



MALAYSIA

TRADEMARK HANDBOOK

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Disclaimer: This IP HANDBOOK is intended to provide general guidelines only and not advice with regard to specific cases. The information given is non-exhaustive. Please also note that the relevant law and its interpretation are subject to change.

You should contact us for advice specific to your own situation. Whilst every effort has been made to ensure the accuracy of the information, Pintas IP Group shall not be responsible for any inaccuracies or omissions, however caused therein. Nor can any responsibility be accepted for any loss or damage to any

Legislation

Trademarks Act 2019 and Trademarks Regulations 2019.

Definition

A trademark means any sign capable of being represented graphically which is capable of distinguishing goods or services of one undertaking from those other undertakings. "Sign" includes 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.

Criteria

What connotes a trademark? For a sign to be regarded as a trademark, the sign must be :-

- Capable of being represented graphically;
- Shall have distinctive character;
- Capable of distinguishing goods and services of one undertaking from those of other undertakings;
- A sign may constitute a trademark even though it is used in relation to a service ancillary to the trade or business of an undertaking and whether or not the service is provided for money or money's worth;
- Trademarks which are not devoid of any distinctive character;
- Trademarks which are not 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
- Trademarks which are not consist exclusively of signs or indications which may have become customary in the current language of the territory or in the bona fide and established practices of the trade;
- Shape of the sign shall not be as a result from the nature of the goods themselves or necessary to obtain a technical result;
- Shape of the sign shall not give substantial value to the goods;
- Sign shall not consist exclusively of a name of a country;
- Sign shall not contain or consist of recognized geographical indications.

Membership

√ - Paris Convention

√- Madrid Protocol

Malaysia is a member of the Paris Convention from 1989, whereby applications from convention countries will be subject to the same priority date in Malaysia. The application for priority has to be made within six months of the first application in a convention country. On 27 September 2019, Malaysia has become the 106th member state of Madrid Protocol whereby it promotes single application for obtaining trademark protection for a number of countries and/or region.

Rule of Priority

"First to Use" is the rule followed by Malaysia in determining priority of trademarks.

Duration and Renewal

A trade mark application once registered is valid for 10 years from the date of application. It may be renewed every ten years thereafter with payment of a renewal fee.

Procedures

- ▼ **Search**
 Every applicant may do a preliminary search regarding their trademarks in the form and fee determined by Registrar
- ▼ **Application**
 Every applicant is required to submit an application with the Malaysian Trademark Office.
- ▼ **Examination**
 On submission of the application, the Trade Marks office will examine the application for statutory compliances. Such examinations could lead to office actions. Applicants will be informed and also given an opportunity to reply make representation, amend and furnish additional evidence to such office actions.
- ▼ **Publication**
 A trade mark which passes through examination be published in the Intellectual Property Official Journal (IPOJ) subject to the satisfaction of the Registrar.
- ▼ **Opposition**
 Third parties can oppose the application within two months of publication of acceptance in the IPOJ.
- ▼ **Registration**
 When an application has not been opposed and period for opposition has expired or the Registrar decides in favour of applicant. The trademark shall be registered as at the date of filing.

Filing Requirements

The following information and/or documents are required to file an application for a trademark application in Malaysia:-

1. Application Form (TMA 2).
2. One clear print for a black-and-white mark; 15 prints for a colour mark.
3. A list of goods or services (which closely follow the Nice International Classification 11th Edition).
4. The full name and address of the applicant, company, country/state of incorporation.
5. For marks that contain non-English words, a certified transliteration and translation.
6. If convention priority is claimed, a certified copy of the priority application (with a certified English translation where documents are not in English).

Documents To Be Furnished For Filing Trade / Service Mark Application

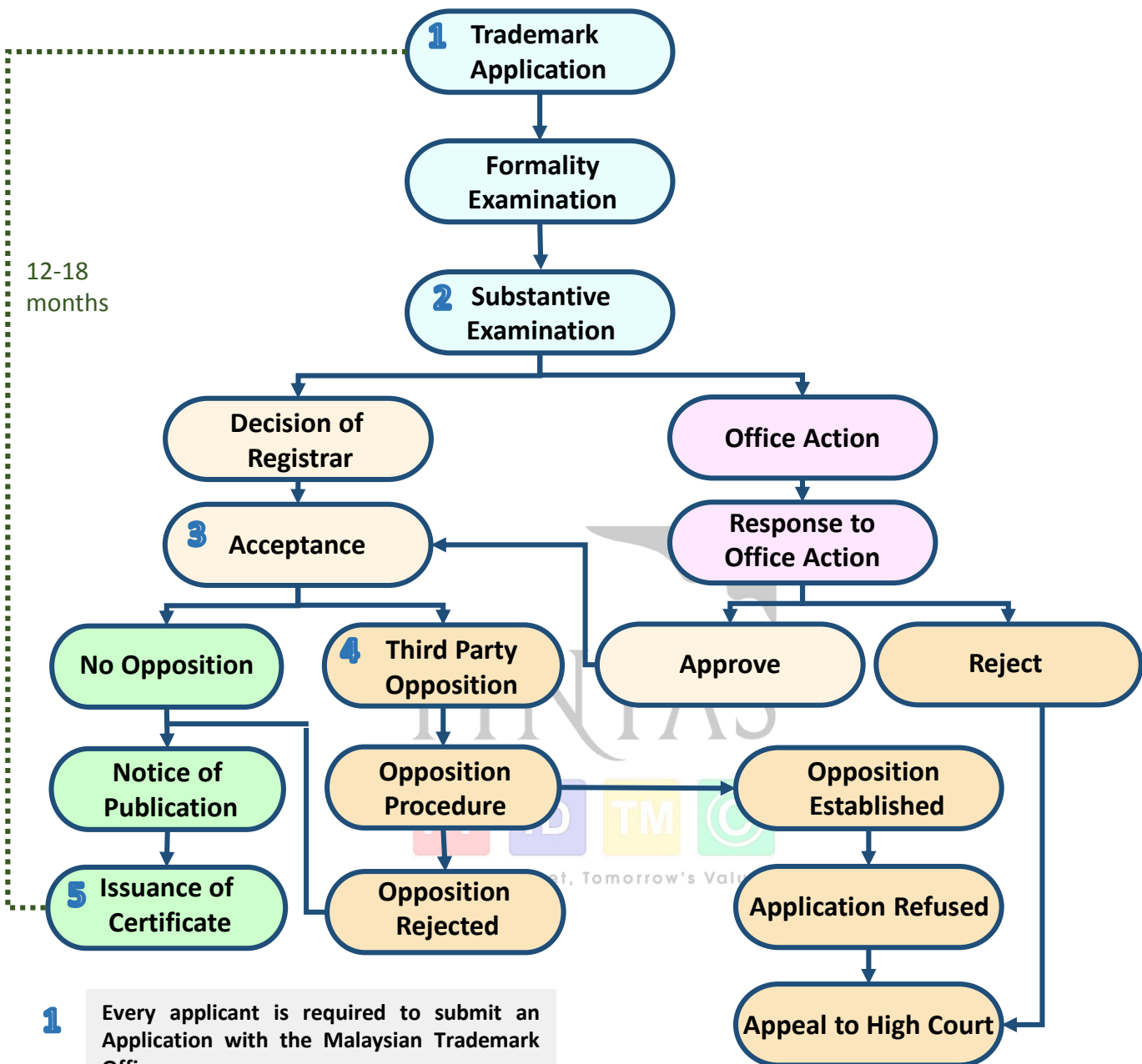
| Basic Requirements | | |
|--|-------------------------|----------------------|
| Documents | Remarks | Time of Filing |
| Mark in the form of foreign characters has to be accompanied with transliteration in English | Certified by Translator | 2 months from filing |

| Additional Documents for Claiming a Convention Priority | | |
|---|---|----------------------|
| Documents | Remarks | Time of Filing |
| Priority documents | Certified copy of the basic application. Documents in any other language has to be provided with its English translation. | 2 months from filing |

| Documents for Filing a Request of Records of Assignments & Changes | | |
|---|-----------------------|---|
| Documents | Remarks | Time of Filing |
| Copy of : - Assignment deed, or - Document of name change - Document of address change | Notorization Required | Anytime before/ after the registration |

| Documents for Filing an Opposition of Counter-Opposition (Deadline for Applying is during 3 Months Publication Period of the Trade Mark Application to be Opposed) | | |
|---|---|----------------|
| Documents | Remarks | Time of Filing |
| Details of registrations in various countries | no legalization | On filing date |
| Copy of advertisements / brochures of the products bearing the mark | no legalization; as many and as early as possible | On filing date |

Trademark Registration Process in Malaysia



1 Every applicant is required to submit an Application with the Malaysian Trademark Office.

2 On submission of the application, the Trade Marks office will examine the application for Statutory compliances. Such examinations could lead to office actions. Applicants will be informed and also given an opportunity to reply make representation, amend and Furnish additional evidence to such office actions.

3 A trade mark which passes through examination be published in the Intellectual Property Official Journal (IPOJ) subject to the satisfaction of the Registrar.

4 Third parties can oppose the application within two months of publication of acceptance in the IPOJ.

5 When an application has not been opposed and period for opposition has expired or the Registrar decides in favor of applicant. The trademark shall be registered as at the date of filing.

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