

**Council for Trade-Related Aspects
of Intellectual Property Rights**

Original: English/
anglais/
inglés

**MAIN DEDICATED INTELLECTUAL PROPERTY LAWS AND REGULATIONS
NOTIFIED UNDER ARTICLE 63.2 OF THE AGREEMENT**

MALAYSIA

The present document reproduces the text¹ of the following laws and regulations, as notified by Malaysia under Article 63.2 of the Agreement (see document IP/N/1/MYS/1):

	<u>Page</u>
- Trade Marks Act 1976 (Act 175) and Regulations	2
- Trade Marks (Amendment) Act 2000 (Act A1078)	154
- Trade Marks (Amendment) Regulations 2001	167

**Conseil des aspects des droits de propriété
intellectuelle qui touchent au commerce**

**PRINCIPALES LOIS ET RÉGLEMENTATIONS CONSACRÉES À LA PROPRIÉTÉ
INTELLECTUELLE NOTIFIÉES AU TITRE DE L'ARTICLE 63:2 DE L'ACCORD**

MALAISIE

Le présent document contient le texte¹ des lois et réglementations ci-après, notifiées par la Malaisie au titre de l'article 63:2 de l'Accord (voir le document IP/N/1/MYS/1):

	<u>Page</u>
- Loi de 1976 sur les marques (Loi n° 175) et réglementation	2
- Loi de 2000 sur les marques (modification) (Loi n° A1078)	154
- Réglementation de 2001 sur les marques (modification)	167

**Consejo de los Aspectos de los Derechos de Propiedad
Intelectual relacionados con el Comercio**

**PRINCIPALES LEYES Y REGLAMENTOS DEDICADOS A LA PROPIEDAD INTELECTUAL
NOTIFICADOS EN VIRTUD DEL PÁRRAFO 2 DEL ARTÍCULO 63 DEL ACUERDO**

MALASIA

En el presente documento se reproduce el texto¹ de las leyes y reglamentos notificados por Malasia en virtud de lo dispuesto en el párrafo 2 del artículo 63 del Acuerdo (véase el documento IP/N/1/MYS/1)

	<u>Página</u>
- Ley de Marcas de Fábrica o de Comercio de 1976 (Ley 175) y Reglamentos	2
- Ley de Marcas de Fábrica o de Comercio de (Modificación) de 2000 (Ley A1078)	154
- Reglamento sobre Marcas de Fábrica o de Comercio (Modificación) de 2001	167

¹ Distributed in English only. The texts of these laws in the original language are available for consultation by interested Delegations at the WTO Secretariat./En anglais seulement. Les délégations intéressées peuvent consulter les textes de ces lois, dans leur langue d'origine, au Secrétariat de l'OMC./Distribuido en inglés solamente. Las delegaciones interesadas podrán consultar en la Secretaría de la OMC los textos de estas leyes en su idioma original.

TRADE MARKS ACT 1976 (ACT 175) & REGULATIONS

(AS AT 5TH FEBRUARY 2001)

TRADE MARKS ACT 1976

(Act 175)

ARRANGEMENT OF SECTIONS

PART I PRELIMINARY

1. Short title, commencement and application.
2. Extent of application.
3. Interpretation.

PART II ADMINISTRATION

4. Registrar, Deputy Registrar and Assistant Registrar.
- 4A. Protection of officers.
5. Central and regional trade marks offices.

PART III THE REGISTER OF TRADE MARKS

6. The Register.
7. Notice of trust.
8. Inspection of Register.
9. False entries in Register.

PART IV REGISTRABLE TRADE MARKS

10. Registrable trade marks.
11. *(Deleted)*.
12. Use by proposed registered user to be considered for the purpose of determining distinctiveness, etc.
13. Colour of trade mark.
14. Prohibition on registration.
- 14A. Where registration shall not be refused.
15. Where registration may be refused.
16. Use of name of another person.

17. Registration for particular goods or services.
18. Disclaimer.
19. Identical trade marks.
20. Concurrent use.
21. Jointly owned trade mark.
22. Association of trade marks.
23. Assignment of associated trade marks.
24. Series of trade marks.

PART V

APPLICATION FOR REGISTRATION

25. Registration.
26. Application may be accepted where trade mark is to be used by assignee or registered user.
27. Advertisement of acceptance of application.
28. Opposition to registration.
29. Non-completion of registration.

PART VI

REGISTRATION AND EFFECT OF REGISTRATION

30. Registration of trade mark.
31. Time for registration.
32. Duration of registration.
33. Words used as name or description of article, substance or service.
34. Powers of registered proprietor.
35. Rights given by registration.
36. Registration *prima facie* evidence of validity.
37. Registration conclusive.
38. Infringement of a trade mark.
39. Infringement of trade mark by breach of certain restriction.
40. Acts not constituting infringement.

PART VII

RENEWAL OF REGISTRATION

41. Renewal of registration.
42. Status of unrenewed trade mark.

PART VIII
CORRECTION AND RECTIFICATION OF REGISTER

- 43. Correction of Register.
- 44. Alterations of registered trade mark.
- 45. Rectification of the Register.
- 46. Provisions as to non-use of trade mark.
- 47. Registration of assignment.

PART IX
REGISTERED USER

- 48. Registered users.
- 49. Powers to vary, extend or cancel registration of a registered user.
- 50. *(Deleted)*.
- 51. Infringement proceeding.
- 52. Registered user not to assign.
- 53. *(Deleted)*.
- 54. *(Deleted)*.

PART X
ASSIGNMENT OF TRADE MARKS

- 55. Assignment and transmission of trade marks.

PART XI
CERTIFICATION TRADE MARKS

- 56. Certification trade marks.

PART XII
DEFENSIVE TRADE MARKS

- 57. Defensive registration of well known trade marks.
- 58. Defensive trade mark deemed to be associated trade mark.
- 59. Rectification of Register.
- 60. Application of Act.

PART XIII
LEGAL PROCEEDINGS, COST AND EVIDENCE

- 61. Certificate of validity.
- 62. Hearing of Registrar.
- 63. Costs.
- 64. Mode of giving evidence.
- 65. Sealed copies to be evidence.
- 66. Minister may declare documents of foreign state pertaining to trade marks to be admissible.
- 67. Discretionary power.
- 68. *(Deleted)*.
- 69. Appeal from Registrar.

PART XIV
CONVENTIONS AND INTERNATIONAL ARRANGEMENTS

- 70. Right of priority under Convention, etc.
- 70A. Temporary protection of trade marks in respect of goods or services which are the subject matters of international exhibitions.
- 70B. Protection of well-known trade marks.

PART XIVA
BORDER MEASURES

- 70C. Interpretation.
- 70D. Restriction on importation of counterfeit trade mark goods.
- 70E. Security.
- 70F. Secure storage of seized goods.
- 70G. Notice.
- 70H. Inspection, release, *etc.*, of seized goods.
- 70I. Forfeiture of seized goods by consent.
- 70J. Compulsory release of seized goods to importer.
- 70K. Compensation for failure to take action.
- 70L. Actions for infringement of registered trade mark.
- 70M. Disposal of seized goods ordered to be forfeited.
- 70N. Insufficient security.
- 70O. *Ex-officio* action.
- 70P. Regulations relating to border measures.

PART XV
MISCELLANEOUS

Section

71. Use of trade mark for export trade.
72. Use of trade mark where form of trade changes.
73. Preliminary advice by Registrar.
74. Powers of Registrar to amend document.
75. Other powers of Registrar.
76. Exercise of discretionary power.
77. Extension of time.
78. Extension of time by reason of error in trade marks office etc.
79. Address for service.
80. Agent.
81. Falsely representing a trade mark as registered.
82. Unregistered trade marks.
83. Regulations.
84. Repeal and saving.

TRADE MARKS ACT 1976*

(Act 175)

An Act to make better provisions in the law relating to trade marks and for other matters connected therewith.

[1st Sept. 1983]

BE IT ENACTED by the Duli Yang Maha Mulia Seri Paduka Baginda Yang di-Pertuan Agong with the advice and consent of the Dewan Negara and Dewan Rakyat in Parliament assembled, and by the authority of the same, as follows:

PART I PRELIMINARY

1. Short title, commencement and application.

(1) This Act may be cited as the **Trade Marks Act 1976**, and shall come into force on such date as the Minister may, by notification in the *Gazette*, appoint.

(2) This Act shall apply throughout Malaysia.

2. Extent of application.

(1) This Act shall apply to applications for trade marks made after the commencement of this Act and to the registrations of trade marks made on such applications.

(2) Subject to subsection (4) of section 6, this Act shall also apply to trade marks registered under the respective repealed Ordinances. ^[Subs. Act A881]

(3) Notwithstanding their repeal, the repealed Ordinances shall apply to applications for trade marks made before the commencement of this Act and to the registrations of trade marks made on such applications after the commencement of this Act.

3. Interpretation.

(1) In this Act, unless the context otherwise requires—

*As amended by Act A881, A1078.

“assignment” means assignment by act of the parties concerned;

“component regions of Malaysia” means the regions of West Malaysia, Sabah and Sarawak;

[Ins. Act
A881]

“Convention country” means a country which is a party to any multilateral treaty relating to trade marks to which Malaysia is also a party;

“Court” means the High Court;

[Ins. Act
A1078]

“geographical indication” means an indication which identifies any goods as originating in a country or territory or a region or locality in that country or territory, where a given quality, reputation or other characteristic of the goods is essentially attributable to their geographical origin;

[Ins. Act
A881]

“in the course of trade”, in relation to the provision of services, means in the course of business;

“limitations” means limitations of the right to the exclusive use of a trade mark given by the registration of the trade mark including limitations of that right as to—

(a) mode of use;

(b) use within a territorial area within Malaysia; or

[Am. Act
A881]

(c) use in relation to goods to be exported to a market outside Malaysia or use in relation to services to be provided in a place outside Malaysia;

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

[Ins. Act
A1078]

“Paris Convention” means the Paris Convention for the Protection of Industrial Property of 20 March, 1883 as revised at Stockholm on 14 July 1967;

“permitted use” in relation to a registered trade mark means the use of the trade mark by a registered user thereof in relation to goods or services with which he is connected in the course of trade and in respect of which the trade mark remains registered and he is registered as a registered user, being use which complies with any conditions or restrictions to which his registration is subject;

“prescribed” means, in relation to proceedings before the Court or preliminary thereto or connected therewith, prescribed by rules of court made by the Rules Committee constituted under the Courts of Judicature Act 1964, and in other cases, prescribed by this Act or any regulations made thereunder;

“prescribed foreign country” means a country declared by the Minister, by order published in the *Gazette*, as having made arrangements with Malaysia for the reciprocal protection of trade marks; [Ins. Act
A881]

“previous registers” means the registers of trade marks kept under the repealed Ordinances;

“Register” means the Register of Trade Marks kept under this Act;

“registered proprietor” in relation to a trade mark means the person for the time being entered in the Register as proprietor of the trade marks;

“registered trade mark” means a trade mark which is actually upon the Register;

“registered user” means a person who is registered as such under Part IX;

“registrable trade mark” means a trade mark which is capable of registration under the provisions of this Act;

“Registrar”, “Deputy Registrar” and “Assistant Registrar” mean respectively the Registrar of Trade Marks, the Deputy Registrar of Trade Marks and the Assistant Registrar of Trade Marks appointed under section 4;

“repealed Ordinances” means the Trade Marks Ordinance 1950, the Trade Marks Ordinance of Sabah and the Trade Marks Ordinance of Sarawak;

“specification” means the designation of goods or services in respect of which a trade mark or a registered user of a trade mark is registered or proposed to be registered; [Ins. Act
A881]

“trade mark” means, except in relation to Part XI, a mark 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 whether with or without an indication of the identity of that person, and means, in relation to Part XI, a mark registrable or registered under the said Part XI;

“transmission” means transmission by operation of law, devolution on the personal representatives of a deceased person and any other mode of transfer not being assignment;

[Ins. Act
A1078]

“TRIPS Agreement” means the Agreement on Trade-Related Aspects of Intellectual Property Rights 1994 which constitutes Annex 1C to the Agreement Establishing the World Trade Organization;

“word” includes an abbreviation of a word.

(2) In this Act—

- (a) references to 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 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 references to the use thereof as a statement or as part of a statement about the availability or performance of services.

[Ins. Act
A881]

PART II ADMINISTRATION

4. Registrar, Deputy Registrar and Assistant Registrar.

[Am. Act
A881]

(1) The Minister may appoint a person to be the Registrar of Trade Marks who shall, in addition to the powers and functions conferred by this Act, have superintendence over all matters relating to trade marks.

(2) The Minister may appoint such number of Deputy Registrars of Trade Marks as may be necessary for carrying out the provisions of this Act and the Deputy Registrars shall, subject to the control of the Registrar, have all the powers and functions of the Registrar under this Act except the power of delegation referred to in subsection (4).

(3) The Minister may appoint such number of Assistant Registrars of Trade Marks as may be necessary for carrying out the provisions of this Act and the powers and functions of an Assistant Registrar shall be as prescribed by the Minister or delegated by the Registrar pursuant to subsection (4).

(4) The Registrar may in relation to a particular matter or class of matters by writing under his hand delegate all or any of his powers or functions under this Act, except his power of delegation, to an Assistant Registrar so that the delegated powers and functions may be exercised by the Assistant Registrar so delegated but a delegation made under this subsection is revocable at the discretion of the Registrar and does not prevent the exercise of that power or function by the Registrar or Deputy Registrar.

(5) The Registrar shall have a seal of such device as may be approved by the Minister and the impressions of such seal shall be judicially noticed and admitted in evidence.

4A. Protection of officers.

No action or prosecution shall be brought, instituted or maintained in any Court against—

[Ins. Act
A1078]

- (a) the Registrar of Trade Marks;

- (b) a Deputy Registrar of Trade Marks; or
- (c) an Assistant Registrar of Trade Marks,

for any act or omission done in good faith in the performance of his functions and the exercise of his powers under this Act.

5. Central and regional trade marks offices.

(1) For the purposes of this Act there shall be established a Central Trade Marks Office which shall be located at Kuala Lumpur.

(2) In each of the States of Sabah and Sarawak there shall be established one regional trade marks office.

[Ins. Act
A881]

(2A) In addition to the regional trade marks office established in the States of Sabah and Sarawak, there may be established such number of trade marks offices as may be necessary for the purposes of this Act.

[Am. Act
A881]

(3) A document required or permitted by this Act to be submitted at the Central Trade Marks Office may be submitted at any trade marks office and reference in this Act to the submission at the Central Trade Marks Office includes reference to the submission at a trade marks office.

PART III

THE REGISTER OF TRADE MARKS

6. The Register.

(1) There shall be kept and maintained at the Central Trade Marks Office a Register of Trade Marks which shall contain—

- (a) all registered trade marks with the names, addresses and descriptions of their proprietors, notifications of assignments and transmissions, the names, addresses and descriptions of all registered users, disclaimers, conditions, limitations; and
- (b) such other matters relating to the trade marks as the Minister may from time to time prescribe.

[Act A1078]

(2) (*Deleted*).

[Am. Act
A1078]

(3) The previous registers of trade marks kept under the repealed Ordinances shall be incorporated with and form part of the Register in accordance with the entries in the previous registers immediately before this Act comes into force.

(4) The incorporation of the previous registers into the Register shall have the following effect:

- (a) where a trade mark has been registered and entered in all the previous registers by a proprietor for all three component regions of Malaysia, such a trade mark shall in its incorporation into the Register be deemed to be a registered trade mark in the name of such proprietor under this Act;
- (b) where a trade mark has been registered and entered in any of the previous registers by a proprietor for any one or two of the component regions of Malaysia, such a trade mark shall in its incorporation into the Register be deemed to be a registered trade mark in the name of such proprietor under this Act if on the date on which this Act comes into force—
 - (i) no identical trade mark or trade mark so nearly resembling the first-mentioned trade mark in respect of the same goods or same description of goods as is likely to deceive or cause confusion has been registered and entered in the remaining previous register or registers prior to the date of the coming into force of this Act by a different proprietor or proprietors for any of the remaining component regions of Malaysia; and
 - (ii) no application for the registration of an identical trade mark or trade mark so nearly resembling the first-mentioned trade mark in respect of the same goods or same description of goods as is likely to deceive or cause confusion has been made prior to the date of the coming into force of this Act by another person for any of the remaining component regions of Malaysia or, where it has been made, it is subsequently refused, abandoned or successfully opposed;

- (c) where a trade mark has been registered and entered in any of the previous registers by a proprietor for any one or two of the component regions of Malaysia and an identical trade mark or trade mark so nearly resembling the first-mentioned trade mark in respect of the same goods or same description of goods as is likely to deceive or cause confusion has been registered and entered in any of the previous registers by a different proprietor or proprietors for all or any one of the remaining component regions of Malaysia both the first-mentioned trade mark and the identical trade mark or trade mark so nearly resembling the first-mentioned trade mark in their incorporation into the Register shall be deemed to be registered trade marks in the names of the respective proprietors under this Act subject to concurrent use of the trade marks by their respective proprietors in accordance with subsection (1) of section 20;
- (d) where a trade mark has been registered and entered in any of the previous registers by a proprietor for any one or two of the component regions of Malaysia and only an application or applications for the registration of an identical trade mark or trade mark so nearly resembling the first-mentioned trade mark in respect of the same goods or same description of goods as is likely to deceive or cause confusion has been made prior to the date of the coming into force of this Act by another person for any of the remaining component regions of Malaysia, the first-mentioned trade mark in its incorporation into the Register shall be effective only in respect of the component region or regions of Malaysia in which it was originally registered unless the application or applications has or have been subsequently refused, abandoned or successfully opposed in which case the first-mentioned trade mark shall be deemed to be a registered trade mark in the name of such proprietor under this Act.

(5) Notwithstanding section 30 the date of the entry of a trade mark in any of the previous registers incorporated and forming part of the Register shall be deemed to be the date of the original registration of the trade mark.

7. Notice of trust.

Notice of a trust express, implied or constructive shall not be entered in the Register or be received by the Registrar.

8. Inspection of Register.

(1) The Register shall be open to the inspection of the public at such times as the Minister may by regulations prescribe.

(2) Certified copies or extracts of any entry in the Register sealed with the seal of the Registrar shall be given to any person requiring the same on payment of the prescribed fees.

(3) Certified copies of the Register shall be deposited in any trade marks office for the purpose of facilitating any search to be made by the public at such times as the Minister may by regulations prescribe and no copy or extract of any entry in such copies shall be made or given to any person. *[Am. Act A881]*

9. False entries in Register.

Every person who—

- (a) makes or causes to be made a false entry in the Register;
- (b) makes or causes to be made a false entry in any certified copy of the Register deposited in a trade marks office; *[Am. Act A881]*
- (c) makes or causes to be made a false document purporting to be a copy of an entry in the Register;
- (d) produces or tenders or causes to be produced or tendered in evidence any such document knowing such document or any entry therein to be false,

is guilty of an offence and is liable, on conviction, to a fine not exceeding five thousand ringgit or to a term of imprisonment not exceeding five years or to both.

PART IV

REGISTRABLE TRADE MARKS

10. Registrable trade marks.

(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;

[Am. Acts A881, A1078]

- (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.

[Am. Act
A1078]

(2) A name, signature or word which is not described in paragraph (a), (b), (c) or (d) of subsection (1) is not registrable unless it is by evidence shown to be distinctive.

[Ins. Act
A881;
Am. Act
A1078]

(2A) For the purposes of this section, “distinctive”, in relation to the trade mark registered or proposed to be registered in respect of goods or services, means the trade mark must be capable of distinguishing goods or services with which the proprietor of the trade mark is or may be connected in the course of trade from goods or services in the case of which no such connection subsists, either generally or, where the trade mark is registered or proposed to be registered, subject to conditions, amendments, modifications or limitations, in relation to use within the extent of the registration.

[Subs. Act
A1078]

(2B) In determining whether a trade mark is capable of distinguishing as aforesaid, regard may be had to the extent to which—

- (a) the trade mark is inherently capable of distinguishing as aforesaid; and
- (b) by reason of the use of the trade mark or of any other circumstances, the trade mark is in fact capable of distinguishing as aforesaid.

[Subs. Act
A1078]

(3) A trade mark may be registered in the Register in respect of any goods or services.

[Act A1078] **11. (Deleted).**

[Subs. Act
A881]

12. Use by proposed registered user to be considered for the purpose of determining distinctiveness, etc.

(1) Where an application for registration of a trade mark has been made by a person, and before the date of the application the trade mark had been used by a person other than the applicant under the control of and with the consent and authority of the applicant, and where an application is made by the applicant and that other person for the registration of that other person as a registered user of the trade mark immediately after the registration of the trade mark and the Registrar is satisfied that the other person is entitled to be registered as a registered user of the trade mark, the Registrar may, for the purpose of determining whether the trade mark is distinctive of or capable of distinguishing the goods or services of the applicant, treat use of the trade mark by that other person as equivalent to use of the trade mark by the applicant and may make an order that the trade mark is so distinctive or capable of distinguishing.

(2) An order of the Registrar under subsection (1) is subject to appeal to the Court.

(3) Where an order is made under subsection (1), the registration of the trade mark shall cease to have effect if at the expiration of the prescribed period, or such further period not exceeding six months as the Registrar may allow, that other person has not become registered as the registered user of the trade mark.

13. Colour of trade mark.

(1) A trade mark may be limited in whole or in part to one or more specified colours and, in any such case, the fact that the trade mark is so limited shall be taken into consideration for the purpose of determining whether the trade mark is distinctive.

(2) Where a trade mark is registered without limitations as to colour, it shall be deemed to be registered for all colours.

14. Prohibition on registration.

(1) A mark or part of a mark shall not be registered as a trade mark—

(a) if the use of which is likely to deceive or cause confusion to the public or would be contrary to law;

(b) if it contains or comprises any scandalous or offensive matter or would otherwise not be entitled to protection by any court of law;

[Ins. Act
A881]

(c) if it contains a matter which in the opinion of the Registrar is or might be prejudicial to the interest or security of the nation;

[Ins. Act
A1078]

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

[Ins. Act
A1078]

(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, and the interests of the proprietor of the well-known mark are likely to be damaged by such use;

[Ins. Act
A1078]

(f) if it contains or consists of a geographical indication with respect to goods not originating in the territory indicated, if use of the indication in the mark for such goods in Malaysia is of such a nature as to mislead the public as to the true place of origin of the goods; or

[Ins. Act
A1078]

(g) if it is a 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.

[Ins. Act
A1078]

(2) Article 6*bis* of the Paris Convention and Article 16 of the TRIPS Agreement shall apply for the purpose of determining whether a trade mark is a well-known trade mark.

[Ins. Act
A1078]

14A. Where registration shall not be refused.

(1) A trade mark shall not be refused registration by virtue of paragraphs (f) and (g) of section 14 if the application for

its registration had been made in good faith, or if it had been used continuously in good faith in the course of trade by the applicant for its registration or his predecessor in title, either—

(a) before the commencement of the Geographical Indications Act 2000; or

(b) before the geographical indication in question is protected in its country of origin.

(2) A trade mark shall not be refused registration by virtue of paragraphs (f) and (g) of section 14 if the geographical indication in question—

(a) has ceased to be protected; or

(b) has fallen into disuse,

in its country of origin.

15. Where registration may be refused.

The Registrar shall refuse to accept an application for the registration of a trade mark which contains or consists of any of the following marks or a mark so nearly resembling any of those marks as is likely to be taken for that mark:

(a) the word or words “Patent”, “Patented”, “By Royal Letters Patent”, “Registered”, “Registered Design” and “Copyright” or a word or words to the like effect in any language whatsoever; or

(b) any mark which is specifically declared by the Minister in any regulations made under this Act to be a prohibited mark.

16. Use of name of another person.

Where a person makes an application to register a trade mark which consists of or includes the name or representation of another person whether living or dead the Registrar may require the applicant to furnish him with the consent of that person if living or of the legal representative of that person if deceased before permitting the name or representation to be used as a trade mark. ^[Am. Act A881]

[Subs. Act
A881]

17. Registration for particular goods or services.

(1) A trade mark may be registered in respect of any or all of the goods comprised in a prescribed class of goods or in respect of any or all of the services comprised in a prescribed class of services.

(2) If any question arises as to the class in which goods or services are comprised that question shall be decided by the Registrar whose decision shall be final.

18. Disclaimer.

(1) If a trade mark—

(a) contains any part—

(i) which is not the subject of a separate application by the proprietor for registration as a trade mark; or

(ii) which is not separately registered by the proprietor as a trade mark; or

(b) contains matter which is common to the trade or business or is not distinctive,

the Registrar or the Court, in deciding whether the trade mark shall be entered or shall remain in the Register, may require as a condition of its being upon the Register, that the proprietor shall disclaim any right to the exclusive use of any such part or matter, to the exclusive use of which the Registrar or the Court holds him not to be entitled or that the proprietor shall make such other disclaimer as the Registrar or the Court may consider necessary for the purpose of defining his rights under the registration.

(2) No disclaimer on the Register shall affect any right of the proprietor of a trade mark except a right arising out of the registration of the trade mark in respect of which the disclaimer is made.

[Subs. Act
A881]

19. Identical trade marks.

(1) No trade mark shall be registered in respect of any goods or description of goods—

- (a) that is identical with a trade mark belonging to a different proprietor and entered in the Register in respect of the same goods or description of goods or in respect of services that are closely related to those goods; or
- (b) that so nearly resembles such a trade mark as is likely to deceive or cause confusion.

(2) No trade mark shall be registered in respect of any services or description of services—

- (a) that is identical with a trade mark belonging to a different proprietor and entered in the Register in respect of the same services or description of services or in respect of goods that are closely related to those services; or
- (b) that so nearly resembles such a trade mark as is likely to deceive or cause confusion.

(3) Where separate applications are made by different persons to be registered as proprietors respectively of trade marks which are identical or so nearly resembling each other as are likely to deceive or cause confusion and—

- (a) such applications are in respect of the same goods or description of goods; or
- (b) at least one of such applications is in respect of goods and the other or others is or are in respect of services closely related to those goods,

the Registrar may refuse to register any of them until their rights have been determined by the Court or have been settled by agreement in a manner approved by him or by the Court.

(4) Where separate applications are made by different persons to be registered as proprietors respectively of trade marks which are identical or so nearly resembling each other as are likely to deceive or cause confusion and—

- (a) such applications are in respect of the same services or description of services; or
- (b) at least one of such applications is in respect of services and the other or others is or are in respect of goods closely related to those services,

the Registrar may refuse to register any of them until their rights have been determined by the Court or have been settled by agreement in a manner approved by him or by the Court.

20. Concurrent use.

[Subs. Act
A881]

(1) Notwithstanding subsection (1) of section 19, in the case of honest concurrent use or of the circumstances described in paragraph (c) of subsection (4) of section 6 or of other special circumstances which, in the opinion of the Court or the Registrar, make it proper so to do, the Court or the 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 where the registration of the different proprietors—

- (a) is in respect of the same goods or description of goods;
or
- (b) in the case of at least one proprietor, is in respect of goods, and in the case of the other or others, is in respect of services closely related to those goods,

subject to such conditions, amendments, modifications or limitations, if any, as the Court or the Registrar, as the case may be, may think right to impose.

[Ins. Act
A881]

(1A) Notwithstanding subsection (2) of section 19, in the case of honest concurrent use or of other special circumstances which, in the opinion of the Court or the Registrar, make it proper so to do, the Court or the 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 where the registration of the different proprietors—

- (a) is in respect of the same services or description of services; or
- (b) in the case of at least one proprietor, is in respect of services, and in the case of the other or others, is in respect of goods closely related to those services,

subject to such conditions, amendments, modifications or limitations, if any, as the Court or the Registrar, as the case may be, may think right to impose.

(2) The Registrar shall not refuse to register a trade mark which is identical to or so nearly resembling another trade mark in the Register if the applicant of the first-mentioned trade mark or his predecessor in business has continuously used that trade mark from a date before—

- (a) the use of that other trade mark by the registered proprietor or his predecessor in business or by a registered user; or

- (b) the registration of that other trade mark by the registered proprietor or his predecessor in business,

whichever is the earlier.

21. Jointly owned trade mark.

(1) Where two or more persons are interested in a trade mark and none of them is entitled as between himself or the other or others to use the trade mark except—

- (a) on behalf of both or all of them; or
(b) in relation to goods or services with which both or all of them are connected in the course of trade,

both or all of them may be registered as joint proprietors of the trade mark and this Act has effect in relation to any rights of such persons to the use of the trade mark as if those rights were rights of a single person.

(2) Subject to subsection (1), nothing in this Act authorises the registration of two or more persons who use a trade mark independently, or propose so to use it, as joint proprietors of the trade mark.

22. Association of trade marks.

(1) Where a trade mark which is registered or is the subject of an application for registration in respect of any goods— *[Subs. Act A881]*

- (a) is identical with another trade mark which is registered or is the subject of an application for registration in the name of the same proprietor in respect of the same goods or description of goods or in respect of services that are closely related to those goods; or
(b) is so nearly resembling it as is likely to deceive or cause confusion if used by a person other than the proprietor,

the Registrar may at any time require that the trade marks be entered on the Register as associated trade marks.

[Ins. Act A881]

(1A) Where a trade mark which is registered or is the subject of an application for registration in respect of any services—

- (a) is identical with another trade mark which is registered or is the subject of an application for registration in the name of the same proprietor in respect of the same services or description of services or in respect of goods that are closely related to those services; or
(b) is so nearly resembling it as is likely to deceive or cause confusion if used by a person other than the proprietor,

the Registrar may at any time require that the trade marks be entered on the Register as associated trade marks.

(2) On application made in the prescribed manner by the registered proprietor of two or more associated trade marks the Registrar may dissolve the association as respects any of them if he is satisfied that there would be no likelihood of deception or confusion being caused if that trade mark were used by another person in relation to any of the goods or services in respect of which it is registered and may amend the Register accordingly.

(3) A decision of the Registrar under subsection (2) is subject to appeal to the Court.

23. Assignment of associated trade marks.

(1) Associated trade marks shall be assignable or transmissible only as a whole and not separately but they shall for all other purposes be deemed to have been registered as separate trade marks.

(2) Where under this Act use of a registered trade mark is required to be proved for any purpose, the Court or the Registrar may, if and so far as it or he shall think right, accept use of an associated trade mark or of the trade mark with additions and alterations not substantially affecting its identity as an equivalent for such use.

(3) The foregoing provisions apply in relation to proof of use of any registered trade mark and not in relation only to proof of use of a trade mark which is one of two or more associated trade marks.

24. Series of trade marks.

(1) Where several trade marks in respect of the same goods or description of goods in a single class or in respect of the same services or description of services in a single class resemble each other in material particulars but differ in respect of— *[Am. Act A88I]*

- (a) statements or representations as to the goods or services in respect of which the trade marks are used or proposed to be used;
- (b) statements or representations as to number, price, quality or names of places;
- (c) other matter which is not distinctive and does not substantially affect the identity of the trade marks; or
- (d) colour,

and a person who claims to be the proprietor thereof seeks to register the trade marks, the trade marks may be registered as a series in one registration.

(2) All trade marks registered in a series shall be deemed to be and shall be registered as associated trade marks.

PART V
APPLICATION FOR REGISTRATION

25. Registration.

(1) Any person claiming to be the proprietor of a trade mark used or proposed to be used by him may make application to the Registrar for the registration of that mark in the Register in the prescribed manner. *[Am. Act
A1078]*

*[Am. Act
A881]* (2) An application shall not be made in respect of goods or services comprised in more than one class.

(3) Subject to the provisions of this Act, the Registrar may refuse the application or may accept it absolutely or subject to such conditions, amendments, modifications or limitations, if any, as he may think right to impose.

(4) In the case of refusal or conditional acceptance the Registrar shall, if required by the applicant, state in writing the grounds of his decision and the material used by him in arriving at the same.

(5) A decision of the Registrar under subsection (3) is subject to appeal to the Court.

(6) An appeal under this section shall be made in the prescribed manner and the Court shall, if required, hear the applicant and the Registrar, and shall make an order determining whether, and subject to what conditions, amendments, modifications or limitations, if any, the application is to be accepted.

(7) The appeal shall be heard on the material stated by the Registrar to have been used by him in arriving at his decision and no further grounds of objection to the acceptance of the application shall be allowed to be taken by the Registrar other than those so stated except by leave of the Court.

(8) Where any further grounds of objection are taken the applicant shall be entitled to withdraw his application without payment of costs on giving notice in the prescribed manner.

(9) The Registrar or the Court, as the case may be, may at any time, whether before or after acceptance, correct any error in or in connection with the application or may permit the applicant to amend his application upon such terms as he or it may think fit.

(10) Any application submitted and accepted under this section shall notwithstanding any correction or amendment permitted by the Registrar or the Court to be made in such application be deemed to have been made on the date of its original submission.

(11) (*Deleted*).

[Act A1078]

(12) Without prejudice to subsection (10) where after the acceptance of an application for registration of a trade mark but before the registration of the trade mark the Registrar is satisfied—

- (a) that the application has been accepted in error; or
- (b) that in the special circumstances of the case the trade mark shall not be registered or shall be registered subject to additional or different conditions or limitations,

the Registrar may withdraw the acceptance and proceed as if the application had not been accepted or, in respect only of a trade mark which shall be registered subject to additional or different conditions or limitations, reissue a new acceptance subject to additional or different conditions or limitations. [Am. Act A881]

26. Application may be accepted where trade mark is to be used by assignee or registered user.

(1) An application for the registration of a trade mark in respect of any goods or services shall not be refused nor shall permission for such registration be withheld on the ground that it appears that the applicant does not use or propose to use the trade mark—

- (a) if the Registrar is satisfied that a body corporate is about to be constituted and that the applicant intends to assign the trade mark to the corporation with a view to the use thereof in relation to those goods by the corporation; or
- (b) if an application has been made for the registration of a person as a registered user of the trade mark, and the Registrar is satisfied that the proprietor intends it to be used by that person in relation to those goods or services and the Registrar is also satisfied that that person will be registered as a registered user thereof immediately after registration of the trade mark. [Am. Act A881]

(2) The Registrar may, as a condition of the exercise of the power conferred by subsection (1) in favour of the applicant, require him to give security for the costs of any proceedings before him relative to any opposition and, in default of such security being duly given, may treat the application as abandoned.

(3) Where a trade mark is registered in respect of any goods or services under the power conferred by subsection (1), then unless the corporation has been registered as the proprietor of the trade mark in respect of those goods or services within a period of six months, the registration shall cease to have effect in respect thereof at the expiration of that period and the Registrar shall amend the Register accordingly.

27. Advertisement of acceptance of application.

(1) When an application for registration of a trade mark has been accepted whether absolutely or subject to conditions, amendments, modifications or limitations, the Registrar shall, as soon as may be after acceptance, cause the application as accepted to be advertised in the prescribed manner.

*[Subs. Act
A881]*

(2) The advertisement shall set forth all conditions, amendments, modifications and limitations subject to which the application has been accepted except that the Registrar may cause an application for registration of a trade mark to be advertised before acceptance thereof if the considerations in subsection (2B) of section 10 or subsection (1A) of section 11 apply or in any other case where it appears to him that it is expedient by reason of any exceptional circumstances to do so.

(3) Where an application has been advertised under subsection (2) the Registrar may, if he thinks fit, advertise it again when it has been accepted but he shall not be bound to do so.

28. Opposition to registration.

(1) Any person may, within the prescribed time from the date of the advertisement of an application for the registration of a trade mark, give notice to the Registrar and applicant of opposition to the registration.

(2) The notice shall be given in writing in the prescribed manner and shall include a statement of the grounds of opposition.

(3) The applicant shall, within the prescribed time after the receipt of the notice of opposition, send to the Registrar and the opponent a counter-statement, in the prescribed manner, of the grounds for his application, and, if he does not do so, he shall be deemed to have abandoned his application. *[Subs. Act
A881]*

(3A) If the applicant submits a counter-statement under subsection (3), the opponent and applicant shall file evidence and exhibits in the prescribed manner and within the prescribed time in support of the opposition or the counter-statement, as the case may be, to be adduced in the prescribed manner, and if the opponent or applicant fails to do so, the opposition or application, as the case may be, shall be treated as abandoned. *[Ins. Act A881]*

(3B) If the applicant files evidence and exhibits under subsection (3A), the opponent may, within the prescribed time, send to the Registrar and applicant evidence in reply to be adduced in the prescribed manner. *[Ins. Act A881]*

(4) After considering the evidence and exhibits and after giving the applicant and the opponent an opportunity of making written submissions, the Registrar shall decide whether— *[Subs. Act A881]*

- (a) to refuse to register the trade mark;
- (b) to register the trade mark absolutely; or
- (c) to register the trade mark subject to such conditions, amendments, modifications or limitations as he may think fit.

(5) A decision of the Registrar under subsection (4) is subject to appeal to the Court.

(6) An appeal under this section shall be made in the prescribed manner and the Court shall, if required, hear the parties and the Registrar, and shall make an order determining whether, and subject to what conditions, amendments, modifications or limitations, if any, registration is to be permitted.

(7) On the hearing of an appeal under this section any party may, either in the manner prescribed or by special leave of the Court, bring forward further material for the consideration of the Court but no further grounds of objection to the registration of a trade mark shall be allowed to be taken by the opponent or the Registrar other than those stated by the opponent except by leave of the Court.

(8) Where any further grounds of objection are taken the applicant shall be entitled to withdraw his application without payment of the costs of the opponent on giving notice as prescribed.

(9) In any appeal under this section the Court may after hearing the Registrar, permit the trade mark proposed to be registered to be modified in any manner not substantially affecting the identity of the trade mark, but in any such case the trade mark as modified shall be advertised in the prescribed manner before being registered.

[Am. Act
A881]

(10) If a person giving notice of opposition or an applicant sending a counter-statement after receipt of such a notice, or an appellant, neither resides nor carries on business in Malaysia, the Registrar or the Court may require him to give security for costs of the proceedings relative to the opposition, application or appeal, as the case may be, and in default of such security being duly given, may treat the opposition, application, or appeal, as the case may be, as abandoned.

29. Non-completion of registration.

[Am. Act
A881]

(1) When an application for registration of a trade mark is not completed within twelve months from the date of the application by reason of default on the part of the applicant, the Registrar may, after giving notice in writing of the non-completion to the applicant in the prescribed manner, treat the application as abandoned unless it is completed within the time specified in that behalf in the notice.

[Am. Act
A881]

(2) Where an appeal under any of the provisions of this Act has been instituted in respect of an application for registration of a trade mark, the Registrar shall not give notice of non-completion of the application until the expiration of three months after the determination of the appeal or until the expiration of such further time as the Court may allow.

PART VI

REGISTRATION AND EFFECT OF REGISTRATION

30. Registration of trade mark.

(1) When an application for registration of a trade mark in the Register has been accepted and either— [Am. Act
A1078]

- (a) the application has not been opposed and the time for opposition has expired; or
- (b) the application has been opposed and the opposition has been decided in favour of the applicant,

the Registrar shall, unless the application has been accepted in error, register the trade mark in the Register on payment of the prescribed fees in the name of the proprietor, and the trade mark so registered shall be registered as of the date of application for registration and that date shall be deemed for the purpose of this Act to be the date of registration.

(2) On the registration of a trade mark the Registrar shall issue to the applicant a certificate of the registration of the trade mark in the prescribed form under the seal of the Registrar.

31. Time for registration.

(1) Subject to subsection (2) a trade mark shall not be registered after twelve months from the date of the advertisement of the acceptance of the application for registration of the trade mark.

(2) Where the registration of a trade mark is delayed by—

- (a) opposition to the registration of the trade mark;
- (b) any appeal made to the Court; or
- (c) an action on the part of the Central Trade Marks office *[Ins. Act A881]* or any trade marks office,

that trade mark may be registered within such time as directed by the Registrar or the Court respectively.

(3) Where a trade mark has not been registered within the time applicable to it the application shall lapse.

32. Duration of registration.

[Am. Act A881]

(1) The registration of a trade mark shall be for a period of ten years but may be renewed from time to time in accordance with this Act.

(2) Where a trade mark is registered under the repealed Ordinances and is incorporated into and forms part of the Register under this Act the registration of such trade mark unless renewed under this Act shall be for a period equal to the unexpired portion of the period for which the trade mark was registered or renewed under the repealed Ordinances.

(3) The registration of a trade mark may be renewed from time to time in accordance with Part VII.

33. Words used as name or description of article, substance or service.

[Subs. Act
A881]

(1) The registration of a trade mark shall not be deemed to have become invalid by reason only of any use after the date of the registration of a word or words which the trade mark contains or of which it consists as the name or description of an article, a substance or a service.

(2) If it is proved either—

(a) that there is a well known and established use of the word or words as the name or description of the article or substance by a person or persons carrying on a trade therein, not being use in relation to goods connected in the course of trade with the proprietor or a registered user of the trade mark on, in the case of a certification trade mark, goods certified by the proprietor;

(b) that the article or substance was formerly manufactured under a patent, that a period of two years after the cesser of the patent has elapsed and that the word or words is or are the only practicable name or description of the article or substance; or

[Ins. Act
A881]

(c) that there is a well known and established use of the word or words as the name or description of some service by a person or persons providing services which include that service, not being use in relation to services the provision of which the proprietor or registered user of the trade mark is connected to in the course of trade,

subsection (3) shall have effect.

(3) When the facts mentioned in paragraph (a), (b) or (c) of subsection (2) are proved with respect to any word or words then—

(a) if the trade mark consists solely of that word or those words, the registration of the trade mark, so far as regards registration in respect of the article, substance or service in question or of any goods or service of the same description, shall be deemed for the purpose of section 45 to be an entry wrongly remaining in the Register;

- (b) if the trade mark contains the word or those words and other matter, the Court or the Registrar in deciding whether the trade mark shall remain on the Register so far as regards registration in respect of the article, substance or service in question or of any goods or service of the same description may in case of a decision in favour of its remaining on the Register require as a condition thereof that the proprietor shall disclaim any right to the exclusive use in relation to that article, substance or service in question or any goods or service of the same description of that word or those words so, however, that no disclaimer on the Register shall affect any right of the proprietor of a trade mark except such as arising out of the registration of the trade mark in respect of which the disclaimer is made; and
- (c) for the purposes of any other legal proceedings relating to the trade mark—
 - (i) if the trade mark consists solely of that word or those words, all rights of the registered proprietor to the exclusive use of the trade mark in relation to the article, substance or service in question or to any goods or service of the same description; or
 - (ii) if the trade mark contains that word or those words and other matter, all rights of the registered proprietor to the exclusive use of the word or those words, in such relation as in subparagraph (1),

shall be deemed to have ceased on the date at which the use mentioned in paragraph (a) or (c) of subsection (2) first became well known and established or at the expiration of the period of two years mentioned in paragraph (b) of subsection (2).

(4) No word which is the commonly used and accepted name of any single chemical element or single chemical compound, as distinguished from a mixture, shall be registered as a trade mark in respect of a chemical substance or preparation except that this subsection shall not have effect in relation to a word which is used to denote only a brand or make of the element or compound as made by the proprietor or a registered user of the trade mark as distinguished from the element or compound as made by others and in association with a suitable name or description open to the public use.

34. Powers of registered proprietor.

Subject to the provisions of this Act,—

- (a) the person for the time being entered in the Register as registered proprietor of a trade mark shall, subject to any rights appearing from such Register to be vested in any other person, have power to assign the same and give good discharges for any consideration for the assignment;
- (b) any equities in respect of a trade mark may be enforced in like manner as in respect of any other personal property.

35. Rights given by registration.

[Am. Act
A1078]

(1) Subject to the provisions of this Act, the registration of a person as registered proprietor of a trade mark (other than a certification 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 any conditions, amendments, modifications or limitations entered in the Register.

(2) Where two or more persons are proprietors of registered trade marks which are identical or nearly resembling each other rights of exclusive use of either of those trade marks are not (except so far as their respective rights have been defined by the Registrar or the Court) acquired by any one of those persons as against any other of those persons by registration of the trade mark but each of those persons have the same rights as against other persons (not being registered users) as he would if he were the sole registered proprietor. [Am. Act
A881]

36. Registration *prima facie* evidence of validity.

In all legal proceedings relating to a registered trade mark (including applications under section 45) the fact that a person is registered as proprietor of the trade mark shall be *prima facie* evidence of the validity of the original registration of the trade mark and of all subsequent assignments and transmissions thereof.

37. Registration conclusive.

In all legal proceedings relating to a trade mark registered in the Register (including applications under section 45) the original registration of the trade mark under this Act shall, after the expiration of seven years from the date thereof, be taken to be valid in all respects unless it is shown— [Am. Act
A1078]

- (a) that the original registration was obtained by fraud;
- (b) that the trade mark offends against section 14; or
- (c) that the trade mark was not, at the commencement of the proceedings, distinctive of the goods or services of the registered proprietor,

except that this section shall not apply to a trade mark registered under the repealed Ordinances and incorporated in the Register pursuant to subsection (3) of section 6 until after the expiration of three years from the commencement of this Act.

38. Infringement of a trade mark.

(1) A registered trade mark is infringed by a person who, not being the registered proprietor of the trade mark or registered

user of the trade 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 trade in relation to goods or services in respect of which the trade mark is registered in such a manner as to render the use of the mark likely to be taken either—

- (a) as being use as a trade mark;
- (b) in a case in which the use is use upon the goods or in physical relation thereto or in an advertising circular, or other advertisement, issued to the public, as importing a reference to a person having the right either as registered proprietor or as registered user to use the trade mark or to goods with which the person is connected in the course of trade; or
- (c) in a case in which the use is use at or near the place where the services are available or performed or in an advertising circular or other advertisement issued to the public, as importing a reference to a person having a right either as registered proprietor or as registered user to use the trade mark or to services with the provision of which the person is connected in the course of trade.

[Ins. Act
A881]

[Act A1078]

(2) (*Deleted*).

39. Infringement of trade mark by breach of certain restriction.

[Am. Act
A1078]

(1) Where, by notice upon goods or upon the container of goods, the registered proprietor or a registered user of a trade mark registered in the Register makes a statement prohibiting the doing of an act to which this section applies, a person who, being the owner for the time being of the goods, does that act, or authorises it to be done, in relation to the goods in the course of trade or with a view to a dealing with the goods in the course of trade, shall be deemed to infringe the trade mark unless—

- (a) at the time when he agreed to buy the goods he acted in good faith without notice that the statement appeared on the goods; or
- (b) he became the owner of the goods by virtue of a title derived from another person who had agreed to buy the goods.

(2) The acts to which this section applies are—

- (a) the application of the trade mark upon goods after they have suffered alteration to their state, conditions, get-up or packing;
- (b) in a case in which the trade mark is upon the goods the alteration, partial removal or partial obliteration of the trade mark, the application of some other trade mark to the goods or the addition to the goods of other matter in writing or otherwise that is likely to injure the reputation of the trade mark; and
- (c) in the case in which the trade mark is upon the goods and there is also other matter upon the goods indicating a connection in the course of trade between the registered proprietor or registered user and the goods, the removal or obliteration, whether wholly or partially, of the trade mark unless that other matter is wholly removed or obliterated.

(3) In this section references in relation to goods to the registered proprietor, to a registered user, and to the registration of a trade mark shall be construed, respectively, as references to the registered proprietor of the trade mark, to a registered user of the trade mark and to the registration of the trade mark in respect of those goods and the expression “upon” includes, in relation to goods, a reference to physical relation to the goods.

40. Acts not constituting infringement.

(1) Notwithstanding anything contained in this Act, the following acts do not constitute an infringement of a trade mark—

- (a) the use in good faith by a person of his own name or the name of his place of business or the name of the place of business of any of his predecessors in business;
- [Am. Act A881] (b) the use in good faith by a person of a description of the character or quality of his goods or services, and in the case of goods not being a description that would be likely to be taken as importing any reference as is mentioned in paragraph (b) of subsection (1) of section 38 or paragraph (b) of subsection (3) of section 56;
- (c) the use by a person of a trade mark in relation to goods or services in respect of which he has by himself or his predecessors in business, continuously used the trade mark from a date before—
 - (i) the use of the registered trade mark by the registered proprietor, by his predecessors in business or by a registered user of the trade mark; or
 - (ii) the registration of the trade mark, whichever is the earlier;
- [Am. Act A881] (d) in relation to goods connected in the course of trade with the registered proprietor or a registered user of the trade mark if, as to those goods or a bulk of which they form part, the registered proprietor or the registered user in conforming to the permitted use has applied the trade mark and has not subsequently removed or obliterated it;
- [Ins. Act A881] (dd) the use by a person of a trade mark in relation to goods or services to which the registered proprietor or registered user has at any time expressly or impliedly consented to;
- (e) the use of the trade mark by a person in relation to goods or services adapted to form part of, or to be accessory to, other goods or services in relation to which the trade mark has been used without infringement of the right given or might for the time being be so used, if the use of the trade mark is reasonably necessary in order to indicate that the goods or services are so adapted and neither the purpose nor the effect of the use of trade mark is to indicate otherwise than in accordance with the facts a connection in the course of trade between any person and the goods or services; and

- (f) the use of a trade mark, which is one of two or more registered trade marks which are substantially identical, in exercise of the right to the use of that trade mark given by registration as provided by this Act.

(2) Where a trade mark is registered subject to conditions, amendments, modifications or limitations, the trade mark is not infringed by the use of the trade mark in any manner in relation to goods to be sold or otherwise traded in in a place or in relation to goods to be exported to a market or in relation to services to be provided in a place or in any other circumstances to which having regard to those conditions, amendments, modifications or limitations the registration does not extend. *[Am. Act A88I]*

PART VII RENEWAL OF REGISTRATION

41. Renewal of registration.

(1) The Registrar shall, on application made by the registered proprietor of a trade mark in the prescribed manner and within the prescribed period, renew the registration of the trade mark for a period of ten years from the date of expiration of the original registration, or of the last renewal of registration, as the case may be, and this date shall hereinafter be referred to as “the date of expiration of the last registration”. *[Am. Act A88I]*

(2) At the prescribed time before the date of expiration of the last registration of a trade mark the Registrar shall send notice in the prescribed manner to the registered proprietor of the date of expiration of the last registration and the conditions as to payment of fees upon which the renewal of the registration may be obtained and if such conditions have not been duly complied with, the Registrar may remove the trade mark from the Register subject to such conditions, if any, as to its restoration to the Register as may be prescribed upon payment of fees for restoration. *[Am. Act A88I]*

(3) Notwithstanding subsection (2), the registration of a trade mark shall not be renewed where the application for renewal is made after one year has lapsed from the date of expiration of the last registration. *[Ins. Act A88I]*

42. Status of unrenewed trade mark.

*[Am. Act
A881]*

Where a trade mark has been removed from the Register for non-payment of the fee for renewal, it shall, nevertheless, for the purpose of an application for the registration of a trade mark within one year from the date of expiration of the last registration be deemed to be a trade mark which is already on the Register except that this section shall not have effect when the Registrar is satisfied either—

- (a) that there has been no use in good faith of the trade mark which has been removed during the two years immediately preceding its removal; or
- (b) that no deception or confusion is likely to arise from the use of the trade mark which is the subject of the application for registration by reason of any previous use of the trade mark which has been removed.

PART VIII

CORRECTION AND RECTIFICATION OF REGISTER

43. Correction of Register.

(1) The Registrar may, on request made in the prescribed manner by the registered proprietor of a trade mark, amend or alter the Register—

- (a) by correcting an error or entering any change in the name, address or description of the registered proprietor of a trade mark;
- (b) by cancelling the entry of a trade mark in the Register;
- (c) by amending the specification of the goods or services in respect of which the trade mark is registered or entering a disclaimer or memorandum relating to the trade mark without extending in any way the rights given by the existing registration of the trade mark,

and may make any consequential amendment or alteration in the certificate of registration and for that purpose may require the certificate of registration to be submitted to him.

(2) The Registrar may on the request made in the prescribed manner by a registered user of a trade mark correct an error or enter any change in the name, address or description of that registered user.

(3) A decision of the Registrar under this section is subject to appeal to the Court.

44. Alterations of registered trade mark.

(1) The registered proprietor of a trade mark may apply in the prescribed manner to the Registrar for leave to add to or alter the trade mark in any manner not substantially affecting the identity thereof and the Registrar may refuse leave or may grant it on such terms and subject to such limitations as he may think fit.

(2) The Registrar may cause an application under this section to be advertised in the prescribed manner in any case where it appears to him that it is expedient to do so, and if within the prescribed time from the date of the advertisement any person gives notice to the Registrar in the prescribed manner of opposition to the application, the Registrar shall, after hearing the parties if so required, decide the matter.

(3) A decision of the Registrar under this section is subject to appeal to the Court.

(4) Where leave under subsection (1) is granted the trade mark, as altered, shall be advertised in the prescribed manner unless it has already been advertised in the form to which it has been altered in an advertisement under subsection (2).

45. Rectification of the Register.

(1) Subject to the provisions of this Act—

(a) the Court may on the application in the prescribed manner of any person aggrieved by the non-insertion in or omission from the Register of any entry or by any entry made in the Register without sufficient cause or by any entry wrongfully remaining in the Register, or by any error or defect in any entry in the Register, make such order for making, expunging or varying such entry as it thinks fit;

- (b) the Court may in any proceeding under this section decide any question that may be necessary or expedient to decide in connection with the rectification of the Register;
- (c) in case of fraud in the registration, assignment or transmission of a registered trade mark or if in his opinion it is in the public interest to do so, the Registrar may himself apply to the Court under this section;
- (d) an order of the Court rectifying the Register shall direct that notice of the rectification be served on the Registrar in the prescribed manner and the Registrar shall upon receipt of the notice rectify the Register accordingly.

[Act A1078] (2) (*Deleted*).

46. Provisions as to non-use of trade mark.

[Am. Act
A881]

(1) Subject to this section and to section 57, the Court may, on application by a person aggrieved, order a trade mark to be removed from the Register in respect of any of the goods or services in respect of which it is registered on the ground—

- (a) that the trade mark was registered without an intention in good faith, on the part of the applicant for registration or, if it was registered under subsection (1) of section 26, on the part of the body corporate or registered user concerned, to use the trade mark in relation to those goods or services and that there has in fact been no use in good faith of the trade mark in relation to those goods or services by the registered proprietor or registered user of the trade mark for the time being up to the date one month before the date of the application; or
- (b) that up to one month before the date of the application a continuous period of not less than three years had elapsed during which the trade mark was a registered trade mark and during which there was no use in good faith of the trade mark in relation to those goods or services by the registered proprietor or registered user of the trade mark for the time being.

(2) Except where an applicant has been permitted under section 20 to register an identical or a nearly resembling trade mark in respect of the goods or services to which the application relates or the Court is of the opinion that the applicant can properly be permitted to register the trade mark, the Court may refuse an application made under subsection (1)— [Subs. Act
A881]

- (a) in relation to any goods, if there has been, before the relevant date or during the relevant period, as the case may be, use in good faith of the trade mark by the registered proprietor of the trade mark for the time being in relation to goods of the same description, being goods in respect of which the trade mark is registered; and
- (b) in relation to any services, if there has been, before the relevant date or during the relevant period, as the case may be, use in good faith of the trade mark by the registered proprietor of the trade mark for the time being in relation to services of the same description, being services in respect of which the trade mark is registered.

(3) Where in relation to goods in respect of which a trade mark is registered—

- (a) the matters referred to in paragraph (b) of subsection (1) are shown as far as regards failure to use the trade mark in relation to goods to be sold or otherwise traded in in a particular place in Malaysia (otherwise than for export from Malaysia) or in relation to goods to be exported to a particular market outside Malaysia; and
- (b) a person has been permitted under section 20 to register an identical or nearly resembling trade mark in respect of those goods under a registration extending to the use in relation to goods to be sold or otherwise traded in in that place (otherwise than for export from Malaysia) or in relation to goods to be exported to that market, or the Court is of the opinion that that person might properly be permitted to register the trade mark, [Am. Act
A881]

the Court may, on application by that person, direct that the registration of the first-mentioned trade mark shall be subject to such conditions, amendments, modifications or limitations as the Court thinks proper for securing that that registration shall cease to extend to use of the trade mark in relation to goods to be sold or otherwise traded in in that place (otherwise than for export from Malaysia) or in relation to goods to be exported to that market. [Am. Act
A881]

[Ins. Act
A881]

(3A) Where in relation to services in respect of which a trade mark is registered—

- (a) the matters referred to in paragraph (b) of subsection (1) are shown as far as regards failure to use the trade mark in relation to services provided in a particular place in Malaysia; and
- (b) a person has been permitted under section 20 to register an identical or a nearly resembling trade mark in respect of those services under a registration extending to the use in relation to services provided in that place, or the Court is of the opinion that that person might properly be permitted to register the trade mark,

the Court may, on application by that person, direct that the registration of the first-mentioned trade mark shall be subject to such conditions, amendments, modifications or limitations as the Court thinks proper for securing that that registration shall cease to extend to use of the trade mark in relation to services provided in that place.

(4) An applicant is not entitled to rely for the purpose of paragraph (b) of subsection (1) or for the purpose of subsection (3) or (3A) on any failure to use a trade mark if failure is shown to have been due to special circumstances in the trade and not to an intention not to use or to abandon the trade mark in relation to the goods to which the application relates.

47. Registration of assignment.

(1) Where a person becomes entitled by assignment or transmission to a registered trade mark he shall make application to the Registrar to register his title and the Registrar shall, on receipt of the application and proof of title to his satisfaction, register that person as the proprietor of the trade mark in respect of the goods or services in respect of which the assignment or transmission has effect and cause particulars of the assignment or transmission to be entered in the Register.

(2) A decision of the Registrar under subsection (1) is subject to appeal to the Court.

(3) Except in the case of an appeal under this section or of an application under section 45 a document or instrument in respect of which no entry has been made in the Register in accordance with subsection (1) shall not, unless the Court otherwise directs, be admissible in evidence in Court to prove title to a registered trade mark.

PART IX
REGISTERED USER

48. Registered users.

(1) Subject to the provisions of this section, where the registered proprietor of a trade mark grants, by lawful contract, a right to any person to use the trade mark for all or any of the goods or services in respect of which the trade mark is registered, that person may be entered on the Register as a registered user of the said trade mark whether with or without any conditions or restrictions, provided that it shall be a condition of any such registration that the registered proprietor shall retain and exercise control over the use of the trade mark and over the quality of the goods or services provided by the registered user in connection with that trade mark. *[Subs. Act
A881]*

(2) Where it is proposed that a person shall be registered as a registered user of a trade mark, the registered proprietor shall submit an application to the Registrar for the registration of that person as a registered user of the trade mark and such application shall be accompanied by the prescribed fee and the following information:

- (a) the representation of the registered trade mark;
- (b) the names, addresses, and addresses for service of the parties;
- (c) the goods or services in respect of which the registration is proposed;
- (d) any conditions or restrictions proposed with respect to the characteristics of the goods or services, to the mode or place of permitted use or to any other matter; and
- (e) whether the permitted use is to be for a period or without limit of period, and if for a period, the duration of that period.

(3) The registered proprietor shall furnish the Registrar with such further documents, information or evidence as may be required by the Registrar or any regulations made under this Act.

(4) On receipt of an application for registration of a person as a registered user of a trade mark under subsection (2), the Registrar shall enter on the Register all the particulars required to be provided thereunder.

(5) Where a person has been registered as a registered user of a trade mark, the use of that trade mark by the registered user within the limits of his registration shall be deemed to be use by the registered proprietor of the trade mark to the same extent as the use of the trade mark by the registered user and shall be deemed not to be use by any other person.

(6) The provisions of subsection (5) shall cease to have effect with regard to any registered user of a trade mark—

- (a) if the trade mark ceases to be a registered trade mark for any reason;
- (b) if the goods or services for which the trade mark is registered are subsequently limited so as to exclude any or all of the goods or services in respect of which the registration of the registered user has been made;
- (c) if the registered proprietor ceases to exercise control over the use of the trade mark and over the quality of the goods or services provided by the registered user concerned in relation to that trade mark;
- (d) at the date of expiration of the last registration of the trade mark unless a fresh application under subsection

(2) accompanies any application for renewal of the registration of that trade mark;

- (e) at the date of any assignment or transmission of the registered trade mark, unless and until the devolution of title is recorded on the Register in accordance with the provisions of this Act and the subsequent proprietor of the registered trade mark makes a fresh application under subsection (2).

(7) If the registered proprietor of a trade mark fails to exercise any of the rights conferred on him by his registration to the prejudice of any registered user of that trade mark, the registered user may apply to the Court for such relief as the Court may consider just, including rectification of the Register by ordering that the registered user be recorded as the registered proprietor of the trade mark, and in any case where use of the trade mark by any person entitled to use it would be likely to deceive or cause confusion, the Court may order that the trade mark shall be removed from the Register, notwithstanding the provisions of section 37.

(8) The provisions of section 62 shall apply to any proceedings under subsection (7) that might lead to any alteration or rectification of the Register.

49. Powers to vary, extend or cancel registration of a registered user.

(1) Without prejudice to section 45, the registration of a person as a registered user—

(a) may be varied by the Registrar on the written application in the prescribed manner of the registered proprietor with respect to the goods or services for which or with respect to any conditions or restrictions subject to which the registration has effect;

(b) may be extended by the Registrar on the application in writing of the registered proprietor for such period as the Registrar thinks fit;

[Subs. Act
A881]

(c) may be cancelled by the Registrar on the application of the registered proprietor.

(2) The Registrar may at any time cancel the registration of a person as a registered user of a trade mark for any goods or services in respect of which the trade mark is no longer registered.

[Ins. Act
A881]

(3) Any decision of the Registrar under subsection (1) or (2) is subject to appeal to the Court.

[Act A881]

50. (Deleted).

51. Infringement proceeding.

(1) Subject to any agreement subsisting between the registered user of a trade mark and the registered proprietor of the trade mark, the registered user is entitled to call upon the registered proprietor to take proceedings for infringement of the trade mark, and if the registered proprietor refuses or neglects to do so within two months after being so called upon, the registered user may institute proceedings for infringement in his own name as if he were the registered proprietor and shall make the registered proprietor a defendant.

(2) A registered proprietor so added as a defendant is not liable for costs unless he enters an appearance and takes part in the proceedings.

52. Registered user not to assign.

This Part does not confer on the registered user of a trade mark an assignable or transmissible right to the use of that trade mark.

[Act A881]

53. (Deleted).

[Act A881]

54. (Deleted).

PART X
ASSIGNMENT OF TRADE MARKS

55. Assignment and transmission of trade marks.

(1) Subject to this section, a registered trade mark shall be

assignable and transmissible with or without the goodwill of the business concerned in the goods or services in respect of which the trade mark is registered or in part of the goods or services.

(1A) Subsection (1) shall have effect in the case of an unregistered trade mark used in relation to any goods or services as it has effect in the case of a registered trade mark registered in respect of any goods or services, if at the time of the assignment or transmission of the unregistered trade mark it is or was used in the same business as a registered trade mark, and if it is or was assigned or transmitted at the same time and to the same person as that registered trade mark and in respect of goods or services all of which are goods or services in relation to which the unregistered trade mark is or was used in that business and in respect of which that registered trade mark is or was assigned or transmitted. *[Ins. Act A881]*

(2) Notwithstanding subsection (1), an assignment of a registered trade mark without goodwill whether before or after the commencement of this Act is invalid if the trade mark has not at any time before the assignment been in use in good faith in Malaysia by the assignor or his predecessor in title except that this subsection does not apply where—

- (a) the trade mark was registered with the intention that it shall be assignable to a body corporate yet to be formed and the trade mark has been assigned; or
- (b) the trade mark was registered with the intention that a person shall be permitted to use it as a registered user and such registered user has been registered in respect of the trade mark within six months after the registration of the trade mark and has used that trade mark within that period.

(3) Notwithstanding subsections (1) and (1A), a trade mark shall be deemed not to be assignable or transmissible if, as a result of the assignment or transmission, whether under common law or by registration, more than one of the persons concerned would have exclusive rights to the use of an identical trade mark or to the use of trade marks so nearly resembling each other as are likely to deceive or cause confusion. *[Subs. Act A881]*

(4) Where an application is made in the prescribed manner by the registered proprietor of a trade mark who proposes to assign it or by a person who claims that a trade mark has been transmitted to him or to a predecessor in title of his since the commencement of this Act, the Registrar, if he is satisfied that in all circumstances the use of the trade marks in exercise of the said rights would not be contrary to the public interest, may in writing approve the assignment or transmission and an assignment or transmission so approved shall not be deemed to be or to have been invalid under this section but this provision shall not have effect unless application for the registration under section 47 of the title of the person becoming entitled is made within six months from the date on which the approval is given or, in the case of a transmission, was made before that date.

[Subs. Act
A881]

(5) Where an assignment in respect of any goods or services of a trade mark which is at the time of the assignment used in a business in those goods or services is made otherwise than in connection with the goodwill of that business, the assignment shall not be deemed to have taken effect unless the assignment has been advertised in the prescribed manner and the application for the assignment without goodwill, accompanied by the advertisement, has been sent to the Registrar.

[Act A881]

(6) (*Deleted*).

(7) A decision of the Registrar under this section is subject to appeal to the Court.

PART XI

CERTIFICATION TRADE MARKS

56. Certification trade marks.

[Am. Act
A1078]

(1) 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 Register in respect of those goods or services in the name of that person as proprietor thereof except that a mark shall not be so registrable in the name of

a person who carries on a trade in goods or services of the kind certified.

(2) In determining whether a mark is capable of distinguishing, the Registrar may have regard to the extent to which— [Subs. Act
A1078]

(a) the mark is inherently capable of distinguishing in relation to the goods or services in question; and

(b) by reason of the use of the mark or any other circumstances, the mark is in fact capable of distinguishing in relation to the goods or services in question.

(3) Subject to paragraphs (a) and (b) of section 37, paragraphs (a) to (c) of subsection (1) of section 40 and this Part, the registration of a person as registered proprietor of a certification trade mark in respect of any goods shall, if valid, give to that person the exclusive right to the use of the trade mark in relation to those goods, and without prejudice to the generality of the foregoing words, that right shall be deemed to be infringed by any person who, not being the registered proprietor of the trade mark or a person authorised by him under the rules in that behalf using it in accordance therewith, uses a mark identical with it or so nearly resembling it as is likely to deceive or cause confusion, in the course of trade, in relation to any goods in respect of which it is registered and in such manner as to render the use of the mark likely to be taken either—

(a) as being use as a trade mark;

(b) in the case in which the use is use upon the goods or services or in physical relation thereto or in an advertising circular, or other advertisement issued to the public, as importing a reference to some person having the right either as registered proprietor or by his authorisation under the relevant rules to use the trade mark or to goods or services certified by the registered proprietor; or

(c) in a case in which the use is use at or near the place where the services are available or performed or in an advertising circular or other advertisement issued to the public, as importing a reference to a person having a right either as proprietor or as a registered user to use the trade mark or to services with the provision of which such person is connected in the course of trade. *[Ins. Act A881]*

[Am. Act A881]

(4) The right to the use of a certification trade mark given by registration shall be subject to any conditions, amendments, modifications or limitations entered on the Register and shall not be deemed to be infringed by the use of any such mark in any mode, in relation to goods to be sold or otherwise traded in in any place, in relation to goods to be exported to any market, in relation to services to be provided in a place or in any circumstances to which having regard to any such conditions, amendments, modifications or limitations, the registration does not extend.

(5) The right to the use of a certification trade mark given by registration shall not be deemed to be infringed by the use of any such mark by a person—

[Ins. Act
A881]

- (a) in relation to goods certified by the registered proprietor of the trade mark if, as to those goods or a bulk of which they form part, the proprietor or another in accordance with his authorisation under the relevant rules has applied the trade mark and has not subsequently removed or obliterated it;
- (aa) where the registered proprietor has at any time expressly or impliedly consented to the use of the trade mark; or
- (b) in relation to goods or services adapted to form part of, or to be accessory to, other goods or services in relation to which the trade mark has been used without infringement of the right given or might for the time being be so used, if the use of the mark is reasonably necessary in order to indicate that the goods or services are so adapted and neither the purpose nor the effect of the use of the mark is to indicate otherwise than in accordance with the fact that the goods or services are certified by the registered proprietor,

except that paragraph (a) shall not have effect in the case of use consisting of the application of any such mark to any goods or services notwithstanding that they are such goods or services as are mentioned in that paragraph, if such application is contrary to the relevant rules.

(6) Where a certification trade mark is one of two or more registered trade marks which are identical or nearly resembling each other, the use of any of those trade marks in exercise of the right to the use of that trade mark given by registration shall not be deemed to be an infringement of the right so given to the use of any other of those trade marks.

(7) An application for the registration of a trade mark under this section must be made to the Registrar in writing in the prescribed manner by the person who proposes to be registered as the proprietor thereof.

(8) The provisions of subsections (2) to (8) and subsection (10) of section 25 shall have effect in relation to an application under this section as they have effect in relation to an application under subsection (1) of that section. [Am. Act
A881]

(9) In dealing with an application under this section the Registrar shall have regard to the like considerations, as far as relevant, as if the application were an application under section 25 and to any other considerations relevant to applications under this section, including the desirability of securing that a certification trade mark shall comprise some indication that it is such a trade mark.

(10) An applicant for the registration of a trade mark under this section shall transmit to the Registrar draft rules for governing the use thereof, which shall include provisions as to the cases in which the proprietor is to certify goods or services and to authorise the use of the trade mark and may contain any other provisions that the Registrar may require or permit to be inserted therein (including provisions conferring a right of appeal to the Registrar against any refusal of the proprietor to certify goods or services or to authorise the use of the trade mark in accordance with the rules) and such rules, if approved, shall be deposited with the Registrar and shall be open to inspection in like manner as the Register.

(11) The Registrar shall consider the application with regard to the following matters, that is to say—

- (a) whether the applicant is competent to certify the goods or services in respect of which the mark is to be registered;
- (b) whether the draft rules are satisfactory; and
- (c) whether in all the circumstances the registrations applied for would be to the public advantage,

and may either—

- (i) refuse to accept the application; or
- (ii) accept the application and approve the rules, either without modification and unconditionally or subject to any conditions, amendments, modifications or limitations of the application or of the rules, which he may think requisite,

but except in the case of acceptance and approval without modification and unconditionally, the Registrar shall not decide the matter without giving to the applicant an opportunity of being heard and the Registrar may, at the request of the applicant, consider the application before authorisation to proceed with the application has been given, so that he shall be at liberty to reconsider any matter on which he has given a decision if any amendment or modification is thereafter made in the application or in the draft rules.

(12) Where an application has been accepted the Registrar shall, as soon as may be after such acceptance, cause the application as accepted to be advertised in the prescribed manner and section 28 shall have effect in relation to the registration of the mark as if the application had been an application under section 25 except that, in deciding under section 28, the Registrar shall have regard only to the consideration referred to in subsection (9), and a decision under section 28 in favour of the applicant shall be conditional on the determination in his favour by the Registrar under subsection (13) of any opposition relating to any of the matters referred to in subsection (11).

(13) When notice of opposition is given relating to any of the matters referred to in subsection (11), the Registrar shall, after hearing the parties, if so required, and considering any evidence, decide whether, and subject to what conditions, amendments, modifications or limitations of the application or of the rules, if any, registration is, having regard to those matters, to be permitted.

(14) (a) The rules deposited in respect of a certification trade mark may, on the application of the registered proprietor, be altered by the Registrar.

(b) The Registrar may cause an application for his consent to be advertised in any case where it appears to him that it is expedient to do so, and, where the Registrar causes an application to be advertised, if within the prescribed time from the date of the advertisement any person gives notice to the Registrar of opposition to the application, the Registrar shall not decide the matter without giving the parties an opportunity of being heard.

(15) The Court may, on the application in the prescribed manner of any person aggrieved, or on the application of the Registrar, make such order as it thinks fit for expunging or varying any entry in the Register, relating to a certification trade mark, or for varying the deposited rules, on the ground—

- (a) that the registered proprietor is no longer competent, in the case of any of the goods or services in respect of which the trade mark is registered, to certify the goods or services;
- (b) that the registered proprietor has failed to observe a provision of the deposited rules to be observed on his part;
- (c) that it is no longer to the public advantage that the trade mark should be registered; or
- (d) that it is requisite for the public advantage that, if the trade mark remains registered, the rules should be varied,

but the Court shall not have any jurisdiction to make an order under section 45 on any of these grounds.

(16) The Registrar shall rectify the Register and the deposited rules in such manner as may be requisite for giving effect to an order made under subsection (15).

(17) Notwithstanding anything in subsection (2) of section 63 the Registrar shall not have any jurisdiction to award costs to or against any party on an appeal to him against a refusal of the registered proprietor of certification trade mark to certify goods or services or to authorise the use of the trade mark.

[Act A1073] (18) *(Deleted)*.

(19) The provisions of this Part shall be construed subject to section 19 of the Standards Act 1966.

PART XII DEFENSIVE TRADE MARKS

57. Defensive registration of well known trade marks.

(1) Where a trade mark consisting of an invented word or words has become so well known as regards any goods or services in respect of which it is registered and, in relation to which it has been used, that the use thereof in relation to other goods or services would likely to be taken as indicating a connection in the course of trade between the other goods or services and a person entitled to use the trade mark in relation to the first-mentioned goods or services, then, notwithstanding that the proprietor registered in respect of the first-mentioned goods or services does not use or propose to use the trade mark in relation to the other goods or services and notwithstanding anything in section 46 the trade mark may, on the application in a prescribed manner of the proprietor registered in respect of the first-mentioned goods or services, be registered in his name in respect of the other goods or services as a defensive trade mark and while so registered, shall not be liable to be taken off the Register in respect of other goods or services under section 46.

(2) The registered proprietor of a trade mark may apply for the registration thereof in respect of any goods or services as a defensive trade mark notwithstanding that it is already registered in his name in respect of the goods or services otherwise than as a defensive trade mark, or may apply for the registration thereof in respect of any goods or services otherwise than as a defensive trade mark notwithstanding that it is already registered in his name in respect of the goods or services as a defensive trade mark, in lieu in each case of the existing registration.

58. Defensive trade mark deemed to be associated trade mark.

A trade mark registered as a defensive trade mark and that trade mark as otherwise registered in the name of the same proprietor shall notwithstanding that the respective registrations are in respect of different goods or services be deemed to be, and shall be registered as, associated trade marks.

59. Rectification of Register.

The Registrar may at any time cancel the registration of a defensive trade mark of which there is no longer any registration in the name of the same proprietor otherwise than as a defensive trade mark.

60. Application of Act.

Subject to this Part, this Act applies in relation to the registration of a trade mark as a defensive trade mark and a trade mark registered as a defensive trade mark but it is not necessary for the registered proprietor of a defensive trade mark to prove use of the trade mark for the purpose of obtaining renewal of the registration.

PART XIII**LEGAL PROCEEDINGS, COST AND EVIDENCE****61. Certificate of validity.**

In any legal proceedings in which the validity of a registered trade mark comes into question and is decided in favour of the registered proprietor of the trade mark, the Court may certify to that effect, and if it so certifies then in any subsequent legal proceedings in which the validity of the registration comes into question the registered proprietor of the trade mark on obtaining a final order or judgment in his favour shall have his full costs, charges and expenses as between solicitor and client, unless in the subsequent proceedings the Court certifies that he ought not to have them.

62. Hearing of Registrar.

(1) In any legal proceedings in which the relief sought includes alteration or rectification of the Register, the Registrar shall have the right to appear and be heard, and shall appear if so directed by the Court.

(2) Unless otherwise directed by the Court, the Registrar, in lieu of appearing and being heard, may submit to the Court a statement in writing signed by him, giving particulars of the proceedings before him in relation of the matter in issue or of the grounds of any decision given by him affecting the same or of the practice of the office in like cases, or of such other matters relevant to the issues, and within his knowledge as Registrar, as he thinks fit, and such statement shall be deemed to form part of the evidence in the proceedings.

63. Costs.

(1) In all proceedings before the Court under this Act, the Court may award to any party such costs as it may consider reasonable and the costs as it may consider reasonable and the costs of the Registrar shall be in the discretion of the Court, but the Registrar shall not be ordered to pay the costs of any of the other parties.

(2) In all proceedings before the Registrar under this Act, the Registrar shall have power to award to any party such costs as he may consider reasonable and to direct how and by what parties they are to be paid, and any such order may, by leave of the Court, be enforced in the same manner as a judgment or order of the Court to the same effect.

64. Mode of giving evidence.

(1) In all proceedings before the Registrar under this Act, the evidence shall be given by statutory declaration in the absence of directions to the contrary, but, in any case in which he thinks fit, the Registrar may take evidence *viva voce* in lieu of or in addition to evidence by declaration.

(2) Any such statutory declaration may, in the case of appeal,

be used before the Court in lieu of evidence by affidavit, but if so used, shall have all the incidents and consequences of evidence by affidavit.

(3) In any action or proceedings relating to a trade mark or trade name, the Registrar or the Court, as the case may be, shall admit evidence of the usages of the trade concerned or evidence of business usages in the provision of the services in question, and evidence of any relevant trade marks or trade name or business name or get-up legitimately used by other persons. [Subs. Act
A881]

65. Sealed copies to be evidence.

(1) Printed or written copies or extracts of or from the Register purporting to be certified by the Registrar and sealed with his seal shall be admissible as evidence in any proceedings before any court of law without further proof or production of the originals.

(2) A certificate purporting to be under the hand of the Registrar as to any act which he is authorised under this Act to perform and which he has or has not performed, as the case may be, shall be *prima facie* evidence in any proceedings before any court of law of his having or not having performed the act.

66. Minister may declare documents of foreign state pertaining to trade marks to be admissible. [Am. Act A881]

(1) The Yang di-Pertuan Agong may by order published in the *Gazette* declare any documents or class of documents of a foreign state to be admissible as evidence in any proceedings before a Court if—

- (a) the document is sealed with the seal of the authorised officer or the government of the foreign state and the seal pertains to the trade marks registered in or otherwise recognised by the foreign country or if there is no such seal there is enclosed a certificate signed by the authorised officer to the effect that the document is evidence of the matter contained therein; and
- (b) the foreign state or part thereof has entered into reciprocal arrangements with the Government of Malaysia in respect of the admissibility of the documents.

(2) For the purpose of this section—

“authorised officer” means a person or authority authorised by the government of the foreign state to keep and maintain a register or other record of trade marks under any written law in force in the foreign state relating to trade marks;

“document” means—

(a) a printed or written copy of extract or other record of trade marks kept and maintained in the foreign state under any written law in force in the foreign state relating to trade marks; or

(b) any other document pertaining to any matter or act in relation to trade marks registered in or otherwise recognised by the foreign state as trade marks;

“trade mark” means any device, brand, heading, label, ticket, name, signature, word, letter, numeral or any combination thereof which is 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 trade mark (in the foreign state) whether with or without any indication of the identity of that person and which is registered or otherwise recognised by the foreign state as a trade mark (under any written law in force in the foreign state relating to trade marks) but does not include the trade marks of another foreign state registered in or otherwise recognised by the foreign state by virtue of a reciprocal arrangement between the foreign state and that other foreign state.

(3) For avoidance of doubt this section shall not be construed to confer recognition of the trade marks of any foreign state for the purpose of registration under this Act but shall be construed only with references to the admissibility of evidence in any proceedings before a Court of the documents of the foreign state.

67. Discretionary power.

In any appeal from the decision of the Registrar under this Act the Court shall have and exercise the same discretionary powers as are conferred upon the Registrar under this Act.

68. (Deleted).

[Act A881]

69. Appeal from Registrar.

Except where expressly given by the provisions of this Act or regulations made thereunder there shall be no appeal from a decision of the Registrar but the Court, in dealing with any question of the rectification of the Register (including all applications under section 45), shall have power to review any decision of the Registrar relating to the entry in question or the correction sought to be made.

PART XIV

CONVENTIONS AND INTERNATIONAL
ARRANGEMENTS

*[Am. Act
A881]*

70. Right of priority under Convention, etc.

*[Subs. Act
A881]*

(1) Where any person has applied for protection of any trade mark in a Convention country or prescribed foreign country, such person or his legal representative or assignee, after furnishing a declaration within the prescribed time indicating the date of the application and the country in which it was made, shall in respect of the application for registration of his trade mark, be entitled to a right of priority and such application in Malaysia shall have the same date as the date of the application for protection in the Convention country or prescribed foreign country concerned, as the case may be, subject to the following:

- (a) that the application for registration is made within six months from the date of application for protection in the Convention country or prescribed foreign country concerned, as the case may be; and where an application for protection is made in more than one Convention country or prescribed foreign country, the period of six months referred to herein shall be reckoned from the date on which the earlier or earliest of those applications is made;
- (b) that the applicant shall be either a national or resident of, or a body corporate incorporated under the laws of, the Convention country or prescribed foreign country concerned, as the case may be; and

(c) that nothing in this section shall entitle the proprietor of a trade mark to recover damages for infringements or any happening prior to the date on which the application for protection of the trade mark is made in Malaysia.

(2) Notwithstanding any other provision of this Act, the registration of a trade mark in respect of which a right of priority exists shall not be refused or revoked by reason only of use of the trade mark by some other person in Malaysia during the said period of six months.

(3) The application for the registration of a trade mark in respect of which a right of priority exists—

- (a) shall be made and dealt with in the same manner as an ordinary application for registration under this Act; and
- (b) shall specify the Convention country or prescribed foreign country, as the case may be, in which the application for protection, or the first such application, was made and the date on which such application for protection was made.

(4) As regards prescribed foreign countries, this section shall apply only for the duration of the period the order continues in force in respect of that country.

(5) For the purposes of this Act, the Minister may, by order published in the *Gazette*, declare a country as having made arrangements with Malaysia for the reciprocal protection of trade marks.

[Ins. Act
A881]

70A. Temporary protection of trade marks in respect of goods or services which are the subject matters of international exhibitions.

(1) Notwithstanding anything in this Act, temporary protection shall be granted to a trade mark in respect of goods or services which are the subject matters of an exhibition at an official or officially recognised international exhibition held in Malaysia or in any Convention country or prescribed foreign country.

(2) The temporary protection granted under subsection (1) shall not extend any period of priority claimed by an applicant and where a right of priority is claimed by an applicant subsequent to the temporary protection, the period of priority shall remain six months but the period shall commence from the date of the introduction of the goods or services into the exhibition.

(3) An applicant for registration of a trade mark whose goods or services are the subject matters of an exhibition at an official or officially recognised international exhibition in Malaysia or in any Convention country or prescribed foreign country and who applies for registration of that mark in Malaysia within six months from the date on which the goods or services first became the subject matters of the exhibition shall, on his request, be deemed to have applied for registration on the date on which the goods or services first became the subject matters of the exhibition.

(4) Evidence that the goods or services bearing the trade mark are the subject matters of an exhibition at an official or officially recognised international exhibition shall be by a certificate issued by the competent authorities of the exhibition.

70B. Protection of well-known trade marks.

[Ins. Act
A1078]

(1) The proprietor of a trade mark which is entitled to protection under the Paris Convention or the TRIPS Agreement as a 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 the 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 a trade mark begun before the commencement of this Act.

(3) In this section, references to a trade mark which is entitled to protection under Article 6*bis* of the Paris Convention or Article 16 of the TRIPS Agreement as a well-known trade mark are to a mark which is 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.

[Ins. Act
A1078]

PART XIVA
BORDER MEASURES

[Ins. Act
A1078]

70c. Interpretation.

In this Part, unless the context otherwise requires—

“authorised officer” means—

- (a) a proper officer of customs as defined under the Customs Act 1967; or
- (b) any officer appointed by the Minister by notification in the *Gazette* to exercise the powers and perform the duties conferred and imposed on an authorised officer by this Part;

“counterfeit trade mark goods” means any goods, including packaging, bearing without authorisation a trade mark which is identical with or so nearly resembles the trade mark validly registered in respect of such goods, or which cannot be distinguished in its essential aspects from such a trade mark, and which infringes the rights of the proprietor of the trade mark under this Act;

“goods in transit” means goods imported, whether or not landed or transshipped within Malaysia, which are to be carried to another country either by the same or another conveyance;

“import” means to bring or cause to be brought into Malaysia by whatever means;

“retention period”, in relation to seized goods, means—

- (a) the period specified in a notice given under section 70G in respect of the goods; or
- (b) if the period has been extended under section 70G, that period so extended;

“security” means any sum of money in cash;

“seized goods” means goods seized under section 70D.

70D. Restriction on importation of counterfeit trade mark goods. [Ins. Act
A1078]

(1) Any person may submit an application to the Registrar stating—

- (a) that he is the proprietor of a registered trade mark or an agent of the proprietor having the power to submit such application;

(b) that, at a time and place specified in the application, goods which, in relation to the registered trade mark, are counterfeit trade mark goods are expected to be imported for the purpose of trade; and

(c) that he objects to such importation.

(2) An application under subsection (1) shall be supported by such documents and information relating to the goods as to enable them to be identified by the authorised officer, and accompanied by such fee as may be prescribed.

(3) Upon receipt of the application under subsection (1), the Registrar shall determine the application, and the Registrar shall within a reasonable period inform the applicant whether the applicant has been approved.

(4) In determining the reasonable period under subsection (3), the Registrar shall take into consideration all relevant circumstances of the case.

(5) An approval under subsection (3) shall remain in force until the end of the period of sixty days commencing on the day on which the approval was given, unless it is withdrawn before the end of that period by the applicant by giving a notice in writing to the Registrar.

(6) Where an approval has been given under this section and has not lapsed or been withdrawn, the importation of any counterfeit trade mark goods into Malaysia for the duration of the period specified in the approval shall be prohibited.

(7) Upon giving his approval under subsection (3) the Registrar shall immediately take the necessary measures to notify the authorised officer.

(8) Where an authorised officer has been notified by the Registrar, he shall take the necessary action to prohibit any person from importing goods identified in the notice, not being goods in transit, and shall seize and detain the identified goods.

[Ins. Act
A1078]

70E. Security.

The Registrar shall, upon giving his approval under section 70D, require the applicant to deposit with the Registrar a security which in the opinion of the Registrar is sufficient to—

- (a) reimburse the Government for any liability or expense it is likely to incur as a result of the seizure of the goods;
- (b) prevent abuse and to protect the importer; or
- (c) pay such compensation as may be ordered by the Court under this Part.

[Ins. Act
A1078]

70F. Secure storage of seized goods.

(1) Seized goods shall be taken to such secure place as the Registrar may direct or as the authorised officer deems fit.

(2) If it is stored on the direction of the authorised officer, the authorised officer shall inform the Registrar of the whereabouts of the seized goods.

[Ins. Act
A1078]

70G. Notice.

(1) As soon as is reasonably practicable after goods are seized under section 70D, the authorised officer shall give to the Registrar, importer and the applicant, either personally or by registered post, a written notice identifying the goods, stating that they have been seized and the whereabouts of the goods.

(2) A notice under subsection (1) shall also state that the goods will be released to the importer unless an action for infringement in respect of the goods is instituted by the applicant within a specified period from the date of the notice.

(3) If at the time of the receipt of the notice an action for infringement has been instituted by the applicant, the applicant shall notify the Registrar of that fact.

(4) The applicant may, by written notice given to the Registrar before the end of the period specified in the notice (the initial period), request that the period be extended.

(5) Subject to subsection (6), if—

- (a) a request is made in accordance with subsection (4); and
- (b) the Registrar is satisfied that it is reasonable that the request be granted,

the Registrar may extend the initial period.

(6) A decision on a request made in accordance with subsection (4) shall be made within two working days after the request is made, but such a decision cannot be made after the end of the initial period to which the request relates.

70H. Inspection, release, etc., of seized goods.

[Ins. Act
A1078]

(1) The Registrar may permit the applicant or the importer to inspect the seized goods if he agrees to give the requisite undertakings.

(2) The requisite undertakings mentioned in subsection (1) are undertakings in writing that the person giving the undertakings will—

(a) return the sample of the seized goods to the Registrar at a specified time that is satisfactory to the Registrar; and

(b) take reasonable care to prevent damage to the sample.

(3) If the applicant gives the requisite undertakings, the Registrar may permit the applicant to remove a sample of the seized goods from the custody of the Registrar for inspection by the applicant.

(4) If the importer gives the requisite undertakings, the Registrar may permit the importer to remove a sample of the seized goods from the custody of the Registrar for inspection by the importer.

(5) If the Registrar permits inspection of the seized goods, or the removal of a sample of the seized goods, by the applicant in accordance with this section, the Registrar is not liable to the importer for any loss or damage suffered by the importer arising out of—

(a) damage to any of the seized goods incurred during that inspection; or

(b) anything done by the applicant or any other person to, or in relation to, a sample removed from the custody of the Registrar or any use made by the applicant or any other person of such a sample.

[Ins. Act
A1078]

70i. Forfeiture of seized goods by consent.

(1) Subject to subsection (2), the importer may, by written notice to the Registrar, consent to the seized goods being forfeited to the Government.

(2) The notice shall be given before any action for infringement in relation to the seized goods is instituted.

(3) If the importer gives such a notice, the seized goods are forfeited to the Government and shall be disposed of in the manner prescribed by regulations made under this Part.

[Ins. Act
A1078]

70j. Compulsory release of seized goods to importer.

(1) The Registrar shall release the seized goods to the importer on the expiration of the retention period for the goods if the applicant—

(a) has not instituted an action for infringement in relation to the goods; and

(b) has not given written notice to the Registrar stating that the action for infringement has been instituted.

(2) If—

- (a) an action for infringement has been instituted in relation to the seized goods; and
- (b) at the end of a period of thirty days commencing on the day on which the action for infringement was instituted, there is not in force an order of the Court in which the action was instituted preventing the release of the goods,

the Registrar shall release the goods to the importer.

(3) If the applicant gives written notice to the Registrar stating that he consents to the release of the seized goods, the Registrar shall release the goods to the importer.

70K. Compensation for failure to take action.

*[Ins. Act
A1078]*

(1) Where goods have been seized pursuant to a notice given under section 70D and the applicant fails to take action for infringement within the retention period, a person aggrieved by such seizure may apply to the Court for an order of compensation against the applicant.

(2) Where the Court is satisfied that the person aggrieved had suffered loss or damage as a result of the seizure of the goods, the Court may order the applicant to pay compensation in such amount as the Court thinks fit to the aggrieved person.

70L. Actions for infringement of registered trade mark.

*[Ins. Act
A1078]*

(1) If an action for infringement has been instituted by the applicant, the Court may in addition to any relief that may be granted—

- (a) order that the seized goods be released to the importer subject to such conditions, if any, as the Court thinks fit;
- (b) order that the seized goods be not released to the importer before the end of a specified period; or
- (c) order that the seized goods be forfeited to the Government,

depending on the circumstances of the case.

(2) The Registrar or the authorised officer is entitled to be heard on the hearing of an action for infringement.

(3) A Court may not make an order under paragraph (1)(a) if it is satisfied that the Government or any statutory authority is required or permitted under any other law to retain control of the seized goods.

(4) The Registrar shall comply with an order made under subsection (1).

(5) If—

- (a) the action is dismissed or discontinued, or if the Court decides that the relevant registered trade mark was not infringed by the importation of the seized goods; and
- (b) a defendant to the action for infringement satisfies the Court that he has suffered loss or damage as a result of the seizure of the goods,

the Court may order the applicant to pay compensation in such amount as the Court thinks fit to that defendant.

[Ins. Act
A1078]

70M. Disposal of seized goods ordered to be forfeited.

If the Court orders that seized goods are to be forfeited to the Government, the goods shall be disposed of in the manner as directed by the Court.

[Ins. Act
A1078]

70N. Insufficient security.

(1) If the reasonable expenses incurred by the Registrar in relation to any action taken by the Registrar under this Part, or taken in accordance with an order of Court under this Part, exceed the amount of security deposited under section 70E, the amount of the excess is a debt due to the Government.

(2) The debt created by subsection (1) is due by the applicant, or, if there are two or more applicants, by the applicants jointly and severally.

[Ins. Act
A1078]

70o. Ex-officio action.

(1) Any authorised officer may detain or suspend the release of goods which, based on *prima facie* evidence that he has acquired, are counterfeit trade mark goods.

(2) Where such goods have been detained, the authorised officer—

- (a) shall inform the Registrar, the importer and the proprietor of the trade mark; and
- (b) may at any time seek from the proprietor of the trade mark any information that may assist him to exercise his powers.

(3) Subject to section 70J, an importer may lodge an appeal against the detention of goods or suspension of the release of goods under subsection (1).

(4) The authorised officer shall only be exempted from liability if his actions under subsection (1) are done in good faith.

70P. Regulations relating to border measures.

*[Ins. Act
A1078]*

(1) The Minister may make such regulations as may be necessary or expedient for the purpose of this Part.

(2) Without prejudice to the generality of subsection (1), regulations may be made for—

- (a) prescribing and imposing fees and providing for the manner for collecting such fees;
- (b) prescribing forms and notices;
- (c) providing for the manner for depositing security;
- (d) prescribing anything required to be prescribed under this Part.

PART XV

MISCELLANEOUS

71. Use of trade mark for export trade.

(1) The application in Malaysia of a trade mark to goods to be exported from Malaysia and any other act done in Malaysia in relation to the goods which if done in relation to goods to be sold or otherwise traded in in Malaysia would constitute use of a trade mark in Malaysia shall for the purpose of this Act be deemed to constitute use of the trade mark in relation to those goods.

(2) Subsection (1) shall be deemed to have had effect in relation to an act done before the date of the commencement of this Act as it has effect in relation to an act done after that date, but does not affect a determination of a Court which has been made before that date or the determination of an appeal from a determination so made.

72. Use of trade mark where form of trade changes.

The use of a registered trade mark in relation to goods or services where a form of connection in the course of trade subsists between the goods and the person using the trade mark shall not be deemed to be likely to cause deception or confusion only on the ground that the trade mark has been or is used in relation to goods or services where a different form of connection in the course of trade subsisted or subsists between the goods or services and that person or a predecessor in title of that person.

73. Preliminary advice by Registrar.

[Am. Act
A1078]

(1) The power to give to a person who proposes to apply for the registration of a trade mark in the Register advice as to whether the trade mark appears to the Registrar *prima facie* to be capable of distinguishing shall be a function of the Registrar under this Act.

(2) Any person who is desirous of obtaining the advice shall make application to the Registrar in the prescribed manner.

[Am. Act
A1078]

(3) Where an application for the registration of a trade mark is made within three months after the Registrar has given advice in the affirmative and the Registrar, after further investigation or consideration, gives notice to the applicant of objection on the ground that the trade mark is not capable of distinguishing the applicant shall be entitled, on giving notice of withdrawal of the application within the prescribed period, to have any fee paid on the filing of the application repaid to him.

74. Powers of Registrar to amend document.

(1) The Registrar may on such terms as to costs as he thinks just whether for the purpose of correcting a clerical error or an obvious mistake, permit the correction of an application for the registration of a trade mark or notice of opposition or other document submitted at any trade marks office.

(2) An amendment of an application shall not be permitted under this section if the amendment would substantially affect the identity of the trade mark as specified in the application before amendment.

(3) A decision of the Registrar under subsection (1) is subject to appeal to the Court.

75. Other powers of Registrar.

(1) The Registrar may, for the purpose of this Act—

- (a) summon witnesses;
- (b) receive evidence on oath;
- (c) require the production of a document or article; and
- (d) award costs as against a party to proceedings before him. *[Am. Act A881]*

(2) Any person who without any lawful excuse fails to comply with any summons, order or direction made by the Registrar under paragraphs (a), (b) and (c) of subsection (1) is deemed to have committed an offence and is liable, on conviction, to a fine not exceeding one thousand ringgit or to a term of imprisonment not exceeding three months or to both.

(3) Costs awarded by the Registrar may in default of payment be recovered in a court of competent jurisdiction as a debt due by the person against whom the costs were accorded to the person in whose favour they were accorded.

76. Exercise of discretionary power.

Where any discretionary power is given to the Registrar by this Act or by any regulations made thereunder, he shall not exercise that power adversely to the applicant for registration or the registered proprietor in question without (if duly required to do so within the prescribed time) giving to the applicant an opportunity of being heard.

77. Extension of time.

[Subs. Act A881]

(1) Where by this Act or any regulations made thereunder, a time is specified within which an act or thing is to be done, the Registrar may, unless otherwise expressly provided or directed by the Court, upon application in the prescribed manner, extend the time either before or after its expiration upon payment of the prescribed fee.

(2) Subsection (1) shall not apply to section 29, subsection (3) of section 31, section 70 and section 70A except where the circumstances mentioned in section 78 apply.

78. Extension of time by reason of error in trade marks office etc.

(1) Where by reason of—

(a) circumstances beyond the control of the person concerned; or

[Am. Act
A881]

(b) an error or action on the part of the Central Trade Marks Office or any trade marks office,

an act in relation to an application for the registration of a trade mark or in proceedings under this Act (not being proceedings in a Court) required to be done within a certain time has not been so done the Registrar may extend the time for doing the act.

(2) The time required for doing an act may be extended under this section although that time has expired.

79. Address for service.

[Subs. Act
A881]

(1) Where an applicant for the registration of a trade mark does not reside or carry on business in Malaysia, he shall give to the Registrar an address for service in Malaysia which shall be the address of his agent, and if he fails to do so, the Registrar may refuse to proceed with the application.

(2) An address for service stated in the application or a notice of opposition shall, for the purposes of the application or notice of opposition, be deemed to be the address of the applicant or opponent, as the case may be, and all documents in relation to the application or notice of opposition may be served by leaving them at, or sending them by post to, the address for service of the applicant or opponent, as the case may be.

(3) An address for service may be changed by notice in writing to the Registrar.

(4) Subject to subsection (1), the registered proprietor of a trade mark shall from time to time notify the Registrar in writing of any change in the Register and the Registrar shall alter the Register accordingly.

(5) The address of the registered proprietor of a trade mark as appearing for the time being in the Register shall for all purposes under this Act be deemed to be the address of the registered proprietor.

80. Agent.

[Subs. Act
A881]

(1) Where an applicant for registration of a trade mark does not reside or carry on business in Malaysia, he shall appoint an agent to act for him.

(2) Where by this Act any act has to be done by or to any person in connection with a trade mark or proposed trade mark or any procedure relating thereto, the act may, under and in accordance with this Act and any regulations made thereunder or in particular cases by special leave of the Registrar, be done by or to an agent of that person duly authorised in the prescribed manner.

(3) No person, firm or company shall be authorised to act as an agent for the purposes of this Act unless that person is domiciled or resident in Malaysia or the firm or company is constituted under the laws of Malaysia and such person, firm or company carries on business or practice principally in Malaysia.

81. Falsely representing a trade mark as registered.

(1) A person who makes a representation—

- (a) with respect to a mark, not being a registered trade mark, to the effect that it is a registered trade mark;
- (b) with respect to a part of a registered trade mark, not being a part separately registered on a trade mark, to the effect that it is so registered;
- (c) to the effect that a registered trade mark is registered in respect of goods or services in respect of which it is not registered; or
- (d) to the effect that the registration of a trade mark gives a right to the exclusive use of the trade mark in circumstances in which, having regard to conditions or limitations entered on the Register, the registration does not give that right,

is guilty of an offence and is liable, on conviction, to a fine not exceeding five hundred ringgit or to a term of imprisonment not exceeding two months or to both.

(2) For the purpose of this section, the use in Malaysia in relation to a trade mark of the word “registered” or of any other word referring whether expressly or impliedly to registration shall be deemed to import a reference to registration in the Register except—

- (a) where the word is used in physical association with other words delineated in characters at least as large as those in which that word is delineated and indicating that the reference is to registration as a trade mark under the law of a country outside Malaysia being a country under the law of which the registration referred to is in fact in force;
- (b) where the word (being a word other than the word “registered”) is of itself such as to indicate that the reference is to registration as mentioned in paragraph (a); or
- (c) where that word is used in relation to a mark registered as a trade mark under the law of a country outside Malaysia and in relation to goods or services to be exported to that country.

82. Unregistered trade marks.

(1) No person shall be entitled to initiate any action to prevent or to recover damages for the infringement of an unregistered trade mark.

(2) Notwithstanding subsection (1), nothing in this Act shall be deemed to affect the right of action against any person for passing off goods or services as those of another person or the remedies in respect thereof.

83. Regulations.

(1) Subject to the provisions of this Act, the Minister may make regulations for the purpose of carrying into effect the provisions of this Act.

(2) In particular and without prejudice to the generality of subsection (1), such regulations may provide for all or any of the following:

- (a) to regulate the practice (other than that relating to proceedings before the Court or connected therewith) under this Act including service of documents;
- (b) to classify goods or services for the purpose of registration of trade marks;
- (c) to make or require duplication of trade marks or other documents;
- (d) to secure and regulate the publishing and selling or distributing in such manner as the Minister may think fit of copies of trade marks and other documents;
- (e) to prescribe the fees to be paid in respect of any matter or thing required for the purposes of this Act;

[Subs. Act
A881]

(*ea*) to provide for the registration and qualifications of agents; *[Ins. Act A881]*

(*f*) to regulate generally on matters pertaining to the business of trade marks carried on in any trade marks office whether or not specially prescribed under this Act but so as not to be inconsistent with any of the provisions of this Act.

(3) (*Deleted*).

[Act A881]

(4) Subject to the provisions of this Act, the Rules Committee constituted under the Courts of Judicature Act 1964, may make rules of court regulating the practice and procedure in relation to proceedings before the Court or connected therewith and the costs of the proceedings.

84. Repeal and saving.

(1) The Trade Marks Ordinance 1950, the Trade Marks Ordinance of Sabah and the Trade Marks Ordinance of Sarawak are hereby repealed.

(2) Notwithstanding the repeal of the Ordinances specified in subsection (1):

(*a*) any subsidiary legislation made under any of the repealed laws shall insofar as such subsidiary legislation is not inconsistent with the provisions of this Act continue in force and have effect as if it had been made under this Act and may be repealed, extended, varied or amended accordingly;

(*b*) any appointment made under the repealed laws or subsidiary legislation made thereunder shall continue in force and have effect as if it had been made under this Act unless the Minister otherwise directs;

(*c*) any certificate issued under any of the repealed laws and is in force immediately prior to the coming into force of this Act shall, subject to the terms, conditions and the period of validity specified in the certificate, continue in force and have the like effect as if it had been issued under this Act and the Registrar may amend, modify, renew, cancel or revoke such certificate in accordance with the powers conferred upon him by the relevant provisions of this Act relating thereto.

TRADE MARKS REGULATIONS 1997

TRADE MARKS REGULATIONS 1997

ARRANGEMENT OF REGULATIONS

PART I

PRELIMINARY

Regulation

1. Citation and commencement.
2. Interpretation.
3. Fees.
4. Forms.
5. Classification.

PART II

DOCUMENTS

6. Size, *etc.* of documents.
7. Signature of documents.
8. Service of documents.
9. Address.
10. Address for service.

PART III

AGENTS

11. Agency.
12. Registration of agents.

PART IV

REGISTRABLE TRADE MARKS

13. Marks subject to statutory restriction.
14. Royal arms, *etc.*
15. Arms of city, *etc.*

Regulation

16. Goods or services described on a mark.
17. Preliminary advice.

PART V

APPLICATION FOR REGISTRATION

18. Form of application.
19. Representation of mark.
20. Representations to be satisfactory.
21. Cases of difficulty.
22. Series of trade marks.
23. Transliteration and translation.
24. Amendment of application.

PART VI

PROCEDURE ON RECEIPT OF AN APPLICATION
FOR REGISTRATION OF TRADE MARK

25. Search.
26. Registrar's acceptance.
27. Registrar's objection.
28. Conditional acceptance.
29. Decision of Registrar.

PART VII

CERTIFICATION TRADE MARK

30. Application for registration of certification trade mark.
31. Case and draft rules.

PART VIII

DEFENSIVE TRADE MARK

32. Application for registration of defensive trade mark.

PART IX

ADVERTISEMENT OF APPLICATION

Regulation

33. Application for registration.
34. Representation for advertisement.
35. Advertisement of series of trade marks.
36. Advertisement in other cases.

PART X

OPPOSITION TO REGISTRATION

37. Opposition.
38. Contents of notice.
39. Counter-statement.
40. Evidence in support of opposition.
41. Evidence in support of application.
42. Evidence in reply.
43. Further evidence.
44. Exhibits.
45. Extension of time.
46. Written submission.
47. Registrar's decision.
48. Security for costs.
49. Costs in uncontested cases.
50. Opposition to a certification trade mark.
51. Opposition to alteration of rules of a registered certification trade mark.

PART XI

REGISTRATION AND RENEWAL

52. Entry in the Register.
53. Registration not completed within twelve months.
54. Associated marks.
55. Death of applicant before registration.
56. Certificate of registration.
57. Renewal of registration.

Regulation

58. Reminder of renewal.
59. Late renewal.
60. Removal and restoration.
61. Record of removal.
62. Notice and advertisement of renewal and restoration.

PART XII

ASSIGNMENTS AND TRANSMISSIONS

63. Application for entry of subsequent proprietor.
64. Particulars to be provided.
65. Proof of title.
66. Assignment without goodwill.
67. Entry of assignment in Register.
68. Partial assignment.
69. Proposed assignment or transmission.

PART XIII

ALTERATION OF THE REGISTER

70. Alteration of address.
71. Application for making, cancelling or varying an entry by a registered proprietor or registered user.
72. Evidence for alteration.
73. Advertisement in certain cases.
74. Application to the court.
75. Order of court.
76. Certificate of validity.
77. Alteration of registered mark.
78. Advertisement before decision.
79. Advertisement of altered mark.

PART XIV

REGISTERED USER

Regulation

- 80. Application for entry of registered user.
- 81. Entry of registered user.
- 82. Variation or cancellation of entry of registered user.
- 83. Expiry or striking out.

PART XV

SUPPLEMENTARY

- 84. Extension of time.
- 85. Excluded days.
- 86. Application for hearing.
- 87. Power to dispense with evidence.
- 88. Amendment of documents.
- 89. Certificate by Registrar.
- 90. Statutory declarations.

PART XVI

REVOCATION AND TRANSITIONAL PROVISIONS

- 91. Revocation.
- 92. Saving.

FIRST SCHEDULE

SECOND SCHEDULE

THIRD SCHEDULE

TRADE MARKS REGULATIONS 1997*

In exercise of the powers conferred by section 83 of the Trade Marks Act 1976, the Minister makes the following regulations:

PART I

PRELIMINARY

1. Citation and commencement.

These regulations may be cited as the **Trade Marks Regulations 1997** and shall come into force on 1 December 1997.

2. Interpretation.

In these Regulations, unless the context otherwise requires—

“agent” means an agent duly authorised to the satisfaction of the Registrar;

“Office” means the Central Trade Marks Office or any other trade marks office established under section 5 of the Act.

3. Fees.

The fees to be paid in pursuance of the Act and these Regulations shall be as specified in the First Schedule.

4. Forms.

(1) The forms referred to in these Regulations are those contained in the Second Schedule.

(2) The forms shall be used in all cases in which they are applicable.

5. Classification.

For the purposes of the registration of trade marks and of the registration of registered users, goods and services are classified in the manner prescribed in the Third Schedule.

PART II

DOCUMENTS

6. Size, etc. of documents.

Subject to any other directions that may be given by the Registrar, all applications, notices, counter-statements, papers having representation affixed, and other documents required by the Act or by these Regulations to be left with or sent to the Registrar shall be in ISO A4 size which shall have on the left hand part thereof a margin of not less than four centimetres.

*Published as P.U. (A) 460/97.

7. Signature of documents.

(1) Subject to subregulation 10(3) and regulation 11 documents and forms filed at the Office and which require a signature shall be signed—

- (a) in the case of an individual, by that person;
- (b) in the case of a partnership, by all the partners, or by the principal acting partner stating that he signs on behalf of all the partners;
- (c) in the case of an association of persons other than a partnership, by the secretary or by any other person who satisfies the Registrar that he is authorised to sign on behalf of the association;
- (d) in the case of a body corporate, by the secretary, or by a director or by any authorised signatory.

(2) A document filed on behalf of a partnership shall contain the names of all the partners in full and in default the Registrar may require the deficiency to be rectified and may decline to take any further step in the matter to which the document in question relates until the deficiency has been rectified to his satisfaction.

8. Service of documents.

(1) All applications, notices, statements, papers having representations affixed, and other documents authorised or required by the Act or these Regulations to be made, left or sent, at or to the Office, may be sent by post.

(2) Any application or any document so sent shall be deemed to have been received at the time when it is received at the Office.

9. Address.

Where any person is, by the Act or these Regulations, bound to furnish the Registrar with an address, the address given shall in all cases be as full as possible for the purpose of enabling the place of trade or business of such person to be found easily.

10. Address for service.

(1) An applicant, opponent, registered proprietor or registered user of a trade mark who does not reside or carry on business in Malaysia shall file Form TM1 giving an address for service in Malaysia and such address may be treated as the actual address of the person for all purposes connected with the matter in question.

(2) Any other applicant, opponent, registered proprietor or registered user of a trade mark may, if he so desires, file Form TM 1 giving an address for service in Malaysia.

(3) Subject to regulation 7, Form TM 1 filed under these Regulations may be signed by an authorised agent and in any case in which the Registrar so requires shall be signed by the applicant, opponent, registered proprietor or registered user, as the case may be.

(4) In any case in which no address for service is filed at the Office, the Registrar may treat the business address in Malaysia, if any, of the person concerned as his address for service for all purposes connected with the matter in question.

(5) Any written communication addressed to a person at an address given by him or treated by the Registrar as his address for service shall be deemed to be properly addressed.

(6) The Registrar may, at any time that a doubt arises as to the continued availability of an address for service entered in the Register, request the person for whom it is entered, by letter addressed to his business address in the Register, to confirm the address for service or to provide another by filing Form TM 1, and if within two months of making such a request the Registrar receives no confirmation or substitution of that address, he may strike the address off the Register.

PART III

AGENTS

11. Agency.

(1) Except as otherwise required by the Act or these Regulations—

- (a) any application, request or notice which is required or permitted to be made or given to the Registrar;
- (b) all other communications between an applicant or a person making such request or giving such a notice and the Registrar; and
- (c) all other communications between the registered proprietor or the registered user of a trade mark and the Registrar or any other person,

may be signed, made or given by or through an agent and the Registrar may—

- (aa) in any particular case, require the personal signature or presence of the applicant, opponent, registered proprietor, registered user or other person;
- (bb) by notice in writing sent to an agent, require him to produce evidence of his authority.

(2) Where a party to proceedings before the Registrar appoints an agent for the first time or appoints one agent in substitution for another, the agent appointed shall file Form TM 1 with the Registrar on or before the first occasion on which he acts as an agent for that party in the proceedings.

(3) No person may appoint more than one agent to act for him concurrently in respect of the same mark, whether in respect of the same or different transactions; and where more than one agent is on record, the Registrar shall recognise only the latest agent duly appointed.

(4) The Registrar shall decline to recognise as an agent any person who is not currently on the Register of Trade Marks Agents of Malaysia compiled and maintained under regulation 12.

12. Registration of agents.

(1) The Registrar shall maintain a Register of Trade Marks Agents.

(2) An application to be registered as a trade marks agent shall be made to the Registrar on Form TM 2 accompanied with payment of the prescribed fee.

(3) In order to be registered in the Register of Trade Marks Agents, the applicant shall satisfy the Registrar that he is either domiciled or resident in Malaysia or has a principal place of business in Malaysia, and—

- (a) is on the Register of Patents Agents maintained in pursuance of regulations made under the Patents Act 1983; or
- (b) is an advocate and solicitor practising solely in Malaysia; or
- (c) holds a recognised degree in any field of studies and has had at least three years experience in the field of industrial property.

(4) The Registrar shall not register any person who has been convicted of any registrable offence or any criminal offence involving fraud or dishonesty.

(5) The Registrar, upon being satisfied that the applicant qualifies to be registered in the Register of Trade Marks Agent, shall register the applicant for a term expiring on the 31st December of that year.

(6) An agent shall be removed from the Register of Trade Marks Agent if he—

- (a) is no longer domiciled or resident in Malaysia or no longer has a principal place of business in Malaysia; or
- (b) is convicted of a registrable offence or any criminal offence involving fraud or dishonesty; or
- (c) is an undischarged bankrupt; or
- (d) has been struck off and not restored to the Register of Patents Agents or the Roll of Advocates and Solicitors or is suspended for the time being from that Register or that Roll.

(7) An application for the renewal of registration as a trade mark agent shall be made to the Registrar on Form TM 3 together with payment of the prescribed fee by 31 January of each year.

(8) The Registrar, shall upon being satisfied that the conditions specified in subregulations (3) and (4) continue to be satisfied, renew the registration of the trade marks agent for a term expiring on 31 December of that year.

PART IV

REGISTRABLE TRADE MARKS

13. Marks subject to statutory restriction.

(1) The Registrar shall refuse to accept any application for the registration of a mark upon which any of the following appears:

- (a) the words "To counterfeit this is a forgery", "Registered Trade Mark", "Registered Service Mark", or any words to the like effect in any language;
- (b) the words "Bunga Raya" and the representations of the hibiscus or any colourable imitation thereof;
- (c) representations of or words referring to Seri Paduka Baginda Yang di-Pertuan Agong, Ruler of a State or any colourable imitation thereof;
- (d) the representations of any of the royal palaces or of any building owned by the Federal Government or State Government or any other government or any colourable imitation thereof;
- (e) the word "ASEAN" and the representation of the ASEAN logotype or any colourable imitation thereof;
- (f) the words "Red Crescent" or "Geneva Cross" and representations of the Red Crescent, the Geneva Cross and other crosses in red, or of the Swiss Federal Cross in white or silver on a red ground, or such representations in a similar colour or colours.

(2) Where there appears in a trade mark, the registration of which is applied for, a representation of a crescent or a cross in any colour, not being one of those mentioned in paragraph (1)(f), the Registrar may require the applicant, as a condition of acceptance, to undertake not to use the crescent or cross device in red, or in white or silver on a red ground, or in any similar colour or colours.

14. Royal arms, etc.

The following devices shall not appear on a trade mark the registration of which is applied for:

- (a) representations of, or mottoes of or words referring to, the royal or imperial arms, crest, armorial bearings or insignia or devices so nearly resembling any of them as to be likely to be mistaken for them;

- (b) representations of, or mottoes of or words referring to, the royal or imperial crowns, or of the royal, imperial or national flags;
- (c) representations of, or mottoes of or words referring to, the crests, armorial bearings or insignia of the Malaysian Army, Royal Malaysian Navy, Royal Malaysian Air Force and of the Royal Malaysia Police, or devices so nearly resembling any of the foregoing as to be likely to be mistaken for them.

15. Arms of city, etc.

Where a representation of the name, initials, armorial bearings, insignia, orders of chivalry, decorations or flags of any international organisation, state, city, borough, town, place, society, body corporate, institution or person appears on a mark, the Registrar shall consider whether to refuse to accept an application for the registration of the mark unless the consent of such official or other person as appears to the Registrar to be entitled to give consent is filed.

16. Goods or services described on a mark.

(1) Where the name or description of any goods appears on a trade mark for any goods or the name or description of any service appears on a trade mark for any services, the Registrar may refuse to register such mark in respect of any goods or services, as the case may be, other than the goods or services so named or described.

(2) Where the name or description of any goods appears on a trade mark for any goods or the name or description of any service appears on a trade mark for any services and in either case the name or description in use varies, the Registrar shall consider whether to refuse to permit the registration of the mark for those and other goods or services, as the case may be, unless the applicant states in his application that the name or description will be varied when the mark is used upon goods or services covered by the specification other than the named or described goods or services.

17. Preliminary advice.

(1) Any person who proposes to apply for the registration of a mark in respect of any goods or services may apply to the Registrar on Form TM 4 for advice as to whether the mark, of which duplicate representations shall accompany the form, appears to the Registrar *prima facie* to be inherently adapted to distinguish within the meaning of section 10 or inherently capable of distinguishing within the meaning of section 11 in relation to those goods or services.

(2) Separate applications shall be made in relation to goods or services comprised within different classes in the Third Schedule.

(3) For the purpose of obtaining repayment of any fee paid on the filing of an application for registration to which the Registrar objects, notice of withdrawal of the application under subsection 73(3) of the Act shall be given in writing within one month from the date of receipt of the notice of the Registrar's objection.

PART V

APPLICATION FOR REGISTRATION

18. Form of application.

(1) An application for the registration of a trade mark, certification trade mark or defensive trade mark shall be made on Form TM 5 accompanied by the prescribed fee and five copies of the application.

(2) Each application shall be in respect of goods or services in only one class in the Third Schedule and applications for the registration of the same mark in different classes shall be treated as separate and distinct applications.

(3) In the case of an application for registration in respect of all the goods or services included in one class, or of a large variety of goods or services, the Registrar may refuse to accept the application unless he is satisfied that the specification is justified by the use of the mark which the applicant has made, or which he intends to make if and when it is registered.

19. Representation of mark.

(1) A representation of the trade mark shall be affixed to the form of application in the space provided for that purpose but if the representation of the mark exceeds that space in size it shall be mounted upon durable material and be annexed to the form of application.

(2) The Registrar may, if he considers that a representation of a trade mark is mounted on a material which will not in the course of time preserve the features of the trade mark, require the applicant to furnish a further representation of the trade mark mounted on a material specified by the Registrar.

20. Representations to be satisfactory.

The representation of a mark shall be clear and durable and if he is dissatisfied with any representation the Registrar may at any time require another representation satisfactory to him to be substituted before proceeding with the application.

21. Cases of difficulty.

(1) Where a representation cannot be filed in accordance with regulation 19, a specimen or copy of the mark, either of full size or on a reduced scale, may, subject to the consent of the Registrar, be filed in any convenient form.

(2) Each specimen or copy filed under subregulation (1) shall be retained by the Registrar for inspection by the public, and the Registrar may refer thereto in the Register in such manner as he may think fit.

22. Series of trade marks.

When application is made for the registration of a series of trade marks under section 24 of the Act, a representation of each mark of the series shall be affixed to the application form in accordance with regulation 19.

23. Transliteration and translation.

(1) Where a trade mark contains a word or words in characters other than Roman there shall, unless the Registrar otherwise directs, be endorsed on the application form for its registration, a certified transliteration and translation of each of such words, and every such endorsement shall state the language to which the words belong.

(2) Where a certified transliteration and translation accompanies the application a sufficient reference to it must be endorsed on the form of application.

(3) Where a trade mark contains a word or words in a language other than the national language or English language, the form of application shall be endorsed with an exact translation of the word or words and the name of the language.

24. Amendment of application.

Any request to amend an application for registration, whether or not the amendment is made to overcome an objection by the Registrar, shall be made on Form TM 26 accompanied by the prescribed fee.

PART VI

**PROCEDURE ON RECEIPT OF AN APPLICATION FOR
REGISTRATION OF TRADE MARK**

25. Search.

(1) Upon receipt of an application for the registration of a trade mark the Registrar shall, for the appropriate purpose specified in subregulation (2) or (3), cause a search to be made amongst registered marks and pending applications and the Registrar may cause the search to be renewed at any time before the acceptance of the application, but shall not be bound to do so.

(2) In the case of an application for the registration of a trade mark in respect of any goods, the appropriate purpose mentioned in subregulation (1) is that of ascertaining whether, for the same goods, for the same description of goods, or for services closely related to those goods, there are on record any marks identical with the mark applied for, or so nearly resembling it as to render use of the mark applied for likely to deceive or cause confusion.

(3) In the case of an application for the registration of a trade mark in respect of any services, the appropriate purpose mentioned in subregulation (1) is that of ascertaining whether, for the same services, for the same description of services, or for goods that are closely related to those services, there are on record any marks identical with the mark applied for, or so nearly resembling it as to render use of the mark applied for likely to deceive or cause confusion.

26. Registrar's acceptance.

After a search conducted as provided for in regulation 25, and after consideration of the application and of any evidence of use or distinctiveness or any other matter which the applicant may, or may be required to furnish, the Registrar may accept the application absolutely, or he may object to it, or he may express his willingness to accept it subject to such conditions, amendments, modifications, or limitations as he may think right to impose.

27. Registrar's objection.

(1) If the Registrar objects to the application, he shall inform the applicant of his objections in writing, and unless within two months from the date of receipt of those objections, the applicant makes a considered reply in writing, he shall be deemed to have abandoned his application.

(2) Any considered reply in writing filed in accordance with subregulation (1) may contain proposals, conditions, amendments, modifications or limitations designed to overcome the Registrar's objections.

(3) Where, after taking into account any considered reply in writing provided in accordance with subregulations (1) and (2), the Registrar maintains his objections to the application, he shall so inform the applicant and if the applicant does not apply for a hearing within two months from the date of receipt of the Registrar's decision he shall be deemed to have abandoned his application.

28. Conditional acceptance.

(1) If the Registrar is willing to accept the application subject to any condition, amendment, modification or limitation, he shall inform the applicant in writing of such willingness.

(2) If the applicant does not respond to the information sent in accordance with subregulation (1) within two months of its receipt he shall be deemed to have abandoned his application.

(3) If the applicant objects to any condition, amendment, modification or limitation contained in the communication sent in accordance with subregulation (1) he may submit his considered reply in writing within two months of its receipt and if he does not do so he shall be deemed to have abandoned his application.

(4) Where, after taking into account any considered reply in writing provided in accordance with subregulation (3), the Registrar maintains his objections to the application, he shall so inform the applicant and if the applicant does not apply for a hearing within two months from the date of receipt of the Registrar's decision he shall be deemed to have abandoned his application.

29. Decision of Registrar.

(1) The decision of the Registrar following a hearing as provided in subregulation 27(3) or 28(4) shall be communicated to the applicant in writing, and if the applicant objects to such decision he may, within two months from the date of its receipt, require, on Form TM 6, the Registrar to state in writing the grounds of, and the materials used by him in arriving at, his decision.

(2) In a case where the Registrar makes any requirements to which the applicant does not object, the applicant shall comply with the requirements before the Registrar issues the statement setting out the grounds of his decision.

(3) The date when a statement is sent to the applicant under this regulation shall be deemed to be the date of the Registrar's decision for the purpose of appeal.

PART VII

CERTIFICATION TRADE MARK

30. Application for registration of certification trade mark.

(1) These Regulations shall apply to an application to register a certification trade mark as they apply to an application to register an ordinary trade mark, except that for references to acceptance of an application there shall be substituted references to authorisation to proceed with the application under regulation 31.

(2) The address of an applicant to register a certification trade mark shall be deemed to be a business address for all the purpose for which such an address is required by these Regulations.

31. Case and draft rules.

(1) The applicant for the registration of a certification trade mark shall send to the Registrar together with his application and the draft rules for governing use of the mark a statement of case setting out the grounds on which he relies in support of his application.

(2) The Registrar may communicate to the applicant any observations he may have to make on the sufficiency of the case or the suitability of the draft rules and the applicant may modify either of those documents.

(3) The Registrar may at any time, call for such evidence as he thinks fit before deciding on the application.

PART VIII

DEFENSIVE TRADE MARK

32. Application for registration of defensive trade mark.

(1) An application to register a defensive trade mark under section 57 of the Act shall be accompanied by a statement of case setting out full particulars of the facts on which the applicant relies in support of his application, verified by a statutory declaration made by the applicant or by some other person approved for the purpose by the Registrar.

(2) The applicant may send with the statutory declaration or within such time as the Registrar may allow, such other evidence as he may desire, whether after request made by the Registrar or otherwise, and the Registrar shall consider the whole of the evidence before deciding on the application.

(3) Subject to subregulations (1) and (2), these Regulations shall, except to the extent that they are inappropriate or it is otherwise provided, apply to applications to register defensive trade marks as they apply to applications to register ordinary trade marks.

PART IX

ADVERTISEMENT OF APPLICATION

33. Application for registration.

(1) Every application for the registration of a trade mark required or permitted to be advertised by section 27 of the Act, shall be advertised in the *Gazette* during such times and in such manner as the Registrar may direct and regulation 34 shall apply.

(2) Before advertising any application in accordance with subregulation (1), the Registrar shall notify the applicant and request payment of the appropriate fee by way of filing Form TM 29; and if the applicant does not pay the fee within two months of receipt of the Registrar's request he shall be deemed to have abandoned his application.

(3) In the case of an application which will be proceeded with by the Registrar only after the applicant has lodged the written consent of the registered proprietor of another mark to the proposed use of the applicant's mark, the words "By Consent" shall appear in the advertisement.

34. Representation for advertisement.

The applicant shall, for the purposes of advertisement, file a representation of the mark in a form approved or directed by the Registrar or in a manner which he thinks fit and such a representation shall be of such dimensions as the Registrar may require or permit for the purpose.

35. Advertisement of series of trade marks.

When an application relates to a series of trade marks differing from one another in respect of the particulars mentioned in section 24 of the Act, the Registrar may, if he thinks fit, insert with the advertisement of the application a statement of the manner in which the marks differ from one another.

36. Advertisement in order cases.

Advertisement under subsections 28(9), 44(2) and 44(4) of the Act shall be made in the same manner, *mutatis mutandis*, as advertisements relating to an application for registration.

PART X

OPPOSITION TO REGISTRATION

37. Opposition.

Any person may, within two months from the date of any advertisement in the *Gazette* of an application for registration of a—

- (a) trade mark;
- (b) certification trade mark; or
- (c) defensive trade mark,

give notice in writing to the Registrar on Form TM 7 accompanied by the prescribed fee of opposition to the registration, and in any such case shall at the same time send a copy of the notice to the applicant.

38. Contents of notice.

(1) A notice of opposition shall include a statement of the grounds upon which the opponent objects to the registration of the applicant's mark.

(2) If registration is opposed on the ground that the mark resembles another mark already on the Register, or the registration of which is the subject of a current application, the number and class of that other mark and, except in the case of an application not yet advertised, the number of the *Gazette* in which it has been advertised shall be set out in the notice.

39. Counter-statement.

(1) Within two months of the receipt of a notice of opposition filed in accordance with regulation 38, the applicant may file a counter-statement on Form TM 8 setting out the grounds on which he relies as supporting his application and the facts, if any, alleged in the notice of opposition which he admits, and shall at the same time send a copy of the counter-statement to the opponent.

(2) If no counter-statement is filed in accordance with subregulation (1), the application shall be deemed abandoned.

40. Evidence in support of opposition.

(1) Within two months of the receipt of the counter-statement, the opponent shall file with the Registrar such evidence by way of statutory declaration as he desires to adduce in support of his opposition, and shall at the same time send a copy of that evidence to the applicant.

(2) If no evidence is filed in accordance with subregulation (1), the opposition shall be deemed abandoned.

41. Evidence in support of application.

(1) Within two months of the receipt of the opponent's evidence, the applicant shall file with the Registrar such evidence by way of statutory declaration as he desires to adduce in support of his application and shall at the same time send a copy of that evidence to the opponent.

(2) If no evidence is filed in accordance with subregulation (1), the application shall be deemed abandoned.

42. Evidence in reply.

(1) Within two months from the receipt by the opponent of the copies of the applicant's evidence filed in accordance with regulation 41, the opponent may file evidence in reply by way of statutory declaration and shall, at the same time, send a copy of that evidence to the applicant.

(2) Evidence in reply shall be confined to matters strictly in reply to the applicant's evidence.

43. Further evidence.

No further evidence may be filed by either side, except that in any proceedings before him, the Registrar may at any time if he thinks fit give leave to either party to file such further evidence upon such terms as to costs or otherwise as he may think fit.

44. Exhibits.

(1) Where there are exhibits to any statutory declaration filed as evidence in an opposition, the party filing them shall, on the request and at the cost of the other party, send to him a copy or impression of each exhibit.

(2) In all cases, the original exhibits filed with the Registrar shall be opened for inspection at the Office by the other side.

45. Extension of time.

Where in opposition proceedings any extension of time is granted to any party, the Registrar may thereafter, if he thinks fit, without giving that party a hearing, grant to the other party, on payment by him of the prescribed fee, any reasonable extension of time in which to take any subsequent step.

46. Written submission.

(1) Upon completion of the evidence the Registrar shall give notice to the parties of a date by which they may send to him any arguments or submissions in writing.

(2) The date mentioned in subregulation (1) shall be at least one month after the date of receipt by the parties of the notice given by the Registrar.

47. Registrar's decision.

As soon as may be after the expiration of the period notified in accordance with regulation 46, the Registrar shall consider the evidence and any written submissions or arguments and shall within two months communicate to the parties in writing his decision in the matter and the grounds of his decision.

48. Security for costs.

(1) Where a party giving notice of opposition under regulation 37 or a counter-statement under regulation 39 neither resides nor carries on business in Malaysia, the Registrar may require him to give security, in such form as the Registrar may deem sufficient, for the costs or expenses of the proceedings before him, for such amount as the Registrar may deem fit, and at any stage in the opposition proceedings he may require further security to be given at any time before giving his decision in the case.

(2) Where an application under subsection 26(1) of the Act is subject to opposition, the Registrar may require the applicant to give security for the costs of any proceedings in relation to the opposition.

(3) In default of such security as mentioned in subregulation (1) being duly given, the Registrar may treat the application or the opposition, as the case may be, as abandoned.

49. Costs in uncontested cases.

In the event of an opposition being uncontested by the applicant, the Registrar in deciding whether costs should be awarded to the opponent shall consider whether proceedings might have been avoided if reasonable notice had been given by the opponent to the applicant before the notice of opposition was lodged.

50. Opposition to a certification trade mark.

(1) Within two months from the date of any advertisement in the *Gazette* of an application for the registration of a certification trade mark, any person may give notice of opposition to the Registrar by filing Form TM 7, accompanied by the prescribed fee, and regulations 37 to 45, 48 and 49 shall apply to the proceedings thereon.

(2) Where the opposition is lodged under subsection 56(12) of the Act, regulations 46 and 47 shall also apply.

(3) Where the opposition is lodged under subsection 56(13) of the Act, subregulations (4), (5) and (6) shall apply.

(4) Upon completion of the evidence the Registrar shall give notice to the parties of a date by which they may either apply for a hearing or send to him any submissions or arguments in writing. If the parties desire to be heard they shall file with the Registrar Form TM 9 accompanied by the prescribed fee.

(5) The date mentioned in subregulation (4) shall be at least one month after the date of receipt by the parties of the notice given by the Registrar.

(6) As soon as may be after the expiration of the period notified in accordance with subregulations (4) and (5), and after hearing the parties if that option has been exercised, the Registrar shall consider the evidence and any written or oral submissions or arguments, and shall within two months communicate in writing to the parties his decision in the matter and the grounds of his decision.

51. Opposition to alteration of rules of a registered certification trade mark.

(1) Within two months from the date of any advertisement in the *Gazette* under subsection 56(14) of the Act of an alteration to the rules deposited in respect of a registered certification trade mark, any person may give notice to the Registrar of opposition to the proposed alteration by filing Form TM 7 accompanied by the prescribed fee.

(2) The subsequent proceedings shall be in accordance with regulations 37 to 45, 48 and 49 and subregulations 50(4) to 50(6).

PART XI

REGISTRATION AND RENEWAL

52. Entry in the Register.

(1) As soon as may be after the expiration of two months from the date of the advertisement in the *Gazette* of any application for the registration of a trade mark, the Registrar shall, subject to any opposition and the determination thereof and subject to subsection 30(1) of the Act, enter the mark in the Register.

(2) Except where the mark consists of a letter, letters, word or words in plain type, or where the Registrar has retained a specimen or copy under subregulation 21(2), the applicant shall if required file a representation of the mark agreeing in all respects with the representation then appearing on the form of application and, subject to subregulation 21(1), complying with regulation 20.

(3) The entry of a trade mark in the Register shall give the following particulars:

- (a) the date of the registration;
- (b) the goods or services in respect of which it is registered;
- (c) the name and the trade or business of the proprietor, including the names of all the partners where the proprietor is a partnership;
- (d) any approved address for service filed under regulation 10;
- (e) particulars of any undertakings given by the proprietor;
- (f) particulars affecting the scope of the registration or the rights conferred by it; and
- (g) any other particulars as the Registrar may determine from time to time.

(4) In the case of an application which the Registrar accepts only after the applicant has lodged the written consent to the proposed registration of the registered proprietor of another trade mark or another applicant for registration, the entry in the Register shall state that it is "By Consent" and shall give the number of the registration of the other trade mark or the other application for registration.

53. Registration not completed within twelve months.

(1) Subject to subregulation (2), where a trade mark has not been registered after six months from the date of the advertisement in the *Gazette* of the application for registration of the mark, the Registrar may give notice in writing to the applicant at his address for service of the non-completion, and if after twelve months from the date of the advertisement the registration is not completed by reason of default on the part of the applicant, the application shall lapse and shall be removed from the record.

(2) Where the registration of a trade mark is delayed by an opposition to its registration and no appeal to the court is made in the matter, the mark may be registered within such time as may be directed by the Registrar and if the mark has not been registered within that time the application shall lapse and shall be removed from the record.

(3) For the purposes of this regulation the requirements for completion are satisfied when the Registrar has received the prescribed fee and, where required, the representation referred to in subregulation 52(2).

54. Associated marks.

(1) Where a mark is registered as associated with any other mark or marks the Registrar shall note in the Register in connection with the first mentioned mark the registration numbers of the marks with which it is associated and shall also note in the Register in connection with each of the associated marks the number of the first mentioned mark as being a mark associated therewith.

(2) An application by a registered proprietor under subsection 22(2) of the Act requesting the Registrar to dissolve the association between two or more registered marks shall be made by filing Form TM 11 accompanied by the prescribed fee and a statement of the grounds of the application.

55. Death of applicant before registration.

(1) If an applicant for the registration of trade mark dies—

- (a) after his application has been made and before the mark has been entered on the Register; and
- (b) another person proves to the satisfaction of the Registrar that he enjoys the same rights in, or in respect of, the mark that the applicant enjoyed,

the application shall, subject to subregulation (2), proceed in that other person's name and regulations 52 and 53 shall apply as if that other person were the applicant.

(2) Before a person may be substituted on an application for registration under subregulation (1), he shall file Form TM 26 accompanied by the prescribed fee and regulation 26 shall apply.

56. Certificate of registration.

Upon the registration of a trade mark, the Registrar shall issue to the applicant a certificate of registration on Form TM 10 and shall affix thereto representation of the mark, if any.

57. Renewal of registration.

(1) At any time not less than three months before the expiration of the last registration of a trade mark, the registered proprietor or his authorised agent may submit Form TM 12 together with the prescribed fee for the renewal of the mark.

(2) If the person filing Form TM 12 is other than the registered proprietor or his authorised agent, he shall enter on the form his name and address and shall attach a letter of authority from the registered proprietor, authorising him to renew the registration of the mark.

58. Reminder of renewal.

(1) If on a date not less than one month and not more than two months before the expiration of the last registration of a trade mark, Form TM 12 accompanied by the appropriate fee has not been received, the Registrar shall notify the registered proprietor in writing of the impending expiration.

(2) Any such notification may be sent in accordance with subregulation 10(5).

59. Late renewal.

If on the expiration of the last registration of a trade mark the renewal fee has not been paid, the Registrar shall forthwith advertise that fact in the *Gazette*, and if, within one month from the date of the advertisement, Form TM 13 is filed, accompanied by the late renewal fee, he shall renew the registration without removing the mark from the Register.

60. Removal and restoration.

(1) If the late renewal fee have not been paid by the end of the period of one month referred to in regulation 59, the Registrar shall remove the mark from the Register as of the expiration of the last registration.

(2) If, within one year from the expiry of the last registration, Form TM 14 is filed, accompanied by the restoration and renewal of registration fee, the Registrar may restore the mark to the Register and renew its registration if he is satisfied that it is just to do so, upon such condition as he may think fit.

61. Record of removal.

Where a trade mark has been removed from the Register for non-payment of the renewal fee the Registrar shall enter in the Register a record of such removal and of the cause thereof and shall advertise the fact of the removal in the *Gazette*.

62. Notice and advertisement of renewal and restoration.

Upon the renewal or restoration and renewal of registration, a notice to that effect shall be sent to the registered proprietor and the renewal or restoration and renewal of registration shall be advertised in the *Gazette*.

PART XII

ASSIGNMENTS AND TRANSMISSIONS

63. Application for entry of subsequent proprietor.

(1) Where a person becomes entitled by assignment or transmission to a registered trade mark he shall make application to register his title by filing Form TM 15 accompanied by the prescribed fee.

(2) An application under subregulation (1) may be made jointly with the registered proprietor.

64. Particulars to be provided.

(1) An application under subregulation 63(1) shall contain the full name and trade or business address of the applicant and, if the applicant is a partnership, the full names of all the partners.

(2) There shall be filed with the application for retention by the Registrar, an attested copy of the instrument, if any, under which the applicant claims his entitlement.

(3) The Registrar may at any time, by notice in writing sent to the applicant, require him to produce for inspection any instrument of which an attested copy has been filed.

(4) An instrument or attested copy of the instrument furnished in accordance with this regulation shall not be opened for public inspection.

(5) Where an applicant does not claim under any instrument which is capable in itself of furnishing documentary proof of his title he shall file with the application a statement of case setting forth the full particulars of the facts upon which his claim to be the proprietor of the mark in question is based and showing that it has been assigned or transmitted to him, and if the Registrar so requires the case shall be verified by statutory declaration.

65. Proof of title.

The Registrar may call on any person who applies to be registered as proprietor of a registered trade mark for such proof or additional proof of title as he may require for his satisfaction.

66. Assignment without goodwill.

(1) An application under subregulation 63(1) relating to an assignment of a trade mark in respect of any goods or services shall state—

(a) whether the mark was, at the time of the assignment, used in a business in any of those goods or services, as the case may be; and

- (b) whether the assignment was made otherwise than in connection with the goodwill of that business,

and if both circumstances subsist the assignment shall be advertised in prominent newspapers or other publications approved by the Registrar in any particular case and the advertisement shall state that the assignment was otherwise than in connection with the goodwill of the business concerned.

- (2) A copy of the advertisement shall be filed with the Registrar and until this has been done the assignment shall be deemed not to have taken effect.

67. Entry of assignment in Register.

When the Registrar is satisfied as to the title of an applicant under subregulation 63(1), he shall cause the applicant to be registered as proprietor of the trade mark in respect of the relevant goods or services and shall enter in the Register—

- (a) the name and the trade or business address of the new proprietor, including the names of all the partners where the new proprietor is a partnership;
- (b) any address for service filed under regulation 10; and
- (c) particulars of the assignment or transmission.

68. Partial assignment.

Where, pursuant to an application under subregulation 63(1) and as a result of a division and separation of the goods or services of a registration, or a division and separation of places or markets, different persons become registered separately, whether or not under different official numbers, as subsequent proprietors of a registered trade mark, each of the resultant separate registrations in the names of different persons shall be treated as a separate registration for all purposes of the Act.

69. Proposed assignment or transmission.

(1) Any person wishing to obtain the Registrar's written approval of a proposed assignment or transmission in accordance with subsection 55(4) of the Act shall file an application on Form TM 15, a statement of case in duplicate setting out the circumstances, and a copy of any instrument or proposed instrument effecting the assignment or transmission in question.

(2) The Registrar may call for any evidence or further information that he may consider necessary, and may require the statement of case to be amended to include all the relevant circumstances or to be verified by statutory declaration; and if the statement of case is amended, two fair copies in its final form shall be filed.

(3) The Registrar shall consider whether in all circumstances use of the trade mark in question in exercise of rights conferred or to be conferred by the proposed assignment or transmission is in the public interest and shall issue a notification in writing of approval or disapproval thereof, as the case may be, and shall seal to the notification a copy of the statement of case in its final form.

PART XIII

ALTERATION OF THE REGISTER

70. Alteration of address.

(1) A registered proprietor or registered user of a trade mark whose—

- (a) trade or business address is changed; or
- (b) address for service as entered in the Register is no longer appropriate, whether by reason of discontinuance of the entered address or otherwise,

and as such the entry in the Register is rendered incorrect shall forthwith, by filing Form TM 16 or TM 1 as appropriate, request the Registrar to make the appropriate alteration of the address in the Register.

(2) Upon a request made under subregulation (1), accompanied by the prescribed fee, the Registrar shall, if he is satisfied in the matter, alter the Register accordingly.

(3) A registered proprietor or a registered user of a trade mark whose registered business address or address for service is altered by a public authority but the address as altered designates the same premises as before shall make a request for the appropriate alteration of the address to the Registrar on Form TM 16 or TM 1 as appropriate and if the request is accompanied by a certificate of the alteration given by the said authority, the Registrar shall alter the Register accordingly if he is satisfied as to the facts of the case, without payment of fee.

(4) If the address of one person is the address for service of more than one registered proprietor or registered user, or in respect of more than one registered mark, that person may request the Registrar to make the appropriate alteration in the Register in respect of each entry concerned by filing a single Form TM 1 suitably amended and, if the Registrar is satisfied that the altered address is that of the applicant and complies with regulation 10, he shall make the alterations in the Register accordingly on payment of the prescribed fee in respect of each such entry, unless the application is made under subregulation (3).

71. Application for making, cancelling or varying an entry by a registered proprietor or registered user.

(1) Subject to regulation 70, an application to the Registrar under section 43 of the Act for making, cancelling or varying an entry in the Register shall be made by filing Form TM 17, TM 18 or TM 19, as the case may be, accompanied by the prescribed fee.

(2) Every application under subregulation (1) shall be accompanied by a statement setting out fully the nature of the applicant's interest, the facts on which he bases his case and the relief which he seeks.

(3) Where the application is made by a person who is not the registered proprietor of the mark in question, the applicant shall forthwith send copies of the application and of the statement to the registered proprietor at his trade or business address as entered in the Register and, if an address for service different therefrom is entered in the Register, at that address also.

(4) In any particular case the Registrar may require a statement made under subregulation (2) to be verified by statutory declaration.

72. Evidence for alteration.

The Registrar may require an applicant under regulation 71 to furnish such evidence by statutory declaration or otherwise as he may think fit as to the circumstances in which the application was made.

73. Advertisement in certain cases.

Before deciding on a request made on Form TM 19 under regulation 71 for the entry of a disclaimer or memorandum, the Registrar shall advertise the request in the *Gazette* to enable any person wishing to oppose the request to state in writing, within two months from the date of the advertisement, any reasons against the making of the entry.

74. Application to the court.

A copy of every application to the court under the Act shall be filed at the Office by the applicant.

75. Order of court.

(1) Where an order is made by the court in any case under the Act, the person in whose favour the order is made or, if there is more than one, such one of them as the Registrar may direct, shall file an office copy of the order with the Registrar and, if rectification or alteration of the Register is required, Form TM 28 accompanied by the prescribed fee.

(2) The Register shall, where appropriate, be rectified or altered by the Registrar accordingly.

(3) If the Registrar considers that an order made by the court under the Act should be given publicity he may publish it in the *Gazette*.

76. Certificate of validity.

(1) Where the court has certified with regard to the validity of a registered trade mark as provided in section 61 of the Act, the registered proprietor of the mark may, by filing Form TM 20 accompanied by the prescribed fee and an office copy of the certificate, request the Registrar to add to the entry in the Register a note that the certificate of validity has been so granted.

(2) The proceedings in the course of which the certificate was granted shall be named in the request.

(3) On receipt of a request made in accordance with subregulation (1), the Registrar shall enter a note in the Register as requested and publish it in the *Gazette*.

77. Alteration of registered mark.

(1) An application under section 44 of the Act for addition to or alteration of a registered trade mark shall be made by filing Form TM 21 accompanied by the prescribed fee and a representation of the mark as it will appear when added to or altered.

(2) The representation of the altered mark shall, subject to regulation 21, comply with regulation 20.

78. Advertisement before decision.

(1) The Registrar shall consider each application filed in accordance with regulation 77 and, if it appears to him expedient to do so, shall advertise it in the *Gazette* before deciding it.

(2) Where the Registrar causes an application made under subsection 44(1) of the Act to be advertised, then, within two months from the date of the advertisement, any person may give notice of opposition to the application by filing Form TM 22 accompanied by the prescribed fee and a statement of the grounds of the opposition.

(3) Regulations 37 to 45 and subregulations 50(4), 50(5) and 50(6) shall apply to any further proceedings on the application with such modifications as may be required to suit the circumstances.

(4) If, in a case where notice has been given under subregulation (2), the Registrar decides to allow the application he shall add to or alter the mark in the Register accordingly.

79. Advertisement of altered mark.

Regulation 34 shall apply in respect of all advertisements made under regulation 78.

PART XIV

REGISTERED USER

80. Application for entry of registered user.

(1) An application to the Registrar under section 48 of the Act for the registration of a person as a registered user of a registered trade mark shall be made by the registered proprietor by filing Form TM 23 accompanied by the prescribed fee.

(2) A separate application shall be made for each proposed registered user of the registered mark.

(3) Every application under this regulation shall contain a representation of the registered mark complying with regulation 34.

81. Entry of registered user.

(1) The Registrar shall send to the registered proprietor of the mark in respect of which an application under regulation 80 has been made and to the registered user a notification in writing of the registration of the registered user and may, if he thinks fit, publish such notification in the *Gazette*.

(2) The date on which the application was duly made under regulation 80 shall be deemed to be the date on which the person mentioned in the entry in the Register as a registered user was so registered.

82. Variation or cancellation of entry of registered user.

(1) Application by the registered proprietor of a registered trade mark for the variation or cancellation of the registration of a registered user of the mark under section 49 of the Act shall be made by filing Form TM 24 accompanied by the prescribed fee.

(2) A representation of the registered mark in question shall accompany any application made under this regulation and regulation 34 shall apply to it.

(3) If the variation or cancellation affects more than one registered user of the mark a separate application shall be made in respect of each of them.

(4) If the Registrar is satisfied in the matter, he shall cancel or vary, as the case may be, the entry on the Register relating to the registered user concerned, in accordance with the application.

(5) The Registrar shall send to the registered proprietor of the registered mark in question a notification of the variation or cancellation and may, if he thinks fit, publish such notification in the *Gazette*.

83. Expiry or striking out.

(1) Where, in accordance with paragraph 48(2)(e) of the Act, the registration of a registered user is for a period and the period expires before the expiration of the last registration of the trade mark, the Registrar may strike out the relevant entry at the end of that period.

(2) If an entry is struck out or varied otherwise than at the instance of the registered proprietor, the Registrar shall send written notification of the striking out or variation to the registered proprietor and to any registered user whose permitted use is affected thereby and shall publish such notification in the *Gazette*.

PART XV

SUPPLEMENTARY

84. Extension of time.

(1) If, in any particular case, the Registrar is satisfied that the circumstances are such as to justify an extension of the time for doing any act or taking any proceeding under these Regulations, not being a time expressly provided in the Act or prescribed by regulation 53, subregulation 60(1), or subregulation 86(2), he may extend the time upon such notice to other parties, and upon such terms as he may direct, and the extension may be granted though the time has expired for doing the act or taking the proceeding.

(2) Every application for an extension of time under subregulation (1) shall be made on Form TM 27 stating the circumstances in sufficient detail to enable the Registrar to determine whether the extension is justified and shall be accompanied by the prescribed fee.

(3) Where, in an *inter-partes* proceeding an extension of time is sought, the party seeking the extension shall at the same time send to every other person who at the time is a party to the proceeding, a copy of the request for extension filed with the Registrar.

(4) Any party may, within fourteen days of receiving a copy of a request in accordance with subregulation (3), send to the Registrar observations on the request for an extension and if no observations are so sent he shall be deemed to consent to the extension being granted by the Registrar.

(5) In considering whether to grant an extension of time in a case falling within subregulation (3) the Registrar shall take into account the circumstances set out in the request for an extension and of any observations submitted by other parties to the proceedings and he shall send a copy of his decision to the party seeking the extension and to every other party referred to in subregulation (3).

85. Excluded days.

(1) The following days shall be excluded days for all purposes under the Act and these Regulations:

- (a) all Sundays;
- (b) any day specified as or proclaimed to be a public holiday;
- (c) any day proclaimed to be an excluded day by notice displayed to public view at an Office.

(2) Whenever the last day fixed by the Act or by these Regulations for doing any act or thing at the Office falls on a day which is an excluded day, it shall be lawful to do the act or thing on the first day following such excluded day which is not an excluded day.

86. Application for hearing.

(1) Before exercising adversely to an applicant for registration or a registered proprietor any discretionary power given to the Registrar by the Act or by these Regulations, the Registrar shall hear that person thereon if so required by that person.

(2) Any request for a hearing under subregulation (1) shall be made to the Registrar within two months from the date the Registrar notifies him that he proposes to exercise a discretionary power.

(3) The decision of the Registrar in the exercise of any such discretionary power shall be notified to the person affected.

87. Power to dispense with evidence.

Where, under these Regulations any person is required to do any act or thing, or any document or evidence is required to be filed, and it is shown to the satisfaction of the Registrar that by any reasonable cause that person is unable to do that act or thing or that document or evidence cannot be filed, the Registrar may, upon the production of such other evidence and subject to such terms as he thinks fit, dispense with the doing of any such act or thing, or the filing of such document or evidence.

88. Amendment of documents.

Any document filed in any proceedings before the Registrar and any mistake in a drawing or other representation of a trade mark may, if the Registrar thinks fit, be amended, and any irregularity in procedure in or before the Office may be rectified, on such terms as the Registrar may direct.

89. Certificate by Registrar.

(1) Subject to subregulation (2), any person may, by filing Form TM 25 accompanied by the prescribed fee, request the Registrar to give a certificate as to any entry, matter or thing which the Registrar is authorised or required by the Act or these Regulations to make or do, other than a certificate of registration issued under subsection 30(2) of the Act.

(2) Before giving a certificate under subregulation (1), the Registrar may, if he thinks fit, require the person making the request to show to his satisfaction an interest in the entry, matter or thing in question and if he is not so satisfied he may decline to furnish the certificate.

(3) The Registrar shall not be obliged to include in any certificate issued under this regulation a copy of the mark unless the person making the request has filed a copy suitable for the purpose.

90. Statutory declarations.

(1) Any statutory declaration required under the Act or these Regulations, or used in any proceedings thereunder, shall be made and subscribed as follows:

- (a) in Malaysia, in accordance with the provisions of the Statutory Declarations Act 1960;
- (b) in any other part of the world before any court, judge, justice of the peace, magistrate, notary public or other officer authorised by law to administer an oath for the purpose of any legal proceedings.

(2) Any document purporting to have affixed, impressed or subscribed thereto or thereon the seal or signature of any person authorised by subregulation (1) to take a declaration may be admitted without proof of the genuineness of the seal or signature or of the official character of the person or his authority to take the declaration.

PART XVI

REVOCATION AND TRANSITIONAL PROVISIONS

91. Revocation.

The Trade Marks Regulations 1983 are hereby revoked.

92. Saving.

(1) These Regulations shall not apply to any application made under the revoked Regulations and submitted prior to the coming into force of these Regulations and for the purpose of such applications, the revocation of the Trade Marks Regulations 1983 shall be deemed to have not been made.

(2) The Registrar may give directions as he deems fit to ensure that the application under subregulation (1) complies with these Regulations in so far as it is not prejudicial to the application of the revoked Regulations.

(3) For the avoidance of doubt, the directions of the Registrar in respect of an application for registration of a trade mark or for renewal of a trade mark or for registration as a registered user or to any trade mark registered, made prior to the coming into force of these Regulations, shall not affect paragraph 31(2)(c), subsection 32(1), section 41, subsection 49(3) and section 70A of the Act.

FIRST SCHEDULE

(Regulation 3)

FEES

The following fees shall be paid in respect of applications, registrations and other matters under the Act. Such fees must in all cases be paid before or at the time of doing the matter in respect of which they are to be paid.

PART 1

<i>Form TM</i>	<i>Matters or Proceedings</i>	<i>Fee RM</i>
1	Form of authorisation and request to enter, alter or substitute an address for service	30.00
2	Application for registration of trade marks agent	1000.00
3	Application for renewal of registration of trade marks agent	400.00
4	Request for Registrar's preliminary advice as to registrability of a mark	100.00

<i>Form TM</i>	<i>Matters or Proceedings</i>	<i>Fee RM</i>
5	Application for registration of a mark	250.00
6	Request for statement of grounds of decision	500.00
7	Notice of opposition	450.00
8	Counter-statement to a notice of opposition	300.00
9	Notice to the Registrar of attendance at hearing	480.00
10	Certificate of registration	Fee collected on Form TM. 29
11	Application to dissolve the association between a registered trade mark and other registered trade mark(s)	120.00
12	Application for renewal of registration of a trade mark	420.00
13	Application for late renewal of registration of a trade mark	630.00
14	Application for restoration and renewal of registration	670.00
15	Application and declaration of an assignment/a transmission for registration as proprietor of a trade mark	180.00
16	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	60.00
17	Request by registered proprietor of a registered trade mark for making, cancelling or varying of an entry in the Register	100.00
18	Request by registered proprietor of a registered trade mark to strike out goods or services	100.00
19	Request by registered proprietor of a registered trade mark for entry of a disclaimer or memorandum	120.00
20	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	120.00
21	Application by registered proprietor for an addition to or alteration of a registered trade mark	120.00

<i>Form TM</i>	<i>Matters or Proceedings</i>	<i>Fee RM</i>
22	Notice of opposition to an application for addition to or alteration of a registered trade mark	480.00
23	Application for registration of registered user	180.00
24	Application for variation or cancellation of the registration of a registered user	150.00
25	Request for Registrar's certificate other than certificate of registration	100.00
26	Request for correction of a clerical error in an application or for permission to otherwise amend an application for registration	100.00
27	Request for extension of time (Per month :	50.00 100.00)
28	Notice of order of court for rectification or alteration of the Register	100.00
29	Advertisement for registration	450.00

PART II

OTHER FEES REQUIRED UNDER THE ACT

	<i>Fee RM</i>
1. Request for copy of office document and manuscript—	
(a) Certified extract from Register	10.00 per page
(b) Non-certified extract from Register	5.00 per page
(c) Computer print-out	5.00 per page
2. Request to conduct public search	10.00 per hour

SECOND SCHEDULE

(Regulation 4)

FORMS

<i>Form TM</i>	
1	Form of authorisation and request to enter, alter or substitute an address for service
2	Application for registration of trade marks agent

Form
TM

- 3 Application for renewal of registration of trade marks agent
- 4 Request for Registrar's preliminary advice as to registrability of a mark
- 5 Application for registration of a mark
- 6 Request for statement of grounds of decision
- 7 Notice of opposition
- 8 Counter-statement to a notice of opposition
- 9 Notice to the Registrar of attendance at hearing
- 10 Certificate of registration
- 11 Application to dissolve the association between a registered trade mark and other registered trade mark(s)
- 12 Application for renewal of registration of a trade mark
- 13 Application for late renewal of registration of a trade mark
- 14 Application for restoration and renewal of registration
- 15 Application and declaration of an assignment/a transmission for registration as proprietor of a trade mark
- 16 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
- 17 Request by registered proprietor of a registered trade mark for making, cancelling or varying of an entry in the Register
- 18 Request by registered proprietor of a registered trade mark to strike out goods or services
- 19 Request by registered proprietor of a registered trade mark for entry of a disclaimer or memorandum
- 20 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
- 21 Application by registered proprietor for an addition to or alteration of a registered trade mark
- 22 Notice of opposition to an application for addition to or alteration of a registered trade mark
- 23 Application for registration of registered user
- 24 Application for variation or cancellation of the registration of a registered user
- 25 Request for Registrar's certificate other than certificate of registration
- 26 Request for correction of a clerical error in an application or for permission to otherwise amend an application for registration
- 27 Request for extension of time: (Per month :
- 28 Notice of order of court for rectification or alteration of the Register
- 29 Advertisement for registration

INTELLECTUAL PROPERTY DIVISION—TRADE MARK

TRADE MARKS REGISTRY

TM 1

TRADE MARKS ACT 1976

TRADE MARKS REGULATIONS 1997

FORM OF AUTHORISATION AND REQUEST TO ENTER, ALTER OR
SUBSTITUTE AN ADDRESS FOR SERVICE

This form must be filed whenever an agent is appointed
or when one agent is substituted for another
(Subregulations 10(1), 10(2), 10(3) and 11(2))

1.	Trade Mark No.:	<input type="text"/>
2.	Class:	<input type="text"/>
3.	Full name and address of proprietor:	
4.	Full name and address of agent (if any):.....	
5.	Agent's Registration No. (if known):.....	
6.	Agent's own reference:.....	
7.	<p>I request that all communication concerning the above trade mark be sent to the address indicated, which is the address for service.</p> <p>Note: Enter (3) or (4) as appropriate in the box. <input type="checkbox"/> An address for service must be in Malaysia. The full postal addresses of the parties must be given.</p> <p>Signature:.....</p> <p>Name of signatory (in block letter):.....</p> <p>Date:.....</p>	

INTELLECTUAL PROPERTY DIVISION—TRADE MARK

TRADE MARKS REGISTRY

TM 2

TRADE MARKS ACT 1976

TRADE MARKS REGULATIONS 1997

APPLICATION FOR REGISTRATION OF TRADE MARKS AGENT

(Subregulation 12(2))

For Official Use

Application received on:.....

Fee received on:.....

Amount:.....

* Cheque/Postal Order/Money Order/Cash/Draft No.:.....
(* Please tick whichever is applicable)

I. APPLICANT:

Name:

Address:

.....

.....

.....

Nationality:

.....

Permanent residence or principal place of business:

.....

.....

.....

.....

Telephone No.:.....

Fax No.:

II. QUALIFICATIONS:

(Please attach copies of qualifications certified by a Commissioner of Oath)

.....
.....
.....
.....
.....
.....

III. EXPERIENCE:

(Please submit in the form of statutory declaration)

.....
.....
.....
.....
.....

IV. DECLARATION:

I hereby declare that all the information given above is true and correct.

Signature:.....

Date:.....

INTELLECTUAL PROPERTY DIVISION—TRADE MARK

TRADE MARKS REGISTRY

TM 3

TRADE MARKS ACT 1976

TRADE MARKS REGULATIONS 1997

APPLICATION FOR RENEWAL OF REGISTRATION OF
TRADE MARKS AGENT

(Subregulation 12(7))

For Official Use

Application received on:.....

Fee received on:.....

Amount:.....

* Cheque/Postal Order/Money/Cash/Draft No.....

(* Please tick whichever is applicable)

I. APPLICANT:

Name:.....

Address:.....

.....

.....

Nationality:.....

.....

Permanent residence or principal place of business:

.....

.....

.....

.....

Telephone No.:.....

Fax No.:.....

II. QUALICATIONS:

(Please attach copies of qualifications certified by a Commissioner of Oath)

.....
.....
.....
.....
.....
.....

III. ADDITIONAL INFORMATION accompanies this Form:

Yes

☐

No

☐

IV. DECLARATION:

I hereby declare that all the information given above is true and correct.

Signature:.....

Date:.....

INTELLECTUAL PROPERTY DIVISION—TRADE MARK

TRADE MARKS REGISTRY

TM 4

TRADE MARKS ACT 1976

TRADE MARKS REGULATIONS 1997

REQUEST FOR REGISTRAR'S PRELIMINARY
ADVICE AS TO REGISTRABILITY OF A MARK

(Subregulation 17(1))

1. Representation of mark:

If the space provided is insufficient, the representation may be made on a separate sheet which must be firmly annexed to this Form.

The representation must be clear and durable and comply with regulation 34 of the Trade Marks Regulations 1997.

2. List of goods or services: 3. Class

Goods or services falling within more than one international class must be the subject of separate applications. Continue on a separate sheet if necessary.

4. Full name and address of applicant:.....

If the applicant resides abroad, an address for service in Malaysia must be provided.

5. Full name and address of agent (if any):.....

If this is the address for service and is not already on record, Form TM 1 must be filed with this Form.

6. Agent's Registration No. (if known):.....

7. Agent's own reference:.....

8. The Registrar is requested to advise whether the mark appears to him *prima facie* to be inherently adapted to distinguish or inherently capable of distinguishing the goods or services specified, within the meaning of sections 10, 11 and 12 of the Act.

Signature:.....

Name of signatory (in block letter):.....

Date:.....

INTELLECTUAL PROPERTY DIVISION—TRADE MARK

TRADE MARKS REGISTRY

TM 5

TRADE MARKS ACT 1976

TRADE MARKS REGULATIONS 1997

APPLICATION FOR REGISTRATION OF A MARK

(Subregulation 18(1))

1. Application is hereby made for the registration of a:

trade mark

☐

defensive trade mark

☐

certification trade mark

☐

Note: Please tick the box appropriate to the kind of mark for which registration is desired.

In the case of a trade mark a copy of the oath, sworn statement or statutory declaration by the applicant are true must be attached.

In the case of a certification trade mark a copy of the rules governing its use must be attached.

In the case of a defensive trade mark a copy of the statement of case verified by a statutory declaration, must be attached.

in part

☐

of the Register.

(Insert, A or B
as appropriate)

(Five (5) copies of this Form must be enclosed with the application)

2. Representation of mark:

Note: If the space provided is insufficient, the representation may be made on a separate sheet which must be firmly annexed to this Form.

If the application is for a series of trade marks under section 24 a representation of each mark in the series must be given.

Representation must be clear and durable and comply with regulation 34.

☐

If the mark is coloured and is to be limited accordingly, please tick this box:

☐

3. List of goods or service:

4. Class:

☐

Goods or services falling within more than one international class must be subject of separate applications. Continue on a separate sheet if necessary.

<p>5. Limitations, etc.:</p> <p>Insert below any conditions, disclaimers or other limitations to which the registration will be subjected to.</p> <p>If the mark contains or consists of a word or words in non-Roman characters or in a language other than English language or the national language a certified transliteration and translation as appropriate must be provided.</p>
<p>6. Full name and address of applicant:.....</p> <p>.....</p> <p>.....</p> <p>.....</p> <p>If the applicant resides abroad, an address for service in Malaysia must be provided.</p>
<p>7. Full name and address of agent (if any):.....</p> <p>.....</p> <p>.....</p> <p>.....</p> <p>If this is the address for service and is not already on record, Form TM 1 must be filed with this Form.</p>
<p>8. Agent's Registration No. (if known):.....</p>
<p>9. Agent's own reference:.....</p>
<p>10. International Convention priority claim:</p> <p>If priority date is claimed under International Convention or a bilateral arrangement, please give details below and attach the relevant documents.</p> <p>Convention country:.....Priority date claimed:.....</p>
<p>11. Date of first use of the mark in Malaysia (if any):.....</p>
<p>12. Declaration: I/We claim to be the <i>bone fide</i> proprietor of the mark whose registration is applied for and, where the mark has not been used in Malaysia, that the application is made in good faith and that I/We am/are entitled to be registered as the proprietor.</p> <p>An agent signing this Form on behalf of the applicant must satisfy himself as to the truth of the declaration.</p> <p>Signature:.....</p> <p>Name of signatory (in block letter):.....</p> <p>Date:.....</p> <p>If the applicant is a partnership, the full names of all the partners must be stated.</p>

INTELLECTUAL PROPERTY DIVISION TRADE MARK

TRADE MARKS REGISTRY

TM 6

TRADE MARKS ACT 1976

TRADE MARKS REGULATIONS 1997

REQUEST FOR STATEMENT OF GROUNDS OF DECISION

(Subregulation 29(1))

1. Application No.:	<input type="text"/>
2. Class:	<input type="text"/>
3. Full name and address of the applicant:..... If the applicant resides abroad, an address for service in Malaysia must be provided.	
4. Full name and address of agent (if any):..... If this is the address for service and is not already on record, Form TM 1 must be filed with this Form.	
5. Agent's Registration No. (if known):.....	
6. Agent's own reference:.....	
7. Date of Registrar's decision:..... Please state above the date of the Registrar's letter conveying his refusal or conditional acceptance of the application.	
8. The Registrar is requested to state in writing his decision and the grounds. Note: The date of the Registrar's decision for the purposes of any appeal will be the date that the written grounds are issued in response to this request. Signature:..... Name of signatory (in block letter):..... Date:.....	

TM 7

TRADE MARKS REGULATIONS 1997

(Regulation 37, Subregulations 50(1) and 51(1))

1. Application No.:	<div style="border: 1px solid black; height: 20px; width: 100%;"></div>												
2. Class:	<div style="border: 1px solid black; height: 20px; width: 100%;"></div>												
<p>3. Notice is hereby given to oppose the application for registration of a:</p> <table style="width: 100%; border: none;"> <tr> <td style="width: 45%; padding: 5px;">trade mark</td> <td style="width: 10%; padding: 5px;"><div style="border: 1px solid black; height: 20px; width: 100%;"></div></td> <td style="width: 45%; padding: 5px;">certification trade mark</td> <td style="width: 10%; padding: 5px;"><div style="border: 1px solid black; height: 20px; width: 100%;"></div></td> </tr> <tr> <td style="padding: 5px;">defensive trade mark</td> <td style="padding: 5px;"><div style="border: 1px solid black; height: 20px; width: 100%;"></div></td> <td style="padding: 5px;">alteration of rules of a registered certification trade mark</td> <td style="padding: 5px;"><div style="border: 1px solid black; height: 20px; width: 100%;"></div></td> </tr> <tr> <td style="padding: 5px;">Others</td> <td style="padding: 5px;"><div style="border: 1px solid black; height: 20px; width: 100%;"></div></td> <td colspan="2"></td> </tr> </table> <p>(Please tick whichever is applicable)</p>		trade mark	<div style="border: 1px solid black; height: 20px; width: 100%;"></div>	certification trade mark	<div style="border: 1px solid black; height: 20px; width: 100%;"></div>	defensive trade mark	<div style="border: 1px solid black; height: 20px; width: 100%;"></div>	alteration of rules of a registered certification trade mark	<div style="border: 1px solid black; height: 20px; width: 100%;"></div>	Others	<div style="border: 1px solid black; height: 20px; width: 100%;"></div>		
trade mark	<div style="border: 1px solid black; height: 20px; width: 100%;"></div>	certification trade mark	<div style="border: 1px solid black; height: 20px; width: 100%;"></div>										
defensive trade mark	<div style="border: 1px solid black; height: 20px; width: 100%;"></div>	alteration of rules of a registered certification trade mark	<div style="border: 1px solid black; height: 20px; width: 100%;"></div>										
Others	<div style="border: 1px solid black; height: 20px; width: 100%;"></div>												
<p>4. Full name and address of the opponent:.....</p> <p>.....</p> <p>.....</p> <p>.....</p> <p>.....</p> <p>.....</p> <p>.....</p> <p>If the opponent resides abroad, an address for service in Malaysia must be provided.</p>													
<p>5. Full name and address of agent (if any):.....</p> <p>.....</p> <p>.....</p> <p>.....</p> <p>.....</p> <p>.....</p> <p>.....</p> <p>If this is the address for service and is not already on record, Form TM 1 must be filed with this Form.</p>													

6.	Agent's Registration No. (if known):.....
7.	Agent's own reference:.....
8.	Date and details of <i>Gazette</i> in which the opposed mark was advertised:
9.	Grounds of opposition: If registration is opposed on the ground that the mark resembles marks already on the Register, the number of those marks and the <i>Gazette</i> in which they were advertised must also be given. If the space provided is in sufficient, please continue on a separate sheet which must be firmly annexed to this Form.
Signature:..... Name of signatory (in block letter):..... Date:.....	
Note: — A copy of this Form must be sent to the applicant for registration at his address for service. — One notice for each opposition.	

INTELLECTUAL PROPERTY DIVISION—TRADE MARK

TRADE MARKS REGISTRY

TM 8

TRADE MARKS ACT 1976

TRADE MARKS REGULATIONS 1997

COUNTER-STATEMENT TO A NOTICE OF OPPOSITION

(Subregulations 39(1), 50(1) and 51(2))

1.	Application No.:	<input type="text"/>
2.	Class:	<input type="text"/>
3.	Full name and address of the applicant:..... If the applicant resides abroad, an address for service in Malaysia must be provided.	
4.	Full name and address of agent (if any):..... If this is the address for service and is not already on record, Form TM 1 must be filed with this Form.	
5.	Agent's Registration No. (if known):.....	
6.	Agent's own reference:.....	
7.	Grounds in support of application: (If the space provided is insufficient, please continue on a separate sheet which must be firmly annexed to this Form) Signature:..... Name of signatory (in block letter):..... Date:..... Note: A copy of this Form must be sent to the opponent at his address for service.	

INTELLECTUAL PROPERTY DIVISION—TRADE MARK

TRADE MARKS REGISTRY

TM 9

TRADE MARKS ACT 1976

TRADE MARKS REGULATIONS 1997

NOTICE TO THE REGISTRAR OF ATTENDANCE AT HEARING

(Subregulations 50(4) and 51(2))

INSTRUCTION

Please type or write in block letters

1. Application number in respect of which the hearing is held:

2. Reason for hearing:

3. Opposition to registration:

4. Other matters (Please specify):

5. I/We hereby confirm that by the Registrar's notice to me/us dated the.....day of..... the hearing of the arguments in respect of the above matter is fixed for:

Time (hours):

Date:

6. Will be attended by me/us or, by an agent/agents on my/our behalf:

Signature :

Name :

Telephone No. :

Date :

INTELLECTUAL PROPERTY DIVISION—TRADE MARK

TRADE MARKS REGISTRY

TM 10

TRADE MARKS ACT 1976

TRADE MARKS REGULATIONS 1997

CERTIFICATE OF REGISTRATION

(Regulation 56)

TRADE MARK NO. :
CLASS :
REGISTERED FROM :day of.....
NAME OF PROPRIETOR :
GOODS/SERVICES :

.....
Registrar of Trade Marks
Malaysia

Date:

INTELLECTUAL PROPERTY DIVISION—TRADE MARK

TRADE MARKS REGISTRY

TM 11

TRADE MARKS ACT 1976

TRADE MARKS REGULATIONS 1997

APPLICATION TO DISSOLVE THE ASSOCIATION BETWEEN A
REGISTERED TRADE MARK AND OTHER REGISTERED
TRADE MARK(S)
(Subregulation 54(2))

Trade Mark No.: Class:

PARTICULARS OF TRADE MARK'S PROPRIETOR

Name:

Address:

.....

.....

.....

.....

.....

.....

Telephone No.:

Signature:

Date:

Note: — If this Form is filed by an agent, please attach Form TM 1
together with this Form.

— A statement of grounds of application must accompany this
application.

INTELECTUAL PROPERTY DIVISION—TRADE MARK

TRADE MARKS REGISTRY

TM 12

TRADE MARKS ACT 1976

TRADE MARKS REGULATIONS 1997

APPLICATION FOR RENEWAL OF REGISTRATION
OF A TRADE MARK

(Subregulation 57(1))

Trade Mark No.:	<div style="border: 1px solid black; height: 25px;"></div>
Class:	<div style="border: 1px solid black; height: 25px;"></div>
<p>I/We/Agent of—</p> <p>hereby apply to renew the above registration. Fee is enclosed herewith.</p> <p>(Cheque/Cash)</p> <p>Signature:ProprietorAgent</p> <p>Date:</p> <p>Note: — If the agent is newly appointed, please file Form TM 1. — A letter of authority must be attached if the applicant is other than the registered proprietor or the agent. — A representation of the mark must accompany the application.</p>	

INTELLECTUAL PROPERTY DIVISION—TRADE MARK

TRADE MARKS REGISTRY

TM 13

TRADE MARKS ACT 1976

TRADE MARKS REGULATIONS 1997

APPLICATION FOR LATE RENEWAL OF REGISTRATION
OF A TRADE MARK

(Regulation 59)

Trade Mark No.:	<input type="text"/>
Class:	<input type="text"/>
<p>I/We/Agent of—</p> <p>hereby apply to renew the above registration. Fee is enclosed herewith.</p> <p>(Cheque/Cash)</p> <p>Signature:ProprietorAgent</p> <p>Date:</p> <p>Note: If the agent is newly appointed, please file Form TM 1.</p>	

INTELLETUAL PROPERTY DIVISION—TRADE MARK

TRADE MARKS REGISTRY

TM 14

TRADE MARKS ACT 1976

TRADE MARKS REGULATIONS 1997

APPLICATION FOR RESTORATION AND RENEWAL OF REGISTRATION

(Subregulation 60(2))

Trade Mark No.:	<input type="text"/>
Class:	<input type="text"/>
I/We/Agent
of—

hereby apply to restore and renew the above registration. Fee is enclosed herewith.	
(Cheque/Cash)	
Signature:Proprietor
Agent
Date:
Note: If the agent is newly appointed, please file Form TM 1.	

INTELLECTUAL PROPERTY DIVISION—TRADE MARK

TRADE MARKS REGISTRY

TM 15

TRADE MARKS ACT 1976

TRADE MARKS REGULATIONS 1997

APPLICATION AND DECLARATION OF AN ASSIGNMENT/A
TRANSMISSION FOR REGISTRATION AS PROPRIETOR
OF A TRADE MARK

(Subregulations 63(1) and 69(1))

Trade Mark No.:..... Class:.....

Associated No.:.....

PARTICULARS OF ASSIGNOR/PRESENT/PREVIOUS PROPRIETOR:

Name:

Address:

PARTICULARS OF ASSIGNEE/NEW PROPRIETOR:

Name:

Address:

Telephone No.:

I/We hereby apply for the approval of the Registrar to be entered in the Register as proprietor of the trade mark for the following:

☐ assignment with goodwill

☐ assignment without goodwill

☐ proposed assignment (with goodwill)

☐ proposed assignment (without goodwill)

☐ transmission

(Please tick whichever is applicable)

I/We am/are entitled to the trade mark by virtue of:

- ☐ "Deed of Assignment"
- ☐ Statement of Case verified by a Statutory Declaration
- ☐ Others. (Please specify)

dated....., a copy/copies which is/are attached together with this Form.

(Please tick whichever is applicable)

.....
(Signature of Assignee)

Date:.....

- Note: — If there is any appointment of agent or address for service, please attach Form TM 1 together with this Form.
- If partial assignment is to be made, goods or services assigned should be stated clearly in the Deed.
- One application form for each trade mark.

INTELLECTUAL PROPERTY DIVISION—TRADE MARK

TRADE MARKS REGISTRY

TM 16

TRADE MARKS ACT 1976

TRADE MARKS REGULATIONS 1997

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

(Subregulation 70(1))

Trade Mark No.:..... Class:.....

I/We am/are the:

Proprietor [] Registered User [] of a registered
mark.

I/We hereby request for:

[] entering a change in the description in the Register

[] alteration of trade/business address in the Register

[] correction of an error in the Register

(Please tick whichever is applicable)

PREVIOUS PARTICULARS:

Name:

Address:

.....

.....

NEW PARTICULARS:

Name:

Address:

.....

.....

Actual date of change of:

(i) name:

(ii) address:

Address for service:

(If there is a change of agent or address for service, please file Form TM 1)

.....
.....
.....
.....
.....
.....
.....

.....
(Signature of registered
proprietor or registered user)

Date:.....

Note: A registered proprietor or a registered user whose address has been altered by a public authority, while the change of address designates the same premises as before, shall attached the supporting statement together with this Form to avoid payment of fee.

INTELLECTUAL PROPERTY DIVISION—TRADE MARK

TRADE MARKS REGISTRY

TM 17

TRADE MARKS ACT 1976

TRADE MARKS REGULATIONS 1997

REQUEST BY REGISTERED PROPRIETOR OF A REGISTERED
TRADE MARK FOR MAKING, CANCELLING OR VARYING
OF AN ENTRY IN THE REGISTER

(Subregulation 71(1))

Trade Mark No.:	<div style="border: 1px solid black; height: 20px;"></div>
Class:	<div style="border: 1px solid black; height: 20px;"></div>
<p>Name and address of registered proprietor:</p> <p>.....</p> <p>.....</p> <p>.....</p> <p>hereby request that an entry in the Register</p> <p>[] be made;</p> <p>[] be cancelled; or</p> <p>[] be varied</p> <p>in the following manner:</p> <p>(If the space provided is insufficient, please continue on a separate sheet which must be firmly annexed to this Form)</p> <p>.....</p> <p>.....</p> <p>.....</p> <p>.....</p> <p>.....</p> <p>.....</p> <p>.....</p> <p>.....</p> <p>Signature:..... Date:.....</p> <p>Note: — If this Form is filed by an agent, please attach Form TM 1 together with this Form.</p> <p> — A statement of case must accompany the application.</p>	

INTELLECTUAL PROPERTY DIVISION—TRADE MARK

TRADE MARKS REGISTRY

TM 18

TRADE MARKS ACT 1976

TRADE MARKS REGULATIONS 1997

REQUEST BY REGISTERED PROPRIETOR OF A REGISTERED
TRADE MARK TO STRIKE OUT GOODS OR SERVICES

(Subregulation 71(1))

1. Trade Mark No.:	<input type="text"/>
2. Class:	<input type="text"/>
3. Full name and address of the registered proprietor:..... If the proprietor resides abroad, an address for service in Malaysia must be provided.	
4. Full name and address of agent (if any): If this is the address for service and is not already on record, Form TM 1 must be filed with this Form.	
5. Agent's Registration No. (if known):.....	
6. Agent's own reference:.....	
7. The Registrar is requested to strike out the following goods or services from the registered specification: (If the space provided is insufficient, please continue on a separate sheet which must be firmly annexed to this Form) Signature: Name of signatory (in block letters):..... Date: Note: A copy of this Form must be sent to the opponent at his address for service.	

INTELLECTUAL PROPERTY DIVISION —TRADE MARK

TRADE MARKS REGISTRY

TM 19

TRADE MARKS ACT 1976

TRADE MARKS REGULATIONS 1997

REQUEST BY REGISTERED PROPRIETOR OF A REGISTERED
TRADE MARK FOR ENTRY OF A DISCLAIMER
OR MEMORANDUM

(Subregulation 71(1))

1. Trade Mark No.:	<input type="text"/>
2. Class:	<input type="text"/>
3. Full name and address of the registered proprietor:..... If the proprietor resides abroad, an address for service in Malaysia must be provided.	
4. Full name and address of agent (if any): If this is the address for service and is not already on record, Form TM1 must be filed with this Form.	
5. Agent's Registration No. (if known):.....	
6. Agent's own reference:.....	
7. The Registrar is requested to enter the following disclaimer or memorandum in the Register: (If the space provided is insufficient, please continue on a separate sheet which must be firmly annexed to this Form) Signature: Name of signatory (in block letter):..... Date:.....	

INTELLECTUAL PROPERTY DIVISION —TRADE MARK

TRADE MARKS REGISTRY

TM 20

TRADE MARKS ACT 1976

TRADE MARKS REGULATIONS 1997

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

(Subregulation 76(1))

Trade Mark No.:	<input type="text"/>
Class:	<input type="text"/>
<p>Details of court proceedings.</p> <p>Please state on a separate sheet of paper, full details of the nature of the court proceedings and the names of the parties in which the certificate was given. (An office copy of the certificate must be attached)</p> <p>Name and address of registered proprietor:</p> <p>.....</p> <p>.....</p> <p>.....</p> <p>.....</p> <p>.....</p> <p>Signature:.....</p> <p>Date:.....</p> <p>Note: If this Form is filed by an agent, please attach Form TM1 together with this Form.</p>	

TM 21

TRADE MARKS REGULATIONS 1997

(Subregulation 77(1))

Note: If this Form is filed by an agent, please attach Form TMI together with this Form.

INTELLECTUAL PROPERTY DIVISION—TRADE MARK

TRADE MARK REGISTRY

TRADE MARK ACT 1976

TM 22

TRADE MARKS REGULATIONS 1997

NOTICE OF OPPOSITION TO AN APPLICATION FOR ADDITION
TO OR ALTERATION OF A REGISTERED TRADE MARK

(Subregulation 78(2))

INSTRUCTION Please type or write in block letters	
1. Trade Mark No.:	<input type="text"/>
2. Name of applicant:	
3. Address for service of applicant:	
4. Class:	<input type="text"/>
5. Date of advertisement:	
6. Page:	
7. Name and address of the opponent: If the opponent resides abroad, an address for service in Malaysia must be provided.	
8. Grounds of opposition: (Please attach)	
Signature: Name: Telephone No.: Date: Note: A copy of this Form must be sent to the applicant at his address for service.	

INTELLECTUAL PROPERTY DIVISION—TRADE MARK

TRADE MARKS REGISTRY

TM 23

TRADE MARKS ACT 1976

TRADE MARKS REGULATIONS 1997

APPLICATION FOR REGISTRATION OF REGISTERED USER

(Subregulation 80(1))

Trade Mark No.: Class:

PARTICULARS OF REGISTERED PROPRIETOR

Full name:

Address:

.....

.....

.....

.....

.....

..... Telephone No.:

PARTICULARS OF REGISTERED USER:

Full name:

Address:

.....

.....

.....

.....

.....

Telephone No.:

Note: Please state the full names of each of the partners, if the registered user is a partnership.

- ☐ Effective from:
- ☐ Without limit of period.
- ☐ With limit. Please state the expiry date:
- ☐ Exclusive/Sole registered user.
- ☐ Non exclusive/Not sole registered user.
- ☐ To use all goods or services registered under the proprietor.
- ☐ To use parts of the goods or services registered under the proprietor.

Please state below:

.....

(If the space provided is insufficient, please continue on a separate sheet which must be firmly annexed to this Form)
 (Please tick whichever is applicable)

Representation of the registered mark:

(If the space provided is insufficient, the representation may be made on a separate sheet which must be firmly annexed to this Form)

.....
 (Signature of registered proprietor)

Date:

Note: — If there is any appointment of agent or address for service, please file Form TM1.

— One application form for each trade mark.

INTELLECTUAL PROPERTY DIVISION—TRADE MARK

TRADE MARK REGISTRY

TM 24

TRADE MARK ACT 1976

TRADE MARKS REGULATIONS 1997

APPLICATION FOR VARIATION OR CANCELLATION OF THE
REGISTRATION OF A REGISTERED USER

(Subregulation 82(1))

Trade Mark No.: Class:

PARTICULARS OF REGISTERED PROPRIETOR:

Name:

Address:

.....

.....

.....

.....

.....

Telephone No.:.....

PARTICULARS OF REGISTERED USER:

Name:

Address:

.....

.....

.....

Telephone No.:.....

State the goods or service registered under the registered user:

.....

.....

(If the space provided is insufficient, please continue on a separate sheet
which must be firmly annexed to this Form)

This application is for: ☐ cancellation ☐ variation

☐ Effective date of cancellation of registered user:

☐ Effective date of variation of registered user:

State the goods in respect of which the registered user is to be altered.

.....
.....
.....
.....
.....

(If the space provided is insufficient, please continue on a separate sheet which must be firmly annexed to this Form)

(Please tick whichever is applicable)

.....
(Signature of registered proprietor)

Date:

Note: — Please attach a representation of the registered mark together with this Form.

— If there is any appointment of agent or address for service, please file Form TM 1.

— One application form for each trade mark.

INTELLECTUAL PROPERTY DIVISION—TRADE MARK

TRADE MARKS REGISTRY

TM 25

TRADE MARKS ACT 1976

TRADE MARKS REGULATIONS 1997

REQUEST FOR REGISTRAR'S CERTIFICATE OTHER
THAN CERTIFICATE OF REGISTRATION

(Subregulation 89(1))

1. Number of the mark in respect of which a certificate is required:	<input type="text"/>
2. Class (if known):	<input type="text"/>
<p>3. Certificate requirements:</p> <p>Set out below the particulars in which the Registrar is requested to certify.</p> <p>Note: A representation of the mark will not be included in any certificate issued in response to this request unless one suitable for the purpose is supplied to the Registrar.</p>	
<p>4. Name and address to which the certificate is to be sent:</p> <p>Signature:</p> <p>Name of signatory (in block letter):</p> <p>Date:</p>	

INTELLECTUAL PROPERTY DIVISION—TRADE MARK

TRADE MARKS REGISTRY

TM 26

TRADE MARKS ACT 1976

TRADE MARKS REGULATIONS 1997

REQUEST FOR CORRECTION OF A CLERICAL ERROR
IN AN APPLICATION OR FOR PERMISSION TO OTHERWISE
AMEND AN APPLICATION FOR REGISTRATION

(Regulation 24)

1. Application No.:	<input type="text"/>
2. Class:	<input type="text"/>
3. Full name and address of applicant:	
.....	
.....	
.....	
.....	
If the applicant resides abroad, an address for service in Malaysia must be provided.	
4. Full name and address of agent (if any):	
.....	
.....	
.....	
.....	
.....	
If this is the address for service and is not already on record, Form TM 1 must be filed with this Form.	
5. Agent's Registration No. (if known):	
.....	
.....	
.....	
6. Agent's own reference:	

7. Details to be amended or corrected:

Here state the nature and full details of the alteration required, e.g. revised specification, transfer to Part B, change of address, change of class number, entry of a disclaimer, translation *etc.* Where the mark itself is amended, six copies of an amended representation complying with regulation 34 must be provided. Where the applicant's name has been changed, a copy of the certificate or other evidence must be attached.

(If the space provided is insufficient, please continue on a separate sheet which must be firmly annexed to this Form).

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.....

Signature:

Name of signatory (in block letter):

Date:

INTELLECTUAL PROPERTY DIVISION—TRADE MARK

TRADE MARK REGISTRY

TM 27

TRADE MARK ACT 1976

TRADE MARKS REGULATIONS 1997

APPLICATION FOR EXTENSION OF TIME

(Subregulation 84(2))

Trade Mark No.:	<input type="text"/>
Class:	<input type="text"/>
<i>Extension of time:</i>	
Number of month(s) requested	<input type="text"/>
Please state the circumstances justifying the application: (If the space provided is insufficient, please continue on a separate sheet which must be firmly annexed to this Form)	
Signature of proprietor/agent: Name/Firm: Telephone No.: Date:	

For Official Use Only:

Decision: (a) Your request for extension of time is approved for.....
month (s) from..... until..... upon payment of
RM.....

Authorised signature:

Name:

Date:

(b) Your request for extension is rejected.

INTELLECTUAL PROPERTY DIVISION—TRADE MARK

TRADE MARKS REGISTRY

TM 28

TRADE MARKS ACT 1976

TRADE MARKS REGULATIONS 1997

NOTICE OF ORDER OF COURT FOR RECTIFICATION OR
ALTERATION OF THE REGISTER

(Subregulation 75(1))

1. Trade Mark No.:	<input type="text"/>
2. Class:	<input type="text"/>
3. Full name and address of the registered proprietor:	
.....	
.....	
.....	
.....	
.....	
If the proprietor resides abroad, an address for service in Malaysia must be provided.	
4. Full name and address of agent (if any):	
.....	
.....	
.....	
.....	
.....	
If this is the address for service and is not already on record, Form TM 1 must be filed with this Form.	
5. Details of the amendment required to be made:	
(An office copy of the order of court must be attached)	
Signature:	
Name of signatory (in block letter):	
Date:	

INTELLECTUAL PROPERTY DIVISION—TRADE MARK

TRADE MARKS REGISTRY

TM 29

TRADE MARKS ACT 1976

TRADE MARKS REGULATIONS 1997

ADVERTISEMENT FOR REGISTRATION

(Subregulation 33(2))

Date:

Your Reference No.:

To:

.....

.....

.....

.....

Application No.:

Class:

INSTRUCTIONS FOR ADVERTISING TRADE MARKS IN THE
GAZETTE

1. Please send in four (4) copies of black/white artworks and a copy of coloured artwork (if relevant) as in the attached Form TM 5.
2. Artwork must be on bromide paper, clear and measuring not more than 7cm X 7cm and not less than 2cm X 2cm.
3. Artwork received are not returnable.
4. Please make sure that all details on the second page are correct and notify the Registrar if there is any error and/or objection.
5. Any alteration to the details on the second page must be filed on Form TM 26.
6. Please return this Form together with the prescribed fee.
7. Your trade mark application will be abandoned if there is no reply within two (2) months from the above date.
8. Certificate of registration will be issued subject to opposition or any other matters related thereto.

Application No. :

Class :

Applicant's name/address :

Agent's name/
address for service :

Associated with :

Condition (s) :

Goods or service :

Note: If the agent is newly appointed, please file Form TM 1.

Signature and designation:

.....
.....
.....
.....

Date:

THIRD SCHEDULE

(Regulation 5)

CLASSIFICATION OF GOODS AND SERVICES

PART 1

CLASSES OF GOODS

CLASS 1

Chemicals used in industry, science and photography, as well as in agriculture, horticulture and forestry; unprocessed artificial resins, unprocessed plastics; manures; fire extinguishing compositions; tempering and soldering preparations; chemical substances for preserving foodstuffs; tanning substances; adhesives used in industry.

CLASS 2

Paints, varnishes, lacquers; preservatives against rust and against deterioration of wood; colorants; mordants; raw natural resins; metals in foil and powder form for painters, decorators, printers and artists.

CLASS 3

Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soap; perfumery, essential oils, cosmetics, hair lotions; dentifrices.

CLASS 4

Industrial oils and greases; lubricants; dust absorbing, wetting and binding compositions; fuels (including motor spirit) and illuminants; candles, wicks.

CLASS 5

Pharmaceutical, veterinary and sanitary preparations; dietetic substances adapted for medical use, food for babies; plasters, material for dressings; material for stopping teeth, dental wax; disinfectants; preparations for destroying vermin; fungicides, herbicides.

CLASS 6

Common metals and their alloys; metal building materials; transportable buildings of metal; materials of metal for railway tracks; non-electric cables and wires of common metal; ironmongery, small items of metal hardware; pipes and tubes of metal; safes; goods of common metal not included in other classes; ores.

CLASS 7

Machines and machines tools; motors and engines (except for land vehicles); machine coupling and transmission components (except for land vehicles); agricultural implements; incubators for eggs.

CLASS 8

Hand tools and implements (hand operated); cutlery; side arms; razors.

CLASS 9

Scientific, nautical, surveying, electric, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers, recording discs; automatic vending machines and mechanisms for coin operated apparatus; cash registers, calculating machines, data processing equipment and computers; fire-extinguishing apparatus.

CLASS 10

Surgical, medical, dental and veterinary apparatus and instruments, artificial limbs, eyes and teeth; orthopaedic articles; suture materials.

CLASS 11

Apparatus for lighting, heating, steam generating, cooking, refrigerating, drying, ventilating, water supply and sanitary purposes.

CLASS 12

Vehicles; apparatus for locomotion by land, air or water.

CLASS 13

Firearms, ammunition and projectiles; explosives; fireworks.

CLASS 14

Precious metals and their alloys and goods in precious metals or coated therewith, not included in other classes; jewellery, precious stones; horological and chronometric instruments.

CLASS 15

Musical instruments.

CLASS 16

Paper, cardboard and goods made from these materials, not included in other classes; printed matter; bookbinding material; photographs; stationery; adhesives for stationery or household purposes; artists' materials; paint brushes; typewriters and office requisites (except furniture); instructional and teaching material (except apparatus); plastic materials for packaging (not included in other classes); playing cards; printers' type; printing blocks.

CLASS 17

Rubber, gutta-percha, gum, asbestos, mica and goods made from these materials and not included in other classes; plastics in extruded form for use in manufacture; packing, stopping and insulating materials; flexible pipes, not of metal.

CLASS 18

Leather and imitations of leather, and goods made of these materials and not included in other classes; animal skins, hides; trunks and travelling bags; umbrellas, parasols and walking sticks; whips, harness and saddlery.

CLASS 19

Building materials (non-metallic); non-metallic rigid pipes for building; asphalt, pitch and bitumen; non-metallic transportable buildings; monuments, not of metal.

CLASS 20

Furniture, mirrors, picture frames; goods (not included in other classes) of wood, cork, reed, cane, wicker, horn, bone, ivory, whalebone, shell, amber, mother-of-pearl, meerschaum and substitutes for all these materials, or of plastics.

CLASS 21

Household or kitchen utensils and containers (not of precious metal or coated therewith); combs and sponges; brushes (except paint brushes); brush-making materials; articles for cleaning purposes; steel wool; unworked or semi-worked glass (except glass used in building); glassware, porcelain and earthenware not included in other classes.

CLASS 22

Ropes, string, nets, tents, awnings, tarpaulins, sails, sacks and bags (not included in other classes); padding and stuffing material (except of rubber or plastics); raw fibrous textile materials.

CLASS 23

Yarns and threads; for textile use.

CLASS 24

Textiles and textile goods, not included in other classes; bed and table covers.

CLASS 25

Clothing, footwear, headgear.

CLASS 26

Lace and embroidery, ribbons and braid; buttons, hooks and eyes, pins and needles; artificial flowers.

CLASS 27

Carpets, rugs, mats and matting, linoleum and other materials for covering existing floors; wall hangings (non-textile).

CLASS 28

Games and playthings; gymnastic and sporting articles not included in other classes; decorations for Christmas trees.

CLASS 29

Meat, fish, poultry and game; meat extracts; preserved, dried and cooked fruits and vegetables; jellies, jams, fruit sauces; eggs, milk and milk products; edible oils and fats.

CLASS 30

Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals, bread, pastry and confectionery, ices; honey, treacle; yeast, baking-powder; salt, mustard; vinegar, sauces (condiments); spices; ice.

CLASS 31

Agricultural, horticultural and forestry products and grains not included in other classes; live animals; fresh fruits and vegetables; seeds, natural plants and flowers; foodstuffs for animals, malt.

CLASS 32

Beers; mineral and aerated waters and other non-alcoholic drinks; fruit drinks and fruit juices; syrups and other preparations for making beverages.

CLASS 33

Alcoholic beverages (except beers).

CLASS 34

Tobacco; smokers' articles; matches.

PART 2

CLASSES OF SERVICES

CLASS 35

Advertising; business management; business administration; office functions.

CLASS 36

Insurance; financial affairs; monetary affairs; real estate affairs.

CLASS 37

Building construction; repair; installation services.

CLASS 38

Telecommunications.

CLASS 39

Transport; packaging and storage of goods; travel arrangement.

CLASS 40

Treatment of materials.

CLASS 41

Education; providing of training; entertainment, sporting and cultural activities.

CLASS 42

Scientific and technological services and research and design relating thereto; industrial analysis and research services; design and development of computer hardware and software; legal services.

CLASS 43

Services for providing food and drink; temporary accommodation.

CLASS 44

Medical services; veterinary services; hygienic and beauty care for human beings or animals; agriculture, horticulture and forestry services.

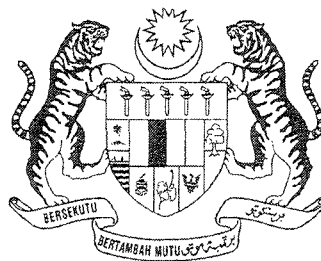
CLASS 45

Personal and social services rendered by others to meet the needs of individuals.

Made 13 August 1997.

[KPDN/BHI/S-0.202; PN. (PU²) 316/II.]

DATUK SERI MEGAT JUNID BIN MEGAT AYOB,
*Minister of Domestic Trade
and Consumer Affairs*



LAWS OF MALAYSIA

Act A1078

TRADE MARKS (AMENDMENT) ACT 2000

Date of Royal Assent 30 May 2000

Date of publication in the
Gazette 15 June 2000

LAWS OF MALAYSIA

Act A1078

TRADE MARKS (AMENDMENT) ACT 2000

An Act to amend the Trade Marks Act 1976.

[]

ENACTED by the Parliament of Malaysia as follows:

Short title and commencement

1. (1) This Act may be cited as the Trade Marks (Amendment) Act 2000.

(2) This Act shall come into operation on a date to be appointed by the Minister by notification in the *Gazette*.

Amendment of section 3

2. The Trade Marks Act 1976 [*Act 175*], which in this Act is referred to as the “principal Act”, is amended in subsection 3(1)—

(a) by inserting after the definition of “Court” the following definition:

“geographical indication” means an indication which identifies any goods as originating in a country or territory or a region or locality in that country or territory, where a given quality, reputation or other characteristic of the goods is essentially attributable to their geographical origin;”

(b) by inserting after the definition of “mark” the following definition:

“Paris Convention” means the Paris Convention for the Protection of Industrial Property of 20 March, 1883 as revised at Stockholm on 14 July 1967;” and

(c) by inserting after the definition of “transmission” the following definition:

“TRIPS Agreement” means the Agreement on Trade-Related Aspects of Intellectual Property Rights 1994 which constitutes Annex 1C to the Agreement Establishing the World Trade Organization;”.

New section 4A

3. The principal Act is amended by inserting after section 4 the following section:

“^{Protection} 4A. No action or prosecution shall be brought, instituted
^{of officers.} or maintained in any Court against—

- (a) the Registrar of Trade Marks;
- (b) a Deputy Registrar of Trade Marks; or
- (c) an Assistant Registrar of Trade Marks,

for any act or omission done in good faith in the performance of his functions and the exercise of his powers under this Act.”.

Amendment of section 6

4. Section 6 of the principal Act is amended—

- (a) by deleting subsection (2); and
- (b) in subsection (3) by deleting the words “of Part A or Part B”.

Amendment of section 10

5. Section 10 of the principal Act is amended—

- (a) by substituting for the marginal note the following marginal note:

“Registrable trade marks.”;

- (b) in subsections (1) and (2) by deleting the words “in Part A of the Register”;

- (c) in subsection (2A) by substituting for the words “it is adapted to distinguish” the words “the trade mark must be capable of distinguishing”;

- (d) by substituting for subsection (2B) the following subsection:

“(2B) In determining whether a trade mark is capable of distinguishing as aforesaid, regard may be had to the extent to which—

- (a) the trade mark is inherently capable of distinguishing as aforesaid; and

- (b) by reason of the use of the trade mark or of any other circumstances, the trade mark is in fact capable of distinguishing as aforesaid.”; and

- (e) by substituting for subsection (3) the following subsection:

“(3) A trade mark may be registered in the Register in respect of any goods or services.”.

Deletion of section 11

6. Section 11 of the principal Act is deleted.

Amendment of section 14

7. Section 14 of the principal Act is amended—

(a) by renumbering the existing section as subsection (1) of that section;

(b) in subsection (1)—

(i) by deleting the word “or” at the end of paragraph (b);

(ii) by substituting for the full stop at the end of paragraph (c) a semicolon; and

(iii) by inserting after paragraph (c) the following paragraphs:

“(d) if it is identical with or so nearly resembles a mark which is 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, and the interests of the proprietor of the well-known mark are likely to be damaged by such use;

(f) if it contains or consists of a geographical indication with respect to goods not originating in the territory indicated, if use of the indication in the mark for such goods in Malaysia is of such a nature as to mislead the public as to the true place of origin of the goods; or

(g) if it is a 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.”; and

(c) by inserting after subsection (1) the following subsection:

“(2) Article 6*bis* of the Paris Convention and Article 16 of the TRIPS Agreement shall apply for the purpose of determining whether a trade mark is a well-known trade mark.”.

New section 14A

8. The principal Act is amended by inserting after section 14 the following section:

“Where registration shall not be refused. 14A. (1) A trade mark shall not be refused registration by virtue of paragraphs (f) and (g) of section 14 if the application for its registration had been made in good faith, or if it had been used continuously in good faith in the course of trade by the applicant for its registration or his predecessor in title, either—

Act 602. (a) before the commencement of the Geographical Indications Act 2000; or
(b) before the geographical indication in question is protected in its country of origin.

(2) A trade mark shall not be refused registration by virtue of paragraphs (f) and (g) of section 14 if the geographical indication in question—

(a) has ceased to be protected; or
(b) has fallen into disuse,
in its country of origin.”.

Amendment of section 25

9. Section 25 of the principal Act is amended—

- (a) in subsection (1) by deleting the words “Part A or Part B of”; and
- (b) by deleting subsection (11).

Amendment of section 30

10. Subsection 30(1) of the principal Act is amended—

- (a) by deleting the words “Part A or Part B of”; and
- (b) by substituting for the words “on payment of the prescribed fees in the name of the proprietor in Part A or Part B of the Register, as the case may be,” the words “in the Register on payment of the prescribed fees in the name of the proprietor,”.

Amendment of section 35

11. Subsection 35(1) of the principal Act is amended by deleting the words “in Part A or Part B”.

Amendment of section 37

12. Section 37 of the principal Act is amended by deleting the words “Part A of”.

Amendment of section 38

13. Section 38 of the principal Act is amended by deleting subsection (2).

Amendment of section 39

14. Subsection 39(1) of the principal Act is amended by deleting the words “Part A or Part B of”.

Amendment of section 45

15. Section 45 of the principal Act is amended by deleting subsection (2).

Amendment of section 55

16. Section 55 of the principal Act is amended in the national language text by substituting for the word “muhibbah” wherever appearing the words “nama baik”.

Amendment of section 56

17. Section 56 of the principal Act is amended—

(a) in subsection (1)—

- (i) by substituting for the words “A mark adapted in relation to any goods or services to distinguish” the words “A mark must be capable, in relation to any goods or services, of distinguishing”; and
- (ii) by deleting the words “Part A of”;

(b) by substituting for subsection (2) the following subsection:

“(2) In determining whether a mark is capable of distinguishing, the Registrar may have regard to the extent to which—

- (a) the mark is inherently capable of distinguishing in relation to the goods or services in question; and
- (b) by reason of the use of the mark or any other circumstances, the mark is in fact capable of distinguishing in relation to the goods or services in question.”; and

(c) by deleting subsection (18).

New section 70B

18. The principal Act is amended by inserting after section 70A the following section:

“Protection of well-known trade marks. 70B. (1) The proprietor of a trade mark which is entitled to protection under the Paris Convention or the TRIPS Agreement as a 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 the 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 a trade mark begun before the commencement of this Act.

(3) In this section, references to a trade mark which is entitled to protection under Article 6*bis* of the Paris Convention or Article 16 of the TRIPS Agreement as a well-known trade mark are to a mark which is 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.”.

New Part XIVA

19. The principal Act is amended by inserting after Part XIV the following Part:

“PART XIVA

BORDER MEASURES

Interpretation. 70C. In this Part, unless the context otherwise requires—

“authorised officer” means—

Act 235. (a) a proper officer of customs as defined under the Customs Act 1967; or

(b) any officer appointed by the Minister by notification in the *Gazette* to exercise the powers and perform the duties conferred and imposed on an authorised officer by this Part;

“counterfeit trade mark goods” means any goods, including packaging, bearing without authorisation a trade mark which is identical with or so nearly resembles the trade mark validly registered in respect of such goods, or which cannot be distinguished in its essential aspects from such a trade mark, and which infringes the rights of the proprietor of the trade mark under this Act;

“goods in transit” means goods imported, whether or not landed or transshipped within Malaysia, which are to be carried to another country either by the same or another conveyance;

“import” means to bring or cause to be brought into Malaysia by whatever means;

“retention period”, in relation to seized goods, means—

- (a) the period specified in a notice given under section 70G in respect of the goods; or
- (b) if the period has been extended under section 70G, that period so extended;

“security” means any sum of money in cash;

“seized goods” means goods seized under section 70D.

Restriction
on impor-
tation of
counterfeit
trade mark
goods.

70D. (1) Any person may submit an application to the Registrar stating—

- (a) that he is the proprietor of a registered trade mark or an agent of the proprietor having the power to submit such application;
- (b) that, at a time and place specified in the application, goods which, in relation to the registered trade mark, are counterfeit trade mark goods are expected to be imported for the purpose of trade; and
- (c) that he objects to such importation.

(2) An application under subsection (1) shall be supported by such documents and information relating to the goods as to enable them to be identified by the authorised officer, and accompanied by such fee as may be prescribed.

(3) Upon receipt of the application under subsection (1), the Registrar shall determine the application, and the Registrar shall within a reasonable period inform the applicant whether the application has been approved.

(4) In determining the reasonable period under subsection (3), the Registrar shall take into consideration all relevant circumstances of the case.

(5) An approval under subsection (3) shall remain in force until the end of the period of sixty days commencing on the day on which the approval was given, unless it is withdrawn before the end of that period by the applicant by giving a notice in writing to the Registrar.

(6) Where an approval has been given under this section and has not lapsed or been withdrawn, the importation of any counterfeit trade mark goods into Malaysia for the duration of the period specified in the approval shall be prohibited.

(7) Upon giving his approval under subsection (3) the Registrar shall immediately take the necessary measures to notify the authorised officer.

(8) Where an authorised officer has been notified by the Registrar, he shall take the necessary action to prohibit any person from importing goods identified in the notice, not being goods in transit, and shall seize and detain the identified goods.

Security. 70E. (1) The Registrar shall, upon giving his approval under section 70D, require the applicant to deposit with the Registrar a security which in the opinion of the Registrar is sufficient to—

- (a) reimburse the Government for any liability or expense it is likely to incur as a result of the seizure of the goods;
- (b) prevent abuse and to protect the importer; or
- (c) pay such compensation as may be ordered by the Court under this Part.

Secure storage of seized goods. 70F. (1) Seized goods shall be taken to such secure place as the Registrar may direct or as the authorised officer deems fit.

(2) If it is stored on the direction of the authorised officer, the authorised officer shall inform the Registrar of the whereabouts of the seized goods.

Notice. 70G. (1) As soon as is reasonably practicable after goods are seized under section 70D, the authorised officer shall give to the Registrar, importer and the applicant, either personally or by registered post, a written notice identifying the goods, stating that they have been seized and the whereabouts of the goods.

(2) A notice under subsection (1) shall also state that the goods will be released to the importer unless an action for infringement in respect of the goods is instituted by the applicant within a specified period from the date of the notice.

(3) If at the time of the receipt of the notice an action for infringement has been instituted by the applicant, the applicant shall notify the Registrar of that fact.

(4) The applicant may, by written notice given to the Registrar before the end of the period specified in the notice (the initial period), request that the period be extended.

(5) Subject to subsection (6), if—

- (a) a request is made in accordance with subsection (4); and
- (b) the Registrar is satisfied that it is reasonable that the request be granted,

the Registrar may extend the initial period.

(6) A decision on a request made in accordance with subsection (4) shall be made within two working days after the request is made, but such a decision cannot be made after the end of the initial period to which the request relates.

Inspection,
release,
etc., of
seized
goods.

70H. (1) The Registrar may permit the applicant or the importer to inspect the seized goods if he agrees to give the requisite undertakings.

(2) The requisite undertakings mentioned in subsection (1) are undertakings in writing that the person giving the undertakings will—

- (a) return the sample of the seized goods to the Registrar at a specified time that is satisfactory to the Registrar; and
- (b) take reasonable care to prevent damage to the sample.

(3) If the applicant gives the requisite undertakings, the Registrar may permit the applicant to remove a sample of the seized goods from the custody of the Registrar for inspection by the applicant.

(4) If the importer gives the requisite undertakings, the Registrar may permit the importer to remove a sample of the seized goods from the custody of the Registrar for inspection by the importer.

(5) If the Registrar permits inspection of the seized goods, or the removal of a sample of the seized goods, by the applicant in accordance with this section, the Registrar is not liable to the importer for any loss or damage suffered by the importer arising out of—

- (a) damage to any of the seized goods incurred during that inspection; or

- (b) anything done by the applicant or any other person to, or in relation to, a sample removed from the custody of the Registrar or any use made by the applicant or any other person of such a sample.

Forfeiture
of seized
goods by
consent.

70i. (1) Subject to subsection (2), the importer may, by written notice to the Registrar, consent to the seized goods being forfeited to the Government.

(2) The notice shall be given before any action for infringement in relation to the seized goods is instituted.

(3) If the importer gives such a notice, the seized goods are forfeited to the Government and shall be disposed of in the manner prescribed by regulations made under this Part.

Compulsory
release of
seized goods
to importer.

70j. (1) The Registrar shall release the seized goods to the importer on the expiration of the retention period for the goods if the applicant—

- (a) has not instituted an action for infringement in relation to the goods; and
- (b) has not given written notice to the Registrar stating that the action for infringement has been instituted.

(2) If—

- (a) an action for infringement has been instituted in relation to the seized goods; and
- (b) at the end of a period of thirty days commencing on the day on which the action for infringement was instituted, there is not in force an order of the Court in which the action was instituted preventing the release of the goods,

the Registrar shall release the goods to the importer.

(3) If the applicant gives written notice to the Registrar stating that he consents to the release of the seized goods, the Registrar shall release the goods to the importer.

Compensa-
tion for
failure to
take action.

70k. (1) Where goods have been seized pursuant to a notice given under section 70b and the applicant fails to take action for infringement within the retention period, a person aggrieved by such seizure may apply to the Court for an order of compensation against the applicant.

(2) Where the Court is satisfied that the person aggrieved had suffered loss or damage as a result of the seizure of the goods, the Court may order the applicant to pay compensation in such amount as the Court thinks fit to the aggrieved person.

Actions for
infringe-
ment of
registered
trade mark.

70L. (1) If an action for infringement has been instituted by the applicant, the Court may in addition to any relief that may be granted—

- (a) order that the seized goods be released to the importer subject to such conditions, if any, as the Court thinks fit;
- (b) order that the seized goods be not released to the importer before the end of a specified period; or
- (c) order that the seized goods be forfeited to the Government,

depending on the circumstances of the case.

(2) The Registrar or the authorised officer is entitled to be heard on the hearing of an action for infringement.

(3) A Court may not make an order under paragraph (1)(a) if it is satisfied that the Government or any statutory authority is required or permitted under any other law to retain control of the seized goods.

(4) The Registrar shall comply with an order made under subsection (1).

(5) If—

- (a) the action is dismissed or discontinued, or if the Court decides that the relevant registered trade mark was not infringed by the importation of the seized goods; and
- (b) a defendant to the action for infringement satisfies the Court that he has suffered loss or damage as a result of the seizure of the goods,

the Court may order the applicant to pay compensation in such amount as the Court thinks fit to that defendant.

Disposal of
seized
goods
ordered to
be for-
feited.

70M. If the Court orders that seized goods are to be forfeited to the Government, the goods shall be disposed of in the manner as directed by the Court.

Insufficient
security.

70N. (1) If the reasonable expenses incurred by the Registrar in relation to any action taken by the Registrar under this Part, or taken in accordance with an order of Court under this Part, exceed the amount of security deposited under section 70E, the amount of the excess is a debt due to the Government.

(2) The debt created by subsection (1) is due by the applicant, or, if there are two or more applicants, by the applicants jointly and severally.

Ex-officio
action.

70o. (1) Any authorised officer may detain or suspend the release of goods which, based on *prima facie* evidence that he has acquired, are counterfeit trade mark goods.

(2) Where such goods have been detained, the authorised officer—

- (a) shall inform the Registrar, the importer and the proprietor of the trade mark; and
- (b) may at any time seek from the proprietor of the trade mark any information that may assist him to exercise his powers.

(3) Subject to section 70j, an importer may lodge an appeal against the detention of goods or suspension of the release of goods under subsection (1).

(4) The authorised officer shall only be exempted from liability if his actions under subsection (1) are done in good faith.

Regulations
relating to
border
measures.

70p. (1) The Minister may make such regulations as may be necessary or expedient for the purpose of this Part.

(2) Without prejudice to the generality of subsection (1), regulations may be made for—

- (a) prescribing and imposing fees and providing for the manner for collecting such fees;
- (b) prescribing forms and notices;
- (c) providing for the manner for depositing security;
- (d) prescribing anything required to be prescribed under this Part.”.

Amendment of section 73

20. Section 73 of the principal Act is amended—

(a) in subsection (1)—

- (i) by deleting the words “Part A or Part B of”; and
- (ii) by substituting for the words “inherently adapted to distinguish, or capable of distinguishing, as the case may be,” the words “capable of distinguishing”; and

(b) in subsection (3) by substituting for the words “adapted to distinguish, or capable of distinguishing, as the case may be,” the words “capable of distinguishing,”.

TRADE MARKS ACT 1976
TRADE MARKS (AMENDMENT) REGULATIONS 2001

IN exercise of the powers conferred by section 83 of the Trade Marks Act 1976 [Act 175], the Minister makes the following regulations:

Citation and commencement

1. (1) These regulations may be cited as the Trade Marks (Amendment) Regulations 2001.

(2) These Regulations come into operation on 1 August 2001.

Amendment of regulation 12

2. The Trade Marks Regulations 1997 [*P.U. (A) 460/97*], which in these Regulations are referred to as the “principal Regulations”, are amended in subregulation 12(3) by substituting for the full stop at the end of paragraph (c) the words “;or” and by inserting after paragraph (c) the following paragraphs:

“(d) has had at least seven years of experience in the field of industrial property by virtue of he being an ex-officer of the Office; or

(e) has acted as a trade mark agent to the satisfaction of the Registrar before the Trade Marks Regulations 1997 came into force.”

New regulations 13A and 13B

3. The principal Regulations are amended by inserting after regulation 13 the following regulations:

“Where 13A. The Registrar shall not register a mark or part

registration of a mark where -
of mark is
not allowed.

- (a) the mark or part of the mark is identical with, or confusingly similar to, or constitutes a translation of a mark which is considered by the competent authority of Malaysia to be well-known in Malaysia, whether or not it is registered here, as being already the mark of a person other than the applicant for registration, and used for identical or similar goods or services;
- (b) the mark or part of the mark is identical with, or confusingly similar to, or constitutes a translation of a mark considered well-known under regulation 13B, which is registered in Malaysia with respect to goods or services whether or not similar to those with respect to which registration is applied for, provided that 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 registered mark, provided further, that the interests of the proprietor of the registered mark are likely to be damaged by such use;
- (c) the mark or part of the mark is likely to mislead the public, particularly as to

the nature, quality, characteristics or geographical origin of the goods or services;

- (d) the mark or part of the mark is likely to mislead the public if it is a 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.

Criteria of
well-known
mark.

13B. In determining whether a mark is well-known or not, the following criteria may be taken into account:

- (a) the degree of knowledge or recognition of the mark in the relevant sector of the public;
- (b) the duration, extent and geographical area of any use of the mark;
- (c) the duration, extent and geographical area of any promotion of the mark, including advertising or publicity and the presentation, at fairs or exhibitions, of the goods or services to which the mark applies;

- (d) the duration and geographical area of any registrations, or any applications for registration, of the mark to the extent that they reflect use or recognition of the mark;
- (e) the record of successful enforcement of rights in the mark, in particular, the extent to which the mark was recognized as well-known by competent authorities;
- (f) the value associated with the mark.”.

Amendment of regulation 17

4. Subregulation 17(1) of the principal Regulations is amended by deleting the words “adapted to distinguish within the meaning of section 10 or inherently.”.

New regulation 17A

5. The principal Regulations are amended by inserting after regulation 17 the following regulation:

“Request for search. 17A. Any person may request the Registrar on Form TM 4A to cause a search to be made in respect of specified goods or services classified in any one class of the Third Schedule to ascertain whether any trade mark is on record at the date of the search which resembles a trade mark of which duplicate representations shall accompany the Form and the Registrar shall cause such a search to be made and

the person making the request to be informed of the result of the search.”.

Substitution of regulation 59

6. The principal Regulations are amended by substituting for regulation 59 the following regulation:

“Late
renewal.

59. If within one month from the expiration of the last registration of a trade mark the renewal fee has not been paid and if Form TM 13 is filed, accompanied by the late renewal fee, the Registrar shall renew the registration without removing the mark from the Registrar.”.

New Part XIVA

7. The principal Regulations are amended by inserting after Part XIV the following part:

“PART XIVA

BORDER MEASURES

Application
to restrict
importation
of counterfeit
trade mark
goods.

83A. (1) An application under section 70D to the Registrar to restrict the importation of counterfeit trade mark goods into Malaysia by the proprietor or an agent of the proprietor having the power to submit such application shall be made in Form TM 30 accompanied by the prescribed fee, an affidavit and five copies of the application.

(2) Each application shall be made in respect of a single trade mark and shall state the

date, time and place the counterfeit trade mark goods are expected to be imported.

(3) An affidavit made under subregulation (1) shall state that the applicant is the proprietor of the mark or an agent having the power to submit such application, registration number of the said trade mark, the representation of the mark and interest of the applicant in the mark, if any.”.

Amendment of First Schedule

8. The First Schedule to the principal Regulations is amended -

(a) in Part I -

(i) by inserting after Form TM 4 and the particulars relating thereto the following:

<i>For TM</i>	<i>Matters or Proceedings</i>	<i>Fee RM</i>
“4A	Request for search	250.00”;

and

(ii) by inserting after Form TM 29 and the particulars relating thereto the following:

<i>Form TM</i>	<i>Matters or Proceedings</i>	<i>Fee RM</i>
“30	Application to restrict importation of counterfeit trade mark goods	300.00”; and

(b) in Part II -

(i) by inserting after sub-item 1(c) the following sub-item:

“(d) Permitted information 100.00 for less
upon request (Hit list) than 10 pages
and 5.00 for
subsequent
pages”; and

(ii) by inserting after item 2 the following item:

“3. Request to conduct 20.00 per hour”.
public search through
computer

Amendment of Second Schedule

9. The Second Schedule to the principal Regulations is amended-

(a) by inserting after Form TM 4 and the relevant particulars the following:

“4A Request for search”;

(b) by inserting after Form TM 30 and the relevant particulars the following:

“30 Application to restrict importation of counterfeit
trade mark goods”;

(c) by inserting after Form TM 4 the following form:

TM 4A

"INTELLECTUAL PROPERTY DIVISION - TRADE MARK
TRADE MARKS REGISTRY
TRADE MARKS ACT 1976
TRADE MARKS REGULATIONS 1997
REQUEST FOR SEARCH
(Regulation 17A)

1. Representation of mark:

If the space provided is insufficient, the representation may be made on a separate sheet which must be firmly annexed to this Form

The representation must be clear and durable and comply with regulation 34 of the Trade Marks Regulations 1997.

2. Class:

3. List of goods or services:

4. Full name and address of applicant:

.....
.....
.....

If the applicant resides abroad, an address for service in Malaysia must be provided.

5. Full name and address of agent (if any):

.....
.....
.....

If this is the address for service and is not already on record, Form TM1 must be filed with this Form.

6. Agent's Registration No. (if known):
7. Agent's own reference:
8. The Registrar is requested to search in Class in respect of to ascertain whether the trade mark(s) are on record which resemble the trade mark(s) sent herewith in duplicate and each representation being mounted on ISO A4. (Priority claim search is not included)
Signature :
Name of signatory (in block letters):.....
Date :

and

(d) by inserting after Form TM 29 the following form:

TM 30

“INTELLECTUAL PROPERTY DIVISION - TRADE MARK
TRADE MARKS REGISTRY
TRADE MARKS ACT 1976
TRADE MARKS REGULATIONS 1997
BORDER MEASURES
APPLICATION TO RESTRICT IMPORTATION OF COUNTERFEIT
TRADE MARKS GOODS
(Regulation 83A)

FOR OFFICIAL USE

Application Date:

Fee :

* Cheque/Postal Order/Money Order/Cash/Draft No.:

Registrar's Remark:

Notice remain in force from until
(Not more than 60 days).

Security Deposit :
(as required under section 70E of the Trade Marks Act 1976)

Place of storage of seized goods:.....
(as directed under section 70F of the Trade Marks Act 1976)

1. Applicant:
(Proprietor of a registered mark or agent having the power)

Name:.....

Address:.....

.....

Nationality:..... 	
Telephone No.:	
2. Trade Mark No.:	<input type="text"/>
3. Class:	<input type="text"/>
4. Representation of mark:	
5. Specification of goods:	
6. Particulars of importers of counterfeit trade mark goods: (i) Name and address of the importer: (ii) Name and registration number of the ship, aircraft, vehicle, etc.: (iii) Name of the place of the counterfeit trade mark goods expected to be imported: (iv) Expected date and time of arrival: (v) Company of origin:	
7. Interest of the applicant in the mark, if any:	

Signature:
Name of signatory (in block letters):
Date:

* Delete where inapplicable."

Made 23 July 2001.
[KPDN/BHI/R-00/193/1/1; PN(PU2)316/IV]



TAN SRI DATO' HAJI MUHYIDDIN HAJI MOHD. YASSIN
Minister of Domestic Trade and Consumer Affairs
