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Privileges of ‘Well-Known’ Trademarks

In so far as protection of trademarks is concerned, the general proposition is that exclusivity of rights and protection goes hand in hand with registration. Without registration, a trademark owner’s recourse lies only in common law, and the safeguards under the statutory armour of the Trademarks Act 2019 are but a far reach.

There is, however, a niche group of trademark owners who enjoy protection under the 2019 Act even without registration. They are proprietors of “well-known” trademarks. They need not carry on any business in Malaysia.¹ Neither do they require any goodwill.²

This protection comes in the form of statutory rights to restrain, by injunction, any unauthorised use by another party.³ The rights extend to situations of usage in relation to different goods or services, if such use would indicate a connection between parties to the detriment of the “well-known” trademark owner.⁴

Besides injunction, the remedy of invalidation is also available.⁵ A trademark ought not be registered if its registration would give rise to unfair advantage or impinge on the distinctive characters or repute of the “well-known” trademark.⁶

What then constitutes a “well-known” trademark? Under the 2019 Act,⁷ the owner must first cross the hurdle of being part of a Convention country⁸ before establishing one or more of the following criteria:⁹

(a) Extent of knowledge or recognition of the trademark in the



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¹ Trademarks Act 2019, s 76(1)

² *Ibid*

³ Trade Marks Act 1976, s 76(2)

⁴ *Ibid*, s 76(2)(b)

⁵ *Ibid*, s 76(3)

⁶ *Y-Teq Auto Parts (M) Sdn Bhd v X1R Global Holdings* [2017] 2 MLJ 609 at para 21(b)

⁷ Read together with Trademarks Regulations 2019

⁸ Section 2 of the Trademarks Act 2019 provides that a Convention country means a country which is a party to any multilateral treaty relating to trademarks to which Malaysia is also a party. For the purposes of well-known trademarks, the Paris Convention and the Agreement on Trade-Related Aspects of Intellectual Property (commonly known as TRIPs Agreement) are relevant.

⁹ Trademarks Regulations 2019, reg 5

relevant sector of the public;

- (b) Duration and extent, and geographical area of any use and promotion of the trademark; and
- (c) Record of successful enforcement of rights in the trademark, in particular, the extent to which the trademark was recognised as well known by competent authorities.

It is a high threshold to cross. In *City Chain Stores (S) Pte Ltd v Louis Vuitton Malletier*, Louis Vuitton, a well-known company in luxury goods¹⁰ with an estimated brand value of US\$20.3 billion,¹¹ commenced proceedings against another company for infringement of its “Flower Quatrefoil” trademark. This trademark is one of the four constituent elements that make up the Louis Vuitton Monogram Canvas design.¹² The Singapore Court of Appeal however disagreed the mark was “well-known”, and held the trademark’s registration in many countries and the substantial duration of such registration do not per se prove that it is well known in Singapore.¹³

In Malaysia, the case of *Y-Teq Auto v X1R Global Holdings*¹⁴ similarly provided an insight into the high threshold required. Here, the Court of Appeal concurred with the High Court’s findings that the trademark in question was “well known”, but only after it was proven, inter alia, that the public and people involved in the trade were able to identify it, that it has been used in more than 30 countries, and that it has been registered as a trademark in 13 countries including Malaysia.

Overall, the reinforcement by the 2019 Act to protect well-known trademarks is a positive development. Nevertheless, its exact parameters especially on qualifying as a “well-known” trademark will only become clearer when more cases are litigated on this issue.

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¹⁰ *City Chain Stores (S) Pte Ltd v Louis Vuitton Malletier* [2010] 1 SLR 382 at para 1

¹¹ *Ibid* at para 3

¹² *Ibid* at paras. 7 and 8

¹³ *Ibid* at para 95

¹⁴ *Y-Teq Auto Parts*, *supra* n 6