

REGISTERING A TRADEMARK IN MALAYSIA

What is Trademark

“Trademark” is defined as any sign capable of being represented graphically, which is capable of distinguishing goods or services of one undertaking from those of other undertakings[1].

Such signs include any letter, word, name, signature, numeral, device, brand, heading, label, ticket, shape of goods or their packaging, colour, sound, scent, hologram, positioning, sequence of motion or any combination thereof.[2]

In Malaysia, trademark matters are governed by the Trademarks Act 2019 (“**TA 2019**”), the Trademarks Regulations 2019 as well as the relevant case law (related to trademark) decided by the courts.

Registering a Trademark

Registration of a trademark is not necessary, but is highly advisable. This is due to the fact that the statutory rights granted under the TA 2019 to the owner of a trademark apply only to registered trademarks. This includes the right to commence trademark infringement action against the alleged trademark infringer. In case of unregistered trademark, its owner may only bring passing off action[3] (instead of trademark infringement action) against any person using a mark which is similar or identical to its trade mark. However, the likelihood to succeed in passing off action is more difficult compared to trademark infringement action as it will depend on the owner of unregistered trademark’s ability to satisfy the requirements of passing off[4].

Any person[5] who claims to be the bona fide[6] proprietor of a trademark may apply for the registration of its trademark with the Intellectual Property Corporation of Malaysia (“**MyIPO**”) in the relevant classes for registration under the MyIPO’s Goods and Services (Pre-Approved) List[7], depending on the goods and/or services that the trademark is being used/ intended to be used by the trademark owners. In total, there are 45 classes for trademark registration. Classes 1 to 34 covers trademark used for goods, while Classes 35 to

45 deal with trademark used in respect of services.

Registration of a trademark in a particular class only gives that trademark, the exclusive rights and protection in that particular class. As such, it is important for trademark owners to register their trademark in all relevant class(es) so as to ensure that their rights are secure.

Registration Procedure of a Trademark

An application for the registration of a trademark must be filed with the MyIPO using the prescribed form and accompanied with the prescribed fee. The information required to be submitted in the application form includes the details of the applicant of the trademark, the representations of the trademark, the description of the trademark, the classes of good and services as well as the specifications of the good and services.

Once filed, the Registrar of Trademark ("**Registrar**") will conduct formality and substantive examinations on the trademark application. During the substantive examination, the Registrar will examine whether the trademark application fulfills the requirements for registration under the TA 2019. The registration of a trademark will be refused by the Registrar if the trademark falls, amongst others:

(a) within any of the absolute grounds for refusal of registration under Section 23 of the TA 2019 including but not limited to the following:

(i) signs which are not capable of being represented graphically and not capable of distinguishing goods or services of one undertaking from those of other undertakings;

(ii) trademarks which are devoid of any distinctive character;

(iii) trademarks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, other characteristics of goods or services or the time of production of goods or of rendering of services; or

(iv) trademarks which consist exclusively of signs or indications which have become customary in the current language of the territory or in the bona fide and established practices of the trade.

(b) within any of the relative grounds for refusal of registration under Section 24 of the TA 2019 including but not limited to the following:

(i) if there exists a likelihood of confusion on the part of the public-

(aa) where the trademark is identical with an earlier trademark and is to be registered for goods or services similar to the earlier trademark; or

(bb) where the trademark is similar to an earlier trademark and is to be registered for goods or services identical with or similar to the earlier trademark;

(ii) if it is identical with or similar to a well-known trademark which is not registered in Malaysia and it is to be registered for the identical goods or services of the proprietor of the well-known trademark.

If the Registrar satisfies that the trademark application has fulfilled the requirements for registration under the TA 2019, he will accept the trademark application for registration and the same will be published in the Intellectual Property Official Journal for a period of two (2) months. During this period, any party may file with the MyIPO, an opposition against the registration of the trademark based on any of the grounds mentioned in the TA 2019[8]. If no party opposes the registration of the trademark within this two (2) months period, such trademark will proceed to be registered by the MyIPO.

Upon registration of a trademark, a notification of registration will be issued by the MyIPO. The registered trademark proprietor may obtain a certificate of registration of the trademark by filing the prescribed form with the MyIPO accompanied with the payment of the prescribed fee.

Exclusive Rights Obtained by Registered Trademark Proprietor

Once a trademark is registered, the TA 2019 grants to the owner of such registered trademark:

- (a) the exclusive right to use the trademark in relation to the goods or services for which the trademark is registered in Malaysia; and
- (b) the exclusive right to authorize other persons to use the trademark in relation to the goods or services for which the trademark is registered in Malaysia.

Maintaining a Trademark

A trademark registration is valid for a period of ten (10) years from the date of its application and may be renewed every ten years.

To maintain the rights obtained through registration of a trademark, the registration of the trademark must be renewed within the prescribed time. Aside from that, a registered trademark proprietor must ensure that he uses the registered trademark (in relation to the goods and/or services for which the trademark is registered). In the event the registered trademark has not been put to use in good faith in Malaysia without proper reasons by the registered trademark proprietor (or with his consent) within a period of three (3) years following the date of issuance of the notification of registration, such trademark registration may be revoked by the Court on an application by an aggrieved person on the ground of non-use[9].

International Considerations

Trademark protection is territorial. Therefore, if trademark owners intend to export their products or services to other countries, the trademark owners should consider either registering their trademark directly in each country of their interest (with the relevant national intellectual property office) or using Protocol relating to the Madrid Agreement Concerning the International Registration of Marks ("**Madrid Protocol**").

The Madrid Protocol is an international registration system for trademarks where trademark

owners can simultaneously seek protection for a trademark in other countries through a single procedure with a single administration. In other word, trademark owners can use their Malaysia trademark application or registration as a basic mark with MyIPO to instruct the International Bureau of World Intellectual Property Organization (WIPO) to designate any other member countries of the Madrid Protocol such as Singapore, Korea and etc. Each of the countries where the protection is sought will then apply their own rules and laws to determine whether or not a trademark may be protected in its jurisdiction[10].

In the event where a trademark owner wishes to register its trademarks in Malaysia directly with the MyIPO, but does not reside or carry on business principally in Malaysia, the TA 2019 requires such trademark owner to appoint a trademark agent registered with the MyIPO to act on its behalf.

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1. Section 3(1) of the TA 2019.
 2. Section 2 of the TA 2019.
 3. a tort founded in common law principles.
 4. as set out in the case of Reckitt & Colman Products Ltd v Borden Inc & Ors (1990) 1 All ER 873 at p 880, which case has been accepted and adopted by the Malaysian Courts such as in the case of Yong Sze Fun & Anor (t/a Perindustrian Makanan & Minuman Layang-Layang) v Syarikat Zamani Hj Tamin Sdn Bhd & Anor [2012] 1 MLJ 585.
 5. individual, corporation or business.
 6. Pursuant to Section 17(1) of the TA 2019, he must either be using or intends to use the trademark in the course of trade or has authorized or intends to authorize another person to use the trademark in the course of trade.
 7. a classification system used by the MyIPO to classify goods and services for the purposes of the registration of trademarks.
 8. Section 34 of the TA 2019.
 9. Section 46(1)(a) of the TA 2019.
 10. There is a common misconception that trademark registration via Madrid Protocol would grant a global trademark protection. However, in fact, the Madrid Protocol trademark registration would only confers national rights governed by the rules and laws of each designated member countries respectively.

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