

## **MALAYSIA TRADEMARK (AMENDMENT) REGULATIONS 2011** **Amendment to the Malaysian Trademark Regulations**

The Malaysian Trade Marks Office has made several amendments to the Trade Marks Regulations 1997 with effect from 15 February 2011 via the Malaysian Trade Marks (Amendment) Regulations 2011. These amendments and regulations were posted online on their official website.

The amendments mark a speedier examination process, with the introduction of an expedited examination process to reduce the trademark pendency period. The present ordinary examination procedure will also be improved.

The Expedited Examination Procedure will be provided by the addition of Regulation 18A. This option allows for a trademark application to be registered within 7 months from the date of filing, assuming that the request for approval of expedited examination is filed within one month from the date of filing, and that there are no adverse examination reports or opposition proceedings.

The improved ordinary examination procedure allows for a trademark application to be registered within 13 months from the date of filing, based on a smooth application to registration process.

In addition, all official fees for all trademark matters have also been revised.

E-filing services are now currently available for the online filing of patents, trademarks, industrial designs and geographical indications at the Malaysian IP Office.

Kindly take note that we anticipate regular updates from the Malaysian Trade Marks Office on the new implementation of the amended Regulations. We will continue to keep you posted, and recommend that you review our website for updates on a regular basis.

The amendments to the Trademark Regulations and details of the ordinary and expedited examination procedures are detailed below:

### **SUMMARY OF AMENDMENTS TO THE TRADEMARK REGULATIONS**

#### **i) Introduction of Expedited Examination**

- New regulations for expedited examination are provided by the addition of Regulation 18A
- This allows for the expedited examination of a trademark, resulting in a trademark application to be registered within 7 months from the date of filing, assuming that the request for approval of expedited examination is filed within one month from the date of filing, and that there are no adverse examination reports or opposition proceedings
- In order to file for expedited examination, the Applicant must justify its grounds for requesting that the trademark be processed under the expedited examination process. This is to be done by way of a Statutory Declaration. The justifications deemed acceptable by the Registrar are:-
  - It is in the national/public interest
  - There are infringement proceedings taking place or evidence showing potential infringement with regards the trademark being applied
  - Registration of a trademark is a condition to obtain monetary benefits from the Government or institutions recognized by the Registrar
  - Any other reasonable grounds which support the request
- New procedures, documents and official fees are applicable for the expedited examination route, which are further detailed below

**ii) Timeline to respond to the Registry's Grant Letter**

- Under the previous regulations, the Applicant and/or its agent had two months from the date of the Grant Letter to reply to the letter and pay the requisite official fee
- Under the new regulations, the timeline to respond to the Registry's Notification of Acceptance has now been reduced to **one month** from the date of receipt of the Registry's Notification of Acceptance

**iii) Series Application Trademarks**

- Extra official fees are now chargeable for applications comprising three or more marks in the same series, such fee to be incurred based on each mark that is added to the series from the third mark onwards

**iv) Request for Hearings**

- All requests for hearings before the Registrar are now to be accompanied by a formal request and payment of an official fee

**v) Introduction of E-Filing Services**

- The new regulations also contain provisions for e-filing services at the Intellectual Property Corporation of Malaysia
- In accordance with this, there is a discounted official fee applicable for documents that are filed using the e-filing system

**vi) Revision of All Official Fees**

- All the official fees for all trademark matters have now been revised upwards

## **REVISION OF OFFICIAL FEES**

The following table highlights the revision in official fees for all trademark-related matters:-

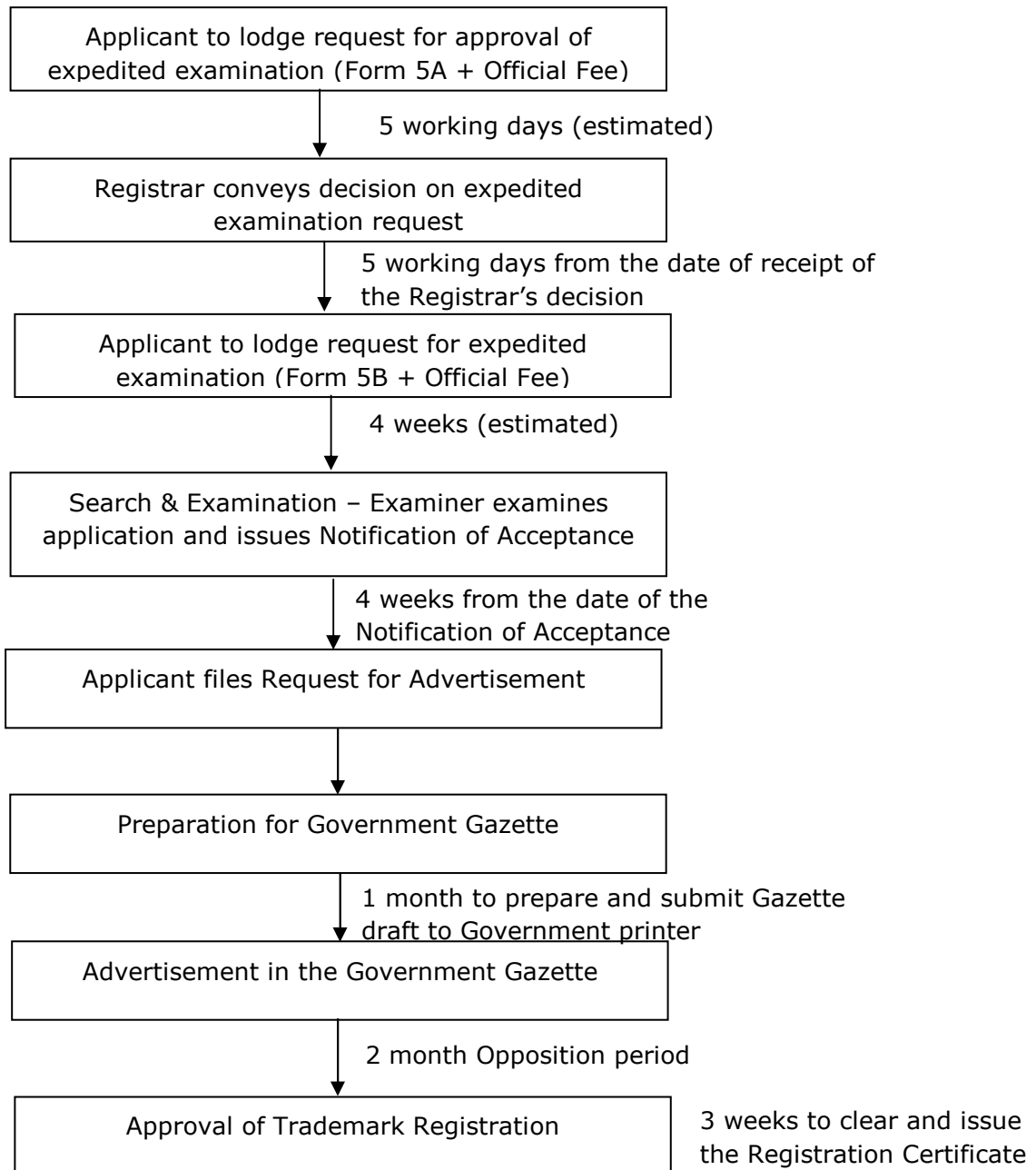
Matter	Form	Old Manual Fee (RM)	New Fee		Diff (Manual) (RM)
			E-Filing Fee (RM)	Manual Filing Fee (RM)	
Form of authorisation and request to enter, alter or substitute an address for service	TM1	30	40	45	15
Application for registration of Trade Marks Agent	TM2	1000	1300	1350	350
Application for renewal of registration of Trade Marks Agent	TM3	400	520	570	130
Request for registrar's preliminary advice as to registrability of a mark	TM4	100	130	140	40
Request for search	TM4A	250	330	360	110
Application for registration of a mark For series mark - (Per series : )	TM5	250 -	330 50	370 50	120 50
Request for approval for expedited examination of a trade mark application	TM5A	-	200	250	250
Request for expedited examination of a trade mark application	TM5B	-	1060	1200	1200
Request for statement of grounds of decision	TM6	500	650	700	200
Notice of opposition	TM7	450	600	650	200
Counter - statement to a notice of opposition	TM8	300	400	440	140
Notice to the registrar of attendance at hearing	TM9	480	630	680	200
Notice to the registrar of attendance at ex-parte hearing	TM9A	-	150	170	170
Certificate of registration	TM10	-	-	-	-
Application to dissolve the association between a registered trade mark and other registered trade mark(s)	TM11	120	160	180	60
Application for renewal of registration of a trade mark	TM12	420	550	600	180

Matter	Form	Old Manual Fee (RM)	New Fee		Diff (Manual) (RM)
			E-Filing Fee (RM)	Manual Filing Fee (RM)	
Application for late renewal of registration of a trade mark	TM13	630	820	870	240
Application for restoration and renewal of registration	TM14	670	880	930	260
Application and declaration of an assignment / a transmission for registration as proprietor of a trade mark	TM15	180	240	260	80
Request by the registered proprietor/registered user of a registered trade mark for entering a change in the description, alteration of trade/business address or correction of an error in the Register	TM16	60	80	90	30
Request by registered proprietor of a registered trade mark for making, cancelling or varying of an entry in the Register	TM17	100	130	140	40
Request by registered proprietor of a registered trade mark to strike out goods or services	TM18	100	130	140	40
Request by registered proprietor of a registered trade mark for entry of a disclaimer of memorandum	TM19	120	160	180	60
Request by registered proprietor of a registered trade mark for entry on the Register of a note of a certificate of validity by the court	TM20	120	160	180	60
Application by registered proprietor for an addition to or alteration of a registered trade mark	TM21	120	160	180	60
Application by registered proprietor for an addition to or alteration of a registered trade mark	TM22	480	630	680	200
Application for registration of a registered user	TM23	180	240	260	80
Application for variation or cancellation of the registration of a registered user	TM24	150	200	220	70
Request for Registrar's certificate other than certificate of registration	TM25	100	130	140	40

Matter	Form	Old Manual Fee (RM)	New Fee		Diff (Manual) (RM)
			E-Filing Fee (RM)	Manual Filing Fee (RM)	
Request for correction of a clerical error in an application or for permission to otherwise amend an application for registration	TM26	100	130	140	40
Application for extension of time (Per month:)	TM27	50 100	70 130	80 140	30 40
Application for extension of time (for Opposition proceedings) (Per month:)	TM27A	- -	70 130	80 140	
Notice of order of court for rectification or alteration of the Register	TM28	100	130	140	40
Application to restrict importation of counterfeit trade mark goods	TM30	300	300	330	30
Request for advertisement of a trade mark	TM31	450	600	650	200
Request for copy of office document and manuscript –	-				
- Certified extract from Register (per page)		10		10	-
- Non-certified extract from Register (per page)		5		5	-
- Computer print-out (per page)		5		5	-
- Permitted information upon request					
Less than 10 pages (per page)		100		100	-
Subsequent pages		5		5	-
Request to conduct public search (per hour)	-	10		10	-
Request to conduct public search through computer (per hour)	-	20		20	-

## **EXPEDITED TRADEMARK EXAMINATION PROCEDURE - FLOWCHART** **(as advised by the Malaysian Trade Marks Office)**

Within 4 months from the date of filing:-



TOTAL TIME FROM FILING DATE OF THE APPLICATION TO REGISTRATION -  
7 MONTHS

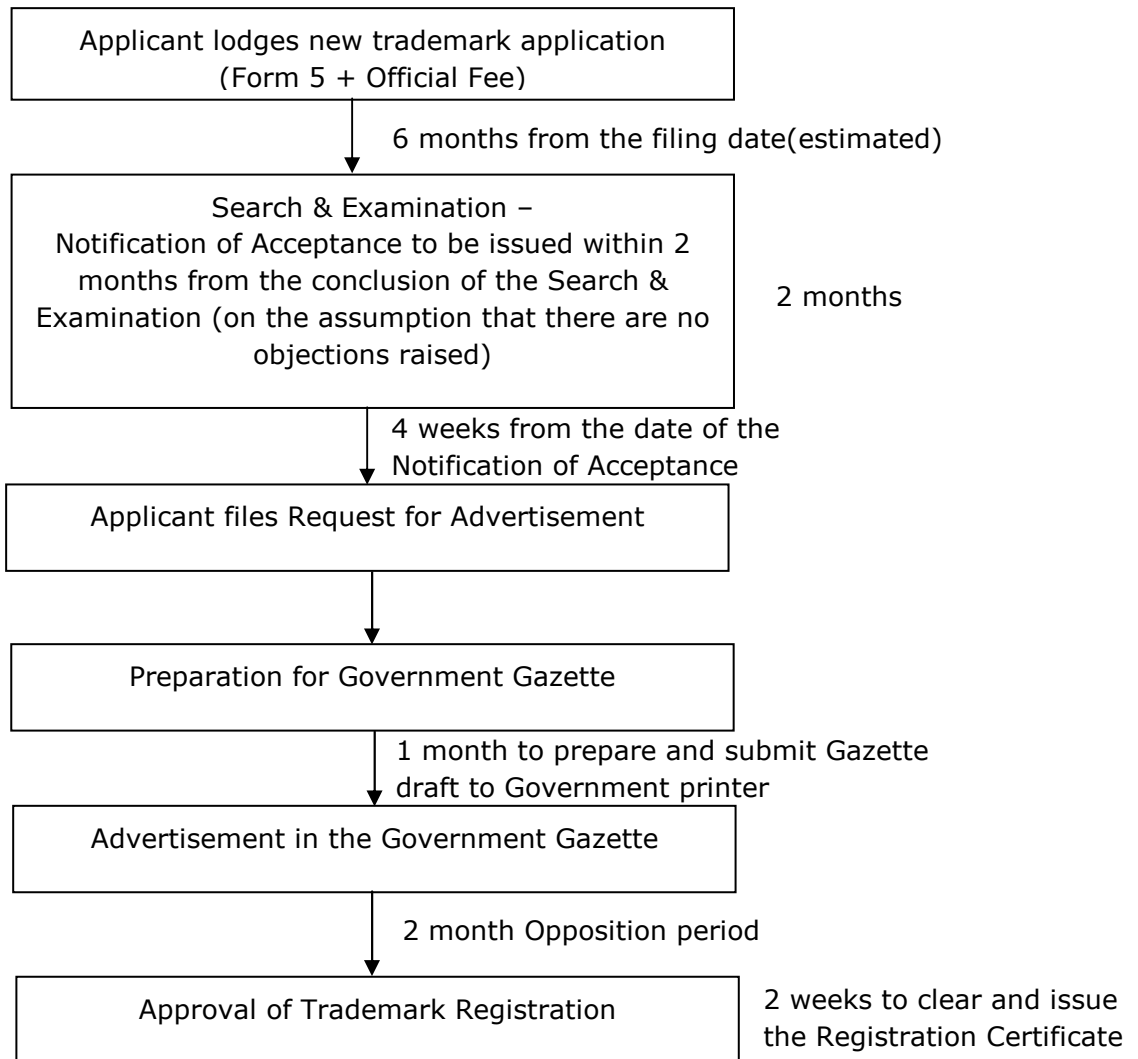
(assuming that the request for approval of expedited examination is made within **1 month from the date of filing**, complies with all requirements, and that there are no adverse reports or opposition proceedings)

## **EXPEDITED TRADEMARK EXAMINATION PROCEDURE - DETAILS**

<b>PROCESS</b>	<b>TIMELINE</b>	<b>DETAILS</b>
<p>1 Applicant to lodge request for approval of Expedited Examination (Form 5A &amp; fee)</p> <p><b><u>Official fees:</u></b> Online filing: RM200 Manual filing: RM250</p>	<p>4 months from the filing date (to be filed within <u>1 month from the filing date</u> if the Applicant desires to obtain registration within 7 months from the filing date)</p>	<p>Request for Approval of Expedited Examination to be filed within 4 months from the date of application by filing Form 5A with the prescribed fee.</p> <p>The request is to be accompanied by a Statutory Declaration</p> <p>Examples of Grounds for Expedited Examination: - National/Public interest - Infringement proceedings - As a condition to obtain funds from the government or recognized institutions - Any other reasonable grounds</p>
<p>2 Registrar's decision on Expedited Examination</p>	<p>5 working days (estimated)</p>	<p>Registrar will evaluate the Request and Grounds given by the applicant</p>
<p>3 Applicant to lodge request for expedited examination (Form 5B &amp; fee)</p> <p><b><u>Official fees:</u></b> Online filing: RM1060 Manual filing: RM1200</p>	<p>5 working days from the date of receipt of the Registrar's decision</p>	<p>Applicant to file Request for Expedited Examination within 5 working days from the Registrar's Notification by filing Form 5B with the prescribed fee</p>
<p>4 Search and Examination – Examiner accepts application</p>	<p>4 weeks</p>	<p>Examiner will conduct the search and examination to evaluate the trade mark application.</p> <p>Notification of Acceptance to be issued within 4 weeks Search and Examination</p>
<p>5 Request for Advertisement (Form 31 &amp; fee)</p> <p><b><u>Official fees:</u></b> Online filing: RM600 Manual filing: RM650</p>	<p>4 weeks from date of Notification of Acceptance</p>	<p>Applicant to file Request for Advertisement within 4 weeks from the date of the Notification of Acceptance by filing Form 31 with the prescribed fee</p>
<p>6 Preparation for Gazette</p>	<p>1 month</p>	<p>MyIPO to prepare the Gazette draft and submit to the Government printer for publication</p>

PROCESS		TIMELINE	DETAILS
7	Advertisement in Government Gazette	2 months	Trademark is advertised in the Government Gazette, and public is given 2 months to oppose the trademark
8	Approval of Registration	3 weeks from the end of the Government Gazette opposition period	MyIPO to clear and issue the registration certificate for the trademark
<b>TOTAL PENDENCY</b>		<b>7 months</b>	

## **IMPROVED ORDINARY TRADEMARK EXAMINATION PROCEDURE - FLOWCHART**



**TOTAL TIME FROM FILING DATE OF THE APPLICATION TO REGISTRATION -  
13 MONTHS**  
(assuming that the application complies with all requirements, and that no adverse reports  
are raised)

## **IMPROVED ORDINARY TRADEMARK EXAMINATION PROCEDURE – DETAILS**

<b>PROCESS</b>	<b>TIMELINE</b>	<b>DETAILS</b>
1 Applicant files new trademark application	-	Applicant files new trade mark application
2 Search and Examination	6 months from filing date  2 months to issue Notification of Acceptance upon conclusion of Search and Examination (on the assumption that there are no objections raised)	Examiner will conduct the search and examination to evaluate the trademark 6 months from filing date of the trademark application  Notification of Acceptance to be issued within 2 months from the conclusion of the Search and Examination (on the assumption that there are no objections raised)
3 Request for Advertisement (Form 31 & fee)  <b>Official fees:</b> Online filing: RM600 Manual filing: RM650	1 month from date of Notification of Acceptance	Applicant to file Request for Advertisement within 1 month from the date of the Notification of Acceptance by filing Form 31 with the prescribed fee
4 Preparation for Gazette	1 month	MyIPO to prepare the Gazette draft and submit to the Government printer for publication
5 Advertisement in Government Gazette	2 months	Trademark is advertised in the Government Gazette, and public is given 2 months to oppose the trademark
6 Approval of Registration	2 weeks from the end of the Government Gazette opposition period	MyIPO to clear and issue the registration certificate for the trademark
<b>TOTAL PENDENCY</b>	<b>13 months</b>	