



TRADEMARK FILING REQUIREMENTS

MALAYSIA



OCTOBER 2014



RECEIPT OF THE APPLICATION

The application must be filed using the prescribed form (TM5). Five copies of the completed form must be submitted together with the prescribed fee. The languages of filing are Malay or English.

The application may be filed in the Malaysian Intellectual Property Corporation (MyIPO) or online.

REPRESENTATION

If the applicant does not reside or carry on business in Malaysia, he must appoint a resident agent who must act on his behalf and who will provide an address for service in Malaysia. The agent must be a resident of or domiciled in Malaysia or if the agent is a firm or company, it must be constituted under the laws of Malaysia and carries on the business or practice principally in Malaysia.

The Registrar may refuse to proceed with the application if the applicant fails to provide the local address for service of his agent.

SEARCH, FORMALITY AND SUBSTANTIVE EXAMINATION

Applicants are advised to make search before submitting applications to avoid applying for identical or similar to trade marks filed earlier. A request may also be made with the Registrar to cause a search to be made in respect of specified goods or services to ascertain whether there is any potentially conflicting trademark.

An application will be accorded a filing date if it complies with the minimum requirements (A). The Office will then carry out a formality examination during which amendments may be required to be made before the mark undergoes search and substantive examination to assess whether it meets the registrability requirements (B).

A. Minimum Filing Requirements.

The following are the minimum requirements for a filing date:

- (a) Name and address of the applicant (or local address for service of agent);
- (b) List of goods or services (one class per application);
- (c) Representation of the mark;
- (d) Declaration of good faith and signature;
- (e) Filing fee.

B. Formality and Substantive Examination.

If the registrar determines that the representation does not meet the requirements, the applicant may be required to submit further representations of the mark. Where the application is for a series of marks, all the marks must likewise be represented.

Where a trademark contains a word/s not in English or Malay, such word/s shall be required to be translated or transliterated.



- (a) For a mark to be registrable, it shall contain or consist of at least one of the following:
 - (i) the name of an individual, company, or firm represented in a special or particular manner;
 - (ii) the signature of the applicant for registration or some predecessor in his business;
 - (iii) an invented word or words;
 - (iv) a word having no direct reference to the character or quality of the goods or services not being, according to its ordinary meaning, a geographical name or surname;
 - (v) any other distinctive mark.
- (b) A name, signature, or word, which is not included in the preceding enumeration, but is shown to be distinctive, i.e., capable of distinguishing goods or services.
- (c) The Registrar shall refuse to accept any application for the registration of a mark upon which any of the following appears:
 - (i) the words "To counterfeit this is a forgery", "Registered Trade Mark", "Registered Service Mark", or any words to the like effect in any language;
 - (ii) the words "Bunga Raya" and the representations of the hibiscus or any colourable imitation thereof;
 - (iii) representations of or words referring to Seri Paduka Baginda Yang di-Pertuan Agong, Ruler of a State or any colourable imitation thereof;
 - (iv) the representations of any of the royal palaces or of any building owned by the Federal Government or State Government or any other government or any colourable imitation thereof;
 - (v) the word "ASEAN" and the representation of the ASEAN logotype or any colourable imitation thereof;
 - (vi) the words "Red Crescent" or "Geneva Cross" and representations of the Red Crescent, the Geneva Cross and other crosses in red, or of the Swiss Federal Cross in white or silver on a red ground, or such representations in a similar colour or colours.
- (d) Where the representation of a crescent or a cross in any colour, not being one of those mentioned in the preceding paragraph, the Registrar may require the applicant, as a condition for acceptance of the application, to undertake not to use the crescent or cross device in red, or in white or silver on a red ground, or in any similar colour or colours.
- (e) The Registrar shall not register a mark or part of a mark where:
 - (i) the mark or part of the mark is identical with, or confusingly similar to, or constitutes a translation of a mark which is considered by the competent authority of Malaysia to be well-known in Malaysia, whether or not it is registered here, as being already the mark of a person other than the applicant for registration, and used for identical or similar goods or services;
 - (ii) the mark or part of the mark is identical with, or confusingly similar to, or constitutes a translation of a mark considered well-known, which is registered in Malaysia with respect to goods or services whether or not similar to those with respect to which registration is applied for, provided that use of the



mark in relation to those goods or services would indicate a connection between those goods or services, and the proprietor of the registered mark, provided further, that the interests of the proprietor of the registered mark are likely to be damaged by such use;

- (iii) the mark or part of the mark is likely to mislead the public, particularly as to the nature, quality, characteristics or geographical origin of the goods or services;
- (iv) the mark or part of the mark is likely to mislead the public if it is a mark for wines which contains or consists of a geographical indication identifying wines, or is a mark for spirits which contains or consists of a geographical indication identifying spirits, not originating in the place indicated by the geographical indication in question.

PUBLICATION, OPPOSITION AND REGISTRATION

Upon completion of the search and examination, the mark shall be advertised in the Gazette. Within two months from the date of the advertisement of the mark in the Gazette, any person may file an opposition to the registration of the mark. After the expiration of the opposition period and if no opposition is filed, the application for the registration of the mark shall be entered in the Register. The certification of registration shall be issued by the Registrar.

CONTACT

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