

# Trade Mark Regulations 1997 (Amendment 2011)

## Summary Guidelines (Updated)

### Trade Marks Regulations 1997 (Amendment 2011), Gazette Date: 15 February 2011

This notice is issued by the Registrar of Trade Mark to specify the procedure for applying a trade mark for registration under the Trade Marks Regulations 1997 (Amendment 2011).

This amendment will come into effect on 15 February 2011.

#### 1. Procedure and schedule of fees:

- a. all proceedings for applications made prior to 15 February 2011, and that the trade marks are registered, the new Regulations apply;
- b. all proceedings for applications made prior to 15 February 2011, and that the application are pending, the previous Regulations apply;
- c. all applications made on 15 February 2011 onwards, the new Regulations apply;

#### Note:

The fees and forms for all applications and requests in connection with trade marks under the Trade Marks Act 1976 will be subject to the Trade Marks (Amendment) Regulations 2011 **with effect from 15 february 2011**. Applicants are given **until 8 March 2011** to fulfil the requirements of the new fees should there be any insufficient amount paid.

Summary of the enforcement date:

Date of Application		Pending Application	Registered Trade Mark
From	To		
-	30/11/1997	Trade Mark Regulations 1983	Trade Mark Regulations 1997 (Amendment 2011)
01 /12/ 1997	14/02/2011	Trade Mark Regulations 1997	Trade Mark Regulations 1997 (Amendment 2011)
15/02/2011	-	Trade Mark Regulations 1997 (Amendment 2011)	Trade Mark Regulations 1997 (Amendment 2011)

#### 2. Electronic Filing:

Pursuant to Regulations 8A and 8B of the Regulations, an applicant who wishes to apply a trade mark via electronic filing will enjoy discounted fees. Fee schedule refer to [\(Click here\)](#).

The applicant has to request a digital ID free of charge from [MyIPO via IP Online](#) website before using the system.

#### 3. Expedited Examination

Pursuant to Regulation 18A, of the Regulations, an applicant who applies or has applied for the registration of a trade mark under Regulation 18 may request for an

expedited examination of the application. The request can be made within four (4) months from the date of filing of the application via filing form [TM 5A](#) (in duplicate). If the request is accepted by the Registrar, the applicant has to file [TM 5B](#) within 5 working days from the Registrar's decision. In the event that the applicant fails to file form [TM 5B](#) within the stipulated time, the Registrar will treat the application for expedited examination as never been filed.

The request for expedited examination must be supported by an affidavit or statutory declaration (sample format of the [SD](#) as attached), setting out the specific circumstances and reasons for the request as stated in the Regulations. The decision to accept or refuse the request will be based on the reason stated by that applicant.

The Registrar will state the decision on the duplicated form TM5A and issue the decision to the applicant via post, email, fax and/or phone within 3 working days.

The procedure for Expedited Examination is attached.

#### 4. Series of Trade Marks

Pursuant to Regulation 22, application for a series of trade marks which contains three marks or more, the third and subsequent marks shall be subject to the payment of the prescribed fee of RM50.00 per trade mark.

#### 5. Ex-parte Hearing

Pursuant to Regulation 27 and 28, application for a hearing under sub Regulation (3) and sub Regulation (4) of the above regulations shall be made by filing form [TM 9A](#) and shall be accompanied by the prescribed fee (Only application made on 15 February 2011 and subsequent is binding by this provision).

#### 6. Request for Advertisement

Substituting Form TM29 with Form [TM 31](#) (Request for Advertisement)

Pursuant to Regulation 33(2), the mode of a notification of an acceptance will be substituted where, if an application is accepted, a written notice will be issued to the applicant informing him of the acceptance and requesting him to submit Form [TM 31](#) together with the prescribed fee **within two (2) months**.

If the applicant fails to comply with the above procedure, the applicant is considered to have abandoned his application.

#### 7. Application for Extension of Time for Opposition Proceeding

Pursuant to Regulation 84(2), there will be a specific form [TM 27A](#) for an application for Extension of Time for Opposition Proceedings.

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**Note:** This document is intended to provide a summary to the Trade Marks Regulations 1997 (Amendment 2011). Any inconsistency between this notice and the said Regulations, the Regulations will prevail.

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## EXPEDITED EXAMINATION OF A TRADE MARK APPLICATION

### The procedure?

Applicant who applies or has applied for application for registration of a trade mark (Form TM 5) may now request for approval for an expedited examination for his application for a trade mark by filing Form TM 5A (Request for Approval for Expedited Examination of a Trade Mark Application) ("Request for Approval") together with the prescribed fee and a statutory declaration stating the reasons for requesting for expedited examination.

#### What is the acceptable condition for expedited examination? If,

- o it is for national or public interest;
- o there are infringement proceedings taking place or evidence showing potential infringement with regards to the trade mark applied for under regulation 18;
- o registration of the trade mark is a condition to obtain monetary benefits from the government or institutions recognised by the Registrar; or
- o there are other reasonable grounds which support the request.
  - Registrar will determine whether the Request for Approval is approved or not ("Registrar's Decision").

If the Registrar approves the Request for Approval, the applicant will have to file Form TM 5B (Request for Expedited Examination of a Trade Mark Application) ("Request for Expedited Examination") together with the prescribed fee within 5 working days from the date of receipt of the Registrar's Decision.

After the Registrar has received the complete Form TM 5B and the prescribed fee, the Registrar will proceed to examine the mark in the 'expedited lane'.

### How much does it cost?

Form TM 5A costs RM200 (for E-Filing) or RM250 (for Manual Filing). This is on top of the ordinary application fee for Form TM 5 ,RM330 (for E-Filing) or RM370 (for Manual Filing).

Form TM 5B costs RM1060 (for E-Filing) or RM1200 (for Manual Filing).

Fee schedule for expedited registration

Form	Normal Application		Expedited Examination	
	E-Filing (RM)	Manual Filing (RM)	E-Filing (RM)	Manual Filing (RM)
TM 5	330	370	330	370
TM 5A	-	-	200	250
TM 5B	-	-	1060	1200
TM 31	600	650	600	650
<b>TOTAL</b>	<b>930</b>	<b>1020</b>	<b>2190</b>	<b>2470</b>

### What happen after my application has been examined?

If there is no objection raised by the Registrar, the application then will be accepted and a written notice will be issued to the applicant informing him of the acceptance and requesting him to submit Form TM 31 together with the prescribed fee **within two (2) months**. The application will be advertised in the Government Gazette for opposition purposes (2 months from the date of publication of the Government Gazette).

If the applicant fails to comply with the above procedure, the applicant is considered to have abandoned his application.

If there is an objection raised by the Registrar, the application will no longer be treated as an expedited examination.

#### Will the expedited examination application still be subjected to the opposition procedure?

Yes, it is a statutory requirement that **ALL** applications are subjected to a 2 months opposition period before they are registered.

#### Are there any other important matters that I need to consider?

Yes, applicant is advisable to conduct a prior search of the mark before submitting Form TM 5A and Form TM 5B.

Each application in respect of goods or services shall contain only one class in the Third Schedule.

#### How to get registration in 6 months 3 weeks?

In order to secure registration according to time line proposed by the Registrar, request for approval for Expedited Examination has to be made within 1 month from the date of application and request for advertisement of application has to be made within 1 month from Registrar's notice of acceptance.

#### How about series of trade marks?

Applications made for a series of trade marks containing three trade marks and more, the third and subsequent trade marks are subjected to an additional fee of RM50.00 per a series of trade mark.

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## PROCEDURE OF REGISTRATION OF A TRADE MARK

Normal Track		Expedited Examination Track	
<ul style="list-style-type: none"> <li>• <b>Application</b> - Applicant to file Form TM5 (TM370)</li> <li>• Priority Date Claimed (to comply with 6 months PDC - Paris Convention)</li> </ul>	6 months	<ul style="list-style-type: none"> <li>• <b>Application</b> - Applicant to file Form TM5 (TM370)</li> <li>• Formality process</li> </ul>	**
<ul style="list-style-type: none"> <li>• <b>Search &amp; Examination &gt; Acceptance</b></li> </ul>	2 months	<ul style="list-style-type: none"> <li>• <b>Request for Approval for Expedited Examination*</b></li> <li>• Applicant to file form TM5A (RM250). Registrar will respond within 5 working days</li> </ul>	Within 4 mths from application date
<ul style="list-style-type: none"> <li>• <b>Request for advertisement</b></li> <li>• Applicant to file form TM31 (TM650) within 2 month from the date of Notification of Acceptance</li> </ul>	1 months **	<ul style="list-style-type: none"> <li>• <b>Request for Expedited Exam</b></li> <li>Applicant to file form TM5B within 5 working days from the date of receipt of the Registrar's Decision</li> </ul>	Within 5 days
<ul style="list-style-type: none"> <li>• <b>Preparation for Gazette</b></li> <li>• 1 month for MyIPO to prepare Gazette Draft &amp; submit to Government Printer for publication</li> </ul>	1 month	<ul style="list-style-type: none"> <li>• <b>Search &amp; Examination &gt; Acceptance</b></li> </ul>	1 month
<ul style="list-style-type: none"> <li>• <b>GAZETTE</b></li> <li>• 2 months for public to oppose</li> </ul>	2 months	<ul style="list-style-type: none"> <li>• <b>Request for advertisement</b></li> <li>Applicant to file form TM31 (RM650) within 2 month from the date of Notification of Acceptance</li> </ul>	1 month **
<ul style="list-style-type: none"> <li>• <b>APPROVAL OF REGISTRATION</b></li> <li>• 2 weeks for clearance and Issuance of certificate</li> </ul>	2 weeks	<ul style="list-style-type: none"> <li>• <b>Preparation for Gazette</b></li> <li>1 month for MyIPO to prepare Gazette Draft &amp; submit to Government Printer for publication</li> </ul>	1 month
		<ul style="list-style-type: none"> <li>• <b>GAZETTE</b></li> <li>2 months for public to oppose</li> </ul>	2 months
		<ul style="list-style-type: none"> <li>• <b>APPROVAL OF REGISTRATION</b></li> <li>3 weeks for clearance &amp; research and issuance of certificate (to comply with 6 months PDC – Paris Convention)</li> </ul>	3 weeks

### \*TERMS & CONDITIONS

- it is for national or public interest;
- there are infringement proceedings taking place or evidence showing potential infringement with regards to the trade mark applied for under regulation 18;
- application for registration of the trade mark is a condition to obtain monetary benefits from the government or institutions recognised by the Registrar; or
- there are other reasonable grounds which support the request

**\*\* IMPORTANT NOTE:** In order to secure registration according to time line proposed by the Registrar, request for advertisement of application has to be made within 1 month from Registrar's notice of acceptance and/or request for approval for Expedited Examination has to be made within 1 month from the date of application

Example of SD for Request for Approval for Expedited Examination

**Statutory Declaration**

**Expedited Examination of a Trade Mark Application**

I, ..... (insert name of person making declaration) of .....

(insert full address of person making declaration) do solemnly and sincerely declare that:

1. I am making this declaration in my capacity as ..... (insert designation of person making declaration) of .....

(insert name of company and address of person making declaration); or I am making this declaration on behalf of another person .....

(insert name name and address of another person)

2. I request the Registrar of Trade Mark to expedite the examination of trade mark application no. ....  
In class ..... for reason(s) stated below:

AND I make this solemn declaration conscientiously believing the same to be true and by virtue of the Statutory Declarations Act 1960.

Subscribed and solemnly declared by the

above named,

this day of

At

Before me,  
Commissioner for Oaths