

MALAYSIA – TRADEMARKS

KEY POINTS

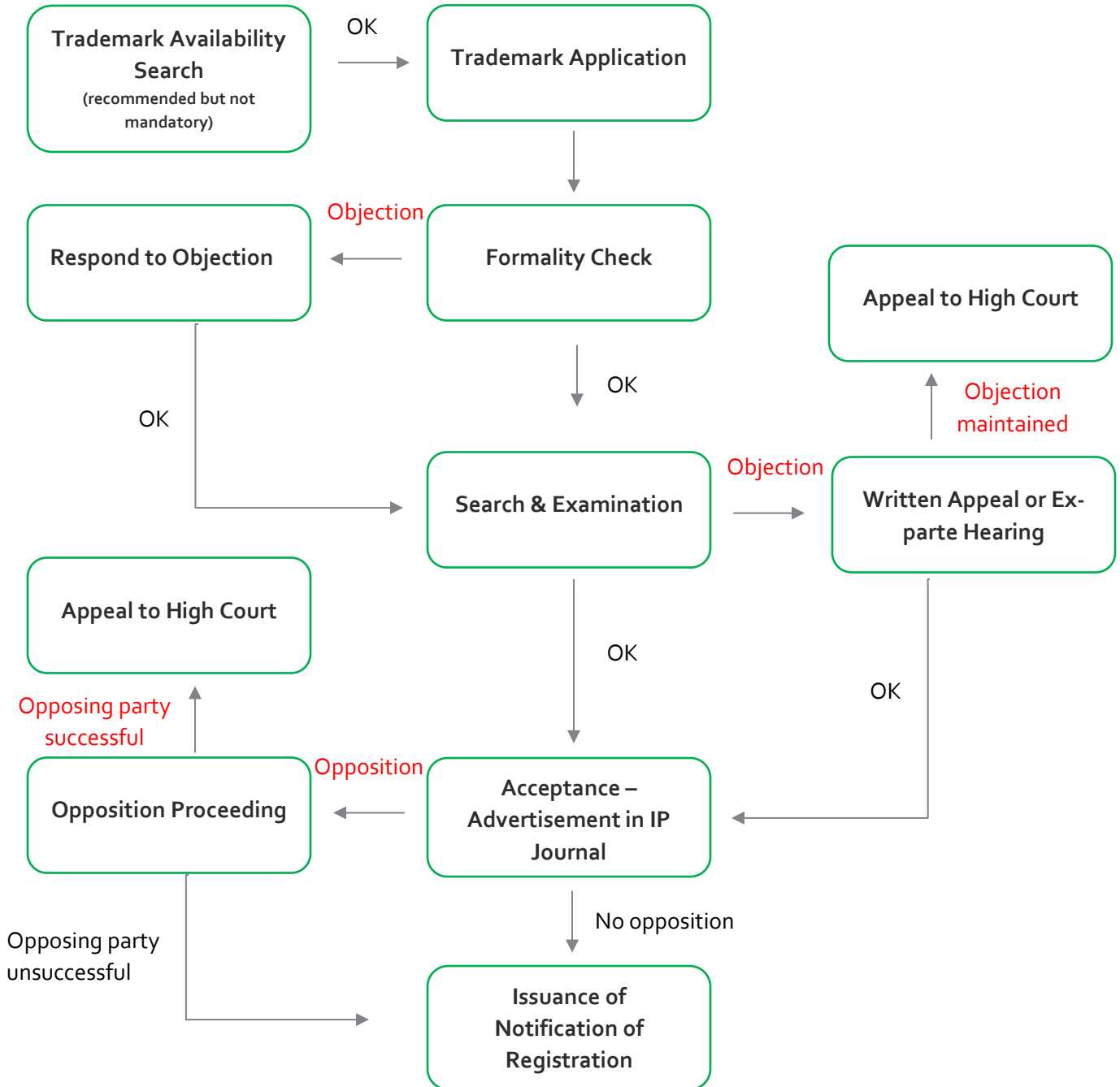
- Trademark protects logo, business name, brand name, colour, shape, sound, scent, hologram, positioning, sequence of motion, 3-D marks, shape of goods or their packaging or any combination thereof.
- Acts & Regulations – governed by the Trademarks Act 2019 and the Trademarks Regulations 2019
- Classification – Malaysia utilizes the 11th edition of the Nice classification
- There are 45 classes of goods and services – 34 classes for goods, 11 classes for services
- Multi-Class System – an application for a trademark can encompass more than one (1) Class
- Madrid System – Malaysia is a party to the Madrid System

DURATION

Upon registration, a mark remains valid for ten (10) years from the date of registration, and, with payment of renewal fees once every ten (10) years, may remain valid in perpetuity.

PROCEDURE FLOWCHART

A brief flowchart depicting the procedures for the registration of trademarks is as follows:-



A trademark takes about 12 – 15 months to be registered, assuming the application is smooth (ie. no inquiries or objections have been raised by the Intellectual Property Corporation of Malaysia (MyIPO) and no opposition raised by third party).

Trademark Availability Search

- Availability search is conducted to assess the registrability of the mark (i.e. whether there is same / similar prior mark(s) already filed / registered with Intellectual Property Corporation of Malaysia (MyIPO) and if the mark fulfills the registrability (i.e., whether the mark of interest is distinctive and non- descriptive of your services of interest).
- If a similar / same prior mark(s) had already been filed / registered by another person, such prior mark(s) will block your trademark application. The pre-filing trademark search is recommended though it is not mandatory.
- A search report with our opinion of the availability and registrability of the mark of interest will be sent to you.

Trademark Application

- If the search result is favorable, you may instruct us to file a trademark application to register the mark.
- We will send you our filing report once the application has been lodged with MyIPO, along with information such as application number and date of filing.

Formality Check, Search & Examination

- The application will be examined by an Examiner in MyIPO.
- In the event the examiner raises any inquiries and/or objections during the examination stage, we will have to file a written response or attend a hearing before the examiner to address the inquiries or overcome the objections in order for the application to proceed to the next stage.
- In the event inquiries and/or objections are raised by the Examiner, we will report it to you and advise you on the next course of action to be taken. If you wish to proceed, we will prepare the necessary for submission to MyIPO in reply of the Examiner's inquiries and/or objections.
- If no inquiries and/or objections are raised, the application will proceed to the acceptance stage.

Acceptance

- When the mark is accepted, it will be advertised in the IP Journal for the mandatory opposition period of 2 months.
- During the two months, any interested party (eg. your competitor) who feels that it has a better right to the mark, may oppose the trademark application.
- If an Opposition is filed, we will have to overcome the Opposition before your mark will be allowed to proceed to the Registration stage.
- If no Opposition is filed, the mark will advance to the Registration stage.
- We will report to you if and when we receive an Acceptance Letter from MyIPO. Should you wish to proceed, we will assist in the submission of relevant form and fees to the Registrar.

Registration

- A notification of registration in electronic form will be issued and we will forward the same to you.

FILING REQUIREMENTS

General details of what is required for filing a trademark application in Malaysia is summarized below.

1. Name & Address of the Applicant
2. Representation of the Mark
3. Class(es) of Interest – we will help you identify the categories of goods/services
4. If there are foreign language characters (characters other than the English and Malay language), a translation and transliteration of the characters must be submitted.
5. For applicant (individual) of Malaysian nationality, a copy of identification card is required.
6. For company incorporated under the laws of Malaysia, a copy of Certificate of Incorporation of Company is required