

# IP ALERT

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## Author

**Ong Boo Seng**  
Partner  
ZICO IP  
booseng.ong@zicolaw.com

**Emily Thea**  
Associate  
ZICO IP  
emily.thea@zicolaw.com

## Trademarks Act 2019: Important Changes To Trademark Filings In Malaysia

The Trademarks Act 2019 came into force on 27 December 2019. In this alert, we will highlight some of the new features and changes arising from the new Act.

### What is new?

#### International registration

- It is now possible to obtain an international registration via the Madrid Protocol by filing **one application** in **one language** and paying **one fee**.

#### Multiple class applications

- Multiple class application is now available. A **single application** may be made for the same mark in **more than one** class of goods and services.

#### Non-traditional marks

- Non-traditional marks such as **scent, colour, shape, hologram** and **motion** marks can now be registered.

### What has changed?

<p>Filing Date</p>	<ul style="list-style-type: none"> <li>The <b>filing date</b> is the date the Registrar receives the trademark application.</li> <li>Should there be any deficiencies in the application, the date in which the application is <b>remedied</b> would be the <b>new</b> date of filing.</li> <li>The <b>filing date will be the date of registration</b>.</li> <li>The application may the claim priority of an earlier application filed in a Convention country but <b>the priority date is no longer deemed to be the filing date</b>.</li> </ul>
<p>Translation and Transliteration</p>	<ul style="list-style-type: none"> <li>If the mark contains words which are <b>not</b> in Roman characters, English or the national language (Malay), the applicant is required to provide:               <ol style="list-style-type: none"> <li>the <b>translation</b> of the words in English or the national language (Malay);</li> <li><b>transliteration</b> of the words; and</li> <li>the <b>language</b> to which the words belong.</li> </ol> </li> <li>The information above is required to secure a filing date i.e. if the information on translation and transliteration above is received after the application form has been submitted, the filing date will be the later date.</li> <li>If the information above is not provided within the time prescribed by the Registry, the application will be deemed withdrawn.</li> </ul>

Statutory Declaration	<ul style="list-style-type: none"> <li>A <b>certified translation and transliteration is no longer required</b> unless the Registrar requests for it.</li> </ul>
	<ul style="list-style-type: none"> <li>This is <b>no longer required</b> to complete filing requirements.</li> </ul>
Official Fees	<ul style="list-style-type: none"> <li>Only <b>one set of official fees for filing and registration</b> is payable upon filing.</li> <li>For multiple class applications, the official fees are calculated on a <b>per class basis</b>.</li> </ul>
	<ul style="list-style-type: none"> <li>The Registrar may issue a <b>provisional refusal</b> after examination. The applicant may respond to the provisional refusal either by <b>filing written submissions or request for a hearing</b>.</li> <li>If the Registrar is not satisfied with the response, the application will be refused. <b>There will no longer be appeals to the Registrar</b>. The applicant may only appeal to the High Court within the prescribed time.</li> </ul>
Certificate of Registration	<ul style="list-style-type: none"> <li><b>A certificate of registration will no longer be issued by the Registry.</b></li> <li>If the proprietor wishes to receive a certificate of registration, a request has to be made to the Registry for a copy of the certificate of registration along with payment of the official fee.</li> </ul>

If you would like to seek protection of your trademarks in Malaysia, or if you have any queries on trademark registration, kindly contact **Ong Boo Seng** or the ZICO IP Partner you usually deal with.

*This alert is for general information only and is not a substitute for legal advice.*