

## PRACTICAL ASPECTS IN DEALING WITH THE TRADEMARK REGISTRATION IN MALAYSIA

### **Introduction**

Intellectual property law is a niche area of law which plays vital roles in our lives from commercial point of views, educational purposes, legal protection and others. This article will, amongst others, discuss on the procedures applicable in registering a trademark in Malaysia, with the Intellectual Property Corporation of Malaysia (MyIPO).

In Malaysia, trademark is mainly governed by the Trademarks Act 2019 (TMA) and the Trademark Regulations 2019 (TMR). Trademark is defined under Section 3(1) of the TMA as “*any sign capable of being represented graphically which is capable of distinguishing goods or services of one undertaking from those of other undertakings*”. The MyIPO is the authority that oversees the enforcement and administration of the TMA and TMR. Any party who wishes to apply for registration of its trademark has to duly submit their trademark application to the MyIPO in accordance with the relevant procedures prescribed by the MyIPO.

### **Factors to be considered in registering the trademark with the MyIPO in Malaysia**

There are many factors that need to be taken into consideration by the applicant who wishes to apply for trademark registration with the MyIPO in Malaysia. The following are, amongst others, the factors that should be taken into consideration in registering the trademark with MyIPO:

- (a) to ensure that the trademark is not prohibited from being registered with MyIPO[1];
- (b) to ensure that the trademark adheres to the requirements prescribed under the TMA and TMR, i.e. in respect of the:
  - (i) Availability of the trademark in Malaysia[2]; and

(ii) Registrability of the trademark[3],

in Malaysia;

(c) to ensure that the applicant is the rightful party applying for the application for registration of the trademark with the MyIPO, in Malaysia[4]; and

(d) to ensure that the trademark is registered in accordance to the applicable class(es) of registration in which the trademark is depicted on[5].

### **Three (3) phases of trademark registration with the MyIPO in Malaysia**

There are three (3) phases applicable for the process of registering the trademark with the MyIPO in Malaysia (i.e. in case for a smooth registration process), namely as follows:

(a) Phase 1: Application for Preliminary Advice & Search ("**PAS**");

(b) Phase 2: Application for registration of the trademark; and

(c) Phase 3: Application for issuance of certificate of registration.

Please note that a smooth registration process for the trademark with the MyIPO will approximately takes up to eighteen (18) months[6].

#### Phase 1: Application for PAS

It is worth to note that despite this phase is not a compulsory step to be undertaken by the applicant in registering its trademark with the MyIPO, in Malaysia, it is always be recommended for the same to be duly attended by the applicant. This is mainly based on the reasons that the Application for PAS will enable the Applicant of the trademark to preliminary receive the MyIPO's advice and views on:

(a) the availability of the trademark[7]; and

(b) the registrability of the trademark[8],

in Malaysia. This will assist for the applicant to better consider in proceeding to Phase 2 of the trademark registration phase.

In this phase, the MyIPO would require the applicant to provide on the details of the applicant and the trademark through the filing of Form TMA1 with the MyIPO. The current fee chargeable by the MyIPO for one (1) Form TMA1 concerning of one (1) trademark in one (1) class of registration is Ringgit Malaysia Two Hundred Fifty (RM250.00) with additional of Ringgit Malaysia (RM20.00) for filing of Form TMR7 should any trademark agent is appointed to act on behalf of the applicant of the trademark.

Upon the completion of the Application for PAS, the MyIPO will takes up to one (1) month in issuing the result for the same. Through such PAS' result provided by MyIPO, the applicant will have preliminary advice and views from the MyIPO on the prospective condition regarding the trademark registration (i.e. Phase 2), on whether the same would be objected, accepted or accepted with condition by the MyIPO. The applicant of the trademark then may consider accordingly on how to move forward with the Phase 2 of the trademark registration (i.e. on whether to maintain the representation, class(es) and details of the trademark or to revamp the same to suit the MyIPO's advice and view as provided in the PAS' result).

### Phase 2: Application for trademark registration

This phase will commence once the applicant attended to the filing of Form TMA2 with the MyIPO, which amongst others, would require the applicant to submit more substantive details on the applicant of the trademark as well as the details regarding the trademark itself with the MyIPO.

It is important to note that the applicant is allowed to mention the first date of usage for the trademark in Malaysia in the Form TMA2 despite the fact that such date may be retrospective in nature comparing to the filing date for the said form with the MyIPO. The general cost for filing of Form TMA2 is at Ringgit Malaysia Nine Hundred Fifty (RM950.00)[9] for one (1) trademark in one (1) class, and in the event that there is an appointment of agent for trademark being made by the applicant, another amount of Ringgit Malaysia Twenty (RM20.00) is to incur for filing of Form TMR7 with the MyIPO.

Upon completion of the filing process for Form TMA2 (and Form TMR7 if applicable) with the MyIPO, the MyIPO will takes up to fourteen (14) months[10] to issue its First Office Action i.e. in informing the applicant on whether the trademark is being accepted or objected by the MyIPO.

In the event where the trademark is accepted by the MyIPO, the trademark will be published in the MyIPO's Online Journal for a period of two (2) months to enable the public to view the same and file an opposition application should they are of the view that the trademark should not be allowed for registration purposes in Malaysia. In the event that there is no opposition application be filed against the trademark during the publication period, the trademark will be duly registered with the MyIPO for a period of ten (10) years, commencing from the filing date of the trademark. During this stage, the applicant is allowed by the MyIPO to proceed with Phase 3 of the registration of trademark.

Nevertheless, in the circumstances where the trademark application is objected by the MyIPO (either from formality and/or substantive sides), the Applicant may consider to attend to the following actions in accordance to its applicability:

(a) filing of written appeal with the MyIPO, supported with the statutory declaration of the applicant on the evidence of usage of the trademark in Malaysia;

(b) filing of application for ex parte hearing application with the MyIPO, accompanied with the submission of a skeletal written submission and statutory declaration of the applicant on the evidence of usage of the trademark in Malaysia;

(c) filing of the necessary form(s) and/or written response to respond to the MyIPO's request and/or inquiry; and/or

(d) other appeal action(s) as described by the MyIPO from time to time in accordance with the type of objection raised against the trademark.

### Phase 3: Application for issuance of certificate of registration

During this final stage of registration, the Applicant may apply to the MyIPO for an issuance of certificate of registration for the registered trademark i.e through the filing of Form TMJ4 with the MyIPO, which will cost Ringgit Malaysia Fifty (RM50.00) for one (1) trademark in one (1) class.

Upon the submission of the document(s) required during this stage with the MyIPO, the MyIPO will issue the certificate of registration for the trademark within two (2) months from the date of the application being made with the MyIPO. Upon the obtainment of the certificate of registration from the MyIPO, the applicant may regard the trademark registration process to have been duly completed.

It is worth to note that the registration of a trademark with the MyIPO, in Malaysia, is only valid for a period of ten (10) years, and thereafter, the proprietor of the trademark has to attend to the trademark renewal application with the MyIPO before the expiry of ten (10) years in order to continue the protection provided for such registered trademark. Further, it also important for the proprietor to note that the registered trademark has to be used<sup>[11]</sup> within the period of three (3) years from the registration date as to avoid any third party from being able to file for an application of revocation of the trademark registration on the grounds of non-use of the trademark.

### **Conclusion**

It is important for the owner of a trademark, especially business owner, to protect their valuable proprietary assets with the MyIPO. Within this fast-paced and technological era, there are a lot of irresponsible third parties who will infringe the trademark just for the purpose of riding on the owner's profit, popularity and reputation. Trademark registration with the MyIPO provides a better platform of protection towards the owner's right in preventing, stopping and dealing with the infringement scenarios over their trademark, as the duly registered trademark in Malaysia marks a clear privilege for the registered proprietor that it has a prima facie evidence of trademark ownership.

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1. Three (3) main prohibitions mentioned in the TMA and TMR are, (i) Firstly, a trademark will be prohibited if the use of it is likely to confuse or deceive the public or contrary to law; (ii) Secondly, when the trademark contains or comprises any scandalous or offensive matter or would not otherwise be entitled to protection in any court of law; and/or (iii) Thirdly, when the trademark is prejudicial to the interest or security of the nation.
  2. Concerning to the requirements mentioned in Section 24 of the TMA.
  3. Concerning to the requirements mentioned in Section 23 of the TMA.
  4. Section 17(1) of the TMA.
  5. All trademarks have to be registered with the MyIPO in accordance to its class(es) of registration. All of these classes of registration have to be opted from the , which amongst others highlighting on the following list of references:
    - MyIPO Goods and Services (Pre-Approved);
    - International Classification of Goods and Services (Nice Classification); and
    - Madrid Goods & Services.
  6. Based on our informal discussion with the respective MyIPO officer. This duration however might differ from case to case basis.
  7. Concerning to the requirements set under Section 23 of the TMA.
  8. Concerning to the requirements set under Section 24 of the TMA.
  9. This cost may change in accordance to characteristic of the application submitted with the MyIPO i.e. for example, (1) application in series will be charged with additional Ringgit Malaysia Fifty (RM50.00) for each series of trademark added to the original trademark (with a limitation of six [6] trademarks in series per application), (2) the fee of Ringgit Malaysia Nine Hundred Fifty (RM950.00) for one (1) trademark in one (1) class is concerning to the pre-approved list of goods or services, while on the other hand, if the list of goods or services is not adopted from the pre- approved list, the MyIPO is imposing a fee of Ringgit Malaysia One Thousand And One Hundred (RM1,100.00) for one (1) trademark in one (1) class, (3) and others.
  10. Based on our informal discussion with the respective MyIPO's officer. This duration however might differ from case to case basis.
  11. \*advisable to be used extensively in Malaysia.

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