

Contact Persons:

12 JANUARY 2018

IP & TMT

Bahari Yeow Tien Hong
Partner
DID: +603 6208 5856
Fax: +603 6201 0122
Email: yth@lh-ag.com

Adlin Abdul Majid
Partner
DID: +603 6208 5816
Fax: +603 6201 0122
Email: aam@lh-ag.com

Eunice Chan Wei Lynn
Partner
DID: +603 6208 5872
Fax: +603 6201 0122
Email: cwl@lh-ag.com

Lim Zhi Jian
Partner
DID: +603 6208 5825
Fax: +603 6201 0122
Email: lzj@lh-ag.com

Is an *Ex Parte* Trade Description Order a Denial of Justice?

Tan Kim Hock Product Centre Sdn Bhd & Anor v Tan Kim Hock Tong
^[1]
Seng Food Industry Sdn Bhd

A registered owner of a trade mark may apply for a Trade Description Order (TDO) pursuant to the Trade Descriptions Act 2011 (the Act) to declare that another mark or get-up is being used by someone else in the course of trade to infringe his statutory rights, thereby imposing criminal liability. A TDO is seen as an effective legal measure to combat counterfeit goods in the market when the identities of the infringers are not known.

^[2]
It has been a long-standing practice that a TDO may be obtained on an *ex parte* application — without notice to the defendant.

The legality of a TDO obtained *ex parte* was put to the test for the first time in *Tan Kim Hock Product Centre*.

The appellants argued before the Federal Court that, *inter alia*, that it is against all norms of criminal justice that an *ex parte* order carrying criminal liability should ever be imposed on a person affected without him being given notice of or being heard in the proceedings. The appellants further argued that any *ex parte* TDO is unjustified and wrong in law as the Act does not expressly provide that a TDO can be applied *ex parte*.

Dismissing the appeal, the Federal Court considered that, unless a TDO is obtained *ex parte*, any effort to curtail the problem of imitation goods flooding the market would be seriously hampered. Further, without an offence creating TDO, there would be no evidence on which a prosecution for an infringement may be brought, making it impossible for authorities to identify and seize imitation goods.

The Federal Court declined to adopt a narrow interpretation of the relevant provisions of the Act, emphasising that if it were Parliament's intention that a TDO cannot be obtained on an *ex parte* basis, it would be up to Parliament to change the law, and not the courts. The purpose and intent of the Act must be given paramount consideration. There is no denial of justice as the right to set aside an *ex parte* order is a right that exists over and above other civil remedies available.

This decision by the Federal Court therefore affirms the validity of a

TDO obtained *ex parte*.

Lim Zhi Jian

If you have any queries or would like to know more about trade description orders, please do not hesitate to contact team partner Mr Lim Zhi Jian (lzj@lh-ag.com).

Lee Hishammuddin Allen & Gledhill

Level 6, Menara 1 Dutamas
Solaris Dutamas
No. 1, Jalan Dutamas 1
50480 Kuala Lumpur
Malaysia

T +603 6208 5888
F +603 6201 0122/0136
E enquiry@lh-ag.com
W www.lh-ag.com

Published by the IP & TMT Practice Group

© Lee Hishammuddin Allen & Gledhill. All rights reserved. The views and opinions attributable to the authors or editor of this publication are not to be imputed to the firm, Lee Hishammuddin Allen & Gledhill. The contents of this publication are intended for purposes of general information and academic discussion only. It should not be construed as legal advice or legal opinion on any fact or circumstance.

[Feedback](#)

[Unsubscribe](#)

[1]

Civil Appeal No 02-6-02/2016(W)

[2]

In-Comix Food Industries Sdn Bhd v A Clouet & Co (KL) Sdn Bhd [1997] 4 MLJ 71; *NV Sumatra Tobacco Trading Co v PT Sampoerna JL Sdn Bhd* [1997] 3 CLJ 946; *Hu Kim Ai (trading as Geneve Timepiece) & Anor v Liew Yew Thoong (trading as Crystal Hour)* [2004] 7 MLJ 590; *Tohtonku Sdn Bhd v Superace (M) Sdn Bhd* [1989] 2 MLJ 298