NON–TRADITIONAL TRADEMARKS

REPRESENTATION AND EXAMINATION OF NON–TRADITIONAL TRADEMARKS; ACCEPTABLE EVIDENCE OF USE:

A MALAYSIAN PERSPECTIVE
NEW MALAYSIA TRADEMARK ACT 2019

• Malaysia has acceded to the Madrid Protocol on 27 September 2019. Malaysia becomes the 106th member state to the Madrid Protocol. The Trademarks Bill 2019 was passed in House of Representatives on 2nd of July and the Senate approved the Bill on 23rd July 2019. The Trademarks Bill 2019 will repeal and replace the existing Trade Marks Act 1976.

• The major features of the Trademarks Bill 2019 includes:

  • (1) The definition of ‘sign’ is widened to include any letter, word, name, signature, numeral, device, brand, heading, label, ticket, shape of goods or their packaging, colour, sound, scent, hologram, positioning, sequence of motion or any combination thereof. (Not touch and taste)
  • (2) Multi-class trademark applications will be permitted.
  • (3) Recognition of a trademark as collateral for loans.
  • (4) Collective marks will be allowed.
  • (5) Provision of in-house publication
  • (6) Accession to the Madrid Protocol.
CONTINUATION

• (7) Protection of geographical indication as collective and certification mark
• (8) Division of application and merging of application
• (9) Monetization and securitization of trademarks application or registration to be recorded
The term “mark” has been changed to “sign” in the new Trademark Bill. For a sign to be regarded as trademark must be –

- capable of being represented graphically
- which is capable of distinguishing goods and services
- of one undertaking from those of other undertakings

- If it is used in relation to a service ancillary to the trade of an undertaking
- Can be using or intend to use
NON-TRADITIONAL TRADEMARK (NTTM)

• Reference of use –
  • To the use of printed representation
  • Other visual representation (3-D mark, hologram, position, colour etc) must be graphically represented
  • Non-visual representation (sound and scent mark)
  • If it is goods – construed as to the use upon or in physical or other relation to the goods
  • If it is services – construed as use as to the statement about the services
  • Any aural representation of the trademark – construed as to the use of the trademark
NTTM

• VISUAL REPRESENTATION (3-D mark, hologram, position, colour, motion, etc.)
  • In form of graphically represented
  • Description of mark in word form
  • Colour tone – pantone/focoltone etc – have to decide on code
  • Drawings
  • A device adjoined to the goods

• NON VISUAL REPRESENTATION (sound and scent)
  • In form of graphically represented (quite challenging)
  • Description of mark in word form
  • Pictorial representation – musical notes
  • Recording / specimen for scent?
A NEW APPROACH

A trademark can only be registered if it does not offend –
  • Absolute grounds for refusal of registration
  • Relative grounds for refusal of registration
  • Raising of relative grounds in case of honest concurrent use

For NTTM, absolute grounds besides being devoids of any distinctive character
  • will be the inability from being represented graphically
  • In case of shapes, it cannot be
    • Result from the nature of the goods themselves
    • Which is necessary to obtain a technical result
    • Which gives substantial value to the goods

so that in the public interest, the natural, technical solution, functional and ornamental shape can be used by all – no monopoly
• ISSUES
  • There are few concerns that need to be addressed, with the expansion of the definition of trademarks by including non traditional trademarks:
    • Formalities Stage:
      • a standard and precise documentation during the submission of the TM applications
      • Method & format of applications vary based on the type of NTTM
      • Data entry in the system
    • Substantive Examination stage:
      • Standardization of examination at the Search & Examination stage
      • Capable and technologically improved search system that to be used by the examiners (major revamp in the system is required in order to cater these substantial changes)
      • Necessary technical conditions for the performance of expert examination
      • Publication of relevant information
    • Post Registration stage:
      • Storage of documentation
CONCLUSION

With the new trademark bill 2019, it allows for the possibility of registration of non-traditional trademarks. It gives the owner of such trademarks an edge in the competitiveness within the market place. However, allowing total freedom in the registration of non-traditional trademarks is risky because applicants may start abusing their rights and registering everything and anything and this situation may lead to adverse consequences, such as the establishment of a monopoly on a certain color, sound, smell, etc.