



LAWS OF MALAYSIA

Act 836

GEOGRAPHICAL INDICATIONS ACT 2022

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Act 836

GEOGRAPHICAL INDICATIONS ACT 2022

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LAWS OF MALAYSIA

Act 836

GEOGRAPHICAL INDICATIONS ACT 2022

An Act to provide for the protection and registration of geographical indications in relation to goods, and for the implementation of the relevant treaties and related matters.

[]

ENACTED by the Parliament of Malaysia as follows:

PART I

PRELIMINARY

Short title, commencement and application

1. (1) This Act may be cited as the Geographical Indications Act 2022.

(2) This Act comes into operation on a date to be appointed by the Minister by notification in the *Gazette* and the Minister may appoint different dates for the coming into operation of different parts or provisions of this Act.

(3) This Act shall apply to any interested person of geographical indications whether or not registered under this Act unless expressly provided otherwise.

Interpretation

2. In this Act, unless the context otherwise requires—

“this Act” includes any subsidiary legislation made under this Act;

“repealed Act” means the Geographical Indications Act 2000 [Act 602];

“goods” means any goods as determined by the Registrar;

“trademark” has the same meaning as assigned to it in the Trademarks Act 2019 [Act 815] or in any previous written law relating to trademark;

“registered trademark” means a trademark registered under the Trademarks Act 2019 or any previous written law relating to trademark;

“well-known trademark” has the same meaning as assigned to it in the Trademarks Act 2019 or any previous written law relating to trademark;

“Register” means the Register of Geographical Indications kept under this Act;

“determined by the Registrar” means any determination made by the Registrar in the guidelines or practice directions under section 95;

“prescribed” means, in relation to proceedings before the Court or preliminary thereto or connected therewith, prescribed by rules of court made by the Rules Committee constituted under the Courts of Judicature Act 1964 [Act 91], and in other cases, prescribed by the Minister in the regulations made under this Act;

“agent” means a geographical indication agent registered in accordance with this Act;

“Court” means the High Court;

“Minister” means the Minister charged with the responsibility for geographical indications;

“interested person” in relation to goods identified by a geographical indication, means a producer of the goods, a trader of the goods, or an association of such producers, an association of such traders or an association of such producers and traders;

“qualified person” means—

- (a) a citizen of Malaysia or an individual who is residing in Malaysia;
- (b) a body corporate incorporated under any written law in Malaysia; or
- (c) any other person who has a real and effective industrial or commercial establishment in Malaysia;

“Registrar” means the Registrar of Geographical Indications as designated in subsection 3(1);

“protected international registration designating Malaysia” has the same meaning as assigned to it in the Trademarks Act 2019;

“producer” means any producer, manufacturer or trader of goods identified by the geographical indication;

“use” means use as part of, in connection with—

- (a) any transaction, including a purchase, a sale or an exchange;
- (b) any importation or exportation;
- (c) any advertisement; or
- (d) any invoice, wine list, catalogue, business letter, business paper, price list or other commercial documents;

“Assistant Registrar” means a person appointed to be an Assistant Registrar under subsection 3(3);

“Corporation” means the Intellectual Property Corporation of Malaysia established under the Intellectual Property Corporation of Malaysia Act 2002 [*Act 617*];

“geographical indication” means an indication which may contain one or more words which identifies any goods as originating in a country or territory, or a region or locality in that country or territory, where a given quality, reputation or other characteristic of the goods is essentially attributable to its geographical origin;

“registered geographical indication” means a geographical indication that is registered under section 17 or the repealed Act;

“homonymous geographical indication” means a geographical indication that, in part or in whole, has the same spelling as, or sounds the same as, a geographical indication for any goods having a different geographical origin;

“earlier geographical indication” means—

- (a) a geographical indication which has been registered under section 17 or the repealed Act; or
- (b) an application for registration of a geographical indication which has been made under section 8 or the repealed Act,

before the date of the application for registration of the geographical indication in question;

“competent authority” means any—

- (a) government or statutory body carrying out the functions of, on behalf of, or sanctioned by, the Government of Malaysia or the Government of a State;
- (b) government other than the Government of Malaysia; or
- (c) authority which is competent to certify goods,

and has the responsibility for the geographical indication in question;

“Deputy Registrar” means a person appointed to be a Deputy Registrar under subsection 3(3);

“registered proprietor” in relation to a geographical indication, means a person for the time being entered in the Register as proprietor of the geographical indication;

“variant” means any variant of a geographical indication constituting the geographical indication, and includes any translation, transliteration or other variation of the indication.

PART II

ADMINISTRATION

Registrar, Deputy Registrar and Assistant Registrar

3. (1) The Director General of the Corporation shall be the Registrar of Geographical Indications and have control of the Geographical Indications Office.

(2) The Registrar shall perform the duties imposed and exercise the powers conferred on him under this Act for the proper administration of this Act.

(3) The Corporation may appoint, on such terms and conditions as the Corporation may determine, from amongst persons in the employment of the Corporation, such number of Deputy Registrars of Geographical Indications, Assistant Registrars of Geographical Indications and other officers as may be necessary for the proper administration of this Act.

(4) Subject to the general direction and control of the Registrar and to such conditions or restrictions as may be imposed by the Registrar, a Deputy Registrar or an Assistant Registrar may exercise any power of the Registrar under this Act.

(5) The Registrar shall have a seal of such device as may be approved by the Corporation and the impressions of such seal shall be judicially noticed and admitted in evidence.

Protection of Registrar, Deputy Registrar, Assistant Registrar and other officers

4. No action, suit, prosecution or other proceedings shall be brought, instituted or maintained in any court against—

- (a) the Registrar, Deputy Registrar or Assistant Registrar, in respect of any act ordered or done for the purpose of carrying into effect this Act; and
- (b) any other officer in respect of any act done or purported to be done by him under the order, direction or instruction of the Registrar,

if the act was ordered or done in good faith and in reasonable belief that it was necessary for the purpose intended to be served by it.

Geographical Indications Office and other branch offices

5. (1) The Central Geographical Indications Office and such number of branch offices of the Central Geographical Indications Office established under section 9 of the repealed Act shall be known as the Geographical Indications Office and branch offices, respectively.

(2) In addition to subsection (1), for the purposes of this Act, such number of branch offices of the Geographical Indications Office as may be necessary shall be established.

(3) Any document required by this Act to be filed at the Geographical Indications Office may be filed at any branch office of the Geographical Indications Office and any reference in this Act to the submission at the Geographical Indications Office includes reference to the submission at a branch office.

(4) All communications with the Geographical Indications Office shall be in the national language or English language.

PART III

REGISTER OF GEOGRAPHICAL INDICATIONS AND RECORD OF REGISTRAR

Register of Geographical Indications and record of Registrar

6. (1) The Registrar shall keep and maintain—

(a) a register called the Register of Geographical Indications;
and

(b) a record of Registrar.

(2) The Register and the record of Registrar shall contain all such matters and particulars relating to geographical indications as prescribed.

(3) The Register and the record of Registrar shall be kept in such form as determined by the Registrar.

Inspection of Register

7. (1) The Register shall be made available for public inspection subject to the conditions as prescribed upon application in the form as determined by the Registrar together with payment of the prescribed fee.

(2) Subject to the conditions in subsection (1), certified copies or extracts of any entry in the Register sealed with the seal of the Registrar shall be given to any person upon application in the form as determined by the Registrar together with payment of the prescribed fee.

PART IV

REGISTRATION OF GEOGRAPHICAL INDICATIONS

Chapter 1

*Application for registration of geographical indications***Application for registration of geographical indication**

8. (1) Any person may file an application for registration of a geographical indication of any goods in the form as determined by the Registrar together with payment of the prescribed fee.

(2) If the person referred to in subsection (1) wishes to register any variant of a geographical indication and the geographical indication is the subject of an application for registration, the registration of the variant shall be made in a different application for registration.

(3) If the geographical indication applied for registration contains or consists of a word which is not in Roman characters, or the national language or English language, the applicant shall furnish the Registrar with—

- (a) the transliteration of the geographical indication;
- (b) the translation of the geographical indication; and
- (c) any information as determined by the Registrar.

(4) If the applicant does not comply with the requirements under this section within the prescribed period, his application for registration of geographical indication shall be deemed to be withdrawn.

(5) For the purposes of subsection (1), “person” means—

- (a) any person who is carrying on an activity as a producer in the geographical area with respect to the goods and includes an association of such persons; or
- (b) a competent authority.

Registration only in respect of goods falling within categories of goods

9. (1) An application for registration of a geographical indication under subsection 8(1) may only be sought in respect of any goods falling within one or more of the categories of goods as set out in the guidelines or practice directions under section 95.

(2) The Registrar shall determine whether or not any goods fall within a category of goods as set out in the guidelines or practice directions under section 95.

Chapter 2

Grounds for refusal of registration

Grounds for refusal of registration of geographical indication

10. (1) The Registrar shall refuse to register a geographical indication if—

- (a) the geographical indication does not correspond to the meaning of “geographical indication” as defined in section 2;
- (b) the geographical indication identifies goods that do not fall within any of the categories of goods as determined by the Registrar;
- (c) the geographical indication consists exclusively of an indication which is identical with the term customary in the common language as the common name of any goods in Malaysia if registration is sought in relation to the goods;
- (d) the geographical indication is contrary to public order or morality;
- (e) the geographical indication is not or has ceased to be protected in its country or territory of origin;
- (f) the goods does not originate in the country, region or locality indicated in the application for the registration of geographical indication; or

- (g) the geographical indication in relation to the goods is of such a nature which may mislead the public as to the true place of origin of the goods.

(2) Subject to section 11, the Registrar shall refuse to register a geographical indication if there exists a likelihood of confusion on the part of the public because the geographical indication is identical with or similar to, and has the same geographical origin as, an earlier geographical indication.

(3) The Registrar shall not register a geographical indication if there exists a likelihood of confusion on the part of the public by reason the geographical indication is identical with or similar to a trademark if the trademark fulfils any of the following conditions:

- (a) the trademark is a registered trademark or protected international registration designating Malaysia, and taking into account, where appropriate, the priorities claimed in respect of the trademark under the Trademarks Act 2019 where—

- (i) the application for the registration of the trademark was made in good faith; or

- (ii) the trademark was registered in good faith,

- under the Trademarks Act 2019 or any previous written law relating to trademarks before the date of application for registration of the geographical indication in Malaysia; or

- (b) the trademark has been used in good faith in Malaysia in the course of trade before the date of application for registration of the geographical indication in Malaysia.

(4) The Registrar shall refuse to register a geographical indication that is identical with or similar to a trademark if—

- (a) before the date of application for registration of the geographical indication, the trademark is a well-known trademark in Malaysia; and

(b) the registration of the geographical indication is liable to mislead consumers as to the true identity of the goods identified by that geographical indication.

(5) Notwithstanding subsections (3) and (4), the Registrar may, in his discretion, register any geographical indication referred to in subsection (3) or (4), if the proprietor of the trademark referred to in subsection (3) or (4), as the case may be—

(a) consents to the registration; or

(b) fails to file a notice to the Registrar of his opposition to the registration in accordance with subsection 16(1).

(6) For the purposes of this section—

(a) a reference to a geographical indication includes a variant of the geographical indication; and

(b) a refusal of registration under this section of any variant of a geographical indication does not prevent the registration of any other variant of the geographical indication if that variant satisfies the requirements of this Act.

Registration of homonymous geographical indication

11. (1) Notwithstanding subsection 10(2), the Registrar may register a geographical indication that is a homonymous geographical indication in relation to an earlier geographical indication.

(2) For the purposes of subsection (1), the Registrar may register the homonymous geographical indication with practical conditions differentiating the homonymous geographical indication from the earlier geographical indication as determined by the Registrar, taking into account the need to ensure equitable treatment of all the parties concerned and that the public are not misled.

Chapter 3

*Examination***Examination of application for registration of geographical indication**

12. (1) The Registrar shall examine whether an application for registration of a geographical indication filed by an applicant under section 8 fulfills the requirements for the registration under this Act.

(2) For the purposes of an examination under subsection (1), the Registrar shall carry out a search of any earlier geographical indication or earlier trademark to such extent as the Registrar considers necessary.

(3) If the application for the registration of the geographical indication made by the applicant does not fulfil any of the requirements for registration of a geographical indication, the Registrar shall inform the applicant of the grounds of provisional refusal by a written notice and give the applicant an opportunity, within such period as the Registrar may specify in the written notice, to—

- (a) make a representation by way of a written submission or hearing;
- (b) amend the application for registration of the geographical indication to meet any condition, amendment, modification or limitation as the Registrar thinks fit to impose; or
- (c) furnish additional or any other information or evidence.

(4) Any hearing under paragraph (3)(a) and amendment under paragraph (3)(b) shall be made by the applicant in the form as determined by the Registrar together with payment of the prescribed fee.

(5) Where—

- (a) the applicant does not respond to the Registrar within such period as specified in the written notice, the application for the registration of the geographical indication shall be deemed to be withdrawn; or

(b) the response given by the applicant does not satisfy the Registrar, the Registrar shall refuse the application for the registration of the geographical indication, and upon an application made by the applicant in the form as determined by the Registrar together with payment of the prescribed fee, state in writing the grounds of the refusal.

(6) Upon examination, where the Registrar finds that the application for the registration of the geographical indication fulfils the requirements for registration of a geographical indication, the Registrar shall accept the application for the registration of the geographical indication.

(7) Where an appeal is made to the Court against the decision of the Registrar relating to the refusal under paragraph (5)(b)—

(a) the appeal shall be made in the prescribed manner;

(b) the Court shall, where necessary, hear the applicant and the Registrar; and

(c) the appeal shall be heard on the material as stated by the Registrar to have been used by him in arriving at the decision and no additional ground of refusal to the acceptance of the application for registration of geographical indication shall be allowed to be introduced by the Registrar other than those so stated except by leave of the Court.

(8) For the purposes of paragraph (7)(c), where any additional ground of provisional refusal is introduced by the Registrar, the applicant shall, without payment of any cost, be entitled to withdraw—

(a) his appeal in the prescribed manner; and

(b) his application for the registration of the geographical indication in the form as determined by the Registrar.

(9) In determining an appeal under subsection (7), the Court shall make an order subject to any condition, amendment, modification or limitation, if any, for the acceptance of the application for the registration of the geographical indication.

(10) Any application for the registration of a geographical indication filed under section 8 and accepted under this section shall, notwithstanding any condition, amendment, modification or limitation permitted by the Registrar or the Court to be made in such application, be deemed to have been made on the date of the application for registration of the geographical indication.

(11) Without prejudice to subsection (10), where after the acceptance of an application for the registration of a geographical indication but before the registration of the geographical indication, the Registrar is satisfied that—

- (a) the application for the registration of the geographical indication has been accepted in error; or
- (b) in the special circumstances of the case—
 - (i) the geographical indication shall not be registered; or
 - (ii) the geographical indication shall be registered subject to any additional or different condition or limitation,

the Registrar may revoke the acceptance and proceed as if the application for the registration of the geographical indication had not been accepted, or in respect of a geographical indication which shall be registered subject to any additional or different condition or limitation, reissue a new acceptance subject to the additional or different condition or limitation.

(12) For the purposes of this section, “earlier trademark” means—

- (a) a registered trademark or protected international registration designating Malaysia, the application for registration of which was made earlier than the application for the registration of the geographical indication in question, taking into account, where appropriate, the priorities claimed in respect of the trademark under the Trademarks Act 2019 or any previous written law relating to trademarks; or

- (b) a trademark which, at the date of application for the registration of the geographical indication in question, was a well-known trademark,

and includes a trademark in respect of which an application for registration has been made and which, if registered, would be an earlier trademark by virtue of paragraph (a) subject to it being so registered.

Acceptance of application for registration of geographical indication

13. (1) If an application for the registration of a geographical indication is accepted under subsection 12(6) or (9), the Registrar shall issue a notice of acceptance to the applicant requiring the applicant to make payment of the prescribed fee within the period as specified in such notice.

(2) If the applicant fails to make payment under subsection (1), the application for the registration of the geographical indication shall be deemed to be withdrawn.

Publication of acceptance of application for registration of geographical indication

14. (1) Upon receipt of the payment of the prescribed fee from the applicant under subsection 13(1), the acceptance of the application shall be published in the Intellectual Property Official Journal.

(2) The publication under subsection (1) shall contain all conditions, amendments, modifications or limitations subject to which the application under section 13 was accepted.

Chapter 4

Amendment or withdrawal of application for registration of geographical indication

Amendment or withdrawal of application for registration of geographical indication

15. (1) An applicant may, before the registration of a geographical indication, amend or withdraw his application for registration of the geographical indication under section 8 in the form as determined by the Registrar together with payment of the prescribed fee.

(2) Any amendment to an application for registration of a geographical indication under subsection (1) shall only be made in relation to the matters as prescribed and shall not substantially affect the identity of the geographical indication, or extend the description of goods covered by the application.

(3) If the applicant withdraws his application for registration of a geographical indication after the acceptance has been published under subsection 14(1), the notice of withdrawal of the application shall be published.

(4) An applicant shall not revoke an application for withdrawal under subsection (3) if the application for withdrawal has been given effect by the Registrar.

Chapter 5

Opposition

Opposition proceedings

16. (1) Any interested person may, within the prescribed period, file a notice of opposition with the Registrar on any ground under section 10 in the form as determined by the Registrar together with payment of the prescribed fee.

(2) The notice of opposition filed under subsection (1) shall be accompanied by a statement of the grounds of opposition.

(3) The opponent shall, within the prescribed period, serve the notice of opposition together with the statement of the grounds of opposition filed with the Registrar under subsections (1) and (2) to the applicant.

(4) The applicant shall, within the prescribed period after the receipt of the notice of opposition from the opponent, file a counterstatement in the form as determined by the Registrar together with payment of the prescribed fee.

(5) If the applicant does not comply with the requirement under subsection (4), the application for the registration of the geographical indication shall be deemed to be withdrawn.

(6) The counterstatement filed under subsection (4) shall be accompanied by a statement of the grounds of the counterstatement.

(7) The opponent and applicant shall file any evidence in the prescribed manner within the prescribed period in support of the opposition or the counterstatement, as the case may be.

(8) If the opponent or applicant does not comply with the requirement under subsection (7), the opposition or application, as the case may be, shall be deemed to be withdrawn.

(9) If the applicant files any evidence under subsection (7), the opponent may file any evidence in reply in the prescribed manner.

(10) The applicant and opponent may file a written submission within the prescribed period.

(11) Upon considering the evidence and written submission, the Registrar shall decide to—

- (a) refuse to register the geographical indication as filed by the applicant;
- (b) register the geographical indication as filed by the applicant; or
- (c) register the geographical indication as filed by the applicant subject to any condition, amendment, modification or limitation as the Registrar thinks fit.

(12) Where an appeal is made to the Court against the decision of the Registrar under subsection (11)—

- (a) the appeal shall be made in the prescribed manner;
- (b) the Court shall, where necessary, hear the parties and the Registrar;
- (c) any party may, either in the prescribed manner or by leave of the Court, file any additional evidence for the consideration of the Court; and
- (d) the opponent shall not introduce any additional ground of opposition to the registration of the geographical indication for the consideration of the Court except by leave of the Court.

(13) Where any additional ground of opposition is introduced by the opponent, the applicant shall be entitled to withdraw his application in the prescribed manner without payment of any cost to the opponent.

(14) For the purposes of this section, if an opponent, applicant or appellant, neither resides nor carries on business in Malaysia, the Registrar or the Court may require him to give security for costs of the proceedings relating to the opposition, application or appeal, as the case may be.

(15) For the purposes of subsection (14), the Registrar may determine the manner and form of giving security for costs together with payment of the prescribed fee.

(16) In default of such security for costs being duly given under subsection (14), the opposition, application for registration of geographical indication, or appeal, as the case may be, is deemed to be withdrawn.

(17) For the purposes of this section, “opponent” means the interested person referred to in subsection (1).

Chapter 6

Registration

Registration of geographical indication

17. (1) When an application for the registration of a geographical indication has been accepted, either—

- (a) the application has not been opposed and the period for opposition has expired; or
- (b) the application has been opposed and the opposition has been decided in favour of the applicant,

the Registrar shall, unless the application has been accepted in error, register the geographical indication in the Register in the name of the applicant.

(2) For the purposes of subsection (1), the geographical indication shall be registered as at the date of filing of the application for registration of the geographical indication and the date shall be deemed for the purposes of this Act to be the date of registration.

(3) Upon the registration of the geographical indication, the Registrar shall issue a certificate of registration of the geographical indication with the seal of the Registrar to the registered proprietor.

PART V

PERIOD AND RENEWAL OF REGISTRATION OF GEOGRAPHICAL INDICATION

Period of registration of geographical indication

18. (1) The registration of a geographical indication shall be for a period of ten years from the date of registration.

(2) The registration of the geographical indication may be renewed in accordance with section 19 for further periods of ten years in respect of each renewal.

Renewal of registration of geographical indication

19. (1) A registered proprietor may, on or before the date of expiry of the registration, renew the registration of a geographical indication in the manner as determined by the Registrar together with payment of the prescribed fee.

(2) For the purpose of renewing the registration of the geographical indication under subsection (1), the Registrar may require the registered proprietor to furnish any additional particulars as prescribed and shall refuse to renew the registration if the registered proprietor does not furnish the additional particulars as required.

(3) If the registered proprietor makes an application for a renewal within the period of six months after the date of expiry of the registration, the application for the renewal shall be made in the form as determined by the Registrar together with payment of the prescribed fee and prescribed surcharge.

(4) In the case where the registered proprietor does not renew the registration of the geographical indication after six months of the expiry date of the registration, the geographical indication shall be deemed to be removed.

(5) Where the geographical indication has been deemed to be removed under subsection (4), the registered proprietor may apply for the restoration of the removed registration in the form as determined by the Registrar within six months from the date of the removal together with payment of the prescribed fee.

(6) For the purpose of restoring the registration of the geographical indication under subsection (5), the Registrar may require the registered proprietor to furnish any additional particulars as prescribed and shall refuse to restore the registration of the geographical indication if the registered proprietor does not furnish the additional particulars as required.

(7) Any renewal or restoration of the registration of the geographical indication made under this section shall take effect from the date of expiry of the registration or the date of expiry of the previous renewal of the registration.

(8) The registration of the geographical indication shall cease if no application for restoration is made under subsection (5) or the application for renewal of the registration of the geographical indication is refused by the Registrar under subsection (6).

(9) The renewal or restoration of the registration of a geographical indication under this section shall be published in the Intellectual Property Official Journal.

PART VI

CORRECTION AND CANCELLATION

Interpretation

20. For the purposes of this Part, “geographical indication” includes a variant.

Correction of Register and record of Registrar

21. (1) The Registrar may, as he thinks necessary, correct any clerical error or any mistake in the Register or the record of Registrar under this Act.

(2) The Registrar may, on the request of any registered proprietor in the form as determined by the Registrar together with payment of the prescribed fee—

(a) correct any error or enter any change in the name, address or description of the registered proprietor in the Register; or

(b) correct the details of description of the goods in the Register in respect of the registered geographical indication without, in any way, extending the rights given under the existing registration of the geographical indication.

(3) The Registrar shall issue a certificate of registration of the geographical indication to the registered proprietor upon making any correction under this section.

Voluntary cancellation of registered geographical indication

22. (1) The registered proprietor may make a request to the Registrar for a voluntary cancellation of a registered geographical indication in respect of any goods in the form as determined by the Registrar together with payment of the prescribed fee.

(2) For the purposes of subsection (1), the registered proprietor shall comply with any requirement as prescribed.

(3) The Registrar shall cancel the registration of the geographical indication if the Registrar is satisfied that the registered proprietor has complied with the requirements as prescribed.

(4) Where the registration of the geographical indication is voluntarily cancelled under this section, the rights conferred by the registration of the geographical indication on any interested party of goods identified by the geographical indication shall cease to exist with effect from the date of the cancellation of the registration.

Cancellation of registered geographical indication by Court

23. (1) The Court may, on the application of any person in the prescribed manner, cancel the registration of a geographical indication on the following grounds:

- (a) the geographical indication was registered in breach of section 10 except for paragraph 10(1)(e);
- (b) the registration of the geographical indication was obtained fraudulently or by misrepresentation;
- (c) the geographical indication has fallen into disuse or has ceased to be protected in its country or territory of origin;
- (d) there has been a failure by a registered proprietor to maintain, in Malaysia, any commercial activity or interest in relation to the geographical indication, including commercialisation, promotion or market monitoring; or
- (e) in consequence of the failure to maintain any commercial activity or interest in relation to the geographical indication, including commercialisation, promotion or market monitoring in Malaysia by any interested party of goods identified by the registered geographical indication, the geographical indication has become the common name of the goods in Malaysia.

(2) Upon an application made under subsection (1), the person shall notify the producer having the right to use the geographical indication under section 28 which is within his knowledge in the manner as determined by the Registrar.

(3) The producer referred to in subsection (2) and any other interested person may, within a period as determined by the Court, apply to the Court for leave to join any proceedings which may be heard by the Court to determine whether or not the registration of the geographical indication should be cancelled.

(4) Where the registration of the geographical indication is cancelled by the Court on any ground under paragraph (1)(a) or (b), the geographical indication shall be deemed to never have been registered, but the cancellation shall not affect transactions past and closed.

(5) Where the registration of the geographical indication is cancelled by the Court on any ground under paragraph (1)(c), (d) or (e), the rights conferred by the registration of the geographical indication on any interested person of goods identified by the geographical indication shall cease to exist with effect from—

- (a) the date of the application for cancellation is made; or
- (b) if the Court is satisfied that the ground existed on an earlier date, that earlier date.

(6) Where cancellation of the registered geographical indication is made by the Court under this section, the person who made an application to cancel the registration shall notify all persons having rights in the registered geographical indication who is within his knowledge in the manner as determined by the Registrar about the cancellation.

(7) For the purposes of this section, “within his knowledge” includes information in the Register of the producer having the right to use the geographical indication.

Cancellation of registration of any variant

24. For the purposes of this Part, any cancellation of the registration of any variant shall not affect the registration of any other variant.

PART VII

EFFECTS OF REGISTERED GEOGRAPHICAL INDICATION

Rights conferred under registered geographical indication

25. (1) A registered proprietor of a geographical indication in relation to the goods for which the geographical indication is registered has the right to—

- (a) use the geographical indication; and
- (b) authorize other persons to use the geographical indication.

(2) For the purposes of this Part, “use” includes making, importing, exporting, offering for sale, selling or using the geographical indication in relation to the goods for which the geographical indication is registered.

(3) Subject to the provisions of this Act, the registered proprietor has the right to take action, or obtain relief or remedies under section 34, 35 or 77.

(4) The rights of the registered proprietor shall accrue from the date of registration of the geographical indication and no proceedings may be instituted before the date on which the geographical indication is in fact registered.

(5) For the purposes of subsection (4), no offence under section 34 or 35 is committed for anything done before the date on which the geographical indication is in fact registered.

(6) If the geographical indication is registered subject to any condition or limitation, the rights of the registered proprietor are restricted by the condition or limitation.

Transfer of registration of registered geographical indication

26. (1) A registered proprietor may file an application for the transfer of the registration of a geographical indication to another person in the form as determined by the Registrar together with payment of the prescribed fee.

(2) The registration of a geographical indication shall not be transferred to another person unless the person—

(a) is entitled to file an application for the registration of the geographical indication under subsection 8(1); and

(b) gives consent in writing for the registration of the geographical indication to be transferred to him.

(3) Upon receipt of the application for the transfer of the registration of the geographical indication from the registered proprietor together with payment of the prescribed fee under subsection (1) and the requirements under subsection (2) are complied with, the Registrar shall register the transfer of registration of the geographical indication.

Registration as *prima facie* evidence

27. In any legal proceedings relating to a registered geographical indication—

- (a) the Register shall be *prima facie* evidence of anything contained in the Register;
- (b) the registration of any transfer made under section 26 shall be *prima facie* evidence of such transfer; and
- (c) the registration of a person as the registered proprietor of a geographical indication shall be *prima facie* evidence of—
 - (i) the validity of the original registration of the geographical indication; and
 - (ii) any subsequent transfer of registration of the geographical indication.

Right of use of producer

28. (1) Subject to section 25, a producer carrying on an activity in the geographical area specified in the Register shall have the right to use the registered geographical indication in the course of trade.

(2) The right of use shall be in respect of the goods in accordance with the quality, reputation or characteristic as specified in the Register.

PART VIII**GEOGRAPHICAL INDICATION AGENTS****Recognition of registered geographical indication agent**

29. (1) Any act which is required or authorized by this Act to be done by or to a person in connection with the application for the registration of a geographical indication, or any procedure relating to a registered geographical indication, may be done by or to a registered geographical indication agent duly authorized by the person in the manner as determined by the Registrar.

(2) A person who does not reside or carry on a business principally in Malaysia shall appoint and authorize a registered geographical indication agent to act for him for the purpose of the registration of a geographical indication or any procedure relating to a registered geographical indication in the form as determined by the Registrar together with payment of the prescribed fee.

(3) Upon being appointed and authorized by the person to act for him under subsection (2), a registered geographical indication agent appointed and authorized to act for the person shall, unless terminated by the person or ceases to act for the person in accordance with the prescribed manner together with payment of the prescribed fee—

(a) continue to be the agent of the person; and

(b) be answerable for all acts, matters and things that are required to be done by the person under this Act.

(4) Where a registered geographical indication agent acting for a person intends to cease to act on behalf of the person—

(a) the registered geographical indication agent shall file a notice of intention to cease to act on behalf of the person with the Registrar in the form as determined by the Registrar together with payment of the prescribed fee; and

(b) the registered geographical indication agent shall notify the person in the manner as determined by the Registrar.

(5) The agent shall cease to be the agent for the person upon the Registrar being satisfied that the agent has complied with subsection (4).

Register of Geographical Indication Agents

30. (1) The Registrar shall keep and maintain a register called the Register of Geographical Indication Agents.

(2) The Register of Geographical Indication Agents shall contain the names, addresses and other prescribed matters of registered geographical indication agents who shall act on behalf of any person for the purposes of section 29.

(3) In all legal proceedings relating to a registered geographical indication agent, the Register of Geographical Indication Agents shall be *prima facie* evidence of anything contained in the Register of Geographical Indication Agents.

Registration of geographical indication agent

31. (1) Any person may apply to the Registrar to be registered as a geographical indication agent by filing an application for registration of a geographical indication agent in the form as determined by the Registrar together with payment of the prescribed fee.

(2) For the purposes of subsection (1), the person shall comply with any requirement as prescribed.

(3) If the person complies with the prescribed requirements, the Registrar shall register the person as a geographical indication agent and enter the name of the person in the Register of Geographical Indication Agents.

Cancellation of registration of geographical indication agent, etc.

32. (1) In relation to the registration of a geographical indication agent, the Registrar shall have the power to—

(a) cancel the registration of the geographical indication agent on any ground as may be prescribed;

(b) allow a voluntary cancellation of the registration of the geographical indication agent upon an application made by the registered geographical indication agent together with payment of the prescribed fee;

- (c) allow a change of name or address for service of the registered geographical indication agent upon an application made by the registered geographical indication agent together with payment of the prescribed fee;
 - (d) remove the registration of the geographical indication agent from the Register of Geographical Indication Agents upon the death of the registered geographical indication agent;
 - (e) refuse to recognize any person as a registered geographical indication agent subject to any circumstances as prescribed; and
 - (f) renew the registration of the geographical indication agent upon an application for renewal of the registration made by the geographical indication agent together with payment of the prescribed fee.
- (2) If the Registrar cancels the registration of a geographical indication agent under this section, the Registrar shall—
- (a) remove the name of the registered geographical indication agent from the Register of Geographical Indication Agents; and
 - (b) publish in the Intellectual Property Official Journal regarding—
 - (i) the removal of the registered geographical indication agent from the Register of Geographical Indication Agents; and
 - (ii) the particulars relating to the applications for registration of geographical indications or registered geographical indications handled by the registered geographical indication agent.

Privileged communications with registered geographical indication agent

33. (1) All communications made between a registered geographical indication agent and the person who appoints and authorizes the agent in matters relating to geographical indications, and any

record or document made for the purposes of such communications, are privileged to the same extent as communications between a solicitor and his client.

(2) A registered geographical indication agent has, in relation to documents and property of the person who appoints and authorizes the agent in a matter relating to geographical indication, the same right of lien that a solicitor has in relation to the documents and property of a client.

PART IX

OFFENCE

Falsely applying registered geographical indication to goods

34. (1) For the purposes of this section and section 35, a person falsely applies a registered geographical indication to the goods if—

(a) he applies the geographical indication or any indication directly or indirectly referring to the geographical indication to the goods without the consent of the registered proprietor; and

(b) the goods are—

(i) not the genuine goods of the registered proprietor, person authorized by the registered proprietor or person who has the right to use the geographical indication under section 28; or

(ii) not in accordance with the quality, reputation or characteristic as specified in the Register.

(2) For the purposes of subsection (1)—

(a) a geographical indication or any indication directly or indirectly referring to the geographical indication is applied to the goods if it is applied directly unto the goods themselves;

(b) a geographical indication or any indication directly or indirectly referring to the geographical indication shall be deemed to have been applied to the goods if it is used in—

- (i) any sign or advertisement; or
- (ii) any invoice, catalogue, business letter, business paper, price list or other commercial documents, including any such document in any medium; and

the goods are delivered to a person pursuant to a request or order made by reference to the geographical indication as so used;

(c) a geographical indication or any indication directly or indirectly referring to the geographical indication shall be deemed to have been applied to the goods if—

- (i) it is applied to any covering, label, reel or thing in or with which the goods are sold, offered or exposed for sale or are in possession for the purpose of trade or manufacture; and
- (ii) it is used in a manner that is likely to lead persons to believe that it refers to, describes or designates the goods.

(3) Any person who falsely applies a registered geographical indication or any indication directly or indirectly referring the geographical indication to the goods under subsection (1) commits an offence and shall, on conviction, be liable—

(a) if the person is a body corporate, to a fine not exceeding fifteen thousand ringgit for each of the goods bearing the falsely applied registered geographical indication, and for a second or subsequent offence, to a fine not exceeding thirty thousand ringgit for each of the goods bearing the falsely applied registered geographical indication; or

(b) if the person is not a body corporate, to a fine not exceeding ten thousand ringgit for each of the goods bearing the falsely applied registered geographical indication or to imprisonment for a term not exceeding three years or to both, and for a second or subsequent offence, to a fine not exceeding twenty thousand ringgit for each of the goods bearing the falsely applied registered geographical indication, or to imprisonment for a term not exceeding five years or to both.

(4) For the purposes of subparagraph (2)(c)(i)—

(a) “covering” includes any stopper, glass, bottle, vessel, box, capsule, case, frame or wrapper; and

(b) “label” includes any band or ticket.

(5) In a prosecution under this section, the burden of proving the consent of the registered proprietor of the geographical indication shall be upon the accused person.

Importing or selling, etc., goods with falsely applied geographical indication

35. (1) Any person who—

(a) imports into Malaysia for the purpose of trade or manufacture;

(b) sells, or offers or exposes for sale; or

(c) has in his possession, custody or control for the purpose of trade or manufacture,

any goods to which a registered geographical indication is falsely applied under section 34, unless the person proves that having taken all reasonable precautions against committing an offence under this section, he had, at the time he allegedly committed the offence, no reason to suspect the genuineness of the geographical indication and on demand made by the Assistant Controller as defined in section 39, he gave all the information in his knowledge with respect to the persons from whom he obtained the goods, commits an offence.

(2) Any person who commits an offence under subsection (1) shall, on conviction, be liable—

- (a) if the person is a body corporate, to a fine not exceeding fifteen thousand ringgit for each of the goods with the falsely applied registered geographical indication, and for a second or subsequent offence, to a fine not exceeding thirty thousand ringgit for each of the goods with the falsely applied registered geographical indication; or
- (b) if the person is not a body corporate, to a fine not exceeding ten thousand ringgit for each of the goods with the falsely applied registered geographical indication or to imprisonment for a term not exceeding three years or to both, and for a second or subsequent offence, to a fine not exceeding twenty thousand ringgit for each of the goods with the falsely applied registered geographical indication, or to imprisonment for a term not exceeding five years or to both.

(3) For the purposes of paragraph (1)(c), a person who has in his possession three or more of the goods to which a registered geographical indication is falsely applied is deemed to have in possession the goods for the purpose of trade or manufacture.

Submission of false information to Geographical Indications Office or false entry in Register

36. Any person who—

- (a) submits or causes to be submitted any false information to the Geographical Indications Office or makes a false entry in the Register;
- (b) submits or causes to be submitted any false information in any certified copy of a document to be deposited in the Geographical Indications Office;
- (c) makes or causes to be made any false thing purporting to be a copy of an entry in the Register or to be filed with the Geographical Indications Office; or

- (d) produces or tenders or causes to be produced or tendered in evidence any document or entry under paragraph (c),

knowing or having reasons to believe that the entry, information or document is false commits an offence and shall, on conviction, be liable to a fine not exceeding fifty thousand ringgit or to imprisonment for a term not exceeding five years or to both.

Falsely representing geographical indication as registered

37. (1) Any person who—

- (a) falsely represents that a geographical indication is a registered geographical indication; or
- (b) makes a false representation as to the goods for which a geographical indication is registered,

knowing or having reason to believe that the representation is false commits an offence and shall, on conviction, be liable to a fine not exceeding ten thousand ringgit.

(2) For the purposes of this section, the use in the course of trade in Malaysia in relation to a geographical indication the word “registered” or any other word or symbol importing a reference expressly or impliedly to registration shall be deemed to be a representation as to registration under this Act unless it is shown that the reference is to a registration elsewhere than in Malaysia and that the geographical indication is in fact so registered for the goods in question.

Offence relating to disobedience to summons or refusal to give evidence

38. (1) The Registrar may, for the purposes of this Act—

- (a) summon witnesses;
- (b) receive evidence on oath; and
- (c) require the production of any document or article.

(2) Any person who disobeys the summons or request made by the Registrar under subsection (1) without any lawful excuse commits an offence and shall, on conviction, be liable to a fine not exceeding two thousand ringgit or to imprisonment for a term not exceeding three months or to both.

PART X

INVESTIGATION AND ENFORCEMENT

Chapter 1

Investigations and complaints

Interpretation

39. For the purposes of this Part—

- (a) “Controller”, “Deputy Controller” or “Assistant Controller” means the Controller, Deputy Controller or Assistant Controller of Trade Descriptions appointed under section 3 of the Trade Descriptions Act 2011 [*Act 730*]; and
- (b) “premises” means any place, stationary or otherwise, established or set up by any person, whether such place is with or without enclosure, and includes a vehicle, aircraft, ship and any other vessel.

Powers of Controller, Deputy Controller and Assistant Controller

40. (1) The Controller shall perform the duties imposed and exercise the powers conferred on him under this Part subject to the general direction and control of the Minister.

(2) The Deputy Controllers and Assistant Controllers shall be under the direction and control of the Controller.

(3) The Deputy Controllers may perform all the duties imposed and exercise all the powers conferred on the Controller.

(4) The Controller and Deputy Controllers may perform all the duties imposed and exercise all the powers conferred on the Assistant Controllers.

(5) The Controller or Deputy Controller may, in writing, delegate all or any of his powers, duties or functions under this Part to any Assistant Controller.

Power of investigation

41. (1) Where any Assistant Controller has reasonable grounds to suspect that any offence is or will be committed under this Act, the Assistant Controller may conduct such investigation as the Assistant Controller thinks expedient for the due administration of this Act.

(2) Any Assistant Controller investigating any commission of an offence under this Act may exercise all or any of the powers in relation to police investigation in seizable cases given by the Criminal Procedure Code [*Act 593*].

Complaints to Assistant Controller

42. (1) Any Assistant Controller may, upon a complaint by an interested person, conduct an investigation on any person who has committed or is committing any offence under this Act.

(2) The complaint made under subsection (1) shall specify the person against whom the complaint is made or the premises where the offence is alleged to have been committed and details of the offence which is alleged to have been committed under this Act.

(3) If the complaint made under subsection (1) is in relation to a geographical indication which is not identical with the registered geographical indication, any interested person shall obtain the Registrar's verification in the form as determined by the Registrar together with payment of the prescribed fee to be submitted to the Assistant Controller.

(4) The Registrar's verification under subsection (3) shall be *prima facie* evidence in any proceedings before any court.

Chapter 2

*Information gathering powers***Power of Assistant Controller to require provision of information**

43. (1) This section applies if any Assistant Controller in carrying out an investigation under this Act has reason to believe that any person—

- (a) has any information or any document that is relevant to the performance of the powers and functions of the Assistant Controller under this Act; or
- (b) is capable of giving any evidence which the Assistant Controller has reason to believe is relevant to the performance of the powers and functions of the Assistant Controller under this Act.

(2) Notwithstanding any provision of any other written law, the Assistant Controller may, by a written notice, direct any person—

- (a) to provide to the Assistant Controller, within the period and in the manner and form specified in the notice, any information or document referred to in subsection (1);
- (b) to produce to the Assistant Controller, within the period and in the manner specified in the notice, any information or document referred to in subsection (1), whether in physical or electronic form;
- (c) to make copies of, or extracts from, any document referred to in subsection (1) and to produce copies or extracts of such documents to the Assistant Controller within the period and in the manner specified in the notice;
- (d) if the person is an individual, to appear before the Assistant Controller at a time and place specified in the notice to give any information, either orally or in writing, and produce any document referred to in subsection (1), whether in physical or electronic form;

- (e) if the person is a body corporate or a public body, to cause a relevant and competent officer of the body to appear before the Assistant Controller at a time and place specified in the notice to give any information, either orally or in writing, and produce any document referred to in subsection (1), whether in physical or electronic form;
- (f) if the person is a partnership, to cause an individual who is a partner in the partnership or an employee of the partnership to appear before the Assistant Controller at a time and place specified in the notice to give any information, either orally or in writing, and produce any document referred to in subsection (1), whether in physical or electronic form; or
- (g) to make a statement to the Assistant Controller providing an explanation on any information or document referred to in subsection (1) within the period and in the manner and form specified in the notice.

(3) Where the Assistant Controller directs any person to produce any document under subsection (2) and the document is not in the custody of the person, the person shall—

- (a) state, to the best of his knowledge and belief, where the document may be found; and
- (b) identify, to the best of his knowledge and belief, the last person who had custody of the document and to state, to the best of his knowledge and belief, where the person may be found.

(4) Any person directed to provide any information under subsection (2) or (3) shall ensure that the information provided is true, accurate and complete and such person shall provide an express representation to that effect, including a declaration that he is not aware of any other information which would make the information provided untrue or misleading.

(5) Any person who refuses or does not comply with the direction given by the Assistant Controller under this section commits an offence and shall, on conviction, be liable to a fine not exceeding fifty thousand ringgit.

Assistant Controller may retain document

44. (1) The Assistant Controller may take and retain for such duration as he thinks necessary any document obtained under this Act.

(2) The person who provided the document is entitled to be supplied, as soon as practicable, with a copy certified by the Assistant Controller to be a true copy of the document.

(3) Notwithstanding the provisions of any other written law, the certified copy of the document shall be admissible as evidence as if it were the original document.

(4) If the Assistant Controller is satisfied that it is no longer necessary to retain the document, the Assistant Controller may return the document to the person who provided the document, as soon as practicable.

Confidentiality

45. (1) Any person who discloses or makes use of any confidential information or document with respect to a particular enterprise or the affairs of an individual obtained by virtue of any provision of this Act commits an offence and shall, on conviction, be liable to a fine not exceeding five hundred thousand ringgit.

(2) Nothing in subsection (1) shall operate to prevent the disclosure of information where—

- (a) the disclosure is made with the consent of the person from whom the information or document was obtained;
- (b) the disclosure is made in circumstances where the information provided is framed in such a manner that the source of the information could not be ascertained;
- (c) the information is already in the public domain;
- (d) the disclosure is made to facilitate the performance of the functions or powers of the Controller, Deputy Controller or Assistant Controller;

- (e) the disclosure is reasonably made during any proceedings under this Act provided that such disclosure is not made against any direction by the Controller, Deputy Controller or Assistant Controller before whom those proceedings are taking place; or
- (f) the disclosure is made in connection with the investigation of an offence under this Act.

(3) For the purposes of this section, “confidential information” means trade, business or industrial information that belongs to any person that has economic value and is not generally available to or known by others or any information which is regarded as confidential under this Act.

Privileged communication

46. (1) No person shall be required, under any provision of this Part, to produce or disclose any communication between an advocate and his client which would be protected from disclosure in accordance with section 126 of the Evidence Act 1950 [*Act 56*].

(2) The Controller may require an advocate and solicitor to provide any document under section 44.

(3) Where the document required under subsection (2) contains privileged communication made by or on behalf of or to the advocate and solicitor in his capacity as an advocate and solicitor—

- (a) the advocate and solicitor shall be entitled to refuse to comply with the requirement; or
- (b) the person to whom or by or on behalf of whom the privileged communication was made, or if the person is a body corporate that is under receivership or is in the course of being wound up, the receiver or the liquidator, as the case may be, may agree that the advocate and solicitor shall comply with the requirement.

(4) Notwithstanding paragraph (3)(b), where the advocate and solicitor refuses to comply with the requirement under subsection (2), the advocate and solicitor shall forthwith furnish in writing to the Controller the name and address of the person to whom, by or on behalf of whom the privileged communication was made.

Giving false or misleading information, evidence or document

47. Any person who does not disclose or omits to give any relevant information, evidence or document, or provides any information, evidence or document that he knows or has reason to believe is false or misleading, in the course of an investigation by the Assistant Controller, commits an offence and shall, on conviction, be liable to a fine not exceeding one hundred thousand ringgit.

Destruction, concealment, mutilation and alteration of records

48. A person who—

(a) destroys, conceals, mutilates or alters; or

(b) sends, attempts to send or conspires with any other person to remove from his premises or send out of Malaysia,

any goods, document, material, article or thing kept or maintained with intent to defraud the Assistant Controller or to prevent, delay or obstruct the carrying out of an investigation or the exercise of any power by the Assistant Controller under this Act commits an offence and shall, on conviction, be liable to a fine not exceeding one hundred thousand ringgit.

Chapter 3

*Powers of arrest, search, seizure, etc.***Power of arrest**

49. (1) Any Assistant Controller may arrest without warrant any person whom he reasonably believes has committed or is attempting to commit an offence under section 34 or 35 of this Act.

(2) Any Assistant Controller making an arrest under subsection (1) shall, without unnecessary delay, bring the person arrested to the nearest police station, and the person shall thereafter be dealt with in accordance with the law relating to criminal procedure for the time being in force.

Power to enter premises, inspect and seize goods, etc.

50. (1) Any Assistant Controller may, at all reasonable hours, exercise the following powers:

- (a) for the purpose of ascertaining whether any offence under this Act has been committed, inspect any goods, document, material, article or thing, and enter any premises other than premises used only for dwelling;
- (b) if the Assistant Controller has reasonable cause to believe that an offence under this Act has been committed, seize and detain any goods, document, material, article or thing for the purpose of ascertaining, by testing or otherwise, whether the offence has been committed;
- (c) seize and detain any goods, document, material, article or thing which the Assistant Controller has reason to believe may be required as evidence in any proceedings for an offence under this Act; and
- (d) for the purpose of exercising his powers under this subsection, seize any goods, document, material, article or thing, but only if and to the extent that it is reasonably necessary in order to secure that the provisions of this Act and of any order made under this Act are duly observed, require any person having authority to do so to break open any container or open any vending machine, and if that person does not comply with the requirement, the Assistant Controller may do so himself.

(2) An Assistant Controller seizing any goods, document, material, article or thing in the exercise of his powers under this section shall inform the person from whom the goods, document, material, article or thing is seized, and in the case of goods seized from a vending machine, the person whose name and address are stated on the machine as being the proprietor, or if no name and address are so stated, the occupier of the premises on which the machine stands or to which it is affixed.

(3) Where the goods, document, material, article or thing seized by the Assistant Controller in the exercise of his powers under this section are by reason of its nature, size or amount not practical to be removed from where the goods, document, material, article or thing is found, he may by any means seal

such goods, document, material, article or thing in the premises or container in which it is found and it shall be an offence for any person without lawful authority to break, tamper with or damage such seal or to remove such goods, document, material, article or thing or to attempt to do so.

Magistrate may issue search warrant

51. (1) Whenever it appears to a Magistrate, upon written information on oath and after such inquiry as he considers necessary, that there are reasonable grounds to believe that any person has committed or is committing an offence under this Act, so that any evidence or thing which is necessary to the conduct of an investigation into any offence may be found in any premises, the Magistrate may issue a warrant authorizing any Assistant Controller named in the warrant to enter the premises at any time, with or without assistance, and if need be by force to search for and seize any such evidence or thing.

(2) An Assistant Controller entering any premises under this section may take with him such other persons and such equipment as may appear to the Assistant Controller necessary and on leaving any premises which he has entered by virtue of a warrant under the preceding subsection the Assistant Controller shall, if the premises are unoccupied or the occupier is temporarily absent, leave them as effectively secured against trespassers as he found them.

(3) Without affecting the generality of subsection (1), the warrant issued by the Magistrate may authorize the search and seizure of any goods, document, material, article or thing which contains or is reasonably suspected to contain information as to any offence suspected to have been committed or is otherwise necessary to conduct an investigation into any offence.

(4) Subject to subsection (5), the Assistant Controller conducting a search under subsection (1) may, for the purpose of investigating into the offence, search any person who is in or on the premises.

(5) Whenever it is necessary to cause a woman to be searched, the search shall be made by another woman with strict regard to decency.

(6) The Assistant Controller making a search of a person under subsection (4) may seize, or take possession of, and place in safe custody all things other than the necessary clothing found upon the person, and any other things, in respect of which there is reason to believe that the things are the instruments or evidence of the offence, and such things may be detained until the order by the court for its disposal is obtained.

(7) If, by reason of its nature, size or amount, it is not practical to remove any goods, document, material, article or thing seized under this section, the Assistant Controller who effected the seizure shall by any means seal the premises or container in which such goods, document, material, article or thing is found.

(8) A person who, without lawful authority, breaks, tampers with or damages the seal referred to in subsection (7) or removes any goods, document, material, article or thing under seal or attempts to do so commits an offence and shall, on conviction, be liable to a fine not exceeding one hundred thousand ringgit.

Search may be made without warrant

52. If the Assistant Controller is satisfied upon information received that he has reasonable cause to believe that by reason of delay in obtaining a search warrant under section 51 the investigation would be adversely affected or evidence of the commission of an infringement or offence is likely to be tampered with, removed, damaged or destroyed, the Assistant Controller may enter the premises and exercise in, upon and in respect of the premises, all the powers referred to in section 51 in as full and ample a manner as if he were authorized to do so by a warrant issued under that section.

Access to recorded information or computerized data, etc.

53. (1) Any Assistant Controller exercising his powers under section 50, 51 or 52 shall be given access to any recorded information, or computerized or digitalized data, whether stored in a computer or otherwise.

(2) In addition to his powers under subsection (1), the Assistant Controller may—

- (a) inspect the operation of any computer and any associated apparatus or material which he has reasonable cause to suspect is or has been used in connection with that information or data; and
- (b) require—
 - (i) the person, by whom or on whose behalf the Assistant Controller has reasonable cause to suspect the computer is or has been so used in connection with the information or data; or
 - (ii) the person having charge of, or is otherwise concerned with, the operation of the computer, apparatus or material in connection with the information or data,

to provide him with such reasonable assistance as he may require for the purposes of this section.

(3) The Assistant Controller may make copies or take extracts of the recorded information, or the computerized or digitalized data, if he thinks necessary.

(4) For the purposes of this section, “access” includes being provided with the necessary password, encryption code, decryption code, software or hardware and any other means required to enable comprehension of recorded information and computerized or digitalized data.

Tipping-off

54. (1) Any person who—

- (a) knows or has reason to suspect that an Assistant Controller is acting, or is proposing to act, in connection with an investigation which is being, or is about to be, conducted under or for the purposes of this Act and discloses to any other person information or any other matter which is likely to prejudice that investigation or proposed investigation; or

- (b) knows or has reason to suspect that a disclosure has been made to an Assistant Controller and discloses to any other person information or any other matter which is likely to prejudice any investigation which might be conducted following the disclosure,

commits an offence and shall, on conviction, be liable to a fine not exceeding one hundred thousand ringgit.

(2) Nothing in subsection (1) makes it an offence for an advocate and solicitor or his employee to disclose any information or other matter—

- (a) to his client or the client's representative in connection with the giving of advice to the client in the course and for the purpose of the professional employment of the advocate and solicitor; or

- (b) to any person in contemplation of, or in connection with and for the purpose of, any legal proceedings.

(3) Subsection (2) does not apply in relation to any information or other matter which is disclosed with a view to furthering any illegal purpose.

(4) In any proceedings against a person for an offence under this section, it shall be a defence to prove that—

- (a) he did not know or suspect that the disclosure made under paragraph (1)(b) was likely to prejudice the investigation; or

- (b) he had lawful authority or reasonable excuse for making the disclosure.

(5) An Assistant Controller or any other person does not commit an offence under this section in respect of anything done by him in the course of acting in connection with the enforcement, or intended enforcement, of this Act.

Search warrant valid notwithstanding defects

55. A search warrant issued under this Act shall be valid and enforceable notwithstanding any defect, mistake or omission in the search warrant or in the application for such search warrant and any goods, document, material, article or thing seized under such search warrant shall be admissible in evidence in any proceedings under this Act.

List of things seized

56. (1) Except as provided in subsection (2), where any goods, document, material, article or thing is seized under this Part, the Assistant Controller who effected the seizure shall as soon as practicable prepare a list of the things seized and immediately deliver a copy of the list signed by him to the occupier of the premises which has been searched, or to his agent or servant, at the premises.

(2) Where the premises are unoccupied, the Assistant Controller who effected the seizure shall wherever possible post a list of the things seized conspicuously on the premises.

Forfeiture of seized goods, etc.

57. (1) Any goods, document, material, article or thing seized under this Act shall be liable to forfeiture.

(2) An order for the forfeiture or for the release of any goods, document, material, article or thing seized under this Act shall be made by the court before which the prosecution relating to it has been held and an order for the forfeiture of the goods, document, material, article or thing shall be made if it is proved to the satisfaction of the court that an offence under this Act has been committed and that the goods, document, material, article or thing was the subject matter of or was used in the commission of the offence notwithstanding that no person may have been convicted of such offence.

(3) If there is no prosecution with regard to any goods, document, material, article or thing seized under this Act, such goods, documents, material, article or thing shall be taken and deemed to be forfeited at the expiration of one calendar month from the date of seizure unless a claim to such goods, document, material, article or thing is made before the date in the manner set out in subsections (4), (5) and (6).

(4) Any person asserting that he is the owner of such goods, document, material, article or thing and that it is not liable to forfeiture may personally or by his agent authorized in writing give written notice to an Assistant Controller that he claims the same.

(5) Upon receipt of the notice under subsection (4), the Assistant Controller shall refer the claim to the Controller who may direct that such goods, document, material, article or thing be released or may direct the Assistant Controller to refer the matter to a court for decision.

(6) The court to which the matter is referred shall issue a summons requiring the person asserting that he is the owner of the goods, document, material, article or thing and the person from whom it was seized to appear before the court and upon his appearance or default to appear, due service of the summons being proved, the court shall proceed to the examination of the matter and on proof that an offence under this Act has been committed and that such goods, document, material, article or thing was the subject matter or was used in the commission of such offence, shall order the same to be forfeited or may in the absence of such proof order its release to the person entitled to it.

(7) Any goods, document, material, article or thing forfeited or deemed forfeited shall be delivered to the Assistant Controller who shall dispose it in accordance with the direction of the Controller.

(8) Where any goods, document, material, article or thing seized under this Act is of a perishable nature or where the custody of such goods, document, material, article or thing involves unreasonable expense and inconvenience, such goods, document, material, article or thing may be sold by the Assistant Controller at any time and the proceeds of the sale held by the Assistant Controller to abide by the result of any prosecution or claim under this section.

Release of seized goods, etc.

58. (1) If any goods, document, material, article or thing has been seized under this Act, the Assistant Controller who effected the seizure may release the goods, document, material, article or thing to the person as he determines to be lawfully entitled to it, if he is satisfied that the goods, document, material, article or thing is not otherwise required for the purposes of any proceedings under this Act, or for the purpose of any prosecution under any other written law, and in such event neither the Assistant Controller effecting the seizure, nor the Government, the Controller or any person acting on behalf of the Government or the Controller shall be liable to any proceedings by any person if the seizure and the release of the goods, document, material, article or thing had been effected in good faith.

(2) A record in writing shall be made by the Assistant Controller effecting the release of anything under subsection (1) specifying in detail the circumstances of, and the reason for, the release, and he shall send a copy of such record to the Public Prosecutor within seven days of the release.

No cost or damages arising from seizure to be recoverable

59. No person shall, in any proceedings before any court in respect of any goods, document, material, article or thing seized under this Act, be entitled to the costs of such proceedings or to any damages or other relief unless such seizure was made without reasonable cause.

Obstruction

60. Any person who—

- (a) refuses to give any Assistant Controller access to any premises which the Assistant Controller is entitled to have under this Act or in the execution of any duty imposed or power conferred by this Act; or

- (b) assaults, obstructs, hinders or delays any Assistant Controller in effecting any entry which the Assistant Controller is entitled to effect under this Act or in the execution of any duty imposed or power conferred by this Act,

commits an offence and shall, on conviction, be liable to a fine not exceeding one hundred thousand ringgit.

Evidence of agent provocateur is admissible

61. (1) Notwithstanding any rule of law or the provisions of this Act or any other written law to the contrary, no agent provocateur shall be presumed to be unworthy of credit by reason only of his having attempted to abet or abetted the commission of an offence by any person under this Act if the attempt to abet or abetment was for the sole purpose of securing evidence against such person.

(2) Notwithstanding any rule of law or the provisions of this Act or any other written law to the contrary, any statement, whether oral or in writing, made to the agent provocateur by any person who subsequently is charged with an offence under this Act shall be admissible as evidence at his trial.

Taking of samples

62. (1) Where goods, documents, materials, articles or things which are the subject matter of an offence under this Act are found in two or more packages or receptacles of the same description, it shall be presumed until the contrary is proved that all the packages or receptacles contain goods, documents, materials, articles or things of the same nature, quantity and quality.

(2) Where packages or receptacles containing goods, documents, materials, articles or things which contravene the provisions of this Act or are otherwise liable to seizure have been seized, it shall be sufficient only to open and examine one per centum or not less than five samples, whichever is the lesser, of the contents of each package or receptacle seized.

(3) The court shall presume that the remaining samples contained in the package or receptacle are of the same nature as those samples examined.

Jurisdiction to try offences

63. Notwithstanding anything to the contrary in any written law, a Sessions Court shall have jurisdiction to try any offence under this Act and to impose the full punishment for any such offence.

Institution of prosecution

64. No prosecution for an offence under this Act shall be instituted except by or with the written consent of the Public Prosecutor.

Compounding of offences

65. (1) The Minister may, with the approval of the Public Prosecutor, make regulations prescribing—

- (a) any offence under this Act as an offence which may be compounded; and
- (b) the method and procedure for compounding such offence.

(2) The Controller may, with the consent in writing of the Public Prosecutor, at any time before a prosecution is being instituted, compound any offence which may be compounded by making a written offer to the person reasonably suspected of having committed the offence to compound the offence upon payment to the Controller of a sum of money not exceeding fifty per centum of the amount of the maximum fine to which the person would have been liable to if he had been convicted of the offence, within such time as may be specified in the written offer.

(3) The written offer under subsection (2) may be made at any time after the offence has been committed but before any prosecution for it has been instituted, and where the amount specified in the written offer is not paid within the time specified in the written offer, or such extended time as the Controller may grant, the prosecution for the offence may be instituted at any time after that against the person to whom the written offer was made.

(4) Where an offence has been compounded under subsection (2), no prosecution shall be instituted in respect of the offence against the person to whom the offer to compound was made, and the Controller may forfeit or return the goods, document, material, article or thing seized in connection with the offence, subject to such terms as the Controller thinks fit.

(5) All sums of money received by the Controller under this section shall be paid into and form part of the Federal Consolidated Fund.

Principal liable for acts of servant or agent

66. Where the servant or agent of a person commits an offence or does anything or omits to do anything which if done or omitted to be done by that person would constitute an offence under this Act, that person shall, notwithstanding that he has no knowledge of the offence, be deemed to be guilty of the offence and shall be liable to punishment for the offence unless he proves that—

- (a) the act or omission complained of was not within the ordinary scope of the employment of the servant or of the agency of the agent; or
- (b) the act or omission complained of was done or omitted to be done without his consent or connivance and that he exercised all such diligence to prevent the commission or omission as he ought to have exercised having regard to all the circumstances of the case.

Offences committed by body corporate

67. (1) If a body corporate commits an offence under this Act, any person who at the time of the commission of the offence was a director, chief executive officer, chief operating officer, manager, secretary or other similar officer of the body corporate or was purporting to act in any such capacity or was in any manner or to any extent responsible for the management of any of the affairs of the body corporate or was assisting in such management—

- (a) may be charged severally or jointly in the same proceedings with the body corporate; and

(b) if the body corporate is found guilty of the offence, shall be deemed to be guilty of that offence unless, having regard to the nature of his functions in that capacity and to all circumstances, he proves—

(i) that the offence was committed without his knowledge, consent or connivance; and

(ii) that he had taken all reasonable precautions and exercised due diligence to prevent the commission of the offence.

(2) If any person would be liable under this Act to any punishment or penalty for his act, omission, neglect or default, he shall be liable to the same punishment or penalty for every such act, omission, neglect or default of any employee or agent of his, or of the employee of the agent, if the act, omission, neglect or default was committed by—

(a) that person's employee in the course of his employment;

(b) the agent when acting on behalf of that person; or

(c) the employee of the agent in the course of his employment by the agent or otherwise on behalf of the agent acting on behalf of that person.

Protection of Controller, Deputy Controller, Assistant Controller and other persons

68. No action, suit, prosecution or other proceedings shall be brought, instituted or maintained in any court against—

(a) the Controller, Deputy Controller or Assistant Controller in respect of any act ordered or done for the purpose of carrying into effect of this Act; and

(b) any other person in respect of any act done or purported to be done by him under the order, direction or instruction of the Controller,

if the act was ordered or done in good faith and in a reasonable belief that it was necessary for the purpose intended to be served by it.

PART XI

LEGAL PROCEEDINGS IN COURT, COSTS AND EVIDENCE

Service of application, order or judgment on Registrar

69. (1) A copy of every application to the Court relating to an application for the registration of a geographical indication or a registered geographical indication in the proceedings including an appeal from such application shall be served on the Registrar by the parties to the application in the manner as determined by the Registrar within the prescribed period together with payment of the prescribed fee.

(2) Upon receipt of a copy of the application including an appeal under subsection (1), the Registrar may change the status of the application for registration of the geographical indication or the registered geographical indication as the Registrar thinks fit, subject to further condition, direction, instruction, order or judgment of the court.

(3) Any order or judgment made by the court upon the completion of the application including an appeal filed under subsection (1) shall be served on the Registrar in the manner as determined by the Registrar together with payment of the prescribed fee by the parties in whose favour the order or judgment is made or given.

(4) Upon receipt of the order or judgment under subsection (3), if the Registrar considers that publicity should be given upon giving effect to the order or judgment of the court, the Registrar may make a publication relating to the giving effect to the order or judgment of the court in the Intellectual Property Official Journal.

Registrar not to be made party to certain proceedings

70. In the absence of a cause of action against the Registrar, the Registrar shall not be made a party to the following proceedings:

- (a) proceedings against certain uses of geographical indication under section 77;
- (b) cancellation of registered geographical indication by the Court under section 23; or
- (c) any appeal against the decision of the Registrar in relation to the matters specified under subsection 96(1).

Appearance of Registrar in proceedings before Court

71. (1) In any legal proceedings before the Court which involves an application for cancellation of a registered geographical indication, the Registrar shall have the right to appear and be heard, and shall appear if so directed by the Court.

(2) Unless otherwise directed by the Court, the Registrar, in lieu of appearing and being heard, may submit to the Court a statement in writing and signed by him, giving the particulars of the proceedings before the Registrar in relation to the matter in issue or the grounds of any decision given by the Registrar affecting the same or of the practice of the Registrar's office in like cases, or of such other matters relevant to the issues, and within his knowledge as Registrar, as he thinks fit, and such statement shall be deemed to form part of the evidence in the proceedings.

Costs of proceedings before court

72. In all proceedings before any court, the court may, in its discretion, award any party including the Registrar such costs as it may consider reasonable but the Registrar shall not be ordered to pay the costs of any party.

Certificate of validity

73. (1) In any legal proceedings in which the validity of a registered geographical indication comes into question and is decided in favour of the registered proprietor, the Court may certify to that effect, and if it so certifies then in any subsequent legal proceedings in which the validity of the registration comes into question, the registered proprietor on obtaining a final order or judgment in favour of himself, shall be awarded his full costs, charges or expenses as between a solicitor and his client, unless in the subsequent proceedings the Court certifies that the registered proprietor shall not be awarded the full costs, charges or expenses.

(2) Upon receiving such certification from the Court under subsection (1), the Registrar shall record such certification upon request by the registered proprietor in the form as determined by the Registrar together with payment of the prescribed fee.

Evidentiary value of copies certified by Registrar

74. A copy of or extract from any form or document filed at the Geographical Indication Office which the Registrar certified to be a true copy or extract signed and sealed by the Registrar shall be admissible in evidence in any proceedings as of equal validity with the original document.

Sealed copies of document to be evidence

75. (1) Any printed or written copy of or extract from the Register purporting to be certified as a true copy or extract by the Registrar and signed by the Registrar and sealed with his seal, shall be admissible in evidence in any proceedings before any court without further proof or production of the original.

(2) A certificate of registration of a geographical indication shall be admissible in evidence in any proceedings before any court without further proof or production of the original.

(3) A certificate purporting to be under the hand of the Registrar as to any act which the Registrar is authorized to perform and which he has or has not performed shall be *prima facie* evidence in any proceedings before any court of him having or not having performed the act.

(4) No person in the employment of the Corporation shall be required to attend court for the purpose of producing any document relating to an application for registration of a geographical indication or a registered geographical indication which may be obtained under the provisions of this Act.

(5) Subject to any condition as determined by the Registrar, any person may request for any document under subsection (1) or (3) by filing a request in the form as determined by the Registrar together with payment of the prescribed fee.

Electronic form, etc., certified by Registrar admissible in evidence

76. (1) Any form, information or document filed with the Registrar or issued by the Registrar, electronically, shall be—

- (a) a true copy of the form, information or document filed with the Registrar as required under this Act; and
- (b) *prima facie* evidence of matters specified in the form, information or document.

(2) Subject to any condition as determined by the Registrar, any person may request for any document under subsection (1) by filing a request in the form as determined by the Registrar together with payment of the prescribed fee.

PART XII**PROTECTION FOR GEOGRAPHICAL INDICATION****Institution of proceedings against certain uses of geographical indication**

77. (1) Subject to the provisions of this Act, any interested person of goods identified by a geographical indication may institute Court proceedings against any person for carrying out an act to which this section applies in relation to the geographical indication.

(2) This section shall apply to the following acts:

- (a) the use in the course of trade of a geographical indication by any means in the designation or presentation of any goods that indicates or suggests, in a manner which misleads the public as to the geographical origin of the goods, that the goods in question originate in a geographical area other than the true place of origin of the goods;
- (b) any use in the course of trade of a geographical indication which constitutes an act of unfair competition within the meaning of Article 10*bis* of the Paris Convention for the Protection of Industrial Property of 20 March 1883, as revised or amended from time to time, as specified in the Schedule;

- (c) any use in the course of trade of a geographical indication identifying wines for wines not originating in the place indicated by the geographical indication in question or a geographical indication identifying spirits for spirits not originating in the place indicated by the geographical indication in question, even if the true origin of the wines or spirits is indicated or the geographical indication is used in translation or accompanied by expressions such as “kind”, “type”, “style” or “imitation” or any similar word or expression.

(3) Any use in the course of trade of a geographical indication within the meaning of subsection (2) shall be deemed to be an act to which this section applies, even if the geographical indication is literally true as to the geographical origin of the goods in question, provided that such use falsely represents to the public that the goods originate in another country, territory, region or locality.

(4) For the purposes of subsection (2), “use in the course of trade of a geographical indication” includes the use of a trademark which contains or consists of the geographical indication in question.

(5) This section shall apply to any use of a registered geographical indication which identifies any goods, other than a wine or spirit, belonging to a category of goods, in relation to any goods which are of the same category as that goods, but which did not originate in the place indicated by the registered geographical indication in question, even if the true origin of those goods is indicated or the geographical indication is used in translation or accompanied by any expressions such as “kind”, “type”, “style” or “imitation” or any similar word or expression.

(6) Any use of a registered geographical indication within the meaning of subsection (5) shall be deemed to be an act to which this section applies, even if the geographical indication is literally true as to the geographical origin of the goods in question, provided that such use falsely represents to the public that the goods originate in another country, territory, region or locality.

(7) Subsection (5) shall not apply to the use of a registered geographical indication to identify an ingredient of any goods, if the geographical indication is literally true as to the geographical origin of the ingredient in question, provided that such use does not falsely represent to the public that the goods originate in the place indicated by the geographical indication.

- (8) In an action under this section, the Court may grant—
- (a) an injunction subject to such conditions as the Court deems fit; or
 - (b) in any case to which subsection (5), (6) or (7) applies—
 - (i) an award of damages or account of profits; and
 - (ii) any other legal remedies or reliefs as the Court deems fit.

Homonymous geographical indication

78. (1) Any interested person of any goods identified by homonymous geographical indication may institute Court proceedings against any person for carrying out any act under section 77.

(2) Any interested person of any goods identified by homonymous geographical indication may, where no practical conditions in respect of the homonymous geographical indication have been imposed by the Registrar under section 11, apply to the Court for a declaration of the practical conditions under which the homonymous geographical indications are to be differentiated from each other, taking into account the need to ensure equitable treatment of the interested parties concerned and that the public are not misled.

PART XIII

EXCEPTIONS

Chapter 1

Exceptions in respect of geographical indication

Exception for certain uses of geographical indication

79. (1) Section 77 shall not apply to the use of a geographical indication—

- (a) which is contrary to public order or morality in Malaysia;
- (b) which is not or has ceased to be protected in its country or territory of origin;

- (c) in relation to any goods or services which is identical with the term customary in the common language as the common name of the goods or services in Malaysia;
- (d) which is identical with the customary name of a grape variety existing in Malaysia as of 1 January 1995, with respect to products of the vine of that grape variety; or
- (e) which is not registered under this Act, and which has fallen into disuse in its country or territory of origin.

Exception for failure to take action

80. (1) No action under section 77 shall be brought against any person for the use of a trademark which contains or consists of a geographical indication after the expiry of five years—

- (a) from the date of such use by the person or his predecessor in title has become generally known in Malaysia; or
- (b) from the date of registration of the trademark by the person under the Trademarks Act 2019,

whichever is earlier.

(2) Subsection (1) shall not apply where the trademark was used or registered in bad faith.

Exception for prior use

81. (1) Section 77 shall not apply to the use by a qualified person of a particular geographical indication of another country identifying wines or spirits in relation to any goods or services if the qualified person has, or he and his predecessor in title have, continuously used that geographical indication in Malaysia in relation to those goods or services or related goods or services either—

- (a) for at least ten years before 15 April 1994; or
- (b) in good faith before 15 April 1994.

(2) Section 77 shall not apply to the use by a person of a trademark which is identical or similar to a geographical indication if—

- (a) the application for the registration of the trademark was made in good faith, or the trademark was registered in good faith, under the Trade Marks Act 1976; or
- (b) he has, or he and his predecessor in title have, continuously used that trademark in good faith in Malaysia in the course of trade,

either before 15 August 2001 or before the geographical indication in question is protected in its country or territory of origin.

Exception for use of personal name

82. Section 77 shall not apply to the use in the course of trade by any person of that person's name or the name of that person's predecessor in business except where such name is used in such a manner as to mislead the public.

Chapter 2

Exceptions in respect of registered geographical indication

Exception for certain uses of registered geographical indication

83. Section 77 shall not apply to the use in the course of trade of—

- (a) any name contained in a registered geographical indication in relation to any goods or services where the name is identical with the term customary in common language to describe such goods or services in Malaysia; or
- (b) any individual component contained in the registered geographical indication where the individual component is identical to a term customary in the common language as the common name of any goods or services in Malaysia.

Exception for prior uses of registered geographical indication and trademark

84. (1) Section 77 shall not apply to the use by a qualified person of a registered geographical indication identifying any goods, other than wine and spirit, in relation to any goods or services if the qualified person has, or he and his predecessor in title have, continuously used that geographical indication in relation to those goods or services or related goods or services in Malaysia either—

(a) for at least ten years before the commencement of this Act; or

(b) in good faith before the commencement of this Act.

(2) Section 77 shall not apply to the use of a trademark which is identical or similar to a registered geographical indication if—

(a) the trademark is a registered trademark or protected international registration designating Malaysia, and taking into account, where appropriate, any priorities claimed in respect of the trademark under the Trademarks Act 2019—

(i) the application for the registration of the trademark was made in good faith; or

(ii) the trademark was registered in good faith,

under the Trademarks Act 2019 relating to trademark before the date of application for registration of the geographical indication in Malaysia; or

(b) he has, or he and his predecessor in title have, continuously used the trademark in good faith in Malaysia in the course of trade, before the date of the application for registration of the geographical indication in Malaysia.

(3) Section 77 shall not apply to the use by a person of a trademark which is identical or similar to a registered geographical indication if—

(a) the trademark is, before the date of the application for registration of the geographical indication in Malaysia, a well-known trademark in Malaysia; and

- (b) the application of section 77 to the use of the trademark is liable to mislead consumers as to the true identity of the goods identified by the geographical indication.

PART XIV

MISCELLANEOUS AND GENERAL

Intellectual Property Official Journal

85. (1) The Registrar shall publish an Intellectual Property Official Journal which shall contain—

- (a) all matters relating to geographical indication which are required to be published under this Act; and
- (b) any information relating to geographical indication as the Registrar thinks necessary.

(2) The Registrar shall make available the Intellectual Property Official Journal to any person upon payment of the prescribed fee.

(3) Publication in the Intellectual Property Official Journal shall constitute sufficient notice of any matter required to be published under this Act.

(4) A copy of the Intellectual Property Official Journal shall, on its production, be admitted in legal proceedings as evidence without further proof being given that the copy was so published.

(5) A copy of the Intellectual Property Official Journal shall be *prima facie* evidence of the facts stated therein.

(6) Where the Intellectual Property Official Journal is published in more than one form, the date that the Intellectual Property Official Journal is first published in any form shall be deemed to be the date of publication of the Intellectual Property Official Journal.

Electronic filing

86. (1) The Registrar may provide a service for the electronic filing of any document required to be filed with the Registrar under this Act.

(2) A document electronically filed under this section shall be deemed to have satisfied the requirement for filing if the document is communicated or transmitted to the Registrar in such manner as determined by the Registrar.

(3) A document that is required to be stamped, signed or sealed shall, if the document is to be electronically filed, be certified to be true copy or authenticated in such manner as determined by the Registrar.

(4) Where a document that is required to be signed and attested under this Act is to be filed electronically, the requirement for attestation of the signature does not apply.

(5) If a document is electronically filed with the Registrar, the Registrar shall not be liable for any loss or damage suffered by any person by reason of any error or omission of whatever nature or howsoever occurring, arising or appearing in any document obtained by any person under the service referred to in subsection (1), if such error or omission occurred, arose or appeared as a result of any defect or breakdown in the service or in the equipment used for the provision of the service or without the knowledge of the Registrar.

Issuing document electronically

87. The Registrar may, by electronic means, issue a document which is to be issued by the Registrar under this Act.

Address for service

88. (1) For the purposes of this Act, an applicant, any person who opposes the registration of a geographical indication or any other person who is involved in any proceedings before the Registrar, who is residing or carrying on business principally in Malaysia, shall furnish an address for service in Malaysia with the Registrar in the manner as determined by the Registrar together with payment of the prescribed fee.

(2) The address furnished with the Registrar under subsection (1) shall be entered into the Register or the record of Registrar and shall be deemed to be the address for service of the person under subsection (1) for all the proceedings before the Registrar.

(3) An applicant, any person who opposes the registration of a geographical indication or any other person who is involved in any proceedings before the Registrar may request to change the address for service in the form as determined by the Registrar within the prescribed period.

(4) Upon receipt of the request for change in subsection (3) together with payment of the prescribed fee, the Registrar shall change the address for service of the person under subsection (1).

(5) The Registrar may refuse to proceed with the application or registration of a geographical indication if the address for service as stated in subsection (1) is not furnished.

(6) If the person stated in subsection (1) is not residing or carrying on business principally in Malaysia, the address for service of his registered geographical indication agent shall be entered into the Register or the record of Registrar and shall be deemed to be the address for service of the person under subsection (1) for all proceedings before the Registrar.

Power of Registrar to allow amendment of document

89. (1) Any applicant, any person who opposes the registration of a geographical indication or any other person who is involved in any proceedings before the Registrar may apply to the Registrar in the form as determined by the Registrar together with payment of the prescribed fee to amend any clerical error or any mistake in—

- (a) an application for the registration of a geographical indication;
- (b) a notice of opposition;
- (c) a counterstatement; or
- (d) any other document as the Registrar thinks fit.

(2) The Registrar may, on such terms as the Registrar thinks just, allow the amendment applied under subsection (1) if the amendment—

- (a) does not in any way extend the rights given by the existing registration of the geographical indication; or
- (b) does not substantially affect the content of the documents filed with the Geographical Indication Office.

Power of Registrar to allow extension of time

90. (1) Where, in any proceedings before the Registrar, a time is specified within which an act or thing is to be done, the Registrar may, unless otherwise expressly provided under this Act or directed by the Court, upon application by the person or by his registered geographical indication agent in the form as determined by the Registrar together with payment of the prescribed fee, extend the time before its expiration.

(2) Where by reason of—

- (a) an error or omission by the person or by his registered geographical indication agent;
- (b) circumstances beyond the control of the person or his registered geographical indication agent; or
- (c) an error or action on the part of the Geographical Indication Office,

an act, in relation to an application for the registration of a geographical indication or in proceedings before the Registrar, is required to be done within a certain time has not been so done, the Registrar may extend the time for doing the act even though that time has expired.

Reinstatement

91. (1) Any person whose—

- (a) application is deemed to be withdrawn; or

- (b) right has been abrogated, or thing has ceased to be in force or to exist, by reason that he has failed to comply with any procedural requirement in any proceedings or other matters before the Registrar within the time as specified or prescribed under the Act or as determined by the Registrar for complying with that requirement,

may make a request to the Registrar for the reinstatement of the application, right or thing, as the case may be, within the period and in the manner as determined by the Registrar together with payment of the prescribed fee.

(2) The Registrar may require the person to justify his request for reinstatement made under subsection (1) by providing any further information as the Registrar thinks necessary.

(3) If the Registrar allows the request for such reinstatement, the Registrar shall publish a notification in the Intellectual Property Official Journal that the application, right or thing has been reinstated.

Mode of giving evidence

92. (1) For the purposes of subsection 38(1), in all proceedings before the Registrar, all evidence shall be given by statutory declarations in the absence of direction to the contrary but in any case in which the Registrar thinks fit, the Registrar may take evidence *viva voce* in lieu of or in addition to evidence by statutory declarations.

(2) Any such statutory declaration may, in the case of an appeal, be used before the Court in lieu of evidence by affidavit, but if so used, shall have all the same evidentiary value and effect as evidence by affidavit.

(3) In any action or proceedings relating to a geographical indication, the Registrar or the Court, as the case may be, shall admit as evidence the practices and usages of the trade concerned or the business practices and usages in the provision of the services in question, and any relevant geographical indication or trade name or business name or get-up legitimately used by other persons.

Exercise of discretionary power

93. Where any discretionary power is given to the Registrar by this Act, he shall not exercise the power to adversely affect the applicant for the registration of a geographical indication or the registered proprietor of a geographical indication in question without, if duly required to do so within the period as specified in any written notice, giving to the applicant or registered proprietor, as the case may be, an opportunity to be heard.

Costs awarded by Registrar

94. (1) In all proceedings before the Registrar, the Registrar shall have the power to award to any party such costs including taxation of the costs as he may consider reasonable and to direct how and by what parties they are to be paid, and any such order may, by leave of the Court, be enforced in the same manner and to the same effect as a judgment or order of the Court.

(2) A party to any proceedings before a Registrar who is desirous to obtain the costs or to have the costs taxed shall apply to the Registrar in the prescribed manner.

(3) The costs awarded by the Registrar under subsection (1) may, in default of payment, be recovered in a court of competent jurisdiction as a debt.

Guidelines or practice directions by Registrar

95. (1) The Registrar may issue guidelines or practice directions to any person in relation to any provision of this Act as the Registrar thinks necessary.

(2) The guidelines or practice directions issued by the Registrar under this section shall be published in the Intellectual Property Official Journal and shall be effective from the date as specified in the guidelines or practice directions.

(3) Any person who is specified in the provisions of this Act shall comply with the guidelines and practice directions.

(4) The Registrar may amend the whole or any part of any guidelines or practice directions issued under this section.

(5) Subsections (2) and (3) shall apply in respect of any amendment of the guidelines or practice directions made under subsection (4).

(6) Any person, applicant or registered proprietor who does not comply with any guidelines or practice directions issued by the Registrar, where such guidelines or practice directions are applicable to the person, applicant or registered proprietor—

- (a) is deemed to have failed to fulfil the requirements as required by the Registrar which renders the application as withdrawn, lapsed, refused, cancelled or any other status as determined by the Registrar; or
- (b) commits an offence and shall, on conviction, be liable to a fine not exceeding ten thousand ringgit.

Appeal from decision of Registrar

96. (1) Notwithstanding any provision in any written law in relation to judicial review, any person aggrieved by a decision of the Registrar in relation to the following matters may appeal to the Court:

- (a) decision of the Registrar under section 9 as to whether any goods falls within a category of goods set out in the guidelines or practice directions under section 95;
- (b) decision of the Registrar on the practical conditions differentiating a homonymous geographical indication from the earlier geographical indication under section 11;
- (c) decision of the Registrar relating to examination of application under paragraph 12(5)(b);
- (d) decision of the Registrar not to allow any amendment of an application for registration of the geographical indication under section 15;
- (e) decision of the Registrar relating to opposition proceedings under subsection 16(11);

- (f) decision of the Registrar not to allow any correction under section 21;
- (g) decision of the Registrar not to allow any voluntary cancellation under section 22;
- (h) decision of the Registrar relating to the transfer of the registration of a registered geographical indication to another person under section 26;
- (i) decision of the Registrar relating to the registration of a geographical indication agent under section 31;
- (j) decision of the Registrar not to allow any amendment of document under section 89.

(2) The procedures of appeal under subsection (1) shall be made in accordance with the rules of court in civil matters.

Rights under other laws unaffected

97. Nothing in this Act shall affect the rights of a person under the Trademarks Act 2019.

Power to make regulations

98. (1) Subject to the provisions of this Act, the Minister may make regulations for the purpose of carrying into effect the provisions of this Act.

(2) In particular and without prejudice to the generality of subsection (1), such regulations may provide for the following purposes:

- (a) to regulate the procedure, other than the procedure relating to proceedings before the Court or connected therewith, under this Act including service of documents;
- (b) to classify goods for the purposes of registration of geographical indications;

- (c) to provide for all matters relating to registration of geographical indications including renewal of registered geographical indications;
- (d) to provide for all matters relating to voluntary cancellations or cancellations of registered geographical indications or corrections of the Register;
- (e) to secure and regulate the publishing and selling or distributing of copies of extracts of geographical indications and other documents from the Register or the record of Registrar;
- (f) to prescribe the fees to be paid in respect of any matter or thing required for the purposes of this Act;
- (g) to regulate all matters relating to registered geographical indication agents;
- (h) to regulate generally on matters pertaining to the business operation relating to geographical indications carried on in the Geographical Indications Office and its branch offices whether or not specifically prescribed under this Act but so as not to be inconsistent with any of the provisions of this Act;
- (i) to regulate the use of geographical indications including how the geographical indications are applied to or applied in relation to goods;
- (j) to regulate matters relating to the use of geographical indications on the internet;
- (k) to provide for the manner and effect of a cancellation and for protecting the interests of other persons having a right in the registered geographical indications;
- (l) to prescribe the entry, particulars or matters to be entered into the Register or the record of Registrar.

(3) Subject to the provisions of this Act, the Rules Committee constituted under the Courts of Judicature Act 1964 [Act 91] may make rules of court regulating the practice and procedure in relation to proceedings before the Court or connected therewith and the costs of the proceedings.

Power to amend Schedule

99. The Minister may, by order published in the *Gazette*, amend the Schedule to this Act.

PART XV

REPEAL, SAVING AND TRANSITIONAL

Repeal, saving and transitional

100. (1) The Geographical Indications Act 2000 is repealed.

(2) Notwithstanding the repeal of the Geographical Indications Act 2000 under subsection (1)—

- (a) any appointment made under the repealed Act shall, on the date of coming into operation of this Act, continue in force and have effect as if the appointment had been made under this Act;
- (b) all decisions, directions and notices made or issued under the repealed Act shall, to the extent that the decisions, directions and notices are consistent with this Act, on the date of coming into operation of this Act, continue in force until such decisions, directions and notices are revoked or amended;
- (c) any registration and any matter relating to it made under the repealed Act and is in force immediately before the date of coming into operation of this Act shall, subject to the terms, conditions, limitations and the duration of validity specified in the certificate of registration, on the date of coming into operation of this Act, continue in force and have the like effect as if the certificate of registration had been issued under this Act and the Registrar or Court may correct, renew or cancel the registration in accordance with the powers conferred upon him or it by the relevant provisions of this Act;

- (d) any matter required to be advertised under the provisions of the repealed Act which is pending publication in the *Gazette* before the date of coming into operation of this Act shall, on the date of coming into operation of this Act, be published in the Intellectual Property Official Journal and such matter shall be deemed to have been advertised under the repealed Act; and
- (e) any registration of geographical indication agent under the repealed Act and is in force immediately before the date of coming into operation of this Act shall, on the date of coming into operation of this Act, continue to be in force and have effect as if the registration had been made under this Act and the Registrar may renew or cancel the registration of a geographical indication agent in accordance with the powers conferred upon him by the relevant provisions of this Act.

(3) Any matter which is required to be advertised under the provisions of the repealed Act and published in the *Gazette* before the date of coming into operation of this Act—

- (a) shall be deemed to have been published in the Intellectual Property Official Journal and section 85 of this Act shall apply accordingly without prejudice to any other written law; and
- (b) shall continue to remain in force until otherwise published in the Intellectual Property Official Journal.

(4) Any application for registration of a geographical indication under the repealed Act which is pending on the date of coming into operation of this Act shall be dealt with under the repealed Act, and if registered, the geographical indication shall be treated for the purposes of this Act as a registered geographical indication.

(5) Any geographical indication registered under the repealed Act and is in force immediately before the date of coming into operation of this Act shall, on the date of coming into operation of this Act, subject to the provisions of this Act, be a registered geographical indication for the purposes of this Act.

(6) Section 19 of this Act shall, on the date of coming into operation of this Act, apply to any geographical indication registered under the repealed Act of which the renewal of the registration of the geographical indication falls due on or after the date of coming into operation of this Act.

(7) For the purposes of subsection (6), the requirement for the renewal of the registration of the geographical indication under this Act shall apply regardless that the renewal fee has been paid before the date of coming into operation of this Act.

Guidelines, etc., on transitional matters

101. The Registrar may issue guidelines or practice directions to provide for any matters in force before the date of coming into operation of this Act to be dealt with in such a manner as to bring the matters in conformity with this Act.

SCHEDULE

[Paragraph 77(2)(b)]

THE PARIS CONVENTION FOR THE PROTECTION OF INDUSTRIAL
PROPERTY OF 20 MARCH 1883

Article 10*bis*

[Unfair Competition]

(1) The countries of the Union are bound to assure to nationals of such countries effective protection against unfair competition.

(2) Any act of competition contrary to honest practices in industrial or commercial matters constitutes an act of unfair competition.

(3) The following in particular shall be prohibited:

1. all acts of such a nature as to create confusion by any means whatever with the establishment, the goods, or the industrial or commercial activities, of a competitor;
2. false allegations in the course of trade of such a nature as to discredit the establishment, the goods, or the industrial or commercial activities, of a competitor;
3. indications or allegations the use of which in the course of trade is liable to mislead the public as to the nature, the manufacturing process, the characteristics, the suitability for their purpose, or the quantity, of the goods.