

IN THE HIGH COURT OF MALAYA AT KUALA LUMPUR
ORIGINATING SUMMONS NO: WA-24IP-24-12/2022

BETWEEN

BONIA INTERNATIONAL HOLDINGS PTE LTD ... PLAINTIFF

AND

THE REGISTRAR OR TRADEMARKS, MALAYSIA ... DEFENDANT

JUDGMENT

Introduction

1. This Originating Summons by Bonia International Holdings Pte Ltd (“Bonia”) is to set aside the decision of the Registrar of Trademarks given on 25.10.2022 (“Registrar’s Decision”) rejecting its Application No: 2015006705 (“Bonia’s Application”) to register a two-letter trademark (“Mark”) for goods in Class 14. The Mark looks like this:

“CR”

2. The Registrar rejected Bonia’s Application on the sole ground that the Mark was not registrable as it did not have any of the particulars required by s. 10(1) of the Trade Marks Act, 1976 (“the Act”), particularly (e).



3. Bonia is applying to set aside the Registrar's Decision, and for the Registrar to accept Bonia's Application and register the Mark, on the ground that the Registrar erred in law in making the Registrar's Decision.

Error of law

4. In **Syarikat Kenderaan Melayu Kelantan Bhd v Transport Workers Union [1995] 2 CLJ 748**, Gopal Sri Ram JCA (as he then was) said:

*"In my judgment, the true principle may be stated as follows. An inferior tribunal or other decision-making authority, whether exercising a quasi-judicial function or purely an administrative function, has no jurisdiction to commit an error of law. Henceforth, it is no longer of concern whether the error of law is jurisdictional or not. If an inferior tribunal or other public decision-taker does make such an error, then he exceeds his jurisdiction. So too is jurisdiction exceeded, where resort is had to an unfair procedure (see *Raja Abdul Malek Muzaffar Shah bin Raja Shahruzzaman v Setiausaha Suruhanjaya Pasukan Polis [1995] 1 MLJ 308*), or where the decision reached is unreasonable, in the sense that no reasonable tribunal similarly circumstanced would have arrived at the impugned decision.*

*It is neither feasible nor desirable to attempt an exhaustive definition of what amounts to an error of law, for the categories of such an error are not closed. **But it may be safely said that an error of law would be disclosed if the decision-maker asks himself the wrong question or takes into account irrelevant considerations or omits to take into account relevant considerations (what may be conveniently termed an Anisminic error) or if he misconstrues***



the terms of any relevant statute, or misapplies or misstates a principle of the general law.” (emphasis added)

5. Pursuant to s. 25(4) of the Act, the Registrar had provided her Alasan-Alasan Keputusan (“the Registrar’s Grounds”).
6. Consequently, Bonia must establish from the Registrar’s Grounds that, by rejecting Bonia’s Application, the Registrar had asked herself the wrong question, or took into account irrelevant considerations, or omitted to take into account relevant considerations, or misconstrued the terms of the Act, or misapplied or misstated a principle of the general law.

Section 10 of the Act

7. Section 10(1) of the Act provides for the particulars that make a trade mark registrable under the Act:

“(1) In order for a trade mark (other than a certification trade mark) to be registrable, it shall contain or consist of at least one of the following particulars:

- (a) the name of an individual, company or firm represented in a special or particular manner;*
- (b) the signature of the applicant for registration or of some predecessor in his business;*
- (c) an invented word or words;*



(d) *a word having no direct reference to the character or quality of the goods or services not being, according to its ordinary meaning, a geographical name or surname; or*

(e) *any other distinctive mark.*

8. Only one of limbs (a) to (e) needs to be satisfied. See **Yong Sze Fan & Anor v Sharifah binti Mohd Tamin & Ors [2008] 7 MLJ 803.**
9. Limbs (a) to (d) clearly do not apply to the Mark; in fact, the Registrar rejected Bonia's Application because it did not satisfy limb (e).

The issues

10. The Plaintiff raises three grounds for contending that the Registrar erred in law in rejecting Bonia's Application under limb (e):
 - (i) the Mark has a reasonable degree of inherent distinctiveness and is capable of distinguishing the Plaintiff's goods from other traders;
 - (ii) the Mark has factual distinctiveness from long and extensive use; and
 - (iii) the Registrar failed to sufficiently consider that the Plaintiff's application to register the Mark in Singapore had been accepted.



11. The three issues to be considered and decided are therefore:
- (i) Whether the Mark has a reasonable degree of inherent distinctiveness and is capable of distinguishing the Plaintiff's goods from other traders;
 - (ii) Whether the Mark has factual distinctiveness from long and extensive use; and
 - (iii) Whether the Registrar erred in law in rejecting Bonia's Application on the basis that the Plaintiff's application to register the Mark in Singapore had been accepted.

Issue 1: Whether the Mark had inherent distinctiveness

12. Subsections (2A) and (2B) of section 10 of the Act elucidate on what "distinctive" is to mean. They provide:

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



(2B) *In determining whether a trade mark is capable of distinguishing as aforesaid, regard may be had to the extent to which—*

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

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

13. Limb (a) of s.10(2B) obviously concerns inherent distinctiveness.

14. In **Illinois Tool Works, Inc v Pendaftar Cap Dagangan (M) [2009] 9 MLJ 101**, Ramli Ali J (as he then was) approved of the test set out in the following statement by the Court in **An application by the Diamond T Motor Company to (Register A Trade Mark (Diamond T case) (1921) 38 RPC 373**:

“... in order to ascertain whether the applicant's mark is registrable trademark, the sole question to be determined is whether it is adapted to distinguish the vehicles of the applicants from those of other manufactures, and in determining this question it is, in my judgment, immaterial to consider whether any of its component parts are or are not registrable by themselves under paras (1)–(4).”

15. Bonia’s Application was to register the Mark for goods in Class 14, specifically:



“electrical and electronic timepieces; chronometric and timing instrument, clocks and watches, clock and watch cases, straps and bracelets, leather watch straps, being parts and fittings of watches; articles made of precious metals or coated therewith, jewellery, ornaments, precious stones; parts and fittings for all the aforesaid goods; all included in Class 14.”

16. The burden therefore lay on the Plaintiff to show that the Mark would serve as a distinctive trade mark between the Plaintiff's goods in Class 14 and other traders of goods in Class 14.
17. The Registrar dealt with this issue of inherent distinctiveness in paragraph 10 of the Registrar's Grounds. She referred, *inter alia*, to the case of **Registrar of Trade Marks v W. & G. Du Cros, Limited [1913] AC 624** in which Lord Parker of Waddington said:

“In my opinion, in order to determine whether a mark is distinctive, it must be considered quite apart from the effects of registration. The question, therefore, is whether the mark itself, if used as a trade mark, is likely to become actually distinctive of the goods of the person so using it. The applicant for registration in effect says, “I intend to use this mark as a trade mark, i.e. for the purpose of distinguishing my goods from the goods of other persons”, and the Registrar or the Court has to determine whether it is of such a kind that the applicant, quite apart from the effects of registration, is likely or unlikely to attain the object he has in view. The applicant's chance of success in this respect must, I think, largely depend upon whether other traders are likely, in the ordinary course of their business and without improper motive, to desire to use the same mark, or some mark nearly resembling it, upon or in connection with their own goods.



18. She also referred to the case of **Re Smith Kline & French Laboratories Ltd's Cimetidine Trade Mark [1991] RPC 17** in which Peter Gibson J said:

"In considering whether the claimed trade mark is inherently adapted to distinguish, the court take s account of the likelihood that other traders may, without improper motive, desire to use the same trade mark in relation to their own goods. On the grounds of public policy a trader will not be allowed to obtain, by a trade mark registration, a monopoly in what other traders may legitimately wish to use."

19. She also referred to the WIPO Manual of Trade Marks Law and Practice in Malaysia (1989 & 2003 Editions), in which in paragraph 12.125 it is stated:

"It is common trade practice to use such combinations as catalogue references, model numbers or part numbers. Accordingly, they are not acceptable as new and unused trade marks unless there are sufficient integers in the combination to lessen the likelihood of their being required in trade...."

20. The Registrar then concluded that the two letters "C" and "R" was a combination that was not distinctive and did not possess any unique features, and said:

"Bagi maksud pendaftaran, huruf atau gabungan huruf mestilah distinktif yang maka perlu dinyatakan dengan suatu cara yang khas atau dalam bentuk representasi yang boleh diterima sebagai suatu lambing (device). Sebaliknya, cap dagangan pemohon iaitu "CR" adalah semata-mata kombinasi dua huruf yang biasa dan tidak mempunyai apa-apa kesan visual yang mewujudkan identifikasi yang



boleh dibentuk pada pemikiran orang awam. Oleh it, cap dagangan pemohon tidak distinktif menurut seksyen 10(1)(e), ACD1976.”

21. I agree with the Registrar’s conclusions. There is nothing fanciful or distinctive of the Mark, or anything that makes it distinctive to the Plaintiff. It is just two letters put together without any special font or stylisation. I also find that there are insufficient integers in the combination to those two letters, to lessen the likelihood of other traders in the ordinary course of their business and without improper motive not desiring to use the same mark, or some mark nearly resembling it, upon or in connection with their own goods.
22. Crucially, I also find that the Registrar did not make any error of law in coming to those conclusions. She did not ask herself the wrong question, or take into account irrelevant considerations, or omit to take into account relevant considerations, or misconstrue the terms of the Act, or misapply or misstate a principle of the general law.
23. In conclusion, I find that the Registrar did not err in rejecting Bonia’s application on the ground that it was not inherently distinctive.

Issue 2: Whether the Mark had factual distinctiveness

24. The Plaintiff contends that the factual distinctiveness comes from use. That involves limb (b) of s.10(2B) of the Act.
25. The Registrar dealt with this issue of factual distinctiveness in paragraph 11 of the Registrar’s Grounds.



26. She first set out what the Plaintiff had to show, namely:

- (i) Continuous and widespread use over time;
- (ii) The mark used functions as a trademark;
- (iii) The mark used generates a high reputation amongst Malaysian consumers;
- (iv) That the long and extensive use makes the trade mark distinguishable in law and not just in fact.

27. The Registrar concluded:

“Setelah meneliti keterangan di dalam dokumen bertarikh 23 Mac 2021 dan Akaun Berkanun yang difailkan pada 29 Jun 2022, Pendaftar mendapati penggunaan cap dagangan pemohon di Malaysia ke atas barangan yang diniagakan adalah melalui CRF Marketing Sdn Bhd dan CR Boutique Sdn Bhd.

Bukti-bukti penggunaan yang dinyatakan adalah merujuk kepada pelbagai representasi cap dengan berbeza yang dimiliki atau dipohon oleh pemohon termasuk representasi sebenar cap dagangan sepertimana dinyatakan di dalam permohonan. Keterangan-keterangan sokongan yang dikemukakan juga tidak dinyatakan secara khusus bagi cap dagangan “CR” ke atas barangan yang difailkan di dalam permohonan.”

28. I again find no fault in the Registrar’s conclusions. The Plaintiff’s exhibits do substantially show many different marks and not just the “CR” mark, and most of them with the letters “CR” are not alone but are accompanied by the brand name “Carlo Rino”.



29. Even though its Affidavit in Support the Plaintiff the adduced a Statutory Declaration by one of its directors and in paragraph 9 thereof he attested to sales of timepieces under the Carlo Rino brand for the period of 2006-October 2020, there was no evidence that all of that was conducted by the Plaintiff. If it was, then surely the Plaintiff's director would have positively attested to that. In fact, the invoices which he then referred to in the next paragraph, as well as a sample of the invoices dated from November 2006 to August 2020 were all issued by CR Boutique Sdn Bhd or CRF Marketing Sdn Bhd, and not the Plaintiff.
30. The only conclusion I can draw is that all of that trade was conducted by either CR Boutique Sdn Bhd or CRF Marketing Sdn Bhd, and not the Plaintiff.
31. On the evidence, I therefore find that there was not any use by the Plaintiff to establish factual distinctiveness.
32. I also find that the Registrar did not make any error of law in coming to that same conclusion.

Issue 3: Whether the Registrar erred in law in rejecting Bonia's Application on the basis that the Plaintiff's application to register the Mark in Singapore had been accepted

33. In a nutshell, the Plaintiff successfully registered the Mark in Singapore, and therefore contended that the Registrar should have likewise accepted the Plaintiff's Application, and erred in law in not doing so.



34. The Registrar dealt with this issue in paragraph 12 of the Registrar's Grounds. She referred, *inter alia*, to **Titan (M) Sdn Bhd v Registrar of Trade Marks [2009] 7 CLJ 338**. In that case, the Registrar had, like here, rejected Titan's application to register its mark "SURE-Loc" on the grounds that it was not registrable. One of the grounds Titan sought to challenge that decision was that that mark had acquired factual distinctiveness since the appellant had registered it as a trade mark in Singapore. Ramli Ali J (as he then was) said:

"The court is of the view that the trade mark registrations are territorial in nature. The registration obtained by the appellant for the appellant's Trade Mark in Singapore is not binding on the registrar as the evaluation of the appellant's application is strictly made pursuant to the provisions of the Malaysian TMA. The respondent had rejected the appellant's application pursuant to the Malaysian TMA. The issue of inconsistency of registration as raised by the appellant does not arise because trade mark law and protection is territorial in nature."

35. Interestingly, in paragraph 19 of the Plaintiff's Affidavit in Support, the deponent, a director of the Plaintiff, conceded that trade mark registrations in other jurisdictions are not binding. This was also the position the Plaintiff took in paragraph 48 of its Written Submissions, saying:

"While trade mark registrations in other jurisdictions are not binding, they can be persuasive depending on the jurisdictions from where they originate....."

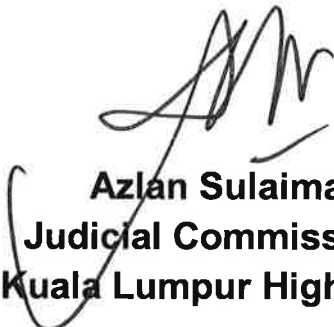


36. Then, in paragraph 49, the Plaintiff referred to the case of **GS Yuasa Corp v GBI Marketing Malaysia Sdn Bhd [2017] 8 MLJ 166** in which Wong Kian Kheong JC (as he then was) expressed the same view, but with a qualification in that case that does not apply here.
37. The point is this: if the registration of the Mark in Singapore is not binding on the Registrar here, then the Registrar cannot be held to have erred in law in not following it or done likewise by accepting the Plaintiff's Application.

Conclusion

38. I therefore find that the Registrar did not err in law in rejecting to the Plaintiff's Application.
39. I therefore dismissed the Originating Summons with costs of RM8,000.00, subject to allocator to, be paid by the Plaintiff to the Defendant.

Dated the 14th day of April 2023


Azlan Sulaiman
Judicial Commissioner
Kuala Lumpur High Court



Counsel:

Indran Shanmuganathan together with Sim Sook Eng (Messrs Shearn Delamore & Co.) for Plaintiff.

Rahimi Arafpin (Perbadanan Harta Intelek Malaysia (MyIPO)) for Defendant.

Legislation:

s. 10(1) Trade Marks Act, 1976

subsections (2A) and (2B) of s. 10 Trade Marks Act, 1976

s. 25(4) Trade Marks Act, 1976

Cases:

GS Yuasa Corp v GBI Marketing Malaysia Sdn Bhd [2017] 8 MLJ 166

Illinois Tool Works, Inc v Pendaftar Cap Dagangan (M) [2009] 9 MLJ 101

Registrar of Trade Marks v W. & G. Du Cros, Limited [1913] AC 624

Re Smith Kline & French Laboratories Ltd's Cimetidine Trade Mark [1991] RPC 17

Syarikat Kenderaan Melayu Kelantan Bhd v Transport Workers Union [1995] 2 CLJ 748

Titan (M) Sdn Bhd v Registrar of Trade Marks [2009] 7 CLJ 338

Yong Sze Fan & Anor v Sharifah binti Mohd Tamin & Ors [2008] 7 MLJ 803

