

# INTRODUCTION TO TRADEMARKS ACT 2019



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TRADEMARK

PATENT

INDUSTRIAL  
DESIGN

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MY I S G I B N

INTELLECTUAL PROPERTY MADE SIMPLE

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DO YOU KNOW

# TM IS MORE THAN JUST WORDS AND LOGOS?

Non-Traditional TM (NTM) ~ shape, colour, sound, scent, motion marks

DO YOU HAVE UNDISCOVERED NTM WITHIN YOUR BUSINESS?

LOOK AT THE SHAPE OF YOUR PRIMARY PRODUCT  
DOES IT HAVE A RECOGNIZABLE SOUND  
DOES IT HAVE A DISTINCTIVE SMELL  
DOES IT MOVE

NEW TYPES OF TM



# CHOOSING A TM

LOOK AT YOUR CORPORATE IDENTITY,  
PRODUCTS AND SERVICES

COIN A WORD(S) - INVENTED TM

PICK A DICTIONARY WORD(S) THAT IS NOT  
DESCRIPTIVE OF PRODUCTS/SERVICES

AVOID WORDS LIKE "PREMIUM", "BEST"

AVOID NAME OF LARGE CITY, COUNTRY,  
WELL-KNOWN MARKS

CONDUCT A PRE-FILING SEARCH

HAVE YOU USED YOUR TM BEFORE AND FOR HOW LONG?

NEW EXAMINATION STANDARDS



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INTERNATIONAL CLASSIFICATION : 34 CLASSES OF GOODS + 11 CLASSES OF SERVICES

DOLPHIN MILK  
[CLASS 29]

DOLPHIN  
COFFEE  
[CLASS 30]

DOLPHIN  
FRUIT JUICE  
[CLASS 32]

# NEW PACKAGE

[MULTIPLE CLASS APPLICATIONS]

WITH A LIMITED BUDGET,  
HOW MANY TM APPLICATIONS  
SHOULD YOU FILE?

IMAGINE A MULTI-PRODUCT  
COMPANY USING A SINGLE HOUSE  
MARK

THE COMPANY NO LONGER NEED TO  
FILE 3 SEPARATE TM APPLICATIONS  
[1 MARK, PER CLASS] AND INCUR  
TRIPLE THE COSTS.

BUT CAN NOW FILE A SINGLE  
APPLICATION FOR DOLPHIN  
COVERING ALL CLASSES [29, 30, 32]  
AT A REDUCED RATE.

# NEW FLEXIBILITY

[DIVISION OR MERGER OF APPLICATIONS]

WHAT IF YOU CHANGE YOUR MIND?

YOU HAVE FILED A  
SINGLE TM  
APPLICATION IN  
MULTIPLE CLASSES

EXAMPLE :  
CLASS 03 + 05 + 10

YOU MAKE A  
BUSINESS DECISION  
TO SELL YOUR TM IN  
RELATION TO CLASS  
03 BUT RETAIN  
OWNERSHIP OF THE  
TM FOR CLASS 05  
AND 10 GOODS

YOU CAN DIVIDE THE  
TM INTO 2 OR MORE  
APPLICATIONS TO DEAL  
WITH THE CLASSES  
SEPARATELY

CONVERSELY, TM APPLICATIONS IN SEPARATE CLASSES CAN ALSO BE MERGED INTO A SINGLE APPLICATION

# COMMERCIALISATION RIGHTS

HOW CAN YOU MAKE MONEY OFF A TM?

## LICENSING

IS ONE WAY YOU CAN RENT OUT THE RIGHTS TO USE YOUR INTANGIBLE ASSET [A REGISTERED TM] FOR ROYALTIES

## SELL

YOUR TM FOR A TIDY SUM, BY WAY OF ASSIGNMENT OF TM

## MONETIZE

YOUR TM AS A SECURITY INTEREST WITH A WILLING BANK IN EXCHANGE FOR A LOAN



# BEWARE OF OFFENCES



Photo by Jamie Street on Unsplash

## GROUNDLESS THREAT OF INFRINGEMENT

MERE NOTIFICATION THAT A TM HAS BEEN FILED OR REGISTERED IS NOT A THREAT



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## COUNTERFEITING

## DO YOU KNOW THAT EVEN THE FOLLOWING ACTS CAN BE CRIMINAL

MAKING OR POSSESSING ARTICLES FOR COMMITTING AN OFFENCE  
FALSELY REPRESENTING A TM AS REGISTERED ® WHEN IT IS NOT  
FALSE ENTRY ONTO THE TM REGISTER



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# THE MADRID SYSTEM

## WHAT IS IT?

INCLUDED IN THE TRADEMARKS ACT 2019

BUNDLE OF INTERNATIONAL REGISTRATIONS :  
UP TO 105 COUNTRIES WORLDWIDE

ACCESSION ON 27 SEPTEMBER 2019

ENFORCED ON 27 DECEMBER 2019

## HOW DOES IT WORK?

ADMINISTERED BY THE INTERNATIONAL BUREAU OF 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

## COSTS & TIMEFRAME

ONE SET OF FEES [CHF]

VARIATION BASED ON TYPE OF MARK AND  
NUMBER OF CLASSES

COMPLEMENTARY FEES / INDIVIDUAL FEES

EXAMINATION BY DESIGNATED OFFICES  
WITHIN 18 MONTHS

## ADVANTAGES

SINGLE INTERNATIONAL APPLICATION

MORE COST EFFECTIVE

MINIMUM BUREAUCRACY

SHORTER PROCESS FOR SMOOTH APPLICATION

EASIER MAINTENANCE POST REGISTRATION

NOTE:

a. DEPENDENCY ON BASIC MARK ~ 5 YEARS

b. RISK OF CENTRAL ATTACK



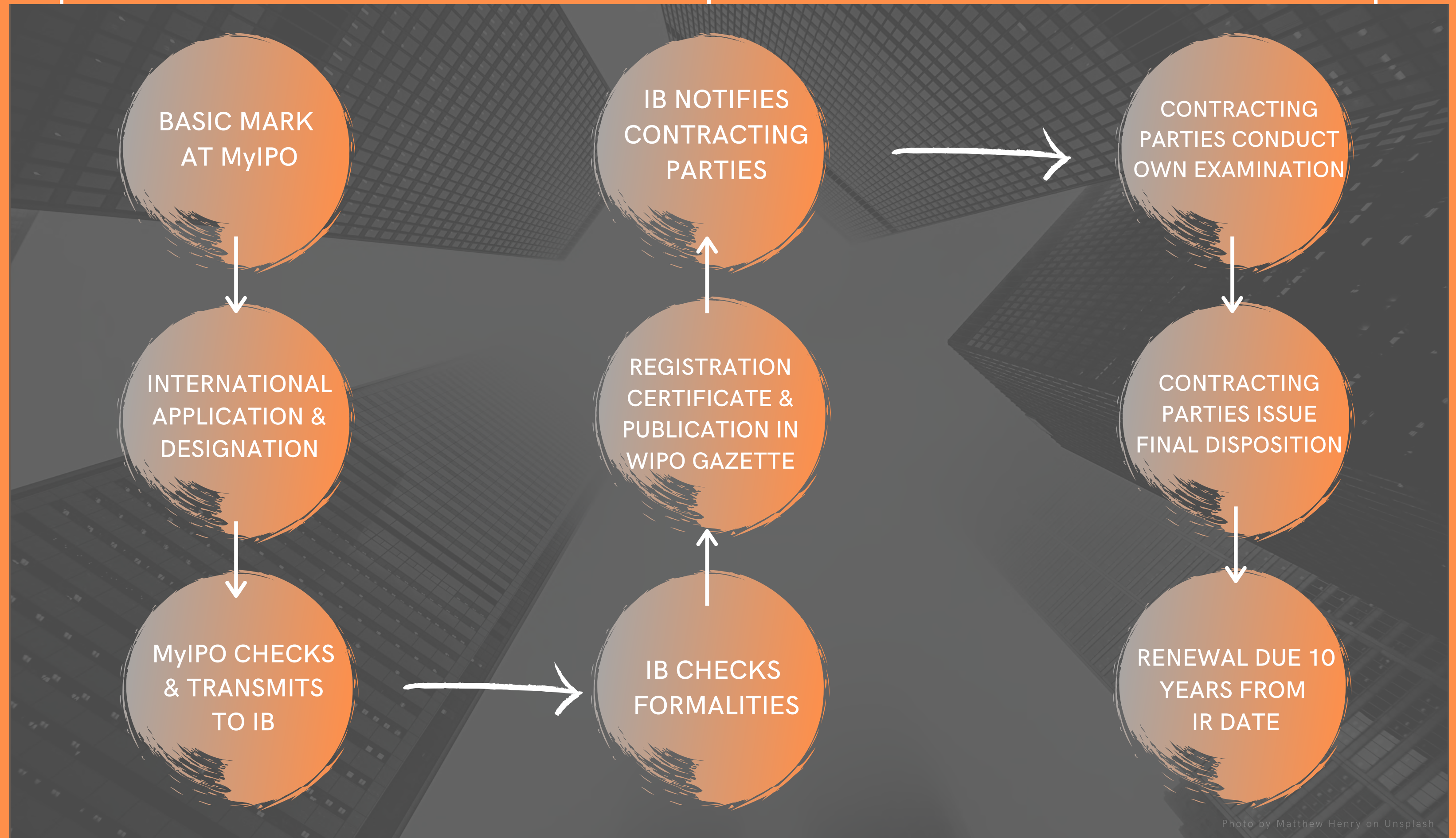


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# MALAYSIA IP AGENCY OF THE YEAR

GLOBAL IP AWARDS 2019

# Henry Goh&Co