



Conference on the Collective Management of Copyright and Related Rights in South- East Asia

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- Updates on Recent Developments in the IP Landscape in Malaysia

Trade Marks Bill 2019

- *When the Trademarks Bill 2019 is passed, the old Trade Marks Act 1976 ("the Old Act") will be repealed in its entirety.*
- *Will be in force October 2019.*
- *Madrid Protocol likely to be in force in January 2020.*

Highlights

- *Applications for non-traditional marks (e.g. shape of goods, colour, sound, scent, hologram, positioning, sequence of motion) will be possible;*
- *Multi-class application will be allowed.*
- *An application may upon the request of the applicant/registered proprietor be divided into two or more applications.*
- *Two or more separate applications may upon the request of the applicant/registered proprietor be merged into one application.*

Highlights

- *Association of trade marks under the Old Act will be disregarded or in other words, registered marks which were associated with each other under the Old Act shall cease to have effect.*
- *A registered trademark is valid in all respect after the expiration of 5 years from the date of registration. This is reduced from 7 years under the Old Act.*
- *Any aggrieved person may apply for relief for groundless threats of infringement proceedings.*

Highlights

- *Trademark applications and registered trademarks are personal or movable property and may be subject to security interest.*
- *Express trust involving trademark applications or registered trademarks may be entered in the Register.*
- *Regulations will be made to give effect to the provisions of the Madrid Protocol in Malaysia.*

Highlights

- *Well-known trademarks are protected whether or not they are registered and whether or not the proprietor carries on business or has any goodwill in Malaysia.*
- *Well-known mark proprietor can restrain by injunction the use of any identical/similar trademark in Malaysia in the course of trade.*

Highlights

- *Counterfeiting a trademark is an offence under the Trademarks Bill and upon conviction will be liable to a fine not exceeding one million ringgit (approximately USD240,000) or to imprisonment not exceeding 5 years or both.*

Highlights

- *Other offences include falsely applying a registered trademark to goods/services;*
- *Making or possessing article specifically designed to make copies of a registered trademark [Note: for possession, there must be 3 or more of such goods];*
- *Importing, selling or possessing any goods with falsely applied trademark;*
- *Making or causing false entries to be made to Trademarks Office or in Register;*
- *Falsely representing trademark as registered.*

Take aways

- *Wait for Trade Mark bill to be in force to file non-traditional marks e.g. 3d marks.*
- *Consider non-traditional marks in your portfolio.*
- *Prepare for Madrid Protocol (Where to file?)*

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