CONNECT 1.0

THE TRADEMARKS ACT 2019

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WHAT IS A TRADEMARK?

Section 3(1) of the Trademarks Act 2019

Trademark means any sign capable of being represented graphically which is capable of distinguishing good or services of one undertaking from those of other undertakings.

Section 2

SIGN includes any letter, word, name, signature, numeral, device, brand, heading, label, ticket, shape of goods or their packaging, colour, sound, scent, hologram, position, sequence of motion or any combination thereof.

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EXAMPLES OF NON TRADITIONAL TRADEMARKS

2 MAIN GROUPS

(a) Visible

Colours, Moving Images & Positioning

(b) Non Visible : Sounds & Scents

74629287 Twentieth Century Fox - Entertaintment / Motion Picture Films : Drums + Trumpets + Strings

[ALL IMAGES SHOWN ARE FOR ILLUSTRATION PURPOSES ONLY]

OTHER TYPES OF TRADEMARKS

pepsi

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WELL KNOWN TRADEMARK

Any trademark well known in Malaysia and

- belongs to a person from a Convention country or
- domiciled or has a real and effective industrial or commercial establishment in the Convention country
- regardless whether or not that person carries on business or has any goodwill here

EARLIER TRADEMARK

- a registered trademark or protected IR designating Malaysia OR a well known trademark

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OTHER TYPES OF TRADEMARKS

COLLECTIVE TRADEMARK

- A sign distinguishing goods or services of members of association.
- Association - registered organisation but not a company; may include a club, trade union and society.
- Use of mark to denote membership or to distinguish the services of members from non members.

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WHAT'S NEW IN TMA 2019?

MULTIPLE CLASS APPLICATIONS

- WIPO International Classification of Goods & Services : 45 in all
- Currect Act - one trademark application per class
- New Act enables filing a single application covering multiple classes
- Results in one registration

DIVISIONS AND MERGERS

- Applicant entitled to merge of divide application
- Merger/Division may be for classes OR specific goods or services

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WHAT'S NEW IN TMA 2019?

CONCEPT OF REGISTRABLE TRANSACTION

- No proper definition given in the Act
- Section 2(1) - "registrable transactions" mean transactions determined by the Registrar in the Guidelines or Practice Directions
- Other countries' Trademarks Acts - specifically defined
- Must be registered in order to take effect

PHOTO BY LUCAS LUDWIG ON UNSPLASH

WHAT'S NEW IN TMA 2019?

SECURITY INTEREST IN A TRADEMARK

- May be granted over a trademark by assignment or by charge
- By assignment:
  a) Transfer of ownership
  b) Assignee can enforce rights in a trademark
- By charge
  a) no transfer of ownership
  b) chargee obtain rights & priority over other creditors

PHOTO BY ALEC FAVALE ON UNSPLASH

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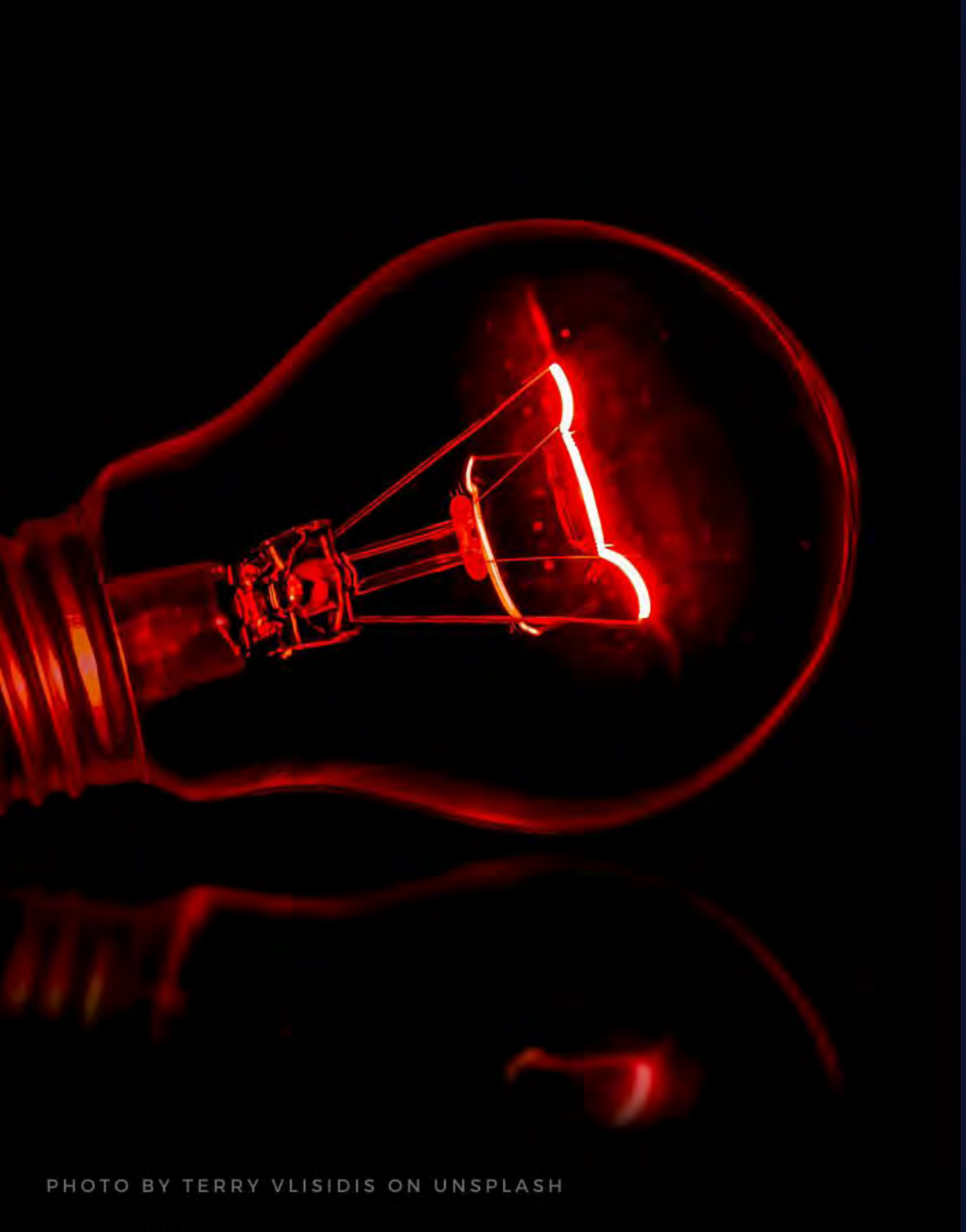

PHOTO BY TERRY VLISIDIS ON UNSPLASH

WHAT'S NEW IN TMA 2019?

LICENSING

- License must be in writing & signed by parties
- Recordation is not mandatory
- General or limited license
- Exclusive license
- Sub license available
- Rights of licensee

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THE TM TRAFFIC LIGHT

STRONG MARK : Distinctive / Non Descriptive

NEUTRAL MARK : Not descriptive / Not Distinctive

WEAK MARK : Descriptive / Non Distinctive

AVOID!

Descriptive Marks

Words common to trade

Non distinctive marks

Contrary to public policy & morality

Similar to famous/well known trademarks

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WHY DISTINCTIVE?

- Ability to distinguish itself from others in trade
- Inherent distinctiveness - the mark itself
- Factual distinctiveness - attained through use
- Accrual of common law rights
- Generate goodwill & reputation
- Evolution into a brand

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TRADEMARKS & BRANDS

Trademark	Brand
1. Legal concept	Marketing tool
2. Registration gives the owner exclusive rights to use	Creates a set of expectations and emotion for consumers
3. Function includes • Source identifier • Guarantee of quality • Generates goodwill and reputation	Function includes • Defining differentials for a good/service • Enhance consumption experience – brand loyalty and premium pricing • Allows for lower cost brand extension
4. Value as an intangible asset and a legal property for owner	Value a) monetary value b) brand equity

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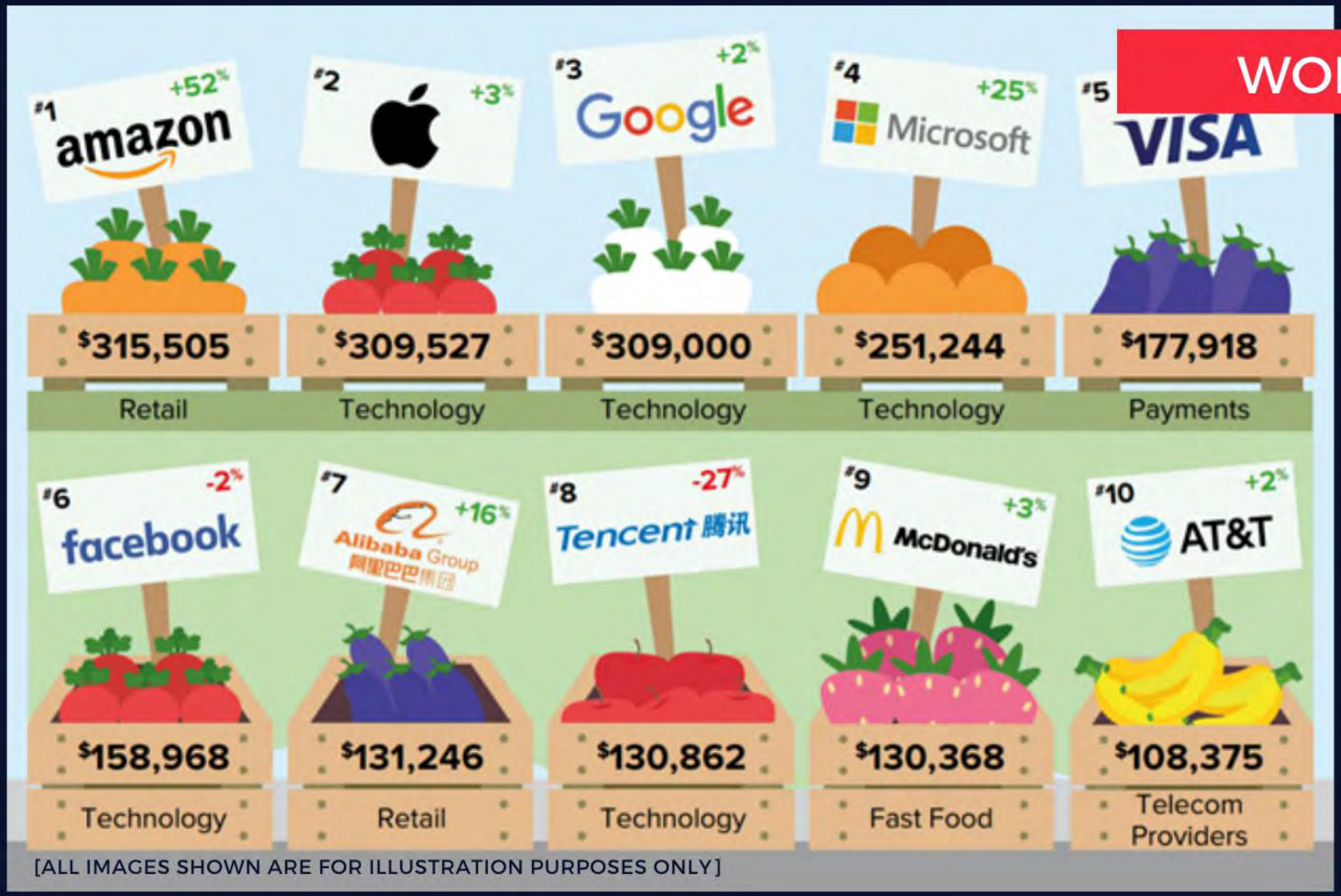
MOST VALUABLE BRANDS 2019

WORLD'S TOP 10



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MALAYSIA'S TOP 3

PETRONAS

USD 13.1 billion

Maybank

USD 4.2 billion

GENTING

USD 3.04 billion

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REGISTRATION PROCESS TMA 2019

FILING DATE - SECTION 17

APPLICATION IN MULTIPLE CLASSES
- DIVISIONS & MERGERS

SEARCH & EXAMINATION
- ABSOLUTE GROUNDS & RELATIVE GROUNDS OF REFUSAL

ACCEPTANCE & PUBLICATION IN IPOJ

NOTIFICATION OF REGISTRATION;
CERTIFICATE UPON REQUEST

Perbadanan Harta Intelek Malaysia
Intellectual Property Corporation of Malaysia

TRADE MARKS ACT 1976
TRADE MARKS REGULATIONS 1997

CERTIFICATE OF REGISTRATION
(Regulation 56)

Trade mark no : 09022523

To : RETAIL

(ABDUL AZIZ B. ISMAIL)
for REGISTRAR OF TRADE MARKS
MALAYSIA

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MADRID PROTOCOL

SECTION 74 & 75 TMA 2019

- Bundle of international registrations : up to 105 listed members
- One single application
- Accession on 27 September 2019
  Enforced on 27 December 2019
- Previously expensive & time consuming to obtain separate national filings in other foreign countries

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MADRID PROTOCOL

HOW DOES IT WORK?

- Administered by the International Bureauof WIPO
- Basic mark (application/registration) with MyIPO
- Entitlement to file:
  - a) National of Malaysia
  - b) A body or corporation incorporated in Malaysia
  - c) Domiciled in Malaysia
  - d) Has a real & effective industrial establishment in Malaysia

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MADRID PROTOCOL

COSTS & TIMEFRAME

- Single application/registration fees (CHF)
- Costs payable dependent on type of mark & number of classes
- Complementary/Individual fees by designated countries
- International Registration first then examination by the respective designated offices (within 18 months)

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MADRID PROTOCOL

ADVANTAGES

- Single international application
- More cost effective
- Minimum bureaucracy
- Shorter time frame for registration process for smooth application
- Things to take note of:
  a) Dependency on basic mark ~ 5 years
  b) Risk of central attack

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MADRID PROTOCOL

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BASIC MARK AT MyIPO

INTERNATIONAL APPLICATION & DESIGNATION

MyIPO CHECKS & TRANSMIT TO IB

IB CHECKS FORMALITIES

REGISTRATION CERTIFICATE & PUBLISHED IN WIPO GAZETTE

IB NOTIFIES CONTRACTING PARTIES

CONTRACTING PARTIES CONDUCT OWN EXAMINATION

CONTRACTING PARTIES ISSUE FINAL DISPOSITION

RENEWAL DUE 10 YEARS FROM IR DATE

PHOTO BY PRISCILLA DU PREEZON UNSPLASH

thank you

CONNECT 1.0

QUESTIONS & ANSWERS

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