

## Judicial Symposium on Intellectual Property/TOKYO 2017

### IP Dispute Resolution in ASEAN Plus Three (Japan-China-Republic of Korea)

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※「英文条文を参照」と記載のある箇所は、英語資料の該当部分を参照されたい。

#### 問1

はい。ブルネイ・ダルサラーム国においては、商標侵害は、民事手続及び刑事手続の双方において処罰される。

#### 「登録商標により与えられる権利」

第 12 (2)条は、「商標権者の権利は、登録出願書類の提出日から生じる。ただし、(a) 侵害訴訟は、商標が実際に登録された日より前には開始できない。また、(b) 登録の公示日前にされたあらゆる行為は、第 94 条の犯罪を構成しない。」と規定している。

#### 「登録商標の侵害」

第 13 (1)条は、「商取引の過程において、指定商品又は指定役務と同一の商品又は役務に関し、登録商標と同一の標示を使用した者は、登録商標を侵害したことになる。」と規定している。

#### 民事手続に関して：

商標法第 98 章第 16 条から第 22 条（英文条文を参照）。「民事事件においては、商標権者は、商標侵害行為に対して訴訟を提起できる。（第 16 (1)条）」「侵害訴訟において、商標権者は、他の一切の財産権に認められているのと同様に、損害賠償、差止命令、利益の返還又はその他の方法による全ての救済措置を求めることができる。（第 16 (2)条）」

#### 「侵害訴訟」

商標法第 98 章第 16 (1)条は、「商標権者は、登録商標の侵害に対し訴訟を提起できる」と規定している。商標法第 98 章第 16 (2)条によれば、「侵害訴訟において、商標権者は、他の一切の財産権に認められているのと同様に、損害賠償、差止命令、利益の返還又はその他の方法による全ての救済措置を求めることができる。」

#### 刑事手続に関して：

##### 「犯罪に関して」

商標法第 98 章第 94 条から第 103 条（英文条文を参照）。第 94 (1)条は、「自己若しくは他人の利益を図る目的で又は他人に損害を与える意図で、商標権者の同意なしに行為した者は、罪を犯したことになる。」と規定している。

ブルネイ・ダルサラーム国においては、商標侵害訴訟の件数は比較的少ない。現在までに、民事事件 3 件(International Coffee & Tea LLC v The Coffee & Tea Leaf Sdn Bhd; Winthrop Pharmaceuticals (Malaysia) Sdn Bhd v Shionogi Seiyaku Kabushiki; and

Koninklijke Philips Electronics N. V. v Aifa Sdn)及び刑事事件 2 件(Public Prosecutor v Yong Teck Sang; and Public Prosecutor v Ecoprime Networks Sdn Bhd)がブルネイ・ダルサラーム国において審理された。

#### 問 2

事前通知又は警告に関する要件はない。ただし、善意／真正な商標の使用、つまり、5年以上にわたって中断することなく使用していることは必要だと思われる。

#### 問 3

商標法第 98 章第 29 条から第 32 条（英文条文を参照）。

Sardine が、商標権者である Tuna からライセンスの許諾を受けているかどうかにより左右される。このライセンスは、許諾者が署名した書面又は会社印を押印した書面によるものでなければならない。商標法第 31 条によれば、ライセンシーは、商標権者に対し、ライセンシーの利益が影響を受ける一切の事項に関し、商標権者において侵害訴訟を提起するよう要求する権利を有する。商標権者が侵害訴訟を提起することを拒否し又は要求を受けた日から 2 か月以内に侵害訴訟を提起しない場合、ライセンシーは、商標権者が共同原告として参加することを条件として（仮処分申請の場合を除く。）、あたかも自分が商標権者であるかのように自己の名義で侵害訴訟を提起することができる。

#### 問 4

##### 「登録商標の侵害」

商標法第 98 章第 13 条は、次のとおり規定している。

- (1) 商取引の過程において、指定商品又は指定役務と同一の商品又は役務に関し、登録商標と同一の標示を使用した者は、登録商標を侵害したことになる。
- (2) 商取引の過程において、次のいずれかの方法で標示を使用した者は、登録商標を侵害したことになる。
  - (a) 標示が登録商標と同一であり、かつ、当該標示を指定商品又は指定役務と類似の商品又は役務に関連して使用した場合
  - (b) 標示が登録商標と類似し、当該標示を指定商品又は指定役務と同一又は類似の商品又は役務に関連して使用し、かつ、一般大衆を混同させる可能性（登録商標を連想させる可能性を含む。）が存在する場合
- (3) 商取引の過程において、次の方法で標示を使用した者は、登録商標を侵害したことになる。
  - (a) 商標と同一又は類似する標示であり、かつ、
  - (b) 当該標示が指定商品又は指定役務と類似しない商品又は役務との関連で用いられ、当該商標がブルネイ・ダルサラーム国において周知であり、かつ、当該標示の使用により、正当な理由なく、当該商標の顕著な特徴若しくは信用から不正に利益を得又は当該特徴若しくは信用に損害を与える場合
- (4) 本条においては、次のいずれかに該当する者は標示を使用したことになる。

- (a) 商品又はその梱包に標示を付した者
  - (b) 標示が付された商品を販売のために申し出若しくは展示した者、市場で流通させた者若しくはこれらの目的のために保管している者又は標示が付された役務の提供を申し出若しくは提供した者
  - (c) 標示が付された商品を輸入又は輸出した者
  - (d) 商業文書又は広告において標示を使用した者
- (5) 商業文書として又は商品若しくは役務の広告のため、商品へのラベル又は梱包に使用される予定である材料に登録商標を付した者は、当該標示を使用した時点で、商標権者又はライセンシーに正当に授權されたものではないことを知っていた又は信じるに足りる理由があった場合、登録商標を侵害する材料を使用した当事者として扱われなければならない。
- (6) 本条の各規定を、商標権者又はライセンシーの商品又は役務を特定する目的のために登録商標を使用することを禁止するものと解釈してはならない。  
ただし、産業上又は商業上の誠実な慣習に沿った使用以外の使用であって、当該使用が、正当な理由なく、当該商標の顕著な特徴若しくは信用から不正に利益を得又は当該特徴若しくは信用に損害を与える場合、当該使用は登録商標を侵害すると扱われなければならない。

|      |              |   |
|------|--------------|---|
| 標章 1 | 第 13 (1)条    | 商品又は役務に関連した商標と同一である = 侵害  |
| 標章 2 | 第 13 (2)(a)条 | 商標と同一であり、商品又は役務に関連して使用されている。一般大衆に混同／登録商標連想の可能性が存在する=侵害  |
| 標章 3 | 第 13 (2)(a)条 | 商標と同一であり、商品又は役務に関連して使用されている。一般大衆に混同／登録商標連想の可能性が存在する=侵害  |
| 標章 4 | 第 13 (3)(b)条 | 同一又は類似の標章が、非類似の商品・役務に使用されている。商標がブルネイにおいて周知であり、かつ、当該標章の使用が、登録商標の顕著な特徴若しくは信用から不正に利益を得又は当該特徴若しくは信用に損害を与える場合=侵害 |
| 標章 5 | 第 13 (4)条    | 商取引の過程における商品の製造、輸入、販売及び輸出のための標章の使用=侵害   |
| 標章 6 | -            | 言葉は音声的及び視覚的に異なっており、観念はが誤解を与えるものでないので、侵害に当たらない。  |
| 標章 7 | -            | 言葉は音声的及び視覚的に異なっており、観念は誤解を与えるものでないので、侵害に当たらない。   |
| 標章 8 | -            | イルカのデザインは誤解を与えるものでないので、侵害に当たらない。  |
| 標章 9 | 第 13 (2)(b)条 | この標章は登録商標と類似している。一般大衆に混同／登録商標連想の可能性が存在する=侵害   |

#### 問5

商標登録の実体審査において、ブルネイ・ダルサラーム国は、英国のガイドラインに従っている。

#### 問6

まず、世界的に有名であるとの立証が必要である。周知である場合は、周知商標保護法第98章第54条に該当する侵害であるか否かが検討される。

無名ブランドの場合には類否判断が変わる可能性がある。商標権者は、一般大衆における混同の可能性を主張し、これを立証することが必要になる可能性があり、これには、当該商標を連想させる可能性が含まれる。

日本やアメリカでのみ有名な場合も類否判断が変わる可能性がある。周知性の評価は属地的である。日本及び米国において有名でも、ブルネイ・ダルサラーム国においては必ずしも有名とは限らない。ブルネイ・ダルサラーム国において周知であることを立証することが必要である。

#### 問7

取り消される可能性がある。商標法第98章第47(1)条によれば、商標登録は、次のいずれかの理由により取り消すことができる。

- (a) 登録手続の完了日から5年間、商標権者又は許諾を受けた者が、指定商品又は指定役務に関連して、当該商標をブルネイ・ダルサラーム国において真正に使用しておらず、この不使用に関して適切な理由が存在しない場合
  - (b) 5年間連続して使用されておらず、この不使用に関して適切な理由が存在しない場合
  - (c) 商標権者の作為又は不作為の結果、当該商標が、指定商品又は指定役務の取引において、普通名称になった場合
  - (d) 商標権者又は許諾を受けた者が指定商品又は指定役務に関連して当該商標を使用した結果、大衆に誤解を生じさせた場合
- 不使用の事実は、類否判断や商標侵害に影響を及ぼす可能性がある。

#### 問8

商標の全ての登録出願は、首相府エネルギー産業省ブルネイ知的財産庁(BruIPO)が審査する。

第33(1)条「商標の登録出願は、登録官に対して行うものとする。」

第38(1)条「登録官は、商標の登録出願が本法の要件（規則が定めるものを含む。）を満たしているか否かを審査するものとする。」

裁判所は、「DolfiN」が二つの侵害被疑商標と類似しているか否かを決定するため、Tunaの主張を検討しなければならないであろう。

更に、Tunaも、ブルネイ・ダルサラーム国において周知のブランドであることを立証しなければならないであろう。

問9

Tuna は、商品標章法第 96 章に従い Bonito に対し訴訟を提起できる。ただし、Tuna は、商標を所有していると立証しなければならない。

「DolfiN」が周知商標である場合、Tuna は、周知商標保護法第 98 章第 54 条を主張できる。

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#### Q1.

Yes. In Brunei Darussalam, a trademark infringement is punishable both in the civil and criminal proceedings.

“Rights conferred by registered trade mark”

Under Section 12 (2) states that “the rights of the proprietor have effect from the date of filing of the application for registration.

Provided that —

(a) “no infringement proceedings may be begun before the date on which the trade mark is in fact registered; and (b) no offence under section 94 is committed by anything done before the date of publication of the registration. Infringement of registered trade mark”.

“Infringement of registered trade mark”

Section 13 (1) states that “a person infringes a registered trade mark if he uses in the course of trade a sign which is identical with the trade mark in relation to goods or services which are identical with those for which it is registered”. (see annex)

For civil proceedings:

Under Section 16 - Section 22 of the Trade Marks Act, Chapter 98

In civil cases, an action of infringement of trade mark is actionable by the proprietor of the trade mark (Section 16 (1)). In an action for infringement, all such relief by way of damages, injunction, account or otherwise is available to him as is available in respect of any other property rights (Section 16(2)).

“Infringement Proceedings”

Under Section 16 (1) of the Trademark Act, Cap 98 states that “An infringement of a registered trade mark is actionable by the proprietor of a trademark”

Under section 16(2) of the Trademark Act, cap 98

“ In an action for infringement, all such relief by way of damages, injunction, account or otherwise is available to him as is available in respect of the infringement of any other property right”

For criminal proceedings:

“For offences”

Under Section 94 – Section 103 of the Trade Marks Act, Chapter 98.

Section 94 (1) states that “A person commits an offence who, with a view to gain for himself or another, or with intent to cause loss to another, and without the consent of the proprietor”

In Brunei Darussalam, cases filed under trademark infringement is relatively small.

So far 3 civil cases (International Coffee & Tea LLC v The Coffee & Tea Leaf Sdn Bhd; Winthrop Pharmaceuticals (Malaysia) Sdn Bhd v Shionogi Seiyaku Kabushiki; and Koninklijke Philips Electronics N. V. v Aifa Sdn) and 2 criminal cases (Public Prosecutor v Yong Teck Sang; and Public Prosecutor v Ecoprime Networks Sdn Bhd) were heard in the Brunei Court (see annex for cases)

**Q2.**

There is no requirement for a prior public notice or warning except perhaps there must bona fide/genuine use of the mark i.e. no suspension of use of the mark for 5 years or more.

**Q3.**

Section 29 - Section 32 of the Trade Marks Act, Chapter 98

Depending on whether Sardine has been granted a licence by the Proprietor Tuna Corp. The licence must be in writing & signed by the grantor or with a company seal. Under s.31 TMA, a licensee is entitled to call on the proprietor to take infringement proceedings in respect of any matter which affects his interests. If the proprietor refuses or fails to do so within 2 months after being called upon, the licensee may bring the proceedings in his own name as if he were the proprietor with a condition that the proprietor is joined as a plaintiff except for application of Interlocutory relief.

Under section 31 of the Trade Marks Act, Chapter 98, a licensee is entitled to call on the proprietor to take infringement proceedings in respect of any matter which affects his interests. If the proprietor refuses or fails to do so within 2 months after being called upon, the licensee may bring the proceedings in his own name as if he were the proprietor with a condition that the proprietor is joined as a plaintiff except for application of Interlocutory relief.

**Q4.**

“Infringement of registered trade mark”

Section 13 of the Trade Marks Act, Chapter 98 provides that:

(1) A person infringes a registered trade mark if he uses in the course of trade a sign which is identical with the trade mark in relation to goods or services which are identical with those for which it is registered.

(2) A person infringes a registered trade mark if he uses in the course of trade a sign where because —

(a) the sign is identical with the trade mark and is used in relation to goods or services similar to those for which the trade mark is registered; or

(b) the sign is similar to the trade mark and is used in relation to goods or services identical with or similar to those for which the trade mark is registered, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the trade mark.

(3) A person infringes a registered trade mark if he uses in the course of trade a sign which —

(a) is identical with or similar to the trade mark; and

(b) is used in relation to goods or services which are not similar to those for which the trade mark is registered, where the trade mark has a reputation in Brunei Darussalam and the use of the sign without due cause takes unfair advantage of, or is detrimental to, the distinctive character or repute of the trade mark.

(4) For the purpose of this section, a person uses a sign if he —

(a) affixes it to goods or the packaging thereof;

(b) offers or exposes goods for sale, puts them on the market or stocks them for those purposes under the sign, or offers or supplies services under the sign;

(c) imports or exports goods under the sign; or

(d) uses the sign on business papers or in advertising.

(5) A person who applies a registered trade mark to material intended to be used for labelling or packaging goods, as a business paper, or for advertising goods or services, shall be treated as a party to any use of the material which infringes the registered trade mark if when he applied the mark he knew or had reason to believe that the application of the mark was not duly authorised by the proprietor or a licensee.

(6) Nothing in this section shall be construed as preventing the use of a registered trade mark by any person for the purpose of identifying goods or services as those of the proprietor or a licensee:

Provided that any such use otherwise than in accordance with honest practices in industrial or commercial matters shall be treated as infringing the registered trade mark if the use without due cause takes unfair advantage of, or is detrimental to, the distinctive character or repute of the trade mark.



|        |               |   |
|--------|---------------|---|
| Mark 1 | Sec 13 (1)    | Identical with the trade mark in relation to goods or services = infringement   |
| Mark 2 | Sec 13 (2)(a) | Identical with the trade mark and used in relation to goods or service. There is a likelihood of confusion on the part of the public/ association with the trade mark = infringement  |
| Mark 3 | Sec 13 (2)(a) | Identical with the trade mark and used in relation to goods or service. There is a likelihood of confusion on the part of the public/ association with the trade mark = infringement  |
| Mark 4 | Sec 13 (3)(b) | Identical or similar marks on non-similar goods and services if the trade mark has reputation in Brunei and the use of the sign would take unfair advantage of or is detrimental to the distinctive character or repute of the trade mark = infringement. |
| Mark 5 | Sec 13 (4)    | The use of a sign for producing, importing, selling and exporting goods in the course of trade = infringement   |
| Mark 6 | -             | It is not infringement because the language used is phonetically and visually different and concept is not misleading.  |
| Mark 7 | -             | It is not infringement because the language used is phonetically and visually different and concept is not misleading.  |
| Mark 8 | -             | It is not infringement because the design of the dolphin is not misleading.   |
| Mark 9 | Sec 13 (2)(b) | The sign is similar to the trade mark. There is a likelihood of confusion on the part of the public/ association to the trade mark = infringement   |

**Q5.**

For the purpose of substantive examination of trademark registration, Brunei Darussalam will follow the United Kingdom guidelines.

**Q6.**

Firstly it needs to show that it has a global profile. If it is well-known, consideration will be taken into account if there is an infringement under section 54 of the Protection of Well-Known Trade Marks, Chapter 98.

(For example, in cases where the trademark in this case is a totally unknown brand, will the judgment on the similarity of the trademarks be different? )

Yes, the proprietor may need to assert and prove that there is a likelihood of confusion on part of the public, which includes the likelihood of association with the trademark.

(Will the judgment on the similarity of the trademarks also be different in cases where it is famous only in the U.S. or Japan? )

Yes. Well Known assessment is territorial based. It may be famous in Japan and the United States but not necessarily in Brunei Darussalam. It is necessary for it to prove that it is well known in Brunei Darussalam.

**Q7.**

Yes. Under Section 47 (1) of the Trade Marks Act, Chapter 98

“ The registration of a trade mark may be revoked on any of the following grounds:

(a) that within the period of 5 years following the date of completion of the registration procedure it has not been put to genuine use in Brunei Darussalam, by the proprietor or with his consent, in relation to the goods or services for which it is registered, and there are no proper reasons for non-use;

(b) that such use has been suspended for an uninterrupted period of 5 years, and there are no proper reasons for non-use;

(c) that, in consequence of acts or inactivity of the proprietor, it has become the common name in the trade for a product or service for which it is registered;

(d) that, in consequence of the use made of it by the proprietor or with his consent in relation to the goods or services for which it is registered, it is liable to mislead the public.

(Even should the validity of the trademark right in this case not be affected, does no use thereof affect: 1) the judgment on the similarity between the trademark in this case and the Accused Marks;)

Yes

( 2) the judgment on whether Bonito infringes the trademark right in this case?)

Yes

**Q8.**

Yes, all application for registration of a trade mark with be examined by the Brunei Intellectual Property Office (BruIPO), Ministry of Energy and Industry, Prime Minister’s Office.

Sec 33 (1) “An application for registration of a trade mark shall be made to the Registrar”.

Sec 38 (1) “The Registrar shall examine whether an application for registration of a trade mark satisfies the requirement of this Act, including any requirements imposed by the rules’

The court would have to hear Tuna’s argument to determine whether or not “Dolfin” have the same similarities to both accused marks.

Tuna would also have to prove that it is a well-known brand in Brunei Darussalam.

**Q9.**

1. Yes, Tuna is able to take legal action against Bonito under the Merchandise Marks Act, Chapter 96; where it has to prove ownership of the mark.
2. If “Dolfin” is well-known mark, Tuna can rely on section 54 of the Protection of Well Known Trade Marks, Chapter 98.

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## **Annex**

### **1. “Trade Mark Act –Chapter 98”**

#### **Definition: Section 4(1)**

Trade mark means any visually perceptible sign capable of being represented graphically which is capable of distinguishing goods or services of one undertaking from those of other undertakings. It can consist of -

- a) Words
- b) Designs
- c) Numerals
- d) The shape of goods
- e) Their packaging

#### **Duration: Section 43**

A period of 10 years from the date of registration

#### **Rights of Proprietor: Section 12**

- (1) The proprietor of a registered trade mark has exclusive rights in the trade mark which are infringed by use of the trade mark in Brunei Darussalam without his consent. The act that amounts to infringement, are specified in section 13.
- (2) The rights of the proprietor have effect from the date of filing of the application for registration:
  - a) no infringement proceedings may be begun before the date on which the trade mark is in fact registered; and
  - b) no offence under section 94 is committed by anything done before the date of publication of the registration.

#### **Section 13**

(1) A person infringes a registered trade mark if he uses in the course of trade a sign which is identical with the trade mark in relation to goods or services which are identical with those for which it is registered.

(2) A person infringes a registered trade mark if he uses in the course of trade a sign where because —

(a) the sign is identical with the trade mark and is used in relation to goods or services similar to those for which the trade mark is registered; or

(b) the sign is similar to the trade mark and is used in relation to goods or services identical with or similar to those for which the trade mark is registered,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the trade mark.

(3) A person infringes a registered trade mark if he uses in the course of trade a sign which —

(a) is identical with or similar to the trade mark; and

(b) is used in relation to goods or services which are not similar to those for which the trade mark is registered,

where the trade mark has a reputation in Brunei Darussalam and the use of the sign without due cause takes unfair advantage of, or is detrimental to, the distinctive character or repute of the trade mark.

(4) For the purpose of this section, a person uses a sign if he —

(a) affixes it to goods or the packaging thereof;

(b) offers or exposes goods for sale, puts them on the market or stocks them for those purposes under the sign, or offers or supplies services under the sign;

(c) imports or exports goods under the sign; or

(d) uses the sign on business papers or in advertising.

(5) A person who applies a registered trade mark to material intended to be used for labelling or packaging goods, as a business paper, or for advertising goods or services, shall be treated as a party to any use of the material which infringes the registered trade mark if when he applied the mark he knew or had reason to believe that the application of the mark was not duly authorized by the proprietor or a licensee.

(6) Nothing in this section shall be construed as preventing the use of a registered trade mark by any person for the purpose of identifying goods or services as those of the proprietor or a licensee:

Provided that any such use otherwise than in accordance with honest practices in industrial or commercial matters shall be treated as infringing the registered trade mark if the use without due cause takes unfair advantage of, or is detrimental to, the distinctive character or repute of the trade mark.

#### **Section 14**

(1) Subject to subsection (6) of section 48, a registered trade mark is not infringed by the use of another registered trade mark in relation to goods or services for which the latter is registered.

(2) A registered trade mark is not infringed by —

(a) the use by a person of his own name or address;

(b) the use of indications concerning the kind, quality, quantity, intended purpose, value, geographical origin, time of production of goods or of rendering of services, or other characteristics of goods or services; or

(c) the use of the trade mark where it is necessary to indicate the intended purpose of a product or service:

Provided the use is in accordance with honest practices in industrial or commercial matters.

(3) A registered trade mark is not infringed by the use in the course of trade in a particular locality of an earlier right which applies only in that locality. For the purpose of this subsection, “earlier right” means an unregistered trade mark or other sign continuously used in relation to goods or services by a person or a predecessor in title of his from a date prior to whichever is the earlier of —

(a) the use of the first-mentioned trade mark in relation to those goods or services by the proprietor or a predecessor in title of his; or

(b) the registration of the first-mentioned trade mark in respect of those goods or services in the name of the proprietor or a predecessor in title of his, and an earlier right shall be regarded as applying in a locality if, or to the extent that, its use in that locality is protected by any law.

#### **Section 16**

• Definition : An infringement of a registered trade mark is actionable by the proprietor of the trade mark

• Remedies:

a) Damages

b) Injunction

c) account or otherwise is available to him as is available in respect of the infringement of any other property right.

#### **Section 17**

• Definition : Order for erasure etc. of offending sign

• Remedies : The Court may order the person who is found to have infringed a registered trade mark to –a) Erased, b)Removed, c)Obliterated

#### **Section 18**

• Definition : Order for delivery up of infringing goods etc.

• Remedies : The proprietor of registered trade mark may apply to the court for an order for the delivery up to him, or such other person as the court may direct, of any infringing goods, material or articles which a person has in his possession, custody or control in the course of business.

## **Section 22**

- Definition : Remedy for groundless threats of infringement proceedings
- Remedies: The relief that may be applied for any person aggrieved are –
  - a) A declaration that the threats are unjustifiable
  - b) An injunction against the continuance of threat
  - c) Damages in respect of any loss the person aggrieved has sustained by threats.

## **Section 19**

Meaning of “infringing goods, material or articles” –

- a) Goods are “infringing goods”, in relation to a registered trade mark, if they or their packaging bear a sign identical to that mark and the application of the sign to the goods was an infringement of the registered trademark. The goods are proposed to be imported and the application of the sign would be an infringement. The sign has been used in relation to the goods in a way as to infringe the registered trademark.
- b) For Materials if it bears a sign identical with or similar to that mark. Also, if it is used for labeling as a business paper or for advertising goods or services, in such a way as to infringe the registered trade mark.
- c) “Infringing articles”, in relation to a registered trade mark, means articles which are specifically designed or adapted for making copies of a sign identical or similar to that mark; and which a person has in his possession, custody or control, knowing or having reason to believe that they have been or are to be used to produce infringing goods or infringing material.

## **Section 29 (Definition)**

- Licensing of a registered trade mark. It may be general or limited, limited license may apply to some but not all of the goods or services for which the trademark is registered.
- It is not effective unless it is in writing
- A sub –license may also be granted

## **Section 30 (Definition)**

- Exclusive license means a license authorizing the licensee to the exclusion of all other persons, including the person granting the license, to use a registered trade mark in the manner authorized by the licensee

## **Section 31 (Definition)**

Rights of licensee in case of infringement

- A licensee is entitled to call on the proprietor of the registered trade mark to take infringement proceedings. When the proprietor refuses or fails to do so in 2 months, the licensee may bring the proceedings as if he were the proprietor.
- The licensee may not, without the leave of the court, proceed with action unless proprietor is either joined as a plaintiff or added as a defendant

### **Section 32 (Definition)**

#### Rights of exclusive licensee

- An exclusive license may provide that the licensee shall have, to such extent as may be provided by the license, the same rights in respect of matters occurring after the grant of the license as if the license had been an assignment.
- Rights are concurrent with those of the proprietor of the registered trademark
- The exclusive licensee may not, without the leave of the court, proceed with action unless proprietor is either joined as a plaintiff or added as a defendant. A person who is added as a defendant shall not be made liable for any costs in the action unless he has taken part in the proceedings.

### **Section 33 (Definition)**

(1) An application for registration of a trade mark shall be made to the Registrar.

(2) The application shall contain —

- a) a request for registration of the trade mark;
- b) the name and address of the applicant;
- c) a statement of the goods or services in relation to which it is sought to register the trade mark; and
- d) a representation of the trade mark.

(3) The application shall state that the trade mark is being used, by the applicant or with his consent, in relation to those goods or services, or that he has a bona fide intention that it should be so used.

(4) The application shall be subject to the payment of the application fee and such classification fees as may be appropriate.

### **Section 38 (Definition)**

(1) The Registrar shall examine whether an application for registration of a trade mark satisfies the requirements of this Act, including any requirements imposed by rules.

(2) For that purpose he shall carry out a search, to such extent as he considers necessary, of earlier trade marks.



(3) If it appears to the Registrar that the requirements for registration have not been met, he shall inform the applicant and give him an opportunity, within such period as the Registrar may specify, to make representations or to amend the application.

(4) If the applicant fails to satisfy the Registrar that those requirements have been met, or to amend the application so as to meet them, or fails to respond before the end of the specified period, the Registrar shall refuse to accept the application.

(5) If it appears to the Registrar that the requirements for registration have been met, he shall accept the application.

#### Section 47 (Definition)

- The registration of a trade mark may be revoked on any of the following grounds
  - a) Within the period of 5 years following the date of completion of the registration procedure it has not been put to genuine use in Brunei Darussalam.
  - b) That such use has been suspended for an uninterrupted period of 5 years, and no proper reason for non-use
  - c) that, in consequence of acts or inactivity of the proprietor, it has become the common name in the trade for a product or service for which it is registered
  - d) that, in consequence of the use made of it by the proprietor or with his consent in relation to the goods or services for which it is registered, it is liable to mislead the public
- An application for revocation may be made by any person, and may be made either to the Registrar or to the court
- Where grounds for revocation exist in respect of only some of the goods or services for which the trade mark is registered, revocation shall relate to those goods or services only.

#### Section 54 (Definition)

(1) References in this Act to a trade mark which is entitled to protection under the Paris Convention as a well-known trade mark, including such a trade mark entitled to the benefits of the Paris Convention by virtue of the World Trade Organisation Agreement are to the trade mark of a person who —

(a) is a citizen of, is domiciled, ordinarily resident or has a right of abode in, a Paris Convention country or a World Trade Organisation country; or

(b) is domiciled in, or has a real and effective industrial or commercial establishment in, any such country, whether or not that person carries on business, or has any goodwill,

in Brunei Darussalam. References to the proprietor of such a trade mark shall be construed accordingly.

(2) Subject to section 49, the proprietor of a trade mark which is entitled to protection under the Paris Convention as a well-known trade mark is entitled to restrain by injunction the use in Brunei Darussalam of a trade mark which, or the essential part of which, is identical or similar to his trade mark, in relation to identical or similar goods or services, where the use is likely to cause confusion.

(3) Nothing in subsection (2) affects the continuation of any *bona fide* use of a trade mark begun before the commencement of this section.

### **- Criminal Infringement**

#### **Section 94**

(1) A person commits an offence who, with a view to gain for himself or another, or with intent to cause loss to another, and without the consent of the proprietor –

(a) applies to goods or their packaging a sign identical to, or likely to be mistaken for, a registered trade mark;

(b) sells or lets for hire, offers or exposes for sale or hire or distributes goods which bear, or the packaging of which bears, such a sign; or

(c) has in his possession, custody or control in the course of a business any such goods with a view to the doing of anything, by himself or another, which would be an offence under paragraph

- Any Person guilty of an offence under this section is liable on conviction to imprisonment for a term not exceeding 10 years, a fine or both

#### **Section 96**

It is an offence for a person to make, or cause to be made, a false entry in the register of trade marks, knowing or having reason to believe that it is false

- Any person guilty of an offence under this section is liable on conviction to imprisonment for a term not exceeding 5 years, a fine not exceeding \$50,000 or both.

#### **Section 97**

Falsely representing trade mark as registered, for example with respect to a mark, not being a registered trade mark, to the effect that it is a registered trade mark

- Any person guilty of an offence under this section is liable on conviction to a fine not exceeding \$10,000

#### **Section 98**

Counterfeiting trade mark used by another, without the consent of the proprietor of the trade mark, or nearly resembling that trade mark as to be calculated to deceive.

- Any Person who counterfeits any trade mark used by any other person is guilty of an offence and liable on conviction to; a) Imprisonment for a term not exceeding 5 years, b) A fine not exceeding \$100,000, or c) both.

#### **Section 99**

• It is an offence for a person to make, or cause to be made, a false entry in the register of trade marks, knowing or having reason to believe that it is false

- Any person guilty of an offence under this section is liable on conviction to; a) imprisonment for a term not exceeding 5 years, b) a fine not exceeding \$50,000 Or c) both.

• Making or possession of instrument for counterfeiting trade mark.

- Is guilty of an offence and liable on conviction to; a) Imprisonment for a term not exceeding 5 years, b) A fine not exceeding \$100,000, Or c) both

#### **Section 100**

Any person who imports, sells or exposes or has in his possession for sale or for any purpose of trade or manufacture any goods or thing to which a counterfeit trade mark has been applied or to which a registered trade mark has been falsely applied.

- Is guilty of an offence and liable on conviction to; a) Imprisonment for a term not exceeding 5 years, b) A fine not exceeding \$10,000 for each goods to which trade mark has been applied (not to exceed aggregate \$100,000), Or c) both.

#### **Section 101**

Falsely applying trademark to services.

- Is guilty of an offence and liable on conviction to; a) Imprisonment for a term not exceeding 5 years, b) A fine not exceeding \$100,000, Or c) both

#### **Section 102**

A person shall not use without the authority of His Majesty the Sultan and Yang DI-Pertuan cause or permit to appear on a trade mark used by him in connection with any business.

- Is guilty of an offence and liable on conviction to; a) Imprisonment for a term not exceeding 5 years, b) A fine not exceeding \$50,000, Or c) both, d) And shall forfeit any goods to which the trade mark bearing the matter has been applied

#### **Section 103**

Offences committed by partnership and bodies corporate. Where a partnership is guilty of an offence under this act, every partner is also guilty of the offence and liable to proceeded against and punished accordingly, unless the partner tried to stop the commission of such offence.

Where an offence is committed by a body corporate and proved to have been committed

with the consent of, or to be attributable to any neglect on the part of, a director, manager, secretary or other similar officer of that body, or of a person purporting to act in any such capacity, he, as well as the body corporate, is also guilty of the offence and liable to be proceeded against and punished accordingly.

## **2. "Merchandise Mark Act –Chapter 96"**

### **Section 5**

Any person who marks any goods or any case, pack- age or other receptacle containing goods, or uses any case, package or other receptacle with any mark thereon, in a manner reasonably calculated to cause it to be believed that the goods so marked, or any goods contained in any such receptacle so marked, are the manufacture or merchandise of a person whose manufacture or merchandise they are not, is said to use a false trade mark.

### **Section 7**

Any person who uses any false trade mark or any false property mark shall, unless he proves that he acted without intent to defraud, be guilty of an offence: Penalty, imprisonment for one year and fine.