



P.U. (A) 47/2011

**TRADE MARKS (AMENDMENT) REGULATIONS 2011**

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**Preamble**

IN exercise of the powers conferred by section 83 of the **Trade Marks Act 1976**[Act 175], the Minister makes the following regulations:

**1. Citation and Commencement**

(1) These regulations may be cited as the **Trade Marks (Amendment) Regulations 2011**.

(2) These Regulations come into operation on 15 February 2011.

**2. Amendment of Regulation 8**

The **Trade Marks Regulations 1997**[P.U. (A) 460/1997], which are referred to as the "principal Regulations" in these Regulations, are amended by substituting for regulation 8 the following regulation:

**"8. Filing and service of documents and things.**

(1) Any document or thing required or authorized by the Act or these Regulations to be filed, shall be delivered by hand to the Office during its normal business hours or sent to the Registrar by post.

(2) Sending by post shall be deemed to be effected by properly addressing, preparing and posting a letter containing the document or thing, with the prepaid postage on it, to the Registrar at the Office and the document or thing shall be deemed to have been received at the time when the document or thing is actually received at the Office.

(3) The filing of a document or thing with the Office shall be deemed to be effected at such time as it is received at the Office and is recorded as received."

### 3. New Regulations 8A and 8B

The principal Regulations are amended by inserting after regulation 8 the following regulations:

#### **"8A. Electronic filing of documents and things.**

(1) The Registrar may provide a service for the electronic filing of the document or thing required or authorized by the Act or these Regulations to be filed at the Office.

(2) A person who intends to use the service provided under subregulation (1) shall comply with the terms and conditions as may be specified by the Registrar, either generally by notice published in the official website or, in any particular case, by notice, including through electronic means, to the person desiring to use such service.

(3) A document or thing which is electronically filed under this regulation shall be deemed to be effected at such time as that document or thing is accepted by the electronic filing system.

(4) Where any accompanying document or thing is not capable of being filed electronically, such accompanying document or thing may be delivered or sent to the Registrar in the manner specified in regulation 8, subject to such terms and conditions as the Registrar may specify.

#### **8B. Terms and conditions for electronic filing.**

(1) Without limiting the generality of subregulation 8A(2), the terms and conditions for electronic filing shall include the following:

*(a)* the procedure to be complied with for the electronic filing of documents and things;

*(b)* the format or media in which a document or thing is to be recorded or stored for purposes of electronic filing;

*(c)* the manner of authenticating a document or thing which is required to be stamped, signed, sealed or certified, including the requirement for a digital signature of the person filing the document or thing; and

*(d)* the actions to be taken in the event of an interruption in the process of performing an electronic filing.

(2) Notwithstanding regulation 8A, the Registrar may refuse to accept or to register any document or thing which is filed electronically if-

(a) the information contained in such document or thing is not capable of being displayed in a legible form;

(b) the electronic record of such document or thing is not capable of being stored in the electronic filing system;

(c) the electronic record of such document or thing appears to the Registrar to be altered, damaged, incomplete or forged; or

(d) any of the terms or conditions on electronic filing specified by the Registrar is not complied with."

#### **4. Amendment of Regulation 12**

Paragraph 12(3)(d) of the principal Regulations is amended by substituting for the words "seven years" the words "three years".

#### **5. Amendment of Regulation 17**

Subregulation 17(1) of the principal Regulations is amended by substituting for the words "section 11" the words "section 10".

#### **6. New Regulation 18A**

The principal Regulations are amended by inserting after regulation 18 the following regulations:

##### **"18A. Expedited examination.**

(1) An applicant who applies or has applied for the registration of a trade mark under regulation 18 may request the Registrar to undertake an expedited examination of the application within four months from the date of filing of the application.

(2) A request for expedited examination shall be made to the Registrar by filing Form TM 5A, and shall be accompanied with-

(a) a statutory declaration stating the reasons for requesting the expedited examination; and

(b) the prescribed fee.

(3) If an applicant has requested for an expedited examination, the Registrar may do so if the Registrar is reasonably satisfied that-

*(a)* the request is in the national or public interest;

*(b)* there are infringement proceedings taking place or evidence showing potential infringement in respect of the trade mark applied for under regulation 18;

*(c)* registration of the trade mark is a condition to obtain monetary benefits from the Government or institutions recognised by the Registrar; or

*(d)* there are other reasonable grounds which support the request.

(4) The Registrar shall notify the applicant in writing, as soon as practicable after making his decision, whether the expedited examination shall be conducted or not.

(5) If the Registrar is satisfied that a request for an expedited examination is warranted, the applicant shall, within five working days from the date of receipt of the Registrar's decision in subregulation (4), file Form TM 5B and pay the prescribed fee.

(6) Each request under subregulation (1) 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."

## **7. Amendment of Regulation 22**

Regulation 22 of the principal Regulations is amended by substituting regulation 22 with the following regulation:

### **"22. Series of trade marks.**

Where an application is made for the registration of a series of trade marks under section 24 of the Act-

*(a)* a representation of each mark of the series shall be affixed to the application form in accordance with regulation 19; and

*(b)* if the application contains three trade marks or more, the third and subsequent marks shall be subject to the payment of the prescribed fee."

## **8. Amendment of Regulation 27**

Regulation 27 of the principal Regulations is amended by inserting after subregulation (3) the following subregulation:

"(4) An application for hearing under subregulation (3) shall be made by filing Form TM 9A and shall be accompanied with the prescribed fee."

#### **9. Amendment of Regulation 28**

Regulation 28 of the principal Regulations is amended by inserting after subregulation (4) the following subregulation:

"(5) An application for hearing under subregulation (4) shall be made by filing Form TM 9A and shall be accompanied with the prescribed fee."

#### **10. Amendment of Regulation 33**

Subregulation 33(2) of the principal Regulations is amended-

*(a)* by substituting for the words "Form TM 29" the words "Form TM 31"; and

*(b)* by substituting for the words "Registrar shall notify" the words "Registrar shall give written notice to".

#### **11. Amendment of Regulation 64**

Subregulation 64(2) of the principal Regulations is amended by deleting the words ", if any,".

#### **12. Amendment of Regulation 84**

Subregulation 84(2) of the principal Regulations is amended by inserting after the words "on Form TM 27" the words "or Form TM 27A, whichever is applicable, and".

## Amendment of First Schedule

The principal Regulations are amended by substituting for Part 1 of the First Schedule the following part:

### PART I

| <b>Form TM</b> | <b>Matters or Proceedings</b>  | <b>E-Filing Fee (RM)</b> | <b>Manual Filing Fee (RM)</b> |
|----------------|--|--------------------------|-------------------------------|
| 1              | Form of authorization and request to enter, alter or substitute an address for service | 40                       | 45                            |
| 2              | Application for registration of trade marks agent                                      | 1300                     | 1350                          |
| 3              | Application for renewal of registration of trade marks agent                           | 520                      | 570                           |
| 4              | Request for Registrar's preliminary advice as to whether a mark may be registered      | 130                      | 140                           |
| 4A             | Request for search   | 330                      | 360                           |
| 5              | Application for registration of a mark for series of mark –<br>Per series:             | 330<br>50                | 370<br>50                     |
| 5A             | Request for approval for expedited examination of trade mark application               | 200                      | 250                           |
| 5B             | Request for expedited examination of a trade mark application                          | 1060                     | 1200                          |
| 6              | Request for statement of grounds of decision   | 650                      | 700                           |
| 7              | Notice of opposition   | 600                      | 650                           |
| 8              | Counter-statement to a notice of opposition  | 400                      | 440                           |
| 9              | Notice to the Registrar in respect of attendance at a hearing                          | 630                      | 680                           |
| 9A             | Notice to the Registrar in respect of attendance at an ex-parte hearing                | 150                      | 170                           |
| 10             | Certificate of registration  | -                        | -                             |
| 11             | Application for renewal of registration of a trade mark                                | 160                      | 180                           |

|    |  |     |     |
|----|--|-----|-----|
| 12 | Application for renewal of registration of a trade mark  | 550 | 600 |
| 13 | Application for late renewal of registration of a trade mark   | 820 | 870 |
| 14 | Application for restoration and renewal of registration  | 880 | 930 |
| 15 | Application and declaration of an assignment/a transmission for registration as proprietor of a trade mark   | 240 | 260 |
| 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 | 80  | 90  |
| 17 | Request by the registered proprietor of a registered trade mark for making, cancelling or varying of an entry in the Register  | 130 | 140 |
| 18 | Request by registered proprietor of a registered trade mark to strike off goods or services  | 130 | 140 |
| 19 | Request by registered proprietor of a registered trade mark for entry of a disclaimer of memorandum  | 160 | 180 |
| 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  | 160 | 180 |
| 21 | Application by registered proprietor for an addition to or alteration of a registered trade mark   | 160 | 180 |
| 22 | Notice of opposition to an application for addition to or alteration of a registered trade mark  | 630 | 680 |
| 23 | Application for registration of a registered user  | 240 | 260 |
| 24 | Application for variation or cancellation of the registration of a registered user   | 200 | 220 |
| 25 | Request for Registrar's certificate other than certificate of registration   | 130 | 140 |
| 26 | Request for correction of a clerical error in an application or for  | 130 | 140 |

|    |  |     |     |
|----|--|-----|-----|
|    | permission to amend an application for registration                      |     |     |
| 27 | Application for extension of time  | 70  | 80  |
|    | Per month:   | 130 | 140 |
| 28 | Notice of order of court for rectification or alteration of the Register | 130 | 140 |
| 29 | Application to restrict importation of counterfeit trade mark goods      | 300 | 330 |
| 31 | Request for advertisement of a trade mark                                | 600 | 650 |

### **Amendment of Second Schedule**

10. The Second Schedule of the principal Regulations is amended –

(a) by deleting the list of forms; and

(b) in each Form –

(i) by substituting for the words “INTELLECTUAL PROPERTY DIVISION – TRADE MARK” wherever appearing the words “INTELLECTUAL PROPERTY CORPORATION OF MALAYSIA”; and

(ii) by substituting Form TM 5 with the following form:

“

INTELLECTUAL PROPERTY CORPORATION OF MALAYSIA

TRADE MARKS REGISTRY

|             |
|-------------|
| <b>TM 5</b> |
|-------------|

TRADE MARKS ACT 1976

TRADE MARKS REGULATIONS 1997

APPLICATION FOR REGISTRATION OF A MARK



[Subregulation 18(1)]

Applicant's\* or Agent's\* file reference: .....

*\* Delete whichever not applicable*

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 which registration is desired. In the case of a trade mark, please attach a copy of the oath, sworn statement or statutory declaration evidencing that the applicant is the true owner. In the case of a certification trade mark, please attach a copy of the rules governing its use. In the case of a defensive trade mark, please attach a copy of the statement of case verified by a statutory declaration.*

*[Please enclose five (5) copies of the Form with the application]*

2. Representation of mark:

*Note: If the space provided is insufficient, the representation may be made on a separate sheet and firmly attached to this Form. Please ensure that the representation is clear and comply fully with regulation 34 and the size of the trade mark shall not exceed 10 x 10 cm.*

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

If the application is for a series of trade marks under section 24, please specify the number of series in this box:

*Note: Any application made for a series of trade marks exceeding two trade marks is subject to an additional fee of RM50.00 per trade mark.*

3. Limitations, etc.:

*(Insert below any conditions, disclaimers or other limitations to which the registration will be subjected to. 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, please provide a certified transliteration and translation as appropriate.)*

.....

.....

.....

.....

4. Class:

5. List of goods or services:

*(Goods or services falling within more than one international class are subject to separate applications. Please use a separate sheet if necessary.)*

.....

.....

.....

.....

6. Full name and address of applicant:

Name : .....

Address : .....

.....

.....

.....

NRIC No./Company Registration No./Passport No.: .....

*(as a personal reference number)*

*If the applicant is a partnership, please state the full names of all the partners.*

*If the applicant resides abroad, please provide an address for service in Malaysia (Column 7).*

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

Name : .....

Address : .....

.....

.....

.....

*Note: If this is the address for service, please file Form TM 1 together with this Form.*

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

9. Agent's own reference: .....

10. International Convention priority claim: *If priority date is claimed under International Convention or a bilateral arrangement, please give details below and attach the relevant documents.*

Convention country in which the trade mark was first filed: .....

Date: ..... No. (if any): .....

11. Date of first use of the mark in Malaysia (if any): .....

12. Declaration: I/We claim to be the bona fide 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 am/we are entitled to be registered as the proprietor of the mark.

An agent signing this Form on behalf of the applicant shall satisfy himself as to the truth of the declaration.

Signature: .....

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

Telephone No.: ..... E-mail: .....

Date: .....

*Note: If the applicant is a partnership, please state the full names of all the partners.*

”;

(iii) by inserting after Form TM 5 the following form:

“

INTELLECTUAL PROPERTY CORPORATION OF MALAYSIA

TRADE MARKS REGISTRY

TM 5A

TRADE MARKS ACT 1976

TRADE MARKS REGULATIONS 1997

REQUEST FOR APPROVAL FOR EXPEDITED EXAMINATION OF A TRADE MARK APPLICATION

[Subregulation 18A(2)]

|  |   |
|--|---|
| <p>Please submit this Form in duplicate together with the prescribed fee</p>                                   | <p>Applicant's* or Agent's* file reference:<br/>.....</p> <p><i>* Delete whichever not applicable</i></p> |
| <p>1. IN THE MATTER OF :</p> <p>Trade Mark Application No. : ..... Filing Date : .....</p> <p>Class: .....</p> |   |
| <p>2. NAME AND ADDRESS OF APPLICANT:</p>   |   |

Name : .....

Address : .....

.....

.....

3. REQUEST:

The applicant requests the Registrar to refer the trade mark application identified above for an expedited examination in accordance with regulation 18A of the Trade Mark Regulations 1997. This application contains the following, stating the reason for the request (*please tick*):

(a) Statutory Declaration

(b) Other (*please specify*)

.....

.....

.....

.....

4. ADDITIONAL INFORMATION accompanying this Form:

Yes  Please specify: ..... No

5. Signature: .....

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

Telephone No.: ..... E-mail: .....

Date : .....

*If Column 5 is signed by an agent on behalf of the applicant, the agent shall satisfy himself as to the truth of the declaration.*

*For Official Use Only*

Notification:

(a) Your request for approval for expedited examination of a trade mark application is approved.

Please file Form TM 5B accompanied with the prescribed fee.



(b) Your request for approval for expedited examination of a trade mark application is refused.

Authorised Signature : .....

Name : .....

Date : .....

*(Note: Applicant is advised to conduct a proper search in respect of the trade mark filed for application prior to the filing of this Form)*  
“;

(v) by inserting after Form TM 9 the following form:

“

INTELLECTUAL PROPERTY CORPORATION OF MALAYSIA

TRADE MARKS REGISTRY

TM 9A

TRADE MARKS ACT 1976

TRADE MARKS REGULATIONS 1997

NOTICE TO THE REGISTRAR OF ATTENDANCE AT AN EX-PARTE HEARING

*[Subregulations 27(4) and 28(5)]*

INSTRUCTION:

Please type or write in block letters

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

2. Reason for hearing:

3. Objection 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 in respect of the above matter is fixed for :

Time (hours):

Date:

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

Signature : .....

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

Telephone No: .....

E-mail: .....  
Date: .....

(vi) by substituting for Form TM 27 the following form:

"

INTELLECTUAL PROPERTY CORPORATION OF MALAYSIA

TRADE MARKS REGISTRY

TM 27

TRADE MARKS ACT 1976

TRADE MARKS REGULATIONS 1997

APPLICATION FOR EXTENSION OF TIME

*[Subregulation 84(2)]*

Trade Mark   
No.:  
Class:

Extension of time:

Number of months required:

Please state the circumstances justifying the application:

*Note: if the space provided is insufficient, please use a separate sheet and firmly attach it to this Form.*

Signature :

Name/Firm :

Telephone :

Date :

*For Official Use Only*

Decision: *(please tick)*

(a) Your request for extension of time is approved for ..... months from ..... until ..... upon payment of RM .....

(b) Your request for extension is rejected.

Authorised Signature :

Name:

Date:

(vii) by inserting after Form TM 27 the following form:

"

INTELLECTUAL PROPERTY CORPORATION OF MALAYSIA

TRADE MARKS REGISTRY

TM 27A

TRADE MARKS ACT 1976

TRADE MARKS REGULATIONS 1997

APPLICATION FOR EXTENSION OF TIME (FOR OPPOSITION PROCEEDINGS)

[Subregulation 84(2)]

Trade Mark   
No.:

Class:

Extension of time:

Number of months required:

Please state the circumstances justifying the application:

*Note: If the space provided is insufficient, please use a separate sheet and firmly attach it to this Form.*

Signature :

Name / Firm :

Telephone :

Date :

*For Official Use Only*

Decision: *(please tick)*

(a) Your request for extension of time is approved for .....  
month(s) from ..... until ..... upon  
payment of RM .....

(b) Your request for extension is rejected.

Authorised Signature:

Name:

Date:

(viii) by deleting Form TM 29; and

(ix) by inserting after Form TM 30 the following form:

"

"INTELLECTUAL PROPERTY CORPORATION OF MALAYSIA

TRADE MARKS REGISTRY

TM 31

TRADE MARKS ACT 1976

TRADE MARKS REGULATIONS 1997

REQUEST FOR ADVERTISEMENT OF A TRADE A MARK

[Subregulation 33(2)]

Applicant's\* or Agent's\* file reference: .....

*\* Delete whichever not applicable*

1. IN THE MATTER OF:

Trade Mark Application No. :..... Filing Date: .....

Class: .....

2. FULL NAME AND ADDRESS OF APPLICANT:

Name : .....

Address : .....

.....

.....

3. REQUEST:

The applicant to make payment of the prescribed fee for the advertisement of the above mentioned application.



4. ADDITIONAL INFORMATION accompanying this Form:

Yes

*Please specify:* .....

No

5. Signature: .....

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

Telephone No.: ..... E-mail: .....

Date: .....

”;

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