

**SEMINAR ON THE IP LANDSCAPE IN SOUTHEAST ASEAN COUNTRIES
- TAIWAN INTELLECTUAL PROPERTY OFFICE (TIPO)**

**MALAYSIAN TRADEMARK PROTECTION
SYSTEM**

**AUGUST 30, 2018
TAIPEI, TAIWAN**

**AZAHAR ABDUL RAZAB
INTELLECTUAL PROPERTY CORPORATION
MALAYSIA**

OUTLINE

TRADE MARKS PROTECTION – DUAL SYSTEM

PROTECTION – REGISTRATION SYSTEM

- **FILING REQUIREMENT**
- **EXAMINATION FOR REGISTRATION**
- **OPPOSITION**
- **RIGHTS / EFFECT OF REGISTRATION**

INFRINGEMENT

- **CIVIL ACTION**
- **REMEDIES**

CRIMINAL ACTION

- **TDA 2011**
- **COUNTERFEIT TRADEMARK GOODS**
- **TDO**
- **PENALTIES**

STATISTICS

LAW UPDATES

TRADE MARKS PROTECTION DUAL SYSTEM

The laws governing protection of trademarks in Malaysia are a composite of statute and common law. Both run concurrently :

PROTECTION THROUGH REGISTRATION

- **GOVERNED BY TRADE MARKS ACT 1976 (TMA 1976)**
 - ✓ **TRADE MARKS REGULATION 1997 (TMR 1997)**
- **ADMINISTRATED BY INTELLECTUAL PROPERTY CORPORATION OF MALAYSIA – MYIPO**
- **REGISTRATION - NOT MANDATORY**
 - ✓ **PRIMA FACIE EVIDENCE OF OWNERSHIP**
- **ACTION FOR TRADEMARK INFRINGEMENT**
 - **Only for registered Trademark**

BY USED – PASSING OFF ACTION UNDER COMMON LAW

IN PARALLEL - TRADE MARK IS PROTECTED BY COMMON LAW AS WELL.

- **ACTION OF PASSING OFF**
 - **REPUTATION & GOODWILL** - protects the goodwill of a business generated by the use of a trade mark or trade name.
 - **must be proven to court**
 - **Common Law tort of passing Off as a separate cause of action**
 - **FOR UNREGISTERED & REGISTERED MARK**

PROTECTION THROUGH REGISTRATION

THE LAWS

✓ **TRADE MARKS ACT 1976**
(Amendment - 1994,
2000, 2002)

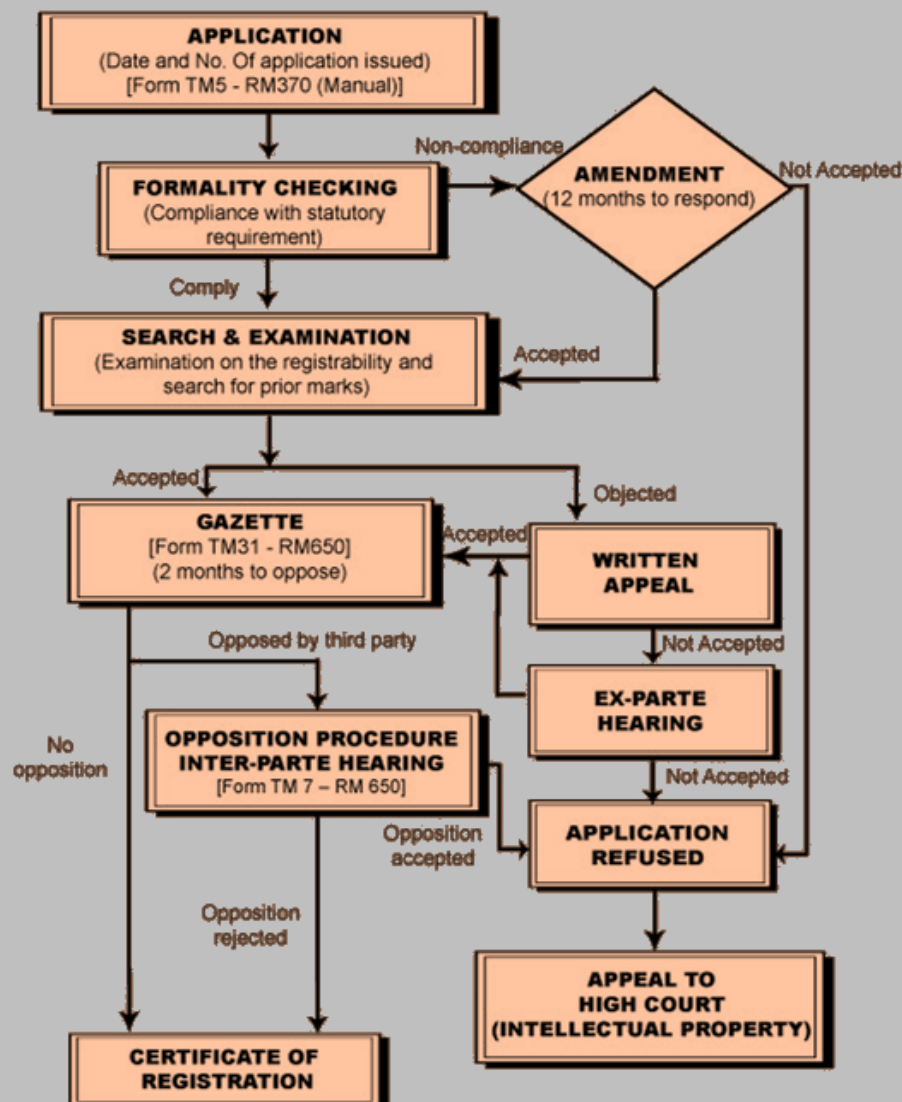
✓ **TRADE MARKS
REGULATION 1997**
(Amendment 2001, 2007,
2011)

PENDENCY

✓ **FIRST OFFICE ACTION (FOA)**
✓ **9 WEEKS**

✓ **REGISTRATION**
✓ **7 - 8 MONTHS**
(for clear-cut case)

FLOWCHART TRADE MARK APPLICATION PROCEDURE (TRADE MARKS ACT 1976)



* Please refer to Trade Marks Regulations for details procedures.

FILING REQUIREMENT

- ✓ **APPLICATION FORM – TM 5**
 - **MANUAL / ONLINE**
 - FEE: MANUAL – RM370 / ONLINE – RM330**
- ✓ **APPOINTMENT OF AGENTS – FORM TM 1**
 - **FEE RM45 (MANUAL) / RM 40 (ONLINE)**
 - **ALL FOREIGN APPLICATION MUST MADE THROUGH REGISTERED TRADE MARK AGENT**
- ✓ **STATUTORY DECLARATION / NOTARY PUBLIC**
 - **DECLARING BONA FIDE OWNERSHIP OF THE MARK**
- ✓ **REPRESENTATION OF A MARK**
 - **MUST CLEAR & DURABLE**
 - **IF MARK CONTAINS A WORD/WORDS IN CHARACTERS OTHER THAN ROMAN - MUST PROVIDED TRANSLITERATION & TRANSLATION**
 - **such as : Japanese Characters, Chinese Characters, etc**
 - **MARK CONTAINS A WORD / WORDS IN OTHER THAN MALAY LANGUAGE OR ENGLISH LANGUAGE – TRANSLATION MUST PROVIDED**
- ✓ **SUPPORTING DOCUMENTS**
 - **such as – PRIORITY CLAIM DOCUMENTS**
- ✓ **LIST OF GOODS / SERVICES**
 - **MUST SPECIFY THE GOODS OR SERVICES**
 - **SHOULD BE RESPECT OF GOODS / SERVICES IN ONLY ONE CLASS**
 - **SEPARATE APPLICATION FOR DIFFERENT CLASSES**

CLASSIFICATION OF GOODS AND SERVICES

- **Applied Nice Classification – International Classification of Goods and Services**
 - **10th. Edition**
 - 45 Classes**
 - ✓ **1 – 34 – SPECIFICATION FOR GOODS**
 - ✓ **35 – 45 – SPECIFICATION FOR SERVICES**
 - ✓ **3rd SCHEDULE, TMR 1997 – r.5, r.17(2) & r.18(2)**
- **Specification must be compliance with NICE Classification**
- **Mono (Single) Class Application System**
 - **Specification must be:**
 - **limited to one class**
 - **definite and clear**
 - **s.25(2) TMA 1976**
 - **r.18(2) TMR 1997**
 - **s.17(1) – all goods / services comprised in a prescribed class**
 - **r.18(3) – registrar's may refuse to accept all goods/services**
- **The Registrar's decision regarding specification shall be final**
 - **s.17(2) TMA 1976**

EXAMINATION FOR REGISTRATION

EXAMINATION ACCORDING TO:

- **TRADE MARKS ACT 1976 (TMR 1976)**
- **TRADE MARKS REGULATIONS 1997 (TMR 1997)**

RELEVANT PROVISION FOR EXAMINATION:

- **SEC.3(1) & 3(2) - DEFINITION OF TRADEMARK**
- **SEC.10(1) - DISTINCTIVE CRITERIA**
- **SEC.10(2) – EVIDENCE**
- **SEC.10(2A) – MEANING OF DISTINCTIVE**
- **SEC.10(2B) – INHERENT & FACTUAL DISTINCTIVENESS**
- **SEC.14(1) - PROHIBITED MARKS**
- **SEC.14(2) – CRITERIA FOR WELL-KNOWN MARKS**
- **SEC.15(a) – STATUTORY RESTRICTION**
- **SEC.15(b) – PROHIBITED MARK DECLARED BY MINISTER**
- **SEC.18 - DISCLAIMER**
- **SEC.19 – SIMILARITY**
- **SEC.20 – CONCURRENT USE & OTHER SPECIAL CIRCUMSTANCES**
- **SEC.25 – REGISTRAR'S DECISION**
- **SEC.27 – ADVERTISEMENT OF ACCEPTANCE**
- **SEC. 42 - UNRENEWED TRADEMARK**
- **RELEVANTS REGULATIONS**

EXAMINATION FOR REGISTRATION

▪ TO ENSURE COMPLIANCE WITH REGISTRATION REQUIREMENTS

❑ SEARCH & EXAMINATION

THREE LEVEL OF EXAMINATION

- PRIMA FACIE**
- BY WRITTEN SUBMISSION & EVIDENCE**
- BY ORAL SUBMISSION – EX-PARTE HEARING**



The do's



The don'ts

▪ EXAMINATION FOR DISTINCTIVENESS & REGISTRABILITY

- ✓ QUALIFIES AS A MARK – s3 TMA 1976 – DEFINITION**
- ✓ MUST CONTAIN AT LEAST ONE OF REGISTRABILITY CRITERIA (DISTINCTIVENESS / UNDESCRIPTIVENESS) - s10(1)**
- ✓ SHOULD NOT FALL UNDER PROHIBITED TRADE MARKS - s.14(1)**
- ✓ NOT CONTAINS ANY OF STATUTORY RESTRICTION – s.15, r.13, r.14 & r.15**

▪ SEARCH FOR SIMILARITY WITH EARLIER MARKS

- ✓ NOT IDENTICAL/SIMILAR MARK - s.14 & s.19**

REGISTRAR'S DECISION :

▪THE REGISTRAR MAY

- ✓ ACCEPT THE APPLICATION ABSOLUTELY, OR**
- ✓ ACCEPT THE APPLICATION SUBJECT TO CONDITION, AMENDMENTS, MODIFICATIONS OR LIMITATIONS, OR**
- ✓ REFUSE THE APPLICATION**

▪ CAN APPEAL to HIGH COURT

QUALIFIES AS A MARK TRADE - DEFINITION

▪ What Constitutes A Mark – Section 3(1), TMA 1976

"mark includes a device, brand, heading, label, ticket, name, signature, word, letter, numeral or any combination thereof"

.....

"trade mark means used or proposed to be used in relation to goods or services for the purpose of indicating or so as to indicate a connection in the course of trade between the goods or services and a person having the right either as proprietor or as registered user to use the mark"

Sect. 3(2), In this act....

- (a) references the use of a mark shall be construed as references to the use of a printed or other visual representation of the mark;***
- (b) references to the use of a mark in relation to goods shall be construed as a references to the use thereof upon, or in physical or other relation to goods; and***
- (c) references to the use of a mark in relation to services shall be construed as a references to the use thereof as a statement or as part of statement about the availability or performance of services.***

TRADE MARKS DEFINITION

LIMITED TO – TRADITIONAL MARKS

“mark includes a device, brand, heading, label, ticket, name, signature, word, letter, numeral or any combination thereof”

LIMITED TO – VISUALLY PERCETIBLE

The definition of the word 'mark' as can be seen is all encompassing. It is construed widely so that almost any visual feature added to goods may come within the definition. Abdul Malik Ishak J In Fazaruddin Bin Ibrahim v Parkson Corp Sdn Bhd [1997] 4 MLJ 360

NOT INCLUDED- sound marks, olfactory marks – smell marks, taste marks, texture or feel marks

NO SPECIFIC PROVISION FOR NEW TYPE OF MARKS

× **3D MARKS & COLOUR MARKS**

× **NON VISUAL MARKS**

TO GIVE PROTECTION TO THE 3D MARKS, SINGLE COLOUR & NON VISUAL MARK – SPECIFIC PROVISION REQUIRED

- **Clear definition on what confines as a mark**
- **Filing requirements for NTM - how to file - graphical representation / deposit of sample**
- **Distinctiveness – inherently / factual (acquire used)**
- **Limitation – functionality / common /**

- ✓ **SHALL CONTAIN/CONSIST OF AT LEAST ONE CRITERIA
BELOW - SEC. 10(1), TMA 1976**

5 REGISTRABILITY CRITERIA

- **NAME REPRESENTED IN A SPECIAL OR PARTICULAR MANNER**
 - **NAME MARKS – S.10(1)(a)**
- **SIGNATURE OF THE APPLICANT – S.10(1)(b)**
- **INVENTED WORD/WORDS – S.10(1)(c)**
- **WORD HAVING NO DIRECT REFERENCE (DESCRIPTIVE TERM) TO:**
 - ✓ **CHARACTER OR QUALITY OF THE GOODS OR SERVICES**
 - ✓ **ITS ORDINARY MEANING, NOT**
 - **A GEOGRAPHICAL NAME OR SURNAME**
 - **S.10(1)(d)**
- **ANY OTHER DISTINCTIVE MARK – S.10(1)(e)**

Section 10(1) TMA 1976 – REGISTRABILITY CRITERIA

S10(1) - In order for a trade mark (other than a certification trade mark) to be registrable, it shall contain or consist of at least one of the following particulars:

- (a) the name of an individual, company or firm represented in a special or particular manner;***
- (b) the signature of the applicant for registration or of some predecessor in his business;***
- (c) an invented word or words;***
- (d) 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; or***
- (e) any other distinctive mark.***

DISJUNCTIVE CRITERIA

- ✓ REGISTRATION ALLOWED BY SINGLE CRITERIA**

PROHIBITED MARK

✓ SHOULD NOT FALL UNDER PROHIBITED TRADE MARKS - s.14(1)

✗ MARKS LIKELY TO DECEIVE OR CAUSE CONFUSION - S14(1)(a) TMA 1976

PROHIBITS THE REGISTRATION OF A MARK AS A TRADEMARK IF ITS USE IS LIKELY TO CAUSE CONFUSION TO THE PUBLIC.

-DECEIVE INTRINSICALLY – REPRESENTATION OF THE MARK WHEN USE ON THE GOODS OR SERVICES

- MARK DESCRIBES FALSE OR UNTRUTH RESULT / INFO

-DECEPTIVE SIMILAR – SIMILAR/IDENTICAL WITH OTHER MARKS

✗ MARKS CONTRARY TO LAW - S14(1)(a) TMA 1976

-ANY LAW OR RULES THAT RESTRICT CERTAIN WORD/SIGN TO USE AND REGISTER AS A MARK

✗ SCANDALOUS AND OFFENSIVE MARKS – S14(1)(b) TMA 1976

PREVENTION OF DISORDER AND PROTECTION OF MORALS

-SCANDALOUS MARK – ANTI SOCIAL BRANDING & *CONTRARY TO PUBLIC MORALITY*

- VULGAR, PROFANE, SWEAR WORD, SMUTTY , MORBID, EROTIC

- OFFENSIVE MARKS – CAUSE GREATER OFFENCE TO A SIGNIFICANT SECTION OF THE GENERAL PUBLIC

- ABILITY TO UNDERMINE AN ACCEPTED SOCIAL AND RELIGIOUS VALUE TO A SIGNIFICANT EXTENT

PROHIBITED – IDENTICAL/ SIMILAR TO WELL-KNOWN TRADE MARKS

- EX OFFICIO EXAMINATION

Section 14(1) A mark or part of the mark shall not be registered as trade mark –

.....

(d) If it is identical with or so nearly resembles a mark which well known in Malaysia for the same goods or services of another proprietor

(e) If it is well known and registered in Malaysia for goods or services not the same as to those in respect of which registration is applied for:

Provided that the 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 well known mark are likely to be damaged by such use

s14(1)(d) - UNREGISTERED - SIMILAR GOODS/SERVICES

s14(1)(e) - REGISTERED – GOODS/SERVICES NOT SIMILAR

HOW TO DETERMINE WELL-KNOWN - REG.13B, TMR 1997 -

- ***Degree of knowledge of the mark***
- ***Duration and extent of its use***
- ***Duration and extent of any publicity associated with it***
- ***Number of registrations worldwide***
- ***Record of successful enforcement of rights in the mark***
- ***Value associated with the mark***

PROHIBITED - MISLEADING USE OF GEOGRAPHICAL INDICATION

EX OFFICIO EXAMINATION - S14(1)(f) & 14(1) (g), TMA 1976

S.14(f), TMA 1976 -MARKS DECEPTIVE AS TO GEOGRAPHICAL INDICATION

- *prohibits the registration of any trade mark which contains or consists of a geographical indication with respect to goods not originating in the territory indicated, if use of the indication is of such a nature as to mislead the public as to the true place of origin of the goods.*

✓ **FALSE GI**

S.14(g), TMA 1976 – ADDITIONAL PROTECTION FOR WINES & SPIRITS

- *prohibits the registration of a trade 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*

✓ **ARTICLE 22 & 23, TRIPS**

STATUTORY RESTRICTION WORD / SIGN

✓ NOT CONTAINS ANY OF STATUTORY RESTRICTION:

- **Marks Claiming Intellectual Property Rights - Patent, Patented, By Royal Letters Patent, Registered, Registered Design, Copyright - s15(a)**
- **Protected Representations And Emblems - Seri Paduka Baginda Yang DiPertuan Agong (KING), word ASEAN, National Flower (BUNGA RAYA), Article 6ter of the Paris Convention – r.13, r.14 & r.15**
- **Any mark, which is specifically declared by The Minister - s15(b)**



PROHIBITED - IDENTICAL & SIMILAR WITH EARLIER MARKS

▪ EX OFFICIO EXAMINATION - SHALL NOT REGISTERED:

- ✓ IDENTICAL**
- ✓ SIMILAR –NEARLY RESEMBLES AS LIKELY TO DECEIVE OR CAUSE CONFUSION**

X S.19 , TMA 1976 – PROHIBITS REGISTRATION OF A MARK IF:

- IT IS IDENTICAL WITH ANOTHER REGISTERED TRADE MARK BELONGING TO ANOTHER PARTY IN RESPECT OF THE SAME GOODS OR SERVICES THAT ARE CLOSELY RELATED TO THOSE GOODS; OR**
- THAT SO NEARLY RESEMBLES SUCH A TRADE MARK AS IS LIKELY TO DECEIVE OR CAUSE CONFUSION**

X S.14(1)(a), TMA 1976 - PROHIBITS REGISTRATION OF A MARK IF:

- USE OF THE MARKS LIKELY TO DECEIVE OR CAUSE CONFUSION**

S.14(1)(a) IS WIDE ENOUGH TO COVER IDENTICAL AND CONFUSINGLY SIMILAR MARKS WHETHER REGISTERED OR NOT REGISTERED

EXAMINATION - APPEAL

- **OBJECTION TO THE APPLICATION**

AFTER EXAMINATION – EXAMINER MAY RAISE OBJECTION TO THE APPLICATION BECAUSE OF NOT COMPLY WITH REGISTRATION REQUIREMENTS:

- **DESCRIPTIVE/NOT DISTINCTIVE**
- **IDENTICAL/SIMILAR WITH EARLIER MARKS**
- **CONSIST OF PROHIBITED MARK/SIGN, ETC.**

- **OVERCOME THE OBJECTION:**

- **THE APPLICANT/HIS AGENT SUBMIT THE WRITTEN SUBMISSION**
 - **ARGUMENTS & SUPPORTING EVIDENCE**
 - **EVIDENCE OF USE**
 - **LAW CASES**
- **THE APPLICANT/HIS AGENT REQUEST FOR EX-PARTE HEARING**

UNDER THE CURRENT PRACTICE, THE APPLICANT OR HIS AGENT TO PRESENT WRITTEN SUBMISSION TO OVERCOME THE OBJECTION AT THE FIRST ROUND. THE EX-PARTE HEARING ONLY CAN REQUEST WHEN THE WRITTEN SUBMISSION FAIL TO CONVINCE THE REGISTRAR.

EXAMINATION OF EVIDENCE

EXAMINER WILL CONSIDER ALL EVIDENCE / ARGUMENTS:

•COMMON REASON FOR DENYING OBJECTIONS:

- ✓ **INVENTED WORDS / NOT DESCRIPTIVE**
- ✓ **NOT SIMILAR**
- ✓ **AGREE TO AMEND THE MARK / GOODS**
- ✓ **HAVE HONEST CONCURRENT USE OR OTHERS SPECIAL CIRCUMSTANCES**

•ACQUIRED FACTUAL DISTINCTIVENESS

- ✓ **THROUGH LONG & EXTENSIVE USE – SUPPORT BY EVIDENCE**
- ✓ **ACHIEVED SECONDARY MEANING**

- for purely descriptive word/words cannot be distinctive unless such words have acquired a secondary meaning. A word in a trade mark has achieved a secondary meaning to distinguish it from the goods of the proprietor of that trade mark, then such proprietor may be entitled to the exclusive use of it. Must provide sufficient evidence to convince examiner.

REFUSAL OF REGISTRATION - APPEAL TO HIGH COURT

- REGISTRAR MAY REFUSE THE APPLICATION – THE APPLICANT CAN REQUEST FOR STATEMENT OF GROUNDS OF DECISION**
- CAN APPEAL TO THE HIGH COURT**

OTHER SPECIAL CIRCUMSTANCES

- **HONEST CONCURRENT USE**
✓ **SECTION 20 TMA 1976**

S.20 – the registrar may permit the application which are identical or closely resembling with registered mark - on the ground of honest concurrent user

The applicant must establish:

- ✓ **that honesty of the user and**
- ✓ **the period of time of use**

TWO TYPES OF CONCURRENT USE:

- **HONEST CONCURRENT USED – S.20(1) / 20(1A)**

The applicant must prove honesty of user:

- ✓ **the period of time of use - extensive and continuous**
- ✓ **used prior to the date of application**

"In order to support the claim of 'honest concurrent user' under s 20(1), a party must prove honesty of user and the period of time of use of the trade mark by the party prior to the date of application for registration (see Tiga Gajah)..... Accordingly, this ground fails." Hakim Nik Hashim di dalam Elba Group Sdn Bhd v Pendaftar Cap Dagangan dan Paten Malaysia [1998] 4 MLJ

- **HONEST PRIOR CONTINUOUS USE – S.20(2)**

The applicant has continuously used that trade mark:

- ✓ **before the used of that conflict registered trade mark; or**
- ✓ **before the date of registration of that conflict trade mark**
- **Shall not refuse to register**

OTHERS SPECIAL CIRCUMSTANCES

S.20(1)&(1a) - ... in the case of honest concurrent use or other special circumstances which, the Court or Registrar may permit the registration of more than one proprietor in respect of trade marks which are identical or so nearly resembling each other as are likely to deceive or cause confusion

WHAT ARE THE CIRCUMSTANCES?

- **LETTER OF CONSENT**
- **WORLDWIDE REGISTRATION**
- **WORLDWIDE CO-EXISTENCE**
- **BONA FIDE PROPRIETOR / TRADER**

✓ **APPLICATION NO. 90000355 – LETTER OF CONSENT**



CONDITIONS:

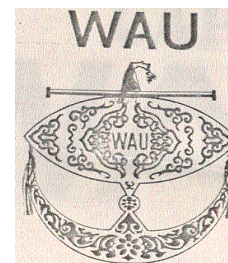
It Is A Condition Of Registration That The Mark Shall Be Only In Relation To Goods Manufactured And Sold In The West Coast Of Malaysia.

By Consent Of Registered Proprietor Of The Trade Mark No. M/083601

GOODS: EDIBLE OIL INCLUDED IN CLASS 29.

**CONSENTED BY REGISTERED PROPRIETOR
- M/083601**

GOODS: EDIBLE OIL INCLUDED IN CLASS 29.



OTHERS SPECIAL CIRCUMSTANCES

✓ WORLDWIDE REGISTRATION

▪ WORLDWIDE REGISTRATION – NOT BINDING

The court is of the view that the trade mark registrations are territorial in nature. The registration obtained by the appellant for the appellant's Trade Mark in Singapore is not binding on the registrar as the evaluation of the appellant's application is strictly made pursuant to the provisions of the Malaysian TMA. Ramly ALI J in SureLoc's Application [2009] 7 CLJ

▪ WORLDWIDE REGISTRATION – PERSUASIVE EVIDENCE

PARIS CONVENTION - Article 6quinquies

A. – (1) Every trademark duly registered in the country of origin shall be accepted for filing and protected as is in the other countries of the Union, subject to the reservations indicated in this Article.

"...considerable importance ought to be attached to the fact that the mark has been registered and used as a Trade Mark, not only in the country of it's origin, but also, in most, of our overseas dominions and in many other countries abroad". - Lawrence J. in Daimond T Motor Co's Application.

It is of the highest importance that such as important branch of commercial law as that relating to trade marks there should be uniformity as far as possible in all countries administering the same system. House of Lords in Shredded Wheat Co Ltd v Kellogg Co (1040) 57 RPC 137

OPPOSITION PROCEDURE

PUBLICATION BEFORE REGISTRATION

- Once a trade mark is accepted by the Registrar

Upon advertisement in the Gazette, any person may oppose the registration. They have a period of 2 months from the date of advertisement to commence opposition proceedings against the trade mark application.

WHO MAY OPPOSE?

- Any person may launch an opposition
 - Trade mark owner
 - Trade organization
 - A consumers association
- ✓ **REGISTRAR SHOULD DECIDE WHETHER TO PROCEED THE REGISTRATION OF THE TRADE MARK OR TO ALLOW THE OPPOSITION**
- ✓ **REGISTRAR DECISION – CAN APPEAL TO THE COURT**

OPPOSITION PROCEDURE

▪ **NOTICE OF OPPOSITION**

Opposition proceedings commence on the date that formal Notice of Opposition on form TM.7 is filed

Notice of Opposition – set out the grounds of opposition to the application. The common grounds included inter alia:

- ✓ **the applicant is not the lawful proprietor of the opposed mark**
- ✓ **likely to deceive or cause confusion to the public – Sec 14(1)(a)**
- ✓ **conflict with other trade mark**
- ✓ **the opposed mark infringes copyright owner**
- ✓ **the opposed mark contains or comprises scandalous or offensive matter**
- ✓ **the opposed mark is not a trade mark within the definition, etc.**

▪ **COUNTER-STATEMENT**

- ✓ **Within 2 months of the receipt of a Notice of Opposition, the Applicant should file a Counter-Statement on Form TM8 setting out the grounds on which he relies as supporting his application**
- ✓ **If no Counter-Statement filed, the application is deemed abandoned (see Reg 39(2), Trade Marks Regulations 1997).**

OPPOSITION PROCEDURE

▪ **EVIDENCE IN SUPPORT**

- ✓ **Within 2 months of the receipt of the Counter-Statement, the opponent shall file a Statutory Declaration adducing the evidence in support of the opposition.**

▪ **EVIDENCE IN REPLY**

- ✓ **Within 2 months from the receipt of the Opponent's Statutory Declaration, the Applicant shall file his Statutory Declaration in support of the application.**
- ✓ **If no SD is filed, the application shall be deemed abandoned.**

▪ **WRITTEN SUBMISSIONS**

- **Upon completion of the evidence – Registrar shall notice to the parties of a date by which they may submit Written Submission**
- **The date must at least one months from Registrar's notice**

OPPOSITION PROCEDURE

DECISION OF THE REGISTRAR

- **Within 2 months of the completion of evidence or Written Submission Registrar must issue his written decision and send a copy of it to both sides. The Registrar may:**
 - **Refuse to register the trade mark**
 - **Register the trade mark absolutely; or**
 - **Register the trade mark subject to such condition, amendments, modifications or limitations**

IN OPPOSITION PROCEEDINGS, THE ONUS WAS ON THE APPLICANT FOR REGISTRATION TO SATISFY THAT THE TRADE MARK WAS REGISTRABLE AND SHOULD BE REGISTERED

REGISTRATION CERTIFICATE

- **If after the expiration of the initial two months or any extended period, no opposition is filed by any person or if opposition rejected, the Registrar will proceed to issue the Registration Certificate.**

TERM OF REGISTRATION

- ✓ **Ten years from the date of filling**

RENEWAL OF TRADE MARK

- ✓ **Renewable for every ten years**
- ✓ **duration of trademark protection perpetual**
(subject to payment of renewal fee – every 10 years)

POST REGISTRATION

CHANGE OF OWNERSHIP

- **Recordal of Assignment**
- **Recordal of Transmission**

LICENSING

- **Registered User (similar to licensing)**

EFFECT OF REGISTRATION

RIGHT CONFERRED BY REGISTRATION

- **Registered Proprietor Right – Section 34**
 - ✓ **Have right to assign**
- **Exclusive right - Section 35.**
 - ✓ **To use**
 - ✓ *The registration of a person as registered proprietor of a trade mark in respect of any goods or services shall, if valid, give or be deemed to have been given to that person the exclusive right to the use of the trade mark in relation to those goods or services subject to conditions imposed. S.35*
- **Incontestability after 7 years - Section 37.**
 - ✓ **Subject to payment of renewal fee – every 10 years**
- **The Exclusive Rights – S.38**
 - ✓ **S.38(1) – The right to prevent others from using an identical or confusingly similar mark on goods within scope of the registration**
 - ✓ **Ability to sue for infringement.**
 - **Civil suit – Injunction & Remedies**
 - **Criminal Suit – Trade Description Acts 2011**
 - **Counterfeit goods of Registered Trademark**

INFRINGEMENT OF TRADE MARK

▪ SECT. 38, TMA 1976 - INFRINGEMENT

A registered trade mark is infringed by a person who, not being the registered proprietor of the trade mark or registered user of the mark using by way of permitted use, uses a mark which is identical with it or so nearly resembling it as is likely to deceive or cause confusion in the course of the trade in relation to goods or services in respect of which the trade mark is registered in such manner"

WHAT IS AN INFRINGEMENT OF TRADE MARK?

A registered trade mark is infringed by a person who, not being the registered proprietor or registered user, uses a mark which is **identical with it or so nearly resembling it as is likely to deceive or cause confusion.**

- ✓ But the mark must be used as a trade mark.
- ✓ And in respect of the goods or services registered.

▪ ELEMENTS OF AN INFRINGEMENT OF TRADE MARK

To establish an action for infringement of trade mark, the plaintiff would need to establish the following ingredients:

- the defendant used a mark **identical** with or **so nearly resembling** the registered trade mark **as is likely to deceive or cause confusion**
- the defendant is not the registered proprietor nor the registered user of the trade mark
- the defendant was using the offending trade mark in the course of trade;
- the defendant was using the offending trade mark in relation to goods or services within the scope of the registration
- the defendant used the offending mark in such a manner as to render the use likely to be taken either as being use as a trade mark or as importing a reference to the registered proprietor or the registered user or to their goods or services

- **REMEDIES FOR TRADE MARK INFRINGEMENT**

A SUCCESSFUL PLAINTIFF IN AN INFRINGEMENT OF TRADE MARK OR PASSING OFF ACTION MAY OBTAIN THE FOLLOWING RELIEF:

- **INJUNCTION - INCLUDING PERMANENT & INTERLOCUTORY INJUNCTION**
 - **AN INJUNCTION RESTRAINING FURTHER INFRINGEMENT BY THE DEFENDANT.**
 - **THE MOST EFFECTIVE REMEDY**
- **AN ORDER FOR DELIVERY UP OF OFFENDING MATTER OR OBLITERATION OF THE OFFENDING TRADE MARK OR SIGN;**
- **DAMAGES IN RESPECT OF THE PAST INFRINGEMENT; OR IN LIEU OF DAMAGES, AN ACCOUNT OF THE PROFITS MADE BY THE DEFENDANT BY THE SALE OF THE MARKED GOODS**
- **A DECLARATION THAT THE DEFENDANT HAS INFRINGED.**

TM CRIMINAL OFFENCES

TRADE DESCRIPTION ACTS 2011 -

False trade description:

7. (1) A false trade description is a trade description which is false to a material degree.

(2) A trade description which, though not false, is misleading, that is to say, likely to be taken for an indication of any of the matters specified in section 6 as would be false to a material degree, is deemed to be a false trade description.

(3) Anything which, though not a trade description, that is to say, likely to be taken for an indication of any of the matters specified in section 6 as would be false to a material degree, is deemed to be a false trade description.

(4) A false indication, or anything likely to be taken as an indication which would be false, that any goods comply with a standard specified or recognized by any person or implied by the approval of any person is deemed to be a false trade description, if there is no such person or no standard so specified, recognized or implied.

TM CRIMINAL OFFENCES

Prohibition of false trade description in relation to trade mark

8. (1) Notwithstanding sections 5 and 6, a trade description shall include an indication, whether direct or indirect, and by any means given, in respect of any goods or parts of goods relating to any rights in respect of trade mark registered under the Trade Marks Act 1976 [Act 175].

(2) Any person who—

(a) applies a false trade description to any goods as if the goods were subject to any rights relating to registered trade mark;

(b) supplies or offers to supply any goods to which a false trade description is applied as if the goods were subject to any rights relating to registered trade mark; or

(c) exposes for supply or has in his possession, custody or control for supply any goods to which a false trade description is applied, commits an offence and shall, on conviction, be liable—

TM CRIMINAL OFFENCES

TRADE DESCRIPTION ORDER (TDO)

9. (1) Where any person being a registered owner of a registered trade mark under the Trade Marks Act 1976 claim that his rights in respect of such trade mark are being infringed in the course of trade, by any other mark or get-up used by any other person, which is not identical with his registered trade mark but can be passed off as his registered trade mark, he may apply to the High Court to declare that the infringing mark is a false trade description for the purpose of section 8.

(2) For the purpose of subsection (1), the person referred to in subsection (1) in making the application shall identify specifically the infringing trade or other mark or get-up and the High Court may, on the application of such person, make an order declaring that the infringing trade or other mark or get-up is for the purposes of this Act, a false trade description in its application to such goods as may be specified in the order.

(3) An order of the High Court made under this section may be referred to as a trade description order.

(4) A subsisting trade description order made by any High Court in Malaysia shall be admissible in evidence in any proceedings under section 8 in which it is relevant as conclusive proof of a false trade description.

PENALTIES

ON CONVICTION, BE LIABLE—

Individual Offenders

(incl. Officers of a body corporate)

First Offender:

- Fine not exceeding RM10,000**
- for each goods and/or**
- Prison up to 3 years**

Repeat Offender:

- Fine up to RM20,000**
- for each goods and/or**
- Prison up to 5 years**

Corporate Offenders

First Offender:

- Fine not exceeding RM15,000**
- for each goods**

Repeat Offender:

- Fine up to RM30,000**
- for each goods**

COMPOUNDABLE OFFENCES

- The Controller may compound offence committed**
 - ✓ not exceeding the maximum fine**

PROTECTION OF WELL-KNOWN TRADE MARKS

- ***PROHIBITED FROM REGISTRATION – EX OFFICIO DUTIES***

- ***Section 14(1) A mark or part of the mark shall not be registered as trade mark –***

- s14(1)(d) - UNREGISTERED - SIMILAR GOODS/SERVICES***

- s14(1)(e) - REGISTERED – GOODS/SERVICES NOT SIMILAR***

- ***RIGHT OF THE PROPRIETOR TO RESTRAIN - Section 70B TMA 1976***

(1) The proprietor of a trade mark which is entitled to protection under Paris Convention or TRIPS Agreement as well known trade mark is entitled to restrain by injunction the use in Malaysia in the course of trade and without the proprietor's consent of the trade mark which, or essential part of which, is Identical with or nearly resembles the proprietor's mark, in respect of the same Goods or services, where the use is likely to deceive or cause confusion.

(2) Nothing in subsection (1) shall affect the continuation of any bona fide use of the trade mark begun before commencement of this Act.

(3) In this section, references to a trade mark which is entitled to protection under Article 6bis of the Paris Convention or Article 16 of the TRIPS Agreement as well known in Malaysia as being the mark of a person whether or not that person carries on business, or has any goodwill, in Malaysia, and references to the proprietor of such a mark shall be construed accordingly.

REGISTRATION OF CERTIFICATION TRADE MARKS

Section 56(1), TMA 1976

"A mark must be capable, in relation to any goods or services, of distinguishing in the course of trade goods or services certified by any person in respect of origin, material, mode of manufacture, quality, accuracy, or other characteristic, from goods or services not so certified shall be registrable as a certification trade mark in the Registrar in respect of those goods or services in the name of that person as a proprietor"



- ✓ To certify certain standard of product or services such as:
 - ORIGIN, QUALITY, ACCURACY
- ✓ The applicant must be an organization, such as an association of manufacturers, a government department, or technical institution, which does not trade in the relevant goods and which is capable of setting and controlling authoritative standards.
- ✓ Proprietor cannot use as a normal trade mark but only to certify standard of others product
- ✓ Must provide Draft Rules – how proprietor governing the use of the mark

STATISTICS

TRADE MARK– APPLICATION & REGISTRATION 1913 – 2018(APR)

YEAR	APPLICATION			REGISTRATION		
	LOCAL	FOREIGN	TOTAL	LOCAL	FOREIGN	TOTAL
1913-1983			162,416			132,273
1984- 2002	97,904	130,485	228,389	20,112	60,112	80,224
2003-2009	78,082	82,621	160,703	38,186	81,174	119,360
2010	13,099	13,271	26,370	5,642	8,652	14,294
2011	13,001	15,832	28,833	10,201	13,618	23,819
2012	14,044	17,832	31,876	9,765	16,311	26,076
2013	14,705	17,520	32,225	9,777	17,202	26,979
2014	15,400	19,171	34,571	10,467	16,961	27,428
2015	15,940	19,983	35,923	10,529	18,271	28,800
2016	18,527	20,580	39,107	12,686	20,120	32,806
2017	19,481	21,612	41,093	12,977	20,248	33,225
2018 (APR)	6,738	7545	14,283	3978	6146	10,124
TOTAL	306,921	366,452	835,788	144,320	278,815	555,408

STATISTICS

TRADE MARK APPLICATION – TOP COUNTRIES 2011 - 2017

COUNTRY	2017	2016	2015	2014	2013	2012	2011
MALAYSIA	19,481	18,527	15,940	15,400	14,705	14,044	13,001
USA	3589	3571	4,049	3,604	3,413	3,995	3,254
JAPAN	2841	2407	2,634	2,610	2,552	2,880	2,224
CHINA	2793	2218	1,821	1,263	1,091	1,213	1,091
SINGAPORE	1542	1424	1,296	1,222	1,107	918	1,120
GERMANY	1111	1244	1,120	1,053	1,066	906	940
UNITED KINGDOM	1055	941	1,027	1,246	985	1,008	887
SWITZERLAND	760	932	854	880	781	921	775
FRANCE	824	914	759	936	882	717	762
SOUTH KOREA	896	959	837	641	492	566	505
TAIWAN	811	721	481	689	589	652	405

TAIWAN APPLICATION - MAIN GOODS OR SERVICES

NO	GOODS & SERVICES	2018	2017	2016	2015	2014	TOTAL
1	CLASS 29 & 30: FOODS	49	84	75	61	65	334
2	CLASS 9: SCIENTIFIC, ELECTRIC, PHOTOGRAPHIC, OPTICAL,SAFETY, ELECTRONIC, COMPUTERS, etc.	41	75	75	52	75	318
3	CLASS 35: ADVERTISING & BUSINESS (ADM'STRATION & MGT)	46	89	67	40	75	317
4	CLASS 3: DETERGENT, SOAP, PERFUMERY, COSMETIC, CLEANING	39	85	70	46	54	294
5	CLASS 43: CAFÉ, RESTAURANT & HOTEL	44	56	47	27	47	221
5	CLASS 5: PHARMACEUTICAL, VETERINATY & SANITARY	25	73	36	27	42	203
7	CLASS 25: CLOTHING, FOOTWEAR & HEADGEAR	12	28	30	21	36	127
8	CLASS 32: NON ALCOHOLIC DRINK	13	24	20	9	9	75
9	CLASS 44: SERVICES – MEDICAL, HYGIENIC, BEAUTY & VETERINARY	13	11	13	3	10	50

LAW UPDATES

PROPOSE SUBSTANTIAL AMENDMENTS

- TMA 1976 - BASED ON UK TMA 1938 – OLD LAW

- **TO MODERNIZE TRADAMARK LEGISLATION**
- **WIDER THE SCOPE OF PROTECTION - INTRODUCE NON TRADITIONAL MARKS (VISUAL SIGN & NON VISUAL SIGN)**
- **PROVISIONS ON MODES OF APPLICATIONS – MULTIPLE CLASS**
- **PROVISIONS ON INTERNATIONAL REGISTRATION SYSTEM (MADRID)**
- **REFORM OF EXISTING EXAMINATION PROCEDURES AND PRACTICES**
- **ENHANCEMENT OF PROVISIONS ON INFRINGEMENT / STATUTORY DAMAGES**
 - **CIVIL & CRIMINAL**
- **INTRODUCE POWER OF REGISTRAR TO REVOKE REGISTRATION**
- **EXTENDED PROVISIONS ON LICENSING**
- **ENHANCEMENT OF BORDER MEASURES PROVISIONS**
- **TO INTRODUCE MYIPO OFFICIAL IP JOURNAL**
- **TO INTRODUCE COLLECTIVE MARK**
- **ENHANCEMENT OF WELLI-KNOWN TRADEMARK PROTECTION**
- **ENHANCEMENT OF PROVISIONS ON POST REGISTRATION**

Thank You!



**INTELLECTUAL PROPERTY CORPORATION OF
MALAYSIA
UNIT 1-7, GROUND FLOOR
MENARA UOA BANGSAR
JALAN BANGSAR UTAMA 59000 KUALA LUMPUR
Tel. No: 03 - 2299 8400
 03 - 2299 8490
Fax. No: 03 - 2299 8989**

**E-mail: ipmalaysia@myipo.gov.my
www.myipo.gov.my**