

# 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 106<sup>th</sup> member state to the Madrid Protocol. The Trademarks Bill 2019 was passed in House of Representatives on 2<sup>nd</sup> of July and the Senate approved the Bill on 23<sup>rd</sup> 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

# NON-TRADITIONAL TRADEMARK (NTTM)

- 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

- graphically represented

must be

- 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 ?

# NTTM

- 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 so that in the public interest, the natural, technical solution, functional and ornamental shape can be used by all – no monopoly
    - Result from the nature of the goods themselves
    - Which is necessary to obtain a technical result
    - Which gives substantial value to the goods

# NTTM

- ISSUES

- There are few concerns that needs 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.