

LAWS OF BRUNEI

CHAPTER 98

TRADE MARKS

S 58/99

REVISED EDITION 2000

(30th December 2000)

REVISED EDITION 2000

CHAPTER 98

TRADE MARKS

Section

ARRANGEMENT OF SECTIONS

1. Citation, commencement and application.

PRELIMINARY

2. Interpretation.

3. Registrar of Trade Marks and other officers, delegation by Registrar, and seal of Registry.

PART I

REGISTERED TRADE MARKS

Introductory

4. Trade marks.

5. Registered trade marks.

## **Grounds for refusal of registration**

6. Absolute grounds for refusal of registration.
7. Specially protected emblems etc.
8. Relative grounds for refusal of registration.
9. Meaning of “earlier trade mark” .
10. Raising of relative grounds in case of honest concurrent use.
11. Power to require that relative grounds be raised in opposition proceedings.

## **Effects of registered trade mark**

12. Rights conferred by registered trade mark.
13. Infringement of registered trade mark.
14. Limits on effect of registered trade mark.
15. Registration subject to disclaimer or limitation.

## **Infringement proceedings**

16. Action for infringement.
17. Order for erasure etc. of offending sign.
18. Order for delivery up of infringing goods etc.
19. Meaning of “infringing goods, material or articles” .
20. Period after which remedy of delivery up not available.
21. Order as to disposal of infringing goods etc.
22. Remedy for groundless threats of infringement proceedings.

## **Registered trade mark as object of property**

23. Nature of registered trade mark.

24. Co-ownership of registered trade mark.
25. Assignment etc. of registered trade mark.
26. Registration of transactions affecting registered trade mark.
27. Trusts and equities.
28. Applications for registration of trade mark as object of property.

### **Licensing**

29. Licensing of registered trade mark.
30. Exclusive licences.
31. Rights of licensee in case of infringement.
32. Rights of exclusive licensee.

### **Application for registered trade mark**

33. Application for registration.
34. Date of filing.
35. Classification of trade marks.

### **Priority**

36. Claims to priority.
37. Temporary protection.

### **Registration procedure**

38. Examination of application.
39. Publication and opposition proceedings.
40. Withdrawal, restriction or amendment of application.
41. Registration.

42. Registration: supplementary provisions.

### **Duration, renewal and alteration of registered trade mark**

43. Duration of registration.

44. Renewal of registration.

45. Alteration of registered trade mark.

### **Surrender, revocation and invalidity**

46. Surrender of registered trade mark.

47. Revocation of registration.

48. Grounds for invalidity of registration.

49. Effect of acquiescence.

### **Collective marks**

50. Collective marks.

51. Application of Act to collective marks.

### **Certification marks**

52. Certification marks.

53. Application of Act to certification marks.

## **PART II**

### **Protection of Well-Known Trade Marks**

54. Protection of well-known trade marks.

### **Emblems etc.**

55. National emblems etc. of Paris Convention and World Trade Organisation countries.

56. Emblems etc. of certain international organisations.

57. Notification under Article 6 ter of Paris Convention.

### Acts of agents or representatives

58. Acts of agents or representatives.

59. Time limit for application under section 58(3).

## PART III

### ADMINISTRATIVE AND OTHER SUPPLEMENTARY PROVISIONS

#### The register

60. The register.

61. Rectification of register.

#### Powers and duties of Registrar

62. Power to require use of forms.

63. Information about applications and registered trade marks.

64. Costs and security for costs.

65. Evidence before Registrar.

66. Exclusion of liability in respect of official acts.

#### Legal proceedings and appeals

67. Registration *prima facie* evidence of validity.

68. Certificate of validity of contested registration.

69. Registrar' s appearance in proceedings involving register.

70. Appeals from Registrar.

71. Rules of court.

#### Fees, business hours etc.

72. Fees.

73. Business hours and business days.

74. Publication in *Gazette* .

#### Trade mark agents

75. Recognition of agents.

76. Register of trade mark agents.

77. Unregistered persons not to be described as registered trade mark agents.

78. Power to prescribe conditions etc. for mixed partnerships and bodies corporate.

79. Use of term “trade mark attorney” .

80. Privilege for communications with registered trade mark agents.

81. Power of Registrar to refuse to deal with certain agents.

#### PART IV

#### PROCEEDINGS RELATING TO IMPORTATION OF INFRINGING GOODS

82. Infringing goods may be detained.

83. Determination whether goods are infringing goods.

84. Limitations on requirement to supply information.

85. Notice of determination.

86. Detention of infringing goods.

87. Proceedings in respect of infringing goods.

88. Forfeiture of goods by consent.

89. Powers of court.

90. Inspection of goods.

91. Power of Controller of Customs to disclose information.
92. Delegation of powers and duties.
93. Protection of Government and officers of customs from liability.

### **Offences**

94. Unauthorised use of trade mark etc. in relation to goods.
95. Application of Chapter 96 in enforcement.
96. Falsification of registers etc.
97. Falsely representing trade mark as registered.
98. Counterfeiting trade mark used by another.
99. Making or possession of instrument for counterfeiting trademark.
100. Importing or selling etc. goods marked with counterfeit trademark.
101. Falsely applying registered trade mark to services.
102. Unauthorised use of Royal arms etc.
103. Offences committed by partnership and bodies corporate.

### **Forfeiture of counterfeit goods etc.**

104. Forfeiture.

## **PART V**

### **MISCELLANEOUS AND GENERAL PROVISIONS**

105. Burden of proving use of trade mark.
106. Regulations and rules.
107. Amendment of Third Schedule.
108. Transitional.



FIRST SCHEDULE — COLLECTIVE MARKS

SECOND SCHEDULE — CERTIFICATION MARKS

THIRD SCHEDULE — TRANSITIONAL PROVISIONS

-----

TRADE MARKS ACT

An Act to make new provision for registered trade marks; and for  
connected purposes

*Commencement (except sections 75 to 81): 1st June 2000*

*[S 18/2000]*

Citation, commencement and applications.

1. (1) This Act may be cited as the Trade Marks Act, and shall commence on the day or days to be appointed by the Attorney General, with the approval of His Majesty the Sultan and Yang Di-Pertuan, by notification in the *Gazette* .

(2) Different days may be appointed under subsection (1) for the different provisions of this Act or for different purposes of the same provision.

(3) This Act applies to things done in or on the continental shelf

(being the area proclaimed by His Highness the Sultan on 30th June, 1954 by the Continental Shelf Proclamation 1954) on a structure or vessel which is present there for purposes directly connected with the exploration of the seabed and its subsoil or with the exploitation of their natural resources, as it applies to things done in Brunei Darussalam.

PRELIMINARY

Interpretation.

2. (1) In this Act, unless the context otherwise requires—

“assignment” means assignment by act of the parties concerned;

“business” includes any trade or profession;

“certification mark” shall be construed in accordance with section 52;



“claimant” , in sections 82, 83, 85 and 89, means a person who has given a notice under subsection (1) of section 82;

“collective mark” shall be construed in accordance with section 50;

“Controller of Customs” means the Controller of Customs for the purposes of the Customs Act (Chapter 36);

“court” means the High Court or an Intermediate Court;

“customs control” has the same meaning as in subsection (2) of section 2 of the Customs Act (Chapter 36);

“earlier right” , in relation to a trade mark, means the right of the proprietor under paragraph (b) of subsection (4) of section 8 to prevent the use of that mark;

“earlier trade mark” has the same meaning as in subsection (1) of section 9;

“exclusive licence” has the same meaning as in subsection (1) of section 30;

“infringement” of a registered trade mark means any act specified in section 13, if done without the consent of the proprietor;

“infringement proceedings” , in relation to a registered trade mark, includes proceedings under section 18;

“infringing articles” shall be construed in accordance with subsection (3) of section 19;

“infringing goods” shall be construed in accordance with subsection (1) of section 19;

“infringing material” shall be construed in accordance with subsection (2) of section 19;

“officer of customs” has the same meaning as in subsection (1) of section 2 of the Customs Act (Chapter 36);

“Paris Convention” means the Paris Convention for the Protection of Industrial Property of 20th. March, 1883, as revised or amended;

“Paris Convention country” means a country, other than Brunei Darussalam,

which is a party to the Paris Convention;

“publish” means make available to the public, and references to publication

(a) in relation to an application for registration, are to publication under subsection (1) of section 39; and

(b) in relation to registration, are to publication under subsection (4) of section 41;

“register” means the Register of Trade Marks maintained by the Registrar under subsection (1) of section 60;

“registered trade mark agent” means a person whose name is entered in the register kept under rules made under section 76;

“Registrar” means the Registrar of Trade Marks appointed under section 3;

“registration” means, unless the context otherwise requires, registration in the register;

“repealed Act” means the Trade Marks Act (Chapter 98) repealed by this Act;

“trade” includes any business or profession;

“transfer” means transfer by operation of law, devolution on the personal representative of a deceased person, or any other mode of transfer other than an assignment;

“use” (or any particular description of use) of a trade mark, or of a sign identical with, similar to, or likely to be mistaken for a trade mark, includes use (or that description of use) otherwise than by means of a graphic representation;

“World Trade Organisation Agreement” means the Agreement Establishing the World Trade Organisation done at Marrakesh in 1994, as revised or amended;

“World Trade Organisation country” means any country, territory or area, other than Brunei Darussalam, which is a party to the World Trade Organisation Agreement.

(2) References in any law passed or made before the commencement of this Act to trade marks or registered trade marks within the meaning of the repealed Act shall, unless the context otherwise requires, be construed after

the commencement of this Act as references to trade marks or registered trade marks within the meaning of this Act.

(3) References subsection (2) and the Third Schedule to the commencement of this Act are to the commencement of the main substantive provisions of Parts I and III of this Act and the consequential repeal of the repealed Act.

### **Registrar of Trade Marks and other officers, delegation by Registrar, and seal of Registry.**

3. (1) There shall be a Registrar of Trade Marks who shall have the chief control of the Registry of Trade Marks.

(2) There shall be one or more Deputy Registrars of Trade Marks who shall, subject to the control of the Registrar, have all the powers and functions of the Registrar under this Act, other than the powers of the Registrar under subsection (5).

(3) There shall be one or more Assistant Registrars of Trade Marks.

(4) The Registrar and Deputy Registrars of Trade Marks under this section shall be appointed by His Majesty the Sultan and Yang Di-Pertuan.

(5) The Registrar may, in relation to a particular matter or class of matters, by writing under his hand delegate all or any of his powers or functions under this Act (except this power of delegation) to an Assistant Registrar of Trade Marks or any public officer so that the delegated powers and functions may be exercised by the delegate with respect of the matter or class of matters specified in the instrument of delegation.

(6) A delegation under this section is revocable at will and no delegation shall prevent the exercise of any power or function by the Registrar or by any Deputy Registrar of Trade Marks.

(7) There shall be a seal of the Registry of Trade Marks and the seal shall be of such device as may be approved by the Attorney General.

(8) Impressions of the seal shall be judicially noticed and admitted in evidence.

## **PART I**

### **REGISTERED TRADE MARKS**

## Introductory

### Trade marks.

4. (1) In this Act, “trade mark” means any visually perceptible sign capable of being represented graphically which is capable of distinguishing goods or services of one undertaking from those of other undertakings. A trade mark may, in particular, consist of words (including personal names), designs, letters, numerals or the shape of goods or their packaging.

(2) References in this Act to a trade mark include, unless the context otherwise requires, references to a collective mark and a certification mark.

### Registered trade marks.

5. (1) A registered trade mark is a property right obtained by the registration of the trade mark under this Act and the proprietor of a registered trade mark has the rights and remedies provided by this Act.

(2) No proceedings lie to prevent or recover damages for the infringement of an unregistered trade mark as such; but nothing in this Act affects any law relating to passing off.

### Grounds for refusal of registration

#### Absolute grounds for refusal of registration.

6. (1) The following shall not be registered —

(a) signs which do not satisfy the requirements of subsection (1) of section 4;

(b) trade marks which are devoid of any distinctive character;

(c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, time of production of goods or of rendering of services, or other characteristics of goods or services;

(d) trade marks which consist exclusively of signs or indications which have become customary in the current language or in the *bona fide* and established practices of the trade:

Provided that a trade mark shall not be refused registration by virtue

of paragraph (b) , (c) or (d) if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.

(2) A sign shall not be registered as a trade mark if it consists exclusively of —

(a) the shape which results from the nature of the goods themselves;

(b) the shape of goods which is necessary to obtain a technical result; or

(c) the shape which gives substantial value to the goods.

(3) A trade mark shall not be registered if it is —

(a) contrary to public policy or to accepted principles of morality; or

(b) of such a nature as to deceive the public.

(4) A trade mark shall not be registered if or to the extent that its use is prohibited in Brunei Darussalam by any law.

(5) A trade mark shall not be registered in the cases specified or referred to in section 7.

(6) A trade mark shall not be registered if or to the extent that the application is made in bad faith.

### **Specially protected emblems etc.**

7. (1) A trade mark which consists of or contains —

(a) a representation of the Emblem, Arms and Regalia of Brunei Darussalam, including the Royal Arms, State Crest, the Insignia of Royalty, armorial bearings and other insignia and emblems of Brunei Darussalam; or any device so closely resembling any of them as to be likely to be mistaken for them;

(b) a representation of the Royal crowns, and His Majesty the Sultan and Yang Di-Pertuan's Standard or any other Royal flag, or any colourable imitation thereof;

(c) a representation of His Majesty the Sultan and Yang Di-Pertuan or any member of the Royal family, or any colourable imitation thereof;



(d) any word, letter or device likely to lead persons to believe that the applicant either has or recently has had Royal patronage or authorisation; or

(e) any name or thing which is a specified name or specified emblem as defined in section 2 of the Emblems and Names (Prevention of Improper Use) Act (Chapter 94), or any colourable imitation thereof,

shall not be registered, unless it appears to the Registrar that consent has been given by or on behalf of His Majesty the Sultan and Yang Di-Pertuan or, as the case may be, that member of the Royal family.

(2) A trade mark which consists of or contains a representation of the national flag of Brunei Darussalam shall not be registered if it appears to the Registrar that the use of that trade mark would be misleading or grossly offensive.

(3) A trade mark shall not be registered in the cases specified in section 55 or 56.

(4) Provision may be made by rules prohibiting in such cases as may be prescribed the registration of a trade mark which consists of or contains —

(a) arms which a person is authorised to use by virtue of a grant of arms by His Majesty the Sultan and Yang Di-Pertuan; or

(b) insignia so closely resembling such arms as to be likely to be mistaken for them,

unless it appears to the Registrar that consent has been given by or on behalf of that person. Where such a mark is registered, nothing in this Act shall be construed as authorising its use in any way contrary to any law relating to arms.

### **Relative grounds for refusal of registration.**

8. (1) A trade mark shall not be registered if it is identical with an earlier trade mark, and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected.

(2) A trade mark shall not be registered if because —

(a) it is identical with an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected; or

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trademark is protected,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.

(3) A trade mark which —

(a) is identical with or similar to an earlier trade mark; and

(b) is to be registered for goods or services which are not similar to those for which the earlier trade mark is protected,

shall not be registered if, or to the extent that, the earlier trade mark has a reputation in Brunei Darussalam and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.

(4) A trade mark shall not be registered if, or to the extent that, its use in Brunei Darussalam is liable to be prevented —

(a) by virtue of any law protecting an unregistered trade mark or other sign used in the course of trade; or

(b) by virtue of an earlier right, other than those referred to in subsections (1), (2) and (3) or in paragraph (a), or by any law relating to the infringement of copyright or registered designs.

(5) Nothing in this section prevents the registration of a trade mark where the proprietor of the earlier trade mark or other earlier right consents to the registration.

### Meaning of “earlier trade mark” .

9. (1) In this Act, “earlier trade mark” means—

(a) a registered trade mark which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks; or

(b) a trade mark which, at the date of application for registration of the trade mark in question or (where appropriate) of the priority claimed



in respect of the application, was entitled to protection under the Paris Convention as a well-known trade mark.

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of paragraph

(a) of subsection (1), subject to its being so registered.

(3) A trade mark within paragraph (a) of subsection (1) whose registration expires shall continue to be taken into account in determining the registrability of a later mark for a period of one year after the expiry, unless the Registrar is satisfied that there was no *bona fide* use of the mark during the 2 years immediately preceding the expiry.

### **Raising of relative grounds in case of honest concurrent use.**

10. (1) This section applies where, on an application for the registration of a trade mark, it appears to the Registrar —

(a) that there is an earlier trade mark in relation to which the conditions set out in subsection (1), (2) or (3) of section 8 apply; or

(b) that there is an earlier right in relation to which the condition set out in subsection (4) of section 8 is satisfied,

but the applicant shows to the satisfaction of the Registrar that there has been honest concurrent use of the trade mark for which registration is sought.

(2) In that case, the Registrar shall not refuse the application by reason of the earlier trade mark or other earlier right unless objection on that ground is raised in opposition proceedings by the proprietor of that earlier trade mark or other earlier right.

(3) For the purpose of this section, “honest concurrent use” means such use in Brunei Darussalam, by the applicant or with his consent, as would formerly have amounted to honest concurrent use for the purpose of section 33 of the repealed Act.

(4) Nothing in this section affects —

(a) the refusal of registration on the grounds mentioned in section 6; or

(b) the making of an application for a declaration of invalidity

undersubsection (2) of section 48.

(5) This section does not apply when there is an order in force under section 11.

### **Power to require that relative grounds be raised in opposition proceedings.**

11. (1) The Attorney General may by order provide that in any case a trade mark shall not be refused registration on a ground mentioned in section 8 unless objection on that ground is raised in opposition proceedings by the proprietor of the earlier trade mark or other earlier right.

(2) The order may make such consequential provisions as appear to the Attorney General appropriate —

(a) with respect to the carrying out by the Registrar of searches of earlier trade marks; and

(b) as to the persons by whom an application for a declaration of invalidity may be made on the grounds specified in subsection (2) of section 48.

(3) An order making such provision as is mentioned in paragraph (a) of subsection (2) may direct that so much of section 38 as requires a search to be carried out shall cease to have effect.

(4) An order making such provision as is mentioned in paragraph (b) of subsection (2) may provide that so much of subsection (3) of section 48 as provides that any person may make an application for a declaration of invalidity shall have effect subject to the provisions of the order.

(5) An order under this section may contain such transitional provisions as appear to the Attorney General to be appropriate.

## **Effects of registered trade mark**

### **Rights conferred by registered trade mark.**

12. (1) The proprietor of a registered trade mark has exclusive rights in the trade mark which are infringed by use of the trade mark in Brunei Darussalam without his consent. The acts amounting to infringement, if done without the consent of the proprietor, are specified in section 13.

(2) The rights of the proprietor have effect from the date of filing of the application for registration:

Provided that —

- (a) no infringement proceedings may be begun before the date on which the trade mark is in fact registered; and
- (b) no offence under section 94 is committed by anything done before the date of publication of the registration.

### **Infringement of registered trade mark.**

13. (1) A person infringes a registered trade mark if he uses in the course of trade a sign which is identical with the trade mark in relation to goods or services which are identical with those for which it is registered.

(2) A person infringes a registered trade mark if he uses in the course of trade a sign where because —

(a) the sign is identical with the trade mark and is used in relation to goods or services similar to those for which the trade mark is registered; or

(b) the sign is similar to the trade mark and is used in relation to goods or services identical with or similar to those for which the trade mark is registered,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the trade mark.

(3) A person infringes a registered trade mark if he uses in the course of trade a sign which —

(a) is identical with or similar to the trade mark; and

(b) is used in relation to goods or services which are not similar to those for which the trade mark is registered,

where the trade mark has a reputation in Brunei Darussalam and the use of the sign without due cause takes unfair advantage of, or is detrimental to, the distinctive character or repute of the trade mark.

(4) For the purpose of this section, a person uses a sign if he —

(a) affixes it to goods or the packaging thereof;

(b) offers or exposes goods for sale, puts them on the market or stocks them

for those purposes under the sign, or offers or supplies services under the sign;

- (c) imports or exports goods under the sign; or
- (d) uses the sign on business papers or in advertising.

(5) A person who applies a registered trade mark to material intended to be used for labelling or packaging goods, as a business paper, or for advertising goods or services, shall be treated as a party to any use of the material which infringes the registered trade mark if when he applied the mark he knew or had reason to believe that the application of the mark was not duly authorised by the proprietor or a licensee.

(6) Nothing in this section shall be construed as preventing the use of a registered trade mark by any person for the purpose of identifying goods or services as those of the proprietor or a licensee:

Provided that any such use otherwise than in accordance with honest practices in industrial or commercial matters shall be treated as infringing the registered trade mark if the use without due cause takes unfair advantage of, or is detrimental to, the distinctive character or repute of the trade mark.

#### **Limits on effect of registered trade mark.**

14. (1) Subject to subsection (6) of section 48, a registered trademark is not infringed by the use of another registered trade mark in relation to goods or services for which the latter is registered.

(2) A registered trade mark is not infringed by —

- (a) the use by a person of his own name or address;
- (b) the use of indications concerning the kind, quality, quantity, intended purpose, value, geographical origin, time of production of goods or of rendering of services, or other characteristics of goods or services; or
- (c) the use of the trade mark where it is necessary to indicate the intended purpose of a product or service:

Provided the use is in accordance with honest practices in industrial or commercial matters.

(3) A registered trade mark is not infringed by the use in the course of trade

in a particular locality of an earlier right which applies only in that locality. For the purpose of this subsection, "earlier right" means an unregistered trade mark or other sign continuously used in relation to goods or services by a person or a predecessor in title of his from a date prior to whichever is the earlier of —

(a) the use of the first-mentioned trade mark in relation to those goods or services by the proprietor or a predecessor in title of his; or

(b) the registration of the first-mentioned trade mark in respect of those goods or services in the name of the proprietor or a predecessor in title of his,

and an earlier right shall be regarded as applying in a locality if, or to the extent that, its use in that locality is protected by any law.

### **Registration subject to disclaimer or limitation.**

15. (1) An applicant for registration of a trade mark, or the proprietor of a registered trade mark, may —

(a) disclaim any right to the exclusive use of any specified element of the trade mark; or

(b) agree that the rights conferred by the registration shall be subject to a specified territorial or other limitation,

and where the registration of a trade mark is subject to such a disclaimer or limitation, the rights conferred by section 12 are restricted accordingly.

(2) Provision shall be made by rules as to the publication and entry in the register of such a disclaimer or limitation.

### **Infringement proceedings**

#### **Action for infringement.**

16. (1) An infringement of a registered trade mark is actionable by the proprietor of the trade mark.

(2) In an action for infringement, all such relief by way of damages, injunction, account or otherwise is available to him as is available in respect of the infringement of any other property right.



## Order for erasure etc. of offending sign.

17. (1) Where a person is found to have infringed a registered trademark, the court may make an order requiring him —

(a) to cause the offending sign to be erased, removed or obliterated from any infringing goods, material or articles in his possession, custody or control; or

(b) if it is not reasonably practicable for the offending sign to be erased, removed or obliterated, to secure the destruction of such infringing goods, material or articles.

(2) If an order under subsection (1) is not complied with, or it appears to the court likely that such an order would not be complied with, the court may order that the infringing goods, material or articles be delivered to such person as the court may direct for erasure, removal or obliteration of the sign, or for destruction, as the case may be.

## Order for delivery up of infringing goods etc.

18. (1) The proprietor of a registered trade mark may apply to the court for an order for the delivery up to him, or such other person as the court may direct, of any infringing goods, material or articles which a person has in his possession, custody or control in the course of business.

(2) An application shall not be made after the end of the period specified in section 20; and no order shall be made unless the court also makes, or it appears to the court that there are grounds for making, an order under section 21.

(3) A person to whom any infringing goods, material or articles are delivered up in pursuance of an order under this section shall, if an order under section 21 is not made, retain them pending the making of an order, or the decision not to make an order, under that section.

(4) Nothing in this section affects any other power of the court.

## Meaning of “infringing goods, material or articles” .

19. (1) Goods are “infringing goods” , in relation to a registered trade mark, if they or their packaging bear a sign identical or similar to that mark and —

(a) the application of the sign to the goods or their packaging was an infringement of the registered trade mark;

(b) the goods are proposed to be imported and the application of the sign in Brunei Darussalam to them or their packaging would be an infringement of the registered trade mark; or

(c) the sign has otherwise been used in relation to the goods in such a way as to infringe the registered trade mark.

(2) Material is “infringing materials”, in relation to a registered trade mark, if it bears a sign identical with or similar to that mark and either —

(a) it is used for labelling or packaging goods, as a business paper or for advertising goods or services, in such a way as to infringe the registered trade mark; or

(b) it is intended to be so used and such use would infringe the registered trade mark.

(3) “Infringing articles”, in relation to a registered trademark, means articles —

(a) which are specifically designed or adapted for making copies of a sign identical or similar to that mark; and

(b) which a person has in his possession, custody or control, knowing or having reason to believe that they have been or are to be used to produce infringing goods or infringing material.

**Period after which remedy of delivery up not available.**

20. (1) An application for an order under section 18 may not be made after the end of the period of 6 years from —

(a) in the case of infringing goods, the date on which the trade mark was applied to the goods or their packaging;

(b) in the case of infringing material, the date on which the trademark was applied to the material; or

(c) in the case of infringing articles, the date on which they were made, except as mentioned in subsection (2).

(2) If, during the whole or part of that period, the proprietor of



the registered trade mark —

(a) is under a disability; or

(b) is prevented by fraud or concealment from discovering the facts entitling him to apply for an order,

an application may be made at any time before the end of the period of 6 years from the date on which he ceased to be under a disability or, as the case may be, could with reasonable diligence have discovered those facts.

(3) In subsection (2), “disability” has the same meaning as in subsection (2) of section 4 of the Limitation Act (Chapter 14).

### **Order as to disposal of infringing goods etc.**

21. (1) Where infringing goods, infringing material or infringing articles have been delivered up in pursuance of an order under section 18, an application may be made to the court —

(a) for an order that they be destroyed or forfeited to such person as the court may think fit; or

(b) for a decision that no such order should be made.

(2) In considering what order (if any) should be made, the court shall consider whether other remedies available in an action for infringement of the registered trade mark would be adequate to compensate the proprietor and any licensee and protect their interests.

(3) Provision may be made by rules of court as to the service of notice on persons having an interest in the goods, material or articles, and any such person is entitled —

(a) to appear in proceedings for an order under this section, whether or not he was served with notice; and

(b) to appeal against any order made, whether or not he appeared,

and an order shall not take effect until the end of the period within which notice of an appeal may be given or, if before the end of that period notice of appeal has been given, until the final determination or abandonment of the proceedings on the appeal.

(4) Where there is more than one person interested in the goods, material or

articles, the court shall make such order as it thinks just.

(5) If the court decides that no order should be made under this section, the person in whose possession, custody or control the goods, material or articles were before being delivered up is entitled to their return.

(6) References in this section to a person having an interest in goods, material or articles include any person in whose favour an order could be made under this section or under any law which makes similar provision in relation to the infringement of copyright, rights in performances or registered designs.

### **Remedy for groundless threats of infringement proceedings.**

22. (1) Where a person threatens another with proceedings for infringement of a registered trade mark other than —

(a) the application of the mark to goods or their packaging;

(b) the importation of goods to which, or to the packaging of which, the mark has been applied; or

(c) the supply of services under the mark,

any person aggrieved may bring proceedings for relief under this section.

(2) The relief which may be applied for is any of the following —

(a) a declaration that the threats are unjustifiable;

(b) an injunction against the continuance of the threats;

(c) damages in respect of any loss the person aggrieved has sustained by the threats,

and he is entitled to such relief unless the defendant shows that the acts in respect of which proceedings were threatened constitute (or if done would constitute) an infringement of the registered trade mark.

(3) If that is shown by the defendant, the person aggrieved is nevertheless entitled to relief if he shows that the registration of the trademark is invalid or liable to be revoked in a relevant respect.

(4) The mere notification that a trade mark is registered, or that

an application for registration has been made, does not constitute a threat of proceedings for the purpose of this section.

## **Registered trade mark as object of property**

### **Nature of registered trade mark.**

23. A registered trade mark is property within the meaning of paragraph (a) of the definition of “property” in subsection (1) of section 3 of the Interpretation and General Clauses Act (Chapter 4).

### **Co-ownership of registered trade mark.**

24. (1) Where a registered trade mark is granted to 2 or more persons jointly, each of them is entitled, subject to any agreement to the contrary, to an equal undivided share in the registered trade mark.

(2) The following provisions apply where 2 or more persons are co-proprietors of a registered trade mark, whether by virtue of subsection (1) or otherwise.

(3) Subject to any agreement to the contrary, each co-proprietor is entitled, by himself or his agents, to do for his own benefit and without the consent of or the need to account to the other or others, any act which would otherwise amount to an infringement of the registered trade mark.

(4) One co-proprietor may not without the consent of the other or others—

(a) grant a licence to use the registered trade mark; or

(b) assign or charge his share in the registered trade mark.

(5) Infringement proceedings may be brought by any co-proprietor, but he may not, without the leave of the court, proceed with the action unless the other, or each of the others, is either joined as a plaintiff or added as a defendant. A co-proprietor who is added as a defendant shall not be made liable for any costs in the action unless he has taken part in the proceedings. Nothing in this subsection affects the granting of interlocutory relief on the application of a single co-proprietor.

(6) Nothing in this section affects the mutual rights and obligations of trustees or personal representatives, or their rights and obligations as such.

### **Assignment etc. of registered trade mark.**

25. (1) A registered trade mark is, subject to this Act, transmissible by assignment or transfer in the same way as other property. It is so transmissible either in connection with the goodwill of a business or independently.

(2) An assignment or transfer of a registered trade mark may be limited so as to apply —

(a) in relation to some but not all of the goods or services for which the trade mark is registered; or

(b) in relation to use of the trade mark in a particular manner or a particular locality.

(3) An assignment of a registered trade mark is not effective unless it is in writing and signed by or on behalf of the assignor.

(4) Subsections (1), (2) and (3) apply to an assignment by way of security as in relation to any other assignment.

(5) A registered trade mark may be the subject of a charge in the same way as other property.

(6) Nothing in this Act shall be construed as affecting the assignment or transfer of an unregistered trade mark as part of the goodwill of a business.

#### **Registration of transactions affecting registered trade mark.**

26. (1) On application being made to the Registrar by —

(a) a person claiming to be entitled to an interest in or under a registered trade mark by virtue of a registrable transaction; or

(b) any other person claiming to be affected by such a transaction,  
the prescribed particulars of the transaction shall be entered in the register.

(2) The following are registrable transactions —

(a) an assignment of a registered trade mark or any right in it;

(b) the grant of a licence under a registered trade mark;

(c) the granting of any interest by way of security (whether fixed or floating)

over a registered trade mark or any right in or under it;

(d) the making by a personal representative of an assignment in relation to a registered trade mark or any right in or under it;

(e) an order of a court transferring a registered trade mark or any right in or under it.

(3) Until an application has been made for registration of the prescribed particulars of a registrable transaction —

(a) the transaction is ineffective as against a person acquiring a conflicting interest in or under the registered trade mark in ignorance of it; and

(b) a person claiming to be a licensee by virtue of the transaction does not have the protection of sections 31 and 32.

(4) Where a person becomes the proprietor or a licensee of a registered trade mark by virtue of a registrable transaction, then unless —

(a) an application for registration of the prescribed particulars of the transaction is made before the end of the period of 6 months beginning with its date; or

(b) the court is satisfied that it was not practicable for such an application to be made before the end of that period and that an application was made as soon as practicable thereafter,

he is not entitled to damages or an account of profits in respect of any infringement of the registered trade mark occurring after the date of the transaction and before the prescribed particulars of the transaction were registered.

(5) Provision may be made by rules as to —

(a) the amendment of registered particulars relating to a licence so as to reflect any alteration of the terms of the licence;

(b) the removal of such particulars from the register —

(i) where it appears from the registered particulars that the licence was granted for a fixed period and that period has expired; or

(ii) where no such period is indicated and, after such period as may be prescribed, the Registrar has notified the parties of his intention to remove



the particulars from the register;

(c) the amendment or removal from the register of particulars relating to an interest by way of security on the application of, or with the consent of, the person entitled to the benefit of that interest.

### **Trusts and equities.**

27. (1) No notice of any trust (express, implied or constructive) shall be entered in the register; and the Registrar shall not be affected by any such notice.

(2) Subject to this Act, equities in respect of a registered trade mark may be enforced in like manner as in respect of other property.

### **Applications for registration of trade mark as object of property.**

28. (1) Sections 23 to 27 apply, with the necessary modifications, in relation to an application for the registration of a trade mark as in relation to a registered trade mark.

(2) In section 24, as it applies in relation to an application for registration, the reference in subsection (1) to the granting of the registration shall be construed as a reference to the making of the application.

(3) In section 26, as it applies in relation to a transaction affecting an application for the registration of a trade mark, the references to the entry of particulars in the register, and to the making of an application to register particulars, shall be construed as references to the giving of notice to the Registrar of those particulars.

## **Licensing**

### **Licensing of registered trade mark.**

29. (1) A licence to use a registered trade mark may be general or limited. A limited licence may apply —

(a) in relation to some but not all of the goods or services for which the trade mark is registered; or

(b) in relation to use of the trade mark in a particular manner or a particular locality.

(2) A licence is not effective unless it is in writing and signed by or on behalf of the grantor. This requirement may be satisfied in a case where the grantor is a body corporate by the affixing of its seal.

(3) Unless the licence provides otherwise, it is binding on a successor in title to the grantor's interest, and references in this Act to doing anything with, or without, the consent of the proprietor of a registered trade mark shall be construed accordingly.

(4) Where the licence so provides, a sub-licence may be granted by the licensee; and references in this Act to a licence or licensee include a sub-licence or sub-licensee.

### **Exclusive licences.**

30. (1) In this Act, "exclusive licence" means a licence (whether general or limited) authorising the licensee to the exclusion of all other persons, including the person granting the licence, to use a registered trade mark in the manner authorised by the licence.

(2) An exclusive licensee has the same rights against a successor in title who is bound by the licence as he has against the person granting the licence.

### **Rights of licensee in case of infringement.**

31. (1) This section has effect with respect to the rights of a licensee in relation to infringement of a registered trade mark, but does not apply where or to the extent that, under subsection (1) of section 32, the licensee has a right to bring proceedings in his own name.

(2) A licensee is entitled, unless his licence or any licence through which his interest is derived provides otherwise, to call on the proprietor of the registered trade mark to take infringement proceedings in respect of any matter which affects his interests.

(3) If the proprietor —

(a) refuses to do so; or

(b) fails to do so within 2 months after being called upon,

the licensee may bring the proceedings in his own name as if he were the proprietor.



(4) Where infringement proceedings are brought by a licensee under this section, the licensee may not, without the leave of the court, proceed with the action unless the proprietor is either joined as a plaintiff or added as a defendant. Nothing in this subsection affects the granting of interlocutory relief on the application of a licensee alone.

(5) A proprietor who is added as a defendant under subsection (4) shall not be made liable for any costs in the action unless he has taken part in the proceedings.

(6) In infringement proceedings brought by the proprietor of a registered trade mark, any loss suffered or likely to be suffered by any licensee shall be taken into account; and the court may give such directions as it thinks fit as to the extent to which the plaintiff is to hold the proceeds of any pecuniary remedy on behalf of such licensee.

(7) This section applies in relation to an exclusive licensee if or to the extent that he has, under subsection (1) of section 32, the rights and remedies of an assignee as if he were the proprietor of the registered trade mark.

### **Rights of exclusive licensee.**

32. (1) An exclusive licence may provide that the licensee shall have, to such extent as may be provided by the licence, the same rights in respect of matters occurring after the grant of the licence as if the licence had been an assignment. Where or to the extent that any such provision is made, the licensee is entitled, subject to the provisions of the licence and to subsections (2) to (8), to bring infringement proceedings against any person other than the proprietor in his own name.

(2) Any such rights of an exclusive licensee are concurrent with those of the proprietor of the registered trade mark; and references to the proprietor of a registered trade mark in this Act relating to infringement shall be construed accordingly.

(3) In an action brought by an exclusive licensee under this section, a defendant may avail himself of any defence which would have been available to him if the action had been brought by the proprietor of the registered trade mark.

(4) Where infringement proceedings brought by the proprietor or an exclusive licensee relate wholly or partly to an infringement in respect of which they have concurrent rights of action, the proprietor or, as the case maybe, the exclusive licensee may not, without the leave of the court, proceed with the

action unless the other of them has either been joined as a plaintiff or added as a defendant. Nothing in this subsection affects the granting of interlocutory relief on the application of a proprietor or exclusive licensee alone.

(5) A person who is added as a defendant under subsection (4) shall not be made liable for any costs in the action unless he has taken part in the proceedings.

(6) Where infringement proceedings are brought which relate wholly or partly to an infringement in respect of which the proprietor and an exclusive licensee have or had concurrent rights of action —

(a) the court shall in assessing damages take into account —

(i) the terms of the licence; and

(ii) any pecuniary remedy already awarded or available to either of them in respect of the infringement;

(b) no account of profits shall be directed if an award of damages has been made, or an account of profits has been directed, in favour of the other of them in respect of the infringement; and

(c) the court shall, if an account of profits is directed, apportion the profits between them as the court considers just, subject to any agreement between them.

This subsection applies whether or not the proprietor and the exclusive licensee are both parties to the action; and if they are not both parties the court may give such directions as it thinks fit as to the extent to which the party to the proceedings is to hold the proceeds of any pecuniary remedy on behalf of the other.

(7) The proprietor of a registered trade mark shall notify any exclusive licensee who has a concurrent right of action before applying for an order under section 18; and the court may on the application of the licensee make such order under that section as it thinks fit having regard to the terms of the licence.

(8) Subsections (4) to (7) have effect subject to any agreement to the contrary between the exclusive licensee and the proprietor.

### **Application for registered trade mark**

## Application for registration.

33. (1) An application for registration of a trade mark shall be made to the Registrar.

(2) The application shall contain —

(a) a request for registration of the trade mark;

(b) the name and address of the applicant;

(c) a statement of the goods or services in relation to which it is sought to register the trade mark; and

(d) a representation of the trade mark.

(3) The application shall state that the trade mark is being used, by the applicant or with his consent, in relation to those goods or services, or that he has a *bona fide* intention that it should be so used.

(4) The application shall be subject to the payment of the application fee and such classification fees as may be appropriate.

## Date of filing.

34. (1) The date of filing of an application for registration of a trade mark is the date on which documents containing everything required by

subsection (2) of section 33 are furnished to the Registrar by the applicant. If the documents are furnished on different days, the date of filing is the last of those days.

(2) References in this Act to the date of application for registration are to the date of filing of that application.

## Classification of trade marks.

35. (1) Goods and services shall be classified for the purpose of the registration of trade marks according to a prescribed system of classification.

(2) Any question arising as to the class within which any goods or services fall shall be determined by the Registrar, whose decision shall be final.

## Priority

## Claims to priority.

36. (1) A person who has filed an application for protection of a trade mark in a Paris Convention country, or a World Trade Organisation country, or his successor in title, has a right to priority for the purpose of registering the same trade mark under this Act in respect of any or all of the same goods or services, for a period of 6 months from the date of filing of the first such application.

(2) If the application for registration under this Act is made within that 6 months period —

(a) the relevant date for the purpose of establishing which right takes precedence shall be the date of filing of the first application; and

(b) the registrability of the trade mark shall not be affected by any use of the mark in Brunei Darussalam in the period between that date and the date of the application for registration under this Act.

(3) Any filing which in a Paris Convention country or a World Trade Organisation country is equivalent to a regular national filing, under that country's domestic legislation or an international agreement, shall be treated as giving rise to the right of priority. In this subsection, "regular national filing" means any filing which is adequate to establish the date on which the application was filed in that country, whatever the result of that application.

(4) A subsequent application concerning the same subject as the first application, filed in the same country, shall be considered the first application (of which the filing date is the starting date of the period of priority), if at the time of subsequent application —

(a) the previous application has been withdrawn, abandoned or refused, without having been open to public inspection and without leaving any rights outstanding; and

(b) it had not yet served as a basis for claiming a right of priority.

Such previous application may not thereafter serve as a basis for claiming a right of priority.

(5) Provision may be made by rules as to the manner of claiming a right to priority on the basis of any such application.

(6) A right to priority arising as a result of any such application may be assigned or otherwise transmitted, either with the application or independently; and the reference in subsection (1) to the applicant's successor in title shall be construed accordingly.

(7) His Majesty the Sultan and Yang Di-Pertuan may by order make provision for conferring on a person who has filed an application for protection of a trade mark in a country or territory in relation to which the Government has entered into a treaty for the reciprocal protection of trade marks, a right to priority, afford the purpose of registering the same trade mark under this Act for some or all of the same goods or services, for a specified period from the date of filing of that application.

(8) An order under subsection (7) may make provision corresponding to that made by this section in relation to Paris Convention countries and World Trade Organisation countries or such other provision as appears to His Majesty the Sultan and Yang Di-Pertuan to be appropriate.

### **Temporary protection.**

37. (1) The applicant for registration of a mark who has at an international exhibition falling within the terms of the Convention relating to International Exhibitions signed in Paris on 22nd. November, 1928, as revised or amended, exhibited goods bearing that mark or services rendered under that mark, and who has applied for registration of that mark within 6 months from the day on which the goods bearing that mark or those services were first so exhibited shall, on his request, be deemed to have applied for registration on that day.

(2) Evidence of the exhibition of such goods or services shall be given by a certificate issued by the competent authority of the exhibition, stating the date on which the mark was first used in connection with those goods or services.

(3) This section does not extend any other priority claimed by the applicant.

### **Registration procedure**

#### **Examination of application.**

38. (1) The Registrar shall examine whether an application for registration of a trade mark satisfies the requirements of this Act, including any requirements imposed by rules.



(2) For that purpose he shall carry out a search, to such extent as he considers necessary, of earlier trade marks.

(3) If it appears to the Registrar that the requirements for registration have not been met, he shall inform the applicant and give him an opportunity, within such period as the Registrar may specify, to make representations or to amend the application.

(4) If the applicant fails to satisfy the Registrar that those requirements have been met, or to amend the application so as to meet them, or fails to respond before the end of the specified period, the Registrar shall refuse to accept the application.

(5) If it appears to the Registrar that the requirements for registration have been met, he shall accept the application.

### **Publication and opposition proceedings.**

39. (1) When an application for registration has been accepted, the Registrar shall cause the application to be published in the prescribed manner.

(2) Any person may, within the prescribed time from the date of publication of the application, give written notice to the Registrar of opposition to the registration. The notice shall be given in the prescribed manner, and shall include a statement of the grounds of opposition.

### **Withdrawal, restriction or amendment of application.**

40. (1) The applicant may at any time withdraw his application or restrict the goods or services covered by the application. If the application has been published, the withdrawal or restriction shall also be published.

(2) In other respects, an application may be amended, at the request of the applicant, only by correcting —

(a) the name or address of the applicant;

(b) errors of wording or of copying; or

(c) obvious mistakes,

and then only where the correction does not substantially affect the identity of the trade mark or extend the goods or services covered by the application.

(3) Provision may be made by rules for the publication of any amendment which affects the representation of the trade mark, or the goods or services covered by the application, and for the making of objections by any person claiming to be affected by it.

### **Registration.**

41. (1) Where an application has been accepted under subsection (5) of section 38 and —

(a) no notice of opposition has been given within the period referred to in subsection (2) of section 39; or

(b) all opposition proceedings have been withdrawn or decided in favour of the applicant,

the Registrar shall register the trade mark, unless it appears to him, having regard to matters coming to his notice since he accepted the application, that it was accepted in error.

(2) A trade mark shall not be registered unless any fee prescribed for the registration is paid within the prescribed period. If the fee is not paid within that period, the application shall be deemed to have been withdrawn.

(3) A trade mark when registered shall be registered as at the date of filing of the application for registration; and that date shall be deemed for the purposes of this Act to be the date of registration.

(4) On the registration of a trade mark, the Registrar shall publish the registration in the prescribed manner and issue to the applicant a certificate of registration.

### **Registration: supplementary provisions.**

42. (1) Provision may be made by rules as to —

(a) the division of an application for the registration of a trademark into several applications;

(b) the merging of separate applications or registrations;

(c) the registration of a series of trade marks.

(2) In paragraph (c) of subsection (1), a series of trade marks means a number



of trade marks which resemble each other as to their material particulars and differ only as to matters of a non-distinctive character not substantially affecting the identity of the trade mark.

(3) Rules under this section may include provision as to —

(a) the circumstances in which, and conditions subject to which, the division, merger or registration of a series is permitted; and

(b) the purposes for which an application to which the rules apply is to be treated as a single application and those for which it is to be treated as a number of separate applications.

### **Duration, renewal and alteration of registered trade mark**

#### **Duration of registration.**

43. (1) A trade mark shall be registered for a period of 10 years from the date of registration.

(2) Registration may be renewed in accordance with section 44 for further periods each of 10 years.

#### **Renewal of registration.**

44. (1) The registration of a trade mark may be renewed at the request of the proprietor, subject to payment of a renewal fee.

(2) Provision may be made by rules for the Registrar to inform the proprietor of a registered trade mark, before the expiry of the registration, of the date of expiry and the manner in which the registration may be renewed.

(3) A request for renewal must be made, and the renewal fee paid, before the expiry of the registration. Failing this, the request may be made and the fee paid within such further period of not less than 6 months as may be prescribed, in which case an additional renewal fee must also be paid within that period.

(4) Renewal shall take effect from the expiry of the previous registration.

(5) If the registration is not renewed in accordance with this section, the Registrar shall remove the trade mark from the register. Provision may be made by rules for the restoration of the registration of a trade mark which has been removed from the register, subject to such conditions (if any) as may be prescribed.

(6) The renewal or restoration of the registration of a trade mark shall be published in the prescribed manner.

### **Alteration of registered trade mark.**

45. (1) Subject to subsection (2), a registered trade mark shall not be altered in the register during the period of registration or on renewal.

(2) The Registrar may, on the application of the proprietor, allow the alteration of a registered trade mark where the mark includes the proprietor's name or address and the alteration is limited to alteration of that name or address and does not substantially affect the identity of the mark.

(3) Provision shall be made by rules for the publication of any such alteration and the making of objections by any person claiming to be affected by it.

### **Surrender, revocation and invalidity**

#### **Surrender of registered trade mark.**

46. (1) A registered trade mark may be surrendered by the proprietor in respect of some or all of the goods or services for which it is registered.

(2) Provision may be made by rules —

(a) as to the manner and effect of a surrender; and

(b) for protecting the interests of other persons having a right in the registered trade mark.

#### **Revocation of registration.**

47. (1) The registration of a trade mark may be revoked on any of the following grounds —

(a) that within the period of 5 years following the date of completion of the registration procedure it has not been put to genuine use in Brunei Darussalam, by the proprietor or with his consent, in relation to the goods or services for which it is registered, and there are no proper reasons for non-use;

(b) that such use has been suspended for an uninterrupted period of 5 years, and there are no proper reasons for non-use;

(c) that, in consequence of acts or inactivity of the proprietor, it has become the common name in the trade for a product or service for which it is registered;

(d) that, in consequence of the use made of it by the proprietor or with his consent in relation to the goods or services for which it is registered, it is liable to mislead the public.

(2) For the purpose of subsection (1), use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and use in Brunei Darussalam includes affixing the trade mark to goods or to the packaging of goods in Brunei Darussalam solely for export purposes.

(3) The registration of a trade mark shall not be revoked on the grounds mentioned in paragraphs (a) or (b) of subsection (1) if such use as is referred to in either of those paragraphs was commenced or resumed after the expiry of the 5 years period and before the application for revocation was made:

Provided that any such commencement or resumption of use after the expiry of the 5 years period, but within the period of 3 months before the making of the application, shall be disregarded unless preparations for the commencement or resumption began before the proprietor became aware that the application might be made.

(4) An application for revocation may be made by any person, and may be made either to the Registrar or to the court, except that —

(a) if proceedings concerning the trade mark are pending in the court, the application must be made to the court; and

(b) if in any other case the application is made to the Registrar, he may at any stage of the proceedings refer the application to the court.

(5) Where grounds for revocation exist in respect of only some of the goods or services for which the trade mark is registered, revocation shall relate to those goods or services only.

(6) Where the registration of a trade mark is revoked to any extent, the rights of the proprietor shall be deemed to have ceased to that extent as from —

(a) the date of the application for revocation; or

(b) if the Registrar or court is satisfied that the grounds for revocation

existed at an earlier date, that date.

### Grounds for invalidity of registration.

48. (1) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 6 or of any of the provisions referred to in that section. Where the trade mark was registered in breach of paragraph (b), (c) or (d) of subsection (1) of that section, it shall not be declared invalid if, in consequence of the use that has been made of it, it has after registration acquired a distinctive character in relation to the goods or services for which it is registered.

(2) The registration of a trade mark may be declared invalid on the ground—

(a) that there is an earlier trade mark in relation to which the conditions set out in subsection (1), (2) or (3) of section 8 apply; or

(b) that there is an earlier right in relation to which the condition set out in subsection (4) of section 8 is satisfied,

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

(3) An application for a declaration of invalidity may be made by any person, and may be made either to the Registrar or to the court, except that—

(a) if proceedings concerning the trade mark are pending in the court, the application must be made to the court; and

(b) if in any other case the application is made to the Registrar, he may at any stage of the proceedings refer the application to the court.

(4) In the case of bad faith in the registration of a trade mark, the Registrar may apply to the court for a declaration of the invalidity of the registration.

(5) Where the grounds of invalidity exist in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards only those goods or services.

(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made:

Provided that this shall not affect transactions past and closed.

## Effect of acquiescence.

49. (1) Where the proprietor of an earlier trade mark or other earlier right has acquiesced for a continuous period of 5 years in the use of a registered trade mark in Brunei Darussalam, being aware of that use, there shall cease to be any entitlement on the basis of that earlier trade mark or other right —

(a) to apply for a declaration that the registration of the later trade mark is invalid; or

(b) to oppose the use of the later trade mark as regards the goods or services in relation to which it has been so used,

unless the registration of the later trade mark was applied for in bad faith.

(2) Where subsection (1) applies, the proprietor of the later trade mark is not entitled to oppose the use of the earlier trade mark or, as the case may be, the exploitation of the earlier right, notwithstanding that the earlier trademark or right may no longer be invoked against his later trade mark.

## Collective marks

### Collective marks.

50. A collective mark is a mark distinguishing the goods or services of members of an association which is the proprietor of that mark from those of other undertakings.

### Application of Act to collective marks.

51. This Act applies to collective marks, subject to the First Schedule.

## Certification marks

### Certification marks.

52. A certification mark is a mark indicating that the goods or services in connection with which it is used are certified by the proprietor of that mark in respect of origin, material, mode of manufacture of goods or performance of services, quality, accuracy or other characteristics.

### Application of Act to certification marks.

53. This Act applies to certification marks, subject to the Second Schedule.



## PART II

### Protection of Well-Known Trade Marks

#### Protection of well-known trade marks.

54. (1) References in this Act to a trade mark which is entitled to protection under the Paris Convention as a well-known trade mark, including such a trade mark entitled to the benefits of the Paris Convention by virtue of the World Trade Organisation Agreement are to the trade mark of a person who —

(a) is a citizen of, is domiciled, ordinarily resident or has a right of abode in, a Paris Convention country or a World Trade Organisation country; or

(b) is domiciled in, or has a real and effective industrial or commercial establishment in, any such country,

whether or not that person carries on business, or has any goodwill, in Brunei Darussalam. References to the proprietor of such a trade mark shall be construed accordingly.

(2) Subject to section 49, the proprietor of a trade mark which is entitled to protection under the Paris Convention as a well-known trade mark is entitled to restrain by injunction the use in Brunei Darussalam of a trade mark which, or the essential part of which, is identical or similar to his trade mark, in relation to identical or similar goods or services, where the use is likely to cause confusion.

(3) Nothing in subsection (2) affects the continuation of any *bonafide* use of a trade mark begun before the commencement of this section.

#### Emblems etc.

### National emblems etc. of Paris Convention and World Trade

#### Organisation countries.

55. (1) A trade mark which consists of or contains the flag of a Paris Convention country or a World Trade Organisation country shall not be registered without the authorisation of the competent authorities of that country, unless it appears to the Registrar that use of the flag in the manner proposed is permitted without such authorisation.

(2) A trade mark which consists of or contains the armorial bearings or

any other state emblem of a Paris Convention country or a World Trade Organisation country which is protected under the Paris Convention or the World Trade Organisation Agreement shall not be registered without the authorisation of the competent authorities of that country.

(3) A trade mark which consists of or contains an official sign or hallmark adopted by a Paris Convention country or a World Trade Organisation country and indicating control and warranty shall not, where the sign or hallmark is protected under the Paris Convention, be registered in relation to goods or services of the same, or a similar kind, as those in relation to which it indicates control and warranty, without the authorisation of the competent authorities of that country.

(4) The provisions of this section as to national flags and other state emblems, and official signs or hallmarks, apply equally to anything which from a heraldic point of view imitates any such flag or other emblem, or sign or hallmark.

(5) Nothing in this section prevents the registration of a trade mark on the application of a citizen of a country who is authorised to make use of a state emblem, or official sign or hallmark, of that country, notwithstanding that it is similar to that of another country.

(6) Where by virtue of this section the authorisation of the competent authorities of a Paris Convention country or a World Trade Organisation country is or would be required for the registration of a trademark, those authorities are entitled to restrain by injunction any use of the mark in Brunei Darussalam without their authorisation.

#### **Emblems etc. of certain international organisations.**

56. (1) This section applies to —

- (a) the armorial bearings, flags and other emblems; and
- (b) the abbreviations and names,

of organisations of which the government or governments of one or more Paris Convention countries or World Trade Organisation countries are members.

(2) A trade mark which consists of or contains any such emblem, abbreviation or name which is protected under the Paris Convention or the World Trade Organisation Agreement shall not be registered without the authorisation of the organisation concerned, unless it appears to the Registrar that the use of the emblem, abbreviation or name in the manner proposed —

(a) is not such as to suggest to the public that a connection exists between the organisation and the trade mark; or

(b) is not likely to mislead the public as to the existence of a connection between the user and the organisation.

(3) The provisions of this section as to emblems of an organisation apply equally to anything which from a heraldic point of view imitates any such emblem.

(4) Where by virtue of this section the authorisation of an organisation is or would be required for the registration of a trade mark, that organisation is entitled to restrain by injunction any use of the mark in Brunei Darussalam which was not authorised by it.

(5) Nothing in this section affects the rights of a person whose *bonafide* use of a trade mark began before the making of this Act.

#### **Notification under Article 6 ter of Paris Convention.**

57. (1) For the purpose of section 55, state emblems of a Paris Convention country or a World Trade Organisation country (other than the national flag), and official signs or hallmarks, shall be regarded as protected under the Paris Convention or the World Trade Organisation Agreement (as the case may be) only if, or to the extent that —

(a) that country has notified Brunei Darussalam in accordance with Article 6 ter (3) of that Convention that it desires to protect that emblem, sign or hallmark;

(b) the notification remains in force; and

(c) Brunei Darussalam has not objected to it in accordance with Article 6 ter

(4) or any such objection has been withdrawn.

(2) For the purpose of section 56, the emblems, abbreviations and names of an organisation to which that section applies shall be regarded as protected under the Paris Convention or the World Trade Organisation Agreement only if, or to the extent that —

(a) that organisation has notified Brunei Darussalam in accordance with Article 6 ter (3) of that Convention that it desires to protect that emblem, abbreviation or name;

(b) the notification remains in force; and

(c) Brunei Darussalam has not objected to it in accordance with Article 6 ter  
(4) or any such objection has been withdrawn.

(3) Notification under Article 6 ter (3) of the Paris Convention shall have effect only in relation to applications for registration made more than 2 months after the receipt of the notification.

(4) The Registrar shall keep and make available for public inspection, at all reasonable hours and free of charge, a list of —

(a) the state emblems and official signs or hallmarks; and

(b) the emblems, abbreviations and names of organisations, which are protected under the Paris Convention by virtue of notification under Article 6 ter (3).

### **Acts of agents or representatives**

### **Acts of agents or representatives.**

58. (1) The following provisions apply where an application for registration of a trade mark is made by a person who is an agent or representative of a person who is the proprietor of the mark in a Paris Convention country.

(2) If the proprietor opposes the application, registration shall be refused.

(3) If the application (not being so opposed) is granted, the proprietor may —

(a) apply for a declaration of the invalidity of the registration;

or

(b) apply for the rectification of the register so as to substitute his name as the proprietor of the registered trade mark.

(4) The proprietor may (notwithstanding the rights conferred by this Act in relation to a registered trade mark) restrain by injunction any use of the trademark in Brunei Darussalam which is not authorised by him.

(5) Subsections (2), (3) and (4) do not apply if, or to the extent that, the agent or representative justifies his action.

### **Time limit for application under section 58(3).**

59. An application under paragraph (a) or (b) of subsection (3) of section 58 must be made within 3 years of the proprietor becoming aware of the registration; and no injunction shall be granted under subsection (4) of that section in respect of a use in which the proprietor has acquiesced for a continuous period of 3 years or more.

### PART III

#### ADMINISTRATIVE AND OTHER SUPPLEMENTARY PROVISIONS

##### The register

##### The register.

60. (1) The Registrar shall maintain a Register of Trade Marks.

(2) There shall be entered in the register in accordance with this Act —

(a) registered trade marks;

(b) such particulars as may be prescribed of registrable transactions affecting registered trade marks; and

(c) such other matters relating to registered trade marks as may be prescribed.

(3) The register shall be kept in such manner as may be prescribed, and provision shall in particular be made for —

(a) public inspection of the register; and

(b) the supply of certified or uncertified copies, or extracts, of entries in the register.

##### Rectification of register.

61. (1) Any person having a sufficient interest may apply for the rectification of an error in or omission from the register:

Provided that an application for rectification may not be made in respect of a matter affecting the validity of the registration of a trade mark.

(2) An application for rectification may be made either to the Registrar or to the court, except that —



(a) if proceedings concerning the trade mark are pending in the court, the application must be made to the court; and

(b) if in any other case the application is made to the Registrar, he may at any stage of the proceedings refer the application to the court.

(3) Except where the Registrar or the court directs otherwise, the effect of rectification of the register is that the error or omission in question shall be deemed never to have been made.

(4) The Registrar may, on request made in the prescribed manner by the proprietor of a registered trade mark, or a licensee, enter any change in his name or address as recorded in the register.

(5) The Registrar may remove from the register matter appearing to him to have ceased to have effect.

### **Powers and duties of Registrar**

#### **Power to require use of forms.**

62. (1) The Registrar may require the use of such forms as he may direct for any purpose relating to the registry of a trade mark or any other proceeding before him under this Act.

(2) The forms, and any directions of the Registrar with respect to their use, shall be published in the prescribed manner.

#### **Information about applications and registered trade marks.**

63. (1) After publication of an application for registration of a trade mark, the Registrar shall on request provide a person with such information and permit him to inspect such documents relating to the application, or to any registered trade mark resulting from it, as may be specified in the request, subject to any prescribed restrictions. Any request must be made in the prescribed manner and be accompanied by any fee that may be prescribed.

(2) Before publication of an application for registration of a trade mark, documents or information constituting or relating to the application shall not be published by the Registrar or communicated by him to any person except—

(a) in such cases and to such extent as may be prescribed; or

(b) with the consent of the applicant; but subject to subsection (3).

(3) Where a person has been notified that an application for registration of a trade mark has been made, and that the applicant will if the application is granted bring proceedings against him in respect of acts done after publication of the application, he may make a request under subsection (1) notwithstanding that the application has not been published, and that subsection shall apply accordingly.

### **Costs and security for costs.**

64. (1) Provision may be made by rules empowering the Registrar, in any proceedings before him under this Act —

(a) to award any party such costs as he may consider reasonable; and

(b) to direct how and by what parties they are to be paid.

(2) Any such order of the Registrar may be enforced in the same way as an order of the court.

(3) Provision may be made by rules empowering the Registrar, in such cases as may be prescribed, to require a party to proceedings before him to give security for costs, in relation to those proceedings or to proceedings on appeal, and as to the consequences if security is not given.

### **Evidence before Registrar.**

65. Provision may be made by rules —

(a) as to the giving of evidence in proceedings before the Registrar under this Act by affidavit or statutory declaration;

(b) conferring on the Registrar the powers of an examiner for the purpose of proceedings in the High Court as regards the examination of witnesses on oath and the discovery and production of documents; and

(c) applying in relation to the attendance of witnesses in proceedings before the Registrar the rules applicable to the attendance of witnesses before such an examiner.

### **Exclusion of liability in respect of official acts.**

66. (1) The Registrar shall not be taken to warrant the validity of the

registration of a trade mark under this Act or under any treaty to which Brunei Darussalam is a party.

(2) The Registrar is not subject to any liability by reason of, or in connection with, any examination required or authorised by this Act or any such treaty or any report or other proceedings consequent on such examination.

(3) No proceedings lie against any person appointed under subsection (2) of section 3 in respect of any matter for which, by virtue of this section, the Registrar is not liable.

## Legal proceedings and appeals

### Registration *prima facie* evidence of validity.

67. In all legal proceedings relating to a registered trade mark (including proceedings for rectification of the register) the registration of a person as proprietor of a trade mark is *prima facie* evidence of the validity of the original registration and of any subsequent assignment or transfer of it.

### Certificate of validity of contested registration.

68. (1) If in proceedings before the court the validity of the registration of a trade mark is contested and it is found by the court that the trade mark was validly registered, the court may give a certificate to that effect.

(2) If the court gives such a certificate and in subsequent proceedings —

(a) the validity of the registration is again questioned; and

(b) the proprietor obtains a final order or judgment in his favour,

he is entitled to his costs unless the court directs otherwise. This subsection does not extend to the costs of an appeal on any such proceedings.

### Registrar's appearance in proceedings involving register.

69. (1) In proceedings before the court involving an application for —

(a) the revocation of the registration of a trade mark;

(b) a declaration of the invalidity of the registration of a trademark; or

(c) the rectification of the register,

the Registrar is entitled to appear and be heard, and shall appear if so directed by the court.

(2) Unless otherwise directed by the court, the Registrar may instead of appearing submit to the court a statement in writing signed by him, giving particulars of —

(a) any proceedings before him in relation to the matter in issue;

(b) the grounds of any decision given by him affecting it;

(c) the practice of the registry in like cases; or

(d) such matters relevant to the issues and within his knowledge as Registrar as he thinks fit,

and the statement shall be deemed to form part of the evidence in the proceedings.

### **Appeals from Registrar.**

70. (1) An appeal, to the court lies from any decision of the Registrar under this Act, except as otherwise expressly provided by rules. In this subsection, “decision” includes any act of the Registrar made in exercise of a discretion vested in him by or under this Act.

(2) In addition to its powers under any other law, in any appeal the court has the same discretionary powers as have been conferred upon the Registrar by this Act.

### **Rules of court.**

71. Subject to this Act, the Chief Justice may, with the approval of His Majesty the Sultan and Yang Di-Pertuan, make rules of court regulating the practice and procedure in relation to appeals before the court or connected therewith, and the costs of such appeals:

Provided that rules of court made under the repealed Act and in force on the commencement of this section shall remain in force and have effect as if they had been made under this Act, so far as they are not inconsistent with this Act, until other provision is made under this Act.

### **Fees, business hours etc.**

## **Fees.**

72. (1) There shall be paid in respect of applications and registration and other matters under this Act such fees as may be prescribed.

(2) Provision may be made by rules as to —

(a) the payment of a single fee in respect of 2 or more matters;

and

(b) the circumstances (if any) in which a fee may be repaid or

remitted.

## **Business hours and business days.**

73. (1) The Registrar shall by notice published in the *Gazette* give directions specifying the business hours of the registry for the purpose of the transaction of business under this Act, and the days which are business days for that purpose:

Provided that any rules relating to business hours and business days made under the repealed Act and in force on the commencement of this section shall continue in force and have effect as if they were directions made under this subsection, so far as they are not inconsistent with this Act, until directions are made under this subsection.

(2) Business done on any day after the specified business hours, or on a day which is not a business day, shall be deemed to have been done on the next following business day; and where the time for doing anything under this Act expires on a day which is not a business day, that time shall be extended to the next following business day.

(3) Directions under this section may make different provision for different classes of business.

## **Publication in *Gazette* .**

74. Provision may be made by rules for the publication by the Registrar in the *Gazette* of particulars of any application for the registration of a trade mark (including a representation of the mark) and such other information relating to trade marks as he thinks fit.

## **Trade mark agents**



## **Recognition of agents.**

\* 75. (1) Except as otherwise provided by rules but subject to rules to be made under section 76, any act required or authorised by this Act to be done by or to a person in connection with the registration of a trade mark, or any procedure relating to a registered trade mark, may be done by or to an agent authorised by that person in writing.

(2) Section 80 applies to an agent authorised under subsection (1).

\* not yet in force.

## **Register of trade mark agents.**

\* 76. The Attorney General may, with the approval of His Majesty the Sultan and Yang Di-Pertuan, make rules requiring the keeping by the Registrar of a register of persons who act as agents for others for the purpose of applying for or obtaining the registration of trade marks, and without prejudice to the generality of this power such rules may contain provisions regulating the registration of such persons, and may —

(a) require the payment of such fees as may be prescribed; and

(b) authorise in prescribed cases the erasure from the register of the name of any person registered in it, or the suspension of a person's registration:

Provided that this section does not affect any person who, on the commencement of this section, had the special leave of the Registrar under section 71 of the repealed Act in any particular case, until revoked by the Registrar under this Act or until other provision has been made under this Act.

## **Unregistered persons not to be described as registered trade mark agents.**

\* 77. (1) An individual who is not a registered trade mark agent shall not —

(a) carry on a business (otherwise than in partnership) under any name or other description which contains the words "registered trade mark agent" ; or

(b) in the course of a business, otherwise describe or hold himself out, or permit himself to be described or held out, as a registered trade mark agent.

(2) A partnership shall not —

(a) carry on a business under any name or other description which contains the words "registered trade mark agent" ; or

\* not yet in force.

(b) in the course of a business, otherwise describe or hold itself out, or permit itself to be described or held out, as a firm of registered trademark agents,

unless all the partners are registered trade mark agents or the partnerships satisfies such conditions as may be prescribed for the purposes of this section.

(3) A body corporate shall not —

(a) carry on a business (otherwise than in partnership) under any name or other description which contains the words "registered trade mark agent" ; or

(b) in the course of a business, otherwise describe or hold itself out, or permit itself to be described or held out, as a registered trade mark agent,

unless all the directors of the body corporate are registered trade mark agents or the body satisfies such conditions as may be prescribed for the purposes of this section.

(4) Any person who contravenes this section is guilty of an offence and liable on conviction to a fine not exceeding \$15,000.

**Power to prescribe conditions etc. for mixed partnerships and bodies corporate.**

\* 78. (1) The Attorney General may, with the approval of His Majesty the Sultan and Yang Di-Pertuan, make rules prescribing the conditions to be satisfied for the purposes of section 77 —

(a) in relation to a partnership where not all the partners are qualified persons; or

(b) in relation to a body corporate where not all the directors are qualified persons,

and imposing requirements to be complied with by such partnerships or bodies corporate.

(2) The rules may include —

\* not yet in force.

(a) the prescription of conditions as to the number or proportion of partners or directors who must be qualified persons;

(b) the imposition of requirements as to —

(i) the identification of qualified and unqualified persons in professional advertisements, circulars or letters issued by or with the consent of the partnership or body corporate and which relate to its business; and

(ii) the manner in which a partnership or body corporate is to organise its affairs so as to secure that qualified persons exercise a sufficient degree of control over the activities of unqualified persons.

(3) Any person who contravenes any requirement imposed by such rules is guilty of an offence and liable on conviction to a fine not exceeding \$15,000.

(4) In this section, “qualified person” means a registered trade mark agent.

#### Use of term “trade mark attorney” .

\* 79. No offence is committed under section 19 of the Legal Profession Act (Chapter 132) by the use of the term “trade mark attorney” in reference to a registered trade mark agent.

#### Privilege for communications with registered trade mark agents.

\* 80. (1) This section applies to communications as to any matter relating to the protection of any trade mark or involving passing off.

(2) Any such communication —

(a) between a person and his trade mark agent; or

(b) for the purpose of obtaining, or in response to a request for, information which a person is seeking for the purpose of instructing his trademark agent,

\* not yet in force.

is privileged from disclosure in legal proceedings in the same way as a communication between a person and his advocate and solicitor or, as the case may be, a communication for the purpose of obtaining, or in response to a request for, information which a person is seeking for the purpose

of instructing his advocate and solicitor.

(3) In subsection (2), “trade mark agent” means —

- (a) a registered trade mark agent;
- (b) a partnership entitled to describe itself as a firm of registered trade mark agents;
- (c) a body corporate entitled to describe itself as a registered trademark agent; or
- (d) any person authorised in writing under section 75.

#### Power of Registrar to refuse to deal with certain agents.

\* 81. (1) The Attorney General may, with the approval of His Majesty the Sultan and Yang Di-Pertuan, make rules authorising the Registrar to refuse to recognise as an agent in respect of any business under this Act —

- (a) a person who has been convicted of an offence under section 77;
- (b) an individual whose name has been erased from and not restored to, or who is suspended from, the register of trade mark agents on the grounds of misconduct;
- (c) a person who is found by the Registrar to have been guilty of such conduct as would, in the case of an individual registered in the register of trade mark agents, render him liable to have his name erased from the register on the grounds of misconduct;
- (d) a partnership or body corporate of which one of the partners or directors is a person whom the Registrar could refuse to recognise under paragraph (a), (b) or (c).

(2) The rules may contain such incidental and supplementary provisions as appear to the Attorney General to be appropriate, including the prescription of circumstances in which a person is or is not to be taken to have been guilty of misconduct.

\* not yet in force.

## PART IV

## PROCEEDINGS RELATING TO IMPORTATION OF INFRINGING GOODS

Infringing goods may be detained.

82. (1) The proprietor of a registered trade mark, or a licensee, may give notice in writing to the Controller of Customs —

(a) claiming that he is the proprietor or, as the case may be, a licensee of such trade mark registered in respect of the goods specified in the notice; and

(b) requesting him to detain any infringing goods that are or at any time come under customs control,

if the use of that trade mark in Brunei Darussalam in relation to those goods would infringe his exclusive right to that use.

(2) A notice shall —

(a) contain such particulars in support of the request as may be prescribed in regulations made under section 106; and

(b) specify the period for which the notice is to be in force, which period shall —

(i) not be longer than 5 years from the date of the notice;

or

(ii) if the registration of the trade mark will expire within 5 years from the date of the notice, expire not later than such date of expiry.

(3) The Controller of Customs shall, in relation to any notice —

(a) accept the notice if it complies with the requirements of this section and of regulations made under section 106, whereupon the goods to which it relates, unless they have been imported for private and domestic use, shall become prohibited goods for the purposes of the Customs Act (Chapter 36); or

(b) decline to accept the notice if it does not comply with such requirements, and shall advise the claimant whether the notice has been accepted or not.

(4) A notice accepted under paragraph (a) of subsection (3) remains in force



for the period specified in the notice unless —

(a) it is revoked by the claimant in writing; or

(b) the court orders, in proceedings under section 87, that it be discharged.

(5) Nothing in this section applies in relation to any sign that has been applied to goods in any country other than Brunei Darussalam by or with the approval of the proprietor of the registered trade mark to which that sign relates.

(6) Subject to any agreement subsisting between a registered user of a registered trade mark and the proprietor of that trade mark, a registered user shall be entitled to call upon the proprietor to give notice under subsection (1) in relation to that trade mark and, if the proprietor refuses or neglects to do so within 2 months of being so called upon, the registered user may give notice under that subsection as if he were the proprietor.

### **Determination whether goods are infringing goods.**

83. (1) Where —

(a) a notice that has been accepted under paragraph (a) of subsection (3) of section 82 is in force; and

(b) an officer of customs forms the opinion that any goods that have been imported and are under customs control may be infringing goods,

he may conduct such investigation as he considers necessary to establish whether or not the goods appear to be infringing goods.

(2) Where an officer of customs conducts an investigation, he may, subject to section 84, require —

(a) the claimant; and

(b) any other person appearing to him to have an interest in the goods,

to supply such information as he may specify within 10 days of being required to do so.

(3) Whether or not the officer of customs conducts an investigation, he shall make a determination whether or not the goods appear to be infringing goods.

(4) Nothing in this section applies to any goods that have been imported for

private and domestic use.

### **Limitations on requirement to supply information.**

84. (1) An officer of customs shall not require any person to supply any information under subsection (2) of section 83 unless he believes that the information is necessary for the purpose of the investigation.

(2) Every person who is required to supply information shall have the same privilege in relation to the giving of the information as a witness has in any court.

(3) Where any person refuses or fails to supply information, the officer of customs may, subject to subsection (2) of this section, take that refusal or failure into account in making a determination under subsection (3) of section 83.

### **Notice of determination.**

85. (1) An officer of customs who has made a determination under subsection (3) of section 83 shall cause written notice of that determination to be served on —

(a) the claimant; and

(b) any other person appearing to him to have an interest in the goods.

(2) Every notice required to be served under subsection (1) may be served by —

(a) personal delivery; or

(b) posting it to the last known address of such claimant or other person.

(3) The detention of any goods under section 86 is not rendered illegal by a failure to serve notice under subsection (1) of this section.

### **Detention of infringing goods.**

86. (1) Where an officer of customs has formed an opinion that any goods that have been imported and are under customs control may be goods to which a notice accepted under paragraph (a) of subsection (3) of section 82 relates, those goods shall forthwith be detained by him until —

(a) the Controller of Customs has been served with an order made in proceedings

under subsection (1) of section 87 that the notice be discharged;

(b) the Controller of Customs has been served with an order made in proceedings under subsection (2) of section 87 that the goods be released;

(c) any proceedings under subsection (3) of section 87 (including any appeal) have been determined by a decision that the goods are not infringing goods;

(d) any proceedings under subsection (3) of section 87 (including any appeal) have been abandoned; or

(e) 10 days have elapsed since notice was served under section 85 and the Controller of Customs has not been served with notice of proceedings brought under subsection (3) of section 87 by any person other than the importer or consignee,

whereupon the goods shall, subject to subsection (3) of this section, be released to the person entitled to them.

(2) The Controller of Customs may, in any particular case, extend the period referred to in paragraph (e) of subsection (1) of this section to 20 days if he considers it appropriate to do so in all the circumstances.

(3) The Controller of Customs shall not release any goods under subsection (1) of this section unless —

(a) any other legal requirements as to importation of the goods have been met;

(b) any requirements prescribed in regulations made under section 106 requiring the deposit of a security have been met; and

(c) the release of the goods would not be otherwise contrary to any law.

### **Proceedings in respect of infringing goods.**

87. (1) Any person may apply to the court for an order that a notice accepted under subsection (3) of section 82 be discharged, and the court may make such an order accordingly.

(2) Any person may apply to the court for an order that any goods detained under section 86 be released, and the court may make such an order accordingly.

(3) Any person may apply to the court for a decision whether or not any goods the subject of a determination made under subsection (3) of section 83

are infringing goods imported otherwise than for private and domestic use, and the court shall make such a decision accordingly.

(4) Notice of proceedings under subsection (3) of this section shall be served on the Controller of Customs.

(5) In proceedings under subsection (3) of this section, the court shall issue directions as to the service of notice on any person having an interest in the goods, and any such person is entitled —

(a) to appear in those proceedings, whether or not he was served with notice under section 85; and

(b) to appeal against any order made in those proceedings, whether or not he appeared in the proceedings.

(6) No order made in proceedings under subsection (3) of this section shall take effect until the end of the period within which notice of an appeal may be given or, if before the end of that period notice of appeal has been given, until the final determination or abandonment of the proceedings on the appeal.

#### **Forfeiture of goods by consent.**

88. Where any infringing goods have been detained by the Controller of Customs or an officer of customs, the importer or consignee of the goods may, by notice in writing to the Controller of Customs, consent to the goods being forfeited and, on the receipt of such notice, the goods shall thereupon be forfeited.

#### **Powers of court.**

89. (1) Where, in proceedings under subsection (3) of section 87, the court decides that any goods the subject of a determination under subsection

(3) of section 83 are infringing goods imported otherwise than for private and domestic use, it shall make an order that the goods be —

(a) forfeited;

(b) destroyed; or

(c) otherwise dealt with as it thinks fit.

(2) In considering what order should be made under subsection (1) of this section, the court shall have regard to —

(a) whether other remedies available in infringement proceedings would be adequate to compensate the claimant and to protect his interests; and

(b) the need to ensure that no infringing goods are dealt with in a manner that would adversely affect his interests.

(3) Where more than one person is interested in any infringing goods, the court may direct that the goods be sold, or otherwise dealt with, and the proceeds divided, or shall make such other order as it thinks fit.

(4) Where, in proceedings under subsection (3) of section 87, the court decides that any goods the subject of a determination under subsection (3) of section 83 are not infringing goods imported otherwise than for private and domestic use, it may make an order that any person who is a party to the proceedings pay such compensation as it thinks fit to the importer, consignee or owner of those goods.

### Inspection of goods.

90. (1) An officer of customs shall, in respect of any goods in customs control that are or may be the subject of —

(a) a notice given under section 82;

(b) an investigation under section 83; or

(d) proceedings under section 87,

allow any person claiming to have an interest in those goods or in an investigation under section 83, or in proceedings under section 87, in relation to those goods, to inspect those goods.

(2) The person referred to in subsection (1) may —

(a) inspect the goods; and

(b) with the approval of an officer of customs, remove the goods or a sample thereof to such place, for such period, and on such conditions as the officer of customs may specify, for the purpose of inspecting them.

(3) Any person who wishes to inspect or remove any goods under this section shall give to an officer of customs not less than 72 hours notice of his intention to do so.



## **Power of Controller of Customs to disclose information.**

91. Where information relating to infringing goods, infringing material or infringing articles has been obtained by the Controller of Customs for the purposes of, or in connection with, the exercise of his functions under this Act or under any other law in relation to imported goods, he may authorise the disclosure of that information to facilitate the exercise by any person of any function in connection with the investigation or prosecution of an offence under section 94 of this Act or under the Merchandise Marks Act (Chapter 96).

## **Delegation of powers and duties.**

92. (1) The Controller of Customs may, either generally or in a particular case, in writing, delegate to any officer of customs all or any of the powers and duties conferred or imposed on him by or under this Act.

(2) No delegation under subsection (1) shall include the power to delegate under that subsection.

(3) Subject to any general or special directions given or conditions imposed by the Controller of Customs, the officer of customs to whom any power or duty is delegated may exercise or perform that power or duty in the same manner and with the same effect as if it had been conferred or imposed on him directly by this Act and not by delegation.

(4) Every officer of customs purporting to act under any delegation under this section shall, in the absence of proof to the contrary, be presumed to be acting in accordance with the terms of the delegation.

(5) Any delegation under this section may be made to any specified person or to the holder or holders for the time being of any specified office or class of office.

(6) Every such delegation shall be revocable at will, and no such delegation shall prevent the exercise or performance of any power or duty by the Controller of Customs.

## **Protection of Government and officers of customs from liability.**

93. (1) In respect of anything done, purported to have been done, or omitted to be done, in the exercise or performance of any power or duty under sections 82 to 92 or under regulations made under section 106, the Government shall not be liable to make good any loss sustained in respect of any goods by fire, theft, damage or other cause while such goods are in any customs warehouse or in the lawful custody or control of any officer of customs, unless such loss is caused

by the wilful neglect or default of an officer of customs or of a person employed by the Government in connection with the customs.

(2) In respect of anything done, purported to have been done, or omitted to be done, as mentioned in subsection (1), no officer of customs or other person employed by the Government in connection with the customs shall be liable to make good any loss sustained in respect of any goods by fire, theft, damage or other cause while such goods are in any customs warehouse or in the lawful custody or control of such officer or any other officer of customs or person so employed in connection with customs, unless such loss is caused by his wilful neglect or default.

## Offences

### Unauthorised use of trade mark etc. in relation to goods.

94. (1) A person commits an offence who, with a view to gain for himself or another, or with intent to cause loss to another, and without the consent of the proprietor —

(a) applies to goods or their packaging a sign identical to, or likely to be mistaken for, a registered trade mark;

(b) sells or lets for hire, offers or exposes for sale or hire or distributes goods which bear, or the packaging of which bears, such a sign; or

(c) has in his possession, custody or control in the course of a business any such goods with a view to the doing of anything, by himself or another, which would be an offence under paragraph (b) .

(2) A person commits an offence who, with a view to gain for himself or another, or with intent to cause loss to another, and without the consent of the proprietor —

(a) applies a sign identical to, or likely to be mistaken for, a registered trade mark to material intended to be used —

(i) for labelling or packaging goods;

(ii) as a business paper in relation to goods; or

(iii) for advertising goods;

(b) uses in the course of a business material bearing such a sign for labelling

or packaging goods, as a business paper in relation to goods, or for advertising goods; or

(c) has in his possession, custody or control in the course of a business any such material with a view to the doing of anything, by himself or another, which would be an offence under paragraph (b) .

(3) A person commits an offence who, with a view to gain for himself or another, or with intent to cause loss to another, and without the consent of the proprietor —

(a) makes an article specifically designed or adapted for making copies of a sign identical to, or likely to be mistaken for, a registered trademark; or

(b) has such an article in his possession, custody or control in the course of a business,

knowing or having reason to believe that it has been, or is to be, used to produce goods, or material for labelling or packaging goods, as a business paper in relation to goods, or for advertising goods.

(4) A person does not commit an offence under this section unless—

(a) the goods are goods in respect of which the trade mark is registered; or

(b) the trade mark has a reputation in Brunei Darussalam and the use of the sign takes or would take unfair advantage of, or is or would be detrimental to, the distinctive character or the repute of the trade mark.

(5) It is a defence for a person charged with an offence under this section to show that he believed on reasonable grounds that the use of the sign in the manner in which it was used, or was to be used, was not an infringement of the registered trade mark.

(6) Any person guilty of an offence under this section is liable on conviction to imprisonment for a term not exceeding 10 years, a fine or both.

#### **Application of enforcement.**

95. (1) Section 30 of the Merchandise Marks Act (Chapter 96) applies in relation to the enforcement of section 94 of this Act as in relation to the enforcement of that Act.

(2) Any law which authorises the disclosure of information for the purpose of facilitating the enforcement of the Merchandise Marks Act (Chapter 96) shall

apply as if section 94 of this Act were contained in that Act, and as if the powers of any person in relation to the enforcement of that section were powers under that Act.

#### **Falsification of register etc.**

96. (1) It is an offence for a person to make, or cause to be made, a false entry in the register of trade marks, knowing or having reason to believe that it is false.

(2) It is an offence for a person —

(a) to make or cause to be made anything falsely purporting to be a copy of an entry in the register; or

(b) to produce or tender, or cause to be produced or tendered, in evidence any such thing,

knowing or having reason to believe that it is false.

(3) Any person guilty of an offence under this section is liable on conviction to imprisonment for a term not exceeding 5 years, a fine not exceeding \$50,000 or both.

#### **Falsely representing trade mark as registered.**

97. (1) Any person who makes a representation —

(a) with respect to a mark, not being a registered trade mark, to the effect that it is a registered trade mark;

(b) with respect to a part of a registered trade mark, not being a part separately registered as a trade mark, to the effect that it is so registered;

(c) to the effect that a registered trade mark is registered in respect of any goods or services in respect of which it is not registered; or

(d) to the effect that the registration of a trade mark gives an exclusive right to the use thereof in any circumstances in which, having regard to limitations entered on the register, the registration does not give that right,

is guilty of an offence and liable on conviction to a fine not exceeding \$10,000.

(2) For the purpose of this section, the use in Brunei Darussalam in relation to a trade mark of the word “registered” , or of any other word referring whether expressly or impliedly to registration, shall be deemed to import a reference to registration in the register, except —

(a) where that word is used in physical association with other words delineated in characters at least as large as those in which that word is delineated and indicating that the reference is to registration as a trade mark under the law of any country other than Brunei Darussalam, being a country under the law of which the registration referred to is in fact in force;

(b) where that word (being a word other than the word “registered” ) is of itself such as to indicate that the reference is to such registration; or

(c) where that word is used in relation to a mark registered as a trade mark under the law of any country other than Brunei Darussalam and in relation to goods to be exported to that country or to services for use in that country.

#### **Counterfeiting trade mark used by another.**

98. (1) Any person who counterfeits any trade mark used by any other person is guilty of an offence and liable on conviction to imprisonment for a term not exceeding 5 years, a fine not exceeding \$100,000 or both.

(2) A person shall be deemed to counterfeit a trade mark if he —

(a) without the consent of the proprietor of the trade mark, makes that trade mark or a mark so;

(b) nearly resembling that trade mark as to be calculated to deceive; or

(c) falsifies any genuine trade mark whether by alteration, addition, effacement or otherwise.

(3) In any prosecution under this section, the burden of proving the consent of the proprietor shall lie on the defendant.

#### **Making or possession of instrument for counterfeiting trade mark.**

99. Any person who makes or has in his possession any die, plate or other instrument for the purpose of counterfeiting a trade mark, or has in his possession a trade mark for the purpose of denoting that any goods are the manufacture or merchandise of a person whose manufacture or merchandise they are not, or that they belong to a person to whom they do not belong, is guilty of an offence and liable on conviction to imprisonment for a term not



exceeding 5 years, a fine not exceeding \$100,000 or both.

#### **Importing or selling etc. goods marked with counterfeit trademark.**

100. Any person who imports, sells or exposes or has in his possession for sale or for any purpose of trade or manufacture any goods or thing to which a counterfeit trade mark has been applied or to which a registered trade mark has been falsely applied, unless he proves that —

(a) having taken all reasonable precautions against committing an offence under this section, he had, at the relevant time, no reason to suspect the genuineness of the mark and on demand made by or on behalf of the prosecution, he gave all the information in his power with respect to the persons from whom he obtained the goods or thing; or

(b) he had acted innocently,

is guilty of an offence and liable on conviction to imprisonment for a term not exceeding 5 years, a fine not exceeding \$10,000 for each goods or thing to which the counterfeit trade mark has been applied or the registered trade mark has been falsely applied (but not to exceed in the aggregate \$100,000), or both.

#### **Falsely applying registered trade mark to services.**

101. Any person who falsely applies a registered trade mark to services, unless he proves that he had acted innocently, is guilty of an offence and liable on conviction to imprisonment for a term not exceeding 5 years, a fine not exceeding \$100,000 or both.

#### **Unauthorised use of Royal arms etc.**

102. (1) A person shall not without the authority of His Majesty the Sultan and Yang Di-Pertuan cause or permit to appear on a trademark used by him in connection with any business —

(a) a representation of the Emblem, Arms and Regalia of Brunei Darussalam, including the Royal Arms, State Crest, the Insignia of Royalty, armorial bearings and other insignia and emblems of Brunei Darussalam, or any device so closely resembling any of them as to be likely to deceive in such manner as to be likely to lead to the belief that he has been authorised to use them or any of them;

(b) any name or thing which is a specified name or specified emblem as defined

in section 2 of the Emblems and Names (Prevention of Improper Use) Act (Chapter 94).

(2) A person shall not without the authority of His Majesty the Sultan and Yang Di-Pertuan, a member of the Royal family or the Government use or permit to be used in connection with any business any arms, device, emblem or title in such manner as to be likely to lead to the belief that he is employed by or supplies goods or services to His Majesty the Sultan and Yang Di-Pertuan, that member of the Royal family or, as the case may be, the Government.

(3) Contravention of subsections (1) or (2) may be restrained by injunction in proceedings brought by —

(a) any person who is authorised to use the arms, device, emblem or title; or

(b) any person authorised by the Adat Istiadat Officer to take such proceedings.

(4) Nothing in this section affects any right of any person who was, on the commencement of this Act the proprietor of a trade mark containing any such arms, device, emblem or title to continue to use that trade mark.

(5) Any person who imports, sells or exposes, or has in his possession for sale or for any purpose of business or manufacture any goods or thing to which a trade mark bearing any matter prohibited by subsections

(1) or (2) has been applied is guilty of an offence and liable on conviction to imprisonment for a term not exceeding 5 years, a fine not exceeding \$50,000 or both, and shall forfeit any goods to which the trade mark bearing that matter has been applied.

### **Offences committed by partnership and bodies corporate.**

103. (1) Where a partnership is guilty of an offence under this Act, every partner, other than a partner who is proved to have been ignorant of or to have attempted to prevent the commission of the offence, is also guilty of the offence and liable to be proceeded against and punished accordingly.

(2) Where an offence under this Act committed by a body corporate is proved to have been committed with the consent or connivance of, or to be attributable to any neglect on the part of, a director, manager, secretary or other similar officer of that body, or of a person purporting to act in any such capacity, he, as well as the body corporate, is also guilty of the offence and liable to be proceeded against and punished accordingly.

(3) In relation to a body corporate whose affairs are managed by its members, "director", in subsection (2), means any member of that body corporate.

### Forfeiture of counterfeit goods etc.

#### Forfeiture.

104. (1) Where there has come into the possession of any person in connection with the investigation or prosecution of an offence under section 94 of this Act or under the Merchandise Marks Act (Chapter 96), or any offence involving dishonesty or deception —

(a) goods which, or the packaging of which, bear a sign identical to or likely to be mistaken for a registered trade mark;

(b) material bearing such a sign and intended to be used for labelling or packaging goods, as a business paper in relation to goods, or for advertising goods; or

(c) articles specifically designed or adapted for making copies of such a sign,

that person may apply to the court under this section for an order for the forfeiture of those goods, material or articles.

(2) On an application under this section, the court shall make an order for the forfeiture of any goods, material or articles only if it is satisfied that an offence mentioned in subsection (1) has been committed in relation to those goods, material or articles.

(3) The court may infer for the purpose of this section that such an offence has been committed in relation to any goods, material or articles if it is satisfied that such an offence has been committed in relation to goods, material or articles which are representative of them, whether by reason of being of the same design, or part of the same consignment or batch, or otherwise.

(4) Subject to subsection (5), where any goods, material or articles are forfeited under this section they shall be destroyed in accordance with such directions as the court may give.

(5) On making an order under this section the court may, if it considers it appropriate to do so, direct that the goods, material or articles to which the order relates shall (instead of being destroyed) be released, to such person as the court may specify, on condition that such person —

- (a) causes the offending sign to be erased, removed or obliterated; and
- (b) complies with any order to pay costs which has been made against him in the proceedings for the order for forfeiture.

## PART V

### MISCELLANEOUS AND GENERAL PROVISIONS

#### Burden of proving use of trade mark.

105. If in any civil proceedings under this Act a question arises as to what use has been made of a registered trade mark, it is for the proprietor to show the use that has been made of it.

#### Regulations and rules.

106. (1) The Attorney General may, with the approval of His Majesty the Sultan and Yang Di-Pertuan, make regulations for —

(a) prescribing all matters which are required or convenient to be prescribed by this Act, including the prescription of fees;

(b) generally for giving effect to the objects and purposes of this Act and for the due administration thereof.

(2) Such regulations may make different provision as respects different classes of case to which they apply, and may include such incidental, consequential and supplementary provisions as the Attorney General considers necessary or expedient.

(3) The Attorney General may, with the approval of His Majesty the Sultan and Yang Di-Pertuan, make rules —

(a) for the purposes of any provision of this Act authorising the making of rules with respect to any matter; and

(b) for prescribing anything required or convenient to be prescribed by this Act, including the prescription of fees,

and generally regulating practice and procedure under this Act:

Provided that rules made under the repealed Act and in force on the commencement of this subsection shall remain in force and have effect as if

they had been made under this Act, so far as they are not inconsistent with this Act, until other provision has been made under this Act.

(4) Without prejudice to the generality of subsection (3), such rules may make provision —

- (a) as to the manner of filing applications and other documents;
- (b) requiring and regulating the translation of documents and the filing and authentication of any translation;
- (c) as to the service of documents;
- (d) authorising the rectification of irregularities of procedure;
- (e) prescribing time limits for anything required to be done in connection with any proceeding under this Act;
- (f) for the extension of any time limit so prescribed, or specified by the Registrar, whether or not it has already expired.

#### **Amendment of Third Schedule.**

107. The Attorney General may, with the approval of His Majesty the Sultan and Yang Di-Pertuan, by order published in the *Gazette*, amend the Third Schedule to make such further transitional provisions as he may consider necessary and expedient.

#### **Transitional.**

108. The Third Schedule has effect with respect to transitional matters, including the treatment of trade marks registered under the repealed Act, and applications for registration and other proceeding pending under the repealed Act, on the commencement of this Act.

### **FIRST SCHEDULE**

#### **COLLECTIVE MARKS**

##### **General.**

(section 51)

1. This Act applies to collective marks, subject to the following provisions.



## **Signs of which a collective mark may consist.**

2. In relation to a collective mark, the reference in subsection (1) of section 4 to distinguishing goods or services of one undertaking from those of other undertakings shall be construed as a reference to distinguishing goods or services of members of the association which is the proprietor of the mark from those of other undertakings.

## **Indication of geographical origin.**

3. Notwithstanding paragraph (c) of subsection (1) of section 6, a collective mark may be registered which consists of signs or indications which may serve, in business, to designate the geographical origin of the goods or services; but the proprietor of such a mark is not entitled to prohibit the use of the signs or indications in accordance with honest practices in industrial or commercial matters.

## **Mark not to be misleading as to character or significance.**

4. A collective mark shall not be registered if the public is liable to be misled as regards the character or significance of the mark; and the Registrar may require that a mark in respect of which application has been made for registration include some indication that it is a collective mark. Notwithstanding subsection (2) of section 40, an application may be amended so as to comply with any such requirement.

## **Regulations governing use of collective mark.**

5. (1) An applicant for registration of a collective mark must file with the Registrar regulations governing the use of the mark.

(2) The regulations must specify the persons authorised to use the mark, the conditions of membership of the association and, where they exist, the conditions of use of the mark, including any sanctions against misuse. Further requirements with which the regulations have to comply may be imposed by rules.

## **Approval of regulations etc.**

6. (1) A collective mark shall not be registered unless the regulations governing the use of the mark —

(a) comply with sub-paragraph (2) of paragraph 5 of this Schedule and any further requirements imposed by rules; and

(b) are not contrary to public policy or to accepted principles of morality.

(2) Before the end of the prescribed period after the date of the application for registration of a collective mark, the applicant must file the regulations with the Registrar and pay the prescribed fee. If he does not do so, the application shall be deemed to have been withdrawn.

7. (1) The Registrar shall consider whether the requirements mentioned in sub-paragraph (1) of paragraph 6 of this Schedule have been met.

(2) If it appears to the Registrar that those requirements have not been met, he shall inform the applicant and give him an opportunity, within such period as the Registrar may specify, to make representations or to file amended regulations.

(3) If the applicant fails to satisfy the Registrar that those requirements have been met, or to file regulations amended so as to meet them, or fails to respond before the end of the specified period, the Registrar shall refuse the application.

(4) If it appears to the Registrar that those requirements, and the other requirements for registration, have been met, he shall accept the application and proceed in accordance with section 39.

8. The regulations shall be published and notice of opposition may be given relating to the matters mentioned in sub-paragraph (1) of paragraph 6 of this Schedule. This is in addition to any other grounds on which the application may be opposed.

### **Regulations to be open to inspection.**

9. The regulations governing the use of a registered collective mark shall be open to public inspection in the same way as the register.

### **Amendment of regulations.**

10. (1) An amendment of the regulations governing the use of a registered collective mark is not effective unless and until the amended regulations have been filed with the Registrar and accepted by him.

(2) Before accepting any amended regulations, the Registrar may in any case where it appears to him expedient to do so cause them to be published.

(3) If he does so, notice of opposition may be given relating to the matters

mentioned in sub-paragraph (1) of paragraph 6 of this Schedule.

### **Infringement: rights of authorised users.**

11. Subsection (5) of section 13, subsection (2) of section 21, and sections 82 to 90 apply in relation to an authorised user of a registered collective mark as in relation to a licensee of a trade mark.

12. (1) Notwithstanding section 31, this paragraph has effect with respect to the rights of an authorised user in relation to infringement of a registered collective mark.

(2) An authorised user is entitled, subject to any agreement to the contrary between him and the proprietor, to call on the proprietor of the registered collective mark to take infringement proceedings in respect of any matter which affects his interests.

(3) If the proprietor —

(a) refuses to do so; or

(b) fails to do so within 2 months after being called upon,

the authorised user may bring the proceedings in his own name as if he was the proprietor.

(4) Where infringement proceedings are brought by virtue of this paragraph, the authorised user may not, without the leave of the court, proceed with the action unless the proprietor is either joined as a plaintiff or added as a defendant. Nothing in this sub-paragraph affects the granting of interlocutory relief on an application by an authorised user alone.

(5) A proprietor who is added as a defendant under sub-paragraph

(4) shall not be made liable for any costs in the action unless he takes part in the proceedings.

(6) In infringement proceedings brought by the proprietor of a registered collective mark, any loss suffered or likely to be suffered by any authorised user shall be taken into account; and the court may give such directions as it thinks fit as to the extent to which the plaintiff is to hold the proceeds of any pecuniary remedy on behalf of such user.

### **Grounds for revocation of registration.**

13. Apart from the grounds of revocation provided for in section 47, the registration of a collective mark may be revoked on the ground —

- (a) that the manner in which the mark has been used by the proprietor has caused it to become liable to mislead the public;
- (b) that the proprietor has failed to observe, or to secure the observance of, the regulations governing the use of the mark; or
- (c) that an amendment of the regulations has been made so that the regulations —
  - (i) no longer comply with sub-paragraph (2) of paragraph 5 of this Schedule and any further conditions imposed by rules; or
  - (ii) are contrary to public policy or to accepted principles of morality.

### Grounds for invalidity of registration.

14. Apart from the grounds of invalidity provided for in section 48, the registration of a collective mark may be declared invalid on the ground that the mark was registered in breach of paragraph 4 or of sub-paragraph (1) of paragraph 6, of this Schedule.

## SECOND SCHEDULE

### CERTIFICATION MARKS

#### General.

(section 53)

1. This Act applies to certification marks subject to the following provisions.

#### Signs of which a certification mark may consist.

2. In relation to a certification mark the reference in subsection (1) of section 4 to distinguishing goods or services of one undertaking from those of other undertakings shall be construed as a reference to distinguishing goods or services which are certified from those which are not.

#### Indication of geographical origin.

3. Notwithstanding paragraph (c) of subsection (1) of section 6, a certification mark may be registered which consists of signs or indications which may serve in business, to designate the geographical origin of the goods or services; but the proprietor of such a mark is not entitled to prohibit the use of the signs or indications in accordance with honest practices in industrial or commercial matters.

#### **Name of proprietor' s business.**

4. A certification mark shall not be registered if the proprietor carries on a business involving the supply of goods or services of the kind certified.

#### **Mark not to be misleading as to character or significance.**

5. A certification mark shall not be registered if the public is liable to be misled as regards the character or significance of the mark; and the Registrar may require that a mark in respect of which application has been made for registration include some indication that it is a certification mark. Notwithstanding subsection (2) of section 40, an application may be amended so as to comply with any such requirement.

#### **Regulations governing use of certification mark.**

6. (1) An applicant for registration of a certification mark must file with the Registrar regulations governing the use of the mark.

(2) The regulations must indicate the person authorised to use the mark, the characteristics to be certified by the mark, how the certifying body is to test those characteristics and to supervise the use of the mark, the fees (if any) to be paid in connection with the operation of the mark and the procedures for resolving disputes. Further requirements with which the regulations have to comply may be imposed by rules.

#### **Approval of regulations etc.**

7. (1) A certification mark shall not be registered unless—

(a) the regulations governing the use of the mark —

(i) comply with sub-paragraph (2) of paragraph 6 of this Schedule and any further requirements imposed by rules; and

(ii) are not contrary to public policy or to accepted principles of morality; and



(b) the applicant is competent to certify the goods or services for which the mark is to be registered.

(2) Before the end of the prescribed period after the date of the application for registration of a certification mark, the applicant must file the regulations with the Registrar and pay the prescribed fee. If he does not do so, the application shall be deemed to have been withdrawn.

8. (1) The Registrar shall consider whether the requirements mentioned in sub-paragraph (1) of paragraph 7 of this Schedule have been met.

(2) If it appears to the Registrar that those requirements have not been met, he shall inform the applicant and give him an opportunity, within such period as the Registrar may specify, to make representations or to file amended regulations.

(3) If the applicant fails to satisfy the Registrar that those requirements have been met, or to file regulations amended so as to meet them, or fails to respond before the end of the specified period, the Registrar shall refuse the application.

(4) If it appears to the Registrar that those requirements, and the other requirements for registration, have been met, he shall accept the application and proceed in accordance with section 39.

9. The regulations shall be published and notice of opposition may be given relating to the matters mentioned in sub-paragraph (1) of paragraph 7 of this Schedule. This is in addition to any other grounds on which the application may be opposed.

#### **Regulations to be open to public inspection.**

10. The regulations governing the use of a registered certification mark shall be open to public inspection in the same way as the register.

#### **Amendment of regulations.**

11. (1) An amendment of the regulations governing the use of a registered certification mark is not effective unless and until the amended regulations have been filed with the Registrar and accepted by him.

(2) Before accepting any amended regulations, the Registrar may in any case where it appears to him expedient to do so cause them to be published.

(3) If he does so, notice of opposition may be given relating to the matters mentioned in sub-paragraph (1) of paragraph 7 of this Schedule.

### **Consent to assignment of registered certification mark.**

12. The assignment or other transfer of a registered certification mark is not effective without the consent of the Registrar.

### **Infringement: rights of authorised users.**

13. Subsection (5) of section 13, subsection (2) of section 21, and sections 82 to 90 apply in relation to an authorised user of a registered certification mark as in relation to a licensee of a trade mark.

14. In infringement proceedings brought by the proprietor of a registered certification mark, any loss suffered or likely to be suffered by any authorised user shall be taken into account; and the court may give such directions as it thinks fit as to the extent to which the plaintiff is to hold the proceeds of any pecuniary remedy on behalf of such user.

### **Grounds for revocation of registration.**

15. Apart from the grounds of revocation provided for in section 47, the registration of a certification mark may be revoked on the ground—

(a) that the proprietor has begun to carry on such a business as is mentioned in paragraph 4 of this Schedule;

(b) that the manner in which the mark has been used by the proprietor has caused it to become liable to mislead the public;

(c) that the proprietor has failed to observe, or to secure the observance of, the regulations governing the use of the mark;

(d) that an amendment of the regulations has been made so that the regulations —

(i) no longer comply with sub-paragraph (2) of paragraph 6 of this Schedule and any further conditions imposed by rules; or

(ii) are contrary to public policy or to accepted principles of morality; or

(e) that the proprietor is no longer competent to certify the goods or services for which the mark is registered.

## Grounds for invalidity of registration.

16. Apart from the grounds of invalidity provided for in section 48, the registration of a certification mark may be declared invalid on the ground that the mark was registered in breach of paragraph 4 or 5 or of sub-paragraph (1) of paragraph 7, of this Schedule.

### THIRD SCHEDULE

#### TRANSITIONAL PROVISIONS

##### Introductory.

(section 108)

1. (1) In this Schedule, “existing registered mark” means a trade mark or certification trade mark registered under the repealed Act immediately before the commencement of this Act.

(2) For the purpose of this Schedule —

(a) an application shall be treated as pending on the commencement of this Act if it was made but not finally determined before such commencement; and

(b) the date on which that application was made shall be taken to be the date of filing under the repealed Act.

##### Existing registered marks.

2. (1) Existing registered marks (whether registered in Part A or Part B of the register kept under the repealed Act) shall be transferred on the commencement of this Act to the register kept under this Act and have effect, subject to this Schedule, as if registered under this Act.

(2) Existing registered marks registered as a series in one registration under section 36 of the repealed Act shall be similarly registered in the new register. Provision may be made by rules for putting such entries in the same form as is required for entries made under this Act.

(3) In any other case, notes indicating that existing registered marks are associated with other marks shall cease to have effect on the commencement of this Act.

3. (1) A condition entered on the former register in relation to an existing

registered mark immediately before the commencement of this Act shall cease to have effect on such commencement.

(2) A disclaimer or limitation entered on the former register in relation to an existing registered mark immediately before the commencement of this Act shall be transferred to the new register and have effect as if entered on the register in pursuance of section 15 of this Act.

### **Effects of registration: infringement.**

4. (1) Sections 12, 13 and 14 of this Act apply in relation to an existing registered mark as from the commencement of this Act and section 16 of this Act applies in relation to infringement of an existing registered mark committed after the commencement of this Act, subject to sub-paragraph (2). The repealed Act continues to apply in relation to infringements committed before such commencement.

(2) It is not an infringement of —

(a) an existing registered mark; or

(b) a registered trade mark of which the distinctive elements are the same or substantially the same as those of an existing registered mark and which is registered for the same goods or services,

to continue after such commencement any use which did not amount to infringement of the existing registered mark under the repealed Act.

### **Infringing goods, material or articles.**

5. Section 18 of this Act applies to infringing goods, material or articles whether the order for delivery up was made before or after the commencement of this Act.

### **Rights and remedies of licensee or authorised user.**

6. (1) Section 31 of this Act, applies to licences granted before the commencement of this Act, but only in relation to infringements committed after such commencement.

(2) Paragraph 14 of the Second Schedule applies only in relation to infringements committed after such commencement.

### **Co-ownership of registered mark.**

7. Section 24 of this Act applies as from the commencement of this Act to an existing registered mark of which 2 or more persons were immediately before such commencement registered as joint proprietors.

#### **Assignment etc. of registered mark.**

8. (1) Section 25 of this Act applies to transactions and events occurring after the commencement of this Act in relation to an existing registered mark; and the repealed Act continues to apply in relation to transactions and events occurring before such commencement.

(2) Existing entries under section 50 of this Act shall be transferred on the commencement of this Act to the register kept under this Act and have effect as if made under section 26 of this Act. Provision may be made by rules for putting such entries in the same form as is required for entries made under this Act.

(3) An application for registration under section 50 of the repealed Act which was pending before the Registrar on the commencement of this Act shall be treated as an application for registration under section 26 of this Act and shall proceed accordingly. The Registrar may require the applicant to amend his application so as to conform with the requirements of this Act.

(4) An application for registration made under section 50 of the repealed Act which had not been finally determined by the Registrar before the commencement of this Act shall be dealt with under the repealed Act; and sub-paragraph (2) shall apply in relation to any resulting entry in the register.

(5) Where before the commencement of this Act a person has become entitled by assignment or transfer to an existing registered mark but has not registered his title, any application for registration after such commencement shall be made under section 26 of this Act.

(6) In cases to which sub-paragraph (3) or (5) apply, subsection (3) of section 50 of the repealed Act continues to apply (and subsections (3) and (4) of section 26 of this Act do not apply) as regards the consequences of failing to register.

#### **Licensing of registered mark.**

9. (1) Section 29 and subsection (2) of section 30 of this Act apply only in relation to licences granted after the commencement of this Act; and the repealed Act continues to apply in relation to licences granted before such commencement.



(2) Existing entries under section 38 of the repealed Act shall be transferred on the commencement of this Act to the register kept under this Act and have effect as if made under section 26 of this Act. Provision may be made by rules for putting such entries in the same form as is required for entries made under this Act.

(3) An application for registration as a registered user which was pending before the Registrar on the commencement of this Act shall be treated as an application for registration of a licence under subsection (1) of section 26 of this Act and shall proceed accordingly. The Registrar may require the applicant to amend his application so as to conform with the requirements of this Act.

(4) An application for registration as a registered user which had not been finally determined by the Registrar before the commencement of this Act shall be dealt with under the repealed Act; and sub-paragraph (2) shall apply in relation to any resulting entry in the register.

(5) Any proceedings pending on the commencement of this Act under subsection (8) or (10) of section 38 of the repealed Act shall be dealt with under the repealed Act and any necessary alteration made to the new register.

#### **Pending applications for registration.**

10. (1) An application for registration of a mark under the repealed Act which was pending on the commencement of this Act shall be dealt with under the repealed Act, subject as mentioned in sub-paragraphs (2) and (3), and if registered the mark shall be treated for the purposes of this Schedule as an existing registered mark.

(2) The power of the Attorney General, with the approval of His Majesty the Sultan and Yang Di-Pertuan, under subsection (3) of section 106 of this Act to make rules generally regulating practice and procedure under this Act, and as to the matters mentioned in subsection (2) of that section, is exercisable in relation to such an application; and different provision may be made for such applications from that made for other applications.

(3) Section 34 of the repealed Act shall be disregarded in dealing after the commencement of this Act with an application for registration.

#### **Conversion of pending application.**

11. (1) In the case of a pending application for registration which was not advertised under section 27 of the repealed Act before the commencement of this

Act, the applicant may give notice to the Registrar claiming to have the registrability of the mark determined in accordance with the provisions of this Act.

(2) The notice must be in the prescribed form, be accompanied by the appropriate fee and be given not later than 6 months after the commencement of this Act.

(3) Notice duly given is irrevocable and has the effect that the application shall be treated as if made immediately after the commencement of this Act.

### **Duration and renewal of registration.**

12. (1) Subsection (1) of section 43 of this Act applies in relation to the registration of a mark in pursuance of an application made after the commencement of this Act; and the repealed Act continues to apply in any other case.

(2) Subsection (2) of section 43, and section 44, of this Act apply where the renewal falls due on or after the commencement of this Act, and the repealed Act continues to apply in any other case. In either case it is immaterial when the fee is paid.

### **Pending application for alteration of registered mark.**

13. An application under section 45 of the repealed Act which was pending on the commencement of this Act shall be dealt with under the repealed Act and any necessary alteration made to the new register.

### **Revocation for non-use.**

14. (1) An application under section 47 of the repealed Act which was pending on the commencement of this Act shall be dealt with under the repealed Act and any necessary alteration made to the new register.

(2) An application under paragraph (a) or (b) of subsection (1) of section 47 of this Act may be made in relation to an existing registered mark at any time after the commencement of this Act:

Provided that no such application for the revocation of the registration of an existing registered mark registered by virtue of section 48 of the repealed Act may be made until more than 5 years after the commencement of this Act.

### **Application for rectification etc.**

15. (1) An application under section 44 or 46 of the repealed Act which was pending on the commencement of this Act shall be dealt with under the repealed Act and any necessary alteration made to the new register.

(2) For the purpose of proceedings under section 48 of this Act as it applies in relation to an existing registered mark, this Act shall be deemed to have been in force at all material times:

Provided that no objection to the validity of the registration of an existing registered mark may be taken on the ground specified in subsection (3) of section 8 of this Act.

#### **Regulations as to use of certification marks.**

16. (1) Regulations governing the use of an existing registered certification mark transmitted to the Registrar in pursuance of section 75 of the repealed Act shall be treated after the commencement of this Act as if filed under paragraph 6 of the Second Schedule to this Act.

(2) Any request for amendment of regulations which was pending on the commencement of this Act shall be dealt with under the repealed Act.

#### **Certificate of validity of contested registration.**

17. A certificate given before the commencement of this Act under section 61 of the repealed Act shall have effect as if given under subsection (1) of section 68 of this Act.