

INTELLECTUAL PROPERTY

Registration – Dismissal of opposition by Registrar of Trade Marks – Appeal to High Court and Court of Appeal - Whether High Court exercising its original or appellate jurisdiction - Whether matter ought to end at Court of Appeal - Whether aggrieved party has right to appeal to Federal Court – Trade Marks Act 1976, sections 28

Merck KGaA v Leno Marketing (M) Sdn Bhd; Registrar of Trade Marks (Interested Party)
[2018] 6 CLJ 167, Federal Court

Facts The appellant is an international pharmaceutical company, and the registered owner of the trade marks 'BION' and 'BION 3'. The respondent applied to register the trade mark 'Bionel'. The Registrar of Trade Marks ('the Registrar') accepted the respondent's application. Upon the publication of the respondent's application in the Gazette, the appellant filed a notice of opposition before the Registrar on the grounds that the respondent's mark was confusingly or deceptively similar to the appellant's mark, and that the registration would likely deceive or cause confusion amongst the public. The Registrar dismissed the appellant's opposition and registered the respondent's trade mark. The appellant appealed against the decision of the Registrar to the High Court pursuant to section 28¹(5) and 28(6) of the Trade Marks Act 1976 ("the TMA"). The High Court dismissed the appellant's appeal. Dissatisfied, the appellant appealed to the Court of Appeal, which was then dismissed. Leave to appeal was granted to the appellant. At the hearing of the appeal, the respondent contended that the appeal was not valid as the TMA confers appellate jurisdiction on the High Court, with an appeal procedure as provided for in Order 55A of the Rules of Court 2012 ('RC'). Thus, it was argued that since the present appeal did not emanate from a decision of the High Court in its original jurisdiction, it was invalid and must be dismissed. The appellant however argued that the term 'appeal' in the TMA was not conclusive of the nature of the legal proceedings; rather, it was the substantive provisions of the statute that were determinative, hence, the appeal was competent.

Issue The main issue is whether the High Court is exercising its original jurisdiction or appellate jurisdiction under the powers conferred to it under sections 28(5), (6) and (7) of the Trade Marks Act ("TMA").

Held In dismissing the Appeal, the Federal Court held that the High Court was exercising its appellate jurisdiction in hearing an appeal from the decision of the Registrar under section 28 of the TMA. Therefore, since the matter was not decided in the High Court in its original jurisdiction, the present appeal is not eligible to be presented before the Federal Court, and that the matter must have ended at the Court of Appeal.

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¹ Section 28 of the TMA - Opposition to registration