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## Case Law Update: Role of trade mark disclaimers in determining likelihood of deception / confusion

In the recent case of *Jyothy Laboratories Limited v Perusahaan Bumi Tulin Sdn. Bhd.* [2018] 1 LNS 272, the High Court was given the opportunity to consider, among other points in law, the effects of disclaimers, amendments, modifications or limitations imposed by the Registrar of Trade Marks on a registered trade mark.

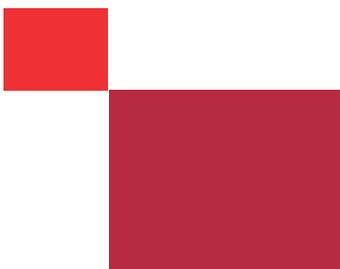
Key details pertaining to the trade marks of this dispute are set out below:-

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Mark	Registrant	Class	Registration Date	Disclaimer / Condition Imposed by the Relevant Registrar of Trade Marks
 ("Neem Mark")	Jyothy Laboratories Limited ("Jyothy") Registered in India <u>only</u> .	Class 3	24 November 1950	There is no exclusive right to the use of the word "Neem".
 ("Neem Active Mark")	Jyothy Registered in India <u>only</u> .	Class 3	14 May 2004	There is no exclusive right to the use of the word "Neem".
 ("Herbal Neem Active Mark")	Perusahaan Bumi Tulin Sdn Bhd ("PBT") Registered in Malaysia <u>only</u> .	Class 3	26 March 2008	The registration of Herbal Neem Active Mark shall give no right to the exclusive use of the words "Herbal", "Active" and "Complete Care".





In the present case, the High Court considered the effect of a registrar's disclaimer / condition in a trade mark expungement dispute. The High Court held, *inter alia*, that:

1. Pursuant to s18(2) and s35(1) of the Trade Marks Act 1976 (“**TMA**”), a registered proprietor cannot bring an action of trade mark infringement in relation to the disclaimed features of a registered mark;
2. Nonetheless, the court may refer to the disclaimed features in determining whether a registered mark should be expunged from the Register on grounds of likelihood of deception or confusion.

Therefore, the High Court affirmed that it would take into consideration the disclaimed words for purposes of deciding whether there exists likelihood of deception / confusion for purposes of expunging a trade mark.

By taking into account the disclaimed words, the High Court found that there exists a likelihood of deception / confusion within the meaning of the TMA between the Herbal Neem Active Mark and Jyothy's marks (Neem Mark and Neem Active Mark). Accordingly, the High Court decided that the Herbal Neem Active Mark should be expunged from the Malaysian Trade Mark Register.

This is a welcomed decision which sheds light on and clarifies the effects of a Registrar's disclaimer on a registered mark.

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