears the words "or services";

(b) by substituting for subsection (2) the following:

"(2) Except where an applicant has been permitted under section 20 to register an identical or a nearly resembling trade mark in respect of the goods or services to which the application relates or the Court is of the opinion that the applicant can properly be permitted to register the trade mark, the Court may refuse an application made under subsection (1)-

(a) in relation to any goods, if there has been, before the relevant date or during the relevant period, as the case may be, use in good faith of the trade mark by the registered proprietor of the trade mark for the time being in relation to goods of the same description, being goods in respect of which the trade mark is registered; and

(b) in relation to any services, if there has been, before the relevant date or during the relevant period, as the case may be use in good faith of the trade mark by the registered proprietor of the trade mark for the time being in relation to services of the same description, being services in respect of which the trade mark is registered.";

(c) by deleting the words "or the Registrar" wherever they appear in subsection (3);

(d) by inserting after subsection (3) the following:

"(3A) Where in relation to services in respect of which a trade mark is registered-

(a) the matters referred to in paragraph (b) of subsection (1) are shown as far as regards failure to use the trade mark in relation to services provided in a particular place in Malaysia; and

(b) a person has been permitted under section 20 to register an identical or a nearly resembling trade mark in respect of those services under a registration extending to the use in relation to services provided in that place, or the Court is of the opinion that that person might properly be permitted to register the trade mark,

the Court may, on application by that person, direct that the registration of the first-mentioned trade mark shall be subject to such conditions, amendments, modifications or limitations as the Court thinks proper for securing that that registration shall cease to extend to use of the trade mark in relation to services provided in that place.";

(e) by inserting after the words "subsection (3)" in subsection (4) the words "or (3A)"; and

(f) by deleting subsection (5).

Section 35. Amendment of section 47.

Subsection 47(1) of the principal Act is amended by inserting after the word "goods" the words "or services".

Section 36. Substitution of section 48.

The principal Act is amended by substituting for section 48 the following:

"48. Registered users.

(1) Subject to the provisions of this section, where the registered proprietor of a trade mark grants, by lawful contract, a right to any person to use the trade mark for all or any of the goods or services in respect of which the trade mark is registered, that person may be entered on the Register as a registered user of the said trade mark whether with or without any conditions or restrictions, provided that it shall be a condition of any such registration that the registered proprietor shall retain and exercise control over the use of the trade mark and over the quality of the goods or-services provided by the registered user in connection with that trade mark.

(2) Where it is proposed that a person shall be registered as a registered user of a trade mark, the registered proprietor shall submit an application to the Registrar for the registration of that person as a registered user of the trade mark and such application shall be accompanied by the prescribed fee and the following information:

(a) the representation of the registered trade mark;

(b) the names, addresses, and addresses for service of the parties;

(c) the goods or services in respect of which the registration is proposed;

(d) any conditions or restrictions proposed with respect to the characteristics of the goods or services, to the mode or place of permitted use or to any other matter; and

(e) whether the permitted use is to be for a period or without limit of period, and if for a period, the duration of that period.

(3) The registered proprietor shall furnish the Registrar with such further documents, information or evidence as may be required by the Registrar or any regulations made under this Act.

(4) On receipt of an application for registration of a person as a registered user of a trade mark under subsection (2), the Registrar shall enter on the Register all the particulars required to be provided thereunder.

(5) Where a person has been registered as a registered user of a trade mark, the use of that trade mark by the registered user within the limits of his registration shall be deemed to be use by the registered proprietor of the trade mark to the same extent as the use of the trade mark by the registered user and shall be deemed not to be use by any other person.

(6) The provisions of subsection (5) shall cease to have effect with regard to any registered user of a trade mark-

(a) if the trade mark ceases to be a registered trade mark for any reason;

(b) if the goods or services for which the trade mark is registered are subsequently limited so as to exclude any or all of the goods or services in respect of which the registration of the registered user has been made;

(c) if the registered proprietor ceases to exercise control over the use of the trade mark and over the quality of the goods or services provided by the registered user concerned in relation to that trade mark;

(d) at the date of expiration of the last registration of the trade mark unless a fresh application under subsection (2) accompanies any application for renewal of the registration of that trade mark;

(e) at the date of any assignment or transmission of the registered trade mark, unless and until the devolution of title is recorded on the Register in accordance with the provisions of this Act and the subsequent proprietor of the registered trade mark makes a fresh application under subsection (2).

(7) If the registered proprietor of a trade mark fails to exercise any of the rights conferred on him by his registration to the prejudice of any registered user of that trade mark, the registered user may apply to the Court for such relief as the Court may consider just, including rectification of the Register by ordering that the registered user be recorded as the registered proprietor of the trade mark, and in any case where use of the trade mark by any person entitled to use it would be likely to deceive or cause confusion, the Court may order that the trade mark shall be removed from the Register, notwithstanding the provisions of section 37.

(8) The provisions of section 62 shall apply to any proceedings under subsection (7) that might lead to any alteration or rectification of the Register."

Section 37. Amendment of section 49.

Section 49 of the principal Act is amended-

(a) in subsection (1)-

(i) by inserting after the word "goods" in paragraph (a) the words "or services";

(ii) by substituting for paragraph (c) the following:

"(c) may be cancelled by the Registrar on the application of the registered proprietor."; and

(iii) by deleting paragraph (d);

(b) by inserting after the word "goods" in subsection (2) the words "or services"; and

(c) by inserting after subsection (2) the following:

"(3) Any decision of the Registrar under subsection (1) or (2) is subject to appeal to the Court."

Section 38. Deletion of section 50.

Section 50 of the principal Act is deleted.

Section 39. Deletion of section 53.

Section 53 of the principal Act is deleted.

Section 40. Deletion of section 54.

Section 54 of the principal Act is deleted.

Section 41. Amendment of section 55.

Section 55 of the principal Act is amended-

(a) by inserting after the word "goods" wherever it appears in subsection (1) the words "or services";

(b) by inserting after subsection (1) the following:

"(1A) Subsection (1) shall have effect in the case of an unregistered trade mark used in relation to any goods or services as it has effect in the case of a registered trade mark registered in respect of any goods or services, if at the time of the assignment or transmission of the unregistered trade mark it is or was used in the same business as a registered trade mark, and if it is or was assigned or transmitted at the same time and to the same person as that registered trade mark and in respect of goods or services all of which are goods or services in relation to which the unregistered trade mark is or was used in that business and in respect of which that registered

trade mark is or was assigned or transmitted.";

(c) by substituting for subsection (3) the following:

"(3) Notwithstanding subsections (1) and (1A), a trade mark shall be deemed not to be assignable or transmissible if, as a result of the assignment or transmission, whether under common law or by registration, more than one of the persons concerned would have exclusive rights to the use of an identical trade mark or to the use of trade marks so nearly resembling each other as are likely to deceive or cause confusion.";

(d) by substituting for subsection (5) the following:

"(5) Where an assignment in respect of any goods or services of a trade mark which is at the time of the assignment used in a business in those goods or services is made otherwise than in connection with the goodwill of that business, the assignment shall not be deemed to have taken effect unless the assignment has been advertised in the prescribed manner and the application for the assignment without goodwill, accompanied by the advertisement, has been sent to the Registrar."; and

(c) by deleting subsection (6).

Section 42. Amendment of section 56.

Section 56 of the principal Act is amended-

(a) by inserting after the word "goods" wherever it appears in subsections (1) and (2) the words "or services";

(b) in subsection (3)-

(i) by inserting after the word "goods" wherever it appears, except in paragraph (b), the words "or services";

(ii) by deleting the word "or" appearing at the end of paragraph (a);

(iii) by substituting for the full stop at the end of paragraph (b) the word "; or"; and

(iv) by inserting after paragraph (b) the following:

"(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 proprietor or as a registered user to use the trade mark or to services with the provision of which such person is connected in the course of trade.";

(c) in subsection (4) by inserting after the word "market," the words "in relation to services to be provided in a place";

(d) in subsection (5)-

(i) by inserting after the words "obliterated it" a semicolon and deleting the words "or the registered proprietor has at any time expressly or impliedly consented to the use of the trade mark; or" in paragraph (a);

(ii) by inserting after paragraph (a) the following:

"(aa) where the registered proprietor has at any time expressly or impliedly consented to the use of the trade mark; or;" and

(iii) by inserting after the word "goods" wherever it appears in paragraph (b) the words "or services";

(e) by substituting for the number "(3)" in subsection (8) the number "(2)";

(f) by inserting after the word "goods" wherever it appears in subsection (10) the words "or services";

(g) by inserting after the word "goods" in paragraph (11)(a) the words "or services";

(h) by inserting after the word "goods" wherever it appears in paragraph services"; and (15)(a) the words "or

(i) by inserting after the word "goods" in subsection (17) the words "or services".

Section 43. Amendment of section 57.

Section 57 of the principal Act is amended by inserting after the word "goods" wherever it appears the words "or services".

Section 44. Amendment of section 58.

Section 58 of the principal Act is amended by inserting after the word "goods" the words "or services".

Section 45. Amendment of section 64.

Section 64 of the principal Act is amended by substituting for subsection (3) the following:

"(3) In any action or proceedings relating to trade mark or trade name, the Registrar or the Court, as the case may be, shall admit evidence of the usages of the trade concerned or evidence of business usages in the provision of the services in question, and evidence of any relevant trade marks or trade name or business name or get-up legitimately used by other persons."

Section 46. Amendment of section 65.

Section 65 of the English text of the principal Act is amended by substituting for the words "from the Registrar" in subsection (1) the words "from the Register".

Section 47. Amendment of section 66.

Section 66 of the principal Act is amended-

(a) by substituting for the words "Yang di-Pertuan Agong" in the marginal note and in subsection (1) the word "Minister"; and

(b) by inserting after the word "goods" wherever it appears in the definition of "trade marks" in subsection (2) the words "or services".

Section 48. Deletion of section 68.

The principal Act is amended by deleting section 68.

Section 49. Amendment of heading of Part XIV.

The principal Act is amended by substituting for, the heading of Part XIV the following:

"CONVENTIONS AND INTERNATIONAL ARRANGEMENTS".

Section 50. Substitution of section 70.

The principal Act is amended by substituting for section 70 the following:

"70. Right of priority under Convention, etc.

(1) Where any person has applied for protection of any trade mark in a Convention country or prescribed foreign country, such person or his legal representative or assignee, after furnishing a declaration within the prescribed time indicating the date of the application and the country in which it was made, shall in respect of the application for registration of his trade mark, be entitled to a right of priority and such application in Malaysia shall have the same date as the date of the application for protection in the Convention country or prescribed foreign country concerned, as the case may be, subject to the following:

(a) that the application for registration is made within six months from the date of application for protection in the Convention country or prescribed foreign country concerned, as the case may be; and where an application for protection is made in more than one Convention country or prescribed foreign country, the period of six months referred to herein shall be reckoned from the date on which the earlier or earliest of those applications is made;

(b) that the applicant shall be either a national or resident of, or a body corporate-incorporated under the laws of, the Convention country or prescribed foreign country concerned, as the case may be; and

(c) that nothing in this section shall entitle the proprietor of a trade mark to recover damages for infringements or any happening prior to the date on which the application for protection of the trade mark is made in Malaysia.

(2) Notwithstanding any other provision of this Act, the registration of a trade mark in respect of which a right of priority exists shall not be refused or revoked by reason only of the use of the trade mark by some other person in Malaysia during the said period of six months.

(3) The application for the registration of a trade mark in respect of which a right of priority exists-

(a) shall be made and dealt with in the same manner as an ordinary application for registration under this Act; and

(b) shall specify the Convention country or prescribed foreign country, as the case may be, in which the application for protection, or the first such application, was made and the date on which such application for protection was made.

(4) As regards prescribed foreign countries, this section shall apply only for the duration of the period the order continues in force in respect of that country.

(5) For the purposes of this Act, the Minister may, by order published in the Gazette, declare a country as having made arrangements with Malaysia for the reciprocal protection of trade marks."

Section 51. New section 70A.

The principal Act is amended by inserting after section 70 the following:

"70A. Temporary protection of trade marks in respect of goods or services which are the subject matters of international exhibition.

(1) Notwithstanding anything in this Act, temporary protection shall be granted to a trade mark in respect of goods or services which are the subject matters of an exhibition at an official or officially recognised international exhibition held in Malaysia or in any Convention country or prescribed foreign country.

(2) The temporary protection granted under subsection (1) shall not extend any period of priority claimed by an applicant and where a right of priority is claimed by an applicant subsequent to the temporary protection, the period of priority shall remain six months but the period shall commence from the date of the introduction of the goods or services into the exhibition.

(3) An applicant for registration of a trade mark whose goods or services are the subject matters of an exhibition at an official or officially recognised international exhibition in Malaysia or in any Convention country or prescribed foreign country and who applies for registration of that mark in Malaysia within six months from the date on which the goods or services first became the subject matters of the exhibition shall, on his request, be deemed to have applied for registration on the date on which the goods or services first became the subject matters of the exhibition.

(4) Evidence that the goods or services bearing the trade mark are the subject matters of an exhibition at an official or officially recognised international exhibition shall be by a certificate issued by the competent authorities of the exhibition."

Section 52. Amendment of section 72.

Section 72 of the principal Act is amended by inserting after the word "goods" wherever it appears the words "or services".

Section 53. Amendment of section 75.

Paragraph 75(1)(d) of the principal Act is amended by substituting for the word "amend" the word "award"

Section 54. Amendment of section 77.

The principal Act is amended by substituting for section 77 the following:

77. (1) Where by this Act or any regulations made thereunder, a time is specified within which an act or thing is to be done, the Registrar may, unless otherwise expressly provided or directed by the Court, upon application in the prescribed manner, extend the time either before or after its expiration upon payment of the prescribed fee.

(2) Subsection (1) shall not apply to section 29, subsection (3) of section 31, section 70 and section 70A except where the circumstances mentioned in section 78 apply."

Section 55. Amendment of section 78.

Section 78 of the principal Act is amended by deleting the word "regional".

Section 56. Amendment of section 79.

Section 79 of the principal Act is amended by substituting for subsection (1) the following:

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

Section 57. Substitution of section 80.

The principal Act is amended by substituting for section 80 the following:

80. Agent.

(1) Where an applicant for registration of a trade mark does not reside or carry on business in Malaysia, he shall appoint an agent to act for him.

(2) Where by this Act any act has to be done by or to any person in connection with a trade mark or proposed trade mark or any procedure relating thereto, the act may, under and in accordance with this Act and any regulations made thereunder or in particular cases by special leave of the Registrar, be done by or to an agent of that person duly authorised in the prescribed manner.

(3) No person, firm or company shall be authorised to act as an agent for the purposes of this Act unless that person is domiciled or resident in Malaysia or the firm or company is constituted under the laws of Malaysia and such person, firm or company carries on business or practice principally in Malaysia."

Section 58. Amendment of section 81.

Section 81 of the principal Act is amended by inserting after the word "goods" in paragraph (l)(c) the words "or services".

Section 59. Amendment of section 82.

Section 82 of the principal Act is amended by inserting after the word "goods" in subsection (2) the words "or services".

Section 60. Amendment of section 83.

Section 83 of the principal Act is amended-

(a) by inserting after the word "goods" in paragraph (2)(b) the words "and services";

(b) by substituting for paragraph (2)(e) the following:

"(e) to prescribe the fees to be paid in respect of any matter or thing required for the purposes of this Act;";

(c) by inserting after paragraph (2)(e) the following:

"(ea) to provide for the registration and qualifications of agents;"; and

(d) by deleting subsection (3).

Section 61. Saving provisions.

(1) The amendments to section 11, section 14, subsections 19(1) and 19(3), subsection 20(1), subsection 22(1), subsection 26(1), section 27, section 28, section 42, subsections 46(1), 46(2), 46(3) and 46(5), section 48, paragraphs 49(1)(c) and 49(1)(d), section 50, section 53, section 54, subsections 55(5) and 55(6), section 68, section 70, subsection 77(1) and subsection 79(1) of the principal Act shall not affect any application for registration of a trade mark or for registration as a registered user or the registration of a trade mark or a registered user, as the case may be, made under the principal Act before the commencement of this Act and those provisions shall apply to that application or registration, as the case may be, as if they had not been so amended.

(2) Paragraph 24(c), section 25, section 31, paragraph 37(c) and section 51 of this Act shall apply only to an application for registration of a trade mark or for renewal of a trade mark or for registration as a registered user or to any trade mark registered, as the case may be, on or after the commencement of this Act.