

Trademark Registration in Malaysia – The Process and Procedures, and the Benefits of Registration

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One Asia Lawyers Group

Yuki Hashimoto
Lawyer (Japan)
Farhatun Najad Zulkipli
Lawyer (Malaysia)

1. Introduction

Trademark is one of the best-known Intellectual Properties in Malaysia. The Trademarks Act 2019 governs the law relating to the registration of trademark, as well as the rights and remedies of the registered owner of the trademark.



In Malaysia, the Intellectual Property Corporation of Malaysia (MyIPO) is responsible for the development and management of intellectual property system in Malaysia. It administers and enforces the intellectual property legislations including the Trademarks Act 2019.

In this section, we will explain about the registration of trademark in Malaysia and the importance of having your brands' name registered under the law.

2. What is Trademark?

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

The “sign” may include any word, letter, name, label, numeral, device, heading, ticket, packaging, shape, colour, scent, hologram, positioning, sequence of motion or any combination thereof.²

¹ Section 3(1) of the Trademarks Act 2019

² Section 2 of the Trademarks Act 2019

As such, any of the above category that represent your brands may be registered as a trademark in Malaysia as for you to ensure your brands are protected and you have the exclusive right to use it in trading your business.

3. Registration of Trademark

3.1 The Process and Procedures

As MyIPO is managing the IP system in Malaysia, the filing of the trademark registration must also be made to MyIPO, subject to certain conditions, fees and procedures set by the institution.

The average processing time from filing to successful registration of trademark is within 12 to 18 months. The process of the registration includes the following steps:

- Step 1:** Preliminary search to identify if the proposed names are already being registered by other entities.
- Step 2:** Upon satisfied with the search result, the trademark owner may decide to proceed with submission of registration to the MyIPO registrar (via manual or online application).
- Step 3:** The application will go through the formality examination to ensure the name fulfils the statutory requirements.
- Step 4:** If Step 3 is accepted, the registrar will proceed with publication of the trademark on the MyIPO official journal (or online system) to allow any opposition by the public (opposition period: 2 months from date of publication).
- Step 5:** Should there be no opposition, a notification of registration will be issued to the trademark owner to signify the successful registration of the trademark.

3.2 Validity Period

The validity of registered trade mark is 10 years from date of application and it is renewable every 10 years subject to payment of renewal fees.

3.3 Representation by a Local Trademark Attorney

When the applicant of trademarks is a foreign company, a local trademark attorney must be appointed to perform the trademark registration in Malaysia.

4. Non-registrable Mark

Despite the various categories of signs available for trademark registration in MyIPO, certain signs are not registrable in Malaysia. As such, when parties would like to register their brand's name, they must ensure that the said name do not fall under the following:

4.1 Non-registrable Trademark

(i) Prohibited Marks

If the use of which is likely to confuse or deceive the public or contrary to law.

(ii) Scandalous or Offensive Matter

If it contains or comprises any scandalous or offensive matter or would not otherwise be entitled to protection in any court of law.

(iii) Prejudicial to the Interest or Security of the Nation

Registrar bears the responsibility of determining the trade mark, whether it might be prejudicial to the interest or security of the nation. It may be that a mark contains an inflammatory statement or words.

4.2 Grounds of Refusal

Further to the above, an application may be refused based on certain grounds stated in Sections 23 and 24 of the Trademarks Act 2019. The grounds are divided into 2 parts i.e., absolute grounds and relative grounds. These grounds include the indistinctive character, identical to the existing registered mark, marks which may deceive or mislead the public as to the nature, quality or geographical origin of the goods or services, there exists a likelihood of confusion on the part of the public and others.

5. The advantages of having your brand's name registered

5.1 Protection of brand name

Having your brand's name registered as a trademark is crucial in order to protect your brand. As an owner, a person will have the sole exclusive right to use his/her brand name and may protect it from any unauthorized used.

5.2 Civil action against unauthorized user

The law provides the remedies where a registered owner may institute a civil claim against any unauthorized user who has used or attempted to use his registered trademark or other similar or identical mark that may cause confusion to the public on the basis of infringement of intellectual property rights.

Section 54 of the Trademarks Act provides that "a person infringes a registered trademark if he uses a sign which is identical with the trademark in relation to the goods or services which are identical with those for which it is registered, in the course of trade, without the consent of the registered proprietor"

An example of a precedent case on this is the case of Danone Biscuit Manufacturing (M) Sdn Bhd v Hwa Tai Industries Bhd. Danone (Plaintiff) has been manufacturing and distributing "ChipsMore" chocolate chip since 1990, Hwa Tai (Defendant) is another manufacturer of chocolate chip cookies bearing the trademark of "ChipsPlus".

The Plaintiff brought a trademark infringement suit against the defendant based on the grounds that the defendant's trademark of ChipsPlus resembled ChipsMore that would likely cause confusion and deceive the customers in public. Additionally, the packaging was also similar and the plaintiff has claimed on the basis of "passing off" under the tort law. The Plaintiff won the case as the judge held that "ChipsPlus" was an infringement of "ChipsMore" as they were similar marks for identical goods and likely to deceive or cause confusion.

Avoid any unnecessary Re-branding

Being the registered owner will regard a person as the pioneer of the said name and will grant him the exclusive right to the trademark. When a brand name is not registered, it will allow someone else to do so and will put the business and any products or services to the said business at high risk.

In the event the brand was registered by another person, re-branding will be required so not to infringe the registered mark. This would cause the initial owner to lose his right against the brand identity and prevent him from operating or expanding under its current identity.

Added value to the business

Trademark is an intangible creation of human intellect that has its own value arising from its reputation. As such, it is regarded as a property that can be owned and carry its own value to the business especially to potential investors. Having the trademark registered in accordance with the law will ensure this value is protected and maintained.

6. Conclusion

Many business owners do not see the value of the trademark at the beginning of the business until the brand's name has gained certain reputation. As the business becomes more successful, the brand will develop an intrinsic value that will attract potential investors to assess if the brand is properly registered in accordance with the applicable local law.

As such, registration of trademark is highly advisable as part of maintaining the business reputation and adding value to the business. It is also important for new companies in Malaysia, when setting up their business in Malaysia to consider the rightful brand names that could be legally registered under the law.

As part of our services regarding the trademark filing in Malaysia, we are able to provide preliminary searches on the proposed brand names to identify if there are any existing trademarks have been registered. Further, we will provide our advice based on the relevant provisions under the Trademarks Act if the proposed names will be subjected to the grounds of refusal by MyIPO or any third party before clients decides to proceed with the registration.

If you are setting up your business or you have a existing and thriving businesses in Malaysia and would like to register your trademark in accordance with the Malaysian law, please contact us.

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For any enquiry regarding this article, please contact us by sending email to: info@oneasia.legal

< Author >



Yuki Hashimoto
One Asia Lawyers Malaysia
Lawyer (Japan)

He established his own firm in Japan and worked as a representative partner of a law firm with three offices in Japan. He has provided legal service as advisor to a wide range of organization in Japan, including companies in construction, real estate management, system development as well as local government and politic parties. He has been a member of One Asia Lawyers since September 2020, providing advice on general cross-border Asian legal matters (M&A, regulatory investigations, etc.) with a focus on Malaysia.

yuki.hashimoto@oneasia.legal

+60-17-3917-926



Farhatun Najad Zulkipli
One Asia Lawyers Malaysia
Lawyer (Malaysia)

She is a Malaysian lawyer with working experience mainly in general corporate and commercial area in both private and in-house practice. Advised various project implementation contracts, corporate facilities, real estate transactions, employment contracts, and regulatory compliance. Joined One Asia Lawyers in September 2021 and provide advice for legal affairs involving Malaysian laws and regulations.

najad.zul@oneasia.legal

+81 90 3904 1122