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**Copyright vs Trade Mark**

*Hakubaku Co Ltd v Asiamega Food Manufacturers Sdn Bhd* <sup>[1]</sup>

| by Bahari Yeow Tien Hong and Sonali Nadkarni (Pupil-in-Chambers)  
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Trade mark and copyright are two separate and distinct intellectual property rights.

A Japanese company, Hakubaku, initiated a claim against a local company, Asiamega Food Manufacturers (AFM), for copyright infringement of its logo. AFM had filed and registered its trade mark consisting of a logo that bears a striking resemblance to the logo used by Hakubaku. The High Court allowed Hakubaku's claim and, in doing so, ordered that records of AFM's registered trade mark be erased.

Although AFM had filed its logo for trade mark registration in Malaysia first, the court found that Hakubaku had been using the logo on its products before AFM registered the trade mark.

Issues	Decision
<p>Since Hakubaku did not oppose AFM's trade mark registration when the mark was published in the <i>Gazette</i>, should Hakubaku's claim for copyright infringement and expungement of AFM's claim be rejected?</p>	<ul style="list-style-type: none"> <li>• Hakubaku's right under copyright should not be stopped for failure to oppose the trade mark registration.</li> <li>• Following <i>Yong Teng Hing</i>, <sup>[2]</sup> failure to oppose a mark when the mark is published in the <i>Gazette per se</i> should not bar a rightful owner from challenging the registration of the mark.</li> <li>• In this case, the trade mark</li> </ul>

	<p>registration was not done in good faith.</p>
<p>Copyright v trade mark: Which IP rights prevail?</p>	<ul style="list-style-type: none"> <li>• Under trade mark law, the first person to use a mark is the “common law proprietor” of the mark. <a href="#">[3]</a></li> <li>• Simply registering an application for a trade mark should not be viewed as “using” that mark, and automatic priority should not be given to a party solely because they were the first to register a trade mark. <a href="#">[4]</a></li> <li>• On the facts, Hakubaku is the first user of the mark, and is the common law proprietor of the mark.</li> <li>• Any attempt to appropriate or unlawfully use someone else’s mark should be criticised, even if that mark is used only in a foreign country and has not yet been registered in Malaysia.</li> <li>• A person infringes a copyright if he appropriates the work which is protected under copyright law without the permission of the copyright owner. <a href="#">[5]</a></li> <li>• By using Hakubaku’s artistic work, i.e. the logo (which is protected under copyright) on its products, AFM had infringed Hakubaku’s copyright.</li> <li>• AFM’s registration of the trade mark had therefore been unlawful, and so provides grounds to remove the trade mark from the register.</li> </ul>
<p>Does the court have the discretion not to remove the trade mark from the register?</p>	<ul style="list-style-type: none"> <li>• Once a ground for removal has been established, the court has no discretion but to remove it. <a href="#">[6]</a></li> </ul>

In this case, AFM also objected to the admissibility of the affidavits presented by Hakubaku on the grounds that:

- (i) they had been affirmed in English by deponents in Japan before

- a Japanese public officer;
- (ii) there was no Bahasa Malaysia translation of the affidavits; and
- (iii) the translator was not identified by name.

In his judgment, Wong Kian Kheong J held that the affidavits were admissible as:

- (a) Malaysian law expressly allows affidavits affirmed outside the country to be in English. Such an affidavit need not be translated into Bahasa Malaysia.
- (b) The law does not specify that such an affidavit must be affirmed before a Malaysian officer or Commonwealth authority, nor that the translator must be identified in the documents, as it does not affect the accuracy of the affidavit.

Further, the fact that AFM had been able to respond to and oppose Hakubaku's application to court demonstrated that it had not been hindered by the lack of Bahasa Malaysia translations.

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[1] Kuala Lumpur High Court Originating Summons No 24IP-23-12/2017

[2] *Yong Teng Hing B/S Hong Kong Trading Co & Anor v Walton International Ltd* [2012] 6 CLJ 337, per Zulkefli Makinudin CJ at para 22

[3] *Mesuma Sports Sdn Bhd v Majlis Sukan Negara Malaysia; Pendaftar Cap Dagangan Malaysia (Interested Party)* [2015] 6 MLJ 465, per Azahar Mohamed FCJ at paras 37 to 47

[4] *Yong Teng Hing*, *supra* n 1, at para 7; *Liwayway Marketing Corp v Oishi Group Public Co Ltd* [2017] 5 CLJ 133, per Balia Yusof Wahi FCJ at para 16

[5] Copyright Act 1987, s 36

[6] *Ho Tack Sien & Ors v Rotta Research Laboratorium SPA & Anor; Registrar of Trade Marks (Intervener) & Another Appeal* [2015] 4 CLJ 20, per Zulkefli bin Ahmad Makinudin CJ at para 25