

AN INTRODUCTION TO TRADEMARK REGISTRATION IN MALAYSIA

by

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Trademarks and service marks are types of Intellectual Property used by traders to identify or distinguish their goods and/or services from those of other traders. These include distinctive words, designs, logos, symbols and/or phrases. It is not compulsory to register a trademark or service mark in Malaysia. However, there is generally less legal protection available to trademarks or service marks that are not registered. Trademarks and service marks are territorial in nature and must be registered in each of the countries where they are being used. For the purposes of this article, the term “trademarks” shall include reference to service marks as well.

In Malaysia, the governing body that oversees the registration of Intellectual Property (patents, industrial designs, copyright and trademarks) is the Intellectual Property Corporation of Malaysia (MyIPO), a body that falls under the purview of the Ministry of Domestic Trade, Cooperatives and Consumerism (MDTCC). There are several forms to be prepared and fees to be paid when applying for trademark registration. The Applicant may apply for the trademark in black and white or in colour. In addition, a Statutory Declaration must be affirmed by the Applicant and filed at the Registry within two months from filing the application.

Not every trademark application will be a straightforward case, as the Registrar will, amongst other things, make sure that there are no other identical and/or confusingly similar trademarks to that of the application on the Register. A thorough examination of the Register is conducted and if there are conflicting trademarks, an objection will be raised by the Registrar. The Applicant is allowed the opportunity to submit arguments against the objections raised and if successful, the trademark will then be published in the Government Gazette. At this stage, the application is made public and other parties may come forward to oppose the application.

Other common objections raised by the Registrar are on grounds that the trademark application contains offensive or scandalous content, is non-distinctive and descriptive of the goods or services, or is an emblem protected under national laws.

A trademark registration is valid for an initial period of 10 years and may then be renewed for further 10-year periods indefinitely. It is important to note that a trademark must be used once it is registered and non-use for three continuous years may result in the trademark being removed from the Register.

Once a trademark is registered, the symbol “®” can be used next to the logo, symbol, design or phrase as the case may be, to signify its status. Trademark owners are not allowed to use this symbol unless registration has been obtained and doing so is an offence. The symbol “™” on the other hand is used for unregistered trademarks.



Trademark registration is *prima facie* proof of ownership and allows a trademark owner to enforce his rights against unauthorised use of the trademark by third parties. Such unauthorised use of a trademark may result in the dilution of the reputation and value of a trademark and could bring about adverse consequences to one's business. Effectively protecting one's trademark is therefore a policy that every trader, whether small, medium or large, should adopt. It is advisable to seek the expertise of a trademark agent when filing a trademark application so as to ensure your Intellectual Property rights are fully protected.

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